

Legislative Decree No 30 of 10 February 2005

**‘Industrial property code, pursuant to Article 15 of Law 12
December 2002, No 273’**

published in *Official Gazette* No 52 of 4 March 2005 — Ordinary Supplement No 28

THE PRESIDENT OF THE REPUBLIC

Having regard to Articles 76 and 87 of the Constitution;

Having regard to Law No 273 of 12 December 2002 laying down measures to promote private initiative and the development of competition, as amended by Article 2(8) of Law No 186 of 27 July 2004 on the conversion into law, with amendments, of Decree-Law No 136 of 28 May 2004 and as further amended by Article 2 of Law No 306 of 27 December 2004, converting into law, with amendments, Decree-Law No 266 of 9 November 2004, and in particular Article 15 thereof, delegating to the Government for the reorganisation of provisions on industrial property;

Having REGARD TO Article 14 of Law No 400 of 23 August 1988 regulating the activities of the Government and the organisation of the Prime Minister’s Office;

Having regard to Royal Decree No 1127 of 29 June 1939;

Having regard to Royal Decree No 244 of 5 February 1940;

Having regard to Royal Decree No 1411 of 25 August 1940;

Having regard to Royal Decree No 1354 of 31 October 1941;

Having regard to Royal Decree No 929 of 21 June 1942;

Having regard to Presidential Decree No 795 of 8 June 1948;

Having regard to Presidential Decree No 540 of 30 June 1972;

Having regard to Presidential Decree No 974 of 12 August 1975;

Having regard to Presidential Decree No 32 of 8 January 1979;

Having regard to Presidential Decree No 338 of 22 June 1979;

Having regard to Law No 194 of 3 May 1985;

Having regard to Law No 620 of 14 October 1985;

Having regard to Law No 60 of 14 February 1987;

Having regard to Law No 70 of 21 February 1989;

Having regard to Law No 349 of 19 October 1991;

Having REGARD TO Presidential Decree No 595 of 1 December 1993;

Having regard to Presidential Decree No 360 of 18 April 1994;

Having regard to Presidential Decree No 391 of 18 April 1994;

Having regard to Law No 890 of 21 December 1984;

Having regard to Legislative Decree No 164 of 12 April 2001;

Having regard to paragraphs 8, 8-*bis*, 8-*ter* and 8-*c* of Article 3 of Decree-Law No 63 of 15 April 2002, converted, with amendments, into Law No 112 of 15 June 2002;

Having REGARD TO the Decree of the Minister for Production Activities of 17 October 2002, published in *Official Gazette* No 253 of 28 October 2002;

Having REGARD TO the preliminary deliberation of the Council of Ministers, adopted at its meeting of 10 September 2004;

Having heard the opinion of the Council of State, expressed at the general meeting of 25 October 2004;

Having obtained the opinion of the Unified Conference, as referred to in Article 8 of Legislative Decree No 281 of 28 August 1997, expressed at its meeting of 28 October 2004;

Having obtained the opinions of the competent committees of the Chamber of Deputies, expressed on 22 December 2004 and of the Senate of the Republic, expressed on 21 December 2004;

Having REGARD TO the deliberation of the Council of Ministers adopted at its meeting of 23 December 2004;

On the proposal of the Minister for Productive Activities, in agreement with the Ministers of Justice, Economy and Finance, Foreign Affairs and the Civil Service;

E m t o n a
the following legislative decree:

Chapter I

GENERAL PROVISIONS AND FUNDAMENTAL PRINCIPLES

Art. 1.

Industrial property rights

1. For the purposes of this Code, the expression industrial property includes trademarks and other distinguishing signs, geographical indications, designations of origin, designs, inventions, utility models, topographies of semiconductor products, confidential business information and new plant varieties.

Article 2.

Establishment and purchase of rights

2. Industrial property rights are acquired by patenting, registration or other means provided for in this Code. Patenting and registration give rise to industrial property rights.

3. Inventions, utility models and new plant varieties are patented.

4. Trade marks, designs and topographies of semiconductor products shall be subject to registration.

5. Distinctive signs other than the registered trade mark, confidential business information, geographical indications and designations of origin shall be protected, subject to legal requirements.

6. The administrative activity of patenting and registration is a constitutive finding and gives rise to certificates subject to a special system of invalidity and revocation on the basis of the rules contained in this Code.

Article 3.

Treatment of foreign nationals

1. Nationals of each State party to the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or of the World Trade Organisation and to nationals of States not party to those Conventions, but who are domiciled or have an industrial or commercial establishment effective in the territory of a State party to the Paris Union Convention for the Protection of Industrial Property, shall be accorded, in respect of the matters referred to in this Code, the same treatment as Italian nationals. In the field of new plant varieties, the treatment accorded to Italian nationals is granted to nationals of a State party to the International Convention for the Protection of New Varieties of Plants UPOV, Geneva text of 19 March 1991, ratified by Law No 110 of 23 March 1998. As regards topographies of semiconductor products, the treatment accorded to Italian nationals shall be accorded to nationals of another State only if the protection afforded by that State to Italian nationals is similar to that provided for in this Code.
2. Nationals of States not party to the Paris Union Convention for the Protection of Industrial Property, of the World Trade Organisation or of new plant varieties to the International Convention for the Protection of New Varieties of Plants shall be accorded, in respect of the matters referred to in this Code, the treatment accorded to Italian nationals if the State to which the national belongs grants Italian nationals reciprocal treatment.
3. All the benefits that the international conventions signed and ratified by Italy confer to the foreign national in the territory of the State, for the matters referred to in this Code, are automatically extended to Italian nationals.
4. The right to obtain under international conventions the registration in Italy of a trade mark previously registered abroad, to which reference is made in the application for registration, belongs to the proprietor of the trade mark abroad, or to his successor in title.
5. Legal persons of corresponding nationality shall be treated as citizens.

Article 4.

Priorities

1. Any person who has duly filed, in or for a State which is party to an international convention ratified by Italy recognising the right of priority, an application for industrial property title or successor in title, shall enjoy a right of priority as from the first application for filing an application for an invention patent, a utility model, a plant variety right, registration of a design or trade mark, in accordance with the provisions of Article 4 of the Paris Union Convention.
2. The priority period shall be twelve months for invention patents and utility models and plant varieties, six months for designs and trademarks.
3. Any deposit having the value of a regular national deposit, that is to say, capable of determining the date on which the first application was lodged, in accordance with the national law of the State in which it was made, or bilateral or plurilateral agreements, shall be recognised as capable of giving rise to the right of priority.

Art. 5.

Exhaustion

1. The exclusive powers conferred by this Code on the holder of an industrial property right shall be exhausted once the products protected by an industrial property right have been placed on the market by the holder or with his consent in the territory of the State or territory of a Member State of the European Community or of the European Economic Area.
2. However, this limitation of the proprietor's powers does not apply to the trade mark where there are legitimate grounds for the proprietor to oppose the further marketing of the goods;

in particular where the state of these products is altered or altered after they have been placed on the market.

3. The exclusive powers conferred on the breeder of a protected variety and of varieties essentially derived from the protected variety where it is not, in turn, an essentially derived variety, to the breeder of varieties which do not clearly differ from the protected variety and to the breeder of varieties whose production requires the repeated use of the protected variety shall not extend:

- a) propagating or vegetative propagating material, whatever its form;
- b) the product of the harvest, including whole plants and parts thereof;
- c) any product produced directly from the product of the collection, and
- d) to any other material derived from those specified which has been sold or marketed by the same breeder or with his consent in the territory of the State or of a Member State of the European Community or of the European Economic Area, except in the case of acts involving a new reproduction or multiplication of the protected variety or an export of the material of the variety in order to reproduce it in a State which does not protect the variety of the genus or plant species to which it belongs, unless the exported material is intended for consumption.

Article 6.

Communion

1. If an industrial property right belongs to several subjects, the relative powers are governed, unless otherwise agreed, by the provisions of the Civil Code relating to community ownership as compatible.

Chapter II

RULES ON THE EXISTENCE, SCOPE AND EXERCISE OF RIGHTS INDUSTRIAL PROPERTY

Section I

TRADE MARKS

Art. 7.

Subject of registration

1. All signs capable of being represented graphically, in particular words, including personal names, drawings, letters, numerals, sounds, the shape of the goods or of the packaging thereof, combinations or colour tones may be registered as a trade mark, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Art. 8.

Portraits of people, names and well-known signs

2. Portraits of persons may not be registered as trademarks without their consent and, after their death, without the consent of their spouse and children; in their absence or after their death, parents and other ascendants, and, in the absence or after the death of the latter, relatives up to and including the fourth degree.

3. Names of persons other than those of those applying for registration may be registered as trade marks, provided that their use is not such as to damage the reputation, credit or decorum of those entitled to bear such names. However, the Italian Patent and Trade Mark Office may make the registration subject to the consent set out in paragraph 1. In any case, the registration will not prevent anyone entitled to the name from using it in the company he has chosen.

4. If known, they may be registered as a trade mark only by the person entitled, or with the consent of the latter, or of the persons referred to in paragraph 1: names of persons, signs used in the artistic, literary, scientific, political or sporting fields, the names and acronyms of manifestations and those of bodies and associations not having economic purposes, as well as the emblems characteristic of these.

Art. 9.

Shape Marks

1. Signs consisting exclusively of the shape imposed by the nature of the goods, the shape of the goods

necessary to obtain a technical result, or the shape giving substantial value to the goods, may not be registered as a trade mark.

Article 10.
Coat of arms

2. The coat of arms and other signs referred to in the relevant international conventions, in the cases and under the conditions laid down in those conventions, and signs containing symbols, emblems and coat of arms which are of public interest cannot be registered as a trade mark unless the competent authority has authorised their registration.
3. As a trade mark containing words, figures or signs with a political or high symbolic significance, or containing heraldic elements, the Italian Patent and Trade Mark Office shall, prior to registration, send the copy of the trade mark and whatever else may be required by the public authorities concerned, or competent, in order to hear the notice, in accordance with the provisions of paragraph 4.
4. The Italian Patent and Trade Marks Office may provide for the terms of paragraph 2 in any case where there is doubt that the trade mark may be contrary to public policy or morality.
5. If the administration concerned, or competent, referred to in paragraphs 2 and 3, expresses an opinion contrary to the registration of the trade mark, the Italian Patent and Trade Mark Office shall reject the application.

Art. 11.
Collective mark

1. Persons carrying out the function of guaranteeing the origin, nature or quality of certain goods or services may obtain registration for appropriate trade marks as collective marks and may grant the use of the marks to producers or traders.
2. Regulations on the use of collective marks, controls and penalties must be attached to the application for registration; regulatory amendments must be communicated by the proprietors to the Italian Patent and Trademark Office in order to be included in the documents attached to the application.
3. The provisions of paragraphs 1 and 2 shall also apply to foreign collective marks registered in the country of origin.
4. By way of derogation from Article 13(1), a collective mark may consist of signs or indications which may be used in trade to designate the geographical origin of the goods or services. In such a case, moreover, the Italian Patent and Trade Marks Office may, by reasoned decision, refuse registration where the trade marks applied for may create situations of unjustified privilege or otherwise adversely affect the development of other similar initiatives in the region. The Italian Patent and Trade Mark Office may request notice from the public administrations, categories and bodies concerned or competent. The registration of the collective trade mark consisting of a geographical name does not entitle the proprietor to prohibit third parties from using that name in the course of trade, provided that that use complies with the principles of professional correctness and thus limited to the function of indication of origin.
5. Collective marks are subject to all other provisions of this Code as they do not conflict with their nature.

