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DESIGN PROTECTION

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Ai miei nonni,

ma soprattutto

A mio nonno Enzo

SUMMARY

INDEX OF ABBREVIATIONS

§, §§	Paragraph, paragraphs
AI	Artificial Intelligence
Art., Artt.	Article, Articles
CAD	Computer-Aided Design
Cfr.	Confer; compare to (Latin)
CJEU	Court of Justice of the European Union
CPI	Italian Code of Industrial Property
DLT	Design Law Treaty
EC	European Council
e.g.	Exempli gratia; for example (Latin)
et al.	Et alia; and others (Latin)
et seq.	Et sequitur; and the following (Latin)
EU	European Union
EUIPO	European Union Intellectual Property Office
GATT	General Agreement on Tariffs and Trades
i.e.	Id est; that is (Latin)
IP	Intellectual Property
Ltd.	Limited
N.	Number, numbers
p., pp.	Page, pages
RCD	Registered Community Design
SCT	WIPO's Standing Committee on Trademarks, Industrial Designs and Geographical Indications
TFEU	Treaty on the Functioning of the European Union
TRIPs	Trade-Related Aspects of Intellectual Property Rights
UCD	Unregistered Community Design
UIBM	Italian Patent and Trademark Office
v.	Versus; against (Latin)
WIPO	World Intellectual Property Office
WTO	World Trade Organization

There's a lot of beauty in ordinary things.
Isn't that kind of the point?

The Office, S9, E25

INTRODUCTION

A spray bottle. A dog chew. An electric shaver. Even a radiator. *Everything* we see and use in our daily life, even the most simple or ordinary object, is the result of design. Behind every product there is a creator who was able to transform an idea into a tangible object, with the intent of capturing the crowd's attention and making their creation stand out in a market that constantly becomes more global and crowded, regardless of how simple or ordinary the product in which their idea is incorporated.

Over the last century, legislators worldwide have elaborated multiple ways to support the work of designers by granting them protection over their ideas: this way, those who have invested resources in the ideation, manufacturing and sale of original designs can profit from their investment without worrying that anyone could unlawfully compete against them by copying their design – and, in the latter case, they can stop infringers by proceeding against them in the courts of law.

The many ways of protecting design include registration as design or as form trademark, patenting as a utility model, and copyright: the designer is free to choose one or more of them based on what aspects of their creation deems worthy of protection, on the duration of the exclusive right granted or on other economical or practical evaluations, also considering the interplay of these different systems. However, only the first one was created with the specific aim of granting the most complete and all-encompassing protection to *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.*

For this reason, the following chapters will provide a complete analysis of the design protection system on a national, European and international level, focusing on the legal framework, the subject matter and requirements for protection, the different types of registration processes and the peculiar case of unregistered designs. Each aspect will be analyzed on a multi-level perspective, taking into account both the existing regulations and most recent legislative proposals, whose purpose is to keep the system on track with the ever-growing challenges of globalization and modern technologies.

CHAPTER I – LEGAL FRAMEWORK

To fully understand the current state of design protection, it is necessary to provide an overview of the European and international laws upon which the system is based, whose historical evolution, foundational principles, and interplay have shaped the current state of design law worldwide.

First, the analysis will delve into the Italian Code of Industrial Property and its origins (§ **1**). Second, it will touch upon the European Design Law framework, consisting in the Designs Directive and the Designs Regulations, and the ongoing Legal Review on Industrial Design Protection in Europe (§ **2**). Finally, international design law will be discussed, highlighting the past, present, and future of key conventions, treaties and agreements on the subject matter (§ **3**).

1. National Design Law: The Italian Code of Industrial Property

The Italian Code of Industrial Property[1] (hereafter "CPI" or "Code") was introduced by the Legislative Decree n. 30 of 10 February 2005. It replaced and incorporated the Design Law[2], which had already implemented the Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (hereafter "Designs Directive"), with the aim of updating and simplifying the subject matter by gathering all the national, European, and international laws and dispositions on industrial property rights under a single text. Following the same technique used for trademarks and patents, the Italian legislator set out some basic rules in Artt. 2592 to 2594 of the Italian Civil Code[3], referring to the CPI for more detailed and complete explanations and dispositions[4].

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[1] Legislative Decree 10 February 2005, n. 30, *Codice della Proprietà Industriale*, pursuant to art. 15 Law 12 December 2002, n. 273.
[2] Royal Decree 25 August 1940, n. 1411, *Text of legislative provisions on patents for industrial models* ("Legge Modelli"), as updated by the Legislative Decree 2 February 2001, n. 95, *Implementation of Directive 98/71/EC on the legal protection of designs.*
[3] Italian Civil Code, Book V, Title VII, Chapter III, entitled "*patenting rights on utility models and registration rights on designs*"
[4] DI CATALDO V. (2012). *I brevetti per invenzione e per modello di utilità: i disegni e i modelli [artt. 2584-2594]*. Giuffrè, p. 281; VANZETTI A., DI CATALDO V., SPOLIDORO M. (2021). *Manuale di diritto industriale.* Giuffrè, pp. 527 – 529.

The Code underwent a significant update in 2010[5], which introduced several modifications to uniform and update the text with all the laws and provisions issued after the release of the Code. In the same year, the Implementing Regulation of the Code was published to define and simplify the procedures for filing applications, appeals, deeds, and petitions in the sense of the provisions of the Code itself[6].

The CPI is comprised of eight Titles regulating all aspects related to industrial property rights. After setting some common provisions and basic principles for interpretation (Artt. 1 to 6), it analyzes the existence, scope, and exercise of industrial property rights (Artt. 7 to 116), their judicial protection (Artt. 117 to 146) and their purchase and maintenance (Artt. 147 to 193); it also regulates special procedures (Artt. 194 to 200), provides for professionals (Artt. 201 to 222) and for the management of services and rights (Artt. 223 to 230) and concludes with transitional and final dispositions on the relationship with other prior or contemporary legislative texts (Artt. 231 to 246).

1.1. The choice of the name

The Italian legislator chose to name this body of law "Code" rather than opting for the broader (and more commonly used in previous legal texts) definition as "Consolidated Text"[7] to stress its systematic importance: in fact, the CPI not only unifies the different systems of protection and registration concerning the different objects of intellectual *property* by reconducting them all to the common concept of *property*, but also provides complete and in-depth regulation of these types of *property* through well-structured and all-encompassing norms. With the choice of the term "Code" the Italian Council of State[8]

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[5] Legislative Decree 13 August 2010, n. 131, *Amendments to Legislative Decree 10 February 2005, n. 30, on the Industrial Property Code*, pursuant to art. 19 Law 23 July 2009, n. 99 ("Decreto Correttivo")

[6] Decree of the Ministry of Economic Development 13 January 2010, n. 33, *Implementing Regulation to the Code of Intellectual Property*, pursuant to Legislative Decree 10 February 2005, n. 30.

[7] Literal translation from the Italian "Testo Unico", which the Treccani Encyclopedia defines as "an official act in which the different legislative provisions in force on the same subject have been incorporated, giving them systematic organization and deleting the superfluous parts".

[8] Council of State ("Consiglio di Stato") Opinion n. 02/2004, given in the Plenary Session of 25 October 2004, p. 2-3, §1: "*this new phase is part of the initiatives of the Italian Legislator aimed at achieving regulatory simplification, reducing the exorbitant number of rules and at remedying their contradictions, their burden on citizens and businesses, and their relatively low quality* […] *at the operational level this development process marks the passage from a dated concept of simplification limited to the mere streamlining of administrative procedures carried out by the delegation of a part of their discipline, to a broader and more current concept, in line with international experience, which covers the whole theme of the quality of the rules*". According to the Council of State, "quality legislation" means *"both consistency*

and the Italian Ministry of Productive Activities[9] aimed at identifying a text composed of deeply interconnected sets of norms coming both from the pre-existing national laws and from the European and international regulations and agreements, thus creating a "quality" set of rules in continuity with similar texts aimed at rationalizing other fields of law[10].

Another key element in naming this body of law was the choice of the descriptor "property". As mentioned above, the *leitmotif* of the Code is the concept of *property,* which is capable of comprising and characterizing the exclusive rights on the different objects of this particular type of property, namely "*trademarks and other distinctive marks, geographical indications, designations of origin, designs and models, inventions, utility models, topographies of semiconductor products, confidential business information and new plant varieties*" – as indicated in Art. 1 CPI.

Notably, the concept of "property" in the Code does not refer to the Roman idea of *dominium*, but rather aims at identifying a wider and less defined type of ownership which can be applied to all the above-mentioned objects and to the rights arising from them, such as patents and copyrights[11]. While this definition allowed the legislator to group several different subject matters into one uniform text, it also created some inconsistencies from a classification standpoint, concerning the equalization between registered and unregistered marks and the distinction between marks geographical indications and designations of origin – the latter having close to no independency from the former.

To the contrary, the choice of adjective "industrial" represents a deviation from the definition of "intellectual property" – which was adopted in some international agreements and treaties, albeit with a wider scope of application[12]: in fact, the latter term encompasses the concepts of both *industrial property* and *copyright*, which the European

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and clarity from a formal-legal point of view and essentiality and less onerousness from a substantial-economic point of view".

[9] Explanatory Report to the Code of Industrial Property by the Ministry of Productive Activities ("Ministero delle Attività Produttive"), p. 3, §1: "[…] *the new idea of codification accompanies the achievement of provisional but meaningful balances, aimed at collecting the numerous special laws, in such a way as to grant the discipline a systematic structure capable of ensuring its unity and overall consistency*".

[10] VANZETTI A., SIRONI G. E. (2013). *Codice della proprietà industriale*. Giuffrè, p. 5.

[11] *ibidem*, p. 6.

[12] Such as the TRIPs Agreement (*cfr* below, § 3.4), which deals with both industrial property and copyright.

Union and its Member States traditionally keep separate[13]. Coherently with this tradition, and as explained by the Ministry of Productive Activities [14], the Code only deals with *industrial property*, namely marks, patents, designs etc., while copyright and its related rights are still regulated by the 1941 Copyright Law[15].

Therefore, the choice of the name for the Code of Industrial Property represents a union of element aimed at describing both the type of legislative text and its content, in order to identify a single body of law containing all the Italian regulation of the objects of industrial property, in conformity with the European Union laws and the international agreements ratified by Italy.

1.2. Relationship with European Union Design Law

As anticipated above[16], and similarly to all other European Union Member States, Italy has implemented the European discipline of design (also referred to as "European Design Law"), consisting in the Designs Directive and the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (hereafter: "Designs Regulation"), in its national design protection system. Therefore, the two models of design protection – national and European – coexist and largely overlap, being different only in the procedural

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[13] Article 36 Treaty on the Functioning of the European Union (ex Art. 30 Treaty establishing the European Community): "*The provisions of Articles 28 and 29 shall not preclude prohibitions or restrictions on […] the protection of industrial and commercial property […]".*

[14] Explanatory Report to the Code of Industrial Property by the Ministry of Productive Activities ("Ministero delle Attività Produttive"), p. 8, § 3: "*The parliamentary delegation, in ordering the reorganization of the existing provisions, refers to the matter of industrial property, expression aimed at excluding the subject of copyright.* […] *Unfortunately, outside the stated organizational justification, the distinction between Industrial Property and Intellectual Property is completely overcome by the fact that intellectual works protected by copyright are no longer the sole result of artistic experience (works of literature, music, figurative arts, etc.) but they also encompass the so-called "utilitarian" ones such as software or databases, and now also as designs and models having creative character and artistic value. Overcoming the distinction between Industrial Property and Intellectual Property, as separate compartments of Intangible Property, is enshrined in the same systematic TRIP's agreement. In fact, this precisely refers to Intellectual Property also including what we call* Industrial Property*, thus reflecting the Anglo-American concept. In the United States, copyright protection is not conceptually distinct from any other exclusive right to an intangible asset. The limitation of the delegate law, therefore, entails a reorganization in some respects incomplete and, from the point of view of systematic interpretation, slows down the process of integration of copyright and Intellectual Property within the overall system in which Intangible Property securities are seen as functional to the proper conduct of competition in the market economy.*

[15] Law 22 April 1941, n. 633, *Protezione del diritto d'autore e di altri diritti connessi al suo esercizio*, as updated by law 30 December 2014, n. 214.

[16] *Cfr.* § 1.

aspects[17]: they can both be applied to national designs, as European designs possess all the requirements to be recognized as national deposits in all EU Member States.

This level of harmonization and overlapping not only allows for the more detailed European model to be applied to national designs, but also grants national courts the possibility to reference the decisions rendered by European bodies (namely the EUIPO, the General Court and the Court of Justice of the European Union) and by other EU Member States courts for the interpretation of all harmonized regulatory issues.[18]

A more detailed analysis of the relationship between the provision of the CPI and those of European Design Law will be provided in the following chapters.

2. European Union Design Law: The Designs Directive and the Designs Regulation

The following paragraphs will analyze the structure of both the Designs Directive and the Designs Regulation, beginning with the European Commission Green Paper on the Legal Protection of Industrial Designs up to the most recent proposals for an amendment of the Designs Regulation and a full recast of the Designs Directive.

2.1. Overview on European Design Law

The European Design Law system was created with the purpose of harmonizing and unifying the different regulations (or lack thereof) of EU Member States. Before this process of harmonization, most of them had a national protection system of bi- or tri-dimensional design applied to industrial products in conformity with international treaties, such as the TRIPs Agreement and the Paris Convention; however, there were still profound differences between the national systems, since these treaties had not yet unified the more substantial provisions on designs of the ratifying Countries[19]. Notwithstanding the persistent divergencies, the common dispositions created by these international

[17]SANNA F., Dis*egni e modelli*, in UBERTAZZI L. C., *La proprietà intellettuale*, in AJANI G., BENNACCHIO G. A. (2011). *Trattato di diritto privato dell'Unione Europea*. Giappichelli, p. 322
[18] FABBIO P., *Disegni e modelli*, in BERTANI et al. (2024). *Lineamenti di diritto industriale*. CEDAM, p. 332.
[19] SANNA, *ibidem*, p. 181

agreements, which will be further analyzed below[20], set forth the basis for a more coherent and comprehensive harmonization process powered by the European Union[21].

The legal basis for the inclusion of design regulation in Europe is found in Articles 34 and 36 of the Treaty on the Functioning of the European Union (hereafter "TFEU"): in fact, Art. 36 TFEU allows for restrictions to the free movement of goods within the common EU market in order to ensure "*the protection of industrial and intellectual property*". The Court of Justice of the European Union (hereafter "CJEU") has confirmed this notion by recognizing that the specific design protection systems of the EU Member States fall within the definition of "industrial and intellectual property", therefore any prohibition or limitation on imports, exports and transit of goods based on national design protection do not constitute quantitative restrictions or equivalent measures in the sense of Article 34 TFEU[22].

The harmonization process of European Design Law began with the publication in 1991 of the *Green Paper on the Legal Protection of Industrial Design*[23], which also included draft projects for a Designs Directive and a Community Designs Regulation[24]; all documents were largely based on a proposal submitted by the Max Planck Institute for Foreign and International Patent, Copyright and Competition Law in the same year[25]. The Green Paper explicit goal was to start widespread discussion and consultation among all European design experts and stakeholders concerning the need to create a uniform system of protection of industrial designs, without serving as a comparative study but rather as a coherent set of suggestions and proposals to be further discussed and adapted by the European legislators[26]. As the Green Paper itself had hoped, the document sparked vast

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[20] *Cfr.* §§ 4.1 and 4.3.
[21] DI CATALDO V. (2002). *Dai vecchi "disegni e modelli ornamentali" ai nuovi "disegni e modelli" – i requisiti di proteggibilità secondo il nuovo regime*. Europa e Diritto Privato, pp. 62-63.
[22] CJEU, judgement of 14/09/1982, C-144/81 - *Keurkoop BV / Nancy Kean Gifts* BV, as cited in SANNA, *ibidem,* p. 182.
[23] European Commission Green Paper on the Legal Protection of Industrial Design, Brussels, June 1991, III/F/5131/91-EN (hereafter: "Green Paper").
[24] DI CATALDO, *ibidem,* p. 62; HARTWIG H. (2022). *Evaluation of EU legislation on design protection. Journal of Intellectual Property Law*, 17(2), p.107; DERCLAYE E., *EU Design Law: transitioning towards coherence?15 years of national case law,* in BRUUN et al. (2020). *Transition and coherence in Intellectual Property Law*. Cambridge University Press, p. 1-2.
[25] Max Planck Institute for Foreign and International Patent, Copyright and Competition Law, *Towards a European Design Law*, 1991, as mentioned in DERCLAYE, *ibidem,* p.1 and DI CATALDO, *ibidem*, p. 62.
[26] Green Paper, Executive Summary, p. 4

conversation across Europe's Member State and Community legislators, which led to the draft Directive and Regulation being adopted with minor changes and resulting in the current Designs Directive and the Designs Regulation.

2.2. The European Council Directive 98/71/EC of 13 October 1998 on the Legal Protection of Designs

The Designs Directive has largely harmonized the substantial regulation of registered designs in the EU by defining the object, the requirements and the invalidity of design protection, leaving to each Member States the choices as to the ownership of designs and related rights, the registration and invalidity procedures, and the sanctions for violations of design rights. Compared to previous EU directives, the one at hand presents a rather rigid structure aimed at creating consistencies in the national design protection systems of EU Member States, leaving them close to none margins for modifications (apart – of course – from those relating to the reception of the directive in the national legal system)[27]. It describes a wide notion of design applicable to both bi- and tri- dimensional shapes that can be mass produced, with the main requirement being the need for the design to be visible from the outside in order to be protected[28].

The Designs Directive will be further analyzed later with regards to the different provisions therein[29].

2.3. The European Council Regulation No. 06/2002 of 12 December 2001 on Community Designs

Following the harmonization of the national systems of design protection created by the implementation of the Designs Directive in all EU Member States, the Designs Regulation created a title of protection of designs with "*uniform effect throughout the entire territory of the Community*"[30]. In that respect, the Designs Regulation contains similar rules to the Designs Directive on the subject matter, the requirements and the

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[27] DI CATALDO, *ibidem,* p. 64-65; SANNA, *ibidem,* p.
[28] As established by EUIPO Third Board of Appeal (ex OHIM), judgement of 8 October 2007, case R 1337/2006-3 – *Honda Giken Kogyo Kabushiki Kaisha/Kwang Yang Motor Co. Ltd.,* also cited in GUGLIELMETTI G. (2002). *Pezzi di ricambio, interconnessioni e prodotti modulari nella nuova disciplina dei disegni e modelli*. Rivista di diritto industriale, I, p. 6.
[29] *Cfr.* Chapter II – III.
[30] Recital 1 to the Designs Regulation.

grounds for invalidity of European registered designs and related rights; additionally, it provides specific and autonomous rules as for the registration, annulment, licensing and other procedures only applicable to the European designs[31].

As both the Designs Directive and the Designs Regulation are rooted in the same project for a uniform European Design Law, as explained in the previous paragraphs[32], the definitions of designs and products, the requirements for registration and all other elements concerning the subject matter of protection contained in the Designs Regulation are largely overlapping, and they will be analyzed in the following chapters along with the corresponding norms contained in the Designs Directive.

Therefore, the Designs Directive and the Designs Regulation presented here created a two-tier system of design protection in Europe: on the one hand, the Designs Directive harmonized the national design protection systems of EU Member States, providing them with more clarity and defined boundaries. On the other hand, the Designs Regulation created a community protection system for both registered and unregistered designs circulating in the European common market and enforceable both by the European Union Intellectual Property Office (EUIPO) and by the intellectual property offices of the EU Member States.

2.4. The Legal Review on Industrial Design Protection in Europe

After more than 20 years from the release of the Green Paper, in 2014 the European Commission initiated a "Legal Review on Industrial Design Protection in Europe (hereafter "Review") as part of a broader evaluation of the European Design Law[33], with the aim of assessing whether harmonization has facilitated design protection within the internal market, examining the current two-tier system of design protection, evaluating the legal framework in light of technological advances, and considering the need for further uniformity and harmonization, with particular regards to spare parts and the impact of 3D printing on intellectual property rights[34]. In order to ensure a comprehensive

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[31] SANNA, *ibidem,* p. 184-185
[32] *Cfr.* § 2.1
[33] Namely, the Economic Review of Industrial Design in Europe, whose Final Report (Document MARKT2014/083/D) was published in January 2015.
[34] HARTWIG H. (2018). *The "Legal Review on Industrial Design Protection in Europe": a closer look.*

and inclusive overview, the Review employed a "cascading methodology", which involved several levels of legal and jurisprudential research, two rounds of public stakeholder consultations through surveys and interviews (carried out respectively in 2018 and in 2021), and a final integration of empirical evidence gathered by the Review Team – although this methodology was criticized by some authors as not being transparent, representative and authoritative enough since the public sources cited as basis for the Review itself were not properly disclosed[35].

The Review, revealed that nearly two-thirds of stakeholders and Member States considered both tiers of European design protection regimes to be functional and effective, recognizing the added value of harmonized national rules and of the community design system compared to the previous unharmonized scenario. However, it underlined the need for a more integrated cooperation between the EUIPO and national IP offices in order to address the areas of divergence, and the need provide clearer a definition of "design" with regards to the visibility requirement, the individual character, and the technical functionality, in order to align national practices with EU standards[36].

Overall, the Review represented a significant step towards refining the European Design Law with the goal of finding a balance between the need for harmonization and the required flexibility to accommodate different national systems, but also in light of updating national and community design protection systems in order to adapt them to emerging technological challenges. The conclusion that follows is that an extensive update to both the Designs Directive and the Designs Regulation is needed in order to make them stand the test of the latest innovations, the legal clarity much requested by Member States and stakeholders, and the economic sustainability goals of the European Union itself[37].

Journal of Intellectual Property Law, 13(4), p. 332-334; HARTWIG H. (2022). *Evaluation of EU legislation on design protection.* Journal of Intellectual Property Law, 17(2), p. 107-108.

[35] HARTWIG (2018), *ibidem*, p. 336.

[36] HARTWIG (2018), *ibidem,* p. 334-335, referring to p. 14 of the Review. In particular, the author mentions that the Review supports the "multiplicity of forms" theory, holding that "[…]*in determining whether features of appearance of a product are solely dictated by its technical function, due consideration should be given to whether the designer has some freedom in the development of features of appearance of the design, where the presence of differences between the existing design corpus and the contested design would demonstrate that the designer had some freedom"*.

[37] HARTWIG (2022), *ibidem,* p. 112.

2.5. The "Design Package"

Based on the results of the Review, on 28 November 2022 the EU Commission released proposals for amending the Designs Regulation[38] and recasting the Designs Directive[39], (collectively referred to as the "Design Package") as part of a broader effort to modernize the EU intellectual property legal framework[40]. The aim of these proposals is to streamline and simplify proceedings, enhance harmonization, and improve the functioning of European Design Law with respect to new forms of designs and technologies. This includes providing a more robust catalogue of limitations, liberalizing the spare parts market, enhancing accessibility for designers, particularly small and medium-sized enterprises, and clarifying the relationship between design protection and copyright. These aims are supported and endorsed by stakeholders and professionals who, at the same time, highlight issues of particular importance that require further comment and clarification[41].

After being presented by the EU Commission, the files have been assigned to the Committee on Legal Affairs (JURI) within the European Parliament; the plenary confirmed the decisions to enter interinstitutional negotiations in November 2023, and a provisional agreement was reached with the EU Council on December 5, 2023, with several amendments introduced by the EU Council[42].

The next step towards the adoption of the Design Package is the formal adoption by both the European Parliament and the European Council. Once adopted, the newly amended Designs Regulation will become directly applicable across the EU; as for the recast Designs Directive, EU Member States will have a 36-month period to transpose it into

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[38] Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002, document n. COM(2022) 666 final ("Proposed Regulation"), which can be found at https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:52022PC0666

[39] Proposal for a Directive of the European Parliament and of the Council on the legal protection of designs (recast), document n. COM(2022) 667 final ("Proposed Directive"), which can be found at https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:52022PC0667

[40] Briefing of the European Parliament "Revision of the EU legislation on design protection", which can be found at https://www.europarl.europa.eu/RegData/etudes/BRIE/2023/751401/EPRS_BRI(2023)751401_EN.pdf

[41] KUR A., ENDRICK-LAIMBÖCK T., HUCKSCHLAG M. (2023). *Position Statement of the Max Planck Institute for Innovation and Competition of 23 January 2023 on the "Design Package*". Max Planck Institute for Innovation and Competition Research Paper, 23(05), p. 2.

