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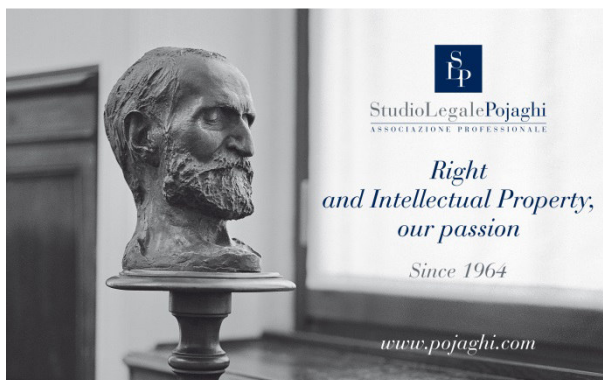


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**Protecting creativity in Art, Fashion and
Design (Main Theme follow-up session)**

**The issues raised for the Design industry
by 3D copying**



Avv. Gianluca Pojaghi
Viale Monte Nero 17
20135 Milan, Italy
Tel. (+39) 02 7607 98.11
Fax (+39) 02 7601 3950
gianluca.pojaghi@pojaghi.com

1- Introduction

According to Jeremy Rifkin,¹ with the (upcoming) Third Industrial Revolution (TIR), people will be able to produce (among other things) their own durable goods through 3D printing.

3D Printers run off a three dimensional product using computer aided design. Software directs the 3D printer to build successive layers of the product using powder, molten plastic or metals to create the material scaffolding. The 3D printer can produce multiple copies just like a photocopy machine. All sorts of goods, from jewelry to mobile phones, auto and aircraft parts, medical implants, and batteries will be printed out in what is being termed “additive manufacturing” (as opposed to “subtractive manufacturing,” which involves cutting down and pairing off materials and then attaching them together, therefore requiring as much as 10 times the raw material expended by 3D printers to build the same object).

This process of energy saving and reduction in materials used, when applied across the global economy, will result into a qualitative increase in energy efficiency beyond anything imaginable in the First and Second Industrial Revolutions (hence, the Third Industrial Revolution), leading to tumbling costs of marketing, as newspapers, magazines, radio, and television will be replaced by the internet as the main form of communication - advertising, and reduction of logistics costs, as an increasing array of goods will be produced locally in thousands of micro-manufacturing plants, if not privately.

While certainly appealing from a purely sociological viewpoint, this scenario of “diffused, or at home, manufacturing” poses a number of questions relating to its coexistence, primarily, with the systems of exclusive rights granted by (patents), trade marks, designs and copyright.

2 - The protection of tridimensional trademark

2.1 In Europe, one of the two major legislative instruments on the protection of trade marks is the EEC Directive n. 1989/104, later codified into the new EC Directive n. 2008/95, to approximate the laws of the Member States relating to trade marks.

For the purpose of our discussion, I will limit myself to recalling the following main provisions of the Trade mark Directive:

- Article 2 - Signs of which a trade mark may consist

A trade mark may consist of any **signs capable of being represented graphically**, particularly words, including personal names, designs, letters, numerals, the **shape of goods or of their packaging**, provided that such signs are capable of **distinguishing** the goods or services of one undertaking from those of other undertakings.

- Article 3 - Grounds for refusal or invalidity

¹ Jeremy Rifkin (born January 26, 1945) defines himself as an “economic and social theorist, writer, public speaker, political advisor, and activist”. Rifkin is president of the Foundation on Economic Trends and author of 19 books about the impact of scientific and technological changes on the economy, the workforce, society, and the environment. His most recent books include The Zero Marginal Cost Society (2014), The Third Industrial Revolution (2011), The Empathic Civilization (2010), The European Dream (2004), The Hydrogen Economy (2002), The Age of Access (2000), The Biotech Century (1998), and The End of Work (1995) (source: Wikipedia)

1. The following shall **not** be registered or, if registered, shall be liable to be declared **invalid**:

(Omissis)²

(e) signs which consist exclusively of:

(i) the shape **which results from the nature of the goods** themselves;

(ii) the shape of goods **which is necessary to obtain a technical result**;

