Reports of Cases

OPINION OF ADVOCATE GENERAL
SAUGMANDSGAARD ØE
delivered on 15 July 2021 [1]

Case C-123/20

Ferrari SpA
v
Mansory Design & Holding GmbH,
WH

(Request for a preliminary ruling from the Bundesgerichtshof (Federal Court of Justice, Germany))

(Reference for a preliminary ruling – Community designs – Regulation (EC) No 6/2002 – Unregistered Community design – Appearance of a part of a product (*partial design*) – Article 3(a) – Part composed of elements of the bodywork of a sports car – Formal condition for obtaining protection – Making available to the public – Article 11(2) – Publication of overall views of the vehicle)

I. Introduction

1. The present request for a preliminary ruling, made by the Bundesgerichtshof (Federal Court of Justice, Germany), concerns the interpretation of Regulation (EC) No 6/2002 on Community designs. [2]

2. The request was submitted in the context of a dispute between (i) Ferrari SpA and (ii) Mansory Design & Holding GmbH ('Mansory Design') and WH, Mansory Design's chief executive officer.

3. Mansory Design manufactures and sells 'tuning kits' designed to make the Ferrari 488 GTB resemble the (more prestigious) Ferrari FXX K.

4. Ferrari brought infringement proceedings against Mansory Design and its chief executive officer, claiming that they had copied a number of unregistered Community designs, within the meaning of Article 1(2)(a) of Regulation No 6/2002, of which it claims to be the holder.

5. Apart from the attraction that it will inevitably have for sports car fans, the legal interest of this case lies in the fact that the subject of the Community design on which Ferrari primarily relies is not the overall appearance of the FXX K, but the appearance of a *part of that vehicle*, made up of

[1] Original language: French.

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

certain elements of bodywork. The referring court thus invites the Court to rule, for the first time, on the conditions in which the appearance of a part of a product – or '*partial design*' – may be protected as an unregistered Community design.

6. In that context, *first*, the question arises whether, in accordance with Article 11(2) of Regulation No 6/2002, in order to be protected as an unregistered Community design, the appearance of a part of the product must be specifically made available, or indeed if the making available of the design of that product in its entirety is sufficient in that respect. In the case in the main proceedings, Ferrari merely published a number of overall views of its FXX K model, the publication of which, in its submission, also amounts to the making available of the claimed design of the elements of bodywork.

7. *Second*, it falls to be ascertained whether, in order to be the subject of a separate Community design, distinct from that protecting, where applicable, the appearance of the product taken as a whole, the appearance of a part of a product must present a certain autonomy by comparison with the overall shape. In the main proceedings, Ferrari was criticised for having claimed a design right for an arbitrarily defined part of the FXX K.

8. In this Opinion, I shall explain, *first*, that the making available to the public, within the meaning of Article 11(2) of Regulation No 6/2002, of the overall design of a product also entails the making available of the design of a part of that product, provided that the latter design is clearly identifiable at the time when the design of the product is made available. *Second*, I shall set out the reasons why, in my view, the appearance of a part of the product may in itself be the subject of a Community design, separate from that protecting, where applicable, the appearance of the product taken as a whole, provided that, in accordance with the actual definition of 'design' in Article 3(a) of that regulation, it is defined by particular lines, contours, colours, shapes or texture that make it identifiable as such.

II. Legal framework

9. Recitals 16, 17, 21 and 25 of Regulation No 6/2002 are worded as follows:

'(16) Some [sectors of industry in the European Union] produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

(17) This calls for two forms of protection, one being a short-term unregistered design and the other being a longer-term registered design.

…

(21) The exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty. It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. Protection could not therefore extend to design products which are the result of a design arrived at independently by a second designer. This right should also extend to trade in products embodying infringing designs.

…

(25) Those sectors of industry producing large numbers of possibly short-lived designs over short periods of time of which only some may be eventually commercialised will find advantage in the unregistered Community design. …'

10. Article 1 of that regulation, entitled 'Community design', states, in paragraph 2(a):

'A design shall be protected:

(a) by an "unregistered Community design", if made available to the public in the manner provided for in this regulation'.

11. Article 3 of that regulation, entitled 'Definitions', provides:

'For the purposes of this regulation:

(a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

(b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

(c) "complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.'

12. Article 4 of that regulation, entitled 'Requirements for protection', states, in paragraphs 1 and 2:

'1. A design shall be protected by a Community design to the extent that it is new and has individual character.

2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and

(b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.'

13. Article 6 of Regulation No 6/2002, entitled 'Individual character', provides:

'1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:

(a) in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

…'

14. Article 11 of that regulation, entitled 'Commencement and term of protection of the unregistered Community design', provides:

'1. A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the [Union].

2. For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the [Union] if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the [Union]. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.'

15. Under Article 19 of that regulation, entitled 'Rights conferred by the Community design':

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

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

…'

III. The main proceedings, the questions referred for a preliminary ruling and the procedure before the Court

16. Ferrari is a racing car and sports car manufacturer established in Italy. Its top-of-the-range FXX K model, which has not been approved for use on the road, is intended solely to be driven on the track.

17. Ferrari first presented the FXX K to the public in a press release dated 2 December 2014. That press release included the following two photographs, showing, respectively, a side view and a front view of the vehicle:



18. The Ferrari FXX K, produced in limited numbers, exists in two versions, which are distinguished solely by the colour of the 'V' on the bonnet. In the first version, illustrated by the photographs reproduced above, that 'V' is black apart from its low point, which is the same colour as the basic colour of the vehicle. In the second version, the 'V' is entirely black in colour.

19. Mansory Design, of which WH is the chief executive officer, is an undertaking that specialises in the personalisation (known as 'tuning') of high-end cars. Mansory Design and WH are both established in Germany. Since 2016 Mansory Design has produced and marketed sets of personalisation accessories (known as 'tuning kits') designed to alter the appearance of the Ferrari 488 GTB (a road-going model, produced in a series, available since 2015) in such a way as to make it resemble the appearance of the Ferrari FXX K.

20. Mansory Design thus offers a number of 'tuning kits' which serve to transform the appearance of the Ferrari 488 GTB: the 'front kit', 'rear kit', 'side set', 'roof cover' and 'rear wing'. In addition, it offers two versions of the 'front kit', reflecting the two versions of the Ferrari FXX K: on the first version, the 'V' on the bonnet is black apart from its low point, while on the second version it is entirely black.

21. A complete conversion of the Ferrari 488 GTB involves replacing a large portion of the visible body panels. In March 2016, at the International Motor Show in Geneva (Switzerland), Mansory Design displayed a vehicle featuring that conversion under the name Mansory Siracusa 4XX.

22. Ferrari maintains that the marketing of those 'tuning kits' by Mansory Design constitutes an infringement of the rights conferred by one or more unregistered Community designs of which it is the holder.

