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Are wheel rims accessories or spare parts?

In *Acacia v Daimler* the Court of Rome has confirmed that wheel rims are spare parts rather than accessories, but adds that the repair clause is not always applicable to this type of case.

The repair clause

Articles 241 of the Italian Industrial Property Code and 110 of the Community Designs Regulation (6/2002) state the following:

the 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.

This is the repair clause, which:

- avoids the creation of a captive market and helps a consumer who has purchased a long-lasting and often expensive product, such as a vehicle, from being indefinitely bound to the manufacturer for the purchase of spare parts for that product; and
- solves the issue of balancing:
 - ✓ the protection of research and innovation through the recognition of exclusive rights; and
 - ✓ the need to preserve the competitive nature of the spare parts market.

However, in several cases, Italian courts have excluded the wheel rims of a vehicle from the repair clause. This is based on the argument that they are not spare parts but rather accessories, or "components suitable for modifying the original appearance of the product with an autonomous aesthetic contribution".

In 2017 the European Court of Justice (ECJ) definitively stated that the repair clause applies to wheel rims, even if their design is not necessarily predetermined by the appearance of the vehicle. Pursuant to this decision, the repair clause should be applied when the replacement and the original components share the same appearance.

Acacia v Daimler

Acacia Srl is an independent manufacturer, which produces and markets wheel rims that are replicas of those fitted as standard or offered as an option on Mercedes cars.

Daimler AG is the manufacturer of Mercedes cars and claimed that Acacia was infringing its registered designs on its wheel rims.

Acacia asked the court to declare that there was no infringement, and that Daimler was guilty of unfair competition and abuse of a dominant position, invoking Articles 110 (6/2002) of the Council Regulation and 241 of the Industrial Property Code to support the lawfulness of its activity.

Acacia also argued that its business was lawful under the repair clause, since its wheel rims were marketed as non-original spare parts and intended exclusively for repair purposes.

Daimler claimed that Acacia's wheel rims were objectively unrelated to the repair clause and that its activity was outside the scope of the clause, since its wheel rims are accessories and not spare parts. In any case, Daimler argued, Acacia's wheel rims do not conform to the original overall appearance of the complex product vehicle.

In addition, Daimler claimed that the wheels rims produced by Acacia correspond to its registered designs, except for their size and/or colour. Since they do not restore the original appearance of a vehicle, they should not be included in the repair clause.

Technical expertise and decision

The court asked a technical expert to compare the original Daimler wheels to those produced by Acacia. The expert concluded that a substantial part of the Acacia wheel rims was not identical in colour and size to the Daimler wheel rims.

On 20 December 2018 the Court of Rome, following ECJ case law, held that:

- the repair clause applies to wheel rims, even if their design is not necessarily predetermined by the appearance of the vehicle;
- the application of the repair clause further requires that there is an identical correspondence between the wheel rims of the independent producer and the original products; and
- the alteration of the colour or the size (diameter) does not by itself exclude the interference between Acacia's products and Daimler's registered designs. What counts is the overall impression of an informed consumer. The variation of sizes does not determine a change in proportions, and a different colour leaves the overall impression determined by the shape only.

The court thus distinguished between two categories of Acacia wheel rims, those different in colour and size from Daimler's registered designs, and those identical in colour and size. Thus, in the first case, the repair clause is not applicable and Acacia infringed Daimler's rights. In the second, the repair clause does apply and there was no infringement.

Comment

The Court of Rome decision confirms that the repair clause applies to wheel rims even if their design is not necessarily predetermined by the appearance of the vehicle, but only if there is an identical correspondence between the replica and the original product.

In the decision, different colors and sizes of wheel rims, although having the same shape, were considered by the court as sufficient to exclude them from the repair clause, based on the 'overall impression' approach.

However, the Court of Rome, following the ECJ, reversed the previous Italian case law and confirmed that wheel rims must no longer be considered as accessories but rather as spare parts of a vehicle.

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