



# Non-Distinctive Uses of a Trademark: The CJEU’s “Function Theory” (and Its Adoption by Italian Courts) – Future Prospects in Light of EU Trademark Law

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**Abstract** The paper takes its cue from recent amendments to EU trademark law to scrutinize the issue of non-distinctive uses of another’s mark and of the limits on the exclusive right stemming from the need for the free use of signs or for the protection of fundamental rights other than that of the trademark proprietor. The aim of the study, therefore, is to identify the perimeter of the exclusive right conferred by a trademark on its proprietor so as to understand whether the latter can claim protection against any non-authorized use of his or her mark, even if the function of such use is not “typical” for distinguishing goods and services. Doubts as to interpretation arise from the recent approach of the CJEU, which on the one hand introduces interference of third-party use of a trademark with the protected functions thereof as a yardstick for assessing the unlawfulness of such use and, on the other, broadens and multiplies such functions. The latest amendments to EU trademark law seem to indicate a different future path to follow in assessing cases of non-distinctive use, reaffirming that use with a distinctive function is the foundation of the exclusive right conferred on the trademark proprietor and determines the extent thereof.

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## 1 Introduction – Reconstruction of the Issue

The aim of this paper is to analyze, in light of recent amendments to EU trademark law, the legal problems related to non-authorized uses of another's trademark which occur in the course of trade, but for purposes other than that ("typical use") of identifying and distinguishing the goods or services in relation to which the sign is used by the third party (uses with a "non-distinctive function" or "atypical" uses).

More specifically, it needs to be determined whether such uses – non-authorized but occurring for non-distinctive purposes – are to be considered infringing or lawful and, in the latter case, to what extent.

The problem, of particular interest to legal scholars and the subject of multiple – not always uniform – positions of the Court of Justice of European Union (hereinafter "CJEU") in recent years, must now be examined in light of Directive 2015/2436<sup>1</sup> and Regulation 2017/1001<sup>2</sup> (hereinafter, respectively, "Dir. 2015" and "Reg. 2017").

Doubts as to interpretation arise from the emergence of a CJEU approach which on the one hand introduces interference of third-party use of a trademark with the protected functions thereof as a yardstick to assess the unlawfulness of such use and, on the other, broadens and multiplies such functions in a manner not always consistent or clear.

To analyze the reach of the recent changes to EU trademark law, this paper will first briefly reconstruct the development of decisions reached by the CJEU in recent years that interpret the previous EU Directive and Regulation (decisions which the Italian Courts seem, at least in part, to be adopting). These decisions appear to be oriented towards extending protection of a trademark against any non-authorized use liable to damage its legally protected functions and the correlated interests of the proprietor.

The CJEU approach must be considered in relation to the rules in trademark matters which expressly provide that a trademark right is an exclusive right to use a sign *in relation* to certain goods and/or services.<sup>3</sup> The question, therefore, is whether extension of the scope of the exclusive right to include uses of the trademark with a function other than its typical function and, more generally, multiplication of the protected functions by the CJEU are in line with these rules.

<sup>1</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015, 2015 O.J. L 336/1.

<sup>2</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017, 2017 O.J. L 154/1.

<sup>3</sup> Until emission of the new rules, Art. 5 of Directive 2008/95/EC (hereinafter "Dir. 2008"), Art. 9 of EU Trademark Regulation 207/2009/EC ("Reg. 2009"). Now, respectively, Art. 10 Dir. 2015 and Art. 9 Reg. 2017. In Italy, Art. 20 of the Intellectual Property Code – Legislative Decree No. 30/2005 (hereinafter "IPC").

The CJEU has for some time acknowledged the need to protect the power of a trademark to attract and evoke (albeit continuing to attribute a sort of "pre-eminence" to the function of origin<sup>4</sup>). It now links this power not to a single function of the trademark (which legal theorists define as being that of attracting or suggesting or, more generally, communicating), but to a number of protected functions which are seemingly different from each other<sup>5</sup> but difficult to distinguish as regards actual application.<sup>6</sup>

This multiplication of ill-defined and at times overlapping<sup>7</sup> protected functions may, however, be a source of confusion in actual application and, in any case, of complexity, as has been clearly shown by legal theorists.<sup>8</sup>

The amendments to EU trademark law seem, in this context, to indicate a different path to follow in assessing cases of non-distinctive use, it being reaffirmed that use with a distinctive function is the foundation of the exclusive right conferred on the trademark proprietor and determines the extent thereof.

The paper will conclude by arguing that the need for clarity in the principles to be applied means it is advisable to avoid fragmentation of the protected functions and to speak more succinctly of the distinctive function, in relation to any trademark, and of the function of attraction (or maybe, more generally, the function of communicating messages to consumers) in relation to a well-known trademark as an instrument to draw the public. This latter function must be protected as regards both

<sup>4</sup> See, for example, decision of 22 March 2007 of the General Court (EU), *SiglaSA/OHIM* (T-215/03) ECLI:EU:T:2007:93; CJEU decision of 12 November 2002, *Arsenal* (C-206/01) ECL:EU:C:2002:651, para. 51; CJEU decision of 20 September 2017, *The Tea Board/EUIPO* (joined cases C-673/15P to C-676/15P) ECLI:EU:C:2017:702, para. 53.

