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NEWS FROM THE FIRM

Vera Collavo joins the firm

The arrival of Vera Collavo has strengthened the firm's IP capability. Prior to joining the firm, Vera obtained an LLM in IP law from Fordham University of New York and worked in the IP department of a major Italian law firm. She assists clients in a wide range of intellectual property proceedings, with a primary focus on design and trademark.

Advising on the acquisition of Tagetik by Wolters Kluwer

A team led by Matteo Orsingher (formed by Silvia Ciardiello and Davide Graziano) and a team led by Alessandro De Palma (formed by Cesare De Falco and Marina Sartor) assisted the shareholders of the Lucca-based software house Tagetik on the IP and labour profiles of the acquisition of the entire corporate capital of the company by Wolters Kluwer respectively.

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CAPITAL MARKETS

Italian Budget Law: innovative start-ups and equity crowdfunding

Law No. 232 of 11 December 2016 (the "Budget Law"), amended the regulation on innovative start-ups and equity crowdfunding. Article 1.69 of the Budget Law provides that the relevant deed of incorporation will be exempted from the payment of stamp duties (*imposta di bollo*) and administrative fees (*diritti di segreteria*). As for equity crowdfunding, article 1.70 of the Budget Law extends the capability to raise venture capital by on-line portals, originally provided only for innovative start-ups and SME (PMIs).

DATA PROTECTION

Italian DPA's investigations for the period January-June 2017

On 16 February 2017, the Italian Data Protection Authority (the "*DPA*") unveiled its investigatory activity for the period January-June 2017 (DPA Decision no. 59/2017). In particular, the investigations shall address – among other things – the processing of data carried out by (a) Italian Consulates in coordination with external entities; (b) private companies operating in the new public digital identification system (known as SPID); (c) private companies from Albania operating in the telemarketing sector; and (d) private companies operating in the debt collection sector. According to the DPA, the above-mentioned investigations will cause about 150 inspections.

For further information please click here.

LABOUR

Unlawful monitoring of employees' emails and smartphones

Italian laws on the remote monitoring of employees do not allow the employer to carry out massive and extended monitoring. The Italian Data Protection Authority (the "DPA") recently declared the behaviour of an employer who monitored the emails and other data in employees' smartphones unlawful, in that the employer (a) did not request the express consent of the employee and (d) had not duly informed the employee on the terms and the conditions of the processing of personal data and on the possibility of monitoring on an individual basis. According to the DPA, the employer – without the employee's consent - can still use the personal data to claim or defend a right.

TRADEMARKS

The revocation of trademarks for lack of use the "Lambretta" case

On 16 February 2017, the EU Court of Justice (ECJ) issued its judgment in case C-577/14 (Brandconcern BV v. European Union Intellectual Property Office / Scooters India Ltd) declaring that the "Lambretta" Community trademark cannot be revoked for lack of use. The proceedings started in 2007, when a Dutch company applied for the revocation of the trademark in respect of products included in class 12 of the Nice classification ("vehicles; apparatus for locomotion by land, air or water"), due to an alleged lack of use for over 5 years. Having such request upheld by the EUIPO's Cancellation Division and First Board of Appeal, the trademark owner turned to the General Court of the European Union, which repealed the EUIPO's decisions, on the ground that the Office did not take into account the use of the trademark for spare parts for scooters. The Dutch company then turned to the CJEU, claiming that spare parts for scooters were not listed among products for which the trademark protection was sought and, consequently, the General Court's judgment was wrong (not being aligned with the ECJ's judgment of 19 June 2012, in C-307/10, Chartered Institute of Patent Attorneys), pursuant to which trademark applications should specify the relevant scope of protection. The CJEU turned down the appeal, pointing out that the principles set forth in case C-307/10 were merely guidelines for the application process.

COPYRIGHT

Italy implements the Barnier Directive

The Legislative Decree No. 35 of 15 March 2017, implementing Directive No. 2014/26/EU of 26 February 2014 (on collective management of copyright and related rights and multi-territorial licensing of rights in musical works for online use in the internal market, the "Barnier Directive") will enter into force on 11 April 2017. The Legislative Decree keeps the monopoly recognised by Italian laws to the *Società Italiana Autori ed Editori* (aka SIAE) for the intermediation of grand rights. The Legislative Decree regulates the organisation, activities and transparency profiles of collecting societies operating in Italy and sets the criteria for granting multi-territorial licences for the exercise of rights in musical works communicated on online networks. The Italian Telecommunications Authority (AGCOM) is granted the supervision of collecting societies. For more information please see here.

The Italian Supreme Court on American Big Red vs Gabbibo

On 11 January 2017, the Italian Supreme Court issued its judgment (No. 503/2017) stating that the Italian puppet known as Gabibbo is not a copy of America's Big Red, and that there is no finding of copyright infringement. The proceedings started back in 2002, when several American companies summoned a number of Italian entities contesting the use and the commercial exploitation of the puppet Gabibbo. The Italian Supreme Court found that the features of America's Big Red were not sufficiently unique to receive copyright protection and that the puppet Gabibbo would not have constituted an infringement anyway due to the differences between the two puppets. In fact, since the assessment of confusion is based on the overall impression of the average viewer, the differences between the two puppets led the Court to exclude any copyright infringement.

