

Trade Mark Functions

1. Origin function

"... guarantee the identity of the origin of the marked product or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin." (ECJ GRUR 2003, 55 para. 48 - *Arsenal FC*)

2. Other functions

The trademark owner may assert his exclusive right under Sec. 14 (2) No. 1 MarkenG, Art. 5 I a MRRL a.F. = Art. 10 II a MRL, Art. 9 II a UMV, if one of the functions of the trademark is impaired, be it its main function, the origin function, or one of its other functions, such as the guarantee of quality or those of communication, investment or advertising (ECJ GRUR 2014, 280 para. 30 - *De Vries/Red Bull*; GRUR 2013, 1140 para. 58 - *Martin Y Paz/Gauquie*; GRUR 2012, 519 para. 71 - *Budvar/Anheuser-Busch*; GRUR 2011, 1124 para. 38 - *Interflora*; GRUR 2010, 841 para. 30 - *Portakabin/Primakabin*; GRUR 2010, 641 para. 20 - *Bananabay*; GRUR 2010, 451 para. 29, 31 - *BergSpechte*; GRUR 2010, 445 para. 76 et seq. - *Google and Google France*; GRUR 2009, 756 para. 58 - *L'Oréal/Bellure*).

Quality function:

"guarantee ... of qualitative consistency (or homogeneity)" (Opinion of Advocate General Mengozzi v. 10.02.2009 in *L'Oréal*, para. 53).

Communication function:

"property of conveying information...e.g., messages about intangible characteristics that shape the image of the product or the company..." (Opinion of Advocate General Mengozzi dated Feb. 10, 2009 in *L'Oréal*, para. 54).

Investment function:

Use of a trademark to acquire or preserve a reputation (ECJ GRUR 2011, 1124 para. 61 - *Interflora*).

Advertising function:

Possibility of using the mark as a factor in sales promotion or as an instrument of commercial strategy (ECJ GRUR 2010, 445 para. 92 - *Google France and Google*).

3. Literature criticism

The ECJ's function doctrine is limited to the area of identity and serves as a limitation there, since the Court - unnecessarily broadly - also sees the case of so-called referential use (e.g. keyword advertising or comparative advertising) covered there. This is an erroneous development, because

- lack of sufficient differentiation between economic functions and normative protection.
- legitimate cases of referential use (e.g., product criticism and trade mark parody) are covered without any necessary barriers being imposed
- legal uncertainty due to unclear boundaries

(Cf. *Ohly*, FS Loschelder, 2010, p. 265 et seq.; *Sosnitza*, Deutsches und europäisches Markenrecht, 3rd ed. 2023, Sec. 3, para. 4 et seq.; *Sosnitza*, GRUR 2014, 93, 94 et seq.).

4. Reform 2015

In its draft reform of the Directive, the EU Commission originally opposed the extension of the ECJ's function doctrine and wanted to limit protection in the area of identity to infringements of the function of origin. However, this could not be enforced, cf. Art. 10 II lit. a MRL.