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ABSTRACT DEGLI STUDI DI PARTE I

ITEMA: SEGNI DISTINTIVI E PUBBLICITÀ DEL MADE IN (NEL DIRITTO UE ED ITALIANO)

STEFANO A. CERRATO, *I segni indicativi del made in*
3/2016

The paper analyzes the «made in» signs.

The Author firstly defines the meaning of «made in» and the rules governing this category, starting from the Paris Convention up to TRIPs.

The Author then focuses on the different signs expressing a «made in» quality (rules of origin, trademarks, GI's, etc.).

The examination of this matter leads to some concluding remarks on the costs and benefits of the system of «made in» signs and shows some possible areas of de jure condendo intervention.

VINCENZO DI CATALDO, *Denominazioni e indicazioni geografiche tra registrazione comunitaria e protezione nazionale. Made in, IGP e DOP*
31/2016

The article considers the doctrine of the EU Court of Justice, which has frequently said that the EU Regulation on Geographical Indications is exhaustive in nature, in the sense that the so called «qualified» Geographical Indications (if not registered at the EU level) cannot enjoy protection under National Law. Developing this doctrine, the Italian Corte di Cassazione has added that the Member States cannot give protection to qualified Geographical Indications neither under the law of unfair competition. The rationale of this doctrine is that National rules protecting Geographical Indications can block the free circulation of products into the Common Market. According to the Author, national rules do not have such a risky effect in the field of Geographical Indications, for the same reason they do not have it in the field of all the other Intellectual Property rights. In this perspective, the Common Market is a really unitary market only for some products and services, really circulating at the EU level; for many other products, circulating only at the local level, and not interested in the transnational trade, Europe still has many smaller markets, having national or subnational dimension. The products moving only at the local level are not interested by EU IP rights, and, for them, National IP rights are much more appropriate; and if this is true for patents, trade marks and designs, it is true also for Geographical Indications. Hence, National laws protecting the Geographical Indications (both qualified and simple) cannot be considered per se to be in contrast with EU Law.

CHIARA ALVISI, *Made in e autodisciplina pubblicitaria*
51/2016

This chapter introduces a summary of opinions and relevant precedents concerning the misleading and unfair exploitation of geographical indications in commercial advertising.

Whenever it comes to qualified geographical indication, which, under art. 22 of the Trips Agreement and art. 29 of the Italian Industrial Property Code, acts as a certification that the product comes from a designated area and meets certain criteria, all business entities from the designated area are entitled to take legal action under the Italian Industrial Property Code (art. 30 and art. 117 et seq.) and art. 2598 et seq. of the Italian Civil Code against a competitor

that gives the impression that its product, or products, has a relevant origin, characteristic, quality or association that does not exist. Nevertheless, the European Court of Justice recently held that protected designations of origin and protected geographical indications used in regard to food and agricultural products must be registered in order to qualify for legal protection under Italian regulations concerning industrial property protection and unfair competition. This decision has been strongly criticised by academics. Notwithstanding this ruling, if a geographical indication is used to mislead the public by indicating the geographical origin of goods but does not act as a certification that the product meets certain standards, competitors, no matter where their legal residence may be, are always entitled to take legal action under the Italian regulation concerning unfair competition on this basis alone. This protection is not available to consumers and their associations, which, along with competitors, may take recourse before the Italian antitrust authority to have an advertisement or misleading use of geographical indications prohibited and sanctioned.

Focus is given to the Italian Ad self-regulatory organization's case law concerning advertisements that use toponyms as fantasy-name products or brand names (e.g. Montenegro liqueur) or as brand names suggesting origin (e.g. Tahiti foam bath) or for the identification of a particular type of regional product (e.g. advertisements for Pasta di Napoli and Pilsner beer) or a protected designation of the area of origin that is not factual (e.g. advertising for Asiago cheese). Italian Ad SRO case-law contains instances of advertising and/or promotion using 'made in' claims (for instance in relation to the marketing of Scottish shoes and Swiss cosmetics that were not made in those countries) or suggesting that the product was «made in Italy» by using the Italian national anthem for the advertisement's musical score.

