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Trading Repaired and Refurbished Goods: How Sustainable is EU Exhaustion of Trade Marks?

Analysing EU, Benelux and German case law, this article examines whether the exhaustion doctrine in trade mark law contributes to a more sustainable economy. It considers that ecological motives seem not to have played a role either in the policy choice against international exhaustion, or in the Court of Justice of the European Union (CJEU) case law on legitimate reasons and the repackaging of medication.

Although exhaustion could, theoretically, incentivise traders to give new life to goods that were legitimately marketed before, the analysis shows that this is a risky business because of the thin and blurry line between lawful renewal activities and creating a false impression of affiliation. As such, it is unclear to what extent de-branding, re-branding, and co-branding can prevent liability for infringement, although co-branding renewed products is probably often the only way to do so. As an alternative to buy–renew–resell, traders could consider providing renewal services. On closer analysis, however, offering services puts them in an even less favourable position, and this seems hard to justify.

In addition to trade mark rights, copyright and/or design rights will often cumulatively apply to mark-bearing products. Although the latter rights are also subject to a principle of exhaustion, the effects of exhaustion can de facto be overruled by the exception for legitimate reasons proper to trade mark law. Moreover, it is argued that repair exceptions in copyright and design legislation have limited effect and that announced legislative reforms are unlikely to change that.

The unattractiveness of renewal businesses is further aggravated by the recurrent use of open norms and references to common practices. It is concluded that IP laws often leave it to the discretion of rightholders whether to offer sustainable post-sale solutions. Besides having clearer guidance on what is allowed, this paper suggests that exhaustion case law should take sustainability arguments into account, for instance by considering what would happen to goods if they were not renewed by the trader. To a large extent, the judiciary already has tools at its disposal to incorporate these kinds of elements.

Introduction

Trade mark law and policy have great potential to contribute to a more sustainable economy fostering product circularity and thriving markets for independent repair. Whereas consumer contract law remedies inevitably require users to turn to their one co-contracting supplier to get their products repaired, more sustainability-centred intellectual property (IP) laws could indeed overcome that deterrent by allowing users and third parties to repair, refurbish or otherwise ‘renew’ used tangible products.¹ Against this backdrop, this piece analyses whether trade mark law of the European Union (EU) lives up to its potential, notably by virtue of the doctrine of exhaustion of trade mark rights.

Following a summary of that doctrine and a brief analysis of the sustainability of its geographical component and the CJEU’s case law on the exception for legitimate reasons

in general (I), it is assessed to what extent that exception fosters or hampers undertakings that engage in the renewal of mark-bearing products (II). Next, the article focusses on the interaction of trade mark exhaustion with copyright and design law (III) before shifting attention to expected policy initiatives (IV). Finally, it is concluded that, at present, the exhaustion doctrine has not explicitly incorporated sustainability arguments, but that it leaves room to do so (V). Where EU case law is unavailable, reference is made to Germany and the Benelux as trade mark jurisdictions that cover a relatively large share of the EU.

I. Exhaustion principle in trade mark law

Pursuant to EU law, a national or EU trade mark does not entitle its holder to prohibit its use in relation to tangible goods which have been put on the market in the European Economic Area (EEA) under that trade mark by that rightholder or with their consent.² Justified by the

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¹ cf Evelyn Terry, ‘A Right to Repair? Towards Sustainable Remedies in Consumer Law’ [2019] ERPL 851, 864–867; Elias Van Gool, ‘De nieuwe Richtlijn Consumentenkoop en duurzame consumptie’ in Evelyn Terry and Ignace Claeys (eds), *Nieuw recht inzake koop & digitale inhoud en diensten* (Intersentia 2020) para 86.

² Regulation (EP & Council) (EU) 2017/1001 on the European Union trade mark (codification) (EUTMR) [2017] OJ L154/1, art 15(1); Directive (EP & Council) (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks (recast) (TMD) [2015] OJ L336/1, art 15(1).

need to ‘liberate’ products from the yoke of IP rights and to facilitate their free circulation on the market as soon as the rightholder was able to reap an appropriate remuneration,³ this doctrine was first established by the Court of Justice of the European Union (CJEU) in relation to the free movement of IP-protected goods on the internal market⁴ and later codified.

