

Protecting designs, copyrights and trademarks: The Italian versus the EU way

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Abstract

The present white paper aims to provide an overview of the existent possibilities of protecting distinctive intellectual property rights such as copyrights, industrial designs and trademarks under the Italian law, in comparison to the European Union system. Options for obtaining full cumulative protection under all the aforesaid IP rights are also analyzed.

About the author



Jan Wrede is an Attorney-at-Law and a Trademark & Design Attorney with over 15 years of practice with well-known IP law firms in Italy. Jan's area of expertise includes trademark filing and prosecution, portfolio management, anti-counterfeiting, IP contracts, labeling, unfair competition, geographical indications, domain names, and IP litigation. He has been a member of several INTA and ECTA Committees, where he currently serves as Vice-Chairman of the Geographical Indications Committee.



“ Originating 145 years ago, the Italian legal and doctrinarian system has since undergone many, often fast and radical changes. ”

Introduction

Italy is certainly well-known for its cultural heritage spanning more than two thousand years. Counting 49 UNESCO World Heritage Sites, it holds a greater number of such sites than any other country worldwide. It is therefore no wonder that today's 21st century Italy contains multiple traits attributed to the “*Bel Paese*” (The Beautiful Country), in particular those related to its pleasing cuisine and modern but timeless design. The latter, a wonderful expression of the eternal Italian creative spirit and its natural sense for beauty, has long been a subject for different types of legal protection. Dating back to 1868, the Italian legal and doctrinarian system has since undergone many, often fast and radical changes. Some of these changes are due to the fact that Italy is member of the EU.

We refer, in particular, to the respective EU Directives in rem which came into force over the last 15 years. The first and foremost point to observe here is the 180° epic conversion from the narrow old to the wider new system: before, the law basically allowed only for an alternative protection, where artistic works fell exclusively under the copyright law, industrial designs under the ornamental model law, and distinctive shapes under the trademark law.

Now, the law allows for a full **cumulative protection** under all the aforesaid intellectual property rights (provided, of course, that each of their single requirements is met in every specific case).

Although a digression into the vivid legislative past would definitely be worth a longer sojourn, the current observations will rather focus on the actual aspects of gaining exclusive rights on designs (understood as visible outward forms or patterns) in Italy and the European Union.

Designs

Italy

The starting point for the current legal situation is, as in the whole EU, the **Harmonization Directive** (Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, HD).

The **Italian IP Code** (Legislative Decree 10 February 2005 no. 30, IPC), which has incorporated the national implementation of the said Directive, establishes the known criteria of individual character, novelty, and public order as prerequisites for a registration.

Its validity is up to 25 years.

On the other hand, the Italian legislator did not opt to protect unregistered design rights, so that the only means of gaining national exclusivity on designs can be achieved through the said registration.

European Union

The **Community Design Regulation** (Council Regulation EC No. 6/2002 of 12 December 2001 on Community designs, CDR) does foresee either registered as unregistered design rights (Art. 11, 19 CDR), again following the same requirements of individual character, novelty, and public order.



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Unregistered rights “*shall be protected ... for a period of three years as from the date on which the design was first made available to the public within the Community*” (Art. 11 CDR), while registered rights may live on to the full, harmonized term of up to 25 years.

Another difference lies in the scope of protection, insofar as the unregistered CD is enforceable „*only if the contested use results from copying the protected design*” (Art. 19 II CDR), while the registered design is enforceable against any use, “*in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes*” (Art. 19 I CDR).

Within the first ten years after its introduction, around 700,000 designs have been filed with the OHIM in Alicante. Germany accounted for ca. 170,000, Italy for ca. 100,000, and France for ca. 60,000 designs alone.

Unlike trademarks, designs are subject to a rather strict **novelty requirement**. Here, the main criterion is whether the informed European “user” (who can be a creator or a consumer) of the design in question would reasonably know about a similar or identical design anywhere in the world. This shall also depend on the particular market, i.e. whether the European customers are used to observe foreign markets in all their details. For instance, published European trademarks may destroy the novelty (as confirmed in an *obiter dictum* by the ECJ in a judgment from 2012) or the individual character of a later design (Art. 25 I e CDR).

On the other hand, the law foresees a **12 month grace period**, so that the very same owner may file for a CD within a year after the first publication of his design (Art. 7 CDR), which extends protection to 26 years.

As far as costs are concerned, it is worth noting that a single CD is far below the fees one would have to spend for all 28 or even only some of the corresponding national rights together.

The Hague Agreement

Through the Hague Agreement, it is possible to register a (multiple) design in more than **100 jurisdictions**, among which are the EU and Italy.

The Agreement offers the unique advantage of providing only one single administrative point of contact, i.e. the WIPO in Geneva, for the whole procedural phase. Thus, the applicant only needs to file one application, use one language, pay one set of fees, and use one currency (CHF). Also all post-registration requirements such as recordals and renewals are dealt with through WIPO alone.

The international registration shall produce the same effects in each of the designated countries, just as national designs would do.

Copyrights

There is no EU copyright law, therefore one has to rely on the Italian national law (Law no. 633 of 22 April 1941, CL).

Copyright protection is already achieved by **creation**.





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National filing is possible and mainly serves to create a certain date, which is especially useful for unpublished works. It is hence declaratory, not constitutive.

Requirements are the creative character and the artistic value of the work of art, which can be any shape including industrial design. These represent a higher threshold than the individual character adopted for designs as such.

