

NEWS FROM THE FIRM

Davide Graziano joins the firm

The arrival of Davide Graziano has strengthened the firm's IP litigation capability. Prior to joining the firm, Davide obtained a PhD in IP law from the University of Parma and worked in the IP department of BonelliErede. He assists clients in a wide range of intellectual property proceedings, with a primary focus on patent cases.

Advising M&C on the acquisition of control of Treofan

A team led by partners [Nicola Barra Caracciolo](#) and [Stephen McCleery](#) (assisted by [Federico Roviglio](#)) advised listed investment company M&C on the acquisition of control of Treofan (a global manufacturer of polypropylene film for packaging, labels and technical applications).

Successful defence of Twentieth Century Fox against infringement proceedings

A team led by partners [Matteo Orsingher](#) and [Fabrizio Sanna](#) assisted Twentieth Century Fox in its successful defence of proceedings brought by an Italian author alleging that a well known movie produced by Twentieth Century Fox infringed his rights in an earlier work.



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DATA PROTECTION

Article 29 Working Party on the EU General Data Protection Regulation

On 16 December 2016, the Article 29 Working Party (the "WP29") released its guidelines and FAQs on implementation of the EU General Data Protection Regulation (the "GDPR", see [Our Echo April 2016](#)). In particular, the WP29 clarified certain rules of the GDPR, such as: (a) the right to data portability, which must be offered to users in the form of both a download option and a tool for direct transmission to another data controller; (b) the data protection officer to be designated by public authorities and other organizations that process certain data on a large-scale basis as part of their core activities; (c) the lead supervisory authority, which is the national authority for the location of the central administration/headquarters of the controller/processor responsible for dealing with cross-border processing of personal data. The above-mentioned guidelines are not final and the relevant stakeholders were invited to submit comments to the WP29 by 31 January 2017. For further information please click [here](#).

Italian Data Protection Authority bans the processing of personal data by a platform designed to rank the reputation of professionals

On 24 November 2016, the Italian Data Protection Authority (the "DPA") issued Decision no. 488/2016 on compliance with the Italian Data Protection Code in relation to a platform that ranks the reputation of professionals and entrepreneurs (the "Platform"). In particular, the Platform is used to process personal data resulting from the collection of information provided directly by the interested persons and/or which is publicly available (e.g. judgements, certifications of public registers, etc.). The DPA found that the Platform infringed the principles laid down in the Italian Data Protection Code as a result of a disproportionate and unnecessary bulk collection of data that could adversely affect individuals' dignity, and therefore prohibited the Platform from processing any personal data. For further information please click [here](#).

FINANCE

Constitutional Court upholds cooperative banks reform

On 21 December 2016, the Constitutional Court handed down a judgment confirming the constitutional legitimacy of article 1 of law decree no. 3 of 24 January 2015 (the "Law Decree"), which implemented a reform of cooperative banks (*banche di credito cooperativo*). The Law Decree requires cooperative banks with assets above a threshold of Euro 8 billion (the "Threshold") to either convert to joint stock companies or take steps to reduce their asset value to a level below the Threshold. The Constitutional Court confirmed that the Threshold is legitimate and consistent with the purpose of maintaining the cooperative form only for small and medium credit institutions, and that the Law Decree was lawfully enacted. To access the full judgement, please click [here](#).

TRADEMARK

The Italian Supreme Court rules on trademarks' secondary meaning

On 19 April 2016, the Italian Supreme Court issued a judgment (no. 7738/2016) overturning the decision of the Court of Appeal of Milan which held that the trademark "ROLOLONI" ("big rolls") was null and void for lack of distinctiveness (on the ground that it was too generic and no reliable evidence of any secondary meaning was provided). The Supreme Court ruled *inter alia* that the Court of Appeal's decision was unreasonable in holding that the fact that 51% of respondents in a survey recognized the trademark as the brand of a specific type of toilet paper was insufficient to establish the existence of a secondary meaning.

CAPITAL MARKETS

New directive on shareholder rights

On 9 December 2016 the Council, the Parliament and the Commission reached an agreement on proposed amendments to Directive (EC) no. 2007/36 of 13 July 2007 (on the exercise of certain rights of shareholders in listed companies). These amendments are aimed at encouraging transparent and active engagement by shareholders of listed companies. To this end the new directive establishes specific requirements, which will apply to remuneration of directors, identification of shareholders, facilitation of the exercise of shareholder rights, transmission of information, transparency for institutional investors, asset managers and proxy advisors, and related party transactions. Member states will have up to two years to incorporate the new provisions into domestic law. The full text of the proposed amendments to the 2007 Directive is available [here](#).

ESMA publishes updated MAR Q&A

On 20 December 2016, the European Securities and Markets Authority ("ESMA") issued a Question & Answer document (the "Q&A") regarding implementation of the Market Abuse Regulation (the "MAR"). The purpose of the Q&A is to promote common supervisory approaches and practices in the application of MAR and its implementing measures. The Q&A includes detailed answers on the notification of managers' transactions and how to handle investment recommendations. The full text of the Q&A is available [here](#).

