

Trademark Functions and Trademark Rights

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Over the last years, the Court of Justice of the European Union (CJEU) has remarkably expanded the potential scope of trademark rights. Under the EU Trademark Directive, a trademark owner may only prevent third-party uses of the mark if such uses are made (i) in the course of trade, (ii) in relation to goods or services, and (iii) for the purpose of distinguishing the goods or services, that is, as a trade mark. The latter requirement had been traditionally understood by the CJEU as referring to the function to guarantee to consumers the identity of the origin of the goods or services (function of origin). Nonetheless, the CJEU case law has evolved to accept a very broad view of the use as a mark requirement so as to include referential, comparative and decorative uses when such uses may somehow affect the origin function. In yet a further step, the CJEU has come to understand that a use as a mark exists not only where the mark is used in connection to the function of origin, but also when it is used in relation to any other trademark function. Thus, in some cases, a trademark owner is entitled to prevent a third-party use even where such use is not capable of affecting the origin function, if it is liable to affect others functions of the mark, such as those of quality, communication, investment or advertising. This working paper provides an analysis of this evolution in the CJEU case law - particularly in the light of the current process of legislative reform. In a further version of the paper I will enrich the analysis by comparing that European trend with US case law examples of broadening the scope of trademark rights.

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