OPINION OF ADVOCATE GENERAL TIZZANO
delivered on 9 December 2004 [1]

I — Introduction

1. This case concerns a reference for a preliminary ruling by the Suomen Korkein Oikeus (Finnish Supreme Court) on the interpretation of Article 6(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (hereinafter 'Directive 89/104', or simply 'the Directive'). [2] In summary, the national court is asking the Court to determine in what circumstances the use of a third party's trade mark is to be considered lawful in terms of the Directive.

1 — Original language: Italian.
2 — OJ 1989 L 40, p. 1.

II — Legislative background

The relevant Community law

2. The Community has intervened in the area of trade mark law, so far as concerns us here, by the adoption of Directive 89/104, which approximates the laws of the Member States in various respects but stops short of full harmonisation.

3. The 10th recital of that directive states, inter alia, that the function of the protection afforded by the registered trade mark 'is in particular to guarantee the trade mark as an indication of origin'.

4. Next of relevance for the purposes of this case is Article 5(1), which provides as follows:

'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.'

5. Also fundamental for present purposes is Article 6(1), which reads as follows:

'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'.

6. Finally, mention must be made of Council Directive 84/450/EEC of 10 September 1984 on misleading and comparative advertising, [3] as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 so as to include comparative advertising, [4] (hereinafter 'Directive 84/450 as amended' and 'Directive 97/55', respectively), the purpose of which, according to

3 — OJ 1984 L 250, p. 17.
4 — OJ 1997 L 290 p. 18.

Article 1, 'is to protect consumers, persons carrying on a trade or business or practising a craft or profession and the interests of the public in general against misleading advertising and the unfair consequences thereof and to lay down the conditions under which comparative advertising is permitted'.

...

7. Article 3a(1) of Directive 84/450 as amended is in the following terms:

'Comparative advertising shall, as far as the comparison is concerned, be permitted when the following conditions are met:

...

(d) it does not create confusion in the market place between the advertiser and a competitor or between the advertiser's trade marks, trade names, other distinguishing marks, goods or services and those of a competitor;

(e) it does not discredit or denigrate the trade marks, trade names, other distinguishing marks, goods, services, activities, or circumstances of a competitor;

(g) it does not take unfair advantage of the reputation of a trade mark, trade name or other distinguishing marks of a competitor or of the designation of origin of competing products;

(h) it does not present goods or services as imitations or replicas of goods or services bearing a protected trade mark or trade name.'

National law

8. In Finland, trade marks are regulated by the Tavaramerkkilaki (Finnish Law on Trade Marks, hereinafter the 'Tavaramerkkilaki'). [5]

5 — Law on Trade Marks No 1964/7 of 10 January 1964.

9. Article 4(1) of the Tavaramerkkilaki sets out the exclusive right of the proprietor of a sign in the following terms:

'The right to a sign for a product under §§1 to 3 of this law means that no one other than its proprietor may use in the course of trade as a sign for his products a sign liable to be confused therewith, on the product or its packaging, in advertising or business documents or otherwise, including also use by word of mouth.'

10. Article 4(2) then specifies:

'It is regarded as unauthorised use for the purposes of the first subparagraph inter alia if a person, when putting on the market spare parts, accessories or the like which are suited to a third party's product, refers to that party's sign in a manner that is liable to create the impression that the product put on the market originates from the proprietor of the sign or that the proprietor has agreed to the use of the sign'.

11. According to the order for reference, that provision is to be understood as a qualification of the trade mark owner's exclusive right in that it is not an infringement for a party when marketing its own products to mention the trade mark of a third party in such a way as not to create the impression that the product put on the market originates from the proprietor of the sign or that the latter has consented to its use.

III — Facts and procedure

12. The Gillette Company of the United States is owner of the GILLETTE and SENSOR trade marks, both registered in Finland for various products including razors. Its Finnish subsidiary Gillette Group Finland Oy (the two companies will together be referred to as 'Gillette') holds the exclusive right to use those marks in Finland, where it markets various shaving products, including a razor, consisting of a handle and a replaceable blade, and blades sold separately.

13. Products of the same kind — a razor consisting of a handle and a replaceable blade as well as blades sold separately — are also sold in Finland by the Finnish company LA-Laboratories Ltd Oy (hereinafter 'LA').