[42] Briefing of the European Parliament "*Revision of the EU legislation on design protection*", p. 8-9.

national law, with such an extended period intended to give Member States enough time to implement necessary measures and ensure a smooth transition[43].

3. International Design Law

Objects covered by industrial property protection (*e.g.* "*patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin*" etc.[44]) have a tendency to circulate beyond the country in which they were first created or used, which is further heightened by the continuous development of international trade; this goes against the interest of the holders of the rights to such objects of protection to control any type of economic exploitation to which they may be subjected, both inside and outside national borders. Furthermore, the protection of this interest is hindered by the existence of a plurality of national legal systems based on the principle of territoriality: because of this, those who intend to market their products abroad must request and obtain protection in each of the countries where they may want to export their products – and therefore have their industrial property rights protected. To overcome these obstacles and to guarantee effective protection beyond national borders, several countries have long concluded international conventions aimed at simplifying and unifying the procedures and the substantive requirements to obtain the protection of the same industrial property in a plurality of jurisdictions.

Therefore, the analysis of design protection would not be complete without a brief presentation of the main international conventions and agreements regulating the subject matter. In particular, the following paragraphs will touch upon design-related provisions of the Paris Convention for the Protection of Industrial Property[45] (hereafter "Paris Convention", *cfr*. § 3.1), the Hague Agreement Concerning the International Registration of Industrial Designs[46] (hereafter "Hague Agreement", *cfr.* § 3.2), the Locarno Agreement Establishing an International Classification for Industrial Designs (hereafter "Locarno

[43] *Ibidem.*
[44] Article 1 (2) Paris Convention.
[45] Reference is made to the text of the Paris Convention as revised by the Stockholm Agreement. The full text of the Convention can be consulted at https://www.wipo.int/wipolex/en/text/287556
[46] Reference is made to the text of the Hague Agreement as revised by the Hague Act of 28 November 1960, which can be consulted at https://www.wipo.int/wipolex/en/text/284253

Agreement, *cfr.* § 3.3)[47], and the Agreement on Trade-Related Aspects of Intellectual Property Rights[48] (hereafter "TRIPs Agreement, *cfr.* § 3.4), followed by an explanation of the draft Design Law Treaty proposed by WIPO (hereafter "DLT", *cfr.* § 3.5).

3.1. The Paris Convention for the Protection of Industrial Property

Within the system of international protection of industrial property, the 1883 Paris Convention has always played role of primary importance, as it was the first of the major multilateral conventions in this field and still grants protection to the greatest number of objects of industrial property. The original text of the Paris Convention was elaborated in two consecutive conferences held in 1880 and 1883, at the end of which, on 20 March 1883, the first *Convention d'Union de Paris pour la protection de la propriété industrielle* was signed by 11 countries. After six revisions conducted over the course of the 20th Century, the current version of the Paris Convention is contained the Stockholm Act adopted on 14 July 1967 as amended on 28 September 1978 and was ratified by 180 countries[49].

3.1.1. The Paris Union for the Protection of Industrial Property and the World Intellectual Property Organization

The Paris Union is a permanent and open organization which groups all the member States to at least one of its numerous acts, established by Art. 1 (1) Paris Convention[50]. Being equipped with legal personality under international law, it is institutionally responsible for ensuring the functioning and enforcement of the Paris Agreement and more generally the international protection of industrial property. Additionally, the 1967 Stockholm Agreement, which revised the Paris Convention, established the World Intellectual Property Organization (WIPO), based in Geneva, with the aim of providing more extensive and continuous administrative assistance to the Paris Union member states and

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[47] As the original 1968 version of the text has been superseded, reference is made to the text of the Locarno Agreement as amended on 28 September 1979, which can be found at https://www.wipo.int/wipolex/en/text/285822

[48] The complete text of the TRIPs Agreement can be consulted at https://www.wto.org/english/docs_e/legal_e/27-TRIPs.pdf

[49] The complete list of the Paris Convention Member States can be consulted at: https://www.wipo.int/pct/en/paris_wto_pct.html

[50] Art. 1(1) Paris Convention reads as follows: *"The countries to which this Convention applies constitute a Union for the protection of industrial property"*

more generally to promote international cooperation and development of intellectual and industrial property[51].

In addition to the Paris Convention, which establishes a "general" Union for the international protection of industrial property, there are several agreements concluded with the aim of integrating the degree of cooperation between the Union States and the process of standardization of national legislation on specific objects of industrial property, thus creating "special" Unions within the Paris Union[52].

3.1.2. Role of the Paris Convention and multi-level coordination

Another fundamental issue to be examined is the role of the Paris Convention in the European and international system of protection of industrial property and its coordination with the several sources of international law.

On the one hand, several European acts address the coordination issue with specific provisions aimed at establishing the principles set out by the Paris Convention as guidelines for the interpretation of European industrial property protection. In the field at hand, Artt. 25.1 (g), 41.1 and 44 Designs Regulation expressly coordinate the European Design Law with the Paris Convention norms on invalidity and union priority[53][54][55].

On the other hand, the relationship between the Paris Convention and other international treaties is regulated by Art. 19 Paris Convention itself, which allows for is member States

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[51] UBERTAZZI L. C. (2007). Commentario breve alle leggi su proprietà intellettuale e concorrenza. CEDAM, pp. 92, 97.

[52] UBERTAZZI, *ibidem*, p. 91.

[53] Art. 25.1 (g) Designs Regulation reads as follows: "*A Community design may be declared invalid only in the following cases:[…] if the design constitutes an improper use of any of the items listed in Article 6ter of the 'Paris Convention' for the Protection of Industrial Property hereafter referred to as the 'Paris Convention', or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State".*

[54] Art. 41.1 Designs Regulation reads as follows: "*A person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application*".

[55] Art. 44 Designs Regulation reads as follows: "*If an applicant for a registered Community design has disclosed products in which the design is incorporated, or to which it is applied, at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first disclosure of such products, claim a right of priority from that date within the meaning of Article 43. […]*".

to conclude specific agreements regulating specific object of industrial property[56]. As they are based on the Paris Convention, these agreements (and the resulting Unions) are depending on and subordinated to the Convention, whose rules shall prevail not only in cases of conflict between member States, but also between the norms of Convention and other national or international provisions. This is further confirmed by Art. 3.1 TRIPs Agreement, which require all World Trade Organization (WTO) Member States to conform to the provisions of the Paris Convention[57].

Finally, on an interpretation level, the rules of international contract law, EU law and Italian law on trademarks, designs, patents, unfair competition, indications of origin, and trade names must be conducted in harmony with the provisions of the Paris Convention, which should always assist the interpreters in the definition of categories and concepts not sufficiently determined by those regulatory sources[58].

3.1.3. Founding principles of the Paris Convention

The industrial property protection system created by the Paris Convention and enforced by the Paris Union is based upon the following principles:

- **Territoriality**: under Artt. 2-3 Paris Convention, while the protection granted by the Paris Convention operates regardless of the existence of a national IP protection system in the adhering member States, it does not constitute a single protection title but rather a group of national independent rights governed by their individual national legislation and effective only within the country that granted them.
- **Assimilation** (or **national treatment**): in the sense of Art. 2 (1) Paris Convention, each member State of the Paris Union shall grant intellectual property rights requested in its territory by resident of another member States the same protection as granted to national titles.

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[56] Art. 19 Paris Convention reads as follows: *"It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention."*
[57] Art. 2.1 TRIPs Agreement reads as follows: "*In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967)".*
[58] UBERTAZZI, *ibidem*, p. 94-96

- **Union priority**: pursuant to Art. 4 Paris Convention, applicants who first file for the protection of a certain IP title in one Paris Union member State can claim priority for subsequent filings in other Union countries within specific periods (*e.g.* six months for designs). This priority is maintained despite any *interim* actions such as other filings or uses of the protected object of intellectual property[59].

3.2. The Hague Agreement Concerning the International Registration of Industrial Designs

The 1925 Hague Agreement, which constitutes a special agreement to the Paris Convention, is a procedural agreement with the specific aim of allowing any legitimate subject to make an international deposit in order to protect industrial designs in more than one country with close to no formalities, thanks to a single deposit made at WIPO's International Bureau[60]. The international deposit then creates a series of autonomous national design titles that enjoy the same level of recognition and protection as the national titles of the chosen countries. Consequently, the Hague Agreement created a special Union within the Paris Union with the purpose of incentivizing the number of design registration requests by foreigners and of creating international guidelines for the harmonization of registration processes by its member States[61].

Additionally, a diplomatic conference held in 1999 led to the adoption in 2003 of the Geneva Act to the Hague Agreement, whose main goal is to make the Hague Agreement more compatible with the legislation of those member States which require a preemptive substantial evaluation of the requested design, allowing them to refuse applications based on their national requirements for protection following a substantive examination[62]. The

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[59] UBERTAZZI, *ibidem*, pp. 98-99.
[60] Art. 3 Hague Agreement, which reads as follows: "*Nationals of contracting States and persons who, without being nationals of any contracting State, are domiciled or have a real and effective industrial or commercial establishment in the territory of a contracting State may deposit designs at the International Bureau*".
[61] UBERTAZZI, *ibidem,* p. 1120.
[62] VOLKEN B., *Requirements for design protection: global commonalities*, in HARTWIG H. (2021). *Research Handbook on design law*. Elgar, p. 23-24.

Geneva Act is an international treaty independent from the Hague Agreement, which can be ratified by any of WIPO's member States[63].

As of 14 December 2023, the Hague Agreement has been ratified by 79 members (77 countries and 2 intergovernmental organizations[64]), 73 of which have also adopted the Geneva Act[65].

3.3. The Locarno Agreement Establishing an International Classification for Industrial Designs

The 1968 Locarno Agreement establishes a comprehensive and unified global system, and subsequently a special Union within the Paris Union, for the classification of industrial designs by providing a detailed classification framework that is based on both the purpose and the aesthetic appearance of products. It is structured into 32 distinct classes and further divided into 219 subclasses, ensuring a thorough and organized categorization of industrial designs[66].

As of June 2024, the Locarno Agreement has been adopted by 58 Contracting Parties, reflecting a broad international consensus on its utility and application based upon the fact that, in accordance with Art. 2 Locarno Agreement[67], the classification is intended primarily for administrative purposes. This is purposefully made to acknowledge the various legal frameworks and practices of different jurisdictions: therefore, some jurisdictions interpret the classification in a broad manner that does not impact the definition, the scope of protection and other substantial elements of design[68]. This interpretation ensures that the legal protection of the design remains broad and unaffected by its classification.

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[63] More information on the Hague System, created by the juxtaposition of the Geneva Act and the Hague Agreement, can be found at https://www.wipo.int/hague/en/guide/introduction.html.
[64] the African Intellectual Property Organization (OAPI) and the European Union.
[65] The complete updated list of signatory States and IGOs to the Hague Agreements, its revisions and the Geneva Act can be found at https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/hague.pdf.
[66] UBERTAZZI, *ibidem*, p. 93.
[67] Art. 2 Locarno Agreement reads as follows: "*Subject to the requirements prescribed by this Agreement, the international classification shall be solely of an administrative character. Nevertheless, each country may attribute to it the legal scope which it considers appropriate*".
[68] For example, according to Article 36 (6) Designs Regulation, the classification of products in which a design is intended to be incorporated, or to which it is intended to be applied, *"shall not affect the scope of protection of the design as such*".

While some jurisdictions have adopted the Locarno Classification on a systematic level, applying it to all registration classes and categories within their national design protection systems, others have opted to limit the protection conferred by the Locarno Agreement to specific classes within the 32 classes, thus potentially narrowing the scope of design protection. In any case, this divergence in interpretation highlights the flexibility of the Agreement, allowing it to be tailored to the legal and administrative needs of different countries while still maintaining a cohesive international classification system[69].

3.4. The Agreement on Trade-Related Aspects of Intellectual Property Rights

The TRIPs Agreement[70] constitutes one of the treaties stipulated during the Uruguay Round, a series of international meetings and conferences held from 1986 to 1994 within the General Agreement on Tariffs and Trade (hereafter "GATT"). The latter was created as a result of the international negotiations launched after the end of the Second World War, aimed at creating a new world economic order, with the intent of concluding a far-reaching agreement to regulate employment, restrictive business practices, international investment and services. To simplify and speed up its implementation within the adhering countries, the GATT scope of application was limited to customs and basic rules on international trades, with the definitive agreement being signed on 30 October 1947 – which also created the eponymous international organization[71].

Over the decades, the GATT underwent several amendments thanks to the so-called *Trade Rounds*, a series of international meetings and conventions intended to assess the compatibility of the agreement with the fast-paced global economic growth and update it accordingly up until the 1980s, when member States realized that the limited scope of the GATT to material goods was no longer sufficient to keep up with the global economy.

For this reason, at the end of the Uruguay Round, the GATT was updated and supplemented by the General Agreement on Trade in Services (GATS) and the TRIPs

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[69] VOLKEN, *ibidem,* p. 24.

[70] Reference is made to the full text of the TRIPs Agreement as contained in Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994, available at: https://www.wto.org/english/docs_e/legal_e/27-TRIPs.pdf.

[71] The full original text of the GATT can be consulted at https://www.wto.org/english/docs_e/legal_e/gatt47_e.pdf.

Agreement, and the GATT organization was replaced by the World Trade Organization (hereafter "WTO")[72].

The latest Trade Round was held in Doha in 2001, with the goal to achieve major reform of the international trading system through the introduction of lower trade barriers and revised trade rules to improve the trading prospects of developing countries.

As of June 2024, the TRIPs Agreement has been adopted by 144 countries, all of which are also Member States to the WTO.

3.4.1. The World Trade Organization

The WTO, which was established by the TRIPS Agreement in 1994 and commenced operations in 1995, is a permanent organization which groups all the member States to the GATT, GATS and TRIPs Agreements. Being equipped with legal personality under international law, it is institutionally responsible for ensuring the functioning and enforcement of the TRIPs Agreement and more generally to deal with all its related aspects and issues. To allow for rapid adaptations of the TRIPs Agreement to the ever-changing needs of its member states, both developed and developing, and to the rising challenges of the global economy, the WTO presents less formalities than the Paris Union, especially for what concerns negotiations and voting procedures[73].

While the ultimate goal of the WTO is to reduce the distortions and the obstacles to international trades and to require all Member States to adopt an adequate protection system of intellectual property rights, the organization is characterized by profound disagreements and clashes of interests between developed and developing countries: while the former are interested in a stronger protection of intellectual property rights, the latter underline their need for limitation of exclusive rights in favor of a more accessible and streamlined transfer knowledge and technology for development purposes. The relationship between intellectual property and development represents the heart of the Doha Round[74] and of the overall current work of the WTO, along with the several new

[72] UBERTAZZI, *ibidem*, p. 5
[73] UBERTAZZI, *ibidem*, p. 6-7.
[74] Art. 2 of the Doha Ministerial Declaration adopted on 14 November 2001: *The majority of WTO members are developing countries. We seek to place their needs and interests at the heart of the Work Programme*

challenges created by the evolution of technologies and subject matters of intellectual property.

Additionally, in 1996 the WTO entered into an agreement with the WIPO for the cooperation in several areas of their activity, such as the notification, access and translation of the national laws and regulations of their respective member states, and the legal-technical assistance and technical cooperation for the benefit of the developing countries[75].

3.4.2. Role and principles of the TRIPs Agreement

As the name suggests, the TRIPs Agreement concerns the availability, scope, use and transfer of trade-related intellectual property rights, namely: copyright and related rights; trademarks; geographical indications; industrial designs; patents; topographies of integrated circuits; protection of undisclosed information; control of anti-competitive practices in contractual licenses. Compared to the Conventions and Agreements discussed in the previous paragraphs, the TRIPs Agreement radically altered the treatment of these intellectual property rights by linking them directly to international negotiations, trades and commercial relationships, while also creating rules for the jurisdictional protection and enforcement and an international dispute resolution system for said rights.

Furthermore, the system outlined by the TRIPs Agreement sets minimum standards and terms of protection, specifically identified for each category of intellectual property rights, concerning the subject matter of the protection, the rights conferred and the exceptions thereto. The standards are configured in part by creating new obligation for the WTO Member States, especially for what concerns the jurisdictional protection and enforcement of intellectual property rights, and in part by recalling the main international

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adopted in this Declaration. […] we shall continue to make positive efforts designed to ensure that developing countries, and especially the least-developed among them, secure a share in the growth of world trade commensurate with the needs of their economic development. In this context, enhanced market access, balanced rules, and well targeted, sustainably financed technical assistance and capacity-building programmes have important roles to play. The full text of the Declaration is available at: https://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.pdf.

[75] The full text of the WTO-WIPO cooperation agreement can be consulted at: https://www.wto.org/english/tratop_e/TRIPs_e/wtowip_e.htm .

conventions on intellectual property and requiring all its signatory States to amend their national legislations to make them compatible with said conventions[76].

As for the principles contained in the TRIPs Agreement, they also largely recall those of the Paris Conventions and of other international conventions on intellectual property rights, such as:

- **Assimilation** (or **national treatment**): in the sense of Artt. 1.3 and 3.1 TRIPs Agreement, each member State shall grant intellectual property rights requested in its territory by nationals of another member States the same protection as granted to national titles[77];
- **Most favored nation**: according to Art. 4 TRIPs Agreement, all benefits concerning intellectual property rights granted to the nationals of another member States shall automatically be extended to all nationals of all TRIPs member States[78].

3.5. *The Design Law Treaty proposal*

Since 2009, WIPO's Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT) has been working on a proposal for a global Design Law Treaty (hereafter "DLT"), aimed at simplifying and harmonizing formalities and proceedings for the cross-border acquisition and protection of industrial design rights by setting out a series of maximum standards and requirements [79]. In order to "*identify*

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[76] Art. 1.3 TRIPs Agreement: *[…] In respect of the relevant intellectual property right, the nationals of other Members shall be understood as those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967), the Berne Convention (1971), the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits, were all Members of the WTO members of those conventions […].*

[77] For Art. 1.3 TRIPs Agreement see the previous note, while Art. 3.1 reads as follows: "*Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection3 of intellectual property, subject to the exceptions already provided in, respectively, the Paris Convention (1967), the Berne Convention (1971), the Rome Convention or the Treaty on Intellectual Property in Respect of Integrated Circuits. In respect of performers, producers of phonograms and broadcasting organizations, this obligation only applies in respect of the rights provided under this Agreement. Any Member availing itself of the possibilities provided in Article 6 of the Berne Convention (1971) or paragraph 1(b) of Article 16 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for TRIPS."*

[78] This principle is derived from the Berne Convention for the Protection of Literary and Artistic Works, adopted in 1886 and last amended in 1979, which is part of the WIPO system.

[79] VOLKEN, *ibidem*, p. 24; BAGLEY M. A., *The Draft Design Law Treaty's Forbidden Words*, in BELDIMAN D. (2024). D*esign Law: Global Law and Practice*. Elgar, p. 1.

possible areas of convergence on industrial design law and practice in WIPO SCT Members, highlighting particular issues to be addressed in that context"[80], the proposal takes into account all existing international instruments concerning designs, including regional protocols and agreement that have come into force since.

While these provisions are merely procedural, as the DLT does not contain a definition of "industrial design" or any other substantial elements, they would enable the applicants to prepare only one set of reproductions for the filing for industrial design protection in all member States of the DLT – thus standardizing the process and rendering it more cost and time efficient[81].

The seemingly irreconcilable differences between developed and developing countries on matters pertaining legal experimentation and development and domestic policy preferences created several rounds of discussions on the need for harmonization within WIPO's SCT, which brought negotiations to standstills for years[82]. Most open issues were resolved after the COVID-19 pandemic, when the need for a more harmonized and streamlined process of recognition and enforcement of industrial property rights – combined with the need for a fast global relaunch of the economy – led WIPO's General Assembly to reach *consensus* over several issues left open.

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[80] WIPO Document SCT/21/4, p. 2, § 1, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_21/sct_21_4.pdf.

[81] STUTZ R. M., *International design law policies: present and future*, in HARTWIG H. (2021*). Research Handbook on design law*. Elgar, p. 439-440.

[82] The most prominent example is the impasse created in 2014 by the African Group on the disclosure of source or origin in relation to design protection. They wanted to implement this requirement in Art. 3 of the draft DLT to ensure proper acknowledgment and designation of origin, in compliance with the African Regional Intellectual Property Organization (ARIPO) Swakopmund Protocol, which provides holders of traditional knowledge and expressions of folklore, also known as traditional cultural expressions, with certain rights and protections in relation to their cultural resources. As this requirement is not found in any other international or regional design agreement and is overall uncommon in national design protection system, it led to several rounds of discussions, proposals and revision to the original text of Art. 3, which only ended in 2022 with the adoption by WIPO's General Assembly of a compromise language.

The final draft of the DLT to be submitted to the Diplomatic Conference, which will be held in Riyadh, Saudi Arabia, from 11 to 22 November 2024, still contains some provisional language and alternative texts in most articles[83]; it will be up to the contracting States to agree upon the definitive text of the Treaty, but it seems likely that the DLT will be ratified by most of WIPO's Member States – finally seeing the light after more than 15 years of work.

[83] The last meetings to discuss the open clauses and the details of the diplomatic conference were held at WIPO's headquarter in Geneva in October 2024; the reports of the Committees, namely the Third Special Session of the SCT and the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT), can be consulted at: https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_10.pdf and https://www.wipo.int/edocs/mdocs/diplconf/en/dlt_2_pm/dlt_2_pm_7.pdf.

CHAPTER II – SUBJECT MATTER AND REQUIREMENTS FOR PROTECTION

For decades, lawmakers have strived to create treaties, regulations and national laws to create a design protection system whose basic elements can be identified worldwide. But *what is design?* Which elements should be considered when looking at a design for it to be considered – and protected – as such?

The answers to these questions differ based on the interpretations provided by national, European and international bodies of law and courts; hence, to provide the most complete overview of the subject matter and the requirements for protection, each element will be analyzed comparatively, underlining both commonalities and differences between the different regulatory levels.

The elements that will be analyzed in the following pages are the definition of design (§ **1**) and of products incorporating it (§ **2**), also looking at the requirements – novelty (§ **3**), individual character (§ **4**), disclosure (§ **5**), and lawfulness (§ **6**)– for a design to be recognized as such and be eligible for protection.

1. The object of protection: design

1.1. Definition of design

The international treaties and agreements referred to in the previous chapter do not provide a uniform definition of design; hence, the definition to which we should refer is the one contained in the Designs Directive and in the Designs Regulation, which has been adopted by all EU Member States[84].

Both Art. 1 (a) Designs Directive and Art. 3 (a) Designs Regulation define a design eligible for protection as

> "*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*"

[84] SANNA, *ibidem,* p. 184.

similarly, Art. 31 (1) CPI states that

> "*Registrations as designs and models may be granted to the appearance of the whole or a part of the product, resulting in particular from the features of the lines, contours, colors, shape, texture or materials of the product or its ornamentation, provided that the same are new and have an individual character*[85]".

Compared to the previous national regulations, the new definition does not require the design to embody an "ornamental" value[86], neither it sets any requirement based on the aesthetic contribution of the design to the product in which it is incorporated[87]: instead, it defines the object of protection as the overall external appearance through which a material object is presented to the public both in its offer for sale and during general use, referring to all the elements that distinguish that product from the other products on the market, regardless of any additional value (be it technical, distinctive, artistic and/or ornamental) the design may add to the product[88].

The protection of the appearance of the product on the market is essential for the very purpose of design protection, which, according to Recital 7 Design Regulation,

> "*Not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production*".

