

Court of Justice EU, 11 January 2024, Inditex v Buongiorno



## TRADE MARK LAW

Use of a trademark for the purpose of identifying or referring to goods or services is only allowed when such use is necessary to indicate the intended purpose of the product (a gift card)

- [Article 6\(1\)\(c\) of Directive 2008/95 must be interpreted as meaning that it covers use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark only when such use of the trade mark is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party](#)

[...]

14. Buongiorno is a provider of information services via the internet and mobile telephone networks. In 2010, that provider launched an advertising campaign for a paid subscription to a multimedia messaging service, marketed under the name ‘Club Blinko’. The subscription to that service allowed for the participation in a prize draw, in which one of the prizes was a ‘ZARA gift card’ worth EUR 1 000. After clicking on a banner to access the prize draw, on the next screen the subscriber was shown the ‘ZARA’ sign in a rectangle, reminiscent of the design of gift cards.

[...]

55. Furthermore, as the Advocate General also observed in point 79 of his Opinion, the Commission’s intention to extend the scope of the limitation previously contained in Article 6(1)(c) of Directive 2008/95 is apparent from the wording of recital 25 of the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final), which stated that ‘the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor’.

56. Consequently, the legislative history of Article 14(1)(c) of Directive 2015/2436 supports the interpretation that the scope of Article 6(1)(c) of Directive 2008/95 is more limited than that of Article 14(1)(c).

57. In the present case, it is for the national court, inter alia, to determine, taking into account all the circumstances of the case in the main proceedings, whether Buongiorno, by its advertising campaign launched for a subscription to one of its services, making it possible to participate in a prize draw, in which one of the prizes was a ‘ZARA gift card’, with the subscriber being shown on the screen the ‘ZARA’ sign in a rectangle, reminiscent of the design of gift cards, uses the ZARA trade mark within the meaning of Article 5 of Directive 2008/95, and, if that is the case, to assess, in the light of Article 6(1) of that directive, whether that use was necessary to indicate the intended purpose of a service which Buongiorno offered and, as appropriate, whether that use was made in accordance with honest practices in industrial or commercial matters.

Source: [ECLI:EU:C:2024:17 / C-361/22](#)

## Court of Justice EU, 11 January 2024

(C. Lycourgos, O. Spineanu-Matei (Rapporteur), J.-C. Bonichot, S. Rodin and L.S. Rossi)

JUDGMENT OF THE COURT (Fourth Chamber)

11 January 2024 <sup>(1)</sup>

(Reference for a preliminary ruling – Trade marks – Directive 2008/95/EC – Article 6(1)(c) – Limitation of the effects of the trade mark – Use of a trade mark to indicate the intended purpose of a product or service – Directive (EU) 2015/2436 – Article 14(1)(c))

In Case C-361/22,

REQUEST for a preliminary ruling under Article 267 TFEU from the Tribunal Supremo (Supreme Court, Spain), made by decision of 12 May 2022, received at the Court on 3 June 2022, in the proceedings  
Industria de Diseño Textil SA (Inditex)

v

Buongiorno Myalert SA,

THE COURT (Fourth Chamber),

composed of C. Lycourgos, President of the Chamber, O. Spineanu-Matei (Rapporteur), J.-C. Bonichot, S. Rodin and L.S. Rossi, Judges,

Advocate General: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Industria de Diseño Textil SA (Inditex), by F. Arroyo Álvarez de Toledo and R. Bercovitz Álvarez, abogados,

- Buongiorno Myalert SA, by J.J. Marín López, abogado, and A. Vázquez Pastor, procuradora,

- the Spanish Government, by I. Herranz Elizalde, acting as Agent,

- the European Commission, by P. Němečková and J. Samnadda, acting as Agents,

after hearing [the Opinion of the Advocate General at the sitting on 7 September 2023](#),

gives the following

**Judgment**

<sup>1</sup> Language of the case: Spanish.

1. This reference for a preliminary ruling concerns the interpretation of Article 6(1)(c) of 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).

2. The request has been made in proceedings between Industria de Diseño Textil SA (Inditex) and Buongiorno Myalert SA (*'Buongiorno'*) concerning an alleged infringement of rights conferred by a national trade mark owned by Inditex by reason of the alleged use by Buongiorno of a sign identical to that trade mark without the consent of Inditex.

#### **Legal context**

#### **European Union law**

#### **First Directive 89/104**

3. Article 5 of First Directive 89/104, entitled *'Rights conferred by a trade mark'*, stated, in paragraphs 1 and 2:

*'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, which 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.'*

4. Article 6 of First Directive 89/104, entitled *'Limitation of the effects of a trade mark'*, provided, in paragraph 1:

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

*...*

*(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.'*

5. First Directive 89/104 was repealed and replaced by 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), which came into force on 28 November 2008.

#### **Directive 2008/95**

6. Article 5 of Directive 2008/95, entitled *'Rights conferred by a trade mark'*, provided, in paragraphs 1 and 2:

*'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.'*

7. Article 6 of Directive 2008/95, entitled *'Limitation of the effects of a trade mark'*, provided, in paragraph 1:

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

*...*

*(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.'*

8. Directive 2008/95 was repealed and replaced, with effect from 15 January 2019, by Directive (EU) 2015/2436 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).

#### **Directive 2015/2436**

9. Article 14 of Directive 2015/2436, entitled *'Limitation of the effects of a trade mark'*, states, in paragraphs 1 and 2:

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

*...*

*(c) the 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 the 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.'*

#### **Spanish law**

10. In the version transposing Article 5 of First Directive 89/104, Article 34 of Ley 17/2001 de Marcas (Law 17/2001 on trade marks) of 7 December 2001 (BOE No 294 of 8 December 2001, p. 45579; ‘the Law on trade marks’) provided:

‘1. The registration of a trade mark shall confer on the proprietor exclusive rights to use it in the course of trade.

2. The registered trade mark proprietor shall be entitled to prohibit all third parties not having his or her 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, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services, gives rise to 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, goods or services which are not similar to those for which the trade mark is registered, where that trade mark is well known or has a strong reputation in Spain and the use of the sign without due cause may indicate a connection between those goods or services and the trade mark proprietor or, generally, where that use takes unfair advantage of, or is detrimental to, the distinctive character, well-known nature or strong repute of the registered trade mark.’

11. In its original version, Article 37(1)(c) of the Law on trade marks, which transposed Article 6(1)(c) of First Directive 89/104 into Spanish law, stated:

‘The rights conferred by the trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, the elements stated below, provided that that use is in accordance with honest practices in industrial or commercial matters:

...

(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.’

12. Article 37 of the Law on trade marks was amended by Real Decreto-ley 23/2018 de transposición de directivas en materia de marcas, transporte ferroviario y viajes combinados y servicios de viaje vinculados (Royal Decree-Law 23/2018 transposing the directives on trade marks, rail transport and package travel and associated travel services) of 21 December 2018 (BOE No 312 of 27 December 2001, p. 127305), in order to transpose Article 14(1)(c) of Directive 2015/2436.

13. In its amended version, Article 37(1) and (2) of the Law on trade marks provides:

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

...

(c) the 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 the 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.’

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

14. Buongiorno is a provider of information services via the internet and mobile telephone networks. In 2010, that provider launched an advertising campaign for a paid subscription to a multimedia messaging service, marketed under the name ‘Club Blinko’. The subscription to that service allowed for the participation in a prize draw, in which one of the prizes was a ‘ZARA gift card’ worth EUR 1 000. After clicking on a banner to access the prize draw, on the next screen the subscriber was shown the ‘ZARA’ sign in a rectangle, reminiscent of the design of gift cards.

15. Inditex brought an infringement action before the Juzgado de lo Mercantil No 2 de Madrid (Commercial Court No 2, Madrid, Spain) against Buongiorno claiming infringement of the exclusive rights conferred by a national trade mark protecting the ‘ZARA’ sign (‘the ZARA trade mark’). In support of that action, based on Article 34(2)(b) and (c) of the Law on trade marks, Inditex cited reasons relating, respectively, to the existence of a likelihood of confusion and to the advantage taken of, and detriment caused to, the trade mark’s reputation.

16. Buongiorno denied that rights conferred by the ZARA trade mark were infringed, arguing that it had made specific use of that sign not as a trade mark but to refer to one of the gifts offered to the winners of the prize draw. According to Buongiorno, such ‘referential’ use comes under the lawful uses of third parties’ distinctive signs provided for in Article 37 of the Law on trade marks, both in its original version and its amended version.

