



Reports of Cases

JUDGMENT OF THE COURT (Fourth Chamber)

11 January 2024*

(Reference for a preliminary ruling – Trade marks – Directive 2008/95/EC – Article 6(1)(c) – Limitation of the effects of the trade mark – Use of a trade mark to indicate the intended purpose of a product or service – Directive (EU) 2015/2436 – Article 14(1)(c))

In Case C-361/22,

REQUEST for a preliminary ruling under Article 267 TFEU from the Tribunal Supremo (Supreme Court, Spain), made by decision of 12 May 2022, received at the Court on 3 June 2022, in the proceedings

Industria de Diseño Textil SA (Inditex)

v

Buongiorno Myalert SA,

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: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Industria de Diseño Textil SA (Inditex), by F. Arroyo Álvarez de Toledo and R. Bercovitz Álvarez, abogados,
- Buongiorno Myalert SA, by J.J. Marín López, abogado, and A. Vázquez Pastor, procuradora,
- the Spanish Government, by I. Herranz Elizalde, acting as Agent,
- the European Commission, by P. Němečková and J. Samnadda, acting as Agents,

* Language of the case: Spanish.

after hearing the Opinion of the Advocate General at the sitting on 7 September 2023,
gives the following

Judgment

- 1 This reference for a preliminary ruling concerns the interpretation of Article 6(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).
- 2 The request has been made in proceedings between Industria de Diseño Textil SA (Inditex) and Buongiorno Myalert SA ('Buongiorno') concerning an alleged infringement of rights conferred by a national trade mark owned by Inditex by reason of the alleged use by Buongiorno of a sign identical to that trade mark without the consent of Inditex.

Legal context

European Union law

First Directive 89/104

- 3 Article 5 of First Directive 89/104, entitled 'Rights conferred by a trade mark', stated, in paragraphs 1 and 2:

'1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

 - (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
 - (b) any sign where, because of its identity with, or similarity to, the trade mark and 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.
2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State 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 trade mark.'

- 4 Article 6 of First Directive 89/104, entitled ‘Limitation of the effects of a trade mark’, provided, in paragraph 1:

‘The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade,

...

(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

provided he uses them in accordance with honest practices in industrial or commercial matters.’

- 5 First Directive 89/104 was repealed and replaced by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), which came into force on 28 November 2008.

Directive 2008/95

- 6 Article 5 of Directive 2008/95, entitled ‘Rights conferred by a trade mark’, provided, in paragraphs 1 and 2:

‘1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

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

(b) any sign where, because of its identity with, or similarity to, the trade mark and 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; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State 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 trade mark.’

- 7 Article 6 of Directive 2008/95, entitled ‘Limitation of the effects of a trade mark’, provided, in paragraph 1:

‘The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

...

(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

provided he uses them in accordance with honest practices in industrial or commercial matters.’

8 Directive 2008/95 was repealed and replaced, with effect from 15 January 2019, by 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).

Directive 2015/2436

9 Article 14 of Directive 2015/2436, entitled ‘Limitation of the effects of a trade mark’, states, in paragraphs 1 and 2:

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

...

(c) the 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 the 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.’

Spanish law

10 In the version transposing Article 5 of First Directive 89/104, Article 34 of Ley 17/2001 de Marcas (Law 17/2001 on trade marks) of 7 December 2001 (BOE No 294 of 8 December 2001, p. 45579; ‘the Law on Trade Marks’) provided:

‘1. The registration of a trade mark shall confer on the proprietor exclusive rights to use it in the course of trade.

2. The registered trade mark proprietor shall be entitled to prohibit all third parties not having his or her consent from using in the course of trade:

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

(b) any sign which, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services, gives rise to 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) any sign which is identical with, or similar to, goods or services which are not similar to those for which the trade mark is registered, where that trade mark is well known or has a strong reputation in Spain and the use of the sign without due cause may indicate a connection between those goods or services and the trade mark proprietor or, generally, where that use takes unfair advantage of, or is detrimental to, the distinctive character, well-known nature or strong repute of the registered trade mark.’

