

Court of Justice EU, 6 October 2015



## TRADE MARK LAW

A manufacturer of replacement parts and accessories for motor vehicles that affixes a sign identical to a trade mark registered for its products without permission can not invoke the repair clause pursuant to article 14 Designs Directive and article 110 Community Designs Regulation:

- mentioned articles do not contain any derogation from the provisions of the Trade Marks Directive and the EU Trade Mark Regulation

It should be noted, first, that it is clear from the wording of Article 14 of Directive 98/71 and of Article 110 of Regulation No 6/2002 that those provisions impose certain limitations only on protection as designs, without any reference to protection as trade marks.

40. Secondly, Article 2 of Directive 98/71 provides that that directive applies only to design rights registered with certain national and international design offices and applications for registration of design rights. Furthermore, it is clear from Article 1 of Regulation No 6/2002, read in the light of recital 5 of that regulation, that the purpose of the latter is merely to create a Community design which is directly applicable in each Member State.

41. Thirdly, it is clear from recital 7 and Article 16 of Directive 98/71, and also from recital 31 and Article 96(1) of Regulation No 6/2002, that those measures of EU law apply without prejudice to any provisions of that law or of the law of the Member State concerned relating, inter alia, to trade marks.

- the objective of protecting the system of undistorted competition was already taken into account in drafting the directive and regulation

As regards the view expressed by the referring court, which is also the view of Wheeltrims, that the European Union's objective of protecting the system of undistorted competition requires the application of Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 to be extended to protection as trade marks, it should be noted that that objective was already taken into account by the EU legislature in Directive 2008/95 and Regulation No 207/2009. By limiting the effects of the rights which a trade mark owner derives from Article 5 of Directive 2008/95 or, in the case of a Community trade mark, Article 9 of Regulation No 207/2009, Article 6 of that directive and Article 12 of that regulation seek to reconcile the fundamental interests of trade mark protection with

those of free movement of goods and freedom to provide services in the internal market in such a way that trade mark rights are able to fulfil their essential role in the system of undistorted competition which the Treaty seeks to establish and maintain (see, to that effect, inter alia, judgments in [BMW, C-63/97, EU:C:1999:82](#), paragraph 62, and [Gillette Company and Gillette Group Finland](#), C-228/03, EU:C:2005:177, paragraph 29).

- national courts may not limit the exclusive right conferred by a trade mark in a manner which exceeds the limitations arising from the directive itself

Furthermore, it follows from the settled case-law of the Court that Articles 5 to 7 of Directive 2008/95 effect a complete harmonisation of the rules relating to the rights conferred by a trade mark and accordingly define the rights of proprietors of trade marks in the European Union. Consequently, save for the specific cases governed by Article 8 et seq. of that directive, a national court may not, in a dispute relating to the exercise of the exclusive right conferred by a trade mark, limit that exclusive right in a manner which exceeds the limitations arising from Articles 5 to 7 of the directive (judgment in [Martin Y Paz Diffusion, C-661/11, EU:C:2013:577](#), paragraphs 54 and 55 and the case-law cited).

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## Court of Justice EU, 6 October 2015

(A. Ó Caoimh, C. Toader, E. Jarašiūnas and C.G. Fernlund)

ORDER OF THE COURT (Third Chamber)

6 October 2015 (\*<sup>1</sup>)

(Reference for a preliminary ruling — Designs — Directive 98/71/EC — Article 14 — Regulation (EC) No 6/2002 — Article 110 — So-called ‘repair’ clause — Use by a third party of a trade mark, without the consent of the owner, for replacement parts or accessories for motor vehicles identical to the goods for which the trade mark is registered)

In Case C-500/14,

REQUEST for a preliminary ruling under Article 267 TFEU from the Tribunale di Torino (Turin District Court, Italy), made by decision of 21 October 2014, received at the Court on 10 November 2014, in the proceedings

Ford Motor Company

v

Wheeltrims srl,

THE COURT (Third Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, A. Ó Caoimh, C. Toader, E. Jarašiūnas and C.G. Fernlund, Judges,