(iii) the shape **which gives substantial value to the goods**;

(Omissis)³

2.2 The Trade mark Directive has been implemented in Italy and its provisions find their national equivalent into the Italian Legislative Decree 30/2005 – Code of Industrial Property (Articles 7 – 28; trade marks):

- Article 7 – Object of the registration

All **signs capable of being represented graphically**, particularly words, including personal names, designs, letters, numerals, **sounds**, the shape of the good or of its packaging, **combinations or chromatic scales**, provided that they are capable of **distinguishing** the goods or services of one undertaking from those of other undertakings, can be the object of a registration as trade mark (*marchio d'impresa*).

- Article 9 – Shape trade marks

Signs consisting exclusively of the shape **imposed by the very nature of the good**, by the shape of the good **which is necessary to obtain a technical result**, or by the shape **which gives substantial value to the good cannot** be the object of registration as trade mark.

2.3 The second major instrument that the European Union has adopted is the EC Regulation 40/1994, later codified into the new EC Regulation 207/2009, on the Community trade mark.⁴

Again, for the purpose of our discussion, I will limit myself to recalling the following main provisions of Community trade mark Regulation:

- Article 4 - Signs of which a Community trade mark may consist

² (a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

³ (f) trade marks which are contrary to public policy or to accepted principles of morality;

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

(h) trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6 ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the 'Paris Convention'.

⁴ Directives are aimed at Member States, who turn them into national laws, while Regulations are legislative instruments that are directly applicable, as such, throughout the entire European Union.

A Community trade mark may consist of any **signs capable of being represented graphically**, particularly words, including personal names, designs, letters, numerals, the **shape of goods or of their packaging**, provided that such signs are capable of **distinguishing** the goods or services of one undertaking from those of other undertakings.

- Article 7 - Absolute grounds for refusal

1. The following shall not be registered:

(Omissis)⁵

(e) signs which consist exclusively of:

(i) the shape **which results from the nature of the goods** themselves;

(ii) the shape of goods **which is necessary to obtain a technical result**;

(iii) the shape **which gives substantial value to the goods**;

(Omissis)⁶

2.4 A few example of Italian decisions:

⁵ (a) signs which do not conform to the requirements of Article 4;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

⁶ (f) trade marks which are contrary to public policy or to accepted principles of morality;

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

(h) trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the 'Paris Convention';

(i) trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authority to their registration has been given;

(j) trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin;

(k) trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (1) when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.



Crocs sandals

On February 15, 2012, the Court of Venice denied protection as tridimensional trade mark to the crocs sandals, **as giving to the product substantial value** (defined as “the shape that is capable to influence and determine the purchase choice of the consumers, not only for its particular aesthetic value but also for its capability to exercise particular attraction”), nonetheless granting protective measures under unfair competition for slavish imitation of the product.



On July 12, 2010, the Court of Turin, after the Italian manufacturer of coffee machines Bialetti failed to obtain the registration as European tridimensional trade mark of its well-renowned coffee machine, denied to it protection as a *de facto* tridimensional trade mark.



Shuanghuan Bubble (Martin Motors)



Mercedes-Benz Smart

On March 20, 2008 the Court of Turin judged that the car model “Bubble”, while not constituting counterfeit of the (community) design of the car model “Smart” (as differing in the bicolor effect) displayed, if not identity, a strict likelihood of the shape of the same car, registered as community tridimensional trade mark as well, and therefore constitute counterfeit of the latter.

3 - The protection of design

3.1 As for trade marks, both a Directive, aimed at Member States, and a Regulation, applicable as such, have been adopted by the European Authorities to grant protection to Designs.

Here are the main provisions (as relevant for this discussions) of the EC Directive 1998/71 on the legal protection of designs:

- Article 1 - Definitions

(a) “design” means 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;

(b) “product” means any **industrial or handicraft item**, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;
(Omissis)⁷

- Article 3 – Protection requirements

(Omissis)⁸

2. A design shall be protected by a design right to the extent that it is **new** (Article 4: A design shall be considered new if **no identical design has been made available to the public before the date of filing** of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.) and has **individual character** (article 5: 1. A design shall be considered to have individual character if the **overall impression it produces on the informed user** differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. 2. In assessing individual character, the degree of **freedom of the designer in developing the design** shall be taken into consideration).

