

**QUESTIONS FOR NATIONAL REPORTERS OF LIDC STOCKHOLM 2015**

**QUESTION B**

**The Protection of Trade Secrets and Know-How**

**Are countries providing enough or too much protection?**

**ITALIAN REPORT**

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## 1. Legal protection of trade secrets

The Italian Intellectual Property Code<sup>1</sup> (“IPC”) contains specific provisions on the protection of trade secrets, i.e. art. 98 and art. 99.

Pursuant to art. 98 IPC (*Scope of protection*), “protection is granted to business information and technical-industrial experience, including commercial information and experience, subject to the legitimate control of the owner, as long as that information (a) is confidential, in the sense that as a whole or in its precise configuration and combination of its elements it is not generally known or easily accessible for experts and operators in the field; (b) has an economic value inasmuch as it is confidential; (c) is subject, by the persons to whose legitimate control it is subject, to measures to be considered reasonably adequate to keep it confidential.

Protection shall also be granted to data relating to tests or other confidential data, whose processing entails a considerable effort and whose presentation is conditional upon the marketing authorization of chemical, pharmaceutical or agricultural products implying the use of new chemical substances”.

Article 99 IPC (*Protection*) provides also that, “without prejudice to the provisions on unfair competition, the legitimate owner of the information and business experience as per art. 98, has the right to prohibit third parties, subject to his consent, from acquiring, disclosing to third parties or using those information and experience in an unauthorized manner, except for cases in which the third party has obtained them in an independent manner<sup>2</sup>”.

Moreover, additional provisions on the protection of trade secrets could be found in the Civil Code (art. 2105 and art. 2598, n. 3) as well as in the Criminal Code (artt. 621 - 623).

Trade secrets meeting the requirements set out in the IPC are regarded as intellectual property rights in Italy. It is interesting to observe that the IPC distinguishes between *titular ip rights* (originating from patenting or registration) and *non-titular ip rights*, amongst which there is secret information (as well as non-registered trademarks, geographical indications and denominations of origin), that may only be protected if the requirements set out in the IPC are met.

The first requirement of protection is that the information has to be not generally known or easily accessible, in a relative sense: this means that the fact that different entrepreneurs are aware of specific information, because they achieved them independently, this doesn't exclude the protection of the information towards third parties until the same, due to the reduced number of the holders, can be still considered not generally known and the competitors cannot accede to them but for with laboured researches or obtaining them from the companies which own them.

The communication of the secret information to third parties bound by confidentiality by virtue of a contract or a regulation does not imply *per se* access to it<sup>3</sup>.

It is important to note that the information which can be obtained through the simple observation, the chemical analysis or the mechanical exam (breakdown) of the competitor's product (reverse engineering) is not protected as secret. However, since, as said, the requirement of the inaccessibility of the information has a relative character, in order to exclude the possibility to protect the information which is essential to manufacture a product, it is necessary to qualify the reverse engineering as *easy for experts and operators in the field*, not being sufficient the abstract possibility to discover them through the analytical exam or the breakdown of the product. Consequently, the information is considered as secret and protected against its acquisition in an unauthorized manner (i.e. not carried out through reverse engineering) when this exam entails timing or costs particularly relevant in relation with the characteristics of the sector.

The reference to the experts and not only to the operators of the field entails, in evaluating if an information is accessible or not, to consider the knowledge of a qualified operator who works in the specific field of the holder of the secret, taking however in to consideration that the state of the art here is relative and not absolute (as it is for patents). So, the expert will be aware only of the information effectively known or easily knowable in the field, as well as those which can be inferred from them effortlessly, not being requested a knowledge of all the information accessible in the abstract. As indicated by art. 98 IPC, the requirement of not being generally known or easily accessible doesn't concern the single information (that, *per se*, could be also known or easily accessible), but rather the ensemble or the precise configuration and combination of the elements which compose it. This is the case of the so called clients list, where the names of the single clients are generally accessible; the *know how*, a coordinated complex of information in itself already known and directed to govern more efficiently a manufacturing process; the chemical formula, or secret recipes,

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<sup>1</sup> Legislative Decree n.30 of February 2005 as amended by Legislative Decree n.131 of August 2010, here in after IPC.

