# International Comparative Legal Guides


# Copyright 2020

A practical cross-border insight into copyright law

## Sixth Edition

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# Expert Chapter



# Country Q&A Chapters

# Italy


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## 1 Copyright Subsistence

### 1.1 What are the requirements for copyright to subsist in a work?

According to Article 2575 of the Italian Civil Code and Article 1 of the Italian Copyright Law, a work can be protected by copyright if it is of a creative nature. The concept of "creativity" does not correspond with that of creation, absolute novelty or innovation but rather means that the work consists of a recognisable author's independent skills and efforts. Moreover, the creative act must be capable of being expressed in a perceptible form and of reflecting itself in the external world.

### 1.2 On the presumption that copyright can arise in literary, artistic and musical works, are there any other works in which copyright can subsist and are there any works which are excluded from copyright protection?

Article 1(1) of the Copyright Law protects those literary, artistic, musical, architectural, theatrical and cinematographic works having creative character, while Article 1(2) covers computer programs and databases. A detailed list of the works protected by copyright is provided for by Article 2 of the Copyright Law; such a list is deemed to be just for an illustrative purpose, meaning that the categories are open to extensive interpretation.

Since the Copyright Law and the Civil Code do not mention anything in particular, there is no category of works excluded from protection.

### 1.3 Is there a system for registration of copyright and if so what is the effect of registration?

Unlike for patents and trademarks, no formalities are explicitly provided for to obtain copyright, since being able to prove authorship of the work is sufficient. In order to do so, the author may file his/her work with the Society of Authors and Publishers (*Società italiana degli autori ed editori*, SIAE).

The deposit of an unpublished work is useful to protect such work since unpublished works are more exposed to plagiarism or unauthorised reproduction. The unpublished work must be filed with SIAE in a special registry.

### 1.4 What is the duration of copyright protection? Does this vary depending on the type of work?

In principle, authors are granted both economic exploitation and moral rights. According to Article 25 of the Copyright Law, the first ones last for the author's whole life and can be exercised by his/her heirs for 70 years after the author's death. After this period, works fall in the "public domain" and, therefore, can be freely published.

As regards moral rights, these are protected by Article 20. According to Article 23, they can be exercised by his/her heirs without time limits once the author has passed away.

For some types of works, in principle, the duration of copyright varies, in particular for the works that benefit from "ancillary" rights.

### 1.5 Is there any overlap between copyright and other intellectual property rights such as design rights and database rights?

Article 2 of the Copyright Law protects industrial design works as long as they are of a creative nature and have artistic value. Therefore, as long as industrial design works may be recognised as having the aforementioned characteristics, they may be protected both as a design and as copyright according to applicable law.

The Copyright Law also protects databases. Databases are intended as collections of works, data or other independent elements systematically or methodically arranged and individually accessible by electronic means. The protection of databases does not extend to their content and is without prejudice to the existing rights on such content (Article 2, n. 9 of the Copyright Law). In some cases, the content may be protected also as know-how under the Industrial Property Code.

### 1.6 Are there any restrictions on the protection for copyright works which are made by an industrial process?

According to Article 2 of the Copyright Law, works made by an industrial design can be copyright protected as long as they are of a creative nature and have artistic value.

## 2 Ownership

### 2.1 Who is the first owner of copyright in each of the works protected (other than where questions 2.2 or 2.3 apply)?

Under Article 6 of the Copyright Law, the author of the work is the first owner of the copyright, while Article 7 of the Copyright Law states that anyone who organises and directs the creation of the work itself is to be considered the author of the collective work.

According to Article 8 of the Copyright Law, the person who claims to be the author is such unless it is proven otherwise. If a work is created by more than one author, copyright lies with them all.

**2.2 Where a work is commissioned, how is ownership of the copyright determined between the author and the commissioner?**

Besides moral rights, which are unalienable and therefore always belong to the actual author, the economic exploitation rights may be enjoyed by the commissioner of the work. This will depend on the content of the contract agreed by the commissioner and the author.

Article 12*bis* of the Copyright Law states that employers enjoy exclusive exploitation rights upon any software and database works created by their staff.

**2.3 Where a work is created by an employee, how is ownership of the copyright determined between the employee and the employer?**

Both Article 12*bis* (computer programs and databases) and Article 12*ter* (industrial design works) of the Copyright Law clearly provide that, unless otherwise stated, employers enjoy exclusive exploitation rights upon any work created by their staff in the fulfilment of their duties.

