Reports of Cases

OPINION OF ADVOCATE GENERAL
MEDINA
delivered on 21 September 2023 [1]

Case C-334/22

Audi AG
v
GQ

(Request for a preliminary ruling from the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland))

(Reference for a preliminary ruling – Regulation (EU) 2017/1001 – Article 9(2) and (3) – Rights conferred by an EU trade mark – Use by a third party of an identical or similar sign in the course of trade – Car spare parts – Radiator grilles – Mounting element for the insertion of the car manufacturer's emblem – Article 14(1)(c) and (2) – Limitation of the effects of an EU trade mark – Use of an identical or similar sign to indicate the purpose of a product as accessories or spare parts – Honest practices in industrial or commercial matters – Criteria for assessment)

I. Introduction

1. This request for a preliminary ruling concerns the interpretation of Article 9(2) and (3) of Regulation (EU) 2017/1001, [2] as well as of Article 14(1)(c) and (2) of that regulation.

2. The request has been made in proceedings between Audi AG, a manufacturer of cars and car accessories, and GQ, a wholesaler of spare parts which sells those products on a website. The dispute concerns an alleged infringement by GQ of the rights conferred on Audi AG by an EU figurative trade mark which it holds.

3. The present case centres on the scope of protection of the exclusive right conferred by an EU trade mark to its holder and on the limitations on the effects of that mark in order to enable a third party to use it in the course of trade. The case represents an opportunity for the Court to develop its case-law on the interpretation of Regulation 2017/1001 in respect of the marketing of spare parts, especially for cars.

[1] Original language: English.

[2] Regulation of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

II. Legal framework

A. Regulation 2017/1001

4. Article 9 of Regulation 2017/1001, headed 'Rights conferred by an EU trade mark', provides:

'1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

…

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging of those goods;

(b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

…'

5. Article 14 of Regulation 2017/1001, headed 'Limitation of the effects of an EU trade mark', provides:

'1. An EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

…

(c) the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.'

B. Regulation (EC) No 6/2002

6. Article 19 of Regulation (EC) No 6/2002,[3] headed 'Rights conferred by the Community design', stipulates:

'1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

…'

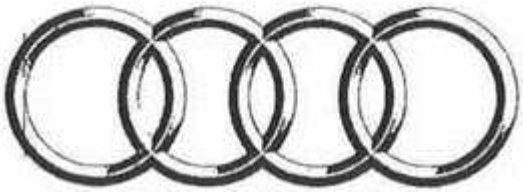
7. Article 110 of Regulation No 6/2002, headed 'Transitional provision', provides:

'1. Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance.

…'

III. Facts and questions referred

8. The applicant, Audi AG, is an undertaking established in Ingolstadt (Germany) which has exclusive rights to the EU figurative trade mark shown below, registered under No 000018762, inter alia, in Class 12 of the Nice Classification (vehicles, spare parts, automotive accessories). The mark is a sign composed of four horizontally juxtaposed and overlapping rings, which the applicant reproduces and uses as its emblem:



9. The defendant, GQ, is a natural person active in the selling of spare parts for cars. He does not offer those products directly to consumers, but sells them to other distributors. Between 1986 and 2017, the defendant advertised and offered for sale on its website radiator grilles customised and designed for old Audi models from the 1980s and 1990s. Those radiator grilles included, like the original ones, a carved space for inserting and mounting the car manufacturer's emblem, corresponding to the outline of the applicant's EU trade mark.

10. Beginning in 2017, the applicant began instituting court proceedings against the defendant, with a view to blocking the offer for sale of non-original spare parts in which the shape of certain elements corresponded, partially or completely, to the applicant's trade mark. In particular, in May 2020, the applicant sought an injunction before the Sąd Okręgowy w Warszawie (Regional

[3] Council Regulation of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

Court, Warsaw), the referring court in the present case, to prohibit the defendant from importing, offering, marketing and advertising non-original radiator grilles bearing a sign identical with, or similar to, its EU trade mark. The applicant also sought the destruction of 70 such automotive radiator grilles seized by customs.

11. The referring court considers that, in order to give a ruling in the case, it must determine whether the scope of protection of the applicant's EU trade mark – which, according to that court, has a highly distinctive character, is widely known in Poland and is clearly associated with the applicant – also extends to the element which allows the emblem of the car manufacturer to be inserted and mounted onto a radiator grille and which, by virtue of its shape, is identical with, or confusingly similar to, that mark.

12. In particular, the referring court harbours doubts, in the first place, as to whether the element for inserting and mounting the car manufacturer's emblem onto a radiator grille fulfils the function of a trade mark, namely indicating the origin of the product. That doubt arises even assuming that the said element corresponds to the shape of the manufacturer's emblem and can therefore be considered identical with or, at least, confusingly similar to its EU trade mark.

13. In that respect, the referring court draws the Court's attention to the absence, in EU trade mark law, of a provision equivalent to Article 110(1) of Regulation No 6/2002 – the 'repair clause' – which, as regards EU designs, excludes protection for a design which constitutes a component part of a complex product for the purpose of the repair of that product so as to restore its original appearance. It further considers that the interpretation of Article 9(2) and (3) of Regulation 2017/1001 should be guided by the objective of EU trade mark law of protecting undistorted competition and the interest of consumers in being able to choose between purchasing original and non-original car spare parts.