23. Principally, Ferrari asserted that the marketing of the 'front kits' constitutes an infringement of the first unregistered Community design, covering the appearance of the part of its model FXX K consisting of the V-shaped element on the bonnet, the fin-like element protruding from the centre of that element and fitted lengthways (the 'strake'), the front lip spoiler integrated into the bumper and the vertical bridge in the centre connecting the spoiler to the bonnet. That section is seen as a unit that defines the specific 'facial features' of that vehicle and also creates an association with an aircraft or Formula 1 car. According to Ferrari, that unregistered Community design arose at the time of the publication of the press release of 2 December 2014.

24. In the alternative, Ferrari claimed to be the holder of a second unregistered Community design for the appearance of the front lip spoiler, which arose at the time of the publication of the press release or, at the latest, on the release of a film entitled 'Ferrari FXX K – The Making Of' on 3 April 2015, and which Mansory Design also infringed by selling its 'front kits'.

25. In the further alternative, Ferrari based its action on a third unregistered Community design for the presentation of the Ferrari FXX K as a whole, as revealed in another photograph of the vehicle, shown in an oblique view, which also appeared in the press release of 2 December 2014.

26. Ferrari also claimed, as regards the 'kits' offered for sale on the territory of the Federal Republic of Germany, rights based on protection against imitation under the law on unfair trading practices.

27. At first instance, Ferrari sought an injunction throughout the European Union against the making, offering, putting on the market, importing, exporting, using or stocking of the accessories at issue, and made a number of associated requests (provision of accounting documents, recall and destruction of the products and the award of financial compensation). The Landgericht (Regional Court, Germany) dismissed those claims in their entirety.

28. Before the appellate court, Ferrari stated that its requests for an injunction and its requests relating to the recall and destruction of the products, in so far as they were based on the rights conferred by the Community designs on which it relied, had become devoid of purpose, as the rights in question were to expire on 3 December 2017. [3] On the other hand, Ferrari maintained, in particular, its claims for compensation.

29. That court dismissed Ferrari's appeal. In particular, it held that Ferrari's claims based on the alleged unregistered Community designs were unfounded. According to that court, the first unregistered Community design claimed, relating to the part of the Ferrari FXX K described in point 23 of this Opinion, was non-existent, since Ferrari had not shown that the minimum requirement of a 'certain autonomy' and a 'certain consistency of form' was satisfied. Ferrari merely referred to an arbitrarily defined section of the vehicle. The second unregistered Community design claimed by Ferrari, covering the front lip spoiler, was also non-existent, on the ground that it too failed to satisfy the 'consistency of form' requirement. As to the third design, covering the overall appearance of the Ferrari FXX K, it did exist, but it had not been infringed by Mansory Design.

[3] See, in that regard, Article 11(1) of Regulation No 6/2002, reproduced in point 14 of this Opinion.

30. Ferrari then lodged an appeal on a point of law, which was declared admissible by the Bundesgerichtshof (Federal Court of Justice). That court considers that the outcome of that appeal, as concerns the claims based on infringement of the rights allegedly conferred by the unregistered Community designs claimed by Ferrari, depends on the interpretation of Regulation No 6/2002.

31. More specifically, it is necessary to clarify the conditions in which the appearance of part of a product may, in accordance with that regulation, enjoy protection as an unregistered Community design.

32. In that context, the referring court asks, *first*, whether the making available to the public, within the meaning of Article 11(2) of Regulation No 6/2002, of the image of a product in its entirety also amounts to the making available of the designs of the parts of that product.

33. Assuming that that is the case, the referring court asks, *second*, whether the appearance of a part of the product must, in order to be capable of constituting a separate design, separate from the overall appearance of the product, present, as the appellate court held, a 'certain autonomy' and a 'certain consistency in form', so that it possible to establish that the appearance of that part is not completely lost in the appearance of that product and presents, on the contrary, an overall autonomous impression by comparison with the form as a whole.

34. In those circumstances, the Bundesgerichtshof (Federal Court of Justice) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

'(1) Can unregistered Community designs in individual parts of a product arise as a result of disclosure of an overall image of a product in accordance with Article 11(1) and the first sentence of Article 11(2) of Regulation No 6/2002?

(2) If Question 1 is answered in the affirmative:

What legal criterion is to be applied for the purpose of assessing individual character in accordance with Article 4(2)(b) and Article 6(1) of Regulation (EC) No 6/2002 when determining the overall impression of a component part which – as in the case of a part of a vehicle's bodywork, for example – is to be incorporated into a complex product? In particular, can the criterion be whether the appearance of the component part, as viewed by an informed user, is not completely lost in the appearance of the complex product, but rather displays a certain autonomy and consistency of form such that it is possible to identify an aesthetic overall impression which is independent of the overall form?'

35. The request for a preliminary ruling, dated 30 January 2020, was registered on 4 March 2020. Ferrari, Mansory Design, the Czech, Italian and Polish Governments and the European Commission lodged written observations. Those parties and interested parties also replied in writing to the questions put by the Court on 15 January 2021.

IV. Analysis

36. As stated in Article 1, Regulation No 6/2002 provides for two categories of unitary titles: the 'registered Community design' and the 'unregistered Community design'. The substantive conditions for obtaining protection are the same for both. In particular, in accordance with Article 4(1) of that regulation, the design in question must be 'new' and have 'individual

character'. On the other hand, the formal conditions applicable to each of those titles differ. In order to obtain a 'registered Community design' it is necessary, by definition, to file an application for registration. Conversely, a design may be protected as an 'unregistered Community design' if it has been made available to the public, according to the procedures laid down in Article 11(2) of that regulation. [4]

37. In the present case, in the infringement action brought against Mansory Design and WH, Ferrari relies on various *unregistered* Community designs. As I indicated in the introduction to this Opinion, the particular feature of the present case is that the applicant in the main proceedings is claiming, notably, [5] such a Community design in the *appearance of a part* of the Ferrari FXX K, composed of various elements of bodywork – namely, the V-shaped element on the bonnet, the fin-like element protruding from the centre of that element and fitted lengthways (the 'strake'), the front lip spoiler integrated into the bumper and the vertical bridge in the centre connecting the spoiler to the bonnet. [6] Ferrari therefore claims rights on what is commonly called a partial design.

38. As the referring court observes, there can be scarcely any doubt that, in application of Regulation No 6/2002, the appearance of only a part of a product may in itself be the subject of an unregistered Community design.

39. In fact, the 'designs' capable of being the subject of a title are defined in Article 3(a) of Regulation No 6/2002 as 'the appearance of the whole *or a part of a product* resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation' (emphasis added).

40. That being the case, *first*, as I stated in point 36 of this Opinion, in order for the appearance of a part of a product to be capable of being protected as an unregistered Community design, it must have been made available to the public, in accordance with Article 11(2) of Regulation No 6/2002.

41. In the main proceedings, Ferrari merely published overall views of the Ferrari FXX K. [7] The referring court is therefore asking, by its first question, whether, in order to satisfy the 'making available' condition laid down in Article 11, Ferrari ought to have *made available separately* the design of the part of the bodywork for which it claims protection. I shall explain, in section A, why in my view that is not the case.