After trade mark rights in an item are exhausted, owners are not only free to resell or otherwise redistribute that item without the rightholder’s consent. Provided that they do not create a false impression of economic affiliation with that rightholder, they can also use the mark to indicate their intention to further market the item,⁵ for example by displaying the mark in offline or online marketing⁶ or by referring to one’s independent repair services.⁷ Cutting the wire between rightholders and tangible embodiments of their subject-matter, exhaustion could thus allow third parties to offer lawful maintenance, repair and other derivative services beyond what rightholders would do. Hence, although it was not conceived with circularity in mind, the exhaustion doctrine could foster commercial and sustainability interests of society alike, at least in theory.

1. Geographic scope of exhaustion

Exhaustion arises when three criteria are cumulatively met: there was first marketing of a product that incorporated IP-protected subject matter; this first marketing took place by the rightholder or with the rightholder’s consent; and the marketing took place in a given geographical territory. With respect to that geographical aspect, the CJEU’s case law on exhaustion used to be built upon cases with cross-border aspects. Before the advent of IP harmonisation through EU legislation a rightholder would typically oppose the owner of imported goods that incorporated protected subject-matter. The Court would then be asked preliminarily to assess whether exhaustion had arisen in the case at hand. This allowed it to explain that, although Member State law cannot subject exhaustion to first marketing within its own territory (i.e. the aspect often still referred to as mandatory ‘Community’ exhaustion),⁸ States were (and, for patents, still are) free to determine whether goods first marketed *outside* the EEA give rise to exhaustion, in other words whether parallel trade of authentic goods first marketed outside the EEA was to be considered legal or illegal without the consent of their rightholders.

Prior to the harmonisation of trade mark law, some Member States considered that exhaustion also applied

to authentic products that were first marketed outside of the EEA by or with the consent of the rightholder, and then imported and resold on EEA territory. Later, the EU legislator purposely abolished this freedom for Member States to install or maintain rules of ‘international’ exhaustion as a policy choice in both trade mark law and copyright law.⁹ As a result, trade mark law in the EU does not distinguish between a person who fabricates counterfeit products and illegally affixes trade mark signs to them and a person who purchases authentic mark-bearing products marketed in a third country and then resells them on EEA territory. Both are considered infringers.¹⁰

From this policy choice against international exhaustion, it follows, first, that third parties cannot legitimately import authentic trade-marked goods from outside of the EEA with the aim of reselling them or using them in the course of trade without the trade mark owner’s consent.¹¹ It is difficult to say what this means from a sustainability perspective. On the one hand, a ban on parallel imports by third parties may lead to fewer kilometres of transportation of goods. As it leads to fewer sporadic and unexpected supplies of authentic products and thus to less need for EEA trade mark holders to compete with their own products, it could also lead to less unsold stock. Moreover, another potential effect is that products that are priced differently in different regions across the world – such as medication or products for water treatment, – might not be bought up in developing states in order to export them in bulk to the EEA to sell them there at a higher price. Hence, these products would remain available in those developing states, which might contribute to the sustainable development goals.¹² On the other hand, a ban on parallel imports might result in more market control for large-sized right owners, allowing them to enforce non-sustainable corporate policy choices, like a refusal to produce spare parts for their products combined with the refusal to allow importation of spare parts into the EEA. In short, it is impossible to reach an overall conclusion as to whether international exhaustion fosters or hampers sustainability, due to the unknown number of factors to be considered.¹³

Second, the abolition of international exhaustion also means that a trade mark holder is entitled to take

³ See Simon Geiregat, *Supplying and Reselling Digital Content: Digital Exhaustion in EU Copyright and Neighbouring Rights Law* (Edward Elgar 2022) 1–3.

⁴ *ibid* 3–6; see, among other, Case 40–70 *Sirena v Eda* ECLI:EU:C:1971:18.

⁵ See EUTMR and TMD, arts 14(1)(c) and 14(2).