14. In the second place, if it were accepted that the element for inserting and mounting the emblem of a car manufacturer onto a radiator grille fulfilled the function of a trade mark, the question would also arise, in the view of the referring court, as to whether Article 14(1)(c) of Regulation 2017/1001 would allow a seller of spare parts to market non-original grilles bearing such an element. In the affirmative, the referring court wonders which assessment criteria should be applied in order to determine whether the EU trade mark is used in accordance with honest practices in industrial and commercial matters, as is required by Article 14(2) of Regulation 2017/1001.

15. It is in those circumstances that the Sąd Okręgowy w Warszawie (Regional Court, Warsaw) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'1 (a) Must Article 14(1)(c) of [Regulation 2017/1001] be interpreted as precluding the trade mark proprietor/court from prohibiting a third party from using in the course of trade a sign which is identical or confusingly similar to an EU trade mark, in relation to automotive spare parts (radiator grilles) where that sign constitutes a mounting element for an automotive accessory (an emblem reflecting the EU trade mark), and:

where it is technically possible to affix the original emblem reflecting the EU trade mark to an automotive spare part (radiator grille) without reproducing on that part a sign identical or confusingly similar to the EU trade mark;

or in a situation

where it is technically impossible to affix the original emblem reproducing the EU trade mark to an automotive spare part (radiator grille) without reproducing on that part a sign identical or confusingly similar to the EU trade mark?

If the answer to any of the questions in 1(a) is in the affirmative:

(b) What evaluation criteria should be used in such cases to determine whether the use of an EU trade mark is consistent with honest practices in industrial and commercial matters?

(c) Must Article 9(2) and Article 9(3)(a) of [Regulation 2017/1001] be interpreted as meaning that, where the trade mark is included in the shape of an automotive part and in the absence in [that regulation] of a clause that would be similar to the repair clause in Article 110(1) of [Regulation No 6/2002], the trade mark does not fulfil a designation function in that situation?

(d) Must Article 9(2) and Article 9(3)(a) of [Regulation 2017/1001] be interpreted as meaning that, where the mounting element for a trade mark, which reflects the shape of the trade mark or is confusingly similar to it, is included in the shape of an automotive part and in the absence in [that regulation] of a clause that would be similar to the repair clause in Article 110(1) of [Regulation No 6/2002], that mounting element cannot be regarded as a trade mark with a designation function even if it is identical to the trade mark or confusingly similar to it?'

IV. Assessment

16. By its questions, the referring court asks, first, whether Article 14(1)(c) of Regulation 2017/1001 can be interpreted as meaning that a seller of non-original car spare parts, namely radiator grilles, is permitted to market those parts where they include an element for inserting and mounting the emblem of a car manufacturer and which, by virtue of its shape, is identical with, or confusingly similar to, an EU trade mark held by that manufacturer.

17. The referring court poses that question by reference to two plausible eventualities, that is to say, depending on whether it is technically possible or technically impossible to insert and mount the emblem of that manufacturer without reproducing its trade mark (Question 1(a)). Should the previous question be answered in an affirmative manner in both or either of those eventualities, the referring court then wonders what would be the criteria for assessing whether that use is, as is required by Article 14(2) of Regulation 2017/1001, in accordance with honest practices in industrial and commercial matters (Question 1(b)).

18. Second, the referring court wishes to ascertain whether the element in a radiator grille which serves for the insertion and mounting of the car manufacturer's emblem and which therefore reproduces the shape of an EU figurative mark held by that manufacturer may be regarded as a trade mark fulfilling the function of indicating origin in accordance with Article 9(2) and (3) of Regulation 2017/1001 (Question 1(c) and (d)).[4]

[4] In parts (c) and (d) of Question 1 respectively, the referring court distinguishes, for the purposes of determining the fulfilment of the designation function by the trade mark at issue in the present case, between (i) whether that mark is included in the shape of an automotive part, and (ii) whether that mark forms part of the mounting element included in the shape of an automotive part. In line with the general view of the parties, both parts can be rephrased in the terms set out in this point.

19. The assessment of the conditions for the application of the limitations to the exclusive right resulting from an EU trade mark, as is provided for in Article 14 of Regulation 2017/1001, is relevant only inasmuch as there is an infringement of that exclusive right, the scope of which is defined in Article 9 of Regulation 2017/1001.[5] For that reason, I shall give an answer, in the first place, to parts (c) and (d) of Question 1 together and, subsequently, to parts (a) and (b) of that same question.

A. Question 1(c) and (d)

20. Question 1(c) and (d) concerns the interpretation of Article 9(2) and (3) of Regulation 2017/1001. In essence, both parts of that question require the Court to determine whether the inclusion by an independent manufacturer of an element in a car radiator grille for the purpose of inserting and mounting the car manufacturer's emblem, which reproduces the shape of an EU trade mark held by that manufacturer, constitutes a use of a sign in the course of trade within the meaning of those provisions.

