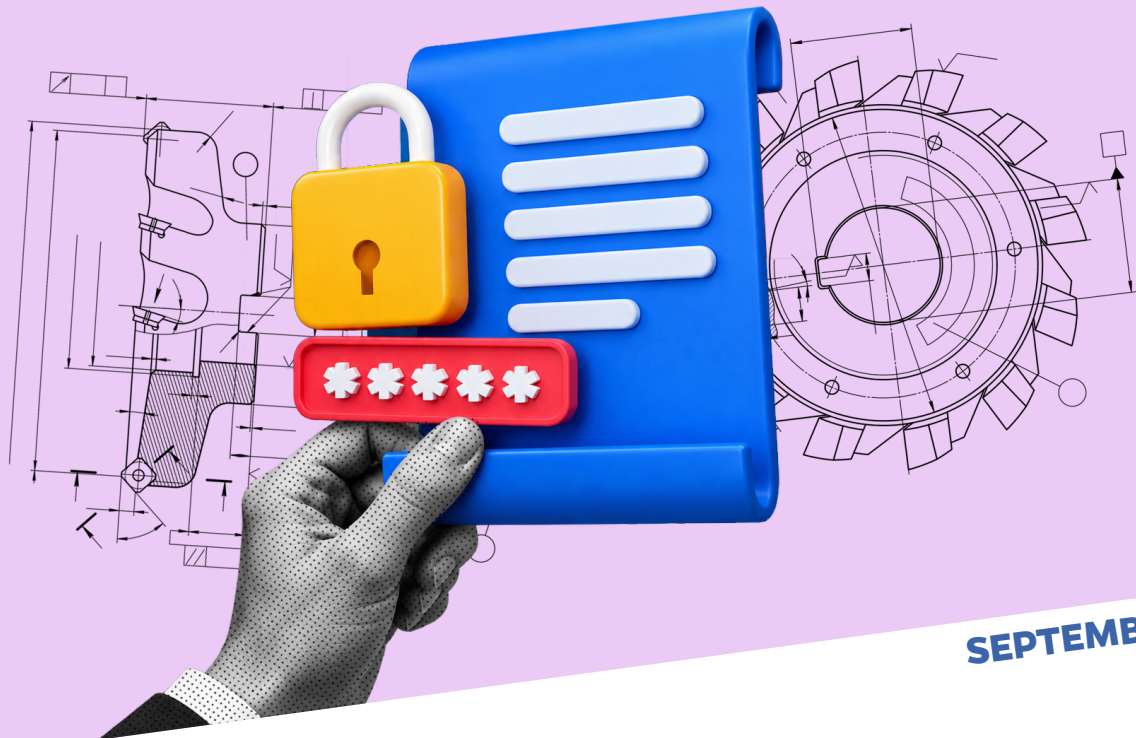


The **I**NTERPATENT newsletter



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TRADE SECRETS: A RECAP ABOUT THE LEGAL PROTECTION OF A STRATEGIC ASSET*

In an economy increasingly based on knowledge, a significant part of a company's value is not necessarily embodied in a patent, a trade mark or another registered intellectual property right. Technologies, production processes, algorithms, formulas, data, commercial information, market strategies and organisational knowledge can represent an equally significant asset, even though they are not intended for disclosure. It is within this context that the protection of **trade secrets** comes into play.

[Directive \(EU\) 2016/943](#) provides a broad definition of trade secrets that encompasses information of a technological, commercial and organisational nature.

Unlike patents and trade marks, **the protection of trade secrets does not arise from registration**, but from the holder's ability to keep the information confidential. There is therefore no register of trade secrets: protection remains in force for as long as the requirements are met.

The 3 Core Requirements for Information to Constitute a Trade Secret

When it comes to protecting a company's most

valuable assets, not just any information qualifies as a trade secret. To hold weight under the law, it has to meet three cumulative requirements:

- 1. Absolute Secrecy:** The information must be **neither generally known nor easily accessible** to people who normally deal with that kind of data. Interestingly, even if individual pieces of information are public knowledge, a unique combination or configuration of them can still be protected if the overall setup remains strictly confidential.
- 2. Commercial Value: The secrecy itself must drive economic value.** This could be anything from a proprietary technology, a chemical formula, or an industrial process, to an algorithm, a database, a client list, a business plan, or a sharp commercial strategy.
- 3. Reasonable Steps to Protect It:** This carries massive practical implications. You can't just call something a secret; you have to prove you actually treated it like one by taking reasonable steps, appropriate to the circumstances, to safeguard it.

Confidentiality + Reasonable Measures

It is a mistake to regard confidentiality as a purely contractual matter, to be resolved by including a confidentiality clause in an employment contract or a commercial agreement. Confidentiality must be regarded as a **business process**.

