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## 2016 – Study Question (Designs)

Sarah MATHESON, Reporter General  
John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General  
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General  
Requirements for protection of designs

Responsible Reporter: Anne Marie VERSCHUUR

National/Regional Group	Italy
Contributors name(s)	Silvia CIARDIELLO, Emidia DI SABATINO, Giacomo GORI, Matteo MUSSI, Chaira PAPPALARDO, Fabrizio SANNA, Alessandro SPINA and Stefano VATTI
e-Mail contact	fabrizio.sanna@orsingher.com
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### I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

Pursuant to articles 2 and 31 of Italian Intellectual property code (Legislative Decree No. 131/2010, hereinafter the **IIPC**) "*the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation*" can be registered as design in Italy.

The provisions of the Community Design Regulation (hereinafter **CDR**) mentioned in the previous paragraphs of this question also apply in Italy and therefore "*the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation*" can be registered as Community design with effect in Italy.

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Registered design ("*disegno e modello registrato*" in Italian language).

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

A registered design is regarded as new if, on the date of the filing of application for registration (or the priority date), no identical design (that is a design whose features differ only in immaterial details) has been "made available to the public" (i.e. no identical design has been made available following registration, exhibition, use in trade or otherwise where these events could be reasonably become known in the normal course of business to the circles specialised in the sector concerned operating within the EU).

b) non-obviousness

c) inventive step

d) individual character

A registered design is considered to have an individual character if the overall impression it produces on an informed user (i.e. the user who knows – either because of his personal experience or his knowledge of the sector concerned – the various designs which exist in the relevant sector, possesses a certain degree of knowledge with regard to the features which those designs normally include and shows a relatively high degree of attention when he uses them) differs from the overall impression produced on that user by any design which has been "made available to the public" before the date of filing of application for registration (or before the priority date).

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

- 4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

Pursuant to article 36 of the IIPC "*the features of appearance of a product which are solely dictated by the technical function of the product itself shall not be subject matter of registration*". The same provision is set forth in article 8(1) of CDR as reported in the previous paragraphs of this question.

- 5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as

being functional? Please tick any relevant boxes and explain as applicable:

- a) whether the overall appearance is dictated solely by its technical function
- b) whether each portion of the overall appearance is dictated solely by its technical function
- c) the availability of alternative appearances that can obtain the same functional result

According to prevailing case-law, the exclusion sets forth in article 36 IIPC should be constructed narrowly. The preparatory works show that the European (and thus Italian) design law system has been established to protect also shapes from which is derived some advantage, mechanical or otherwise. Designs are thus protected without regard to any artistic consideration, and the protection encompasses aesthetic as well technical designs (Explanatory Memorandum Reg I 8.2 and II sub Art 3; EC Green Paper, 3.1.4). From this point of view the features of a design which are necessary to achieve a technical effect are still protected if some alternative shape to achieve the same effect is available (Colomer '*Opinion of the AG on C-299/99 Philips Electronics NV v Remington Consumer Products*' [2001] RPC 745). On the contrary, such features are excluded from protection when they represent the only way to achieve a particular technical effect (Court of Milan, 27 November 2012, ord., [2012] GADI 1194; Court of Turin, 15 July 2008, [2008] GADI 985).

- d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected
- e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

Articles 36 of the IIPC and 8(1) of CDR deny protection to the "*features of appearance*" of a product which are solely dictated by its technical function.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

- a) whether the overall appearance is dictated solely by its technical function
- b) the availability of alternative appearances for the portion to obtain the same functional result
- c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

This is the Italian group selection.

- d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

This is the Italian group selection.

b) any portions deemed functional will not be taken into account when assessing validity

This is the Italian group selection.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

## II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

N/A

b) the requirements for protection of a design

N/A

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

N/A

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

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### III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

In all three areas (definition or meaning of a "design", requirements for protection of a design and treatment of functionality)

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

N/A

13) If so, what should that right be called?

Registered design right.

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

See under "originality".

b) non-obviousness

c) inventive step

d) individual character

e) originality

Article 25 of TRIPs agreement currently provides that *“Members shall provide for the protection of independently created industrial designs that are new or original”*. Further harmonisation should start from TRIPs acquis. Irrespective of how they are called, two requirements should be met by a design to be protected:

(a) independent creation or novelty (as a preliminary requirement); and

(b) originality (individual character in an EU perspective) in the sense required by TRIPs (currently as a non binding provision) *“Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features”*.

It is then submitted that the main requirement for design protection should be that the relevant design is *different* from the prior arts (i.e. the impression it produces differs from the impression produced by any design which has been made available to the public before the date of filing of the application for registration or the date of priority).

However, this is not enough to build an harmonised system.

The political choice that should be made in advance is whether the height of the threshold of protection for design seeking registration be kept high or low. In fact, on the one hand, it can be suggested that a low standard of originality would help the industry to enjoy widely the protection granted by the registered design system. On the other hand, it can be argued that only a high threshold of protection would allow the system to grant a broad scope of protection to truly valuable design in order to encourage investment in this field.

If the first “political choice” is upheld, the originality test would pose a significantly higher threshold than mere near-novelty. The design seeking registration would be requested to differ significantly from prior art (also because a suitable figure would be selected to conduct the test, i.e. the test would be for instance gauged through the eyes of a “consumer”).

If the second point of view is upheld, the test of originality should ascertain that the design seeking registration is not identical to prior art/non-commonplace (and this test would be conducted through the eyes of a figure suitable to spot also small differences between the design concerned, e.g. a design expert).

We would suggest that arguments in favour of a fairly high threshold of protection are more consistent. The design seeking protection should then show a significant degree of originality in relation to the relevant sector, being a ‘possible factor’ influencing the consumer to prefer the product over the others.

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

This provision is justified by the policy of avoiding restrictive effects on legitimate competition which can arise when functional shapes are monopolised beyond the limits posed by the patent system.

- 16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

When an excluded subject matter exception is opposed, Courts should firstly ascertain whether the features of the design proposed for exclusion lead to an objective result (real and not only perceived as such by the public). Secondly it must be demonstrated that the shape of the features is the most efficient way to achieve the result and it is not possible to achieve the same technical result by a different shape.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

- 17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

Only to the to the "features of appearance" of a product which are solely dictated by its technical function.

- 18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

See question 16 herein above.

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions?  
Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

This is the Italian group selection.

b) any portions deemed functional will not be taken into account when assessing validity

This is the Italian group selection.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

N/A

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

N/A

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

N/A



Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

N/A

#### Summary

According to the Italian Group, further harmonization is advisable on the three are of meaning of a "design", requirements for protection of a design and treatment of functionality. Irrespectively from how they are called, two requirements should be met by a design to be protected (a) independent creation or novelty (as a preliminary requirement); and (b) originality (individual character in the EU perspective) in the sense required by TRIPs (currently as a non binding provision) *“members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features”*. Furthermore, we would suggest that design seeking protection should show a significant degree of originality in relation to the relevant sector, being a ‘possible factor’ influencing the consumer to prefer the product over the others. Finally, the Italian group submits that the features of a design which are necessary to achieve a technical effect should still be protected if some alternative shape to achieve the same effect is available (i.e. when an excluded subject matter exception is opposed, Courts should firstly ascertain whether the features of the design proposed for exclusion lead to an objective result and secondly it must be demonstrated that the shape of the features is the most efficient way to achieve the result and it is not possible to achieve the same technical result by a different shape).