[IT] Anti-Piracy Measures Outweigh Private Copying

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Valentina Moscon
Max Planck Institute for Intellectual Property and Competition Law. Trento Law and Technology Research Group, University of Trento

The *Tribunale di Milano* (Court of Milan) issued a decision concerning the conflict between the private copying exception and technical protection measures (TPM).

The case involved a user who wanted to make a copy of a DVD, but was not able to do so because of technological protection measures. This is the first case decided by an Italian court on the relationship between TPM and the private copying exception under EU Directive 2001/29 (the Copyright Directive). The issue, much debated in the doctrine, is the following: “can copyright limitations be overridden by contractual agreements and relative TPM under European law?” In other words, should the private copying exception be preserved, as this exception is often ’put out of order’ by technical measures?

The Italian Copyright Statute, Law No 633 of 22 April 1941, (Article 71 sexies, paragraph 4), in implementation of the European Copyright Directive, lays down the requirement that the rightsholder permit, despite the application of TPM, the user who has lawfully acquired possession of a work to make a private copy of that work. According to the so-called ‘three-step test’ (Article 5.5 EU Copyright Directive and Article 71 sexies, paragraph 4 Italian Copyright Statute) however, a certain number of restrictive criteria apply. The limitation must not conflict with the normal exploitation of the work and not constitute an unreasonable prejudice to the legitimate interests of the rightsholder. The exact scope of this legal instrument still remains, on the whole, very uncertain. The first step, according to which the use should not conflict with the normal exploitation of the work, is problematic. The concept of ‘normal exploitation’ is very imprecise. Neither the Directive nor the national legislators, who have transposed the test into national law, provide a definition. The test is addressed to the judge, who seems be required to examine whether the application of a limitation to a specific case respects the conditions it imposes. As a result, the private copying exception faces possible nullification by judges.

In the present case, the plaintiff (user) had lawfully purchased a DVD (Pink Floyd Live at Pompei) produced in 2004 by Universal Pictures Italia s.r.l. He could not create a private copy due to the presence of TPM measures. He thus took Universal Pictures Italia s.r.l. to court, claiming violation of the Copyright Statute (Article 71 sexies, paragraph 4). Universal Pictures defended themselves saying

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that the rightsholder has a right to affix TPM to works placed in the market (Article 102 quater Italian Copyright Statute). The right to private copying, on the contrary, is only an exception, while in 2004 (when the work was distributed) TPM that enabled users to make a single copy for private purposes did not exist.

The court ruled in favour of the defendant, reasoning that private copying is "only" an exception to the exclusive right of reproduction, which is one of the most significant and economically important manifestations of the economic rights over protected works. Accordingly, the reproduction right and the right to private copying are not on par with each other. In the instant case, the court found no prevailing assumptions and conditions for the exercise of the concrete right to private copying. Universal had shown that, at the time the DVD was purchased, there were no protective systems in existence which technically could allow for private copying. This meant that the only options available were either the total suppression of copying or the opposite solution of not applying any security measures at all and allowing the production of an infinite number of identical copies. Essentially, the court stated that, given the state of the technology, application of TPMs that prevented copying (even for personal use) did not infringe the 'right' of private copying. In the court's opinion, the conditions laid down in Article 71 sexies, paragraph 4, reproduce the content of Article 5 of Directive 2001/29/EC, i.e., the 'three step test', which is intended to verify eligibility for a copyright exception. On the basis of the above, the court found that the possibility of copying the work should be examined in contrast to "the normal exploitation of the work" and that, in the present case, it would have constituted an unreasonable prejudice to the legitimate interests of the rightsholders.

The 1 July 2009 decision of the Milan court applied Article 5.5 of the Directive (transposed into the Italian Copyright Statute) in order to overcome the application of an exception in favour of a technical protection measure, arguing abstractly and generally that the private copying of a DVD conflicts with the normal exploitation of the work, without providing a definition of this term at any time. The same solution was adopted in 2008 by the French Court of Cassation (see IRIS 2008-9: 9, IRIS 2007-5: 8 and IRIS 2006-4: 12).

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http://www.ilsole24ore.com/fc?cmd=document&file=/art/SoleOnLine4/Norme%20e%20Tributi/2009/09/sent-8787-09-trib-milano.pdf?cmd=art

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