Information does not become a trade secret simply because the company designates it as 'confidential': it must be possible to demonstrate that appropriate measures have actually been taken to protect it.

The reasonableness of the measures depends on the nature and value of the information, the structure of the company, the individuals who have access to it, and the ways in which it is stored and shared. Factors such as the classification of information, access restrictions, internal procedures, confidentiality agreements, contractual clauses, IT security systems and physical security measures may all be relevant.

It is not necessary to create an absolute security system. However, it is necessary to be able to demonstrate that the company genuinely **regards the information as confidential and recognises its value**.

This exact requirement is what sets trade secrets apart from other major intellectual property tools:

- **Trade Secrets:** Preserve economic value precisely through *non-disclosure*.
- **Patents:** Grant an exclusive monopoly for a limited time in exchange for public disclosure of the invention.
- **Copyrights:** Protect the expressive form of a creative work.
- **Trade marks:** Safeguard distinctive signs and branding.

The Power of a Hybrid IP Strategy

Despite these differences, these tools can easily coexist within the same IP strategy. A company might choose to patent certain core aspects of a technology while keeping other elements—such as specific manufacturing methods or optimization parameters—strictly confidential as trade secrets.

The right choice always requires a case-by-case evaluation, especially keeping in mind that filing for a patent means your secret is ultimately laid bare for the world to see.

Trade Secrets vs. Know-How

A trade secret is closely linked to—yet not necessarily the exact same thing as—**know-how**.

Know-how encompasses the technical, operational, and organisational expertise required to develop, manufacture, or market a product or service. When that expertise meets the criteria of secrecy, commercial value, and reasonable protection measures, it crosses the line into the legal definition of a trade secret.

For any business, this shifts the mindset. The question shouldn't just be, "**What patents do we own?**" but rather, "**What do we know that our competitors don't?**".

Who Controls the Information?

Another critical puzzle piece revolves around **ownership and access**.

Employees, executives, consultants, collaborators, developers, suppliers, and business partners may all touch pieces of a company's informational assets. However, granting access should never automatically equal giving away control.

The Power of the "Need-to-Know" Principle

It is vital to distinguish between who **needs** to know a piece of information and who simply **has access** to it.

The **need-to-know principle** lies at the heart of this strategy: restricting and carefully controlling the flow of information also means reducing the risk of losing your secrecy.

Protecting Secrets Without Choking Talent

Special care must be taken when managing employment relationships. Safeguarding trade secrets can never become a blanket restriction on professional mobility.

Under European regulations, companies cannot block workers from using information that fails to qualify as a trade secret, nor can they restrict the general experience and skills honestly acquired

during the normal course of their employment.

Trade Secrets as a Business Process

From this perspective, one essential principle emerges: **protecting a trade secret is not simply a matter of signing an NDA.**

An NDA is an important tool, but it is only one component of a broader protection framework. Effective protection requires companies to identify their strategic information, determine who should have access to it, define how it may be used, control how it is shared and circulated, and document the measures put in place.

Trade secret management should therefore become an integral part of the company's ordinary processes for **IP management, HR, procurement, cybersecurity, compliance, and the management of relationships with customers and business partners.**

The New Caveat: AI and the Circulation of Information

This approach has become even more relevant in today's technological environment. Artificial intelligence is increasing the amount of information that can be collected, processed, and transferred, while also introducing new risks to

confidentiality. Proprietary data, technical documentation, source code, models, datasets, and internal processes can enter AI systems through seemingly routine activities, such as employees' use of generative AI tools.

The [EU AI Act](#) also recognizes the need to safeguard confidential business information and trade secrets.

For businesses, therefore, the question can no longer be limited to **where information is stored**. It must also encompass **who is authorized to use it, which tools they may use, and which systems the information may be transferred to.**

Ultimately, a trade secret is not simply information that a company chooses not to disclose. It is **a strategic asset whose value depends on the company's ability to govern how that information is accessed, used, and circulated.**

Legal protection is the end point of this process. Its effectiveness depends, first and foremost, on the organization's ability to know what needs to be protected-and to demonstrate that it has actually taken the necessary steps to protect it.

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INTERNATIONAL TRADE MARKS DESIGNATING ITALY: JURISDICTION, STANDING AND GENUINE USE



On **14 September 2026**, the IP Specialized Court of Rome issued judgment No. 12804, which we consider of particular interest for foreign trade mark owners and IP counsels managing international registrations designating Italy.

The decision addresses an action for revocation for non-use concerning the Italian designation of an international trade mark and provides useful clarifications on **three practical aspects**: the jurisdiction of Italian courts, the standing required to bring a non-use action, and the evidence that a trade mark proprietor must provide to demonstrate genuine use in Italy.

