

## AIDA 2017

### ABSTRACT DEGLI STUDI DI PARTE PRIMA

#### **I TEMA: NOVITÀ UE IN MATERIA DI MARCHI**

GIOVANNI GUGLIELMETTI, *I marchi registrabili*  
3/2017

*L'abolizione del requisito della rappresentazione grafica del segno, l'allargamento dell'elenco dei segni registrabili, e l'estensione degli impedimenti assoluti alla registrazione dei marchi di forma anche ai marchi costituiti da altre caratteristiche dei prodotti, sono espressione della ratio unitaria di aprire il sistema europeo ai marchi c.d. non tradizionali, che hanno assunto negli ultimi anni una importanza sempre maggiore. La nuova disciplina mantiene un equilibrio tra l'interesse delle imprese a poter adottare sempre nuovi segni, anche percepibili mediante sensi diversi dalla vista, e l'interesse generale a promuovere una libera concorrenza non distorta. In questa prospettiva si conserva la fondamentale distinzione tra, rispettivamente, i requisiti attinenti all'idoneità del segno a distinguere (sanabili), e i requisiti preordinati a evitare che possano essere monopolizzate caratteristiche rilevanti per l'apprezzamento dei prodotti (non sanabili).*

GIULIO ENRICO SIRONI, *I segni geografici*  
22/2017

*The EU 2015 trademark package introduced a number of important amendments to the rules on trademarks containing geographical signs, the aim being to align these rules with those on PDOs and PGIs. This paper, after a general overview of the changes relating to geographical trademarks, examines the new absolute and relative grounds for refusal or invalidity concerning trademarks containing geographical signs of quality, focusing in particular on: i) which types of signs are subject to these grounds; ii) who is entitled to enforce these grounds in the registration procedure or, potentially, in the invalidity proceedings of a trademark granted in violation of them; iii) the scope of application of the new grounds for refusal or invalidity of the registration as trademarks of geographical signs. The last part of the paper is dedicated to considerations on collective trademarks and to the question of whether the new grounds for refusal or invalidity can also be applied to these trademarks.*

GUSTAVO OLIVIERI, *Riflessioni a margine della nuova disciplina europea sui marchi di garanzia o di certificazione*  
42/2017

*The new EU Trademark Regulation 2015/2424 and the new EU Trademark Directive 2015/2436 have introduced significant changes to the regulation of collective trademarks and certification or guarantee trademarks. Despite the attempt to provide a clarification of the (different) functions and use of collective marks and certification or guarantee marks and to remedy the current imbalance between national systems and the EU trade mark system, the new EU framework still seems to fail to provide a consistent set of rules. This article aims at identifying the main innovative features of the EU rules on collective marks and certification or guarantee marks and at showing their difficult interplay with the current Italian trademark system, which will be harmonized in accordance to EU law.*

ROBERTO PENNISI, ***La salvezza dei diritti anteriori alla registrazione del marchio***  
58/2017

*The Author examines conflicts between trade marks belonging to different owners, looking at European Court of Justice's doctrine. In the conflicts that don't be resolved by the application of priority rule, the Author emphasizes the general rule of good faith in concurrent use of trade marks, to avoid the risk of deception of consumers.*

MARCO RICOLFI, ***Deposito e identificazione dei prodotti e servizi***  
78/2017

*The paper explores the issues dealt with in Artt. 39 of the EU TM Directive and 28 of the EUTMR in the light of the previous case law of the ECJ (in the 2012 IP translator and the 2017 Lambretta case) and of the General Court (in the 2014 Lambretta case) as well as of the various Communications issued by the EUIPO. A discussion follows of the outstanding open questions, including the impact of the new rules on the interpretation and application of the Nice Agreement.*

ANSGAR OHLY, ***Limitations of Trade Mark Protection – the New Regime***  
105/2017

*This article explores the new regime of trade mark limitations. The exceptions for the use of indistinctive and descriptive elements as well as for referential use have been extended. Although many of the results could also have been reached under the old law, the changes are welcome because they increase legal certainty.*