LA has been marketing blades under the PARASON FLEXOR trade mark, on the packaging of which was placed a red sticker bearing the words 'These blades fit all PARASON FLEXOR HANDLES and all GILLETTE SENSOR HANDLES'.

14. According to the order for reference, LA was not authorised by licence or other agreement to use Gillette's trade marks.

15. Gillette thereupon brought proceedings against LA in the Helsingin Käräjäoikeus (Helsinki District Court), claiming that the defendant's conduct infringed its registered trade marks GILLETTE and SENSOR. According to the plaintiff, LA's conduct created the false impression that LA's products were identical or similar to its own products or that LA was licensed or otherwise lawfully entitled to use the said trade marks.

16. That argument was accepted by the Helsingin Käräjäoikeus, which, by decision of 30 March 2000, held that by using the trade marks in question on its Parason Flexor razor-blade packages, LA had infringed Gillette's exclusive right under Article 4(1) of the Tavaramerkkilaki.

17. The Helsingin Käräjäoikeus took the view that the case did not come within the exception provided for by Article 4(2) of the Tavaramerkkilaki. That exception, which was subject to strict interpretation in the light of Directive 89/104, in particular Article 6(1)(c), did not apply to the main product but only to spare parts, accessories and the like. In the view of the Käräjäoikeus, both the handle and the blade were main components of the razor and hence did not fall within the ambit of the exception.

18. The Finnish court therefore ordered LA not to continue or repeat the conduct in question, to remove from the packages the references to GILLETTE and SENSOR, to destroy the relevant stickers used in Finland, and to pay damages to Gillette.

19. LA appealed to the Helsingin Hovioikeus (Helsinki Court of Appeal) which by judgment of 17 May 2001 reversed the decision of the lower court in toto.

20. The appellate court first held that the blades constituted spare parts within the meaning of Article 4(2) of the Tavaramerkkilaki. In any event, a consumer already in possession of a Gillette Sensor handle was informed by the sticker that this handle can be used not only with Gillette's blades but with Parason Flexor blades too. The court also found that the packages of Parason razor-blades were marked prominently with the PARASON and FLEXOR trade marks, showing clearly the origin of the products, whereas the GILLETTE and SENSOR marks appeared in small letters on relatively small stickers placed on the razor-blade packages. That practice could not be regarded as exploiting the trade reputation of a third party's trade mark or as creating the impression of a business connection between the owners of the different marks concerned. The appellate court therefore concluded that LA had used Gillette's trade marks in a manner permitted by Article 4(2) of the Tavaramerkkilaki.

21. Gillette appealed to the Korkein Oikeus, which then raised doubts as to the interpretation of Article 6(1)(c) of Directive 89/104.

22. Accordingly, by order of 23 May 2003, it decided to stay the proceedings and to refer the following questions to the Court:

'When applying Article 6(1)(c) of Directive 89/104:

(1) What are the criteria

(a) on the basis of which the question of regarding a product as a spare part or accessory is to be decided, and

(b) on the basis of which those products to be regarded as other than spare parts and accessories which can also fall within the scope of the said subparagraph are to be determined?

(2) Is the permissibility of the use of a third party's trade mark to be assessed differently, depending on whether the product is like a spare part or accessory or whether it is a product which can fall within the scope of the said subparagraph on another basis?

(3) How should the requirement that the use must be "necessary" to indicate the intended purpose of a product be interpreted? Can the criterion of necessity be satisfied even though it would in itself be possible to state the intended purpose without an express reference to the third party's trade mark, by merely mentioning only for instance the technical principle of functioning of the product? What significance does it have in that case that the statement may be more difficult for consumers to understand if there is no express reference to the third party's trade mark?

(4) What factors should be taken into account when assessing accordance with honest commercial practice? Does the mentioning of a third party's trade mark in connection with the marketing of one's own product constitute a reference to the fact that the marketer's own product corresponds, in quality and technically or as regards its other properties, to the product designated by the third party's trade mark?

(5) Does it affect the permissibility of the use of a third party's trade mark that the economic operator who refers to the third party's trade mark also markets, in addition to a spare part or accessory, a product of his own which that spare part or accessory is intended to be used with?'

23. In the ensuing proceedings, written observations were submitted by the appellant in the main proceedings, the United Kingdom Government, the Finnish Government, and the Commission.

