JUDGMENT OF THE COURT (Fifth Chamber)
25 October 2001 *

In Case C-112/99,

REFERENCE to the Court under Article 177 of the EC Treaty (now Article 234 EC) by the Landgericht Düsseldorf (Germany) for a preliminary ruling in the proceedings pending before that court between

Toshiba Europe GmbH

and

Katun Germany GmbH,

on the interpretation of Article 2(2a) and Article 3a(1)(c) and (g) of Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising (OJ 1984 L 250, p. 17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (OJ 1997 L 290, p. 18),

* Language of the case: German.

THE COURT (Fifth Chamber),

composed of: P. Jann, President of the Chamber, D.A.O. Edward, A. La Pergola, L. Sevón (Rapporteur) and M. Wathelet, Judges,

Advocate General: P. Léger,
Registrar: H.A. Rühl, Principal Administrator,

after considering the written observations submitted on behalf of:

— Toshiba Europe GmbH, by P.-M. Weisse, Rechtsanwalt,

— Katun Germany GmbH, by W. Mielke, Rechtsanwalt,

— the French Government, by K. Rispal-Bellanger and R. Loosli-Surrans, acting as Agents,

— the Austrian Government, by F. Cede, acting as Agent,

— the Commission of the European Communities, by U. Wölker, acting as Agent,

having regard to the Report for the Hearing,

after hearing the oral observations of Toshiba Europe GmbH, represented by C. Osterrieth, Rechtsanwalt; of Katun Germany GmbH, represented by M. Magotsch, Rechtsanwalt; and of the Commission, represented by U. Wölker, at the hearing on 19 October 2000,

after hearing the Opinion of the Advocate General at the sitting on 8 February 2001,

gives the following

Judgment

1 By order of 19 January 1999, received at the Court on 1 April 1999, the Landgericht Düsseldorf (Regional Court, Düsseldorf) referred to the Court for a preliminary ruling under Article 177 of the EC Treaty (now Article 234 EC), three questions on the interpretation of Articles 2(2a) and 3a(1)(c) and (g) of Council Directive 84/450/EEC of 10 September 1984 on misleading and comparative advertising (OJ 1984 L 250, p. 17), as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (OJ 1997 L 290 p. 18; hereinafter 'Directive 84/450 as amended').

2 These questions have been raised in proceedings between a German company, Toshiba Europe GmbH ('Toshiba Europe'), and another German company, Katun Germany GmbH ('Katun'), concerning Katun's advertising in the course of selling

spare parts and consumable items that can be used for the photocopiers distributed by Toshiba Europe.

Legal background

Directive 84/450 as amended

3 Directive 84/450, which concerned only misleading advertising, was amended in 1997 by Directive 97/55 in order to cover also comparative advertising. The title of Directive 84/450 was therefore amended by Article 1(1) of Directive 97/55.

4 Under Article 2(1) of Directive 84/450 as amended, 'advertising' means, for the purposes of that directive, 'the making of a representation in any form in connection with a trade, business, craft or profession in order to promote the supply of goods or services, including immovable property, rights and obligations'.

5 According to Article 2(2a) of Directive 84/450 as amended, 'comparative advertising', within the meaning of that directive, is 'any advertising which explicitly or by implication identifies a competitor or goods or services offered by a competitor'.

6 Article 3a(1) of Directive 84/450 as amended provides as follows:

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

(a) it is not misleading according to Article 2(2), 3 and 7(1);

(b) it compares goods or services meeting the same needs or intended for the same purpose;

(c) it objectively compares one or more material, relevant, verifiable and representative features of those goods and services, which may include price;

(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;

(f) for products with designation of origin, it relates in each case to products with the same designation;

(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.'

7 The second recital of the preamble to Directive 97/55 states as follows:

'Whereas the completion of the internal market will mean an ever wider range of choice; whereas, given that consumers can and must make the best possible use of the internal market, and that advertising is a very important means of creating genuine outlets for all goods and services throughout the Community, the basic provisions governing the form and content of comparative advertising should be uniform and the conditions of the use of comparative advertising in the Member States should be harmonised; whereas if these conditions are met, this will help demonstrate objectively the merits of the various comparable products; whereas comparative advertising can also stimulate competition between suppliers of goods and services to the consumer's advantage.'