VINCENZO DI CATALDO, ***Beni in transito e diritto di marchio***  
120/2017

*The article analyses the new rules on goods in transit provided for by the new EU texts on trade mark law (Regulation No 2015/2434 and Directive No 2015/2436). Considering the previous doctrine of the EU Court of Justice and the international obligations of all the EU Member States and of the EU itself (i.e., the principle of freedom of transit put forward by Article V of the GATT), the article proposes interpreting the new texts in the sense that the proprietor of a trade mark can block goods in mere transit only by giving evidence of the infringement of his own trade mark both in the country of transit and in the country of final destination. This interpretation is said to be consistent with the principle of the proximity of the evidence and with the principle of reasonableness, which are both important principles of the civil proceeding in many modern countries, in Europe and beyond.*

ALEXANDER VON MÜHLENDAHL, ***The European Union Intellectual Property Office (EUIPO)***  
135/2017

*The European Union Intellectual Property Office (EUIPO), established in 1994 in Alicante, Spain, is responsible for the administration of the EU's trade mark and design system, but has assumed additional tasks since its creation, such as the Observatory for IP rights infringements and the data base of orphan works. The Office is integrated into the network of EU agencies, among which it has a special place because it is entirely self-financed by the fees paid by the users of the system.*

MARCO SAVERIO SPOLIDORO, *L'unitarietà del marchio europeo e i suoi limiti*  
147/2017

*The principle of the unitary character of the EU Trade Marks (and of its predecessor, the Community Trade Mark) and the interconnections of such principle with the territoriality of national trademarks have been brought up to the attention of the legal community by a series of cases decided by the Court of Justice since its 2006 Armafoam judgment. These decisions were delivered both in opposition and cancellation cases and in infringement cases and are widely recognized as limitations of the unitary character of the EUTM. After a scrutiny of these precedents, it remains doubtful whether the Court is following a clear agenda and a consistent line of thought. Rather, it appears that the Court is mediating time by time among different needs, including that of remaining faithful to its own precedents. This common sense approach entails excessive reliance on not determined standards, such as «serious risk of conflict with a protected function of a trade mark» and «significant but not irrelevant part of the interested public». Of special concern is the judicial creation of evidence rules, distributing the burden of proof between the parties, which should apply, yet only «in principle». A final element of concern is the commingling of arguments drawn from quite different sources. This provides poor guidance to national Courts, can create tensions with the unitary character of national trade marks in their own territories and, at the end of the day, might endanger the success of the EUTM as such.*

LUIGI CARLO UBERTAZZI, *Brexit, marchi UE e diritto intertemporale*  
175/2017

*The article investigates mainly 3 issues of intertemporal law concerning the situation of EU trademarks after the UK's withdrawal from the EU, namely: a) whether the prior UK use continues to cause (in the EU member states) the invalidity of a posterior EU trademark registered before UK's withdrawal; b) whether an EU trademark continues to produce effects in the UK; c) whether the rules on the conversion of EU trademarks into national signs continue to apply to the UK.*

## **II TEMA: INTERNET E DIRITTO D'AUTORE UE**

PADRO A. DE MIGUEL ASENSIO, *Overcoming fragmentation and territoriality in EU Copyright Law?*  
181/2017

*Territoriality of copyright and the restrictions that result from the fragmentation of copyright within the EU are central issues in the current reform initiatives in the EU that include a long term vision of a complete unification of copyright. A basic feature of EU unitary rights, as compared to national rights, is that because of their territorial reach and the goal to ensure uniform protection, measures against an infringement issued by a competent court must, as a rule, extend to the entire area of the EU. In contrast, enforcement measures based on national rights are limited to the territory of the respective rights, although the possibility to adopt measures with respect to the Union or several Member States depends, first of all, on the extent of the jurisdiction granted to national courts. The case law of the CJEU concerning the application of the jurisdiction rules of the Brussels I Regulation to copyright infringements is particularly relevant to make possible the enforcement of copyright in several Member States before a single court. Such a possibility leads in the current framework to the application of*

*the law of each of those Member States. With a view to overcome the fragmentation of copyright along national borderlines, in some proposals a trend may be identified to have recourse to the country of origin principle within the internal market. This approach remains limited to specific issues and hence its potential to make possible the application of a single copyright regime to determine copyright infringement as a result of online activities within the EU remains basically unexploited.*

ROSARIA ROMANO, ***Un qualche ritorno a formalità costitutive?***  
217/2017

*(Re)formalizing copyright is a relevant issue of the recent copyright's debate. The Internet poses the dilemma of a huge number of easy-accessible works and the uncertainty about their legal status. This paper examines the different perspectives on the copyright's formalities debate and the various possible solutions, focusing on the European and Italian ones.*

