Reports of Cases

JUDGMENT OF THE COURT (Fourth Chamber)

25 January 2024*

(Reference for a preliminary ruling – EU trade mark – Regulation (EU) 2017/1001 – Article 9(2) and (3)(a) to (c) – Rights conferred by an EU trade mark – Concept of 'using in the course of trade any sign' – Article 14(1)(c) – Limitations of the effects of an EU trade mark – Right of the proprietor of an EU trade mark to oppose the use by a third party of a sign identical with, or similar to, the trade mark for motor vehicle spare parts – Component of a radiator grille designed for the attachment of an emblem representing the trade mark of a motor vehicle manufacturer)

In Case C-334/22,

REQUEST for a preliminary ruling under Article 267 TFEU from the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland), made by decision of 25 February 2022, received at the Court on 23 May 2022, in the proceedings

Audi AG

v

GQ,

THE COURT (Fourth Chamber),

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

Advocate General: L. Medina,

Registrar: M. Siekierzyńska, Administrator,

having regard to the written procedure and further to the hearing on 8 June 2023,

after considering the observations submitted on behalf of:

– Audi AG, by J. Alchimionek, B. Kochlewski, M. Popielska and P. Siekierzyński, adwokaci,

– GQ, by E. Jaroszyńska-Kozłowska and S. Karpierz, radcowie prawni,

– the Polish Government, by B. Majczyna, J. Lachowicz and J. Sawicka, acting as Agents,

* Language of the case: Polish.

– the French Government, by R. Bénard, A. Daniel and E. Timmermans, acting as Agents,

– the European Commission, initially by S.L. Kalėda, P. Němečková, J. Samnadda and B. Sasinowska, then by P. Němečková, J. Samnadda and B. Sasinowska, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 21 September 2023,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 9(2) and (3)(a) and Article 14(1)(c) and (2) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

2 The request has been made in proceedings between Audi AG and GQ concerning an alleged infringement of the rights conferred by an EU trade mark owned by Audi.

Legal framework

Regulation 2017/1001

3 Article 9 of Regulation 2017/1001, entitled 'Rights conferred by an EU trade mark', provides, in paragraphs 1 to 3:

'1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

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

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the [European] Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging of those goods;

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

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

(d) using the sign as a trade or company name or part of a trade or company name;

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC [of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising (OJ 2006 L 376, p. 21)].'

4 Article 14 of that regulation, entitled 'Limitation of the effects of an EU trade mark', reads as follows:

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

…

(c) the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.'

Regulation (EC) No 6/2002

5 Article 19 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), entitled 'Rights conferred by the Community design', provides in paragraph 1:

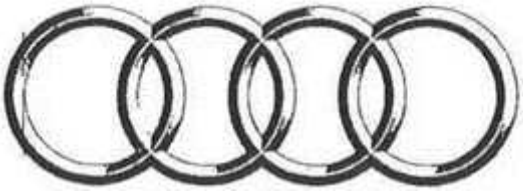
'A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which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

6 Article 110 of that regulation, entitled 'Transitional provision', provides in paragraph 1:

'Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance.'

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

7 Audi is a manufacturer of motor vehicles which is the proprietor of the figurative mark of the European Union, represented below, registered under the number 000 018 762, designating inter alia 'land, air and water vehicles, parts and constituent parts of such articles included in this class, including engines', falling within Class 12 within the meaning of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of 15 June 1957, as revised and amended ('the AUDI trade mark'):



8 GQ is a natural person engaged in the sale, via an internet site, of spare parts for motor vehicles, primarily to distributors of such parts. As part of that business, GQ advertised grilles, adapted and designed for older models of Audi motor vehicles dating from the 1980s and 1990s, and offered those grilles for sale. The grilles contained an element designed for the attachment of an emblem of the brand of the motor vehicle manufacturer Audi ('the Audi emblem').

9 From 2017 onwards, Audi has taken legal action against GQ to prevent him from offering for sale non-original spare parts, tha shape of parts of which represented the AUDI brand in whole or in part.