(Omissis)⁹

- Article 7 – Designs dictated by their technical functions and designs of interconnections

1. A design right **shall not subsist in features of appearance** of a product which are **solely dictated by its technical function** (“shape which is necessary to obtain a technical result”, for trade marks).

2. A design right **shall not subsist in features of appearance** of a product which must necessarily be reproduced in their exact form and dimensions **in order to permit the**

⁷ (c) “complex product” means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

⁸ 1. Member States shall protect designs by registration, and shall confer exclusive rights upon their holders in accordance with the provisions of this Directive.

⁹ 3. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

4. “Normal use” within the meaning of paragraph (3)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may **perform its function**.

3. Notwithstanding paragraph 2, a design right shall, under the conditions set out in Articles 4 and 5, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

- Article 10 – Term of protection

Upon registration, a design which meets the requirements of Article 3(2) shall be protected by a design right for **one or more periods of five years** from the date of filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, **up to a total term of twenty-five years** from the date of filing.

- Article 13 – Limitation of the rights conferred by the design right

1. The rights conferred by a design right upon registration **shall not be exercised** in respect of:

(a) **acts done privately and for non-commercial purposes;**

(b) acts done for experimental purposes;

(c) acts of reproduction for the purposes of making **citations or of teaching**, provided that such acts are compatible with **fair trade practice** and do not **unduly prejudice** the normal exploitation of the design, and that **mention** is made of the source.

(Omissis)¹⁰

- Article 17 – Relationship to copyright

A design protected by a design right registered in or in respect of a Member State in accordance with this Directive **shall also be eligible for protection under the law of copyright** of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

3.2 And then the Regulation 6/2002 on Community Designs

- Article 3 – Definitions

(a) “design” means 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;

(b) “product” means any **industrial or handicraft item**, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

(Omissis)¹¹

¹⁰ 2. In addition, the rights conferred by a design right upon registration shall not be exercised in respect of:

(a) the equipment on ships and aircraft registered in another country when these temporarily enter the territory of the Member State concerned;

(b) the importation in the Member State concerned of spare parts and accessories for the purpose of repairing such craft;

(c) the execution of repairs on such craft.

- Article 4 – Requirements for protection

1. A design shall be protected by a Community design to the extent that it is **new** (Article 5: A design shall be considered to be new if **no identical design has been made available to the public**: (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public; (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority. 2. Designs shall be deemed to be identical if their features differ only in immaterial details.) and has **individual character** (article 6: 1. A design shall be considered to have individual character if the **overall impression it produces on the informed user** differs from the overall impression produced on such a user by any design which has been made available to the public: (a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public; (b) in the case of a registered Community design, before the date of filing of the application for registration or, if priority is claimed, the date of priority. 2. In assessing individual character, the degree of **freedom of the designer in developing the design** shall be taken into consideration).
(Omissis)¹²

- Article 8 – Designs dictated by their technical functions and designs of interconnections

1. A Community design **shall not subsist in features of appearance** of a product which are **solely dictated by its technical function** (“shape which is necessary to obtain a technical result”, for trade marks).
2. A Community design **shall not subsist in features of appearance** of a product which must necessarily be reproduced in their exact form and dimensions **in order to permit the product** in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may **perform its function**.
3. Notwithstanding paragraph 2, a Community design shall, under the conditions set out in Articles 5 and 6, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

- Article 10 – Scope of protection

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.
2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

¹¹ (c) “complex product” means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

¹² 2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

3. “Normal use” within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

- Article 11/12 – Commencement and term of protection

According to cases (unregistered or registered Community design), protection is granted “from the date on which the design was first made available to the public” or “from the date of the filing of the application”, for a period, respectively, of three years or five years, in the latter case **up to a total term of twenty-five years** from the date of filing.