Art. 12.
News

1. Signs which, on the date of filing of the application, are not new within the meaning of Article 7:
 - a) consist exclusively of signs which have become commonly used in the current language or in the constant uses of trade;

b) are identical or similar to a sign already known as a trade mark or distinctive sign of goods or services manufactured, put on the market or supplied by others for identical or similar goods or services, if by reason of the identity or similarity between the signs and the identity or similarity between the goods or services a likelihood of confusion on the part of the public can arise, which may also consist of a likelihood of association between the two signs. The trade mark is also known as the trade mark which, under Article 6*bis* of the Convention of the Paris Union for Industrial Property, revised at Stockholm on 14 July 1967, ratified by Law No 424 of 28 April 1976, is well known to the public concerned, including by virtue of the reputation acquired in the State through the promotion of the trade mark. Previous use of the sign, when it does not import a reputation of the sign, or amounts of purely local reputation, does not detract from the novelty, but the third party pre-user is entitled to continue the use of the trade mark, including for the purposes of advertising, within the limits of local distribution, notwithstanding the registration of the mark itself. Prior use of the sign by the applicant or his predecessor is not an obstacle to registration;

c) are identical or similar to a sign already known as a trade name, trade name or business name, adopted by others, if by reason of the identity or similarity between the signs and the identity or similarity between the business activity carried out by them and the goods or services in respect of which the trade mark is registered there may be a likelihood of confusion on the part of the public, which may also consist of a likelihood of association between the two signs. The previous use of the sign, when it does not import any reputation of it or amounts purely local reputation, does not remove the novelty. Prior use of the sign by the applicant or his predecessor is not an obstacle to registration;

d) are identical with a trade mark already registered in the State or effective in the State following an application filed at an earlier date or having effect from an earlier date by virtue of a right of priority or a valid seniority claim for identical goods or services;

e) are identical or similar to a trade mark already registered in the State or with effect in the State by others, following an application filed at an earlier date or having effect from an earlier date on the basis of a right of priority or a valid seniority claim for identical or similar goods or services, if because of the identity or similarity between the signs or the identity or similarity between the goods or services a likelihood of confusion on the part of the public can arise, which may also consist of a likelihood of association between the two signs;

f) are identical or similar to a trade mark already registered in the State or with effect in the State by others, following an application filed at an earlier date or having effect from an earlier date under a right of priority or a valid seniority claim for goods or services, whether or not similar, where the earlier trade mark enjoys in the Community, whether Community, or in the State, of reputation and where the use of the subsequent trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier sign;

g) are identical with, or similar to, a trade mark already well known within the meaning of Article 6-*bis* of the Paris Union Convention for Industrial Property, goods or services, whether or not similar, where the conditions laid down in point (*g*) are fulfilled;

h) in the cases referred to in points (*d*) and (*e*) , the earlier trade mark which has expired for more than two years or three if it is a collective mark or can be considered to have been revoked for non-use within the meaning of Article 26 when the application or objection of invalidity is filed shall not remove the novelty.

2. For the purposes referred to in paragraph 1(*d*), (*e*) and (*f*), earlier applications shall be treated as earlier trade marks registered, subject to subsequent registration.

Art. 13.

Distinctive capacity

1. Signs which are devoid of any distinctive character, and in particular those consisting exclusively of generic names of goods or services or descriptive indications referring to them, such as signs which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of manufacture of the goods or of the service or other characteristics of the goods or service may not be registered as a trade mark.

2. By way of derogation from paragraph 1 and Article 12(1)(*a*), signs which, as a result of the use made of them, have acquired distinctive character prior to the application for registration may be registered as a trade mark.
3. A trade mark may not be declared invalid or declared invalid if, as a result of the use made of it, the sign forming the subject matter of the application or objection of invalidity has acquired distinctive character.
4. The trade mark shall be revoked if, as a result of the proprietor's activity or inactivity, the trade mark has become a generic name of the product or service or has lost its distinctive character.

Art. 14.
Lawfulness

1. The following may not be registered as a trade mark:
 - a*) signs contrary to law, public policy or morality;
 - b*) signs liable to mislead the public, in particular as to the geographical origin, nature or quality of the goods or services;
 - c*) signs the use of which would constitute an infringement of another person's copyright, industrial property or other exclusive right of third parties.
2. The trade mark shall lapse:
 - a*) has become liable to mislead the public, in particular as to the nature, quality or provenance of the goods or services, by reason of the manner and context in which it is used by the holder or with his consent, for the goods or services for which it is registered;
 - b*) whether it has become contrary to law, public policy or morality;
 - c*) by omission by the proprietor of the controls provided for by the regulatory provisions on the use of the collective mark.

Art. 15.
Effects of registration

1. The exclusive rights covered by this code are conferred upon registration.
2. The first registration shall take effect from the date of filing of the application. In the case of renewal, it shall take effect from the date of expiry of the previous registration.
3. Without prejudice to Article 20(1)(*c*), registration shall have effect only to the goods or services indicated in the registration itself and to the related goods or services.
4. Registration shall last 10 years from the date of filing of the application, except in the case of withdrawal by the holder.
5. The waiver becomes effective by its entry in the Register of Trade Marks and it must be reported in the Official Bulletin.

Art. 16.
Renewal

1. Registration may be renewed for the same earlier mark, in respect of the same kind of goods or services according to the International Classification of Goods and Services resulting from the Nice Agreement, Geneva text of 13 May 1977, ratified by Law No 243 of 27 April 1982.
2. Renewal shall take place for periods of ten years.
3. The renewal of registration of a trade mark which has been transferred in respect of part of the goods or services shall be carried out separately by the respective proprietors.

4. The date and duration of the effects of registration for trademarks registered with the World Intellectual Property Organisation in Geneva remain unchanged.

Art. 17.

International registration

1. For the registration of trademarks with the World Intellectual Property Organisation in Geneva (WIPO), the provisions in force under the international conventions remain unchanged.
2. International trade marks registered with the World Intellectual Property Organisation (WIPO) in Geneva, on the basis of the Madrid Agreement concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976 and its Protocol, adopted in Madrid on 27 June 1989, ratified by Law No 169 of 12 March 1996, designating Italy as the country in which protection is sought, shall comply with the requirements laid down for national trade marks under this Code.
3. The Italian Patent and Trade Mark Office shall carry out the examination of international trade marks designating Italy in accordance with the provisions applicable to national trade mark applications.

Art. 18.

Temporary protection

1. Within the limits and under the conditions set out in paragraph 2, temporary protection may be granted, by decree of the Minister for Production Activities, to new marks affixed to products or materials inherent in the provision of services appearing in national or international exhibitions, official or officially recognised, held in the territory of the State or in a foreign State which accords reciprocal treatment.
2. Temporary protection shall give priority to the registration, in favour of the holder or his successor in title, on the day of delivery of the product or material relating to the provision of the exhibition service, and shall take effect provided that the application for registration is filed within six months of the date of delivery and, in any event, no later than six months from the date of opening of the exhibition.
3. In the case of exposure held in a foreign State, if a shorter period is set there, the application for registration must be filed within that period.
4. Among several identical or similar marks for identical or similar goods or services presented for exhibition on the same day, priority shall be given to the trade mark for which the application for registration was first filed.
5. The dates referred to in paragraphs 2, 3 and 4 must be indicated by the person concerned and mentioned in the registration certificate, after verification by the Italian Patent and Trade Mark Office.

Art. 19.

Right to registration

1. Any person using it or proposing to use it may be registered as a trade mark in the manufacture or trade in goods or in the provision of services of his own undertaking or of undertakings over which it is in control or using it with its consent.
2. A person who has made the application in bad faith may not obtain a trade mark registration.
3. The administrations of the State, regions, provinces and municipalities may also obtain trade mark registrations.

Art. 20.

Rights conferred by registration

1. The rights of the proprietor of the registered trade mark consist of the right to make exclusive use of the trade mark. The holder shall have the right to prohibit third parties, unless they consent, from using in the economic activity:

- a) a sign identical with the trade mark for goods or services identical with those for which it was registered;
 - b) a sign identical with, or similar to, the registered trade mark, for identical or similar goods or services, if by reason of the identity or similarity of the signs and the identity or similarity between the goods or services a likelihood of confusion on the part of the public can arise, which may also consist of a likelihood of association between the two signs;
 - c) a sign identical with or similar to the trade mark registered for goods or services, whether or not similar, if the registered trade mark enjoys a state of renown and if use of the sign without due cause makes it possible to take unfair advantage of, or is detrimental to, the distinctive character or reputation of the mark.
2. In the cases referred to in paragraph 1, the proprietor of the trade mark may in particular prohibit third parties from affixing the sign to the goods or their packaging; to offer the goods, to place them on the market or to hold them for such purposes, or to offer or provide the services covered by the sign; to import or export goods bearing the sign itself; to use the sign in commercial correspondence and advertising.
3. The trader may affix his trade mark to the goods he offers for sale, but may not delete the trade mark of the manufacturer or trader from whom he received the goods or goods.

Art. 21.

Limitations on trade mark rights

1. Registered trade mark rights shall not allow the proprietor to prohibit third parties from using in the economic activity:
- a) their name and address;
 - b) indications relating to the species, quality, quantity, intended purpose, value, geographical origin, the time of manufacture of the goods or the performance of the service or other characteristics of the goods or service;
 - c) the trade mark if it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided that the use complies with the principles of professional fairness.
2. It is not permitted to use the trade mark in a manner contrary to the law, or, in particular, to create a likelihood of confusion on the market with other signs known as distinguishing undertakings, goods or services, or in any event to mislead the public, in particular as to the nature, quality or origin of the goods or services, by reason of the way and context in which it is used, or to harm another person's copyright, industrial property or other exclusive right of third parties.
3. Any person shall be prohibited from making use of a registered trade mark after its registration has been declared invalid, where the ground for invalidity leads to the unlawfulness of the use of the trade mark.

Art. 22.

Unity of distinctive signs

1. It is prohibited to adopt as a trade name, name or business name a sign equal to or similar to the other trade mark if, by reason of the identity or similarity between the business activity of the proprietors of those signs and the goods or services for which the trade mark is adopted, there is a likelihood of confusion on the part of the public which may also consist of a likelihood of association between the two signs.
2. The prohibition referred to in paragraph 1 shall extend to the adoption as a company, name or business name, sign and business name of a sign equal to or similar to a trade mark registered for goods or services, whether or not similar, which enjoys in the State of renown if use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the mark.

Art. 23.

Transfer of the trade mark

1. The trade mark may be transferred in respect of all or part of the goods or services for which it is registered.
2. The trade mark may also be the subject of a non-exclusive licence in respect of all or part of the goods or services for which it is registered and for all or part of the territory of the State, provided that, in

in the case of a non-exclusive licence, the licensee expressly undertakes to use the trade mark to distinguish goods or services which are similar to those put on the market or supplied in the territory of the State with the same trade mark by the proprietor or other licensees.

3. The proprietor of the trade mark may invoke the right to exclusive use of the trade mark against the licensee who infringes the provisions of the licence agreement as regards duration; the manner in which the trade mark is used, the nature of the goods or services for which the licence is granted, the territory in which the trade mark may be used or the quality of the goods and services provided by the licensee.

4. In any event, the transfer and licence of the trade mark must not mislead those characteristics of goods or services which are essential in the public's appreciation.

Art. 24.

Use of the trademark

1. On pain of revocation, the trade mark must be put to genuine use by the proprietor or with his consent, in respect of the goods or services for which it is registered, within five years of registration, and such use shall not be suspended for an uninterrupted period of five years, unless the non-use is justified by a legitimate reason.

2. For the purposes referred to in this Article, use of the trade mark in a modified form which does not alter its distinctive character and the affixing in the State of the trade mark to the goods or their packaging for the purpose of exporting them shall be treated as use of the trade mark.

3. Except in the case of rights acquired in the trade mark by third parties through filing or use, revocation may not be enforced where genuine use of the trade mark has commenced or resumed between the expiry of the five-year period of non-use and the lodging of the application or objection of revocation. However, if the proprietor makes preparations for the commencement or resumption of use of the trade mark only after knowing that the application or objection of revocation is about to be filed, such commencement or resumption shall not be taken into account unless it has been made at least three months before the application or objection of revocation is filed; however, that period is relevant only if it has elapsed after the expiry of the five-year period of non-use.

4. Nor will there be revocation for non-use if the proprietor of the unused trade mark is the proprietor, at the same time, of another or other similar trade marks still in force of at least one of which actually uses the same goods or services.

Art. 25.