<sup>2</sup> Paragraph as substituted by paragraph 1 of Article 48, Legislative Decree No. 131 of 13 August 2010.

<sup>3</sup> Court of Appeal of Milan, 13 June 2007, in GADI 2007, 836.

where the components and their generic function are normally known and the secret is on their precise quantitative combination.

The second requirement is the economic value of the information as secret: this means that the exclusive (or almost exclusive) possession of the information, deriving from the fact to be secret, guarantees to the holder a competitive advantage compared to the others operators in the field. Moreover, the communication of the secret information to determined third parties bounded by confidentiality by virtue of a contract or a regulation doesn't imply a disclosure, consequently doesn't jeopardize the economic value of the information.

The third and final requirement is to adopt measures reasonably adequate to keep the information confidential, in order to show to the employees and the other subjects who cooperates with the company, and who will use the information at issue, that they will keep them secret and also in order to prevent their disclosure to third parties.

However, art. 98 IPC doesn't request to adopt measures (physical and contractual) which can make impossible the revelation of them or the spying, but "measures to be considered reasonably adequate to keep it confidential". The concept of measure "reasonably adequate" is also here relative and impose to evaluate the suitability of the measures adopted case by case, keeping in to consideration the sector and the value of the information to protect, the connection between the costs of the possible measures and the efficacy of the same, as well as the technological evolution of the systems of protection (the entrepreneur has the duty to update to the last security techniques available on the market, although proportioned with the value of the information and the economic resources of the company<sup>4</sup>). The measures adopted should be objectively perceptible and verifiable (i.e. precautionary mechanisms of protection which pertain to the internal organisation<sup>5</sup> and the ways of circulation of the know how, like internal newsletters, protocols, service orders, non competition agreements, non disclosure agreements), but also subjectively adequate, meaning to express unequivocally the will to keep them secret<sup>6</sup> (i.e. the entrepreneur is determined to maintain the information in range of the company). In any case the measures shouldn't be too onerous in terms of costs economic and human, avoiding controls too intrusive towards the employees.

The third requirement of art. 98 IPC performs different functions: first, it constitutes the logical and factual prerequisite of the misappropriation in an unauthorized manner of the information by a third party, impeding concretely to unauthorized third parties the access to the confidential information; second, is the better "proof" of the existence of the economic value required by art. 98 IPC, since the provision of adequate measures of secrecy has a cost which, as a Doctrine said<sup>7</sup>, is incurred by the company only if the secret information has an economic value which endures as long as the secrecy endures, so the protection measures distinguish the secrets economically significant from those which, on the contrary, are not.

In the past the Italian Supreme Court and also some local Courts<sup>8</sup> were of the opinion that some information, as that concerning clients and the commercial conditions reserved to them, is by their nature confidential and that consequently it is not necessary to demonstrate the adoption of special secrecy measures. This approach has been criticized by a Doctrine<sup>9</sup> who thinks it obsolete. More recently Jurisprudence has established that is necessary to adopt secrecy measures<sup>10</sup>

Passing to consider art. 99 IPC, it has to be underlined that, in its first version, the legislator had deleted any reference to the fact that the acquisition and the use of the information are considered illicit when made "in a manner contrary to honest commercial practice", in contrast with art. 6 bis of the previous Italian Patent law, which was congruent with art. 39 TRIPs<sup>11</sup> and then has been abrogated because incorporated in to the IPC.

This choice by the legislator was largely criticized by the Doctrine, because in contrast with the Italian juridical tradition, reaffirmed by art. 39 TRIPs, which connect the protection of the secret information with the rules inhibiting the unfair competitions behaviours (art. 39 TRIPs refers to art. 10 bis Paris Convention), limiting such protection to the

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<sup>4</sup> Mansani, *La nozione di segreto di cui all'art. 6 bis l.i.*, Diritto Industriale, 2002, 218 onwards

<sup>5</sup> Court of Rome, 31 March 2004, in GADI 04, 997 identify them in to the meticulous attention adopted by the company in to the storage and classification of the documents and in to the instructions given to their employees.