CARLO EMANUELE MAYR, ***I diritti di riproduzione e distribuzione***  
234/2017

*The author examines the latest decisions of the Court of Justice of the European Union on software distributed over the Internet. He considers what kind of limits have been set for the distribution right and analyzes the logical path of the Court. The author then examines the EU legal norms applied by the dominant doctrine, noting how the investigators overlooked the importance of the principle of exhaustion. Thus, the author denied the admissibility of a right of communication to the public when digital contents are downloaded on hard disks or other material media to which the customer can access without time limitation. Consequently, in such cases, the copyright is exhausted and digital contents maybe freely resold by the first buyer.*

GIORGIO SPEDICATO, ***Il diritto di comunicazione e di messa a disposizione del pubblico***  
264/2017

*In a number of decisions handed down in the last ten years the EU Court of Justice has progressively expanded the notion of communication and making available of a work to the public in such a way to include acts which has no direct relationship with the works (allegedly) communicated, but which merely facilitate the access to them, such as the management of a peer-to-peer platform allowing sharing of protected works or the sale of a multimedia player on which there are pre-installed add-ons containing hyperlinks to websites on which protected works have been made available to the public. In order to do so, the EU Court of Justice has included in the definition of communication and making available to the public both objective and subjective criteria whose legal grounds are uncertain, at the very least: under this perspective, the so-called «new public» criterion is only the most prominent example. One of the side effects of the case-law of the EU Court of Justice has been to produce what has been dubbed an indirect harmonisation of indirect liability for copyright infringement, which has been criticized by many. This essay critically reviews the case-law of the EU Court of Justice concerning the right of communication and making available to the public trying to show that the several complementary, not autonomous and interdependent criteria introduced by the Court may be economically justified in the light of the general principle expressed in the FAPL case according to which the specific subject-matter of the intellectual property does not guarantee the right holders the opportunity to demand the highest possible remuneration, but*

only a remuneration which is appropriate, i.e. reasonable in relation to the actual or potential number of persons who enjoy or wish to enjoy the work.

FRANCESCO MEZZANOTTE, *Le «eccezioni e limitazioni» al diritto d'autore UE (parte II: Le libere utilizzazioni nell'ambiente digitale)*  
300/2017

*The article analyses the peculiarities of exceptions and limitations to EU copyright in the digital and online environment. It moves from the conceptual distinction between exceptions and limitations «in the system» of EU intellectual property (indicating rules aimed at balancing the conflicting interests of the author, on the one hand, and users, on the other), and exceptions and limitations «for the system» of EU intellectual property (thus focusing on legal regimes whose function can be ultimately traced back to the fulfilment of general interests of the legal system, especially in the perspective of the fundamental freedoms of the Single Market). On this basis, the contribution investigates the state of the art of the current European legal framework looking at it through the lens of two peculiar set of rules: namely those on private copy and on uses of works for teaching purposes.*

GIANCARLO FROSIO, *Pragmatismo, contaminazioni e politiche del linking nella giurisprudenza della CGEU*  
349/2017

*Linking is essential to the very existence of the Internet. There's been a long-standing debate on whether linking – and other related activities such as framing - to third party content may trigger liability for direct copyright infringement. Recently, different approaches have been increasingly emerging in different jurisdictions. Is linking just a mere digital citation or communication to the public? US and Canadian case law seems to have established that the former is not the case, construing linking as no more than digital references. In contrast, the Court of Justice of the European Union (CJEU) have been wrestling with this question for some time and has apparently chosen an opposite option, construing linking as a communication which would be relevant for copyright infringement if qualified enough. Actually, the CJEU departed from consistent jurisprudence from national courts relegating copyright infringement through linking to tort-based secondary liability. The CJEU has recently decided a multitude of cases - Svensson, BestWater, and C More Entertainment, and later GS Media, FilmSpeler, and Ziggo- that redesigned the notion of communication to the public. In doing so, the CJEU construed linking through a pragmatic approach that contaminated traditional objective standards for primary liability with subjective standards for secondary liability to the end of balancing competing fundamental rights. This jurisprudence stands against a fluid legal framework struggling with an ongoing copyright reform and searching for the optimal allocation of intermediary liability for online platform and other information service providers.*