- Article 20 – Limitation of the rights conferred by a Community design

1. The rights conferred by a Community design **shall not be exercised** in respect of:

(a) **acts done privately and for non-commercial purposes;**

(b) acts done for experimental purposes;

(c) acts of reproduction for the purposes of making **citations or of teaching**, provided that such acts are compatible with **fair trade practice** and do not **unduly prejudice** the normal exploitation of the design, and that **mention** is made of the source.

(Omissis)¹³

- And on the relationship to copyright (Article 17 of the Design Directive), whereas 32 of the Design Regulation:

In the absence of the complete harmonization of copyright law, it is important to establish the principle of cumulation of protection under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.

3.3 The Community Design Directive has also been implemented in Italy and its provisions find their national equivalent into the Italian Legislative Decree 30/2005 – Code of Industrial Property (Articles 31 – 44; designs and models):

- Article 31 – Object of registration

1. The appearance of the whole **product** or of a part thereof as resulting, in particular, from the features of the lines, of the contours, of the colours, of the shape, of the texture or of the materials of the product itself or of its ornamentation can constitute the object of registration, provided that they are **new** (Article 32: A design or model is new if **no identical design or model has been divulged¹⁴ before the date of filing** of the application for registration or, if priority is claimed, the date of the latter. Designs or models shall be deemed to be identical if their features differ only for irrelevant details.) and have **individual character** (article 33. A design or model has individual character if the **overall impression that it produces on the informed user** differs from the overall impression produced on such a user by any design or model which has been divulged before the date of filing of the application for registration or, if priority is claimed, the date

¹³ 2. In addition, the rights conferred by a Community design upon registration shall not be exercised in respect of:
 (a) the equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community;
 (b) the importation in the Community of spare parts and accessories for the purpose of repairing such craft;
 (c) the execution of repairs on such craft.

¹⁴ Definition under article 34

of the latter. 2. In assessing the individual character referred to in paragraph 1, the degree of **freedom of the designer in developing the design or model** is taken into consideration).

2. Product is deemed to mean **any industrial or handicraft item**, including inter alia the parts that have to be assembled in order to form a complex product, packaging, presentations, graphic symbols and typographic typefaces, excluding computer programs. (Omissis)¹⁵

- Article 36 – Technical function

1. Such **features of the appearance** of a product that are **solely dictated by the technical function** of the same product cannot constitute the object of registration as designs or models.

2. The **features of appearance** of a product that must necessarily be reproduced in their exact forms and dimensions **in order to permit the product** in which the design or model is incorporated or to which it is applied to be mechanically united or connected to another product, or to be incorporated into it or around or against it, so that either product may **perform its function** cannot constitute the object of registration as designs or models. However, designs or models that possess the requirements of novelty and individual character can constitute the object of registration as designs or models when they serve the purpose of allowing the multiple union or connection of interchangeable products within a modular system.

- Article 37 – Duration of protection

The registration of the design or model lasts **five years** from the date of filing of the application. The right holder may obtain the prorogation of the duration for one or more periods of five years, **up to a maximum of twenty-five years** from the date of filing.

- Article 42 – Limitation of the rights on design or model

1. The rights conferred by the registration of the design or model **do not extend** to:
(a) **acts done privately and for non-commercial purposes**;
(b) acts done for experimental purposes;
(c) acts of reproduction necessary for **citations or for teaching purposes**, provided that such acts are compatible with **fair trade practice** and do not **unduly prejudice** the normal exploitation of the design or model, and that the source is **mentioned**.
(Omissis)¹⁶

- Article 44 – Duration of the right of economical exploitation under copyright

¹⁵ 3. Complex product is deemed to mean a product composed of multiple components that can be replaced, permitting the disassembly and a new assembly of the product.

¹⁶ 2. The exclusive rights conferred by the registration of a design or model are not exercisable in respect of:
(a) the furniture and installations of ships and aircrafts registered in another Country that enter temporarily the territory of the State;
(b) the importation in the State of spare parts and accessories destined to the repairing of the means of transportation referred to in letter a);
(c) the execution of repairs on such craft.