Nullity

1. The mark shall be invalid:

- a) if one of the requirements laid down in Article 7 is missing or if one of the impediments provided for in Article 12 is present;
- b) is contrary to the provisions of Articles 9, 10, 13, 14(1) and 19(2);
- c) if it is contrary to the provisions of Article 8;
- d) in the case of Article 118(3)(b).

Art. 26.

Forfeiture

1. The brand expires:

- a) by vulgarisation pursuant to Article 13(4);
- b) for unlawfulness in accordance with Article 14(2);
- c) for non-use pursuant to Article 24.

Art. 27.

Revocation and partial nullity

1. Where the grounds for revocation or invalidity of a trade mark exist in respect of only part of the goods or services for which the trade mark is registered, the revocation or invalidity concerns only that part of the goods; or

services.

Art. 28.
Validation

2. The proprietor of an earlier trade mark within the meaning of Article 12 and the proprietor of a pre-use right with a reputation which is not purely local and who have, for five consecutive years, tolerated, being aware of, the use of a later registered trade mark equal or similar, may not apply for a declaration of invalidity of the later trade mark or oppose the use thereof in respect of the goods or services in respect of which that trade mark was used on the basis of his earlier trade mark or pre-use, unless the later trade mark has been applied for in bad faith. The proprietor of the later trade mark may not oppose the use of the earlier mark or the continuation of the pre-use.
3. The provisions of paragraph 1 shall also apply to the case of a trade mark registered in breach of Articles 8 and 14(1)(c).

Section II
GEOGRAPHICAL INDICATIONS

Art. 29.
Subject-matter of protection

1. Geographical indications and designations of origin identifying a country, region or locality shall be protected where they are adopted to designate a product originating there and whose qualities, reputation or characteristics are due exclusively or essentially to the geographical environment of origin, including natural, human and traditional factors.

Art. 30.
Protection

1. Without prejudice to the rules governing unfair competition, without prejudice to the relevant international conventions and without prejudice to trade mark rights previously acquired in good faith, the use of geographical indications and designations of origin and the use of any means in the description or presentation of a product which indicate or suggest that the product originates from a place other than the true place of origin shall be prohibited, or that the product has the qualities which are characteristic of products originating from a place designated by a geographical indication.
2. The protection referred to in paragraph 1 shall not prevent third parties from using in the economic activity their name or the name of their predecessor in that activity, unless that name is used in such a way as to mislead the public.

Section III
DESIGNS

Art. 31.
Subject of registration

1. The appearance of the entire product or part thereof as shown, in particular, by the characteristics of the lines, contours, colours, shape, surface structure or materials of the product or of its ornament may be registered as designs, provided that they are new and have an individual character.
2. A product means any industrial or craft object, including, inter alia, components which must be assembled to form a complex product, packaging, presentations, graphic symbols and typefaces, excluding computer programs.
3. A complex product is a product consisting of several components that can be replaced, allowing disassembly and reassembly of the product.

Article 32.

What's new

1. A design shall be new if no identical design has been disclosed before the date of filing of the application for registration or, where priority is claimed, before the date of the application for registration. Designs shall be deemed to be identical where their characteristics differ only in irrelevant details.

Art. 33.

Individual character

2. A design shall have individual character if the overall impression it gives on the informed user differs from the overall impression produced on that user by any design which was disclosed before the date of submission of the application for registration or, where priority is claimed, before the date of the date of the filing of the application for registration.

3. When determining the individual character referred to in paragraph 1, the degree of freedom which the designer has enjoyed in the design of the design shall be taken into account.

Art. 34.

Disclosure

1. For the purposes of Articles 32 and 33, a design shall be deemed to have been disclosed if it has been made available to the public as a result of registration or otherwise, or if it has been exhibited, marketed or otherwise made public, unless such events could reasonably have been known to the circles specialised in the sector concerned, operating in the Community, in the normal course of business, before the date of submission of the application for registration or, where priority is claimed, before the date of the application for registration.

2. The design shall not be deemed to be made available to the public solely on the ground that it has been disclosed to a third party under an explicit or implicit constraint of confidentiality.

3. For the purposes of Articles 32 and 33, a design which is disclosed by the author or his successor in title or by any third party on the basis of information or acts carried out by the author or his successor in title during the 12 months preceding the date of submission of the application for registration or, where priority is claimed, within 12 months of the date of submission of the application for registration shall not be deemed to be made available to the public.

4. For the purposes of Articles 32 and 33, disclosure shall also not constitute disclosure if the design has been made available to the public during the 12 months preceding the date of submission of the application or the date of priority, if this results, directly or indirectly, from an abuse committed against the author or his successor in title.

5. Disclosure in official or officially recognised exhibitions under the Convention on International Exhibitions, signed in Paris on 22 November 1928, as amended, shall also not be considered.

Art. 35.

Complex product

1. A design applied or incorporated into the component part of a complex product fulfils the requirements of novelty and individual character only:

a) if the component, once incorporated into the complex product, remains visible during normal use, i.e. during use by the final consumer, excluding maintenance, servicing and repair;

b) whether the visible characteristics of the component in themselves meet the requirements of novelty and individuality.

Art. 36.

Technical function

1. Those characteristics of the appearance of the product which are determined solely by the technical function of the product may not be registered as designs.
2. The characteristics of the appearance of the product which must necessarily be reproduced in their exact shapes and dimensions in order to enable the product in which the design is incorporated or to which it is applied to be joined or mechanically connected with, or be incorporated into or around or in contact with, the product in which the design is incorporated or to which it is applied may not be registered by design in such a way that each product can carry out its function. However, designs which meet the requirements of novelty and individual character may be registered where they are intended to permit the combination or multiple connection of interchangeable products in a modular system.

Art. 37.

Duration of protection

1. The registration of the design shall take five years from the date of submission of the application. The holder may be extended for one or more periods of five years up to a maximum of 25 years from the date of submission of the application for registration.

Art. 38.

Right to registration and effects

1. Exclusive rights to designs shall be granted by registration.
2. The right to registration lies with the designer and its successors in title.
3. Unless otherwise agreed, registration in respect of designs, whether by employees, as part of their duties, is the responsibility of the employer, without prejudice to the employee's right to be recognised as the author of the design and to have his name included in the registration certificate.
4. The registration shall take effect from the date on which the application with the relevant documentation is made available to the public.
5. The Italian Patent and Trade Mark Office shall make available to the public the application for registration with graphic reproductions or samples and any descriptions after filing, provided that the applicant has not excluded accessibility in the application for a period which may not exceed 30 months from the date of filing or the date of priority.
6. In respect of persons to whom the application with the reproduction of the design and any description has been notified by the applicant, the registration shall take effect from the date of such notification.

Art. 39.

Multiple registration

1. Only one application may be applied for registration in respect of several designs, provided that they are intended to be implemented or incorporated into objects included in the same class as the International Design Classification, formed in accordance with the provisions of the Locarno Agreement of 8 October 1968, as amended, ratified by Law No 348 of 22 May 1974.
2. Without prejudice to paragraph 1 and Article 40, an application for several registrations or one single registration for several designs shall not be allowed. If the application is not admissible, the Italian Patent and Trade Mark Office shall invite the person concerned, with a time limit, to limit the application to the eligible party, with the right to submit, for the remaining designs, as many applications that will take effect from the date of the first application.
3. The registration of several models or designs may be limited to one or more of them at the request of the proprietor.

4. An application or registration in respect of a design which does not meet the requirements for validity may, at the request of the proprietor, be maintained in an amended form if the Italian Patent and Trade Mark Office verifies that the design retains its identity in that form. The amendment may also result from partial waiver by the proprietor or from a note on the certificate of registration of a judgment declaring that the registration is partially invalid.

Art. 40.

Simultaneous recording

1. If a design fulfils the requirements of registrability and at the same time increases the usefulness of the object to which it relates, the utility model patent and the registration by design may be applied for at the same time, but both protection cannot be combined in a single title.
2. If the application for registration includes an object the shape or design of which confers on it a new and individual character and at the same time increases its usefulness, the limitation procedure referred to in Article 39(2) shall apply by making the necessary amendments.

Art. 41.

Rights conferred by the design

1. The registration of a design shall confer on the holder the exclusive right to use it and to prohibit third parties from using it without his consent.
2. In particular, the manufacture, offer, marketing, import, export or use of a product in which the design is incorporated or to which it is applied, or the possession of such a product for such purposes, shall constitute acts of use.
3. The exclusive rights conferred by the registration of a design shall extend to any design which does not produce a different overall impression on the informed user.
4. In determining the extent of protection, account shall be taken of the degree of freedom of the designer in the realisation of the design.

Art. 42.

Limitations of the design right

1. The rights conferred by the registration of the design shall not extend to:
 - a) acts carried out in the private sphere and for non-commercial purposes;
 - b) acts carried out for the purpose of testing;
 - c) acts of reproduction necessary for quotations or for educational purposes, provided that they are compatible with the principles of professional correctness, do not unduly prejudice the normal use of the design and indicate the source.
2. The exclusive rights conferred by the registration of the design shall not be enforceable in respect of:
 - a) the furnishing and installations of naval and air locomotives registered in other countries temporarily entering the territory of the State;
 - b) the importation into the State of spare parts and accessories intended for the repair of the means of transport referred to in point (a);
 - c) the execution of repairs on the abovementioned means of transport.

Art. 43.

Nullity

1. The registration is void:
 - a) if the design is not registrable in accordance with Articles 31, 32, 33, 34, 35 and 36;
 - b) if the design is contrary to public policy or to morality; the design cannot be regarded as contrary to public policy or morality solely because it is prohibited by a legal or administrative provision;
 - c) if the holder of the registration was not entitled to obtain it and the author did not make use of the powers granted to him by Article 118;
 - d) if the design conflicts with an earlier design which has been disclosed after the date of submission of the

application or, where priority is claimed, after the date of the application, but the exclusive right of which takes effect from an earlier date as a result of Community, national or international registration or as a result of the relevant application;

- e)* if the design is such that its use would constitute an infringement of a distinctive sign or a work of the intellectual protected by copyright;
- f)* if the design constitutes an improper use of one of the elements listed in Article 6*b* of the *Convention of the Paris Union for the Protection of Industrial Property*, Stockholm of 14 July 1967, ratified by Law No 424 of 28 April 1976, or of signs, emblems and coat of arms other than those referred to in that article and which are of particular public interest in the State.

2. The invalidity of the registration of a design which is the subject of earlier rights within the meaning of paragraph 1(*d*) and (*e*) may be brought solely by the holder of those rights or his successors in title.

3. The invalidity of the registration of a design which constitutes an improper use of one of the elements listed in Article 6*b* of the Paris Convention for Industrial Protection or of signs, emblems and coat of arms which are of particular public interest in the State may be relied on only by the person concerned for use.

Art. 44.

Duration of the right of economic use by copyright

1. The rights of economic use of industrial designs protected under Article 2(1)(10) of Law No 633 of 22 April 1941 shall last for the duration of the author's life and until the end of the 25th calendar year after his death or after the death of the last of the co-authors.

2. The Ministry of Cultural Assets and Activities shall periodically communicate to the Italian Patent and Trade Mark Office the data relating to the works filed pursuant to Article 103 of Law No 633 of 22 April 1941, with reference to the title, the description of the subject and the author, the name, the domicile of the right holder, on the date of publication, as well as any other annotation or transcription.

3. The Italian Patent and Trade Mark Office shall record the data referred to in paragraph 2 in the Official Bulletin, published in accordance with Article 189 of this Code.

Section IV

INVENTIONS

Art. 45.

Patent object

1. New inventions involving inventive activity and capable of industrial application may be patented for inventions.

2. In particular, the following shall not be considered as inventions within the meaning of paragraph 1:

- a)* discoveries, scientific theories and mathematical methods;
- b)* plans, principles and methods for intellectual activities, gaming or commercial activity and computer programs;
- c)* presentations of information.

3. The provisions of paragraph 2 exclude the patentability of what is mentioned in them only to the extent that the patent application or patent relates to discoveries, theories, plans, principles, methods, programs and presentations of information considered as such.

