A. Protection of Artistic or Literary reputation:

At the front of the "B" Museum, located in the country "X", there is an enormous wall of a unique architectural structure, faced with basalt stone made by the Basalt Co. Ltd. incorporated in your country. The Basalt Co. photographed the basalt wall of the museum without the consent of the architect and made use of the photograph in order to market its products. The company also copied and constructed an identical basalt wall at the front of its offices in your country. The architect sued Basalt Co. in your country, claiming infringement of copyright, loss of reputation, unlawful enrichment, and petitioned for compensation for damage; compensation without proof of damage; compensation due to unlawful enrichment and punitive compensation. The architect also applied for an injunction; an order for submission of accounts in order to learn of the profit derived by the company from the publicity; and an Anton Piller order for the purpose of seizure and demolition.

1. On what terms will a work (of art, music, literature) from a foreign country enjoy copyright protection in your country?
   What works of art are covered by copyright in your country? Did Basalt Co. Ltd constitute an infringement of copyright or moral rights or injured the architect’s reputation by:
   (a) Photograph of an architectural work located in a public place?
   (b) Copying a unique wall from a museum building? What are the tests?

2. Are there other actionable claims which can be brought to protect the reputation of the architect or any artists and authors, other than claims based on infringement of copyright? Can he obtain compensation by virtue of the "unlawful enrichment" laws?

3. If damages can be claimed for loss of, or injury to, reputation:
   (a) What type(s) of damages can be awarded – e.g. compensatory or punitive?
   (b) How are the damages to be proved and measured?

4. What permitted uses can be made of a protected work or reputation without constituting infringement of copyright? What is fair use?

(I) COPYRIGHT PROTECTION IN ITALY: CURRENT LEGISLATION

Between March and May 2004 the Italian Government decided suddenly that the copyright law, which had been in place since 1941 – established during the fascist era and in force for 63 years, almost without modification (see Law No. 633 of April 22, 1941) – needed to be revised. The Italian Government used a special procedure, the “Decreto Legge” (Decree) that is allowed by the Constitution only when there is a clear necessity and urgency of the reorganization of the rules. The copyright issue did not seem so vital to everyone, but the Government decided otherwise. There was apparently no pressure to define a new copyright protection system, but the tool used allowed the Government to define all the details of the law and to control the discussions in both the Parliament and the Senate. Once the new law was proposed using that special procedure, it was necessary to approve it, converting it into a real law within 60 days. The “Decreto Legge” (DL No. 72 of March 22, 2004), approved in March 2004 by the Government, was transformed into a Law of
the State (Law No. 128 of May 21, 2004) in May 2004, with the promise of making further changes in the near future, because, due to the rapidity of the approval process, it was clear to everybody, even to the MPs who approved it, that there were many mistakes, problems and even risks of permitting unconstitutional rules.

One of the major changes of the new legislation is the change of the degree of the copyright infringement offence. Before 2004 in Italy the offence was committed only if the copy of the protected material was realized for a direct lucrative objective. Now it is considered an offence the simple copy for a generic profit aim. So according to the law, if you make an electronic copy of a CD that you bought, paying a fair price, and you keep it in your hard disk while belonging to a Peer2Peer network, the bare fact that you allow other people to download the electronic copy of your file, giving you the opportunity to make a profit of it in exchange, means that you have committed an offence. This is true also if you look only for material that is already free from copyright protection, because you can achieve a profit anyway.

The new formulation of the offence is connected with another relevant change: the criminalization of the use of certain technologies such as some electronic distribution methods: Peer2Peer. The idea is that you commit an offence if you simply “use any telecommunication system to distribute an entire work or a part of it that is protected by the copyright law” (Article 1.3). The generic profit aim includes all sort of non-lucrative enterprises such as libraries, research institutions, universities, museums, etc., that create a data bank of electronic material, or even a website in which it is possible to access some of the content (protected by the copyright law) that is in their possession. The aim of such institutions should be to protect the right of the users to access as much information as possible and increase the awareness of the available content among their users. However this behaviour represents a so-called “profit” for the cultural institutions in terms of recognition of their authorities and increase of their “brand awareness” among users that could be exploited if they decided to organize an event or an exhibition, etc.

“Fair use” by such institutions is not protected or even mentioned in the legislation, while it is clear that everyone can make copies of legally owned material for personal use. However, libraries sometimes need to make copies of material for social use, but the law does not guarantee permission for their activities, while pursuing the social role that is clearly stated by their legal identities and their natural objectives.