42. *Second*, the referring court is asking, by its second question, whether, in order to be capable of being the subject of a Community design, the appearance of a part of that product must present a 'certain consistency' and a 'certain autonomy' by comparison with the overall appearance of the product. The referring court wonders, in short, whether certain limits should be placed on the possibility, for a designer, to subdivide the appearance of his or her product into different parts, each benefiting from autonomous protection. I shall examine that delicate problem in section B.

43. Before doing so, I must nevertheless clarify a final point. Although the referring court referred, in its first question and in the grounds of the order for reference, to the concept of 'a part of a product', as provided for in Article 3(a) of Regulation No 6/2002, it also stated that the

4 See Article 1(2)(a) and (b) of Regulation No 6/2002.

5 In this Opinion, I shall take as a factual hypothesis for my analysis the design *primarily* claimed by Ferrari in support of its claims, leaving aside, except where it is necessary to mention them, the designs relied on in the alternative and in the further alternative.

6 See point 23 of this Opinion.

7 See point 17 of this Opinion.

elements of the bodywork of the Ferrari FXX K at issue in the main proceedings constituted 'component parts of a complex product', within the meaning of Article 3(c) and Article 4(2) of that regulation.

44. I recall that the Court stated, in the judgment in *Acacia and D'Amato*,[8] that, in the absence of a definition in Regulation No 6/2002, the concept of 'component parts of a complex product' covers multiple components, intended to be assembled into a complex industrial or handicraft item, which can be replaced permitting disassembly and re-assembly of such an item, without which the complex product could not be subject to normal use.

45. The Court thus held that a car wheel rim must be classified as a 'component part of a complex product', since such a wheel rim is a component of a complex product which a car constitutes, without which that product could not be subject to normal use.[9]

46. Likewise, in my view, elements of bodywork must be classified as 'component parts of a complex product' if those elements can be replaced and if their presence is necessary for the normal use of the vehicle concerned.

47. Ferrari nevertheless disputed that classification as 'component parts' within the meaning of Article 3(c) and Article 4(2) of Regulation No 6/2002, on the ground that the elements of bodywork covered by the designs at issue in the main proceedings do not satisfy those criteria.

48. It is clearly not for the Court to settle that issue, which is part of the assessment of the facts. It would be for the referring court to verify it, should that be necessary.

49. Nonetheless, when questioned on that point by the Court, the parties and the interveners are agreed that the answer to that question is not of decisive importance for the answers to the questions submitted by the referring court.

50. In fact, as Ferrari and the Polish Government observe, in essence, a 'design' within the meaning of Article 3(a) of Regulation No 6/2002 may consist in the appearance of both a product and part of a product, including of a component part of a complex product, or even of a part of such a component part.

51. All that matters for the purposes of the questions referred in the present case, to my mind, is that Ferrari is relying on the appearance of a 'part of a product' as an unregistered Community design. Whether that product is 'complex' and whether the part in question does or does not consist of elements corresponding to the definition of 'component parts' of such a product is not, however, decisive for the answer to those questions. I shall therefore refer, in the following paragraphs, essentially to the concepts of 'product' and 'a part of a product'.

8 Judgment of 20 December 2017 (C-397/16 and C-435/16, EU:C:2017:992, paragraph 65).

9 See judgment of 20 December 2017, *Acacia and D'Amato* (C-397/16 and C-435/16, EU:C:2017:992, paragraph 66).

A. The making available to the public, within the meaning of Article 11(2) of Regulation No 6/2002, of the designs of parts of a product (first question)

52. By its first question, the referring court is asking, in essence, whether Article 11(2) of Regulation No 6/2002 must be interpreted as meaning that the making available to the public of the overall design of a product, such as the appearance of a vehicle, may also entail the making available to the public of the design of a part of that product, such as the appearance of certain elements of the bodywork of that vehicle and, if so, in what circumstances.

53. In the main proceedings, the referring court has established that, in publishing two overviews of its FXX K model, Ferrari made available to the public, within the meaning of Article 11(2) of Regulation No 6/2002, the design of that vehicle in its entirety. The conditions laid down in that provision are therefore satisfied in so far as that design is concerned. [10]

54. Nevertheless, the referring court is of the view that that making available is capable of giving rise to protection solely with regard to the overall design of the FXX K. It would not amount to the making available of the designs of the component parts of that vehicle. In the referring court's view, in which it is supported by Mansory Design, the Polish Government and the Commission, the appearance of such a part of a product, in order to be itself protected as an unregistered Community design, should be *made available separately*. That interpretation of Article 11(2) of Regulation No 6/2002 would ensure legal certainty by allowing the public, and in particular economic operators, to determine readily and without ambiguity, on the basis of the images made available by the rightholder, the subject of the protection which it claims.

55. In practice, Ferrari ought therefore to have published, in addition to its overall photographs of the FXX K, one or more images specifically focusing on the part of that vehicle for which it claims protection as an unregistered Community design, or to have used, on those overall photographs, a sign allowing the design concerned to be easily identified, such as colours, contrasts, arrows or lines defining the elements in question.

56. I do not share that view. Like Ferrari and the Czech and Italian Governments, I consider that the making available to the public, within the meaning of Article 11(2) of Regulation No 6/2002, of the overall design of a product may also entail the making available of the design of a part of that product. In other words, it is not necessary, in all situations, to make a part of a product available separately in order for the design of such a part to be capable of being protected as an unregistered Community design.

57. In that regard, and *in the first place*, I observe that Article 11 of Regulation No 6/2002 does not contain any specific rule concerning the making available of the design of a part of a product.

58. More precisely, Article 11(2) of that regulation defines a single criterion for the purpose of determining whether a design has been made available to the public, which applies to all designs – whether they are applied to or incorporated in products or parts of a product – namely that the design has been 'published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned'.

[10] In particular, it must be taken as a fact that the specialist circles could reasonably have become aware of the publication of the photographs in question.

59. As Ferrari and the Czech and Italian Governments have correctly submitted, the words of that provision do not therefore require that the designs of parts of a product be specifically made available to the public. Nothing in the wording of that provision tends to exclude the possibility that the publication of a single same image entails the making available of the design of a product in its entirety and that of the design of the parts of that product. It would have been open to the EU legislature to formulate a condition to that effect, had that been its intention.

60. *In the second place*, it is clear from Article 11(2) that a design is 'made available' when it is made public by events which, in the normal course of business, could 'reasonably have become known to the circles specialised' [11] in the sector concerned, operating within the European Union. In essence, it must therefore be ascertained whether those specialised circles could reasonably have become aware of the design in question. [12]

61. I am of the view that, in certain circumstances, the specialised circles may reasonably become aware of the appearance of a part of a product when the overall appearance of that product is made available to the public, as Ferrari has claimed.

62. The circumstances of the dispute in the main proceedings provide a good illustration in that respect. I recall that the event on which Ferrari relies as having made the design available is the publication of two photographs of the FXX K, including a front view. [13] The latter photograph reveals, in particular, the appearance of the bonnet and the spoiler of that vehicle.

