

International Comparative Legal Guides



Practical cross-border insights into designs law

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Expert Analysis Chapter

1

Overhauling the Design Protection Landscape in the UK: A First Step?
Ewan Grist, Bird & Bird LLP

Q&A Chapters

5

Australia
FB Rice: Jeremy Dobbin, John Hogan,
Andrea Ruhmann & Stuart Campbell

13

Brazil
Murta Goyanes Advogados: Luiza Duarte Pereira,
Patrícia Rizel, Conrado Steinbruck & Fernanda Mósca

20

Canada
Marks & Clerk Law LLP: Jean-Charles Grégoire,
Kevin Shipley, Amrita V. Singh & Paul Horbal

28

France
Cabinet Armengaud Guerlain: Catherine Mateu

37

Germany
BARDEHLE PAGENBERG: Philipe Kutschke &
Jan Lersch

46

India
LexOrbis: Manisha Singh & Omesh Puri

56

Israel
Reinhold Cohn Group: David Gilat, Ena Pugatsch,
Ifat Katzhendler & Amotz Thee

65

Italy
DDPV Studio Legale: Luciano Vasques

75

Japan
Anderson Möri & Tomotsune: Nobuto Shirane

83

Norway
Acapo AS: Espen Clausen & Erik Otby

90

Portugal
Caiado Guerreiro, Soc. de Adv., SP RL:
Ricardo Costa Macedo, Adriana Magalhães &
João Bertholo Meireles

99

Serbia
MIKIJEJLJ JANKOVIC & BOGDANOVIC:
Mara Jankovic & Maja Popovic

106

Spain
Arochi & Lindner: Gonzalo Barboza &
Miriam Anidjar Mogeda

119

Switzerland
BMG Avocats: Anne-Virginie La Spada

127

United Kingdom
Bird & Bird LLP: Ewan Grist & Louise Sargeant

135

USA
McAndrews, Held, and Malloy: Christopher V. Carani,
Dunstan H. Barnes & Sarine R. Hagopian

143

Zimbabwe
Wintertons Legal Practitioners:
Cordellia Nyasha Midzi

Italy

DDPV Studio Legale



Luciano Vasques

Italy

1 Relevant Authorities and Legislation

1.1 What is the relevant Design authority in your jurisdiction?

Design applications may be filed in Italy, with the Chambers of Commerce or with the Italian Patent and Trademark Office (*Ufficio Italiano Brevetti e Marchi* (“**UIBM**”)).

The European Union Intellectual Property Office (“**EUIPO**”) is the relevant authority concerning Community Designs, which are valid and enforceable in Italy.

Italian courts hold jurisdiction over the revocation, invalidity, and infringement proceedings regarding National Designs. However, when any such legal action also concerns a Community Design, then the jurisdiction lies with the Community Design Court.

1.2 What is the relevant Design legislation in your jurisdiction?

In Italy, the appearance of a product as a design can be protected through either a registered or unregistered Community Design, or a registered National Design. National registrations can be applied for at the UIBM. The legal basis is provided in Arts 31–44 of the Industrial Property Code (“**CPI**”) (D.Lgs. 10 February 2005 n. 30 – *Codice della Proprietà Industriale* – D.M. 13 January 2010 n. 33), which is fully harmonised with the EU Designs Directive (98/71/EC).

Registered Community Designs, administered by the Office for Harmonization in the Internal Market, automatically cover all EU Member States and are regulated by EU Community Designs Regulation 6/2002. The Regulation also provides for the protection of unregistered designs (see below). Designs can also be protected by means of copyright and three-dimensional (“**3D**”) trademark registration. A further way to protect the appearance of a product consists of invoking national rules related to the prohibition of unfair competition.

2 Application for a Design

2.1 What can be registered as a Design?

Bi- and tri-dimensional industrial and handicraft items and their visible parts, packaging, get-up, graphic symbols, typographic typefaces, web browser screens, and computer icons that fulfil the requirements of novelty and individual character are registrable designs.

The range of registrable products is actually quite vast, including figurative designs to be applied to products as a decoration or characterisation. The weft of a fabric, unusually visible stitching, the shape of a pocket, or other parts of articles of clothing or designs that can be applied thereto, are registrable as marks consisting of graphic elements that are not registrable as trademarks or are used only temporarily, etc.

Components of complex products are registrable only if they remain visible during normal use by the consumer and if the visible features of the component fulfil the requirements as to novelty and individual character.

With a single application for multiple designs, it is possible to request protection for a group of designs as long as they belong to the same class of goods of the international Locarno Classification on designs.

2.2 What cannot be registered as a Design?

Designs and models that do not meet the novelty requirements, have no individual character or are contrary to public order cannot be registered as a design, nor those with characteristics that are determined solely by the technical function of the product itself. The characteristics of the appearance of the product must necessarily be reproduced in their exact shapes and sizes in order to allow the product to be connected or combined with another product so that each of them can perform its function.