By way of conclusion, the author highlights that advertising self-regulation concerns the commercial exploitation of geographical indications in the context of the likely understanding and perceptions of the average consumer, and that the Ad SRO shows respects and promotes the European basic rule of freedom of movement of goods within the European market, which is enshrined in the European Union Treaty.

LUCA NIVARRA, ***Illeciti e sanzioni civili***
73/2016

Made in» in recent years has been the subject of numerous regulatory measures to give it special protection. In this essay we will analyze if the Made in Italy may be subject to special protection from the point of view of civil law remedies. In particular, we will try to understand whether and to what extent, the origin can integrate the quality of the object of a contract and, therefore, what are the consequences in the event of false or erroneous indication of a particular place of origin.

MARCO RICOLFI, ***La protezione doganale della proprietà intellettuale***
82/2016

The article looks at EU border measures to protect IP as provided by (EU) reg. n. 608/2013 in specific connection with their impact on geographically misleading signs. Before specifically dealing with the provisions of the regulation, it places them in the context of general international and EU principles. In the second half of the article special attention is paid to domestic implementation of the regulation, with emphasis on Italian «made in legislation» and on the interplay between criminal and administrative remedies and sanction.

ALFREDO MARRA, ***La disciplina degli illeciti e delle sanzioni amministrative in materia di made in***

99/2016

The paper focuses on the latest approach of public enforcement of consumers' rights, both at European and national level. The overview of the evolution of administrative sanctions and related inhibitory powers offers an interesting point of view. Particularly the analysis of sanctions against the violation of rules on the geographical origin of the goods and products, in three distinct sectors, shows a progressive expansion of public enforcement. Public enforcement is therefore an industrial policy tool with only indirect and accidental effects on consumers.

FRANCESCO GOISIS, ***La tutela amministrativa cross border del made in Italy***
117/2016

The essay aims at investigating, both de iure condito and de iure condendo, whether it may be conceivable and beneficial a cross-border administrative protection of the made in. Despite the fact that administrative acts are in principle enforceable only within the national boundaries, prospectively the question may receive a positive answer. This especially to the extent that the increasing assimilation between judicial and administrative functions as emerging in the ECHR system, and, therefore, the ample cross border enforceability of judgments in the civil and commercial field are taken in full count.

FEDERICO CONSULICH, ***La pena ed il confine. La repressione delle abusive indicazioni di provenienza geografica tra diritto penale e libero mercato***
128/2016

This paper examines the different criminal and administrative offences compulsively introduced by the Italian legislator in the last few years in order to offer a suitable penal protection to the so called made in, which consists in the correct geographical indications and designations of origin marks on the products for sale. Furthermore, the Author tries to offer a logical reconstruction of the punitive subsystem, which includes cases concerning the punishment for the sellers' unlawful behaviours and cases concerning the punishment for buyers who purchase counterfeit goods, albeit He is conscious that the rules that constitute this subsystem show a high rate of irrationality and uneffectiveness. Among the uneffectiveness factors that interest the made in regulations, this paper highlights the limits of norms' territorial application, which is limited to the national borders, and the Supreme Court very restrictive interpretation, which conflicts with the purpose of protection pursued by the legislator in some cases. In a criminal lawyer's perspective, the absence of a definite legal asset to protect is the real gravest defect of these regulations. The geographical indications and designations of the products origin is not, for itself, an asset deserving protection: it can acquire this quality within a wider regulatory framework of the rights to information for the consumer in the European judicial area. Finally, this paper aims to implement the effectiveness of the regulations relating to the fight against designated origin abuse through the institution of the new offence of self-laundering established in the art. 648 ter.1 c.p., that is particularly able to repress the behaviours of investment of proceeds derived from the counterfeit goods sale.

II TEMA: UN BILANCIO DEL DIRITTO D'AUTORE UE. I FONDAMENTALI DEL DIRITTO PRIMARIO

ANDREA OTTOLIA, *L'interferenza permanente fra proprietà intellettuale e libertà di espressione nel diritto dell'Unione Europea: una proposta di bilanciamento*
157/2016

The present paper investigates the interference between copyright and freedom of expression in the European Union. In particular it (i) shows that the Court of Justice has substantially avoided to balance those rights, while a significant space remains for an interpretative fine tuning in this field; (ii) analyses the meaning of freedom of expression and recognises how it «permanently interferes» with copyright; (iii) argues that the balance between these fundamental rights could be undertaken by the Court beyond the breathing spaces provided by specific intellectual property clauses containing exceptions or limitations; (iv) suggests that such balancing should be pursued by selecting solutions not meant to maximize third interests but to minimize both rights' sacrifices.