As designs influence the choice of consumers, and since consumer choices influence the development of new products – and therefore of the market and the fair competition between industries - legislators must incentivize producers to create new designs by

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[85] Translation from the original Italian version: "*Possono costituire oggetto di registrazione come disegni e modelli l'aspetto dell'intero prodotto o di una sua parte quale risulta, in particolare, dalle caratteristiche delle linee, dei contorni, dei colori, della forma, della struttura superficiale ovvero dei materiali del prodotto stesso ovvero del suo ornamento, a condizione che siano nuovi ed abbiano carattere individuale"*. The Italian language distinguishes between "designs" and "models", wherein "disegni" only refers to two-dimensional designs, while "modelli" indicates three-dimensional designs. See - FLORIDIA G., SIRONI G.E., *I disegni e modelli*, in AUTERI et al. (2023). *Diritto industriale, proprietà intellettuale e concorrenza*. Giappichelli, p. 345.

[86] See Art. 5 Royal Decree 25 August 1940, n. 1411, Text of legislative provisions on patents for industrial models ("Legge Modelli").

[87] FLORIDIA - SIRONI, *ibidem*, p. 345.

[88] BOSSHARD M. (2015). *La tutela dell'aspetto del prodotto industriale*. Giappichelli, p. 2- 4.

creating an adequate system for protection to the results of aesthetic research applied to the production of marketable objects, while also dictating the limits of said protection in order not to excessively limit industrial and commercial activities[89].

In light of that, the first requirement for a design to fall under the scope of design protection is the incorporation into a material object (principle of materiality or "of sufficient concretization") that falls within a certain product category (principle of product determination)[9091]. The notion of product will be analyzed later[92]; here, it must be highlighted the need for aesthetic creations to access a physical product in order for them to be granted protection as designs, as the system of design protection was created to protect arts applied to industrial products as opposed to copyright, whose object of protection is art in its pure form[93].

Over the years, the link between designs and their material medium has become outdated due to the technological advancements, hence creating the need for a notion of design that could stand the test of time. The Design Package solves this issue by broadening the definition of "design" to include "*movement, transition or any other sort of animation of those features*"[94], a significant leap towards coherence in national registration process and case law on the matter[95].

1.2. Visibility

As established in the previous paragraph, design is defined as "*appearance of the whole or a part of a product*". Recital 11 and 12 to the Designs Directive[96] and by Recital 12 to

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[89] FABBIO, *ibidem,* p. 4.
[90] FABBIO in BERTANI et al., *ibidem,* p. 335.
[91] The aforementioned principles appear to be contradicted by class 32 of the Locarno Classification, which contemplates "*Graphic symbols and logos, surface patterns, ornamentation, arrangement of interiors and exteriors*". Furthermore, Art. 37 Designs Regulation allows for the registration of several designs to be applied to more than one product belonging to the same Locarno Class (so-called "multiple registration") – with the exception of "ornamentation", which shall be deemed protectable regardless of them referring to a specific product.
[92] *Cfr.* § 2 of this chapter.
[93] FABBIO in BERTANI et al., *ibidem,* p. 336. For an updated analysis of copyright protection in Italy and Europe, see BERTANI et al. (2024). *Lineamenti di diritto industriale.* CEDAM.
[94] Art. 2 (3) Proposed Directive and Art. 3 (1) Proposed Regulation.
[95] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 3; HARTWIG H. (2018), *ibidem*, p. 334.
[96] Recital 11 and 12 to the Designs Directive read as follows:
(11) *Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application and made available to the public*

the Designs Regulation[97] clarify this wording through the concept of *visibility*: design protection is only applicable to those elements of a design which are "*visible during normal use of a product*". Additionally, visibility is set as a requirement for the protection of component parts in both Art. 3.3 (a) Designs Directive and Art. 4.2 (a) Designs Regulation, wherein

> "*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* […][98].

However, neither the Designs Directive nor the Designs Regulation establish a definition of *visibility*. Whilst the preparatory works of both documents generally refer to it as what can be perceived by human senses in a broad sense[99], the final documents do not contain any explanation as such, leaving it to the interpretation of courts and authors. In lack of any guidance from the legislator, both EU case law[100] and legal doctrine gravitated towards a definition of *visibility* confined to those characteristics that can be perceived by the eye, while calling for a reform of the definition of design to better encompass the requirement of visibility, since the lack of a clear link between visibility and perceptibility

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by way of publication or consultation of the relevant file;
(12) *Whereas protection should not be extended to those component parts which are not visible during normal use of a product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual char- acter; whereas features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection*.

[97] Recital 12 to the Designs Regulation reads as follows: "*Protection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection*".

[98] For the definition of parts of complex products, *cfr.*below, § 2.3 *et seq.*

[99] For example, § 4.5.7 Green Paper mentions, *inter alia*, textile textures, shapes and materials – with a clear reference to the senses of touch and sight.

[100] EUIPO Third Board of Appeal, judgement of 25 January 2008, R 1391/2006-3 - *Mars UK Ltd./Paragon Products BV (Animal foodstuff)*, § 20 referring to "[…] *all the characteristics which may be perceived visually*".

to the eye had created discrepancies between registration practices amongst EU Member States[101].

Eventually, these demands were met in the Design Package: Art. 15 Proposed Directive and Art. 18 (a) Proposed Regulation confer protection to "*those features of appearance of a registered design which are shown visibly in the application for registration*". Additionally, Recital 38 to the Proposed Directive dictates that the representation of a design may take any visual form, taking into account the technological advances for visualization[102]. These changes were long overdue and have been welcomed by all relevant authors, as they finally identify the object of protection as solely dependent on those elements that are visible in the application, regardless of the product upon which they insist[103].

1.3. First exclusion: features dictated solely by a technical function

Having established the reason behind the adopted definition of design – namely, the protection of those visible features of a product which render it more appealing to the public, hence incentivizing technological research and development to continuously – it is fundamental to identify the elements that fall outside the scope of design protection, as they do not fulfill the goals of the design protection system[104].

The first exclusion is set out in Art. 7 (1) Designs Directive and Art. 8 (1) Designs Regulation (and, consequently, in Art. 36 (1) CPI):

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[101] BRANCUSI L. (2024). *A multi-perspective view on visibility in EU design law.* Journal of Intellectual Property Law, 00(00), p. 2-3, referring to the Economic Review of Industrial Design in Europe (Document MARKT2014/083/D).

[102] Recital 38 to the Proposed Directive read as follows: "*To this effect, it is necessary to provide common rules regarding the requirements and technical means for the clear and precise representation of designs in any form of visual reproduction at filing stage, taking into account technical advance for the visualisation of designs and the needs of the Union industry in relation to new (digital) designs. In addition, Member States should establish harmonised standards by means of convergence of practices*".

[103] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p. 4; BRANCUSI, *ibidem,* p. 3.

[104] Recital 14 to the Designs Directive and Recital 12 to the Designs Regulation point out that "*Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function.* […] *Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection*."

"*A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function*".

It was first introduced by Art. 25 (1) TRIPs Agreement with almost the same wording[105], and its purpose is to limit the monopoly effect of design protection for those features of a product that have no practical alternative[106]: it is considered unquestionable to the point that it has not undergone any update since its first introduction, and it has not been changed in the Design Package as well.

A feature is considered to be "*solely dictated by its technical function*" if, at least on a functional level, there are no equivalent solutions through which the same or a better technical result can be achieved; hence, the essential functional features of that shape are attributable only to the technical result[107].

In that respect, two different positions emerged within the jurisprudence of the CJEU and the legal doctrine:

- According to the "multiplicity of forms" theory, all the different shapes by which an identical technical function can be achieved are eligible for protection as designs[108], regardless of having acquired distinctive character through use or publicization[109]. Following this interpretation, producers should incentivize to find new technical solution for the same product, thus not excessively limiting the scope of design protection[110];

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[105] "*Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations*".
[106] FABBIO, *ibidem*, p. 104 *et seq;* DU MONT J. J., JANIS M.D (2012). *Functionality in design protection systems*. Journal of Intellectual Property Law, 19(2), p. 288.*Cfr.* also note 104 above.
[107] BERTANI M. (2004). *Proprietà intellettuale, antitrust e rifiuto di licenze*. Quaderni di AIDA n. 10, p. 39-40; FABBIO, *ibidem,* p. 206; CJEU, judgement of 18 June 2002, C-299/99 - *Koninklijke Philips Electronics NV/Remington Consumer Products Ltd.*, § 84.
[108] Among the authors who have supported this position, see SANNA, *ibidem,* p. 185; FABBIO, *ibidem,* p. 106-107; Opinion of Advocate General Colomer in Case C-299/99 - *Koninklijke Philips Electronics NV/Remington Consumer Products Ltd.*, § 34
[109] Case C-299/99 - *Koninklijke Philips Electronics NV/Remington Consumer Products Ltd,* § 35; SCUFFI M. (2009). *Diritto processuale della proprietà industriale ed intellettuale*. Giuffrè, p. 594.
[110] To the contrary, design protection would have been reserved to those elements who are purely "ornamental", leaving solely up to patents and utility models the protection of alternative design elements based on the same technical function. With that regard, see FLORIDIA - SIRONI, *ibidem*, p. 349.

- Recently, the CJEU has adopted a different interpretation, according to which any and all design features that are significantly affected by technical and functional necessities, with minor to no room for choices based on the appearance of the product and the requirements of novelty and individual character, shall be excluded from registration[111]. This new "sufficient causation" theory appears to be more coherent with the purported scope of registered designs compared to other forms of industrial property protection applicable to technological inventions (*e.g.* patents and utility models): technology contributions alone should not obtain an exclusive right on the basis of a protection characterized by conditions and discipline extraneous to it, as it would be if the features "*solely dictated by its technical function*" could qualify as designs[112], because a situation as such would create the very monopolies on technological innovation Art 8 (1) Designs Regulation was made to prevent[113].

1.4. Second exclusion: design of interconnections

The second exclusion is related to the first in the sense that it concerns features solely dictated by their technical function, namely the design of interconnections or *must fit*

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[111] CJEU, judgement of 8 March 2018, C-395/16 - *Doceram GmbH/CeramTec GmbH*, § 31: "*it must be held that Article 8(1) of Regulation No 6/2002 excludes protection under the law on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist*". *Cfr.* also Opinion of Advocate General Saugmandsgaard Øe in the same case, § 40-41; RICOLFI M. (2019). *Le "caratteristiche tecniche dell'aspetto di un prodotto determinate unicamente dalla sua funzione tecnica" nella giurisprudenza europea in tema di disegni e modelli*. Rivista di diritto industriale, III, p. 189-191; HARTWIG H. (2019). *Contemplating the state of European Design Law….* Journal of Intellectual Property Law, 14(12), p. 977-978.

[112] RICOLFI, *ibidem*, p. 190

[113] CJEU, judgement of 8 March 2018, case C-395/16 - *Doceram GmbH/CeramTec GmbH*, § 30: "[…] *if the existence of alternative designs fulfilling the same function as that of the product concerned was sufficient in itself to exclude the application of Article 8(1) of Regulation No 6/2002, a single economic operator would be able to obtain several registrations as a Community design of different possible forms of a product*

incorporating features of appearance of that product which are exclusively dictated by its technical function. That would enable such an operator to benefit, with regard to such a product, from exclusive protection which is, in practice, equivalent to that offered by a patent, but without being subject to the conditions applicable for obtaining the latter, which would prevent competitors offering a product incorporating certain functional features or limit the possible technical solutions, thereby depriving Article 8(1) of its full effectiveness". Also, RICOLFI, *ibidem,* p. 189-191; RICOLFI M. (2019). *La forma del prodotto nella giurisprudenza europea recente*. Rivista di diritto industriale, VI, 526-527.

elements. Art. 7 (2) Designs Directive and Art. 8 (2) Designs Regulation (with the same wording adopted also by Art. 36 (2) CPI) define "*interconnections*" as

> "(the) *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".*

Designs of *must fit* components fall out of the scope of design protection because, although at first they may stem from a creative process, once established they ought to be reproduced in their exact characteristics in order to allow for a union or connection between products; therefore, it is necessary for any producer of compatible or replacement products to the original one to replicate the interconnection without any limitation[114].The reasoning behind this exclusion is, once again, to avoid any hindrance to the development and sale of elements that can be connected and operated together with already-established products, as the granting of such protection would have significant monopoly effects on the market[115].

This provision is aimed at excluding from protection the sole interconnection: all products, accessories and component which – as the name suggests - *must fit* together with a pre-existing product via an interconnection can be eligible for protection if they have all other requirement for protection[116].

1.4.1. Exclusion to the exclusion: modular systems

Both Art. 7 Designs Directive and Art. 8 Designs Regulation end on a clarification:

> "*Notwithstanding paragraph 2, a design right shall […] subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system*".

[114] GUGLIELMETTI, *ibidem,* p. 25; SANNA, *ibidem,* p. 185.
[115] FLORIDIA - SIRONI, *ibidem*, p. 350.
[116] GUGLIELMETTI*, ibidem*, p. 26.

This indicates that designs of interconnections of modular products are eligible for protection, since the European legislator holds them as "*an important element of the innovative characteristics of modular products and present a major marketing asset*"[117].

A system of elements is considered "modular" if it fulfills the following requirements:

1) Interchangeability: the components can be replaced one another without alteration to the final visual effect;
2) Multiple union: the components can be rearranged to alter the final visual effect of the ensemble;
3) Assemblability into one system: each individual component can be arranged by the final user with all other components of the same system[118].

The most cited example of a modular system is LEGO bricks: each brick is made to be connected to other pieces within the same homogenous system, not with a different compatible product[119]. Therefore, in case of modular systems, the design of interconnections between individual components does not represent a limitation to the protection of the design, as such an exclusion would allow competitors to imitate not only the *must fit* element, but the entire modular system[120].

2. Product

2.1. Definition of product and requirements

After defining "*design*" as "*the appearance of the whole or a part of a product*", Art. 1 (b) Designs Directive and Art. 3 (b) Designs Regulation (and Art. 31 (2) CPI) state that

> "*'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*".

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[117] Recital 15 to the Designs Directive and Recital 11 to the Designs Regulation.
[118] FABBIO, *ibidem,* p. 111; GUGLIELMETTI, *ibidem*, p. 25.
[119] Among others, SANNA, *ibidem*, p. 186; FABBIO, ibidem, p. 111; FLORIDIA - SIRONI*, ibidem,* p. 350. As Lego has undergone several judgements in different EU countries and courts over almost three decades, reaching such a level of notoriety that it is used as an example by all relevant authors on the matter, it is not necessary to mention a specific judgement.
[120] FLORIDIA - SIRONI*, ibidem*, p. 350; FABBIO in BERTANI et al., p. 344.

As stated before[121], this provision reflects the traditional destination of design protection to industrial art; additionally, it excludes any object which is not the direct result of human intervention, such as natural or causal products – or even products applied to the human body, such as tattoos or hairdos[122].

A product is, therefore, any industrial or handicraft item, regardless of the means of production or the quantity in which it is reproduced[123]; according to the principles of materiality and of product determination, a product falling under this definition on which a design is applied must be indicated in the request for protection of the design itself in order for the latter to be eligible for protection[124].

This definition has been long considered outdated due to the need for incorporation in a material object, which limits the scope of protection to the elements of the product that are visible during usage, and due to the exclusion from the definition of new products resulting from the technological advancement[125]. The EU legislator has addressed these issues by proposing a new definition of "product" in the Design Package, now referring to "*any industrial or handicraft item other than computer programs, regardless of whether it is embodied in a physical object or materialises in a digital form, including:*

> *(a) packaging, sets of articles, get-up, spatial arrangement of items intended to form, in particular, an interior environment, and parts intended to be assembled into a complex product;*

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[121] *Cfr.* above, § 1.1
[122] FABBIO, *ibidem*, p. 9-10. As the author underlines in § 3.2, the object of protection is any aesthetic innovation which contributes to the sales value of a product and indirectly encourages its production. In this setting, granting protection to products applied to the human body would restrict innovation in this field. Moreover, such protection would lead to a discussion concerning their very nature, which some authors, such as FABBIO, consider to be services rather than products. In any case, his interpretation would confirm the exclusion of such services from EU design protection, as the latter is only applicable to products. For the reasoning behind the exclusion of services from the scope of application of European Design Law, see BOSSHARD, *ibidem,* p. 4-5.
[123] Reproducibility is an implied requirement for a product upon which a design exists: if the product, and consequently its appearance, cannot be reproduced, there is no risk of counterfeiting, thus no need for protection
[124] *Cfr.* above, § 1.1
[125] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p. 7-8.

(b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces […]"[126].

Although the most relevant authors on the matter are not satisfied with the seemingly baseless exclusion of computer programs, they praise the ability of this new definition to stand the test of time by including instances in which a product is indiscernible from its appearance, its only dimension [127].

2.2. Complex products

Art. 1 (c) Designs Directive and Art. 3 (c) Designs Regulation (as well as Art. 31 (3) CPI) conclude by defining as complex any product "[…] *composed of multiple components which can be replaced permitting disassembly and re-assembly of the product*". This specification is not aimed at affirming the eligibility of complex products for design protection, but rather serves the purpose of introducing the issue of protecting their components under a single filing request[128].

In order to determine whether a group or series of objects can be considered as a single product, the criterion of physical unity must be taken into account [129]; in lack of the former, components are considered as one if:

- They are presented to the observer in such a manner as to be considered complementary – or at least united by the same aestethic quality ("aestethic unity"); and
- They are meant to be used and sold together ("functional unity")[130].

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[126] Art. 3 (2) Proposed Regulation and Art. 2 (4) Proposed Directive.
[127] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 8-9. As for the exclusion of computer programs, the Max Planck Institute note that " […]*from a public domain perspective, it is rather unlikely that the visual appearance of a code, just as that of any other form of text, will be new or have individual character.* […] *While digital designs (Articles 3(2) PDEUR and 2(4) PDDir) and use related to software (Articles 19(2)(d) PEUDR and 16(2)(d) PDDir) do not concern the visual appearance of a software code as such, the exclusion of computer programs in Articles 3(2) PEURDR and 2(4) PDDir could lead to misunderstandings as to the meaning and scope of these provisions. To minimise confusion, the exclusion could be dropped from the definition.*"
[128] FABBIO, *ibidem*, p. 11.
[129] A similar criterion to physical unity is that of legal unity: *e.g.*, the law may consider the components of a car as a group of objects merging into a single product.
[130] *E.g.,* a teapot set with cups, a men's suit, and set of chess pieces are all considered complex products.

If a set of objects is united either physically or aesthetically and functionally, they fall under the definition of and are eligible for protection as a complex product[131].

This aspect of design protection is generally agreed upon: it has not been significantly discussed neither by authors nor by courts, nor it has undergone any alteration in the Design Package[132].

2.3. Parts of complex products

On the other hand, the issue of the autonomous protection of parts of complex products has been at the center of the debate on design protection both on a European and on a national level for years before the introduction of the Designs Directive, which has mainly revolved around the regulation of parts of complex products as an exception or as a special discipline within the design protection system[133]. The discussion has been widespread to the point that legal literature on the matter largely surpasses that of any other aspect of design protection[134]: here, the focus will be set on the most important and recent contributions, both from authors and from courts, in order to provide a cohesive overview of the existing legislation and its prospected amendments and updates.

Based on the definition in Art.1 (c) Designs Directive, Art. 3 (c) Designs Regulation, and Art. 31 (3) CPI, a part of a complex product is any component "*which can be replaced permitting disassembly and re-assembly of the product*", with minimal effect to the

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[131] FABBIO, *ibidem*, p. 12.
[132] Art. 2 (5) Proposed Directive and Art. 3 (3) Proposed Regulation repeat verbatim the provision in the Designs Directive and the Designs Regulation, with no additional comments or suggestions.
[133] These opposite perspectives originate from a different interpretation of Art. 26 (2) TRIPs Agreement: "*Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties*". Before the implementation of EU Design Law, Italy and several other countries interpreted it as excluding *tout court* protection of components and spare parts (*e.g.* body panels of cars, which in Italy were excluded from protection due to their inability to be patented separately as ornamental utility models in the sense of the old Legge Modelli – *cfr.* GUGLIELMETTI*, ibidem*, p. 5-7; FRASSI P. A. E. (2003*). Registrazione come disegno o modelli di parti di prodotti complessi e clausola di riparazione*. Rivista di diritto industriale, II, p. 95-97). To the contrary, the Designs Directive affirmed the principle of protection of component parts by setting out the criteria for their protection – hence, confirming that parts of complex product represent a special discipline within the design law system. *Cfr.* FABBIO, *ibidem*, p. 87.
[134] FABBIO, *ibidem*, p. 86.

physical integrity of the component itself (which may be soldered, glued or fixed with nails or screws onto the main object)[135].

This provision serves as a base for the application of Art. 3 (3) Designs Directive and Art. 4 (2) Designs Regulation (and of Art. 35 CPI), which, consistently with the goals of European Design Law[136], establish that:

"*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".

Additionally, the final paragraphs to both articles specify the meaning of "*normal use*" as the "*use by the end user, excluding maintenance, servicing or repair work[137]*".

This wording has not been recast neither in the Design Package: in light of the interpretation provided by courts and authors, and together with the amendments to other complex-product-related provisions, it is considered clear and up to date by the European legislator.

2.3.1. Specific requirements for protection

The aforementioned paragraphs of Art. 3 Designs Directive and Art. 4 Designs Regulation infer the specific requirements for protection of parts of complex products, namely visibility during normal use and autonomy.

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[135] FABBIO, in BERTANI et al., *ibidem*, p. 343.
[136] Recital 12 to the Designs Directive and Recital 12 to the Designs Regulation both state that "*protection should not be extended to those component parts which are not visible during normal use of a product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual char- acter; whereas features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection*".
[137] Art. 3 (4) Designs Directive and Art. 4 (3) Designs Regulation, referring respectively to Art. 3 (3)(a) Designs Directive and Art. 4 (3)(a) Designs Regulation.

The visibility criterion is coherent with the goals of design protection: as established above,[138] and as confirmed by the European courts, a design constituting a component of a complex product is eligible for protection only if it remains visible during "normal use", meaning the duration in which the complex product is functioning or is being operated by the end user. The sole elements that remain visible to the end user over the normal use of the complex product are deemed to influence the overall appearance of the product and, consequently, the choices of the buyer based on aesthetic preferences[139]. The requirement is also fulfilled if the product can serve alternative purposes to the "normal" one, even if the component is not visible during all possible ways of usage[140].
The legislator specifically excludes from this criterion all usage of the complex product aimed at its maintenance, servicing or repair, since during these operations the object is not serving the purpose for which it is marketed.[141]

The autonomy criterion requires for the visible element of the component to fulfill the two main requirements for design protection: novelty and individual character[142]. According to the predominant interpretation, these two requirements must be assessed by comparing the visible elements of the component to other components, regardless of the appearance of the final or assembled product: if the part is clearly defined by features which constitute its particular appearance (*e.g.* particular lines, contours, colours *etc.*), and it can be used separately from or adds a particular aesthetic value to the original complex product, then the component can obtain protection[143].

The CJEU has further specified that, if "*a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture*" fulfills

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[138] *Cfr.* § 1.2
[139] EUIPO Third Board of Appeal, 4 August 2009, case R 1276/2008-3 - *Albright France SARL/Schaltbau GmbH*, § 45 *et seq.*; EU General Court (First Chamber), judgement of 9 September 2011, case T-10/08 - *Kwang Yang Motor Co. Ltd/ OHIM - Honda Giken Kogyo Kabushiki Kaisha(internal combustion engine)*, § 20-22: "*The applicant has accepted that the challenged design constituted an internal combustion engine which could be incorporated into a lawnmower. Therefore, it must be considered that the challenged design constitutes a component part of that complex product* […]. *During the normal use of a lawnmower, it is placed on the ground and the user stands behind the lawnmower. Thus, the user, standing behind the lawnmower sees the engine from the top and therefore sees principally the upper side of the engine*".
[140] FABBIO, *ibidem*, p. 94-95
[141] EUIPO Third Board of Appeal, 4 August 2009, case R 1276/2008-3 - *Albright France SARL/Schaltbau GmbH*, § 49.
[142] These two requirements will be discussed later in this chapter - see § 3 and 4.
[143] GUGLIELMETTI, *ibidem*, p. 8-9; FABBIO, *ibidem*, p. 96-97.

these two criteria, it "*is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole*", hence being eligible for design protection as a component part of a complex product[144].

2.3.2. Must-match components and repair clause

Within the issue of parts of complex products lies another issue: that of the replacement components which do not have any technical function or interconnection, but whose appearance must necessarily replicate that of the original component in order to restore the original aspect of a complex product – the so-called spare or *must-match* parts.