The Italian law must be in line with European legislation and it should be noticed that there is a discrepancy here between the lack of consideration of the rights of the users and the strong protection of the rights of the producers and of the distributors of “art works.” Instead, according to the European Directive 2001/29/EC: “A fair balance of rights and interests between (...) the different categories of right holders and users of protected subject matter must be safeguarded.”

In case of inconsistency between the national and the European legislation, an Italian judge should be obliged to apply the European principle. In the European Directive, however, it is not very clear by what means by which the users’ rights could be “safeguarded.” In a situation of legal uncertainty the weakest people tend to be penalized, because they do not have the financial backing to defend themselves before the law using all the available tools. In this case we can affirm that the cultural institutions are likely to be more careful than before in launching digitalization initiatives that involve dealing with copyright protection issues and their prudent behaviour will result in a limitation of the end users’ rights.

In order to monitor suspect copyright infringements, Internet Service Providers (ISP) are charged with especially onerous duties: if the judiciary authority asks for their cooperation in the investigation of potential offences, they are obliged to provide all the useful information about their clients who could be guilty of copyright infringements. This obligation is severe and they risk a very expensive fine in case of lack of action (up to € 250,000). The technological effort in order to guarantee observation of the behaviours of all their clients is particularly arduous and expensive, especially for small ISPs, such as universities and other institutions that offer Internet service without asking for payments from their clients. Moreover, the delicate issue of the privacy of clients
has to be taken into account too. ISPs are thus in a dilemma: on one hand they are supposed to respond efficiently to legal requests; on the other hand they must guarantee the respect of the free expression of thought and the protection of the other major liberties of private citizens, guaranteed by the Constitution.

There is also another strategic change in the copyright protection principle: the transformation of infringement into a criminal offence that allows the judge to sentence a convicted person with up to four years of imprisonment. According to the previous law, this was only an administrative misdemeanour that could only be punished with a fine. This is not a minor question, because it is related to the category of offence and consequently to the ontology of the juridical principle infringed in committing the offence. In order for the behaviour to be considered criminal, a significant social danger should be involved; however the social menace at stake in copyright infringement activities is unclear.

The last issue that is raised by the new law relates to the institution of a new obligation: the adequate demonstration of a clear statement that there is no infringement of the copyright law, whenever much electronic material is published. This is a very complicated request that is not well defined and is another area of ambiguity of the Decree. It risks generating misunderstandings and problems for users as well as ISPs that are responsible for checking that this is the case for all the content made available using their network facilities (including websites, email, weblogs, etc.). The Italian situation is at the moment effectively in a state of limbo, because everybody knows that the law cannot be applied completely due to inconsistencies and confusions. It is not easy to advance a new law on the same subject so quickly, though it was explicitly promised by the Government during the approval of the “emergency measure.” The only hope is that the sensitivity of the subject and of the cultural issues will succeed in producing a proposal that allows a radical change in the balance of the rules for more reasonable copyright protection that is more respectful of users’ rights.

(II) ANSWERS TO THE QUESTIONNAIRE

<table>
<thead>
<tr>
<th>1. On what terms will a work (of art, music, literature) from a foreign country enjoy copyright protection in your country?</th>
</tr>
</thead>
</table>

As far as the European level is concerned, EU activity in matters of judicial cooperation in civil matters goes back to Article 220 of the Rome Treaty (present 293 EC), and the 1968 Brussels Convention. Such activity has acquired new vigour and a systematic character following the entry into force of the Amsterdam Treaty and Article 65 EC. Today, EU action in matters of judicial cooperation is increasingly entangled with the protection of intellectual property rights and information technology.

Since the early 1990s, the EU has produced a good number of instruments legislating on intellectual property matters – mostly Directives seeking the harmonization of Member States laws, but also Regulations establishing Community forms of intellectual property. There are also even plans for a community patent tribunal with first-instance jurisdiction over Community Patents, under Article 225a EC. Last but not least, the EU has been taking an active and influential part in the World Intellectual Property Organization (WIPO).

