

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Italy

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

Pretore [monocratic judge] and Courts (Arts. 8 and 9 of the Code of Civil Procedure - CCP).

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Right holders and those claiming such rights have standing before the Court (Arts. 99 and 100 CCP). Companies have standing before the Court through their legal representatives. Each party has to be represented before the Court by a defence counsel (attorney/solicitor) (Art. 82 CCP).

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

The judge in charge of the proceeding may order the other litigant or a third party to disclose documents or other things which he deems necessary to include in the case file (Art. 210 CCP). The judge may further order description or sequestration of things representing infringement of copyright (Art. 62 of the statute on [trade]marks - MS - and Art. 82 of the patent statute - PS - and Art. 161 of the copyright statute - CS).

4. What means exist to identify and protect confidential information brought forward as evidence?

When ordering either litigant or a third party to disclose a work or other things, the judge provides as appropriate regarding time, place and mode of disclosure (Art. 210 CCP); further, he has to reconcile the interests of justice with the need to respect the rights of a third party (Art. 211 CCP).

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **injunctions**

A judge may order an injunction prohibiting the use of a [trade]mark or patent as a provisional decision until a final judgment is reached (Art. 63 MS and 83 PS).

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- **damages, including recovery of profits, and expenses, including attorney's fees**

A judge may order, in the judgment settling the litigation, that the person infringing copyright shall pay damages as related both to resulting damage (loss incurred by the person suffering damage) and to cessation of gain (loss of gain) (Arts. 2043, 2056, 1223 of the Civil Code - CC-; Art. 66 PS, 86 MS, 158 CS) in addition to paying the costs of the proceeding (Art. 91 CCP). With regard to [trade]marks and patents, a party may request damages to be paid as a total sum to be determined on the basis of the acts of the proceeding and of the relevant presumptions.

- **destruction or other disposal of infringing goods and materials/implements for their production**

A judge may order destruction of whatever represents infringement of copyright, ([trade]marks, objects, envelopes, etc.) (Art. 66 MS, Arts. 158 and 159 CS, Art. 85 PS). Under specific circumstances, ownership of the said goods may be assigned to the right holder (Art. 85 PS, Art. 159 CS). A judge may further order an injunction inhibiting the final utilization of a work infringing copyright (Art. 156 CS).

- **any other remedies**

A judge may order the unsuccessful party to pay the costs of publication of the judgment in one or more newspapers (Arts. 65 MS, 86 PS, 166 CS).

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

When questioning the defendant, whether in accordance or not with specific rules, a judge may ask which subjects are involved in the production or distribution of the goods or services infringing copyright (Arts. 183 and 230 CCP).

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Any person in whose respect an order for sequestration or description was issued and subsequently became unenforceable may make a claim for damages against the plaintiff who acted unintentionally (Art. 62 MS and 82 PS). A third party whose goods were unduly sequestered may make a claim for damages against the plaintiff (Art. 2043 CC). No specific liability of jurisdictional bodies is provided for except for the cases in which the judge is made liable as per the relevant law.

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

No period of time is determined by law for jurisdictional proceedings; such periods of time are laid down exclusively as regards procedure (e.g., the period of time for entering an appearance). Duration of a proceeding depends on the stage at which a final judgment/decision is reached (Appellate Court/Corte di Cassazione). Costs of a proceeding may vary depending upon the judge having jurisdiction and on the value of the action. In particular, the fees of legal representatives are determined with respect to the value to the action (Ministerial Decree No. 392 of 24 November 1990).

(b) *Administrative procedures and remedies*

9. **Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

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Provisional Measures

(a) *Judicial measures*

10. **Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

The following provisional remedies may be granted during a proceeding: description of the goods, sequestration of the goods (Arts. 81 MS, 81 PS, 161 CS), inhibitory injunction on the utilization of a [trade]mark or patent (Arts. 63 MS, 83 PS). As to copyright, a claim for such inhibitory injunction may be made pursuant to Art. 700 CCP.