2.3 What information is needed to register a Design?

The application must be drawn up in the appropriate form (DIS-RI) and must contain the following information:

- the total number of designs and models for which registration is requested (single design and model or multiple filing);
- the surname and first name, nationality, residence and domicile of choice under the law of the applicant and possibly of the agent/lawyer; an application made by a company, association or institution must include its exact and complete name and the seat, nationality and qualification of the signatory. If the applicant resides abroad, he must elect his domicile in Italy and indicate this in the application;
- the title of the design or model, which specifies the industrial product whose manufacture must be the subject of the exclusive right, the characteristics of the product itself to be claimed and, where necessary for the intelligence of the model, the purposes to be achieved with the characteristics themselves; the title, however, must not contain any proper name or special denomination;

- the surname and first name of the design's inventor. If the inventor's name is unknown, it can be sent within two months from the filing date of the application;
- the details of the first filing made out of Italy, for the same invention, in the event that the applicant intends to claim, within the terms of the current Paris Convention, the priority of a previous filing made in another State; and
- a list of any documentation attached (drawings, letter of appointment, etc.).

In addition, in the application form, the applicant must specify whether he intends to make the description, drawings and photos of the design immediately accessible to the public or prefers to keep them secret for a limited period (up to 30 months from filing). In the absence of specific indication, the documentation will be made immediately accessible to the public.

Furthermore, the following documents must be attached:

- a graphic reproduction of the design or model signed by the applicant or his representative/lawyer on each page;
- a description of the model, if necessary, containing the claims and signed by the applicant or his agent/lawyer on each page; the engagement letter or general power of attorney with stamp duty, only if the deposit is made by his agent/lawyer;
- the designation of the inventor indicating the surname and first name, nationality and residence of the same, if the name is not indicated in the application form. It is subject to stamp duty and must be signed by the owner of the application and the inventor;
- priority documents, translated into Italian, if the right of ownership of a first deposit made outside of Italy is claimed in the application;
- a revenue stamp of €16 if an authentic copy of the deposit report is requested; and
- €40 in cash for secretarial fees to be paid to the Chamber of Commerce.

2.4 What is the general procedure for Design registration?

Filing of a patent application for a design and model can be made by submitting an application in paper form at the Patent and Trademark Office of a Chamber of Commerce in the national territory or electronically, directly via the website of the UIBM (<https://www.uibm.gov.it/index.php/deposito-telematico>) or, alternatively, by means of the postal service by registered letter with a return receipt sent directly to the UIBM.

The application can be filed by the applicant or by a mandate, with a letter of appointment, who is qualified in the procedures before the UIBM, or by a lawyer registered in the relevant professional register.

The registration procedure starts with the presentation of the application for registration at the UIBM, and application submission forms are available on the UIBM website to be filled in by PC in a duplicate of the original.

2.5 How is a Design adequately represented?

Adequate representation of a design includes the following:

- Drawings must be made on resistant, non-shiny, white paper in A4 format (29.7 × 21cm), leaving a margin of at least 2cm; the drawings must be completed in a workman-like manner and traced with indelible black ink or printed.
- Designs can be replaced by photographic or lithographic reproductions of the model. If the colour(s) characterise(s)

the model, the reproduction must be performed in the claimed colour(s).

- Tables of the drawings must not contain any written words, with the exception of the indications necessary for their understanding and possibly the scale adopted.
- Drawings must be signed by the applicant or his representative.
- A description of the model must be attached to the application, in circumstances when it is considered useful for the realisation of the model or design and better defines the visible characteristics that are intended to be claimed. It must be completed in Italian, and written indelibly by a typewriter or computer.
- Each sheet must not contain more than 25 lines of writing, leaving a margin of 3cm to the left of the sheet and an adequate margin to the other sides of the sheet, as well as a space between the lines to allow for interlinear corrections.
- The description must consist of a title and text.
- The description must include in the header the title of the model, identical to that reported in the application, and formulated in such a way that it clearly shows the characteristics and purpose of the model (in the case of multiple filings, the number of models or designs to be patented has to be indicated).

2.6 Are Designs registered for specific goods or products?

Designs can be registered for specific goods in accordance with the Locarno Classification. However, in contrast to trademark law rules, design protection is not limited to the products in connection to which it is intended to be incorporated as specified in the application. A registered design confers on its holder a wider exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration. Neither the product indication nor the classification affects the scope of a design, as they serve merely descriptive purposes.

2.7 Is there a "grace period" in your jurisdiction, and if so, how long is it?

The "grace period" is a period of 12 months that is granted to the owners of a new design or model to formalise the application, which elapses between the first display of a new design and model and the filing of the registration application.

