



/ advocaten  
/ avocats  
/ lawyers

# FROM THE HAGUE TO LUXEMBOURG VIA BRUSSELS, AND BACK AGAIN: JURISPRUDENTIAL ‘MILLE BORNES®’ IN THE AUTOMOTIVE SECTOR

BMM, The Hague, 11 April 2019

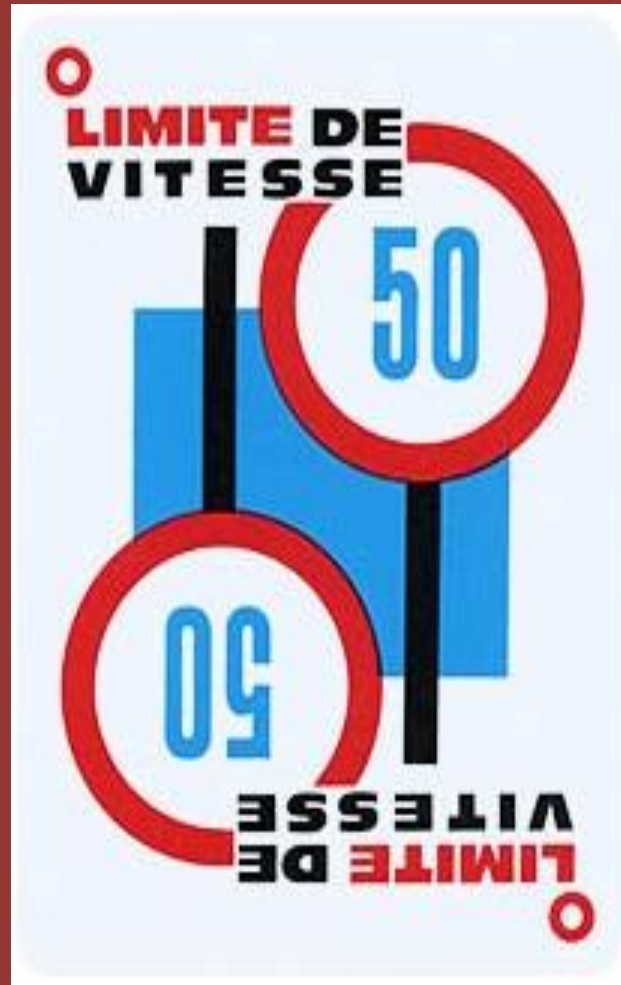
Olivier Vrins



/

## OUTLINE







## FORKLIFTS



- CJEU 25/07/2018, C-129/17, *Mitsubishi v Duma*  
'De-branding' / 'Re-branding' for parallel import purposes

### ➤ Infringement (sub a ?)

- 'Use': Arts 5(3) TMD - 9(2) EUTMR not exhaustive
- 'In the course of trade'
- Affects functions of the mark
  - ✓ Function of origin (TM owner cannot control first marketing within the EEA 'of goods *[initially]* bearing that mark')
  - ✓ Investment and advertising functions
- Art. 9(4) EUTMR ?





## / CONSTRUCTION AND FORESTRY EQUIPMENT

- Liege CA 20/03/2018, 2016/RG/1286, *Caterpillar v Clohse* (appeal to the Supreme Court pending)

‘CAT’ for construction machines v ‘TIGERCAT’ for forestry equipment

### ➤ Infringement sub *b*

- Relevant public’s level of attention is higher than average
  - ✓ Professional public, but not necessarily aware of commercial relations between undertakings
- ‘CAT’ trademarks have a reputation in the Benelux
- The signs are conceptually similar - *Medion* (?)
- The goods are similar
  - ✓ Same nature, colors and layout (?) and markets
  - ✓ Overlapping publics
- No peaceful coexistence



R

# RÉPARATIONS



# RÉPARATIONS

R



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (1)

- CJEU 20/12/2017, C-397/16, *Acacia v Audio - Porsche*

Sale on Acacia's website of replica car wheel rims identical to original Audi & Porsche wheel rim designs

⇒ Interpretation of Art. 110(1) CDR (comp. Art. 3.19(3) CBIP)

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

- (i) a design which constitutes a component part of a complex product
- (ii) used within the meaning of Article 19(1) CDR
- (iii) for the purpose of the repair of that complex product
- (iv) so as to restore its original appearance.



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (2)

### (i) A component part protected as a Community design

- 'A component part of a complex product'

'Component part' not defined, but 'complex product' = a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product (Art. 3(c) CDR)

⇒ 'Component part of a complex product' = 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.**

⇒ A car wheel rim is a component part of a complex product

- Protected as a Community design





## / 'REPAIR CLAUSE' UNDER DESIGN LAW (3)

**(ii) Any 'use' within the meaning of Art. 19(1) CDR  
(comp. Art. 3.16 BCIP)**

⇒ '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'



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (4)

### (iii) Use 'for the purpose of the repair' of the complex product

The component part must be necessary for the normal use of the complex product - i.e. if that part were **faulty or missing**, this would **prevent such normal use**

⇒ Use for reasons of preference or purely of convenience (e.g. replacement of a part for aesthetic purposes or customisation of the complex product) is excluded from the 'repair' clause.



