THE BATTLE OVER SPARE PARTS

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In France, automotive spare parts can be protected by design rights or copyright if they meet the conditions for protection provided by the national laws, whereas they are no longer protectable in many European countries and cannot be protected by a Community design.

However, in France this protection may be limited in some cases, notably because of the 'must fit' rule, provided by Article L.511-4.2, which was introduced into French law when the European Designs Directive CE No. 98/71 (October 13, 1998) was implemented.

For these reasons, car manufacturers have tried to find new solutions for fighting against the copying of their spare parts and limiting spare parts suppliers from manufacturing and selling compatible products.

They also remain very vigilant about the use of their trademarks by the spare parts suppliers and react when this use is not strictly in conformity with the law.

In this context, the Court of Turin in Italy filed on November 10, 2014 a request for a preliminary ruling in a case involving car manufacturer Ford and Italian parts supplier Wheeltrims, which was selling spare parts with trademarks owned by Ford affixed to them without its authorisation.

This dispute seems at first glance to raise the old question concerning the use of the original trademark in relation to spare parts and accessories when they are not manufactured by the constructor itself.

We know that such reproduction is considered to be trademark infringement when it occurs without the consent of the owner and when this use is not necessary for informing the consumer about the destination of the goods.

However, in the present case, Ford was affixing its trademark to its own spare parts itself and, as a result, the Italian company had been reproducing the trademark on the compatible products so that they would be identical to the original ones, and the vehicle, when the spare part is installed, would keep its original appearance.

Therefore, it seems hard in such a case to find a compromise that maintains competition on the market between the spare parts suppliers, which are willing to offer spare parts and accessories to the consumer, and the exclusive rights of the IP right owner.

Article 14 of the European Designs Directive, the so-called repair clause, defines the replacement part as "a part of a complex product, used for the purpose of the repair of that complex product in order to restore its original appearance". Article 110 of the Community Design regulation gives a similar definition.

However, the European authorities did not define the conditions of application of these provisions, which only exclude any protection as a Community design on these parts and forbid member states from amending existing national provisions, except for the purpose of market liberalisation.

"THE CJEU HAS NOW BEEN ASKED WHETHER IT IS COMPATIBLE WITH EU LAW FOR PRODUCERS OF REPLACEMENT PARTS AND ACCESSORIES TO AFFIX THIRD PARTY TRADEMARKS ON THE PRODUCTS."

The problem in the present case goes beyond the issue of the interpretation of articles 14 and 110 of the directive and regulation respectively. It also concerns the question of whether trademark law, like design law, can be defeated, on the ground that the spare part must conform to the original.

The CJEU has then been asked whether it is compatible with EU law for producers of replacement parts and accessories to use third party trademarks to allow end purchasers to restore a complex product's original appearance when the trademark is affixed to the part and externally visible, and therefore contributes to the external appearance of the complex product.

The question is therefore whether in such a situation there can be derogation from the rules laid down in the EU Council Regulation No. 207/2009 and Directive No. 2008/95/EC on trademarks.

The potential economic impact of the decision that the CJEU will render is obviously very important and there is no doubt that this issue will be closely watched by all operators in the market. ■

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