- 11 In its original version, Article 37(1)(c) of the Law on Trade Marks, which transposed Article 6(1)(c) of First Directive 89/104 into Spanish law, stated:

‘The rights conferred by the trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, the elements stated below, provided that that use is in accordance with honest practices in industrial or commercial matters:

...

(c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.’

- 12 Article 37 of the Law on Trade Marks was amended by Real Decreto-ley 23/2018 de transposición de directivas en materia de marcas, transporte ferroviario y viajes combinados y servicios de viaje vinculados (Royal Decree-Law 23/2018 transposing the directives on trade marks, rail transport and package travel and associated travel services) of 21 December 2018 (BOE No 312 of 27 December 2018, p. 127305), in order to transpose Article 14(1)(c) of Directive 2015/2436.

- 13 In its amended version, Article 37(1) and (2) of the Law on Trade Marks provides:

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

...

(c) the 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 the 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.’

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

- 14 Buongiorno is a provider of information services via the internet and mobile telephone networks. In 2010, that provider launched an advertising campaign for a paid subscription to a multimedia messaging service, marketed under the name ‘Club Blinko’. The subscription to that service allowed for the participation in a prize draw, in which one of the prizes was a ‘ZARA gift card’ worth EUR 1 000. After clicking on a banner to access the prize draw, on the next screen the subscriber was shown the ‘ZARA’ sign in a rectangle, reminiscent of the design of gift cards.

- 15 Inditex brought an infringement action before the Juzgado de lo Mercantil No 2 de Madrid (Commercial Court No 2, Madrid, Spain) against Buongiorno claiming infringement of the exclusive rights conferred by a national trade mark protecting the ‘ZARA’ sign (‘the ZARA trade mark’). In support of that action, based on Article 34(2)(b) and (c) of the Law on Trade Marks, Inditex cited reasons relating, respectively, to the existence of a likelihood of confusion and to the advantage taken of, and detriment caused to, the trade mark’s reputation.
- 16 Buongiorno denied that rights conferred by the ZARA trade mark were infringed, arguing that it had made specific use of that sign not as a trade mark but to refer to one of the gifts offered to the winners of the prize draw. According to Buongiorno, such ‘referential’ use comes under the lawful uses of third parties’ distinctive signs provided for in Article 37 of the Law on Trade Marks, both in its original version and its amended version.
- 17 The court of first instance dismissed Inditex’s action. Having found that Buongiorno’s use of the ZARA trade mark did not constitute a ‘referential’ use covered by Article 37 of the Law on Trade Marks, in its original version, that court took the view that the conditions set out in Article 34(2)(b) and (c) of the Law on Trade Marks were not met.
- 18 Inditex brought an appeal against that decision before the Audiencia Provincial de Madrid (Provincial Court, Madrid, Spain), relying on an infringement of the trade mark under Article 34(2)(c) of the Law on Trade Marks. That appeal was dismissed by the Audiencia Provincial de Madrid (Provincial Court, Madrid), which found that the use of the ZARA trade mark by Buongiorno did not damage the reputation of that trade mark or take unfair advantage of that reputation.
- 19 Inditex brought an appeal on a point of law before the Tribunal Supremo (Supreme Court, Spain), which is the referring court.
- 20 That court states that Article 37(c) of the Law on Trade Marks, in its original version, applicable *ratione temporis* to the facts of the dispute in the main proceedings, constituted the transposition of Article 6(1)(c) of First Directive 89/104, the wording of which was not substantially amended by Directive 2008/95.
- 21 The referring court states that the current version of Article 37(1)(c) of the Law on Trade Marks transposes Article 14(1)(c) of Directive 2015/2436, that directive having repealed and replaced Directive 2008/95.
- 22 The referring court notes that Article 14(1)(c) of Directive 2015/2436 makes reference to general conduct, that is to say, ‘identifying or referring to goods or services as those of the proprietor of that trade mark’, followed by the expression ‘in particular’, which in turn is followed by a reference to more specific behaviour, that is to say, ‘where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts’. Given that only the more specific conduct appeared in Article 6(1)(c) of First Directive 89/104, that court has doubts as to the scope of the reference to general conduct introduced in Article 14(1)(c) of Directive 2015/2436. That court asks whether that reference makes explicit something that was implicitly included in Article 6(1)(c) of First Directive 89/104 or whether the scope of ‘referential’ uses has been expanded by Directive 2015/2436.