21. As a preliminary remark, it is important to recall that, under Article 9(1) of Regulation 2017/1001, the registration of an EU trade mark confers on the proprietor exclusive rights which, according to Article 9(2) of that regulation, entitle that proprietor to prevent all third parties not having his or her consent from using in the course of trade any sign, identical or similar, in relation to goods or services where certain conditions are satisfied.

22. Article 9(3) of Regulation 2017/1001 lists, in a non-exhaustive manner, the types of use which may be prohibited by the proprietor of an EU trade mark. These include affixing the sign to the goods or their packaging (subparagraph (a)); offering the goods, putting them on the market or stocking them for those purposes under that sign (subparagraph (b)); and importing or exporting the goods under the said sign (subparagraph (c)).[6]

23. The Court has consistently held that the exclusive right of the proprietor of an EU trade mark is conferred in order to enable him or her to protect his or her specific interests as proprietor, namely to ensure that the trade mark can fulfil its functions. The exercise of that right must therefore be reserved to cases in which a third party's use of a sign affects, or is liable to affect, the functions of the trade mark. Those include not only the essential function of the mark, which is to guarantee to consumers the origin of the product or service, but also the other functions of the mark, such as, in particular, that of guaranteeing the quality of the product or service, or those of communication, investment or advertising.[7]

24. It follows that the proprietor of an EU trade mark cannot oppose the use of a sign identical with, or confusingly similar to, the trade mark on the basis of Article 9 of Regulation 2017/1001 if that use is not liable to cause detriment to any of the functions of that mark.[8]

[5] See also, in that regard, Hasselblatt, G.N. (ed.), *European Union Trade Mark Regulation (EU) 2017/1001 – Article-by-Article Commentary*, Beck, 2018, p. 431.

[6] Question 1(c) and (d) refers only to Article 9(3)(a) of Regulation 2017/1001. However, having regard to the facts of the case in the main proceedings as are set out in the order for reference, it is apparent that Article 9(3)(b) and (c) of that regulation should also be taken into account for the purposes of the present case.

[7] See, to that effect, judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe* (C-129/17, EU:C:2018:594, paragraph 34 and the case-law cited).

[8] See, to that effect, judgment of 18 June 2009, *L'Oréal and Others* (C-487/07, EU:C:2009:378, paragraph 60 and the case-law cited).

25. In the present case, I should point out, in the first place, that the products at issue in the main proceedings are non-original car radiator grilles, which reproduce the original models in accordance with design law.[9] Those grilles are spare parts intended to cover and protect the car's radiator as a component of the engine cooling system. Radiator grilles are external and visible parts of the bodywork of a car and have a considerable impact on its front appearance. Their position makes them very vulnerable in the event of a frontal accident. In addition, it is common for car manufacturers to design the radiator grilles of their vehicles so as to include an element for inserting and mounting their emblem, often in a chrome finish, which reproduces a previously registered trade mark held by them.

26. The location for the insertion and mounting of the car manufacturer's emblem forms an integral part of the radiator grille, usually being in the middle upper third of the front part of the vehicle. That element is formed by a carved space for the insertion of the emblem and by a series of openings for mounting it. Similarly, the rear side of the emblem has nails for affixing the emblem to the grille. It is important to bear in mind that the question asked by the referring court in the present case relates not to the reproduction of the emblem of a car manufacturer as such, but to the location envisaged for the affixing of that accessory to the radiator grille, which, by definition, has a shape which outlines the emblem itself.

27. In the second place, as regards the question whether an element such as that previously described constitutes a sign capable of affecting the functions of a trade mark, as is required by the case-law cited in point 24 above, I would point out, from the outset, that the term 'sign' used in Article 9(2) of Regulation 2017/1001 is not defined in any of the other provisions of that regulation. However, as the Republic of Poland, the Commission and the defendant in the main proceedings submit, an essential condition of the concept of the term 'sign' is its distinct and autonomous character in relation to the product it designates. In other words, in order to conclude that an element of a product functions as a sign, it must be perceived as being independent and distinct from the product itself.

28. I observe that that understanding of the concept of the term 'sign' has been confirmed on several occasions by the Court, which has held, as the defendant contends, that a sign cannot be a mere property of the product concerned.[10] This essentially means that a sign cannot be equated with the components of that product, especially those which fulfil only a specific function and which, despite having an impact on the overall appearance of that product, are not perceived as a sign.

29. Illustrative reasoning in that regard was provided by Advocate General Léger in his opinion in the *Dyson* case,[11] in which he concluded, in essence, that a functional element forming part of the appearance of a product – a transparent bin forming part of the external surface of a vacuum cleaner – does not fulfil the conditions required to constitute a sign since that element is not capable of distinguishing the goods and services of one undertaking from those of other undertakings.[12]

30. That is, in my view, true also of the element at issue in the present case, which, as I have already described in points 25 and 26 of the present Opinion, constitutes the support for a car manufacturer's emblem in a radiator grille, thus forming part of the product itself and fulfilling a

[9] As noted above, see Article 110(1) of Regulation No 6/2002, containing the 'repair clause'.

[10] Judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 27).

[11] Opinion of Advocate General Léger in *Dyson* (C-321/03, EU:C:2006:558, operative part).