24. At the hearing on 21 October 2004, representations were made on behalf of the parties in the main proceedings, the Finnish Government, and the Commission.

IV — Legal analysis

Introduction

25. The essential function of a trade mark, according to the 10th recital to Directive 89/104 and settled case-law, is that of guaranteeing the origin of goods. [6]

6 — See, *ex multis*, Case 102/77 *Hoffman-La Roche* [1978] ECR 1139, paragraph 7, Case C 206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraph 51, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 36, and Case C-245/02 *Anheuser-Busch* [2004] ECR I-10989, paragraph 59.

26. If that function is to be properly protected, a trade mark owner must be able to prevent unauthorised use by third parties liable to engender confusion among consumers and resulting in their mistakenly attributing a particular product to the trade mark owner. Article 5(1) of the directive therefore gives the owner an exclusive right to the use of the mark.

27. That right is not absolute, however. Article 6 of the directive provides that in certain circumstances a trade mark may be lawfully affixed to products other than those of the trade mark owner.

28. In particular, according to that article, the use of a third party's trade mark is lawful where it: indicates the intended purpose of a product, is necessary to that end, and is in accordance with honest practices in industrial or commercial matters (hereinafter also 'honest practices').

29. The reasons justifying that restriction on the exclusive use of the trade mark have been elucidated by the Court. According to settled case-law, 'by a limitation of the effects of the rights derived from Article 5 of Directive 89/104 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 common 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'.[7]

30. It can therefore be said that, in limiting the exclusive right provided for under Article 5, Article 6(1)(c) of Directive 89/104 seeks to balance the owner's interest in the trade mark being able to perform to the full its function of guaranteeing the product's origin against the interest of other traders in having full access to the market, but leaving the door open — as would appear borne out by the broad reference to free movement in the Court's statement quoted above and as we will see below — for other interests too to come into play.

The first and second questions

31. Following those preliminary observations, I now come to the questions referred by the national court.

7 — Case C-100/02 *Gerolsteiner Brunnen* [2004] ECR I-691, paragraph 16 and cases cited there.

32. By its first two questions, which I will consider together, the national court asks, in substance, what criteria are to be used, when applying Article 6(1)(c) of Directive 89/104, to distinguish main products from accessories and spare parts, and to determine which other products, apart from spare parts and accessories, are capable of falling within the scope of that provision. This with a view to ascertaining whether in the case of such other products the lawfulness or otherwise of affixing a third party's trade mark must be assessed differently than in the case of spare parts and accessories.

33. As we have seen, one of the conditions to be satisfied in order for a third party's trade mark to be lawfully placed on a product is that it must perform the function of indicating the intended purpose of the product, not its origin.

34. It seems to me that from that perspective the question of using a third party's trade mark to indicate intended purpose, without adding anything concerning origin, arises in substantially the same terms for every product or service.

35. Of course, the issue will arise more often for accessories and spare parts, which have to be used in conjunction with a main product that in most cases cannot be identified otherwise than by its trade mark. One need think only of an exhaust pipe or a bicycle-rack specially designed for the Volkswagen Polo, to take the examples adduced by the United Kingdom Government. But the same situation can also arise with two products that are capable of being used together but of which neither is the accessory or spare part of the other. Taking our cue again from the United Kingdom Government, we may consider the example of a computer produced by company A and an operating system produced by company B which are mutually compatible. These are neither accessories nor spare parts because each product exists in its own right. And yet the producer in each case has a legitimate interest in informing the public that its product can have the other's product as its intended purpose.

36. I therefore take the view that there are no goods or services excluded ex ante from the scope of Article 6(1)(c) of the directive by virtue of the condition now under consideration. Thus, regardless of whether the item in question is a main product, an accessory, or a spare part, if using a third party's trade mark is necessary in order to indicate its intended purpose, this condition must be regarded as satisfied.

37. This interpretation appears to me to be borne out by other considerations. To begin with the letter of the provision in question, I note that the reference to accessories and spare parts is preceded by the expression 'in particular'. That suggests that the limitation of the exclusive right can also apply to products which are not accessories or spare parts, all the more so since, as the Commission points out, its original proposal for a directive specifically excluded that possibility but was subsequently amended in precisely that respect. [8]

38. In addition, as the United Kingdom Government pointed out, the provision in question refers to the intended purpose not only of goods but also of services, for which it would be difficult to conceive of spare parts or accessories.