8 The sixth recital of the preamble to Directive 97/55 states that it is desirable 'to provide a broad concept of comparative advertising to cover all modes of comparative advertising'.

9 The seventh recital states:

'Whereas conditions of permitted comparative advertising, as far as the comparison is concerned, should be established in order to determine which practices relating to comparative advertising may distort competition, be detrimental to competitors and have an adverse effect on consumer choice; whereas such conditions of permitted advertising should include criteria of objective comparison of the features of goods and services.'

National law

10 Paragraph 1 of the Gesetz gegen den unlauteren Wettbewerb (Law against unfair competition) of 7 June 1909 ('the UWG') provides:

'Any person who acts *contra bonos mores* in business dealings for a competitive purpose shall be liable to proceedings for a restraining injunction and damages.'

11 According to the order for reference, under the settled case-law of the Bundesgerichtshof (Germany) an undertaking's comparison of its own goods with those of a competitor was in principle *contra bonos mores* within the meaning of Paragraph 1 of the UWG. However, in view of the entry into force of Directive 97/55, the Bundesgerichtshof held, in judgments delivered on 5 February 1998 (GRUR 1998, 824 — Testpreis-Angebot) and on 23 April 1998 (BB 1998, 2225 — Preisvergleichsliste II), that, even though that directive had not

then been transposed into Germany law and the period for its transposition had not expired, comparative advertising should thenceforth be regarded as permissible where the conditions referred to in Article 3a of Directive 84/450 as amended were satisfied.

The main proceedings and the questions referred for a preliminary ruling

12 Toshiba Europe is the German subsidiary of Toshiba Corporation, a Japanese company. It distributes, in Europe, photocopiers and spare parts and consumable items for them.

13 Katun also sells spare parts and consumable items which may be used for Toshiba photocopiers.

14 In order to identify its photocopier models, Toshiba Europe uses particular model references, such as Toshiba 1340. In order to identify its equipment, it also uses distinguishing marks, known as product descriptions. Furthermore, each product has an order number, the so-called product number.

15 In Katun's catalogues the spare parts and consumable items are set out in categories listing the products specific to a group of particular models of Toshiba photocopiers. Reference is made there, for example, to 'Katun products for Toshiba photocopiers 1340/1350'. Each list of spare parts and consumable items is made up of four columns. In the first column, headed 'OEM product number', is Toshiba Europe's order number for the corresponding product sold by it. According to the national court, in the relevant business sector 'OEM' means,

without any doubt, 'Original Equipment Manufacturer'. The second column headed 'Katun product number', contains Katun's order number. The third column contains a description of the product. The fourth column refers to the number of the particular model or models for which the product is intended.

16 As regards prices, the documents before the Court show that the catalogues refer to the prices in the order form. Moreover, with regard to some products statements are made in the catalogues, between the lists, such as 'you can reduce your costs without loss of quality or performance', 'thanks to their cost and the lower servicing they require, these quality products are clearly a more profitable alternative for businesses' or 'an ideal solution for many high-performance Toshiba photocopiers'.

17 In the main proceedings, Toshiba Europe complains solely of the fact that in Katun catalogues its own product number appears alongside the Katun product number. Relying on a judgment of the Bundesgerichtshof of 28 March 1996 (AZ I ZR 39/94, GRUR 1996, 781 — Verbrauchsmaterialen), Toshiba Europe claims that the indication of its own product number is not indispensable in order to explain to customers the possible use of products offered by Katun and that it would suffice to refer to the corresponding models of Toshiba photocopiers. By using the Toshiba Europe product number, Katun is making use of original goods in order to boost its own. It misleads the customer by asserting that the products are of equivalent quality and unlawfully exploits Toshiba's reputation. The use of Toshiba Europe product numbers is not necessary since Katun can use detailed diagrams to identify the products. Lastly, the use of Toshiba Europe product numbers is not necessary in order to compare the prices of the products.

18 Katun contends that its advertising is directed exclusively at specialised traders, who are aware that the products which it offers are not those of the original

manufacturers. Furthermore, in view of the large number of spare parts and consumable items involved in a photocopier model, a reference to the Toshiba Europe product number is objectively necessary in order to identify the products. Furthermore, the parallel indication of the Toshiba Europe product number and the Katun product number allows the customer to compare prices.