Advocate General: M. Wathelet,

Registrar: A. Calot Escobar,

having regard to the written procedure,

<sup>1</sup> Language of the case: Italian

after considering the observations submitted on behalf of:

- Ford Motor Company, by A. Camusso, avvocato,
  - Wheeltrims srl, by D. Rizzo, avvocato,
  - the German Government, by T. Henze and J. Kemper, acting as Agents,
  - the European Commission, by V. Di Bucci and J. Samnadda, acting as Agents,
- having decided, after hearing the Advocate General, to rule by reasoned order, pursuant to Article 99 of the Rules of Procedure of the Court,

makes the following

#### Order

1 This request for a preliminary ruling concerns the interpretation of Article 14 of 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) and Article 110 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2. The request has been made in proceedings between Ford Motor Company ('Ford') and Wheeltrims srl ('Wheeltrims'), concerning the latter's marketing of wheel covers for cars, on which appeared a sign identical to the trade mark which Ford has registered, inter alia, for such goods.

#### Legal context

##### EU law

Rules relating to designs

3. Recital 7 of Directive 98/71 reads:

*'Whereas this Directive does not exclude the application to designs of national or Community legislation providing for protection other than that conferred by registration or publication as design, such as legislation relating to unregistered design rights, trade marks, patents and utility models, unfair competition or civil liability.'*

4. Article 2 of that directive, entitled 'Scope of application', is worded as follows:

*'1. This Directive shall apply to:*

- (a) design rights registered with the central industrial property offices of the Member States;*
- (b) design rights registered at the Benelux Design Office;*
- (c) design rights registered under international arrangements which have effect in a Member State;*
- (d) applications for design rights referred to under (a), (b) and (c).*

*2. For the purpose of this Directive, design registration shall also comprise the publication following filing of the design with the industrial property office of a Member State in which such publication has the effect of bringing a design right into existence.'*

5. Article 14 of that directive, entitled 'Transitional provision', provides:

*'Until such time as amendments to this Directive are adopted on a proposal from the [European] Commission in accordance with the provisions of Article 18, Member States shall maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the*

*repair of a complex product so as to restore its original appearance and shall introduce changes to those provisions only if the purpose is to liberalise the market for such parts.'*

6. Article 16 of the same directive, entitled 'Relationship to other forms of protection', provides: *'The provisions of this Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.'*

7. Recitals 5 and 31 of Regulation No 6/2002 are worded as follows:

*'(5) This calls for the creation of a Community design which is directly applicable in each Member State, because only in this way will it be possible to obtain, through one application made to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) in accordance with a single procedure under one law, one design right for one area encompassing all Member States.*

...

*(31) This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws or other relevant laws of the Member States, such as those relating to design protection acquired by registration or those relating to unregistered designs, trade marks, patents and utility models, unfair competition or civil liability.'*

8. Article 1 of that regulation, entitled 'Community design', provides:

*'1. A design which complies with the conditions contained in this Regulation is hereinafter referred to as a "Community design".*

*2. A design shall be protected:*

- (a) by an "unregistered Community design", if made available to the public in the manner provided for in this Regulation;*
- (b) by a "registered Community design", if registered in the manner provided for in this Regulation.*

*3. A Community design shall have a unitary character. It shall have equal effect throughout the [European Union]. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole [European Union]. This principle shall apply unless otherwise provided in this Regulation.'*

9. Paragraph 1 of Article 96 of that regulation, which is entitled 'Relationship to other forms of protection under national law', reads as follows:

*'The provisions of this Regulation shall be without prejudice to any provisions of [EU] law or of the law of the Member States concerned relating to unregistered designs, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability and unfair competition.'*

10. Under Article 110 of the same regulation, entitled 'Transitional provision':

*'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.*

*2. The proposal from the Commission referred to in paragraph 1 shall be submitted together with, and take into consideration, any changes which the Commission shall propose on the same subject pursuant to Article 18 of Directive [98/71].'*

Rules relating to trade marks

11. Article 5 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25 and corrigendum OJ 2009 L 11, p. 86), entitled 'Rights conferred by a trade mark', provides:

*'1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:*

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

*(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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.*

*2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*

*3. The following, inter alia, may be prohibited under paragraphs 1 and 2:*

*(a) affixing the sign to the goods or to the packaging thereof;*

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

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

*(d) using the sign on business papers and in advertising.*

*4. Where, under the law of the Member State, the use of a sign under the conditions referred to in paragraph 1(b) or paragraph 2 could not be prohibited before the date of entry into force of the provisions necessary to comply with [First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1)] in the Member State concerned, the rights conferred by*

*the trade mark may not be relied on to prevent the continued use of the sign.*

*5. Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.'*

12. Article 6 of that directive, entitled 'Limitation of the effects of a trade mark', provides:

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

*(a) his own name or address;*

*(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;*

*(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;*

*provided he uses them in accordance with honest practices in industrial or commercial matters.*

*2. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.'*

13. Article 7 of that directive concerns exhaustion of the rights conferred by a trade mark.

14. Article 8 of the same directive deals with the licensing of a trade mark.

15. Under Article 17 of Directive 2008/95, Directive 89/104 is repealed and references to the repealed directive are to be construed as references to Directive 2008/95.

16. Article 9 of Council Regulation (EC) No 207/2009 of 26 February 2009, on the Community trade mark (OJ 2009 L 78, p. 1), entitled 'Rights conferred by a Community trade mark', is worded as follows:

*'1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:*

*(a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;*

*(b) any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, 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;*

*(c) any sign which is identical with, or similar to, the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a*



reputation in the [European Union] and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.

2. The following, *inter alia*, may be prohibited under paragraph 1:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign on business papers and in advertising.

3. The rights conferred by a Community trade mark shall prevail against third parties from the date of publication of registration of the trade mark. Reasonable compensation may, however, be claimed in respect of acts occurring after the date of publication of a Community trade mark application, which acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court seised of the case may not decide upon the merits of the case until the registration has been published.'

17 Article 12 of that regulation, entitled 'Limitation of the effects of a Community trade mark', is worded as follows:

'A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
- (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practices in industrial or commercial matters.'

#### **Italian law**

18. Article 20 of Legislative Decree No 30 concerning the Industrial Property Code (decreto legislativo n. 30 — Codice della proprietà industriale) of 10 February 2005 (GURI No 52 of 4 March 2005), as amended by Legislative Decree No 131 of 13 August 2010 (decreto legislativo n. 131, GURI No 192 of 18 August 2010, 'the CPI'), entitled 'Rights conferred by registration', provides:

'1. The rights of a proprietor of a registered trade mark shall consist in entitlement to make exclusive use of that mark. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
- (b) any sign which is identical with or similar to a registered mark, in relation to goods or services which are identical or similar, where, because of the identity with or similarity between the signs and the identity or

similarity of the goods or services, there is a likelihood of confusion on the part of the public: the likelihood of confusion includes the likelihood of association between the two signs;

(c) any sign which is identical with or similar to the registered trade mark in relation to goods or services which are not even similar, where the registered trade mark has a reputation and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

2. In the cases referred to in paragraph 1, the proprietor of the trade mark shall be entitled *inter alia* to prevent all third parties from affixing the sign to the goods or to the packaging thereof; offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder; importing or exporting the goods under the sign; using the sign on business papers and in advertising.

3. A trader may affix his own trade mark to goods he offers for sale, but he may not remove the trade mark of the producer or of the trader from whom he obtained the products or goods.'

19. Article 21 of the CPI, entitled 'Limitations on a trade mark', provides:

'1. A registered trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade, where such use complies with the principles of professional probity:

- (a) his own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods; or
- (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

2. The trade mark must not be used in any way that is unlawful, and in particular in a way that would lead to a likelihood of confusion on the market with other signs known to be distinctive of the undertakings, goods or services of others, or, in any event, to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services, by reason of the way or context in which it is used, or to infringe a copyright or an industrial property right, or any other exclusive right of a third party.