10 In particular, on 5 May 2020, Audi brought an application before the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland), the referring court, seeking to prohibit GQ from advertising, importing, offering for sale or placing on the market non-original radiator grilles bearing a sign identical with, or similar to, the AUDI trade mark. It also requested the destruction of 70 radiator grilles that had been seized by the Polish customs authorities and that infringed the exclusive right conferred by the AUDI trade mark.

11 GQ contests those claims, citing a practice of motor vehicle manufacturers whereby they do not object to the sale of non-original radiator grilles incorporating an element designed for the attachment of the emblem representing their brand.

12 The referring court takes the view that, in order to rule on the dispute before it, it must determine whether the scope of the protection conferred by the AUDI trade mark, which, according to that court, has a high degree of distinctiveness, is widely known in Poland and is clearly associated with Audi, also extends to elements designed for the attachment of the Audi emblem to the radiator grilles which are identical in appearance, in particular in shape, to the AUDI trade mark, are confusingly similar to it or are merely similar to it.

13 In that regard, in the first place, the referring court considers that it is necessary to examine the consequences of the absence, in trade mark law, of a provision equivalent to the so-called 'repair' clause provided for in Article 110(1) of Regulation No 6/2002.

14 That court stresses the need to protect undistorted competition and the interest of consumers in being able to choose between purchasing an original motor vehicle part and a non-original part. That court states that, although there is no question in the present case of the protection of a Community design, the reference to the so-called 'repair' clause is based on the idea that the right conferred by an EU trade mark cannot grant the proprietor of that mark more extensive protection than that resulting from the rights conferred both by such a mark and by a Community design. The same court notes that it is apparent from the order of 6 October 2015, *Ford Motor Company* (C-500/14, EU:C:2015:680, paragraphs 39 and 42), that that clause cannot be applied by analogy in trade mark law. However, it questions whether the judgment of 20 December 2017, *Acacia and D'Amato* (C-397/16 and C-435/16, EU:C:2017:992), does not require a new reading of that order, so as to avoid a situation in which third parties are neither authorised to use a trade mark of a motor vehicle manufacturer to produce and offer for sale spare parts for that manufacturer's vehicles, nor authorised not to use that trade mark for such a purpose. It considers that even if, according to the Court's case-law, the application by analogy of the so-called 'repair' clause is excluded, that does not preclude the possibility of limiting trade mark protection having been envisaged by the EU legislature or arising from the order of 6 October 2015, *Ford Motor Company* (C-500/14, EU:C:2015:680).

15 The referring court therefore asks whether, in the circumstances of the case before it, a trade mark fulfils the function of indicating the origin of a spare part when it is an element of that part. It also asks whether, where an element of a spare part for a motor vehicle, namely a radiator grille, enables the emblem of the manufacturer of that vehicle to be affixed to that part and represents the shape of a trade mark of that manufacturer or is confusingly similar to that trade mark, that element can be regarded as a trade mark fulfilling a function as an indication of origin.

16 In the second place, the referring court asks whether Article 14(1)(c) of Regulation 2017/1001 must be interpreted as precluding the proprietor of an EU trade mark from prohibiting a third party from using, in the course of trade, a sign identical with, or confusingly similar to, that trade mark in respect of spare parts for motor vehicles, namely radiator grilles, where that sign constitutes a component of those parts designed for the purpose of attaching the emblem of the manufacturer of those vehicles to them. It distinguishes between two situations in that regard, depending on whether or not it is technically possible to affix such an emblem without reproducing on those parts a sign which is identical to that trade mark or confusingly similar to it. However, it points out that such a technical criterion would not constitute an easily applicable assessment criterion.

17 In the third place, the referring court asks what assessment criteria, if any, should be applied to determine whether the EU trade mark is used in accordance with honest practices in industrial and commercial matters, as required by Article 14(2) of Regulation 2017/1001.

