

NEWS FROM THE FIRM

The Firm awarded best IP firm in 2015

During the Toplegal Award gala dinner held on 23 November, the firm received the award for best IP firm in Italy for trademarks and copyright.

Mario Ortu one of the top 50 Italian lawyers

The Italian legal magazine LegalCommunity ranked our partner [Mario Ortu](#) in the top 50 Italian lawyers.

Advising on the capital increase of Bonifiche Ferraresi

A team led by partners [Mario Ortu](#) and [Manfredi Leanza](#), with support from associates [Manuela Villa](#) and [Gaia Sansone](#), assisted Bonifiche Ferraresi with its capital increase, providing for the issue of up to 2,250,000 new shares, with pre-emptive rights to be offered to existing shareholders. The Stock Exchange Commission (Consob) approved the prospectus relating to the transaction on 18 November 2015. The offer will begin on 23 November 2015 and close on 11 December 2015.

Matteo Orsingher at Venice conference

On 14 November, [Matteo Orsingher](#) (head of the IP/TMT department) joined the panel at the conference in Venice on "Arbitration and Pathology in Creativity. Fashion, Art and Design" to discuss the topic "Deceptive trademarks and arbitration: a case study".

Events

The firm will host the following events:

- 21 December 2015, 13.00 – 15.00 seminar on "*Il nuovo diritto del lavoro alla luce degli ultimi decreti attuativi del Jobs Act: opportunità tra regole davvero nuove e regole che nuove lo sembrano solamente*" dealing with the recently approved "Jobs Act"
- 22 December 2015, 13.00 – 15.00 seminar on "*Le categorie di azioni e il declino del c.d. principio 'one share - one vote'*" dealing with categories of shares and the "one share – one vote" principle.

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COPYRIGHT

ECJ rules on copyright protection of maps (as databases)

In its decision of 29 October 2015 (in [Case-490/14](#)), the ECJ ruled that a topographic map falls within the scope of Article 1(2) of EU Database Directive 96/9/EC (which defines a database as a "collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means") and is therefore eligible for protection under Articles 3(1) and 3(2) of that Directive. The ECJ pointed out, *inter alia*, that the term "database" should be given a wide interpretation, in line with the objective of the EU legislation. From this perspective, any collection of "independent materials" (meaning materials which are separable from one another without their informative, literary, artistic, musical or other value being affected) is to be deemed a 'database' within the meaning of Article 1(2) of the Directive (in the relevant case a combination of geographical coordinate points plus the code used to designate a unique feature, e.g. a church).

ANTITRUST

EUJ rules on cartel facilitators

On 22 October 2015, the ECJ issued a judgment (in [Case C-194/14](#)) stating that an undertaking which facilitates collusion between other undertakings may infringe the prohibition of anticompetitive agreements (Art. 101), despite not operating in affected or neighbouring markets. The case involved a consultancy company (AC-Treuhand) which advised undertakings on how to exchange competitively sensitive information. Although the Advocate General had advised the ECJ that only where the undertaking in question is capable of exerting competitive pressure on the other cartellists can it be held liable under Article 101, the ECJ dissented from that opinion on the grounds that such interpretation would prevent the "full effectiveness" of Article 101. The judgment is not surprising since EU Competition law is a sphere where the principle of full effectiveness (*effete utile*) has often prevailed over imprecise provisions. The judgment is also a reminder to the IT and Big Data industry that companies may be held liable under Article 101 should their products or services be construed as indirectly facilitating collusion between undertakings.

LABOUR

Exemption from social security contributions in 2016 Italian budget

The Italian Parliament is currently examining the Italian budget law for 2016 which, if approved, will provide for the extension of the exemption for companies from payment of social security contributions for new permanent hirings (and also conversion of fixed term employment relationships into permanent ones). However, the exemption for 2016 will differ from that currently in force for new hirings/conversions in 2015. The 2016 exemption – if the law is approved in its current draft – will last for up to 24 months (instead of 36), covers 40% of total social security contributions (instead of 100%) and can be used for up to EUR 3,250 for each year (instead of EUR 8,060). The law for 2016 will also provide for the reintroduction of tax relief on the so-called "productivity bonuses" provided for in collective labour bargaining agreements at company level. The tax relief – which can be used only in relation to employees with an annual income from employment of less than EUR 50,000.01 – will provide for the application of a discounted 10% rate up to a maximum annual amount of EUR 2,000 gross.

CAPITAL MARKETS

Public consultation on regulation on administrative sanctions

On 6 November 2015, the Italian Companies and Stock Exchange Commission (Consob) launched a public consultation (the Consultation) on draft amendments to the regulation on the administrative sanctions procedure approved by resolution no. 18750 of 19 December 2013 (the Regulation), as recently amended by Consob resolution no. 19158 of 29 May 2015, which introduced *inter alia* a new phase of direct communication between the parties to the procedure and Consob. The proposed changes are aimed at implementing the amendments made to Legislative Decree no. 58 dated 24 February 1998 (the Financial Act) by Legislative Decree no.72/2015 (implementing Directive 2013/36/EU on access to the activity of credit institutions and the prudential supervision of credit institutions and investment firms – the so-called CRD IV). The Consultation proposes *inter alia* the following additions: (a) definition of "turnover" of the entity in breach, for the purpose of determining the amounts of fines to be applied by Consob (Article 6, paragraph 4-bis, and Addendum to the Regulation); (b) in accordance with Article 194-quater of the Financial Act, provisions granting Consob the power to indicate the measures to be adopted as an alternative to administrative sanctions (Article 6, paragraph 4-ter of the Regulation); (c) provisions concerning the publication of the fines applied by Consob, including the timing and the content of the document to be published (Article 8-bis of the Regulation). The Consultation period ends on 7 December 2015. More information [here](#).