<sup>6</sup> Sena, *I diritti sulle invenzioni e sui modelli di utilità*, Giuffrè, 2011, 275.

<sup>7</sup> Floridia, Aa.Vv., *Diritto Industriale – Proprietà Intellettuale e concorrenza*, III ed. Torino, 2009, 194

<sup>8</sup> Italian Supreme Court, 20 March 1991, n. 3011; Court of Verona, 4 May 1996, GADI, 1996, 779

<sup>9</sup> Mansani, *La nozione di segreto di cui all'art. 6 bis l.i.*, Diritto Industriale, 2002, 218

<sup>10</sup> Court of Milan, 31 March 2004, GADI, 2004, 979; Court of Brescia 29 April 2004, *ivi*, 1079; see also Court of Bologna 4 July 2008, *ord.*; Court of Florence 26 November 2008, *ord.*; Court of Venezia 20 November 2009; Court of Bologna 16 May 2006.

<sup>11</sup> Trade-Related Aspects of Intellectual Property Rights signed in Marrakesh on 15 April 1994 and ratified by Italy with Law n. 747 of 29 December 1994)

misappropriation/use of secret information by third parties “*in a manner contrary to honest commercial practice*”. It has been also observed that, moving away from this tradition, the IPC risked breaking the balance between the interest of the entrepreneur to the confidentiality and the patent system, because a protection of the secret potentially unlimited in terms of duration and free from the burden of description to which, instead, the grant of the patent is subject, is scarcely compatible with the *ratio* of the patent system, i.e. reward the research, stimulating it through the conferment to the inventor of an exclusive temporally limited, provided that this latter reveal the innovation to the public<sup>12</sup>. Lastly, there was also a doubt of unconstitutionality of this rule.

The debate was overtaken by art. 18 of the Decree n. 131/2010 which introduced as condition of protection the fact that the acquisition, use or revelation of the secret information are occurred “in an unauthorized manner”, adding also at the end of article 99 IPC the clarification “except for cases in which the third party has obtained them in an independent manner”.

According to the interpretation made by the Italian Doctrine, the Italian wording “*in an unauthorized manner*” has to be comprehensive of a wilful misconduct or gross negligence and does not contemplate the mere “negligence” (the Italian legal system makes a distinction between the different levels of negligence). In particular, according to a Doctrine<sup>13</sup>, the expression “in an unauthorized manner” should be interpreted by the Court as being the equivalent to the expression “in a manner contrary to honest commercial practice” pursuant to art. 39 of the TRIPS agreement, since in the Ministerial Report regarding the decree which introduced this article in the IPC, it is expressly mentioned the wish to line up art. 99 with art. 39 of the TRIPs agreement.

The above mentioned Author emphasized also that it could be useful to interpret the vague expression “in an unauthorized manner” to refer to the official note of art. 39 (TRIPS), which specifies that “For the purpose of this provision, <a manner contrary to honest commercial practice>, shall mean at least practices such as breach of contract, breach of confidence and inducement to breach, and includes the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition”.

This Author concludes that the protection accorded by articles. 98 and 99 of the IPC “operates against those who have subtracted secret information illegally (for instance through industrial spying), and against those who have acquired the information with malice (i.e. with the knowledge that such subtraction was illegal) from the author of the misappropriation”. Consequently, no protection is instead accorded against whom has autonomously accomplished the information and neither against whom has acquired the information in good faith (bona fide i.e. without being aware of the illegal appropriation) from the subject from which the subtraction was made. Vanzetti affirms moreover that “Nor is protection given to those who have acquired the information legally, for instance through reverse engineering (in fact if the reverse engineering operation is easy, the information is not protected because it lacks the requirement of secrecy; if it’s not easy, the operation constitutes autonomous research activity and cannot be considered illegal)”<sup>14</sup>.