<sup>5</sup> See CJEU decision of 25 March 2010, *BergSpechte* (C-278/08) ECLI:EU:C:2010:163, paras. 29–41 *et seq.*; CJEU decision of 23 March 2010, *Google France* (joined cases C-236/08 to C-238/08) ECLI:EU:C:2010:159, paras. 75 *et seq.*; CJEU decision of 18 June 2009, *L'Oréal/Bellure* (C-487/07) ECLI:EU:C:2009:378, paras. 58 *et seq.*; CJEU decision of 12 June 2008, *O2* (C-533/06) ECLI:EU:C:2008:339, paras. 57 *et seq.*; CJEU decision of 11 September 2007, *Céline* (C-17/06) ECLI:EU:C:2007:497, paras. 16 and 26–27; CJEU decision of 25 January 2007, *Adam Opel* (C-48/05) ECLI:EU:C:2007:55, paras. 21 *et seq.*; CJEU decision of 16 November 2004, *Anheuser-Busch* (C-245/02) ECLI:EU:C:2004:717, paras. 59 *et seq.*; CJEU decision of 8 July 2010, *Portakabin* (C-558/08) ECLI:EU:C:2010:416, para. 30; CJEU decision of 22 September 2011, *Interflora* (C-323/09) ECLI:EU:C:2011:604, paras. 60 *et seq.*

<sup>6</sup> As shall be seen, of these functions the CJEU has so far given a definition of the advertising function with the *Google France* decision (paras. 91–92) and of the investment function with the *Interflora* decision (para. 60), stating that the former is the capacity of a trademark to "inform and persuade consumers" and to therefore be used "in sales promotion or as an instrument of commercial strategy", while the investment function is linked to use of a trademark "to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty".

<sup>7</sup> The CJEU ruled that the investment function "may overlap with the advertising function" (CJEU – *Interflora* decision, para. 61).

<sup>8</sup> *Inter alia*, Roncaglia and Sironi (2011), p. 170; Vanzetti and Di Cataldo (2018), pp. 148 *et seq.*

preservation of the power of attraction of a trademark with a reputation and its exploitation.<sup>9</sup>

## 2 Protection of a Trademark against Non-Distinctive Uses: The CJEU Position. From the Use of a Sign as a Trademark as an Essential Condition for Infringement to the Theory of the Existence of Detriment to the Functions of an Unduly Used Trademark as an Essential Condition for Infringement

Ever more frequently, use of a trademark by third parties has purposes other than that of distinguishing goods and services: at times a trademark is used for purely descriptive purposes in relation to certain goods or services; at other times – especially in the case of the most well-known trademarks – in order to exploit the power of attraction which a certain sign may possess in the eyes of the public.

Non-distinctive uses of another's trademark can take the most diverse forms, such as:

- (i) a trade or company name;<sup>10</sup>
- (ii) for merely descriptive purposes;<sup>11</sup>
- (iii) a demonstration of support, loyalty or affiliation to a team;<sup>12</sup>
- (iv) an ornament or decoration of a product in order to embellish it and make it more pleasing in the eyes of the public;<sup>13</sup>
- (v) in scale toys (or other goods), in order to offer the consumer a product which is identical to the original;<sup>14</sup>
- (vi) in comparative advertising;<sup>15</sup>
- (vii) for artistic, critical or satirical expression.

With particular regard to the internet and new technologies, the problem has been raised specifically for use of a trademark:

<sup>9</sup> Economic studies show that the market value of trademarks (in terms of selling power) is now most concentrated in the evocative components incorporated in certain signs, since, thanks to their capacity to bring positive images to the minds of consumers, they bestow important added value on the good or service for the public, to the point of leading consumers to prefer the good or service bearing the trademark, often regardless of its objective qualities and characteristics: *see, inter alia*, Drescher (1992), pp. 301–340.

<sup>10</sup> CJEU – *Céline* decision; CJEU – *Anheuser-Busch* decision; CJEU decision of 21 November 2002, *Robelco* (C-23/01) ECLI:EU:C:2002:706.

<sup>11</sup> These are, for example, “referential uses”: *see* CJEU decision of 15 May 2002, *Hölterhoff/Freiesleben* (C-2/00) ECLI:EU:C:2002:287.

<sup>12</sup> CJEU – *Arsenal* decision.

<sup>13</sup> This is a frequent use in the field of fashion goods, articles of clothing and footwear: CJEU decision of 23 October 2003, *Adidas/Fitnessworld* (C-408/01) ECLI:EU:C:2003:582; CJEU decision of 10 April 2008, *Adidas/Marca Mode II* (C-102/07) ECLI:EU:C:2008:217.

<sup>14</sup> *See* CJEU – *Adam Opel* decision.

<sup>15</sup> CJEU – *O2* decision; CJEU – *L'Oréal/Bellure* decision.

- (viii) a keyword of pop-up advertising or of sponsored links;<sup>16</sup>
- (ix) in relation to goods or services advertised and/or offered for sale on online marketplaces, such as eBay, Amazon, Groupon and others;<sup>17</sup>
- (x) on social networking websites, where, more and more frequently, sponsored links or advertising banners appear that are connected to areas in which users have expressed interest online or in their personal information in their social network profile, which contain or call to mind, without authorization, the trademarks of third parties.