39. All this confirms, in my opinion, that for the purposes of the application of Article 6 (1)(c) of the directive, it is not necessary first to categorise an item as main product or accessory or spare part, because the fundamental factor *in all cases* is whether the use of the third party's trade mark is necessary in order to indicate the intended purpose of the product (or service) and does not give rise to confusion as to its origin.

40. But if that is so, it does not then appear to me necessary, for present purposes, for the Court to decide the criteria to be used to identify main products and to distinguish them from accessories and spare parts, as the first question asks.

41. I therefore propose that the first and second questions should be answered to the effect that since all that needs to be established, for the purposes of the application of Article 6(1)(c) of the directive, is whether the use of the third party's trade mark is necessary in order to indicate the intended purpose of the product (or service) and does not give rise to confusion as to its origin, the assessment of the lawfulness of the use of a third party's trade mark does not vary according to whether it is a main product or an accessory or spare part.

The third question

42. By its third question, the national court asks in substance what factors should be

8 — Article 5 of the Proposal for a First Council Directive to approximate the laws of the Member States relating to trade marks, presented by the Commission on 25 November 1980, provided that '[t]he trade mark shall not entitle the proprietor thereof to prohibit a third party from using, in the course of trade: ... (c) the trade mark for the purpose of indicating the intended purpose of accessories or spares parts ...' (OJ 1980 C 351, p. 1).

taken into account in determining whether the use of a third party's trade mark is 'necessary', within the meaning of Article 6 (1)(c) of the directive, to indicate the intended purpose of a product.

43. In their observations to the Court, the intervening parties support two very different interpretations of this condition that the use of a third party's trade mark must be necessary.

44. The United Kingdom Government suggests that the condition should be considered satisfied if the use of the trade mark is an 'efficient and accurate means' [9] of informing potential purchasers as to the intended purpose of the product.

45. It argues that the purpose of the provision in question is to assist in promoting undistorted competition and that too strict an interpretation of the condition would have the effect of neutering the provision.

46. In the United Kingdom's view, if the condition that the use of a third party's trade mark must be necessary were interpreted as being satisfied only if no other way can be found of conveying the information needed by the potential purchaser to understand the intended purpose of the product, then in practice the provision might never apply. In virtually every case it would be possible to conceive of some way of indicating the intended purpose of the product other than by using the third party's trade mark, for example by using a picture or a technical description of the type of product it will fit.

47. This view is shared by the Finnish Government and the Commission, who believe it is important also to take into account the characteristics of potential purchasers of the product carrying the third party's trade mark. What is 'necessary' to communicate varies according to whether the product is one aimed at final consumers or at other businesses. Only in the latter case could technical details adequately convey the information as to the intended purpose of the product, without it being 'necessary' therefore to use the third party's trade mark. For average consumers, however, the absence of the trade mark would make it more difficult to understand a product's

9 — Footnote not relevant to the English version.

intended purpose, unless there are technical standards which are universally known and which allow even the average consumer to understand easily the intended purpose of the product in question. A case in point, as was observed at the hearing, is that of tyres, where a system of easy-to-understand codes is used to let potential buyers know which models are right for their cars.

48. Quite the opposite view is taken by Gillette, which contends for a rigidly and exclusively economic interpretation of the condition in question. According to Gillette, the use of a third party's trade mark can be considered 'necessary' only if it is the sole means by which the user can market its own product on a sustainable economic basis.

49. Applying that interpretation to the case in hand, Gillette observes that LA's blades have as their intended purpose not only Gillette's handles but also LA's own handles and indeed, as emerged during the hearing, other makes of handle as well. It follows, in Gillette's view, that LA's blades would have access to the market and could be marketed on an economically viable basis even without it being stated on the packaging that they also fit the handles produced by Gillette.

50. It would be different if it were not possible to indicate any intended purpose for LA's blades without mentioning the trade marks in question, because in that case there would be no demand for the blades and therefore no possibility whatsoever of trading viably. But such is not the case here, Gillette maintains, given that LA itself also produces handles, so that its blades would not be completely denied access to the market if the Gillette trade marks were not allowed to appear on their packaging.