63. Consequently, and subject to the assessment of the facts, which is within the jurisdiction of the national court, it seems to me that, as a result of the publication of the photograph in question, [14] the specialised circles could reasonably have become aware of the design of the part claimed by Ferrari – including the V-shaped element on the central part of the bonnet of the Ferrari FXX K. Likewise, the publication of a side view of that vehicle could reasonably have allowed them to become aware of, for example, the design of the wheel rims attached to that vehicle.

64. Of course, as the Czech Government has observed, in order for the making available to the public of the design of a product taken as a whole to entail the making available of the design of a part of that product, it is essential that the appearance of that part is *clearly identifiable* when that event whereby the design is made available takes place. [15] If not, the specialised circles cannot reasonably become aware of it on that occasion, as required by Article 11(2) of Regulation No 6/2002.

[11] See, concerning the concept of 'circles specialised [in the sector]', judgment of 13 February 2014, *H. Gautzsch Großhandel* (C-479/12, EU:C:2014:75, paragraphs 27 to 30).

[12] Although the words of Article 11(2) of Regulation No 6/2002 refer to whether the *event whereby the design was made available* (publication, exhibition, etc.) could reasonably have become known to circles specialised in the sector, it seems to me that that criterion is intended, more broadly, to determine whether those circles might reasonably have become aware of the *design* in question. See, to that effect, judgment of 13 February 2014, *H. Gautzsch Großhandel* (C-479/12, EU:C:2014:75, paragraphs 25 and 29).

[13] See point 17 of this Opinion.

[14] I recall, in that regard, that it is established that the circles specialised in the sector could reasonably have become aware of that publication (see footnote 10 to this Opinion).

[15] See, for an analogous interpretation, Ruhl, O., Tolkmitt, J., *Gemeinschaftsgeschmackmuster – Taschenkommentar – 3. Auflage*, Wolters Kluwer, Alphen aan den Rijn, 2019, p. 423.

65. In other words, when, as in this instance, the event whereby the design is made available consists in the publication of a photograph of a product, the characteristics of the design of the part relied on – such as its lines, contours, colours, etc.[16] – must be *clearly visible* on that photograph.

66. Thus, it is clear that, for example, the publication of an image of the rear of the Ferrari FXX K could not have resulted in the design of the V-shaped element on the bonnet of that vehicle being made available. Similarly, it must be considered that the design is not made available when the appearance of the part in question cannot be clearly identified by the specialised circles on the image published, in particular because the reproduction is too small, of poor quality or partly concealed by another element.

67. Fundamentally, there is nothing original here, since that requirement of clarity applies, in my view, to the making available of *any* design, for the purposes of Article 11(2) of Regulation No 6/2002, irrespective of whether the design in question is of a non-complex product, a complex product or a part of a product. Whatever the situation, the design is deemed to have been made available to the public only if it could, in the normal course of business, reasonably have become known to the circles specialised in the sector concerned.[17] To my mind, that condition necessarily implies that the event whereby the design is made available reveals that design in a sufficiently *clear* manner.

68. *In the third place*, it is clear from recitals 16 and 25 of Regulation No 6/2002 that, in establishing the unitary title which the unregistered Community design constitutes, the EU legislature intended, with a view to encouraging innovation,[18] to protect designs applied to or incorporated in products which frequently have a short market life[19] and for which their designers wish to obtain rapid and efficient protection without the burden of registration formalities.

69. Thus, under Article 1(2)(a) of Regulation No 6/2002, provided that the substantive conditions for obtaining protection are satisfied, designs are automatically protected as unregistered Community designs from the time when they are made available to the public, on the conditions laid down in Article 11(2) of that regulation, without further formalities.

70. As Ferrari and the Czech and Italian Governments rightly maintain, a requirement for designers to make available each part of their products separately in order to be able to enjoy specific protection for the designs of those parts would be contrary to the objective of simplicity

[16] I recall that, in the words of Article 3(a) of Regulation No 6/2002, 'design' means 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

[17] See footnote 12 to this Opinion.

[18] Generally, in establishing a unified system of Community design, the EU legislature wished to offer efficient and uniform protection throughout the territory of the Member States to the industrial aesthetic, in order to promote the contribution of individual designers to the sum of EU excellence in the field and to encourage innovation and the development of new products and investment in their production. See recitals 1, 5, 7 and 29 of Regulation No 6/2002 and judgments of 27 September 2017, *Nintendo* (C-24/16 and C-25/16, EU:C:2017:724, paragraph 73), and of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172, paragraph 28).

[19] Contrary to the Polish Government's submissions, the fact that the unregistered Community design was introduced in consideration of products with a short economic life cycle – typically those whose appearance changes rapidly in line with fashions, such as clothing – does not preclude the appearance of part of a vehicle such as the Ferrari FXX K, which does not prima facie come within that category of product, being protected on that basis. On that point, it is sufficient to observe that the EU legislature did not lay down restrictions, in Regulation No 6/2002, with respect to the types of products the appearance of which may be protected as an unregistered Community design.

and rapidity which, as I have just stated, justified the establishment of the unregistered Community design.[20] Such a requirement would amount to introducing formality in a regime which is supposed to be formality-free.

71. The interpretation which I suggest is, *in the fourth place*, supported by an argument of a systematic nature.

72. In that regard, the making available of a design has two legal consequences in Regulation No 6/2002. *First*, as we have seen, the making available of a design may give rise to protection as an unregistered Community design. *Second*, in the context of the examination of the substantive conditions for obtaining protection as a Community design – registered or unregistered – the fact that an identical design, or one which gives the same overall impression as the design for which that protection is claimed, was previously made available has the consequence of 'destroying' the novelty (Article 5 of Regulation No 6/2002) and/or the individual character (Article 6 of that regulation) of the latter design – and, in doing so, of precluding the benefit of that protection. For the purposes of that examination, the definition of the events whereby a design is made available, set out in Article 7(1) of that regulation, is similar to that set out in Article 11(2).[21] Those two provisions contain, in particular, the same criteria concerning the awareness of specialised circles.[22] Therefore, in the absence of any indication of an intention to the contrary on the part of the EU legislature, the 'making available' condition must be assessed in the same way in the context of each of those provisions.

73. As Ferrari claims, if the Court were to hold, in the present case, that the publication by a designer of a photograph representing a product in its entirety does not count as the making available of the design of a part of that product, even though specialised circles could reasonably have become aware of that photograph and though that design is clearly identifiable in the photograph, the consequence would be that a third party might itself subsequently be able to claim protection of that design as a Community design. On that interpretation, the initial publication would not be considered to be an earlier 'making available' that 'destroyed' novelty, within the meaning of Article 7(1) of Regulation No 6/2002, providing an obstacle to such a claim. That interpretation would encourage not *innovation* in designs, as envisaged in recital 7 of that regulation, but the *copying* of existing designs.[23]

74. On the other hand, and in *fifth place*, I am not convinced by the argument put forward by the referring court, and supported by Mansory Design, the Polish Government and the Commission, that the requirements of legal certainty would preclude the interpretation suggested above. According to that argument, already set out in point 54 of this Opinion, if the making available of the appearance of an entire vehicle had the consequence of giving rise to unregistered Community design rights in the parts or component parts of that vehicle, such as the bumpers, headlights, etc., it would be difficult for economic operators to determine the subject of the protection claimed by the designer. Such uncertainty might well discourage innovation.