3. It is prohibited for a registered trade mark to be used by anyone after the registration has been declared invalid where the ground for invalidity renders use of the trade mark unlawful.'

20 Article 241 of the CPI, entitled 'Exclusive rights in respect of component parts of a complex product', is worded as follows:

'Until Directive [98/71] is amended following a proposal by the Commission as provided for in Article 18 of that directive, the exclusive rights relating to component parts of a complex product may not be relied upon in order to prevent the manufacture and sale of such parts for the purpose of the repair of the

*complex product so as to restore its original appearance.'*

**The dispute in the main proceedings and the questions referred for a preliminary ruling**

21 Ford, a manufacturer of motor vehicles, and of accessories and replacement parts for such vehicles, identifies its products by affixing to them an oval sign, placed longitudinally, inside which is the name 'Ford' in fancy italic lettering, which may or may not be in colour (*'the Ford trade mark'*). That sign was registered as a trade mark both for vehicles and for replacement parts and accessories, including wheel covers. Ford affixes that trade mark, inter alia, to wheel covers mounted on the rims of the wheels of the cars it produces.

22 Wheeltrims, a supplier of replacement parts for motor vehicles, markets wheel covers, each of which shows a faithful reproduction of the trade mark of a number of motor vehicle manufacturers, including the Ford trade mark, without possessing the necessary authorisations. That company also produces and markets '*universal*' wheel covers, that is to say, covers which do not bear a trade mark, at prices lower than those which do bear a manufacturer's trade mark.

23 On 15 May 2013 Ford brought an action for infringement against Wheeltrims before the Tribunale di Torino (Turin District Court) seeking, first, that Wheeltrims be prohibited from producing and marketing wheel covers bearing the Ford trade mark and from using that trade mark without authorisation within the European Union and, secondly, that that company be ordered to pay compensation for the losses incurred by Ford. According to Ford, the unauthorised affixing of that trade mark to wheel covers marketed by Wheeltrims constitutes infringement of Ford's exclusive rights under Article 20 of the CPI and Article 9 of Regulation No 207/2009. Furthermore, such use is not justified by any of the exceptions contained in Article 21 of the CPI and Article 12 of Regulation No 207/2009, since it is not necessary to affix the Ford trade mark to wheel covers marketed by Wheeltrims to indicate the intended purpose of such a replacement part or for other descriptive purposes, within the meaning of those provisions.

24. Wheeltrims, contends that its use of the Ford trade mark is purely descriptive. It relies in that regard on the so-called '*repair clause*' derogation contained in Article 241 of the CPI, which provides for the right to reproduce components of a complex product that are protected by a trade mark, without obtaining the prior consent of the proprietor of that mark, where such reproduction will restore the original appearance of the complex product (*'the repair clause'*). The affixing by Wheeltrims of the Ford trade mark to the wheel covers it markets performs the function not of indicating the origin of such parts, but of identifying the manufacturer with reference to the product as a whole, namely the motor vehicle on which the wheel covers are mounted. That use of the Ford trade mark serves to reproduce, on the replacement part, an aesthetic and descriptive characteristic of the original part concerned, namely the

wheel cover, a characteristic that must be regarded as essential for the purposes of restoring the original appearance of the complex product constituted by the motor vehicle as a whole. If producers of replacement parts for motor vehicles were not able to use trade marks for that purpose free competition would be impeded on the market concerned.

25. The Tribunale di Torino (Turin District Court) considers that the unlawful conduct imputed to Wheeltrims constitutes a breach of the rights conferred by the Ford trade mark which is not justified on any of the grounds referred to in Article 21 of the CPI or Article 12 of Regulation No 207/2009. That court refers in that regard to the judgment in [Gillette Company and Gillette Group Finland](#) (C-228/03, EU:C:2005:177) and holds that it is not necessary for Wheeltrims to use the Ford trade mark to indicate to the public the intended purpose of the wheel covers in question or their compatibility with a '*Ford*' product, within the meaning of that judgment.

