



Ministero dello Sviluppo Economico

Having REGARD TO the *Patent Cooperation Treaty*, signed in Washington on 19 June 1970 and subsequent amendments, ratified by Italy by Law No 260 of 26 May 1978;

Having regard to Legislative Decree No 30 of 10 February 2005 laying down the Industrial Property Code, pursuant to Article 15 of Law No 273 of 12 December 2002, as amended, hereinafter referred to as the “Code”;

Having regard to Decree-Law No 34 of 30 April 2019 on ‘Urgent measures for economic growth and for the resolution of specific crisis situations’, converted into Law No 58 of 28 June 2019;

Having regard, in particular, to Article 32(16) and (17) which amended Article 55 of Legislative Decree No 30 of 10 February 2005 and inserted Article 160-bis, providing that an international patent application containing the designation or election of Italy may, under certain conditions, be equivalent to an application for an Italian patent for the grant of the title, irrespective of the designation of the European Patent Organisation;

Having regard to Decree No 33 of the Minister for Economic Development of 13 January 2010 laying down the ‘Regulation implementing the Industrial Property Code’;

Having REGARD TO the Decree of the Minister for Economic Development of 27 June 2008 on ‘Research of precedence in respect of patent applications for industrial invention’;

Having regard to the *Regulations under the Patent Cooperation Treaty*, last edition, which entered into force on 1 July 2019;

Considering the need to implement the new procedure for examining international patent applications at the UIBM by means of a decree of the Ministry of Economic Development;

DECREE

Article 1

Entry of international demand into the national stage in front of UIBM

1. Entry into the national stage before the UIBM for the grant of a patent for invention or utility model is accepted only for international patent applications filed since 1 July 2020 containing the designation or election of Italy independently of the designation of the European Patent Organisation.
2. Entry into the national stage shall take place by filing with the UIBM, within 30 months of the date of international filing or of the date of priority, if claimed, of the request for the opening of the national phase accompanied by the full text — description, claims, summary and any drawings — in the Italian language of the international patent application, as published by the World Intellectual Property Organisation, accompanied by any amendments to the claims made pursuant to Article 19 of the Patent

Cooperation Treaty, even if they were subsequently published, or made following an international preliminary examination, pursuant to Article 34 of that Treaty, or made pursuant to Article 41 of that Treaty.

3. The Italian translation of the international application must be declared in conformity with the original text by the applicant or his representative.
4. The 30-month period for the opening of the national examination phase remains firm even if the international research report is not yet available.
5. This is without prejudice to the possibility of using the institution of the continuation of the procedure, in accordance with Article 192 of the Code.
6. Documents drawn up in a language other than Italian may not be filed for entry into the national stage. Article 148(5) and Article 4(2) of Decree No 33 of the Minister for Economic Development of 13 January 2010 shall apply. The time limit for lodging the translation of the documents referred to in paragraph 2 shall be two months from the date of submission of the request for the opening of the national stage. That period shall not be extended.

Article 2

Admissibility of the request for the opening of the national stage and deposit and maintenance rights

1. The international application lodged in Italy within the meaning of Article 1 shall not be admissible if the applicant is not identifiable or cannot be reached. Article 147, paragraphs 3-bis to 3-quater, of the Code shall apply to the election of an address for service.
2. The application shall also not be admissible if the documents have not been lodged in accordance with the provisions of Article 160-bis(1) of the Code and Article 1(2) of this Decree, subject to the application of paragraph 6.
3. The filing and maintenance fees shall be paid to the extent laid down in Table A of the Decree of 2 April 2007 for national patent applications for inventions and utility models. Any claims due shall be calculated in relation to the claims on which the national stage is based.
4. If the filing in Italy is in the name of a person other than that resulting from the publication of the international application, the applicant must lodge proof that he is the successor or successor to the international application. The transfer document may consist of a declaration of transfer or transfer, in accordance with the provisions of Article 196, paragraph 1, letter a) of the Code.

Article 3

Examination of the application

1. The Office shall initiate the examination of the application no earlier than 30 months after the date of filing or priority date, if claimed, even if the application is submitted before 30 months, on the basis of Articles 23 and 40 of the Patent Cooperation Treaty. The opening of the examination shall be communicated by the office to the applicant, setting the time limit within which any reply to the

objections contained in the written opinion of the International Research and Examination Authority may be lodged.

2. For the administrative checks and the substantive examination of the application, reference is made to the corresponding articles of the Code, in particular Article 170(1)(b) and the articles referred to in Chapter II, Section IV and IV-bis, for industrial inventions, and Section V for utility models, and the corresponding articles of its implementing regulation, as applicable.
3. In particular, the provisions in force in respect of national applications shall apply to the examination of an application for a patent for industrial invention. The examination is based on the international research report and the attached written opinion of patentability and on the preliminary international report, made available in English by the World Intellectual Property Organisation.
4. The examiner may, for the purposes of the national examination procedure, request the World Intellectual Property Organisation or the applicant for further details or documents, with translation into Italian, relating to the international examination phase, including the priority document.

Art. 4

Procedural arrangements for submitting applications

1. The practical arrangements for submitting applications via the UIBM online filing system or through the Chambers of Commerce, the adoption of the filing forms and any further details for the implementation of the national procedure for examining international patent applications, are defined by successive circulars of the Director-General for Combating Counterfeiting-Italian Patent and Trademark Office of the Ministry of Economic Development.

Rome, **13 NOV. 2019**

IL MINISTRO
