Chapter 7
An Italian Way to Disgorgement of Profits?

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Abstract One *locus classicus* of comparative analysis, with regard to different approaches to the problem of *quantum* of damages, is the consistent gap between remedial solutions available in the Italian legal context and those adopted in common law. In the Italian judicial system, as in the majority of civil law systems, the concept of compensation is prevalent, to the exclusion of any function of punishment or sanction; whereas a salient feature of the common law is the principle that no-one should be able to benefit or profit from illicit conduct, so that the use of remedial instruments which include a considerable element of punishment and/or sanction has become over time indispensable. However, setting out a framework which can adapt to unforeseen exigencies, while remaining deeply rooted in the fundamental quest for 'actual' justice, calls for a mode of thinking 'outside the square', if necessary beyond the usual models. Therefore, although in Italy the area of the law concerned with the workability of a legal instrument capable of giving the victim the possibility to recover the profit accrued by the perpetrator of the illicit act must be compatible with the 'macro-area' of compensation for damages, it must be acknowledged that the role of forerunner has been assumed by industrial law that has demonstrated a propensity for investigating and developing innovative legal solutions. For these reasons our field of enquiry will necessarily focus on aspects related to the relationship between the infringement of IPRs and compensatory damages.

Keywords Disgorgement damages • Compensation for damages enrichment by illicit means • Restitution of the illicit profit • Functional equivalents

Introduction

In the Italian judicial system, as in the majority of civil law systems, the concept of compensation is prevalent, to the exclusion of any function of punishment or sanction; whereas a salient feature of the common law is the

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principle that no-one should be able to benefit or profit from illicit conduct, so that the use of remedial instruments which include a considerable element of punishment and/or sanction has become over time indispensable.

However, it cannot be taken for granted that the certainties of the past, with all their authoritative weight, will inevitably determine the direction of current developments, much less those of the future. Setting out a framework which can adapt to unforeseen exigencies, while remaining deeply rooted in the fundamental quest for 'actual' justice (commensurate with the interests of those concretely involved), calls for a mode of thinking 'outside the square', if necessary beyond the usual models.

The area of the law concerned with the workability of a legal instrument capable of giving the victim the possibility to recover the profit accrued by the perpetrator of the illicit act must be compatible with the 'macro-area' of compensation for damages. Yet, it must be acknowledged that the role of forerunner has been assumed by industrial law that has demonstrated a propensity for investigating and developing innovative legal solutions. In fact, as will be seen in the course of this survey, our field of enquiry will necessarily focus on aspects related to the relationship between the infringement of IPRs and compensatory damages.

In this context, particular attention should be devoted to the academic and jurisprudential elaborations regarding the modifications [introduced with the *decreto legislativo* (hereinafter d. lgs.) of March 16 2006, no. 140, relating to the implementation of Directive 2004/48/EC of the European Parliament and the Council of April 29, 2004 on the enforcement of IPRs] of the new remedies provided by so-called restitution of the illicit profits (otherwise: *retroversione degli utili*). To put it more clearly, the mode of operation of this remedial instrument has been completely assimilated, and has become a necessary step in the process to be followed by a judge in the determination of the *quantum* of compensation. A new dimension has been added to the 'normal' dynamics of the assessment of damages for actual loss and loss of profit; in relation to the latter, it is similar to the general rule, but is nevertheless absolutely innovative, even eccentric, when compared with past approaches. The calculation now covers not only the earnings lost by reason of the illicit activity of another, but also includes an estimate of the amount that such activity earned for the perpetrator of the illegal conduct.

The Legal Problems Related to the Concept of 'Enrichment by Illicit Means'

Beyond the first impression that there is nothing in the Italian legal system similar to the range of remedies provided by the common law[1] (and in particular nothing like the institution of disgorgement damages), traces of what could take on the character

[1]Knowing full well that the Italian legal system differs considerably from the ensemble of remedies provided by the common law, some of my previous work has given me insight into how, adopting a more flexible approach, it is possible to identify at least two paths [(1) one based on an alternative

of a progressive change in the Italian legal system can be found in an analysis of so-called enrichment by illicit means, which relates to any circumstance in which the economic advantage gained by the person who has acted illicitly is much greater – in terms of profit – than the direct loss suffered by the right-holder.[2] In Italy, the traditional approach to the complex matter of compensation for damages (whether in relation to contracts or not) has been based on the idea that the perpetrator of the illegal action should be required to compensate the victim for the damage suffered. Nevertheless, this principle – even though it is based on the accepted tenet that no-one should be permitted to have a negative effect on the legal rights or assets of another, without the consent of the owner of those rights and/or assets – clearly involves a level of inconsistency when the question at issue is the very notion of enrichment by means of an illicit act. In fact, with the law anchored in the traditional system of remedies (where the perpetrator of the illicit act is required 'merely' to compensate for the loss), the result would be to 'reward' the perpetrator of the illicit conduct. Hence, it is reasonable to wonder whether it would not be opportune to provide for the restitution to the right-holder of an amount equal either to the loss, or to the profit realized by means of the illicit conduct, whichever is the greater.[3] These problematic issues, accentuated by the 'deafening silence' of the legislature, have pushed scholars and courts to interrogate themselves as to the need to find 'alternative' solutions, aimed not only at making restitution for the misappropriation, but at obliging the perpetrator of the illicit act to award the injured right-holder the profit resulting from the illegal conduct.

Doctrinal Developments

On a doctrinal level, a first attempt to overcome the legislative impasse in our legal system has been to recognize "the effectiveness … of a principle under which to require the restitution of profits obtained 'by means of an unjust action', independently both of the impoverishment inflicted and of the subjective state of the perpetrator of the act at the time of the injurious action".[4] Ultimately, a tangible response to the need to avoid such a (serious) grey zone in our remedial mechanisms should come from a systematic analysis of the discipline provided for in Art. 2032

reading of Art. 1223 c.c., and (2) one relating to the institutions which govern the 'crisis in contract law'] capable of arriving at a remedial framework which has many similarities with that operating in Anglo-American judicial systems (see P. Pardolesi (2005), 138 et seq.; see also P. Pardolesi (2003), 748 et seq.).

[2]On the concept of enrichment by illicit means, see P. Pardolesi (2012a), 129 et seq.; Trimarchi (2010), 104 et seq.; P. Pardolesi (2006a), 523; P. Pardolesi (2003), 713 et seq.; Trimarchi (1994), 1147.

[3]On this point, see Floridia (2012), 5, 7.

[4]Sacco (1959), 114 et seq. On this profile see also Sirena (2000); Guglielmetti (2000), 174.

civil code (hereinafter c.c.) in relation to the *negotiorum gestio* (management of the affairs of another). On closer inspection: (*a*) it is assumed that the ratification of the interested party may produce, in relation to such management, the effects that would have resulted from an actual mandate, even if the management was carried out by someone who believed himself to be acting in his own interests; (*b*) the above represents "the manifestation of a more general principle, according to which the owner of assets may always claim from another who takes or uses such assets, the profit which thereby accrues".[5] It follows that whoever enriches himself by means of actions injurious to the rights of another shall be required to transfer to the victim of the injury the entire profit realized therefrom, independently of the impoverishment caused (and therefore independently of the possibility that absolutely no impoverishment was caused). This unwritten principle – beyond the consideration of the subjective nature of intentionality – has its roots in the objective element of the infringement (or injury) committed by the perpetrator of the illicit conduct to the detriment of the victim of the injury.[6] Using such a framework, the rules concerning disposal, damage or destruction of the assets of others, as well as those relating to the enjoyment of the proceeds of such actions, and to their rehabilitation, addition and reparation, "would be reduced ... to a mere extension and/or elaboration of that principle".[7] This would possibly have a double effect: removal of the profit realized by the perpetrator of the illicit act and pursuit of the objective of prevention/deterrence.[8]

A further cause for reflection comes from that aspect of legal doctrine according to which the essential assumption underlying provisions for the restitution of profits illegitimately achieved can be found in the principle of unjustified enrichment.[9] In short, starting from the concept that the net profit of an economic activity should accrue to the person who in good faith was the author of the initiative, that authoritative doctrinal position recognized the obligation, for the individual who had acted in bad faith, to restore the unjustified profit to the victim of the injury, even beyond the limits of the harm suffered.[10]

Finally, to conclude this brief exploration of theoretical/doctrinal developments aimed at overcoming the inadequacies of civil responsibility which result from the possibility that the benefits accruing to the tortfeasor are much greater than the losses suffered by the injured party, mention should be made of the position of those who – basing their reasoning on the discipline of revenues deriving from goods[11]

[5] See Sacco (1959), 114 et seq.

[6] For an in-depth examination of these aspects see, once again, Sacco (1959), 114 et seq.

[7] See Lo Surdo (2000), 700, 701.

[8] The effectiveness of the principle of restitution theorized in this way has not failed to arouse strongly critical comments: see, as one example among many, Lo Surdo (2000), 702 et seq.