[12] Ibid., paragraph 43.

mere technical function. That technical function is obvious when one considers that the carved space that remains in the radiator grille is used only for inserting and mounting an additional accessory – the emblem – and that, in order to serve that specific purpose, must be necessarily adapted to the contours of that accessory.

31. In that regard, it is important to bear in mind that the aim of car spare parts is to replace the originally assembled parts. [13] In the case of external elements, spare parts are primarily intended to restore the original appearance of the repaired car. Otherwise, the replacement of an assembled part in a car might fall under the practice of *tuning*, which also may provide with a new appearance to a car, but which conceptually differs from the repair of that car for the purpose of restoring its original appearance. The Court has in fact endorsed that understanding, emphasising that the purpose of repair may be achieved only by parts that are visually identical to the original parts. [14]

32. To my mind, it is evident that only a radiator grille with a position designed in such a way to enable the insertion and mounting of the car manufacturer's emblem, as conceived in the original radiator grille, makes it possible to replicate the vehicle's original appearance. Consequently, as a spare part, radiator grilles can serve to restore a car's original appearance only if the position for affixing the emblem faithfully reproduces the position provided in the original grille. It is important to emphasise that, unlike other types of spare parts such as wheel rims and hubcaps, a radiator grille, due to its front position in the bodywork of the car, cannot achieve a full restoration of a car's appearance unless it is identical to the original product. This explains why radiator grilles with a non-identical appearance are not frequently offered on the market by independent manufacturers, except when they are intended, as I have already noted, for *tuning* purposes.

33. Furthermore, the use of a sign for the purpose of indicating goods or services as originating from a particular undertaking must be assessed in the context of the course of trade. [15] That assessment must be carried out in the light of the perception and judgement of the consumer who might actually be interested in buying spare parts for a particular brand of vehicle. In that regard, the referring court notes in the order for reference that the defendant in the main proceedings sells its spare parts only to professional distributors, which must therefore be taken as the average consumer of the products at issue in the present case. [16]

34. Interestingly, a recent empirical study, published in a specialised academic journal and replicating the main premisses of the present case, has been conducted in order to determine how the presence of the original manufacturer's trade mark on a spare part affects the perception of the commercial origin of the spare part and the quality expectations of consumers, in particular in the Polish market. [17]

[13] For a definition of the term 'spare parts' in EU legislation, see Article 1(1)(h) of Commission Regulation (EU) No 461/2010 of 27 May 2010 on the application of Article 101(3) of the Treaty on the Functioning of the European Union to categories of vertical agreements and concerted practices in the motor vehicle sector (OJ 2010 L 129, p. 52), which provides that that term means 'goods which are to be installed in or upon a motor vehicle so as to replace components of that vehicle'.

[14] See, to that effect, judgment of 20 December 2017, *Acacia and D'Amato* (C-397/16 and C-435/16, EU:C:2017:992, paragraph 75).

[15] Judgment of 23 February 1999, *BMW* (C-63/97, EU:C:1999:82, paragraph 38, 'the judgment in *BMW*').

[16] Even though the Court of Justice has not yet stated its position in that regard, it is worth noting that the General Court has consistently considered that, having regard to the technical and costly nature of automotive spare parts, which are aimed, in principle, at a specialist and professional public, that public will only purchase those goods after a careful examination of their properties, composition and other characteristics. See, to that effect, judgment of 12 July 2019, *MAN Truck & Bus v EUIPO – Halla Holdings (MANDO)* (T-792/17, EU:T:2019:533, paragraph 41 and case-law cited).

[17] Tischner, A, and Stasiuk, K, 'Spare Parts, Repairs, Trade Marks and Consumer Understanding', *IIC – International Review of Intellectual Property and Competition Law*, No 54, 2023, p. 42.

35. The study suggests, first, that the context surrounding the use of the sign can neutralise its impact as an indication of the commercial origin of a product, especially, as was discussed at the hearing for the present case, when the information available during the sale of radiator grilles includes the following main elements: (i) the name of the product and the models of car to which it is applicable; (ii) the price per unit, usually lower than the original spare part; (iii) additional information that the spare part offered by the trader is not original, and (iv) the name of the independent manufacturer. [18]

36. Second, the study explains, on the basis of the survey conducted, that professional retailers and workshops 'overwhelmingly' indicated that the spare parts came from an independent source, which showed that those professional sellers do not tend to be misled as to the origin of the radiator grilles. Even in the case of end users, the percentage pointing to the original manufacturer was relatively insignificant. On those bases, the study concludes that professionals appear to perceive the EU trade mark of the original manufacturer in the context of the sale of independently sourced spare parts as a description of the characteristics of the product – as an element which fulfils a technical purpose – rather than an as an indication of origin. [19]

37. Certainly, an empirical study cannot be the only decisive factor in the final assessment of an individual case in trade mark law such as that of the main proceedings. However, the abovementioned study demonstrates that a circumstantial analysis must be conducted on a case-by-case basis in order to define the degree of perception by relevant consumers of the sign at issue. For that purpose, particular attention should be paid inter alia to the information available during the selling process of the spare part concerned and to the special features of the geographical market in question. For instance, in the case of Poland, it appears to be undisputed among the parties in the present case that significant quantities of used and damaged cars are still imported into that Member State from other Member States. In that context, older cars in need of repair are remarkably common on the Polish automotive market, making the repair market in that country highly developed and familiar to consumers, who show a willingness to repair such older cars to restore their original appearance. [20]

38. That conclusion is also consistent with the case-law of the Court, in particular the judgment in *Adam Opel*, [21] which has been cited in the academic literature [22] as an illustration of the reproduction by a third party of an EU trade mark held by a car manufacturer which does not fulfil the function of indicating the origin of a product.