Such prolific activity poses challenges to the sound implementation of the instruments constituting the European Judicial Area. Much interesting work has already been done with regard to the Community protection of intellectual-property rights, mainly from the points of view of intellectual-property and internal market experts. However, substantial work is still needed in studying the judicial-cooperation aspects of such matters. The need for a thorough judicial-cooperation approach to IP/IT matters was perhaps first exemplified in the course of the communitarization of the Brussels Convention into Regulation 44/2001, in terms both of actual discussion and the canvassing of the lawmakers by business lobbies. The reaction of intellectual-
property lawyers and IP/IT lobbies was one of the reasons behind the demise of the Hague Judgments Convention Project. Others have urged a stronger cooperation between the two fields. Today, however, the main initiatives in the field are driven primarily by intellectual-property experts. This may create issues of compatibility and coherence with the existing instruments of judicial cooperation. The challenges are exacerbated by the specificity of the IP/IT subject matter. The fact that in this area it is even more difficult to insulate the Community space from the global IP/IT marketplace further adds to the challenges, as was illustrated in the negotiations of the Hague Conference Judgments Project. The Union has to decide, along with other international actors, which is the best forum to pursue such matters and whether the principles of the Brussels/Lugano system are appropriate.

Having said this, and focusing on Italy, we can remark that, according to Articles 185, 186, 187 and 188 of the Italian copyright protection law, works by foreign citizens created in Italy are protected the same way as the Italian ones. Otherwise (e.g.: works created by foreigners in foreign countries), they are protected in Italy according to the Italian law, provided that the foreign country respects the condition of reciprocity. Such rules do not apply if international conventions are applicable to the case, as in this situation latter provisions are decisive on this issue.

As far this peculiar aspect is concerned, we can add that Italy has ratified the Bern convention of 9 September 1886 (as completed in Paris in 1896, revised in Berlin in 1908, completed in Bern in 1914, revised in Rome in 1928, in Brussels in 1948, in Stockholm in 1967 and in Paris 1971).

According to Article 3 of the Bern Convention for the Protection of Literary and Artistic Works, “

“(1) The protection of this Convention shall apply to:
(a) authors who are nationals of one of the countries of the Union, for their works, whether published or not;
(b) authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a country of the Union.

(2) Authors who are not nationals of one of the countries of the Union but who have their habitual residence in one of them shall, for the purposes of this Convention, be assimilated to nationals of that country.

(3) The expression ‘published works’ means works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.

(4) A work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.”

2. What works of art are covered by copyright in your country? Did Basalt Co. Ltd constitute an infringement of copyright or moral rights or injured the architect’s reputation by:
(a) Photograph of an architectural work located in a public place?
(b) Copying a unique wall from a museum building? What are the tests?

The copyright statute in Italy, or Law No. 633 of April 22, 1941, is designed to protect the intellectual property of individuals. As already said, there have been several amendments to the law as technology has evolved. Italian copyright law protects a wide variety of intellectual property, including literature, music, theatre, and screenplays. Graphic arts, such as sculpture and paintings,
and architecture are also protected under this law. Law No. 399 of June 20, 1978 classified computer programs as well as a literary work worthy of copyright protection.

As we have seen, architectural works are explicitly mentioned by Article 1 of the Law No. 633 of April 22, 1941. Also according to Italian case law, such works do enjoy of the above mentioned protection. On 26th January 2000 the First instance Court of Milan issued a judgement in which a geometra (a sort of technical expert specialised in small size constructions), as the author of an architectural project, was sentenced to pay damages to an architect for having copied her project for a building. We can also cite here a decision by the Italian Supreme Court of Cassation (see Cass., 16 December 2010, No. 25510), which allocated non-pecuniary damages to an architect who had projected a fountain for a public park, which had been subsequently modified by other people.

3. Are there other actionable claims which can be brought to protect the reputation of the architect or any artists and authors, other than claims based on infringement of copyright? Can he obtain compensation by virtue of the “unlawful enrichment” laws?

According to Italian law, remedies under “unlawful enrichment” are envisageable only in case no other kind of special remedies are at stake. Therefore, if copyright law cannot be applied for lack of one or more elements required by the law, “unlawful enrichment” as well is not applicable.

As far as procedural remedies are concerned, it must be added that in Italy the owner of the IP right can claim any provisional remedy such as seizure, description, injunction and publication of the provisional order in newspapers and magazines.

Such remedies can be both claimed and granted ante causam (i.e., before the case is judged on its merits) or lite pendente (i.e., during judicial proceedings.) When claiming a provisional remedy ante causam, it is also possible to claim it without notice to the other party. If granted, this proves to be very effective in defending the interests of the IP right owner, as the infringer is not prepared for the action and cannot hide any information or evidence of the infringements.