[9] Trimarchi (1962), 54. On this point see also Troiano (2000), 207; Castronovo (2003), 7, 15.

[10] See Trimarchi (1962), 54.

[11] On this point see Barcellona (1970); Gitti (2000), 152.

and on the means of acquiring property on the basis of an original endowment[12] – felt that a more efficacious solution was available, which would not only guarantee to the victim compensation for the injury suffered due to the illicit conduct, but also function as a real deterrent for the 'violator' or 'usurper', preventing him from retaining the profits realized by means of injury to the rights of others.

Jurisprudential Solutions

Shifting our attention to the jurisprudential aspects of the matter, the outcome does not change: given the necessity of overcoming the often cited legislative *impasse*, the Italian courts have seen fit to devise a number of different (and complicated) solutions, amongst which stands out, without a shadow of a doubt, the attempt to perform an extensive exegesis of Art. 158 of the Act of 22 April 1941 no. 633 (otherwise: *legge sul diritto d'autore* – copyright law, hereinafter l.a.),[13] by means of which the expression "damages award" could be interpreted as being in conformity with Art. 45 TRIPS.[14]

More prosaically, the question has been raised as to whether compensatory techniques could be actually directed to the recovery of the earnings/profits illegitimately realized by the 'usurper'. The affirmative position rested on two arguments. The first was based on the conviction that disgorgement damages constitutes a minimal, indeclinable rule [to be inferred from, amongst other factors, an interpretation of the fact that in the preparatory proceedings of copyright law it was decided to omit, as superfluous, Art. 161 of the bill in Parliament according to which "the owner of a right of use (copyright) can request the restitution into his assets of the pecuniary benefits obtained by its improper use, by means of a sentence, against the violator of the right, to payment of a sum equivalent to those benefits, as well as interest at the legal rate from the date of the judgment"].[15]

The second argument rested on the particular interpretation of Art. 158 l.a. formulated by the Tribunal of Modena in relation to a charge of unintentional

[12] See Barcellona (2002).

[13] See App. Bologna 22 April 1993, in: Foro it., Rep. 1996, item Diritti d'autore, no. 121, and also in: AIDA, 1995, 429. In this sense see also Cass. 24 October 1983 no. 6251, in: Foro it., Rep. 1984, item Diritti d'autore, no. 49 and also in: Dir. autore, 1984, 52; App. Roma 15 February 1958, in: Foro it., Rep. 1958, item Diritti d'autore, no. 21, 22, 86; Cass. 7 August 1950 no. 2423, id., 1951, I, 17. In its original draft Article 158 l.a. states that "*a person whose exercise of economic rights to which he is entitled is infringed can take legal action to ensure that the state of affairs that resulted in the infringement be annulled or eliminated or to obtain compensation for the damage*". For the new text of Article 158 l.a. as modified by the d. lgs. of 16 March 2006, no. 140, see, infra, paragraph 3.2.

[14] For an interesting reconstruction of the Italian case law in relation to compensation see Plaia (2005), 29 et seq.

[15] Cass. 6251/1983 cit., 52. On this point see Greco and Vercellone (1974), 347; De Sanctis and Fabiani (2000), 2000, 150; Troiano (2000), 221.

falsification of copyright.[16] In short, the expression "damages award" can refer either to the action of compensation (*ex* Art. 2043 c.c.), or to enrichment without just cause (*ex* Art. 2041 c.c.), which – without the need to establish extreme malice or negligence –gives rise to the transfer to the copyright owner of the economic benefits obtained by the illegitimate user.[17] This interpretation was confirmed on appeal on the assumption that, in case of unintentional infringement of copyright, the only possible solution available to the victim of the injury was to seek compensation equal to the enrichment obtained by the perpetrator from the illegitimate use of the work of another.[18] Restitution of profits thus came to be defined as "a rule not infrequently applied in cases of compensation for damage due to infringement of copyright": a possible alternative remedial resource in relation to the criterion, widely applied in jurisprudence, of the so-called 'just price for consent', *i.e.* consideration for allowing use.[19]

A case in the same vein is a recent decision of the Court of Appeal of Rome, relating to compensation for damage for copyright infringement: the case concerned the infringement – claimed by the company possessing the license – of the contractual obligation to reproduce and distribute the works of the singer-songwriter Renato Zero, based on curatorial sub-division of the published collections of his work in accordance with its artistic evolution and maturation.[20] Also in this case, the appellate court (confirming in its entirety the decision of the lower judge) established that the appellant company had, by means of the illicit production of a 'new' collection, "obtained a profit it was not entitled to", at the same time inflicting on the author "damages corresponding to the profit he could have obtained if he himself had produced the composition, as was his right". The argument on which this decision stands (confirming the decision of the trial court) is based on the principle that "the damage can be compensated, at a minimum, and in the absence of proof of greater damage, with a sum equal to the net profit obtained by the illicit use of the copyright, for the reason that this profit could have been gained by the owner of the copyright if he/she had directly used the composition".[21]

Along the same lines there is the case concerning a company which – offering services in the electronic collection of authoritative news dailies and journals – was sued by these latter "because it reproduced on-line in electronic form whole articles from their newspapers, put systematically at the disposition of its clientèle from 6 o'clock in the very morning of publication, providing the entire text in the

[16] This judgment, brought down on 2 October 1990, appears – as far as can be discovered – not to have been published.

[17] See App. Bologna 22 April 1993 cit., 429. On this profile see Attolico (1988), 417 et seq.

[18] App. Bologna 22 April 1993 cit., 430.

[19] In this regard see Cass. 6251/1983 cit., 54 et seq.

[20] See App. Roma 18 April 2005, in: AIDA, 2006, 511.

[21] See App. Roma 18 April 2005 cit., 514.

same format as the printed hard-copy journal".[22] The Court of Appeal of Milan, recognizing the illegality of the activity undertaken by the company being sued, sentenced it to pay damages corresponding to the financial advantage derived from the illegal act. In particular the appeal emphasized the fact that, in the specific case of extra-contractual responsibility for the illicit economic use of a literary or other creative work, or the illegal reproduction of the qualities of the competitive product, the profit thereby lost must be compensated for taking into account the element of greatest significance for determining the severity of the offense and the loss sustained by the business affected, that is, the profit obtained by the perpetrator of the illegal act.[23]

Of course the proposition of developing an equitable determination of damages, given that the underlying assumption is strained at the very least, has entailed a trade-off in terms of certainty of outcome. It is not in fact uncommon for Italian courts to opt for diametrically opposed solutions.[24] In one relevant decision concerning the unauthorized commercialization of the texts of lectures given by a university professor, the court, far from using definite and available information which would have allowed for easy recourse to the criterion of the profit gained by the perpetrator of the illicit act (in other words, the price at which the notes were available in a bookshop),[25] preferred to opt for the evaluation of the damages in terms of the profit lost to the injured party.[26]

[22] App. Milano 26 March 2002, in: AIDA, 2003, 799.

[23] In the same vein (in other words, favorable to the application of the criterion of profit obtained by the counterfeiter in the quantification of damages in judgments on industrial property), see App. Milano 22 January 2002, in: AIDA, 2002, 794; Trib. Firenze 9 January 2001, in: Giur. It., 2002, I, 339; Trib. Vicenza 4 September 2000, in: Giur. ann. dir. ind., 2001, 4235; Trib. Milano 31 May 1999, in: AIDA, 2000, 732; Trib. Milano 16 April 1998, id, 564; Trib. Milano, 18 December 1997, in: Dir. autore, 1999, 127; Trib. Roma 9 June 1993, in: Dir. informazione e informatica, 1993, 972.

[24] In this regard, a sentence brought down in the Court of Appeals is emblematic: the case related to the market in welding machines (see App. Milano 15 February 1994, in: Giur. ann. dir. ind., 1995, 3222). The court, aware that the case had to do with a limited and specialist market sector, ruled that "those who acquired the machines in question from [the company which carried out the counterfeiting, Fimer], which had neither produced the machines nor brought them to market, would have purchased them from the [company which brought the counterfeiting case, Gen Set]". Therefore, "*although the company had recourse to a criterion of an equitable settlement — legitimated by the evident impossibility of demonstrating with precision how the market would have behaved in a situation different from what actually occurred — it is correct to hypothesize that Gen Set had suffered an injury, due to the loss of sales, equal to the profit obtained by Fimer through the sale of machines which it should not have marketed.*". In other words: "*since the number of machines sold by Fimer during the period under consideration (verified by the technical consultant in the lower court) is not contested, it appears to be easy to estimate the liquidated damages (. . .) by referring to the profit which Fimer itself has obtained (at the expense of Gen Set) by the sale of that number of machines*".

[25] Trib. Milano 12 October 1998, in: AIDA, 1999, 618.

[26] See Plaia (2005), 45.

The Role of Disgorgement Damages in Italian Legal System: A General Remedy for All Kind of Law Infringements?