Validity follows the general rule and amounts to **70 years** *post mortem auctoris*.

3D & Figurative Trademarks

The approach offered by trademarks is significantly different from the previous two: here, the entry ticket does not lie in the originality of the design (at least not in an absolute sense, but only in relation to prior signs), it follows from its **distinctiveness**, i.e. its capacity to distinguish a given good or service from other similar ones.

Another corrective means aiming to avoid that trademark protection, which is virtually unlimited in time (unlike design and copyright), shall extend likewise to forms which are, in the first place, ornamental, is that the said form itself might not offer substantial value to the goods in question. In such case, trademark protection is not available and may not even be gained later through extensive use (like in the case of *secondary meaning* to overcome lack of distinctiveness). This has led Italian scholars to remark that beauty lies within the designs, while the trademarks have to arrange themselves with the beasts.

The truth may lie somewhere in the middle, insofar as a trademark may be good-looking, as long as its shape itself is not the main object of the customer's purchase desires.

Protection is available in the form of a registered national and/or Community Trade Mark.

Unlike the above-mentioned condition for the CD, which exists as an unregistered right in the EU, but not in Italy, the situation for trademarks is exactly the opposite: while the EU does not recognize **de facto rights** (we do disregard ultra-class protection of famous marks or bad faith applications here), Italy does recognize them. Therefore, use, and/or renown may lead to the creation of exclusive rights.

Unfair competition

Again, and besides some fragmentary rules (e.g. on advertising), there is no harmonized EU law on unfair competition. It is widely left to the Member States to determine the amount of commercial fairness they require according to their specific cultural and traditional notions.

Italy follows an open concept of possible applications of unfair competition rules (UCR) to IP rights, such as **confusion**, **exploitation of reputation**, **slavish imitation**, **parasite imitation**, or violating general rules of **fair trade**.

Italian scholars and case law have continuously debated the right approach for **harmonizing** designs with UCR, but have not come to a unanimous result.



Protecting shapes: the Italian versus the EU way



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Opinions sway from full protection of ornamental forms under UCR, to their complete exclusion therefrom. The former view holds that unlike patents of inventions, there is no common interest in designs falling into the public domain, while the latter view holds there is no justification to prolong the legally fixed term of 25 years any further. The middle way accepts to apply UCR if the copies are highly similar or identical notwithstanding the availability of other forms, i.e. it seeks to establish an obligation to somehow differentiate the new from the old forms. Interestingly enough, some older case law from the 80's and 90's accepted the attachment of a (different) trademark as sufficient for this purpose, therefore paving the road to “civil law disclaimers” which are otherwise not allowed in trademark law. However, it is doubtful (and rightly so) whether this doctrine would still be accepted nowadays.

| Enforcement

Any right is only as good as its possibility of being enforced. This may occur gradually: as a preventive matter by filing the aforementioned registered rights with the **Customs**, then out-of-court through **warning letters**, administratively through **oppositions** and **invalidation** actions, and last but not least by way of a court trial (**urgency** or **ordinary** proceedings). But where to start?

A **copyright** aims to protect the concrete form of art rather than the idea behind the creative work.

Thus, it normally lags behind design protection, which may expand to other

forms incorporating the same “concept”, and trademark protection, which applies the even wider criterion of similarity. Also, the higher threshold to obtain this right usually leads to its reduced importance in daily practice, at least as designs are concerned.

Designs, first of all, are not subject to any use requirement and they do not follow the specialty principle applied to trademarks. However, the informed design user - as confirmed by European case law - is more advanced than the average trademark user (meaning he is not so easily “confused”). Secondly, a designer has a certain **freedom of expression**, so that a later design is harder to invalidate or challenge than in the case of having to compare two trademarks. This is due to the fact that the design itself already represents the value of the good, so case law allows it to come closer to existing forms, since the designer may introduce just some small variations and be able to achieve an overall different result. Instead, in the trademark law, the consumer uses the mark as a remembrance of the commercial origin and attractive value of the product and has to be protected from any similar look-alikes.

Generally speaking, judges are indeed far more familiar with **trademark** enforcement than with the other types of IP rights in question, which gives this alternative a clear strategic advantage. And for famous trademarks which often exist for far more than 25 years, the design term of 25 years may even seem too short...





Conclusions

In conclusion, one may file for copyrights (national) and designs (national and/or EU) and trademarks (national and/or EU) all at the same time. Adding unfair competition rules, one and the same form may easily accumulate up to ten parallel types of IP protection. But the question remains: does quantity equal quality?

Moreover, since the five registered rights require a certain budget either once and for each renewal period, the design owner and his counsel have to think about the question of whether it is advisable or necessary to use all of the said IP rights, or if it might be more appropriate to concentrate on determined or even only one of the available different legal means in order to obtain the best possible result.

“ One may file for copyrights, designs and trademarks all at the same time. ”

In a nutshell, multi-filing should make sense:

- a) if a pattern may be applied to a large **variety of different goods** (like a cartoon character which may be found on virtually any given merchandising item), so that full trademark protection is expensive and jeopardized to become vulnerable due to the use requirement;
- b) if a 3D-trademark is at risk of being **ornamental** and thus null;
- c) if a pattern / shape is **of outstanding importance** - either economically or because law suits are likely on the rise - so that the fullest possible protection shall be afforded.

Needless to say, the multiple parameters in question do not allow for a “one size fits all” solution - this can only be found through a thorough study case by case.

