Proceeding of ICGPSH 2025 Symposium: Exploring Spelling Evolution and Educational Approaches to Dyslexia
DOI: 10.54254/2753-7048/2025.HT25294

Exploration of the "Use as a Trademark" Element in Trademark Infringement Determination: Focusing on the Actual Functional Impairment of the Trademark as the Core Criterion

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Abstract. In the theory and judicial practice of trademark law, the limitations of the formal requirement of "whether used as a trademark" in determining trademark infringement have become increasingly prominent. Based on the research background of UK trademark law, this study explores the paradigm shift in the core of trademark infringement determination — from "formal use" to "substantial damage". By integrating the diversified functions of trademarks, the special protection rules for well-known trademarks, the logic behind assessing the likelihood of confusion, and the fundamental values of trademark law, the research highlights that the focus should be on whether the alleged act has caused substantial damage to the identifying function, goodwill value, or market competition order of the trademark. The findings reveal that it is more pertinent to assess the impact of the contested action on the trademark's essential functions rather than to impose a mechanical requirement for the actor to exhibit a subjective purpose or objective form of "use as a trademark". Such a shift not only accords with the essential requirements of trademark law to protect multiple functions and maintain market order but also achieves a balance between right protection and competition promotion in a dynamic business environment, providing a more adaptable legal framework for addressing new types of infringement.

Keywords: Trademark infringement determination, UK trademark law, Trademark function, Substantial damage

1. Introduction

In the intellectual property legal system, the constituent elements of trademark infringement have always been a core issue in theoretical research and judicial practice. As an important representative of the common law system, the United Kingdom's 1994 Trademark Act established the basic framework for modern trademark protection [1,2]. Its legislative practice has long broken through the single understanding of trademark functions. Trademarks not only have the basic function of identifying the source of goods or services but also have derived multiple values such as quality assurance, advertising promotion, and reputation accumulation, and have developed into multi-

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dimensional tools for market competition. Against this backdrop, if one still adheres to the formal requirement of “used as a trademark”, it may lead to acts that damage the functions of trademarks evading legal regulation, making it difficult to effectively protect the legitimate rights and interests of trademark owners and the fair market competition order.

This article advocates for a shift in the core standard for determining trademark infringement from formal requirements to a focus on substantial damage. This study breaks through the formalistic limitations of "use as a trademark" in trademark infringement determination. Drawing on the institutional practices and judicial cases of UK trademark law, it explores how to transcend the traditional formalistic determination framework against the backdrop of diversified trademark functions and complex market competition. It provides theoretical support for constructing a more adaptable paradigm for trademark infringement determination, aiming to achieve the protection of multiple trademark functions, the maintenance of market competition order, and the dynamic balance between rights and innovation in trademark law.

2. The diverse functions of trademarks

2.1. The evolution of trademark functions

The diversity of trademark functions determines the broadness of the protection scope. Trademarks are not only indicators of the source of goods but also carry multiple functions such as quality assurance and brand reputation. Legal protection should cover all acts that may damage these functions, rather than being limited to the traditional situation of source confusion. British trademark law has evolved from the early common law's protection of the single function of “indicating the source of goods” to the protection of the multiple values of trademarks. After the revision of the 1994 Trademark Act, the legislature explicitly regarded trademarks as a core element of the “commercial identification system”, and the scope of protection was expanded to include derivative functions such as quality assurance and advertising promotion. The Act, in its Article 5(3), stipulates that using a trademark on different goods or services without a good reason, if it could unfairly benefit from or damage the uniqueness or reputation of a registered trademark, is considered infringement [3]. This provision breaks through the traditional limitation of “source confusion” and extends the protection object to the reputation value and market competitiveness of the trademark.

2.2. Case analysis: Interflora Inc. v. Marks & Spencer plc

In Interflora Inc. V. Marks & Spencer plc, the defendant, Marks & Spencer, purchased “Interflora” as a keyword in Google’s advertising system to promote its own flower delivery service. The well-known flower brand Interflora Ltd claimed that this act constituted trademark infringement, and the defendant was ultimately found guilty of infringement.

This case highlights that trademarks do not merely indicate the source of goods; they also embody the brand's accumulated reputation and advertising functions. Although the defendant did not use “Interflora”as a trademark, it was used for advertising promotion, infringing on the advertising function rights of the plaintiff's trademark.

The multi-functionality of trademarks suggests that their protection scope should not be limited to the situation of“used as a trademark”. Instead, the scope of protection must encompass various functions that trademarks serve in the marketplace.

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3. The special protection of well-known trademark

3.1. The particularity of well-known trademark

The special protection of well-known trademarks breaks through the formal requirements. Article 10(3) of the British Trademark Act explicitly prohibits the use of well-known trademarks on non-similar goods that leads to“unfair advantage or damage to reputation”, without the need to prove “used as a trademark” [4]. This means that even in scenarios not directly involving the use of a trademark, if an act may damage the distinctiveness or reputation of a well-known trademark, it may constitute trademark infringement.

3.2. Case analysis: L’ oréal SA v. Bellure NV

The judgment of the UK court in the L'Oreal v. Bellure reflects this logic: although the defendant clearly marked “replica” on the product and did not directly use the plaintiff's trademark to indicate the source, the court held that its comparative advertisement constituted “unfair use of the trademark's reputation” and found infringement. This judgment demonstrates that safeguarding a trademark's diverse functions should extend beyond merely adhering to formal regulations; it should also take into account how the action impacts the overall value of the trademark.