In the Italian judicial system, disgorgement damages cannot be considered a general remedy for any hypothetical infringement of copyright. As we will see set out in more detail below (see paragraphs 5. and 5.1.), the inclination towards punishment and sanction, evident within the 'interstices' of the institution we are discussing, effectively collides with the strongly compensatory and remedial approach characterizing the Italian judicial system. However, the phenomenon of 'convergence' that we have already noted between the doctrinal and jurisprudential 'souls 'of Italian law, in the direction of bridging the *lacuna* in relation to enrichment resulting from illegal activity, represents the basis for legislation which offers an opportunity (in one sector at least, industrial law, which has always shown itself open to finding innovative solutions) to develop a legal remedy capable of achieving the double objective of punishing the perpetrator of the illicit act while dissuading anyone else from emulating such illegal conduct: here I refer to 'restitution of the illicit profits', see Articles 125 Codice di Proprietà Industriale (C.P.I.) and 158 l.a. as revised by Art. 5 of the d. lgs. of 16 March 2006, no. 140, covering the response to Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on intellectual property rights (henceforth the Enforcement decree).

Restitution of the Illicit Profits ex Art. 125 C.P.I.

The opportunity for the much-invoked change in direction (mainly but not solely at the legislative level) materialized when – by virtue of the mandate provided by Art. 15 of the Act of 12 December 2002 no. 273 – the Government entrusted to a dedicated inter-ministerial commission the task of drawing up a new legal code on industrial property rights, the C.P.I.. The avowed objective was to simplify and reorganize the multiple laws currently in force (of national, international and European community origin) which had become ever more complex in interpretation, not only due to the diversity of languages used, but chiefly because of the unraveling of systematic linkages and of the necessary coherence of the individual legal systems.[27] One of the most interesting (but arduous) dispositions in this new codification is the section of Art. 125 which addresses the delicate problem of compensation for damages in relation to hypothetical enrichment from an illicit act (see paragraph "The Tormented Adventure of Art. 125 C.P.I.". on the genesis of this regulation).[28] In fact, with this rule the ministerial Commission – responding to the common

[27]For a careful analysis of Articles 5–18 of Act 273/2002 see Floridia (2003), 22 et seq.

[28]For an incisive analysis of the evolution and logical implications of this article see Floridia (2012), 5 et seq.

charge that the remedial system in Italian law was insufficient, or rather inadequate in addressing hypothetical enrichment from illicit acts – introduced a new remedial solution, which equates the amount of compensation due to the profits obtained by the counterfeiter in violation of the copyright.[29]

The Tormented Adventure of Art. 125 C.P.I.

In its original draft (completed 22 July 2003), the provisional text of the C.P.I. dedicated Article 134 to the discipline of compensation for damages. With this disposition the legislature had a double aim. On the one hand, it guaranteed an essential continuity with the guiding principles in relation to compensation (*ex* Articles 1223, 1226, 1227 c.c.). On the other, drawing on the many instances of complaint (as well as the demand for the upgrading and modernization of the law from both the academic and professional legal communities), it gave owners of industrial property rights the concrete possibility of claiming "in addition" the profits obtained by the counterfeiter.

Such a legislative intervention, however, constituted only the first in a series of moves that characterized the introduction of the legal instrument of disgorgement damages into the range of Italian legal remedies. In December of the same year the legislature again amended the regulations in question (meanwhile renumbered as Art. 125), calling for both a formal modification (by which the expression "profits obtained by the counterfeiter" in the second clause of Art. 125 was replaced by the formulation "profits obtained by means of copyright infringement"), and the addition of a third clause (of less interest in terms of this discussion), which introduced a financial penalty.

An effective reformulation of the article in question took place only following the third provisional draft of the Code (dated 10 September 2004), which – by means of an outright compression of the conclusions to the first and second clauses of the original Art. 125 – produced the following result: to the original wording

[29]This is the text of Article 125, as modified by Article 17 d. lgs. on enforcement: "1. *The compensation due to the injured party is calculated according to the provisions of Articles 1223, 1226 e 1227 of the civil code, having regard to all relevant aspects of the injured right-holder, such as the negative economic consequences, including loss of earnings, the gains realized by the tortfeasor and, in appropriate cases, elements other than the purely economic, such as moral damage to the proprietor of the right which has been infringed. 2. The judgment awarding compensation can base the calculation of its global amount on the proceedings of the case and the assumptions deriving from them. In this case the lost of profits is in any case determined at an amount not less than the fee that the perpetrator of the infringement would have had to pay had he obtained a license from the injured right-holder. 3. In any case the injured right-holder can ask for disgorgement damages as restitution of the profits obtained by the perpetrator of the infringement, as an alternative to compensation for the loss of profit or by the amount by which those profits exceed such compensation*". For a more in-depth scrutiny of the new addition introduced by the enforcement decree see Floridia (2012), 9 et seq.; Colangelo (2011), 274 et seq.; Albertini (2010), 1149; Di Sabatino (2009), 442; Barbuto (2007), 172; Savorani (2007), 500; Bonelli (2007), 195; Menzetti (2006), 1881; Vanzetti (2006), 323; P. Pardolesi (2006b), 1605.

(according to which "the compensation due to the injured party is to be calculated in accordance with the terms of Articles 1223, 1226 and 1227 of the civil code") was added the directive that the lost profits be calculated "also taking into account the profits obtained by means of copyright infringement".

Nevertheless, Art. 125 (in this new formulation) underwent a further modification with the definitive draft of the C.P.I. (d. lgs. of 10 February 2005, no. 30). It is not by chance that the legislator in this case – having stated that in determining the lost earnings the judge should also take into account the profits gained in violation of copyright – makes clear that this calculation should also take into account the so-called price of consent. As a consequence, the earnings gained by the perpetrator of the illicit conduct should be calculated taking into account not only the illicit profit but also (if only virtually) the costs avoided by means of that specific conduct.

The tormented 'adventure' of Art. 125, however, was still far from its conclusion. The formulation envisaged in d.lgs. 30/2005, in fact, triggered two doggedly critical reactions. On the one hand, the ministerial commission emphasized that the wording of the draft entailed a notable divergence from the objective of filling the considerable legislative gap in the matter of illicit enrichment. On the other hand, a careful interpretation finds that the domestic legislature, working in this way, has the effect of discarding the instrument of 'disgorgement damages', limiting itself to producing "a measure which is functional in terms of recovering lost profits but is aimed at compensation (...) rather than an 'objective' measure on the model of the 'TRIPS'". In other words, according to the same author, it represents a lost opportunity: the legislature, rather than adopting an autonomous legal instrument (disgorgement damages), capable – in accordance both with international rules (Art. 45 TRIPS) and with the less forceful rules of the European Community (Art. 13 of Directive 2004/48/EC) – of excluding the subjective element, apparently preferred to include it within the possible instruments of damages award.

Finally – with the bill on enforcement – arrives the last 'restyling' (at least for the moment, given the need for the law to be rendered less insecure) of the Article under consideration. The reformulation brings three relevant innovations: (1) in the first place, it foreshadows – in the introduction to the Article in question – a decisive separation between the remedial instruments for damages award and "restitution of profits"; (2) secondly, there is provision for a minimum limit to global liquidation corresponding to the price of consent to the exploitation of the intellectual property being protected; and, lastly, (3) there is the possibility that the restitution of the profits obtained by the perpetrator of the copyright infringement can be claimed as an alternative to compensation for damages, or – only in the event that the profits to be restituted exceed the amount of compensation due – be combined with lost profits.

Restitution of the Illicit Profits ex Art. 158 l.a.

In this survey of the statutory provisions, it is worth mentioning Art. 158 of the law on copyright (as updated by Art. 5 of the decree on enforcement). In the article in question the legislator, having conveniently cited the need to calculate damages in

accordance with the dispositions of clauses 1223, 1226 and 1227 *c.c.*, states that the judge – in calculating the value of lost profits – must also take into account the "profits gained by means of the copyright infringement".[30]

At first blush, given the 'counter-intuitive' choice not to include copyright law within the ambit of the legislation on industrial intellectual property,[31] it is not surprising that there is a substantial similarity between the article under discussion and Art. 125 C.P.I. (and, in particular, one of its last versions; that is, the draft formulated in the bill dated February 10 2005, no. 30).[32] Art. 158 l.a. also expresses the clear intention, on the one hand, of guaranteeing continuity with our system of legal remedies (by means of the reference to the principles of loss of profit, of actual loss, of fair assessment of damage, as well as the contributory negligence of the creditor), and on the other hand, actually overcoming the reluctance to innovate in proposing recourse to a remedial solution capable of satisfying simultaneously the multiple functional requirements arising from violation of copyright. Not by chance, Art. 158 l.a. would also appear to have been intended to fulfill the double function (prevention/deterrence and punishment/sanction) to be found in Art. 125 C.P.I.

