



Study Question

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Patentability of computer implemented inventions

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I. Current law and practice

1 Does your current law contain any statutory provisions which specifically apply only to CII?

Yes

Please Explain

The Italian Industrial Property Code does not provide any statutory provisions in the matter of CII. According to Article 45, computer programs "as such" are not considered patentable inventions.

2 Please briefly describe the general patentability requirements in the written statute based law of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

The Italian Industrial Property Code does not have a written statute relevant for the examination of the patentability of CII. As for any other invention an Examiner has to assess patentability of a CII on the basis of novelty, inventive step and industrial applicability.

3 Under the case law or judicial or administrative practice in your jurisdiction, are there rules which specifically apply only to CII? If yes, please explain.

No

Please Explain

We have not found any judicial practice nor administrative practice useful in this matter.

4 Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

The Italian Industrial Property Code has the same patentability requirements for all types of invention, i.e. novelty, inventive step and industrial applicability.

5.a Exclusion of non-patentable subject matter per se.
Do the statutory provisions, case law or judicial or administrative practice (hereinafter collectively referred to as Law / Practice) in your jurisdiction exclude any particular subject matter relating to CII from patentability per se?
In this context, "per se" means that the non-patentable subject matter is identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.

If yes, please answer questions 5.b-5.e, if no, please go to question 6.a

No

Please Explain

See point 1 above

5.b Please describe the subject matter excluded from patentability per se and explain in detail how it is identified in practice

5.c If there is any subject matter identified in a patent claim relating to CII that is excluded from patentability per se, is it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?

If yes, please answer questions 5.d-5.e, if no, please go to question 6.a

5.d Does the "other subject matter" need to have a certain quality, e.g. does it need to be inventive?

5.e Can you describe the areas of human endeavour the "other subject matter" needs to relate to?

6.a Requirement of a contribution in a field of technology.

Does the examination of the patentability of CII in your jurisdiction implicitly or explicitly involve an examination of the contribution the claimed CII makes to the state of the art (such examination may be part of a general "patentability" test or part of the novelty and inventive step/non-obviousness test)?

If yes, please answer questions 6.b-6.d, if no, please go to question 7

Yes

Please Explain

Yes. Patent applications relating to a CII are treated as any other application and undergo a substantive examination concerning novelty, inventive step and industrial applicability

6.b Does this test implicitly or explicitly involve excluding contributions from areas of human endeavour which are not deemed to be sources of patentable inventions? In other words, does patentability of CII implicitly or explicitly require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? If yes, please explain.

No

Please Explain

It is not required any test about human endeavour.

6.c Does this test also implicitly or explicitly require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. If yes, please explain.

Yes

Please Explain

Yes according to the general principles of an invention.

6.d Is there an implicit or explicit consensus in your jurisdiction as to the areas of human endeavour which are accepted as sources of patentable CII? If yes, are these areas of human endeavour defined, and if so how?

No

Please Explain

No.

7 Does the Law / Practice in your jurisdiction contain any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

In our jurisdiction there are no special formal requirements applicable to CII.

However, in the practice, claims for CII are drafted in the form of method claims. Also the following formulation, referring back to method claims, is often used for protecting CII "A computer program product loadable in the memory of at least one computer and including software code portions for performing the steps of the method of any of claims ..., when the product is run on at least one computer".

8 Does the Law / Practice in your jurisdiction contain any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

No

9 Do courts and administrative bodies in your jurisdiction apply the Law / Practice for patentability of CII in your jurisdiction in a harmonized way? If not, please explain.

Yes

Please Explain

Yes, Italian courts and administrative bodies generally follow the principles of the EPC rules in this matter, even though the Italian Industrial Property Code is not bound to the principles of the EPC.

II. Policy considerations and proposals for improvements of your current Law/Practice

10 Is the current Law/Practice in your jurisdiction regarding the patentability of CII considered by users of the patent system and practitioners to be understandable and workable? If not, please explain.