ELISABETTA LOFFREDO, *Unificazione, armonizzazione e sussidiarietà nel diritto d'autore europeo*
193/2016

The study traces the process of Europeanization of Copyright Law, through which the framework of EU Countries' rights was outlined. The focus was set on the analysis of the two methods of coordination between the legislations of EU Countries, namely full harmonization and harmonization by rules which refer back (also here called conditional harmonization), and on the analysis of their correlation with the principle of subsidiarity. This principle restricts the discretionality of the EU Institutions in choosing ways and contents of centralised intervention, allowing harmonization by Directives only when it is followed by efficiency gains in comparison to national action. The study therefore identifies as good harmonization that one which corresponds with a correct use of legislative competence, in accordance with the principle of subsidiarity and of the objectives of the European Union. The harmonization process is analysed with regard to the two phases of the process, that is to say negative harmonization – through the decisions of the EUCJ – and positive harmonization, that was achieved by the Directives on harmonization of Copyright, which were adopted in the period 1991-2012. The analysis takes account of several elements that influenced methods and contents of the harmonization of Copyright law. In particular, specific consideration is given to the international Conventions to which the European Union takes part as a juridical subject (BUC, Wipo Cooperation Treaty, Wipo Performance and Phonograms Treaty); at the same time, the analysis observes the new structure of the EU Treaties, with Intellectual Property being acknowledged as one of the fundamental rights protected by the European Union, the emergence of culture as one of the EU objectives and the new perspective of a single European Copyright Title.

KARL-NIKOLAUS PEIFER, *Territorialità e portabilità dei servizi di contenuti on line*
230/2016

Users of online content on portable devices have an interest to access services wherever users are and whenever they want to have access. Within the European Union this interest is protected by the freedom to move but endangered by the territoriality principle in Copyright Law. The European Commission wishes to harmonize both interests by imposing to service providers an obligation to grant access not only within the territory of the consumer's ordinary residence but also in territories of temporary residence. This obligation is the kernel of the proposal of a Regulation to ensure cross-border portability. Right holders fear that the

difference between temporary and ordinary residence remains unclear. Misuse scenarios come up. The overall fear is that the territoriality principle in Copyright Law and territorial license schemes will be undermined. The text will discuss the future of the digital market within this seemingly small ambit and the impact on other areas. It argues that the proposal is a reduced but necessary and technically also an elegant step forward from a legal policy point of view.

CARLA ZUDDAS, ***Commons e diritti d'autore***
244/2016

The issue of «Commons and copyrights» needs unification of meanings and contexts, traceable in the system of the sources of European copyright, and in particular in the Berne Convention for the Protection of Literary and Artistic Works. An interrelation between the concepts of «commons» and «copyright» is identifiable in the unwritten tradition of cultural expressions (TCEs): traditional works and practices that represent all those manifestations of the culture of communities and social groups, whose spread and survival is often entrusted to dynamics of intergenerational transmission, mainly in an oral form. They are works that live in a kind of limbo: it is rare to know the original name of the author, and often the beneficiaries are ignored, without considering that it is assumed that they have already fallen into the public domain, without a given time to refer to in case of authorial protection. The study addresses the issue of protection of folklore works in the Berne Union Convention, where one can find regulations to identify the subjects entitled to exercise rights for works of unknown authors, and in other sources of copyright. The qualification of the concept of TCE as intellectual work in indistinct ownership, hardly protectable by copyright, lead one to take into account additional paths that provide a management model based on the concept of «commons of knowledge» and to present a solution which recognizes to the communities the membership and will grant them their rights. To recognize the expressions of folklore as commons of knowledge will allow a reasonable collective use that does not affect the transmission of this intangible heritage and that serves to prevent inappropriate or unauthorized use by persons outside the contexts and communities. The recent guidelines of the European and national policies indulge to consider the collective and social dimension of heritage in terms of the possible interactions between the various parties concerned, namely development models in which communities play a key role, not only as guardians of the common values , but also mediator in and of cultural diversity.

