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Italy: copyright protection only for 'high level' industrial design

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The "Arco" lamp is protected by copyright. But Italy is still struggling with the moratorium of the copyright protection of industrial design.

With a 56-pages decision of the District Court of Milan published on 12 September 2012 and made available last week, the "Arco" lamp case, started as far back as 2006, has finally come to an end. In the meanwhile, a few amendments to the relevant norms and a judgment of the European Court of Justice (case C?168/09) intervened. But let's start this story from the beginning.

In November 2006 FLOS SpA, the Italian company producing the famous Arco floor lamp designed in 1962 by Achille and Pier Giacomo Castiglioni, brought proceedings against Semeraro Casa e Famiglia SpA, complaining that Semeraro had imported from China and marketed in Italy a lamp called "Fluida", which slavishly imitated the aesthetic features of the Arco lamp, thus infringing its copyright on the design of the lamp (it is worth remembering that the design of the Arco lamp was never registered by Flos).

While the similarity between the two lamps could not be seriously challenged (even if it obviously was by the defendant), the core of the dispute was whether the design of the Arco lamp was eligible for copyright protection.

As a matter of fact, the Italian legislator implemented the Directive 98/71/EC on the legal protection of designs amending the Law no. 633/1941 (the Italian Copyright Act), whose article 2, para. 1, no. 10, now states that «works of industrial design that have per se creative character and artistic value» are protected by copyright. Nonetheless, a couple of months after the implementation of Directive 98/71/EC, a transitional provision was introduced, providing for a 10-year moratorium starting on 19 April 2001, during which the protection conferred under copyright law "shall not be enforceable as against those persons who engaged before that date in the manufacture, supply or marketing of products based on designs that were in, or had entered into,

the public domain”. This transitional provision was subsequently restated in Article 239 of the Italian Industrial Property Code (the “IPC”), which was adopted in 2005, and then amended 5 times (this is not a typo: it was really amended five times).

Being in doubt about the conformity of the aforementioned provision with Directive 98/71/EC, the Court of Milan referred to the CJEU for a preliminary ruling. With the decision handed down on 27 January 2011 in case C?168/09, the CJEU stated that:

“1. 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

2. 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.”

It is worth noting that the CJEU considered in its decision only designs which entered the public domain, meaning that they were previously registered, because unregistered designs are outside the scope of article 17 of Directive 98/71/EC (the CJEU observed, however, that “it is conceivable that copyright protection for works which may be unregistered designs could arise under other directives concerning copyright, in particular Directive 2001/29, if the conditions for that directive’s application are met”).

As I pointed out before, article 239 ICP was revised five times: the fourth revision was made by the Italian government right after the Advocate General Yves Bot delivered his conclusions on the case C?168/09. In an attempt to comply with AG’s conclusions, Legislative Decree no. 131/2010 stated that the protection granted to designs and models according to article 2, no. 10, of the Law no. 633/1941 operated also vis-à-vis those works that, prior to 19.4.2001, were in, or had become part of, the public domain. Nevertheless, those persons who, 12 months prior to 19.4.2001, had engaged in the manufacture or marketing of products based on designs or models that were in the public domain may not be held liable for copyright infringement if they had continued this activity after this date within the limits of the products manufactured or purchased prior to 19.4.2001 and the products manufactured in the following 5 years, provided that this activity had been performed within the limits of the pre-use. Quite incredibly, less than a year after the CJEU ruling (which confirmed AG’s conclusions on this point), a further amendment was made by article 22 bis of the Law no. 14/2012, modifying the moratorium from the previous 5-years to a longer 13-years term.

This amendment was harshly contested by a number of Italian associations for the protection of the industrial design and it is now quite easy to foresee the possible consequences: the norm will likely be disapplied by Italian judges and Italy will face (for the umpteenth time) an infringement procedure brought by the EU Commission.

Anyway, getting back to the Court of Milan decision, this new version of Article 239 IPC was not

taken into account by the judges, as the defendant provided no evidence that it was marketing products manufactured or purchased prior to 19 April 2001…

As I said before, in deciding the FLOS case the Court of Milan had to establish if the Arco lamp was protected under copyright law, which means determining if it has per se creative character and artistic value. While the creative character is a general requirement in copyright law, by demanding an inherent artistic value, the Italian legislator has set the threshold for the protection of industrial design quite higher in comparison with all other kind of works eligible for copyright protection. Following a principle set forth in previous cases, the Court of Milan pointed out that, in order to evaluate if a work of industrial design has artistic value per se, an objective test has to be applied. Under this respect, the recognition by art critics and cultural institutions plays a significant role and must be properly taken into account (while it is irrelevant, for example, the name of the designer, meaning that not every object designed by a famous designer is, for this sole reason, eligible for copyright protection). In this case, the circumstance that the ARCO lamp was included in the MoMA collection (and in the collections of many other important cultural institutions worldwide) is clearly indicative of the internationally renowned artistic value of the work, which transcends its functional value and goes well beyond the mere elegance and pleasantness of the forms.

The reasoning of the Court echoes the institutional theory of art, which has both strong supporters and fierce opponents. Some commentators actually argued that the "artistic value" should be identified applying an ex ante approach, which is the point made by the defendant in the Arco case, too. In fact, the a-posteriori analysis of the "artistic value" was strongly opposed by Semeraro, claiming that the presence of this requirement should be properly evaluated having regard to the very moment of the creation of the work. The Court, however, observed that the ex post recognition of the artistic value just provides the evidence of the presence of the artistic value and does not establish it.

The Court of Milan seems to be aware that such a strict interpretation of the requirement of the "artistic value" implies that the copyright protection may be reserved only to a few design objects having a «consolidated and permanent representative and evocative character» (which means: only to design icons). But this, according to the judges, is exactly the intent of the Legislator, who – benefiting from the discretionality offered to Member States by Article 17 of the Design Directive as for the extent to which, and the conditions under which, the copyright protection is to be conferred to an object of industrial design – wanted to reserve the copyright protection only for works of design of a "high level".

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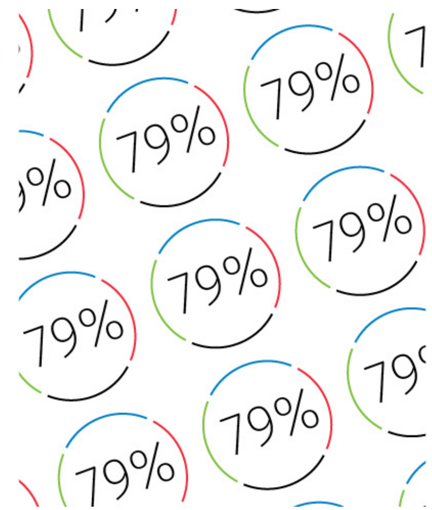

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