It may be said that Dir. 2008 and Reg. 2009 do not extend (at least in literal terms) protection of the distinctive character or repute of a trademark (also) against uses for purposes other than that of distinguishing goods or services.<sup>18</sup>

However, the CJEU does not seem to follow this interpretation in its decisions; rather, it has introduced a different type of reasoning based on the existence of detriment to the functions of an unduly used trademark as a condition for infringement (hereinafter "function theory"). The most recent decisions of the CJEU have been in favor of broader trademark protection, aimed at preserving (in addition to distinctive values) the value acquired by a sign through its use and promotion on the market against any use which may harm this value in terms of damage to the power of attraction and to the image of the trademark. The result is that the proprietor is afforded the full and exclusive right to exploit the trademark in relation to every guaranteed use.

The CJEU introduced this type of reasoning when it was asked to interpret Art. 5(1) Dir. 2008 in order to assess its applicability to non-distinctive uses of the trademark in the well-known *Arsenal Football Club v. Matthew Reed* case.<sup>19</sup>

In deciding the *Arsenal* case, the CJEU looked not at the *methods of use* of a sign by a third party (with or without a distinctive function) but at the *impact of this use* on the protected functions of the reproduced trademark and on the correlated interests of the proprietor. It thus established a new criterion for assessing third-party conduct to be taken into consideration in relation to the various forms of infringement provided by the law.<sup>20</sup>

The CJEU has gone on to apply the function theory in subsequent decisions relating to various cases of non-distinctive uses, such as (in the *Adidas* cases) the non-authorized reproduction of another's trademark as a *decoration* or *ornament* of

<sup>16</sup> With regard to this use, see in particular: CJEU – *Google France* decision; *BergSpechte* decision; CJEU decision of 26 March 2010, *Eis.de* (C-91/09) ECLI:EU:C:2010:174; *Portakabin* decision; CJEU – *Interflora* decision; CJEU decision of 19 April 2012, *Wintersteiger* (C-523/10) ECLI:EU:C:2012:220.

<sup>17</sup> CJEU decision of 12 July 2011, *L'Oréal/eBay* (C-324/09) ECLI:EU:C:2011.

<sup>18</sup> The argument that the provisions of Dir. 2008 and Reg. 2009 cannot be applied to non-distinctive uses of another's trademark is followed in the CJEU decisions in the *BMW* case, see CJEU decision of 23 February 1999, *BMW* (C-63/97) ECLI:EU:C:1999:82, para. 38. See also *Robelco*; *Anheuser-Busch*; *Céline*; *Hölterhoff*.

<sup>19</sup> In the *Arsenal* case, use of the sign *Arsenal* (registered as a trademark by the homonymous football club) in relation to merchandising intended for football fans was accompanied by the specification that the goods were not "official".

<sup>20</sup> The Court had actually already mentioned, in the CJEU – *Hölterhoff* decision, this new criterion of assessment of third-party conduct.

a product to embellish it and make it more pleasing in the eyes of the public.<sup>21</sup> In cases of this kind, the use, albeit non-distinctive or not giving rise to confusion, may still harm the trademark's function of attraction/advertising if it is such as to lead "the relevant section of the public" to establish "a link between the sign and the mark" ("associative link")<sup>22</sup>.

In the assessment of the lawfulness of the use of another's trademark in scale reproductions of goods (in this case toy car models<sup>23</sup>) intended to offer the consumer a product identical to the original, the Court concluded that the scale reproduction of well-known trademarks infringes the rights of the proprietor of the sign whenever such use, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trademark, i.e. whenever it damages those characteristics of the mark.<sup>24</sup>

The function theory was then also reaffirmed in relation to use of another's trademark in comparative advertising<sup>25</sup> and in relation to online uses of another's trademark.

In particular, regarding the keyword advertising service, the CJEU has ruled on a number of occasions that use by an advertiser of keywords which correspond, wholly or in part, to another's earlier trademarks to make hypertext links to the website of the advertiser appear infringes the exclusive right of the proprietor should use of the other's trademark be liable to damage the legally protected functions of the trademark.<sup>26</sup>

The criterion applied by the Court to assess infringement looks, therefore, once again at the potentially negative effect that use of a third-party sign may have on the legally protected functions of a trademark, that of indicating origin<sup>27</sup> and the advertising,<sup>28</sup> investment<sup>29</sup> and communication functions. According to this position, the way in which the sign is used by the third party (as a trademark or

<sup>21</sup> CJEU – *Adidas/Fitnessworld* decision and *Adidas/Marca Mode II* decision: hereinafter jointly defined as the "Adidas decisions". For opinions see Gielen and Verschuur (2008), pp. 254 *et seq.* and opinions on the cited decisions published, respectively, in *Giurisprudenza Annotata di Diritto Industriale* (hereinafter "GADI") 2003, pp. 1458–1471 and GADI 2009, pp. 1357–1376.

<sup>22</sup> The principle was asserted by the CJEU in the *Adidas/Fitnessworld* decision, paras. 39–41. Likewise see the CJEU – *Adidas/Marca Mode II* decision, para. 41.

<sup>23</sup> The CJEU – *Adam Opel* decision concerned use of the logo of the car manufacturer Opel (the so-called "blitz") on scale models of Opel cars made by an independent producer (Autec AG).

<sup>24</sup> CJEU – *Adam Opel* decision, paras 34 and 36–37.