More specifically, loss of profit may be quantified in two ways. Firstly, by means of an equitable settlement, based on an impartial evaluation of the circumstances of the case (Art. 2056 *c.c.*), which include the profits obtained by the counterfeiter. To achieve this, therefore, the judge 'is obliged' to include in the process of calculation of damages the profits obtained by the counterfeiter. In contrast to the provisions of Art. 45 of the TRIPS Agreement (in which the legislature affords to the member states – "in appropriate cases" – the capacity to "authorize the judicial authorities

[30]This is how the 'new' Art. 158 reads: "*1. Whoever is injured in the exercise of a right to economic utilization to which he is entitled may take legal action to ensure, not only that he receive compensation for the damage, but that the state of affairs which led to the infringement be destroyed or removed at the perpetrator's expense. 2. The compensation due to the injured party is calculated in accordance with the provisions of Articles 1223, 1226 and 1227 of the civil code. The lost of profits is assessed by the judge in accordance with Article 2056 of the civil code, second clause, also taking into account the profits obtained by the infringement of the right. The judge can moreover assess damages as a lump sum on the basis at least of the value of the rights which would have been recognized, if the perpetrator of the infringement had asked the right-holder for authorization to use the right. 3. Non-pecuniary damages are also due in accordance with Article 2059 of the civil code.*" For a more in-depth analysis of the issues related to Art. 158 l.a. see Colangelo (2011), 93 et seq.; Casaburi (2010), 1194; Di Sabatino (2009), 442; Menzetti (2006), 1881.

[31]On this point see Casaburi (2010), 1194.

[32]The text of Art. 125 (in the version given by the d. lgs. of 10 February 2005, no. 30) provides that: "*the compensation die to the injured party is assessed according to the provisions of Articles 1223, 1226 and 1227 of the civil code. The loss of profit is evaluated by the judge also taking into account the profits obtained by the infringement of the right and the fee that the perpetrator of the infringement would have had to pay in the event that he had obtained authorization from the right-holder.*" I seems hardly necessary to point out that in the second clause (of the same Article) it is stated that: "*the sentence which awards compensation can, at the request of one of the parties, set the amount as a lump sum established on the basis of the proceedings of the case and of the assumptions deriving from them.*"

to order the recovery of profits and/or the payment of pre-established sums" even in the absence of guilt), the national legislation seems to incline towards a complete 'assimilation' of the new remedial approach.

More in detail. The use of the expression "also taking into account the profits obtained", thus overcoming the extreme limitation expressed in Art. 45 of the Agreement with the phrase "in appropriate cases" (limiting the cases in which it would appear possible to take advantage of the remedy offered by disgorgement damages), would seem to offer a wider range of remedial solutions or, better still, greater room to maneuver in the Italian remedial system. In other words, within the 'normal' dynamics of the assessment of actual loss and loss of profit, in the same manner as the general rule, in relation to the second item, a really innovative dimension has been inserted, which is quite revolutionary in relation to the reference model. This no longer covers only the profits lost due to the illegal activities of others, but also a modified computation of the proceeds that such illicit activities have provided to the counterfeiter.

Secondly, as an alternative to the "ordinary criterion", Art. 158 l.a. provides that lost profits can be quantified by means of a fixed rate settlement based at a minimum on the rights that would have been recognized if the perpetrator of the copyright infringement had asked the copyright owner for authorization for the use of the right.[33] Therefore compensation for the damage is to be determined "by quantifying the fee usually sought in the market for that specific type of use of the work" (that is, measuring it against the objective or market value of the work").[34]

The Main Differences Between the Two Provisions

In the light of these premises, let us attempt to outline succinctly the principal differences between Articles 158 l.a. and 125 C.P.I.[35]

To this end, it is important to start by considering the absence of a consistent literature on copyright law. In other words, in the absence of such a body of preventive information, there is ample space for hypotheses of unintentional infringement such as to justify the burden on the injured party to prove not only that the tortfeasor had benefited from the action, but also that the infringement was negligent or malicious.[36] Furthermore, "while for patents, brands etc. the monopoly arises out of legally enacted regulations and there is a system of legal publicity

[33] "*This is a criterion – at least in principle (. . .) – which is marginal with respect to disgorgement damages, and essentially equitable*": Casaburi (2010), 1208. On this point, see also Menzetti (2006), 1883.

[34] Casaburi (2010), 1208. In this sense see Guglielmetti (2002), 251; Frassi (2000), 93 et seq.; Auteri (2004), 353 et seq.

[35] On this point see Casaburi (2010), 1194 et seq.

[36] See Menzetti (2006), 1884.

(. . .), this does not apply to copyright. In the case of the former, therefore, the perpetrator of the infringement would be hard pressed to declare himself totally free of guilt, given that in any case there exists the duty to inform; thus, even if there is no concrete proof of his malice or negligence, it is not unfair that he be required to pay a compensation restitution commensurate with the economic benefit he has obtained. In the second case, on the other hand, a completely unintentional infringement is possible (. . .), and in the absence of a system of publicity the alleged perpetrator could not even be required to inform himself in advance of the existence of pre-existing rights which his activities may infringe". Therefore, the same careful analysis points out – combining the absence of constitutive proceedings and of publicity with the substantial difference in treatment between original and derivative creation that characterizes copyright generally, and patents in particular – that "in the province of copyright not only does unintentional infringement exist, but (i) it is far from improbable, (ii) it can involve an autonomous 'investment' both in terms of creativity and in terms of the 'dissemination' of the work; (iii) it can even take on the guise of a worthy act, by bringing to the market a product which may not be absolutely new, but which nevertheless makes a contribution to cultural progress, to the sum of available information, or of available entertainment etc. The absence of an obligation for compensation (or restitution) to be borne by the innocent person thus appears efficient from the point of view of the public interest in the diffusion of creative works".[37]

A further element of differentiation between the two dispositions under discussion can be seen in the determination of loss of profit. On closer inspection, in fact, Art. 125 C.P.I. – following the indications provided by 45 TRIPS and Art. 13 of Directive 2004/48/EC[38] – recalls the wider concept (in the case of negligent infringement) of "profits obtained by the perpetrator of the violation" as an autonomous element in the evaluation process highlighted by its similarity to lost earnings.[39] In Art. 158, in the other hand, without having recourse to the optional provisions of Directive 2004/48/EC concerning disgorgement damages, reference is made to the more restricted concept of "profits obtained by means of copyright infringement" as the criterion for equitable restitution (which, as previously pointed out, the judge on the bench is required to take into account in the evaluation of lost profits) to be employed in relation to a negligent infringer of copyright.

From this it follows that the tool of disgorgement damages represents the "optimal method, but the legal procedure which results from it appears milder, and lacks the gradation of 'sanctions' between someone who has violated private rights with negligence or malice, as opposed to someone who has done so without such negligence or malice. The first will be required to pay compensation for the lost profits only; the second appears to bear no duty to compensate".[40]

[37] Menzetti (2006), 1885.

[38] For a more in-depth analysis of this profile see Menzetti (2006), 1884.

[39] Casaburi (2010), 1199.

[40] Menzetti (2006), 1884.

The Problems Relating to the Functional Characteristics of the Italian Remedial System

In the Italian legal context – although it is possible to conceive of a substantial convergence of theoretical, jurisprudential and legislative approaches toward the adoption of remedial instruments capable of guaranteeing both punishment and sanction[41] – there does not seem to be a coherent theory relating to their functional nature. To put it more clearly: we must consider how problematic it is for the Italian remedial system to acknowledge the need for a role beyond that of mere reparation/compensation. Not be chance, this difficulty has found specific confirmation in the alternating positions manifested in a number of very recent decisions of the Supreme Court which, after an initial period of effective standstill, would seem to have proposed an authoritative change in attitude in the functional characteristics of the Italian remedial system.

The Fluctuating Orientations of the Italian Supreme Court

In 2007, the Supreme Court, in a decision strongly criticized by scholars,[42] denied legal recognition to a sentence passed by the Jefferson County District Court which called for punitive damages of one million dollars against the Italian manufacturer of a protective helmet which at the moment of collision, due to a defect in the design and construction of the buckle, came off the victim's head. This decision was based on the assumption that objectives in terms of punishment and sanction of such compensation were in clear conflict with public policy, given that the regulatory principles of our civil law system regarding civil responsibility in relation to illegal extra-contractual actions set the payment by the perpetrator as equivalent to reparation for the damage suffered by the injured party.[43] In particular, besides

[41] I refer, in particular, to the above-mentioned remedial instrument of disgorgement damages ex Articles 125 C.P.I. and 158 l.a. which is capable of taking as a reference point the profit obtained rather than the loss alone.

[42] A concise criticism in relation to Cass. 19 January 2007 no. 1183, in: Foro it., 2007, I, 1460, can be found in Ponzanelli (2007), 1461; P. Pardolesi (2007), 1125. On this profile see also Fava (2007), 497; Giussani (2008), 395; Miotto (2008), 188. For an overall analysis of the vigorous debate about punitive damages I would refer to my own paper P. Pardolesi (2011a), 59.