⁶ Case C-337/95 *Dior v Evora* ECLI:EU:C:1997:517, para 38; Case C-63/97 *BMW* ECLI:EU:C:1999:82, para 48; Case C-558/08 *Portakabin* ECLI:EU:C:2010:416, paras 77–78.

⁷ *BMW* (n 6).

⁸ Case 78–70 *Deutsche Grammophon* ECLI:EU:C:1971:18; Case 15–74 *Centrafarm* ECLI:EU:C:1974:114; Case 119–75 *Terrapin* ECLI:EU:C:1976:94; Joined Cases 55/80 and 57/80 *Musik-Vertrieb Membran* ECLI:EU:C:1981:10.

⁹ Case C-355/96 *Silhouette* ECLI:EU:C:1998:374; Case C-479/04 *Laserdisken* ECLI:EU:C:2006:549.

¹⁰ EUTMR, art 9(2)(a); TMD, art 10(2)(a).

¹¹ Case C-173/98 *Sebago and Maison Dubois* ECLI:EU:C:1999:347, para 13; Joined Cases C-414/99 and C-416/99 *Zino Davidoff and Levi Strauss* ECLI:EU:C:2001:617, para 33; Case C-244/00 *Van Doren + Q* ECLI:EU:C:2003:204, para 25; cf EFTA Court, Joined Cases E-9/07 and E-10/07 *L’Oréal Norge v Aarskog Per* of 8 July 2008.

¹² See, eg STD1 (‘no poverty’), STD3 (‘good health and well-being’), STD6 (‘clean water and sanitation’) as adopted by UN General Assembly, resolution ‘Transforming our world: the 2030 Agenda for Sustainable Development’, 25 September 2015, A/RES/70/1.

¹³ Similarly, see Josef Drexler, ‘EU competition law and parallel trade in pharmaceuticals: lessons to be learned for WTO/TRIPS?’ in Jan Rosén (ed), *Intellectual Property at the Crossroads of Trade* (Edward Elgar 2012) 6–7; Simon Geiregat, *Analoge distributie en uitputting* (Intersentia 2020) paras 450–454; Jane Ginsburg, dissenting opinion to US Supreme Court judgment in *Kirtsaeng v John Wiley & Sons, Inc.* (2013) 133 S.Ct. 1351, 35 ITRD 1049, 185 L.Ed.2d 392, 81 USLW 4167, 2013 Copr.L.Dec. P 30,396, 106 U.S.P.Q.2d 1001, 41 Media L. Rep. 1441, 13 Cal. Daily Op. Serv. 2983, 24 Fla. L. Weekly Fed. S 87, 75 A.L.R. Fed. 2d 767 (m.n. 133 S.Ct. (1351) 1384), at para IV; Ariel Katz, ‘The economic rationale for exhaustion: distribution and post-sale restraints’ in

recourse to the same set of corrective enforcement mechanisms regardless of whether a product is a case of either blunt counterfeit or of parallel import of goods produced by the rightholder itself. In combination with Art. 10(1) Enforcement Directive¹⁴ and the Customs Enforcement Regulation,¹⁵ this in turn implies that a trade mark holder is entitled, at least in theory and as a matter of principle, to demand the definitive removal and physical destruction¹⁶ of authentic and potentially flawless products.¹⁷ In 2022, the CJEU explicitly confirmed this in a preliminary judgment on unconsented imports of Hugo Boss perfume testers.¹⁸ However, it added that it is for the seized judicial authorities to ‘take account of the fact that the seriousness of the infringement and the remedies ordered must be proportionate, and of the interests of third parties’ and to decide on a case-by-case basis.¹⁹ Not having been asked to judge on motives of sustainable development, the Court does not explicitly refer to ecological interests. Nonetheless, by affirming the need to assess proportionality and take account of third-party interest, EU case law does leave the door open for national courts to incorporate the potential impact of corrective measures in their judgments.

