

Anonymised version

Translation

C-123/20 — 1

Case C-123/20

Request for a preliminary ruling

Date lodged:

4 March 2020

Referring court:

Bundesgerichtshof (Germany)

Date of the decision to refer:

30 January 2020

Applicant and Appellant in the appeal on a point of law:

Ferrari SpA

Defendants and Respondents in the appeal on a point of law:

Mansory Design & Holding GmbH

WH

BUNDESGERICHTSHOF (FEDERAL COURT OF JUSTICE)

DECISION

[...]

Delivered on

30 January 2020

[...]

in the case of

Ferrari S.p.A., [...] Modena, Italy,

EN

Applicant and Appellant in the appeal on a point of law,

[...]

v

1. Mansory Design & Holding GmbH, [...] Brand,
2. WH, [...] Brand,

Defendants and Respondents in the appeal on a point of law,

[...] **[Or. 2]**

Further to the hearing of 14 November 2019 [...], the First Civil Chamber of the Federal Court of Justice

makes the following order:

- I. The proceedings are stayed.
- II. The following questions are referred to the Court of Justice of the European Union for a preliminary ruling on the interpretation of Article 11(1) and the first sentence of Article 11(2), as well as of Article 4(2)(b) and Article 6(1)(a) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3):

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 (EC) 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 **[Or. 3]** is possible to identify an aesthetic overall impression which is independent of the overall form?

Grounds:

- 1 A. The applicant, which is established in Italy, manufactures racing and sports cars. Its current top-of-the-range model is the Ferrari FXX K, which was manufactured in only very limited numbers and is designed for use on racetracks only; it is not approved for use on public roads. The Ferrari FXX K was first unveiled to the public in a press release issued by the applicant on 2 December 2014, which contained the following images (one side view and one front view).



- 2 The limited edition was sold out in a few days at a price of EUR 2.2 million per car. There are two variants of the model, which differ in appearance only in so far as on one, the bottom part of the 'V' that curves down to the front of the bonnet is painted the same colour as the car, whereas the rest of the 'V' is painted black, as illustrated in the images below: [Or. 4]

WORKING DRAFT



- 3 On the other, the entire 'V', including the tip, is painted black, as illustrated below:



[Or. 5]



- 4 The first defendant, of which the second defendant is the chief executive officer, manufactures attachments for the applicant's cars. Since 2016, it has distributed parts in 'body kits' for the Ferrari 488 GTB under the label '4XX'. The body kits can be used to alter the road model Ferrari 488 GTB, which has been available in an unlimited edition since 2015 at a net list price of EUR 172 607 per car. The following kits or attachments are available and are offered and distributed separately: 'front kit', 'rear kit', 'side set', 'roof cover' and 'rear wing'. The first defendant distributes two different versions of the 'front kit', one with a completely dark-coloured 'V' on the bonnet and one with a 'V' that is only partially filled in. A complete conversion, which costs approximately EUR 143 000, involves replacing most of the visible body panels. The first defendant unveiled one such conversion at the Geneva Motor Show in March 2016 under the name 'Mansory Siracusa 4XX', as illustrated in the image below. [Or. 6]



- 5 The applicant contends that components offered by the defendants infringe an unregistered Community design that subsists in its favour in the section of the car comprising the V-shaped element that curves down to the front of the bonnet on the Ferrari FXX K, the fin-like element protruding from the centre of that element and fitted lengthways ('strake'), the front lip spoiler integrated into the bumper and the vertical bridge in the centre connecting the front spoiler to the bonnet (claimed design 1); that that section is seen as a unit that shapes the individual features of the Ferrari FXX K, while at the same time creating an association with an aircraft or Formula 1 car; and that claimed design 1 arose on publication of the press release on 2 December 2014.
- 6 The applicant further contends that, in the alternative, an unregistered Community design for the front lip spoiler arose in its favour on publication of the press release on 2 December 2014 or, at the very latest, on the release of a film entitled 'Ferrari FXX K — The Making Of' on 3 April 2015 (claimed design 2), that has also been infringed.
- 7 The applicant bases its claim, in the further alternative, on an unregistered Community design (claimed design 3) in respect of another image depicting the car in an oblique view, also contained in the press release of 2 December 2014 and shown below, that extends to the design of the Ferrari FXX K illustrated therein. **[Or. 7]**