2.8 What territories (including dependents, colonies, etc.) are or can be covered by a Design in your jurisdiction?

Registration protects the design in the entire Italian territory and in the State of San Marino, and may be recognised as an Italian design in Vatican City.

2.9 Who can own a Design in your jurisdiction?

Any natural or legal person of Italian or foreign nationality (the author of the design or his assignee) may apply for an Italian design. Applicants may only be represented professionally by qualified attorneys holding membership in the Italian Industrial Property Consultants Institute, or by attorneys-at-law.

2.10 How long on average does registration take?

The application for registration is made immediately accessible to the public unless, at the time of filing, the holder of the application requests that the same be made inaccessible for up to 30 months, through the appropriate indication on the form.

The registration of the design is performed at the end of the examination phase and after the publication of the application.

The UIBM sends the registration certificate approximately six months after the filing date.

2.11 What is the average cost of obtaining a Design in your jurisdiction?

Filing fees must be paid upon filing the application via postal order on current account n. 668004 in the name of the Revenue Agency – Operational Center of Pescara.

In the case of paper filing, registration of a single design has a filing fee of €100, and €200 for multiple designs.

In the case of electronic filing, the fee for a single design is €50, and €100 for multiple designs.

At the same time as making the deposit, it is also necessary to pay a fee of €40 or €43 if an authentic copy of the application for filing is requested. In the latter case, it is also necessary to pay a revenue stamp of €16. If the application is submitted by a legal representative of the applicant, a letter of assignment with a relative revenue stamp duty paid (€16) has to be filed.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are three main routes to obtaining a registration in Italy: filing a request for national registration before the UIBM; filing a request for European design registration before the EUIPO; and filing a request for International Design registration before the World Intellectual Property Organization (“WIPO”), designating either Italy or the EU among the States for protection.

2.13 Is a Power of Attorney needed?

Applications for registration may be filed directly or through an agent or representative. Only in the latter case will a valid power of attorney be needed.

2.14 If so, does a Power of Attorney require notarisatio and/or legalisation?

The mandate must always be in writing and can consist of (i) an engagement letter, which must be signed by the applicant and countersigned by the representative, or (ii) a general power of attorney.

The engagement letter may concern one or more questions (single or multiple) and must contain the mandatory indication of the patent design rights to which it refers, is subject to stamp duty (€16), and must be written on plain paper (A4 format) without any type of authentication.

The general power of attorney can be made by public deed or private writing. In this case, the signature of the principal must be ascertained by a notary. The general power of attorney is also subject to registration and €16 stamp duty and, accompanied by an application for a design or model, gives the representative of a subsequent application for other protective rights

in the name of and in the interest of the mandate itself. The representative may subsequently produce a copy in plain paper of the same power of attorney general, or a declaration, written on plain paper, which refers to the general power of attorney produced earlier. This act is valid for all proceedings before the UIBM.

2.15 How is priority claimed?

Anyone who has duly filed an application for registration in one of the countries adhering to the Paris Convention for the Protection of Industrial Property can claim a right of priority in Italy.

This right consists of the possibility of filing an application for protection for the same design or model in Italy, within a maximum period of six months from the date of filing of the previous application. The subsequent registration application will be valid from the same filing date as the original application.

To claim priority in Italy for an application previously filed in another State, the documents issued by the competent service of the country in which the first filing took place must be provided.

The priority claim must be made at the same time as the application for registration of the design or model, or at the latest within the following two months, as long as two months from the date of priority claimed are not exceeded. The documentation demonstrating the right of priority, if it is not filed together with the claim of the priority itself, must be sent within six months from the filing of the application for registration.

The priority documents must contain the applicant's data and information relating to the details of the first filing and be accompanied by a translation into Italian (this is not required for documents in French issued by France to French citizens).

If the foreign deposit was made by others, the applicant must also provide documentary proof of being the successor, or successor in the title, of the foreign title.

2.16 Can you defer publication of Design applications in your jurisdiction? If so, for how long?

The application is made immediately available to the public unless, upon filing, the applicant requests that the application be made accessible to third parties only at a later date, which cannot be later than 30 months running from the filing or priority date.

3 Grounds for Refusal

3.1 What are the grounds for refusal of registration?

The registration procedure is rather documentary and administrative, and the requirement of novelty is not verified in any way by the authorities. Although it is theoretically possible for the UIBM to refuse registration of a design due to lack of a legal requirement, this practically never occurs, except in the case of an attempt to register trivial or well-known forms.

3.2 What are the ways to overcome a grounds objection?

In order to overcome an objection, a response to the objection must be submitted, explaining the reasons why the alleged ground of objection does not take place or modify the application.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of the UIBM that totally or partially rejects an application can be appealed before the Appeals Commission of the UIBM (*Commissione dei Ricorsi presso l'Ufficio Italiano Brevetti e Marchi*) – Art. 135 CPI (Legislative Decree 10/2/2005 and subsequent amendments).