4. Methods for the surgical or therapeutic treatment of the human or animal body and methods of diagnosis applied to the human or animal body shall not be considered as inventions within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or mixtures of substances, for the implementation of one of the methods appointed.

5. Animal breeds and essentially biological procedures for obtaining such breeds and animal breeds cannot be patented. This provision shall not apply to microbiological processes and products obtained by such processes.

Art. 46.

What's new

1. An invention is considered new if it is not included in the state of the art.
2. The state of the art shall consist of everything which has been made available to the public in the territory of the State or abroad before the date of filing of the patent application, by a written or oral description, use or any other means.
3. The content of national patent applications or European or international patent applications which have effect for Italy, as they have been filed, which have a filing date prior to that referred to in paragraph 2 and which have been published or made available to the public also on that date or later shall also be considered to be included in the state of the art.
4. The provisions of paragraphs 1, 2 and 3 do not exclude the patentability of a substance or composition of substances already included in the state of the art, provided that it is re-used.

Art. 47.

Unenforceable disclosures

1. For the purposes of applying Article 46, disclosure of the invention shall not be taken into account if it has occurred within the six months preceding the date of filing of the patent application and results directly or indirectly from an obvious abuse of the detriment of the applicant or his predecessor.
2. Disclosure in official or officially recognised exhibitions under the Convention on International Exhibitions, signed in Paris on 22 November 1928, as amended, shall also not be considered.
3. For inventions for which priority has been claimed under international conventions, the existence of the requirement of novelty must be assessed by reference to the date on which the priority dates.

Art. 48.

Inventive activity

1. An invention is considered to involve an inventive activity if, for a person experienced in the branch, it is not evident from the state of the art. If the state of the art includes documents referred to in Article 46(3), these documents shall not be taken into account for the assessment of the inventiveness.

Art. 49.

Industriality

1. An invention is considered to have an industrial application if its object can be manufactured or used in any kind of industry, including agricultural industry.

Art. 50.

Lawfulness

1. Inventions whose implementation is contrary to public policy or morality may not be the subject of a patent.
2. The implementation of an invention cannot be regarded as contrary to public policy or to morality solely because it is prohibited by a legal or administrative provision.

Art. 51.

Sufficient description

1. The application for a patent for industrial invention must be accompanied by the description and drawings necessary for its intelligence.

2. The invention must be described in a sufficiently clear and complete manner so that any expert in the branch can implement it and must be marked by a title corresponding to its object.

3. Where an invention relates to a microbiological process or to a product obtained by such a process and involves the use of a micro-organism which is not accessible to the public and which cannot be described in such a way as to enable any person with an expert in the branch to implement the invention, the rules laid down in the Regulation shall be observed in the patent application.

Art. 52.

Claims

1. The description must begin with a summary which is for technical information purposes only and must end with one or more claims in which it is specifically stated what is intended to be the subject of the patent.

2. The limits of protection are determined by the content of the claims; however, the description and drawings serve to interpret the claims.

3. The provision of paragraph 2 must be understood in such a way as to ensure at the same time fair protection for the holder and reasonable legal certainty for third parties.

Art. 53.

Effects of patenting

1. The exclusive rights covered by this code are conferred by the grant of the patent.

2. The patent shall take effect from the date on which the application with the description and any drawings is made available to the public.

3. After the expiry of the 18-month period from the date of filing of the application or from the date of priority, or 90 days after the date of filing of the application, if the applicant has stated in the application that he wishes to make it immediately accessible to the public, the Italian Patent and Trade Mark Office shall make the application available to the public with the annexes.

4. In respect of persons to whom the application with the description and any drawings has been notified by the applicant, the effects of the industrial invention patent shall take effect from the date of such notification.

Art. 54.

Effects of the application for a European patent

1. The protection conferred by an application for a European patent under Article 67(1) of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978, starts to run from the date on which the proprietor has made available to the public, through the Italian Patent and Trade Marks Office, a translation into Italian of the claims or has notified it directly to the alleged infringer. The effects of the application for a European patent shall be considered null from its origin where the application itself has been withdrawn or rejected or where the designation of Italy has been withdrawn.

Art. 55.

Effects of the designation or election of Italy

2. The international application filed under the Patent Cooperation Treaty, ratified by Law No 260 of 26 May 1978, and containing the designation or election of Italy, is equivalent to an application for a European patent in which Italy has been designated and produces its effects under the terms of

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European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978 and its implementing rules.

Art. 56.

Rights conferred by the European patent

3. The European patent granted for Italy confers the same rights and is subject to the same regime as Italian patents from the date on which the mention of the grant of the patent is published in the European Patent Bulletin. Where, as a result of the opposition procedure, it is maintained in an amended form, the limits of

protection established by the grant and maintained shall be confirmed from the date on which the mention of the decision on the opposition is published.

4. Counterfeits are assessed in accordance with the relevant Italian legislation.
5. The proprietor must provide the Italian Patent and Trade Mark Office with a translation into Italian of the text of the patent granted by the European Office and of the text of the patent maintained in an amended form following the opposition proceedings.
6. The translation, declared perfectly in conformity with the original text by the proprietor of the patent or by his authorised representative, must be filed within three months of the date of each of the publications referred to in paragraph 1.
7. In the event of non-compliance with the provisions referred to in paragraphs 3 and 4, the European patent shall be considered, from the outset, without effect in Italy.

Art. 57.

Text of the authentic European application or patent

1. The text of the application for a European patent or of the European patent, drawn up in the language of proceedings before the European Patent Office, shall be authentic as regards the extension of protection, without prejudice to Article 70(2) of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978.
2. However, the Italian translation of the documents relating to the filing of the application and the grant of the European patent shall be deemed to be authentic in the territory of the State if it confers less protection than that conferred by the text in the language of proceedings of the European Patent Office.
3. The provision referred to in paragraph 2 shall not apply in the case of an action for invalidity.
4. A corrected translation may be submitted at any time by the holder of the application or patent; it shall take effect only after it has been made available to the public at the Italian Patent and Trade Marks Office or notified to the alleged infringer.
5. Any person who, in good faith, has begun to implement an invention in Italy or who has made effective preparations for that purpose without such implementation being infringing the application or patent in the text of the translation initially submitted, may continue to exploit the invention in his company free of charge or for its needs even after the rectified translation has taken effect.

Art. 58.

Transformation of the European patent application

1. An application for a European patent, in which Italy has been designated, may be converted into an application for an Italian patent for industrial invention:
 - a) in the cases referred to in Article 135(1)(a) of the European Patent Convention of 5 October 1973, ratified by Law No 260 of 26 May 1978;
 - b) in the event of non-compliance with the time limit laid down in Article 14(2) of the European Patent Convention, where the application was originally filed in Italian.

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2. The transformation into a national utility model application of a European patent application rejected, withdrawn or deemed withdrawn or of the revoked European patent the object of which has the patentability requirements laid down by Italian utility models legislation is permitted.
3. Those who request the transformation referred to in paragraph 1 shall be allowed to request at the same time any conversion into a utility model application within the meaning of Article 84.
4. If a proper request for conversion pursuant to paragraphs 1, 2 and 3 has been forwarded to the Italian Patent and Trade Mark Office, the patent application shall be deemed to have been filed in Italy on the same date as the filing of the European patent application; the documents annexed to that application which were submitted to the European Patent Office shall be deemed to have been filed in Italy on the same date.

Art. 59.

1. Where, for the same invention, an Italian patent and a European patent valid in Italy have been granted to the same inventor or his successor in title with the same filing date or priority, the Italian patent, in so far as it protects the same invention as the European patent, shall cease to produce its effects on the date on which:
 - a) the time limit for bringing opposition to the European patent has expired without opposition being made;
 - b) the opposition procedure has been definitively concluded with the maintenance of the European patent;
 - c) the Italian patent has been granted, if that date is later than that referred to in points (a) or (b).
2. The provisions of paragraph 1 shall remain valid even if, subsequently, the European patent is annulled or lapsed.
3. On expiry of the periods referred to in paragraph 1, the person who has brought an action for the protection of the Italian patent may request its conversion into the corresponding action for the protection of the European patent, without prejudice to the rights arising from the Italian patent for the earlier period.

Art. 60.

Duration

1. The patent for an industrial invention shall last 20 years from the date of filing of the application and may not be renewed or its duration extended.

Art. 61.

Supplementary certificate

2. Supplementary protection certificates granted under Law No 349 of 19 October 1991 shall be governed by the legal regime with the same exclusive rights and obligations as the patent. The supplementary protection certificate shall have the same effect as the patent to which it relates only to the part or parts thereof relating to the medicinal product which is the subject of the marketing authorisation.
3. The effects of the supplementary protection certificate shall take effect from the moment when the patent reaches the end of its legal term and extends for a period equal to the period between the date of filing of the patent application and the date of the decree granting the first authorisation to place the medicinal product on the market.
4. In any event, the duration of the supplementary protection certificate may not exceed 18 years from the date on which the patent reaches the end of its legal term.
5. In order to progressively adjust the duration of supplementary patent cover to that provided for by Community legislation, the provisions of Law No 349 of 19 October 1991 and Council Regulation (EEC) No 1768/1992 of 18 June 1992 are implemented by means of a reduction in supplementary protection of six months for each calendar year, from 1 January 2004, until full alignment with European legislation.

6. Companies intending to produce pharmaceutical specialties outside patent cover may initiate the procedure for registering the product containing the active substance in advance of one year before the expiry of the additional patent coverage of the active substance.

Art. 62.

Moral right

1. The right to be recognised as the author of the invention may be invoked by the inventor and, after his death, by the spouse and descendants up to the second degree; in their absence or after their death, by the parents and other ascendants and in the absence, or after the death of these too, by relatives up to and including the fourth degree.

Art. 63.

Property rights

1. The rights arising from industrial inventions, except the right to be recognised as author, are alienable and transmissible.

2. The right to a patent for industrial invention lies with the author of the invention and its successors in title.

Art. 64.

Employee inventions

1. Where the industrial invention is made in the performance or performance of a contract or employment or employment relationship, in which the inventive activity is envisaged as the object of the contract or relationship and for that purpose remunerated, the rights arising from the invention shall belong to the employer, without prejudice to the right of the inventor to be recognised as author thereof.

2. If remuneration is not provided for and established, in return for inventiveness, and the invention is made in the performance or performance of a contract or employment relationship, the rights arising from the invention belong to the employer, but the inventor, save always the right to be recognised as the author, shall be entitled, if the employer obtains the patent, a fair prize for the determination of which the importance of the protection conferred on the invention by the patent, the duties performed and the remuneration received by the inventor, and the contribution which he has received from the employer's organisation, will be taken into account.

3. Where the conditions laid down in paragraphs 1 and 2 are not met, and where the industrial invention falls within the employer's field of activity, the employer shall have the right of option for the exclusive or non-exclusive use of the invention or the acquisition of the patent, as well as the right to apply for or acquire, for the same invention, patents abroad for payment of the price, to be fixed with a deduction of a sum corresponding to the aid which the inventor has in any event received from the employer in order to obtain the invention. The employer may exercise the right of option within three months from the date of receipt of the notification of the filing of the patent application. The relationships entered into with the exercise of the option shall be terminated by right if the consideration due is not paid in full at the due date.

4. Without prejudice to the jurisdiction of the ordinary judge to determine whether there is a right to a fair prize, to the fee or to the price, if agreement is not reached on the amount of the prize, even if the inventor is an employee of State administration, the amount shall be determined by a panel of arbitrators, composed of three members, appointed by each of the parties and the third appointed by the first two, or, in the event of disagreement, by the President of the specialised section of the competent court where the service provider habitually performs his duties. Articles 806 et seq. of the Code of Civil Procedure shall apply *mutatis mutandis*.

5. The arbitration panel may also be seised in the course of the proceedings establishing whether there is a right to a fair prize, rent or price, but, in that case, the enforceability of its decision is subject to that of the judgment on the determination of entitlement. The panel of arbitrators must proceed with fair appreciation. If the determination is manifestly unfair or incorrect, the determination shall be made by the court.

6. For the purposes of paragraphs 1, 2 and 3, the industrial invention for which the patent is sought shall be deemed to have been made during the performance of the contract or employment or employment relationship within one year after the inventor has left the private company or the public administration in whose field of activity the invention falls.

