

ITALY - THE LAW AND HOW IT AFFECTS DESIGNERS

Italy has long been known for iconic designs and quality craftsmanship: the Arco lamp, the Fiat 500, the Vespa, Bialetti coffee pots, Alessi Kitchenware, to name just a few...

Italian courts and customs: the designer's best friend

Overseas mass-production and counterfeiting has raised the importance of design protection. Italian courts are taking an active role in allowing rights holders of registered and unregistered designs to exercise their rights and Customs are particularly active in preventing suspected counterfeit goods from entering into Italy and the EU via Italian points of entry. Whereas in the UK the debate has been focussed more on copyright than design right, in Italy, probably due to its strength in designs, the attention is focussed largely on designs.

Italy provides for the protection of registered and unregistered designs. Registration is relatively inexpensive and is highly recommended. Unregistered design right lasts for three years and protects only against mere copying of the design, whereas registered design right lasts for up to 25 years and its scope extends to any design that does not give a different general impression to the informed user while taking into account the author's degree of freedom in making the design.

The Italian secret weapon...

A very significant aspect of Italian law is that it allows the proprietor of a design application to initiate court action, seizures at fairs, or interlocutory injunctions even before registration is completed, provided that the application has been published. Moreover, seizure orders

can be granted within just a few hours. The applicant is entitled to prevent third parties from manufacturing, offering, putting on the market, importing, exporting or using a product in which the design is incorporated.

Registering designs in Italy

As in the UK, in Italy a design registration may be granted for the appearance of the whole or a part of a product resulting from lines, shape, colours and materials, provided that the appearance is new and possesses individual character in the sense that the overall impression produced on the informed user is different from the overall impression produced by any design previously made available to the public. Components of complex products are registrable only if they remain visible during their normal use. Features of appearance solely determined by a technical function cannot be registered, nor can "must fit" products where the shape is necessary in order to connect the products to one another.

The novelty requirement is of the absolute type: disclosure of the design before the filing date of the application for design registration or before the priority date is prejudicial to registration. However, disclosure of the design by the author is not considered novelty destroying if the application for registration is filed within the 12 months following such a disclosure. Moreover, the novelty requirement is met if the disclosure cannot reasonably be considered available to the specialised and interested circles within the EU.

Priority can be claimed for up to six months from the filing date of a first

design filed in any country that is a member of the Paris Convention. Multiple designs can be filed in one application, provided that all objects belong to the same class of the International Locarno classification, thereby reducing costs. On filing the application, the applicant may request that the application be made accessible to third parties only in a subsequent period which can not exceed 30 months from the filing or priority date.

The Italian Patent Office does not perform any substantive examination, and registration is granted after the formal requirements have been checked, usually about one or two years from the filing date. There is no opposition procedure. As a result, a design lacking novelty and/or individual character can only be invalidated by launching a court action before one of the specialist IP courts in Italy. Other grounds that can be raised are non-entitlement, and public policy or morality preventing the validity of the registration.

Italy: something to consider

Italy is not always known as being a country that sticks to its rules when it comes to politics, but good design is well-respected. Accordingly, the Italian design registration and protection system has been honed to help protect rights holders. With the availability of quick seizure orders, commencing action based on just a design application, and the vigilance of Italian customs, Italy provides very viable options to designers to protect their designs and enforce their rights.

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