18 In those circumstances, the Sąd Okręgowy w Warszawie (Regional Court, Warsaw) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Must Article 14(1)(c) of Regulation [2017/1001] be interpreted as precluding the trade mark proprietor [or] court from prohibiting a third party from using in the course of trade a sign which is identical or confusingly similar to an EU trade mark, in relation to automotive spare parts (radiator grilles) where that sign constitutes a mounting element for an automotive accessory (an emblem reflecting the EU trade mark), and:

– where it is technically possible to affix the original emblem reflecting the EU trade mark to an automotive spare part (radiator grille) without reproducing on that part a sign identical or confusingly similar to the EU trade mark;

or in a situation

– where it is technically impossible to affix the original emblem reproducing the EU trade mark to an automotive spare part (radiator grille) without reproducing on that part a sign identical or confusingly similar to the EU trade mark?

If the answer to [the first question, first or second indent] is in the affirmative:

(2) What evaluation criteria should be used in such cases to determine whether the use of an EU trade mark is consistent with honest practices in industrial and commercial matters?

(3) Must Article 9(2) and Article 9(3)(a) of Regulation [2017/1001] be interpreted as meaning that, where the trade mark is included in the shape of an automotive part and in the absence in Regulation 2017/1001 of a clause that would be similar to the repairs clause in Article 110(1) of Regulation [No 6/2002], the trade mark does not fulfil a designation function in that situation?

(4) Must Article 9(2) and Article 9(3)(a) of Regulation [2017/1001] be interpreted as meaning that, where the mounting element for a trade mark, which reflects the shape of the trade mark or is confusingly similar to it, is included in the shape of an automotive part and in the absence in Regulation 2017/1001 of a clause that would be similar to the repairs clause in Article 110(1) of Regulation [No 6/2002], that mounting element cannot be regarded as a trade mark with a designation function even if it is identical to the trade mark or confusingly similar to it?'

The questions referred for a preliminary ruling

The third and fourth questions

19 As a preliminary point, it should be noted that, according to Article 9(1) and (2) of Regulation 2017/1001, an EU trade mark confers on its proprietor the exclusive right to prevent any third party from using, in the course of trade, a sign which is identical to that trade mark in relation to goods or services which are identical to those for which that trade mark is registered, or a sign in relation to which, because of its identity with, or similarity to, the EU trade mark and because of the identity or similarity of the goods or services covered by that trade mark and that sign, there is a likelihood of confusion on the part of the public, or a sign which is identical with, or similar to, the EU trade mark for goods or services which are not similar to those for which that trade mark is registered, where that trade mark has a reputation in the European Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of that trade mark (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 31).

20 In that regard, it is apparent from the order for reference that, by its third and fourth questions, which must be considered together and in the first place, the referring court is in fact seeking to ascertain whether the importation and offer for sale of a spare part for a motor vehicle, namely a

radiator grille, comprising a component the shape of which is identical or similar to a trade mark of which the manufacturer of that vehicle is the proprietor and which is designed for the attachment, to that component, of the emblem of that manufacturer, which represents that trade mark, constitutes 'using in the course of trade any sign' within the meaning of Article 9(2) of Regulation 2017/1001.

21 By contrast, despite the wording of the third question, that court does not question the capacity of a sign to be registered as an EU trade mark. The essential function of an individual EU trade mark which has been registered, such as the AUDI trade mark in the present case, is to guarantee to consumers the origin of the goods or services which it designates (see, to that effect, judgment of 8 June 2017, *W.F. Gözze Frottierweberei and Gözze*, C-689/15, EU:C:2017:434, paragraphs 40 and 41 and the case-law cited). Such a mark is thus deemed to be capable of indicating, in itself and in the absence of any other element, the origin of those goods or services. It is not apparent from the reference for a preliminary ruling that the referring court has doubts as to the validity of the registration of the AUDI trade mark as an EU trade mark and the capacity of that mark to designate the origin of the goods for which it is registered.

22 It is also necessary to emphasise that the condition for the application of Article 9(2) of Regulation 2017/1001 relating to 'using in the course of trade any sign' must be examined before any assessment of whether there is a likelihood of confusion within the meaning of Article 9(2)(b) of that regulation. The existence of such a likelihood is not a prerequisite for an examination of whether a sign is used in the course of trade.

