

F.A.Q. – PCT APPLICATIONS NATIONAL ROUTE REQUEST FOR OPENING ITALIAN NATIONAL PHASE

Legal references

- IPC : Legislative Decree n. 30/2005 "Industrial Property Code"
- MD : Ministerial Decree 13/11/2019 "Implementation rules for international applications entering the Italian national phase"

1. What deadline have PCT applications for entry into the Italian national phase?

The deadline, which cannot be extended, for submitting the request for entry into the national phase in Italy is 30 months from the filing date or from the date of priority, if claimed (art. 55 IPC).

2. Is it possible to request the national phase even if the 30-months deadline expired?

Within the 2 months subsequent to the expiry of the 30 months deadline it is allowed to proceed with a request of "further processing". Following art. 192 IPC, the request must be accompanied by the proof of payment of the prescribed fee and the submission of the full documentation for entry into Italian phase (complete Italian translation of the PCT application text).

3. Which fees are due for patent applications deriving from PCT?

The filing and renewal fees are established by Interministerial Decree 2nd April 2007 - Table A attached. A fee summary is published in the IT National Chapter available on the WIPO website:

<https://www.wipo.int/export/sites/www/pct/guide/en/gdvol2/annexes/it.pdf>

For invention patent applications, the filing fees for entry into the national phase is calculated on the basis of the number of claims of the international application as published (WO), i.e. the claims as originally filed or as amended under PCT art. 19. Claims modified after the international publication for the purposes of the preliminary examination under PCT art. 34 or modified under art. 172 IPC (PCT art. 28 and art. 41), are not taken into account for the filing fees calculation.

4. What methods are allowed for payment of fees?

The due fees shall be paid in EUR currency.

Fee payment methods are listed below:

- 1) F24 model;
- 2) PAGO PA;
- 3) (exclusively FROM ABROAD) Bank transfer.

Please use treasury account in the name of the Bank of Italy having the following coordinates:

IBAN: IT09Z0100003245348008121701;

BIC (SWIFT): BITAITRRENT.

In case of bank transfer payment or in case of filing by postal service, proof of payment must also be attached together with the documentation for entry into Italian phase.

5. What is the deadline for paying filing fees?

For applications for entry into the national phase, payment may be made within 30 months from the date of international filing or the date of claimed priority, failing this time limit the application will be inadmissible. In case of non-payment, the Office shall invite the applicant to pay by assigning the period of 2 months from the communication (according to Art. 148, c. 2, lett.e IPC), or a shorter period if the period of 2 months goes beyond the final deadline of 30 months. After this period has elapsed, the application is declared inadmissible.

6. How is the filing of national stage entry applications done?

- electronically, through the UIBM system, available at the link: <https://servizionline.uibm.gov.it> .
- paper mode, using INV-PCT form (for industrial invention) or MU-PCT form (for utility model), both available on IPTO website: <https://uibm.mise.gov.it/index.php/it/brevetti/domande-internazionali-di-brevetto-pct/via-italiana-per-domande-pct> .

7. Is it possible to indicate any address - as long as it is in a PCT contracting State - to receive communications from UIBM?

No, pursuant to art. 147 of the IPC, to receive all communications the applicant shall indicate or elect domicile in a member state of the European Union or the European Economic Area.

The address must be complete in full. It can correspond to:

- the domicile of the applicant(s);
- the domicile of a representative, or a lawyer registered in the professional register pursuant to art. 201 of IPC;
- the domicile of an authorized representative at the IPTO registered in the Official List of Industrial Property Consultants.

It is also mandatory for professionals or their agents, if any, to indicate their certified e-mail address or similar e-mail address based on technologies that certify the date and time of sending and receiving communications and the integrity of their content, ensuring interoperability with similar international systems (Article 147, paragraph 3-ter IPC).

Please note that the mandate of representation must always be documented by attaching the documentation proving the appointment.

In absence of address, all communications and notifications relating to the request for entry into the national phase will be published on the UIBM online register, available at the internet address:

<https://uibm.mise.gov.it/index.php/it/normativa-pi/albo-on-line> .