[20] See judgment of 19 June 2014, *Karen Millen Fashions* (C-345/13, EU:C:2014:2013, paragraph 42).

[21] Article 7(1) of Regulation No 6/2002 provides: 'For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published … or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the [European Union]. …'

[22] With the sole difference that that criterion is formulated in negative terms in the first provision, whereas it is formulated in positive terms in the second.

[23] In practice, that interpretation would encourage economic operators to scrutinise, for example, images of products published in specialist magazines in order to pick up designs of parts of products and, where appropriate, themselves apply to register those appearances as Community designs.

75. In order to be clear, from a factual viewpoint, I obviously agree that making the design of a part of a product available separately allows legal certainty to be increased, whether for users or for the creator of the design in question. It is thus open to designers to make their designs of parts of products available separately. In this instance, Ferrari would have been able to demonstrate more readily that, in accordance with Article 11(2) of Regulation No 6/2002, the specialised circles could reasonably have become aware of the design in question. [24]

76. However, to require designers, in the interest of the legal certainty of third parties, to make their designs available separately would amount, in my view, to disregarding the equilibrium desired by the EU legislature in the context of the regime for unregistered Community designs, which *by nature* means a reduction in the level of legal certainty by comparison with the certainty resulting from registered Community designs.

77. In that connection, the fact that, as I have stated, unregistered Community designs are, by definition, not the subject of an application for registration inevitably entails a certain degree of legal uncertainty for third parties. Economic operators do not have, in that respect, a public register that allows them to obtain clear and precise information about existing rights in respect of a particular design, as is the case for registered designs. [25] The lack of registration thus makes it more difficult to identify in advance the precise subject of the protection claimed. [26] It will frequently be only in the context of infringement proceedings that the designer will specify whether he is claiming the overall appearance of the product in question or only that of a part of that product. [27]

78. Conversely, the level of protection and, accordingly, of legal certainty enjoyed by the designer is also lower. *First*, the protection afforded to the holder of an unregistered design has a limited scope, as Ferrari correctly observes. From a substantive viewpoint, in accordance with Article 19(2) of Regulation No 6/2002, the holder is protected *solely* against the 'copying' of his design. [28]

79. *Second*, the duration of the protection afforded by an unregistered Community design is relatively short, since under Article 11(1) of Regulation No 6/2002 it is limited to three years from the date on which the design concerned was first make available to the public. [29]

[24] In other words, specifically making the design of a part of a product available may constitute a *practical* means for a designer to ensure that that design becomes known in circles specialised in the field.

[25] See judgment of 5 July 2018, *Mast-Jägermeister* v *EUIPO* (C-217/17 P, EU:C:2018:534, paragraphs 52 to 54). The precise purpose of the protection conferred by a registered design must be established specifically at the time of its registration. Thus, even if that question is not relevant for the outcome of the dispute in the main proceedings, it is precluded, in my view, in the light of Articles 35 and 36 of Regulation No 6/2002, which refer to the registration of *a* design, in the singular, that an application for registration for the overall design of a product may also be valid, indirectly, for the design of a part of that product, as the referring court has also emphasised. In addition, Article 37 of that regulation expressly governs multiple applications.

[26] See judgment of 19 June 2014, *Karen Millen Fashions* (C-345/13, EU:C:2014:2013, paragraph 43).

[27] Where appropriate, an applicant in infringement proceedings may, to that end, emphasise, on the image which he provides in support of his application, the design claimed by means of colours, contrasts, arrows or lines defining the design in question. That allows the court and the defendant readily to understand the precise subject of the protection claimed. In that regard, Article 85(2) of Regulation No 6/2002 provides that, in the context of an infringement action, in order to benefit from the presumption of validity of the alleged unregistered Community design, the applicant must indicate what constitutes the individual character of that design. The Court has already held that precisely this condition 'arise[s] from the need to determine, with regard to [unregistered Community designs], … specifically what is covered [by the protection claimed]' (judgment of 19 June 2014, *Karen Millen Fashions* (C-345/13, EU:C:2014:2013, paragraph 43)).

[28] By comparison, the registered Community design affords protection against any 'use', which is defined in Article 19(1) of Regulation No 6/2002. In that regard, it is apparent from recital 21 of that regulation that the EU legislature thus intended to give greater legal certainty to that type of design by comparison with the unregistered Community design.

[29] By contrast, in accordance with Article 12 of Regulation No 6/2002, protection of a registered Community design may be for up to 25 years from the date of filing.

80. Incidentally, I do not think that there is any need to exaggerate the risks in terms of legal certainty and innovation involved in the interpretation proposed above, according to which the making available to the public of the overall design of a product may in itself entail the making available of the design of a part of that product.

81. *First*, as I have explained in points 64 to 67 of this Opinion, the criterion of becoming known by the specialised circles assumes that the design of the part of a product is *clearly identifiable* when the design of the product as a whole is made available, which reduces the risk of legal uncertainty.

82. *Second*, as regards innovation, apart from what I have already explained in point 73 of this Opinion, it must be borne in mind that, in accordance with the second subparagraph of Article 19(2) of Regulation No 6/2002, the use of an unregistered Community design by a third party without the holder's consent is not to be deemed to result from the 'copying' of the design in question 'if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with [that] design'.

83. Thus, designers may continue to innovate without fear of inadvertently infringing unregistered Community designs. Even on the assumption that they create designs producing an overall visual impression identical to that of a protected design that was previously made available,[30] they will be able to demonstrate that they acted in good faith[31] and thus avoid any liability.

84. Nor, *in the last place*, is the interpretation suggested in this Opinion called in question, in my view, by the argument put forward by Mansory Design, the Polish Government and the Commission that a photograph reproducing not only the design of the part of a product that is claimed, but the overall appearance of that product would not permit a determination as to whether that design satisfies the substantive conditions for obtaining protection as a Community design.

85. Admittedly, as the Courts of the European Union have held in the context of applications for a declaration that registered Community designs are invalid,[32] in order to assess the novelty and the individual character of the design claimed, it must be possible to compare it, in a reliable manner, with the earlier design relied on by the applicant for a declaration of invalidity. To that end, it is essential to have an image of the earlier design that allows it to be identified precisely and with certainty. The applicant for a declaration of invalidity must therefore supply one or more precise

30 See Article 10 of Regulation No 6/2002 and points 94 and 95 of this Opinion.

31 I would note that the onus of proving that the contested use results from 'copying' that design rests with that holder, whereas the onus of proving that use 'results from an independent work of creation' rests with the defendant. See judgment of 13 February 2014, *H. Gautzsch Großhandel* (C-479/12, EU:C:2014:75, paragraph 41).