23 Finally, it should be borne in mind that, under Article 9(3)(b) and (c) of that regulation, it may be prohibited, respectively, to offer the goods, to place them on the market or to hold them for those purposes under that sign and to import or export the goods under that sign. Thus, having regard to the facts of the main proceedings as set out in the order for reference, those provisions may also be relevant to the determination of those proceedings.

24 Consequently, the third and fourth questions must be reworded to the effect that, by them, the referring court asks, in essence, whether, in the absence, in Regulation 2017/1001, of a provision equivalent to the so-called 'repair' clause in Article 110(1) of Regulation No 6/2002, Article 9(2) and (3)(a) to (c) of Regulation 2017/1001 must be interpreted as meaning that a third party who, without the consent of the manufacturer of motor vehicles which is the proprietor of an EU trade mark, imports and offers for sale spare parts, namely radiator grilles for those motor vehicles, containing an element which is designed for the attachment of the emblem representing that trade mark and the shape of which is identical with, or similar to, that trade mark, is using a sign in the course of trade in a manner liable to affect one or more of the functions of that trade mark.

25 It should be noted, in the first place, that, although a sign protected as an EU trade mark may, in certain circumstances, also be protected as a Community design, it is apparent from the order for reference that the dispute in the main proceedings concerns solely the protection conferred by an EU trade mark and not also the protection conferred by a Community design.

26 It should be pointed out, as the referring court did, that a so-called 'repair' clause, such as that existing in design law under Article 110 of Regulation No 6/2002, was not provided for by the EU legislature in Regulation 2017/1001.

27 Furthermore, the Court has already clarified the scope of Article 110 of Regulation No 6/2002, in that it imposes certain limitations only on protection conferred on designs and applies without prejudice to the provisions of EU law relating to trade marks. That provision therefore contains no derogation from EU trade mark law (see, to that effect, order of 6 October 2015, *Ford Motor Company*, C-500/14, EU:C:2015:680, paragraphs 39, 41 and 42).

28 Moreover, the objective of preserving undistorted competition has been taken into account by the EU legislature in the context of Regulation 2017/1001, in that Article 14 of that regulation limits the effects of the right which the proprietor of an EU trade mark derives from Article 9 of that regulation. Article 14 thereof seeks to reconcile the fundamental interests of the protection of the right conferred by such a trade mark with those of the free movement of goods and the freedom to provide services in the internal market, and to do so in such a way that that right can fulfil its role as an essential element of the system of undistorted competition which the TFEU seeks to establish and maintain (see, to that effect, order of 6 October 2015, *Ford Motor Company*, C-500/14, EU:C:2015:680, paragraph 43 and the case-law cited).

29 Consequently, Article 9 of Regulation 2017/1001 cannot be interpreted in such a way as to lead, in order to take account of an objective of preserving undistorted competition between manufacturers of motor vehicles and sellers of non-original spare parts, to the application by analogy of Article 110 of Regulation No 6/2002 and to the limitation, on the basis of that provision, of the right conferred on the proprietor of an EU trade mark by Article 9 of Regulation 2017/1001.

30 In the second place, it should be noted that the concept of 'using', within the meaning of Article 9(2) of Regulation 2017/1001, is not defined by that regulation (judgment of 22 December 2022, *Louboutin (Use of an infringing sign on an online marketplace)*, C-148/21 and C-184/21, EU:C:2022:1016, paragraph 25).

31 It follows from the case-law that, under Article 9(2)(a) and (b) of that regulation, the proprietor of an EU trade mark is entitled to prevent any third party from using, in the course of trade and without its consent, a sign which is identical to the trade mark in relation to goods or services which are identical to those for which it is registered or a sign in relation to which, by reason of its identity with, or similarity to, the trade mark and by reason of the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark. The exercise of that right must, however, be reserved for cases in which the use of the sign by a third party adversely affects or is liable to adversely affect the functions of the trade mark, which include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services, but also its other functions, such as, in particular, that of guaranteeing the quality of that product or service, or those of communication, investment or advertising (judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe*, C-129/17, EU:C:2018:594, paragraphs 33 and 34 and the case-law cited).