Requirements in order to grant such provisional remedies are not particularly strict. The plaintiff shall prove: (i) fumus boni iuris: which is to say prima facie evidence of the ownership of an IP right and the likelihood of an infringement operated by the third party; and (ii) periculum in mora: imminent and irreparable harm which must be prevented. As far as the second requirement is concerned, courts usually consider it satisfied, under the assumption that, in IP matters, damages will be suffered in re ipsa, i.e., the infringement will by itself cause damage to the IP right owner.

As for seizure and description, it is important to further stress that since 2005, when the new IP code came into effect in Italy, it has been possible to not only seize and inspect products, tools and production plants, advertising materials and similar information of the infringer, but also financial and commercial information such as accounts and invoices. In this way, the owner of the IP right becomes immediately aware of the breadth of the infringement, and if any other entities were involved in the infringement. The information collected in this way can be used not only as proof of the infringement, but also as a way to quantify the damage during the judicial case.

As a result of the latter, since 2005 the courts have substantially increased the amount of damages for infringement, compared to their previous rulings. This makes a significant difference, as in the past it was quite difficult for the owner of the IP right to figure out and prove the sales of the infringer and thus to obtain fair recompense for damages suffered. It is also very important that the possibility exists for the owner of IP right, during the execution of provisional remedies like seizure and description, to find out if third parties are involved in the infringements, and the related possibility to automatically extend to such third parties the enforcement of the provisional order, with a significant reduction in the time of the action.

Provisional remedies can be obtained very quickly, normally in less than two weeks, and never more than two or three months from the filing of the petition. If the description is requested during a trade show, it is usually granted (if there are the requirements) in only two days, in order to
execute it during the trade show. The time required to reach a judgment has also been drastically reduced. While the Italian courts are still not as fast as those in the UK (where usually within two and a half years both the first and the second decrees are issued), you can now normally obtain a first instance judgment within three to four years, and it is immediately enforceable.

Relevant legal texts in Europe in this area have been drawn on the basis of the EU Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights. Article 13 of such text provides for as follows:

“1. Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the right holder damages appropriate to the actual prejudice suffered by him as a result of the infringement.

When the judicial authorities set the damages:
(a) they shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the right holder by the infringement;

or
(b) as an alternative to (a), they may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

2. Where the infringer did not knowingly or with reasonable grounds to know, engage in infringing activity, Member States may lay down that the judicial authorities may order the recovery of profits or the payment of damages, which may be pre-established.”

The Italian statute transposing such rules into our legal system (see Legislative Decree No. 140 of March 16, 2006) provides for (so altering Article 158 of Law No. 633 of April 22, 1941) as follows:

“1. Whoever is damaged in the exercise of a right of economic use pertaining to him/her, can sue the author of the infringement, with the aim to obtain compensation for damages. He/she can as well obtain that that the object or situation which turns out to concretize the violation be destroyed or removed; such destruction of removal has to be done at expenses of the author of the violation.

2. Compensation due to the damaged person is allocated according to Articles 1223, 1226 and 1227 of the Civil Code. Loss of profit is liquidated by the judge according to Article 2056, of the Civil Code, also taking into account profits obtained in breach of the right. The judge can also allow a lump-sum on the base of the amount of the royalties that could have been recognized, had the author of the violation asked the right holder for authorization for the use of that right.

3. Also non-pecuniary damages shall be allocated, according to Article 2059 of the Civil Code.”

According to Italian legal tradition damages are only compensatory and never punitive, which has very often brought judges to be very (too much!) cautious. As an example we can cite a decision by the Supreme Court of Cassation (see Cass., 19 January 2007, No. 1183, in Foro it., 2007, I, c. 1460), according to which foreign judgements allocating punitive damages cannot be deliberated by Italian Appeal Courts, as against our international ordre public. Legal scholars are
increasingly against this position and we can mention at least two more recent decisions by the Italian Cassation Court, according to which, precisely in the matter of the infringement of copyrights, compensation of damages can consist in compelling the subject liable of the violation to compensate the copyright owner by allocating him/her profits gained by the unlawful use of his/her rights. By this way, according to the Italian Supreme Judges, compensation of damages performs at the same time a “partially punitive function,” by avoiding that the subject who infringed the copyright can take advantage of violated rights (see Cass., 15 April 2011, No. 8730; see as well Cass., 16 December 2010, No. 25510, on the issue of compensation of non-pecuniary losses of an architect who had projected a fountain for a public park, which had been subsequently modified by other people).