MARIA LILLÀ MONTAGNANI – GIORGIO AIME, *Il text and data mining e il diritto d'autore*  
376/2017

*In the information society the opportunity to analyze significant amounts of material in order to extract, in a short period of time, data and information therein included represents a valuable asset that results in a remarkable competitive advantage, regardless of the sector. To this end, the text and data mining techniques could be considered the most efficient and widespread of the instruments. However, lawful use of such techniques may find a significant*

*obstacle in copyright law, both at national and European level. In this paper we analyse the main issues and possible elements of incompatibility between copyright law and a lawful use of text and data mining techniques, taking into account the possible application of the statutory exceptions to copyright. This is done to better evaluate the solution proposed by the European Commission in response to the concerns expressed by the relevant stake-holders with reference to the possibility to lawfully use text and data mining techniques.*

GIORGIO GIANNONE CODIGLIONE, ***I motori di ricerca***  
395/2017

*This paper moves from a reading of the EU regulatory framework, including the contribution of the CJEU, with the goal of investigating and reconstructing an autonomous legal status of search engines in relation to copyright, without necessarily resorting to the application by analogy of the e-commerce directive. The result is a complex relationship between the regime of exemptions and limitations and the combined interpretation of the notions of the right to reproduction and the right to communication to the public. On the one hand, EU copyright law in general permits snippets, press reviews and citations where the content indexed and partially reproduced is made available without restriction by the source site. Other services, such as the indicization of literary works and text-mining must be expressly permitted under specific provisions. On the other hand, the recent CJEU rulings on linking activities indicates that the main service of providing a list of hyperlinks organised in response to a user query may involve search engines in direct liability issues and overall shows a tendency to require providers who are working for profit to cooperate more closely with copyright holders, and implement content-control systems.*

FRANCESCA FERRARI, ***Internet e diritto d'autore UE. La giurisdizione civile***  
460/2017

*This paper deals with the phenomenon of on-line violations of both personality rights and of intellectual property rights, from the point of view of jurisdiction. The Author analyses the provisions of law contained in the European regulations applicable to these infringements, with particular reference to the rules on the forum delicti commissi under article 7 of Regulations no. 1215/2012, also from the point of view of the negative declaratory judgment, as well as on the possibility for the plaintiff, in case of multiple defendants, to take action before the court of the place where one of such defendants is domiciled, under article 8 of the same Regulations no. 1215/2012. Moreover, the Author examines the evolution of the jurisprudence of the Court of Justice of the European Union in the interpretation of the abovementioned rules, taking into account the most relevant cases in this field.*

ELEONORA ROSATI, ***Inibitoria o risarcimento?***  
461/2017

*Under the umbrella of its own Digital Single Market Strategy (DSMS) the EU Commission has announced its intention to review, among other things, the enforcement of intellectual property rights (IPRs). Further to the release of the DSMS, the EU Commission has conducted a number of public consultations. Yet, to date there has been no real initiative on IPR enforcement, and the current framework appears both fragmented and (at times) contradictory. In contrast with inactivity at the policy and legislative levels, over the past few years the Court of Justice of the European Union (CJEU) has issued a number of judgments which, in certain cases, have not been limited to interpreting relevant provisions in EU directive, but have rather pushed the*

*boundaries of harmonization further. This has also occurred in relation to: (I) injunctions (notably intermediary injunctions); (II) liability; and (III) compensation of damages. This contribution focuses on these three areas, and reflects on whether and to what extent future initiatives can depart from or disregard CJEU case law.*

FABRIZIO PIRAINO, ***Spunti per una rilettura della disciplina giuridica degli internet service provider***  
468/2017

*The essay addresses the issue of the so called Internet Service Provider's Liability under artt. 12-14 dir. 00/31, with specific regard to the violations of copyright. The study aims at demonstrating that European Law on ISP is not a law on tort, but regulates a sphere of lawful action in favor of Internet Service Providers. The analysis of the Court of Justice's case-law reveals that the primary remedy against offenses committed on the internet is an injunction, while damages are only a secondary relief. This confirms the hypothesis that artt. 12-14 dir. 00/31 draw the perimeter of the legitimate activity of the Internet Service Provider. The essay ends with a re-interpretation of the Italian provisions set forth at artt. 14-16 d.lgs. 70/2003 in order to align them, with the European directive, especially with regard to the hosting performance rules.*