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (5)

### (iv) So as to restore its original appearance

- 'Appearance': cf. Art. 3(a) CDR: features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation
- ⇒ The component part must be:
  - visible
  - used so as to restore the complex product to the appearance it had when it was placed on the market
- ⇒ The 'repair' clause applies only to component parts of a complex product that are visually identical to original parts



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (6)

### No further requirement

- ⇒ The protected design of the component part need not be dependent on the appearance of the complex product
  
- >< High Court of Justice, Chancery Division, 27/07/2012, *BMW/Round and Metal* ('must match')
  
- >< Recital 13 CDR



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (7)

### 'Duty of diligence' of the manufacturers and sellers

- ⇒ They cannot be expected to guarantee, objectively and in all circumstances, that the parts they make or sell for use in accordance with the conditions prescribed by Article 110(1) CDR are actually used by end users in compliance with those conditions
- ⇒ However, they must contribute, so far as possible, to ensuring strict compliance, particularly by the end user, with the conditions laid down in Article 110(1) CDR



## / 'REPAIR CLAUSE' UNDER DESIGN LAW (8)

- ⇒ Inform the downstream user, through a **clear and visible indication** on the product, on its packaging, in the catalogues *or* in the sales documents, on the one hand, that:
  - the component part concerned incorporates a design of which they are not the holder and
  - the part is intended exclusively to be used for the purpose of the repair of the complex product so as to restore its original appearance
  
- ⇒ Ensure, through appropriate means, in particular contractual means, that **downstream users do not intend to use the component parts in a way that does not comply** with the conditions prescribed by Article 110(1) CDR
  
- ⇒ **Refrain from selling** such a component part **where** they know or, in the light of all the relevant circumstances, ought reasonably to know that the part in question will not be used in accordance with the conditions laid down in Article 110(1) CDR



/

## COPYRIGHT LAW

### Cumulative protection design/copyright as a way to 'circumvent' the repair clause ?

No repair clause under BE/NL/LU copyright law

⇒ CJEU 4/11/1997, C-337/95, *Dior v Evora*

⇒ ≠ CJEU 6/10/2015, C-500/14, *Ford v Wheeltrims*



## TRADEMARK LAW

- CJEU 6/10/2015, C-500/14, *Ford v Wheeltrims*

Sale by Wheeltrims of wheel covers showing a faithful reproduction of the Ford trade mark

⇒ Art. 14 Design Directive and Art. 110 CDR do not allow, by way of derogation from the provisions of the TMD and EUTMR, a manufacturer of replacement parts and accessories for motor vehicles to affix to its products a sign identical to a trade mark registered for such products inter alia by a producer of motor vehicles, without obtaining the latter's consent, on the ground that the use thus made of that trade mark is the only way of repairing the vehicle concerned, restoring to that complex product its original appearance.





## NON-AUTHORIZED DEALERS

- CJEU 23/02/1999, C-63/97, *BMW v Deenik*

⇒ Right to use figurative trademarks (as opposed to word marks)?



- Prohibited per se - E.g.:
  - Brussels CA 14/10/2008, *Jaguar*
  - Brussels CA 11/03/2009, *Land Rover*
  - Pres. Comm. Brussels 17/07/2009, *BMW*
  - Pres. Comm Brussels 30/05/2012, *Nissan*
  - Mons CA 25/01/2016, *Ssangyong*



- Assessment *in concreto* - E.g.:
  - Hof Amsterdam 7/07/2005, *Van As v Subaru*
  - HR, 10/07/2009, *G-Star v Makro*
  - CFI The Hague 13/03/2019, *Hyundai*

C

**CREVÉ !**



**CREVÉ !**

C



## FLAT TRADEMARKS (1)

- Pres. Brussels FR Enterprise Court 18/01/2018, *Bridgestone v Campagnolo*, A/16/05258

‘POTENZA’ v



BX: tires for vehicles      BX: spare parts for bicycles

EU: tires for cars, for bicycles, for aircrafts

- Partial cancellation of earlier marks for non-use
  - Use for tires for automobiles only:
    - ✓ BX TM: Sufficient to prove use for ‘tires for vehicles’ (homogeneous category)
    - ✓ EU TM: Cancellation for other tires than ‘tires for cars’



## FLAT TRADEMARKS (2)

Conflict between 'POTENZA' (BX for 'tires for vehicles'; EU for 'tires for cars, tires for bicycles, tires for aircrafts etc.')