As far as “fair use” is concerned pls. see above, under chapter (I).

B. The Court’s use of experts or assessors:

1. Does your country have a specialist Court or Tribunal that hears intellectual property disputes?

Since 2003, 12 specialised IP courts have been set up in Italy. They have an exclusive competence in all IP matters, ranging from trademarks, design and patent protection, domain name dispute resolution, unfair competition and copyright. Judges of these courts are skilled, and they only (or mainly) rule over IP cases and matters. The limited number of specialised courts allows a fairly homogeneous and predictable ruling, with only limited jurisprudential differences among the various IP courts.

It is usually also possible, in practice, to choose a specific competent court in which to start an IP action. In fact, the selected court can either be in the place where the defendant is located or one of the places where the infringement took place. For example, if the infringed item is sold across the whole Italian market, the plaintiff can choose any of the IP courts.

Having said this, we must add that civil courts are not always the best and most appropriate resort for IP law disputes. It is also possible and convenient for some cases to resort to a criminal action. This action can be performed on all matters covered by civil actions, from patents to trademarks, domain name and copyright, including protection of software, and they are not limited to actions against criminal organisations, but also to infringements operated by individual and small companies. Such actions are rapid and economical. They are also extremely spectacular and effective, with provisional remedies like seizures at trade shows for instance being conducted by Customs Police (Guardia di Finanza) when they are open to the public. However, as a drawback, the legal action will then be managed by a public prosecutor, which determines a certain loss of control on the case evolution.

In summary, against common perception, Italy is a recommended country to start an IP lawsuit, because, thanks to the availability of specialised courts, it now has relatively fast and fairly predictable rulings, thus ensuring solid protection for IP right owners.

2. Does the Court/Tribunal which hears intellectual property disputes in your country use experts or assessors:

(a) to assist in determining liability; and/or
(b) to assist in quantifying damages or determining the appropriate form of remedy?

The Italian model of IP litigation does not provide non professional judges involved in the composition of specialised sections or otherwise sitting on the bench; the expert is appointed by the Court and is usually expected to present a written expertise; especially in urgent procedures; he/she can also be asked to present oral conclusions. In hard cases even a panel of several experts may be
asked to present conclusions. Parties can appoint each private experts, who participate in the Court expert’s investigations.

The main question raised by the appointment of experts is their selection. The Italian trial procedure provides experts to be usually chosen from among a special register established in each First Instance Court.

Questions to be asked to the expert are decided over by the judge. This may happen after having consulted parties, who may propose special questions to be submitted to the Court’s expert. The main question raised by the appointment of experts is their selection. The Italian trial procedure provides experts to be usually chosen from among a special register established in each First Instance Court.

Questions to be asked to the expert are decided over by the judge. This may happen after having consulted parties, who may propose special questions to be submitted to the Court’s expert. The final say pertains to the judge, who has to prepare the question/s which the Court’s expert has to answer. Expert’s report has to be submitted to parties before being delivered to the judge. Parties dispose of a deadline assigned by the judge to make written comments and the expert has a deadline to reply to such remarks. Finally the expert delivers his/her written report (containing an explication about the activities he/she made and the meetings with parties, lawyers, parties’ experts and third parties, as well as the replies to the questions asked by the judge), together with parties remarks and his/her own assessment of parties’ remarks. The judge can at any time summon the expert in order to ask further clarifications on his/her work before taking the final decision on the matter.

3. If not, does the Court/Tribunal have the power to refer the dispute or part of the dispute to an independent expert or assessor who has relevant specialist knowledge? If so, is this power often used and how effective is it?

Articles 190-195 of the copyright statute in Italy, or Law No. 633 of April 22, 1941, provide for the setting up of a “Permanent Consultative Committee on Copyright” (http://www.librari.beniculturali.it/genera.jsp?id=107). The panel is appointed by the Government from among experts in IP law. Among its activities it tries to conciliate parties in certain cases provided for by the aforementioned law (Article 71-bis). Apart from such cases, during an IP right case the judge can make use of the power provided for by Article 5, Para. 2, of Legislative Decree No. 28 of 2010 (d.lgs. 28/2010), inviting parties to address themselves to a mediator.