1. The rights of economical exploitation of designs and industrial models protected under article 2, first paragraph, n. 10, of the law of April 22, 1941, n. 633 (Italian Copyright Law), last the whole life of the author and until the end of the seventieth solar year after his/her death of after the death of the last (surviving) coauthor.

And under the Italian Copyright Law:¹⁷

- Article 1

Works of the mind having a creative character and belonging to literature, music, figurative arts, architecture, theatre or cinematography, whatever their mode or form of expression, **shall be protected** in accordance with this Law.

Computer programs shall also be protected as literary works, within the meaning of the Convention for the Protection of Literary and Artistic Works, ratified and enforceable pursuant to Law no. 399 of June 20, 1978, as well as data-bases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright.

- Article 2

In particular, protection shall extend to:

- 1) literary, dramatic, scientific, didactic and religious works, whether in written or oral form;
- 2) musical works and compositions, with or without words, dramatico-musical works, and musical variations that themselves constitute original works;
- 3) choreographic works and works of dumb show, the form of which is fixed in writing or otherwise;
- 4) works of sculpture, painting, drawing, engraving and similar figurative arts, including scenic art
- 5) architectural plans and works;
- 6) works of cinematographic art, whether silent or with sound form, provided they are not mere documentaries protected in accordance with the provisions of Chapter V of Part II.
- 7) works of photographic art and works expressed with processes analogous to photograph, provided they are not simple photographs, protected according to the provisions of Chapter V of Part II.
- 8) computer programs, in whatever form they are expressed, provided that they are original and result from the author's own intellectual creation. Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, shall be excluded from the protection afforded by this Law. The term "computer program" shall include their preparatory design materials.
- 9) databases under point II of art. 1, meant as collections of works, data or other independent materials which are systematically or methodically arranged and can be individually accessed by electronic or other means. The copyright protection for databases shall not extend to their contents and shall be without prejudice to any rights subsisting in said contents.

10) Works of industrial designs which themselves have a creative and artistic value

3.4 The controversial provision of Article 239 of the Italian Code of Industrial Property (Legislative Decree 30/2005) and the Flos/Semeraro EUCJ Decision

¹⁷ Law of April 22, 1941, n. 633

A particular mention should be reserved to the transitory provision of Article 239 of the Italian Code of Industrial Property, that in 2005 fell under the scrutiny of the European Authorities together with the provision of Article 44 thereof.

In the version (Article 5 of the Royal Decree n. 1411 of August 25, 1940) in force before the implementation in Italy of the Design Directive (1998/71/EC), protection (in the form of a patent) was available for **“new (ornamental) models or designs which are capable of conferring on certain industrial products a special ornamental character** by virtue of shape or by a particular combination of lines of colours or of other features.”

On the other side, point 4 of the first paragraph of Article 2 of the Italian Copyright Law, in its original language, made copyright protection for designs subject to the condition of **“separability”** (*“scindibilità”*), providing that copyright protection was afforded for “works ..., even the industrial applications of such works, **provided that their artistic value is separable from the industrial nature of the product** with which they are associated”. Back then, protection under copyright law lasted for the whole life of the designer(s) and 50 years after his (their) death.

When implementing in Italy the Design Directive, the Legislative Decree n. 95 of February 2, 2001 (art. 22), simplified the protection of designs under the Italian Copyright Law by repealing the requirement of separability and introducing the requirement of **“creative character and artistic value”** of the design in order to be protected by copyright (by then, for **70 years after the death** of the author), but the provision was immediately (Legislative Decree n. 164 of April 12, 2001) amended with a transitory provision (**art. 25 bis**), excluding from the protection granted by art. 22, “for a period of **ten years from April 19, 2001**”, products that, before such date, were manufactured, offered or commercialized according to designs and models formerly protected by the (1940 Decree) patent and fallen in the public domain.

The provision was then incorporated under Article 239 of the Industrial Property Code (Legislative Decree n. 30 of February 10, 2005) which also (re)stated (Article 44) the protection of design under copyright law, but only for the **shorter term of 25 years after the death of the author**.