PHILIPP FABBIO, ***Opere protette e requisiti di tutela nel diritto d'autore UE***
281/2016

Starting with its decision in the Infopaq case (2009), the Court of Justice of the European Union has undertaken a first and partial harmonization of the general concept of work as well as the requirement of originality under copyright law (through the AOIC standard: «author's own intellectual creation») and in doing so has moved beyond the existing harmonization directives that deal only with specific categories of works . This article outlines the state of the art under EU law, and presents what could be a desirable evolution at the level of both legislation and interpretation. It claims that a legislative intervention would allow for a more in depth and comprehensive harmonization of this area of the law, but that legal scholars and the Courts would continue to play within it a fundamental role. The article concludes with a number of substantial proposals to advance further harmonization at the level of interpretation and toward additional legislative initiatives.

EMANUELA AREZZO, ***Il dibattito sull'opera utile par excellence: il software***

309/2016

The debate regarding software protection and in particular whether software innovations are better spurred through the implementation of copyright vis-a-vis patent protection is one of the longest in the history of IP law. The debate arose at the end of the sixties in the United States of America and was initially framed in terms of which paradigm was best suited to protect software, hence worth being adopted as official instrument of protection. As well known, the debate seemed to end, both in USA and Europe, with the recognition of copyright, as instrument to foster creativity in such sector. Nonetheless, both in USA and in Europe a significant portion of software innovations recur to patent protection. As experience has come to show, the two instruments of protection must not necessarily be seen as alternative, as software should be considered just as any other technical means which can well be implemented to write a computer program, in the meaning espoused by the Copyright Directive, but can also be employed to build a software invention, which can take the form of both a complex technical device which works thanks to the instruction given by the software or of a tiny sliver of technology, performing a single function to be adopted in several electronic devices. The acknowledgement of such coexistence, however, is not the end of the debate, as we must now deal with the issues such coexistence is likely to bring about.

MASSIMILIANO GRANIERI, *L'appartenenza dei diritti d'autore*
328/2016

This article analyzes the evolution of the European Union copyright law, from the perspective of harmonization, with respect to ownership of economic rights on intellectual creation. The results of the analysis seem to support the view that EU law resorted ever since to two models of allocation of rights. In the first place, a rule of individual ownership is restated at European level, although imported from the CUB. Yet, in some instances, where prevalence of the organizational efforts is straightforward and crucial to ensure incentives to employers, a rule of institutional rule is also introduced, which involves at least software, databases and design. The author tries to affirm that, when compared with the current dynamics and the modern forms of creation, the harmonized framework is an unfinished painting that the European institutions could complete. The Treaties (particularly as far as the creation of the internal market is concerned) would provide a consistent basis to further harmonization.

LUIGI CARLO UBERTAZZI, *La disciplina UE dei diritti morali d'autore*
349/2016

Questo studio critica la communis opinio secondo cui la UE non avrebbe ancora disciplinato i diritti morali d'autore: e ricostruisce la ragnatela delle fonti comunitarie dedicate a questi diritti. Poi si propone di dimostrare che la CUB è stata incorporata/appartiene al diritto della UE, e d'altro canto si applica non soltanto allo straniero ma anche al cittadino dello stato di protezione. Infine si dedica ad alcuni dei temi relativi ai diritti morali d'autore; ricorda per ciascuno di essi la disciplina prevista dalle diverse fonti del diritto UE; e qui tra l'altro sostiene ed indica gli argomenti per cui la CUB non garantisce all'autore il diritto all'indicazione del suo nome su ogni esemplare ed in ogni utilizzazione dell'opera.