17. The court of first instance dismissed Inditex’s action. Having found that Buongiorno’s use of the ZARA trade mark did not constitute a ‘referential’ use covered by Article 37 of the Law on trade marks, in its original version, that court took the view that the conditions set out in Article 34(2)(b) and (c) of the Law on trade marks were not met.

18. Inditex brought an appeal against that decision before the Audiencia Provincial de Madrid (Provincial Court, Madrid, Spain), relying on an infringement of the trade mark under Article 34(2)(c) of the Law on trade marks. That appeal was dismissed by the Audiencia Provincial de Madrid (Provincial Court, Madrid), which found that the use of the ZARA trade mark by Buongiorno did not damage the reputation of that trade mark or take unfair advantage of that reputation.

19. Inditex brought an appeal on a point of law before the Tribunal Supremo (Supreme Court, Spain), which is the referring court.

20. That court states that Article 37(c) of the Law on trade marks, in its original version, applicable *ratione temporis* to the facts of the dispute in the main proceedings, constituted the transposition of Article

6(1)(c) of First Directive 89/104, the wording of which was not substantially amended by Directive 2008/95.

21. The referring court states that the current version of Article 37(1)(c) of the Law on trade marks transposes Article 14(1)(c) of Directive 2015/2436, that directive having repealed and replaced Directive 2008/95.

22. The referring court notes that Article 14(1)(c) of Directive 2015/2436 makes reference to general conduct, that is to say, ‘*identifying or referring to goods or services as those of the proprietor of that trade mark*’, followed by the expression ‘*in particular*’, which in turn is followed by a reference to more specific behaviour, that is to say, ‘*where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts*’.

Given that only the more specific conduct appeared in Article 6(1)(c) of First Directive 89/104, that court has doubts as to the scope of the reference to general conduct introduced in Article 14(1)(c) of Directive 2015/2436. That court asks whether that reference makes explicit something that was implicitly included in Article 6(1)(c) of First Directive 89/104 or whether the scope of ‘*referential*’ uses has been expanded by Directive 2015/2436.

23. In that respect, the referring court states that its question is highlighted by the interpretation of Article 6(1)(c) of First Directive 89/104 in the judgments of 17 March 2005, Gillette Company and Gillette Group Finland (C-228/03, EU:C:2005:177), and of 8 July 2010, Portakabin (C-558/08, EU:C:2010:416, paragraphs 63 and 64). That court considers that the Court of Justice appears to have restricted the scope of the limitation of the effects of the mark to the use necessary to indicate the intended purpose of a product, particularly when it explained that the objective pursued by Article 6(1)(c) of First Directive 89/104 is ‘*to enable providers of goods or services, which are supplementary to the goods or services offered by a trade mark proprietor, to use that mark in order to inform the public of the practical link between their goods or services and those of the proprietor of the mark*’.

24. The referring court indicates that the answer to the question referred for a preliminary ruling will affect the outcome of the dispute in the main proceedings. It states that, if it upholds the ground of appeal relating to the interpretation and application of the provision conferring protection on trade marks with a reputation, it will have to examine whether the use of the ZARA trade mark by Buongiorno is covered by the limitation provided for in Article 37(1)(c) of the Law on trade marks, in its original version, applicable *ratione temporis* to the dispute which is the subject of the appeal, that limitation being equivalent to the one provided for in Article 6(1)(c) of First Directive 89/104. In the referring court’s view, Buongiorno’s conduct could, however, align more with the wording of Article 14(1)(c) of Directive 2015/2436 than with the wording of Article 6(1)(c) of First Directive 89/104.

25. In those circumstances, the Tribunal Supremo (Supreme Court) decided to stay the proceedings and to

refer the following question to the Court of Justice for a preliminary ruling:

‘*Must Article 6(1)(c) of [First Directive 89/104] be interpreted as implicitly including within the limitation on trade mark rights the more general conduct now referred to in Article 14(1)(c) of [Directive 2015/2436], namely the use of “the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark”?*’

#### **Admissibility of the request for a preliminary ruling**

26. Inditex submits that the request for a preliminary ruling is inadmissible on two grounds.

27. In essence, Inditex states, in the first place, that, according to the referring court, the interpretation of Article 6(1)(c) of First Directive 89/104 is relevant only if the appeal can be upheld due to an infringement of Article 34(2)(c) of the Law on trade marks, that is to say, due to an infringement of a trade mark with a reputation. According to Inditex, the use of another person’s trade mark will not, in that case, be in accordance with ‘*honest practices in industrial or commercial matters*’ within the meaning of Article 37(1)(c) of the Law on trade marks, in its original version. Since the answer to the question is therefore not decisive for the purposes of the decision to be given by the referring court, the request for a preliminary ruling is inadmissible.

28. It should be noted that, according to the Court’s settled case-law, in the context of the cooperation between the Court and the national courts provided for in Article 267 TFEU, it is solely for the national court before which the dispute in the main proceedings has been brought, and which must assume responsibility for the subsequent judicial decision, to determine, in the light of the particular circumstances of the case, both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the question which it submits to the Court. Consequently, where the question submitted concerns the interpretation or validity of a rule of EU law, the Court is in principle bound to give a ruling (judgment of 16 March 2023, Beobank, C-351/21, EU:C:2023:215, paragraph 43 and the case-law cited).

29. It follows that a question referred for a preliminary ruling concerning EU law enjoys a presumption of relevance. The Court may refuse to rule on such a question only where it is quite obvious that the interpretation or assessment of the validity of an EU rule which 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 question submitted to it (judgment of 16 March 2023, Saatgut-Treuhandverwaltung (KWS Meridian), C-522/21, EU:C:2023:218, paragraph 26 and the case-law cited).

30. In the present case, it is apparent from the order for reference that the dispute in the main proceedings concerns the alleged use of a national trade mark by a third party without the authorisation of the proprietor of that mark and that the parties to that dispute disagree, in particular, as to the applicability of Article 37(1)(c) of

the Law on trade marks, in its original version. It is also apparent from the order for reference that the national court is uncertain as to the scope of Article 6(1)(c) of First Directive 89/104, which concerns the limitation of the effects of a national trade mark and which was transposed into Spanish law by Article 37.

31. In those circumstances, it is not self-evident that the interpretation of Article 6(1)(c) of First Directive 89/104 that is sought bears no relation to the actual facts of the main action or its purpose or that the problem raised is hypothetical.

32. Furthermore, in so far as Inditex argues that the question referred for a preliminary ruling is hypothetical because the conditions for lawful use laid down in Article 6(1)(c) of First Directive 89/104 coincide with the conditions for use relating to a trade mark with a reputation which its proprietor may oppose, in accordance with Article 5(2) of that directive, with the result that those two provisions are mutually exclusive, it must be stated that that line of argument concerns the interpretation of the last sentence of Article 6(1) of that directive. Inditex's argument therefore seeks to raise a question of interpretation of Article 6(1) which differs from the one raised by the referring court and it cannot be inferred from this that the question referred is manifestly hypothetical.

33. In the second place, Inditex submits that the referring court appears to take the view that the wording of Article 14(1)(c) of Directive 2015/2436 allows the use of the mark at issue in the main proceedings, on the ground that this concerns 'referential' use, unlike what may be inferred from a literal interpretation of Article 6(1)(c) of First Directive 89/104. It observes that the use of a trade mark 'for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark' is not in itself lawful but must, moreover, be in accordance with 'honest practices in industrial or commercial matters' and comply with the rules on exhaustion of trade mark rights in the case of transactions involving the goods of another person. Therefore, the answer to the question referred for a preliminary ruling cannot be useful, because it is insufficiently clear to settle the question of law raised in the dispute in the main proceedings.

34. The fact that, in order to resolve that dispute, the referring court may also be required to examine or take into consideration provisions other than those referred to in its question cannot lead to the conclusion that that question bears no relation to the subject matter of the dispute and is therefore inadmissible.

35. Accordingly, the two arguments put forward by Inditex to challenge the admissibility of the request for a preliminary ruling must be rejected.

36. In its observations, the European Commission, without, however, openly submitting that the request for a preliminary ruling is inadmissible, observes that the question of the interpretation of Article 6(1)(c) of Directive 2008/95, applicable *ratione temporis* to the dispute in the main proceedings, arises only if the use of the ZARA trade mark by Buongiorno constitutes use by third parties in the course of trade, prohibited by Article

5 of that directive. Since the national court of first instance does not appear to have erred in law in finding that the use of the ZARA trade mark was not covered by any of the cases of use of the trade mark provided for in Article 34 of the Law on trade marks, transposing into Spanish law Article 5 of First Directive 89/104, there is no need to examine whether the conditions in Article 37 of that law, transposing, in its original version, Article 6(1)(c) of Directive 2008/95, are satisfied.

