Yet another change in the protection of Industrial Design vs. Copyright in Italy

In recent years, the hard-fought transitional law regarding the application of copyright protection to works of industrial design has evolved through a series of legislative provisions, enacted in quick succession and for the most part unconvincing and contradictory.

In the most recent wording of Article 239 of the Italian Industrial Property Code (IPC) introduced by Legislative Decree no. 131 of August 13th, 2010 (which implemented European directive no. 98/71/EC), copyright protection was recognised for industrial designs which, before April 19th, 2001 (the date of entry in force of the law on cumulative protection), never had been registered as designs or had a now-expired registration and thus entered the public domain.

This article allowed for a moratorium: third parties who had made or sold, in the twelve months before April 19th, 2001, copies of such products in the belief that they were products that had entered the public domain, would not be in violation of copyright by continuing their copying activities even after the date of the law's coming into force, only for products made or bought by them before April 19th, 2001 and products made by them in the 5 years following that date, and on condition that the activity be kept to the quantitative limits of the prior use.

Such grace period has now been recently changed, since Article 22 bis of the Year's End Decree (Decreto Milleproroghe) extends the moratorium on design infringement from the 5 years to 13 years, with the result that the duration of the moratorium will now be until 2014. Basically the deadline is extended for third parties who copy design objects that are protected by copyright, so they can continue to do so unfettered and without infringing anyone's copyright.

This latest move has been strongly criticised by several industry associations (such as the associations of furniture designers and of brand owners) who have filed a complaint against Italy at the European Commission.