The European Union therefore initiated against Italy an infringement procedure (4088/05), objecting that Italy had violated the Copyright Term Directive (93/98/EEC, now 2006/116/EC) with reference to both the *post mortem* protection period and the transitory measure, prompting Italy to once again modifying (Law Decree n. 10 of February 15, 2007, converted into law with Law n. 46 of April 6, 2007) into **70 years after the death of the author** the term foreseen by art. 44 of the Industrial Property Code.

On that occasion, however, **art. 239 of the Code was also modified in order eliminate the 10 years moratorium period but not the exemption of protection for designs that were fallen into public domain at the date of April 19, 2001, which were therefore, from there on, excluded from copyright protection at all.**

After the re-wording of the provision,¹⁸ Article 239 was amended again in 2010,¹⁹ and the moratorium restated for the period of **five years** from April 19, 2001; which became **thirteen**

¹⁸ Article 19 of Law 99/2009

¹⁹ Legislative Decree n. 131 of August 13, 2010

years by the modification introduced by Article 22 bis of the Legislative Decree n. 216 of December 29, 2011.²⁰

Not surprisingly, the procedure is still pending, and on March, 2014, lead the European Commission to issue a formal request to Italy to address the disparity of treatment, not in line with the Design Directive, between (the rights of right-holders on) designs made after the entry into force of the implementation instrument (April 19, 2001), which enjoy the double regime protection under design **and** copyright (provided that they have creative and artistic value), and (the rights of right-holders on) designs pre-dating the implementation of the Directive, which **are excluded from copyright protection for a period of 13 years** and therefore deprived, during that period, from the benefits of copyright protection.

The procedure therefore entered its second stage (when the Commission's request takes the form of a reasoned opinion) and the Italian authorities were given two months²¹ to provide a satisfactory reply, failing which the matter may be referred to the EU Court of Justice.

3.5 In the meantime, in 2006 the matter was taken to Court by a furniture producer, Flos, who brought proceedings against Semeraro, another furniture producer, before the Court of Milan, complaining that Semeraro had imported from China and marketed in Italy a lamp called “Fluida”, which, in its submission, imitated all the stylistic and aesthetic features of the “Arco” (arch) lamp, an industrial design in which Flos claimed to hold property rights²².

The Arco lamp was created in 1962, entered the public domain before 19 April 2001 and was, the Court said, eligible for copyright protection.



Arco lamp



Diamonds are forever, 1971, Sean Connery, Henry Blofeld (and Arco lamp)

Market price in the range of €2.000,00 (\$ 3.000,00)

²⁰ Converted into law with Law n. 14/2012

²¹ At the time of writing this article, I have no news of the Italian reply

²² Described as “inspired by a streetlight, the Arco cleverly provides overhead lighting without requiring ceiling suspension, its polished shade extending nearly seven feet to accommodate a dining table or sofa beneath the light source. Aware that the 78-pound lamp would be difficult to move, the designers Achille and Pier Giacomo Castiglioni smartly placed a hole in the base to accommodate a broom handle. They also gave the Arco an adjustable arc and swiveling shade for precise lighting control. As groovy as it is elegant, the lamp's iconic status was sealed when it appeared on screen alongside Sean Connery in *Diamonds Are Forever* and in *The Italian Job* (apropos). The Arco is included in the permanent collection at MoMA.”



Semeraro lamp

The case was then referred to the European Court of Justice, asked to render its interpretation of Articles 17²³ and 19²⁴ of the Design Directive. In doing so, the EUCJ made an interesting reference to Article 12(2) of Directive 98/71, concerning the carrying out of acts of exploitation of designs by third parties who first carried out such acts before the date of entry into force of the national provisions of implementation of the directive, which states the following: “2. Where, under the law of a Member State, acts referred to in paragraph 1 (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, n.d.r.) could not be prevented before the date on which the provisions necessary to comply with this Directive entered into force, **the rights conferred by the design right may not be invoked to prevent continuation of such acts by any person who had begun such acts prior to that date.**”

The point though, noted the Court, was that the provision of **Article 12(2) could not apply in relation to copyright protection**, even if it could be argued that the absence of a provision expressly referring to protection, for third parties, of acquired rights and legitimate expectations in relation to the revival of copyright protection provided for in Article 17 of Directive 98/71 should not preclude application of the principle that acquired rights must be respected or the principle of legitimate expectations, both of which are among the fundamental principles of European Union law.