37. In that regard, it should be noted that the Commission's line of argument implies that the Court is to take a view on the interpretation of Article 5 of Directive 2008/95. Therefore, it must be rejected for the same reasons as those set out in paragraph 34 above.

38. Consequently, the request for a preliminary ruling must be held to be admissible.

#### Consideration of the question referred

39. It is apparent from the order for reference that the facts giving rise to the dispute in the main proceedings occurred in 2010. Since First Directive 89/104 was repealed and replaced by Directive 2008/95, which entered into force on 28 November 2008, the provision applicable *ratione temporis* at the time of the facts in the main proceedings is Article 6(1)(c) of Directive 2008/95, and not Article 6(1)(c) of First Directive 89/104, the latter provision having been replaced by the former. It should, however, be pointed out that the wording of those two provisions is identical.

40. It is also apparent from the request for a preliminary ruling that the referring court does not express any doubts as to the fact that, under Article 6(1)(c) of Directive 2008/95, the use of the trade mark must relate to the identification of or reference to the goods or services 'as those of the proprietor of that trade mark'. It should be noted that, although the wording of Article 14(1)(c) of Directive 2015/2436 now explicitly expresses that requirement, the existence of that requirement was apparent from the case-law relating to the interpretation of Article 6(1)(c) of First Directive 89/104 (see to that effect, [judgments of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 33, and of [8 July 2010, Portakabin, C-558/08, EU:C:2010:416](#), paragraph 64).

41. Thus, the doubts expressed by the referring court as to the interpretation of Article 6(1)(c) of Directive 2008/95 stem from the different wording of the provision which replaced it, namely Article 14(1)(c) of Directive 2015/2436, as regards the extent of the use of the trade mark by a third party which the proprietor of that mark could not prohibit, in so far as that use does not relate solely to the indication of the intended purpose of a product marketed by that third party or to a service offered by that party.

42. Therefore, in order to give a useful answer to the referring court, it is necessary to reformulate the question to the effect that, by that question, that court asks, in essence, whether Article 6(1)(c) of Directive 2008/95 must be interpreted as meaning that it covers any use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in

accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark, or only use of that trade mark which is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.

43. It should be recalled that, according to settled case-law, the interpretation of a provision of EU law requires account to be taken not only of its wording, but also of the context in which it occurs, as well as the objectives and purpose pursued by the act of which it forms part. The legislative history of a provision of EU law may also reveal elements that are relevant to its interpretation (judgment of 16 March 2023, Towercast, C-449/21, EU:C:2023:207, paragraph 31 and the case-law cited).

44. According to the wording of Article 6(1)(c) of Directive 2008/95, the trade mark must not entitle its proprietor to prohibit a third party from using the mark in the course of trade where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

45. However, Article 14(1)(c) of Directive 2015/2436 states, first of all, that it covers the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, and then it reproduces the normative content of Article 6(1)(c) of Directive 2008/95, preceded by the expression ‘*in particular*’.

46. It is thus apparent from the literal comparison of those two provisions that the use that was capable of limiting the effects of a trade mark under Article 6(1)(c) of Directive 2008/95 now constitutes one of the situations of lawful use which the proprietor of a trade mark cannot oppose under Article 14(1)(c) of Directive 2015/2436.

47. It follows that the scope of Article 6(1)(c) of Directive 2008/95 is more limited than that of Article 14(1)(c) of Directive 2015/2436, in that Article 6(1)(c) covers only the use, in the course of trade, of the trade mark where that is necessary to indicate the intended purpose of a product or service.

48. That interpretation of Article 6(1)(c) of Directive 2008/95 is supported both by the objectives pursued by that directive, in particular the objective of that provision as defined by the case-law, and by the analysis of the legislative history of the provision which replaced it, namely Article 14(1)(c) of Directive 2015/2436.

49. In the first place, it is apparent from the case-law of the Court that, by limiting the effects of the rights derived from Article 5 of Directive 2008/95 by the proprietor of a trade mark, Article 6 of that directive seeks 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, [judgment of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 29).

50. As regards, more specifically, Article 6(1)(c) of Directive 2008/95, the Court stated that the application of that provision is not limited to situations in which it is necessary to use a trade mark to indicate the intended purpose of a product ‘*as accessories or spare parts*’ (see, to that effect, [judgment of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraph 32). The situations coming within the scope of Article 6(1)(c) must, however, be limited to those which correspond to the objective of that provision ([judgment of 8 July 2010, Portakabin, C-558/08, EU:C:2010:416](#), paragraph 64).

51. In that regard, the Court has stated that the objective pursued by Article 6(1)(c) of Directive 2008/95 is to enable providers of goods or services that are supplementary to the goods or services offered by a trade mark proprietor to use that mark in order to provide the public with comprehensible and full information on the intended purpose of the product which they market or the service which they offer or, in other words, as to the practical link between their goods or services and those of the proprietor of the mark (see to that effect, [judgments of 17 March 2005, Gillette Company and Gillette Group Finland, C-228/03, EU:C:2005:177](#), paragraphs 33 and 34, and of [8 July 2010, Portakabin, C-558/08, EU:C:2010:416](#), paragraph 64).

52. It follows that, in accordance with the case-law, the scope of Article 6(1)(c) of Directive 2008/95 refers to the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark only where that use is limited to the situation in which it is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party. In the context of Article 14(1)(c) of Directive 2015/2436, such a situation corresponds only to one of the situations in which the use of the mark may not be prohibited by its proprietor.

53. In the second place, given that, by its question, the referring court seeks guidance on the scope of Article 6(1)(c) of Directive 2008/95 in the light of the normative content of the provision which replaced it, the legislative history of the latter provision may reveal elements that are relevant to the interpretation of Article 6(1)(c).

54. In that regard, it is apparent from the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final) that it was ‘*considered appropriate to provide ... for an explicit limitation covering referential use in general*’. Thus, as the Advocate General observed, in essence, in point 78 of his Opinion, the term ‘*appropriate to provide ... for*’ indicated the Commission’s intention to propose the introduction of a limitation of the effects of a trade mark covering referential use in general and to extend the scope of the limitation now provided for in Article 14(1)(c) of Directive 2015/2436, and not to propose merely to clarify or specify the parameters of Article 6(1)(c) of First Directive 89/104.

55. Furthermore, as the Advocate General also observed in point 79 of his Opinion, the Commission’s intention

to extend the scope of the limitation previously contained in Article 6(1)(c) of Directive 2008/95 is apparent from the wording of recital 25 of the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final), which stated that *'the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor'*.

56. Consequently, the legislative history of Article 14(1)(c) of Directive 2015/2436 supports the interpretation that the scope of Article 6(1)(c) of Directive 2008/95 is more limited than that of Article 14(1)(c).

57. In the present case, it is for the national court, *inter alia*, to determine, taking into account all the circumstances of the case in the main proceedings, whether Buongiorno, by its advertising campaign launched for a subscription to one of its services, making it possible to participate in a prize draw, in which one of the prizes was a 'ZARA gift card', with the subscriber being shown on the screen the 'ZARA' sign in a rectangle, reminiscent of the design of gift cards, uses the ZARA trade mark within the meaning of Article 5 of Directive 2008/95, and, if that is the case, to assess, in the light of Article 6(1) of that directive, whether that use was necessary to indicate the intended purpose of a service which Buongiorno offered and, as appropriate, whether that use was made in accordance with honest practices in industrial or commercial matters.

58. In the light of all the foregoing considerations, the answer to the question referred is that Article 6(1)(c) of Directive 2008/95 must be interpreted as meaning that it covers use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark only when such use of the trade mark is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.

#### Costs

59. 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 (Fourth Chamber) hereby rules:

**Article 6(1)(c) 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 must be interpreted as meaning that it covers use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark only when such use of the trade mark is**

**necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.**

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## OPINION OF ADVOCATE GENERAL M. SZPUNAR

OPINION OF ADVOCATE GENERAL  
SZPUNAR

delivered on 7 September 2023 (1)

Case C-361/22

Industria de Diseño Textil SA (Inditex)

v

Buongiorno Myalert SA

(Request for a preliminary ruling from the Tribunal Supremo (Supreme Court, Spain))

(Reference for a preliminary ruling – Trade marks – Directive 89/104/EEC – Directive 2008/95/EC – Limitation of the effects of a trade mark – Use of a trade mark to indicate the intended purpose of a product or service – Conditions on which such use is lawful)

### I. Introduction

1. The dispute in the main proceedings, which gave rise to the present reference for a preliminary ruling, is between a provider of information services via the internet and mobile telephony, and the proprietor of the trade mark ZARA on account of an alleged infringement of the rights conferred by that mark. In the course of an advertising campaign, the information services provider had offered free entry into a prize draw, one of the prizes of which was a ZARA gift card, an image of which had been shown as part of that advertising campaign. The trade mark proprietor brought an action for infringement against that services provider, claiming that the latter had taken advantage of, and acted to the detriment of, the trade mark's reputation.