8. Is the "early processing" procedure admitted in Italy?

No, pursuant to art. 3, c. 1, of the MD the Office starts the examination no earlier than 30 months from the PCT filing date or from the claimed priority date. The only early examination exceptions are related to the provisions of Articles 64 and 120 IPC.

9. Is it allowed to file the request for entry into the Italian national phase before the publication of the international application?

Yes, it is possible to file it before the international publication. In this case, the attached translation must be declared "in compliance with the text as originally filed with the World Intellectual Property Organization". The applicant is responsible for the documentation submitted before the end of the secrecy period. Consequently, before examination, the applicant has to prove that the text declared "as filed" coincides with the text "as published" or to provide the modified translation with relative declaration of compliance.

10. When does the protection start in Italy?

Protection starts from the date of filing of the Italian translation of patent documents for the entry into the national phase as long as the 18-month publication period has expired.

11. Which version of the international application must be filed?

The text to be filed must be the translation of the application as published (art. 160-bis, c. 1, letter A of IPC). It is allowed to initially provide the text of the international application in a foreign language but it is mandatory to file the complete Italian translation strictly within the following 2 months (Art. 1, c. 6, MD).

If the IPTO acts as Elected Office, the translation of any amendments (description, claims and summary) attached to the International Preliminary Report (Annexes to the IPRP Chapter II) must also always be furnished, regardless of whether these documents are outdated by subsequent amendments. These documents are actually the subject of the international preliminary report, whose content has to be evaluated by the Office, along with the results of the international search report, for the purposes of the substantive examination (Article 3, paragraph 2, MD).

12. Can the patent documents into the Italian phase be amended?

Pursuant to art. 172, paragraph 2, CPI (art. PCT 28 or 41), the applicant has the right to correct the non-substantial aspects of the application. It is necessary to file for each amended document a copy reporting visibly all the changes and a copy in the final "clean" version accompanied by a letter with explanations supporting those changes.

13. When entering the Italian national phase, can the priority claim be modified with respect to the PCT application?

No, the indication of one or more priorities within the request for entry into the Italian national phase must trace exactly the priority claim stated within the PCT application. Neither deleting nor adding the priority of any application prior to what was claimed during the international phase is allowed.

14. In case of international application for which incorporation by reference was requested, is the filing date re-evaluated by IPTO?

No, if the Receiving Office preserved the international filing date, the Italian examination national phase proceeds on the basis of the integrated/corrected text, keeping the filing date established by the RO.

15. How examination is carried out for invention patent applications deriving from PCT?

The examination of international applications entering the Italian national phase is carried out with the same criteria as the national patent applications. The examination is based on the international search report, on the related written opinion, as well as on the international preliminary report, taking into account any reply presented by the applicant. In case of intention to refuse the application, UIBM assigns a deadline of at least 2 months to formulate any observations (Article 173, paragraph 7, IPC).

16. Is an additional prior art search planned?

There is no additional prior art search. The novelty search carried out in the international phase replaces the corresponding search prepared for the national applications (art. 160-bis, c. 3 IPC).

17. How examination is carried out for utility model applications deriving from PCT?

To the extent that the provisions relating to patentability requirements are applicable to utility models, the substantive examination of applications is also carried out taking into account the search report prepared in the international PCT phase, this document being present in the patent specification and accessible to the public in the same way as the other documents, as is the case, for example, for national utility model patent applications converted from a patent application for an invention for which the prior art search has already been carried out. IPTO always gives the applicant, in case of an intention to refuse, a period of at least 2 months to make any comments (Art. 173, para. 7 IPC).

18. Is it necessary to file priority documents? In case of foreign priority (e.g. Chinese), is it necessary to submit the corresponding translation into Italian or in English?

It is not mandatory to provide priority documents. IPTO can access the WIPO application dossier and it decides whether the documentation available is satisfactory for the purposes of patent examination. Otherwise, the Office has the right to ask WIPO or applicant further details or documents, with Italian translation, relating to the international examination phase, including priority documents (Art. 3, c. 4 MD).

19. Is it necessary that ownership be the same of the international application as published? Which documents must be submitted if the change of ownership took place during the international phase?