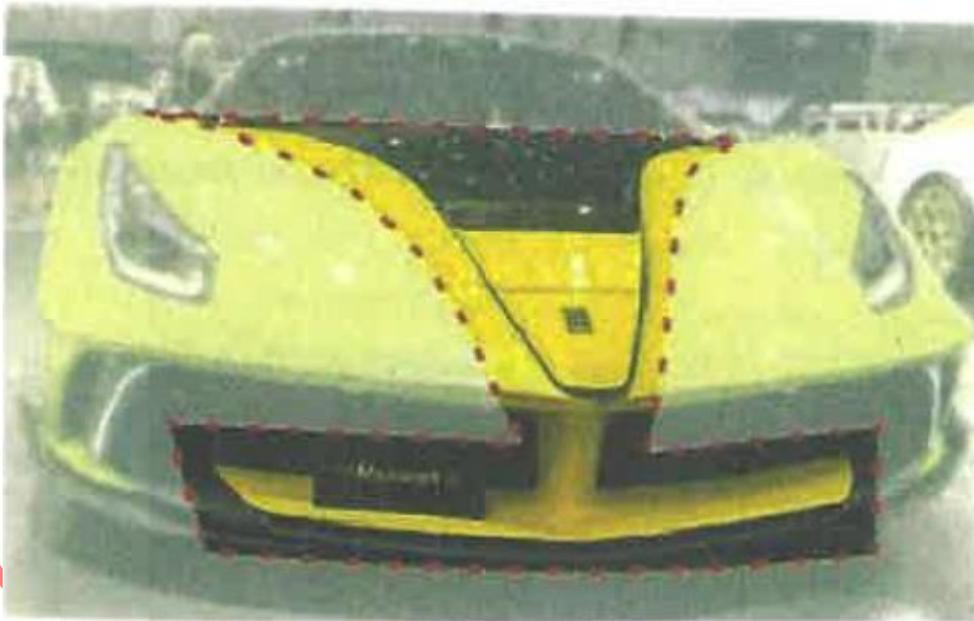
- 8 In the fourth place, the applicant alleges that it is entitled to protection against imitation under the law on fair trading practices, and that the Ferrari FXX K has individual character in respect of the three defining features of the front section.
- 9 In the proceedings at first instance, the applicant sought an EU-wide injunction against the making, offering, putting on the market, importing, exporting, using or stocking of the attachments, and made a number of associated requests (rendering of account, recall, destruction and determination of damages). The Landgericht (Regional Court) dismissed the action.
- 10 In the appeal proceedings, and in view of the fact that the protective rights claimed were to expire on 3 December 2017, the applicant declared the dispute to have been settled in part in the main issue: first, in respect of the injunction application, inasmuch as it was based on Community design rights, and, second, in respect of the associated requests for recall and destruction. The defendants concurred with the declaration of partial settlement.
- 11 In the appeal proceedings, the applicant, in so far as is relevant for the reference to the Court of Justice of the European Union, requested that the judgment at first instance be varied by claiming that the court should:

find the defendants jointly and severally liable for damages for all its losses past and future incurred by reason of the fact that, up to 3 December 2017, the defendant

made, offered, put on the market, imported, exported, used or stocked for those purposes, as attachments for cars within the territory of the European Union, ‘front kits’ which, irrespective of the colour, are configured in the middle section as outlined in dashed red lines in the following images: [Or. 8]



and/or



with the following design features:

- 1 a V-shaped element along the centre of the entire bonnet to create the illusion of the cockpit extending forwards and the impression of a raptor's head, with the V-shaped element forming a curved beak and the upper section at least in a dark colour;
- 2 a fin-like element protruding from the centre of that element and fitted lengthways;

- 3 a front lip spoiler,
 - 3.1 the upper lip of which, painted in the same colour as the bodywork, extends over approximately half the width of the car and is connected via a central vertical bridge to the bonnet,
 - 3.2 the lower lip of which is painted a contrasting colour and is wider than the upper lip,
 - 3.3 whereby there is a horizontal slit between the upper lip and the lower lip,
 - 3.4 whereby the upper lip is embedded in the lower lip so that both lips form a continuous surface;

in the alternative:

used, as attachments for sports cars throughout the territory of the European Union, 'front kits', 'rear wings', 'side sets' and 'roof covers', together with a two-digit number applied to the door of the sports car, which, irrespective of [Or. 9] the colour, are configured in such a way that, after the conversion, the car appears as illustrated below:



with the following design features:

- 1 to 3.4 [as in the main claim]
- 4 a basic sports car design with a flat nose and raised tail, the upper outline of which resembles a soft curve with an almost continuous alignment along the entire length of the car;
- 5 a dark sunken cockpit with a lens-shaped side window;