[43] "*[I]n the current system the idea of punishment and sanction is extraneous to compensation, as is the conduct of the person causing the injury. Civil responsibility is required to take on the principle task of restoring the assets of the person who has suffered the injury, by means of the payment of a sum of money intended to eradicate the consequences of the injury suffered. And that is the case for any type of injury, including non-economic or moral injury; for compensation for this type of injury, precisely because it may not involve punitive objectives, not only are the state of need of the injured party and the economic capacity of the respondent irrelevant, but there also must be proof of the existence of suffering caused by the wrongful act, through the identification of*

the way in which the judges of the Supreme Court had rejected the rationale for the appeal, many questions were raised by the opinion, which not only ignored the provisions pointing in the opposite direction,[44] but excluded the possibility of taking advantage of the opening in the Italian remedial system (in relation to punishment and sanctions) offered by legal literature and jurisprudential practice acting jointly.[45]

Nevertheless, and although everything seemed to confirm the trend towards the 'crystallization' of our civil responsibility in relation exclusively to compensation, the Supreme Court, with two almost contemporaneous decisions (the first relating to illicit use of image copyright[46] and the second concerning infringement of author's copyright),[47] became the protagonist of an unexpected change in direction.

With the first decision, the Court established that, in the case of compensation for the illicit use of the image of a young and unknown dancer (made for profit by the dancing school where he had been a pupil for a number of years), the settlement could have been determined "by reference to the profit presumably made by the perpetrator of the illegal act".[48] On this basis the Court opted for the application of the instrument of disgorgement damages in a way which resembles the 'almost punitive' steps of disgorgement damages. Thus, taking to heart the modifications introduced by Art. 5 of the enforcement decree to Art. 158 l.a.,[49] the Cassazione has established that the victim of the illicit conduct, above and beyond the traditional techniques of quantification (such as the price of consent, the dilution of the image, and moral damage), could be offered the opportunity to obtain compensation adequate, on one hand, to simplify the critical issues related to the determination of the amount of restitution and, on the other hand, to overcome the risks implicit in the traditional concept that the perpetrator of the illegal act is required to compensate the victim only for the damage caused to him.

This position was confirmed a few months later when the Supreme Court – addressing a controversy about the quantification of damages for infringement of copyright[50] – returned to pronounce in favor of the employment of disgorgement damages (to address the critical issues implicit in the so-called hypothesis of enrichment by illicit means).[51] Pursuing the objective of "preventing the illegal

concrete circumstances from which to presume cause, given that such a proof cannot be assumed to be self-evident in re ipsa": Cass. 1183/2007 cit., 1460.

[44] See infra, paragraphs 6., 6.1., 6.2., 6.3. and 6.4.

[45] On this point see P. Pardolesi (2012a), 132 et seq.

[46] Cass. 11 May 2010, no. 11353, in: Foro it., 2011, I, 540 (with a note by P Pardolesi (2011b)).

[47] Cass. 15 April 2011 no. 8730, in: Foro it., 2011, I, 3073 (with a note by P. Pardolesi (2011c)).

[48] Cass. 11353/2010 cit., 540.

[49] On this point see, supra, paragraph 3.2.

[50] Specifically, the controversy in question consisted of the unlawful broadcasting of a television series by companies which colluded at the expense of the plaintiff company which had acquired the exclusive rights of economic utilization over the whole country (see Cass. 8730/2011 op. cit., 3073).

[51] In relation to the concept of unlawful enrichment by means of illicit actions see paragraph 2.

user from obtaining advantage from his illicit conduct, withholding the profits in the place of the holder of the legitimate right of appropriation", the Court seems to have marked a decisive rehabilitation in a multi-functional sense of the remedial system (a perspective too often sacrificed on the altar of the systematic guaranteed coherence of the most moderate function of compensation) "bending the institution of compensation for damages to perform a partly sanctioning function, (. . .), rather than compensation for the loss of assets".[52]

A Drastic Change in the Approach to Reparation for Damages: The Need to Rediscover the Multi-functional Character of the Italian Tort System

In this context, the novelty is not of slight moment: the idea, first simply foreshadowed in theory (and, successively, validated, if only tangentially, by the legislature), that the range of relevant remedies available could extend, on the basis of suggestions arising from the experience of the common law, as far as to include restitution of the illicit profits, would appear to have been validated by the Supreme Court.[53] This implies that compensation with a nuance of punishment and sanction no longer constitutes a chimera.[54] Naturally, taking a critical stance, one can reply that the reference to the profits of the perpetrator of the illicit action represents a mere *proxy* in support of an attitude which is problematic to define. The fact is that, faced with an injury which is impalpable or of limited dimensions, one can proceed to measure the more evident advantage accruing to the infringer of the right: going

[52]Cass. 8730/2011 cit., 3073.

[53]Nevertheless, it should be pointed out that a very recent judgment (see Cass. 17 February 2012 no. 1781, in: Corriere giur., 2012, 1068, with a note by P Pardolesi (2012b)) saw a counter-intuitive about-face by our Supreme Court in denying the exequatur of a judgment brought down by the Supreme Court of Massachusetts (which called for compensation for injury suffered by a worker, in the amount of five million dollars—raised to more than eight million dollars due to a very high rate of interest—against an Italian company which produced a defective machine) which had been approved by the Court of Appeal of Torino. More specifically, what raised much perplexity were the reasons given by the Supreme Court for its decision to deny the exequatur: in fact, irrespective of the lack of any reference to the concept of punitive damages, granting such a large sum would appear in any case to manifest a punitive leaning foreign to the Italian legal system (not forgetting, furthermore, that the absence of any indication as to the criteria adopted in the North American judgment to arrive at the amount of compensation made it impossible to verify whether the judgment did or did not contain aspects in relation to damages not admitted in the Italian system). For an incisive analysis of the critical aspects of this judgment, see Ponzanelli (2012), 613.

[54]In this regard it is useful to point out how recently not only legal scholarship but also the Supreme Court (cfr. Cass. 19499/2008 op. cit., 2786) have been moved to re-consider the applicability of the instrument of disgorgement damages in the context of contracts as well. For a closer examination of the peculiarities underlying such a decision see, infra, paragraph 6.4.

beyond interpretative contortions, this is in fact the logic of private punishment, or, if you will, of punitive damages and 'disgorgement damages'.

Nevertheless, the need/demand to assure systematic coherence requires a drastic change in approach to the matter of reparation for damages, rediscovering (and fortifying) its multi-functional character, permanently rooted in its DNA but, in the last half-century, overshadowed by the predominance of compensation.

It therefore appears evident that the cases just examined constitute a first important step in the direction of legitimizing an approach different from the merely compensatory; nevertheless, only future developments will permit to ascertain whether the Italian juridical landscape is really mature enough to develop a coherent theory of disgorgement damages capable of envisaging remedial instruments (encompassing punishment and sanction) capable of assuming the legal response roles which in the common law are occupied by disgorgement damages.

The Modus Operandi of the Italian Courts in the Quantification of Disgorgement Damages: Are They Practically Relevant?

Beyond the jurisprudential efforts cited above,[55] there is no large body of case law from which to identify the *modus operandi* of the Italian courts in the quantification of disgorgement damages. Recently, however, the Tribunal of Genoa, in a pronouncement on the improper use of a registered trademark, speculated on the concrete practicability of disgorgement damages (*ex* Art. 125 C.P.I.), as well as the difficulties inherent in their calculation. Despite their apparent conceptual simplicity, the actual quantification of disgorgement damages is a rather controversial subject: "the profits must be given back, but it is certainly not necessary for the restitution to be equal to what appears in the books of the perpetrator of the infringement because these accounts could include not only the competitive advantage deriving from the copyright infringement but also a number of other factors which have nothing to do with the competitive advantage".[56] The trajectory of the argument therefore becomes very complex.

It must be remembered, above all, that any form whatever of calculation/evaluation raises very delicate critical issues; in this specific case, apart from the 'evidentiary' difficulties in relation to compensation for injury,[57] the applicability

[55] On this point see, supra, paragraph 2.2.

[56] Floridia (2003), 10.

