Industrial design protection: news and reassessment

A new change in the Italian regulation of the industrial design has been recently introduced by section 8, paragraph 10, of Law Decree no. 70 of May 13, 2011 ("*First urgent provisions for the economy*"), aimed at restricting the temporary protection granted to industrial design works under copyright law under section 239 of the Industrial Property Code (Legislative Decree no. 30 of February 10, 2005, as amended by Legislative Decree no. 131 of August 13, 2010, hereinafter also "c.p.i.") only to those industrial design works which became of public domain before April 19, 2001 "*further to the termination of the effects of the registration*".

Further to its conversion, however, the abovementioned provision of Law Decree no. 70/2011 has been repealed by Law no. 106 of July 12, 2011; as a consequence, the temporary protection granted to industrial design works under copyright law is still that set forth by section 239 of c.p.i., which states that "*The protection granted to design and models pursuant to section 2 no. 10) of Law no. 633 of April 22, 1941* (i.e. the Italian Copyright Law, hereinafter also "l.a.") *also includes those industrial design works which were or had become of public domain before April 19, 2001. However, those who had manufactured or marketed, in the twelve months prior to April 19, 2001, products similar to industrial design works which were in public domain at that time are not deemed liable for the copyright infringement they carried out by continuing such activity after said date, only with reference to the products they manufactured or purchased before April 19, 2001 and those they manufactured in the subsequent five years and provided that such activity was carried out within the limits – also quantitative – of the prior use*".

This is the last step of the long internal implementing process of EC Directive no. 98/71/CE concerning industrial design, whose section 17 has provided for the obligation for the Member States to introduce in their own legal system the principle of the aggregation of the protections of the industrial design as registered "designs and models" and as "author works" under copyright law, leaving nonetheless the Member States free to determine the scope, the conditions and the extent to which such copyright protection should have been conferred.

In fact, it is worth specifying that the Italian Copyright Law historically used to prohibit the aggregation of the protections of industrial design products as registered "designs and models" and as "author works" under copyright law. Namely, section 2 par. 1 no. 4) of l.a. used to limit the protection under copyright law only to those industrial design works whose artistic value could be appreciated separately from the industrial character of the product to which it was associated.

On the contrary, Legislative Decree no. 95/2001, implementing EC Directive no. 98/71/CE, has provided for the possibility to aggregate the two abovementioned protections; therefore, under the current Italian legal system, industrial design works are granted a **double protection**:

(i) as **"designs and models"** pursuant to sections 31 and following of the Industrial Property Code, provided they are "new" (i.e. they are not identical to a design or model previously made available to the public: section 32 c.p.i.) and have "individual character" (i.e. they are able to produce on the informed user an overall impression which is different from that produced by designs and models previously made available to the public: section 33 c.p.i.): in this case, they can be validly "registered" at the Italian Patent and Trademark Office (section 38 c.p.i.) and are granted protection for a period of "5 years… which can be extended up to a maximum of 25 years" (section 37 c.p.i.); and

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(ii) as "author works" pursuant to section 2 no. 10 of the Italian Copyright Law, provided that they have "creative character" (i.e. they are able to express their author's personality and individual contribution) and "artistic value" (i.e., according to a uniform line of precedents, they can be regarded as "artistic works" even if they are of daily use and they have inherent value and autonomous appreciation in the artistic works chain as may be evidenced, by way of example, by their exhibition in fairs, by their mentioning in specialized magazines, by the experts evaluations and the like): in this case, they do not need any registration and they are granted protection for all author's life and for seventy solar years after his/her death (section 25 l.a.).

In order to coordinate the consecutive introduction of the two abovementioned protections, and to protect the investments of those who, at the time of the introduction of the copyright law protection for industrial design products, had already started in good faith the manufacture and commercialization of such products relying on the fact that they were not (or not anymore) registered (and therefore protected) as designs and models, the Italian legislator has provided for several and consecutive temporary rules, the last of which has been implemented in section 239 of c.p.i., setting forth - as a "grace period" for the abovementioned third parties in good faith - the twelve months prior to April 19, 2001.

The recent Law Decree no. 70/2011 referred to above was aimed at further extending such "safe harbour", by totally excluding from the introduced copyright law protection those industrial design works which were in public domain on April 19, 2011 because they had never been registered as designs or models.

Law no. 106 of July 12, 2011 which converted in law said decree has put the temporary protection of design works under copyright law back to the limits already provided for by section 239 of c.p.i..