2. Exception for legitimate reasons

Given the essential function of trade marks to protect commercial origin,²⁰ the principle of exhaustion is subject to an important exception: even if they were exhausted, trade mark rights in goods revive when rightholders can prove that there are *legitimate reasons* to oppose further commercialisation of those goods. Given the open wording of this exception, courts enjoy considerable discretion. Pursuant to the

CJEU, they should apply a case-by-case approach and take into account all circumstances.²¹ In legislation, only one example is non-exhaustively²² cited: despite exhaustion, rightholders can notably take action when the condition of the goods (or their packaging²³) is impaired or otherwise changed after they have been put on the market.²⁴

The CJEU has rendered an impressive amount of case law about the particular instances of exhaustion and the repackaging of medication. Important aspects of the market of pharmaceutical products have not been subject to European harmonisation.²⁵ As a result, trade customs and price setting often differ enormously from one EU Member State to another, making the parallel importation of medication between Member States a lucrative business. The mere reselling of legitimately marketed trade-mark-bearing pharmaceuticals in another Member State is permitted pursuant to the principle of exhaustion. However, in the pharmaceutical sector legal requirements and market considerations could force or incentivise importers to alter the product or its packaging, e.g. to add a required accessory or a leaflet in all national languages of the import state or because the product is known by a different name in that state. Hence, questions arose as to whether and to what extent these alterations amount to *legitimate reasons* allowing trade mark owners to oppose redistribution despite exhaustion. Against this background, the CJEU repeatedly had to strike a balance between the interests of trade mark owners, the interests of the importers and the EU’s primary-law aim to establish an internal market featuring free movement of goods by avoiding partitioning in national markets.²⁶

Based on considerations of primary EU law, the CJEU has established that a trade mark holder cannot successfully prove the presence of *legitimate reasons* in instances of modification which involves any repackaging of a pharmaceutical product bearing its mark unless five cumulative conditions are met.²⁷ First and most importantly, it should be established that the trade mark owner’s right to oppose the marketing of the repackaged products under its trade mark would contribute to the artificial

Irene Calboli and Edward Lee (eds), *Research Handbook on Intellectual Property Exhaustion and Parallel Imports* (Edward Elgar 2016) 32–34; Keith E Maskus, ‘Economic perspectives on exhaustion and parallel imports’ in Irene Calboli and Edward Lee (eds), *Research Handbook on Intellectual Property Exhaustion and Parallel Imports* (Edward Elgar 2016) 109, 115–18 and 122–24; WIPO, ‘Committee of Experts on a Possible Protocol to the Berne Convention for the Protection of Literary and Artistic Works. Third Session (Geneva, June 21 to 25, 1993). Memorandum prepared by the International Bureau’ Copyright (WIPO Monthly Review) 1993, (84) 89, No 40; WIPO, ‘Committee of Experts on a Possible Instrument on the Protection of the Rights of Performers and Producers of Phonograms. First Session (Geneva, June 28 to July 2, 1993). Report adopted by the Committee’ Copyright (WIPO Monthly Review) 1993, (196) 218, No 99.

¹⁴ Directive (EP & Council) 2004/48/EC on the enforcement of intellectual property rights (Enforcement Directive) [2004] OJ L157/45.

¹⁵ Regulation (EP & Council) (EU) 608/2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (Customs Enforcement Regulation) [2013] OJ L181/15, arts 23–26.

¹⁶ See Enforcement Directive (n 14) art 10(1)(b) and (c).

¹⁷ Dirk JG Visser and Simon Dack, ‘Kroniek van de intellectuele eigendom’ [2023] Nederlands Juristenblad 1216, 1219; Charlotte JS Vrendenburg, ‘Duurzamer vorderen en veroordelen in IE-zaken’ [2022] IER 275, 276–277; Charlotte JS Vrendenburg, ‘Towards a Judicial Sustainability Test in Cases Concerning the Enforcement of Intellectual Property Rights’ [2023] GRUR International 1126.

¹⁸ Case C-355/21 *Perfumesco.pl* ECLI:EU:C:2022:791, paras 40–41 and 54–55.

¹⁹ *ibid* para 41; cf Enforcement Directive (n 14) art 10(3).

²⁰ EUTMR, recital 11; TMD, recital 16; priorly, see Case 102/77 *Hoffmann-La Roche* ECLI:EU:C:1978:108, para 7.