As to the clarification added at the end of art. 99 IPC (“except for cases in which the third party has obtained them in an independent manner”), probably introduced by the Legislator in order to expressly exclude the reverse engineering from the hypothesis of illicit acquisition, the same Doctrine expressed perplexity about the fact that this clarification has been introduced by the Legislator as exception to the general rule (according to which it is illicit any acquisition of the information “in an unauthorized manner”), because it is not possible to postulate an independent acquisition occurred in an unauthorized manner.

The prohibition to disclose the information concerns both those who came into possession of the secret information in an unauthorized manner and those who are legitimately aware of it because they contributed in developing it on behalf of the owner (i.e. employees), or because they had knowledge of it to conduct an activity of its interest (i.e. suppliers, consultants), or because they dispose of it or use it with the owner’s consent (i.e. licensees).

The prohibition to acquire concerns the learning of the secret information violating the owner’s confidentiality/secrecy and doesn’t cover the autonomous discovery of the information as well as the reverse engineering.

As to the prohibition to use, Jurisprudence and Doctrine have discussed if this concerns also other information derivable only from the secret information or that can be more easily developable (in terms of time and costs) thanks to the knowledge of the secret information. With reference to this issue, the Court of Milan judged illicit the realisation of

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<sup>12</sup> Ghidini-Falce, *Upgrading trade secret as IPRs – a recent break trough in IP law*, Dir. Aut., 2008, 121 onwards

<sup>13</sup> Vanzetti *La tutela ‘corretta’ delle informazioni segrete*, in Riv. Dir. Ind. 2011, I, 95

<sup>14</sup> Vanzetti-Di Cataldo, *Manuale di diritto industriale* 2009, p. 481 onwards

chemicals based on formula different from those stolen, but that could not have been realized based on the state of the art and without the knowledge of the stolen information<sup>15</sup>.

## 2. Procedural aspects and remedies in the event of trade secret misappropriation

In order to be able to launch a legal action against trade secret misappropriation, the trade secret proprietor shall indicate and describe in detail the confidential information for which he claim protection since, in the absence of this description, it would be impossible for the defendant to reply and for the Court to judge the effective misappropriation and/or use of the information.

The trade secrets proprietor shall also establish the existence of the requirements of validity ex art. 98 IPC and this could be especially difficult, in particular for the requirements a) and b) of the article (in relation with the not general knowledge of them or the easy accessibility and their economic value as secret), even though the owner of the trade secrets could resort to the witnesses and opinions of experts, taking in to consideration also the counterpart's behaviour on the market and during the proceedings (this latter ex art. 116 Italian Civil Procedure Code) and, of course, the information acquired through the legal measures which it has at his disposal to secure evidence of trade secret misappropriation.

These legal measures are order of exhibition, as well as description and seizure, provided for by articles 121 and 129 IPC respectively, which also provide that the Court, in taking the above mentioned actions, shall indicate the measures necessary to guarantee the safeguarding of the confidential information of the subjects who undergo these measures and who could use different trade secret from those of the claimant and deserving protection as well. These measures generally are the restricted access to the documents containing the trade secrets/confidential information, in particular obscuring them and/or placing them in a closed envelope, sealed by the bailiff.

In such regard, the Court of Turin<sup>16</sup> recently stated that the purpose of the description is gathering evidence for the future proceedings on the merit and that, keeping the confidentiality on the secret information of the defendant, would involve peculiar consequences for the completeness of the right of a fair trial on important facts of the controversy, as the lacking knowledge of the effective subject matter of the controversy for the subject who should begin the proceedings on the merit, although it has instituted the description proceedings in order to obtain essential evidence<sup>17</sup>. The Court has in any case reaffirmed that the lawyers and technical experts of the parties have to keep the professional secrecy and the parties are forbidden to use or/and communicate third parties/competitors data/information known because of the description proceedings.

