

SLAVISH IMITATION UNDER ITALIAN LAW AND INFRINGEMENT OF UTILITY MODEL PATENTS: A BRIEF EXAMINATION

When competing on the Italian market, companies should be aware of the legal tools available to protect their rights, even beyond those limited dispositions specifically focused on the protection of trademarks, patents, and other IP rights.

As a matter of fact, Italian law has robust protections available in the area of unfair competition. Indeed, an act of competition can be defined, in certain circumstances, as being “unfair” and punished according to the provisions covered by article 2598 of the Italian Civil Code (“ICC”).

Article 2598 ICC sets forth three different scenarios that can be sanctioned as unfair competition. However, this article will only focus on one specific category of commercial behaviour, i.e., the slavish imitation of a competitor’s product, governed in subsection (1) of Article 2598 ICC.

To correctly understand how and when slavish imitation occurs, it is important to remember that the guiding light, which lawmakers intended to avoid in creating these protections, is the existence of a risk of confusion for consumers. More specifically, the relevant legal provisions seek to avoid confusion of the average consumer, whose attention is generally drawn to the overall appearance of a product. When the shape of a product is imitated by a competitor in such a manner that leaves the average consumer in a situation where they are unable to perceive the different origins of the original product and the imitation, such imitation might be considered as “slavish” and, if so, can be challenged as an act of unfair competition.

However, establishing a case of slavish imitation is not as straightforward as it might appear at first glance because, according to established jurisprudence, slavish imitation exists only when two requirements are fulfilled: the imitated product must have 1) a sufficient degree of originality (novelty), and 2) distinctive character. These two requirements are cumulative.

In this respect, a recent decision of the Italian Supreme Court (order n. 4340 of February 10, 2022) applied these principles, holding that the mere fact that a competitor reproduced the shape of a product that was – or could have been – protected by a utility model (or by a design), is not *per se* sufficient to fulfil the requirements of slavish imitation. Indeed, the Court stressed that to establish slavish imitation, it is in fact necessary to demonstrate that the average consumer’s perception is such that they experience confusion as to the origin of similar products, and that this may happen only when the shape allegedly copied is new and distinctive.

To better understand the Court’s reference to the utility model above mentioned, it is useful to briefly recall that, in Italy, it is possible to protect a new technical form of an industrial product. More specifically, the innovative improvement of the technical performance of an existing product can be protected by a utility model patent. The requirements for validity of a utility model are the same as those for patents: i.e. novelty, originality, industrial application. An inventive step is also required, though the qualitative level differs from that required for patents, in the sense that it is sufficient that

the innovation impacts on even marginal aspects of the product. As to the duration, utility models are valid for ten years from the filing date.

In the case at issue, the company Somm S.r.l. had produced – since 1960 – a special metallic shelter used to protect parked cars from the sun and from hail. Said shelter was characterized by having the shape of seagull wings, which the company indicated was protected by a utility model. Somm S.r.l. claimed that this shape had been slavishly imitated by the company CML S.r.l..

This case escalated to the Supreme Court, following a long procedural history. At first instance, the judges noted that the utility model had been abandoned by the claimant and that, in any case, the utility model invoked did not cover the “seagull wings shape” at issue, but the shape of another shelter, albeit very similar. The First Instance Court however concluded that the shape was nonetheless aesthetically new and distinctive, and found CML S.r.l. liable for unfair competition.

In the second instance proceedings, the Court of Appeal reversed this decision, observing that the evidence submitted was not sufficient to prove that the relevant consumers perceived the seagull wings shape as a product originating from the company Somm S.r.l., nor that it had been the first shelter with such a shape to be commercialized on the market. Accordingly, the Court of Appeal held that the shape invoked was not new or distinctive, and that Somm S.r.l. had not proven a risk of confusion for customers.

Somm S.r.l. appealed the decision before the Supreme Court, which however rejected the appeal and confirmed the Court of Appeal’s reasoning. The Supreme Court also held that when a claim of unfair competition for slavish imitation is raised and formulated as a claim strictly dependant on the infringement of a utility model, then a declaration of invalidity of such model would automatically exclude unfair competition. In other words, the claimant would have had to provide other grounds to show that the shape in question satisfied the requirements for protection, even aside from whether it is covered by a utility model.

To conclude, to successfully protect the shape of a product in an action for unfair competition for slavish imitation, the claimant must demonstrate that the shape is new and distinctive, and that the presence of a competing, imitation product raises a risk of confusion for consumers. While holding a registration for a utility model or design for the shape in question may be helpful in meeting this burden of proof, the IP right holder is advised to broaden their claims, and seek to satisfy these requirements even aside from the existence of the registered right, which meanwhile can form the basis for a claim of infringement. That all considered, starting a legal action against a competitor by invoking unfair competition and infringement of a registered IP right may therefore be a good strategy, providing that the respective requirements for both causes of action are fulfilled.