3.4 What is the route of appeal?

An appeal, drawn up on plain paper, must be addressed to the Appeals Commission of the UIBM. Pursuant to Art. 136, paragraph 1, CPI, both the UIBM and the counter-interested parties, to whom the deed refers directly, must be notified of the appeal within the peremptory term of 60 days from the day on which the interested party received the communication or became aware of the contested deed or – for documents for which individual communication is not required – from the day on which the deadline for publication expired.

The decisions of the Commission can be challenged before the Italian Supreme Court (*Corte di Cassazione*).

4 Opposition

4.1 Can a Design application be opposed, and if so, on what grounds?

Italian law does not regulate any opposition procedure for design registration before the UIBM.

4.2 Who can oppose the registration of a Design in your jurisdiction?

Please see question 4.1.

4.3 What is the procedure for opposition?

Please see question 4.1.

5 Registration

5.1 What happens when a Design is granted registration?

When a design is granted registration following a formal examination carried out by the UIBM, it will be published in the IP Bulletin and the UIBM will issue the corresponding design registration certificate. The application, with the attached documentation, is immediately made available to the public unless the applicant has excluded accessibility for a period that cannot exceed 30 months from the date of filing or priority.

The protection period of the design or model lasts five years from the date of submission of the application and can be renewed by paying the maintenance fee for four additional five-year periods, up to a maximum of 25 years.

5.2 From which date following application do an applicant's Design rights commence?

The applicant's design rights commence from the date of publication of the registered design.

However, provisional protection is granted from the date of application for design registration. Such provisional protection consists of the right to claim compensation if a third party has carried out a prohibited use of the design between the date of application and the date of publication. Provisional protection can only be claimed after publication of the design registration.

5.3 What is the term of a registered Design right?

Please see question 5.1.

5.4 How is a Design renewed?

The holder of a design or model registration can request an extension for the duration of an additional five years by paying a renewal fee. For registrations already granted, payment of the aforementioned extension rights must be made within the expiry of the five-year period, or by the last day of the month corresponding to that in which the application was filed.

Otherwise, from the day the registration is granted, it is possible to submit an application for an extension within the four months following the date of registration, paying without surcharge the rights for the five-year renewal that will expire.

Once these deadlines have elapsed, an extension is allowed within the following six months.

If the holder does not make payment for the extension rights by the last day, the title is declared forfeited.

6 Registrable Transactions

6.1 Can an individual register the assignment of a Design?

An individual can register the assignment of both a registered design and a design application.

6.2 Are there different types of assignment?

Where the assignment concerns registration or application of multiple designs, the request for registration of the assignment may concern all or only part of the designs included in those multiple designs.

6.3 Can an individual register the licensing of a Design?

An individual can register the licensing of both a registered design and a design application.

6.4 Are there different types of licence?

A model, apart from use, can be assigned or licensed to third parties. Italian law allows several kinds of licences, which can be exclusive or non-exclusive, and the licensor may or may not grant other licences to third parties and exploit the design by themselves.

The licence (as the assignment) may concern the whole or only part of the rights granted by the design, and may be granted for the whole or only part of the Italian territory.

The licence or assignment may be permanent or temporary, indefinite, over the whole registration and possible renewal period, or limited to a specified time frame, or assignable or non-assignable. The licensee may or may not assign the licence to third parties or grant sublicences.

The assignment, or licence, of a model, can be recorded with the UIBM with a specific petition for the record. The record is not mandatory for the validity of the licence-assigning agreement, but is extremely useful for effectiveness before third parties and to safeguard the acquiring party or licensee.

6.5 Are there any laws that limit the terms upon which parties may agree a licence?

No, there are no such laws.

6.6 Can Designs be the subject of a compulsory licence (or licences of right), and if so, in what circumstances does this arise and how are the terms settled?

No, designs cannot be the subject of a compulsory licence.

6.7 Can a Design licensee sue for infringement?

Pursuant to Art. 122 CPI, the legitimacy of acting for an IP right infringement belongs to the owner of the IP right only. The owner and the licensee can agree that the licensee has the right to take action against any counterfeiters.

The owner may also subsequently authorise the licensee to take legal action if it is not specifically allowed by any licence agreement clause.

However, even in the absence of (i) contractual agreements that allow it to act, or (ii) authorisation from the owner, the licensee will be able to act if the owner does not initiate an action himself within an appropriate time frame, if the licensee (i) has informed the owner about the counterfeit, and (ii) has invited the owner to take action in due course.

The licensee is granted the possibility of intervention in a trial concerning the infringement action initiated by the owner to obtain, from the infringer, the restoration of the damage he suffered.