- 23 In that respect, the referring court states that its question is highlighted by the interpretation of Article 6(1)(c) of First Directive 89/104 in the judgments of 17 March 2005, *Gillette Company and Gillette Group Finland* (C-228/03, EU:C:2005:177), and of 8 July 2010, *Portakabin* (C-558/08, EU:C:2010:416, paragraphs 63 and 64). That court considers that the Court of Justice appears to have restricted the scope of the limitation of the effects of the mark to the use necessary to indicate the intended purpose of a product, particularly when it explained that the objective pursued by Article 6(1)(c) of First Directive 89/104 is ‘to enable providers of goods or services, which are supplementary to the goods or services offered by a trade mark proprietor, to use that mark in order to inform the public of the practical link between their goods or services and those of the proprietor of the mark’.
- 24 The referring court indicates that the answer to the question referred for a preliminary ruling will affect the outcome of the dispute in the main proceedings. It states that, if it upholds the ground of appeal relating to the interpretation and application of the provision conferring protection on trade marks with a reputation, it will have to examine whether the use of the ZARA trade mark by Buongiorno is covered by the limitation provided for in Article 37(1)(c) of the Law on Trade Marks, in its original version, applicable *ratione temporis* to the dispute which is the subject of the appeal, that limitation being equivalent to the one provided for in Article 6(1)(c) of First Directive 89/104. In the referring court’s view, Buongiorno’s conduct could, however, align more with the wording of Article 14(1)(c) of Directive 2015/2436 than with the wording of Article 6(1)(c) of First Directive 89/104.
- 25 In those circumstances, the Tribunal Supremo (Supreme Court) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

‘Must Article 6(1)(c) of [First Directive 89/104] be interpreted as implicitly including within the limitation on trade mark rights the more general conduct now referred to in Article 14(1)(c) of [Directive 2015/2436], namely the use of “the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark”?’

Admissibility of the request for a preliminary ruling

- 26 Inditex submits that the request for a preliminary ruling is inadmissible on two grounds.
- 27 In essence, Inditex states, in the first place, that, according to the referring court, the interpretation of Article 6(1)(c) of First Directive 89/104 is relevant only if the appeal can be upheld due to an infringement of Article 34(2)(c) of the Law on Trade Marks, that is to say, due to an infringement of a trade mark with a reputation. According to Inditex, the use of another person’s trade mark will not, in that case, be in accordance with ‘honest practices in industrial or commercial matters’ within the meaning of Article 37(1)(c) of the Law on Trade Marks, in its original version. Since the answer to the question is therefore not decisive for the purposes of the decision to be given by the referring court, the request for a preliminary ruling is inadmissible.
- 28 It should be noted that, according to the Court’s settled case-law, in the context of the cooperation between the Court and the national courts provided for in Article 267 TFEU, it is solely for the national court before which the dispute in the main proceedings has been brought, and which must assume responsibility for the subsequent judicial decision, to determine, in the light of the particular circumstances of the case, both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the question which it submits to the Court.

Consequently, where the question submitted concerns the interpretation or validity of a rule of EU law, the Court is in principle bound to give a ruling (judgment of 16 March 2023, *Beobank*, C-351/21, EU:C:2023:215, paragraph 43 and the case-law cited).