Art. 14 Designs Directive lays out a transitional provision concerning the production and sale of spare or *must-match* components:

> *"Until such time as amendments to this Directive are adopted on a proposal from the Commission in accordance with the provisions of Article 18[145], Member States shall maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance and shall introduce changes to those provisions only if the purpose is to liberalise the market for such parts".*

This transitional provision is better known as the "*freeze-plus clause*", in reference to the standstill to which it led in the national and European regulation of such components[146].

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[144] CJEU, judgement of 28 October 2021, case C-123/20 - *Ferrari S.p.A/Mansory Design & Holding GmbH and WH*, § 49-52. See also Opinion of Advocate General Saugmandsgaard Øe, § 116: "[…] *the part of a product must notably be defined by its particular appearance – its lines, contours, colour, etc. In short, there must be a design that is identifiable as such and capable in itself of being subject to the assessment of the conditions for obtaining protection. I can therefore share the referring court's assessment that the appearance of the part must be capable of producing in itself an 'overall impression' and cannot therefore be completely lost in the overall impression produced by the product. A Community design not meeting that definition would have to be declared invalid– or, more precisely, non-existent*". In its opinion, the Advocate General seems to reject the application of the criteria of visibility and autonomy as, in § 112, he states " […] *I am somewhat reluctant to accept the idea of introducing, by means of interpretation and in an area as delicate as that of the Community design, unwritten criteria such as 'autonomy' or 'consistency' to define the parts of a product whose appearance may be the subject of specific protection*": however, these criteria – which are expressly set forth in art. Art. 3 (3) Designs Directive and Art. 4 (2) Designs Regulation (*cfr.* above, § 2.3) – are referred to by the Court in § 29 of the decision, consistently with the legal doctrine and the jurisprudence on the matter (*cfr.* note 141 and 143).

[145] Art 18 concerns revisions to the Directive itself, which was set to take place three years after its entry into force.

[146] GUGLIELMETTI, *ibidem*, p. 14-15. KUR A., GYÖRGY A., *Protection of spare parts in design law: a comparative law analysis*, in HARTWIG H. (2021). Research Handbook on design law. Elgar, p. 306-307.

When discussing whether to allow for spare parts to be eligible for European design protection, the European Commission considered two opposing issues. On the one hand, prohibiting independent manufacturers from replicating the exact appearance of these components, even when not technically needed, would create a monopoly in favor of the original manufactures, as no compatible alternatives could ever be created and sold. On the other hand, if the replication of *must-match* features was broadly allowed, manufacturers of complex products would lose their exclusive market position and the ability to control aftermarket pricing. Any effort to reach a compromise between the Member States and the industry sectors involved – namely, manufacturers and producers of spare parts, especially in the automotive industry – fell through; eventually, the Commission opted for the *freeze-plus* rule to prevent further issues, postponing the solution to a later date[147]. Despite repeated efforts of the European Commission, a compromise was not reached until the proposal of the Design Package, which finally achieves harmonization[148].

The solution adopted by Art. 19 (1) Proposed Regulation and Art. 20a (1) Proposed Regulation is the so-called *repair clause*, based on Art. 110 (1) Designs Regulation:

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[147] The reasoning behind the *freeze-plus clause* is laid out (in a rather detailed manner) in Recital 19 to the Designs Directive: "*Whereas the rapid adoption of this Directive has become a matter of urgency for a number of industrial sectors; whereas full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent, cannot be introduced at the present stage; whereas the lack of full-scale approximation of the laws of the Member States on the use of protected designs for such repair of a complex product should not constitute an obstacle to the approximation of those other national provisions of design law which most directly affect the functioning of the internal market; whereas for this reason Member States should in the meantime maintain in force any provisions in conformity with the Treaty relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance, or, if they introduce any new provisions relating to such use, the purpose of these provisions should be only to liberalise the market in such parts; whereas those Member States which, on the date of entry into force of this Directive, do not provide for protection for designs of component parts are not required to introduce registration of designs for such parts; whereas three years after the implementation date the Commission should submit an analysis of the consequences of the provisions of this Directive for Community industry, for consumers, for competition and for the functioning of the internal market; whereas, in respect of component parts of complex products, the analysis should, in particular, consider harmonisation on the basis of possible options, including a remuneration system and a limited term of exclusivity; whereas, at the latest one year after the submission of its analysis, the Commission should, after consultation with the parties most affected, propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of com- ponent parts of complex products, and any other changes which it considers necessary*".

[148] KUR – GYÖRGY, *ibidem*, p. 306-308; KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 17.

"*Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, 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*[149]".

Community designs covered by this provision are not protected when *must-match* features are reproduced for repair purposes, regardless of whether the national law of the Member State where the design is being enforced includes a repair clause. Consequently, manufacturers of complex products must register their designs nationally to ensure protection in those Member States where such protection is available under national law.

So far, a similar *repair clause* has been implemented in Ireland, Belgium, the Netherlands, Luxemburg, Spain, Italy, Hungary, Latvia and Poland: in these EU Member States, aftermarket supplier associations have successfully carried forward their battle for liberalization for years with the support of national courts[150]. Following the entry into force of the Design Package, Member States whose national design protection concerning *must-match* features had been "frozen" by the *freeze-plus* clause (*e.g.* France and Germany), in addition to those opposing an exclusion of spare parts from design protection, will implement the *repair clause* in their national design legislation as well[151]. However, to allow for the adaptation of national laws to the *repair clause* and for its

[149] Art. 19 (1) Designs Regulation concerns the right conferred by the design: "*A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, 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*". The exclusive rights conferred by registered designs will be analyzed in chapter III.

[150] For instance, the repair clause enshrined in Art. 241 CPI reads as follows: "*Until Directive 98/71/EC of 13 October 1998 of the European Parliament and the Council, on legal protection of designs and models, is amended* […], *the exclusive rights on the components of a complex product shall not be invoked to prevent the manufacture and sale of the components themselves for the repair of a complex product, in order to restore the original appearance*". Both authors and courts have confirmed the pro-competition nature of this clause especially in the aftermarket resale of body panels and cars – *cfr.* Naples Court of Appeal, judgement of 22 October 2013 - *BMW/Acacia srl and Codacons Campania Onlus*; comment by SANDRI S. (2014). Clausola di riparazione e cerchioni di autoveicoli. Il diritto industriale, I, p. 70-84.

[151] Briefing of the European Parliament "Revision of the EU legislation on design protection", p. 4,6; KUR-GYÖRGY, *ibidem*, p. 310-311.

application to pending registration processes, its entry into effect can be postponed until ten years from the entry into force of the Directive[152].

Having established that *must-match* parts can be freely reproduced in its original appearance by third-party producers, the EU legislator introduces a new provision aimed at protecting the commercial interests of manufacturers and sellers of original components in Art. 19 (2) Proposed Directive and Art. 20a (2) Proposed Regulation:

> "*Paragraph 1 cannot be invoked by the manufacturer or the seller of a component part of a complex product who failed to duly inform consumers, through a clear and visible indication on the product or in another appropriate form, about the origin of the product to be used for the purpose of the repair of the complex product, so that they can make an informed choice between competing products that can be used for the repair*".

This follows the recent jurisprudence of the CJEU, establishing that independent manufacturers of spare parts must inform the end user through a clear and visible indication on the product, its packaging, catalogues, or sales documents, that the component in question incorporates a design they do not own, and that the part is solely intended for use in repairing the complex product to restore its original appearance[153]. Additionally, the Court has clarified that the application of the *repair clause* cannot go to the detriment of other industrial property rights, *e.g.* by affixing the registered trademark of the original manufacturer to third-party components[154]

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[152] Art. 19 (3) Proposed Directive states as follows: "*Where at the time of adoption of this Directive the national law of a Member State provides protection for designs within the meaning of paragraph 1, the Member State shall, by way of derogation from paragraph 1, continue until ten years from the date of entry into force of this Directive] to provide that protection for designs for which registration has been applied before the entry into force of this Directive*". See also KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 18; KUR – GYÖRGY, *ibidem*, p. 310.

[153] CJEU, judgement of 20 December 2017, joint cases C-397/16 and C-435/16 - *Acacia and D'Amato / Audi AG and Porsche AG*, § 86 *et seq.* In this case, concerning ally car wheel rims, the court held that "*the manufacturer or seller of a component part of a complex product are under a duty of diligence as regards compliance by downstream users with the conditions laid down in that provision*", meaning that, in order to enjoy freedom of reproduction of the *must-match* component, the aftermarket producers has a duty to disclose to the end user that the product is not original and that it is only intended to restore the original appearance of the complex product whose design belongs to the original manufacturer. See also KUR – GYÖRGY, *ibidem*, p. 308-309.

[154] CJEU, judgement of 6 October 2015, case C-500/14 - *Ford Motor Company/Wheeltrims srl (wheel covers*), in which the Court held that "*Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002*

To conclude this overview, reference shall be made to Art. 26 (2) TRIPs Agreement, which states that

> "*Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties*".

The compatibility of the *repair clause* to this provision – and therefore to the TRIPs system of IP protection - must be assessed using the three requirements set forth by the provision itself:

1) The *repair* clause represents a "*limited exception to the protection of industrial designs*" because it addresses the specific, rare situations where customers cannot choose alternative designs;
2) The exclusion from protection of *must-match* components does not *"unreasonably conflict with the normal exploitation of protected industrial designs*", since it is consistent with the fact that most WTO members exclude exploitation of design rights on spare parts from third-party manufacturers or resellers through repair clauses or functionality exclusions;
3) Lastly, the "*legitimate interests of the owner of the protected design*" is unreasonably impacted as long as their ability to recover investments in the primary market remains intact. As for "*the legitimate interests of third parties*", limiting rights related to spare parts balances the interests of third parties, such as aftermarket competitors, and consumers who benefit from lower prices[155].

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must be interpreted as not allowing, by way of derogation from the provisions of Directive 2008/95 and Regulation No 207/2009, a manufacturer of replacement parts and accessories for motor vehicles, such as wheel covers, to affix to its products a sign identical to a trade mark registered for such products inter alia by a producer of motor vehicles, without obtaining the latter's consent, on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance". See also FLORIDIA - SIRONI, *ibidem*, p. 347; ALVANINI S. (2015). Un apparente epilogo della guerra tra ricambisti indipendenti e case automobilistiche. Il diritto industriale, VI, p. 583-590.

[155] KUR – GIÖRGY, *ibidem,* p. 339-341; SANDRI, *ibidem,* p. 71.

In light of these considerations, the *repair clause* to be implemented by the Proposed Directive and the Proposed Regulation represents the most coherent solution to the *must-match* parts issue considering both the existing national, European and international Design Law system and the specific instances of all parties and industry sectors involved – finally putting and end to a debate lasted more than three decades[156].

3. Novelty

Art. 3 (2) Designs Directive and Art. 4 (1) Designs Regulation establish that

> "*A design shall be protected by a design right to the extent that it is new and has individual character*"[157].

These requirements for protection were first indicated in Art. 25 TRIPs Agreement[158] and have since been transposed in the national legislation of EU Member States; in Italy, they are found in the last part of Art. 31 (1) CPI[159].

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[156] The interests of all parties involved within the purpose of the system of design protection are directly taken into account in Recital 33 and to the Proposed Directive: "(33) *The purpose of design protection is to grant exclusive rights to the appearance of a product, but not a monopoly over the product as such. Protecting designs for which there is no practical alternative would lead in fact to a product monopoly. Such protection would come close to an abuse of the design protection regime. If third parties are allowed to produce and distribute spare parts, competition is maintained. If design protection is extended to spare parts, such third parties infringe those rights, competition is eliminated and the holder of the design right is de facto given a product monopoly.* […] (35) […] *As the intended effect of such repair clause is to make design rights unenforceable where the design of the component part of a complex product is used for the purpose of the repair of a complex product so as to restore its original appearance, the repair clause should be placed among the available defences to design right infringement under this Directive. In addition, in order to ensure that consumers are not mislead but are able to make an informed decision between competing products that can be used for the repair, it should also be made explicit in the law that the repair clause cannot be invoked by the manufacturer or seller of a component part who have failed to duly inform consumers about the origin of the product to be used for the purpose of the repair of the complex product*".

[157] *Cfr.* also Recital 9 to the Designs Directive: *"Whereas the attainment of the objectives of the internal market requires that the conditions for obtaining a registered design right be identical in all the Member States; whereas to that end it is necessary to give a unitary definition of the notion of design and of the requirements as to novelty and individual character with which registered design rights must comply*"

[158] The first two periods of Art. 25 (1) TRIPs Agreement state as follows: "*Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features*".

[159] Art. 31 (1) CPI reads as follows: "*Registrations as designs and models may be granted to the appearance of the whole or a part of the product, resulting in particular from the features of the lines, contours, colors, shape, texture or materials of the product or its ornamentation, provided that the same are new and have an individual character*".

Due to the unclear wording of Art. 25 (1) TRIPs Agreement and to the interpretation of the provision by some national courts, part of the legal doctrine is convinced that the requirement of novelty lacks independence from that of individual character, with its presence in legal text being justified as a residue of outdated norms and proposals[160]. In reality, European courts have repeatedly established the autonomy of the two requirements, as both shall exist for a design to be eligible for protection and must be invoked and assessed separately during judgements[161]. Additionally, a two-step verification of a design based on two separate, subsequntial requirements prevents design protection from being too easily accessible, hence proving the effectiveness of novelty, to be assessed before individual character, in granting a fair and selective access to design protection[162]. Therefore, the following paragraphs will analyze the two requirements independently, explaining the differences between them and the methods of assessment used by courts.

Before proceeding with the analysis of the two requirements, a first common consideration shall be made. As anticipated when commenting the definition of design[163], both novelty and individual character depend on whether the same visible design has already been incorporated in a product falling under the same category (principles of materiality and of product determination) and/or whether the design has already been registered or made availabe to the public[164]. This – along with the considerations that will follow – is consistent with the scope of both European and international design law, which is to provide legal certainty to holders of design rights (namely, designers and manufacturers) while also incentivizing technological and industrial advancement[165]. Moreover, none of the provisions concerning novelty and individual character have undergone any alteration in the Design Package, thus further confirming the coherence of

[160] FABBIO in BERTANI et al., ibidem, p. 338; VOLKEN, *ibidem*, p. 11-12.
[161] EUIPO Third Board of Appeal, judgement of 2 November 2010, case R 1451/2009-3 - *Antrax IT srl/ The Heating Company BVBA (Radiators for heating)*, § 21.
[162] FABBIO, *ibidem*, p. 20-21; EUIPO Third Board of Appeal, judgement of 25 January 2008, R 1391/2006-3 - *Mars UK Ltd./Paragon Products BV (Animal foodstuff)*, § 24.
[163] *Cfr.* above, § 1.1 and 1.2 of this chapter.
[164] *Cfr.* Art. 4 and 5 (1) Designs Directive and Art. 5 (1) and Art. 6 (1) Designs Regulation (and Art. 32-33 CPI). Disclosure will be discussed in § 5 of this chapter, while priority will be commented in the following chapter, as it strictly concerns the process of designs registration.
[165] FABBIO, *ibidem*, p. 21.

the current definitions and requirements for novelty and individual character to the design protection system[166].

Starting with novelty, according to Art. 4, first period Designs Directive and Art. 5 (1) (b) Designs Regulation (and Art. 32 CPI)

> "*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.*"[167].

Based on this definition, novelty is distinguished from individual character based on its more straightforward nature: the registration or publicization of a design which is identical to the one requested for registration, meaning that their appearance is completely the same or indistinguishable from one another, destroys the novelty of the later design[168]. Consequently, due to its narrow and objective nature, the test for novelty is the first one to be conducted, as it solely depends on whether the contested design is identical to the prior one(s) to which it is compared; its goal is to swiftly solve simple and obvious cases while leaving the more complex ones to individual charater – whose assessment, as it will be explained later, is more general and depends on several subjective elements[169].

3.1. Immaterial differences

The articles on novelty of both the Designs Directive and the Designs Regulation (and of the CPI) end on a clarification concerning the practical assessment of the novelty requirement:

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[166] Both Artt. 4-5 Proposed Directive and Artt. 5-6 Designs Regulation are identical to their counterpart in the current Designs Directive and Designs Regulation.
[167] Additionally, Art. 5 (1) (a) Designs Regulation states that novelty is also present "*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*". The protection of unregistered designs will be touched upon in the last chapter since, apart from a few *ad hoc* provisions, the subject matter and the assessment of the requirements of novelty and individual character is the exact same as for registered designs. In this sense, BOSSHARD, *ibidem*, § 3, p. 5.
[168] EUIPO Third Board of Appeal, judgement of 2 November 2010, case R 1451/2009-3 - *Antrax IT srl/ The Heating Company BVBA (Radiators for heating)*, § 31; FABBIO, *ibidem*, p. 20
[169] Ireland High Court, judgement 449 of 21 December 2007 - *Karen Millen Ltd./Dunnes Stores (Limerick) Ltd.*, § 19; FABBIO, *ibidem*, p. 20; VOLKEN, *ibidem,* p. 13. Individual character and its elements will be commented in § 4 of this chapter.

"*Designs shall be deemed to be identical if their features differ only in immaterial details*"[170].

The meaning of "*immaterial detail*" has been specified by European courts and authors as referring to:

1) Elements that are extraneous or accessory to the project of the design, such as a stamp, a product code or a quality mark[171];
2) Features that are necessary for the construction or adaptation of the design[172];
3) Details that tend to go unnoticed in the overall economy of the design, due to their size, position, visibility or application to parts of the product that are irrelevant to the consumer or that can only be observe by adopting an unusual point of view[173].

Thus, when it comes to comparing two designs to establish whether the later one is new, they are considered identical regardless of any difference in features that are deemed as immaterial.

3.2. How is novelty assessed?

As anticipated above, the assessment on novelty or lack thereof is objective and "abstract": the comparison between the requested design and all opposed priority is

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[170] Art. 4, last period Designs Directive and Art. 5 (2) Designs Regulation, which has been transposed *verbatim* in Art. 4, last period Proposed Directive and in the Proposed Regulation.
[171] EUIPO Third Board of Appeal, judgement of 25 July 2009 - *Harron SA/THD Acoustic Ltd. (MP3 player recorder)*, § 18; EUIPO Third Board of Appeal, judgement of 2 November 2010, case R 1451/2009-3 - *Antrax IT srl/ The Heating Company BVBA (Radiators for heating)*, § 32: "*The concept of 'immaterial details' must be interpreted restrictively if the identity requirement of the first paragraph is not to be deprived of meaning. Design differences cannot in principle be classed as 'immaterial details'. An 'immaterial' detail is one that is not intrinsic to the design as such but extraneous or accessory thereto. An immaterial detail might be, for example, the presence of a sign stamped on a design, such as a product code or quality mark. In such a way that, if the two designs differ only by the presence of that sign – and it is clear that the stamp does not form part of the design – they must be considered, despite this difference, identical in accordance with the second paragraph*".
[172] SANNA*, ibidem*, p. 191
[173] FABBIO in BERTANI et al., *ibidem*, p. 339; EU General Court (Third Chamber), judgement of 18 March 2010, case T-9/07 - *Grupo Promer Mon Graphic SA/ OHIM - PepsiCo Inc.*, § 72 *et seq*. To the contrary, the EUIPO Third Board of Appeal has considered the difference in color shade between two products as material in judgement of 7 December 2010, case R 803/2009-3 - *C&G Carandini SA/Fundició Dúctil Benito SL (Luminaires)*, § 15-16.

strictly based upon a mechanical evaluation, regardless of the characteristics of the subject conducting it[174].

On the one hand, when abstactly assessing the novelty of a design the test shall be carried out in the sense of Art. 4, first period Designs Directive and Art. 5 (1) (b) Designs Regulation (and Art. 32 CPI): the design is to be compared to the *prior art*, meaning all previous designs which have either been registered or made available to the public before the disclosure of the design in question[175]. Nonetheless, in order to protect both designers and manufacturers from the so-called *obscure prior art*, the event of disclosure is irrelevant if, in the sense of Art. 6 (1) Designs Regulation and Art. 7(1) Designs Regulation (and Art. 34 (1) CPI), it "*could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community*"[176].

On the other hand, novelty in the sense of lack of identity between two designs is evaluated on a one-on-one basis: the test is conducted by juxtaposing the questioned design to each opposed priority separately, and the final judgement shall be based on whether the sum of the characteristics of the later design produces amount to a design identical to the prior one(s) to which it is compared[177]. Of course, the features that come into play during the test are, for the contested designs, those that are requested for protection, and, for each prior design, all elements (registered and/or unregistered) that could be subject to design protection[178].

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[174] FABBIO, *ibidem*, p. 26.
[175] DI CATALDO, *ibidem*, p. 72; FABBIO, *ibidem,* p. 21.
[176] VOLKE, *ibidem*, p. 14-15. The concept of "disclosure" will be further analyzed later (*cfr*. § 5 of this chapter)
[177] DI CATALDO, *ibidem,* p. 72; FABBIO in BERTANI et al., *ibidem*, p. 338; EUIPO Third Board of Appeal, judgement of 25 January 2008, R 1391/2006-3 - *Mars UK Ltd./Paragon Products BV (Animal foodstuff)*, § 18 *et. seq*. In this case, The Board of Appeal contested the way the Invalidity Division carried out the identity test: in fact, the Invalidity Division compared each contested feature one by one, disregarding the fact that the main characteristics of both products were the exact same, and those different features (that the Division considered as the main reason for a non-identity ruling) were mere immaterial details that ended up going unnoticed when looking at the products side by side.
[178] FABBIO, *ibidem*, p. 25.

4. Individual character

After passing the test for novelty, a design has to be tested for a second, more complex and multi-faceted requirement whose purpose is to filter out those creations which do not fulfill the ultimate scope of design protection: that of individual character.

This term was introduced anew by the EU legislator, as neither international texts nor national legislations contained a similar definition before the European Design Law system, but it is considered in line with the purpose of international design law and its test is consistent with those found in foreign jurisdictions under different names[179]. However, the lack of direct precedents to this requirement led to inconsistencies in its application by national courts, thus leaving up to the EU doctrine and jurisprudence the task of interpreting and specifying how the individual character test should be carried out[180].

Art. 5 Designs Directive and Art. 6 Designs Regulation (followed by Art. 33 CPI) state that

> "*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*

[179] As a matter of fact, according to Art. 25 (1) TRIPs Agreement, the two tests for protection of a design are novelty and originality. Although legal doctrine is scarce on the matter, it seems that the EU has interpreted the requirement of individual character as being similar, if not identical, to that of originality in the sense of the TRIPs Agreement – which, in its turn, appears to be an "umbrella concept" that can be further specified by national or regional legislations; another example of a similar requirement to originality (and, therefore, to individual character) is that of "non obviousness", which can be found in the U.S. and in the Japanese system of design protection. As for the European national criteria established prior the introduction of individual character, in the context of this analysis it is important to mention Art. 5 of the Italian Legge Modelli, which provided for the stricter requirement of the "special ornament": under this requisite, a design creation could only be subject to protection if its ornamental value, its innovative style or the creative effort of the designer was deserving of protection. However, as underlined by the European Commission Green Paper on the Legal Protection of Industrial Designs, there was no uniformity amongst the EU Member States on both the denomination and the test of this second requirement for protection: the only commonality was that it was used "*to answer the following question: when does a design which only differs in some details from a prior design cease to be an imitation and become a "new" design?*. Apart from that, "*The tests applied to determine the demarcation line are however not uniform: they are sometimes very strict, sometimes very loose and it is in many cases difficult to identify clear guidelines in the various national case-laws"* (Green Paper, § 2.3.8, p. 18). In order to create a uniform definition for this second requirement and, consequently, a common test for assessing it to be applied by all national and European courts within the EU, the European legislator introduced this new notion of individual character. In this sense, *cfr*. VOLKEN, ibidem, p. 25; FABBIO, *ibidem*, p. 29; DI CATALDO, *ibidem*, p. 73.

[180] DERCLAYE, *ibidem,* p. 4-5, 9.

public before the date of filing of the application for registration or, if priority is claimed, the date of priority[181].

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration".

Recital 13 to the Designs Directive and Recital 14 to the Designs Regulation add some specifications concerning the test for individual character, which

"[…] *should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design*".