4. The basis for determining the possibility of confusion

4.1. Objective market-oriented determination of the possibility of confusion

The determination of the likelihood of confusion relies on objective market effects. According to Section 10(2) of the UK Trademark Act, using the same or similar trademarks on similar goods or services, leading to a “likelihood of confusion”, constitutes infringement [5]. Here, “confusion” includes direct source confusion (such as consumers mistakenly believing that the accused goods come from the trademark owner) and indirect association confusion (such as consumers mistakenly believing that the accused goods have some connection with the trademark owner). When determining the likelihood of confusion, UK courts adopt the “comprehensive assessment” principle, comprehensively considering factors such as the similarity of the trademarks, the similarity of the goods or services, and the degree of consumer attention, without strictly requiring that the accused act must have the subjective purpose of “use as a trademark”. Courts pay more attention to the actual impact of the act on consumer perception rather than the legal form of the use, which provides practical support for breaking through the requirement of “use as a trademark”.

4.2. Case analysis: Jack Wills Ltd v. House of Fraser (stores) Ltd

In the Jack Wills v. House of Fraser case, defendant Fraser & Chalmers used a pelican pattern highly similar to the plaintiff Jack Wills' trademark when selling clothing, arguing that the pattern was only used as a decorative element and not to indicate the source.

However, the court held that although the pattern was not marked as a trademark, its prominent use on the goods was sufficient to cause consumers to be confused about the connection between the goods and the Jack Wills brand, thus constituting infringement. This judgment clearly states that the determination of the likelihood of confusion focuses on the objective market effect of the act rather than the form of use [6]. Even if the accused mark is not used as a trademark, as long as the actual

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use may cause consumers to be confused about the source or association of the goods, it can be determined as infringement.

This judgment logic further weakens the necessity of the “use as a trademark” requirement and reflects the substantive protection of trademark law for consumer perception and market order.

5. The core role of trademark law

The core function of trademark law requires a substantive justice orientation. The core role of trademark law is to protect the legitimate rights and interests of trademark owners and maintain a fair competitive market order [7]. The core of trademark law lies in balance - it is necessary to protect the legitimate interests of rights holders while also preventing the abuse of rights from leading to market monopolies [8-9]. This balance concept is reflected in the specific rules of trademark law: on the one hand, it grants exclusive rights to trademark owners through the registration system; on the other hand, it restricts the abuse of rights through defense clauses such as“fair use”and “prior rights”. If “use as a trademark”is taken as a necessary prerequisite for infringement determination, it may lead to imbalances in two aspects. The article, created by author Chris Reed’s Internet Law - UK: Trademark Infringement on Web Pages, explores the application of trademark law to web page content within the UK legal system [10]. It reviews the legislation related to trademark infringement on web pages and introduces the specific application rules of UK trademark protection laws in the online environment. The article emphasizes the significant role of trademark law in safeguarding the legitimate rights and interests of trademark owners in the new business environment (the online environment), and also analyzes how to balance the rights and interests of trademark owners and other market participants to ensure a fair competitive order in the online market [11-12]. This article demonstrates that in the new market environment, the primary role of trademark law is to protect the legitimate rights and interests of trademark owners and maintain a fair competitive market order. The legitimate rights and interests of trademark owners may not be fully protected if trademark infringement on online pages is exclusively assessed on the basis of "use as a trademark." Additionally, infringers can cite "not used as a trademark" as a defense to avoid paying fines, which is unjust in a market where competition is fierce and goes against the fundamental purpose of trademark law.

6. Paradigm shift in trademark infringement determination

In the interactive development of business practices and legal systems, the core of trademark infringement determination should focus on“protecting trademark functions and maintaining market order”,and abandon the formalistic judgment based mainly on“use purpose” [13]. A determination paradigm oriented towards substantive damage should be constructed, such as establishing functional damage as the core standard, improving diversified infringement determination rules, and strengthening the substantive justice orientation of judicial judgments. Only in this way can trademark law balance the protection of rights and the promotion of competition in a dynamic market environment and lay a solid legal foundation for innovation and fair competition.

7. Conclusion

This study challenges the traditional formalistic paradigm of trademark infringement determination based on the "use as a trademark" requirement, advocating for a fundamental shift towards a framework centered on substantive harm through the lens of British trademark law. By analyzing the

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multifaceted functions of trademarks, including source identification, quality assurance, advertising promotion, and reputation capital, as well as the special protection mechanisms for well-known trademarks, the objective logic of likelihood of confusion assessment, and the core mission of trademark law to balance rights and competition, this paper argues that the essence of infringement lies in whether a certain act causes substantive harm to the functional integrity of the trademark, the value of business reputation, or the competitive order of the market, rather than merely conforming to formal usage standards. By grounding infringement determination in functional maintenance and market realities, this study aims to endow trademark law with flexibility to safeguard innovation and fairness in the increasingly complex global market, and looks forward to further discussions on its theoretical refinement and practical application.

However, there still exists some limitations in this study. For instance, it lacks empirical data to support its claims, which could strengthen its conclusions. Additionally, the practical implications of implementing such a framework in varying jurisdictions remain underexplored, potentially limiting its applicability.

Looking ahead, further research should focus on establishing quantitative indicators for damage assessment, developing empirical models to measure the loss of business reputation or market share, integrating economic data to implement the "substantive harm" standard; balancing public interests, and exploring the contradictory relationship between trademark exclusivity and open innovation in scenarios such as open-source software or non-commercial imitation, clarifying the boundaries of fair use.

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