32 Furthermore, it follows from Article 9(2)(c) of Regulation 2017/1001 that the proprietor of an EU trade mark with a reputation is entitled to prevent the use without its consent by a third party, in the course of trade, of a sign identical with, or similar to, that trade mark, irrespective of whether the goods or services for which that sign is used are identical, similar or dissimilar to those for which that trade mark is registered, where such use, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of that trade mark.

33 In that regard, as regards the term 'use', the Court has already held that it refers exclusively to active conduct on the part of the third party (see, to that effect, judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe*, C-129/17, EU:C:2018:594, paragraph 38 and the case-law cited) and that the list of types of use which the proprietor of the EU trade mark may prohibit, contained in Article 9(3) of Regulation 2017/1001, is not exhaustive (see, to that effect, judgment of 2 April 2020, *Coty Germany*, C-567/18, EU:C:2020:267, paragraph 32 and the case-law cited).

34 Use of a sign identical with, or similar to, an EU trade mark occurs 'in the course of trade' if it is in the context of a commercial activity intended to obtain an economic advantage and not in the private sphere (see, to that effect, judgments of 12 November 2002, *Arsenal Football Club*, C-206/01, EU:C:2002:651, paragraph 40, and of 23 March 2010, *Google France and Google*, C-236/08 to C-238/08, EU:C:2010:159, paragraph 50).

35 As regards the functions of an EU trade mark, the essential function, referred to in paragraphs 21 and 31 of this judgment, of guaranteeing identity of origin serves in particular to attest that all the goods or services bearing that mark have been manufactured or supplied under the control of a single undertaking to which responsibility for their quality may be attributed, so that it can play its role as an essential element of the system of undistorted competition (see, to that effect, judgments of 12 November 2002, *Arsenal Football Club*, C-206/01, EU:C:2002:651, paragraph 48, and of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe*, C-129/17, EU:C:2018:594, paragraph 35).

36 Among the other functions of an EU trade mark, that of investment refers to the possibility for the proprietor of a trade mark to use it to acquire or maintain a reputation capable of attracting and retaining consumers, by means of various commercial techniques. Thus, where the use by a third party, such as a competitor of the proprietor of an EU trade mark, of a sign identical with, or similar to, that trade mark in relation to goods or services identical with, similar to or different from those for which the trade mark is registered substantially impedes the proprietor's use of its trade mark to acquire or maintain a reputation likely to attract or retain consumers, that use adversely affects that function. That proprietor is therefore entitled to prohibit such use under Article 9(2) of Regulation 2017/1001 (see, to that effect, judgment of 25 July 2018, *Mitsubishi Shoji Kaisha and Mitsubishi Caterpillar Forklift Europe*, C-129/17, EU:C:2018:594, paragraph 36 and the case-law cited).

37 In the present case, it is important to note that the third and fourth questions are based on the premiss that the radiator grilles imported and offered for sale by GQ are not products originating from the proprietor of the AUDI trade mark or placed on the market with its consent.

38 In addition, it is apparent from the reference for a preliminary ruling that the shape of the component of those grilles designed for the attachment of the AUDI emblem is considered by the referring court to be identical or similar to the AUDI trade mark. That shape thus constitutes a sign within the meaning of Article 9(2) of Regulation 2017/1001, the fact that it is an element of a spare part for a motor vehicle, namely a radiator grille, not being capable of altering that finding.

39 It is also apparent from the reference for a preliminary ruling that that sign is affixed to or incorporated into those radiator grilles for the purpose of marketing them, which represents use falling within Article 9(3)(a) of Regulation 2017/1001. Furthermore, in so far as GQ imports and offers for sale radiator grilles bearing that sign, it may be regarded as carrying out the types of use falling within Article 9(3)(b) and (c) of that regulation.

40 That is all the more so where, as in the present case, that element is placed on the spare part, namely the radiator grille, in such a way that, as long as the emblem representing the vehicle manufacturer's trade mark is not affixed, the sign identical with, or similar to, that trade mark is visible to the relevant public when it sees that part, that public being the one wishing to purchase such a part in order to repair or have repaired a motor vehicle. Such a fact is capable of establishing the existence of a material link between that part, which a third party imports, advertises and offers for sale, and the proprietor of the AUDI trade mark.