- 6 front headlights on each side of the top of the front section, optically extending backwards as far as the wings;
 - 7 a large air intake in the rear section of the door;
 - 8 a large number painted on the door in a sans serif italic font;
 - 9 a downward curve on the side of the car starting behind the front wheel, dropping 45° and then extending upwards in a thin line to the top third of the rear wheel;
 - 10 a fin with a short, stubby spoiler extending sideways from the fin at each top corner of the tail.
- 12 The applicant's appeal was unsuccessful [...]. The applicant is pursuing its claims by way of the appeal on a point of law which the chamber granted it leave to bring. The defendants contend that the appeal on a point of law should be dismissed.
- 13 B. The success of the appeal on a point of law regarding the claims based on infringement of unregistered Community designs depends upon the interpretation of Article 11(1) and the first sentence of Article 11(2), as well as of Article 4(2) and Article 6(1) of Regulation (EC) No 6/2002 on Community designs ('the Community Design Regulation'). **[Or. 10]** For that reason, prior to a decision on the appeal, the proceedings are to be stayed and a preliminary ruling is to be obtained from the Court of Justice of the European Union pursuant to the first paragraph, under (b), and the third paragraph of Article 267 TFEU.
- 14 I. The court of appeal found the claims put forward under Community design law to be unfounded, holding in that regard as follows:
- 15 Claimed design 1 had not arisen, as the applicant had failed to show conclusively the minimum requirement of a certain autonomy and consistency of form. It merely refers to an arbitrarily defined section. Even if one accepted that the front is viewed as a 'face', that would include components not included by the applicant, namely the 'eyes' (headlamps) and 'jaws' (side ends of the spoiler). Likewise, claimed design 2 does not subsist, due to the lack of consistency of form. Although claimed design 3 may be assumed to exist, it is not protected sufficiently broadly to justify an assumption that there has been an infringement. The degree of freedom of the designer of the Ferrari FXX K was so restricted due to the design density that only average protection can be assumed. By that standard, there is insufficient correspondence in the overall impression.
- 16 II. The success of the appeal on a point of law depends, as regards the claims based on infringement of unregistered Community designs, upon the interpretation of Article 11 as well as of Article 4(2) and Article 6(1) of the Community Design Regulation, which need to be clarified in terms of the question of whether and

subject to what requirements an unregistered Community design can subsist in component parts of a complex product.

- 17 1. The sections of the Ferrari FXX K car claimed by the applicant as designs (claimed designs 1 and 2) are component parts of a complex product within the meaning of Article 4(2) of the Community Design Regulation. **[Or. 11]**
- 18 (a) Article 3(b) of the Community Design Regulation defines a product as 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. Article 3(c) of the Community Design Regulation defines a complex product as a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product. In the absence of any definition of the term ‘component part’ in the Regulation, it must be understood in accordance with its usual meaning in everyday language (judgment of 20 December 2017, *Acacia and D’Amato*, C-397/16 and C-435/16, EU:C:2017:992, paragraph 64). It is through the words ‘component parts of a complex product’ that the Community Design Regulation 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 (judgment of 20 December 2017, *Acacia and D’Amato*, C-397/16 and C-435/16, EU:C:2017:992, paragraph 65).
- 19 (b) On that basis, the section of the Ferrari FXX K car comprising the V-shaped element that curves down to the front of the bonnet, the fin-like element protruding from the centre of that element and fitted lengthways (‘strake’), the front lip spoiler integrated into the bumper and the vertical bridge in the centre connecting the front spoiler to the bonnet, which section is claimed by the applicant as claimed design 1, is a component part of a complex product. That section comprises parts, intended to be assembled into an industrially produced car, which can be replaced permitting disassembly and re-assembly of the car, without which the car could not be subject to normal use. The same applies to the parts claimed by the applicant as claimed design **[Or. 12]** 2 (front lip spoiler of the Ferrari FXX K).
- 20 2. In this dispute, the question that requires clarification is whether and subject to what requirements part of the bodywork of a vehicle qualifies as a component part of a complex product and can be protected as an unregistered Community design.
- 21 (a) The first question that requires clarification is whether publication of an overall image of a product can give rise to an unregistered Community design in individual parts of the product (Question 1).
- 22 (aa) Article 11(1) of the Community Design Regulation states that a design which meets the requirements under Section 1 of the Community Design Regulation is to 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 Community. The first sentence of Article 11(2) of the Community Design Regulation states that a design is to be deemed to have been made available to the public within the Community 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 Community. Article 3(a) of the Community Design Regulation defines a design for the purposes of the Regulation 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.