2. Accordingly, the dispute in the main proceedings might stand at the crossroads between trade mark law and the law on unfair competition. However, the question referred for a preliminary ruling in the present case concerns the directives on trade mark law only.

3. In that regard, the proprietor of a trade mark registered in one of the Member States is entitled to prevent all third parties from making certain uses of the signs where those uses infringe his or her intellectual property rights, having regard to the conditions laid down in those directives.

4. However, the proprietor's exclusive rights are not absolute. For instance, Article 6(1)(c) of Directives 89/104/EEC (2) and 2008/95/EC (3) provided that the proprietor could not prohibit a third party from using, in the course of trade, the trade mark where it was necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts. In 2015, Directive 2008/95 was replaced by Directive (EU) 2015/2436, (4) Article 14(1)(c) of which appears to introduce, at the very least in literal terms, a broader limitation of the effects of a trade mark than that in Article 6(1)(c) of Directives 89/104 and 2008/95.

5. Considering the conduct at issue in the dispute in the main proceedings to fall rather within the scope of that broader limitation, the referring court asks the Court, in the question referred for a preliminary ruling, whether Article 14(1)(c) of Directive 2015/2436 in fact amended the scope of the limitation at issue or whether that provision concerns uses already implicitly covered by Article 6(1)(c) of Directives 89/104 and 2008/95.

6. Whilst the request for a preliminary ruling refers to Article 6(1)(c) of Directives 89/104 and 2008/95, the significance of the answer to be given to that question as it is worded far exceeds, however, the system of national trade marks.

7. First, that answer will also affect the system of European Union trade marks based on Regulation (EC) No 207/2009, (5) which was replaced from 1 October 2017 by Regulation (EU) 2017/1001. (6) In the intervening period, Regulation No 207/2009 was amended by Regulation (EU) 2015/2424. (7) A similar limitation to that contained in Article 6(1)(c) of Directive 89/104 appeared in Article 12(c) of Regulation No 207/2009. Regulation 2015/2424 amended the latter provision and reproduced, in essence, the wording of Article 14(1)(c) of Directive 2015/2436.

8. Second, according to settled case-law of the Court, the limitation of the effects of the rights of a trade mark proprietor provided for by the EU legislature seeks to reconcile the fundamental interests of trade mark protection with those of free movement of goods and the 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. (8)

## II. Legal framework

### A. European Union law

#### 1. Directive 89/104

9. Article 5 of Directive 89/104, entitled ‘Rights conferred by a trade mark’, stated:

‘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, which 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.
- ...’

10. Article 6 of Directive 89/104, entitled ‘Limitation of the effects of a trade mark’, provided, in paragraph 1 thereof:

‘1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, ...

- (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. Directive 2008/95

11. Directive 89/104 was repealed and replaced by Directive 2008/95, which entered into force on 28 November 2008. Directive 2008/95 made no substantive amendments to Article 5(2) or Article 6(1)(b) and (c) of that directive.

#### 3. Directive 2015/2436

12. Directive 2015/2436, which repealed and replaced Directive 2008/95 with effect from 15 January 2019, provides, in Article 14 thereof, entitled ‘Limitation of the effects of a trade mark’:

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

- (c) the 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 the 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. Spanish law

13. Article 34 of Ley 17/2001 de Marcas (Law 17/2001 on trade marks) of 7 December 2001 (BOE No 294 of 8 December 2001, p. 45579), in the version applicable to the facts of the dispute in the main proceedings (‘the Law on trade marks’), transposed Article 5 of Directive 89/104 into the Spanish legal order. Article 34 of the Law on trade marks provided:

‘1. The registration of a trade mark shall confer on the proprietor exclusive rights to use it in the course of trade.



2. The registered trade mark proprietor shall be entitled to prohibit all third parties not having his or her 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, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services, gives rise to 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, goods or services which are not similar to those for which the trade mark is registered, where that trade mark is well known or has a strong reputation in Spain and the use of the sign without due cause may indicate a connection between those goods or services and the trade mark proprietor or, generally, where that use takes unfair advantage of, or is detrimental to, the distinctive character, well-known nature or strong repute of the registered trade mark.'

14. Article 37(1)(c) of the Law on trade marks, which transposed Article 6(1)(c) of Directive 89/104 into Spanish law, provided:

'1. The rights conferred by the trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, the elements stated below, provided that that use is in accordance with honest practices in industrial or commercial matters:

...

(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part.'

15. Following the entry into force of Directive 2015/2436, the Spanish legislature amended Article 37(1)(c) of the Law on trade marks, which reads as follows:

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

...

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

### III. The facts of the main proceedings

16. Buongiorno Myalert SA ('Buongiorno') is an undertaking which, in 2010, provided information services via the internet and mobile telephony. In that same year, it launched an advertising campaign for subscription to a multimedia messaging service via SMS marketed under the name 'Club Blinko', as part of which it offered free entry into a prize draw in which one of the prizes was a ZARA gift card in the value of EUR 1 000. After clicking on a banner to access the draw, on the next screen the subscriber was shown the 'ZARA' sign in a rectangle, reminiscent of the design of gift cards.

17. The company Industria de Diseño Textil, SA ('Inditex') brought an action for infringement against

Buongiorno, claiming infringement of the exclusive rights conferred by a national trade mark protecting the 'ZARA' sign. In support of that action, based on Article 34(2)(b) and (c) of the Law on trade marks, Inditex cited reasons relating, respectively, to the existence of a likelihood of confusion and to the advantage taken of, and detriment caused to, the trade mark's reputation.

18. Buongiorno denied that the rights conferred by the ZARA trade mark were infringed, arguing that it had made specific use of that sign not as a trade mark but to refer to one of the gifts offered to the winners of the prize draw. According to Buongiorno, such 'referential' use comes under the lawful uses of third parties' distinctive signs provided for in Article 37 of the Law on trade marks.

19. The court of first instance rejected Inditex's claims. Having found that Buongiorno's use of the ZARA trade mark did not constitute a 'referential' use covered by Article 37 of the Law on trade marks, that court took the view that the conditions set out in Article 34(2)(b) and (c) of the Law on trade marks were not met.

20. Inditex appealed against that decision, relying on an infringement of the trade mark under Article 34(2)(c) of the Law on trade marks. That appeal was dismissed by the court of second instance, which found that the use of the ZARA trade mark did not damage the reputation of that trade mark or take unfair advantage of that reputation.

21. Inditex brought an appeal on a point of law before the Tribunal Supremo (Supreme Court, Spain), the referring court in the present case.

22. Given the use in Article 14(1)(c) of Directive 2015/2436 of the expression 'in particular', which links the more general conduct ('identifying or referring to goods or services as those of the proprietor of that trade mark'), which did not appear in Article 6(1)(c) of Directive 89/104, to the more specific conduct referred to in the latter directive (where use of the trade mark 'is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts'), the referring court has doubts as to the scope of that passage introduced in Article 14(1)(c) of Directive 2015/2436. It asks whether this makes explicit something that was implicitly included in Article 6(1)(c) of Directive 89/104 or whether the scope of 'referential' uses has been expanded. In the referring court's view, Buongiorno's conduct is more in line with the current wording of Article 14(1)(c) of Directive 2015/2436 than with that of Article 6(1)(c) of Directive 89/104.

23. The referring court explains that it invited the parties to the main proceedings to submit their observations on the relevance of a reference for a preliminary ruling concerning the interpretation of Article 6(1)(c) of Directive 89/104 'in the event that the ground of appeal founded on infringement of Article 34(2)(c) of the Law on trade marks should succeed, making it necessary to review whether the limitation of the effects of a trade mark established in Article 37[(1)](c) of that law applies'.

**IV. The question referred for a preliminary ruling and the procedure before the Court**

24. It was in those circumstances that the Tribunal Supremo (Supreme Court), by order of 12 May 2022, received at the Court on 3 June 2022, decided to stay the proceedings and to refer the following question to the Court for a preliminary ruling:

‘Must Article 6(1)(c) of Directive [89/104] be interpreted as implicitly including within the limitation on trade mark rights the more general conduct now referred to in Article 14(1)(c) of Directive [2015/2436], namely the use of “the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark”?’