Art. 65.

Inventions by researchers from universities and public research bodies

1. By way of derogation from Article 64, where the employment relationship exists with a university or a public authority having as one of its institutional research purposes, the researcher shall have exclusive rights arising from the patentable invention of which he is the author. In the case of several authors, employed by universities, public administrations or other public administrations, the rights arising from the invention belong to all equally, unless otherwise agreed. The inventor shall submit the patent application and notify the administration thereof.

2. Universities and public administrations, within the scope of their autonomy, determine the maximum amount of the fee, relating to licences to third parties for the use of the invention, payable to the same university or to the public administration or to private funding of research, as well as any other aspect of mutual relations.

3. In any event, the inventor shall be entitled to not less than fifty per cent of the proceeds or royalties from the exploitation of the invention. In the event that universities or public administrations do not make the determinations referred to in paragraph 2, they shall be responsible for thirty percent of the proceeds or fees.

4. Five years after the date on which the patent was granted, where the inventor or his successors in title have not commenced its industrial exploitation, unless this results from causes beyond their control, the public administration of which the inventor was dependent at the time of the invention shall automatically acquire a free, non-exclusive right to exploit the invention and the related property rights or to have them exploited by third parties, without prejudice to the right of the inventor to be recognised as author.

5. The provisions of this Article shall not apply to research financed, in whole or in part, by private entities or carried out in the context of specific research projects financed by public entities other than the researcher's university, body or administration.

Art. 66.

Patent law

1. Patent rights for an industrial invention shall consist of the exclusive right to implement the invention and to profit from it within the territory of the State, within the limits and under the conditions laid down in this Code.

2. In particular, the patent confers on the proprietor the following exclusive rights:

- a) where the patent is a product, the right to prohibit third parties, without the consent of the proprietor, from producing, using, marketing, selling or importing for that purpose the product in question;
- b) where the patent is a process, the right to prohibit third parties, without the consent of the proprietor, from applying the process and from using, marketing, selling or importing for that purpose the product directly obtained by the process in question.

Art. 67.

Process patent

1. In the case of a process patent, any product identical to that obtained by the patented process shall be presumed to have been obtained, unless it is proved otherwise, by means of that process, alternatively:

- a) if the product obtained by the process is new;
- b) if there is a substantial likelihood that the identical product has been manufactured by the process and if the patent holder has failed through reasonable efforts to determine the process actually implemented.

2. For the purposes of proof to the contrary, account must be taken of the legitimate interest of the infringing defendant in the protection of his manufacturing and commercial secrets.

3. Where the holder of a patent relating to a new method or industrial process administers to others the means uniquely intended to implement the subject-matter of the patent, he shall be presumed to have also licensed to make use of that method or process, provided that there is no agreement to the contrary.

Art. 68.

Limitations of the patent right

1. The exclusive power conferred by the patent right shall not extend, whatever the subject matter of the invention:

- a) acts carried out in the private sector and for non-commercial purposes, or on an experimental basis, even for the purpose of obtaining, even in foreign countries, an authorisation to place a medicinal product on the market and the consequent practical requirements, including the preparation and use of the pharmacologically active starting materials strictly necessary for that purpose;
- b) the extemporaneous preparation, and per unit, of medicinal products in pharmacies on prescription and to medicinal products thus prepared, provided that active ingredients manufactured industrially are not used.

2. An industrial invention patent, the implementation of which involves inventions protected by previous patents for industrial inventions still in force, may not be implemented, or used, without the consent of the holders of such patents.

3. Any person who, during the 12 months preceding the date of filing of the patent application or the priority date, has made use of the invention in his business may continue to use the invention within the limits of pre-use. This option may be transferred only together with the undertaking in which the invention is used. Proof of pre-use and its extension shall be borne by the pre-user.

Art. 69.

Implementation burden

1. The industrial invention which is the subject of a patent must be implemented in the territory of the State to such an extent that it does not result in serious disproportion with the needs of the country.

2. Inventions concerning articles appearing for the first time in an official or officially recognised exhibition, held in the territory of the State, shall be deemed to have been implemented from the time when the articles are introduced to the State until the closure of the State, provided that they have been exhibited for at least 10 days or, in the case of a shorter exposure, throughout the period of the State.

3. The introduction or sale in the territory of the State of objects produced in States other than those which are members of the European Union or the European Economic Area or those which are members of the World Trade Organisation shall not constitute the implementation of the invention.

Art. 70.

Compulsory licence for non-implementation

1. Three years after the date of grant of the patent or four years after the date of filing of the application, if this period expires after the previous one, if the patent holder or his successor in title, either directly or through one or more licensees, has not implemented the patented invention, by producing in the territory of the State or by importing objects produced in a Member State of the European Union or the European Economic Area or in a Member State of the World Trade Organisation, or has implemented it to such an extent that it is seriously disproportionate to the needs of the country, compulsory licence may be granted for the non-exclusive use of the invention to any interested party who applies for it.

2. The compulsory licence referred to in paragraph 1 may also be granted if, for more than three years, the implementation of the invention has been suspended or reduced to such an extent as to result in serious disproportion with the needs of the country.

3. A compulsory licence shall not be granted if the non-enforcement or insufficient implementation is due to causes beyond the control of the proprietor of the patent or his successor in title. This does not include a lack of financial means and, where the product itself is spread abroad, the lack of demand in the internal market for the product patented or obtained by the patented process.

4. The grant of the compulsory licence shall not relieve the holder of the patent or his successor in title from the burden of implementing the invention. The patent shall expire if the invention has not been implemented within two years of the date of granting of the first compulsory licence or to such an extent as to be gravely disproportionate to the needs of the country.

Art. 71.

Dependent patent

1. A compulsory licence may be granted if the invention protected by the patent cannot be used without prejudice to the rights relating to a patent granted on the basis of a previous application. In such a case, the licence may be granted to the proprietor of the later patent to the extent necessary to exploit the invention, provided that it represents, in relation to the subject-matter of the previous patent, significant technical progress of considerable economic importance.

2. The licence thus obtained is not transferable except in conjunction with the patent on the dependent invention. The holder of the patent on the principal invention is entitled, in turn, to the grant of a compulsory licence on reasonable terms to the patent of the dependent invention.

Art. 72.

Common provisions

1. Any person applying for the grant of a compulsory licence pursuant to Articles 70 and 71 must prove that he has previously applied to the patent holder and that he has not been able to obtain a contractual licence from him under fair conditions.

2. A compulsory licence may be granted only in return for fair compensation by the licensee and to the proprietor of the patent or his successors in title and provided that the applicant for the licence provides the necessary guarantees that the invention will be satisfactorily implemented in accordance with the conditions laid down in that licence.

3. A compulsory licence may not be granted where it appears that the applicant has infringed the patent, unless it proves that he has acted in good faith.

4. The compulsory licence may be granted for the exploitation of the invention intended primarily for the supply of the internal market.

5. The compulsory licence shall be granted for a period not exceeding the remaining duration of the patent and, unless there is the consent of the patent holder or his successor in title, it may be transferred only with the licensee's business or with the particular branch of the licensee in which the licence is used.

6. The grant of a compulsory licence shall be without prejudice to the exercise, including by the licensee, of legal proceedings concerning the validity of the patent or the extension of the rights deriving therefrom.

7. The licence granting decree shall determine the scope of the licence, the duration, the arrangements for implementation, the guarantees and other conditions to which the grant is subject in relation to the purpose of the licence, the measure and the method of payment of the fee. In the event of an objection, the measure and the manner in which the remuneration is to be paid shall be determined in accordance with Article 80.

8. The conditions of the licence may, by decree of the Ministry of Production Activities, be varied at the request of each of the parties concerned, if there are valid reasons for this.

9. Article 80 shall apply to the modification of the remuneration.

10. Where the holder of the patent for which a compulsory licence has been granted or his successor in title grants to third parties the use of the patent on terms more advantageous than those laid down for the compulsory licence, those conditions shall be extended to the compulsory licence, at the request of the licensee.

Art. 73.

Revocation of the compulsory licence

1. The compulsory licence shall be revoked by decree of the Ministry of Production Activities, if the conditions laid down for the implementation of the invention are not fulfilled or if the licence holder has not paid the fee to the extent and in the manner prescribed.
2. The compulsory licence shall also be revoked by decree of the Ministry of Production if and when the circumstances giving rise to the concession cease to exist and are unlikely to occur again or at the request of the parties.
3. Revocation may be requested by the proprietor of the patent by application to the Italian Patent and Trade Mark Office, which shall promptly notify it by registered letter with acknowledgment of receipt to the holder of the compulsory licence, who, within sixty days of the date of receipt of the registered letter, may oppose the revocation, with an application submitted to the Italian Patent and Trade Mark Office. The provisions of Article 199(3), (4), (5), (6) and (7) shall apply.
4. In the event of revocation, the person who obtained the licence may carry out the invention under the same conditions, within the limits of pre-use or in those resulting from serious and effective preparations.

Art. 74.

Military inventions

1. The provisions relating to the granting of a compulsory licence for failure or insufficient implementation of inventions, or on dependent patents, shall not apply to patented inventions belonging to the military administration or to those subject to the obligation of secrecy by the military administration.

Art. 75.

Forfeiture for non-payment of entitlements

2. The patent for invention shall expire for failure to pay within six months of the expiry of the annual fee due, subject to compliance with paragraphs 2, 3 and 4.
3. After the month of expiry of the annual fee and also unnecessarily the following six months in which payment is permitted with the application of a right of late payment, and in any case the deadline for payment of the right has expired, the Italian Patent and Trade Marks Office shall notify the person concerned, by registered notice, that payment of the due fee has not been made within the prescribed period. The Italian Patent and Trade Marks Office, after thirty days from the date of the aforementioned communication, shall record in the Register of Patents, with appropriate annotation, that the patent has been revoked for failure to pay the annual fee, and then publishes in the Official Bulletin the notice of revocation itself.
4. If the proprietor of the patent proves that he has made the payment in good time, he may, by appeal to the Board of Appeals, request, within six months of the date of publication of the Official Bulletin, the annulment of the aforementioned revocation note and rectification of the publication. The Commission shall, after hearing the party concerned or its representatives, take into account any written observations they may have. Both the lodging of the application and the operative part of the judgment must be noted in the Register of Patents and published in the Official Bulletin.
5. After the publication referred to in paragraph 2 has elapsed six months after the date of such publication, or if the action has been dismissed, the patent shall be deemed to have been revoked in respect of any person from the end of the last year for which the right has been paid.

Art. 76. *Nullity*

1. The patent is null and void:
 - a) if the invention is not patentable in accordance with Articles 45, 46, 48, 49 and 50;
 - b) if, in accordance with Article 51, the invention is not described in a sufficiently clear and complete manner to enable an expert to implement it;
 - c) whether the subject-matter of the patent extends beyond the content of the initial application;
 - d) if the proprietor of the patent was not entitled to obtain it and the person entitled did not avail himself of the powers granted to him by Article 118.

2. If the grounds for invalidity affect only part of the patent, the partial invalidity judgment shall entail a corresponding limitation of the patent itself.
3. The null patent may produce the effects of a different patent of which it contains the requirements for its validity and which would have been sought by the applicant if he had known it to be null and void. The request for conversion can be made in any state and degree of judgment. The judgment establishing the requirements for the validity of the different patents shall provide for the conversion of the patent void. The converted patent holder shall, within six months of the conversion judgment becoming final, submit an application for correction of the text of the patent. The Office, having verified that the text is in line with the judgment, shall make it available to the public.
4. Where the conversion results in the extension of the original duration of the null patent, licensees and those who, in view of the forthcoming expiry, had made serious and effective investments to use the subject matter of the patent shall be entitled to obtain a compulsory, free non-exclusive licence for the longer term.
5. The European patent may be declared invalid for Italy pursuant to this Article and, in addition, where the protection conferred by the patent has been extended.

Art. 77.