39. In particular, the Court held in that case – with regard to the use, on reduced-scale toy cars, of an EU trade mark owned by a car manufacturer – that there was no adverse effect on the function of that mark since the relevant public would not perceive the car emblem appearing on the toy cars as an indication that the scale models came from that manufacturer or an undertaking economically linked to it. [23] Again, the particular circumstances and practices in the sector concerned played a decisive role. The Court based its ruling on the referring court's factual finding that the average consumer of the products of the toy industry was used to scale models being based on real examples and even accorded great importance to absolute fidelity to the

[18] Ibid., p. 44.

[19] Ibid., p. 53.

[20] Ibid., p. 42.

[21] Judgment of 25 January 2007, (C-48/05, EU:C:2007:55) ('the judgment in *Adam Opel*').

[22] Kur, A, and Senftleben, M., *European Trade Mark Law – A commentary*, Oxford University Press, 2017, p. 301.

[23] The judgment in *Adam Opel* (paragraph 24).

original, such that the consumer would perceive the car manufacturer's emblem appearing on the toy cars as a feature of the reduced-scale reproduction of a car, and not as an indication that the toy car itself originated from that manufacturer. [24]

40. In my view, the foregoing considerations are sufficient to allow the Court to exclude, in the present case, the mere silhouette of an EU trade mark of a car manufacturer, as part of a faithful reproduction of an original radiator grille and with the sole technical purpose of inserting and mounting the emblem of that manufacturer, from fulfilling the functions of a trade mark and thus from constituting a use of a sign in the course of trade within the meaning of Article 9(2) and (3) of Regulation 2017/1001 – especially where the circumstances referred to in points 35 and 37 of the present Opinion arise, which it would be for the national court to assess.

41. For the sake of completeness, I would also point out that the absence, in EU trade mark law, of a provision equivalent to the 'repair clause' in EU design law, as referred to by the referring court in the formulation of Question 1(c) and (d), is irrelevant in arriving at the previous conclusion. The Court has in fact held, in the *Ford Motor Company* case, [25] that the 'repair clause' contained in Article 110 of Regulation No 6/2002 imposes certain limitations *only* on protection as designs, without any reference to protection as trade marks. [26] That interpretation of the Court thus excludes the taking into account, from a formal standpoint, of the 'repair clause' of Article 110 of Regulation No 6/2002 for the purposes of interpreting Article 9 of Regulation 2017/1001.

42. That being said, in cases where EU trade mark law converges with other domains of intellectual property law, the Court has consistently interpreted fundamental provisions of Regulation 2017/1001 – and its predecessors – in such a manner as to avoid the neutralisation of the common objectives of those domains and to ensure that they are satisfied in full, especially with a view to protect a system of undistorted competition in the market.

43. For instance, in the *Lego Juris* case, [27] concerned by the intersection between trade mark and patent law, the Court emphasised the need to prevent trade marks from granting an undertaking a monopoly on technical solutions or functional characteristics of a product. [28] In particular, the Court held that, when the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once a patent over that product has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. [29] It is clear that rulings such as that rendered in the *Lego Juris* case illustrate the good sense of the Court to adopt a coherent and workable interpretation of all domains of intellectual property law, thereby avoiding the creation of monopolies and protecting the interest of consumers in accessing products or services from a wide variety of sources.

44. In the present case, it should be noted that the activity of manufacturing and distributing spare parts for motor vehicles is essentially carried out in three market segments: (a) spare parts manufactured by car manufacturers; (b) parts manufactured by operators other than car manufacturers, often on behalf of or in cooperation with car manufacturers, and (c) parts manufactured by independent manufacturers which are not supplied to car manufacturers but

[24] Ibid., paragraph 23.

[25] Order of the Court of 6 October 2015, *Ford Motor Company* (C-500/14, EU:C:2015:680).

[26] Ibid., paragraph 39.

[27] Judgment of 14 September 2010, *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, 'the *Lego Juris* case').

[28] Ibid., paragraph 43.

[29] Ibid., paragraph 46.

which are produced according to specifications and standards supplied by those car manufacturers.[30] Evidently, a broad interpretation of the term 'sign' contained in Article 9(2) of Regulation 2017/1001 would, as a consequence, favour the creation of a monopoly over the repair of radiator grilles for restoring the original appearance of vehicles, benefiting car manufacturers – either acting autonomously or through licences with independent sellers. Those effects, capable of limiting consumers' choices and impacting the aims of the new proposed legislative instruments in EU design law,[31] would be manifest if car manufacturers objected, under EU trade mark law, to the marketing by independent sellers of non-original radiator grilles bearing an element for the insertion and mounting of their emblem.[32]

45. It is for those reasons that, even though, as I have already explained, the 'repair clause' is not applicable in the present case for the purpose of interpreting Regulation 2017/1001, and even though the Court has held that it is Article 14 of that regulation that is intended to reconcile the fundamental interests of trade mark protection within a system of undistorted competition,[33] attention should be paid to the consequences of a decision on EU trade mark law that might also impair the aims of a close domain of EU intellectual property law, namely design law, intended to broaden the choice for consumers of spare parts between independent and non-independent manufacturers.