In fact, the **EEC Directive 1993/98**, harmonizing the term of protection of copyright and certain related rights, **did contain a transitory provision** (Article 10(3)) according to which “This Directive shall be without prejudice to any acts of exploitation performed before the date referred to in Article 13 (1) (July 1, 1996, n.d.r.). Member States shall adopt the necessary provisions to protect in particular acquired rights of third parties”). Which Italy did with the

²³ Relationship to copyright

A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection under the law of copyright of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

²⁴ Implementation

1. Member States shall bring into force the laws, regulations or administrative provisions necessary to comply with this Directive not later than 28 October 2001.

When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

2. Member States shall communicate to the Commission the provisions of national law which they adopt in the field governed by this Directive.

provision of **Article 17, paragraph 4, of the Law n. 52 of February 6, 1996**, stating that “Acts and contracts made or executed before the entry into force of the present law are made safe and unprejudiced (...) as well as rights legally acquired and exercised by third parties as a consequence of them”, consequently granting an exemption clause to (a) the distribution and reproduction of editions of works fallen into public domain (according to the earlier regime), with limitation to the **already adopted graphical composition and editorial shape** (including future updates), and only in favor of **those who had already started** such distribution and reproduction, and (b) the distribution of **phonograms** the rights of which had expired (according to the earlier regime), but only in favor of those that had reproduced and put into commerce such phonograms before the entry into force of the new legislation, and only for the period of **three months** thereafter. In other words, in much stringent terms than those provided for by the years long, unconditional, moratorium regime.

On the basis of such ground, the Court stated that:

“Article 17 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs must be interpreted as **precluding legislation of a Member State which excludes from copyright protection** in that Member State designs which were protected by a design right registered in or in respect of a Member State and which entered the public domain before the date of entry into force of that legislation, **although they meet all the requirements to be eligible for copyright protection.**

Article 17 of Directive 98/71 must be interpreted as **precluding legislation of a Member State which – either for a substantial period of 10 years or completely – excludes from copyright protection** designs which, although they meet all the requirements to be eligible for copyright protection, entered the public domain before the date of entry into force of that legislation, that being the case with regard to any third party who has manufactured or marketed products based on such designs in that State – **irrespective of the date on which those acts were performed.**”

3.6 A few more Italian decisions:



Thun statue, “Margit”



Thun “Bride and Groom” decorations



Copyright protection was denied by the Court of Venice on February 13, 2008, the Court of Naples on January 18, 2013 and the Court of Florence on April 8, 2013, and then again on July 8, 2013, to figures of the south-Tyrolean manufacturer Thun, as lacking the artistic and creative value required for by Article 2 of the Italian copyright law, but two of them (Venice and Florence) granted them protection under the designs and models legislation.

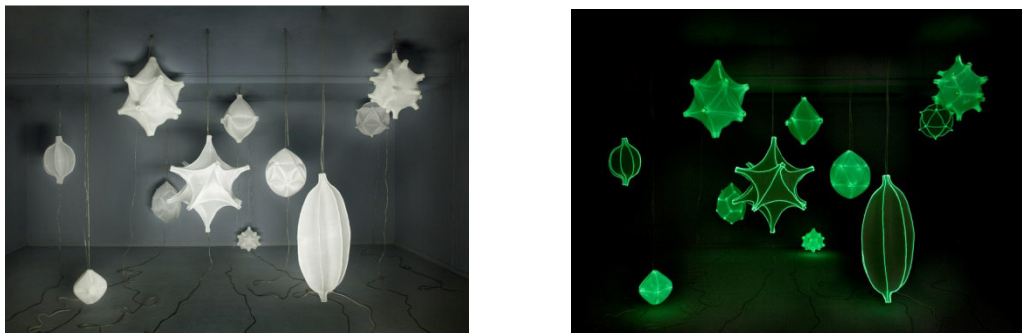
4 - 3D printing

3D printing of objects covered by trade marks or designs already exists.