The Case: A Non-Use Revocation Action Brought by a Competitor

The dispute arose from an action brought by an

Italian company operating in the personal care, hygiene and cosmetics sector against a Bulgarian company active in the same field.

The claimant, which owned trade marks used for hair-care products, asked the Rome IP specialized Court to establish the non-use in Italy of **International Trade Mark No. 680733**, registered in 1997 in Classes 3, 5 and 21 and designating, among other countries, Italy.

The action was based on **Article 24 of the Italian Industrial Property Code (IPC)**, under which a trade mark is subject to revocation where, within the relevant **five-year period**, it has not been put to **genuine use** by its proprietor or with its consent for the goods or services for which it is registered, or where such use has been suspended for an uninterrupted period of five years, unless there is a legitimate reason for non-use.

The claimant stated that it had carried out specific market research which, according to its findings, indicated an absence of genuine use of the trade mark in Italy for a significant period.

Jurisdiction: Italy, not the EUIPO

The first issue addressed by the Court was jurisdiction.

The proprietor of the international registration argued that the dispute should fall within the jurisdiction of the **EUIPO** or, alternatively, the courts of the proprietor's home country.

The Court rejected both arguments.

The dispute concerned an international trade mark designating Italy, rather than an EU trade mark. The **EUIPO therefore had no jurisdiction**. Under the Madrid System, an international registration produces, in each designated country, effects corresponding to those of a national trade mark. Accordingly, a dispute concerning the protection of the Italian designation falls within the jurisdiction of the **Italian courts**.

In this case, since the defendant was a foreign company, jurisdiction was attributed to the **Specialized IP Court of Rome**, pursuant to the Italian rules governing intellectual property disputes involving foreign defendants.

This is an important point for international trade mark owners and foreign counsels: **a judicial**

action for revocation for non-use concerning the Italian designation of an international registration is dealt with in Italy, rather than by the EUIPO or by the courts of the proprietor's home country.

It should also be noted that, while in that case the non-use revocation action was started before the Court, since **29 December 2022**, revocation for non-use may alternatively be sought through an administrative proceeding before the **Italian Patent and Trade mark Office (UIBM)**. The administrative route therefore now exists alongside the judicial route.

Who May Bring a Non-Use Action?

The judgment is also noteworthy for its clarification of **standing to bring an action for revocation for non-use**.

The defendant challenged the claimant's standing and interest in bringing the proceedings. The Court rejected this objection, relying on **Article 122 IPC**, which grants standing to bring an action for revocation to anyone **having a relevant interest**.

According to the Court, such an interest may exist where the claimant operates **in competition with the trade mark proprietor in the same economic sector**, and the continued existence of the challenged trade mark may represent a concrete obstacle to the claimant's business activities.

Importantly, the claimant does **not** have to demonstrate that one of its existing rights has already been infringed by the challenged trade mark. It is sufficient that the third-party trade mark right constitutes a **concrete interference with the claimant's economic activity**.

The decision therefore confirms that the interest required to bring a non-use action is not necessarily linked to an existing infringement. A competitor may have standing where the continued existence of the trade mark itself creates a concrete impediment to its business activities.

This is a relevant point for trade mark owners and foreign counsels alike, as it means that an unused registration may become vulnerable to challenge even where no infringement action could otherwise be brought by the party seeking its revocation.

Genuine Use Must Be Proved in Italy

The substantive issue concerned the alleged non-use of the trade mark in Italy.

The Court reaffirmed that **genuine use must be real and effective, rather than merely symbolic or occasional**, and must demonstrate an actual presence on the relevant market and fulfil the trade mark's function as an indication of commercial origin.

Importantly, the **burden of proof lies with the trade mark proprietor**. Once non-use is put in issue, the proprietor must demonstrate genuine use in Italy for the relevant goods or services and during the relevant five-year period.

The evidence must therefore establish, in a sufficiently clear manner:

- **when** the trade mark was used;
- **where** it was used;
- **for which goods or services**; and
- whether the use was sufficiently significant to demonstrate a genuine presence on the relevant market.

Limited or Undated Evidence May Not Be Sufficient

The evidence submitted in the proceedings illustrates the Court's approach.

Documents concerning sales, distribution agreements and participation in trade fairs in **2008 and 2014** could not establish use during the relevant five-year period. Similarly, screenshots showing the products being offered online were considered insufficient because they were not dated and therefore could not establish when the relevant commercial activity had taken place.

The Court also disregarded evidence relating to use after the commencement of the proceedings.

