



# Notiziario

dell'Ordine dei Consulenti in Proprietà Industriale

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## Directive of the EU Council on the protection of undisclosed know-how and business information

Trade secrets regulations are central to any discussion regarding technology introduction as well as related technology transfer, setting up Collaborations and Joint Ventures as they provide rules and safe and environment to disseminate the information. In addition, the risk of trade secrets misappropriation is increasing in EU and all around the World.

A report published recently by CREATE.org, in partnership with PricewaterhouseCoopers LLP, estimated losses attributable to theft of Trade Secrets run between 1 and 3% of GDP in the United States<sup>1</sup>. European Commission held a Conference<sup>2</sup> in June 2012 aimed at Trade-Secret protection as one of the prerequisites of holding future jobs in Europe, and presented some cases of “secret theft”.

An example of Trade Secret theft happened in May 2005 during a rally in Japan, where Michelin was testing a prototype tyre. The new tyre had proven to be a huge success, giving Michelin’s team supremacy in the rally. After the competition one of the tyres was stolen from Michelin’s stand. The tyre, being a prototype, had not been previously commercialised and as such its compound and design was a Trade Secret. Following the theft the secret was disclosed through reverse engineering, (not prohibited under any of TS Acts) and caused serious damage to Michelin by depriving it of its first-mover advantage on the professional rally market. The economic and legal significance of Trade Secrets to European Companies and Industries is confirmed by the results of a survey held as part of this Conference: 75% of the Companies stated that Trade Secrets are important for their competitiveness and innovative performance<sup>3</sup>.

As stated during the conference, the actual legal framework in the EU may not always be sufficient to ensure this adequate protection and remedy. This is mainly because different protections and remedies and different interpretations of the National Courts in this respect.

A detailed study on the different Law Regimes related the Trade Secret protection in the EU Countries has been provided in the “*Report on Trade Secrets*

*for the European Commission*” by Hogan Lovells International LLP.<sup>4</sup>

In **France**, a specific Trade-Secrets legislation aims to protect the “*manufacturing secrets*”. Other provisions of civil and criminal law protect Trade Secrets more generally. Three general categories of Trade Secrets are protected under French law: manufacturing secrets, confidential business information and know-how.

In **Germany**, there is a number of provisions protecting Trade Secrets. The most important statutory provisions for the protection of Trade Secrets are found in the “*Act against Unfair Competition*”. These provisions apply to employees and to Third Parties. Many of the statutes protecting trade secrets under the criminal law also have civil law provisions. These provisions allow for damages and injunctive relief if one of the relevant criminal law provisions is violated. Civil law remedies are also available under the Civil Code. German contract law also provides effective protection where there is a contractual obligation to maintain the secrecy of Trade Secrets.

In **England**, there is no legislation providing specific protection for Trade Secrets. Trade Secrets are protected by contract and/or by the law of equity.

**Sweden** is the only Country in the EU to have an “*Act*” specifically protecting Trade Secrets. The Act provides a definition, penalises espionage and contains provisions on civil liability.

In **Italy**, specific provisions on the protection of Trade Secrets are contained in the Italian Code of Industrial Property (CPI). There are also unfair competition provisions in the Civil and Penal Codes. Trade Secrets benefit from the enhanced enforcement measures provided by the law implementing the Enforcement Directive, because they are regarded as Intellectual Property Rights in Italy.

Therefore, the introduction of harmonized legislation in EU that provides sufficient and comparable remedy will have a deterrent effect for the attempts of Trade Secrets misappropriation arising not only in the EU Countries but also in the non-EU Countries.