19 Katun also submits that the decision of the Bundesgerichtshof of 28 March 1996 is incompatible with Community law in the light of Directive 84/450 as amended, which allows comparative advertising. That directive in principle allows advertising enabling a price comparison to be made between spare parts and accessories of the original manufacturer and those of a competing supplier. Katun could not indicate the actual product being compared if it were unable to use Toshiba Europe's product numbers and could refer only to the corresponding photocopier model, there being numerous, mutually indistinguishable accessories and spare parts for different photocopier models.

20 Considering that the determination of the dispute before it depended in particular on the interpretation of Articles 2(2a) and 3a(1)(c) and (g) of Directive 84/450 as amended, the Landgericht Düsseldorf decided to stay proceedings and to refer the following questions to the Court for a preliminary ruling:

'1. Is advertising by a supplier of spare parts and consumable items for an equipment manufacturer's product to be regarded as comparative advertising within the meaning of Article 2(2a) of the directive if the advertising indicates the manufacturer's product numbers (OEM numbers) for the relevant original spare parts and consumable items for reference purposes in order to identify the supplier's products?

2. If Question 1 is to be answered in the affirmative:

   (a) Does the display of the equipment manufacturer's product numbers (OEM numbers) alongside the supplier's own order numbers constitute a comparison of goods permissible under Article 3a(1)(c) of the directive, in particular a comparison of the prices?

   (b) Are the product numbers (OEM numbers) "distinguishing marks of a competitor" within the meaning of Article 3a(1)(g)?

3. If Question 2 is to be answered in the affirmative:

   (a) What are the criteria to be used when assessing whether an advertisement within the meaning of Article 2(2a) takes unfair advantage of the reputation of a distinguishing mark of a competitor within the meaning of Article 3a(1)(g)?

   (b) Is the fact that the equipment manufacturer's product numbers (OEM numbers) appear alongside the supplier's own order numbers sufficient to justify an allegation that unfair advantage is being taken of the reputation of the distinguishing mark of a competitor within the meaning of Article 3a(1)(g), if the third party competitor could instead indicate in each case the product for which the consumable item or spare part is suitable?

(c) When assessing unfairness, does it matter whether a reference (solely) to the product for which the consumable item or spare part is suitable, rather than to the product number (OEM number), is likely to make sale of the supplier's products difficult, particularly because customers generally go by the equipment manufacturer's product numbers (OEM numbers)?'

Question 1 and Question 2(a)

21 By its first question, the national court asks in substance whether, on a proper construction of Article 2(2a) of Directive 84/450 as amended, indications, in the catalogue of a supplier of spare parts and consumable items suitable for the products of an equipment manufacturer, of product numbers (OEM numbers) allocated by the equipment manufacturer to the spare parts and consumable items which it itself sells is to be regarded as comparative advertising. By question 2(a), it asks whether, on a proper construction of Article 3a(1)(c) of Directive 84/450 as amended, such indications constitute lawful comparisons within the meaning of that provision, in particular price comparison.

Observations submitted to the Court

22 Toshiba Europa submits that Directive 84/450 as amended does not apply in the present case, because there is no comparison of product features. The listing of the product numbers alongside each other is a generalised assertion that the products are equivalent, not an objective comparison of material, relevant, verifiable and representative features of those products within the meaning of Article 3a(1)(c) of the directive. Moreover, the fact that this indication allows the

price of its products to be compared with the price of Katun's products does not render it comparative advertising for the purposes of the directive.

23 Katun and the Commission submit that Katun's catalogues constitute 'comparative advertising' within the meaning of Article 2(2a) of Directive 84/450 as amended. The Austrian Government submits more generally that there is 'comparative advertising' where the customers to which it is addressed can identify the manufacturer of the original models through the product numbers.

24 According to Katun and the Austrian Government, the comparison of the product numbers is a shorthand way of comparing the technical features of a product, indicating its suitability for use in the original manufacturer's equipment.

25 Katun states that, since such a comparison is being made, it is irrelevant whether prices are also being compared. The Austrian Government submits in that regard that there is no price comparison since the setting out of product numbers alongside each other does not reveal the prices of the products. The Commission, on the other hand, takes into consideration the order form containing the prices to which Katun catalogues refer and submits that in the case in point there is solely a comparison of prices.