²¹ Case C-46/10 *Viking Gas* ECLI:EU:C:2011:485, para 38.

²² Case C-427/93 *BMS* ECLI:EU:C:1996:282, para 39; *Dior v Evora* (n 6) para 42; Case C-59/08 *Copad* ECLI:EU:C:2009:260, para 54.

²³ See Federal Supreme Court (*Bundesgerichtshof*), judgment of 5 October 2000, I ZR 1/98, [2001] GRUR 448, at 450; Commercial Court of Liège, judgment of 4 February 2005 [2005] *Revue de droit intellectuel - l’ingénieur conseil* 217.

²⁴ EUTMR and TMD, art 15(2); priorly, see *Hoffmann-La Roche* (n 20) paras 8 and 14.

²⁵ Case 16-74 *Winthrop* ECLI:EU:C:1974:115, paras 16–18; *BMS* (n 22) para 46; see, eg, Directive (EP & Council) 2001/83/EC on the Community code relating to medicinal products for human use [2011] OJ L311/67 (as amended) (Community Code on Medicinal Products), art 57.

²⁶ cf Case C-147/20 *Novartis Pharma* ECLI:EU:C:2022:891, para 46; Case C-204/20 *Bayer Intellectual Property* ECLI:EU:C:2022:892, para 57; Case C-224/20 *Merck Sharp & Dohme* ECLI:EU:C:2022:893, para 49; Joined Cases C-253/20 and C-254/20 *Impexco* ECLI:EU:C:2022:894, para 50.

²⁷ *BMS* (n 22) operative part; Case C-348/04 *Boehringer Ingelheim* ECLI:EU:C:2007:249, operative part; *Novartis Pharma* (n 26) para 50; Case C-642/16 *Junek Europ-Vertrieb* ECLI:EU:C:2018:322, paras 15 and 28; *Bayer Intellectual Property* (n 26) para 61; *Merck Sharp & Dohme* (n 26) para 52; *Impexco* (n 26) para 53.

partitioning of the market between Member States.²⁸ In other words, there has to be an ‘objective need’ to alter or change the packaging, to relabel, to add accessories and so on, in the sense that it would be impossible for parallel importers to enter the market without an intervention of this kind.

A prime example of such an objective need is national legislation setting requirements for packaging and/or leaflets. Mere commercial reasons or strategic choices of the importer do not suffice.²⁹ However, the CJEU does accept that importers can remove the original packaging and repackage the product in new packaging that bears *another* trade mark owned by the manufacturer, if a parallel importer can prove that consumers in the import state only know that manufacturer’s product by that other mark in that state.³⁰ Nonetheless, this entitlement does not go as far as allowing importers to repackage pharmaceuticals bearing a manufacturer’s trade mark for *generic* medicinal products into a packaging with one of the trade marks that the manufacturer uses for its reference medicinal products, unless when both medicinal products are truly identical, an objective need is proven, and the other criteria for repackaging are fulfilled.³¹

Besides necessity (‘objective need’), repackaging importers secondly need to show that the repackaging does not affect the original condition of the product contained in it. For instance, the blister pack should not be removed from tablets. Third, the new packaging should clearly state the identities of whoever repackaged the product and of the manufacturer. Fourth, the presentation of the product should not be such as to be liable to damage the reputation of the trade mark or its owner. This means that the packaging should not be defective, untidy, or of poor quality. It also means that the product should not be marketed in a form that detracts from the image of reliability and quality attached to such a product and the confidence that it is capable of inspiring in the public concerned, which is for the national courts to assess.³² And last, the importer is to give notice to the trade mark holder before offering the repackaged product for sale and should supply them with a specimen on demand. If all five criteria are met, the CJEU accepts that the importer is conferred with certain rights which in normal circumstances are reserved for the trade mark proprietor itself.³³ By contrast, failure to meet at least one of these criteria implies that the parallel importer can be held liable for trade mark infringement, despite the advent of exhaustion.³⁴ In later case law, the CJEU considered that

these criteria are not limited to the parallel importation of pharmaceutical products. They can also be applied to other products where packaging plays an important role in the bond between the manufacturer and its consumers and where there is a risk of partitioning of markets, like luxury perfumes and medical devices.³⁵