- 29 It follows that a question referred for a preliminary ruling concerning EU law enjoys a presumption of relevance. The Court may refuse to rule on such a question only where it is quite obvious that the interpretation or assessment of the validity of an EU rule which is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the question submitted to it (judgment of 16 March 2023, *Saatgut-Treuhandverwaltung (KWS Meridian)*, C-522/21, EU:C:2023:218, paragraph 26 and the case-law cited).
- 30 In the present case, it is apparent from the order for reference that the dispute in the main proceedings concerns the alleged use of a national trade mark by a third party without the authorisation of the proprietor of that mark and that the parties to that dispute disagree, in particular, as to the applicability of Article 37(1)(c) of the Law on Trade Marks, in its original version. It is also apparent from the order for reference that the national court is uncertain as to the scope of Article 6(1)(c) of First Directive 89/104, which concerns the limitation of the effects of a national trade mark and which was transposed into Spanish law by Article 37.
- 31 In those circumstances, it is not self-evident that the interpretation of Article 6(1)(c) of First Directive 89/104 that is sought bears no relation to the actual facts of the main action or its purpose or that the problem raised is hypothetical.
- 32 Furthermore, in so far as Inditex argues that the question referred for a preliminary ruling is hypothetical because the conditions for lawful use laid down in Article 6(1)(c) of First Directive 89/104 coincide with the conditions for use relating to a trade mark with a reputation which its proprietor may oppose, in accordance with Article 5(2) of that directive, with the result that those two provisions are mutually exclusive, it must be stated that that line of argument concerns the interpretation of the last sentence of Article 6(1) of that directive. Inditex's argument therefore seeks to raise a question of interpretation of Article 6(1) which differs from the one raised by the referring court and it cannot be inferred from this that the question referred is manifestly hypothetical.
- 33 In the second place, Inditex submits that the referring court appears to take the view that the wording of Article 14(1)(c) of Directive 2015/2436 allows the use of the mark at issue in the main proceedings, on the ground that this concerns 'referential' use, unlike what may be inferred from a literal interpretation of Article 6(1)(c) of First Directive 89/104. It observes that the use of a trade mark 'for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark' is not in itself lawful but must, moreover, be in accordance with 'honest practices in industrial or commercial matters' and comply with the rules on exhaustion of trade mark rights in the case of transactions involving the goods of another person. Therefore, the answer to the question referred for a preliminary ruling cannot be useful, because it is insufficiently clear to settle the question of law raised in the dispute in the main proceedings.
- 34 The fact that, in order to resolve that dispute, the referring court may also be required to examine or take into consideration provisions other than those referred to in its question cannot lead to the conclusion that that question bears no relation to the subject matter of the dispute and is therefore inadmissible.

- 35 Accordingly, the two arguments put forward by Inditex to challenge the admissibility of the request for a preliminary ruling must be rejected.
- 36 In its observations, the European Commission, without, however, openly submitting that the request for a preliminary ruling is inadmissible, observes that the question of the interpretation of Article 6(1)(c) of Directive 2008/95, applicable *ratione temporis* to the dispute in the main proceedings, arises only if the use of the ZARA trade mark by Buongiorno constitutes use by third parties in the course of trade, prohibited by Article 5 of that directive. Since the national court of first instance does not appear to have erred in law in finding that the use of the ZARA trade mark was not covered by any of the cases of use of the trade mark provided for in Article 34 of the Law on Trade Marks, transposing into Spanish law Article 5 of First Directive 89/104, there is no need to examine whether the conditions in Article 37 of that law, transposing, in its original version, Article 6(1)(c) of Directive 2008/95, are satisfied.
- 37 In that regard, it should be noted that the Commission's line of argument implies that the Court is to take a view on the interpretation of Article 5 of Directive 2008/95. Therefore, it must be rejected for the same reasons as those set out in paragraph 34 above.
- 38 Consequently, the request for a preliminary ruling must be held to be admissible.