Actually, in 2010 the Italian Government approved the Legislative Decree n. 28 of 4 March 2010, enacted on 20 March 2010, implementing the delegation indicated by Law n. 69 of 2009 on the matter of “civil process.” The Decree is all in favour of the institution of “mediation” intended to solve the dispute of two or more parties, in civil and commercial matters. It contains rules regulating and promoting the use of mediation in civil and commercial disputes. In the meaning of the Decree, that regulates mediation aimed at the conciliation of civil and commercial issues, the “mediation” is the procedure used by the mediator among the parties, trying to help them to find a mutual and satisfactory solution, while the term “conciliation” is used to define the agreement reached by the parties’ consensus.

The attempt of mediation is considered by the law as “voluntary” for all disputes on disposable rights, but it is considered as a condition of admissibility of judicial action, and therefore “mandatory”, for disputes relating to a range of subjects: condominium; real rights; division; hereditary succession; some kinds of family agreements; leasing, loan; renting of companies; damages deriving from medical liability and defamation through the press or through other means of publicity; damages deriving from driving vehicles and boats; insurance; banking and financial agreements. The parties, in those cases, must first attempt to solve their disputes through an attempt of mediation before they are able to avail themselves to the Italian Judicial System. Actually, IP rights dispute do not fall under such provision; therefore parties are not compelled to try a previous mediation, but the judge can address them to “voluntary” mediation.

The mediation proceeding can last for up to four months, after which the mediation attempt is considered done.

The entire proceeding in this case can be described as follows:
a) Parties (or one of the litigants) submit a written mediation request at an “independent qualified professional ADR provider accredited by the Ministry of Justice;”

b) The chosen ADR Provider designates an independent mediator (chosen among the mediators accredited by the ADR Provider) and arranges for an initial meeting between parties;

c) The date, the location and the name of the chosen mediator are communicated to the other parties by the ADR Provider and by the claimant, if he/she wants, with every means capable to insure that the other parties have received the communication;

d) At this point two different scenarios could be possible, depending to the choices of the parties involved in the mediation. (I) If the parties are able to reach an agreement, the mediator drafts the minutes of the meeting which must be signed by all the parties. The signed minutes, once approved by the President of the court of the district of the seat of the chosen ADR Provider, will be binding on the parties and the agreement will be enforceable to the repossession and for the filling of a judicial mortgage. (II) If no agreement is reached among all the participating parties and the mediator is mutually asked by the parties, he/she is obliged to issue a non-binding proposal about the possibility of resolution of the dispute, which the parties may choose to accept or refuse. If the parties (or one among them) refuse the mediator’s proposal, the mediation attempt is considered failed and every party of that mediation proceeding may be able to commence a lawsuit but, then, if the judicial decision is entirely the contents of the previous mediator’s proposal, such a ruling may affect the allocation of judicial expenses because the court will refuse to award all the costs and the expenses in favour to the winning party if that party had previously rejected the mediator’s proposal. Furthermore, in this circumstance, the court will order to the winning party to pay to the losing party’s costs and court fees.

The legislator was convinced that, in this way, the procedure would help Italian justice to be decongested from 5 million cases pending. Experience shows, on the contrary, that very few attempts have been made so far and in very few cases mediation was successful.

4. Do specialists (that i.e. non-lawyers with specialist training in the field of intellectual property) sit on the Court/Tribunal? If so, what is the role of the specialist? E.g. solely to assist the Court/Tribunal to understand the specialist subject matter of the intellectual property dispute or does the specialist have a decision-making role?

No.

5. Does the Court/Tribunal hear expert evidence on specialist subject matters in intellectual property disputes? How is the evidence given? E.g. in writing, in person or by both means?

Yes: pls. see above the answer to question No. B.2.

6. What other processes are used by the Court/Tribunal to assist in understanding specialist subject matter in an intellectual property dispute, and where experts have differences of opinion on a topic, to assist in deciding which opinion to accept?

Pls. see above the answer to questions No. A(II)3, B.1 and B.2.

7. What processes do you think would be useful for the Court/Tribunal to adopt or implement to assist in deciding intellectual property disputes where the making of the decision requires specialist knowledge on a non-legal topic?

I think the current system does already provide for the judge the possibility to widely use the advice of experts in deciding intellectual property disputes where the making of the decision
requires specialist knowledge on a non-legal topic. Therefore I do not think that deferring the whole process, or even a part of it, to non-legal experts would be advisable.

Turin, 16 July 2012.

[Signature]

Giacomo OBERTO
Judge – Court of Turin (Italy)
Deputy Secretary General of the IAJ