This configuration aligns the requirement to the so-called *market approach* to design protection: any design creation able to influence the consumers' choices towards products incorporating it is worth protecting, because it is so "originally different" from the others available on the market that it increases the possibilities of the product of being preferred – and therefore purchased – by buyers. Regardless of any aesthetic quality or ornamental value,[182] the mere fact that a certain design feature creates a privileged contact with potential consumers incentivizes industries to create new designs that could compete with it, thus increasing competitiveness in the market – which is the ultimate goal of design protection[183]. Additionally, the *market approach* is consistent with Art. 25 (1), second period, of the TRIPs Agreement, according to which those designs which *"do not*

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[181] Additionally, Art. 6 (1) (a) Designs Regulation states that individual character is also present "*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*". See note 166 above.

[182] Recital 14 to the Designs Directive and Recital 10 to the Designs Regulation, when negating protection to features solely dictated by their technical function both affirm that "*this does not entail that a design must have an aesthetic quality*". This is a further confirmation of the *market approach*, as it clearly expresses that European Design Law does not require a particular worthiness in the sense of ornamental value, style innovation and/or creative effort for a design to be eligible for protection. *Cfr.* also note 178 above.

[183] BOSSHARD*, ibidem*, p. 15-16; FABBIO, *ibidem*, p. 30-31; FABBIO in BERTANI et al., *ibidem*, p. 339; FLORIDIA – SIRONI*, ibidem*, p. 354-355; DI CATALDO, *ibidem*, p. 76-77; DALLE VEDOVE G. (2001). *Dal modello ornamentale all'industrial design*. Il Diritto d'Autore, III, p. 337-338.

significantly differ from known designs or combinations of known design features" can be refused protection: any design which fulfills the requirement of individual character under the provisions set forth above "significantly differs" from the existing design corpus, as it has the capability of distinguishing the product from its competitors on the same market[184].

According to the definition provided by the European legislator, the individual character of a design is composed of three criteria to be analyzed separately, namely the informed user (§ ***4.1***) upon whom the design generates a different overall impression (§ ***4.2***) compared to all other products on the market, taking into account the degree of freedom of the designer in the creative process (***4.3***). The individual character test is based upon these criteria, whose existence should be evaluated by comparing the design requested for protection to any opposed priority (§ ***4.4***). Since European Design Law does not provide any further explanation, to properly understand these requirements reference will be made to landmark decisions rendered by European courts, especially by the Court of Justice of the European Union.

4.1.Informed user

European Design Law defines the subjects whose point of view should be considered when assessig the individual character as "informed user", without explaining how and when a user is considered to be "informed". This concept is understood to lie in between that of "average consumer" for trade marks and that of "sectoral expert" for patents: the former does not have any specific knowledge that would make them "informed", as they may enter into contact with a product by chance, while the latter has a detailed technical expertise that only manufacturers or designers would have, but that a "user" cannot be requested to develop[185].

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[184] TERRANO F. (2004). *Brevi note sul design comunitario*. Il diritto industriale, I, p. 2.

[185] EU General Court, judgement of 18 March 2010, case T-9/07 – *Grupo Promer Mon Graphic SA/ OHIM - PepsiCo Inc.*, § 62 *et seq.*; CJEU, judgement of 20 October 2011, case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA*, § 53-54, referencing the Opinion of Advocate General Mengozzi, § 43: "*Obviously, the informed user to whom the Regulation refers is not the average consumer to whom reference must be made in order to apply the rules on trade marks, who needs to have no specific knowledge and who, as a rule, makes no direct comparison between the trade marks at issue; nor, however, is the informed user the sectoral expert referred to for the purposes of assessing a patent's inventiveness. The informed user can be said to lie somewhere between the two. Accordingly, the informed user is not a general consumer who might, entirely by chance and with no specific knowledge, also come into contact with the*

In fact, while the term "user" refers to a person that uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended, the qualifier "informed" implies that, while not being a designer or technical specialist, the user is aware of the different designs available in the relevant field, has a certain level of knowledge of typical features of those designs, and, due to their interest in the products in question, is relatively attentive when using them[186].

Therefore, the informed user is a particularly observant person who is aware of the existing designs in a particular field thanks to the experience gained by using certain products or to an extensive knowledge of the field in question, and, without being an expert, knows what the market offers and the basic design features of products in that field[187].

Based on their knowledge of the field in question, the informed user is able to identify the similarities and differences between two designs which an average consumer may not notice or grasp, and they can conclude whether the two products produce the same overall impression upon them when directly comparing them[188].

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goods characterised by a particular design. Nor yet is the informed user an expert with detailed technical expertise". In the same sense, EUIPO Third Board of Appeal, judgement of 18 September 2007, case R 250/2007-3 – *Reflex S.p.A/Fiam Italia S.p.a. (Tables)*, § 12: […] *The parameter against which it will be necessary to assess whether the Community model in question has an individual character is, therefore, the final purchaser/user of the product - albeit "informed" - but certainly not a designer and even contrary to the applicant's view of the invalidity, an architect. The architect does not "use" the table, but chooses it on behalf of his client"*

[186] EU General Court (Second Chamber), judgement of 22 June 2010, case T-153/08 – *Shenzen Taiden Industrial Co. Ltd/ OHIM – Bosch Security Systems BV*, § 47. Furthermore, authors have specified that knowledge of the relevant sector is the only personal requirement to determine whether a user is informed: their education, culture, intelligence and personal style are not taken into account, as they should be "on average": in this sense, see FABBIO, *ibidem*, p. 38-41.

[187] EU General Court (Sixth Chamber), judgement of 21 November 2013, case T-337/12 – *El Hogar Perfecto del Siglo XXI, SL/ OHIM – Wenf International Advisers Ltd.*, § 26-27. See also EUIPO Third Board of Appeal, judgement of 18 September 2007, case R 250/2007-3 – *Reflex S.p.A/Fiam Italia S.p.a. (Tables),* § 12: "*Therefore, a user is someone who buys a table for their home, but the informed user is the person who chooses the table after visiting various furniture stores, consulting furniture magazines, surfing the Internet – meaning that they have "learned" about the product*". *Cfr* also, England and Wales High Court of Justice, judgement 346 of 16 January 2008 - *J Choo (Jersey) Ltd/Towerstone Ltd*, § 7: in the case of handbags, "*The informed user in the present case would be someone with a knowledge of handbag design; not the woman in the street, not a handbag designer. Such a person would know about the design constraints inherent in handbag design, what features were necessary and unnecessary, and so on*".

[188] Ireland High Court, judgement 449 of 21 December 2007 – *Karen Millen Ltd./ Dunnes Stores (Limerick) Ltd.*, p. 20; CJEU, judgement of 20 October 2011, case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA,* § 57.

4.2. Overall impression

In order to assess whether a design possesses individual character, it has to produce a "different overall impression" on the informed user compared to all other products previously available on the market.

First, the qualifier "overall" signifies that, when establishing the differences between the designs of two products, the informed user does not check if some features of the product match similar ones amongst all goods in that field, but rather compares the combination of the most relevant features of that particular product to one or more pre-existing products[189]. The identical impression created by two designs that have the same overall structure, components, and basic features cannot be offset by some minor or immaterial differences on an informed user - who, as established above, knows what to look for in that particular field[190].

Second, the "impression" on the informed user is created by perceiving all visible components during normal usage of the products. When faced with two products, the informed user will compare the impression they create by focusing on those visible elements "*that are arbitrary or different from the norm*", automatically disregarding the ones that are common to all products in that category – such as those dictated by the technical function of the product itself[191]. Therefore, if the informed user is not able to perceive any difference between two product when directly comparing them, the latter is deemed not to produce a different overall impression to the prior one.

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[189] CJEU (Second Chamber), judgement of 19 June 2014, case C-345/13 - *Karen Millen Ltd./Dunnes Stores (Limerick) Ltd.*, § 35: "[…] *Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually*". *Cfr.* also, Juzgado de Marca Comunitaria de Alicante, judgment 455/2007 of 25 July 2007 - *Apple Computer Inc / Diario AS SL- Mosaico Logistics & Supply Chain*, § 5.

[190] EU General Court (First Chamber), judgement of 9 September 2011, case T-10/08 - *Kwang Yang Motor Co. Ltd/ OHIM - Honda Giken Kogyo Kabushiki Kaisha (internal combustion engine),* § 43; EUIPO Third Board of Appeal, judgement of 18 September 2007, case R 250/2007-3 – *Reflex S.p.A/Fiam Italia S.p.a. (Tables),* § 14-15, in which the Court states that an informed user would consider the legs of a table as its most relevant feature, and would therefore be able to notice any difference in the design of the legs of another table.

[191] EU General Court (Third Chamber), judgement of 18 March 2010, case T-9/07 - *Grupo Promer Mon Graphic SA/ OHIM - PepsiCo Inc.*, § 74; EU General Court (Second Chamber), judgement of 22 June 2010, case T-153/08 – *Shenzen Taiden Industrial Co. Ltd/ OHIM – Bosch Security Systems BV*, § 53 *et seq.* As for the notion of features dictated by their technical function, *cfr.* above, § 1.3 of this chapter.

Third, the informed user assesses the "different overall impression" generated by a product in direct comparison with one or more prior products incorporating the contested design, either by looking at the goods side-by-side or, if an in-person comparison is not practicable, by using any available means of assessment, as it cannot rely on an imperfect recollection by the user[192].

4.3.Degree of freedom of the designer

Art. 5 (2) Designs Directive and Art. 6 (2) Design Regulation specify the third criteria for the assessment of individual character as being the "*degree of freedom of the designer in developing the design*". This means that, when the creativity of the designer is constrained or limited, small differences can be enough for a product to create a different overall impression of a certain good on an informed user, who is aware of said limitations and therefore more prone to noticing smaller differences between similar products[193].

The constraint can be due to the technical function of the goods or part thereof[194], but also due to the amount of similar products in the same relevant sector, the latter being the case of the so-called "*crowded art*". In those sector consisting of products with predetermined technical requirements and shapes that identify certain goods, or crowded by features that

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[192] CJEU, judgement of 20 October 2011, case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA*, § 56-58; *cfr.* also, Opinion of the Advocate General Mengozzi, § 51-52: "*It must in fact be pointed out that, while it is doubtless possible in many cases for an informed user to make a direct comparison of the goods characterised by the designs at issue, it cannot be ruled out that in some situ ations this is, on the contrary, impracticable. I am thinking here, for example, of designs relating to goods which – because of their large size or because they have to be placed far apart – can never, generally speaking, be set alongside one another: an informed user will not always be in a position to make a direct comparison of, for instance, two boats or two large items of industrial equipment. In such circumstances, the informed user will perhaps have adequate documentation to make the comparison, but will seldom be able to make a 'live' comparison, and some time may elapse between that user's assessment of one design and then the other. The type of comparison which the informed user is able to make between two de signs must not, therefore, be rigidly defined in advance; it will in fact need to be assessed case by case, on the basis of the circumstances and the features of the goods characterised by the designs at issue. The very nature of the informed user means that, when possible, he will make a direct comparison between the goods; however, in cases where that is impossible or not very realistic, it will be necessary to envisage a comparison which, although not based exclusively on vague recollection, as in the field of trade marks, may none the less be made over a period of time and at different locations, so far as is required in the specific case*" See also HARTWIG H. (2022). *A critical review of recent design case law by the General Court of the European Union.* Queen Mary Journal of Intellectual Property, 12(4), p. 554 - 556.

[193] England and Wales High Court of Justice, judgement 936 of 10 October 2007 – *The Procter & Gamble Co./ Reckitt Benckiser (UK) Ltd.*, § 29-31; Opinion of Advocate General Mengozzi in case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA*, § 30-35.

[194] EU General Court (Second Chamber), judgement of 22 June 2010, case T-153/08 – *Shenzen Taiden Industrial Co. Ltd/ OHIM – Bosch Security Systems BV*, § 53

correspond to the expectations of the relevant public, it is sufficient for a design to present few or small differentiating elements that stand out in the eye of an informed user in order for it to possess individual character[195].

4.4. How is individual character assessed?

After having analyzed the three criteria of which it is comprised, it can be understood how courts combine them when assessing the individual character of a certain product in comparison to the opposed priority (or priorities).

The first assessment concerns the informed user: the court has to correctly identify the relevant public of the market sector in which the product falls into[196]. After that, the degree of freedom of the designer comes into play, in order to assess the threshold for different elements to be considered as relevant in the comparison: the more freedom a designer has, the less probable it is that small differences between the designs in question will result in a different overall impression on the informed user. On the other hand, the more limited the designer's creative freedom, due to the crowdedness of the relevant sector or certain technical requirements of the products therein, the more likely it is that even minor differences between the designs in question will lead to a different overall impression on the informed user[197]. Finally, assuming the perspective of the informed user and taking into account the degree of freedom of the designer, the court carries out the direct comparison of the two products in order to assess whether, based on their similarities and differences, they produce a different overall impression – and, therefore, whether both design can be subject to design protection[198].

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[195] EUIPO Third Board of Appeal, judgement of 7 December 2010, case R 803/2009-3 - *C&G Carandini SA/Fundició Dúctil Benito SL (Luminaires)*, § 18-19; EUIPO Third Board of Appeal, judgement of 10 October 2014, case R 1273/2013-3 – *Antrax IT Srl/ Vasco Group BVBA*, § 34 *et seq.*; CJEU, judgement of 20 October 2011, case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA*,§ 43. The *crowded art* principle has been elaborated by authors based on the abovementioned decisions; amongst others, see FABBIO, *ibidem*, p. 49-52; FLORIDIA - SIRONI, *ibidem*, p. 355; SANNA*, ibidem*, p. 195-196; LIUZZO L., *L'aspetto estetico dei prodotti e le diverse forme della sua tutela giuridica,* in ALVISI C. et al. (2019). *Studi per Luigi Carlo Ubertazzi*. Giuffrè, p. 444.

[196] CJEU, judgement of 20 October 2011, case C-281/10 – *PepsiCo Inc./Grupo Promer Mon Graphic SA*, § 53 *et seq.*

[197] EU General Court (Sixth Chamber), judgement of 21 November 2013, case T-337/12 – *El Hogar Perfecto del Siglo XXI, SL/ OHIM – Wenf International Advisers Ltd.*, § 33.

[198] Amongst others, EU General Court (Second Chamber), judgement of 22 June 2010, case T-153/08 – *Shenzen Taiden Industrial Co. Ltd/ OHIM – Bosch Security Systems BV,* § 85.

The legal doctrine has considered other elements, mainly relating to the aspect of a product, that could influence the level of attention of the informed user: for example, the informed user tends to analyze more attentively the appearance of products that are more expensive or durable, or that they are supposed to wear or to use more often, compared to goods with limited or occasional usage or which are destined to be transformed or incorporated into final products[199]. They all converge toward the overall impression created by the product upon the informed consumer, but they shall be taken into account during the individual character test.

A final consideration shall be made with regards to parts of complex products, which, as established above[200], in order to be eligible for protection, must possess the same novelty and individual character as required for final products. In this case, the test for both requirements shall be based on those elements of the component which remain visible during normal use of the product, and it is conducted by comparing the contested component to the similar ones separately from the final product in which they are supposed to be incorporated[201].

5. Disclosure

For the purpose of assessing novelty and individual character, Art. 6 Designs Directive and Art. 7 Designs Regulation set out the notion of disclosure by exhaustively enumerating all events that render prior designs validly enforceable against the contested design, along with the relevant exclusions.

Art. 6 Designs Directive provides that:

> *1. For the purpose of applying Articles 4 and 5, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community,*

[199] FABBIO, *ibidem*, p. 42-44.
[200] *Cfr.* § 2.1 of this chapter.
[201] FABBIO in BERTANI et al., *ibidem*, p. 343; FLORIDIA – SIRONI, *ibidem*, p. 359.

before the date of filing of the application for registration or, if priority is claimed, the date of priority. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

2. A disclosure shall not be taken into consideration for the purpose of applying Articles 4 and 5 if a design for which protection is claimed under a registered design right of a Member State has been made available to the public:

(a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and

(b) during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority.

3. Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designre or his successor in title.

This has been transposed *verbatim* in the national designs law of EU Member States, such as in Art. 34 CPI, and a similar wording is used in Art. 7 Designs Regulation[202]; moreover, it has not undergone significant alterations in the Design Package[203].

The norm begins by stating which events produce the disclosure effect, meaning registration, exhibition and availability to the public (§ ***5.1***), the latter two only if cognizable by the specialized circles in that particular field (§ ***5.2***). Then, it specifies that

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[202] The Designs Regulation references those paragraphs in Art. 5 and 6 that differentiate between registered and unregistered Community Designs. In this sense, disclosure of a prior design is deemed to have occurred: *"a) In the case of an unregistered Community design, before the date of 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 the application for registration or, if a priority is claimed, the date of priority".

[203] The only alteration has been made to the introductory words of Art. 6 (2) Proposed Directive and Art. 7 (2) Designs Regulation, which read as follows: "*A disclosure shall not be taken into consideration for the purpose of applying Articles 4 and 5 if the disclosed design, which is identical or does not differ in its overall impression from the design for which protection is claimed under a registered design right of a Member State has been made available to the public* […]". It appears to have been added to improve the reference to the requirement of individual character - although it seems a little redundant, given that, as explicitly stated in both the first and the second paragraph, this provision is *for the purpose of applying Article 4 and 5* (of the Directive, or Artt. 5 and 6 Regulation)", meaning the test for novelty and individual character.

the confidential revelation of the design to a third party does not amount to disclosure (§ ***5.3***), and establishes a "grace period" for the twelve months following the initial making available to the public, be it legitimate (§ ***5.4***) or abusive (§ ***5.5***).

5.1. Disclosure events

"Disclosure" in a narrow sense means the making available to the public of the product incorporating a certain design; EU Design Law distinguishes between disclosure events that make the product accessible to the public, namely the registration as design or as trademark, and disclosure events that render the product public *tout court* so that it could be seen by a potentially unlimited number of people, such its exhibition or commercialization[204].

On the one hand, national or European registrations of prior designs, either pending or definitive, always amount as disclosure if published: secret registrations are not opposable priorities, as they are not accessible to the general public. Moreover, design publications made outside of the EU constitute disclosure if they can become reasonably known to the circles specialised in the sector concerned, operating within the Community[205]. Similarly, a published national or European trademark registration can be opposed as priority only if published[206].

On the other hand, the exhibition of a design to the public can occurr at trade fairs and similar events or via publication on specialized magazines or websites[207], and the "use in

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[204] FABBIO, *ibidem*, p. 65, 69.

[205] EUIPO Third Board of Appeal, judgement of 07 July 2008, case R 1516/2007-3 - *Normanplast SNC/Castrol Ltd. (Cans)*, § 7-10. The Board added that it is up to the owner of the contested design to prove that the earlier design could not have been reasonably known within the EU specialized sectors; in lack of this proof, "*said earlier design should be deemed to indeed have been disclosed and it should be possible for said disclosure to be invoked in opposition to the contested design".* This is particularly true for publications made in important or renowned foreign markets or in which important producers operate – such as Hong Kong for tanks. *Cfr.* FABBIO, *ibidem*, p. 66-67.

[206] However, if a design is incorporated in the representation of a final product in a trademark application, said design only represents an opposable priority if the trademark application could have reasonably been known within the specialized circles. In this sense, see FABBIO, *ibidem*, p. 67.

[207] Tribunal of Milan, judgement of 27 July 2005 - *Leggiuno S.p.A/Gruppo Coin S.p.a;* Tribunal de Grande Instance de Paris, judgement of 24 May 2011, case 10/078542 - *S.A.R.L. MFB Diffusion/- (buggy)*, p. 4; EU General Court (Second Chamber), judgement of 22 June 2010, case T-153/08 – *Shenzen Taiden Industrial Co. Ltd/ OHIM – Bosch Security Systems BV,* § 20-21, in which the earlier design had both been presented at a sectorial trade fair and published on the specialized press; EUIPO Third Board of Appeal, judgement of 26 March 201, case R 9/2008-3 - *Crocs Inc./Holey Soles Holdings Ltd. (Crocs)*, § 59, in which the challenged design had been both exhibited at a national trade fair and published on the company's

trade" consists of the making available of products incorporating the design on the market in relatively large amounts[208].

5.2. Reasonable knowledge in the specialized circles

The exhibition or use in trade of a prior design only amounts as disclosure if it could "*reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community*"; this serves the *market approach* of the design protection system by limiting protection to those creations that have a commercial value coming both from inside and outside the EU, through the establishment of a territorial parameter[209].

This provision can be broken down into a series of elements to be commented separately:

1) *Circles specialized in the sector concerned*

   The specialize circles include all the people and undertakings that participate in the creation, development and sale of a certain product, including designers, manufacturers, traders, and importers; a design is considered as disclosed if it has been made available to a significant number of insiders within that particular market sector, regardless of their effective knowledge of the design itself[210].
2) *Operating within the Community*

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website; although Crocs had claimed that *"the website was 'unsophisticated' and not designed for commercial operations"*, the Board found that having the product displayed on an active website, regardless of its commercial purpose, was enough for the event to produce disclosure by exhibition to the general public.

[208] The relevant amount that has been made available or sold depends on the nature of the product. In this sense, see EUIPO Third Board of Appeal, judgement of 26 March 201, case R 9/2008-3 - *Crocs Inc./Holey Soles Holdings Ltd. (Crocs)*, § 67-69: according to the Board, "*shoes are design items, which fashion-conscious people immediately start to wear and proudly show around rather than storing them away far from public sight*", hence the sale of 10.000 pairs of Crocs clogs was deemed as realizing a disclosure event.

[209] FLORIDIA - SIRONI, *ibidem*, p. 356.

[210] CJEU, judgement of 13 February 2014, case C-479/12 - *H. Gautzsch Großhandel GmbH & Co. KG/ Münchener Boulevard Möbel Joseph Duna GmbH*, § 30; *cfr.* also, Opinion of Advocate General Wathelet, § 38: "*As summarised by the High Court of Justice (England and Wales) Chancery Division (Patents Court) (United Kingdom), the question that arises is 'who is in the circle? Moreover, I agree with that court's answer to that question, namely that, in principle, the concept includes all persons who are involved in trade associated with the products in the sector concerned. That consequently includes not only those who design and manufacture them, but also those who advertise, market, distribute and sell them by way of commercial activity in the European Union"*; EU General Court, (Fourth Chamber), judgement of 14 June 2011, case T-68/10 – *Sphere Time/ OHIM – Punch SAS*, § 31; EUIPO Third Board of Appeal, judgement of 25 July 2009, case R 552/2008-3 - *Harron SA/THD Acoustic Ltd. (MP3 player recorder)*, § 21; Juzgado de Marca Comunitaria de Alicante, judgement 267/07 of 20 November 2011 - *Silverlit Toys Manufactury Ltd./Ditro Ocio 2000 SL*, § 6.

Only those specialized fields that operate within the European Union are taken into account when assessing a diclosure event. This does not entail that the making available of a product outside of the EU is inconsequential: if a foreign market or event has international relevance, the disclosure can be considered as reasonably knowable by European undertakings insiders of that specialized field within the EU[211].

3) *Reasonable knowledge in the normal course of business*

The reasonable knowledge refers to the corpus of theorical and practical knowledge that can be acquired by insiders during the normal course of business[212]. To protect designers and companies from the *obscure prior art*, knowledge obtained hypotethically or by chance (such as during local fairs or by reading a limited edition or hard to find publication), or limited to few selected individuals (*i.e.,* information only available to design critics or professors, or obtained via privileged contacts), does not amount to disclosure. Likewise, prior products that have long gone out of production or whose memory has been lost do not constitutes opposing priorities – with the exclusion, of course, of world-renowned design classics[213].

5.3. Confidential disclosure

According to the last period of Art. 6 (1) Designs Directive and Art. 7 (1) Designs Regulation, the disclosure of a design to a third party under a confidentiality obligation does not entail the distruction of its novelty and individual character, be it explicit or implicit.