32 See Article 24 et seq. of Regulation No 6/2002. It follows from Article 24(3) of that regulation that, in the case of an unregistered Community design, compliance with the substantive conditions for obtaining protection will be examined by the court where a counterclaim to an action for a declaration of invalidity is lodged by the defendant in an action alleging infringement of the Community design in question.

and complete reproductions of the design.[33] Likewise, it is necessary to have a reproduction of the design claimed that is of a quality sufficient to distinguish clearly the details of the object for which protection is sought.[34]

86. To my mind, however, a photograph reproducing the appearance of a product in its entirety allows such a comparison to be made as regards the design of a part of that product where, as I stated in points 64 to 66 of this Opinion, the characteristics of that design are *clearly visible* on that photograph. Such a reproduction makes it possible to grasp that design, to discern any aesthetic or ornamental differences by comparison with an earlier design and, in doing so, assess the novelty and individual character thereof. Conversely, that is not the case when the reproduction is too small or of poor quality or when the design claimed is partly hidden by another element.[35]

87. In the light of the foregoing considerations, I propose that the Court's answer to the first question be that Article 11(2) of Regulation No 6/2002 must be interpreted as meaning that the making available to the public of the full design of a product, such as the appearance of a vehicle, also entails the making available to the public of the design of a part of that product, such as the appearance of certain elements of the bodywork of that vehicle, provided that the latter design is clearly identifiable at the time when that design is made available.

B. The possibility of claiming protection for the design of 'a part of a product' within the meaning of Article 3(a) of Regulation No 6/2002 (second question)

88. In the event that the Court should answer the first question in the affirmative, as I suggest, the referring court asks, by its second question, about the legal criterion to be applied, in the examination of individual character within the meaning of Article 4(2)(b) and Article 6(1) of Regulation No 6/2002, in order to determine the overall impression produced by the design of component parts incorporated into a complex product, such as parts of a vehicle's bodywork.

89. I have explained, in points 43 to 51 of this Opinion, the reasons why in my view it is immaterial, in the present case, whether the part of the Ferrari FXX K the appearance of which Ferrari claims as an unregistered Community design is or is not made up of 'component parts' incorporated into a 'complex product'. I shall therefore continue to refer, in this section, to the concept of 'a part of a product'.

90. Some explanations of a general nature are called for in order properly to understand this second question.

[33] See, in particular, judgments of 21 September 2017, *Easy Sanitary Solutions and EUIPO* v *Group Nivelles* (C-361/15 P and C-405/15 P, EU:C:2017:720, paragraphs 64 and 65, and of 24 October 2019, *Atos Medical* v *EUIPO – Andreas Fahl Medizintechnik-Vertrieb (Medical patches)* (T-559/18, not published, EU:T:2019:758, paragraphs 40 and 43).

[34] See, as regards applications for registration of designs, Article 4(1)(e) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs (OJ 2002 L 341, p. 28), and judgment of 5 July 2018, *Mast-Jägermeister* v *EUIPO* (C-217/17 P, EU:C:2018:534, paragraphs 47 to 55).

[35] Contrary to Mansory Design's contention, the situation at issue in the present case is in no way comparable to that dealt with in the judgment of 21 September 2017, *Easy Sanitary Solutions and EUIPO* v *Group Nivelles* (C-361/15 P and C-405/15 P, EU:C:2017:720, paragraphs 68 and 69). In that judgment, the Court held that the European Union Intellectual Property Office (EUIPO) cannot be required, in the context of the comparison of the designs at issue, to combine various elements of one or more earlier designs in order to obtain the complete appearance of that design, on the ground that it is for the applicant for a declaration of invalidity to produce a complete representation of that earlier design and that any comparison would necessarily entail approximations. In fact, in application of the interpretation which I suggest, the court is not required to take the hazardous approach of combining elements that are represented separately. It must simply assess a design reproduced in full, and clearly visible, in a part of the photograph supplied to it by the applicant in the infringement action.

91. As stated in point 36 of this Opinion, among the substantive conditions that a design must satisfy in order to be protected as a Community design – registered or unregistered – is 'individual character'. In accordance with Article 6 of Regulation No 6/2002, a design is to be deemed to have 'individual character' if the overall impression it produces on the informed user [36] differs from the overall impression produced on such a user by any design which has previously been made available to the public.

92. Assessing that condition therefore requires, as already explained in point 85 of this Opinion, that the design claimed be compared with an earlier design.

93. As is apparent from the wording of Article 6, it is necessary, more specifically, to compare the 'overall impression' produced by each of the designs at issue. In other words, it is necessary to ascertain whether they are *similar overall*. All of their characteristics are therefore taken into account, and it is not possible to compare only parts of each design. Consequently, differences in details, or even significant differences, which are concentrated on only a part of the design claimed cannot suffice to demonstrate that it produces an 'overall impression' different from that produced by the earlier design and thus to establish its 'individual character'. [37]

94. The same reasoning applies, *mutatis mutandis*, to infringement. In that regard, Article 10 of Regulation No 6/2002 provides that the scope of the protection conferred by a Community design 'shall include any design which does not produce on the informed user a different overall impression'. [38]

95. It follows that, here again, the comparison of the designs at issue must be made by reference to the overall appearance making up the protected design, without it being possible to compare only a part of that design with the contested design. Again, even if the latter design is identical to a part of the protected design, it is possible that the 'overall visual impressions' produced by those two designs are different and that there is therefore no infringement. [39]

96. Those situations are particularly likely to materialise when the Community design claimed relates to the *appearance of a whole product*. If, for example, a designer has registered the design of a whole doll [40] and a third party markets, without the designer's authorisation, a model which has various differences but a similar head, the infringement will perhaps not be recognised. That partial similarity will not necessarily be sufficient to demonstrate the same 'overall visual impressions'.

[36] For a definition of the concept of 'informed user', see judgments of 20 October 2011, *PepsiCo* v *Grupo Promer Mon Graphic* (C-281/10 P, EU:C:2011:679, paragraph 59), and of 21 September 2017, *Easy Sanitary Solutions and EUIPO* v *Group Nivelles* (C-361/15 P and C-405/15 P, EU:C:2017:720, paragraphs 124 and 125).

[37] See recital 14 of Regulation No 6/2002 and Passa, J., *Droit de la propriété industrielle, tome I*, 2nd edition, L.G.D.J, Paris, 2009, p. 934. In that sense, the General Court has consistently held that 'the individual character of a design results from an overall impression of difference, or lack of "*déjà vu*", from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently marked to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked to produce dissimilar overall impressions' (judgment of 17 May 2018, *Basil* v *EUIPO – Artex (Bicycle baskets)* (T-760/16, EU:T:2018:277, paragraph 77 and the case-law cited)). The General Court has also held that the comparison of the overall impressions produced by the designs 'must be synthetic and may not be limited to an analytic comparison of a list of similarities and differences' (judgment of 8 July 2020, *Glimarpol* v *EUIPO – Metar (Pneumatic tool)* (T-748/18, not published, EU:T:2020:321, paragraph 47 and the case-law cited)).

[38] Subject to the fact that, as has been pointed out in point 78 of this Opinion, in relation to an unregistered Community design, the holder is protected only against 'copying', within the meaning of Article 19(2) of Regulation No 6/2002.