26. In the view of that court, there is, however, considerable uncertainty as to the scope of the repair clause. The Court of Justice has not yet ruled on the relationship between protection of the rights conferred by a trade mark and that clause. According to the referring court, Article 241 of the CPI and Article 110 of Regulation No 6/2002 are open to two different interpretations, over which Italian case-law is divided.

27. According to the first interpretation, the wording of those provisions and the place they occupy in the legislation containing them suggest that the repair clause allows a producer such as Wheeltrims to market replacement parts which are identical to the original part only where the production of those replacement parts is intended to restore a complex product to its original appearance and it involves only a derogation from the protection afforded to a design and not from any other right protecting industrial property, particularly a registered trade mark.

28. According to the second interpretation, the repair clause is a general clause and its scope should be understood in a broad sense, taking into account the need to restore complex products to their original appearance irrespective of the existence of other rights protecting industrial property, in particular those resulting from the registration of a trade mark. That is necessary in order to enable a manufacturer of replacement parts to operate on the market on an equal footing with the producer of the original parts, irrespective of the type of protection invoked by the latter, by allowing that manufacturer of replacement parts to reproduce the original part with all its aesthetic and functional features.

29. The referring court states that that second interpretation has been adopted by other Italian courts, in particular by the Corte di Appello di Milano (Court of Appeal, Milan).

30. The Tribunale di Torino (Turin District Court) points out that that interpretation was also adopted by the court which dismissed Ford's application for interim measures, based on the same facts as those

currently before the referring court. The court hearing that application held, in essence, that the repair clause contained in Article 241 of the CPI was effective against Ford, since that clause guarantees a fundamental economic right for manufacturers of replacement parts to produce a perfect alternative to the original component of a complex product.

31. In those circumstances the Tribunale di Torino (Turin District Court) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

*'(1) Is it compatible with EU law to interpret Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 as conferring on producers of replacement parts and accessories the right to use trade marks registered by third parties in order to allow the end purchaser to restore the original appearance of a complex product and, therefore, also when the proprietor of the trade mark applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product?'*

*(2) Is the repair clause set out in Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 to be interpreted as constituting a subjective right for third-party producers of replacement parts and accessories and, if so, does that subjective right include the right for such third parties to use the trade mark registered by another party in respect of replacement parts and accessories, by way of derogation from the rules laid down in Regulation No 207/2009 and Directive 89/104 and, therefore, when the proprietor of the trade mark also applies the distinctive sign in question to a replacement part or accessory intended to be mounted on the complex product in such a way that it is externally visible and thus contributes to the external appearance of the complex product?'*

#### **Consideration of the questions referred**

32. Pursuant to Article 99 of its Rules of Procedure, where the answer to the question referred for a preliminary ruling admits of no reasonable doubt, the Court may at any time, on a proposal from the Judge-Rapporteur and after hearing the Advocate General, decide to rule by reasoned order.

33. It is appropriate to apply that provision in the present reference for a preliminary ruling.

#### **Admissibility**

34. The German Government harbours doubts regarding the admissibility of the request for a preliminary ruling. The referring court, it submits, has not set out the reasons why it is necessary, in order to resolve the dispute in the main proceedings, to answer the question concerning the possibility of transposing the repair clause to the area of trade marks, since that clause is specific to the area of designs. The problem thus raised is therefore hypothetical.

35. The Court points out in this regard that, according to the settled case-law of the Court, questions on the interpretation of EU law referred by a national court in the factual and legislative context which that court is

responsible for defining and the accuracy of which is not a matter for the Court to determine enjoy a presumption of relevance. The Court may refuse to rule on a question referred for a preliminary ruling from a national court only where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (judgments in *Fish Legal and Shirley*, C-279/12, EU:C:2013:853, paragraph 30 and the case-law cited, and *Idrodinamica Spurgo Velox and Others*, C-161/13, EU:C:2014:307, paragraph 29).

36. In the present case, it is clear from the order for reference that the wheel covers at issue in the main proceedings, produced by Wheeltrims, reproduce the Ford trade mark, so, if the interpretation given in paragraph 27 of the present order were to be adopted, that producer of non-original parts would have to be found to have infringed that trade mark, whilst if the interpretation given in paragraph 28 of the present order were to apply instead, there would have been no infringement of that trade mark.