For entry into the Italian national phase the applicant must be the same as published in the international application. Otherwise, it is necessary to provide proof of being the assignee, or successor in title of the first applicant, by filing a copy of the deed of transfer of ownership. It is necessary to respect formalities referred to in art. 196 c. 1-A IPC but no registration with the Revenue Agency is required. If the change of ownership was carried out during the international phase and registered by the IB before entering the national examination phase, it is not necessary to file the transfer documentation, provided that this change can be fully verified by the Italian examiner on WIPO database.

20. What is the deadline for payment of examination fee?

There is no fee for the examination of patent applications.

21. What is the deadline for payment of granting fee?

There is no fee for granting patent applications.

22. How long does the patent protection last in Italy?

The filing date of the international PCT application is used as a basis for calculating the validity of patent rights in Italy. Patent protection lasts 20 years for invention, 10 years for utility models. The protection is valid as long as the deadlines for renewal fees payment are respected.

23. How renewal fees are calculated? Is there a penalty in case of late payment?

For invention patent applications, the payment of renewal fees is due from the beginning of the fifth year from the filing date of the PCT application. Such payment shall be made each year before the expiration of the last day of the month in which the international application was filed. The payment may still be made, together with a surcharge, for an additional period of six months (art. 227 IPC).

Scenario in case of industrial invention patent application

- PCT filing date: 10 August 2020
- Date of entry into the national phase: 5 November 2022
- Deadline for payment of the fifth annuity: 31 August 2024
- Late payment period: 6 months
- Deadline for payment of the next annuity: 31 August 2025

For utility model patent applications, the payment of the renewal fees is required only for the second five-year period calculated from the filing date of the PCT application. The payment may still be made, together with a surcharge, for an additional period of six months (art. 227 IPC).

Scenario in case of utility model patent application

- PCT filing date: 10 August 2020
- Date of entry into the national phase: 5 November 2022
- Deadline for payment of the second five-year period: 31 August 2025
- Late payment period: 6 months

Further information on renewal fees and late payment fee available at the link: <https://uibm.mise.gov.it/index.php/it/brevetti/vita-di-un-brevetto/mantenere-un-brevetto> .

24. Are renewal fees due while application is still pending or only after grant?

Renewal fees start accumulating even when the request is still pending. However, all annuities accumulated during this period must be paid within 4 months from the granting of the patent (art. 227 IPC).

25. Can multiple renewal fees be paid in advance?

Yes, the owner has the right to pay in advance to keep patent protection for some following years.

26. What happens in case of more than 6 months delay in paying renewal fees?

A delay in payment exceeding 6 months leads to the loss of the industrial property right (art. 227 IPC).

27. In case of accumulated renewal fees, what is the deadline for the payment of accumulated amounts?

The annuities cannot be accumulated (art. 227 IPC). In fact, the renewal fees must be paid strictly within 6 months of the annual expiry.

28. Are divisional applications allowed in Italy? From what date are the renewal fees and expiration of divisional patents calculated?

Divisional applications are allowed (art. 161 IPC). Filing fees must be paid imperatively within 1 calendar month from the submission of the divisional patent application.

The basis for calculating the expiration of a divisional application is always the filing date of the parent PCT application; also the renewal fees are calculated from the same date. Further information on how to file divisional applications from PCT is contained in Circular No. 624 of Feb. 24, 2023.

29. Are there other formalities to be respected for the entry into Italian national phase from an international PCT application?

In addition to the Industrial Property Code and its Implementing Regulation (DM 33/2010), it is necessary to refer to:

- Ministerial Decree of the 13 november 2019

https://uibm.mise.gov.it/images/documenti/Brevetto_internazionale_nuovo.pdf

- IT National Chapter PCT

<https://www.wipo.int/export/sites/www/pct/guide/en/gdvol2/annexes/it.pdf>

- Circular No. 610 of Jul. 02, 2020

https://uibm.mise.gov.it/images/circolari/Circolare_610.pdf

- Circular No. 618 of Jun. 06, 2022

https://uibm.mise.gov.it/images/circolari/Circolare_618.pdf

- Circular No. 624 of Feb. 24, 2023

https://uibm.mise.gov.it/images/circolari/Circolare_624.pdf