DATA PROTECTION

National DPA decisions after ECJ "Safe Harbour" judgment

A number of European Data Protection Authorities issued decisions following the ECJ's Safe Harbour judgment of 6 October 2015. In particular; **Italy**: on 22 October 2015, the Italian DPA issued [Decision no. 564/2015](#) declaring Decision no. 36/2001 (which authorised data transfers to the USA under the Safe Harbour scheme) no longer applicable. Furthermore, Decision no. 564/2015 declared valid data transfers effected on the basis of (i) the Standard Contractual Clauses and (ii) the Binding Corporate Rules. In any event, the DPA reserved its right to verify the legitimacy of any data transfer. **Spain**: the Spanish DPA is requiring entities that subscribed to the Safe Harbour scheme to inform the Authority by 29 January 2016 about (i) the continuity of the international transfers and (ii) the application of alternative legal measures such as the Binding Corporate Rules or the Standard Contractual Clauses. **Germany (Hesse)**: on 26 October 2015, the DPA of the German state of Hesse declared in a [position paper](#) that it will (i) forbid any data transfer to the USA under the Safe Harbour scheme, (ii) not grant any approval for data transfers to the USA on the basis of the Binding Corporate Rules and (iii) closely review Standard Contractual Clauses as implemented by local entities on the basis of the principles of the ECJ Safe Harbour judgment.

CORPORATE FINANCE

Amendments to "Issuers Regulation"

On 29 October 2015, the Companies and Stock Exchange Commission (Consob) amended article 6 of Regulation no. 11971 of 14 May 1999 (Regolamento emittenti) in accordance with the relevant provision introduced by Directive 2014/51/UE (Omnibus II). The **Omnibus II** directive modified the Prospectus Directive by introducing an obligation on National Authorities which are competent for approving prospectuses (such as Consob in Italy) to notify the European Securities and Markets Authority (ESMA) of the final conditions of any public securities offer which were not originally in the relevant prospectus or in its supplement. Prior to such amendment, issuers/offers were obliged to notify the relevant information to ESMA.

INDUSTRIES

AUTOMOTIVE

ECJ on the "repair clause"

In January 2015, the ECJ was requested by the court of Turin to provide a preliminary ruling on the extent of application of the so-called "repair clause" set forth in Article 14 of Directive 98/71 (on the legal protection of designs) and Article 110 of Regulation 6/2002 (on Community designs), which were implemented in Italy by Article 241 of the Industrial Property Code. The relevant provisions essentially limit the rights of a design owner, by stating that it cannot object to the manufacture and marketing of items reproducing the registered design, if the relevant items are sold as replacement parts of a complex product (designed to restore the original appearance of the latter). In a case involving the unauthorised manufacture of "spare part" wheel trims bearing the trade marks of the original manufacturer (Ford Motor Company), the ECJ was asked to clarify whether it is compatible with EU law to grant manufacturers of replacement parts the right to use trade marks registered by third parties in order to allow the end purchaser to restore the original appearance of a complex product. On 6 October 2015, the ECJ issued a judgment (in [Case C-500/14](#)) stating that the "repair clause" only applies to the unauthorised reproduction of design. The rationale of this decision is that Article 14 of Directive 98/71 and Article 110 of Regulation 6/2002 are exceptional rules that derogate from the exclusivity rights granted by design registration and as such cannot apply to IP rights other than those specifically mentioned.

INTERIOR DESIGN / FASHION

Copyrightability of a store's interior design

In its decision of 13 October 2015 (no. 11416/15), the Court of Milan deemed the interior design of the stores of a cosmetic chain (Kiko) to be eligible for protection under section 2(5) of the Italian Copyright Law, pursuant to which "architectural designs and works" enjoy copyright protection. The case was brought by Kiko, which sued a competitor for copyright infringement and slavish imitation, claiming that it unlawfully copied the interior design of Kiko stores (including the specific layout of spaces accompanied by the presence of shop fittings, e.g. product display surfaces placed on dedicated side display units and in-wall compartments, along with TV screens). The Court upheld the plaintiff's claims, pointing out that the combination of elements present in its stores had not previously been used in the field, at least in their specific combination, and that such combination was characterised by originality and creativity (and therefore eligible for protection under Italian copyright law). A ruling on the protection of stores' interior design (as a trademark) was also handed down by the European Court of Justice on 10 July 2014 (in [Case C-421/13](#)), a decision which has wide implications for the sector.

E-COMMERCE

EC's Work Programme for 2016

The European Commission (EC) has presented its Work Programme for 2016 to the European Parliament in Strasbourg. Under the title "No time for business as usual", the EC has indicated to the European Parliament and the Council its main priorities for the year ahead. In particular, the EC has reiterated the importance of a connected Digital Single Market and has announced that it will undertake initiatives on geo-blocking and VAT for e-commerce in the course of 2016. See the full document [here](#).

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