25. Written observations were lodged by the parties to the main proceedings, the Spanish Government and the European Commission. No hearing was held.

## V. Analysis

### A. Delimitation of the question referred for a preliminary ruling

26. By the question referred for a preliminary ruling, the referring court seeks to ascertain, in essence, whether Article 6(1)(c) of Directive 2008/95 is to be interpreted as meaning that the use, in the course of trade, of the trade mark ‘for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark’, to which reference is now made in Article 14(1)(c) of Directive 2015/2436, falls within the scope of that first provision.

27. As a preliminary point, in view of the comments made by the parties in their written observations, it seems to me to be relevant to set out the following considerations vis-à-vis the delimitation of the question referred for a preliminary ruling.

28. In the first place, it should be observed that the facts of the main proceedings occurred in 2010, whereas the question referred for a preliminary ruling makes reference to Article 6(1)(c) of Directive 89/104. That directive was replaced by Directive 2008/95, which entered into force on 28 November 2008. It is true that the latter directive did not amend Article 6(1)(c) of Directive 89/104, but it does nevertheless appear to be applicable *ratione temporis* in the dispute in the main proceedings. I will therefore refer to Directive 2008/95 and to Article 6(1)(c) thereof in this Opinion, and I propose that the question referred for a preliminary ruling is reworded to that effect. (9)

29. In the second place, it might be tempting to reword the question referred for a preliminary ruling on the assumption that, by that question, the referring court seeks to ascertain whether Article 6(1)(c) of Directive 2008/95 is to be interpreted as meaning that conduct by which a third party uses the trade mark in the context of an advertising campaign to refer to a prize which one of its customers can win in a prize draw can come under that provision. However, the answer to the question as worded by the referring court will be of use to it in resolving the dispute brought before it, and there is therefore no need to take over the role of that court and reword that question.

30. In the third place, Buongiorno argues that the question referred for a preliminary ruling makes no reference whatsoever to the limitation of the effects of a

trade mark provided for in Article 6(1)(b) of Directive 2008/95, according to which the proprietor of a trade mark cannot prohibit a third party from using, in the course of trade, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of the service, or other characteristics of goods or services. Buongiorno also states that it previously relied on that provision at first instance to defend the legality of its conduct. It is therefore of the view that, in order to provide a useful and exhaustive answer to the referring court, the Court must also examine the question referred for a preliminary ruling from the perspective of that provision.

31. Since the referring court does not express doubts as to the interpretation of Article 6(1)(b) of Directive 2008/95, nor do I propose that the Court reword the question referred for a preliminary ruling in that respect so as to interpret that provision too. The right to determine the questions to be put to the Court devolves upon the national court alone and the parties to the main proceedings may not change their tenor. (10)

32. That said, for the sake of completeness, I must observe, in the first place, that Article 6(1)(b) of Directive 2008/95 can apply only if Buongiorno’s conduct is regarded as a ‘use’ within the meaning of Article 5 of that directive. As that point appears to be contentious *inter alia* from the perspective of the application of Article 6(1)(c) of the directive, I will return to it in my analysis of the substance of the question referred for a preliminary ruling. (11)

33. In the second place, as the Court has held, Article 6(1)(b) of Directive 2008/95 gives expression to the requirement of availability. In order for a third party to be able to rely on the requirement of availability underlying that provision, the indication used by it must relate to one of the characteristics of the goods marketed or the service provided by that third party. (12) Furthermore, the Court has also held that the affixing of a sign which is identical to a trade mark registered, *inter alia*, in respect of motor vehicles to scale models of that make of vehicle in order to reproduce those vehicles faithfully is not intended to provide an indication as to a characteristic of those scale models, but is merely an element in the faithful reproduction of the original vehicles. (13)

34. In the present case, a third party’s display of a proprietor’s trade mark in the context of an advertising campaign to refer to a prize that that third party’s customers can win in a prize draw perhaps amounts to indicating a characteristic of the proprietor’s product rather than a characteristic of the service of providing multimedia content offered by the third party. Even assuming that Inditex marketed gift cards with the characteristics shown in Buongiorno’s advertising campaign, the reproduction of those gift cards in that advertising campaign cannot be regarded as being intended to provide an indication as to a characteristic of the service provided by Buongiorno.

35. In the fourth place, given the facts as set out by the referring court, the question might also arise as to

whether Buongiorno's conduct came within the ambit of Article 7 of Directive 2008/95, entitled 'Exhaustion of the rights conferred by a trade mark'. Under that provision, the trade mark did not entitle the proprietor to prohibit its use in relation to goods which had been put on the market in the Community under that trade mark by the proprietor or with his or her consent, unless there were legitimate reasons for him opposing further commercialisation of the goods.

36. Without prejudice to the correct answer to that question, I am bound to observe, first of all, that the referring court does not request the interpretation of Article 7 of Directive 2008/95. Next, Inditex claims that, in the absence of an initial sale of the product, that is to say, the gift card, or an initial placement on the market with its consent, its trade mark rights were not exhausted when its trade mark was used by Buongiorno. Lastly, Inditex submits, in a different context, that it does not market, and did not market at the time, gift cards with the characteristics shown in the advertising campaign. The product in question therefore does not exist.

37. In view of the foregoing, I propose to analyse the legal problem raised by the question referred for a preliminary ruling exclusively from the perspective of the relationship between Article 6(1)(c) of Directive 2008/95 and Article 14(1)(c) of Directive 2015/2436. However, before doing so, consideration must be given to the arguments raised by the parties concerning the admissibility of the question referred.

#### **B. Admissibility**

38. Inditex raises two arguments by which it claims that the present reference for a preliminary ruling is inadmissible.

39. In the first place, Inditex notes that, as the referring court itself observes, (14) the interpretation of Article 6(1)(c) of Directive 2008/95 can be of use to that court only if the appeal on a point of law, upon which the referring court must give a ruling, is upheld on account of infringement of Article 34(2)(c) of the Law on trade marks, which, as the national provision by which the Spanish legislature exercised the right provided for in Article 5(2) of that directive, affords special protection to trade marks 'with a reputation'. However, according to Inditex, the use of a sign identical with or similar to a trade mark with a reputation covered by the latter provision is on no account in accordance with honest practices in industrial or commercial matters, and therefore a third party using that trade mark cannot rely on Article 6(1)(c) of the directive. I would add, even though this means pre-empting my later considerations, that the argument raised by Inditex to claim that the question referred for a preliminary ruling is inadmissible can also be viewed, on the merits, as an argument relating to the interpretation of the provisions cited above. (15)

40. In the second place, Inditex claims that, in any event, the answer to the question referred for a preliminary ruling cannot be useful, because it is insufficiently clear to settle the question of law raised in the dispute in the main proceedings. The 'referential' use of a trade mark is in itself unlawful. To be lawful, such

use would have to be made 'in accordance with honest practices in industrial or commercial matters' and comply with the rules on the exhaustion of trade mark rights in the case of transactions relating to another party's goods.

41. In that regard, the argument that a question referred for a preliminary ruling is based on an assumption on which the referring court must still rule, and therefore that question must be regarded as being premature and hypothetical, (16) or the argument that the answer to be given to a question referred for a preliminary ruling would not be sufficient to resolve the dispute in the main proceedings, (17) does not automatically lead to the conclusion that that question is inadmissible.

42. It is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case the relevance of the question which it submits to the Court. Where the question referred concerns the interpretation or the validity of a rule of EU law, the Court is in principle required to give a ruling. It follows that a question referred for a preliminary ruling concerning EU law enjoys a presumption of relevance. The Court may refuse to rule on such a question 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. (18)

43. That is not the case here. It is true that, in order to rule on the appeal on a point of law, the referring court must undertake assessments before assessing the legal issue raised by the question referred for a preliminary ruling (use of a trade mark with a reputation, covered by Article 5(2) of Directive 2008/95) and, potentially, make further assessments after so doing (use in accordance with honest practices in industrial or commercial matters). However, it is not obvious that Article 6(1)(c) of Directive 2008/95 is not applicable in a situation in which a trade mark appears in the context of a third party's advertising campaign in order to refer to a prize which a customer of that third party can win in a prize draw.