[39] See Passa, J., *op. cit.*, p. 1004.

[40] See, for that example, Passa, J., *op. cit.*, pp. 1004 and 1115.

97. In that context, as has been discussed throughout this Opinion, the EU legislature has allowed designers to claim protection, as a Community design, of a *more specific object*, namely the appearance of a 'part of a product', in accordance with Article 3(a) of Regulation No 6/2002. [41]

98. Thus, to take once again the example given in point 96 of this Opinion, a designer may choose to claim protection of the appearance of the doll's head only. In doing so, he increases the level of protection of the design of that 'part of a product' and, in particular, maximises his prospects of having the infringement relating to that part recognised. In fact, he avoids the comparison of the overall visual impressions produced by the overall designs by the competing dolls. *Only the appearance of the head*, which is the subject of the Community design, is taken into consideration. When only the appearance of the heads of those dolls is compared, the infringement is blatant. [42]

99. The explanations above echo, in my view, the facts of the case in the main proceedings. I recall that Ferrari relied in particular, in support of its infringement action, very much in the alternative, on an unregistered Community design relating to the appearance of the Ferrari FXX K as a whole. [43] As I understand the order for reference, the appellate court, in comparing that design with the overall appearance of the Mansory Siracusa 4XX, [44] found, in essence, that those two designs did not produce the same overall visual impression, within the meaning of Article 10 of Regulation No 6/2002, [45] in spite of visual similarities concerning, in particular, the V-shaped element on the bonnet and the lip spoiler. In relying on an unregistered Community design targeted at the appearance of the part of the FXX K in question, Ferrari therefore seeks to maximise its chances of having the infringement recognised in the present case.

100. In the light of those explanations, it seems to me that, by its second question, the referring court is wondering whether there are limits on the possibility for designers to subdivide the overall appearance of their products into different designs of 'parts of a product', with each being the subject of separate protection as a Community design, in order to maximise the level of protection which they enjoy.

101. That question is all the more relevant because, in the main proceedings, the appellate court considered that the unregistered Community design relied upon, primarily, by Ferrari on the part of its FXX K model, including, in particular, the V-shaped element on the bonnet and the lip spoiler, was *non-existent*, on the ground that that part did not present 'a certain autonomy' and 'a certain consistency in form' and was arbitrarily defined by the applicant in the main proceedings.

102. The order for reference contains little by way of explanation as to what is to be understood by the expressions 'autonomy' and 'consistency in form'. As I understand it, those expressions refer, in the case-law of the German courts, to cumulative conditions for claiming a Community design relating to the appearance of 'a part of a product'. The 'autonomy' condition refers, it seems to me, to whether the appearance of the part is distinguished from or, on the contrary, is

41 The Commission maintained before the Court, moreover, that that is a 'fundamental aspect' of the Community design system.

42 In that regard, the *unregistered* Community design offers the designer a flexibility not offered by the *registered* Community design. In the case of a registered Community design, the subject of the protection, namely the design claimed, is defined rigidly in the application for registration (see footnote 25 to this Opinion). Still using the same example, if the designer chooses to register not the design of the doll's head, but that of the doll as a whole, the infringement will be assessed by reference to that object. Conversely, in such a situation the designer will be able to rely on an unregistered Community design consisting in the appearance of the head alone, provided that it was made available less than three years before, in accordance with Article 11 of Regulation No 6/2002, and satisfies in itself the substantive conditions laid down in that regulation. See Passa, J., *op. cit.*, pp. 1004 and 1115.

43 See point 25 of this Opinion.

44 See point 21 of this Opinion.

45 See point 29 of this Opinion.

completely lost in that of the product taken as a whole. The 'consistency' condition concerns whether the partial design claimed constitutes a complete assembly. Specifically, in this instance, the appellate court considered that Ferrari's definition was 'arbitrary' on the ground that Ferrari did not include the headlights and the lateral extremity of the spoiler of the FXX K – elements which constitute, respectively, the 'eyes' and the 'jaws' of that vehicle, to use the 'facial features' metaphor used by Ferrari.[46] Those conditions aim, ultimately, to determine whether the appearance of the part of a product claimed presents an 'autonomous overall impression by comparison with the overall form'.

103. It must therefore be determined, in the present case, whether the appearance of a part of a product must, in order to be the subject of a separate Community design, distinct from that protecting, where appropriate, the overall appearance of that product, actually present such 'autonomy' or such 'consistency'.

104. To my mind, the answer to that question does not lie in the interpretation of the concept of 'individual character', within the meaning of Article 6 of Regulation No 6/2002. That concept governs not the relationship between the design of a product and the designs of its component parts, but rather, as I stated in point 92 of this Opinion, the relationship between those designs and other earlier designs. That concept is therefore not relevant for the purpose of determining whether, on the Ferrari FXX K, the appearance of the part claimed, composed in particular of the V-shaped element on the bonnet and the lip spoiler, may constitute a design of a 'part of a product', within the meaning of Article 3(a) of Regulation No 6/2002, distinct from the overall design of that vehicle.

105. Conversely, that answer must be found, in my view, in the actual definition of the concept of 'design', as laid down in Article 3(a) of Regulation No 6/2002.

106. In that regard, I recall that that definition refers to 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

107. A number of criteria may be inferred from that definition. As 'part of a product' is not defined, it must be understood, in accordance with its normal meaning in everyday language,[47] as a section of the 'whole' that is the product. Furthermore, in order to be protected as a design, that section must have an appearance, that is to say, it must be *visible*.[48] In addition, as Ferrari claims, that section must be defined by particular *lines, contours, colours, shape or texture*.

108. Should the Court add to those criteria the criteria relating to 'autonomy' and 'consistency' suggested by the referring court?

109. Admittedly, the General Court, in its judgment in *Buck-Chemie* v *EUIPO – Henkel (Cleansing block for toilets)*,[49] applied criteria very close to those thus suggested.

[46] See point 23 of this Opinion. Conversely, as I understand it, a vehicle grille, as a complete assembly, would present such 'consistency'.

[47] See, by analogy, judgment of 20 December 2017, *Acacia and D'Amato* (C-397/16 and C-435/16, EU:C:2017:992, paragraph 64 and the case-law cited).

[48] If the part of the product is a component part of a complex product, within the meaning of Article 3(c) of Regulation No 6/2002, the appearance of that component part must also be visible 'in the normal use of the product'.

[49] Judgment of 22 November 2018 (T-296/17, not published, EU:T:2018:823).