On 17 November 2022 the CJEU provided further guidance on exhaustion and repackaging in four partly interrelated judgments.³⁶ In three of them the Court addressed, among other things, the extent to which the precondition of an ‘objective need’ codetermines the choice between repackaging a pharmaceutical product by adding new labels to its original packaging (‘relabeling’) on the one hand, and by removing it from the original packaging and putting it in entirely new packaging (‘reboxing’) on the other.³⁷ Reboxing amounts to greater interference with a trade mark holder’s prerogatives than mere relabelling. Pursuant to the principles of proportionality and necessity, it follows that the rightholder is entitled to oppose the reboxing of its product if the circumstances dictate that relabelling would have been sufficient to guarantee the actual access to the market for the parallel importer.³⁸

As a matter of principle, importers need to content themselves with relabelling unless it does not suffice to overcome the risk of market fragmentation. However, because of reinforced EU measures adopted as part of the continued fight against falsified medicinal products, the outer packaging of such products is required to be equipped with security features. Those features include an anti-tampering device intended to determine whether a product had been altered between its packaging and its sale, something which pharmaceutical intermediaries are under an obligation to check and to report in case of breach. The Union-wide requirement to add anti-tampering devices increasingly turned reboxing into a more favourable option for importers. After removing and discarding the original packaging with its anti-tampering device, they put the product in different packaging with a new device that is ‘equally effective’ as required by the Community Code on Medicinal Products.³⁹ By contrast, relabelling implies that the original anti-tampering device would be destroyed and that a new and equally effective device would need to be added to the original packaging, inevitably leaving visual and/or tangible traces of the fact that the packaging had been opened.⁴⁰ Against this backdrop, the CJEU was asked to clarify to what extent these obligatory security measures have an impact on the choice for either reboxing or relabelling.

Confirming that it is genuinely possible to add ‘equally effective’ anti-tampering devices to original

²⁸ *Boehringer Ingelheim* (n 27) para 18; *Novartis Pharma* (n 26) para 47 and 48; *Merck Sharp & Dohme* (n 26) para 53; *Impexco* (n 26) para 51.

²⁹ *Boehringer Ingelheim* (n 27) para 37; *Novartis Pharma* (n 26) para 53; *Bayer Intellectual Property* (n 26) para 64; *Merck Sharp & Dohme* (n 26) para 55; *Impexco* (n 26) paras 55-56 and 73.

³⁰ Case C-379/97 *Pharmacia & Upjohn* ECLI:EU:C:1999:494, para 46.

³¹ *Impexco* (n 26) paras 66 and 74.

³² *Boehringer Ingelheim* (n 27) paras 40, 43 and 46; *Merck Sharp & Dohme* (n 26) paras 122-25.

³³ *Novartis Pharma* (n 26) para 49; *Merck Sharp & Dohme* (n 26) para 51.

³⁴ *BMS* (n 22) operative part; *Boehringer Ingelheim* (n 27) operative part; *Junek Europ-Vertrieb* (n 27) paras 15 and 28; *Impexco* (n 26) para 52.

³⁵ See Case C-324/09 *L’Oréal v eBay* ECLI:EU:C:2011:474, paras 74-83; *Junek Europ-Vertrieb* (n 27) para 30.

³⁶ *Novartis Pharma* (n 26); *Bayer Intellectual Property* (n 26); *Merck Sharp & Dohme* (n 26); *Impexco* (n 26).

³⁷ *Novartis Pharma* (n 26) para 54; *Bayer Intellectual Property* (n 26) para 65; *Merck Sharp & Dohme* (n 26) para 56.

³⁸ *Novartis Pharma* (n 26) para 55; *Bayer Intellectual Property* (n 26) paras 66 and 68; *Merck Sharp & Dohme* (n 26) para 57.

³⁹ Community Code on Medicinal Products, art 47a(1)(b).