[57] Proof of this can be seen in the fact that the court pointed out in strong terms that the effects of the injury arising from the illicit use of a registered trademark (that is "*the loss of market share, in terms of diminishing – or more slowly increasing – turnover", as well as the "tarnishing of the brand caused by the commercialization – with the counterfeit label – of products of inferior quality*") must be "*alleged and proved by the injured right-owner*" (as in the judgment of the Trib. Genova of 23 February 2011, in: Danno e resp., 2012, 788, with a note by P Pardolesi (2012c)).

of disgorgement damages was excluded by the Tribunal on the basis of the absence of two essential prerequisites: (1) "the verification of the profits obtained" and (2) "the necessary causal relationship between the infringement and the resulting profit".[58] Furthermore, it is essential to clarify what is meant by 'profit realized by the perpetrator of the infringement' (and thus what is the structural 'profile' to be taken into consideration), to avoid the risk of a worrying over-punishment of the counterfeiter. Not by chance, as attentive legal scholarship observed, while "counterfeiting the patent on a drug which is unique and irreplaceable for therapy gives rise to profits which can be completely restored precisely because they are totally due to the competitive advantage illicitly exploited by the counterfeiter", the matter becomes 'slippery' when "the copyright infringement concerns a brand and does not involve the illicit application of the brand to products commercialized by the right-holder but the use of the brand on similar products; or else when the brand being counterfeited is very well-known and is illicitly used in a merchandising operation, in a situation in which there is no relationship between the products thus branded by the counterfeiter and those of the right-holder".[59]

To sum up, it appears evident that the efficacy as 'para-sanction' of the instrument of disgorgement damages (which is recommended as a prudent measure to deal with the possibility of enrichment by illicit means) may be counterbalanced by the possible difficulties in calculating the amount of the restitution according to the specificities of the case in question. As mentioned previously, it is one thing to identify the profits made in relation to a unique and irreplaceable patent; it is quite another to follow this trajectory when – as in the case under examination – the target of the infringement is a brand and, more specifically, its illicit application to related products. In short, the game could be not worth the legendary candle.

Again, a valuable suggestion could be drawn from the experience of the common law, in which the courts are in a position to adopt one of a number of available solutions for calculating damages ('restitutory', 'reliance', 'expectation' and 'disgorgement' damages), choosing from time to time the solution they consider most appropriate in view of the actual circumstances, convenience, and the objective difficulty of calculation. Put more clearly, in the presence of a serious risk of under-compensation for the victim of the infringement (due, for example, to an abuse of contract in which the injured party is left with defective performance, with absolutely no possibility of recuperating the damage resulting from the loss actually suffered),[60] compensation is calculated by means of disgorgement damages, an

[58]Trib. Genova 23 February 2011 cit., 788.

[59]Floridia (2003), 10.

[60]Consider of the case in which a builder – having signed a contract with a client for the construction of a building, setting a high contract price because it involved using a particularly high quality material – decides to substitute for it a material of much lower, even shoddy, quality (thus realizing a substantial cost saving), without however reducing the contract sum. In such a context problems arise when the buyer, at the moment of selling the building, finds out that, because of the use of the alternative material 'cunningly' chosen by the builder, not only has the market price of the building been substantially reduced, but that replacing it eventually with the material originally

instrument permitting the injured party to 'recover' the whole of the profit from the counterpart. Such a solution, however, would be completely subverted if the injury suffered (which, let us suppose, corresponds to the diminution of the market value of the asset in question) was much greater than the profit realized by the perpetrator of the illicit action: the victim would choose to claim 'expectation damages' precisely because, in the hypothetical case, that instrument guarantees more appropriate compensation.

The decision of the Tribunal of Genoa bears witness (once again) to the fact that notwithstanding the significant steps forward made by our legislature in relation to compensation for damages, there is still a long way to go.

Functional Equivalents to Disgorgement Damages in the Italian Legal System: Are They Applied and How Are They Used in Practice?

In the light of the above considerations it appears possible to identify certain techniques which – moving beyond mere compensation – present interesting analogies with disgorgement damages, demonstrating that the notion of a remedial instrument with clear utility in terms of punishment and sanction is not completely foreign to our legal system.

In this context emphasis should be placed on the principal statutory provisions in which it is possible to read the will of the legislature to introduce legal instruments capable of guaranteeing the double objective of sanctioning the perpetrator of illicit acts and of dissuading anyone else from emulating such illegitimate actions: (1) in the first place, disgorgement damages as discussed previously, *ex* Articles. 125 C.P.I. and 158 l.a.; (2) the sanction measures *ex* Art. 709 *ter* c.p.c. (otherwise: Codice di Procedura Civile); (3) pecuniary reparation *ex* Art. 12 of the Act of 8 February 1948, no. 47 (subsequently known as the 'press law'); (4) compensation for environmental damage *ex* Art. 18 of the Act of 8 July 1986 no. 349; and, lastly, (5) damages for monetary devaluation *ex* Art. 1224, clause 2, c.c.

specified would entail spending an amount equal to half the total cost of the building itself, because of the costs involved in the partial demolition and reconstruction of the building. This is how, as described by Farnsworth (1985), 1382, on the assumption that the court would in all probability decide to exact compensation in a sum corresponding to the reduction in the market price of the building, the plaintiff would run the serious risk of ending up with a defective building and with the practical impossibility of achieving any compensation for the damage.

The Sanction Measures ex Art. 709 c.p.c.

Returning to the preceding paragraphs for further analysis of the instrument of disgorgement damages,[61] in this context attention should first be paid to the measures in Art. 709 *ter* c.p.c., which, by virtue of the possibility they provide for both punishment and sanction, present notable analogies with the common law instrument.[62]

In reforming the discipline on joint custody of children and on cooperation between parents,[63] Art. 709 *ter* c.p.c. introduces "a special procedure aimed at regulating the conflicts arising between spouses in relation to the implementation of procedures for the custody of minors, and at managing in a positive way the relationship between parents and children; this now sanctions breaches and non-fulfillment of judicial provisions during the pathological phase of a relationship, within the framework of the final objective of better and more effective achievement of outcomes compatible with the pre-eminent interests of the minor involved, inevitably affected by the breakdown of the family unit".[64] Starting with the "principle of shared parenting [*bigenitorialità*]", it recognizes the need for more effective protection of the interests of the minor which will guarantee the essential continuity of the child-parent relationship in the most balanced and harmonious way possible.[65]

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[61] On this profile see, supra, paragraphs 3.1. and 3.2.

[62] This is the substance of Article 709 ter c.p.c. (Resolution of disputes and provisions in the case of default or infringement): "*(1) For the resolution of disputes between the parents in relation to the exercise of parental authority or the arrangements for custody the competent authority is the judge presiding in the proceedings underway. For proceedings referred to in Article 710 the competent forum is the tribunal of the minor's place of residence. (2) When a case is brought to court, the judge summons the parties and adopts the most appropriate provisions. In the case of serious breaches or of actions which might be prejudicial to the welfare of the minor, or constitute obstacles to the correct implementation of the arrangements for child custody, can modify the existing arrangements and can, do any or all of the following: 1) reprimand the defaulting parent; 2) make a compensation order against one of the parents on behalf of the minor; 3) make a compensation order against one of the parents on behalf of the other; 4) sentence the defaulting parent to the payment of a pecuniary administrative fine, from a minimum of 75 euro to a maximum of 5.000 euro to be paid into the Cassa delle ammende. The provisions laid down by the presiding judge can be appealed in the normal way.*"

For a more in-depth analysis of the measures related to Art. 709 ter c.p.c. see Figone (2008), 799; La Rosa (2008), 64; Facci (2008), 1026; Cassano (2008), 498; Farolfi (2009), 610; Astiggiano (2011), 574; De Salvo (2012), 613; Paladini (2012), 853.

[63] The rationale for this is the objective of guaranteeing that children can grow up in a balanced and harmonious way in an environment of family collaboration, no longer centered on the continuity of the family unit but focused on the enhancement of their relationships with their parents. For an incisive analisys of the provision introduced by the Act of 8 February 2006, no. 54, see Patti and Rossi Carleo (2006); Graziosi (2006), 1856; De Filippis (2006); Marino (2007); Finocchiaro and Poli (2007), 532.

[64] La Rosa (2008), 64.

[65] See La Rosa (2008), 70.

The mechanism hinges on the seriousness of any conduct which damages the rights of the children employing a punitive logic which, with the aim of preserving and protecting the interests of the minor, disregards the compensation of the injury suffered by the latter (as well as the proof of their existence):[66] "the relevant issue is not the injured party, that is, the injury concretely suffered by the minor; it is the conduct of the perpetrator of the illicit act, which because it serves as an example, evaluated *a priori* by the legal system, dictates recourse to instruments of sanction and deterrence. Therefore, with the conduct in question evaluated by the law in terms of its potential dangerousness, the judge has only to ascertain the actual existence of the relevant prerequisites for the application of the legal remedy".[67]

From this it follows that, by virtue of such a logic of punishment and sanction,[68] the compensation measure provided for in Art. 709 *ter* c.p.c. (as well as the various cases considered within it) should be proportionate and commensurate to the seriousness of the conduct detrimental to the value to be protected.