In 2013, British designer Ross Lovegrove presented a **series of 3D-printed 18 carat gold rings** at the US design fair Design Miami.



Earlier this year, Dutch designer Anke Bernotat presented at the design fair Ventura Lambrate in Milan a series of **knitted fabric lamps** emulating microscopic organisms (they change color and glow in the dark) which do not require structural reinforcement thanks to their 3D-woven structure.



So the question is: how soon will consumers, as Jeremy Rifkin predicts, start using additive manufacturing technology to print their own jewelry and design objects at home, instead of visiting old-style boutiques, and how is the industry going to react against the homemade use of its exclusive rights ?

5 - The private copying regime (under copyright law)

The need for a compensatory measure for unauthorized reproduction became urgent, at least in Italy, in the nineties, when digital technology made it possible to evolve from the earlier analogue copies (often of a lesser quality and therefore incapable, by definition, to compete with the original) to a virtually limitless series of “clones” of the original material reproduced.

In Italy, the law dates back to 1992²⁵, and was recently incorporated into the new Articles 71-sexies and following of the Italian copyright law.²⁶ It covers reproductions of phonograms and videograms made by a natural person for private use, nonprofit making and for purposes that are neither directly nor indirectly commercial. Remuneration is levied at source by the Italian

²⁵ Law n. 93 of February 5, 1992

²⁶ Law n. 633 of April 22, 1941

collecting Society (SIAE), from producers and importers of carriers and devices that enable audio and video recordings.

SIAE is responsible for distribution to rights holders and does that by distributing directly to individual rights holders (authors) and through organizations of rights holders, according to the following scheme:

- phonograms: 50% to authors; 50% to phonographic producers and performers (half to be paid to performers).
- videograms: 30% to the authors; 70% in three equal parts to the original producers of audio-visual works, to the producers of videograms and to the performing artists thereof. 50% of the video distribution scheme assigned to performing artists is dedicated to study and research activities as well as to the promotion, training and professional support for artists and performers.

Remuneration for private copying is set by decree of the Minister of Culture and the National Heritage (subject to a three yearly update), the last of which was adopted, amongst vivid discussions, on June 20, 2014.

According to a recent Wipo survey,²⁷ private copying incomes, in 2012, amounted to 71 million euro for Italy, quite remarkable when compared to the 173 million euro collected in France or to the 23 million euro collected in Belgium, but also to the 1 and a half million euro collected in Spain.

6 - Conclusions

Leaving aside the use of 3D printers by entrepreneurs for the unauthorized reproductions of (goods protected by) trade marks or designs, which is easier to address with the traditional tools of law, the question is therefore whether the private copying model could be applicable to trade marks and design violations made by (the use of 3D printers by) private users.

One obstacle that comes to mind is that trade marks and designs, by definitions, are meant to defend an **entrepreneurial activity** and the exclusive use of its goods and services from the unauthorized use of a **competing entrepreneur**.

In a recent decision of the Italian Supreme Court²⁸, for example, the car manufacturer Ferrari obtained the affirmation of the principle that the unauthorized use of its notorious trademark



²⁷ International Survey on Private Copying. Law & Practice 2013

²⁸ 26498 of November 27, 2013



by the Ferrari Club Milano

did, indeed, constitute counterfeit even if the unauthorized user did not have the qualification of entrepreneur, but only because its use of the trade mark was, nonetheless, intended to address the market (through the organization of gatherings and other public events) and was structured as a commercial activity with purpose of gain, not as a mere private activity.

On the other hand, if the scenario of home manufacturing suggested by Jeremy Rifkin is correct, the increasing diffusion of 3D printers will modify the shapes of the market and shift the manufacturing process of goods from organized businesses to private users (to which new business might sell, for example, 3D printers together with the instructions to manufacture goods protected by trade marks and designs).

If that is the case, it might be worth it to look into the private copying compensatory scheme as a model to be imported into the trade marks and designs legal systems, in order to compensate right-owners, with a fee imposed on 3D printers producers and importers, for the uncontrolled – and uncontrollable – private reproductions of their materials that 3D printers will enable their private owners to do.