However, this solution by the Court has been criticized, for the difficulty to re-establish the *status quo ante* in case the description order be revoked or cease to have effect if the plaintiff doesn't begin the proceedings on the merits within the deadline provided by the law.

If a trade secret misappropriation is established, the remedies are ex art. 131 IPC the interim injunction and the withdrawal from the market of the goods realized using the trade secrets; moreover, according to art. 124 IPC, with the decision on the merit the owner of the trade secrets could obtain various remedies as the definitive injunction against the manufacture, sale and use of the items constituting an infringement of the trade secrets and their withdrawal from the market, as well as their destruction at the expense of the author of the infringement or it may be ordered that the items produced, imported or sold infringing the right and the specific means that univocally serve to produce them or to carry out the protected method or process, be assigned to the ownership of the owner of the right, without prejudice to the right to compensation for damages.

The injunction and order for definitive withdrawal from the market may also be issued against any intermediary who is a party to the proceeding and whose services are used to infringe an industrial property right. In issuing the injunction, the Court may set a sum due for any infringement or instance of non-compliance subsequently determined, and for any delay in carrying out the order.

As to the damages, art. 125 IPC provides that the compensation due to the damaged party shall be set according to the provisions of Articles 1223, 1226 and 1227 of the Civil Code, taking into account all of the pertinent aspects, such as the negative economic consequences, including lost income, of the owner of the infringed right, the benefits achieved by the infringer, and in the appropriate cases, non-economic elements, such as the moral damage caused to the owner of the right by the infringement. The judgment that rules on the compensation of damages may establish payment of an overall sum set based on the proceedings in the case and the presumptions that result from them. In this case the loss of

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<sup>15</sup> Court of Milan, 2 February 2000, in GADI 2000, 758

<sup>16</sup> Court of Turin 13 June 2012, in Il Diritto Industriale n. 3 2013

<sup>17</sup> In the same sense Court of Milan, 21 February 2011, not published

profits shall however be determined as an amount not less than the royalties that the author of the infringement would have had to pay, had he obtained a license from the owner of the infringed right. In any event, the owner of the infringed right may request the recovery of the profits obtained by the infringer, either as an alternative to compensation for the loss of profits or to the extent that they exceed that compensation.

This last remedy is particularly effective, since it obliges the author of the misappropriation to return to the owner of the trade secrets all the profits obtained using them, eliminating the economic and competitive advantage that the infringer has illegally achieved.

Finally, according to art. 126 IPC the judicial authority may also dispose that the interim relief order or the judgment that determines the infringement of the industrial property rights be published in full or as a summary, or only the ruling of the judgment be published, taking into account the seriousness of the circumstances, in one or more newspapers, at the expense of the losing party.

The Jurisprudence is of the opinion that the publication operates also as compensation of the damages suffered, as well as a precautionary function with reference to the worsening of the damages deriving from the misappropriation of the trade secrets and to the communication towards third parties of the restoration of the harmed rights<sup>18</sup>.

It is important to point out that the IPC also provide for a system of discovery: according to art 121 IPC, if a party has provided serious clues that its claims are grounded and has identified documents, elements or information held by the other party that confirm those clues, it may request that the Court order their production or request the information from the other party, including the production of the banking, financial and commercial documentation that is in the possession of the other party. The party may also request that the Court order the other party to provide the elements for the identification of the persons involved in the production and distribution of the goods or services that constitute an infringement of the industrial property rights. In taking the actions identified above, the Court shall adopt measures suitable to guarantee the safeguarding of confidential information, after consulting with the other party.

### **3. Protection of know-how in confidentiality or non-disclosure agreements**

With regard to the protection of the know-how under contractual terms, for example under a license or confidentiality agreement, a specific issue has been raised about the juridical nature of the secret information contained in such agreement. In other words, whether the know-how does not meet statutory trade secret standards ex art. 98 IPC, it has often been asked if the trade secret proprietor in any event is entitled to remedies under contracts law.