41 In the third place, it should be noted that such use is, where appropriate, liable to adversely affect one or more of the functions of the trade mark.

42 In that regard, it should be borne in mind that Article 9(2)(a) of Regulation 2017/1001 refers to the so-called 'double identity' situation, namely the use by the third party of a sign identical to the EU trade mark for goods or services identical to those for which that trade mark is registered. In such a case, use of the sign by the third party within the meaning of Article 9(2) of that regulation may be prohibited by the proprietor of that trade mark pursuant to Article 9(2)(a) of that regulation (see, to that effect, judgment of 22 September 2011, *Interflora and Interflora British Unit*, C-323/09, EU:C:2011:604, paragraph 33), where that use adversely affects or is liable to adversely affect the functions of the trade mark, which include not only the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services, but also its other functions, such as, in particular, that of guaranteeing the quality of those goods or services, or those of communication, investment or advertising (see, to that effect, judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134, paragraph 26 and the case-law cited).

43 If there is no double identity between the sign used by the third party and the EU trade mark and between the goods concerned, in particular where the sign used by the third party and the EU trade mark are similar, and not identical, the goods or services concerned being identical or similar, the national court will have to assess whether the use of that sign gives rise to a likelihood of confusion within the meaning of Article 9(2)(b) of Regulation 2017/1001. According to the case-law, a likelihood of confusion exists where the public might believe that the goods or services in question come from the same undertaking or, where appropriate, from economically linked undertakings (judgments of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 17, and of 8 July 2010, *Portakabin*, C-558/08, EU:C:2010:416, paragraph 51). Accordingly, under that provision, the proprietor of a trade mark may prohibit the use by a third party of a sign identical with, or similar to, that trade mark only if, because of the existence of such a likelihood of confusion, that use adversely affects, or is liable to adversely affect, that 'essential' function (see, to that effect, judgment of 3 March 2016, *Daimler*, C-179/15, EU:C:2016:134, paragraph 27 and the case-law cited).

44 Furthermore, where a trade mark has a reputation in the European Union within the meaning of Article 9(2)(c) of Regulation 2017/1001, the proprietor of that trade mark is entitled to prohibit the use by a third party, in the course of trade, of a sign identical or similar to that trade mark under the conditions noted in paragraph 32 of this judgment. The exercise of that right by the proprietor of the trade mark with a reputation does not presuppose the existence of a likelihood of confusion on the part of the relevant public (see, to that effect, judgment of 22 September 2011, *Interflora and Interflora British Unit*, C-323/09, EU:C:2011:604, paragraphs 70 and 71 and the case-law cited).

45 In the present case, it is for the national court first of all to determine, first, whether the sign used by GQ, which consists of the shape of the element of the radiator grille designed for the attachment of the Audi emblem, is identical with, or similar to, the AUDI trade mark and, secondly, whether a radiator grille is identical with, or similar to, one or more of the goods in respect of which that trade mark is registered, referred to in paragraph 7 of this judgment.

46 If the national court determines that that shape is a sign identical to the AUDI trade mark and that those radiator grilles, as spare parts, are identical to the goods in respect of which that trade mark is registered, it will have to apply Article 9(2)(a) of Regulation 2017/1001.

47 If, by contrast, that court determines that GQ is using a sign which is similar, and not identical, to the AUDI trade mark and that his radiator grilles, as spare parts, are identical or similar to the goods for which that trade mark is registered, it will have to assess whether there is a likelihood of confusion, within the meaning of Article 9(2)(b) of Regulation 2017/1001, taking into account all the relevant factors, in particular the degree of similarity between the signs and the goods, the perception of the average consumer of the relevant public, who is reasonably well informed and reasonably observant and circumspect when he sees the goods for which the third party uses the sign, and the level of attention of that public, the distinctive character of the EU trade mark or the conditions under which the goods are marketed (see, to that effect, judgments of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 22, and of 4 March 2020, *EUIPO* v *Equivalenza Manufactory*, C-328/18 P, EU:C:2020:156, paragraphs 57 and 70).

