Kluwer Copyright Blog

Cumulation of design and copyright protection under Italian law: is the Italian Supreme Court's approach in line with the CJEU case law? – Part Two

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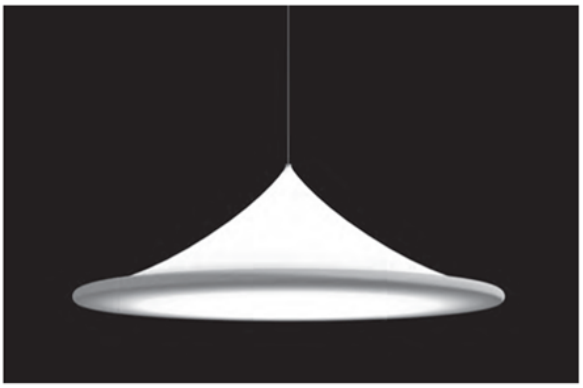

Earlier this year, the Italian Supreme Court (Corte di Cassazione) issued an order (Cass., ord. no.11413/2024) in a case concerning the protection by copyright of a lamp design. Part I of this post outlined the decisions issued as the case made its way through the Italian court system. Part II will now turn to the compatibility of the approach adopted by the Italian courts to the cumulation of design and copyright protection for works of industrial design and applied art (WAA) with the existing case law of the CJEU in the area.

Is the Italian approach to copyright/design cumulation compatible with EU law?

The very first controversial aspect of both the appellate and the Supreme Court's decisions lies in the missing application of the originality and expression requirements to determine whether the brothers Castiglioni's lamp could be defined as an independent protected work. This, however, is the unintended consequence of the unclear stance of the Cassazione *vis-à-vis* the relationship between Article 2(1)(10) l.aut. and the *acquis communautaire* post-*Cofemel*.

The indirect carry-home message of the Italian Supreme Court's order is that the assessment conducted by the Milan Court of Appeal could not be censored in point of law. This approach departs from the one the Court has adopted for architectural works (Cass. no.8433/2020, *Kiko*)

where it suggested that art.2 l.aut. should be read in light of the most recent CJEU's decisions, limiting the "work" requirements to originality and expression. In this sense, the position taken in the order comes as a surprise, since the Cassazione could have taken this opportunity to set clearer principles in a field where first instance decisions keep on being fragmented and sometime blatantly disregard the impact of the CJEU case law. The requirement of "additional artistic value" and related criteria, in fact, are still followed by several precedents issued after 2020. The supporting arguments vary. They range from a disapplication of *Cofemel* in light of the "potential distortive effects on competition" of the cumulation, which grants to design products "a more general protection that is almost unlimited in time" (Trib. Milano, ord.5 July 2021, *Softball*), to a reading of *Cofemel* as implying that the requirements for copyright protection under art.17 of the Design Directive are still remitted to Member States (Trib.Roma, ord. 4 August 2021, *Land Rover Defender*). Other decisions argue that *Cofemel* just requires a "less rigorous assessment" of the additional artistic value requirement (Trib.Venezia, ord.5 July 2021). Only a minority of courts believe that the CJEU decision had a "substantially abrogative impact" on art.2(1)(10) l.aut. (Trib.Milano, n.1679/22, *Le Pliage*).

These signs of "confusion" are not just an Italian phenomenon. Other Member States have reacted in a similarly contradictory fashion to the hazy and fragmented input coming from the CJEU in its 15-year-long incremental construction of a harmonized notion of a protected work, with the copyright/design interface being one of the most impacted fields.