and BX trademark



for spare parts for bicycles

- Cancellation later mark: likelihood of confusion
  - Professional and general public; average level of attention
  - Similar goods (earlier BX TM)
    - ✓ Similar nature, same destination and use, functional complementarity, overlap in distribution channels
  - Signs at issue not identical (*LTJ Diffusion*) but highly similar
  - High inherent distinctiveness of earlier marks



/

## FLAT JUDGMENT ?

- GCEU 19/09/2018, T-623/16, *Volkswagen v EUIPO - Paalupaikka Oy*



v



(both for 'vehicles')

- No similarity between the signs; hence, no ground for refusal under Articles 8(1)(b) or 8(5) EUTMR
  - 'Main Auto Wheels' not descriptive
  - Overall different visual impression - prospective analysis
  - No phonetical or conceptual similarity
    - ✓ Same pattern ≠ conceptual similarity

**MAXITUNING**



**MAXITUNING**

*TAGEL*



## / TUNING OF SECOND-HAND LUXURY CARS

- Antwerp CA 26/02/2015, *Luxurycarselection v Porsche* 2014/AR/1120

Use of 'Porsche' and/or 'Cayenne' to promote sale of tuned second-hand Porsche Cayenne cars

- Infringement under Art. 2.20.1(a) and (c) BCIP and fair market practices
  - Function of origin/guarantee of quality (a)
  - Prejudice to reputation/distinctiveness (c)
  - Good faith not relevant
- No reference to Art. 2.23.3 BCIP
  - Cf. Benelux CJ 6/11/1992, A 89/1, *Valeo*





## / CONFLICT WITH EARLIER MARK FOR (CONVERSION OF MOTOR VEHICLES INTO) HEARSESES

- GCEU 20/02/2018, T-45/17, *Kwang Yang Motor v EUIPO - Udo Schmidt*

Conflict between earlier EUTM (conversion of motor vehicles word mark for motorcycles)



registered for automobiles and into) hearses, and later 'CK1'

- Likelihood of confusion
  - Level of attention of relevant public higher than average
  - Similar goods
    - ✓ *Similar nature and use, same destination and distribution channels*
  - Average degree of similarity between the signs
  - Distinctiveness earlier mark is normal
  - '1' = sequence number of earlier mark ?

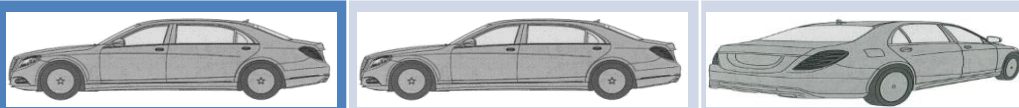




## STRETCHED CARS

- Pres. Brussels FR Enterprise Court, 20/04/2016, A/15/04227, *Trasco v Capital People* ('stretched Mercedes SW 222')

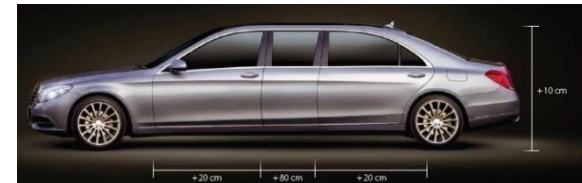
Community design No 001411888-0001



Community design No 001411888-0005



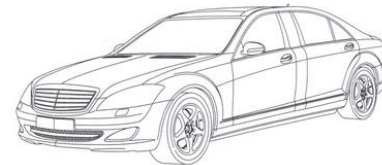
Community design No 001411888-0006





## STRETCHED CARS

- Claim is admissible despite possible copyright infringement Mercedes SW 222
- Validity Community designs?
  - Prior designs (Wayback machine): Mercedes SW 222 and stretched Mercedes SW 221



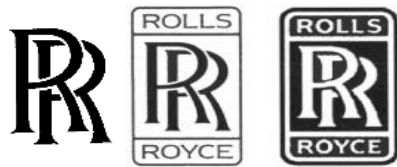
- Novelty: yes
- Individual character: no ('déjà vu')
  - ✓ Informed user unlikely to pay attention to the doors' length and proportions





## / NOT EVERY RR IS A ROLLS-ROYCE (1)

- CFI The Hague 13/06/2018, C/09/505582 / HA ZA 16-202, *Rolls-Royce v Rebel & Rich a.o.*



for cars and jewellery

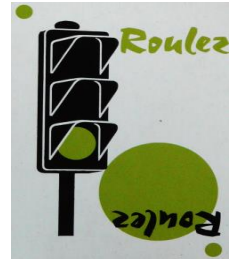
v



REBEL&RICH

for jewellery

- No infringement sub b
  - Identical goods (jewellery)
  - But low degree of (visual) similarity between the signs
  - ✓ No phonetical or conceptual similarity
  - Earlier marks, though distinctive, have no reputation for jewels
  - Contextual use of later marks (celebrities) ?