ALESSANDRO COGO, *L'armonizzazione comunitaria del diritto patrimoniale d'autore*
412/2016

Twenty-five years ago, the first harmonization directive on copyright law was adopted. Many directives followed, supplemented by dozens of decisions of the European Court of Justice. As we are heading towards a new round of interventions from Brussels, the time seems right to assess to what extent the rights granted by copyright law have been harmonized so far and which principles inspire the protection that they provide. Given the importance acquired over the years by the jurisprudence of the Court of Justice, the paper attempts to answer these questions mainly by reviewing critically the decisions of the Court. Within this framework, the paper highlights the absence in EU law of a general clause reserving all uses of the work to the author and analyses its consequences. In this connection, it argues that the catalogue of authors' exclusive rights has been fully harmonized (including – contrary to the opinion expressed repeatedly by the Court – all forms of communication of the work to the public, no matter whether taking place from a distance or in the same place where the public is), leaving no room for national legislators to provide additional rights. Then, the paper focuses on the conflicts between right-holders and users which have arisen in the last years and that are apparently driven by the intention of the right-holders to extract the maximum potential economic value from their rights. It argues that the Court has elaborated on the idea that copyright protects the interest of right-holders to obtain an «adequate remuneration» and not the «maximum remuneration» or, at the other extreme, a «symbolic remuneration». This seems to be the principle inspiring the solutions adopted by the Court on several issues, going from the definition of «equitable remuneration» to that of «exhaustion» and «communication to the public», particularly in respect of acts of communication that stem from other acts of communication to the public. The paper focuses then on the conflicts which have arisen from the attempt of right-holders to stop altogether certain uses of their works. It highlights that the Court has increasingly relied on fundamental rights to solve a number of crucial issues (including in particular that of linking), which the UE legislator left open without clearly referring their solution to the member States. Lastly, the paper singles out the conflicts arisen between different categories of potential beneficiaries of equitable remuneration rights. It argues that the Court expressed, in a rather creative manner, solutions which resume the idea of protecting the authors also in their contractual relationships with the industry, which was expressed in an early directive and then reaffirmed from time to time in later pieces of legislation. In conclusion, the paper compares its findings with the rules contained in the proposed directive on copyright in the digital single market.

GIORGIO SPEDICATO, *L'esaurimento UE dei diritti*
443/2016

This paper examines the evolution of the EU copyright exhaustion, from its first recognition by the European Court of Justice in the Deutsche Grammophon case to the recent perspective taken by the CJEU in the Usedsoft case with respect to digital copies. Taking into account the economic rationale of the principle of exhaustion and considering the ongoing dematerialisation of markets for copyrighted works, the author investigates whether – in the light of international and EU legislation and of the ambiguous approach of the European Court of Justice when requested to interpret the copyright rules in the context of the digital environment – such principle will still play a central role in the near future as a tool to avoid the artificial partitioning of the common market.

FRANCESCO MEZZANOTTE, *Le «eccezioni e limitazioni» al diritto d'autore UE*
480/2016

The article aims at sketching the state of the art of exceptions and limitations in European copyright law. It provides a survey of the relevant provisions of EU law, in the light of the interpretative criteria imposed by the hierarchical relations between primary and secondary sources, and inferable also from the case law of the European Court of Justice. The analysis is in particular focused on the suitability of the current regulatory framework: (i) to promote an adequate level of harmonization of rules on exceptions and limitations in the EU Single Market, and (ii) to adapt itself flexibly to evolving exploitation techniques of copyrighted materials, connected to the digital and the online environment. This latter topic is related to one of the most controversial issue traditionally associated with the rules on exceptions and limitations: the admissibility of their extensive, and possibly analogical, interpretation.

ALTRI STUDI

PAOLO SPADA, *Utile et «futile» dans la propriété intellectuelle: la «valeur artistique» des dessins et modèles en droit italien*
526/2016

Under Italian Copyright law an industrial item registered as a design can accede to copyright protection if it is endowed with «artistic value». While Courts refrain from directly assessing the aesthetical level, the acknowledgement of «artistic value» is commonly linked to the circumstance that the industrial item is appreciated also in the art circuit/market - typically, if it is hosted by a museum or an art gallery. The author holds that a Constitution-oriented interpretation of Copyright law - one, thus, capable to prevent deeply anti-competitive cumulus of copyright and registration protection after the termination of latter - should lead to affirm that copyright protection must be limited to infringements occurring within the art market, as distinguished from the ordinary mass-scale commercial circuit.