Yes

Please Explain

Yes

11 Does the current Law/Practice in your jurisdiction regarding patentability of CII provide appropriate outcomes, in particular from an economic perspective? If not, please explain.

No

Please Explain

No. In our jurisdiction, the current law/practice does not provide appropriate outcomes regarding patentability of CII.

12 In your jurisdiction, is copyright protection of CII regarded as sufficient from an economic standpoint? Please state why in either case.

Yes

Please Explain

Yes, our copyright law provides protection to most of the CII.

13 Alternatively, is there an explicit or implicit consensus that patent protection of CII is required to ensure sufficient reward on investments made into the development of CII? If yes, please explain.

No

Please Explain

No

14 In your jurisdiction, is there an implicit or explicit consensus that availability of patent protection should be limited to contributions from certain areas of human endeavour, excluding contributions from all other areas of human endeavour, no matter how advanced these contributions?

No

Please Explain

No

III. Proposals for harmonisation

15 Do you consider that harmonisation regarding patentability of CII is desirable?
*If yes, please respond to the following questions without regard to your Group's current Law/Practice.
Even if no, please address the following questions to the extent your Group considers your Group's current Law/Practice could be improved.*

No

Please Explain

We do not see any reasonable need to reach harmonization.

6.a **Exclusion of non-patentable subject matter per se.**
Should there be any exclusion from patentability per se of subject matter relating to CII?
In this context, "per se" means that the non-patentable subject matter has to be identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.
If yes, please answer questions 16.b-16.e, if no, please go to question 17.a

No

Please Explain

No. It should be underlined that the copyright law protects the form of expression of a computer program. If a CII is not a computer program "as such", it is possible to file a patent application, which appears to be the best form of protection.

6.b Please describe the subject matter that should be excluded from patentability per se and explain in detail how it should be identified in practice.

6.c If there is subject matter identified in a patent claim related to CII you consider should be excluded from patentability per se, should it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?
If yes, please answer questions 16.d-16.e, if no, please go to question 17.a

6.d Should such “other subject matter” be required to have a certain quality, e.g. should it need to be inventive? Please state why in either case.

6.e If yes to question 16.d above, please describe the areas of human endeavour to which such “other subject matter” should relate.

7.a Requirement of a contribution in a field of technology.
Should the examination of subject matter eligibility of CII involve an examination of the contribution the claimed CII makes to the state of the art? If not, please explain.

If yes, please answer questions 17.b-17.e, if no, please go to question 18

Yes

Please Explain

Yes, of course. Otherwise, the protection should be a copyright.

7.b Should such examination be made under a test specific to CII, or should it be part of the usual novelty and inventive step/non-obviousness test? Please state why in either case.

Yes

Please state why.

It is opinion of the Italian group that there are no reasons of a specific test: the computer has to be considered as a means to implement a patentable solution.

7.c Under this test, should patentability of CII require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? In other words, should contributions from areas of human endeavour which are not deemed to be sources of patentable inventions be disregarded? If not, please explain.

If yes, please answer questions 17.d-17.e, if no, please go to question 18

No

Please Explain

It seems to Italian group that no contribution from areas of human endeavour could be useful to identify the sources of patentable inventions. Any kind of human activities could be interested in protecting a CII.

7.d Should this test also require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. Please state why in either case.

7.6 Should there be a non-exhaustive list of areas of human endeavour which are accepted as sources of patentable CII, taking into account the ultimate purpose of patent law (protecting unforeseen, non-obvious subject matter)? If yes, please provide such a list. If not, why?

18 Should there be any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

No

Please Explain

No, because the CII patent is considered as a common patent.

19 Should there be any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

No

Please Explain

As explained before, a patent directed to a CII has identical features and protection of a common patent. So, it is opinion of this group that no specific requirement is needed.

20 Please comment on any additional issues concerning patent protection of CII your Group considers relevant to this Study Question.

It is opinion of our group that there are no additional issues to point out.

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

N/A

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.

Lamberto Liuzzo