48 Furthermore, it is apparent from the order for reference that the AUDI trade mark is widely known in Poland and has a high degree of distinctiveness. If the national court finds that that trade mark has a reputation and that the shape of the element of the radiator grille designed for the attachment of the Audi emblem is identical with, or similar to, that trade mark, the latter must enjoy protection on that ground, regardless of whether the radiator grilles imported and offered for sale by GQ and the goods for which that trade mark is registered are identical, similar or different. GQ's use of the sign would then be liable to be prohibited, pursuant to Article 9(2)(c) of Regulation 2017/1001, if the national court establishes that such use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the AUDI trade mark. In that case, that court will not be required to assess whether there is a likelihood of confusion, since, in that context, the fact that the average consumer perceives the grilles as not being original is irrelevant.

49 Having regard to all the foregoing considerations, the answer to the third and fourth questions is that Article 9(2) and (3)(a) to (c) of Regulation 2017/1001 must be interpreted as meaning that a third party who, without the consent of the manufacturer of motor vehicles which is the proprietor of an EU trade mark, imports and offers for sale spare parts, namely radiator grilles for those motor vehicles, containing an element which is designed for the attachment of the emblem representing that trade mark and the shape of which is identical with, or similar to, that trade mark, makes use of a sign in the course of trade in a manner liable to affect one or more of the functions of that trade mark, which is a matter for the national court to ascertain.

The first question

50 By its first question, the referring court asks, in essence, whether Article 14(1)(c) of Regulation 2017/1001 must be interpreted as precluding the manufacturer of motor vehicles which is the proprietor of an EU trade mark from prohibiting a third party from using a sign identical with, or similar to, that trade mark in relation to spare parts for those motor vehicles, namely radiator

grilles, where that sign consists of the shape of an element of the radiator grille designed for the attachment thereto of the emblem representing that trade mark, irrespective of whether it is technically possible to attach that emblem to that radiator grille without affixing that sign to it.

51 It should be noted at the outset that, where the use of a sign identical with, or similar to, an EU trade mark by a third party may be prohibited by its proprietor under Article 9 of Regulation 2017/1001, Article 14 of that regulation limits, in the situations it sets out, the right of that proprietor to oppose that use.

52 Thus, under Article 14(1)(c) of Regulation 2017/1001, an EU trade mark does not entitle its proprietor to prohibit a third party from using, in the course of trade, that trade mark to designate or refer to goods or services as being those of that proprietor, in particular where use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part.

53 Notwithstanding the existence of significant differences between that provision, which corresponds to Article 14(1)(c) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1), and its preceding provision in the EU legislation previously in force, the impossibility for the proprietor of a trade mark to prohibit a third party from using that trade mark where such use is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part, and is done in accordance with honest practices in industrial or commercial matters, has been retained and now constitutes one of the situations in which the exclusive right conferred by the trade mark cannot be relied on against a third party (see, to that effect, judgment of 11 January 2024, *Inditex*, C-361/22, EU:C:2024:17, paragraphs 44 to 46).

54 The purpose of the limitation, referred to in that situation, of the exclusive right conferred by the trade mark is to enable suppliers of goods or services which are complementary to goods or services offered by the proprietor of a trade mark to use that trade mark in order to inform, in a comprehensible and complete manner, the public of the intended purpose of the goods which they market or of the service which they offer or, in other words, of the practical link between their goods or services and those of the proprietor of the trade mark (see, by analogy, judgments of 17 March 2005, *Gillette Company and Gillette Group Finland*, C-228/03, EU:C:2005:177, paragraphs 33 and 34, and of 11 January 2024, *Inditex*, C-361/22, EU:C:2024:17, paragraph 51).

55 Thus, the use of a trade mark by a third party to designate or refer to goods or services as being those of the proprietor of that trade mark, where that use is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that third party, is, under Article 14(1)(c) of Regulation 2017/1001, one of the situations in which use of the trade mark is not capable of being prohibited by its proprietor (see, to that effect, judgment of 11 January 2024, *Inditex*, C-361/22, EU:C:2024:17, paragraph 52). That limitation of the exclusive right conferred on the proprietor of the trade mark by Article 9 of that regulation applies, however, only where such use of that mark by the third party is in accordance with honest practices in industrial or commercial matters, within the meaning of Article 14(2) of that regulation.