44. Furthermore, without expressly questioning the admissibility of the question referred for a preliminary ruling, the Commission argues that, since it appears that the national court of first instance did not err in law in finding that the use of the ZARA trade mark was not covered by any of the cases of 'use of the trade mark' provided for in Article 34 of the Law on trade marks, by which the Spanish legislature transposed Article 5 of Directive 89/104, there is no need to examine whether the conditions laid down in Article 37 of the Law on trade marks and in Article 6(1)(c) of Directive 2008/95 are satisfied in the present case. It is, however, my view that the Commission's argument cannot render the question referred for a preliminary ruling inadmissible

for the same reasons as those set out in points 41 and 42 of this Opinion in relation to Inditex's arguments.

45. Although I am receptive to the arguments put forward by the Commission in support of its position that Buongiorno's conduct did not constitute use, within the meaning of Article 5 of Directive 89/104, it must be recalled that the referring court does not express any doubts as to the interpretation of that provision, and therefore this cannot lead to the conclusion that the question referred for a preliminary ruling is inadmissible. (19)

46. It follows that the question referred is admissible.

### C. Substance

47. Before turning to the legal issue raised by the question referred for a preliminary ruling, I will briefly consider the point upon which the parties rely in their written observations regarding the classification of Buongiorno's conduct as 'use of a sign which is identical with, or similar to, a trade mark with a reputation', which comes under Article 5(2) of Directive 89/104.

48. The interest presented by that analysis is twofold. First, for Article 6 of Directive 2008/95 to be applicable, a third party must make a use of a sign which the proprietor can oppose, in accordance with Article 5 of that directive. Second, Inditex's argument regarding the inadmissibility of the question referred for a preliminary ruling can also be understood to be a substantive argument, namely that Article 6(1)(c) of the directive can on no account apply in the case of a use relating to a trade mark with a reputation, which is covered by Article 5(2) of the same directive.

#### 1. Use of a trade mark with a reputation, as provided for in Article 5(2) of Directive 2008/95

49. The question whether the conduct of a third party in relation to a trade mark can be lawful in the light of the rule laid down in Article 6(1)(c) of Directive 2008/95 arises only if that conduct is deemed to constitute a use, within the meaning of Article 5 of that directive. (20)

50. Here, the referring court submits its question for a preliminary ruling in the event that it were to uphold the ground of the appeal on a point of law alleging infringement of Article 34(2)(c) of the Law on trade marks, by which the Spanish legislature exercised the right provided for in Article 5(2) of Directive 2008/95. In other words, before ruling on the argument based on referential use, the referring court would have deemed Buongiorno's conduct to constitute a use of a sign identical with or similar to the trade mark with a reputation, which without due cause takes unfair advantage of, or is detrimental to, the reputation of the trade mark.

51. As I have already noted in point 39 of this Opinion, Inditex's argument concerning the hypothetical nature of the question referred for a preliminary ruling can be understood to mean that, in that company's view, a trade mark proprietor's right to oppose the use referred to in Article 5(2) of Directive 2008/95 is by no means circumscribed by the limitation of the effects of a trade mark, provided for in Article 6(1)(c) of that directive.

52. In that regard, Inditex claims, first, that a use of the trade mark by way of a reference must be, as required

by Article 6(1)(c) of Directive 2008/95, read in conjunction with Article 6(1), in fine, of that directive, made in accordance with honest practices in industrial or commercial matters. According to Inditex, the Court held, in the judgment in *Gillette Company and Gillette Group Finland*, (21) that use of a trade mark is not in accordance with such honest practices *inter alia* if it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute. It states, further, that the use of a trade mark with a reputation, as referred to in Article 5(2) of the directive, consists in a use of a sign which is identical with or similar to the trade mark with a reputation which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

53. In those circumstances, in Inditex's view, the conditions for lawful use laid down in Article 6(1)(c) of Directive 2008/95 mirror those for use in relation to a trade mark with a reputation which may be opposed by that mark's proprietor, in accordance with Article 5(2) of that directive, such that those two provisions are mutually exclusive. It concludes from that fact that a third party who makes use of a trade mark with a reputation, if that use is unlawful under Article 5(2) of the directive, cannot plead 'referential' use.

54. Although I am sympathetic to that line of argument, it is my view that considerations of scheme and case-law preclude such a strict interpretation which, from the outset and in all cases, rules out the joint applicability of those two provisions.

55. Before setting out those considerations, I must observe that there is nothing to suggest that, in exercising the right provided for in Article 5(2) of Directive 2008/95, the Spanish legislature sought to exclude such joint applicability of those provisions. Accordingly, there is no need to address the question whether, in the course of such exercise, the national legislature can decide not to make the rights of the proprietor of a trade mark with a reputation subject to the limitation provided for in Article 6(1)(c) of that directive.

#### (a) The relationship between Article 5(2) and Article 6(1)(c) of Directive 2008/95

56. As the Court has held, the protection conferred by Article 5(1)(a) of Directive 2008/95 is intended solely to enable the trade mark proprietor to protect its specific interests as proprietor of the mark, that is to say, to ensure that the trade mark can fulfil its functions. From this the Court has concluded, in the first place, that the exercise of the exclusive right conferred by the trade mark must be reserved to cases in which a third party's use of the sign adversely affects, or is liable adversely to affect, the functions of the trade mark. Article 5(2) of that directive, however, establishes, for the benefit of trade marks with a reputation, a wider form of protection than that laid down in Article 5(1). The specific condition of that protection consists of a use without due cause of a sign identical with or similar to a registered trade mark which takes, or would take, unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark. (22)

57. Accordingly, in the second place, unlike the situation covered by Article 5(1)(b) of Directive 2008/95, the exercise of the right of the proprietor of a mark with a reputation is not conditional upon there being a likelihood of confusion on the part of the relevant section of the public. (23)

58. Although Article 5(2) of Directive 2008/95 distinguishes between three different cases of injury, that is to say, detriment to the distinctive character of the trade mark, detriment to the repute of that mark and unfair advantage taken of the distinctive character or the repute of the mark, (24) in the present case Inditex submitted, in support of its action for infringement, that Buongiorno had taken advantage of, and acted to the detriment of, the reputation of its mark.

59. In that regard, the Court has held that the examination of whether there has been an infringement under Article 9(1)(c) of Regulation No 207/2009 – and, by extension, under Article 5(2) of Directive 2008/95 – must be based on a global assessment, taking into account all the factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. (25)

60. Furthermore, if the proprietor of the trade mark with a reputation has succeeded in demonstrating that one of the infringements referred to in Article 5(2) of Directive 2008/95 has occurred, it is for the third party which made use of a sign identical with or similar to the trade mark with a reputation to establish that there is due cause for the use of such a sign. The claim by a third party that there is due cause for such use obliges the proprietor of that mark to tolerate the use of that sign. (26)

61. *Prima facie*, the claim that there is due cause for the use of a sign which is identical with or similar to a trade mark with a reputation has the same outcome as the claim that the effects of a trade mark are limited, as provided for in Article 6(1) of Directive 2008/95. In both cases, the proprietor must tolerate the use of a sign identical with or similar to its trade mark.

62. That being said, for a third party to be able to rely on the limitation of the effects of a trade mark, as laid down in Article 6(1)(c) of Directive 2008/95, the use of a sign must satisfy the conditions set out in that provision and, as required by Article 6(1), in fine, of that directive, be in accordance with honest practices in industrial or commercial matters.

63. In those circumstances, it is necessary to define the scope of the concepts of 'due cause' and of 'use in accordance with honest practices in industrial or commercial matters', which are used respectively in Article 5(2) and Article 6(1), in fine, of Directive 2008/95, in order to determine whether the lack of 'due cause', within the meaning of that first provision, means that the use is in any event not 'honest', within the meaning of that second provision.

64. In that regard, there is in the first place, in literal terms, a difference between those two concepts, and

therefore it cannot be assumed that they share the same meaning.

65. In the second place, from a schematic perspective, Article 6(1)(c) of Directive 2008/95 does not contain any reservation capable of precluding that provision from being applicable in the case of an infringement of a trade mark with a reputation, as covered by Article 5(2) of that directive. It could admittedly be argued that such a reservation was not inserted into the wording of the directive because the limitation laid down in that first provision must necessarily be transposed into national law, whereas it is for each Member State to decide whether it wishes to exercise the right provided for in the second. However, provisions similar to Article 5(2) and Article 6(1)(c) of the directive are included in the system of European Union trade marks, which affords no leeway to the Member States. (27)

66. In the third place, first, the condition of 'honest use' constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor. (28) Second, the concept of 'due cause' is intended to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 2008/95 and in the light of the enhanced protection enjoyed by the mark concerned, of the interests of the third party using that sign. (29) The concept of 'due cause' may not include only objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical with or similar to the mark with a reputation. (30)

67. Although there may be an overlap between some of the factors to be taken into account when assessing each of those two conditions, the approach adopted in making those assessments is not the same. Put simply, the 'due cause' condition is focussed more on the perspective of a third party and his or her interests, whereas that of 'honest use' adopts the proprietor's point of view. Taking that observation further, the significance attached to a factor taken into account as part of those two assessments can also differ.