These observations find timely confirmation in a very recent pronouncement made by the Tribunal of Messina about what is known as illegal intra-familial conduct.[69] This makes quite clear the Tribunal's intention to exercise a deterrent function, by means of 'afflictive' measures *ex* Art. 709 *ter* c.p.c., which would dissuade the defaulting parent from continuing in seriously obstructive or retaliatory behavior likely to psychologically damage the minor. Therefore, based on the need to guarantee an equal exercise of parental authority and balanced fulfillment of parental educational responsibilities, even though in the field of a heated and conflicted relationship with the spouse, this punitive instrument can be employed in an effectively intimidatory fashion to induce the mother to stop obstinately obstructing the father's parental role.[70]

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[66] "*[I]n setting the level of compensation it is necessary first to consider the seriousness of the defaulting parent's conduct, taking into account also the fact that the remedies set out in Art. 709 ter c.p.c. have essentially punitive objectives, and there is no requirement for a specific proof of the existence of injury, which can be considered a natural consequence of the unacceptable behavior of one of the parents.*" Trib. Messina 8 October 2012, in: Danno e resp., 2013, 409 (with a note by P Pardolesi (2013)).

[67] La Rosa (2008), 72.

[68] For an introduction to how the payment of compensation can enhance the function of both punishment and sanction ex Art. 709 ter c.p.c. see D'Angelo (2006), 1048; Casaburi (2006), 565; Graziosi (2006), 1884; Salvaneschi (2006), 152; De Marzo (2006), 90. However, it should be noted that alongside this interpretive option it is also possible to identify two different approaches: I) the first emphasizes the pre-eminence of an approach based on compensation (on this point see Greco (2006), 1199)) the second on the other hand, adopting an intermediate position, not only recognizes the restorative function of compensation but at the same time does not deny its purpose as sanction [see Trib. Reggio Emilia 5 November 2007 no. 1435, in: Fam. pers. succ., 2008, 74].

[69] Trib. Messina 8 October 2012 cit., 409.

[70] Trib. Messina 8 October 2012 cit., 409.

The Pecuniary Reparation ex Art. 12 of the 'Press Law'

Another remedial tool to which we should turn our attention is pecuniary reparation as provided by Art. 12 of the 'press law', which states: "in the case of libel by press, the injured person can demand, in addition to damages in accordance with Art. 185 Codice penale (c.p.), a sum by way of restitution. The sum is determined in relation to the seriousness of the offense and the dissemination of the libelous printed matter". In other words, given the possibility of submitting to judicial scrutiny under the criminal code, the injured person can ask not only for compensation for financial losses (*ex* Art. 2043 c.c.) and moral injury (*ex* Art. 2059 c.c.), but also for so-called pecuniary damages.

Besides the problematic nature of its status in the civil law (as opposed to the penal code), we should identify its effective scope in functional terms (in other words, whether it can also have the punitive/deterrent character of disgorgement damages).

From this perspective, it is worth pointing out the presence of a vigorous confrontation between courts and scholarly literature. While the first academic opinions stated that pecuniary damages constituted a sort of duplication of criminal moral injury,[71] there has been a subsequent change in direction. In fact, some authors – relying upon the preparatory work for, and the literal wording of, the provision in question[72] – have identified in the monetary redress a punitive/deterrent function aimed at 'draining away' the economic advantage realized by means of willful injury to the reputation of another, and discouraging behavior of this type.[73] In the light of these observations, the reference made by our legislature – as far as the severity of appropriate sanctions is concerned – to the "seriousness of the offense" and to the "dissemination of the libelous printed matter" legitimates a level of reparation significantly greater than the injury suffered by the victim. This interpretation found timely jurisprudential endorsement.[74] After an initial disbanding, the Supreme Court stated that "Art. 12 of the law cited does not confuse restoration with compensation for damages, whether monetary or non-monetary [. . .], but defines and configures it differently from compensation, as can be clearly understood from the text of the regulation".[75] It then added, in two subsequent judgments, that pecuniary reparation can be asked for in a civil suit even when "the injured party intends, without filing charge, to take the matter directly to court (provided that the constitutive elements of the libel have been substantiated in the

[71] See Janniti-Piromallo (1957), 121.

[72] On this profile see Baratella (2001), 287 et seq.

[73] On this point see Zeno Zencovich (1983), 40.

[74] Cass. 10 June 2005, no. 12299, in: Foro it., Rep. 2005, item Responsabilità civile, no. 225; Cass. 7 November 2000, no. 14485, in: Giur. it., 2001, 1360; Cass. 3 October 1997, no. 9672, in: Giur. it., 1998, 2276; Trib. Roma, 31 October 2002, in: Giust. Civ., 2003, 1936.

[75] Cass. 29 January 1965, no. 2300, in: Giur. it., 1966, I, 726.

case)";[76] and, again, that the 'private penalty' (the amount of which is "determined in relation to the seriousness of the offense and to the dissemination of the libelous printed matter") can also be sought from the publisher of the newspaper, "given that damages are due not only from the writer of the libelous matter but from anyone who has contributed to causing the action constituting the crime, whether by committing it, or by having failed to stop it, being legally required to do so".[77]

The Compensation for Environmental Damage ex Art. 18 of the Act of 8 July 1986 No. 34

In this survey, it is worth referring to the compensation for environmental damage *ex* Art. 18 of the Act of 8 July 1986 no. 349, which – before very recent legislative events[78] – testified to the uncertainties and difficulties which our legislator has to address whenever it is called upon to introduce measures of a definitely punitive/inhibitory nature. In fact, before it came into force, Art. 18 of Act 349/1986 was seen as a regulatory measure extending beyond the logic of mere compensation for injury in order to guarantee a real opportunity for punitive sanctions with the objective of discouraging such actions.[79] This trajectory found convincing confirmation precisely from the criteria laid down by the legislator to provide for the quantification of damages: where it is not possible to proceed to a precise quantification of the environmental damage, the judge would determine the amount in an equitable manner, taking into account not only the expenditure necessary for rehabilitation, but above all the "seriousness of the offense" and the "profit obtained by the perpetrator".[80] In this way, beyond the affinity with punitive damages assessed on the criterion of serious negligence (which, making a pair with the concepts of malice and gross negligence at common law, set itself up as a subjective paradigm for establishing the *an* and the *quantum* of compensation/punishment due

[76] See Cass. pen. 11 April 1986, in: Foro it., Rep. 1987, item Stampa ed editoria, no. 85, and in full in: Resp. Civ., 1987, 85.

[77] Cass. pen. 15 March 2002, in: Foro it., Rep. 2002, item Ingiuria, no. 68. In this sense see App. Milano 16 April 2004, id., Rep. 2004, item Stampa ed editoria, no. 11.

[78] See d. lgs. 3 April 2006 no. 152 [known as the Environmental Law (Codice dell'Ambiente)] setting out the "*regulations for compensatory protection against environmental damage*", which implemented the legge delega no. 308/2004 on the environment as well as the directive 2004/35/EC of the European parliament and Council of 21 April 2004, on environmental responsibility in relation to the prevention and reparation of environmental damage.

[79] See Gallo (1996). In this sense see Busnelli (1988), 667. For an opposite point of view see Patti (1995), 335.

[80] This is the text of the Clause Six of Art. 18 of Act 349/1986: "*the judge, when a precise assessment of the damage is not possible, shall determine the sum equitably, having regard to the seriousness of the individual culpability, to the necessary cost of reparation, and to the profit obtained by the law-breaker as a result of his environmentally destructive behavior.*"

from the perpetrator), the affinity with disgorgement damages was made clear by reference to the profit obtained by the perpetrator of the illicit conduct.

Nevertheless, with the passing into law of the d.lgs. of 3 April 2006 no. 152 (known as the Environmental Code) the situation has been radically reversed. Ignoring the difficulties inherent in the transformation "[of the] special case of environmental damage contained in the now abrogated Art. 18 into a real hotch-potch of definitions, concepts and principles often absolutely antithetical one to another",[81] it is necessary to point out how, back-tracking drastically, the legislator has ended up with closing off any glimmer of hope for a workable system of punitive sanctions furthering the aim of discouraging illicit conduct. Not by chance, in the new Art. 311, relating to compensation for environmental damage, the reference to the criteria of gross negligence and to the profit obtained by the perpetrator (with the objective of accurate quantification of the environmental damage) has disappeared; there remains only the criterion of the cost of "rehabilitation to the pristine situation and, in the absence of such rehabilitation, of compensation at an equivalent financial level in favour of the State".[82] In other words, the legislator – opting for a more traditional solution – has eliminated in a single stroke the punitive/inhibitory approach that for years had characterized compensation for environmental damage. In short, environmental offenses – losing the 'typicality' provided by Act 349/1986[83] – were patterned on the model of tort (see Art. 2043 c.c.): thus "environmental damage also becomes an 'atypical' offense, which could thus have to do with any behavior whatever, whether intentional/malicious or unintentional/negligent".[84]

[81] The innovations introduced by the d.lgs. 152/2006 do not convince Prati (2006), 1049.