<sup>25</sup> CJEU – *O2* decision; CJEU – *L'Oréal/Bellure* decision.

<sup>26</sup> Keyword advertising cases (especially the CJEU – *Google France* decision) have been the subject of many comments, including Bailey (2013), p. 868; Meale (2012), p. 11. For an overview of the different positions taken by the various national courts on keyword advertising, see, *inter alia*, Colangelo (2012), p. 78; Cornthwaite (2009), pp. 347 *et seq.*; Fabian (2008), pp. 148–149; Shemtov (2008), p. 470; Tosi (2009).

<sup>27</sup> CJEU – *Google France* decision, para. 87.

<sup>28</sup> The advertising function is defined by the CJEU as the capacity of a trademark to "inform and persuade consumers" and to therefore be used "in sales promotion or as an instrument of commercial strategy": CJEU – *Google France* decision, paras. 91–92.

<sup>29</sup> CJEU – *Google France* decision, paras. 91–98; CJEU – *Portakabin* decision, paras. 32–33; CJEU – *Interflora* decision, paras. 54–59.

not) is irrelevant for the purposes of ascertaining infringement. What is relevant is the effect of use of a third-party sign on the other's trademark with regard to the functions performed thereby and the interests of its proprietor.

### 3 Effects of Applying CJEU Principles on the Scope of Trademark Protection

The effects of the application of the function theory on the cases of trademark protection regulated by Art. 5 Dir. 2008, Art. 9 Reg. 2009 and Art. 20 IPC need to be specifically examined, also because the introduced EU amendments have not modified the wording of these cases.

The principle whereby there may also be infringement in the absence of use of a sign as a trademark should such use cause detriment to one of the functions fulfilled by the earlier trademark is important in relation to the two cases of protection which prescind from likelihood of confusion,<sup>30</sup> i.e.:

- (i) use of a sign which is identical to another's trademark for goods and/or services which are identical to those for which the trademark is registered under Art. 5(1)(a) Dir. 2008, Art. 9(2)(a) Reg. 2009 and Art. 20(1)(a) IPC; and
- (ii) protection of a trademark with a reputation beyond a likelihood of confusion under Art. 5(2) Dir. 2008, Art. 9(2)(c) Reg. 2009 and Art. 20(1)(c) IPC.

As to the former, the CJEU decision to apply the function theory<sup>31</sup> has been strongly criticized by EU legal theorists on the grounds that it runs counter to:

- (i) the literal meaning of the rules in matters of double identity, whose singular nature consists in giving protection to the trademark proprietor due to the fact per se of double identity between the signs in conflict and the goods or services to which those signs refer, and therefore regardless of there being any other condition;
- (ii) Recital 11 of Dir. 2008 (now 16 of Dir. 2015), whereby "the protection afforded by the registered trademark, the function of which is in particular to guarantee the trademark as an indication of origin should be absolute in the event of there being identity between the mark and the corresponding sign and the goods or services";
- (iii) Article 16(1) of the TRIPS Agreement, whereby detriment to distinctive function is the limit for affording protection to a registered trademark (unless it has a reputation) against its use by non-authorized third parties and that, in

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<sup>30</sup> As concerns trademark protection based on likelihood of confusion as to origin (i.e. Art. 5(1)(b) Dir. 2008, Art. 9(2)(b) Reg. 2009 and Art. 20(1)(b) IPC), for there to be infringement the third-party sign must be used with a distinctive function, since otherwise there would be no likelihood of confusion as to origin. Consequently, there is no infringement whenever the public perceives a third-party sign only as a decoration or ornament of the product or as having another non-distinctive function.

<sup>31</sup> Of the double identity cases in which the function theory has been applied, see: CJEU – *Celine* decision, para. 16; CJEU – *Adam Opel* decision, para. 21; CJEU – *Google France* decision, para. 79.

cases of use of an identical sign for identical goods or services, a likelihood of confusion is presumed (save for proof to the contrary).<sup>32</sup>

The effect of the CJEU approach, therefore, is the establishment of a threshold of access to protection which is not provided by double identity rules. However, as shall be seen, the new EU rules also insist on absolute protection regardless of the occurrence of conditions other than those of double identity.

According to an approach also followed by some legal theorists, the function theory may, however, be justified in cases of protection of a trademark with a reputation beyond likelihood of confusion, by reason of the fact that these rules aim to safeguard certain trademarks against parasitism and undue exploitation of their values.<sup>33</sup>

Although we are favorable to the function theory in relation to protection of a trademark with reputation beyond likelihood of confusion, we cannot agree with the decision of the Court to “fragment” the functions of attraction or of communication of the trademark into distinct “other functions”. These functions cannot be easily defined, and despite the attempt of the Court to separate them, there are still inevitable areas of overlap.

Considering Art. 5(5) Dir. 2008 and the rationale behind such provision, it may be asked whether the path to follow in sanctioning the use of another’s well-known trademark for *non*-distinctive purposes, which may give rise to an unfair advantage for the third party and/or detriment to the unduly used trademark, could be that of unfair competition law.<sup>34</sup>

The perplexity that the CJEU approach has given rise to – as shown by the copious legal theory (both within the EU and in the USA) – derives from the consideration that trademark protection extended also to non-distinctive uses goes beyond the rationale of the rules regulating the exclusive right on a registered trademark. The consequent risk is alteration of the nature of the trademark and the logic which should underpin its grant.<sup>35</sup>

If it is true on the one hand that the need to protect a trademark’s powers of attraction can no longer be denied, and likewise that trademarks which achieve a high level of distinctive capacity and repute deserve protection against dissimilar

<sup>32</sup> See the criticisms leveled against the Court’s position by Gielen and Verschuur (2008), p. 254.