51. For my part, I have no difficulty accepting that the approach proposed by Gillette appears more in keeping with the letter of Article 6(1)(c) of the directive, which refers to the use of the third party's trade mark not as 'efficient' but as 'necessary', and needless to say the two are not synonymous.

52. Moreover, this seems to be borne out by a comparison of the final text of the

provision and the Commission's original proposal. [10] The latter provided that third parties could use a third party's trade mark *'for the purpose* of indicating the intended purpose of accessories or spare parts'; [11] the final version, as we have seen, is couched in more restrictive terms, providing that such use is permitted 'where it is necessary to indicate the intended purpose ...'.

53. That said, however, it has to be asked whether the matter can be disposed of by a semantic analysis of an isolated phrase of the provision in question or whether a more comprehensive approach is called for that takes fuller account of the meaning and scope of that provision and the purposes it seeks to achieve.

54. More specifically, it has to be asked whether trade mark protection, which is inarguably the fundamental aim of the directive, is to be seen purely in terms of the trade mark proprietor's needs, and is therefore, as Gillette argues, subject only to such limits as are strictly economically necessary to permit other suppliers to have a viable presence in the market, or whether the exception introduced by Article 6(1) is also premissed on the importance of other needs.

55. It seems to me in fact that that provision opens the door also to other values and interests which it does not expressly mention but which in the broader perspective it would be difficult to ignore. All the more so as they are referred to in the judgment quoted above (see paragraph 29), where the Court stated that Article 6(1) 'seeks to reconcile the fundamental interests of trade-mark protection with those of free movement of goods and freedom to provide services in the common 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'.

56. It is therefore, as the Court points out, a matter of reconciling two different interests, both of which however are directed at ensuring a system of undistorted competition and thus, ultimately, the right of consumers to choose from a variety of interchangeable products. What this means, in other words, is that, as well as protecting the economic interests of the trade mark owner, the directive also seeks to ensure choice for consumers by allowing them not

10 — Article 5(c), quoted in footnote 8.

11 — Emphasis added.

only to be sure about the origin of products but also to enjoy to the full the benefits resulting from competition between different products capable of satisfying the same need.

57. However, since the exception provided for by Article 6(1) is meant to balance these different interests, it follows that, in the context of the more comprehensive analysis of the provision I mentioned above, one cannot simply rely on textual arguments derived from one phrase in that provision to give primacy to one of those interests and to discount the others, because the purpose of the provision, according to the Court, is to reconcile all of them.

58. Moreover, an important testimony to the need to take into account, and as far as possible conciliate, the different requirements in play seems to me to be found, once more, in the case-law of the Court, in this instance in *BMW*, [12] in which the Court did indeed reconcile the requirement of protecting the trade mark owner with that of protecting the consumer even in terms of maximising competition and providing complete information.

59. I would recall, so far as concerns us here, that in that case the owner of a garage not part of the BMW network carried on business repairing BMW cars and described himself in advertisements as 'specialised in BMWs'. BMW claimed that such conduct was not within the exception in Article 6(1)(c) of the directive and should therefore be held to be an infringement of BMW's exclusive right. In its view, since the trader could also carry on an economically viable business offering repair services without naming any specific make of car (and hence any trade mark), the use of the BMW trade mark did not satisfy the condition of necessity laid down by that provision.

60. But that interpretation of the condition in question, which is not in my view dissimilar to that contended for by Gillette in this case, does not seem to me to have met the Court's favour. For instead of considering whether the garage-owner's business would be commercially viable were he to drop the references to the BMW trade mark, the Court focused solely on the need to provide his prospective customers with the fullest possible information.

61. Having first noted that 'the use [of the BMW mark] [was] intended to identify the

12 — Case C-63/97 *BMW* [1999] ECR I-905.

goods in respect of which the service [was] provided [and was] necessary to indicate the intended purpose of the service', it went on to find that 'if an independent trader carries out the maintenance and repair of BMW cars or is in fact a specialist in that field, that fact cannot in practice be communicated to his customers without using the BMW mark'. [13]

62. In so doing, the Court espoused the approach followed by Advocate General Jacobs in his Opinion in that case, [14] when he noted that the issue in such circumstances was in effect whether a trader in the position described above was 'free to describe the nature of the services he is offering'. [15] The Advocate General went so far as to assert that 'to prevent such use of the mark would be an undue restriction on the trader's freedom'. [16]

63. It seems to me that the interpretation of the condition in question emanating from that case is less rigid than what Gillette seeks. The condition appears to be satisfied simply by the fact that the use of a third party's trade mark is the only effective means of extending the range of products from which the prospective purchaser can choose.