A Doctrine<sup>19</sup> observed how the answer is not easy and immediate, since a system that make an *intellectual property rights* the information on which secret nature the parties agreed, would entail an extension of their protection beyond the field of the implementation of the agreement. In any case he concluded for a positive response, considered the peculiarity of the matter.

In fact, in range of the relationship between the parties and limited to the content of the agreement, this Doctrine is of the opinion that the mutual and binding acknowledgment of the respective rights is not contrary to the general principles of the Italian juridical system. However, as to the delicate issue of the existence, through the above mentioned acknowledgment, of an intellectual property right, enforceable toward third parties who have nothing to do with the agreement, this Doctrine consider it as valid both because the defaulting party will be responsible not only for the violation of the contract, but also for violation of secret information, and because it will provide to the potential Judge, appointed with reference to violations realized by third parties extraneous to the agreement, a clue that could be sufficient in a first analysis of likelihood about the existence of the right. At this regard, the Jurisprudence has denied that art. 98 IPC was enforceable in consideration of the absence of “contractual” precautions implemented by the company which claimed the violation of its trade secrets by external third parties. In particular, the Court stated that the lack of the above mentioned measures is symptomatic that the company was aware of not being the owner of original trade secrets, so that it had not believed as necessary to implement particular measures with the purpose to impede their diffusion<sup>20</sup>.

In case of breach of a confidentiality or non-disclosure agreement, the owner of the confidential information could act against the contracting party for breach of contract and the subsequent liability, as well as reimbursement of the damages suffered.

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<sup>18</sup> Court of Brescia, 29 April 2004

<sup>19</sup> Camusso, *La tutela del know-how*, Giuffrè 2012, 62 onwards

<sup>20</sup> Court of Catania, 10 October 2005, GADI, 4984

#### 4. Misuse of trade secrets protection

Where competent judicial authorities determine that a claim concerning the unlawful acquisition, disclosure or use of a trade secret is manifestly unfounded and the plaintiff, i.e. the trade secrets owner, is found to have initiated the legal proceedings in bad faith with the purpose of unfairly delaying or restricting the respondent's access to the market or otherwise intimidating or harassing the defendant, this latter has the right to ask for the condemnation of the plaintiff for vexatious litigation ex art. 96 Italian Civil Procedure Code (CPC).

As a general rule, in Italy, the losing party also pays for the winner's legal costs, in compliance with existing professional fees. The losing party will also normally pay the costs of any party or court-appointed expert.

The Code of Civil Procedure, moreover, sanctions vexatious litigation with aggravated costs and it operates in proceedings on the merit, as well as in summary proceedings (preliminary injunctions). Vexatious litigation may be defined as the situation where the losing party is found to have either sued or defended itself in bad faith or inexcusable fault.

Traditionally, on the counterpart's request, the Court may order the losing party to pay both legal costs and any damages it proves to have suffered (Art. 96 CPC). However, in practice, this sanction is not often allowed by Italian courts, since it is rather hard for the winning party to prove the bad faith or inexcusable fault of the counterpart as well as that the winning part suffered some extra damages as a consequence of the dispute it had to bring or resist to.

Law no. 69 of 2009, however, added a new paragraph to art. 96 CPC, stating that, in any case, in granting orders for costs, the judge may, even on his own motion, sentence the losing party to pay, to the counterpart, a sum of money equitably awarded. This new provision is much more effective than the traditional one: here, there is no need to prove that the losing party has caused any actual damage to the counterpart: the mere fact that it was found to have sued or resisted in bad faith is deemed enough to sentence it to pay for these extra costs<sup>21</sup>. Moreover, the law does not fix any limits to the amount of money which the judge may award in this context: more specifically, the Court now enjoys complete discretion in sanctioning vexatious litigation. Case law refers to this new sanction as a form of punitive award<sup>22</sup>, to safeguard both private and public interests<sup>23</sup>.