68. In the fourth place, the same is true of factors which, on the one hand, form one of the three cases of infringement of the trade mark with a reputation, laid down in Article 5(2) of Directive 2008/95, and which, on the other hand, are taken into account when assessing the condition of 'honest use' within the meaning of Article 6(1), in fine, of that directive. By way of illustration, as Inditex observes, the Court did indeed find, in the judgment in *Gillette Company and Gillette Group Finland*, (31) that the use of a sign is not in accordance with honest practices *inter alia* if it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute. However, under Article 5(2) of the directive, in order to find that a trade mark with a reputation has been infringed, it is sufficient for a third party to take unfair advantage of the reputation of that mark, without its conduct affecting the value of the mark.

69. Moreover, the lessons that can be taken from the case-law of the Court are likewise a strong indication

that the limitation provided for in Article 6(1)(c) of Directive 2008/95 can also apply where the proprietor can, a priori, rely on a national provision adopted in exercise of the right laid down in Article 5(2) of that directive.

**(b) Relevant case-law**

70. The Court was asked, in the context of the case which gave rise to the judgment in *Adam Opel*, (32) about Article 5(1)(a) of Directive 89/104. First, while the Court initially took the view that, having regard to the circumstances of the case in the main proceedings, the referring court had also to be given an interpretation of Article 5(2) of that directive, it did however leave to the referring court the assessment of a factual nature as to whether the use at issue constituted use without due cause which takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark, as a registered trade mark. (33) Next, the Court proceeded to interpret Article 6(1)(b) of the directive, also referring to Article 6(1)(c) thereof. (34) I must point out, in that regard, that both the limitation provided for in Article 6(1)(b) of Directive 89/104 and that provided for in Article 6(1)(c) thereof are subject to the condition that the use is made in accordance with honest practices in industrial or commercial matters.

71. Similarly, in the judgment in *adidas and adidas Benelux*, (35) as it was not disputed that the case concerned a trade mark with a reputation, the Court interpreted, first, Article 5(2) of Directive 89/104 and, second, without any reservation, Article 6(1)(b) of that directive. (36)

72. In that same vein, with regard to the limitation of the effects of a trade mark provided for in Article 6(1)(a) of Directive 2008/95, which is also subject to the condition of honest use, the Court held, in the judgment in *Céline*, (37) that the satisfaction of that condition must be assessed taking into account, inter alia, whether the trade mark concerned enjoys a certain reputation in the Member State in which it is registered and its protection is sought, from which the third party might profit in marketing his or her goods or services. On the basis of that judgment, it can be argued that while, in order to determine whether a third party can rely on one of the limitations of the effects of a trade mark provided for in Article 6(1) of that directive, account must also be taken of the reputation of the trade mark concerned, not every infringement of a trade mark with a reputation, within the meaning of Article 5(2) of the directive can be regarded as falling outside those limitations.

73. I deduce from that case-law that, in the Court's view, there is not necessarily a contradiction between, on the one hand, the existence of a use which the proprietor of a trade mark with a reputation can, a priori, oppose on the basis of a national provision adopted in exercise of the right laid down in Article 5(2) of Directive 2008/95 and, on the other hand, a third party's reliance on the limitation provided for in Article 6(1)(c) of that directive.

74. Consideration must therefore be given to the interpretation of Article 6(1)(c) of Directive 2008/95.

**2. Article 6(1)(c) of Directive 2008/95**

75. The interpretation of a provision of EU law requires that account be taken not only of the wording of that provision and of the objectives pursued by it, but also of its context. The origins of a provision of EU law may also provide elements relevant to its interpretation. (38)

76. In that regard, in the first place, a literal comparison of Article 6(1)(c) of Directive 2008/95 and of Article 14(1)(c) of Directive 2015/2436 suggests that the only use which limited the effects of a trade mark ('using ... the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts') is now one of the cases of lawful use which cannot be opposed by a trade mark proprietor. Indeed, Article 14 of Directive 2015/2436 provides, first, that it now covers the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark and, second, that it reproduces the normative content of Article 6(1)(c) of Directive 2008/95, preceding that content with the expression 'in particular'.

77. In the second place, that consideration is borne out by analysis of the travaux préparatoires in relation to Directive 2015/2436.

78. First of all, it is apparent from the Commission's proposal for a directive that it was 'considered appropriate to provide ... for an explicit limitation covering referential use in general'. (39) Thus, the Commission did not take the view that Article 14(1)(c) of Directive 2015/2436 is confined to clarifying or specifying the parameters of Article 6(1)(c) of Directive 89/104. The words 'appropriate to provide for' show that institution's intention to propose the introduction of a limitation of the effects of a trade mark covering referential use in general. In addition, it was from the outset the general nature of that limitation that distinguished it from the limitation provided for in Directives 89/104 and 2008/95, which has a specific, and therefore narrower, scope.

79. Next, in that same vein, the initial wording of recital 25 of that proposal for a directive referring to referential use was clearer than that of recital 27 of Directive 2015/2436 as regards the intention of widening the scope of the limitation previously contained in Article 6(1)(c) of Directive 2008/95. (40) Recital 25 of that proposal stated that 'the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor'. (41)

80. Lastly, the consideration that the EU legislature sought to broaden the scope of the limitation now provided for in Article 14(1)(c) of Directive 2015/2436 is not called into question by the discussions which took place in the course of the travaux préparatoires.

81. Whilst the Commission's initial proposal did refer, in wording almost identical to that used in Article 14(1)(c) of Directive 2015/2436, to 'the use ... of the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts', the Parliament proposed

inserting a few additional illustration of lawful use, (42) namely, inter alia, use ‘made to bring to the attention of consumers the resale of genuine goods that have originally been sold by or with the consent of the proprietor of the trade mark’ and use ‘made for the purposes of parody, artistic expression, criticism or comment’. The Council however opposed that proposal. (43)

82. The Commission ultimately supported the Council’s position, (44) whilst proposing to reflect, at the very least in part, the position of the Parliament in recital 27 of Directive 2015/2436, which states that ‘use of a trade mark by third parties to draw the consumer’s attention to the resale of genuine goods that were originally sold by, or with the consent of, the proprietor of the trade mark in the Union should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Use of a trade mark by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Furthermore, this Directive should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression’.

83. In the third place, the narrower scope of Article 6(1)(c) of Directive 2008/95 as compared with that of Article 14(1)(c) of Directive 2015/2436 appears to be confirmed by analysis of the relevant case-law of the Court.

84. In that regard, referring to the judgments in *Gillette Company and Gillette Group Finland* (45) and *Portakabin*, (46) the referring court observes that the Court appears to have restricted the scope of the limitation provided for in Article 6(1)(c) of Directive 89/104 to use necessary to indicate the intended purpose of a product.

85. The Court in fact clarified in those judgments that the situations coming within the scope of Article 6(1)(c) of Directive 2008/95 must be limited to those which correspond to the objective of that provision. According to the Court, the objective of the provision is to enable providers of goods or services, which are supplementary to the goods or services offered by a trade mark proprietor, to use that mark in order to inform the public of the practical link between their goods or services and those of the proprietor of the mark. (47)

86. In addition, in the judgment in *Adam Opel*, (48) the Court made brief reference to Article 6(1)(c) of Directive 89/104, finding that the affixing of a trade mark consisting of a manufacturer’s logo on scale-model cars was not designed to indicate the intended purpose of those toy models. It can be inferred from that, a contrario, that the affixing of a trade mark on a third party’s product to indicate the intended purpose of that product can be caught by the limitation laid down in that provision.

87. In that same vein, the Court also appears to have taken the view, in the judgment in *BMW*, (49) that only a use indicating the intended purpose of a third party’s

product or service constitutes a legitimate use, for the purposes of Article 6(1)(c) of Directive 2008/95. In that judgment, the Court stated that ‘the use of the trade mark to inform the public that the advertiser repairs and maintains trade-marked goods ... constitute[s] use indicating the intended purpose of the service within the meaning of [that provision]. Like the use of a trade mark intended to identify the vehicles which a non-original spare part will fit, the use in question is intended to identify the goods in respect of which the service is provided’. (50)

88. In the fourth place, the interpretation to the effect that Article 6(1)(c) of Directive 89/104 had a relatively narrow scope as compared with that of Article 14(1)(c) of Directive 2015/2436 is broadly supported by academic legal writing.