6.8 Are quality control clauses necessary in a licence?

No, quality control clauses are not necessary in a licence.

6.9 Can an individual register a security interest under a Design?

An individual can register a security interest under both a registered design and a design application.

6.10 Are there different types of security interest?

The rights emanating from a design registration or application may be given as security or be subject to other rights *in rem*, licences, purchase options, seizures, or other measures resulting from enforcement proceedings.

7 Invalidity

7.1 What are the grounds for invalidity of a Design?

A design can be declared invalid if it is shown that it lacks the following requirements: “The absence of disclosure of an identical model prior to the date of its application for registration”; individual character; and the “ability of the design to create a general impression different from that of other designs or other earlier models in the informed user” (Court of Milan, 6 October 2019 n. 8888).

7.2 What is the procedure for invalidation of a Design?

A design can be invalidated by specialised courts (*Tribunale delle Imprese*) through an action for ascertaining the nullity of a design or, in a counterclaim, in a counterfeit action that involves a design infringement claim.

Once an invalidation lawsuit has been filed, the claimant may request to enter a preventive annotation into that effect on the Design Register.

7.3 Who can commence invalidation proceedings?

Any natural or legal person who demonstrates a legitimate interest (e.g. potentially affected by the existence and validity of the design) can act before civil specialised courts (*Tribunale delle Imprese*) for invalidation proceedings.

However, invalidity actions based on the existence of prior rights can only be filed by their owners (or, in certain circumstances, by the licensee; see the answer to question 6.7).

7.4 What grounds of defence can be raised to an invalidation action?

Defence is mainly based on claims of the plaintiff and the grounds of allegations; thus, the plaintiff could, for example, argue that:

- i) The design is not novel and/or does not have individual character.
- ii) The design is contrary to public policy or accepted principles of morality.
- iii) The applicant is not entitled to own the design.
- iv) The registered design is incompatible with a previously registered or applied-for design in Italy. The defence to this kind of allegation has to be based on contesting that the evidence provided by the plaintiff is not enough to support these allegations from an evidence point of view and by providing new pieces of evidence, if any.

7.5 What is the route of appeal from a decision of invalidity?

A decision of the first instance court (*Tribunale delle Imprese*) can be appealed before the second instance court (*Corte d'appello*). See questions 11.1 and 11.2.

8 Design Enforcement

8.1 How and before what tribunals can a Design be enforced against an infringer?

In case of infringement of an Italian design, the holder may bring an action against the alleged infringer before the national Civil Court whatever the citizenship, domicile or residence of the parties may be.

In Italy, specialised divisions of the civil ordinary courts (“**Enterprise Courts**”) were established by Decree 168/2003 and have the jurisdiction to enforce patent infringements (and IP rights in general). In particular, there are 22 specialised courts. Appeals must be proposed before specialised sections of the courts of appeal of the same cities.

Patent claims are brought before the Enterprise Court of the place where the defendant has his residence or domicile, and if these are unknown, in the place where the defendant has his place of abode. When the defendant does not have a residence, domicile or place of abode in the territory of Italy, actions are brought before the judicial authority of the place in which the plaintiff has his residence or domicile. If neither the plaintiff nor the defendant have their residence, domicile or place of abode in the territory of Italy, jurisdiction shall lie with the judicial authority of Rome. Actions based on circumstances that are presumed to harm the plaintiff’s rights may also be brought before the judicial authority having specialised sections in the district where the acts were committed (Art. 120 CPI).

8.2 Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

Issues of validity and infringement are heard in the same proceedings. However, parallel Community Design invalidity proceedings can take place before the EUIPO.

8.3 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

In Italy, an infringement case is rarely started by sending a warning letter. This document would allow an alleged infringer to destroy the relevant evidence and entitle him to start a declaratory action for non-infringement before any action is brought by the design owner.

The best strategy in Italy is to file an application for a description order (an *ex parte* measure for preserving evidence under Art. 7 of the EU IP Rights Enforcement Directive (2004/48/EC), plus an application for a preliminary seizure and injunction (under Art. 9(1) of the same Directive). The preliminary decision (issued by one judge within an average of one month in design and trademark cases) can be appealed.

Actions on the merits must be lodged within 20 working days or 31 calendar days of the issuance of the preliminary measures.

The duration of an ordinary action is around three years. The remedies available are claims for a permanent injunction, destruction of the infringing good and three types of damages under the Directive (lost profits, infringer’s profits and reasonable royalty). The Court of Milan has a well-established rule according to which negotiated royalty rates are doubled, in order to provide an effective deterrent effect for the future (without being punitive). Moreover, the so-called “moral prejudice” provided by Art. 13 of the Directive is generally recognised by the Court of Milan and awarded as an additional value corresponding to 50% of the economic damage ascertained as above.