Case law shows that judges are applying this new provision rather extensively (in general and not in the specific field of trade secrets protection), as a reaction to clearly abusive practices<sup>24</sup>, i.e. procedural behaviours in bad faith or with the intent to disrupt or interfere with the fast and efficient dispatching of the case<sup>25</sup>. It is believed that, in the medium term, the application of the new Art. 96(3) CPC may help effectively curtailing vexatious litigation in Italy. On the other hand, the advisability of granting the Court such wide discretionary powers is questioned, since it may infringe upon the parties' right of action or defense when the judge adopts low standards of culpability<sup>26</sup>.

#### 5. Conclusions

A real protection of trade secrets cannot disregard an effective precautionary defense. At this regard, the measures that the trade secrets proprietor shall take to effectively protect them could be within the framework of its company, but also external and oriented to protect them against third parties.

Part of the first group are the so called "physical" barriers (for example the practice to keep in locked closet the most important technical projects, or to entrust to a third depositary chemical formula, or to create growing getaways for the employees and independent contractors depending on the level of confidentiality of the documents), but also measures of protection of the electronic documents and the Internet (for example passwords and more sophisticated mechanism of defense), as well as the measures which have the purpose to communicate the will of the entrepreneur to

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<sup>21</sup> A. Briguglio, 'Le novità sul processo ordinario di cognizione nell'ultima, ennesima riforma in materia di giustizia civile', *Gisut. civ.*, 2009, II, 270; Court of Piacenza 7 December 2010, <[www.ilcaso.it](http://www.ilcaso.it)>

<sup>22</sup> Court of Varese 23 January 2010, ord., <[www.ilcaso.it](http://www.ilcaso.it)>

<sup>23</sup> Court of Piacenza 7 December 2010, <[www.ilcaso.it](http://www.ilcaso.it)>

<sup>24</sup> See, e.g., Court of Salerno 27 May 2010, <[www.ilcaso.it](http://www.ilcaso.it)> and Court of Varese 23 January 2010, cit. which refer to an abuse of the right of action.

<sup>25</sup> For instance, many decisions mention the serious culpableness or malice of one of the parties: see Court of Salerno 27 May 2010, cit.; Court of Padua 10 November 2009, ord., *Giur. mer.*, 2010, 1858; Court of Piacenza 7 December 2010, cit.; Court of Verona 1 July 2010, ord., *Guida dir.*, 2010, No. 49-50, 24; Court of Modena 22 September 2010, n. 1208, <[www.giuraemilia.it](http://www.giuraemilia.it)>.

<sup>26</sup> See for instance Court of Terni 17 May 2010, *GM*, 2010, 1834, stating that Art. 96(3) CPC may sanction also common culpability (*colpa comune*).

keep the confidentiality within its company (for example informative and internal newsletter, recommendations for the different staff departments regarding the filing system of the documents and also the procedures for the identification of the documents which are confidential<sup>27</sup>).

Are part of the second group of protective and preventive measures all the initiatives of the entrepreneur directed to communicate to external third parties (suppliers, clients, freelancers), with whom the company wants or has to share technical or commercial information, the confidential character of this latter. Consequently, the company will have to explicitly specify to the above mentioned external third parties that the information at issue, although disclosed, has to be considered as confidential and its use has to be strictly limited.

Among the protective and preventive measures are of great importance the non disclosure/confidentiality agreements, as well as the confidentiality clauses integrated in various typologies of commercial contracts (distribution, supply, settlement agreements, etc.) and also the non competition agreements.

All the above mentioned measures are crucial for a solid and effective strategy of defense but, first of all, are essential for the existence of the same right on trade secrets. As observed by a Doctrine<sup>28</sup>, the preventive protection is a constitutive element of the matter in question. In fact, without measures actively put in place by the owner of the trade secrets, in order to protect its intrinsic characteristics, we wouldn't have trade secrets appreciable from a juridical point of view.

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<sup>27</sup> The Court of Milan has decided that the imprint “Confidential” on an internal document makes its content worthy of protection as trade secret, independently from its novelty or from other characteristics of the information. See Court of Milan, 31 March 2004, GADI, 2004.

<sup>28</sup> Camusso, *La tutela del know-how*, Giuffrè, 2012.