64. If that interpretation is transposed to the present case, it follows that, were the Gillette trade marks not to appear on LA's blade packages, consumers might have no other means of apprehending the objective fact that those products fit Gillette handles, and might thereby be denied information material to their purchasing decisions. Accordingly, if it were the only means of providing that information, the use of the Gillette trade marks should be considered 'necessary' within the meaning of the directive.

65. It would naturally be for the national court to decide the issue, that is, to ascertain whether without the references to the Gillette trade marks on LA's blade packages, potential purchasers could be effectively informed by other means that those blades can be used with Gillette handles. The use of Gillette's trade marks might not be neces-

13 — *BMW*, paragraphs 59 and 60.

14 — In his Opinion delivered on 2 April 1998, Advocate General Jacobs dismissed as 'unrealistic' the proposition that the garage-owner could have provided his services without needing to name any specific make of car, observing that 'if [he] does in fact specialise in maintaining and repairing BMW cars it is difficult to see how he could effectively communicate that fact to his customers without using the sign BMW' (paragraph 54).

15 — Opinion, paragraph 54.

16 — Opinion, paragraph 55.

sary, for example, if there were technical standards known to consumers indicating which handles fit which blades (as in the aforementioned case of tyres).

66. That being so, and while stating my preference for the above approach, I must acknowledge that, besides the fact that it does not fully meet the objections of a general nature raised by Gillette (undue reduction of the trade mark owner's protection), it also leaves a large grey area as to its application. But this consequence, in my opinion, is difficult to avoid if the discussion of the test of necessity continues to be conducted in isolation from the remaining conditions set out in Article 6(1), reducing it in effect, as I have said, to a semantic dispute about the relevant phrase in that provision.

67. It is a different matter, however, if account is taken of the fact that that test does not represent the entirety of the provision in question, but is in fact accompanied by, and strictly correlated with, a clear condition as to the manner of use of the trade mark claimed to be necessary (i.e. in accordance with honest practices). In other words, the fact that the interpretation of that condition is the subject of a separate question referred for a preliminary ruling should not have the effect of splitting the issue in such a way as to lose sight of the direct link which exists between the different parts of the provision and which is therefore going to affect the interpretation of each of them.

68. It seems to me that the grey area which, as I have said, is an inevitable concomitant of the test of necessity, can be resolved at the stage of examining the circumstances and manner of use of the trade mark, in the terms indicated by Article 6(1). In this way too it is possible to meet legitimate concerns as to the damage that might be done to trade mark protection as a result of a less rigorous interpretation of the condition of necessity.

69. The less rigorous that interpretation may be, the more stringent will be the scrutiny of the manner of use. At the same time, it is precisely on the more solid ground of that scrutiny that the actual 'necessity' of the use of the mark can be better assessed and such doubts as may always arise in the abstract in that regard dispelled.

70. Besides, the Court did not deal with the issue under consideration by separate and sequential tests, first 'measuring' the degree

to which the use of the third party's trade mark was 'necessary' and then determining whether that use was in accordance with 'honest practices'. Instead it adopted a unitary approach, in which I would say that the emphasis was placed less on the issue of 'necessity' than on compliance with honest practices, on the basis that they are decisive in avoiding any confusion as to the origin of the product and hence to the protection of the trade mark proprietor. [17]

71. It is therefore only with the above qualifications that I propose that the Court should answer the third question to the effect that the use of a third party's trade mark is 'necessary' to indicate the intended purpose of a product if it constitutes the only means of providing consumers with complete information as to the possible uses of the product in question.

The fourth question

72. We now come to the interpretation of the phrase 'honest practices in industrial or commercial matters', which by its fourth question the national court asks the Court to provide, in view of the fact that Article 6(1) of Directive 89/104 makes the right of a third party to use a trade mark subject to compliance with those practices.

73. In this regard, I would note that, according to settled case-law, '[t]he condition of 'honest practice' constitutes ... the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner'. [18] That being so, however, it still remains to ascertain the scope of that duty, given that it is not defined in Directive 89/104.