8.4 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case?

Yes, preliminary injunctions are admissible in urgent cases that require the right holder to move quickly once he has become aware of an infringement of the design and the infringer. The right holder needs to provide *prima facie* evidence (i) of the infringement, and (ii) that a fast and immediate injunction of the court is essential for avoiding unlawful, irreparable damage.

8.5 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary, and if so, how?

The judge, at the request of one of the parties, can order the defendant or a third party to exhibit documents or information that he deems necessary for the decision of the pending case (pursuant to Art. 210 Code of Civil Procedure (“**CPC**”). The court-appointed expert may require the parties to provide further documents and/or information useful for the issuing of the technical brief required by the court if these documents/information are not in the file of the proceedings; the parties must be informed of the technical expert’s request of documents/information (Art. 121.5 CPI). If the infringement was committed on a commercial scale through acts of piracy, the judge can also order the defendant to exhibit banking, financial and commercial documents (Art. 121.2*bis* CPI).

However, the party who received the disclosure order can refuse to obey, but any unjustified refusal to comply with the orders could be assessed by the judge as indirect evidence against the party that does not fulfil the disclosure order (Art. 121.4 CPI).

The court shall adopt measures suitable to guarantee the safeguarding of confidential information (so-called “protective orders”, Art. 121.3 CPI).

8.6 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Italian infringement proceedings are mainly conducted in writing. The plaintiff will submit its arguments in the writ of summons, while the defendant can present the counterclaim in the defence statement and both parties must submit the documents/evidence in support of their claim. The burden of proof is on the plaintiff.

During the first hearing, the judge, if requested by the parties, will set the deadlines to submit further briefs (Art. 183 CPC): (i) 30 days for amending their respective claims, exceptions and conclusions; (ii) a further 30 days for replying to the first brief filed by the counterpart and producing evidence or requesting from the judge the admission of several examples of evidence; and (iii) a further 20 days for replying and filing evidence in rebuttal. The first brief opens the gathering of evidence phase of the proceeding.

During the second hearing, the judge decides on the requests of evidence, such as the request to hear witnesses. The list of questions to be asked to the witnesses are submitted in advance to the judge, who decides which questions are relevant for the case. The third phase of the proceeding starts when all the evidence is before the judge. Given the high degree of specialisation in IP matters required in these kinds of proceedings, the court usually appoints technical patent experts in order for any technical questions to be answered.

Furthermore, in the technical debate, the parties usually appoint their respective technical experts, who draft technical briefs.

A party can change its arguments proposed in the first writ of summons or in the first defendant's defence brief. The plaintiff cannot add new requests other than those proposed in the first writ of summons, but could specify/reduce the requests submitted in the first writ of summons.

The arguments that support the main claim or statement of defence (or counterclaim, if applicable) shall be based on written evidence, which must be submitted together with the corresponding writs. Such evidence may include expert reports and any other documents that provide evidence of the facts or legal pleadings raised.

During the oral hearing, each party will request the court to admit the evidence on which it intends to rely during the trial, such as the cross-examination of witnesses, experts or parties. The entire trial is held orally.

8.7 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Issues of invalidity and infringement are not bifurcated and can be claimed in the same proceeding; if separate proceedings have been brought, they should be joined in order to avoid conflicts between the two decisions. If the proceedings could not be joined (which can happen for several reasons, i.e. joining the proceedings would lead to an excessive delay in judgment), the infringement proceeding will remain suspended until judgment on the invalidity is available.

8.8 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

No. There are no alternative shorter, flexible or more streamlined procedures available.

8.9 Who is permitted to represent parties to a Design dispute in court?

Each party shall appear before court represented by a court attorney (barrister), who shall be appointed by virtue of a power of attorney being granted.

8.10 After what period is a claim for Design infringement time-barred?

Civil actions for design infringements are time-barred after five years from the day on which the right holder knew or should have known the last fact allowing him to exercise it (Art. 2947 Italian Civil Code).

8.11 Are there criminal liabilities for Design infringement?

Patent infringements may constitute a criminal offence (Art. 473 Italian Criminal Code, R.D. n. 1398/1930), and a design could thus be enforced before the Criminal Courts by submitting a complaint before the public prosecutor (*Procura della Repubblica*). Anyone who counterfeits or uses a counterfeited design may be punished by a fine of up to €35,000 and/or one to four years' imprisonment (Art. 473 Italian Criminal Code).

If the design is also granted as copyright, the provision of Arts 171–173 CPI (violation of copyright as a criminal offence) are applicable.

8.12 If so, who can pursue a criminal prosecution?

A design could be enforced before the Criminal Courts by submitting a complaint before the public prosecutor. Criminal law proceedings may be initiated by the right holder and, in certain circumstances, also by the public prosecutor.