Consideration of the question referred

- 39 It is apparent from the order for reference that the facts giving rise to the dispute in the main proceedings occurred in 2010. Since First Directive 89/104 was repealed and replaced by Directive 2008/95, which entered into force on 28 November 2008, the provision applicable *ratione temporis* at the time of the facts in the main proceedings is Article 6(1)(c) of Directive 2008/95, and not Article 6(1)(c) of First Directive 89/104, the latter provision having been replaced by the former. It should, however, be pointed out that the wording of those two provisions is identical.
- 40 It is also apparent from the request for a preliminary ruling that the referring court does not express any doubts as to the fact that, under Article 6(1)(c) of Directive 2008/95, the use of the trade mark must relate to the identification of or reference to the goods or services 'as those of the proprietor of that trade mark'. It should be noted that, although the wording of Article 14(1)(c) of Directive 2015/2436 now explicitly expresses that requirement, the existence of that requirement was apparent from the case-law relating to the interpretation of Article 6(1)(c) of First Directive 89/104 (see, to that effect, judgments of 17 March 2005, *Gillette Company and Gillette Group Finland*, C-228/03, EU:C:2005:177, paragraph 33, and of 8 July 2010, *Portakabin*, C-558/08, EU:C:2010:416, paragraph 64).
- 41 Thus, the doubts expressed by the referring court as to the interpretation of Article 6(1)(c) of Directive 2008/95 stem from the different wording of the provision which replaced it, namely Article 14(1)(c) of Directive 2015/2436, as regards the extent of the use of the trade mark by a third party which the proprietor of that mark could not prohibit, in so far as that use does not relate solely to the indication of the intended purpose of a product marketed by that third party or to a service offered by that party.
- 42 Therefore, in order to give a useful answer to the referring court, it is necessary to reformulate the question to the effect that, by that question, that court asks, in essence, whether Article 6(1)(c) of Directive 2008/95 must be interpreted as meaning that it covers any use of the trade mark in the

course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark, or only use of that trade mark which is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.

- 43 It should be recalled that, according to settled case-law, the interpretation of a provision of EU law requires account to be taken not only of its wording, but also of the context in which it occurs, as well as the objectives and purpose pursued by the act of which it forms part. The legislative history of a provision of EU law may also reveal elements that are relevant to its interpretation (judgment of 16 March 2023, *Towercast*, C-449/21, EU:C:2023:207, paragraph 31 and the case-law cited).
- 44 According to the wording of Article 6(1)(c) of Directive 2008/95, the trade mark must not entitle its proprietor to prohibit a third party from using the mark in the course of trade where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.
- 45 However, Article 14(1)(c) of Directive 2015/2436 states, first of all, that it covers the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, and then it reproduces the normative content of Article 6(1)(c) of Directive 2008/95, preceded by the expression ‘in particular’.
- 46 It is thus apparent from the literal comparison of those two provisions that the use that was capable of limiting the effects of a trade mark under Article 6(1)(c) of Directive 2008/95 now constitutes one of the situations of lawful use which the proprietor of a trade mark cannot oppose under Article 14(1)(c) of Directive 2015/2436.
- 47 It follows that the scope of Article 6(1)(c) of Directive 2008/95 is more limited than that of Article 14(1)(c) of Directive 2015/2436, in that Article 6(1)(c) covers only the use, in the course of trade, of the trade mark where that is necessary to indicate the intended purpose of a product or service.
- 48 That interpretation of Article 6(1)(c) of Directive 2008/95 is supported both by the objectives pursued by that directive, in particular the objective of that provision as defined by the case-law, and by the analysis of the legislative history of the provision which replaced it, namely Article 14(1)(c) of Directive 2015/2436.
- 49 In the first place, it is apparent from the case-law of the Court that, by limiting the effects of the rights derived from Article 5 of Directive 2008/95 by the proprietor of a trade mark, Article 6 of that directive seeks to reconcile the fundamental interests of trade-mark protection with those of free movement of goods and freedom to provide services in the internal market in such a way that trade mark rights are able to fulfil their essential role in the system of undistorted competition which the Treaty seeks to establish and maintain (see, to that effect, judgment of 17 March 2005, *Gillette Company and Gillette Group Finland*, C-228/03, EU:C:2005:177, paragraph 29).
- 50 As regards, more specifically, Article 6(1)(c) of Directive 2008/95, the Court stated that the application of that provision is not limited to situations in which it is necessary to use a trade mark to indicate the intended purpose of a product ‘as accessories or spare parts’ (see, to that effect, judgment of 17 March 2005, *Gillette Company and Gillette Group Finland*, C-228/03,

EU:C:2005:177, paragraph 32). The situations coming within the scope of Article 6(1)(c) must, however, be limited to those which correspond to the objective of that provision (judgment of 8 July 2010, *Portakabin*, C-558/08, EU:C:2010:416, paragraph 64).