74. It seems to me that this can be done simply by consulting the relevant case-law of the Court, which provides the means by which to demarcate the scope of the duty in question. The Court has explained that a third party cannot use a trade mark 'in a way that may create the impression that there is a commercial connection between the other undertaking and the trade mark proprietor, and in particular that ... there is a special relationship between the two undertakings'. [19] It also noted that an undertaking using a third party's trade mark must not

17 — See *BMW*, paragraphs 61 et seq. and the Opinion in that case, paragraphs 55 and 56.

18 — *BMW*, paragraph 61, and *Gerolsteiner Brunnen*, paragraph 24.

19 — *BMW*, paragraph 64.

take 'unfair advantage of its distinctive character or repute'. An advantage will be unfair, in particular, if it is the result of prospective buyers being led to believe that there is a connection between the trade mark proprietor and the undertaking that produced the product. [20]

75. But as the referring court itself, the United Kingdom Government and the Commission suggest, useful guidance is provided not only by the case-law but also by the Community provisions on misleading and comparative advertising, in particular Directive 84/450 as amended by Directive 97/55.

76. Recitals 13 to 15 of the latter directive indicate that the exclusive right conferred on the proprietor of a trade mark by Article 5 of Directive 89/104 is not infringed where a third party uses the trade mark in compliance with the conditions laid down by Directive 97/55.

20 — *BMW*, paragraphs 52 and 53. I must point out that this reasoning concerned Article 7(2) of Directive 89/104; however, in paragraphs 62 and 63, the Court stated that the same considerations 'apply mutatis mutandis' to Article 6(1).

77. It follows that, if the message conveyed through the use of the trade mark is lawful for the purposes of the provisions on misleading and comparative advertising, the 'honest practices' referred to in Article 6(1) of Directive 89/104 can be regarded as having been observed.

78. In fact the conditions that are laid down by Article 3a of Directive 84/450 as amended (inserted by Article 1(4) of Directive 97/55) for comparative advertising to be lawful (and which are most relevant to the present case) do not differ substantially from those that can be inferred from the Court's case-law quoted above. Those conditions are that such advertising does not create confusion in the market place between the advertiser and a competitor (subparagraph (d)) and does not seek to take unfair advantage of the reputation of a trade mark of a competitor (subparagraph (g)).

79. It follows therefore from the case-law quoted above and from the provisions of Directive 84/450 that it is clearly unlawful to use a third party's trade mark in such as way as to create confusion among prospective purchasers as to the origin of the product. In particular, prospective purchasers must not be led to believe that the product is referable to the trade mark owner and therefore possesses the same quality as its products.

80. The Finnish and United Kingdom Governments contend, however, that when an undertaking places a third party's trade mark on its own product, it does not necessarily intend to represent that its own products and those of the trade mark proprietor are of equal quality. In *BMW*, the Court effectively acknowledged the lawfulness of the use of a third party's trade mark on the part of a trader wishing to 'lend an aura of quality to his own business'. [21]

81. As described above (paragraph 59), however, that case, to the extent that it is relevant here, concerned the carrying out of repairs on BMW cars. The subject-matter of the trader's business consisted of products lawfully bearing the BMW trade mark; the 'aura of quality' that the trader derived from the subject-matter of his own business was not unlawful as it was a reflection of the fact that he had the ability to work on products whose quality was guaranteed by the presence of the BMW mark.

82. In the present case, by contrast, LA's blade production is a process that is already complete at the point when the information is conveyed that the blades can be used with the Gillette razors. Therefore, the fact that the two products are compatible should not have any bearing on consumers' judgment of the quality of LA's blades. If however the use of the trade mark led consumers to believe that the quality of both types of blade was the same, then the conclusion would have to be that the condition of compliance with honest practices was not met.

83. It is therefore for the national court to determine whether the use of the Gillette trade marks on LA's blade packages is aimed solely at informing prospective buyers of the fact that LA's blades can be attached to Gillette's razor handles because the fittings are compatible, or whether it also implies that LA's blades have the same cutting characteristics, and are hence of the same quality, as the Gillette blades.

84. The examination to be conducted by the national court for this purpose must consist of a global assessment 'taking into account all factors relevant to the circumstances of the case'. [22] That is what the Court has stipulated in relation to the manner of assessment of the likelihood of confusion in determining the scope of the exclusive right enjoyed by the trade mark proprietor under Article 5(1)(b) of Directive 89/104. Since however the determination of the honest

21 — *BMW*, paragraph 53.