Effects of nullity

1. The declaration of invalidity of the patent shall have retroactive effect, but shall not affect:
 - a) acts of enforcement of judgments of infringement which have become *res judicata*;
 - b) contracts for invention concluded before the judgment declaring null and void has become final in so far as they have already been performed. In such a case, however, the court may, having regard to the circumstances, grant a fair refund of sums already paid in performance of the contract;
 - c) payments already made under Articles 64 and 65 by way of a fair premium, fee or price.

Art. 78.

Renunciation

1. The proprietor may waive the patent by document received by the Italian Patents and Trade Marks Office, to be noted in the Register of Patents.
2. Where, in relation to the patent, acts or judgments conferring or establishing third parties' property rights over the patent or proceedings seeking the attribution or establishment of such rights are transcribed, the waiver shall be without effect unless accompanied by the written consent of those third parties.

Art. 79.

Limitation

1. The patent may be limited at the request of the proprietor, to whom the description, claims and modified drawings must be joined.
2. If the Italian Patent and Trademark Office accepts the application, the applicant will have to pay again the fee for the publication in print of the description and the drawings, if the original patent has already been printed.
3. An application for limitation shall not be granted if a patent invalidity judgment is pending and the relevant judgment has become final. Nor can it be granted in the absence of the consent of third parties who have transcribed acts or judgments conferring or establishing property rights or legal proceedings seeking the attribution or establishment of such rights.
4. The Italian Patent and Trademark Office publishes in the Bulletin the information about the limitation of the patent.

Art. 80

Licence of right

1. The applicant or the holder of the patent in the application or at the request of the authorised representative who receives the Italian Patent and Trade Mark Office, if it is not transcribed exclusive license, may offer to the public license for the non-exclusive use of the invention.
2. The licence shall take effect by notifying the holder of the acceptance of the offer, even if the fee is not accepted.
3. In the latter case, a panel of arbitrators, composed of three members, appointed by each of the parties and the third appointed by the first two or, in the event of disagreement, by the chairman of the Board of Appeal, shall be responsible for determining the measure and the method of payment of the remuneration. The panel of arbitrators must proceed with fair appreciation. If the determination is manifestly unfair or incorrect or if one of the parties refuses to appoint its arbitrator, the determination shall be made by the court.
4. The remuneration may be modified in the same manner as those prescribed in the determination of the original remuneration, if facts have been produced or revealed which clearly show that the compensation already fixed is manifestly inappropriate.
5. The applicant for or proprietor of the patent who has offered the public licence for the patent shall be entitled to a reduction to half of the annual fee.
6. The reduction referred to in the paragraph shall be granted by the Italian Patent and Trade Mark Office. The declaration of offer shall be recorded in the Register of Patents, published in the Bulletin and its effects shall continue until it is revoked.

Article 81.

Voluntary licence on active substances mediated by the Minister

1. Third parties wishing to produce for export active ingredients covered by supplementary protection certificates granted pursuant to Law No 349 of 19 October 1991 are permitted to initiate with the holders of the above certificates, at the Ministry of Production Activities, a procedure for the issuing of voluntary, non-exclusive licences for consideration in accordance with the relevant legislation in force.
2. The licences referred to in paragraph 1 are in any case valid only for export to countries in which patent protection and the supplementary protection certificate does not exist, has expired or in which the export of the active ingredient does not constitute infringement of the relevant patent, in accordance with the regulations in force in the countries of destination.
3. The licence shall cease to take effect upon expiry of the supplementary certificate to which it refers.

Section V

UTILITY MODELS

Art. 82.

Patent object

1. A utility model patent may be granted to new models which give particular effectiveness or convenience of application or use to machines, or parts thereof, tools, tools or objects for use in general, such as new models consisting of particular conformations, provisions, configurations or combinations of parts.
2. The patent for machines as a whole does not include the protection of individual parts.
3. The effects of the utility model patent extend to models that achieve equal utility, as long as they use the same innovative concept.

Art. 83

The right to patenting

1. The right to patent lies with the author of the new utility model and its successors in title.

Art. 84.

Alternative patenting

2. A person applying for the patent for an industrial invention within the meaning of this Code shall be permitted to apply for a utility model patent at the same time, in the event that the first is not granted or is only partially granted.
3. If the application relates to a model rather than an invention or vice versa, the Italian Patent and Trade Marks Office shall invite the person concerned to amend the application by assigning a time limit, which shall, however, take effect from the date of original submission.
4. If the utility model patent application also contains an inversion or vice versa, Article 161 shall apply.

Art. 85.

Duration and effects of patenting

1. The utility model patent lasts ten years from the date of submission of the application.
2. The rights conferred and the effect of the patent shall be governed in accordance with Article 53.

Art. 86.

Postponement

1. The provisions of Section IV on industrial inventions, in addition to such inventions, also have an effect on utility models, as they are applicable.
2. In particular, provisions on employee inventions and compulsory licences are extended to utility model patents.

Section VI

TOPOGRAPHIES OF SEMICONDUCTOR PRODUCTS

Art. 87

Subject-matter of protection

1. Any finished or intermediate product shall be produced as semiconductors:
 - a) consisting of a set of materials comprising a layer of semiconductor material;
 - b) which contains one or more layers composed of conductive, insulating or semiconductor material, arranged according to a predetermined three-dimensional scheme;
 - c) intended to perform, exclusively or together with other functions, an electronic function.
2. The topography of a semiconductor product is a series of related drawings, however fixed or coded:
 - a) representing the three-dimensional pattern of the layers of which a semiconductor product is composed;
 - b) in which series each image reproduces in whole or in part a surface of the semiconductor product at any stage of its manufacture.

Art. 88.

Protection requirements

1. Exclusive rights may apply to topographies resulting from the creative intellectual effort of their author which are not common or familiar in the semiconductor product industry.

2. Topographies resulting from the combination of common or family elements may also be the subject of exclusive rights provided that they satisfy the requirements set out in paragraph 1.

Art. 89.

Right to protection

1. The exclusive rights to topographies of semiconductor products which meet the requirements of protection are the responsibility of the author and his successors in title.
2. Where the topography is created in the context of an employment or employment relationship, Article 64 shall apply.
3. Where the topography is created in the performance or performance of a contract other than a contract of employment, the right to protection shall, unless the contract itself provides otherwise, be the subject of the topography.

Art. 90.

Content of rights

1. The exclusive rights to topographies of semiconductor products consist of the right to:
 - a) reproduce in any way or form, in whole or in part, the topography;
 - b) commercially exploit, or hold or distribute for marketing purposes, or import a semiconductor topography or product in which the topography is fixed.
2. Commercial exploitation consists of the sale, rental, leasing or any other method of commercial distribution or offering for such purposes.

Art. 91.

Limitation of exclusive rights

1. The protection afforded to topographies of semiconductor products does not extend to the concepts, processes, systems, techniques or information encoded, incorporated into the topographies themselves.
2. The exclusive rights referred to in Article 90 shall not extend to reproductions made privately, on an experimental basis, for the purpose of teaching, analysing or evaluating the topography and the concepts, procedures, systems or techniques included in the topography itself.
3. Exclusive rights may not be exercised in respect of topographies created by third parties on the basis of an analysis or evaluation carried out in accordance with paragraph 2, where such topographies meet the requirements of protection.

Art. 92.

Registration

1. The topography of semiconductor products shall be protected provided that:
 - a) registration is required in Italy or, if the topography has been the subject of previous commercial exploitation anywhere in the world, registration is required within two years from the date of such first exploitation, provided that this date is specified in a written declaration. For these purposes, commercial exploitation shall not include exploitation under conditions of confidentiality in which there has been no further distribution to third parties, unless the exploitation of the topography is carried out in accordance with the conditions of confidentiality imposed by the adoption of measures deemed necessary for the protection of the essential interests of national security and which relate to the production of or trade in arms, ammunition and war material;
 - b) at the time of the first commercial exploitation or of the application for registration, the owner of the topography is an Italian national or legal person or, if foreign, meets the requirements set out in Article 3 of Chapter I.
2. The right to apply for registration shall expire 15 years after the date of the first fixation or codification of the topography, where it has not been commercially exploited

anywhere in the world for the same period. For these purposes, commercial exploitation means commercial exploitation which does not include exploitation in a confidential condition according to the indications set out in paragraph 1(a).

Art. 93.

Date and duration of protection

1. The exclusive rights referred to in Article 90 shall arise on the first, in order of time, of the following dates: *on the* date of the first commercial exploitation of the topography in any part of the world; *on the date on which* the application for registration was duly lodged.
2. The exclusive rights referred to in paragraph 1 shall be extinguished ten years after the first, in order of time, of the following dates:
 - a) the end of the calendar year in which the topography was first exploited commercially in any part of the world;
 - b) the end of the calendar year in which the application for registration was submitted in due form.
3. For the purposes of this Article, commercial exploitation shall mean commercial exploitation which does not include exploitation under conditions of confidentiality in accordance with the provisions of Article 92(1)(a).

Art. 94.

Reservation mention

1. The topography, semiconductor product and its outer casing may bear a reference consisting of:
 - a) the T sign enclosed by a circle;
 - b) the date on which the topography was first commercially exploited;
 - c) the name, name or acronym of the right holder on topography.
2. That statement shall prove that the topography has been registered, i.e. the claim of ownership in the topography or the intention to apply for registration within two years of the date of the first commercial exploitation.
3. The mention may not be made on products for which the application for registration has not been submitted within two years of the date of the first commercial exploitation anywhere in the world or has been definitively refused.

Art. 95.

Counterfeiting

1. Acts of infringement and infringement of the exclusive rights topographies of semiconductor products shall constitute the exercise, without the consent of the holder, of the following activities, including by intermediary:
 - a) reproduction in any way and by any means of the topography;
 - b) fixation by any means of topography in a semiconductor product;
 - c) the use, importation and holding for marketing purposes and the marketing or distribution of the product to semiconductor in which the topography is fixed.
2. The importation, distribution, marketing or use of counterfeit semiconductor products, carried out without knowing or having no valid reason to consider the existence of the exclusive rights referred to in Article 90, shall not constitute acts of infringement.
3. In the case referred to in paragraph 2, the activity undertaken may continue, within the limits of the contracts already concluded and existing stocks, but the holder of the exclusive rights is entitled to the payment of a fair consideration, as soon as he has properly informed the purchaser in good faith that the topography has been reproduced illegally. In the absence of an agreement between the parties, the provisions laid down in Section IV for the right licence shall apply for the determination and payment of fair consideration at the market price.

Art. 96.

Compensation for damage and fair compensation

1. Any person who, after the registration of the topography or after the notice of the applicant for registration, if successful, carries out the acts referred to in Article 95, shall be liable for damages in accordance with the provisions of Chapter III.
2. If the acts referred to in paragraph 1 take place between the first act of commercial exploitation of the semiconductor product with a reference to the reservation and the registration of the topography, the person responsible shall pay only fair compensation to the holder of the registered topography.
3. If the acts referred to in points (a) and (b) of Article 95(1) take place after the first act of commercial exploitation of a semiconductor product without reservation, the holder of the registered topography shall be entitled to fair compensation and the infringer shall be entitled to obtain a licence under fair conditions to continue to exploit the topography within the limits of the use made before it was registered. Where the holder of the registration refuses to grant a contractual licence, the provisions on the granting of a compulsory licence set out in Section IV shall apply mutatis mutandis, including those relating to the determination of the measure and arrangements for payment of remuneration in the event of opposition.
4. If you have purchased a semiconductor product without knowing or having a valid reason to believe that the product is protected by registration, you are entitled to continue commercial exploitation of the product. However, in the case of acts carried out after having known or had valid reasons to believe that the semiconductor product is protected, fair compensation shall be payable. The successor to the purchaser referred to in this paragraph shall retain the same rights and obligations.
5. For the purposes of this Article, commercial exploitation means commercial exploitation which does not include exploitation in a confidential condition, in accordance with the indications referred to in Article 92(1).

Art. 97.