**2.4 Is there a concept of joint ownership and, if so, what rules apply to dealings with a jointly owned work?**

Unless the parties have stipulated otherwise, certain specific statutes apply when two or more authors have contributed to the creation of the work.

According to Article 7 of the Copyright Law, in case of works made of autonomous contributions from different persons under the direction of a single one, the latter is considered the author of the work as a whole. However, according to Article 3 of the Copyright Law, there is no prejudice to the copyright on the single contributions to the collective work, meaning that each contributor is considered as the author of his/her specific contribution.

However, if works are made of indistinguishable and inseparable contributions from two or more authors, according to Article 10 of the Copyright Law the copyright belongs to all the authors jointly and, unless otherwise stated by a written agreement, the indivisible shares to the work are presumed to be of equal value.

## 3 Exploitation

**3.1 Are there any formalities which apply to the transfer/assignment of ownership?**

The exploitation rights can be transferred both *inter vivos* and by succession. Under Article 110 of the Copyright Law, transmission of exploitation rights must be proved in writing.

Moral rights are personal and cannot be transferred.

The author, in case of serious moral reasons, has the right to request to withdraw the work from the market; those who have acquired exploitation rights have access to compensation.

**3.2 Are there any formalities required for a copyright licence?**

Copyright licence agreements must be proved in writing.

**3.3 Are there any laws which limit the licence terms parties may agree (other than as addressed in questions 3.4 to 3.6)?**

With regard to publishing contracts, Article 119 of the Copyright Law provides the requirements that need to be met for the licensing of exploitation rights. Since the contract can cover all exploitation rights or just some of them, and both on an exclusive or non-exclusive basis, it is provided that, unless otherwise agreed, the exclusive rights have been transferred.

Future rights, which may be conferred by subsequent laws, involving wider or longer-term copyright protection, cannot be included.

Unless expressly agreed, the transfer shall not extend to the exploitation rights deriving from any elaboration or transformation of the work.

Unless otherwise agreed, the disposal of one or more exploitation rights shall not imply the transfer of other rights, which are not necessarily dependent on the transferred one.

**3.4 Which types of copyright work have collective licensing bodies (please name the relevant bodies)?**

SIAE assures authors and publishers remuneration for their work, in particular: music, cinematographic or similar works; works specially created for radio, television or other means of remote broadcasting; theatrical and musical theatre works; operas, oratories, similar dramatic-musical works, ballets, choreographic and similar works; works of the visual arts, including paintings, sculptures, graphics, photography and computer art; and literary works.

Since 2017, with the Tax Decree 2018 (Law Decree n. 148/2017), SIAE is no longer the only authorised collective licensing body. With the Tax Decree 2018, access to the market for rights management and brokering activities has also been extended to other collective licensing bodies.

Recently, Soundreef Ltd entered the Italian market, after an agreement with LEA (*Liberi Editori Autori*), a not-for-profit organisation.

**3.5 Where there are collective licensing bodies, how are they regulated?**

In Italy, the collective licensing bodies are, at present, SIAE, whose activity is regulated by its own statute and regulations, and Soundreef Ltd, governed by the legal regime provided for collective licensing bodies in Article 180 of the Copyright Law, as modified by the Tax Decree 2018. The legislation is still ongoing.

**3.6 On what grounds can licence terms offered by a collective licensing body be challenged?**

Licence terms offered by a collective licensing body can be challenged in front of the competent Civil Courts.

SIAE has for many years acted as a monopolist in the collective licensing market. New entrants have reported SIAE's conduct to the Italian Competition Authority (AGCM) for allegedly abusing its dominant position. (See, recently, AGCM 25.09.2018, Case A508, *SIAE/Servizi Intermediazione Diritti D'autore*.)

## 4 Owners' Rights

**4.1 What acts involving a copyright work are capable of being restricted by the rights holder?**

The copyright holder is capable of challenging an infringement by taking legal actions to have his/her rights established and the continuation of the violation prohibited.

### 4.2 Are there any ancillary rights related to copyright, such as moral rights, and if so what do they protect, and can they be waived or assigned?

The Copyright Law considers moral rights as exclusive rights recognised in favour of the author. They include the rights to be recognised as the author of the work and to oppose any act against the integrity of the work (Article 20 of the Copyright Law), as well as the right to withdraw the work from the market for moral reasons (Article 2582 of the Civil Code, Articles 142 and 143 of the Copyright Law).

