

Preface of "The Proper Function of the Trademark", edited by da A.Giuffrè Editore

Jurisprudential theory concerning a trademark's function takes an explicit or implied view that distinctiveness comprises identification linked to differentiation (substantive distinction), or it does not. On the other hand it is well understood that trademarks have always distinguished a product that is itself changeable and therefore self-evidently non-identifiable.

Thus a trademark's function amounted to identifying the manufacturer or maker, a notion that became ever more problematical as the artisan evolved, little by little, into company, holding company, group, or indeed anyone – subjects who are evermore, and ultimately totally, removed from the manufacture, and only responsible for applying the trademark. As a result under the old law it became less and less, and ultimately (in my view) totally unwarrantable to claim that a trademark identifies products since they are comprised of articles of such disparate and changeable content; and the same observation holds good as regards indirect connection through a source (a firm, a branch of the firm, a formula etc) or an agent (project managers, researchers) all of whom are indeterminable. Despite the fact that the only alternative was to admit that trademarks no longer performed the function of distinguishing, theory has remained unchanged.

According to the thesis I outlined in "The Function of the Trademark" 1988 distinctiveness is not necessarily substantive but may be just simple indication (pointing to an item) and diversification (individualisation), what I call 'formal distinctiveness'. To illustrate, Juventus is always the same football team, quite distinct from other football teams, even though its players (components) are not identifiable once and for all. They change all the time either because they are substituted or because they may play in a different position. In any case it may be necessary to change the style of play over time. Results will fluctuate during the course of a single match. For none of these reasons, however, does a fan fail to recognise Juventus, think that it has become a nameless team or has turned into Milan Football club. Nor will he feel he has been tricked if the centre forward who always scores does not score on the occasion the fan attends a match.

In the same way a trademark distinguishes each product unit it is attached to without giving each a once-and-for-all individual identity, not only because the item may be substituted by a similar but also because an article can change (be adapted) over time or even contemporaneously.

The formal distinction performed by the trademark allows common attributes to be assigned to these production units, which when recalled, selected and put together create the picture of the ideal "product" by way of a mental construct; no less real for the fact that the items have been identified and differentiated by the trademark. More precisely it allows anyone to carry out this operation as, when and how he thinks best so that in reality trademarks substantially distinguish not just a single "product", as one says for convenience, but innumerable "products" each more or less different from another, and from itself over time, making co-existence possible.

Thus a trademark formally distinguishes units of production to which it is attached and substantively distinguishes the historical "product" in the innumerable versions ideally elaborated from it. This allows the holder to change the product in any manner possible, without surrender of its historical – long or short, positive or negative as that may be – inheritance; its "goodwill" we can say. Each consumer can choose his own "product" according to his own criteria, even be they far from anyone else's, including those of the trademark holder.

This thesis has not been challenged. Nor in truth has it even been considered in any way either in theory or jurisprudence, which in the research and the cases on trademark function have continued to hold to the view of distinction as traditionally understood. And this despite the reforms of 1992 and 1996, and in particular the role of the "well-known trademark", which were not without effect. In fact one school claims that the new trademark – some say generally, others only the "well-known trademark" – has the role of appeal (attraction) independent of a distinguishing function. Whilst another school (less authoritative it must be said) continued to claim that trademarks had the function of indicating an item's provenance.

The reform of 1999 – which established the lawfulness of the contemporaneous existence on the market of different versions of the same article, coming from diverse sources but, if so authorised by the holder, with the same trademark attached, – made such a view untenable. Today the almost universal theory is that trademarks have the role of attraction; this is recognised as a monopoly "which reminds one of copyright more than a distinctive sign". This is like saying that the trademark is no longer even a distinctive sign but is instead a new undefined entity.

In effect distinctiveness as traditionally or for all I know generally understood is regarded in this way. Only if one maintains that a trademark formally distinguishes material units of production, indicated but not identified, and at the same time distinguishes substantively the ideal "product" identified in each case, can it still be considered a distinctive sign.

That is what I past and continue to sustain; further this view is useful and avoids deception, as I have striven to demonstrate.

So I have initiated a new examination with the intention of taking up the theme of my earlier work in a more global yet simple fashion to underline how it is the only one compatible with successive national and European reforms of the nineties.

Thus the first three chapters- concerning the concept and ascertainment of the proper function of the trademark; the concept of distinctiveness; as well as a description how the juridical regime moved towards proper function - constitute an explanatory resume of "The Function of the Trademark" largely pruned of citation. Certain parts of that work also come into later chapters but without reference. It is the case that even a simple fresh exposition of the same theme brings new detail and clarification, and with these the raising of new doubts and further reflection for the intellectual process never stops. It can go down a new road without limits or find itself up a blind alley returning along its own steps; it is unstoppable. And that is just what happened in this work. So what was just intended as a review became a development of the discussion begun in 1988 on the distinctive function the sole "proper function of the trademark".