Invalidity of registration

1. An application for a judicial declaration of invalidity of the registration of the topography may be brought at any time and by any person having an interest in it, if it is omitted, one of the following conditions is not met or is absolutely uncertain:
 - a) the protection requirements referred to in Article 88;
 - b) the owner of the topography is not any of the subjects referred to in Article 92(1)(b);
 - c) registration in Italy has not been applied for within the time limit laid down in Article 92(1)(a) and, in the case of topographies whose commercial exploitation began in the two-year period prior to 18 March 1989, the registration was not applied for by 18 March 1990;
 - d) the date of the first act of exploitation has not been specified in a written declaration;
 - e) the application for registration does not meet the required requirements.

Section VII

SECRET INFORMATION

Art. 98.

Subject-matter of protection

1. Company information and technical-industrial experience, including commercial experience, which is subject to legitimate control of the holder, shall be protected, where such information:
 - a) are secret, in the sense that they are not as a whole or in the precise configuration and combination of their elements generally known or easily accessible to experts and practitioners;
 - b) they have economic value as secret;
 - c) are subject, by persons whose legitimate control they are subject to, to measures which are reasonably reasonable to keep them secret.
2. Data relating to evidence or other secret data, the processing of which involves a considerable effort and which is subject to authorisation, is also subject to protection.

the placing on the market of chemical, pharmaceutical or agricultural products involving the use of new chemicals.

Art. 99.
Protection

1. Without prejudice to the rules governing unfair competition, it shall be prohibited to disclose to third parties or to acquire or use the information and business experience referred to in Article 98.

Section VIII
NEW PLANT VARIETIES

Art. 100.
Subject matter of the law

1. A plant grouping of a botanical taxon of the lowest known degree may be the subject of the right in respect of a new plant variety which, in accordance with the conditions laid down for conferring the breeder's right in full or not, may be:

- a) defined on the basis of the characters resulting from a certain genotype or combination of genotypes;
- b) distinct from any other plant combination on the basis of the expression of at least one of these characters;
- c) considered as an entity in relation to its suitability to be reproduced in a consistent manner.

Art. 101.
Breeder

1. For the purposes of this Code, a breeder shall mean:

- a) the person who created or discovered and developed a variety;
- b) the person who is the employer of the person mentioned above or who has commissioned the work of that person;
- c) the person entitled or successor in title to the persons referred to in points (a) and (b).

Art. 102.
Requirements

1. The breeder's right shall be conferred when the variety is new, distinct, homogeneous and stable.

Art. 103.
News

1. The variety shall be deemed to be new where, on the date of submission of the breeder's application, the propagating material or vegetative propagation material or a harvest product of the variety has not been sold, or otherwise transferred to a third party, by the breeder or with his consent, for the purpose of exploiting the variety:

- a) in Italy for more than one year from the date on which the application was lodged;
- b) in any other State for more than four years or, in the case of trees and vines, for more than six years.

Art. 104.
Distinction

1. The variety shall be regarded as distinct when it is clearly distinguished from any other variety the existence of which, at the date of filing of the application, is known to be known.

2. In particular, another variety is notoriously known when:

- a) an application has been filed in any country for the grant of the breeder's right or for registration in an official register, provided that the effect of the application is the conferral of the breeder's right or the entry in the official variety register;
- b) it is present in public collections.

Art. 105.
Homogeneity

1. The variety shall be considered to be homogeneous when it is sufficiently uniform in its relevant characteristics and relevant for protection, subject to the foreseeable variation due to the particularities of its sexual reproduction and vegetative propagation.

Art. 106.

Stability

1. The variety shall be deemed to be stable when the characteristics relevant and relevant for protection remain unchanged as a result of subsequent reproductions or multiplications or, in the case of a particular cycle of reproduction or multiplication, at the end of each cycle.

Art. 107.

Content of the breeder's right

1. Authorisation by the breeder shall be required for the following acts carried out in relation to reproductive or propagating material of the protected variety:

- a) production or reproduction;
- b) packaging for reproduction or multiplication;
- c) offer for sale, sale or any other form of marketing;
- d) export or import;
- e) detention for one of the purposes listed above.

2. The breeder's authorisation shall be required for the acts referred to in paragraph 1 carried out in relation to the product of the harvest, including whole plants and parts of plants, obtained by unauthorised use of reproductive or propagating material of the protected variety, unless the breeder could reasonably have exercised his right in relation to that reproductive or propagating material. Use is presumed not to be authorised unless proven otherwise.

3. Paragraphs 1 and 2 shall also apply to:

- a) varieties essentially derived from the protected variety, where it is not, in turn, an essentially derived variety;
- b) varieties which do not clearly distinguish themselves from the protected variety in accordance with the requirement of distinction;
- c) varieties whose production requires the repeated use of the protected variety.

4. For the purposes of paragraph 3(a), a variety shall be considered to be essentially derived from another variety, defined as the initial variety, where:

- a) it derives mainly from the initial variety or from a variety which in turn is predominantly derived from the initial variety, while retaining the expressions of the essential characteristics resulting from the genotype or combination of the genotypes of the initial variety;
- b) it is clearly distinguished from the initial variety and, except for the differences generated by derivation, conforms to the initial variety in the expression of the essential characteristics resulting from the genotype or combination of the genotypes of the initial variety.

5. Essentially derived varieties may be obtained, inter alia, by selection of a natural or induced mutant or from a somaclonal variant, by selection of an individual variant between plants of the initial variety, by retro-crossing or by transformation through genetic engineering.

6. During the period between the publication of the application and the grant of the plant variety right, the breeder shall be entitled to equitable remuneration by the person who, during that period, carried out the acts which, once the right has been granted, require the breeder's authorisation.

Art. 108.

Limitations on the breeder's right

1. The breeder's right does not extend to acts carried out in the private sphere, for non-commercial purposes; acts carried out on an experimental basis; acts carried out for the purpose of creating other varieties and, where the provisions of Article 107(3) are not applicable, to acts referred to in Article 107(1) and (2) carried out in relation to those other varieties.

2. Without prejudice to the provisions of Article 107(1), any person wishing to propagate, with a view to certification, material from varieties subject to a plant variety right for a new plant variety shall be required to notify the holder of the right in advance.

Art. 109.

Duration of protection

1. The breeder's right granted under this Code shall last 20 years from the date of its granting. In the case of trees and vines, this right shall last 30 years from the date on which it was granted.
2. The design shall take effect from the date on which the application, accompanied by the descriptive elements, is made available to the public.
3. In respect of persons to whom the application, together with the descriptive information, has been notified by the breeder, the effects of the design shall take effect from the date of such notification.

Art. 110.

Moral right

1. The right to be considered author of the new plant variety may be invoked by the author himself and, after his death, by his spouse and descendants up to the second degree; in their absence or after their death, by the parents and other ascendants and in the absence, or after the death of these too, by relatives up to and including the fourth degree.

Article 111.

Property rights

2. The rights arising from the creation of new plant varieties, except the right to be recognised as authors, shall be alienable and transmissible.
3. Where the new plant variety is created in the context of an employment or employment relationship, Article 64 shall apply.

Art. 112.

Nullity of the right

1. The breeder's right shall be void if it is established that:
- a) the conditions laid down by the rules on novelty and distinction were not actually fulfilled at the time of conferring the breeder's right;
 - b) the conditions laid down in the rules on homogeneity and stability were not actually met at the time of conferral of the breeder's right, where the breeder's right was conferred essentially on the basis of information or documents provided by the breeder;
 - c) the breeder's right was conferred on those who were not entitled and the person entitled did not make use of the powers granted to him by Article 118.

Art. 113.

Forfeiture of the right

1. The breeder's right shall lapse when it is established that the conditions relating to homogeneity and stability are no longer actually met.
2. The right shall also lapse if the breeder, after notice of formal notice by the competent authority:
 - a) does not submit, within 30 days, any information, documents or material which it considers necessary for monitoring the maintenance of the variety;
 - b) has not paid the fees due for the maintenance of its right;
 - c) it does not propose, in the event of cancellation of the variety denomination after the conferral of the right, another appropriate name.

3. In the cases referred to in paragraph 2(*a*) and (*c*), revocation shall be declared by the Italian Patent and Trade Mark Office, on a proposal from the Ministry of Agricultural and Forestry Policy.

Art. 114.

Variety denomination

1. The variety must be designated by a name intended to be its generic designation.
2. The name must make it possible to identify the variety. It may not consist only of figures, unless it is a practice established for designating certain varieties. It must not be liable to mislead or create confusion as to its characteristics, the value or identity of the variety or the identity of the breeder. In particular, it must be different from any other name designating, in the territory of a State acceding to the European Union for the protection of new plant varieties (UPOV), a pre-existing variety of the same plant species or of a similar species, unless that other variety no longer exists and its name has taken on any particular importance.
3. Rights acquired previously by third parties shall not be affected.
4. The name must be the same as that already registered in one of the States which are members of the Union for the protection of new plant varieties (UPOV) to designate the same variety.
5. A registered name which meets the requirements of paragraphs 1, 2, 3 and 4 shall be registered.
6. The name deposited and registered and any changes thereto shall be communicated to the competent authorities of the States Parties to the UPOV.
7. The registered name must also be used for the variety after extinction of the breeder's right, in so far as, in accordance with the provisions of paragraph 3, acquired rights previously do not oppose such use.
8. It is permissible to associate a trade mark, trade name or similar indication with the variety denomination, provided that the variety denomination is, in any event, easily recognizable.

Art. 115.

Compulsory licences and expropriation

1. The breeder's right may be the subject of compulsory, non-exclusive licences only for reasons of public interest.
2. Compulsory licences for non-implementation shall apply, insofar as they are compatible with the provisions of this Section, with the rules on compulsory licences set out in Section IV, including those relating to the determination of the extent and methods of payment of remuneration in the event of opposition.
3. The absence, suspension or reduction of the implementation provided for in Article 70 shall occur where the holder of the breeder's right or his successor in title, either directly or through several licensees, does not make available to users in the territory of the State material for the propagation and propagation of the protected plant variety to an extent appropriate to the needs of the national economy.
4. In the same manner as provided for in paragraph 2, they may also, irrespective of the implementation of the subject matter of the breeder's right, be granted at any time by payment of fair compensation to the holder of the breeder's right, special, non-exclusive compulsory licences for the use of new protected plant varieties which may be used for human or livestock consumption, as well as for therapeutic uses or for the production of medicinal products.
5. The licences provided for in paragraphs 1, 2, 3 and 4 shall be granted following the assent of the Ministry of Agricultural and Forestry Policy, which shall rule on the conditions for the granting of licences.
6. The order granting the licence may lay down an obligation on the holder of the right to make the necessary propagating or propagating material available to the licensee.

7. The expropriation takes place, for new plant varieties, after hearing the Ministry of Agricultural and Forestry Policies.

Art. 116.
Postponement

1. The provisions of Section IV shall apply to new plant varieties in so far as they do not conflict with the provisions of this Section.

Chapter III

JUDICIAL PROTECTION OF INDUSTRIAL PROPERTY RIGHTS

Section I
PROCEDURAL PROVISIONS

Art. 117.
Validity and membership

1. Registration and patenting shall be without prejudice to the exercise of actions concerning the validity and ownership of industrial property rights.

Art. 118.
Claims

1. Any person entitled under this Code may submit an application for registration or a patent application.

2. Where a judgment which has the force of *res judicata* establishes that the right to registration or to the patent is vested in a person other than the person who lodged the application, the latter may, if the industrial property right has not yet been granted and within three months of the date of *res judicata* of the judgment:

- to assume the patent application or the application for registration in its own name, with the full status of applicant;
- to apply for a new patent or registration, the starting date of which, in so far as its content does not exceed that of the first application or relates to an object substantially identical to that of the first application, is the date of filing or priority of the initial application, which shall in any event cease to have effect; in the case of a trade mark, to lodge a new application for registration, the date of which, in so far as the trade mark contained in it is substantially identical to that of the first application, dates from the date of filing or priority of the initial application, which shall in any event cease to have effect;
- have the application rejected.

3. If the patent was granted or the registration was made in the name of a person other than the entitled person, he or she may alternatively:

- obtain by judgment the transfer in his name of the patent or of the certificate of registration from the time of filing;
- claim the invalidity of the patent or registration granted in the name of a person who was not entitled to it.

