

## The Protection of Famous Trade Marks and its Impact on the Freedom of Speech

Protection of trade marks is generally given against unauthorised use that might harm the ability of the trade mark to perform its functions. Whilst modern trade marks have a number of roles, historically the primary function of a trade mark was to indicate the source of the products. Inevitably, the quality of many products could not always be determined accurately before consumption. As a result, manufacturers have, especially since the industrial revolution, started affixing their names or trade marks to their products to indicate the source and quality of the products. This meant that trade marks became indicators of trade origin and quality.<sup>1</sup>

As society has developed, so has our insatiable appetite for choice, such that now a potentially infinite range of needs exist requiring satisfaction. Traders have come to appreciate the importance of symbols and trade marks in satisfying the ‘needs’ of consumers, whether these needs are real or artificial. Accordingly, traders started using trade marks not only to *indicate* origin and quality but to *induce* and *stimulate* consumers’ purchasing decisions and choices. Schechter identified the three crucial functions of trade marks as: (i) differentiating the products from those sold by others; (ii) a product guarantee and (iii) an ‘advertiser’ for the products and the manufacturer.<sup>2</sup> Similarly, Cornish stated that there are three functions: the origin, quality and investment functions.<sup>3</sup> While it is accepted nowadays that trade marks have a number of functions, there is no formal definition of these functions and theorists divide them according to their own protectionist or free trade inclinations.<sup>4</sup>

Therefore, the issues to be determined in this paper are what functions trade marks, and in particular famous trade marks, are actually used to perform and whether legal rights should extend to protect each function even if this protection might harm other fundamental rights such as the freedom of speech. The main question of this paper is

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<sup>1</sup> Peter Groves & Tony Martino, ‘Trade Marks-Deliver Us from the Old’ (1991) 13(10) *EIPR* 335,356.

<sup>2</sup> Frank Schechter, ‘The Rational Basis of Trade Mark Protection’ (1927) 40 *HLR* 813.

<sup>3</sup> William Cornish, *Intellectual Property: Omnipresent, Distracting, and Irrelevant?* (OUP, Oxford 2004) 89.

<sup>4</sup> The ECJ in *L’Oreal* seems to have taken the first step in solving this problem by naming the ‘additional functions’ of trade marks as the ‘communication, investment, or advertising functions’; see *L’Oreal SA v. Bellure NV*. (C-487/07) (18/6/2009)

not whether there should be trade mark protection, but rather ‘what do we want to protect in a trade mark?’ and ‘how can this be achieved without harming other fundamental rights?’ To answer these questions, the paper will put forward a comprehensive account of the levels of protection that recognise the different roles a trade mark plays nowadays, in particular famous trade marks.

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