Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

First Name:

[redacted]

Last Name:

[redacted]

Country:

Italy

IP Office

Ministry of Enterprises Italian patent and Trademark Office

Job title

Head Divisione 5 Patents

Email address:

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

i) Study on the determination of inventorship and conditions of foreign filing, with a view to identifying potential challenges for innovators in the cross-border collaborative environment

1. Which of the following does the applicable legal framework in your jurisdiction require before a patent application can be filed in another country or at a regional patent organization?

Foreign filing license
'First filing' or first domestic filing requirement (FDFR)

2. With which specific authority or government body must a request for a foreign filing license be filed?

The request must be filed with the Italian patent and Trademarks Office, but the assessment and the fnal decision above the foreign filing is carried out by the Ministry of Defence

3. Prior to taking which specific actions must a request for a foreign filing license be filed?

Prior to file a patent application in foreign countries if a first domestic filing has not been done.

4. Please list the statutes or guidance documents that patent applicants in your country can consult to inform themselves of the foreign filing requirements and the procedure to follow.

Industrial Property Code (legislative Decree n. 30/2005, as amended by Law n. 102/2023) in particular , art. 198.
see also https://uibm.mise.gov.it/index.php/it/i-servizi/deposito-estero

5. Please list the most important case law on foreign filing conditionality requirements, if any, with a brief summary of the main findings.

n.a.

Do you have a digital copy of the case law that you could upload?

No

Please provide below the exact citation of the case law, or provide an online link to the case law.

n.a.

6. What specific criteria will trigger the Foreign Filing Conditionality?

Impact on the country's national security or national defense;
Nationality or residency of the inventor;
Nationality or residency of the applicant;

Please provide any further details on the scope of the specific criteria applicable in your jurisdiction.

see Industrial Property Code (legislative Decree n. 30/2005, as amended by Law n. 102/2023) in particular , art. 198.

7. Does your law allow for a deemed license or automatic approval, if the Office does not act or respond within a specific time period?

No

8. What specific forms or documents must an applicant submit to request a foreign filing license?

The authorization request must be filed when there is not a previous first domestic filing of the specific application . Both paper and electronic filings are available.
Description, drawings, if any, and claims, must be attached to the request.
see https://uibm.mise.gov.it/images/circolari/Circolare_612.pdf

9. What are the legal consequences if an applicant files a patent application abroad without obtaining a required foreign filing license?

specific sanctions could be decided by the jurisdictional authorities

In cases where two or more countries' foreign filing requirements appear to apply, how is the conflict handled?

n.a.

10. Does your legislation provide a mechanism for obtaining a retroactive foreign filing license?

No

11. Does the foreign filing license requirement prevent the transfer of technical data, experimental results, or invention disclosures that convey the substance of the invention to foreign entities (such as foreign patent agents) prior to obtaining the license?

No

12. If a foreign filing license is denied, does this decision also impose a prohibition on the export of the underlying technical information or know-how (cross-border technology transfer)?

Yes

Please refer to the relevant legislation, regulation, or practice and procedure.

n.a.

13. Are there instances of denial of foreign filing licenses in your jurisdiction ?

Yes

14. If a foreign filing license is denied, what legal consequences follow for the invention and/or any related domestic patent application?

see Industrial Property Code (legislative Decree n. 30/2005, as amended by Law n. 102/2023) in particular , art. 198.

15. Is there any mechanism in place under the applicable legal framework in your jurisdiction to compensate for the loss of opportunity of obtaining a patent if a foreign filing license is denied?

Yes

What is the procedure to obtain compensation and what are the factors that are taken into account when determining the nature and extent of compensation?

see Industrial Property Code (legislative Decree n. 30/2005, as amended by Law n. 102/2023) in particular , art. 198.

16. Does your jurisdiction's patent law provide for the imposition of a "Secrecy Order" (or other similar national security restrictions) that prohibits or restricts an applicant from filing for patent protection in other jurisdictions?

Yes

What is the nature/impact of this restriction regarding foreign filing?

see Industrial Property Code (legislative Decree n. 30/2005, as amended by Law n. 102/2023) in particular , art. 198.

17. Please cite, if available, any official studies, policy documents, or reports which highlight the working of the foreign filing requirements in your jurisdiction.

n.a.

If a digital copy is available, please provide the link or upload it here

Circolare_612.pdf

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.