110. In that case, an undertaking had filed an application for registration for the design of a part of a cleansing block for toilets, corresponding to four balls of detergent contained in that block. A competitor had filed an application for a declaration of invalidity of that design, on the ground, in particular, that it lacked novelty and individual character. In that context, the applicant for a declaration of invalidity had presented as earlier designs, in particular, the appearance of four aligned balls, selected arbitrarily on the photograph of the ball pool containing those balls and dozens of others, and the appearance of a succession of balls taken from the overall image of a puzzle. The General Court considered, in essence, that the latter designs were *non-existent*, holding that the 'parts of a product' relied on did not have an 'independent character' and could not be 'separated from the overall impression produced by the product seen as a whole'. [50]

111. In that context, the General Court further held that, 'in order to constitute a separate design, separate from that of the main product, the main elements *must be particularly obvious and thus prevent the main product from being perceived as a whole*' (emphasis added). Conversely, the succession of balls taken from the image of a puzzle that was presented by the applicant for a declaration of invalidity formed an 'integral part of the whole of the game presented and its image' and was not 'especially highlighted'. [51]

112. However, I am somewhat reluctant to accept the idea of introducing, by means of interpretation and in an area as delicate as that of the Community design, unwritten criteria such as 'autonomy' or 'consistency' to define the parts of a product whose appearance may be the subject of specific protection.

113. As Ferrari and the Czech and Italian Governments have claimed, in essence, irrespective of the fact that those criteria were not envisaged by the EU legislature, I find it difficult to imagine how they would be capable of enhancing the level of legal certainty. In what circumstances would it be necessary to consider that the design of a part of a product satisfied those requirements of 'autonomy' and 'consistency'?

114. In that regard, I observe, in particular, that, in accordance with Article 3(a) of Regulation No 6/2002, a 'part of a product' may be limited to the ornamentation of a product. I therefore wonder how those criteria should be applied in such a situation. Likewise, in the example of the doll given in point 96 of this Opinion, to what extent would the appearance of the doll's head present a certain 'consistency' and a certain 'autonomy' by comparison with that of the rest of the body? Should the extent to which it would do so vary depending on whether the doll in question was a Barbie doll or a Russian doll? And what about the elements of a vehicle's bodywork? In absolute terms, such an element is never genuinely autonomous of the rest of the bodywork, since it forms part of its aesthetic.

115. That being so, of course, as the *Cleansing block for toilets* case [52] shows, completely arbitrary definitions of parts of a product may be submitted to the examiner or to the court.

116. Nevertheless, the solution that must be applied in order to regulate that type of attempt lies, in my view, not in the adoption of additional criteria, but merely in the strict application, by the examiner or the court, of the criteria that emerge from the definition of 'design', within the

[50] Judgment of 22 November 2018, *Cleansing block for toilets* (T-296/17, not published, EU:T:2018:823, paragraphs 51 and 52).

[51] Judgment of 22 November 2018, *Cleansing block for toilets* (T-296/17, not published, EU:T:2018:823, paragraph 52). See also, for analogous reasoning, judgment of 25 October 2013, *Merlin and Others* v *OHIM – Dusyma (Game)* (T-231/10, not published, EU:T:2013:560, paragraphs 34 and 35).

[52] Judgment of 22 November 2018 (T-296/17, not published, EU:T:2018:823).

meaning of Article 3(a) of Regulation No 6/2002. As I stated in point 107 of this Opinion, the part of a product must notably be defined by its particular appearance – its lines, contours, colour, etc.[53] In short, there must be a design that is identifiable as such and capable in itself of being subject to the assessment of the conditions for obtaining protection. I can therefore share the referring court's assessment that the appearance of the part must be capable of producing in itself an 'overall impression' and cannot therefore be completely lost in the overall impression produced by the product. A Community design not meeting that definition would have to be declared invalid[54] – or, more precisely, *non-existent*.

117. Generally, I consider that the examiner or the court should ensure that it is not possible to claim, as an autonomous Community design, parts of a product that are genuinely insignificant or completely arbitrary. Furthermore, in my view, when a designer subdivides the appearance of a product in an artificial manner with the sole aim of circumventing the 'overall impression' test laid down in Article 6 and Article 10 of Regulation No 6/2002, such conduct would tend to qualify as an abuse of rights.[55]

118. In the main proceedings, it is for the national court to ascertain whether the unregistered Community designs relied on by Ferrari meet the definition of 'design', within the meaning of Article 3(a) of Regulation No 6/2002, as explained in points 107 and 117 of this Opinion. I consider it appropriate nonetheless to give some indications which may be useful in that respect.

119. I observe to that effect that the part of the FXX K the appearance of which is claimed by Ferrari as an unregistered Community design, composed of the V-shaped element on the bonnet of the FXX K, the fin-like element protruding from the centre of that first element and fitted lengthways (the strake), the lip spoiler incorporated in the bumper and the vertical bridge in the centre connecting the spoiler to the bonnet, is a section of that vehicle. That section is visible, as the referring court has already found. Furthermore, it seems to me that that section is defined by particular lines, contours, colours and shapes. I tend, in particular, to consider, as does Ferrari, that those various elements may be perceived as a whole, characteristically evoking the front of a Formula 1 car.[56]

120. In the event that the referring court should be of the same opinion, it will be for that court, next, to ascertain whether the appearance of the part of a product claimed satisfies in itself the conditions for obtaining protection as a Community design. The criteria to be applied in the context of the assessment of those conditions should be the same as for any design. In particular, it is necessary, in order to determine the overall impression produced by the design of a part of a product – for the purpose of assessing the 'individual character' or the infringement – to take account of the appearance of that part alone, independently of the overall impression produced by the product taken as a whole.

121. Having regard to all of the foregoing, I suggest that the Court's answer to the second question should be that Article 3(a) of Regulation No 6/2002 must be interpreted as meaning that a visible section of a product, defined by particular lines, contours, colours, shape or texture,

53 On the other hand, as Ferrari claims, the part does not need to be 'structurally independent' of the product.

54 See Article 25(1)(a) of Regulation No 6/2002.

55 I recall that the prohibition of abuse of rights is a general principle of EU law. According to the Court's case-law, evidence of an abusive practice requires, first, a combination of objective circumstances in which, despite formal observance of the conditions laid down by the EU rules, the purpose of those rules has not been achieved and, second, a subjective element consisting in the intention to obtain an advantage from the EU rules by creating artificially the conditions laid down for obtaining it. See my Opinion in *Altun and Others* (C-359/16, EU:C:2017:850, footnote 45).

56 See point 23 of this Opinion.

constitutes the 'appearance of … a part of a product', within the meaning of that provision, which may be protected as a Community design. There is no need, when assessing whether a given design complies with this definition, to apply additional criteria such as 'autonomy' or 'consistency of form'.

V. Conclusion

122. In the light of all of the foregoing considerations, I propose that the Court should answer the questions for a preliminary ruling referred by the Bundesgerichtshof (Federal Court of Justice, Germany) as follows:

(1) Article 11(2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that the making available to the public of the full design of a product, such as the appearance of a vehicle, also entails the making available to the public of the design of a part of that product, such as the appearance of certain elements of the bodywork of that vehicle, provided that the latter design is clearly identifiable at the time when that design is made available.

(2) Article 3(a) of Regulation No 6/2002 must be interpreted as meaning that a visible section of a product, defined by particular lines, contours, colours, shape or texture, constitutes the 'appearance of … a part of a product', within the meaning of that provision, which may be protected as a Community design. There is no need, when assessing whether a given design complies with this definition, to apply additional criteria such as 'autonomy' or 'consistency of form'.