46. In the light of the foregoing considerations, I would conclude that Article 9(2) and (3) of Regulation 2017/1001 should be interpreted as meaning that the inclusion of an element in a non-original radiator grille for inserting and mounting the car manufacturer's emblem which reproduces the shape of an EU figurative mark held by that manufacturer or is confusingly similar to it does not constitute a use of a sign in the course of trade within the meaning of those provisions, especially where the circumstances referred to in the present Opinion in relation to the sale of those radiators grilles and to the geographical market concerned arise, which it is for the national court to assess.

B. Question 1(a)

47. As I have stated in point 19 of the present Opinion, in applying Article 14 of Regulation 2017/1001, it is a precondition that an infringement of an EU trade mark by a third party is established. For the purposes of the present case, this means that it is only if the Court were to disagree on the answer to be provided to Question 1(c) and (d) and considered that the inclusion

[30] This segmentation of the spare parts market results indirectly from the EU legislation on vertical agreements and concerted practices in the motor vehicle sector, in particular from Commission Regulation No 461/2010. See also European Commission, Directorate-General for Internal Market, Industry, Entrepreneurship and SMEs, *Market structure of motor vehicle visible spare parts in the EU*, Publications Office, 2021, p. 14, available at https://op.europa.eu/en/publication-detail/-/publication/6a303741-0b95-11ec-adb1-01aa75ed71a1.

[31] On 28 November 2022, the Commission published proposals to revise (i) Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28; 'the Design Directive') and (ii) Regulation No 6/2002 as steps towards creating a coherent package for the implementation of the intellectual property action plan published in November 2020. In particular, Article 19 of the proposed directive and Article 20a of the proposed regulation address the 'repair clause', making it clear that the holder of a design relating to a spare part cannot exercise a monopoly and cannot prevent a third party from placing on the market spare parts intended for repairing a product or restoring it to its original appearance. See also European Parliament, *Revision of the EU legislation on design protection*, July 2023, p. 5, available at https://www.europarl.europa.eu/RegData/etudes/BRIE/2023/751401/EPRS_BRI(2023)751401_EN.pdf.

[32] See, in that regard, Kur, A., 'As Good as New' – Sale of Repaired or Refurbished Goods: Commendable Practice or Trade Mark Infringement?', *GRUR International*, Oxford University Press, vol. 70, 2021, p. 236. That would be all the more so in relation to spare parts for car models which are no longer being produced by manufacturers, as it is the case of the radiator grilles concerned by the main proceedings.

[33] See, to that effect, inter alia, order of the Court of 6 October 2015, *Ford Motor Company* (C-500/14, EU:C:2015:680, paragraph 43 and the case-law cited).

of the element at issue in the present case constituted a use of a sign in the course of trade, within the meaning of Article 9(2) of Regulation 2017/1001, that an answer to Question 1(a) and (b) posed by the referring court would be required.

48. In particular, by Question 1(a), that court wishes to ascertain whether Article 14(1)(c) of Regulation 2017/1001 allows a seller of non-original radiator grilles to market those products where they incorporate an element for the purpose of inserting and mounting the emblem of the car manufacturer and which, by virtue of its shape, is identical with, or confusingly similar to, an EU trade mark of that manufacturer.

49. As I have already pointed out, under Article 9 of Regulation 2017/1001, the registration of an EU trade mark confers on the proprietor exclusive rights which entitle that proprietor to prevent all third parties not having his or her consent from using in the course of trade any sign, identical or similar, in relation to goods or services. The exclusive rights conferred on the proprietor of an EU trade mark are subject, however, to the limitations listed in Article 14 of Regulation 2017/1001.

50. More specifically, according to Article 14(1)(c) of that regulation, an EU trade mark is not to entitle the proprietor to prohibit a third party from using, in the course of trade, the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where the use of that mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

51. As a preliminary remark, I would point out that, even though Article 14(1)(c) of Regulation 2017/1001 refers, from a literal perspective, to the use of an 'EU trade mark' by a third party for the purpose of designating or referring to goods or services, that provision must be understood as being applicable where that third party uses not an EU trade mark as such, but a sign which is considered to be identical with or confusingly similar to it. After all, Article 14(1)(c) of Regulation 2017/1001 establishes a defence against the claim that Article 9 of that same regulation has been infringed, which, as I have already explained in my analysis of Question 1(c) and (d), refers merely to the use of a sign in the context of trade. In the present case, this means that Article 14(1)(c) of Regulation 2017/1001 could still be applied to the facts of the main proceedings even if it were considered that the defendant did not use the applicant's EU trade mark on its radiator grilles, but only, as the referring court notes, a sign confusingly similar to it.