<sup>33</sup> See Cornish et al. (2013), p. 762.

<sup>34</sup> See Vanzetti (2006), pp. 13–14. According to the author it is unnecessary to “force trademark rules beyond the limits. There is no need, given that protection against unfair competition is no less effective than the protection provided for a registered trademark”. This solution, however, was not adopted by the Italian legislator, which, with Legislative Decree No. 15/2019 (which implemented Dir. 2015), extended protection of well-known trademarks (Art. 20 IPC) to non-distinctive uses (on this point *see infra*).

<sup>35</sup> In relation to the EU, in the sense that distinctive use should be a further condition for infringement, *see, inter alia*: Senftleben (2013), pp. 156 *et seq.*; Bently et al. (2018), pp. 912 *et seq.*; Cornish et al. (2013), p. 760; Spuhler (2000), p. 200; Tsoutsanis (2006), p. 74; Yap (2009), pp. 81 *et seq.*; Max Planck Institute (2011), p. 98. The following, however, are in favor of protection of a trademark *also* against non-distinctive uses: Adams (2003), pp. 229 *et seq.*, especially pp. 231–232, whereby in order to protect a trademark under Dir. 2008 “TM use is not required”; Hidaka et al. 2004, pp. 1105–1153, especially pp. 1143 *et seq.*; Knaak (2008), p. 92; Kur (2008a, b), pp. 1 *et seq.*; Phillipps (2003), pp. 204 *et seq.*; Simon (2006), pp. 321 *et seq.*



goods or services beyond any likelihood of confusion as to origin, it is equally true that giving a trademark "absolute" protection, extended to any case of exploitation of its power of attraction, essentially corresponds to (indefinitely) protecting with an exclusive right commercial "goodwill", which expresses a mere capacity of communication. However, the IP system accords this type of protection only to accomplished creative, technological or aesthetic works:<sup>36</sup> patents and copyrights protect the result of creative effort which, by increasing technical/scientific or aesthetic/artistic assets, justifies greater protection (with a time limit), giving the proprietor the right to total and unconditional exploitation of his or her work.

The question therefore is whether, in principle, protection of trademark rights is justifiable only if it comes within the limits in which the right itself can exist, and thus when both the proprietor and the third party use the sign for the purpose (among possible others) of identifying the commercial source of their goods or services (also considering the principles now expressed by Reg. 2017 and Dir. 2015<sup>37</sup>).

Another question is whether "absolute" trademark protection risks clashing with the principles of protecting free and fair competition and the good functioning of markets. Indeed, it could result in new barriers to entry, also with regard to market sectors which are completely different and markedly distant from those claimed by the trademark application, in which the proprietor would be assured a "privileged" position not necessarily justified by objective reasons or reasons based on competitive merit.<sup>38</sup>

Lastly, the idea whereby use of a third-party sign (identical or similar to another's trademark) with the function of trademark is irrelevant for the purposes of infringement seems to clash with the letter of the law. On the one hand, Arts. 5(1) and 5(2) Dir. 2008, Art. 9 Reg. 2009 and Art. 20 IPC impose a "relationship" between the sign and the goods/services of the third party (the CJEU gives a very broad scope to this "relationship" which is not limited to third-party goods or services). On the other hand, Art. 5(5) Dir. 2008 leaves Member States free to regulate at the national level "protection against the use of a sign for purposes other than for the purposes of distinguishing goods or services", thus expressly excluding this type of use from the scope of application of EU trademark rules.

#### 4 Adoption of CJEU Principles by the Italian Courts

While the traditional position in Italy has been that only use of a sign with a distinctive function, as an indicator of origin, may give rise to infringement,<sup>39</sup> the

<sup>36</sup> Senftleben 2013, p. 143.

<sup>37</sup> We refer, in particular, to Recital 18 and Recital 27 of Dir. 2015 and Recital 21 of Reg. 2017.

<sup>38</sup> Simon (2006), pp. 321–328; Graziadei and Saltarelli (2010), pp. 300–301; Dogan and Lemley (2007a, b), pp. 1227–1228; Dogan and Lemley (2007a, b), pp. 1672–1673; Glynn Lunney (1999), pp. 367, 370 and 421, who observes that absolute protection of trademark rights may encourage monopolistic behavior.