- 23 (bb) The chamber has ruled in respect of registered designs that protection for parts or elements of an overall product does not arise from a design registered as an overall product under design law harmonised in EU law under the Community Design Regulation and Directive 98/71/EC. It does not follow from the wording of either the Community Design Regulation or Directive 98/71/EC that protection can be claimed for parts or elements of a registered design **[Or. 13]**. Nor is protection needed for parts or elements of a design as, according to the definition in Article 3(a) of the Community Design Regulation, it is also possible to obtain protection as a design for the appearance of parts or elements of a product [...]. In the interests of legal certainty, only the appearance of part of a product applied for and registered as the appearance of part of a product is to be protected as a registered design. That requirement ensures that the interested public can search the design register and reliably identify what is protected by a design, whereas if parts of registered designs could be protected as designs, it would often be unclear whether and to what extent parts of a registered design qualified for that protection. Applicants are able and can be reasonably expected to clarify whether protection is sought for the appearance of a (whole) product or for part of a product [...].
- 24 (cc) It is perfectly clear from Article 3(a) of the Community Design Regulation that an unregistered Community design can also subsist in part of a product. However, if the image of an overall product for the purposes of Article 11(1) of the Community Design Regulation is made available to the public, rather than the image of the part of the product, the question arises, as for registered designs, as to whether that disclosure can give rise to an unregistered Community design for parts of the overall product shown. The chamber is inclined to the view that disclosure of the image of an overall product can only give rise to an unregistered Community design for the overall product and not for its parts. That view promotes legal certainty, as it makes clear that separate disclosure **[Or. 14]**, for example by providing an image of the individual part or marking it on the overall image, is necessary in order to claim protection for parts of a product [...]. Another view would be that disclosure of an overall product can include disclosure of, and thus establish protection for, the product's components, provided that specialised circles recognise that such disclosure establishes protection [...]. However, the ability to determine if it has a recognisable effect of

establishing protection, for example in light of whether parts can also be used in other products [...], is vitiated by considerable uncertainty.

- 25 Question 1 is not adequately clarified by the Court of Justice of the European Union in a judgment delivered in proceedings to have a registered design declared invalid (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).
- 26 (b) Inasmuch as the disclosure of an image of an overall product may also establish protection for parts of the product, it is also necessary to clarify the requirements subject to which an unregistered Community design may arise for parts of a product (Question 2).
- 27 (aa) Article 4(1) of the Community Design Regulation states that a design is to be protected by a Community design to the extent that it is new and has individual character. Article 4(2) of the Community Design Regulation states that a design applied to or incorporated in a product which constitutes a component part of a complex product is to be considered to be new and to have individual character only (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the product, and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character. Article 4(3) of the Community Design Regulation states that [Or. 15] normal use means use by the end user, excluding maintenance, servicing or repair work. Article 6(1)(a) of the Community Design Regulation states that an unregistered design is to 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 before the date on which the design for which protection is claimed has first been made available to the public.
- 28 (bb) Once they have been incorporated into the cars manufactured by the applicant, the parts of the bodywork which the applicant claims are unregistered Community designs are visible during normal use of the product, and thus the requirement of Article 4(2)(a) of the Community Design Regulation is met.
- 29 (cc) In the case of a component part which is to be incorporated into a complex product, such as the car bodywork parts at issue in this dispute, the question arises as to the legal criterion by which the overall impression should be determined when examining individual character within the meaning of Article 4(2)(b) and Article 6(1)(a) of the Community Design Regulation.
- 30 Individual character exists if the overall impression produced by the component part on the informed user differs from the overall impression produced by a different component part. A design applied to or incorporated in a product which constitutes a component part of a complex product is considered to have individual character if the component part, once it has been incorporated into the complex product, remains visible during normal use of the product (as is the case

here), and to the extent that those visible features of the component part fulfil in themselves the requirements as to individual character. This means that the overall impression produced by these visible features of the component part on the informed user must differ from the overall impression produced on such a user by the visible features of a different component part. According to the case-law of the chamber, the function of a design is to stimulate an aesthetic feeling through its effect on the sense of shape (and colour) of the person viewing the product **[Or. 16]**. Therefore, the consistency of the overall impression cannot be judged independently of how the product is viewed during normal use [...].

- 31 The chamber has ruled in respect of registered designs within the meaning of Paragraph 1(1) of the previous version of the Gesetz über den rechtlichen Schutz von Design (GeschMG) (Law on the Legal Protection of Designs) that a part of a registered design could qualify separately for design protection, inasmuch as, of itself, it fulfilled the requirements of novelty and individual character and displayed a certain autonomy and consistency of form such that it was possible to identify an aesthetic overall impression of the sub-assembly which was independent of the overall form [...]. However, it is no longer possible to apply those criteria to registered designs under design law harmonised in EU law under the Community Design Regulation and Directive 98/71/EC, as they do not allow partial protection to be derived from a registered design [...]. **[Or. 17]**
- 32 In the chamber's view, in the case of an unregistered design of a component of a complex product also, the component part may only be considered to have individual character where 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 that is independent of the overall form.

[...]