# INTELLECTUAL PROPERTY LAW IN ITALY

VALERIA FALCE

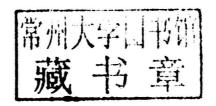


### **Intellectual Property Law in Italy**

#### Valeria Falce

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

General Editor: Roger Blanpain Associate General Editor: Michele Colucci Volume Editor: Hendrik Vanhees





Published by: Kluwer Law International PO Box 316 2400 AH Alphen aan den Rijn The Netherlands Website: www.kluwerlaw.com

Sold and distributed in North, Central and South America by:
Aspen Publishers, Inc.
7201 McKinney Circle
Frederick, MD 21704
United States of America
Email: customer.service@aspenpublishers.com

Sold and distributed in all other countries by: Turpin Distribution Services Ltd. Stratton Business Park Pegasus Drive, Biggleswade Bedfordshire SG18 8TQ United Kingdom Email: kluwerlaw@turpin-distribution.com

DISCLAIMER: The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

ISBN 978-90-411-5424-8

This title is available on www.kluwerlawonline.com

© 2014, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without written permission from the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal, 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Email: permissions@kluwerlaw.com

Printed and Bound by CPI Group (UK) Ltd, Croydon, CR0 4YY.

# **Intellectual Property Law in Italy**



Valeria Falce is Professor of Economics Law at the European University of Rome. As Co-Director of CREDA – Center Research for Copyright Law, Innovation and Information, in 2013 she has been Visiting Scholar at the Schuman Centre of the European University Institute, Florence. In 2012 she has been Advisor to the (DG Internal Market) Study on trade secrets and confidential business information in the Internal Market (2012/S 26-041230) as well as to the 2013 World Intellectual Property Organization (WIPO) Study on Competition, Copyright and Development. From 2007 to 2009 she served as Independent Expert appointed

by the Italian Ministry of Culture within the Committee for the Reform of Copyright Law and as Coordinator of the Committee Copyright appointed by the Italian Ministry of Culture. After graduation *cum laude* from the Luiss Guido Carli University of Rome, Valeria gained a PhD in Competition Law at the University of Perugia, and succeeded with full marks a Master in Law in Intellectual Property from the London School of Economics, University of London. Author of three monographs and more than eighty articles published in leading national and international law reviews, Valeria's scientific interests are so far mostly focused on Intellectual Property, Competition Law and Regulation.

THE AUTHOR	2
List of Abbreviations	11
Preface	13
General Introduction	17
§1. GENERAL BACKGROUND  I. Political System  II. The Legislative Power  III. The Government  IV. The Judicial Power  V. Sources of Italian Law	17 17 18 19 19
§2. RESEARCH AND INNOVATION	21
Intellectual Property Law	23
Chapter 1. Copyright and Neighbouring Rights	23
§1. Introduction	23
§2. Sources: Legislation	24
§3. Subject Matter of Protection	25
§4. CONDITIONS OF PROTECTION  I. Formal Expression as General Substantive Requirement  II. Creativity and Originality as General Substantive Requirements  III. Novelty and Unintended Coincidence  IV. Mobile Boundaries of the Notion of a Work: A Work, Portions of a Work and a Collective Work  V. Continued: Complex Works  VI. Derivative Works	25 25 27 29 30 31 31

§5. OWNERSHIP  I. The Author (Initial Authorship)  II. Works Made for Hire	34 34 35
§6. Transfer	38
§7. Scope of Exclusive Rights I. Introduction II. Moral Right ( <i>Droit Moral</i> )	45 45 46
A. The Right to Attribution B. The Right to Integrity C. The Right to Withdrawal III. Property Rights	47 48 50 51
A. Introduction B. Distribution Rights C. Continued: The Principle of Exhaustion	51 53 53
<ul><li>D. Rental and Lending Rights</li><li>E. Right to Execute, Perform and Recite in Public</li><li>F. The Right to Elaboration</li></ul>	54 55 56
§8. EXCEPTIONS AND LIMITATIONS TO THE SCOPE OF COPYRIGHT PROTECTION	57
§9. DURATION OF PROTECTION	62
§10. RELATED RIGHTS  I. General Overview  II. Protection of Databases  III. Special Rules	63 63 69 70
§11. COPYRIGHT MANAGEMENT IN THE INTERNET ERA  I. Introduction  II. The Traditional Paradigm in Pills  III. The Era of Disintermediation: From the EU Approach to the	72 72 73
Italian Solution  IV. Article 39 of the Liberalization Decree: A Necessary Premise  V. The Rationale of the Provision and Its Inconsistencies  VI. The (Still) Awaited Happy End  VII. Conclusions	74 75 76 77 79
Chapter 2. Patents	80
§1. Introduction	80