- 51 In that regard, the Court has stated that the objective pursued by Article 6(1)(c) of Directive 2008/95 is to enable providers of goods or services that are supplementary to the goods or services offered by a trade mark proprietor to use that mark in order to provide the public with comprehensible and full information on the intended purpose of the product which they market or the service which they offer or, in other words, as to the practical link between their goods or services and those of the proprietor of the mark (see, to that effect, judgments of 17 March 2005, *Gillette Company and Gillette Group Finland*, C-228/03, EU:C:2005:177, paragraphs 33 and 34, and of 8 July 2010, *Portakabin*, C-558/08, EU:C:2010:416, paragraph 64).
- 52 It follows that, in accordance with the case-law, the scope of Article 6(1)(c) of Directive 2008/95 refers to the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark only where that use is limited to the situation in which it is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party. In the context of Article 14(1)(c) of Directive 2436, such a situation corresponds only to one of the situations in which the use of the mark may not be prohibited by its proprietor.
- 53 In the second place, given that, by its question, the referring court seeks guidance on the scope of Article 6(1)(c) of Directive 2008/95 in the light of the normative content of the provision which replaced it, the legislative history of the latter provision may reveal elements that are relevant to the interpretation of Article 6(1)(c).
- 54 In that regard, it is apparent from the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final) that it was ‘considered appropriate to provide ... for an explicit limitation covering referential use in general’. Thus, as the Advocate General observed, in essence, in point 78 of his Opinion, the term ‘appropriate to provide ... for’ indicated the Commission’s intention to propose the introduction of a limitation of the effects of a trade mark covering referential use in general and to extend the scope of the limitation now provided for in Article 14(1)(c) of Directive 2015/2436, and not to propose merely to clarify or specify the parameters of Article 6(1)(c) of First Directive 89/104.
- 55 Furthermore, as the Advocate General also observed in point 79 of his Opinion, the Commission’s intention to extend the scope of the limitation previously contained in Article 6(1)(c) of Directive 2008/95 is apparent from the wording of recital 25 of the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (COM(2013) 162 final), which stated that ‘the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor’.
- 56 Consequently, the legislative history of Article 14(1)(c) of Directive 2015/2436 supports the interpretation that the scope of Article 6(1)(c) of Directive 2008/95 is more limited than that of Article 14(1)(c).

- 57 In the present case, it is for the national court, *inter alia*, to determine, taking into account all the circumstances of the case in the main proceedings, whether Buongiorno, by its advertising campaign launched for a subscription to one of its services, making it possible to participate in a prize draw, in which one of the prizes was a ‘ZARA gift card’, with the subscriber being shown on the screen the ‘ZARA’ sign in a rectangle, reminiscent of the design of gift cards, uses the ZARA trade mark within the meaning of Article 5 of Directive 2008/95, and, if that is the case, to assess, in the light of Article 6(1) of that directive, whether that use was necessary to indicate the intended purpose of a service which Buongiorno offered and, as appropriate, whether that use was made in accordance with honest practices in industrial or commercial matters.
- 58 In the light of all the foregoing considerations, the answer to the question referred is that Article 6(1)(c) of Directive 2008/95 must be interpreted as meaning that it covers use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark only when such use of the trade mark is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.

Costs

- 59 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:

Article 6(1)(c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks

must be interpreted as meaning that it covers use of the trade mark in the course of trade by a third party for the purpose of identifying or referring to, in accordance with honest practices in industrial or commercial matters, goods or services as those of the proprietor of that trade mark only when such use of the trade mark is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party.

[Signatures]