LABOUR

Referendum on key provision of the Jobs Act dismissed

On 11 January 2017, the Italian Constitutional Court rejected a request for a referendum proposed by the main trade unions related to new rules on dismissals introduced by the Jobs Act (see [Jobs Act Newsletter 1 and 2](#)). The referendum was aimed at re-introducing mandatory reinstatement for unfair dismissal in all companies employing at least 5 employees. The Constitutional Court green lighted a referendum proposal on joint liability of the principal and the contractor with respect to the compensation and contribution in favour of the contractor's employees and a referendum proposal on the use of a voucher system for the payment of the consideration for certain works.

PATENT

European Patent Office's order on partial priority reduces concerns over "toxic" priority and "poisonous" divisionals

On 30 November 2016, the Enlarged Board of Appeal of the European Patent Office issued its order in [Case G1/15](#) (the "Order") regarding partial priority entitlement. A partial priority occurs when the patent's claims are broader than the subject matter disclosed in the priority claimed by the patent. In this case, broader claims are not entitled to priority, and may lack novelty vis-à-vis partial priority (so called "toxic" priority). The Order provided clarity in this matter; asserting that entitlement to partial priority may not be refused for claims encompassing alternative subject matter by virtue of more generic expressions, provided that such alternative subject matter has been disclosed for the first time, directly, or implicitly, unambiguously and in an enabling manner in the priority document. The reasoning is not yet available, but the Order appears to be good news for patent applicants, as it allows the scope of patent applications to be broadened, with fewer risks related to toxic priority.

INDUSTRIES

FASHION

Trademark infringement punishable even in absence of deceit

On 5 January 2017, the Italian Supreme Court issued a judgment (no. 553/2017) reasserting the principle that "blatant" trademark infringement is sanctionable under Italian criminal law. The case concerned the marketing of perfumes with packaging bearing words that mimicked (without entirely reproducing) the brands of well known fragrances. Based on previous case law (e.g. Decision 11 December 2013 no. 5260), the Court pointed out that trademark law is aimed at preserving public faith in trademarks, and that counterfeiting is punishable even if there is merely a risk (and not necessarily the actual occurrence) of consumers being misled.

E-COMMERCE

IMCO debates draft report on tangible goods proposal

On 29 November 2017, the Internal Market and Consumer Protection Committee of the European Parliament (the "IMCO") held a session to consider the [draft report](#) for the [Proposal for a Directive on contracts for online and other distance selling of goods \(the Proposal\)](#). The session was an opportunity for the rapporteur to present and explain the report and for other members of the European Parliament to share their perspective on it. Notably, several other members of the European Parliament expressed their concerns about the Proposal includes a reduction of maximum guarantee periods to two years, including in those Member States which currently grant a longer period. As far as next steps are concerned, members of the IMCO committee were requested to submit their amendments to the report by 11 January 2017. The amendments will be considered on 20-21 March 2017 and the final vote on the proposal in Committee will be held on 8 June.

TELECOMMUNICATIONS

Italian Communications Regulator on IVR systems

By its decision issued on 24 November 2016, the Italian Communications Authority (the "Authority") fined a major telecommunications player for breaching articles 4.1(h) and (k) and 6.1 of Resolution no. 79/2009/CSP (the "Resolution"). The Authority challenged the company for its failure to provide a user-friendly Interactive Voice Response ("IVR") customer care system, including the option for users to talk in real time with operators in order to submit complaints, on the basis that the Resolution enshrines the principle that users should be able to talk with a customer care service directly. For further information please click [here](#).

MEDIA

Public consultation launched by Italian Communications Regulator on centralization of sales of Serie A rights

On 3 November 2016, the Italian Media and Communications Authority (the "Authority") launched a public consultation on guidelines for the centralization of the sales of media rights by Lega Nazionale Professionisti Serie A (the Italian football league premier division) for the seasons 2018/2019, 2019/2020 and 2020/2021. The consultation will end on 29 January 2017. For further information please click [here](#).

The Authority starts proceedings against Vivendi

On 21 December 2016, by Resolution no. 654/16/CONS, the Italian Media and Communications Authority (the "Authority") started an inquiry in connection with Vivendi S.A. increasing its shareholding in Mediaset, with a view to verifying whether such increase may breach article 43 of the Italian Audio-visual Media Service Code, which prevents "companies ... whose revenues in the electronic communications sector are higher than 40% per cent of the total revenues of the sector" from generating revenues "in excess of 10%" in the overall media market in Italy (including television, radio, newspapers and periodicals). According to the Authority, this provision may be applicable (should Vivendi gain control of Mediaset), given that Telecom Italy (of which Vivendi is the controlling shareholder) is the main operator on the telecommunications market (44.7% market share) and Mediaset represents a 13.3% share of the entire media market in Italy.

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