<sup>39</sup> See in particular Vanzetti (2006), pp. 13–14; Graziadei and Saltarelli (2010), pp. 288 *et seq.* Likewise see Ricolfi (2006), p. 19.

prevailing approach today shows greater openness to the different position of the CJEU.<sup>40</sup>

Italian decisions in matters of ornamental or decorative use are in line with the positions described above. In no case has use of another's trademark or of a sign which is similar thereto for decorative or ornamental purposes been considered per se a "justification": in some cases because the third-party sign was also used with, or in any case perceived by the public as having, a distinctive function, with the consequent likelihood of confusion and/or association relevant for the purposes of applicability of Art. 20.1.b IPC or Art. 20.1.a IPC (in relation to which this likelihood must be presumed);<sup>41</sup> in other cases because, albeit in the absence of likelihood of confusion and/or association, the degree of similarity between the third-party sign and the other's trademark on the one hand and the repute of the latter on the other led the public to establish a "link" (albeit not giving rise to confusion) between the signs, with consequent applicability of protection as per Art. 20(1)(c) IPC, in the event of the third party taking unfair advantage, by means of the link, of the power of attraction (or the distinctive capacity) of the earlier, well-known trademark or causing detriment thereto.<sup>42</sup>

There is, however, greater uncertainty in the positions in relation to other cases of non-distinctive use of a trademark. As to use of another's trademark on scale model cars there are only a few decisions – moreover, prior to the cited CJEU decisions on atypical uses – and all of them have held this type of use to be in principle lawful.<sup>43</sup> As to use of another's trademark in comparative advertising, it is much discussed at the national level whether such use – to identify the goods or services (not of the third party but) of the trademark proprietor, with which a comparison is made – can even be considered use as a trademark.<sup>44</sup>

What is significant is the affirmation in some decisions (in line with the CJEU positions) of the need, in assessing infringement, to consider whether the

<sup>40</sup> In favor of the protection of a trademark also against non-distinctive uses, *see*: Galli and Gambino (2011), p. 329; Galli (2007), pp. 88–90; Ricolfi (2015), pp. 1163–1187 (especially p. 1179); Roncaglia and Sironi (2011), pp. 154–162; Sironi (2013), pp. 63 and 327–328. On trends in non-distinctive uses of a trademark *see also* Scotti (2016).

<sup>41</sup> *See, inter alia*, District Court of Milan, 22 June 2004, published in *GADI* 2004, pp. 1173 *et seq.*; District Court of Firenze, 27 November 2007, published in *GADI* 2008, pp. 609 *et seq.*; District Court of Bologna, 14 June 1994, published in *GADI* 1994, pp. 782 *et seq.*

<sup>42</sup> In relation to the use in question there are, in particular, three decisions: District Court of Rome, 9 January 2004 (Order), in *GADI*, pp. 730–734; Court of First Instance of Venezia, 23 January 2006, published in *AIDA* 2007, pp. 1148 *et seq.*, with opinion by Sironi, *Considerazioni in tema di marchi olimpici e segni distintivi dello sport*; District Court of Milan, 30 June 2008 (Order), in *Il diritto industriale* 2008, pp. 437 *et seq.*, with opinion by Guerrieri.

<sup>43</sup> *See* District Court of Milan, 26 October 1972, published in *Rivista di diritto industriale* 1973, pp. 429 *et seq.*; District Court of Milan, 27 November 1972, published in *GADI* 1972, pp. 1552 *et seq.*; more recently, District Court of Modena, 12 October–5 November 2010, available on the online database Darts-IP.

<sup>44</sup> *See* District Court of Milan, 1 February 1999, published in *GADI* 2000, pp. 209 *et seq.*; District Court of Milan, 2 December 1993, published in *Rivista di diritto industriale* 1994 (II), pp. 286 *et seq.*; District Court of Milan, 28 January 1974, published in *GADI* 1974, pp. 344 *et seq.*; District Court of Bologna, 12 February 2008 (Order), published in *GADI* 2009, pp. 352 *et seq.*; District Court of Turin, 22 October 2014, published in *GADI*, 2016, pp. 1151 *et seq.*

communication, investment or advertising functions of another's trademark are harmed. However, the occurrence of such harm is not actually ascertained by national courts, possibly confirming the difficulty in actual cases of identifying each of the trademark functions indicated by the CJEU and ascertaining infringement thereof.<sup>45</sup>

A number of decisions of the Court of First Instance of Milan in matters of use of another's trademark as a sponsored link keyword within the context of internet positioning services offered by search engines such as Google<sup>46</sup> and a number of decisions in relation to parodistic uses<sup>47</sup> and critical uses<sup>48</sup> of another's trademark in the course of trade also accept the CJEU principles.

To sum up, there is a general openness on the part of the Italian courts to the CJEU approach and, therefore, to broader trademark protection in all cases in which there may be detriment to the legally protected functions of a trademark. Specifically in relation to identification of these functions, prevailing Italian case law also seems to be still linked to the traditional approach, referring more generally to distinctive values in relation to any trademark, and to powers of attraction (or of communicating messages to consumers) in relation to the well-known trademark as an instrument to attract the public.

## 5 Reform of the EU Directive and Regulation: Effect on the Scope of Trademark Protection. Final Remarks

The EU Trademark Law reform seems to be oriented towards limiting the scope of the exclusive right by way of guaranteeing the interests of third parties and of society in general which merit protection.

We refer, in particular, to Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trademarks and Regulation (EU) 2017/1001 on the European Union Trademark, which constitute the "Reform Package", one of whose aims is to modernize and improve "the existing provisions of the Directive, by amending outdated provisions, increasing legal certainty of the right and clarifying trademark rights in terms of their scope and limitations".