## / NOT EVERY RR IS A ROLLS-ROYCE (2)



for cars and jewellery

v



for jewellery

### ➤ No infringement sub c

- Earlier marks have a reputation for cars
- Risk of association ?
- No free-riding
- Prejudice to earlier mark's distinctiveness or reputation is unlikely
- ✓ Economic behavior average consumer of RR cars unlikely to change



/

P@RSCHE...



- Hof Den Haag 14/08/2018, C/09/491187 / HA ZA 15/732, *X v Porsche*  
'PORSCHE' & 'PORSCHE DESIGN' v 'P@RSCHE' (various goods and/or services)
  - Cancellation later trademark (likelihood of confusion)
    - Not in dispute: identity of goods or services
    - Signs at issue are similar
    - Earlier marks highly distinctive
    - No intent to use later mark is irrelevant (prospective analysis)
  - Prohibition to file further trademarks consisting of 'P@RSCHE' or any other sign comprising seven letters including 'P', 'R', 'S', 'C', 'H' and 'E' in positions 1, 3, 4, 5, 6 and 7, and another letter or symbol in position 2 ('exceptional circumstances') - also for dissimilar goods or services (sub c)
  - Legal costs: Art. 14 Dir. 2004/48/EC not applicable to cancellation actions



/

...CARRERA



- CJEU 21/01/2016, C-50/15 P, *Kurt Hesse v OHIM - Porsche*

‘CARRERA’ for cars

v ‘CARRERA’ for (satellite-based) mobile navigation apparatus

➤ Likelihood of confusion

- The goods might not be of the same nature, destination and use, might not have the same commercial origin and might not be marketed through the same distribution channels, but the complementary nature of the goods is an autonomous criterion capable of being the sole basis for the existence of similarity between the goods concerned







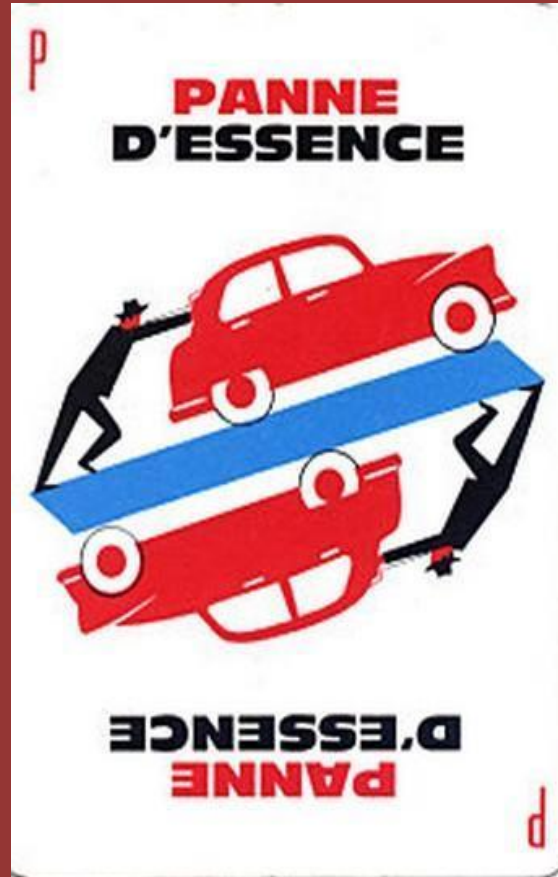
## THE RACE FOR REGISTRATION

- Pres. Brussels FR Enterprise Court 3/08/2018, *ACO v Masters Historic Racing Ltd.*, A/17/03342

Conflict between EUTMs ‘LE MANS LEGEND’ and  and ‘MASTERS LE MANS LEGENDS SERIES’

- Infringement under Art. 9(1)(c) EUTMR
  - Comparison with the later trademark *as used* (not *as registered*)
  - Signs at issue are similar (‘LE MANS’ not generic)
  - Association
  - Unfair advantage and risk of prejudice to distinctiveness
  - No due cause
- Pan-European injunction (defendant in the UK)

# CONCLUSION





# Thank you for your attention !



## **ALTIUS Brussels**

**Tour & Taxis Building**

Havenlaan 86C B414 Avenue du Port

1000 Brussels / Belgium

t +32 2 426 14 14

## **ALTIUS Louvain-La-Neuve**

**Business Center Centre du Lac**

Rue de Rodeuhaie 1

1348 Louvain-La-Neuve / Belgium

t +32 10 88 11 67



[olivier.vrins@altius.com](mailto:olivier.vrins@altius.com)

[www.altius.com](http://www.altius.com)

IN COOPERATION WITH TIBERGHIE