8.13 What, if any, are the provisions for unauthorised threats of Design infringement?

There are no specific provisions; if the unauthorised threats could give rise to damage to the reputation of third parties (individuals and/or undertakings), this could also give rise to civil liability (unfair competition). Thus, depending on the facts, threats of design infringement may be considered unlawful by courts and lead to remedies such as prohibition orders, publication orders, orders to inform clients or damages.

9 Defences to Infringement

9.1 What grounds of defence can be raised by way of non-infringement to a claim of Design infringement? For example, are there "must match" and/or "must fit" defences or equivalent available in the jurisdiction?

In addition to non-infringement, designs are excluded from design protection if they constitute a "must-fit" part.

"Must-match" parts are defined as designs that have to be manufactured in a certain shape to produce the appearance of a complex product, but are not mandatory. Such parts are not excluded from design protection.

9.2 What grounds of defence can be raised in addition to non-infringement?

To challenge the validity of a design, the statute of limitations, forfeiture and/or the exhaustion of the design right can be raised as grounds of defence.

9.3 How does your jurisdiction deal with Design protection for spare parts?

Art. 241 CPI (in compliance with Art. 110 Community Designs Regulation 6/2002) states that "...the protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance".

This rule is applied in Italy; thus, protection for spare parts is not illimitated but is subject to certain conditions.

The Court of Rome made a relevant decision in the case of *Daimler vs Acacia* on 20 December 2018. Acacia is an independent manufacturer, which produces and markets wheel rims that are replicas of those fitted as standard or offered as an option on Mercedes cars. Daimler AG is the manufacturer of Mercedes cars and claimed that Acacia was infringing its registered designs on its wheel rims.

In this case, the court held that: the repair clause applies to wheel rims, even if their design is not necessarily predetermined

by the appearance of the vehicle; the application of the repair clause further requires that there is identical correspondence between the wheel rims of the independent producer and the original products; and alteration of the colour or size (diameter) does not by itself exclude the interference between Acacia's products and Daimler's registered designs. What counts is the overall impression of an informed consumer. The variation of sizes does not determine a change in proportions, and a different colour leaves the overall impression determined by the shape only. The court thus distinguished between two categories of Acacia wheel rims: those differing in colour and size from Daimler's registered designs; and those identical in colour and size. Thus, in the first case, the court said that the repair clause is not applicable and Acacia therefore infringed Daimler's rights, while in the second instance, the repair clause does apply and there was no infringement.

10 Relief

10.1 What remedies are available for Design infringement?

In infringement proceedings, the owner of the design is entitled to obtain: (i) injunctions not to infringe under penalties per day of delay or per infringing conduct; (ii) the definitive recall of the infringing goods from the market; (iii) the destruction of the infringing products; (iv) publication orders both online and on paper; (v) the transfer of the property of both the infringing products; and (vi) damages resulting from the infringement, which can also give rise to monetary compensation.

10.2 Are damages or an account of profits assessed with the issues of infringement/validity or separately?

Damages or an account of profits are normally assessed simultaneously. On some occasions, the court could judge the preliminary violation of the right and thus judge the quantification of the damages in a different decision.

10.3 On what basis are damages or an account of profits assessed?

Pursuant to Art. 125 CPI, compensation due to the damaged party shall be set by taking into account all of the pertinent aspects, such as negative economic consequences, including lost income of the owner of the infringed right, the benefits achieved by the infringer and, in certain specific circumstances, non-economic elements, such as the moral damage caused to the owner of the infringed right. Damages may also be assessed (on the basis of a discretionary evaluation by the judge) on an equitable basis and, in this case, at least a reasonable royalty is due.

The loss of profits shall be determined as an amount not less than the royalties that the author of the infringement would have had to pay, had he obtained a licence from the owner of the infringed right.

In any event, the owner of the infringed right may request the recovery of the profits obtained by the infringer, either as an alternative to compensation for the loss of profits or to the extent that they exceed that compensation. The infringer could be bound to pay the statutory court fees and the counterpart's lawyers' fees, which are determined by the court taking into account the value of the dispute.

10.4 Are punitive damages available?

Punitive damages are not provided under Italian law; however, in a recent decision (n. 16601/2017) regarding the enforceability in Italy of a US judgment on punitive damages, the Italian Supreme Court stated that the sanctioning function of damages is no longer incompatible with the general principles of the Italian legal system.

10.5 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

See question 10.3.

11 Appeal

11.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A first instance judgment can always be appealed before the territorially competent Court of Appeal, within six months from the decision's publication or within 30 days if the judgment has been formally served by one of the parties to the other party.

The losing party in the first instance judgment could seek a full review of the decision, both facts and law, but the parties cannot ask the Court of Appeal for new requests or exceptions other than those already proposed in the first instance judgment.