52. Moreover, it is important to note that, in the judgment in *Gillette Company and Gillette Group Finland*,[34] the Court had the occasion to interpret Article 6(1)(c) of Directive 89/104/EEC.[35] That provision has been repealed and is currently applicable with respect to national trade marks by virtue of Article 14(1)(c) of Directive (EU) 2015/2436,[36] which is the counterpart of Article 14(1)(c) of Regulation 2017/2001.

53. In the dispute which gave rise to the judgment in *Gillette*, an undertaking was selling razors consisting of a handle and a replaceable blade and blades similar to those marketed by the Gillette Company, the proprietor of the trade marks Gillette and Sensor. Those blades were being sold under the trade mark Parason Flexor and their packaging bore a label bearing the words 'All the

[34] Judgment of 17 March 2005 (C-228/03, EU:C:2005:177, 'the judgment in *Gillette*').

[35] First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1)

[36] Directive of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

Parason Flexor and Gillette Sensor handles are compatible with this blade'.[37] The undertaking concerned was not authorised by a trade mark licence or by any other contract to use the trade marks owned by the Gillette Company. In those circumstances, the latter brought an action before a national court in which it claimed that that undertaking had infringed its registered trade marks.

54. It follows from the judgment in *Gillette* that the use of an EU trade mark by a third party under Article 6(1)(c) of Directive 89/104 depended on whether the purpose of that use was to provide the public with comprehensible and complete information as to the intended purpose of the product which that third party markets.[38] Moreover, that use had to be necessary, that is, that that information could not in practice be communicated to the public by a third party without use being made of the EU trade mark of which the latter was not the owner.[39]

55. It is important to bear in mind that the wording of Article 14(1)(c) of Regulation 2017/1001 no longer focuses on the necessity requirement, this being mentioned only by way of illustration in relation to 'indication of the intended purpose'. Consequently, the primary test for applying Article 14(1)(c) of Regulation 2017/1001 should be whether the use of the EU trade mark by a third party serves the function of exclusively identifying or referring to the goods or services of the trade mark owner ('referential use').[40] This defence against a claim that Article 9 of that same regulation has been infringed is not subject to the necessity requirement established in the judgment in *Gillette*, which remains applicable to the use of an EU trade mark only for the specific purpose of indication of the intended purpose of a good or service.[41]

56. The parties to the main proceedings disagree, first, on whether the use of a sign as an element of a radiator grille fulfils the function of exclusively identifying or referring to the goods or services of the trade mark owner. They also disagree on whether that sign may be used to inform the relevant public about the intended purpose of the radiator grille and on whether the necessity requirement, applicable in that case, can be considered to be of a technical nature rather than of informative value.

57. In that regard, I am of the view, first, that the use of the sign at issue in the present case does not serve the function of exclusively identifying or referring to the goods or services as being from the applicant in the main proceedings. Certainly, consumers of radiator grilles must be able to obtain information that the spare part is suitable or intended for cars of a particular manufacturer. However, it is clear, to my mind, that the inclusion of an element in a radiator grille, which is used only for inserting and mounting an additional accessory – the car manufacturer's emblem –, does not amount to a referential use within the meaning of Article 14(1)(c) of Regulation 2017/1001. As I have noted in my analysis for Question 1(c) and (d), that element fulfils a technical function[42] and not a designation aim.

58. Second, I consider for similar reasons that the sign at issue in the main proceedings cannot be understood as an indication of the intended purpose of the radiator grille, in particular as an accessory or spare part. Furthermore, even assuming the contrary, the technical need to use a sign identical with, or similar to, the trade mark concerned, would not satisfy the necessity

37 The judgment in *Gillette* (paragraph 14).

38 The judgment in *Gillette* (paragraph 34).

39 The judgment in *Gillette* (paragraph 35). See also the judgment in *BMW* (paragraph 60).

40 Hasselblatt, G.N. (ed.), *European Union Trade Mark Regulation (EU) 2017/1001 – Article-by-Article Commentary*, Beck, 2018, p. 436.

41 See also Kur, A, and Senftleben, M., *European Trade Mark Law – A commentary*, Oxford University Press, 2017, p. 420.

42 See point 30 of the present Opinion.

requirement of Article 14(1)(c) of Regulation 2017/1001, given that informing the end consumer remains the objective that must be pursued by the use of the mark. In other words, a technical need, as it is referred to by the referring court in the formulation of Question 1(a), cannot be invoked in order to limit the rights of the trade mark proprietor under Article 14(1)(c) of Regulation 2017/1001.

59. It follows from the foregoing that Article 14(1)(c) of Regulation 2017/1001 should be interpreted as meaning that it does not allow a seller of car spare parts, namely of radiator grilles, to market those parts where they include an element for inserting and mounting the car manufacturer's emblem and which, by virtue of its shape, is identical with, or confusingly similar to, an EU trade mark of that manufacturer.

C. Question 1(b)

60. Regarding Question 1(b), an answer should be provided only if the Court answers Question 1(a) in a manner contrary to my proposal. In that case, it will be necessary to examine whether the use made of the EU trade mark is in accordance with honest practices in industrial or commercial matters within the meaning of Article 14(2) of Regulation 2017/1001.