When in *Cofemel* the highest EU court was asked to establish whether or not the InfoSoc Directive precluded national legislation from conferring copyright protection to designs or WAA on the sole ground that they generate a "specific and aesthetically significant visual effect" over and above their practical purpose, its answers brought some clarity as to the relationship between the InfoSoc and the Design Directive (DD) and Regulation (CDR), but still left a number of questions unsolved. It confirmed that the extent of protection should not depend on the degree of creative freedom exercised by the author (*Cofemel*, paras 29-35), and highlighted that art.17(2) CFREU does not require that all categories of IPRs subject matter must qualify for the same protection, as testified by the different legislative treatment adopted by the EU for copyright and registered design works, in line with the Berne Convention (*Cofemel*, paras. 37-41). Then, it clarified that the InfoSoc Directive left the principle of cumulation enshrined in arts.17 DD and 96(2) CDR unprejudiced, but specified that copyright protection for WAA, which is significantly greater than design rights, must be "reserved to subject matter that merits being classified as works" (*Cofemel*, para 50).

Still, the decision did not spell out how the new harmonized notion of protected work and its requirements are supposed to interplay with the minimum harmonization approach adopted by the Design Directive, which leaves to Member States the determination of the degree of originality necessary for WAA to be eligible for copyright protection. In fact, the Court only used this detour to highlight that the two legal texts pursue different objectives (*Cofemel*, para 50), and since the grant of cumulation should not undermine them nor their effectiveness, a concurrent copyright/design protection can be admitted only in **certain specific situations** (*Cofemel*, para 52). With particular regard to the requirement of producing a "specific and aesthetically significant visual effect", the CJEU excluded that the criterion was compatible with the "expression" requirement, since the aesthetic effect is the product of "an intrinsically subjective sensation of beauty" that does not permit subject matter to be characterized as existing and as identifiable with sufficient precision (*Cofemel*, para 53). Not much later, in *Brompton* the Court followed the same approach (i.e., the application of its previous case law on the notion of a work and on its originality

and expression requirements) to state that copyright may be granted to a design product whose shape is, at least in part, necessary to obtain a technical result, where, through that shape, its author expresses his/her creative ability in an original manner by making free and creative choices, which it is for the national court to verify (*Brompton*, para 38).

Clearly, the CJEU case law substantially abrogated, or at least largely limited, the discretion left to Member States to shape the requirements needed to grant copyright protection for WAA. However, the definition of such criteria has been left in a haze. The Court merely stated that the cumulation shall happen in "certain specific situations" only, hinting at the possibility that the originality criteria for WAA may be stricter than those applied to general works. Unsurprisingly, it took little for the CJEU to receive further referrals asking for a clarification of this interface. With *MIO and Others* (C-580/23) and *konektra* (C-795/23), the Court will be called to determine which factors (subjective vs objective) should be taken into account in the examination of originality for WAA, and more specifically whether: (a) higher requirements are to be imposed with regard to the creator's free and creative choices; (b) the creator's subjective view of the creation OR circumstances occurring after the date of design creation (such as, e.g., the presentation of the design in art exhibitions or recognition in professional circles) should be taken into account; (c) any relevance should be given to the novelty of the subject matter. The two cases will also give the CJEU the opportunity to intervene on the assessment of infringement, determining the actual focus of the similarity test, and whether and to which extent national courts may give relevance to the degree of originality of the work and the commonality of the elements copied.

Against this background, it is clear that the "additional artistic value" required by Article 2(1)(10) l.aut. and the criteria developed by the Italian Supreme Court to assess it may not be considered fully in line with the requirements set by the CJEU to grant copyright protection. Its most controversial aspects lay in the partially subjective nature of some of its evaluation criteria. On the contrary, the mere fact that the originality assessment for WAA includes additional/different requirements compared to other categories of work does not represent in itself an element incompatible with EU law. This does not imply, however, that Member States are free to determine these, as suggested by the Design Directive. The CJEU's definition of protected works and its requirements operate a bottom-up harmonization that cannot be ignored, and which now calls for an EU legislative intervention – at least in the field of design law – to solve the *hiatus*. Until that point, it will be up to the CJEU, once again, to offer more guidance on the "certain specific situations" that allow a copyright/design rights cumulation. *MIO* and *konektra* will hopefully clarify, then, whether the Italian approach – followed also by other Member States – may still be maintained and, if so, to which extent.

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This entry was posted on Wednesday, October 9th, 2024 at 9:39 am and is filed under Case Law, Design Rights, Italy, Originality
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