11. **In what circumstances may such measures be ordered *inaudita altera parte*?**

With respect of [trade]marks and patents, the defendant may be heard as to description or sequestration if this is deemed appropriate by the judge (Arts. 61 MS and 81 PS). As to copyright, the said remedies may be granted *inaudita altera parte* in case of *periculum in mora* (Art. 162 CS).

12. **Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

Description and sequestration relating to [trade]marks and patents are unenforceable if, within 8 days of their execution, service of a copy of the writ initiating the proceeding and of the decree ordering sequestration or description is not effected and the judgment on the merits has not begun (Arts. 62 and 82 MS). As to copyright, it is enough for the action to begin within 8 days (Art. 163 CS). Upon compliance with these provisions, the provisional remedies remain in force until a judgement on the merits is entered. The inhibitory injunction on the utilization of a [trade]mark or patent remains in force until the final judgment is entered.

13. **Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Any costs for provisional remedies are computed in the final costs of the proceeding on the merits.

(b) *Administrative measures*

14. **Reply to the above questions in relation to any administrative provisional measures.**

With respect to copyright, the holder of the rights of representation and performance of a work may request the prefetto to prohibit representation or performance where proof of his consent is lacking (Art. 157 CS).

Special Requirements Related to Border Measures

- 15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

The measures aimed at prohibiting release into free circulation, export, re-export and placement under a suspensive procedure are applied to all counterfeit goods and goods infringing copyright.

These measures do not apply to goods:

- Presumed to be counterfeit, originating from the Community or released into free circulation in another member State;
- bearing a trade or service mark with the consent of the owner of that mark, or protected by copyright or another related right or a right relating to a design or a model, and manufactured with the consent of the right holder, but which are authorized for release into free circulation, exported, re-exported or placed under a suspensive procedure without the latter's consent;
- which have been manufactured or given a mark on conditions other than those agreed with the holders of the rights in question;
- devoid of commercial value and transported by travellers as accompanied goods, with a total value not exceeding the maximum established for relief from customs duty.

- 16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

The person entitled to lodge an application is the owner of the trade or service mark or of a right to the goods which involve infringements of intellectual property rights or the representative of the said owner (natural or legal person) or any person authorized to avail himself of one of the rights in question. The legal persons authorized to avail themselves of a right include, commercial partnerships which have as their exclusive aim, or one of their exclusive aims, the management or administration of copyright or related rights.

The body empowered to receive applications from the holders of the said rights is the Dipartimento delle Dogane e delle Imposte Indirette - Direzione Centrale dei Servizi Doganali - Divisione XII - Via Carucci, 71 - 00144 Roma.

The requirements for acceptance of the application are the following:

- Ownership of the mark;
- registration of the mark with the "Ministero dell'Industria, Commercio ed Artigianato - Direzione Generale della produzione Industriale, Ufficio Brevetti, Modelli e Marchi", or with the WIPO under the terms of the Madrid Agreement Concerning the International Registration of Marks.

The application must be accompanied by:

- A copy of the act of registration or the application for registration of the mark;
- a copy of the document identifying the owner of one of the other protected rights;
- a copy of the contract recognizing the right to exclusive use of the mark or of one of the other protected rights, or alternatively the status of exclusive distributor;
- a copy of the authorization to act as a representative of the owner of the mark or of one of the protected rights;
- documentation relating to:
 - the goods concerned;
 - the mark;
 - the counterfeit goods;
- copies of court judgements already delivered;
- a declaration of acceptance of civil liability for any damage caused to a third party as a result of the procedure requested.

During the inspection of the goods to establish more detailed findings, the customs authority may take samples for technical examination, in order to facilitate the procedure.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

The owner of one of the rights in question is required - within 10 working days, with a possible ten-day extension where warranted (from the date of suspension of the procedure for release of the goods or their impoundment) - to submit a copy of the appeal addressed to the competent judicial authority or of the decision adopted by the latter, concerning the preventive attachment of the goods or the revocation of the impoundment.