89. The introduction of a general referential limitation by means of an amendment of Article 6(1)(c) of Directive 2008/95 and of Article 12(c) of Regulation No 207/2009 had been proposed by legal writers before the adoption of Directive 2015/2436 and Regulation 2015/2424. (51) As I have noted in points 78 and 79 of this Opinion, the EU legislature considered adopting the approach advocated by those writers. In addition, as regards the wording of Article 14(1)(c) of Directive 2015/2436 and that of Article 12(1)(c) of Regulation 2015/2424, the writers argue that their scope is broader than that of the similar provisions contained in Directive 2008/95 and Regulation No 207/2009. (52)

90. In view of those considerations relating to the literal interpretation of Article 6(1)(c) of Directive 2008/95 and to the origins of that provision, as well as the considerations concerning case-law and legal literature, I propose that the question referred for a preliminary be answered to the effect that that provision must be interpreted as meaning that the use, in the course of trade, of the trade mark ‘for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark’, to which reference is now made in Article 14(1)(c) of Directive 2015/2436, does not fall within the scope of that first provision, save in the case of use necessary to indicate the intended purpose of that third party’s product or service. (53)

## VI. Conclusion

91. In the light of all the foregoing considerations, I propose that the Court answer the question referred for a preliminary ruling by the Tribunal Supremo (Supreme Court, Spain) as follows:

Article 6(1)(c) 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 must be interpreted as meaning that the use, in the course of trade, of the trade mark ‘for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark’, to which reference is now made in Article 14(1)(c) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, does not fall within the scope of that first provision, save in the

case of use necessary to indicate the intended purpose of that third party's product or service.

#### Sources

1 Original language: French.

2 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).

3 Directive 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).

4 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).

5 Council Regulation of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

6 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).

7 Regulation of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 (OJ 2015 L 341, p. 21).

8 See, with regard both to the national trade marks system and the European Union trade marks system, order of 6 October 2015, Ford Motor Company (C-500/14, EU:C:2015:680, paragraph 43 and the case-law cited).

9 See point 26 of this Opinion.

10 See judgment of 21 December 2011, Danske Svineproducenter (C-316/10, EU:C:2011:863, paragraph 32). See also, to that effect, judgment of 4 April 2000, Darbo (C-465/98, EU:C:2000:184, paragraph 19).

11 See points 49 to 53 of this Opinion.

12 See, to that effect, judgment of 10 April 2008, adidas and adidas Benelux (C-102/07, EU:C:2008:217, paragraphs 46 and 47).

13 See, to that effect, judgment of 25 January 2007, Adam Opel (C-48/05, EU:C:2007:55, paragraph 44).

14 See point 23 of this Opinion.

15 See points 49 to 53 of this Opinion.

16 See, with regard to this issue, judgment of 12 January 2023, RegioJet (C-57/21, EU:C:2023:6, paragraphs 95 to 97).

17 See, with regard to this issue, judgment of 6 November 2008, Trespa International (C-248/07, EU:C:2008:607, paragraphs 31 to 37).

18 See, recently, judgment of 29 June 2023, International Protection Appeals Tribunal and Others (Attack in Pakistan) (C-756/21, EU:C:2023:523, paragraph 36).

19 See points 41 and 42 of this Opinion, in so far as they concern the argument that a question referred for a preliminary ruling is based on an assumption upon which a referring court must still rule, and therefore that question must be regarded as premature and hypothetical.

20 See, to that effect, judgment of 23 February 1999, BMW (C-63/97, EU:C:1999:82, paragraph 45).

21 Judgment of 17 March 2005 (C-228/03, EU:C:2005:177).

22 See, to that effect, judgment of 6 February 2014, Leidseplein Beheer and de Vries (C-65/12, EU:C:2014:49, paragraphs 32 and 33).

23 See judgment of 11 April 2019, ÖKO-Test Verlag (C-690/17, EU:C:2019:317, paragraph 45 and the case-law cited).

24 See, to that effect, judgment of 22 September 2011, Interflora and Interflora British Unit (C-323/09, EU:C:2011:604, paragraph 72).

25 Judgment of 18 July 2013, Specsavers International Healthcare and Others (C-252/12, EU:C:2013:497, paragraph 39).

26 See, to that effect, judgment of 6 February 2014, Leidseplein Beheer and de Vries (C-65/12, EU:C:2014:49, paragraph 46).

27 See Article 9(1)(c) and Article 12(c) of Regulation No 207/2009.

28 See, to that effect, judgment of 23 February 1999, BMW (C-63/97, EU:C:1999:82, paragraph 61).

29 See, to that effect, judgment of 6 February 2014, Leidseplein Beheer and de Vries (C-65/12, EU:C:2014:49, paragraph 46).

30 See, to that effect, judgment of 6 February 2014, Leidseplein Beheer and de Vries (C-65/12, EU:C:2014:49, paragraphs 44 and 45).

31 Judgment of 17 March 2005 (C-228/03, EU:C:2005:177).

32 Judgment of 25 January 2007 (C-48/05, EU:C:2007:55, paragraph 32).

33 Judgment of 25 January 2007, Adam Opel (C-48/05, EU:C:2007:55, paragraph 36).

34 Judgment of 25 January 2007, Adam Opel (C-48/05, EU:C:2007:55, paragraphs 38 and 45).

35 Judgment of 10 April 2008 (C-102/07, EU:C:2008:217, paragraph 37).

36 Judgment of 10 April 2008, adidas and adidas Benelux (C-102/07, EU:C:2008:217, paragraph 37).

37 Judgment of 11 September 2007 (C-17/06, EU:C:2007:497, paragraph 34).

38 See, recently, judgment of 8 June 2023, VB (Information for a person convicted in absentia) (C-430/22 and C-468/22, EU:C:2023:458, paragraph 24).

39 Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final) (emphasis added).

40 Recital 27 of Directive 2015/2436, which clarifies the normative content of Article 14(1)(c) thereof, states that 'the exclusive rights conferred by a [European Union] trade mark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters. ... The proprietor should not be entitled to prevent the fair and honest use of the mark for the purpose of identifying or referring to the goods or services as those of the proprietor' (emphasis added).

41 Emphasis added.



42 P7\_TA(2014)0119 European Parliament legislative resolution of 25 February 2014 on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 – C7-0088/2013 – 2013/0089(COD)) available at the following address: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A52014AP0119>.

43 P7\_TA(2014)0119 European Parliament legislative resolution of 25 February 2014, *op. cit.*

44 Communication from the Commission to the European Parliament pursuant to Article 294(6) of the Treaty on the Functioning of the European Union concerning the position of the Council on the adoption of a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2015) 588 final).

45 Judgment of 17 March 2005 (C-228/03, EU:C:2005:177).

46 Judgment of 8 July 2010 (C-558/08, EU:C:2010:416).

47 See judgments of 17 March 2005, *Gillette Company and Gillette Group Finland* (C-228/03, EU:C:2005:177, paragraphs 33 and 34), and of 8 July 2010, *Portakabin* (C-558/08, EU:C:2010:416, paragraph 64).

48 Judgment of 25 January 2007 (C-48/05, EU:C:2007:55, paragraph 39).

49 Judgment of 23 February 1999 (C-63/97, EU:C:1999:82).

50 See, to that effect, judgment of 23 February 1999, *BMW* (C-63/97, EU:C:1999:82, paragraph 59).

51 See, *inter alia*, Knaak, R., Kur, A., von Mühlendahl, A., ‘The Study on the Functioning of the European Trade Mark System’, Max Planck Institute for Intellectual Property and Competition Law Research Paper, Nos 12-13, 2012, p. 15: ‘The Study proposes a general limitation for the use of trade marks as an indication or reference to the goods or services of the trade mark holder’.

52 See Kur, A., Senftleben, M., *European Trade Mark Law*, Oxford University Press, Oxford, 2017, p. 421, sections 6.39 to 6.41, and p. 429, section 6.62.

53 I must clarify that the answer which I propose cannot be construed as meaning that Buongiorno’s conduct would come under Article 14(1)(c) of Directive 2015/2436 if that directive were applicable in the dispute in the main proceedings. Such a consideration is dependent on a finding of fact. In addition, if read to that effect, the answer which I propose would be of no use to the referring court since the directive is not applicable *ratione temporis* in the dispute in the main proceedings.