The EU policy makers recognized the importance of Trade Secrets for innovation and technology investment. Followed by a number of studies and discussions

1 <http://create.org/resource/economic-impact-of-trade-secret-theft/>

2 [http://ec.europa.eu/internal\\_market/iprenforcement/docs/conference20120629/ts\\_summary\\_consolidatedfinal20120913\\_en.pdf](http://ec.europa.eu/internal_market/iprenforcement/docs/conference20120629/ts_summary_consolidatedfinal20120913_en.pdf)

3. [http://ec.europa.eu/internal\\_market/iprenforcement/docs/trade-secrets/130711\\_final-study\\_en.pdf](http://ec.europa.eu/internal_market/iprenforcement/docs/trade-secrets/130711_final-study_en.pdf)

4. [http://ec.europa.eu/internal\\_market/iprenforcement/docs/trade-secrets/120113\\_study\\_en.pdf](http://ec.europa.eu/internal_market/iprenforcement/docs/trade-secrets/120113_study_en.pdf)

undertaken in the last years and public consultation, which took place at the turn of 2012/2013, European Commission issued in November 2013 a Proposal for a Directive<sup>5</sup>.

The New Framework<sup>6</sup> amended by the EU Council in May 2013 set up the general approach for the draft of the Directive Proposal includes the following main features:

- *a minimum harmonisation of the different civil law regimes, whilst allowing member states to apply stricter rules;*
- *the establishment of common principles, definitions and safeguards, in line with international agreements, as well as the measures, procedures and remedies that should be made available for the purpose of civil law redress;*
- *a limitation period of six years for claims or bringing actions before courts;*
- *the preservation of confidentiality in the course of legal proceedings, while ensuring that the rights of the parties involved in a trade secret litigation case are not undermined;*
- *the establishment of a favourable regime to employees in what concerns their liability for damages in case of violation of a Trade Secret if acting without intent.*

The Directive Proposal introduced a common definition of Trade Secrets (Art.2):

*For the purposes of this Directive, the following definitions shall apply: (a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question; (b) has commercial value because it is secret; (c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.*

The main Provisions in the Directive Proposal can be divided into Provisional Protection Measures (Section 2: “*interim and precautionary measures*”) and Legal Sanctions (Section 3: “*measures resulting from a decision of the merits of the case*”).

The Interim Measures includes the cessation or the prohibition of use or disclosure of Trade Secrets (Article 9.1.a), the prohibition to produce, offer, place on the market or use infringing goods, as well as their import, export or storage for these purposes (Article 9.1.b), and the seizure or delivery of goods that allegedly infringe Trade Secrets (Article 9.1.c).

For the moment, such Directive Proposal does not include the possibility that National Courts impose penalty payments in accordance with their National Law in the event that Interim measures are violated.

The Commission is actually working to improve such an aspect.

The Legal Sanctions already provided in the Directive Proposal include:

- *the cessation/prohibition of the use/disclosure of the Trade Secret (Art.11.a)*
- *the prohibition to produce, offer, place on the market or use infringing goods, or import, export or store infringing goods for those purposes (Art.11.b)*
- *the adoption of the appropriate corrective measures with regard to the infringing goods (Art.11.c) ... (omissis)... including a declaration of infringement, a recall of the infringing goods from the market; a depriving the infringing goods of their infringing quality; the destruction/withdrawal of the infringing goods; the destruction of all or part of any document, object, material, substance or electronic file containing or implementing the Trade Secret or the delivery up to the Trade Secret holder of all or part of those documents, objects, materials, substances and electronic files.*
- *Publication of judicial decisions (Art.14)*
- *Damages commensurate to the actual prejudice suffered (Art.13.1)... (omissis)... taking into account all appropriate factors, such as the negative economic consequences, including lost profits, any unfair profits made by the infringer and elements other than economic factors, such as the moral prejudice, use or disclosure of the Trade Secret... (omissis)... a lump sum on the basis of elements such as, at a minimum, the amount of royalties or fees which would have been due if the infringer had requested authorization to use the Trade Secret in question (Art.13.2).*

The Ministers of the Competitiveness Council took their position on the Directive Proposal in May 2014 and agreed on a general approach.

As a next step, the Proposal will be submitted to the European Parliament for adoption. If approved, it could enter into force by the end of this year.

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5. <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:52013PC0813&from=EN>

6. [http://www.consilium.europa.eu/uedocs/cms\\_data/docs/pressdata/en/intm/142780.pdf](http://www.consilium.europa.eu/uedocs/cms_data/docs/pressdata/en/intm/142780.pdf)



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Le opinioni espresse dai singoli articolisti non rappresentano  
necessariamente le posizioni del Consiglio dell'Ordine.

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