These rights are not considered as ancillary. Moral rights are inalienable and imprescriptible; they can be exercised independently from the patrimonial rights deriving from the creation of the work, even if the latter have been transferred to third parties.

Under Articles 72 to 102 of the Copyright Law, ancillary rights include: the rights of producers of a cinematographic or audiovisual work; the rights of performers; and the rights related to photographs. Their content and duration are established by the Copyright Law.

### 4.3 Are there circumstances in which a copyright owner is unable to restrain subsequent dealings in works which have been put on the market with his consent?

According to Article 17 of the Copyright Law, the right to distribute the original or copies of the work shall not be exhausted in the European Union (EU), except where the first sale or the first act of transfer of ownership in the EU is carried out by the holder or with his consent. This provision shall not apply to works distributed by means that allow customers to freely access it.

Under Article 16 of the Copyright Law, the exclusive right of communication to the public of the work by distance communication tools is not exhausted by any act of communication to the public in such a way that individuals can choose where and when to access the work.

## 5 Copyright Enforcement

### 5.1 Are there any statutory enforcement agencies and, if so, are they used by rights holders as an alternative to civil actions?

Under Article 182*bis* of the Copyright Law, SIAE and the Italian Communications Authority (AGCOM) can carry out surveillance and investigative actions. To protect copyright on electronic communications networks, the AGCOM can also carry out surveillance and investigative actions against information society service providers. Enforcement actions can be taken by courts.

### 5.2 Other than the copyright owner, can anyone else bring a claim for infringement of the copyright in a work?

According to Article 156 of the Copyright Law, anyone who has reasons to believe there is a violation of his/her right of economic use can bring a claim for infringement. Besides the copyright owner, his/her heirs and legatees also have the right to bring judicial claims, as well as his/her assignees and exclusive licensees.

### 5.3 Can an action be brought against 'secondary' infringers as well as primary infringers and, if so, on what basis can someone be liable for secondary infringement?

The action can be brought not only against the author of the violation, but also against an intermediary whose services are used for such infringement (Article 156 of the Copyright Law).

Moreover, Internet Service Providers (ISP) may be held liable for copyright infringements if they were aware of the illicit material uploaded on their servers, but took no action to remove it or to prevent access to the server at the request of the competent authority (Articles 14 to 16 of Legislative Decree 70/2003).

### 5.4 Are there any general or specific exceptions which can be relied upon as a defence to a claim of infringement?

The reproduction and communication to the public of certain copyright-protected works is allowed, such as: articles of current interest of economic, political or religious character, as long as the source from which they are taken is indicated (Article 65 of the Copyright Law); speeches on topics of political or administrative interest given in public (Article 66 of the Copyright Law); and works or pieces of works in parliamentary, judicial or administrative procedures (Article 67 of the Copyright Law). The reproduction of certain works is also allowed as long as it is for personal use (Article 68 of the Copyright Law), as well as specific uses of protected works by libraries and cultural heritage conservation institutes (Article 69 and following of the Copyright Law). Moreover, under Article 70 of the Copyright Law, the reproduction and communication to the public of parts of a work are allowed for criticism and discussions, within the limits justified by such purposes and provided that they do not cause competition to the economic use of the work. If carried out for teaching or scientific research purposes, the use of the work is allowed for illustrative purposes and for non-commercial purposes.

### 5.5 Are interim or permanent injunctions available?

Under Article 156 of the Copyright Law, the copyright holder may seek a court injunction prohibiting both the author of the infringement and the intermediary whose services are used for such infringement from continuing to violate his/her rights. In the injunction, the judge can fix a sum due for any violation or non-compliance to his/her decision, or for any delay in the execution of the decision. Article 157 of the Copyright Law also provides that whoever is in the exercise of the rights of representation or execution of a work suitable for public entertainment may request the Prefect of the province to prohibit its representation or execution. The copyright holder is also entitled to obtain, in addition to compensation for damages, an order ordering the infringer to destroy or remove the state of affairs from which the violation results (Article 158 of the Copyright Law). Interim measures may also be asked, in accordance with the rules of the Code of Civil Procedure (Article 161 and following of the Copyright Law).