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[211] FABBIO, *ibidem*, p. 73-74; see EUIPO Third Board of Appeal, judgement of 26 March 201, case R 9/2008-3 - *Crocs Inc./Holey Soles Holdings Ltd. (Crocs)*, § 64-69: according to the reasoning of the Board, the launch of new footwear in the United States "*always attracts attention from the public at large, the press and the business circles*", and "*This sort of news circulates instantly and easily in the Internet era*". Therefore, even if the sale of Crocs clogs had been limited to the US market, the product could have reasonably become known to the specialized circles operating within the Community.

[212] Which, thanks to today's technology, is deemed to include everything that has been disclosed by professional undertakings operating in industrialized countries. *Cfr.* SANNA, *ibidem,* p. 190.

[213] According to some authors, it takes a few decades for a discontinued product to be forgotten, while the design classics are known to all insiders because they are exhibited in important museums, illustrated in art books, or "celebrated with commemorative stamps". *Cfr.* FABBIO, *ibidem*, p. 76; FABBIO in BERTANI et al., *ibidem*, p. 337.

On the one hand, an explicit confidentiality condition may result from specific norms (*e.g.* art. 2105 Italian Civil Code, which provides for the loyalty obligation of the employee) or can be requested by the disclosing party *expressis verbis*, without the need of an underlying written agreement.

On the other hand, implicit confidentiality exists in those situations wherein it can be inferred from the circumstances of the disclosure, therefore the disclosing party can reasonably expect the other party to maintain secrecy, such as when secrecy is a normal use between the parties in that sector, when the disclosure precedes a licensing agreement between the parties, or when the disclosing party exhibits samples of the product after stating that the design has not yet been registered or disclosed[214].

5.4. Grace period

Art. 6 (2) Designs Directive and Art. 7 (2) Designs Regulation (followed by Art. 34 (2) CPI) establishes a "grace period" that does not preclude registration of a design which has been diclosed by the author or another authorized person; this period has been set to 12 months after the first event that made the design available to the public. The purpose of this provision is to it protect the author from accidental disclosures or late afterthoughts, while also allowing them to test the product on the market before committing to the registration process[215].

During the grace period, the design enjoys the same "informal" protection as unregistered designs, without any retroactive effect of the eventual registration filed before the 12-month deadline: consequently, if a third party registeres or dicloses an identical design to the unregistered one during the grace period without having copied the prior one, the latter can no longer be registered as it has been deprived of its novelty and individual character[216].

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[214] DI CATALDO, *ibidem,* p. 68; FABBIO, *ibidem*, p. 78-79; FLORIDIA - SIRONI*, ibidem*, p. 357.
[215] FABBIO, *ibidem*, p. 80; EU General Court, (Fourth Chamber), judgement of 14 June 2011, case T-68/10 – *Sphere Time/ OHIM – Punch SAS*, § 25-27.
[216] SANNA, *ibidem*, p. 190-191; DI CATALDO, *ibidem*, p. 70; FABBIO, *ibidem,* p. 80-81. This situation is called "*fortuitous encounter*", and it is based upon Art. 19 (2) Designs Regulation, which states that "*An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design*". Furthermore, ex Art. 22 Designs Regulation, the owner of the opposing design can enjoy a right of prior use on the unregistered design.

Moreover, some national design regulations also explicitly refer to Art. 11 (1) Paris Convention, which states that

"*The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them*".

The duration of this temporary protection, as set out by Art. 4 (A) (1) Paris Convention, only amounts to six months: since it has the same purpose to allow for the test the reception of the product on the market as the grace period, to which it can be assimilated, it has been repealed by most EU Member States[217].

5.5. Abusive disclosure

In conclusion, Art. 6 (3) Designs Directive and Art. 7 (3) Designs Regulation specify that the grace period also applies to disclosure events resulting from an abuse to the designer or its successor in title. The abuse can either be direct, if stemming from the violation of an explicit confidentiality obligation, or indirect, if committed by a third party based on information received without the authorization of the entitled subjects, regardless of it being deliberate or accidental. In any case, the party alleging the abuse can validly file for registration of the disclosed design within the grace period if it provides evidence of the abusive, fraudolent or dishonest conduct of the disclosing party[218].

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[217] For example, Art. 34 (5) CPI read as follows: "*Disclosure that takes place during exhibitions that are official or officially recognized pursuant to the Convention Concerning International exhibitions, signed in Paris on 22 November 1928, and subsequent amendments, shall also not be taken into consideration*". This paragraph has been repealed by the 2010 Decreto Correttivo (*cfr.* note 5), as it was deemed redundant. However, the new Art. 34-*bis* CPI, as introduced by Legislative Decree 24 July 2023, n. 102, provides that the Ministry of Enterprises and Made in Italy can grant temporary protection to designs presented in official exhibitions; this temporary protection creates a right of priority only if the registration is filed within six months from the granting of said protection. In this sense, *cfr*. FLORIDIA - SIRONI*, ibidem*, p. 358.

[218] FABBIO, *ibidem*, p. 82-83; FLORIDIA - SIRONI, *ibidem*, p. 357; EUIPO Third Board of Appeal, judgement of 25 July 2009, case R 552/2008-3 - *Harron SA/THD Acoustic Ltd. (MP3 player recorder)*, § 23-27.

6. Lawfulness

Lawfulness is the last requirement for protection set out by European Design Law. According to Art. 8 Designs Directive and Art. 9 Designs Regulation,

> "*A design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality*".

The unlawfulness may concern either the design itself or the typical use of the product incorporating it. In general, it is considered contrary to public policy anything that goes against the fundamental values and principles of a particular legal system: for instance, with regards to the European Union, a design is unlawful if it violates Art. 10 TFEU by inciting "*discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation*". Moreover, a design goes against the principles of morality if it is deemed obscene or offensive by a person of average sensitivity and tolerance[219].

Since the concepts of "public policy" and "accepted principles of morality" are not uniform throughout the European Union, the provisions at hand have been adapted and further specified by Member States in accordance with their national legislations[220]. For instance, Art. 33-*bis* (1) CPI, second period, adds that

> "*a design or model shall not be considered contrary to public policy or accepted principles of morality only because it is prohibited by a provision of law or administrative regulations*"

according to which designs of prohibited products can obtain valid registration, although the products themselves cannot be produced[221].

Furthermore, Art. 11 (2) (c) Designs Directive and Art. 25 (1) (g) Designs Regulation establish that a design shall be refused registration or declared invalid

> "*if the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention for the Protection of Industrial Property, or of badges,*

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[219] FABBIO in BERTANI et al., *ibidem*, p. 342.
[220] SANNA, *ibidem*, p. 197.
[221] FLORIDIA - SIRONI, *ibidem*, p. 357.

emblems and escutcheons other than those covered by Article 6ter of the said Convention which are of particular public interest in the Member State concerned".

This means that the items listed in Art. 6*ter* Paris Convention – and, in general, of those distinctive signs that constitute a prerogative of the State sovereignty – could be subject to design protection unless the design interferes with the normal function of the sign or offends what the sign represents[222]. In case of unlawful designs requested for protection, the EUIPO or the national office in which the design application is filed should reject the application or declare it invalid *ex officio*.

The purpose of this provision is to dissuade those usages of a design that go against the public interest associated with certain distinctive signs. Since it is consistent and up-to-date with the general purpose of design protection on an international, European and national level, it has not undergone any revision in the new Design Package.

[222] FABBIO in BERTANI et al., *ibidem*, p. 342. For instance, the use of a police emblem on t-shirts constitutes an improper use of the distinctive sign, as it should only be worn by police officers as not to confound the general public.

CHAPTER III – REGISTERED DESIGNS

Having established what a design is and what requirements it must possess to be eligible for protection, it must be understood *how* design is protected on different levels – and how such levels of protection coordinate to create a harmonious set of rights for the holder of the design itself.

A creation with the characteristics set forth in the previous chapter can enjoy protection either as a registered or as an unregistered design. Here, the analysis will delve into registered designs and all rights arising from the registration according to European and international design law, while the following chapter will focus on unregistered designs.

In particular, this chapter will present the terms and procedures for registering a design (§ **3.1**), followed by the acknowledgment of the designer (§ **3.2**) and the identification of all subjects upon which a right to the design exists (§ **3.3**). Additionally, it will examine the rights conferred by registration (§ **3.4**) and the circumstances that may lead to its invalidity (§ **3.5**).

1. National, European and international terms and procedures

A design can be registered as a national design according to the national law of the State in which registration is requested (*e.g.* in Italy, where the registration procedure is set out in Artt. 167 *et seq.* CPI), as a Registered Community Design (RCD) in the sense of European Design Law, or as an International Design following the dispositions of the Hague Agreement[223] and of the TRIPs Agreement. Each level of registration presents its own specific features and can be obtained independently from the others; however, since they can be cumulated, they will be analyzed jointly in order to highlight commonalities and differences between the application procedures (§ ***1.1.***), the duration of the protection

[223] From this point forward, reference will be made to the Geneva Act to the Hague Agreement for the sake of clarity and straightforwardness in the exposition: as addressed above (*cfr.* Chapter I, § 3.2), 73 out of the 79 Member States to the Hague Agreement have ratified the Geneva Act, hence the dispositions therein will be references when discussing all procedural matters. For additional information concerning the relationship between the 1960 Hague Agreement and the 1999 Geneva Act, see STUTZ*, ibidem*, p. 498-501.

(§ ***1.2***), the handling of multiple applications (§ ***1.3***) and the claim of priority (§ ***1.4***) under national, European and international bodies of law.

1.1. Procedures

Usually, national design registrations are dealt with by the intellectual property office of the Country in which the application for registration is filed, which establishes the procedures to obtain protection in accordance with the international conventions and agreements of which the Country is part. This is also valid for EU Member State: in fact, the Designs Directive only sets out a few requirements concerning the duration and requirements for validity of national registered designs, leaving all remaining procedural issues to the determination of national IP offices. However, as established above, since the requirements for protection are the same for both national and European designs[224] and the two levels of protection coexist[225], most EU Member States, such as Italy, have used the provisions of the Designs Regulations as guidelines to update and harmonize their national registration procedures.

1.1.1. Italian registration procedure

In Italy, applications for national design registration must be deposited at Italian Patent and Trademark Office (herafter "UIBM")[226] and must the contain all the elements set forth in Art. 167 CPI, namely:

a) The identification of the applicant and, if the applicant has appointed a representative, the letter of engagement of the representative and their identification;
b) the indication of the design and of all its specific characteristics intended to receive specific protection, if any;
c) the indication of the products in which the design is to be incorporated according to the Locarno Agreement product classification (hereafter "Locarno Classification")[227];

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[224] *Cfr.* Chapter II.
[225] For an overview on the relationship between EU Member States and European Design Law, *cfr.* Chapter I, § 1.2.
[226] From the Italian *Ufficio Italiano Brevetti e Marchi*.
[227] *Cfr.* Chapter I, § 3.3.

d) a clear, precise and complete visual representation of the design, including one or more perspectives and animated or dynamic reproductions.

The application can also be accompanied by a written description if deemed necessary to understand the design, by the indication of the author or group of authors and, in case of a priority claim, all relevant documents. Pursuant to Art. 38 (4) (5) and (6) CPI, the application becomes effective and is published immediately after the deposit, unless the applicant requests a deferment of up to thirty months for the publication; in order to render the application immediately enforceable against a third person, the latter must be notified by the applicant of the deposit, and the registration becomes effective against that subject from the date of notification.

After that, the UIBM examines the formal requirements of the application ex Art. 170 (1) (c) CPI, verifying that it complies with the legal definition of design and that it is not contrary to public policy or to accepted principles of morality. No further assessment concerning the remaining requirements for protection is carried out[228].

Finally, if the application fulfills all the requirements, the registration is finalized, and the design is given a registration number.

1.1.2. European registration procedure

Pursuant to Art. 35 Designs Regulation, the application for an RCD can be filed either directly at the EUIPO or at the central IP office of a Member State (for Italy, the UIBM), which shall forward the application to the EUIPO within two weeks. According to Art. 38 Designs Regulation, protection commences on the filing date regardless of the filing office unless the EUIPO receives the application more than two months after the original filing date: in this case, the relevant date is that of receipt of the application by the EUIPO.

The application must contain all the elements set forth in Art. 36 Designs Regulation, which, as established by Art. 39 Designs Regulation, are the same as for national applications[229]. Art 40 Design Regulation specifies that the products on which the

[228] FABBIO in BERTANI et al., *ibidem*, p. 354-355.
[229] *Cfr.* to the previous paragraph.

requested design is to be incorporated shall be categorized according to the Locarno Classification.

After the deposit, the EUIPO examines the formal requirements of the application ex Art. 45 and 47 Designs Regulation, verifying that all fees have been paid, that it complies with the legal definition of design and that it is not contrary to public policy or to accepted principles of morality. No further assessment concerning the remaining requirements for protection is carried out.

Pursuant to Artt. 48 to 50 Designs Regulation, if the application fulfills all the requirements, the EUIPO registers the application in the Community Designs Register with a serial number and publishes the RCD in the Community Designs Bulletin. Pursuant to Art. 50 Designs Regulation, the applicant may request a publication deferment of up to thirty months from the application filing date.

To the contrary, if the application is refused registration due to a remediable deficiency as provided for in Art. 46 Designs Regulation, the EUIPO shall request the applicant to remedy said deficiency within a prescribed period and only grant registration if it is remedied[230].

Along with some specifications on the requirements, procedures and fees for deferral of publication[231], the Design Package will introduce a new registration symbol to facilitate the marketing of design protected products and to increase of the design registration regimes[232].

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[230] SANNA, *ibidem*, p. 198-201.

[231] Art. 30 Proposed Directive and Art. 50 Proposed Regulation which, in particular, will eliminate the procedural link between publication and prior payment of the publication fee, as provided for in Art. 5 (4) (a) Designs Regulation.

[232] Art. 26a Proposed Regulation and Article 24 Proposed Directive read as follows: "*The holder of a registered EU design may inform the public that the design is registered by displaying on the product in which the design is incorporated or to which it is applied the letter D enclosed within a circle. Such design notice may be accompanied by the registration number of the design or hyperlinked to the entry of the design in the Register*". This seems to be consistent with the *market approach* to design law because, as explicitly stated by Recital 17 to the Proposed Regulation, the goal of the symbol is "*to facilitate the marketing of design protected products, in particular by SMEs and individual designers, and to increase awareness of the design registration regimes existing both at Union and national level".* However, this proposal has been harshly contested by the Max Planck Institute - which generally considers claiming intellectual property with symbols as a deterrence for both competitors and consumers and, in this particular case, highlights the risk of a misinterpretation of the design protection system itself. *Cfr.* KUR, ENDRICK-

1.1.3. International registration procedure

The Hague Agreement establishes a mechanism for the international deposit of a design application, with the aim of allowing Member States to the Agreement to obtain registration in multiple selected countries through a single application. According to Art. 4 Hague Agreement, the applicant can deposit the application, complete with all elements enumerated in Art. 5, either at its national IP office or at WIPO's International Bureau, indicating all Countries in which registration is requested. Since 2008, the EU can be designated for the deposit, although the application for the international design cannot be made at the EUIPO[233].

Pursuant to Artt. 9 to 11 Hague Agreement, the International Bureau, after checking that the application fulfills the formal requirements and asking the applicant to correct any irregularities (if needed), transmits the application to the national IP offices of the countries in which the applicant has requested registration, which then proceed to register the design. As explained above[234], the international deposit creates a series of autonomous national design titles that enjoy the same level of recognition and protection as the national titles of the chosen countries. The relevant date for each individual registration is the date of the international deposit.

According to Art. 12 Hague Agreement, the national IP offices can refuse registration of the received application if the design does not meet the conditions for protection under the law of that country; in this case, the national IP office must communicate the refusal to the International Bureau within a certain period, which in turn notifies the refusal to the original applicant in order to allow for an appeal or a re-examination request[235].

LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 24: "*It seems highly unlikely that informing consumers about either of those facts will help to facilitate marketing of design-protected products. Using a registration symbol as a marketing tool thus incentives marketing strategies which give additional (in fact misleading) meaning to what the registration tells (the consumer) about the design, e.g. turning it into a seal of quality. Incentivising such mischaracterisation of the design registration regime comes close to incentivising consumer confusion and misinformation"*.

[233] FRYER W. T. III (2002). *European union (eu) revolutionizes general industrial design protection*. Journal of the Patent and Trademark Office Society, 84(11), p. 902-903.

[234] *Cfr.* Chapter I, § 3.2

[235] FABBIO, *ibidem*, p. 356; SANNA, *ibidem*, p. 202.

The Design Law Treaty sets out a similar procedure for the deposit of international designs to the one established by the Hague Agreement, with the main difference being that, as the Treaty provides for maximum standards not to be surpassed by its Contracting Parties, any deposit made under the Treaty will undergo faster and more streamlined examination and it will be less likely to be refused by the countries in which registration will be requested.

1.2. Terms and Renewal

Regardless of the starting date, the global consensus is that design registration lasts five years, with the possibility to renew the registration for one or more five-year terms.
As a matter of fact, Art. 26 (3) TRIPs Agreement establishes that:

"*The duration of protection available shall amount to at least 10 years*"

First, Art. 17 Hague Agreement provides for an initial protection term of five years for international design applications, that can be renewed for two additional terms up to a total of fifteen years starting from the date in which the application is filed with the International Bureau; however, if the national design registration of a Member State lasts longer, the maximum duration of protection of the international design is extended accordingly.

Second, pursuant to Art. 12 and 13 Designs Regulation, RCDs are protected for a period of five years beginning from the date of the application filing, and registration can be renewed for one or more terms of five years each for a maximum protection term of twenty-five years – not counting the *grace period* of twelve months during which the design enjoys protection before the application for registration[236]. Renewal shall be requested within six months from the end date of the protection term.

Third, according to Art. 10 Designs Directive (which is identical to Art. 12 Designs Regulation) – and, continuing with Italy as our example, Art. 37 CPI – designs registered within the national IP offices of any EU Member States enjoy protection for an initial

[236] *Cfr.* above, Chapter II, § 5.4.

term of five years, which can then be renewed for up to four five-year terms totaling a maximum of twenty-five years of protection[237].

This five-year-term solution allows for the holders of registered designs to evaluate multiple times whether to maintain exclusive rights on a certain design by renewing its protection; in case upkeeping registration is no longer convenient, the holder can decide to let the design fall into public domain in order to allow other companies to market it and/or to let other designers reinterpret it. Again, this solution is consistent with the *market approach* to design protection, and it is aimed at avoiding monopoly or excessive protection over designs that, without further innovation, could lose the interest of the public or become obsolete: in light of that, the provision concerning terms and renewals have not undergone any modification either in the Design Package or in the Design Law Treaty[238].

1.3. Multiple applications

European Design Law allows for the combination of multiple designs into one so-called *multiple application*: according to Art. 37 (1) Designs Regulation,

> *"[...] this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs"*[239].

Therefore, several designs can be deposited within a multiple application with the sole condition that they are all intended to be incorporated to products falling within the same class of the Locarno Classification (so-called "unity of class"), without limits to the number of designs that can be contained in one multiple application. Each design is then examined individually ex Art. 37 (4) Designs Regulation, and it is granted autonomous protection as RCD regardless of the overall impression created by the combination of the designs deposited together[240].

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[237] FABBIO, *ibidem*, p. 116-119.
[238] FABBIO in BERTANI et al., *ibidem*, p. 367-368.
[239] This condition, however, does not apply to ornamentations, *i.e.* any repetitive motif to be applied to the surface of a product. *Cfr.* SCUFFI, *ibidem*, p. 173.
[240] FABBIO in BERTANI et al., *ibidem*, p. 355; FABBIO, *ibidem*, p. 143.

The multiple application can be limited or separated into individual applications or more multiple applications to the request of the applicant, who may want to modify or delete some of the designs of the original deposit, or by EUIPO itself for deficiencies or other issues arising from some designs. In the latter case, if the applicant does not limit or fix the original application, EUIPO declares the application inadmissible, and the applicant shall proceed *ex novo* to obtain protection of the requested designs[241].

An identical provision is found in all national design legislations of EU Member States, such as in Art. 40 CPI.

Under Artt. 5 (4) and 13 Hague Agreement, multiple applications containing up to one hundred designs can be deposited as international applications; however, if the country in which registration is requested does not allow for multiple applications, or only allows them under certain conditions which the international application does not fulfill, its national IP office can refuse registration if the international application is amended accordingly or it is split into single international applications by the applicant – to which the International Bureau may charge additional registration fees. The Design Law Treaty is set to introduce maximum requirements for the amendment and division of multiple application in order to avoid such situations[242].

Multiple applications (and renewals thereof) save the applicant time and money: only one deposit with the relevant IP office containing all the requested designs is needed, hence all deposited design obtain registration starting from the same date, and the deposit fee is significantly reduced compared to filing several individual applications[243]. Furthermore, they incentivize the registration of series and collections while also increasing the number of "defensive applications", meaning the registration of similar designs to a main one with the sole purpose of strengthening the protection of the latter[244].

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[241] FABBIO, *ibidem*, p. 146.
[242] STUTZ*, ibidem*, p. 406.
[243] Using EUIPO as reference, the deposit fee for a single RCD application and for the first design in a multiple application amounts to € 230,00; as for multiple applications, the fee for the second to tenth design is € 115,00 per design, while the fee from the eleventh design on only amounts to € 50,00 each. Additional information can be found on EUIPO's Guidelines at the following link: https://guidelines.euipo.europa.eu/2058424/1788504/designs-guidelines/7-multiple-applications
[244] FABBIO, *ibidem*, p. 146.

Article 37 Proposed Regulation and Article 27 Proposed Directive are set to remove the unity of class requirement, and the Proposed Regulation will also limit multiple applications to a maximum of fifty designs.

1.4. Priority

As anticipated[245], it is a well-established principle within the Paris Union that the filer of the first application of a design is entitled to deposit the same application in other Member States of the Paris Convention – and, therefore, in all Contracting Parties of the TRIPs[246] and the Hague agreements. This priority right was established to relieve designers and applicants of the need to file a multitude of registration applications simultaneously all over the world in order to avoid the novelty-destroying effect of the first publication[247].

Pursuant to Art. 4 A (1) Paris Convention,

> *"Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed*".

According to Art. 4 C, the duration is six months starting from the date of the first filing, and the priority right only covers those subsequent applications concerning the same subject matter as the first one[248].

Hence, the right of priority allows the applicant to retroactively date the assessment of the requirements for the protection of the uniform design in each of the Member States requested for protection to the date on which the first national application was file, so that

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[245] *Cfr.* Chapter I, § 3.1.3.
[246] This right of priority also applies, in accordance with Article 2 (1), 3 (1) TRIPs Agreement, to Member States of the WTO which have not ratified the Paris Convention
[247] VOLKEN, *ibidem*, p. 10-11.
[248] HARTWIG H., *Claiming priority under the Community Design scheme*, in HARTWIG H. (2021). *Research Handbook on design law*. Elgar, p. 260. Additionally, VOLKEN, ibidem, p. 11, specifies that "*If the same subject is filed but different figures are used, priority is properly being claimed if such differences are required by national law. A claim of priority does not necessarily have to be based on an application for registration of a design. Rather, it can also be based, largely depending on individual national requirements, on other applications for IP rights such as, for instance, applications for utility patents, utility models and three-dimensional trade marks*".

any conflicting right arisen in the interval between the first deposit and the subsequent ones is not enforceable against the holder of the original application[249]. This is further confirmed by the possibility to claim priority in all levels of design protection.

As for international applications, Art. 6 Hague Agreement provides that they can be accompanied by "*a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization".* The declaration may be submitted simultaneously or after the deposit. Moreover, international applications can also serve as basis for a priority claim in the sense of Art. 4 Paris Convention.

An identical right of priority is established pursuant to Art. 41 Designs Regulation: national applications for design rights or utility models filed in any Member State to the Paris Convention or to the TRIPs Agreement enjoy a right of priority of six months for the purpose of filing an application for a RCD in respect of the same design or utility model. The same right is also granted to applications filed in non-Member States to the condition that a reciprocal right of priority with equivalent effects is afforded to RCDs in that country[250]. According to art. 42 Designs Regulation, the priority claim shall be submitted simultaneously to the design application, along with a copy of the original application translated in one of the official languages of the EUIPO[251].