The applicant is required to provide a security of LIT 5 million, which may be raised to up to 10 per cent of the value of the goods, when the value is known. This security is designed to cover the cost of storing the goods in question, when this is necessary during the period of suspension of release or impoundment of the goods.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?

If, in the course of a targeted inspection in this field, a customs office finds that the goods in question are without any doubt counterfeit or that they involve an infringement of an intellectual property right, the customs authority may inform the holder of the right of the risk of an offence. In such a situation, the customs office concerned is authorized to suspend customs formalities for a period of three working days, in order to enable the right holder - after he has been contacted directly in accordance with the applicable rules of confidentiality - to submit an application for action under Article 3 of Regulation (EC) No. 3295/94.

If the customs authority, after consulting the right holder if need be, finds that the goods in question correspond to the description given, it suspends their release or has them impounded.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

If the goods in question are recognized as being counterfeit and/or involving an infringement of an intellectual property right, the customs authority may take appropriate steps for the destruction of the goods. However, if the customs authority does not consider it necessary to take such steps, the goods may be donated to charitable organizations, after the marks affixed to them have been removed.

Criminal Procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

Pretoire and courts (Arts. 6 and 7 of the Code of Criminal Procédure - CCRP).

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

[Trade]marks and Patents

Art. 473 of the Criminal Code (CRC) - Counterfeiting or altering Italian or foreign [trade]marks, patents, designs or models, or making use thereof: imprisonment for up to 3 years and a fine of up to Lit 4 million.

Art. 474 CRC - Introducing into the State, holding for sale, commercially distributing or circulating intellectual works or industrial products bearing counterfeited or altered [trade]marks: imprisonment for up to 2 years and a fine of up to Lit 4 million.

Art. 514 CRC - Offering for sale or circulating intellectual works or industrial products bearing counterfeited [trade]names, [trade]marks or distinctive signs, thereby causing harm to national industry: imprisonment for between 1 and 5 years and a fine of not less than Lit 1 million.

Art. 517 CRC - Offering for sale or circulating intellectual works or industrial products bearing [trade]names, [trade]marks or distinctive signs likely to mislead the purchaser as to the origin, source and quality of the product: imprisonment for up to 1 year or a fine of up to Lit 2 million.

Copyright

CS, Art. 171 - Without prejudice to the provisions of Art. 171-bis, any person shall be punishable by a fine of from Lit 100,000 to 4,000,000 who, without having the right, and for any purpose and in any form:

- (a) reproduces, transcribes, recites in public, disseminates, sells or offers for sale, or otherwise commercially distributes the work of another person, or reveals the contents of such work before it is made public, or introduces or circulates within the State copies produced abroad contrary to Italian Law;
- (b) performs or recites in public or diffuses, with or without variations or additions, the work of another person suitable for public performance, or a musical composition. Performance includes the public showing of a cinematographic work, the performance in public of musical compositions included in cinematographic works, and broadcasting by means of a loudspeaker operated in public;
- (c) commits the acts indicated in the preceding clauses by means of any of the forms of elaboration referred to in this law;
- (d) reproduces copies or gives performances in excess of the number which he had the right to reproduce or perform;
- (e) [repealed]; and
- (f) in violation of Art. 79, retransmits by wire or by broadcasting, or records upon phonographic records or other like contrivances, radiophonic transmissions or retransmissions, or sells phonographic records or other contrivances which have been unlawfully made.

The punishment shall be imprisonment up to one year or a fine of not less than Lit 1,000,000 if the acts referred to above are committed in relation to a work of another person which is not intended for public disclosure, or by usurpation of the authorship of the work, or with deformation, mutilation or other modification of the work and such acts constitute an offence against the honour or reputation of the author.

