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A design for life

Gabriel Cuonzo and Julia Holden of the Italian Law firm Trevisan & Cuonzo explain how the case of the Panton chair changed Italian copyright law.

A recent judgement of the court of Milan in the case *Vitra v. High Tech* casts light on the legal criteria followed by Italian courts in granting copyright protection to industrial designs. The decision also opens the door to ancillary trade dress claims in cases of copyright infringement of industrial designs. Last but not least, the Milanese judges take the view that the current so-called 'grace period' of 13 years (starting from 2001) granted by newly amended Art. 239 of the Italian IP Code to companies that could prove to have manufactured copies before the implementation (in 2001) of Directive 98/71/EC is in breach of the directive based on the principles laid down by the CJEU in the *Flos* case.

Case politics

The *Panton chair* case (*Vitra v. High Tech*) lasted some six years and triggered consecutive legislative amendments to the relevant provision (Art. 239 IP Code) of Italian IP law. Such amendments took place during the proceedings - which were stayed during a referral to the CJEU - and inevitably interfered with the management of the case. From a political dimension the *Panton chair* case (together with the subsequent twin case "*Flos*") can't be compared with any other intellectual property dispute before the Italian courts to date. The case and the underlying



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political battle between the Italian design industry and so called 'independent manufacturers' mirror the fragility and the contradictions of the Italian IP system. At the same time the firm commitment of the relevant economic sectors in favour of copyright protection and the unusual attention of the media constitute encouraging signs of an increased awareness of IP issues that had been neglected for a long time.

In late 2006, Vitra sued High Tech S.r.l. (a well known Milanese retailer of furniture and design goods) for importing and selling in Italy Chinese copies of Vitra's iconic Panton chair designed by Verner Panton. Vitra alleged copyright infringement and unfair competition for passing off. The action was brought before the court of Milan, home court of the defendant. Vitra filed a motion for preliminary injunction which was granted by the court. It was the first time that an Italian court acknowledged copyright protection for a piece of classic design furniture. The decision was widely reported on the Italian press and endorsed by experts and opinion leaders. Shortly after, the same judges of the court of Milan issued a similar injunction in a case commenced by the Italian lighting company Flos against Semeraro S.p.A. concerning the famous lamp Arco designed by Achille Castiglioni. The new trend of the court of Milan triggered a vigorous reaction - both in the media and on a political level - by the "Tuscan consortium", an association of unauthorised manufacturers of classic design furniture based in Tuscany. Their 'social' argument was that classic design should be free in a country like Italy where a number of small and medium-sized firms were essentially sustaining their business by manufacturing copies of iconic products like Vitra's Eames furniture or Cassina's Le Corbusier series. The counter-attack by the 'independent' manufacturers proved successful. In February 2007 the Italian government amended the relevant provision of the IP Code (Art. 239) which in practice prevented copyright owners from enforcing their rights in relation to all designs published before 2001. The reform encountered fierce opposition from leading Italian industrial associations. In light of the impact that the 'new' version of Art. 239 would have on the pending Vitra and Flos cases, the court of Milan made a preliminary referral to the CJEU requesting - in essence - whether Art. 17 of Directive 98/71/EC should be interpreted as to preclude a Member State from passing legislation which excludes (or severely limits with an excessively long grace period) from copyright protection designs published or in public domain before 2001.



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