

## Italy: the Ministry for the Economic Development issues the Decree on the patent substantive search

Today, on the Italian Patent and Trademark Office website, the Decree of June 18, 2008, establishing the substantive search for all the new Italian patent applications, has been published.

The search will affect all the patent application filed on or after July 1st, 2008

The text of the Decree contains many procedural details for this kind of search, representing an absolute and remarkable change in the Italian patent system. In particular, the following remarks should be considered:

- the search is carried out only for those applications not claiming any priority (first applications);
- at the filing, it is requested to show the proof of the fee payment, particularly the filing fee, the search fee (&euro; 200,00) and the claim fee (&euro; 45,00 for each claim exceeding the tenth claim);
- the search fee is not due if a translation into English of the claim is provided;
- a lack in search fee payment is interpreted as the intention of filing such English translation within two months from the filing date;
- the application is transmitted to the EPO within five months from the filing date;
- the IPTO has the power of not transmitting to the EPO those applications at first sight concerning non-patentable inventions, on the basis of the statements in the application and considering only the well-known prior art;
- in such a case, the IPTO transmits to the applicant observations concerning the patentability, giving a term for the reply;
- the specification, the drawings, the claim translation and the possible sequence listing should comply with the formal and physical requirements provided for a EP application;
- the EPO drafts a Search Report as established in the EPC, and a preliminary non-binding opinion on patentability according to the PCT standard;
- in case of more than one invention claimed in the application, the EPO carries out the search only on the first claimed invention, no supplementary search is provided;
- the IPTO transmits the Search Report "without delay" to the applicant, as long as the EPO send it to the IPTO - the EPO should draft the Search Report in nine months after the filing date;
- only before the publication (i.e. within 18 months from the filing date), the applicant has the opportunity to amend the application and/or to file arguments in support of the patentability and/or to file possible divisional application(s) and this documentation is made available to the public;
- after, the UIBM starts the substantive examination (another absolute change in Italy), possibly sending written remarks to the applicant and giving a term for the reply;
- in case of refusal, the decision can be appealed to the IPTO Board of Appeal;
- guidelines for the examination will be soon drafted and made available to the public, to assist both the examiners and the applicant in the new substantive examination procedure.