[82] This is the text of Art. 311 contained in Section III of Part Six of the d.lgs. 152/2006: "*1) The Minister for the Environment and the Protection of the Territory [Ministro dell'ambiente e della tutela del territorio] acts, even taking civil action in the penal justice system, in the interests of the restoration of the actual environmental damage and, if necessary, by a pecuniary equivalent, or else proceeds in accordance with the provisions of Part Six of the present decree. 2) Whoever, by committing an illegal act, or by neglecting to carry out an obligatory activity or behavior, constituting a violation of a law, of a regulation, or of a technical rule, causes damage to the environment, altering it, despoiling it or destroying it in whole or in part, is required to restore it to its preceding condition and, if this is not possible, to provide compensation in terms of a pecuniary equivalent in favor of the State. 3) For the assessment of the damage, the Minister for the Environment will apply the criteria enunciated in Attachments 3 and 4 of Part Six of the present decree. For the assessment of the responsibility for compensation and for the collection of the sums due as pecuniary equivalent the Minister for the Environment follows the procedures as set out in Section III of Part Six of the present decree*."

[83] On this point see Feola (1996), 1078.

[84] For an analysis of these aspects, see, once again, Prati (2006), 1052 et seq.

The Damages for Monetary Devaluation ex Art. 1224, Paragraph 2, c.c.

To conclude this survey of legal instruments akin to disgorgement damages which have actually been applied in practice, it is worth analyzing a recent decision of the Supreme Court (sitting in joint session, its most authoritative mode) which among other matters – though it had been called upon to make a pronouncement not specifically on the level of reparatory damages but on the burden of proof required to claim such reparation – rationalized in a radical manner the criteria applicable in determining further damage caused by currency devaluation *ex* Art. 1224, second clause, c.c.[85] Overturning two famous pronouncements from the past,[86] the joint session chose to rewrite the entire discipline in relation to breach of pecuniary debt, thus causing the collapse of the regime which – not without some difficulty[87] – had held sway for a quarter of a century.

More specifically, starting with the statement that the operational orientations developed in the wake of the two above pronouncements do not appear to be aligned with the original intention,[88] the Joint Session updated the framework of the relevant data. It is true, in fact, that starting from the doubling of the official interest rate in 1990, and the later introduction of a flexible rate-setting methodology, starting from 1 January 1997, its level has always been higher than the increase of the cost-of-living index (with the exception of 2000 and what is likely for the current year). But it is just as evident that the gross return on the most common forms of investment – exemplified by the median gross return on Treasury bonds with terms under 12 months – has always been constantly higher than the official interest rate (with the sole exception of 1994). Thus there is always the concrete danger that, for the debtor, it is profitable to choose to defer meeting his obligations as long as possible.[89] To counteract this perverse incentive, the Joint Session rediscovered the deterrent value of contractual responsibility: the unsatisfied creditor is entitled to receive a larger sum, corresponding at least to the minimum economic profit that the debtor obtained or could have obtained from retaining the money that he should have paid

[85]Cass., sez. un., 16 July 2008, no. 19499, in: Foro it., 2008, I, 2786 (with a note by R. Pardolesi (2008)).

[86]I refer to Cass., sez. un., 4 July 1979, no. 3776, in: Foro it., 1979, I, 2622 (with a note by R Pardolesi (1979)) and to Cass., sez. un., 5 April 1986, no. 2368, in: Foro it., 1986, I, 1265 (with a note by R. Pardolesi (1986)) in which the Italian Supreme Court – seeking, on the one hand, to put an end to a heated argument and, on the other, to reduce the evident embarrassment of the relevant area of jurisprudence about an approach which, characterized by a rigorous attitude to the evidence to be provided by the disappointed creditor, ended by removing from consideration the damage caused by devaluation – dictated the conditions for consideration of "further damage" according to paragraph 2 of Art. 1224 c.c., due to the debased purchasing power of the currency.

[87]For an incisive analysis of this matter, see, once again, R. Pardolesi (2008), 2789 et seq.

[88]For an in-depth examination of these aspects see R. Pardolesi (2008), 2789.

[89]On this point see R. Pardolesi (1979), 2624 et seq.

and has not paid. This is a minimum which, on the basis of the updated text of Art. 1284 c.c., is in fact related to annual net earnings (after tax) of Treasury bonds (a parameter that the Minister of the Treasury must utilize, bearing in mind meanwhile the rate of inflation, to determine the legal rate). Provided that the rate of inflation is not higher, as has happened only in 1994, in which case it is necessary to take the latter parameter into account. In short – overturning the traditional approach in which compensation for contractual default had the effect of placing the creditor in the same 'indifference curve' in which he/she would have found himself/herself if the obligation had been respected in a timely fashion – the Joint Session, in a belated intervention calling for the application of equitable evaluation *ex* Art. 1226 c.c., suggested instead the adoption, as a term of reference for compensation, the profit that the perpetrator of the illicit action obtained (or should have obtained in minimally normal circumstance) by the choice to delay fulfillment of his contractual obligation and retain the sum owed for himself.

The impact of such a decision is very evident: disgorgement damages (or, more accurately, the remedial instrument of restitution of the illicit profits) in contractual matters are no longer a mirage; on the contrary, the idea that the range of remedies available in this context could be extended, following the suggestions coming from the experience of common law, to include the restitution of the illicit profits, receives the unhesitating approval of the highest judicial body in Italy.

Final Remarks

The analysis of the Italian legal experience leads to a necessary conclusion: the problematics inherent in quantifying damages do not lend themselves to being crystallized into a simplistic regulatory directive. Even while recognizing the synecdochical tendency typical of the civilian approach to regulation, one should not ignore its inappropriateness to the issue of confronting the range of situations in which reference to the notions of actual loss and loss of profit does not [succeed in itself to] assure the victim of the illicit conduct (whether in a contractual or an extra-contractual context) effective compensation for the damage suffered. Therefore, if we remain anchored to the traditional regulatory approach according to which the perpetrator of the illicit action is required to compensate the victim within the limits of the damage suffered, we must resign ourselves to being mired in desperate situations in which 'the damage exists, but cannot be seen'.[90]

[90]In this type of controversy, the prize probably goes to the celebrated Meroni case (Cass. 26 January 1971 no. 174, Foro it., 1971, I, 342; 29 May 1978 no. 1459, id., 1979, I, 827), which relates to the issue of extra-contractual liability, but is symptomatic of a more general concern. This painful affair had a double outcome: on the one hand (in the perspective whether there existed liability), it affirmed and consolidated the possibility of bringing the protection of credit as one of the interests safeguarded by Art. 2043 c.c., while, as far as the quantum was concerned, the result was a total failure. The Supreme Court did not succeed in establishing any type of compensation:

Thus, comparison with the experience of the common law is very valuable. In fact, the theme of compensation for breach of contract belongs in a legal context in continual evolution, aimed at assuring for victims of breach of contract the best form of compensation in relation to the specific characteristics of each kind of situation. The inclusion of disgorgement interest in the ambit of contract law (making it an issue worthy of legal protection) attests, once again, to a propensity to confront without fear the difficulties inherent in the delicate matter of quantifying damages.[91]

Naturally, the effectiveness of the common law experience in widening the range of techniques for evaluating the loss amount, betrays the 'straight jacket' effect of regulatory indicators entrenched in the principle of compensation (as in Art. 1223 c.c. or Art. 2043 c.c.). From this perspective, one very important move would be to decisively overcome these regulatory restrictions (for example, in the context of the law of contract, making use of the opportunity for compensation which would result from a more dynamic use of the concept of lost opportunity). In fact there is clearly a need to (re)define what is meant by compensation or, better still, what functional outcomes it should aim for: with the result of directing attention towards logical approaches (in part already known from the formative theoretical and jurisprudential sources of the law) on the basis of which the courts could apply techniques for calculating liquidated damages with subtle variations according to the specific nature of each case. Therefore, looking at the more elastic model provided by the common law, we can get closer to the possibility of overcoming the traditional (but no longer acceptable) limits of an exclusively compensatory approach, which the Italian legal system itself now puts at issue when it appears to opt resolutely for a move towards punishment and sanctions.[92]

The door is open, but most of the work is still to be done.

in the first place, because – compared with the year in which Meroni played – subscriptions had increased, and, secondly, since the Torino football club, replacing a famous (and expensive) player such as Meroni with the more modest Facchin, saved money by the engagement, and thus ended up with an economic advantage.

[91]For an in-depth examination of these issues two theoretical models deserve attention – at least as far as the response they have elicited is concerned: those set up, on the one hand, by Kull, around the appropriation and extension of the concept of restitution (Kull (2008)), and on the other, by Eisenberg, on a broad interpretation of section 344 of Restatement Second of Contracts (Eisenberg (2006), 599). It would also be useful to highlight the acceptance at a more specifically pragmatic level of the instrument of disgorgement damages as a remedy for breach of contract. In fact, section 39 emerges in the interstices of the Restatement [Third] of Restitution and Unjust Enrichment (American Law Institute (2011)); the section expressly provides for the 'bold remedy' of disgorgement damages to address the possibility of "*profit derived from opportunistic breach*".

[92]Think of the predictability of the injury and its irrelevance in the event that the breach is found to be criminal.

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