### 5.6 On what basis are damages or an account of profits calculated?

The damages may be asked for the loss of profit suffered as a consequence of the violation (Article 158 of the Copyright Law). The compensation due is settled according to the provisions of the Civil Code. The loss of profit is assessed by the judge pursuant to Article 2056 of the Civil Code, also taking into account the profits made in violation of the law. The judge can also liquidate the damage on a flat-rate basis based on at least the amount of the rights that should have been recognised if the author of the violation had asked the holder for authorisation to use the rights.

### 5.7 What are the typical costs of infringement proceedings and how long do they take?

The costs of infringement proceedings usually depend on the value of the claim and on the phase of the procedure. The duration of each instance may be, on average, two years. As regards injunction proceedings, they usually take less time: a decision can be obtained in 40 days.

### 5.8 Is there a right of appeal from a first instance judgment and if so what are the grounds on which an appeal may be brought?

A party can appeal a first instance judgment providing reasons related to the legal grounds or the logical process used by the court of first instance. Under the Code of Civil Procedure, the appellant cannot propose new claims or introduce new evidence or documents, unless they could not be produced during the first instance proceeding for reasons not attributable to the appellant.

### 5.9 What is the period in which an action must be commenced?

Article 2946 of the Civil Code states that rights will be extinguished by prescription within a period of 10 years.

Under Article 2947 of the Civil Code, an action to obtain compensation for tort must be commenced within five years as from the date of the infringement.

## 6 Criminal Offences

### 6.1 Are there any criminal offences relating to copyright infringement?

Articles 171 and following of the Copyright Law provide circumstances under which copyright infringements are considered criminal offences. These include the breach of certain economic exploitation rights, such as the rights to reproduce, distribute, elaborate and translate. The violation of the author's moral rights may also be considered criminal offences (Article 168 of the Copyright Law). In some cases, administrative sanctions may be imposed in addition to criminal ones (Article 172 and following of the Copyright Law).

### 6.2 What is the threshold for criminal liability and what are the potential sanctions?

Under Article 172 of the Copyright Law, there is criminal liability if the violation is intentionally committed. If the violation is the result of fault or negligence, administrative sanctions will be imposed.

Pecuniary sanctions range between 2,582 euros and 25,822 euros, while imprisonment may be for a period of between six months to four years (Article 171 and following of the Copyright Law).

## 7 Current Developments

### 7.1 Have there been, or are there anticipated, any significant legislative changes or case law developments?

With the Tax Decree 2018 (Law Decree n. 148/2017), Italy modified Article 180 of the Copyright Law, which reserved exclusively to SIAE any form (direct and indirect) of intermediary activity, as well as the management of copyright. The Tax Decree 2018 extended the access to the market of rights management also to other collective management bodies pursuant to the Legislative Decree of 15.03.2017, n. 35, challenging SIAE's legal monopoly.

In September 2018, the AGCM found that SIAE abused its dominant position in the collective management of copyright (Case A508).

### 7.2 Are there any particularly noteworthy issues around the application and enforcement of copyright in relation to digital content (for example, when a work is deemed to be made available to the public online, hyperlinking, etc.)?

In recent years, Italian courts have started limiting the liability exemptions for information society service providers listed by Article 14-17 of Legislative Decree 70/2003, defining the criteria to be used in the examination of the provider's nature (active or passive). According to the Italian courts, the greater the degree of involvement of a content sharing platform in data management, the more evident its active nature.

Recently, the Tribunal of Rome (decision n. 3512 of 15.02.2019) established that if the provider is aware of the illicit contents available on its server, it is irrelevant to verify whether, based on the activities it carries out, it can be considered as an active hosting provider or a passive one. Also, the passive hosting provider, as soon as it is aware of the offence committed by the users of its service, must take actions to promptly remove the illicit content or prevent access to it.

The Court of Cassation, with decision n. 7708 of 19.03.2019, clarified the liability of the hosting provider under Article 16 of Legislative Decree 70/2003, stating that:

- The hosting provider can be considered as active when its conduct has the effect of effectively supporting the unlawful act of the user.
- In the absence of such active behaviour, the service provider can be considered as passive, and, therefore, the exemption provided by Article 16 of Legislative Decree 70/2003 applies. However, the service provider is still liable if it is aware of the illegal nature of the content uploaded by third parties on its server and does not remove it or does not block access to it.
- If the activities carried out by the passive hosting provider are limited to the technical process of activating and providing access to a communication network on which the information made available by third parties is transmitted or temporarily stored, such activities, being purely technical, imply that the information society service provider does not know or control the information transmitted or stored.

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