For further information please click here.

FINANCE

Adaptation of national legislation to Regulation (EU) No. 1024/2013.

On 13 December 2016, Legislative Decree No. 223 of 14 November 2016 (the "Legislative Decree") entered into force, amending, *inter alia*, article 19 of Legislative Decree No. 385 of 1 September 1993 (the "Consolidated Banking Act"). These amendments relate to the acquisition of significant shareholdings in Italian Banks and provide that the purchaser requires previous authorisation from the European Central Bank (following a non-binding proposal from the Bank of Italy as to whether authorisation should be granted). In addition, the Legislative Decree repeals those provisions of article 19 which assigned the Minister of Finance and Economy the power to refuse authorisation to acquirers from non-EU states which did not grant conditions of reciprocity. Lastly, the Legislative Decree provides that any reference to the Bank of Italy as a supervisory authority should be considered a reference to the European Central Bank, when it is the competent supervisory authority pursuant to Regulation (EU) No. 1024/2013.

PATENTS

The Turin Court of Appeal rules on software patentability

On 3 January 2017, the Turin Court of Appeal issued a judgment (no. 30/2017) regarding the matter of software patentability (which still lacks a specific regulation). The Court, upholding the decision of the Court of first instance, ruled that a computer program is entitled to patent protection (despite the ban of patentability on computer programs "as such") if it is capable of bringing about a further technical effect going beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run. This reasoning aligns with European Patent Office case law (see i.a. T-1173/97 and G-3/08) which admits software patentability relying on the "further technical effect" doctrine.

INDUSTRIES

E-COMMERCE

ECJ on reduced VAT for digital publications

On 7 March 2017, the EU Court of Justice issued its judgment in case C-390/15 (*Rzecznik Praw Obywatelskich v. Marszałek Sejmu Rzeczypospolitej Polskiej*) to (in case,) the European Court of Justice (ECJ) to confirm that the exclusion of digital books, newspapers and periodicals from the application of a reduced rate of VAT where they are supplied electronically is not contrary to the principle of equal treatment and that the VAT Directive is accordingly valid from that point of view. In particular, the ECJ clarifies that this difference is grounded on the necessity to make electronic services subject to a clear, simple and uniform set of rules in order that the VAT rate applicable to them might be established with certainty. ECJ's press release on the decision is available here, while the full text of the judgment is published on the CURIA website.

MEDIA

ITV vs. TVcatchup: the ECJ ruling on the concept of 'access to cable of broadcasting services'

On 1 March 2017, the EU Court of Justice issued its judgment on case C-275/15 (*ITV Broadcasting Ltd. (and others) vs. TVCatchup Ltd.*) as to whether article 9 of Directive No. 2001/29/EC of 22 May 2001 (on the harmonisation of certain aspects of copyright and related rights in the information society, the "*InfoSoc Directive*") permits the UK to retain the defence contained in section 73 of the Copyright, Designs and Patents Act 1988, which permits retransmission of a broadcast by cable to users in the area to which the original broadcast was made. The ECJ affirmed that the concept of "access to cable of broadcasting services" of article 9 of the InfoSoc Directive must be interpreted as not permitting a national legislation to provide that copyright is not infringed in the case of immediate retransmission by cable of a programme broadcast on television channels subject to public service obligations. It follows that a retransmission by cable is subject to the authorisation of the relevant right holder unless this activity falls within one of the exceptions contained in article 5 of the InfoSoc Directive. For more information please click here.

TECHNOLOGY

EU Parliament approves resolution on robotics

On 16 February 2017, the European Parliament approved a resolution directed to the EU Commission on Civil Law Rules on Robotics (Procedure 2015/2103(INL), hereinafter the "*Resolution*"). In particular, the Resolution recommends assessing and considering for future legislative initiatives the implementation of specific measures, such as (among others): (a) the establishment of compulsory insurance coverage for damages caused by robots; (b) the creation of a European Union register for robots, which should indicate the relevant owner and a unique identification number for each robot; and (c) the definition of a specific legal status for robots that might make autonomous decisions or interact autonomously with third parties. For further information please click here.

TELECOMMUNICATIONS

AGCOM on the implementation of roaming obligations

On 18 January 2017, the Italian Communications Authority (the "AGCOM") fined a major telecommunications player for its failure to implement without delay articles 6-sexies, 6-septies and 14 of Regulation (EU) No. 2012/531 of 13 June 2012 (on roaming on public mobile communications networks within the Union), as amended by Regulation (EU) No. 2015/2120 of 25 November 2015. The Authority challenged the company for its failure to allow users to use roaming services at the applicable national tariff and to provide users with comprehensive information about the legal and economic conditions of the tariffs applied in the European Union. According to the AGCOM, such circumstances prevented users from making appropriate contractual and economic choices. For further information please click here.

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