The remaining evidence consisted principally of a limited number of invoices and delivery documents concerning sales in Italy between **May 2017 and May 2022**, with an aggregate value of approximately **EUR 2,500 over the entire five-year period**.

In the circumstances of the case, the Court found this evidence insufficient to establish genuine

use. The assessment was not based solely on the value of the sales, but on the **overall circumstances**, including the limited number of transactions and the absence of evidence of advertising or promotional investment supporting the mark's presence on the Italian market.

The Court therefore declared the **Italian portion of the international trade mark revoked for non-use** in respect of the relevant goods.

Practical Implications for International Trade Mark Portfolios

The decision provides several practical reminders for foreign trade mark owners and IP counsels managing Madrid System portfolios.

For judicial proceedings, disputes concerning the Italian designation of an international trade mark registration fall within the Italian judicial system. Since December 2022, the administrative route before **the UIBM** has also been available as an alternative.

Second, the need to **maintain and document genuine use in Italy**. Where non-use is challenged, the proprietor bears the burden of proving use during the relevant period.

For international portfolios, it is therefore important to preserve evidence that clearly connects the trade mark with:

The Italian Market + the Relevant Period + the Relevant Goods or Services.

Finally, the judgment highlights the importance of considering the potential exposure of unused registrations to challenges brought by **competitors with a concrete economic interest**, even where no existing right has been infringed.

For foreign counsels and international brand owners, these considerations may be particularly relevant when reviewing Madrid System portfolios designating Italy, both in assessing the scope of protection and in ensuring that adequate evidence is available to support continued protection.

INTERPATENT assists international trade mark owners and foreign IP counsels with the protection, enforcement and management of trade mark portfolios in Italy (and Europe), including Madrid System designations and proceedings concerning revocation for non-use.

UNITED ARAB EMIRATES: CLASS 33 NOW AVAILABLE FOR TRADE MARK REGISTRATION



The UAE Trade mark Office has opened Class 33 to trade mark applications covering alcoholic beverages, marking an important change for international beverage and hospitality brands.

Until now, Class 33 was not available for trade mark registration in the UAE, and brand owners often had to rely on alternative filing strategies, including protection in Class 32. The new practice allows trade mark owners to seek **direct protection for alcoholic beverages in Class 33**, bringing UAE trade mark practice more closely in line with international classification standards.

An important point also concerns **beer**: under the Nice Classification, beer belongs to Class 32, while other alcoholic beverages fall under Class 33. The UAE is now accepting trade mark applications for beer in Class 32 as well.

The change is particularly relevant for international portfolios and calls for a review of existing UAE protection, as well as appropriate monitoring of new filings in Class 33. Existing Class 32 registrations may continue to play an important role and should not necessarily be replaced.

The opening of Class 33 therefore represents an opportunity for brand owners to reassess their UAE trade mark strategy and strengthen protection for key alcoholic beverage brands.

We can assist our local clients directly with international trade mark filings designating the UAE, through the Madrid System. Foreign clients may also benefit from our services where the applicable requirements are met, including where the trade mark owner has a domicile or permanent establishment in Italy or the EU. Please do not hesitate to contact INTERPATENT for the management and monitoring of UAE trade mark portfolios of local and international clients.

BAHAMAS – ACCESSION TO THE PATENT COOPERATION TREATY (PCT)

On 19 August 2026, The Bahamas officially acceded to the **Patent Cooperation Treaty (PCT)**, becoming the **159th Contracting State** to the Treaty.

As a result of its accession, international patent applications filed on or after 19 August 2026 will automatically include The Bahamas among the designated States.

The Bahamas' accession further extends the geographical reach of the PCT system in the Caribbean region and provides applicants with an additional avenue for seeking patent protection in the country through this international filing system.



BAHRAIN AND THE UNITED ARAB EMIRATES – ACCESSION TO THE LOCARNO AGREEMENT

A significant procedural development is taking place in the field of **industrial property protection in the Gulf region**: the **United Arab Emirates and Bahrain have officially acceded to the Locarno Agreement**, administered by the World Intellectual Property Organization (WIPO), which establishes an international classification system for industrial designs.

In the past, the descriptions provided at the time of filing design applications before the patent and trade mark offices of these two countries frequently required adjustments to comply with local requirements. The adoption of the **standard Locarno Classification codes** is expected to reduce the risk of formal objections or refusals on classification-related grounds.

Furthermore, as the classification codes now correspond to those used across key markets, including the **United States, the European Union and Asian jurisdictions**, design filings in Bahrain and the United Arab Emirates will be more readily identifiable and searchable through WIPO's **Global Design Database**.

These accessions are therefore expected to facilitate **cross-border design filing strategies**, providing design owners with greater consistency and efficiency when seeking protection across multiple jurisdictions.



The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



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