11.2 In what circumstances can new evidence be added at the appeal stage?

There is a very limited possibility of producing new evidence; thus, the parties cannot produce new evidence or documents unless they prove that they were not able to produce this evidence earlier for reasons not attributable to them.

12 Border Control Measures

12.1 Is there a mechanism for seizing or preventing the importation of infringing articles and, if so, how quickly are such measures resolved?

EU Regulation n. 608/2013 (the Customs Enforcement Regulation) applies in Italy; thus, customs authorities can detain or suspend the release of goods suspected of infringing upon a design right.

Where customs authorities identify goods suspected of infringing a design right covered by a decision granting an application, they can suspend the release of the goods. Before suspending the release of the goods, customs authorities may ask the holder of the decision to provide them with any relevant information with respect to the goods (Art. 17 Regulation n. 608/2013).

13 Other Related Rights

13.1 To what extent are unregistered Design rights enforceable in your jurisdiction?

In Italy, the provision of Art. 11 of Community Designs Regulation 6/2002 is enforceable, which grants the protection of unregistered designs.

13.2 What is the term of unregistered Design rights enforceable in your jurisdiction?

A design can be protected by an unregistered Community Design for a period of three years from the date on which the design was made available to the public within the European Community.

13.3 What, if any, are the key differences between unregistered and registered Design rights in your jurisdiction?

The protection of unregistered designs is lower than the protection granted to registered designs or models.

Firstly, protection of an unregistered Community Design or model allows the exclusive right to be exercised only in relation to a copy intended as a pure and simple reproduction of the design or model by an unauthorised third party, meaning that the owner of an unregistered design or model can prevent acts of disposition of creation only if the contested imitation is slavish.

Secondly, while registration gives designs or models a presumption of validity on the basis of which they are considered valid until proven otherwise, unregistered designs do not allow their owner to prevent the use of designs or models that are the result of an independent creation of another creator. In fact, in these cases, the owner of the unregistered design must prove the bad faith of the unauthorised user or that the same has not made an independent creation.

13.4 If unregistered Design protection is available in your jurisdiction, is protection cumulative or mutually exclusive?

Protection of an unregistered Community Design and a registered design is cumulative. However, the requirement of novelty for filing an application for a registered design is no longer met after a grace period of 12 months, so it is not possible to first use the three-year protection period for an unregistered Community Design and then file an application for a registered design.

13.5 Is copyright available to protect industrial Designs?

Art. 2(10) Copyright Act provides the possibility to invoke copyright protection for industrial designs with creative character and “artistic value” (see Court of Milan decision dated 16 February 2016 n. 1935 and Supreme Court Cass. Civ. decision n. 27901 dated 13 October 2021 Cass. Pen, sez. III, 1 August 2022 n. 30289).

For Italian courts, artistic value of the design can be deduced from: (a) the recognition of aesthetic and artistic qualities by cultural and/or specialised institutions; (b) display in the context of exhibitions or museums; (c) publication in the technical press; or (d) awards received.

Italian court precedents are not fully coherent with the decision of the Court of Justice of the European Union (“CJEU”) in the *Confemel* case (12 September 2019, in *Confemel*, C-683/17), in which the court stated that *the only* condition for a design to be eligible for copyright protection is its originality, so that it shall qualify as a “work” within the meaning of Directive CE/2001/29, when it is its author’s own intellectual creation and bears his personal touch (see also CJEU, *Infopaq*, C-5/08 and *Painer*, C-145/10).

Due to the CJEU’s *Flos* decision (Case C-168/09), Italy was also obliged to recognise protection for designs created before the implementation of the Designs Directive.

14 Current Developments

14.1 What have been the significant developments in relation to Designs in the last year?

See question 14.2 below.

14.2 Please list three important judgments in the Designs sphere that have been issued within the last 18 months.

A recent ruling by the Court of Milan (decision n. 10280/2021, *Longchamp*) confirmed that the Italian court’s approach regarding the criteria for recognition of copyright to industrial design industrialists is not coherent with the precedent of the CJEU’s *Comefel* case (see question 13.5).

A relevant decision of the Tribunal of Milan (interim measure decision n. 102/2020 of 13 July 2020, *Eredi di Gio Ponti vs Coin S.p.a*) has recognised the artistic value of certain pictures of a well-known Italian artist, Gio Ponti (thus not only a design, but also a work eligible for copyright protection). See also Tribunal of Milan, Sez. Sp. Impresa A sent. n. 493/2021, of 25 January 2021, *Moon Boots c. Ferragni*, in which the Court of Milan recognised the copyright protection of the snow boot (or “moon boot”) design.

14.3 Are there any significant developments expected in the next year?

See question 14.2.

14.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

See question 14.2.



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