37. Consequently, it is by no means clear that the problem raised in the request for a preliminary ruling is hypothetical. That request is accordingly admissible.

#### **Substance**

38. By its questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 must be interpreted as allowing, by way of derogation from Directive 2008/95 and Regulation No 207/2009, a manufacturer of replacement parts and accessories for motor vehicles, such as wheel covers, to affix to its products a sign identical to a trade mark, registered *inter alia* for such products by a producer of motor vehicles, without obtaining the latter's consent, on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance.

39. It should be noted, first, that it is clear from the wording of Article 14 of Directive 98/71 and of Article 110 of Regulation No 6/2002 that those provisions impose certain limitations only on protection as designs, without any reference to protection as trade marks.

40. Secondly, Article 2 of Directive 98/71 provides that that directive applies only to design rights registered with certain national and international design offices and applications for registration of design rights. Furthermore, it is clear from Article 1 of Regulation No 6/2002, read in the light of recital 5 of that regulation, that the purpose of the latter is merely to create a Community design which is directly applicable in each Member State.

41. Thirdly, it is clear from recital 7 and Article 16 of Directive 98/71, and also from recital 31 and Article 96(1) of Regulation No 6/2002, that those measures of EU law apply without prejudice to any provisions of

that law or of the law of the Member State concerned relating, inter alia, to trade marks.

42. It follows from those considerations that Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 do not contain any derogation from the provisions of Directive 2008/95 and Regulation No 207/2009.

43. As regards the view expressed by the referring court, which is also the view of Wheeltrims, that the European Union's objective of protecting the system of undistorted competition requires the application of Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 to be extended to protection as trade marks, it should be noted that that objective was already taken into account by the EU legislature in Directive 2008/95 and Regulation No 207/2009. By limiting the effects of the rights which a trade mark owner derives from Article 5 of Directive 2008/95 or, in the case of a Community trade mark, Article 9 of Regulation No 207/2009, Article 6 of that directive and Article 12 of that regulation seek to reconcile the fundamental interests of trade mark protection with those of free movement of goods and freedom to provide services in the internal market in such a way that trade mark rights are able to fulfil their essential role in the system of undistorted competition which the Treaty seeks to establish and maintain (see, to that effect, inter alia, judgments in *BMW*, C-63/97, EU:C:1999:82, paragraph 62, and *Gillette Company and Gillette Group Finland*, C-228/03, EU:C:2005:177, paragraph 29).

44. Furthermore, it follows from the settled case-law of the Court that Articles 5 to 7 of Directive 2008/95 effect a complete harmonisation of the rules relating to the rights conferred by a trade mark and accordingly define the rights of proprietors of trade marks in the European Union. Consequently, save for the specific cases governed by Article 8 et seq. of that directive, a national court may not, in a dispute relating to the exercise of the exclusive right conferred by a trade mark, limit that exclusive right in a manner which exceeds the limitations arising from Articles 5 to 7 of the directive (judgment in *Martin Y Paz Diffusion*, C-661/11, EU:C:2013:577, paragraphs 54 and 55 and the case-law cited).

45. In the light of the foregoing, the answer to the questions referred is that Article 14 of Directive 98/71 and Article 110 of Regulation No 6/2002 must be interpreted as not allowing, by way of derogation from the provisions of Directive 2008/95 and Regulation No 207/2009, a manufacturer of replacement parts and accessories for motor vehicles, such as wheel covers, to affix to its products a sign identical to a trade mark registered for such products inter alia by a producer of motor vehicles, without obtaining the latter's consent, on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance.

#### Costs

46. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby orders:

Article 14 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs and Article 110 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as not allowing, by way of derogation from the provisions of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, a manufacturer of replacement parts and accessories for motor vehicles, such as wheel covers, to affix to its products a sign identical to a trade mark registered for such products inter alia by a producer of motor vehicles, without obtaining the latter's consent, on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance.

[Signatures]

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