4. After the expiry of two years from the date of publication of the grant of the patent for invention, utility model, for a new plant variety, or from the publication of the granting of registration of the topography of semiconductor products, without the person entitled having availed himself of one of the powers referred to in paragraph 3, the invalidity may be invoked by any interested party.

5. Paragraph 4 shall not apply to trade mark and design registrations.

6. Without prejudice to the application of any other protection, the registration of a business domain name granted in breach of Article 22 or requested in bad faith may be revoked or transferred to him by the registration authority at the request of the rightholder.

Art. 119.

Paternity

1. The Italian Patent and Trade Marks Office does not verify the accuracy of the designation of the inventor or author, or the legitimacy of the applicant, without prejudice to the verifications provided for by law or international conventions. Before the Italian Patent and Trade Mark Office, the applicant is presumed to be the holder of the right to registration or to the patent and is entitled to exercise it.
2. An incomplete or incorrect designation may only be rectified upon application accompanied by a declaration of consent of the previously designated person and, where the application is not submitted by the applicant or holder of the patent or registration, also by a declaration of consent of the latter.
3. If a third party submits an enforceable judgment to the Italian Patent and Trade Mark Office according to which the applicant or proprietor of the patent or registration is required to designate it as the inventor or author of the Office, it shall record it on the register and notify it in the Official Gazette.

Art. 120.

Jurisdiction and jurisdiction

1. Actions relating to industrial property the titles of which are granted or are being granted shall be brought before the courts of the State, irrespective of the nationality, domicile and residence of the parties. If an action for a declaration of invalidity is brought when the title has not yet been granted, the judgment may be given only after the Italian Patent and Trade Mark Office has proceeded with the application, examining it with precedence over applications lodged at an earlier date.
2. The actions referred to in paragraph 1 shall be brought before the courts for the place where the defendant is resident or domiciled and, if they are unknown, the place where the defendant is staying, except as provided for in paragraph 3. Where the defendant is neither domiciled nor domiciled in the territory of the State, proceedings shall be brought before the courts for the place where the claimant is resident or domiciled. If neither the plaintiff nor the defendant has residence, domicile or stay in the territory of the State, the court of Rome shall have jurisdiction.
3. The indication of domicile made in the application for registration or patenting and entered in the register shall be used as an exclusive address for the purposes of determining jurisdiction and any service of documents of proceedings before ordinary or administrative courts. The address thus elected may be changed only by means of an appropriate replacement application to be noted on the register by the Italian Patent and Trade Marks Office.
4. Jurisdiction over industrial property rights belongs to the courts expressly indicated for this purpose by Legislative Decree No 168 of 27 June 2003.
5. Community trade mark and design courts within the meaning of Article 91 of Regulation (EC) No 40/94 and Article 80 of Regulation (EC) No 2002/6 shall mean those referred to in paragraph 4.
6. Actions based on facts which infringe the applicant's law may also be brought before the judicial authority with specialised section in whose constituency the facts were committed.

Art. 121.

Allocation of the burden of proof

1. In any event, the burden of proving the invalidity or revocation of an industrial property right lies with the person challenging the title. Without prejudice to Article 67, the burden of proving infringement shall lie with the proprietor. Proof of revocation of the mark for non-use may be provided by any means including simple presumptions.
2. Where a party has provided serious evidence of the merits of its claims and has identified documents, elements or information held by the other party confirming that evidence, that party may obtain that evidence from the court or request the information from the other party. It may also obtain that the court orders to provide the elements for the identification of the persons involved in the production and distribution of goods or services which constitute an infringement of industrial property rights.

3. The court, when taking the measures referred to above, shall take appropriate measures to ensure the protection of confidential information, after hearing the other party.
4. The court infers arguments of proof from the answers given by the parties and of unjustified refusal to comply with the orders.
5. In the field covered by this Code, the technical adviser of its own motion may receive the documents relating to the questions put by the court even if they have not yet been produced, making them known to all parties. Each Party may appoint more than one consultant.

Art. 122.

Locus standi for nullity and revocation

1. Without prejudice to the provisions of Article 188(4), an action seeking a declaration of revocation or invalidity of an industrial property right may be brought by any person having an interest in it and brought of its own motion by the public prosecutor. By way of derogation from Article 70 of the Code of Civil Procedure, the intervention of the Public Prosecutor is not mandatory.
2. An action seeking a declaration of invalidity of a trade mark for the existence of earlier rights or because the use of the trade mark would constitute an infringement of another person's copyright, industrial property or other exclusive right of third parties, or because the trade mark constitutes an infringement of the right to a name or portrait or because the trade mark was registered in the name of the non-beneficiary, may be brought only by the proprietor of the earlier rights and his successor in title or by the person entitled to it.
3. An action for a declaration of invalidity of a design for the existence of the earlier rights referred to in Article 43(1)(*d*) and (*e*), either because the registration was made in the name of the non-beneficiary or because the design constitutes improper use of one of the elements listed in Article 6b of the *Convention of the Paris Union for the Protection of Industrial Property* — Stockholm text of 14 July 1967, ratified by Law No 424 of 28 April 1976, or of designs, emblems and coat of arms of a particular public interest in the State, may be exercised respectively only by the holder of the earlier rights and his successor in title or by the person entitled to do so or by the person having an interest in the use.
4. An action for revocation or invalidity of an industrial property right shall be brought in adversarial proceedings by all persons who are recorded in the register as entitled persons.
5. Judgments declaring the invalidity or revocation of an industrial property right shall be entered in the register by the Italian Patent and Trade Marks Office.
6. A copy of the application initiating any civil proceedings concerning industrial property rights must be communicated to the Italian Patents and Trade Marks Office, by the person bringing the proceedings.
7. If the abovementioned communication has not been effected, the judicial authority shall, at any instance of the proceedings, before deciding on the substance, provide that such communication shall be made.
8. The Registrar must forward to the Italian Patents and Trade Marks Office a copy of any judgment concerning industrial property rights.

Art. 123.

Efficacy erga omnes

1. Revocations or invalidity, even partial, of an industrial property right shall have effect vis-à-vis all if they are declared by a judgment which has the force of *res judicata*.

Art. 124.

Civil sanctions

1. The judgment establishing an infringement of an industrial property right may prohibit the manufacture, trade and use of what constitutes an infringement of the law.
2. By ordering the injunction, the court may fix a sum due for any infringement or non-compliance subsequently found and for any delay in the execution of the order.

3. The judgment establishing an infringement of an industrial property right may order the destruction of all the property constituting the infringement. Destruction of the property cannot be ordered and the person entitled can only obtain compensation for damages if the destruction of the property is detrimental to the national economy. In the case of infringement of trade mark rights, the destruction shall concern the trade mark but may include the packaging and, where the judicial authority deems it appropriate, also the goods or materials inherent in the provision of services, if this is necessary to eliminate the effects of the infringement of the right.
4. By a judgment finding that industrial property rights have been infringed, it may be ordered that objects produced or imported in breach of the right and the specific means which are uniquely used to produce them or to implement the protected method or process shall be assigned to the rightholder, without prejudice to the right to compensation for damage.
5. It shall also be open to the court, at the request of the owner of the objects or means of production referred to in paragraph 4, taking into account the remaining duration of the industrial property right or the particular circumstances of the case, to order the seizure, at the expense of the infringer, until the title, objects and means of production are extinguished. In the latter case, the holder of the industrial property right may request that the seized items be awarded to him at the price which, in the absence of an agreement between the parties, will be determined by the executing court, after hearing an expert.
6. Infringing industrial property rights, removal or destruction cannot be ordered, nor may they be prohibited when they belong to those who use them personally or domestically.
7. On the disputes arising in the implementation of the measures referred to in that article, it shall decide, by order not subject to appeal, after hearing the parties, having obtained summary information, the court which delivered the judgment containing those measures.

Art. 125.

Compensation for damage

1. Compensation due to the injured person shall be paid in accordance with the provisions of Articles 1223, 1226 and 1227 of the Civil Code. Loss of profit shall be assessed by the court also taking into account profits made in breach of the right and the compensation that the infringer would have had to pay if it had obtained a licence from the rightholder.
2. The judgment awarding damages may, at the request of the party, settle it in an overall sum determined on the basis of the documents in the case and the resulting presumptions.

Art. 126.

Publication of the judgment

1. The court may order that the protective order or the judgment establishing the infringement of industrial property rights be published in its entirety or in summary or in its entirety, having regard to the seriousness of the facts, in one or more newspapers indicated by it, at the expense of the unsuccessful party.

Art. 127.

Criminal and administrative sanctions

2. Without prejudice to the application of Articles 473, 474 and 517 of the Criminal Code, any person who manufactures, sells, exposes, uses industrially, introduces objects in violation of a valid industrial property right into the State

in accordance with the rules of this Code, fines of up to EUR 1032.91 shall be imposed on a party's complaint.

3. Any person who affixes, on an object, words or indications which do not correspond to the truth, which tends to make it believe that the object is protected by a patent, design or topography or to make it believe that the trade mark distinguishing it has been registered, shall be punishable by an administrative penalty of from EUR 51.65 to EUR 516.46.
4. Unless the act constitutes an offence, an administrative penalty of up to EUR 2065.83 shall be punishable, even where there is no harm to the third party, any person who uses a registered trade mark after the registration has been declared invalid, where the ground for invalidity leads to the unlawful use of the trade mark, or deletes the trade mark of the producer or trader from whom he received the goods or goods for commercial purposes.

Art. 128.

Description

1. The holder of an industrial right may request that a description of the objects constituting an infringement of that right be ordered, as well as of the means used to produce them and of the evidence relating to the alleged infringement and its extent.
2. The application shall be brought by appeal to the President of the specialised section of the court having jurisdiction to adjudicate on the substance, pursuant to Article 120.
3. The President of the specialised section shall, by decree, fix the appearance hearing and set the mandatory time limit for the notification of the decree.
4. The same court shall, after hearing the parties and, where necessary, provide summary information, shall give an order which is not open to appeal and, if the description is made, shall indicate the measures necessary to ensure the protection of confidential information and shall authorise the possible taking of samples of the objects referred to in paragraph 1. Where the convening of the other party could jeopardise the implementation of the measure, he shall act on the application by decree, stating the reasons, by way of derogation from paragraph 3.
5. Where an application has been lodged before the commencement of the main proceedings, the order must set a mandatory time limit not exceeding 30 days for the commencement of proceedings as to the substance of the case.
6. The measure shall lose effect if it is not enforced within the time limit laid down in Article 675 of the Code of Civil Procedure.
7. Article 669- undicies of the Code of Civil Procedure shall *also* apply to the description.

Art. 129.

Seizure

1. The holder of an industrial property right may request the seizure of some or all of the objects constituting an infringement of that right, as well as of the means used to produce them and the evidence relating to the alleged infringement. Appropriate measures shall be taken in the latter case to ensure the protection of confidential information.
2. Seizure proceedings are governed by the rules of the Code of Civil Procedure concerning interim proceedings.
3. Subject to the requirements of criminal justice, the objects in which an industrial property right is found to have been infringed may not be seized, but only described, as long as they appear in the enclosure of an official or officially recognised exhibition held in the territory of the State, or are in transit to or through the State.

Art. 130.

Common provisions

1. The description and seizure shall be carried out by a bailiff, with the assistance, where appropriate, of one or more experts and also by the use of technical means of ascertaining, photographic or other.
2. Data subjects may be authorised to attend operations, including through their representatives, and to be assisted by technicians of their trust.
3. After the expiry of Article 675 of the Code of Civil Procedure, the description and seizure operations which have already begun may be completed, but no other operations based on the same order may be initiated. This is without prejudice to the right to request the court to order further description or seizure orders in the course of the proceedings on the substance.
4. The description and seizure may relate to objects belonging to persons who have not been identified in the application, provided that they are produced, offered, imported, exported or marketed by the party against whom the said measures have been issued and provided that such articles are not used for personal use.
5. The report of the seizure and description, together with the appeal and the order, must be notified to the third party to whom the objects on which the description or seizure were carried out belong, within 15 days of the date of completion of the operations, failing which they will be ineffective.

(Subsequent Articles)