26 The French Government points out that the definition of comparative advertising in Article 2(2a) of Directive 84/450 as amended does not require that there be a comparison. Either the Community legislature wished to avoid tautology, or identification of the competitor is sufficient to introduce a comparison since any potential customer can himself obtain information concerning the features of the products, or the concept of a comparison has to be taken into account only at the stage where the lawfulness of the comparative advertising is assessed.

27 Having settled on the last of these interpretations, the French Government examines the scope of the conditions laid down in Article 3a of Directive 84/450 as amended. Since that article uses the expression 'as far as the comparison is concerned', it may be that the conditions which it lays down do not have to be satisfied where there is no comparison. In that case, the advertising at issue in the main proceedings may not be unlawful for the purposes of Article 3a but, on the other hand, be misleading within the meaning of Article 3 of the directive. However, Article 3a may also signify that the conditions which it lays down must be satisfied as soon as there is comparative advertising within the meaning of Article 2(2a). Examining the question from that point of view, the French Government submits that one may question the usefulness to customers of having lists which merely establish that product reference numbers tally with each other.

Findings of the Court

28 As regards, first, the definition of comparative advertising, it must be observed that, according to Article 2(1) of Directive 84/450 as amended, 'advertising' means, for the purposes of that directive, the making of a representation in any form in connection with a trade, business, craft or profession in order to promote the supply of goods or services, including immovable property, rights and obligations. In view of that especially broad definition, advertising, including comparative advertising, may occur in very different forms.

29 As regards the 'comparative' nature of advertising within the meaning of Directive 84/450 as amended, it is apparent from Article 2(2a) that the test is that comparative advertising identifies, explicitly or by implication, a competitor or goods or services offered by a competitor.

30 Likewise, as far as that test is concerned, the Community legislature has laid down a broad definition, as is confirmed by the sixth recital of the preamble to Directive 97/55, which states that the legislature wished to lay down a broad concept of comparative advertising so as to cover all its forms.

31 In order for there to be comparative advertising within the meaning of Article 2(2a) of Directive 84/450 as amended, it is therefore sufficient for a representation to be made in any form which refers, even by implication, to a competitor or to the goods or services which he offers. It does not matter that there is a comparison between the goods and services offered by the advertiser and those of a competitor.

32 As regards, second, the conditions under which comparative advertising is lawful, it must be observed that they are laid down in Article 3a of Directive 84/450 as amended. Amongst those conditions, Article 3a(1)(c) requires that this type of advertising should objectively compare one or more material, relevant, verifiable and representative features of the goods and services, which may include price.

33 It follows from a comparison of Article 2(2a) of Directive 84/450 as amended, on the one hand, and Article 3a of that directive, on the other, that, on a literal interpretation, they would render unlawful any reference enabling a competitor, or the goods or services which he offers, to be identified in a representation which did not contain a comparison within the meaning of Article 3a. That would have to be the case where there were mere mention of the trade mark of the manufacturer of the original models or of the reference numbers of models for which the spare parts and consumable items are manufactured. In the main proceedings, Toshiba Europe does not contest Katun's use of such marks or reference numbers.

34 However, it is apparent from 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) and the case-law of the Court (Case C-63/97 *BMW* [1999] ECR I-905, paragraphs 58 to 60) that the use of another person's trade mark may be legitimate where it is necessary to inform the public of the nature of the products or the intended purpose of the services offered.

35 A literal interpretation of Directive 84/450 as amended results in a contradiction with Directive 89/104 and cannot therefore be accepted.

36 In those circumstances, it is necessary to take account of the objectives of Directive 84/450 as amended. According to the second recital of the preamble to Directive 97/55, comparative advertising will help demonstrate objectively the merits of the various comparable products and thus stimulate competition between suppliers of goods and services to the consumer's advantage.

37 For those reasons, the conditions required of comparative advertising must be interpreted in the sense most favourable to it.

38 In a situation such as that in the main proceedings, specification of the product numbers of the equipment manufacturer alongside a competing supplier's product numbers enables the public to identify precisely the products of the equipment manufacturer to which that supplier's products correspond.

39 Such an indication does however constitute a positive statement that the two products have equivalent technical features, that is to say, a comparison of material, relevant, verifiable and representative features of the products within the meaning of Article 3a(1)(c) of Directive 84/450 as amended.