For the purposes of this paper, the reform is of great interest since the EU legislator does not appear to fully concur with the position adopted by the CJEU with the function theory, but seems to pay greater attention to the needs of third

<sup>45</sup> District Court of Bologna, 8 May 2012, available on the online database Darts-IP (*see* pp. 17 *et seq.*, especially p. 19). *See also* District Court of Bologna, 12 February 2008 (Order), published in *GADI* 2009, pp. 352 *et seq.*

<sup>46</sup> *E.g.* District Court of Milan, 22 April 2016, published in *Il Foro Italiano*, 2016, pp. 2944 *et seq.*; District Court of Milan, 6 May 2013, published in *GADI*, 2016, pp. 339 *et seq.*; District Court of Milan, 23 April 2013, available on the online database Darts-IP; District Court of Milan, 20 November 2012, *ibid.*; District Court of Milan, 30 June 2010, *ibid.*; District Court of Milan, 22 October 2010, *ibid.*; District Court of Milan, 7–16 October 2010, *ibid.*; District Court of Milan, 11 March 2009, published in *Giurisprudenza Italiana*, 2009, pp. 129 *et seq.*

<sup>47</sup> *E.g.* District Court of Rome, 23 May 2008, in *Il Foro Italiano* 2008 (I), pp. 3484 *et seq.*

<sup>48</sup> *E.g.* District Court of Milan, 8 July 2013 (Order), in *Il diritto industriale* 2014, pp. 150 *et seq.*

parties in the use of signs for purposes other than that of distinguishing goods and services.

It clarifies, in particular, the absolute nature of the double identity provisions,<sup>49</sup> the peculiar nature of which consists in the trademark proprietor being afforded protection due to the fact per se of double identity between the signs and the goods/services at issue, regardless of the occurrence of other conditions, above all the effects of use of a third-party sign in terms of detriment to the functions of the trademark: “The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the event of there being identity between the mark and the corresponding sign and the goods or services”.<sup>50</sup>

The Commission proposals, which preceded the final versions of the Directive and Regulation,<sup>51</sup> tried to limit ascertainment of detriment to the essential function (i.e. the function of origin), adding the following words to Art. 5(1)(a) Directive and Art. 9(2)(a) Regulation (Art. 10(2)(a) Proposal Dir. and Art. 9(2)(a) Proposal Reg.): “where such use affects or is liable to affect the function of the trademark to guarantee to consumers the origin of the goods or services”.<sup>52</sup> It also stated, in the Recitals of the Directive and of the Regulation, that “in order to ensure legal certainty and clarity, it is necessary to clarify that not only in the case of similarity but also in case of an identical sign being used for identical goods or services, protection should be granted to a trademark only if and to the extent that the main function of the trademark, which is to guarantee the commercial origin of the goods or services, is adversely affected”.<sup>53</sup>

It was the European Parliament which fully freed these provisions from conditions other than mere identity between signs and goods/services. In its positions it eliminated from the provisions of the Directive and Regulation (as revised by the Commission) all reference to detriment to the function of origin (or

<sup>49</sup> The Proposal Dir. and Proposal Reg. (as both defined below in footnote 51) stated that “the recognition of additional trademark functions under Art. 5(1)(a) of the Directive [and Art. 9(2)(a) Reg. 2009, writer’s note] has created legal uncertainty. In particular, the relationship between double identity cases and the extended protection afforded by Art. 5(2) [Dir. 2008 and Art. 9(2)(c) Reg. 2009, writer’s note] to trademarks having a reputation has become unclear” (see Proposal Dir., 6 and Proposal Reg., 8).

<sup>50</sup> Dir. 2015, Recital 16; Reg. 2017, Recital 11.

<sup>51</sup> Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trademarks, COM (2013) 162 final, Brussels, 27 March 2013 (“Proposal Dir.”) and the Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) 207/2009 on the Community trademark, COM (2013) 161 final, Brussels, 27 March 2013 (“Proposal Reg.”).

<sup>52</sup> The text of Art. 10(2)(a) Proposal Dir. and Art. 9(2)(a) Proposal Reg. in the Commission version, was therefore as follows: “2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, the proprietor of a registered trademark shall be entitled to prevent all third parties not having his or her consent from using in the course of trade any sign in relation to goods or services where: (a) the sign is identical with the trademark and is used in relation to goods or services which are identical with those for which the trademark is registered, where such use affects or is liable to affect the function of the trademark to guarantee to consumers the origin of the goods or services (...)”.

<sup>53</sup> Recital 19 Proposal Dir. and Recital 15 Proposal Reg.

any other function) and removed Recital 19 of the Proposal Directive and Recital 15 of the Proposal Regulation from the Reform Package.<sup>54</sup>

In line with the position taken on cases of double identity is the absence of any revision of the Directive and Regulation provision which protects a trademark against the other two forms of infringement, i.e. third-party uses which may give rise to a likelihood of confusion among the public and uses aimed at taking unfair advantage of, or causing detriment to, a trademark with a reputation.<sup>55</sup> It is a decision which, if interpreted in light of the process of modifying the double identity provisions, cannot but confirm the decision not to afford express and autonomous protection to the other trademark functions indicated by the CJEU.

It therefore seems preferable to continue to refer to the concepts of distinctive function (in terms of likelihood of confusion) and attraction function or, more generally, to the values of the trademark as an instrument of communication between the proprietor and consumers. There is no mention in the new rules of further fragmentation of the legally protected functions.

As concerns the related problem of extension of the proprietor's rights to include uses of the trademark for purposes other than that of distinguishing goods and services, the new EU rules contain several suggestions as to interpretation. There remains, however, a certain degree of uncertainty with regard to how the new rules may be applied by the courts.