81

§2. Sources: Legislation

§3. PATENTABLE SUBJECT MATTER AND CREATIONS NOT DEEM	IED AS
Inventions	81
I. Principles and Rules	81
II. The Underlying Rationale and Recent Trends	82
§4. CONDITIONS OF PATENTABILITY	86
I. Industrial Application	86
II. Novelty	88
III. Originality	90
IV. Indices of 'Non-obviousness'	93
V. Legality	95
§5. FORMALITIES	95
I. Principles and Rules	95
II. The Disclosure	97
§6. OWNERSHIP AND TRANSFER	99
I. Introduction to Ownership	99
A. Joint Ownership	100
B. Ownership in Employees' Inventions	100
C. Inventions by Research Workers in University and	
Research Centres II. Principles and Rules on Transfer	101
n. Filiciples and Rules on Transfer	102
§7. SCOPE OF EXCLUSIVE RIGHTS	103
I. The Product Invention	103
II. The Invention of New Use	104
III. The Method Invention	105
IV. Derivative Invention	107
V. Territoriality and Exhaustion Principle	108
VI. Unlawful Exploitations	108
§8. LIMITATIONS AND EXCEPTIONS TO THE SCOPE OF PATENT	
PROTECTION: COMPULSORY LICENSING	110
I. Non-competitive Uses and Experimental Use	110
II. Pre-use	111
III. Compulsory Licenses	112
<ul> <li>A. Compulsory Licenses for Non-implementation</li> <li>B. Compulsory Licenses for Derivative Inventions</li> </ul>	113 114
B. Compulsory Electises for Derivative Inventions	114
§9. DURATION OF PROTECTION	116
§10. Innovation in the New Sectors	117
I. Introduction	117
II. The Challenge of Chemical Patents	117
III. Biotechnological Patents	120
IV The Continuation of Decearch in New Sectors of the A	rt 121

<ul><li>A. The Patent Pool Technique</li><li>B. The Clearing House Technique as a Sound Solution</li><li>C. Conclusions</li></ul>	124 126 126
Chapter 3. Utility Models, Designs and Models	128
§1. Sources: Legislation	128
§2. THE PROTECTION OF UTILITY MODELS	128
§3. THE PROTECTION OF DESIGNS AND MODELS	129
§4. THE PROTECTION OF THE SHAPE OF PRODUCTS	132
Chapter 4. Trademarks	142
§1. Introduction	142
§2. Sources: Legislation	144
§3. SUBJECT MATTER OF PROTECTION  I. Signs Which May Serve as Trademarks II. Signs Excluded from Protection	145 145 146
§4. CONDITIONS OF PROTECTION OF TRADEMARKS  I. The Distinctive Capability II. Continued: The Rehabilitation of the Trademark III. Novelty IV. Novelty and Previous Filings V. The Disabling Power of the Trademark Which Enjoys Renown VI. Novelty and Validation of the Trademark VII. Lawfulness	147 149 149 151 151 152
§5. FORMALITIES: REGISTERED AND UNREGISTERED TRADEMARKS – PROCEDURES AND EFFECTS OF REGISTRATION I. Procedures and Effects II. The Discipline of the Unregistered Trademarks	152 152 154
§6. Ownership and Transfer	156
§7. SCOPE OF EXCLUSIVE RIGHTS  I. Principles and Rules II. Weak and Strong Trademarks III. The trademark Which Enjoys Renown	157 157 161 162
88 I IMITATIONS OF THE SCORE OF TRADEMARK PROTECTION	162