40 The answer to Question 1 and Question 2(a) must therefore be that, on a proper construction of Articles 2(2a) and 3a(1)(c) of Directive 84/450 as amended, the indication, in the catalogue of a supplier of spare parts and consumable items suitable for the products of an equipment manufacturer, of product numbers (OEM numbers) by which the equipment manufacturer designates the spare parts and consumable items which he himself sells may constitute comparative advertising which objectively compares one or more material, relevant, verifiable and representative features of goods.

Question 2(b) and Question 3

41 By Question 2(b) and Question 3, the national court asks in substance whether, on a proper construction of Article 3a(1)(g) of Directive 84/450 as amended, product numbers (OEM numbers) of an equipment manufacturer are distinguishing marks within the meaning of that provision and whether their use in catalogues of a competing supplier enables the latter to take unfair advantage of the reputation attached to them.

42 Under Article 3a(1)(g) of Directive 84/450 as amended, comparative advertising is to be permitted where, *inter alia*, it does not take unfair advantage of the reputation of a trade mark, trade name or the distinguishing marks of a competitor or the designation of origin of competing products.

43 Toshiba Europe, the French and Austrian Governments and the Commission submit that the product numbers of an equipment manufacturer can be regarded as distinguishing marks within the meaning of Article 3a(1)(g) of Directive 84/450 as amended, where the relevant public identifies the manufacturer's products by means of those numbers. Katun, on the other hand, submits that a manufacturer uses those numbers in order to differentiate between his own products and not to distinguish them from the products of other manufacturers. They are not therefore 'distinguishing marks' within the meaning of that provision.

44 Toshiba Europe submits that, for the use of a distinguishing mark to take unfair advantage of the reputation attached to it, it suffices that such use is not 'necessary' within the meaning of Article 6(1)(c) of Directive 89/104. In the case in point, the use of the equipment manufacturer's product numbers is not necessary since the competing supplier could describe the product which he sells and indicate the model for which the product is suitable.

45 The French Government submits that advertising which cites an equipment manufacturer's product numbers takes unfair advantage of the reputation attached to them if the advertising does not have an objective comparative purpose and *a fortiori* where it is apt to create confusion.

46 Katun and the Austrian Government emphasise the need for rapid and reliable identification of spare parts and consumable items. According to Katun, the indication of the product numbers of various manufacturers enables a rapid comparison to be made between the prices of products and can thereby help to stimulate competition.

47 According to the Commission, the fact that a supplier uses the product numbers of an equipment manufacturer does not of itself establish that the supplier is taking unfair advantage of the reputation of a distinguishing mark.

48 With regard to the distinctiveness of a mark, the Court has already held that 'in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings' (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 22).

49 In the same way, a sign used by an undertaking may be a 'distinguishing mark' within the meaning of Article 3a(1)(g) of Directive 84/450 as amended if the public identifies it as coming from a particular undertaking.

50 As regards product numbers used by an equipment manufacturer to identify spare parts and consumable items, it is not established that, in themselves, that is to say when they are used alone without an indication of the manufacturer's trade mark or the equipment for which the spare parts and consumable items are intended,

they are identified by the public as referring to the products manufactured by a particular undertaking.

51 They are in fact combinations of numbers or of letters and numbers and it is questionable whether they would be identified as product numbers of an equipment manufacturer if they were not found, as in the present case, in a column headed 'OEM product number'. Likewise, it may be wondered whether those combinations would enable the manufacturer to be identified if they were not used in combination with his trade mark.

52 However, it is for the national court to determine whether the equipment manufacturer's product numbers in question in the case before it are distinguishing marks within the meaning of Article 3a(1)(g) of Directive 84/450 as amended, in the sense that they are identified as coming from a particular undertaking. In order to do so, it will have to take into account the perception of an average individual who is reasonably well informed and reasonably observant and circumspect. Account should be taken of the type of persons at whom the advertising is directed. In the present case, those persons appear to be specialist traders who are much less likely than final consumers to associate the reputation of the equipment manufacturer's products with those of the competing supplier.