DAVIDE SARTI, *Campi di gioco e vasi di Pandora: la gestione collettiva dei diritti d'autore nel confronto UE-USA*
535/2016

Directive 2014/26/EU on collective management of copyright and related rights aims at creating a level playing field of competition between collective management organisations. The article compares the European system with the US system, and shows that the US system is based on a different approach. Not only the US system is based on the application of general antitrust rules, where the EU system provides for special rules, which are relevant independently from any consideration of market power, price fixing or excessive prices practices. In addition, the US level playing field created through consent decrees only apparently resembles the system of special rules introduced through the European directive. The US system strikes essentially on the objective to find a proper balance between the interest in lowering transaction costs and the opposite interest in preventing excessive prices. Although the same objective finds many references in European scholarship, the article suggests that the problem of transaction costs is not central in the system of the EU directive. This conclusion argues through the solution adopted by US courts in Pandora case. Pandora was essentially judged considering the interest in lowering transaction costs; but this judgement would be completely inconsistent with the European directive. Therefore, the article proposes a different approach to the Euroan directive. Under this alternative approach, transaction costs do not play a central role. Instead, it should be considered the interest in realizing a fair market system to determine a proper compensation of copyright and related rights owners. Only after this mechanism (implemented through the directive) is furtherly investigated, it should be evaluated

if it would be consistent with the general antitrust rules when (and only when) a collective management organisation exerts market power. This investigation should also consider another aspect of US implementation of antitrust rule to collective management organisations, namely the notion of “right compensation” of intellectual property owner under US general antitrust rules. This notion is not clearly expressed in US antitrust cases, and sometimes seems to be contradictory exposed. Therefore, the notion of “right compensation” according to the US system will be investigated in future articles, which will consider US cases concerning the application of the special rules contained in the consent decree.

GIUSEPPE CARRARO, ***Il pentimento dell'autore come diritto fondamentale***
569/2016

This essay investigates the authors' moral right to withdraw. It particularly focuses on the right to withdraw as a fundamental right, both in the perspective of the ECHR and its Art. 8, 9 and 10, and in light of the recently adopted Regulation (EU) 2016/679 of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data (General Data Protection Regulation).

FRANCESCO BANTERLE, ***Brevi cenni sulla titolarità dei dati comportamentali nei big data tra privacy e proprietà intellettuale***
579/2016

Data about customers are becoming a critical asset in new marketing strategies. This article investigates the concept of data ownership in the context of big data, particularly in relation to cloud platforms. In particular, it elaborates the ownership regime set out by the intersection between data protection and intellectual property laws. Finally, the article asks which ownership regime is applicable to raw data that are not subject to privacy or intellectual property rights, in particular, whether raw data can be subject to a general property right.

LUIGI CARLO UBERTAZZI, ***Brexit e brevetto UE***

The paper concludes in particular that 1) the EU patent applies only to the EU territory; 2) the instruments composing the Patent Package are tied to each other; in particular there are at least 12 connection-phases between the UPCA (on the one hand), the decision 167 and regulations 1257 and 1260 (on the other hand), and 5 additional connection-phases may exist; 3) the withdrawal of the UK makes the TEU and TFEU inapplicable to its territory, as well as the whole secondary law deriving from them (including the above-mentioned decision and regulations); 4) the withdrawal is necessarily extended to the UPCA by the rules on tied instruments, in particular by the clause of the Vienna convention on treaties concerning the interpretation and the performance of the international agreements according to the good faith, but also by the general private law principles considered as source of international law under art. 38 of the international Court of justice statute; 5) the withdrawal of the UK (also) from the UPCA implies that the currently scheduled London section of the UPC needs to be relocated in a(nother) EU member state; 6) (according to one author) after the withdrawal declaration, UK could ratify the UPCA only in fraudem legis; I am of the opinion that the UK ratification of the UPCA would infringe some rules, among which the general principle of the Vienna convention stating that treaties have to be performed in good faith, the private law principle on the performance of contracts in good faith, considered as a source of international law under art. 38 of the international Court of justice statute; the principles deriving from those on

good faith imposing the protection of co-contracting parties in a contract or a treaty; maybe the precautionary principle.