9

§9. DURATION OF PROTECTION	164
§10. COLLECTIVE MARK AND DESIGNATIONS OF ORIGIN	164
Chapter 5. Plant Variety Protection	170
Chapter 6. Chip Protection	174
Chapter 7. Trade Secrets	176
Chapter 8. Infringement, Procedure and Remedies	180
§1. Introduction	180
§2. THE BURDEN OF PROOF OF THE PRELIMINARY INVESTIGATION PHASE	180
§3. THE BURDEN OF PROOF IN THE JUDGMENT OF INVALIDITY OR REVOCATION OF BRANDS	181
§4. Infringement and Remedies: The Invalidity and Revocation of the Trademark	181
§5. THE BURDEN OF PROOF IN JUDGMENT OF INVALIDITY OR REVOCATION OF PATENTS	185
§6. CLAIMS OF INTELLECTUAL PROPERTY TITLES	185
§7. Claims over Brands	185
§8. Claims over Patents	185
§9. ACTION FOR INVALIDITY AND REVOCATION: ACTIVE LEGITIMACY	186
§10. EFFECTIVENESS OF THE SENTENCE OF INVALIDITY AND REVOCATION	186
§11. THE JUDGMENT OF COUNTERFEITING	186
§12. Precautionary Measures	187
§13. PRIOR TECHNICAL ADVICE, DESCRIPTION, SEIZURE, INJUNCTION	187
§14. CIVIL SANCTIONS	187
§15. Damages	188
§16. REIMBURSEMENT OF COUNTERFEITER'S PROFITS	189

§17.	TEMPORARY PROTECTION OF THE PATENT APPLICATION OR REGISTRATION	189
§18.	CRIMINAL AND ADMINISTRATIVE SANCTIONS	190
§19.	EUROPEAN PATENT PROTECTION	192
§20.	JUDGMENTS RELATING TO EUROPEAN COMMUNITY TRADE MARKS	192
§21.	AVAILABLE PROCEDURES	193
Sele	ected Bibliography	195
Inde	ex	201

## **Intellectual Property Law in Italy**

#### Valeria Falce

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

General Editor: Roger Blanpain Associate General Editor: Michele Colucci Volume Editor: Hendrik Vanhees



Published by: Kluwer Law International PO Box 316 2400 AH Alphen aan den Rijn The Netherlands Website: www.kluwerlaw.com

Sold and distributed in North, Central and South America by: Aspen Publishers, Inc. 7201 McKinney Circle Frederick, MD 21704 United States of America

Sold and distributed in all other countries by: Turpin Distribution Services Ltd. Stratton Business Park Pegasus Drive, Biggleswade Bedfordshire SG18 8TQ United Kingdom Email: kluwerlaw@turpin-distribution.com

Email: customer.service@aspenpublishers.com

DISCLAIMER: The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

ISBN 978-90-411-5424-8

This title is available on www.kluwerlawonline.com

© 2014, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without written permission from the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal, 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Email: permissions@kluwerlaw.com

Printed and Bound by CPI Group (UK) Ltd, Croydon, CR0 4YY.



Valeria Falce is Professor of Economics Law at the European University of Rome. As Co-Director of CREDA – Center Research for Copyright Law, Innovation and Information, in 2013 she has been Visiting Scholar at the Schuman Centre of the European University Institute, Florence. In 2012 she has been Advisor to the (DG Internal Market) Study on trade secrets and confidential business information in the Internal Market (2012/S 26-041230) as well as to the 2013 World Intellectual Property Organization (WIPO) Study on Competition, Copyright and Development. From 2007 to 2009 she served as Independent Expert appointed

by the Italian Ministry of Culture within the Committee for the Reform of Copyright Law and as Coordinator of the Committee Copyright appointed by the Italian Ministry of Culture. After graduation *cum laude* from the Luiss Guido Carli University of Rome, Valeria gained a PhD in Competition Law at the University of Perugia, and succeeded with full marks a Master in Law in Intellectual Property from the London School of Economics, University of London. Author of three monographs and more than eighty articles published in leading national and international law reviews, Valeria's scientific interests are so far mostly focused on Intellectual Property, Competition Law and Regulation.

List of Abbreviations	11
List of Abbieviations	
Preface 1	13
General Introduction	17
I. Political System  II. The Legislative Power  III. The Government  IV. The Judicial Power  1	17 17 18 19 19
§2. RESEARCH AND INNOVATION 2	21
Intellectual Property Law	23
Chapter 1. Copyright and Neighbouring Rights	23
§1. Introduction	23
§2. Sources: Legislation	24
§3. SUBJECT MATTER OF PROTECTION	25
<ul> <li>I. Formal Expression as General Substantive Requirement</li> <li>II. Creativity and Originality as General Substantive Requirements</li> <li>III. Novelty and Unintended Coincidence</li> <li>IV. Mobile Boundaries of the Notion of a Work: A Work, Portions of a Work and a Collective Work</li> <li>V. Continued: Complex Works</li> </ul>	25 25 27 29 31 31 31