53 Even assuming that the equipment manufacturer's product numbers are, as such, distinguishing marks within the meaning of Article 3a(1)(g) of Directive 84/450 as amended, it will in any event be necessary, when assessing whether the condition laid down in that provision has been observed, to have regard to the 15th recital of the preamble to Directive 97/55, which states that the use of a trade mark or distinguishing mark does not breach the right to the mark where it complies with the conditions laid down by Directive 84/450 as amended, the aim

being solely to distinguish between the products and services of the advertiser and those of his competitor and thus to highlight differences objectively.

54 An advertiser cannot be considered as taking unfair advantage of the reputation attached to distinguishing marks of his competitor if effective competition on the relevant market is conditional upon a reference to those marks.

55 Further, the Court has already held that a third party's use of a mark may take unfair advantage of the distinctive character or the reputation of the mark or be detrimental to them, for example by giving the public a false impression of the relationship between the advertiser and the trade mark owner (see the judgment in *BMW*, cited above, paragraph 40).

56 As stated in paragraph 39 above, the indication of an equipment manufacturer's product numbers alongside a competing supplier's product numbers constitutes a positive statement that the technical features of the two products are equivalent, that is to say, it is a comparison within the meaning of Article 3a(1)(c) of Directive 84/450 as amended.

57 It is, however, necessary to determine also whether that indication could cause the public to associate the equipment manufacturer, whose products are those identified, with the competing supplier, in that the public might associate the reputation of that manufacturer's products with the products of the competing supplier.

58 In order to make that determination, the overall presentation of the advertising at issue must be considered. The equipment manufacturer's product number may be only one of several indications in it relating to that manufacturer and his products. The trade mark of the competing supplier and the specific nature of his products may also be highlighted in such a way that no confusion or association is possible between the manufacturer and the competing supplier or between their respective products.

59 In the present case, it appears that Katun would have difficulty in comparing its products with those of Toshiba Europe if it did not refer to the latter's order numbers. It also seems clear from the examples of Katun's lists of spare parts and consumable items set out in the order for reference that a clear distinction is made between Katun and Toshiba Europe, so that they do not appear to give a false impression concerning the origin of Katun's products.

60 In the light of those considerations, the answer to be given to Question 2(b) and Question 3 is that, on a proper construction of Article 3a(1)(g) of Directive 84/450 as amended, where product numbers (OEM numbers) of an equipment manufacturer are, as such, distinguishing marks within the meaning of that provision, their use in the catalogues of a competing supplier enables him to take unfair advantage of the reputation attached to those marks only if the effect of the reference to them is to create, in the mind of the persons at whom the advertising is directed, an association between the manufacturer whose products are identified and the competing supplier, in that those persons associate the reputation of the manufacturer's products with the products of the competing supplier. In order to determine whether that condition is satisfied, account should be taken of the overall presentation of the advertising at issue and the type of persons for whom the advertising is intended.

Costs

61 The costs incurred by the French and Austrian Governments and by the Commission, which have submitted observations to the Court are not recoverable. Since these proceedings are for the parties in the main proceedings, a step in the proceedings pending before the national court the decision on costs is a matter for that court.

On those grounds,

THE COURT (Fifth Chamber),

in answer to the questions referred to it by the Landgericht Düsseldorf by order of 19 January 1999, hereby rules:

1. **On a proper construction of Articles 2(2a) and 3a(1)(c) of Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising, as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997, the indication, in the catalogue of a supplier of spare parts and consumable items suitable for the products of an equipment manufacturer, of product numbers (OEM numbers) by which the**

equipment manufacturer designates the spare parts and consumable items which he himself sells may constitute comparative advertising which objectively compares one or more material, relevant, verifiable and representative features of goods.

2. On a proper construction of Article 3a(1)(g) of Directive 84/450 as amended by Directive 97/55, where product numbers (OEM numbers) of an equipment manufacturer are, as such, distinguishing marks within the meaning of that provision, their use in the catalogues of a competing supplier enables him to take unfair advantage of the reputation attached to those marks only if the effect of the reference to them is to create, in the mind of the persons at whom the advertising is directed, an association between the manufacturer whose products are identified and the competing supplier, in that those persons associate the reputation of the manufacturer's products with the products of the competing supplier. In order to determine whether that condition is satisfied, account should be taken of the overall presentation of the advertising at issue and the type of persons for whom the advertising is intended.

Jann Edward La Pergola

Sevón Wathelet

Delivered in open court in Luxembourg on 25 October 2001.

R. Grass P. Jann

Registrar President of the Fifth Chamber