22 — Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40.

practices condition will inevitably affect the scope of that exclusive right, by making it more or less extensive, it seems to me that the assessment to be conducted by the national court as to whether that condition is satisfied must also obey the criterion stated above. [23]

85. On the basis of the foregoing, I therefore propose that the Court answer the fourth question to the effect that a trader complies with 'honest practices in industrial or commercial matters' if by using a third party's trade mark it does not create the impression that there is a commercial connection between itself and the trade mark proprietor and does not take unfair advantage of the trade mark's distinctive character or repute. The fact that a trader also sells those products and places the third party's trade mark on them does not necessarily mean that it represents that its products are equal in quality to those of the trade mark proprietor. The trader's conduct must therefore be considered on the basis of a global assessment of all the relevant factors.

23 — I would note as a preliminary point that the same approach was adopted by the Court to determining whether the conditions set out by Directive 84/450, as amended, are met, when it stated that 'account should be taken of the overall presentation of the advertising at issue' (Case C-112/99 *Toshiba Europe* [2001] ECR I-7945, paragraph 60).

The fifth question

86. By its fifth question, the national court asks in substance whether the assessment of the lawfulness of the use of a third party's trade mark is affected by the fact that the trader who places a third party's trade mark on its own product also sells the type of product that the former is intended to be used with.

87. It seems to me that in order to answer that question there are two different aspects to consider separately, one concerning the requirement of necessity and the other concerning compliance with 'honest practices', which were considered in the analysis of the third and fourth questions respectively.

88. As regards the first aspect, I must say that if the economic approach to the condition of necessity advocated by Gillette had been accepted then the fact that, as well as the blades, LA also sells a razor handle that constitutes one of their possible intended purposes could have cast doubt on whether the condition was satisfied, since even without using the Gillette trade marks there would still be demand for LA's blades on the part of owners of LA's razor handle.

89. Since however, for the reasons given, I have come to the conclusion that the necessity condition is met if the use of a third party's trade mark on a product constitutes the only means of providing consumers with complete information as to the possible uses of the product in question, the assessment of the lawfulness of the use of the trade mark does not seem to me to be affected by the fact that the trader also sells a product which constitutes one of the possible intended purposes of the product on which it places the third party's trade mark.

90. As regards the aspect concerning 'honest practices', I will simply note, along with the United Kingdom, Finland and the Commission, that what is described in this question is just one of the factors, albeit an important one, that the national court has to take into account in assessing whether the use of the trade mark by the third party is in accordance with honest practices.

91. I therefore propose that the fifth question be answered to the effect that the fact that a trader who places a third party's trade mark on its own product also sells the type of product that the former is intended to be used with is an important factor in assessing the lawfulness of the use of the trade mark but does not alter the criteria applicable to that assessment.

V — Conclusion

92. In the light of the foregoing considerations I propose that the Court answer the questions of the Korkein Oikeus in the following terms:

(1) since all that needs to be established, for the purposes of the application of Article 6(1)(c) of Council Directive 89/104/EEC of 21 December 1988 to

approximate the laws of the Member States relating to trade marks, is whether the use of the third party's trade mark is necessary in order to indicate the intended purpose of the product (or service) and does not give rise to confusion as to its origin, the assessment of the lawfulness of the use of a third party's trade mark does not vary according to whether it is a main product or an accessory or spare part;

(2) the use of a third party's trade mark is necessary to indicate the intended purpose of a product if it constitutes the only means of providing consumers with complete information as to the possible uses of the product in question;

(3) a trader complies with 'honest practices in industrial or commercial matters' if by using a third party's trade mark it does not create the impression that there is a commercial connection between itself and the trade mark proprietor and does not take unfair advantage of the trade mark's distinctive character or repute. The fact that a trader also sells those products and places the third party's trade mark on them does not necessarily mean that it represents that its products are equal in quality to those of the trade mark proprietor. The trader's conduct must therefore be considered on the basis of a global assessment of all the relevant factors;

(4) the fact that a trader who places a third party's trade mark on its own product also sells the type of product that the former is intended to be used with is an important factor in assessing the lawfulness of the use of the trade mark but does not alter the criteria applicable to that assessment.