On the one hand it is stated that assessment of infringement needs to be linked to use of a sign with a distinctive function: "it is appropriate to provide that an infringement of a trademark can only be established if there is a finding that the infringing mark or sign is used in the course of trade for the purposes of *distinguishing goods or services*. Use of the sign for purposes other than for distinguishing goods or services should be subject to the provisions of national law".<sup>56</sup>

Under Art. 10(6) Dir. 2015 protection against non-distinctive uses of a trademark remains optional for Member States: "Paragraphs 1, 2, 3 and 5 shall not affect provisions in any Member State relating to the protection against the use of a sign other than use for the purposes of distinguishing goods or services, where use of that

<sup>54</sup> European Parliament Report on the Proposal Dir., 16 January 2014, A7-0032/2014 and European Parliament Report on the Proposal Reg., 12 February 2014, A7-0031/2014. In this regard, some comments on the Reform Package (in the version as revised by the Parliament) were positive: "INTA strongly supports these amendments which delete the request to provide trademark protection against identical marks for identical goods and services only when the origin function of the trademark has been affected. The reference to the origin function would result in a step backward regarding the fight against counterfeiting and could cause uncertainty in a number of situations" (INTA, Trademark Reform: INTA Recommendations, February 2014, which may be found online at [http://www.inta.org/PDF%20Library/2014-01\\_INTA%20views%20on%20the%20JURI%20report-%20FINAL\\_2014-03-28\\_updated-letterhead.pdf](http://www.inta.org/PDF%20Library/2014-01_INTA%20views%20on%20the%20JURI%20report-%20FINAL_2014-03-28_updated-letterhead.pdf)).

<sup>55</sup> Without prejudice to the additional cases of infringing uses under Art. 9(3) Reg. 2017 and Art. 10(6) Dir. 2015, i.e. uses of another's trademark "on business papers and in advertising"; in "comparative advertising in a manner that is contrary to Directive 2006/114/EC"; and "as a trade or company name or part of a trade or company name", the latter with the limit that use be made with a distinctive function and therefore "for the purposes of distinguishing the goods or services" of the enterprise bearing said trade or company name (Recital 13 Reg. 2017 and Recital 19 Dir. 2015).

<sup>56</sup> Recital 18, Dir. 2015.

sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark”.<sup>57</sup>

The above, therefore, seems to rule out the present extension of protection to non-distinctive uses of another’s trademark, which the CJEU has legitimized with the function theory.

On the other hand, however, the fact that the new EU rules extend the provisions on lawful uses to uses of “signs or indications which are not distinctive” gives rise to some doubt.<sup>58</sup>

This could mean, in other words, that non-distinctive uses are not per se lawful (otherwise there would be no need to amend the provisions in question), but only “justified”, provided they comply with honest practices.

Once this provision has also been considered, it is ultimately unclear whether the new EU rules are to be interpreted in such a way as to mean that a trademark is protected regardless of the methods of use (with or without a distinctive function) of the third-party sign or whether these methods must play a decisive role for the purposes of exercising an exclusive right.<sup>59</sup>

In any case, what seems to emerge from the new EU trademark law (from its objectives and from the above amendments) is the intention to circumscribe the exclusive right conferred by a trademark on its proprietor, preventing this right from being relied upon in cases of uses (such as *non*-distinctive uses) which involve needs deserving of protection (e.g. the need for the free use of signs or for the protection of other fundamental rights).

Therefore, although the means by which this intention has been achieved may not be considered appropriate (i.e. instead of precluding *ab origine* the exercise of the exclusive right against non-distinctive uses, it has been decided to justify such uses under the provisions on lawful uses, the proprietor again being required to demonstrate, on each occasion, that the individual actual use does not deserve protection), it is still significant that the EU legislator has taken a path which considers the possible interests of third parties (and of society in general), limiting the risk that exercising an exclusive right may hamper the enjoyment of fundamental rights and/or be an obstacle to the good functioning of the market. It is therefore a system in which trademark protection is based on striking a balance

<sup>57</sup> The provision has recently been transposed into Italian law with Legislative Decree No. 15/2019, which – in implementing Dir. 2015 – extended the protection of (only) well-known trademarks (Art. 20(1)(c) IPC) to non-authorized third-party use of a trademark for purposes other than that of distinguishing goods/services, where such use occurs without due cause and allows unfair advantage to be drawn from the distinctive character or repute of the trademark or causes detriment thereto.

<sup>58</sup> Article 14.1 Dir. 2015: “1. A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade: (a) (...); (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services; (...)”. Likewise, Art. 14 Reg. 2017. The provision has recently been transposed into Italian law with Legislative Decree No. 15/2019 (*see* Art. 21(1)(b) IPC).

<sup>59</sup> The fact that, following the reform, Art. 10 Dir. 2015 and Art. 9 Reg. 2017 refer to the third-party sign at times using the word “sign” (as in Art. 5 Dir. 2008 and Art. 9 Reg. 2009), and at times “trademark”, may also be the source of further doubts as to interpretation. From this perspective, too, it would therefore be good to have clarification.

between the various interests involved. What is new is that the direction now taken seems to be aimed at giving more space to possible third-party interests deserving of protection.

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