While filers of national designs application in any Member State of the Paris Union automatically enjoy the right of priority thanks to Art. 4 Paris Convention, some countries have added provisions in their national legislation to further specify the content and procedure for priority claims. In Italy, Art. 169 CPI clarifies that, if not filed contextually with the application, the claim of priority can be submitted within six months from the deposit and within sixteen months from the date of the first priority claimed, along with all documents pertaining to the original application.

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[249] SANNA, *ibidem*, p. 201.
[250] HARTWIG in HARTWIG, *ibidem,* p. 251.
[251] EUIPO complete language policy for the submission of design and trademark applications can be consulted at https://www.euipo.europa.eu/en/info/language-policy#.

Due to the international consensus on the matter, neither the Proposed Regulation nor the Design Law Treaty have updated on the right of priority, the latter solely containing more detailed procedural provisions concerning priority claims submitted after the filing.

2. Right to the design

The subject who is entitled to apply for design registration is generally referred to as "designer" (Art. 14 Designs Regulation) or as "author" (Art. 38 CPI) or "creator" (Art. 5 (2) (b) (i) Hague Agreement) of the design. The definition of designer is not found in any legal text, but it can be construed indirectly from the definion of design[252]: it is the person who gives the product a specific appearance fulfilling the requirements of novelty and individual character[253].

This definition emphasizes the result of the creative effort of the designer to the detriment of its quality or originality: though apparently contrasting with the goal of European Design Law to "*promote the contribution of individual designers to the sum of Community excellence in the field*", this aligns with the *market approach* to design protection, as shifting the focus on the final product of the process "*encourages innovation and development of new products and investment in their production*"[254].

The ultimate purpose of the design protection system is to protect designs that are able to stir the choices of the consumers towards the product incorporating them, thus incentivizing the creation and marketing of new products that can capture the preference of the consumers[255]. Therefore, the economic rights to and arising from the design shall be entrusted in those who have the best chances of exploiting the design in this continuous cycle of industrial production and innovation – and, more often than not, these subjects do not correspond to the authors of designs.

Starting from this consideration, the analysis of the right to the design, meaning the right to obtain registration and all other rights arising from it, must focus on the difference

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[252] *Cfr.* Chapter II, § 1.1
[253] TISCHNER A., *Design rights and designer's rights in the EU*, in HARTWIG H. (2021*). Research Handbook on design law*. Elgar, p. 175.
[254] Recital 7 to the Designs Regulation.
[255] *Cfr.* Chapter II, § 4.

between authorship and ownership (§ ***2.1***), also with regards to designs stemming from the work of a plurality of creators (§ ***2.2***) or of designers bound by employment relationships (§ ***2.3***), up to those situations in which the design is the product of dematerialized entities (§ ***2.4***).

2.1. Authorship v. ownership

The system of design protection attributes the economic right to the design to the entity who has funded its development and who is able to invest in the production and sale of products incorporating it with the expectation of profit[256]. In this context, little space is left for the protection of the designer's non-economic interest, which is solely limited to the possibility of being recognized as the "father" of its creations[257].

Consequently, the creation of a design gives rise to two separate rights, the one pecuniary and the other non-pecuniary: the right to the design and the right of paternity. Both can be attributed to designer if they have self-funded their own creative process and intend to profit off of the design by directly manufacturing and selling products incorporating it; however, if the majority of the funding for the creation and development of the design have come from a company or any other subject with the ultimate goal of economically exploiting the result of the creative process, this entity shall be granted ownership of the design right, while the designer shall only be recognized authorship of the design itself.

On the one hand, the right of paternity is enshrined in Art. 5 (2) (b) (i) Hague Agreement[258], in Art. 18 Designs Regulation[259] and, with reference to Italian design law, in Art. 38 (3), last period, CPI[260]: due recognition is given to the designer by noting their name in the application and subsequent registration. As it is based on a general principle of protection of the moral personality of the author, it is not mandatory and can be

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[256] FABBIO in BERTANI et al., *ibidem*, p. 347.
[257] FABBIO in BERTANI et al., *ibidem*, p. 350; TISCHNER, *ibidem*, p. 171.
[258] Art. (2) (b) (i) Hague Agreement allows the filer of an international design to notify WIPO of "*indications concerning the identity of the creator of the industrial design that is the subject of that application*".
[259] Art. 18 Designs Regulation reads as follows: "*The designer shall have the right, in the same way as the applicant for or the holder of a registered Community design, to be cited as such before the Office and in the register. If the design is the result of teamwork, the citation of the team may replace the citation of the individual designers*".
[260] The last period of Art. 38 (3), while referring to designs made by employees, states that the designer has the right to be "*acknowledged as the author of the design or model and to have his name entered in the certificate of registration*".

renounced by the designer itself[261]; in any case, no sanction is established for failure to comply, which devoids it even more of any practical value[262].

On the other hand, Art. 14 (1) Designs Regulation and Art. 38 (2) CPI vest the right to the design in the designer or its successor in title[263]; in the sense of Art. 17 Designs Regulation, the receiving office presumpts that the designer is the filer of the application, who does not have to provide proof of their entitlement to ownership[264].

2.2. Multiple authors

As the creation design is likely to involve multiple individuals, each tasked with a specific part or role in the process, Art. 14 (2) Designs Regulations provides that

> "*If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly*".

The contribution of multiple designers the creative effort should be recognized as co-authorships whenever it is substantial to the final design, such as:

- When they progressively alterate or update the same elements of the designs;
- When they intervene in the process of specifying and perfecting the final design;
- In case of complex products or designs, when each designer is tasked with the creation of a part of the final design. In addition to the right of co-paternity of the

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[261] Pursuant to Art. 36 (3) (e) Designs Regulation, if the author of a designs applied for registration as RCD wants to stay anonymous, the application must be accompanied by "*a statement under the applicant's responsibility that the designer or the team of designers has waived the right to be cited*".
[262] TISCHNER, *ibidem*, p. 172-173.
[263] The expression "successor in title" in vague and not specified elsewhere by neither national nor international legislators. This usually means that the right to the design can be transmitted via succession both *mortis causa* and *inter vivos*, but also via contract, the latter seeming more consistent with the *market approach* to design protection as it is best suited to grant the economic exploitation of the design and the continuation of the innovation cycle. *Cfr.* also, CJEU, judgement of 2 July 2009, case C-32/08 – *FEIA / Cul de Sac Espacio Creativo SL – Acerta Product & Position SA*, § 79: "[…] *the possibility of assigning by way of contract the right to the Community design from the designer to his successor in title within the meaning of Article 14(1) of the regulation is consistent with both the wording of that article and the aims of the regulation*"; Opinion of Advocate General Mengozzi in case C-32/08, § 50: "*The regulation in fact places the designer and his successor in title, as defined above, on the same footing as regards acquiring the ownership of the rights to exploit the Community design, the only obvious difference being that the designer acquires such rights in an original capacity, as a result of creating the design, while the successor in title derives them by means of transfer*".
[264] FABBIO in BERTANI et al., *ibidem*, p. 347.

complex design, the author can also be recognized authorship of the single component of the complex product[265].

To the contrary, co-designership is not recognized to the individual who performs a task based on given instructions, works on minimal elements, chooses between pretermined options or gives generic indications or ideas, and whose work is subject to the approval or revision of a supervisor or another designer, as this contribution is deemed "immaterial" to the final product[266].

2.3. Designs made by employees

Whereas the author of the design is bound by an employment relationship, and the design has been developed in execution of the employee's duties or following the employer's instructions, Art. 14 (3) Designs Regulation establishes that the right to the design is automatically vested in the employer unless the parties have agreed otherwise. This default ownership system, commonly found across various national regimes (such as in Art. 38 (3) CPI), aims at addressing the conflict between labour law and IP law regulations: since the purpose of a designer's employment contract is typically to complete projects that could benefit the employer, without such specific provisions, employees would need to transfer their rights to employers individually or could potentially assign them to a different party, thus devoiding the employment contract of its meaning[267].

Art. 14 (3) CPI is undoubtedly applied when the employment contract explicitly stipulate that the work performed in the course of the employment consists exactly of design development, but it also applies to all situations in which the making of the design falls within the types of activity that the employer may reasonably expect or demand from the

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[265] Of course, if the component itself fulfills the requirements for protection. *Cfr.* Chapter II, § 2.2.
[266] FABBIO in BERTANI et al., *ibidem*, p. 348-349; FABBIO, *ibidem*, p. 132-133.
[267] TISCHNER, *ibidem*, p. 184-185; SANNA, *ibidem,* p. 198; CJEU, judgement of 2 July 2009, case C-32/08 – *FEIA / Cul de Sac Espacio Creativo SL – Acerta Product & Position SA*, § 50; Opinion of Advocate General Mengozzi in case C-32/08, § 52: "[…] the Community legislature has seen fit to introduce uniform rules on the basis of which, in the absence *of a specific agreement of the parties to the contract of employment or of a provision of national law applicable to such a contract that would confer the right to the design produced by the employee on the designer, the right to the design is to vest in the employer without the need for a specific transfer. In that respect, contrary to the Commission's argument, Article 14(3) does not introduce an exception to the rule laid down by Article 14(1), but supplements it, providing for a separate set of rules where it is necessary to determine the right to the Community design in the context of a specific contractual relationship*".

employee, and the relationship generally carries with it a duty to create the design for the employer's benefit. The scope of the employee's responsibilities should be determined on a case-by-case basis especially with regards to problematic situations, such as for designs created during the employee's free time or those developed during working hours out of an autonomous initiative of the employee:

- As for the first hypothesis, the right to designs created by employees outside working hours shall be vested in the employer whenever they would have been assigned to the employer if they had been developed on the workplace as part of the employment relationship and, at the same time, the author is granted autonomy in the creative process. This is to avoid the employee leaving the creation of design, which may have been devised on the workplace as part of their duties, to their free time in order to benefit from the patrimonial right to the design;
- As for the second hypothesis, the employee enjoys the right to a design created during working hours out of their own initiative if the design falls outside the employer's business or market strategy, or if the initiative is extraneous to the employment relationship.
- In any uncertain case, the right to the design shall be attributed to the employer: coherently with the *market approach* to design protection, the employer is presumed to be better suited to exploit the designs for investment, development and business purposes, unless otherwise agreed or established[268].

Additionally, when faced with the question whether this notion encompasses designs made under commission or other types of contractual obligations different from an employment contract: European Courts have argued that Art. 14 (3) CPI provides for a special regime exclusive to employment relationship, while designs created in the context of a different contract fall under the general provision of Art. 14 (1) CPI; hence, the right to the commissioned design shall be awarded "*on the basis of the intention of the parties set out in the contract, and also in accordance with the applicable law*"[269].

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[268] FABBIO, *ibidem*, p. 137-138; TISCHNER, *ibidem*, p. 188-189; FABBIO in BERTANI et al., *ibidem*, p. 349.
[269] Opinion of Advocate General Mengozzi in case C-32/08, § 53; FABBIO, *ibidem*, p. 135; *cfr.* also, EUIPO Third Board of Appeal, judgement of 11 February 2008, case R 64/2007-3 – *ISS Manufacturing Limited / Christian M. Andersen (loudspeakers)*, § 18.

2.4. Computer generated and AI designs

In recent years, the growing role of generative technologies has been raising questions about ownership and authorship of intellectual property objects, especially within copyright and patent law; although legislative and jurisprudential discourse on computer-generated or computer-aided design is still underexplored, the legal doctrine have started setting out some basic principles concerning Computer-Aided Design (CAD), designs developed with Artificial Intelligence (AI), and "authorless" designs[270].

Thus far, the only national legislation expressly regulating computer-generated design is the United Kingdom. Art. 263 (1) and 214 (2) Copyright, Designs and Patents Act 1988 provide that

"*"computer-generated", in relation to a design, means that the design is generated by computer in circumstances such that there is no human designer*"

> "*In the case of a computer-generated design the person by whom the arrangements necessary for the creation of the design are undertaken shall be taken to be the designer*"

The solution to vest the paternity right to the model in the user of the AI or CAD kit, who has given the system the parameters or imput to generate the design and has corrected and finalized the final product before mass production – be it the designer, the programmer or the owner of the computer or software on which the design is developed – seems to be the most consistent with the *market approach* to design, and especially to the purpose of design protection as laid out by the European Legislator[271].

In order to solve possible difficulties in the designation of an author, the link between the human and the machine work shall be emphasized: the right of authorship and ownership of a design created by or with the help of generative technologies shall be attributed to the physical or juridical entity to which the machine is linked, whether the subject has

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[270] FABBIO in BERTANI et al., *ibidem,* p. 351.
[271] SENA G. (2020). *Intelligenza Artificiale, opere dell'ingegno e diritti di proprietà industriale e intellettuale*. Rivista di diritto industriale, VI, p. 328; FABBIO P. (2021*). Intelligenza Artificiale e disciplina dei disegni e dei modelli*. Rivista di diritto industriale, III, p. 138.

programmed, given imput or taken advantage of the AI or CAD tools or they simply own the software or hardware from which the design originates[272].

The legal doctrine has also considered "authorless designs", *i.e.* the hypothetical (for now) case in which the final design has been entirely generate by AI without any human apport. As AI systems cannot be recognized authorship, it is deemed that computer-generated designs created by autonomous choices of AI using standard tools should fall under public domain, as no right to the design exists. However, given the the role of design protection in stimulating investments in design creativity, legislators and stakeholders are called to rethink the impact of AI on the concept of designership and on the design community[273].

3. Rights conferred by registration

The holder of a registered design is granted, on the one hand, the exclusive right to use it and, on the other hand, to prevent others to use it without its permission, "use" being intended as any economic exploitation of the design itself. National, European and international design protection systems all contain similar, non-exhaustive enumerations of prohibited acts that can amount to infringement of the design right (§ ***3.1***). Third parties can only be allowed to use protected designs with the authorization of the holder, which is usually grated via licensing agreements (§ ***3.2***), under condition of fair use (§ ***3.3***) or if they are entitled to a right of prior use (§ ***3.3***).

3.1. Infringement

Infringement can be defined as the act or activity of a third party that affect the interest of the holder to economically benefit from their design rights[274]. Art 26 (1) TRIPs Agreement, Art. 12 (1) Designs Directive, Art. 19 (1) Designs Regulation and Art. 41 CPI contain a similar, non-exhaustive enumeration of prohibited acts that can amount to infringement of the protected design, namely "*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*".

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[272] TISCHNER, *ibidem*, p. 176-177; SENA, *ibidem,* p. 330.
[273] FABBIO in BERTANI et al., ibidem, p. 351; TISCHNER, *ibidem,* p. 177.
[274] FABBIO in BERTANI et al., *ibidem*, p. 361.

The assessment of infringement mirrors the assessments of the requirements for protection: a later design does not present material differences and does not produce on the informed user a different overall impression on the informed user compared to a previous design, the holder of the infringed design can initiate proceedings against any unauthorized commercial use of products incorporating their registered design by a third party, regardless of said third party being the holder of a later valid registered design[275].

3.1.1. Making

The first enumerated act of infringement is the physical reproduction of the product incorporating the registered the design. Being a preparatory act to the other infringement acts (commercialization, import etc.), it affects the economic interest of the design holder indirectly, but it is considered counterfeiting nonetheless. The production of intermediate products or parts of complex products amounts to indirect infringement as well if they only require assembly or transformation by the end user to recreate the product integrating the registered design, or whereas said component represents a registered design itself. Additionally, reproduction is prohibited for prototypes and molds, whereas they are functionally and aesthetically identical to the final product and their use does not fall under a licensing agreement or under the limitation for experimental purposes. To the contrary, neither the activity of planning a design with drafts, sketches, outlines etc., nor the repairing of an original product amounts to infringement, as not to excessively limit the creativity of the designer or the freedom of the user to repair purchase goods[276].

Art. 16 (2) (d) Proposed Directive and Art. 19 (2) (d) Proposed Regulation expand the list of infringing reproduction acts to include

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[275] FABBIO in BERTANI et al., *ibidem,* p. 363-364; SANNA, *ibidem,* p. 204; CJEU, judgement of 16 February 2012, case C-488/10 – *Celaya Emparanza y Galdos Internacional SA/Proyectos Integrales de Balizamiento SL,* § 52. Additionally, the CJEU has specified that the owner of bring infringement proceedings against the holder of a later RCD, the holder of the prior design does not have to obtain a declaration of invalidity of the infringing design – although, as underlined by Advocate General Mengozzi in § 39 of his opinion, "*If the holder of the earlier design is successful in infringement proceedings against the holder of a later design, but then decides not to seek a declaration of invalidity in respect of that later design, the legal position of the later design remains, so to speak, equivocal. On the one hand, the product in question can no longer be marketed. On the other, since the national court has not declared the later design invalid, as it has no jurisdiction to do so, that design remains valid from a formal point of view, and, in theory, its holder could use it, albeit no longer to market the relevant product, at least to bring proceedings against other manufacturers and/or holders of registered designs*". For the analysis of the requirements for protection, *cfr.* Chapter II.

[276] FABBIO, *ibidem*, p. 156-157.

"*Creating, downloading, copying and sharing or distributing to others any medium or software recording the design for the purpose of enabling a product referred to in point (a) to be made*"[277].

Pursuant to Recital 28 to the Proposed Directive and Recital 11 to the Proposed Regulation, this provision covers indirect infringement via 3D printing technologies, which allow for physical reproductions of a design via sharing software that encodes the design, which is then processed and translated by a computer, to ensure full effectiveness of the right of the holder to prevent the illegitimate copying of their protected design[278].

3.1.2. Offering

The offer of a product can be defined as a communication to third parties aimed at promising certain advantages specifically depending on the design at issue. The offer of infringing products affects the holder of the copied design both directly, as it interferes with the latter's communications, and indirectly, as it precedes the sale of the counterfeits[279].

3.1.3. Putting on the market

In order to safeguard the economic interest of the design holder, he notion of "putting on the market" shall be intended in a broad sense as to include the making available of the product to third parties free of charge or against payment, temporarily or permanently, whereas the transaction can affect sales made by the design owner[280].

3.1.4. Importing, exporting and transit

Import and export consist in the transfer of physical goods from or to another country; as they represent preparatory acts to the commercialization of copied products, they amount to indirect infringement.

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[277] Point (2)(a) of both Art. 16 Proposed Directive and Art. 19 Proposed Regulation prohibits "*making, offering, putting on the market, or using a product in which the design is incorporated or to which the design is applied*"

[278] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p. 11-12. The authors also call for the introduction in the Design Package of infringement by way of sharing any medium or software including the registered design (*e.g.* by recording the screen with the design or by way of analogy), without limitations to the purpose of producing a final product.

[279] FABBIO, *ibidem*, p. 158; FABBIO in BERTANI et al., *ibidem*, p. 362

[280] *ibidem*

Currently, a product incorporating a different design can transit through a country where the latter is registered if the former is validly registered in the countries of origin and of destination. This will change with the introduction of Art. 16 (3) Proposed Directive and Art. 19 (3) Proposed Regulation, which state that:

> "[…] *the holder of a registered design right shall be entitled to prevent all third parties from bringing products, in the course of trade, from third countries into the Member State where the design is registered, that are not released for free circulation in that Member State, where the design is identically incorporated in or applied to those products, or the design cannot be distinguished in its essential aspects from such products, and an authorisation has not been given*".

Recitals 29-30 to the Designs Directive and Recitals 12-13 to the Designs Regulation clarify that this provision, in conformity with the TRIPs framework, would better protect the interest of the design holder and render the system of design protection more effective and more consistent with IP regulation in its entirety[281].

3.1.5. Using and stocking

The usage of product incorporating the contested design constitutes an act of infringement whenever the third party derives an economic advantage from it (e.g. in case of use as decoration), meanwhile stocking amounts to infringement only if preparatory to one of the acts insofar analyzed, also taking into account the stocked quantities and the type of

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[281] Recitals 12-13 Designs Regulation read as follows:
(12) "*In order to ensure design protection and combat counterfeiting effectively, and in line with international obligations of the Union under the framework of the World Trade Organisation (WTO), in particular Article V to the General Agreement on Tariffs and Trade (GATT), which provides for freedom of transit, and, as regards generic medicines, the Declaration on the TRIPS Agreement and Public Health, the holder of a registered EU design should be entitled to prevent third parties from bringing products, in the course of trade, into the Union without being released for free circulation there, where such products come from third countries and without authorisation incorporate a design which is identical or essentially identical to the registered EU design or where a design is applied to those products which is identical or essentially identical to the registered EU design".*
(13) "*To that effect, it should be permissible for holders of registered EU designs to prevent entry of infringing products and their placement in all customs situations, also when such products are not intended to be placed on the market of the Union. In performing customs controls, the customs authorities should make use of the powers and procedures laid down in Regulation (EU) No 608/2013 of the European Parliament and the Council, including at the request of the right holders. In particular, the customs authorities should carry out the relevant controls on the basis of risk analysis criteria".*
Recitals 29-30 to the Designs Directive are almost identical. *Cfr.* also, KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem*, p. 12-13.

stocker (e.g. if the stocker holds large amounts of copied product and is an entrepreneur in that particular sector, then the stocking is considered as infringement)[282].

3.1.6. Other prohibited acts

To conclude the overview on acts that can be considered as infringement, some additional cases shall be considered. In particular:

- The purchase of counterfeits does not constitute a prohibited act, to the extent that the purchased product is intended for private use;
- Graphic reproduction of the copied design does not amount to infringement, unless the images itself constitute infringement (e.g. in case of posters) or are linked to a commercial offer;
- Under Art. 19 (2), second period, Designs Regulation, the "fortuitous encounter", *i.e.* any design independently created but identical to a prior unregistered design or to an unpublished registered design, does not amount to infringement "*if it results from an independent work of creation of a designer who may be reasonably thought not to be familiar"* with the prior design. This is aimed at protecting innovation and fair competition on the market rather than the personality of the author of the design: if a design has not been entered into a registry or published, it is deemed that the designer could not have reasonably known the prior one[283]. In this case, as it will be explained later, a right of prior use may also be vested in the designer[284].

3.2. Limitations

In order not to excessively hinder innovation fueled by the circulation of creative ideas, Art. 26 (2) TRIPs Agreement establishes that

> "*Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties*"[285].

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[282] FABBIO, *ibidem,* p. 159; FABBIO in BERTANI et al., *ibidem*, p. 362.
[283] FABBIO, *ibidem*, p. 160-163.
[284] *Cfr.* below, § 3.4.
[285] BERTANI, *ibidem*, p. 40.

For European Design Law, the main catalog of limitations is enshrined in Art. 13 (1) Designs Directive and Art. 20 (1) Designs Regulation (along with Art. 42 (1) CPI), which refer to

> *"(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".*

Additional limitations concerning ships and aircraft are provided for in Art. in Art. 13 (2) Designs Directive and Art. 20 (2) Designs Regulation. Here, the analysis will focus on the three types of limitations as listed above.

3.2.1. Acts done privately and for non-commercial purposes

Private users may not be aware that they have purchased a product incorporating an infringed design, and it would be too burdensome to ask them to verify the status of a design every time they purchase something. This, along with the fact that design protection usually concerns product that require industrial production, and that the individual limits purchase to a few pieces, entails that the economic interest of the design owner is not compromised by the private, non-commercial use of a copied product. On the one hand, "private use" refers to the person rather than the space: it includes usage by the user and their family, friends and neighbors, not including usage by companies, firms, public administrations, libraries etc. On the other hand, "non-commercial use" implies that there is occasional to no profit involved, as massive manufacturing and sale would qualify as commercial use[286].

3.2.2. Acts done for experimental purposes

The limitation for experimental uses originates from patent law and is aimed at preventing registration as designs of experimental objects, which cannot be patented as not to hinder

[286] FABBIO, *ibidem*, p. 165-166; FABBIO in BERTANI et al., *ibidem*, p. 364-365.

development and research in that particular field. In any case, experimental usage of designs for project development and production of prototypes to be showcased to potential buyers or partners are permitted, as they are merely preparatory to usage and do not directly affect the interest of the design holder. However, market tests or sample giveaways directly subtract profit from the holder, hence they cannot benefit from this limitation[287].

3.2.3. Acts done for citation or teaching purposes

Free reproduction of a registered design for citation and teaching purposes is allowed as expression of the freedom of speech, research and teaching. On the one hand, usage for citation implies that the used design is recognizable as the result of the creative effort of a different subject, and that the reproduction is not made for the sole purpose of commercially exploiting the legitimate holder's designs. Usage in teaching, on the other hand, occurs within lessons, courses or tests held by academic institutions or by companies (e.g. during internal trainings); it includes reproduction in textbooks and by students and teachers during classes and exams.