#### **ALTRI STUDI**

THOMAS COTTIER, ***Copyright and Human Rights: The Impact of International and European Law***  
518/2017

*This paper addresses the relationship of copyright and human rights which is of increasing importance in the age of digitalization. Upon expounding the history of the relationship and the special status of property protection as an institutional guarantee depending upon legislation in case law of the European Union, the European Charter on Human Rights and the World Trade Organization, the paper suggests that human rights should inform the shaping and interpretation of copyright rules. The paper develops a methodology to this effect. It is not simply a matter of broadly balancing copyright and human rights interests, but to assess the impact of all relevant human rights and of statutory exceptions in the process of law-making and the implementation of existing copyright rules. The methodology leaves behind distinctions of public and private law and may also entail the examination of content in sensitive areas of human rights protection which so far has been outside the scope of copyright analysis.*

MICHELE BERTANI, ***Big Data, proprietà intellettuale e mercati finanziari***  
538/2017

*This essay will analyse both the regulations about ownership and dissemination of the information regarding trades and quotes of financial market securities. The research will start with an analysis of the general regulation about information ownership, as in particular the rules regarding the protection of trade secrets and databases. Successively, the essay will analyse the rules about financial market transparency, which acts as general regulation regarding the dissemination of the financial information. The outcome of this research path suggests that the rules on intellectual property and financial market transparency interact in a complementary way, in order to vary the intensity of the information disclosure and disseminate it to maximize the market performance, and more in general to achieve the main*

goals of the financial market regulation. In light of the above, the intellectual property rules act as a means to diversify the features of the different trading venue models and stimulate the competition among them.

LUCA NIVARRA, ***La Cassazione e il punitive damage: un mondo piccolo per grandi danni***  
572/2017

*Il saggio ripercorre le due tappe del pronunciamento della S.C. che ha portato al riconoscimento della delibabilità delle sentenze straniere di condanna al pagamento dei “danni punitivi”. Esso si afferma, fondamentalmente, sui due profili più critici rappresentati, per un verso, dalla sostanziale elusione dell’art. 23 Cost. e, dall’altro lato, all’improprio richiamo all’istituto della responsabilità civile.*

SUSANNA LOPOPOLO, ***Il recepimento italiano della Direttiva 2014/104/UE sul private enforcement antitrust***  
584/2017

*In order to achieve a greater efficiency of the overall antitrust enforcement system, Directive 2014/104 EU has introduced mechanisms for linking public and private enforcement and supporting damages action. In particular, it acknowledges the binding effect of the findings contained in the final measures issued by the national authorities (Article 9), which indicates a specific discipline of the evidence presented during the antitrust investigation (Articles 5-7), it allows exception for the transfer of damage passing on (Articles 12 to 16) and enables the civil court to rely on the expertise of the Competition Authority for the purpose of quantifying the antitrust damage (Article 17). This contribution is intended to provide a first analysis of the Italian law on the implementation of the Directive and the regulatory solutions adopted with the D. lgs. 19 gennaio 2017, n. 3.*

GIUSEPPE PAOLO ALLECA, ***La ditta e la sua tutela nel sistema del diritto commerciale***  
608/2017

*This paper focuses the ratio for the introduction of the firm name in the commercial law system, for the purpose of establishing how to solve the conflict between competitive undertakings with confusable firm names. The method used allows to highlight the role of entry in commercial register and to prefer it compared to the prior use method on which a large part of doctrine converges.*

FRANCESCA FERRARI, ***La consulenza tecnica a scopo conciliativo in materia di proprietà intellettuale: una chimera?***  
621/2017

*This paper focuses on the study of the court-expert examination with conciliatory purposes introduced by the lawmaker of 2005 in the Italian civil procedure system. The analysis conducted by the Author addresses preliminarily the issue of the nature of the court-expert examination governed by article 696 bis of the Italian code of civil procedure, on the basis of the reconstruction of the relevant conditions, applicable procedure and purposes. The verification continues in relation to the controversial issue of the possibility to apply this court-expert examination in disputes concerning industrial property rights, taking note of the choice revealed by the lawmaker in 2012 in reforming article 128 of the Italian industrial property code, which now explicitly makes reference to article 696 bis of the Italian code of civil*



*procedure. This paper deals with the possibility to use the court-expert examination with conciliatory purposes in relation to copyright, taking into consideration the evolution of case law on the point.*