61. The case-law of the Court provides detailed guidance in that regard. [43]

62. According to the Court, the use of a trade mark is not in accordance with honest practices in industrial or commercial matters where, first of all, it is done in such a way that it may give the impression that there is a commercial connection between the third party and the trade mark proprietor. Moreover, such use of the mark cannot affect its value by taking unfair advantage of its distinctive character or repute. Furthermore, a mark is not used in accordance with Article 14(2) of Regulation 2017/1001 where it discredits or denigrates that mark. Finally, the use of a trade mark is also incompatible with honest practices in industrial and commercial matters where a third party presents its product as an imitation or replica of the product bearing that mark.

63. It is for the referring court to ascertain whether, in the circumstances of the main proceedings, the use of the trade mark was in accordance with honest practices. However, as the Commission submits, three specific elements of that assessment appear to be of particular importance in the light of the facts of the case.

64. First, as I have already noted, the Court has considered that the use of a trade mark is not in accordance with honest practices in industrial or commercial matters where such use entails the 'discrediting or denigration' of that mark. [44] In view of the similarity between the shape of the mark used for the mounting element and the mark itself – that is to say, the emblem of the car manufacturer – the referring court should determine, inter alia, whether the guarantee of quality of the goods offered by the defendant is relevant in that context. Quality inferior to that ensured by manufacturers of original spare parts could adversely affect the function of guaranteeing the quality of the trade mark.

[43] See the judgment in *Gillette* (paragraphs 41 to 49), and the judgment in *BMW* (paragraphs 51, 52 and 61).

[44] The judgment in *Gillette* (paragraph 44).

65. Second, the Court has held that the presentation of a product as an 'imitation or replica of the product' is contrary to honest practices.[45] It is therefore for the national court to examine, in the light of the nature of the spare parts of the products at issue and their resemblance to the original parts, whether the defendant has taken the necessary steps to indicate that the products were manufactured by it and to ensure that they will not be regarded as imitations or reproductions of the original parts.

66. Third, in view of the conditions similar to those laid down by the Court in relation to Article 110(1) of Regulation No 6/2002,[46] the manufacturer or seller of spare parts is subject to a duty of diligence as regards compliance with the conditions required to ensure that downstream users comply with honest practices in industrial or commercial matters. In particular, in order to determine compliance with honest practices, it is necessary to assess whether the manufacturer of non-original spare parts has complied with the obligation to inform the downstream user in the supply chain in a clear and visible manner by indicating on the product, its packaging, catalogues or sales documents that these parts are not produced by the original spare parts manufacturer. It must also be ascertained whether, by appropriate means, including contractual, the manufacturer of spare parts has ensured that downstream users in the supply chain do not engage in practices liable to mislead the origin of the goods or discredit the mark in question.

67. In the light of the above considerations, and if the Court were to consider – contrary to my analysis of Question 1(a) – that Article 14(1)(c) of Regulation 2017/1001 allowed the use of a EU trade mark in circumstances such as those of the main proceedings, Article 14(2) of that regulation should be interpreted as requiring, first, that the use of the EU trade mark does not entail a discredit or denigration of that mark; second, that the user has taken the necessary steps to indicate that the products were manufactured by it and to ensure that they will not be regarded as imitations or reproductions of the original part, and, third, that the manufacturer or seller of spare parts is subject to a duty of diligence as regards compliance with the conditions required to ensure that downstream users comply with honest practices in industrial or commercial matters.

V. Conclusion

68. On the basis of the analysis set out above, I propose that the Court answer Question 1(c) and (d) referred by the Sąd Okręgowy w Warszawie (Regional Court, Warsaw) as follows:

(1) Article 9(2) and (3) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark,

must be interpreted as meaning that the inclusion of an element in a non-original radiator grille for inserting and mounting the car manufacturer's emblem which reproduces the shape of an EU figurative mark held by that manufacturer or is confusingly similar to it does not constitute an use of a sign in the course of trade within the meaning of those provisions, especially where the circumstances referred to in the present Opinion in relation to the selling process of those radiators grilles and to the geographical market concerned arise, which is for the national court to assess.

If the Court were to answer Question 1(c) and (d) in an opposite sense, I propose that the Court answer the Question 1(a) as follows:

[45] The judgment in *Gillette* (paragraph 45).

[46] See, to that effect, judgment of 20 December 2017, *Acacia and D'Amato* (C-397/16 and C-435/16, EU:C:2017:992, paragraphs 85 to 88).

(2) Article 14(1)(c) of Regulation 2017/1001,

must be interpreted as meaning that it does not allow a seller of car spare parts, namely radiator grilles, to market those parts where they include an element for the purpose of inserting and mounting the emblem of the car manufacturer and which, by virtue of its shape, is identical with, or confusingly similar to, an EU trade mark of that manufacturer.

If the Court were to answer Question 1(a) in an opposite sense, I propose that the Court answer Question 1(b) as follows:

(3) Article 14(2) of Regulation 2017/1001,

must be interpreted as requiring, first, the use of the EU trade mark does not entail a discredit or denigration of that mark; second, the user has taken the necessary steps to indicate as it must be that the products were manufactured by it and to ensure that they will not be regarded as imitations or reproductions of the original part; and, third, that the manufacturer or seller of spare parts is subject to a duty of diligence as regards compliance with the conditions required to ensure that downstream users comply with honest practices in industrial or commercial matters.