In such occurrences, a protected design can be freely reproduced whereas the acts of reproduction are compatible with fair trade practice, there is no undue prejudice to the normal exploitation of the design on account of such acts and the source is mentioned[288].

The Design Package contains some updates to this limitation to expressly include "*acts carried out for the purpose of identifying or referring to a product as that of the design right holder*" and "*acts carried out for the purpose of comment, critique or parody*"[289]. Both European courts and authors have long called for an update to the list of limitations, as it was deemed too narrow and unclear especially with regards to allowed citation acts. In this sense, the CJEU has clarified that the reproduction of a registered design for the purpose of "*lawfully offering for sale goods intended to be used as accessories to the specific goods of the holder of the rights conferred by those designs, in order to explain*

[287] FABBIO, *ibidem*, p. 167; FABBIO in BERTANI et al., *ibidem*, p. 365.
[288] FABBIO, *ibidem*, p. 168-170; FABBIO in BERTANI et al., *ibidem*, p. 366-367; CJEU, judgement of 27 September 2017, joined cases C-24/16 and C-25/16 - *Nintendo Co. Ltd./BigBen Interactive SA – GmbH*, § 78; ANDREOLETTI M. A. (2018). *L'utilizzo del disegno e modello ai fini di citazione*. Rivista di diritto industriale, II, p. 198.
[289] Respectively, Art. 16 (1) (d) and (e) Designs Directive and Art. 20 (1) (d) and (e) Proposed Regulation.

or demonstrate the joint use of the goods" falls within the case of fair use for citation, reference or advertisement purposes insofar as the source in mentioned in a way that "*enables a reasonably well-informed and reasonably observant and circumspect consumer easily to identify the commercial origin of the product corresponding to the Community design*" [290]. Instead, the act of comparing similar products to suggest that the later design is better than the prior one is prohibited, as the infringers "*takes unfair advantage of the holder's commercial repute*"[291].

As they limit the rightful holder's design right, this set of limitations is exhaustive and not meant for extensive interpretation; for this reason, the legal doctrine is currently suggesting the European legislator modifies the Design Package proposal as to encompass a more general "use of design by reference" in the list of limitations as to permit referential use as a rule instead of the current circumstantiated cases, which may cause some interpretative issues in the future for unclear situations[292].

3.3. Right of prior use

Art. 22 Designs Regulation introduces an additional limitation in favor of third parties who, before the relevant date of a registered design have prepared or commenced use in good faith of a design falling within the scope of protection of the registered design, the so-called "right of prior use"; this protects the investments made by the third party in good faith before the registration or claim of priority of the design holder, granted that the design at issue had been independently created by the former[293].

Art. 22 (2) Designs Regulation specify that the third party can continue using the design

> "*For the purposes for which its use had been effected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design*".

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[290] CJEU, judgement of 27 September 2017, joined cases C-24/16 and C-25/16 - *Nintendo Co. Ltd./BigBen Interactive SA – GmbH*, § 84-86; ANDREOLETTI, *ibidem*, p. 202.
[291] CJEU, judgement of 27 September 2017, joined cases C-24/16 and C-25/16 - *Nintendo Co. Ltd./BigBen Interactive SA – GmbH*, § 80; ANDREOLETTI, *ibidem*, p. 202-203.
[292] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p. 15-16. The authors also suggest reducing the benchmark for artistic uses (such as parody) to honest trade practices, as requiring the same identification as for the other types of usage would be inappropriate, and applying to designs the same rules as for trademarks whenever a product is identified by its trademark.
[293] This happens in case of the "fortuitous encounter" as defined above, *cfr.* § 3.1.6 of this chapter.

The same limitation applies to the territory in which use or preparations had commenced, while no indications are given concerning the quantities that can be sold.

Pursuant to Art. 22 (3) and (4), the right of prior use restricts the authorized party from granting licenses for or limiting usage of their own limited right; additionally, if the third party is a business, the right can only be transferred jointly to the business of branch thereof in the context of which the authorized acts have been carried out[294].

While the Design Directive does not establish a right of prior use, Art. 21 Proposed Directive lays out an identical provision to Art. 22 (1) and (2) Designs Regulation, without establishing the abovementioned restrictions for the authorized party[295].

3.4. Licensing

What has been said on infringement and limitations implies that the holder of the protected design has not authorized use of their design. However, if the design holder grants authorization via any type of unilateral act or contract, either implicit or explicit, the third party can legitimately exploit the design right for the commercial purposes agreed upon or unilaterally decided by the design holder[296].

The authorization is typically contained in a licensing agreement. This aspect of design protection is still largely unharmonized and often lacks specific regulation within national laws, as neither international agreements nor the Designs Directive contain any reference to it. The only relevant provision is Art. 32 Designs Regulation, which establishes a detailed discipline for the licensing of RCD.

The license may be either exclusive or non-exclusive and may be limited to specific categories of products; multiple design registrations can be split up and each design can

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[294] FABBIO in BERTANI et al., *ibidem*, p. 357; KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p.18.

[295] Although the Explanatory Memorandum to the Proposed Directive does not provide any explanation in this respect, the most likely reason appears to be that the Proposed Directive is silent on matters concerning the design right as property, to which Art. 22 (3) and (4) apply. *Cfr.* KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p.18.

[296] In any case, the mere tolerance of an infringing act does not amount to authorization, and, in case of conflict, the burden of proving that the authorization has occurred lies upon the alleged infringer. See FABBIO in BERTANI et al., *ibidem*, p. 363.

be licensed individually. The Design Regulation also provides for conflicts between the licensor and the licensee and between holders of different types of licenses[297].

The law applicable to the conflict is the law of the EU Member State in which the acts of infringement, either occurred or threatened, have taken place[298]; pursuant to Art. 88 Designs Regulation, the party whose right has been infringed is entitled to the sanctions and provisional measures laid out by Artt. 89-90 Design Regulation or by the national law of the Community design court hearing the proceedings, including its private international law[299].

No progress on the harmonization process has been made, leaving a lot of contradictions and different levels of strictness between the national legislations of EU Member States: this is confirmed by the fact that no provision on licensing has been introduced in the Proposed Directive and the Proposed Regulation contains no update on the matter[300].

4. Invalidity

When examining any application for design registration, the receiving IP office, be it WIPO, EUIPO or any other regional or national office, assesses that the application fulfills the formal requirements above listed[301], and that the requested design is

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[297] Art. 32 (2) (3) (4) (5) Designs Regulation reads as follows:
2. "*Without prejudice to any legal proceedings based on the law of contract, the holder may invoke the rights conferred by the Community design against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form in which the design may be used, the range of products for which the licence is granted and the quality of products manufactured by the licensee.*
3. *Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community design only if the right holder consents thereto. However, the holder of an exclusive licence may bring such proceedings if the right holder in the Community design, having been given notice to do so, does not himself bring infringement proceedings within an appropriate period.*
4. *A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in an infringement action brought by the right holder in a Community design.*
5. *In the case of a registered Community design, the grant or transfer of a licence in respect of such right shall, at the request of one of the parties, be entered in the register and published".*
[298] CJEU, judgement of 13 February 2014, case C-479/12 - *H. Gautzsch Großhandel GmbH & Co. KG/ Münchener Boulevard Möbel Joseph Duna GmbH*, § 52; TISCHNER, *ibidem*, p. 199-200.
[299] TISCHNER, *ibidem*, p. 200. In Italy, the civil remedies for design protection are the same as for all other IP rights, and can be found in Title III, Section I CPI (Artt. 117-146).
[300] Art. 32 Proposed Regulation is identical to Art. 32 Designs Regulation, with the only news being Art. 32 (a) on the procedure for entering licenses and other rights in the EUIPO Register.
[301] *Cfr.* § 1.1 of this chapter.

conforming to the definition of design and lawful pursuant to the applicable law[302]. If the application passes this test, the requested design(s) are validly registered.

This is consistent with Art. 12 (1), first period of the Hague Agreement, which states that

> "*The Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration in the territory of the said Contracting Party*"

The other requirements for protection are not assessed during the application phase; therefore, if the design is not refused registration *ex ante,* they can be invoked as grounds for invalidity *ex post*. As provided for by Art. 15 (2) Hague Agreement,

> "*Invalidation, by the competent authorities of a designated Contracting Party, of the effects, in part or in whole, in the territory of that Contracting Party, of the international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights*".

With regards to European Design Law, Art. 11 Designs Directive enumerates all circumstances in which the national IP office should refuse registration or, if the design has already been registered, the competent authority should declare the invalidity of the registered design. A corresponding provision is found in the national design laws of EU Member States (for Italy, in Art. 43 CPI, rubricated as "nullity") for national designs and in Art. 25 Designs Regulation for RCDs.

Pursuant to these provisions, a registered design may be declared invalid in the following cases:

1) If the design does not correspond to the definition of design[303];

[302] *Cfr.* chapter II, §§ 1.1, 6.
[303] *Cfr.* chapter II, § 1

2) If the design lacks one or more requirements of protection (e.g. it is not new and/or does not possess individual character)[304];
3) If the design is unlawful or constitutes improper use of one of the items listed in Art. 6*ter* Paris Convention[305];
4) If the design is solely dictated by the technical function of the product[306];
5) If the applicant for or the holder of the design right was not entitled to it under the applicable law[307];
6) For the so-called "bypassing invalidity", if the design violates a prior design whose deposit had not been published or whose priority had been claimed after its registration[308];
7) if the design constitutes an unauthorized use of a work protected under copyright law[309];
8) if the design incorporates a distinctive sign, and the law governing that sign confers on the holder of the right to that sign the right to prohibit such use[310].

The list is exhaustive and has not been modified or expanded by the Design Package.

4.1. Relative v. absolute invalidity

While certain grounds for invalidity are absolute, *i.e.* they can be invoked by anyone to safeguard the public interest to only grant protection to valid designs, others can only be invoked by the holders of a conflicting right[311].

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[304] *Cfr.* Chapter II, § 3,4
[305] *Cfr.* Chapter II, § 6
[306] *Cfr.* Chapter II, § 1.3
[307] Art. 43 (1) (c) CPI; Art. 11 (1) (c) Designs Directive; Art. 25 (1) (c) Designs Regulation. *Cfr.* Chapter III, § 2.
[308] Art. 43 (1) (d) CPI; Art. 11 (1) (d) Designs Directive; Art. 25 (1) (d) Designs Regulation. *Cfr.* Chapter III, § 1.4.
[309] Art. 43 (1) (e) CPI; Art. 11 (2) (b) Designs Directive; Art. 25 (1) (f) Designs Regulation. Interference with third party copyright shall be intended broadly as to include not only designs protected as copyright, but also graphic works of art, photography or cinematography, and visual reproductions of works belonging to other figurative arts or genres. In this case, the party invoking invalidity shall prove that they are the rightful owner of the copyright and that the design constitutes an unauthorized reproduction of their copyrighted work. In this sense, FABBIO in BERTANI et al., *ibidem*, p. 358; FABBIO, *ibidem*, p. 177.
[310] Art. 43 (1) (e) CPI; Art. 11 (2) (a) Designs Directive; Art. 25 (1) (e) Designs Regulation. Interference with a third-party distinctive sign occurs when the sign is used in a design destined to be incorporated in identical or similar products, if such application creates a risk of confusion for the consumer (as intended in trademark law). In this sense, FABBIO in BERTANI et al., *ibidem*, p. 358; FABBIO, *ibidem*, p. 177-180.
[311] SANNA, *ibidem*, p. 210.

The cases of relative invalidity as enumerated in Art. 11 Designs Directive, Art. 25 Designs and Art. 43 CPI are the following:

- Invalidity for interference with a third-party copyright or distinctive sign can only be invoked by the holder of the infringed right or its successor in title;
- Bypassing invalidity can only be invoked by the owner of the holder of the design whose priority is invoked;
- Invalidity for a design registered by an unentitled individual can only be invoked by the person who is entitled to the design right;
- Invalidity for violation of Art. 6*ter* Paris Convention can only be invoked by the person or entity concerned by the use.

All remaining instances constitute absolute invalidity, which can be invoked by anyone, including the public authority of the Member State concerned with the registration. Here, it is important to remind that the test for invalidity is carried out on a one-on-one basis, especially when the contested design is deemed to lack novelty or individual character[312].

4.2. Consequences of invalidity

Pursuant to Art. 26 (1) Designs Regulation,

"*A Community design shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that it has been declared invalid*".

The declaration of invalidity operates *erga omnes* and *ex tunc*, as if the invalid design had never existed[313]. However, under Art. 26 (2) Designs Regulation, this does not affect

> "*(a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the invalidity decision;*
>
> *(b) any contract concluded prior to the invalidity decision, in so far as it has been performed before the decision; however, repayment, to an extent justified by the circum- stances, of sums paid under the relevant contract may be claimed on grounds of equity*".

[312] *Cfr.* above, Chapter II; §§ 3.2 and 4.4.
[313] SANNA, *ibidem*, p. 211-212.

Additionally, according to Art. 11 (7) Designs Directive and Art. 25 (6) Designs Regulation, if the cause of invalidity only refers to part of the design, registration can be maintained if the modified design does not significantly alter the scope of protection of the original design[314]. Finally, ex Art. 11 (9) Designs Directive, even expired or renounced registered designs can be declared invalid, with the purpose of excluding the invalidity of later conflicting designs[315].

4.3. How is invalidity actioned?

While the Designs Directive does not contain any provision as to the authority in front of which invalidity shall be invoked, Artt. 52 to 54 Designs Regulation lay out the procedure to be followed for the declaration of invalidity of RCDs. In particular, the action shall be brought in front of the EUIPO Invalidity Division which, after a formal check, start the proceedings at the necessary presence of the applicant for invalidity and the holder of the contested RCD. The Decision of the Invalidity Division can be appealed in front of the EUIPO Third Board of Appeal, the EU General Court and, as a last instance, the CJEU.
Instead, pursuant to Art. 24 (3) Designs Regulation, counterclaims can be actioned in front of Community Design Courts, which are specialized tribunal selected by Member States[316].As for designs registered in Italy, the procedure for invoking nullity is laid out in Art. 118 *et seq.* CPI and applies to all IP rights. Pursuant to Art. 122 (4) CPI and Legislative Decree 27 June 2003, n. 168, jurisdiction lies within the Industrial Divisions of the civil tribunals and courts of appeal of Bari, Bologna, Catania, Florence, Genoa, Milan, Naples, Palermo, Rome, Turin, Trieste and Venice, which also serve the purpose of Community Design Courts in the sense of European Design Law.

[314] This is the case for "hard designs", whose individual character is not compromised by the partial invalidity and/or the alteration only involves minimal details. *Cfr.* FABBIO, *ibidem*, p. 181; FABBIO in BERTANI et al., p. 359.
[315] SANNA, *ibidem*, p. 210.
[316] *Ibidem*, p. 211.

CHAPTER IV – UNREGISTERED DESIGNS

As established in the previous chapter, the holder of a design right is entitled to request and obtain registration of their creation as a national, European or international design by following the terms and procedures and against payment of registration (and renewal) fees accordingly.

Certain sectors of industry, however, deal with ephemeral or short-lived products, or change their designs constantly depending on evolving trends or requirements within their field: for these types of products, going through the whole registration process seems excessively burdensome and expensive, considering that the design holders usually have no intent of renewing registration *a priori.* This especially applies to the fashion industry, whose constant trend cycles and "seasons" require short-term protection against counterfeits and imitations.

To tailor design protection to the needs to the ever-changing needs of industry, technology and market, the EU legislator introduced the Unregistered Community Design (UCD) in the Design Regulation as a short-term, formality-free alternative to RCDs. The purpose behind the instrument, as laid out by the European Commission, is twofold:

- on the one hand, it allows the designer to test the commercial value of the design on the market before deciding whether it is worthwhile to commence the registration process (during the so-called grace period);
- on the other hand, it grants protection to designs which were not intended to be manufactured, marketed or sold long-term from the outset[317].

Since its introduction, the UCD format has been used extensively in all the industry sectors for which it was created and beyond, as it is deemed effective and clear, although

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[317] Green Paper, p. 55, 79-80, 84; FABBIO in BERTANI et al., *ibidem*, p. 353; BOSSHARD, *ibidem*, p. 28-29; SANNA*, ibidem*, p. 212. *Cfr.* also, Recitals 16-17 to the Designs Regulation, which read as follows: "(16) *Some of those sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.* (17) *This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design*".

provisions in the Designs Regulation on the matter are very limited and have not been reproduced in the national designs legislations of EU Member States (yet)[318].

Art. 1 (2) (a) Design Regulation expressly establish that any design that fulfills the requirements for protection laid out in Artt. 4 to 9, and that has been made available to the public in the manner provided for in the Design Regulation itself, is be protected as a UCD. Pursuant to Artt. 5 (1) (a) and 6 (1) (a), an unregistered design is new and has individual character if it has been made available to the public before any other conflicting priority[319]. As for the right to the design, the person who has disclosed the design is presumed to be the rightful holder of the design right; similarly to RCDs and pursuant to Art. 15 (1), if the design has been disclosed or claimed by a person who was not entitled to it, the rightful owner can "*claim to become recognised as the legitimate holder of the Community design*"[320].

In general, the considerations made thus far on the different aspects of design protection also apply to unregistered designs. As for the differences between Registered and Unregistered Community Designs, they only concern:

- The disclosure of the design and proof thereof (§ **1**);
- The rights conferred, which only protect the UCD against copying (§ **2**);
- The duration of the protection (§ **3**).

1. Disclosure

Art. 11 (2) Designs Regulation provide that, in order to receive protection as a UCD,

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[318] A single precedent to the EU concept of unregistered design can be found in the United Kingdom's system of design protection. Art. 213 (4) Copyright, Designs and Patents Act 1988 grants protection without the need for registration, to the shape of a product (but not the decorations applied to its surface) – whether it has aesthetic or functional value – on the sole condition that the shape itself is not "*commonplace in the industry*," *i.e.* it differs from shapes generally known for that type of product. The main differences between the British legal concept and the UCD lie in the duration of exclusivity (ten to fifteen years instead of three) and the type of protection, which appears similar to that provided for a registered design as the infringement consists simply in the act of making and/or marketing a product that essentially reproduces the overall impression created by the design. *Cfr.* BOSSHARD*, ibidem*, p. 28.
[319] *Cfr.* Chapter II, § 3-4.
[320] *Cfr.* Chapter III, § 2.

> "*A design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality*".

The relevant events are the same that, pursuant to Art. 6 (1), render a prior design validly enforceable against the contested design for the purpose of assessing novelty and individual character[321]. In particular, the concepts of "reasonable knowledge" entails that the supposed knowledge of the design in the specialized circles within at least one of EU Members States gives rise to the unregistered design right: this is consistent with the purpose of the UCD system, which grants designer limited protection on design whose limited production or market test would not justify formal disclosure via registration on a continental level[322].

To avoid abuses, Art. 85 (2) Designs Regulation introduces a presumption of validity of UCDs subject to two conditions:

> "*In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity*".

The holder of a presumed unregistered design right bears the burden to prove that one of the disclosure events has occurred and what constitutes the individual character of the

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[321] *Cfr.* above, Chapter II, § 5.
[322] SANNA, *ibidem*, p. 213; GIUDICI S. (2007). *Il design* non *registrato*. Rivista di diritto industriale, I, p. 202.

contested design[323]. As the wording is rather unprecise, European courts have clarified that it must be interpreted as solely requiring the holder to identify the features of the design which give it individual character: any additional burden of proof, such as to specifically prove the fulfillment of all requirements for individual character under Art. 6, would be incompatible "*with the objective of simplicity and expeditiousness which, as evidenced by recitals 16 and 17 in the preamble to Regulation No 6/2002, underpins the idea of protection of unregistered Community designs*"[324]. Therefore, in order for European design courts to hold a UCD as valid, the holder of the contested unregistered design must prove that one of the enumerated disclosure events has occurred, and that the elements of the design they specifically indicate as being covered by protection possess individual character[325].

The Proposed Regulation is set to remove the last sentence of Art. 110a (5) Designs Regulation, which currently reads as follows:

"*Pursuant to Article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design.*"

This has been interpreted by the legal doctrine as not to discriminate non-EU based industries, while also taking into account the increasing impracticality of localizing acts of disclosure in the age of the internet: this would not result in an automatic protection of unregistered designs disclosed worldwide, as for UCDs to be protected they would still have to "*have become known in the normal course of business to the circles specialised in the sector concerned which are operating in the EU*", but it would encompass those cases in which publication has not been made within the EU – which, thus far, have been interpreted by European courts as not constituting a valid UCD right even if disclosure within the EU had been validly occurred pursuant to Art. 11 (2)[326].

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[323] CJEU (Second Chamber), judgement of 19 June 2014, case C-345/13 - *Karen Millen Ltd./Dunnes Stores (Limerick) Ltd.,* § 37 – 45; CERA M. (2015). *Il design non registrato: una strategia di tendenza*. Rivista di diritto industriale, III, p. 246.
[324] CJEU (Second Chamber), judgement of 19 June 2014, case C-345/13 - *Karen Millen Ltd./Dunnes Stores (Limerick) Ltd.*, § 42.
[325] CERA, *ibidem,* p. 248; SANNA, *ibidem*, p. 213; FABBIO in BERTANI et al., *ibidem*, p. 353.
[326] KUR, ENDRICK-LAIMBÖCK, HUCKSCHLAG, *ibidem,* p. 9-11.

2. Rights conferred

The Design Regulation entitles the holder of a UCD to proceed against a third party who has infringed their exclusive right only if the contested use is the result of directly copying the unregistered design. In fact, according to Art. 19 (2) Designs Regulation,

> "*An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.*
>
> *The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder*"[327].

In other words, in order for a contested design to be infringing a prior UCD, the holder of the latter must prove not only that the former lacks novelty and individual character, but also that the similarities between the two designs are the result of copying and that the holder of the contested design could have reasonably become aware of the prior UCD due to its valid disclosure in the relevant sectors of the EU[328]. Proof may be based upon factors such as the identity of non-irrelevant details, the exact correspondence of shapes and measures, the degree of originality and the notoriety of the prior design. On their turn, the holder of the contested design can counterclaim that they were not aware of the UCD, that their design results from copying a different design, or that it is a fortuitous encounter[329].

Of course, as also reminded in Art. 19 (3) Designs Regulation, the same regime applies to RCD whose publication has been deferred and not yet made available to the public[330].

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[327] For the complete analysis of the acts of disclosure under Art. 19 (1) Designs Regulation, see Chapter III, § 3.1.
[328] SANNA, *ibidem*, p. 213; BOSSHARD, *ibidem*, p. 29-30; GIUDICI, *ibidem*, p. 202-203.
[329] FABBIO, *ibidem,* p. 354; As for the definition of fortuitous encounter, *Cfr.* Chapter II, § 3.1.6.
[330] GIUDICI, *ibidem*, p. 204. As for the deferment of publication, see Chapter III, § 1.1.2.

3. Terms

Finally, under Art. 11 (1) Designs Regulation, protection of UCDs lasts for three years from the date on which the design was first made available to the public within the EU. The European legislator has deemed this period as sufficient to protect ephemeral or temporary designs. If the design holder wants to extend protection of their UCD, they can do so by registering the design within the one-year grace period; otherwise, the unregistered design falls under public domain[331].

Therefore, the possibility of granting protection to unregistered designs represents the last type of protection that the designer can confer to its creation pursuant to the *market approach* to the design protection system:

- If a design is believed to create a long-lasting, strong privileged contact with the public, it can be registered as a national, European or international design;
- If the design was created with the purpose of being temporary, ephemeral or seasonal from the outset, the designer can forego registration and be recognized a short-term right limited to protection against copying.

In any case, regardless of it being registered, if a design becomes so renowned and aesthetically appreciated that it obtains distinctive character, it may be recognized protection as form trademark or copyrighted work of art – thanks to which it will continue its life beyond the scope of design protection[332].

[331] SANNA, *ibidem* p. 214; BOSSHARD, *ibidem*, p. 32. As for the grace period, see Chapter II, § 5.4.
[332] BOSSHARD, *ibidem,* p. 33.

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