



CHINA

# Jurisdiction – Italian approach 意大利司法管辖制度报告

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# 1. The challenge of the validity of a IP right 知识产权异议程序



# How challenge the validity of a national IP right 国家知识产权异议程序

## 1. Opposition to Italian Patent and Trademark Office (only for trademarks) 向意大利专利和商标局提出异议 (仅限商标)

**When:** after the filing of an application for trademark registration, but before the registration of the trademark by the Office

**何时:** 商标注册申请提交后, 但早于商标注册日

**Who:** anyone who claims earlier trademark rights

**何人:** 主张在先商标权的任何人



# How challenge the validity of a national IP right 国家知识产权异议程序

## 2. Direct claim to Enterprise Court for invalidity 直接向企业法院申请无效

**When:** after the registration by the Office

**何时:** 商标注册后

**Who:** anyone who has interest; also the public prosecutor (but that never happened)

**何人:** 任何利害关系人; 公诉人 (尚未有此类案例)

The Enterprise Court has the power to invalidate the trademark/patent  
without previous assessment by National Office

企业法院有权不经国家局审查直接宣告商标/专利无效



# How challenge the validity of a national IP right

## 国家知识产权异议程序

- An unsuccessful claim for invalidity filed by a person does not prevent anyone else to file another claim for invalidity of the same trademark/patent on the same or different grounds 他人无效宣告请求被驳回，不妨碍任何人以相同或不同事由再次提出针对该商标/专利的无效宣告请求
- A successful claim leads to a declaration of invalidity of the registered trademark/patent *erga omnes* 宣告商标/专利无效的审查决定结论具有普遍适用效力
- A claim may lead to a declaration of a partial invalidity 无效宣告请求审查决定结论可以是维持知识产权部分有效



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3. Counterclaim or defense to Enterprise Court for invalidity of the registered trademark/patent 向企业法院提出反诉或抗辩，请求宣告商标/专利无效

**When:** after a claim for IP rights infringement has been filed

**何时:** 知识产权侵权诉讼发起后

**Who:** the defendant in a IP rights infringement action

**何人:** 知识产权侵权诉讼中的被告

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# Suing the IP rights owner for damages ?

## 向权利人发起赔偿诉讼？

- The judgement that declares the invalidity of an IP right has a retroactive effect 无效宣告请求审查决定溯及既往
- If requested, the Court shall award damages to the injured party if there is evidence that the infringer knowingly, or with reasonable grounds to know, engaged in an infringing activity 有证据显示侵权人明知或有充分理由应明知其从事侵权活动的，法院应当应请求裁定给予受害方赔偿





## 2. Specific principles of IP litigation 知识产权诉讼的具体原则



# 1. Specialisation of judges 专业法官

- IP judicial proceedings are decided by specialised courts (Enterprised courts) 知识产权司法案件由专门法院（企业法院）裁决
- The judicial panel is composed by three judges (except for interim/protective measures that are taken by the judge rapporteur) 合议庭由三名法官组成（报告法官采取临时/保全措施的除外）
- The court can appoint and independent expert, but he is not a member of the judicial panel 法院可指定独立专家，但专家不是合议庭成员



## 2. Burden of proof 举证责任

- In invalidity action: on the plaintiff 无效宣告请求诉讼：原告
- In conterefting action: on the plaintiff, but there is a rebuttal presumption of the validity of the registered trademark/patent 假冒侵权诉讼：原告，但对商标/专利有效性采取可反驳推定



### 3. Immediate disclosure of facts and legal grounds 即时披露事实和法律依据

- The claim must contain the indication of the facts and the legal grounds on which the action is based 起诉状必须说明诉讼的事实和法律依据
- The defendant must take immediate position on the claim and reply to the relevant allegations 被告必须就起诉状即时声明主张，答复相关指控
- No fact can be added to the claim or to the defence unless it is occurred after the beginning of the trial 不得向起诉状或答辩状增添事实（审理后发生的事实除外）



## 4. Discovery of evidence 证据开示

- Deadline for giving evidence indicated by the judge 法官指定证据提交截止时间
- In case the judge thinks that a party did not comply with the disclosure duty, he can: 法官认为一方当事人未遵守披露责任的，可以
  - request for information 请求信息披露
  - order the production of documents 要求出具文件
  - draw adverse inferences 作出不利推断



## 5. The judgement and the adversarial principle 裁决和对抗原则

- No definitive judgement can be delivered if the parties were not giving the opportunity to explain properly their arguments 如果未能给予双方当事人合理的解释机会，不得作出最终裁决
- The judge should have an active role in the hearing, favouring settlements, if in the best interest of the parties, and indicating the issues that needs to be addressed 法官应在听审、推动和解（如果符合双方当事人的最佳利益）、指明待决争点问题方面，发挥积极作用



## 6. Sanctions in case of infringement 侵权行为的制裁

- Corrective measures (declaration of infringement; recalling the products from the channels of commerce; depriving the product of its infringing property; definitively removing the products from the channels of commerce; destruction of the products and/or of the materials and implements concerned) 纠正措施 (宣告侵权; 要求产品从商业渠道召回; 要求剥离产品侵权部分; 命令产品从商业渠道下架; 销毁产品和/或所涉材料与工具)
- Prohibition of the continuation of the infringement 禁止继续实施侵权行为
- Award of damages: criteria of the negative economic consequences or of amount of the royalties or fees which would have been due 给予赔偿: 就不利经济后果或应付特权使用费/许可费设定赔偿标准



THANK YOU  
感谢聆听