CS, Art. 171-bis

1. Whoever unlawfully duplicates computer programs for purposes of gain, or imports, distributes, sells, holds for commercial purposes or leases the said programs, for the selfsame purposes and being aware or having reason to be aware of the fact that such copies were not authorized, shall be punished by imprisonment for between three months and three years and by a fine of between 500,000 and 6,000,000 liras. The same punishment shall apply if the act concerns any contrivance intended exclusively for allowing or facilitating the unauthorized removal or the operational disconnection of protection devices for computer programs. The punishment shall be not less than imprisonment for six months and a fine of 1,000,000 liras if the offence is serious or if the program which was unlawfully duplicated, imported, distributed, sold, held for commercial purposes or leased had been previously distributed, sold or leased on media bearing the mark of the Italian Authors' and Publishers' Association [S.I.A.E.] pursuant to this law and to the relevant Regulations as per Royal Decree No. 1369 of 18 May 1942.

2. Conviction for any of the offences as per paragraph 1 shall entail publication of the judgment in one or more newspapers and in one or more specialized magazines.

Law of 20 July 1985, No. 4

1. Imprisonment for between three months and three years and a fine of between 500,000 and 6,000,000 liras shall be imposed on any person who unlawfully duplicates or reproduces, for purposes of gain and by whatever means, cinematographic works intended for cinematographic or television distribution or, though not participating in the duplication or reproduction, commercially distributes, holds for sale, introduces into the State's territory for purposes of gain, performs a public showing of or broadcasts by television the aforesaid duplications or reproductions. The punishment shall be not less than imprisonment for six months and a fine of 1,000,000 liras if the offence is especially serious.

2. Conviction for any of the offences as per the above paragraph shall entail publication of the judgment in one or more newspapers and in one or more specialized magazines.

Decree-Law of 26 January 1987, converted, with amendments, into Law No. 121 of 27 March 1987 - Art. 2:

1. The provisions of Law No. 400 of 20 July 1985 shall apply to the sale or lease of videotapes reproducing cinematographic works which do not bear the mark of the Italian Authors' and Publishers' Association [S.I.A.E.] pursuant to Law No. 633 of 22 April 1941, for the protection of copyright and other rights connected with the exercise thereof, and to the relevant Regulations as per Royal Decree No. 1369 of 18 May 1942.

2. The penalties as per Law No. 400 of 20 July 1985 shall apply to any person selling music cassettes which do not bear the mark of the Italian Authors' and Publishers' Association [S.I.A.E.] pursuant to the provisions of copyright and other rights connected with the exercise thereof mentioned under paragraph 1.

Law No. 159 of 22 May 1993:

1. An administrative sanction consisting in the payment of a sum between Lit 1 million and Lit 3 million, up to a maximum of Lit 10 million if the offence is especially serious, shall be imposed on any person who reproduces for purposes of gain and by whatever means, without being authorized to do so, the layout of literary, dramatic, scientific, instructional or musical works, or of portions thereof, which are protected by Law No. 633 of 22 April 1941, as subsequently amended, or who, though not participating in the said reproduction, but having knowledge thereof, commercially distributes, holds for sale or introduces into the State, for purposes of gain, the aforesaid reproductions.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

Prosecution by the public prosecutor is mandatory with regard to copyright (Art. 50 CCRP). The proceeding is initiated *ex officio*, even though it may follow information preferred by a party.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Any subject may prefer information on copyright crimes (Art. 333 CCRP), although the proceeding is initiated *ex officio* by the public prosecutor.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

See under 21.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

Duration of a proceeding is governed by the running of time, in that a judgment has to be entered within a given number of years from the date on which the proceeding was initiated - unless the running of time is interrupted by specific events - depending on the punishment to be imposed (i.e., 5 years if the offence is punishable by imprisonment for less than 5 years, 10 years if the term of imprisonment is longer) (Arts. 157, 158, 159, 160 CRC). Furthermore, specific stages of a proceeding must be completed within specific periods of time: for instance, preliminary investigations should be completed within 18 months, although this only affects the taking of evidence (Art. 407 CCP). The costs of a proceeding must be paid by the unsuccessful party (Art. 535 CCP); they may vary with the activities performed in the course of the proceeding (Arts. 181, 182, 199 and 200 of the provisions implementing the Code of Criminal Procedure).