56 In the present case, it is apparent from the order for reference that the grille element, the shape of which is identical with, or similar to, the AUDI trade mark, enables the emblem representing that trade mark to be affixed to that radiator grille. As is also apparent from the order for reference and

the parties' observations, the choice of the shape of that component is guided by the desire to market a radiator grille which resembles as closely as possible the original radiator grille of the manufacturer of the motor vehicles at issue.

57 Such a situation, in which an undertaking which is not economically linked to the proprietor of the trade mark affixes a sign identical with, or similar to, that trade mark to spare parts marketed by it and intended to be incorporated into the goods of that proprietor, must be distinguished from a situation in which such an undertaking, without affixing a sign identical with, or similar to, the trade mark to those spare parts, uses that trade mark to indicate that those spare parts are intended to be incorporated into the goods of the proprietor of that trade mark. While the second of those situations falls within the situation referred to in paragraph 55 of this judgment, the first of those situations does not. The affixing of a sign identical with, or similar to, the trade mark on the goods marketed by the third party exceeds, as the Advocate General observed in point 57 of her Opinion, the referential use referred to in Article 14(1)(c) of Regulation 2017/1001 and therefore does not fall within any of the situations covered by that provision.

58 It follows that, where a sign identical with, or similar to, an EU trade mark constitutes an element of a spare part for motor vehicles, which is designed for the attachment of the emblem of the manufacturer of those vehicles to it and is not used to designate or refer to goods or services as being those of the proprietor of that trade mark, but to reproduce as faithfully as possible a product of that proprietor, such use of that trade mark does not fall within Article 14(1)(c) of Regulation 2017/1001.

59 In those circumstances, it is irrelevant whether or not there is a technical possibility of attaching the emblem representing the trade mark of the motor vehicle manufacturer to the radiator grille without the shape of the element of the radiator grille designed for that attachment constituting a sign identical with, or similar to, the trade mark. GQ's use of that shape, which in the present case is considered by the referring court to be a sign identical with, or similar to, the AUDI trade mark, must be assessed in the light of the rules set out in Article 9 of Regulation 2017/1001, as interpreted by the Court in the case-law referred to in paragraphs 42 to 48 of this judgment.

60 Having regard to all the foregoing considerations, the answer to the first question is that Article 14(1)(c) of Regulation 2017/1001 must be interpreted as meaning that it does not preclude the manufacturer of motor vehicles which is the proprietor of an EU trade mark from prohibiting a third party from using a sign identical with, or similar to, that trade mark in relation to spare parts for those motor vehicles, namely radiator grilles, where that sign consists of the shape of an element of the radiator grille designed for the attachment thereto of the emblem representing that trade mark, regardless of whether or not there is a technical possibility of attaching that emblem to the radiator grille without affixing that sign to it.

The second question

61 Given the answer to the first question, there is no need to answer the second question.

Costs

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

On those grounds, the Court (Fourth Chamber) hereby rules:

1. **Article 9(2) and (3)(a) to (c) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark**

   must be interpreted as meaning that a third party who, without the consent of the manufacturer of motor vehicles which is the proprietor of an EU trade mark, imports and offers for sale spare parts, namely radiator grilles for those motor vehicles, containing an element which is designed for the attachment of the emblem representing that trade mark and the shape of which is identical with, or similar to, that trade mark, is using a sign in the course of trade in a manner liable to affect one or more of the functions of that trade mark, which is a matter for the national court to ascertain.

2. **Article 14(1)(c) of Regulation 2017/1001**

   must be interpreted as meaning that it does not preclude the manufacturer of motor vehicles which is the proprietor of an EU trade mark from prohibiting a third party from using a sign identical with, or similar to, that trade mark in relation to spare parts for those motor vehicles, namely radiator grilles, where that sign consists of the shape of an element of the radiator grille designed for the attachment thereto of the emblem representing that trade mark, regardless of whether or not there is a technical possibility of attaching that emblem to the radiator grille without affixing that sign to it.

[Signatures]