⁴⁰ *Bayer Intellectual Property* (n 26) para 77; *Merck Sharp & Dohme* (n 26) paras 68-70.

packaging that was opened,⁴¹ the CJEU found that the mere fact that noticeable traces of opening remain on the relabelled packages does not, in itself, suffice to justify reboxing over relabelling. If properly done, then relabelling will leave no doubt about the origin of those traces, at least from the perspective of professional resellers of pharmaceuticals. Indeed, professionals will reasonably expect that these traces were not caused by unlawful tampering but by a parallel importer who added a new anti-tampering device, in particular because its identity, the fact of repackaging and the origin of the product have to be mentioned.⁴² Seeing no reasons to deviate from its established case law on proportionality and necessity, the Court thus considered that a parallel importer will still need to prove that relabelling would be insufficient in the given circumstances.

In practice, an importer who wants to proceed to reboxing will need to prove that ‘on the market of the Member State of importation or on a substantial part of it’, there is ‘such strong resistance from a significant proportion of consumers to the medicinal products repackaged in that way [i.e., by mere relabelling] that it would constitute a barrier to effective access to that market’. The CJEU is strict in this regard. A parallel importer will need to provide concrete evidence supporting such ‘strong resistance’ on a case-by-case basis. Conversely, it ‘cannot rely on a general presumption of consumer resistance to relabelled medicinal products whose anti-tampering devices have been replaced’.⁴³ As has been noticed in the literature, it is yet to be seen what concrete evidence courts will require in practice.⁴⁴

Undoubtedly, repackaging medicinal products is not the most environmentally friendly practice: leaflets are replaced by other leaflets before they were ever seen by human eyes; ink-printed packaging is either covered with ink-printed stickers or discarded and replaced with other packaging. The CJEU has not yet had occasion to rule on sustainability arguments in this debate, nor did it raise sustainability arguments in its quadruple judgment of November 2022. However, by confirming that relabelling has preference over reboxing, that case law does seem to be aligned with ecological concerns. Disregarding the (important) economic pros and cons of parallel importation of pharmaceuticals between EEA Member States, the overall impact of the repackaging case law on the ecological environment is probably rather negative. Nonetheless, the preference for repackaging over ecological interests will often be proportional in light of another prime interest of primary law, namely the protection of public health – the rationale that ought to be at the core of all regulation on medication.⁴⁵ In relation to the 2022 judgments in particular, the statute-based requirement to have anti-tampering devices in place can certainly be justified against the aim of preventing the entry of falsified

medication in the legal supply chain.⁴⁶ However, as its case law on pharmaceuticals is gradually being applied to certain luxury products too, it is advisable that the environmental impact of repackaging should also be included in the discussion.

II. Renewed goods versus legitimate reasons

The mere fact of offering used goods does not in itself constitute legitimate reasons that allow rightholders to set aside the effects of exhaustion and successfully claim for trade mark infringement.⁴⁷ Indeed, it is an unavoidable fact that products just wear out as they are used and as time passes. Moreover, so the CJEU argues, consumers are accustomed to second-hand markets. The effective marketing of used authentic goods would therefore be impaired if rightholders could prohibit resellers from referring to the original mark.⁴⁸

To the CJEU’s finding that used mark-bearing goods can, as a matter of principle, be resold pursuant to the principle of exhaustion, established German and Benelux case law add that this conclusion remains unaltered when minor modifications are implemented to those goods (think of small repairs or a replacement with spare parts).⁴⁹ However, in a more sustainability-centred economy, independent traders may want to do more than just repair goods and replace components. Indeed, there is a growing interest in refurbishing or upcycling used goods, making them look or work ‘as good as new’, upgrade them by adding features, or use all or some of their components to make novel products.⁵⁰ And there traders enter a murkier area, where there is no strict set of EU-primary-law-based criteria established in CJEU case law to assess whether the remarketing amounts to legitimate reasons. Therefore, a case-by-case approach is unavoidable.⁵¹

Traders could use a trade-marked product as a resource to produce a different type of product as an extensive form of renewal. In German and Benelux trade mark law, these metamorphoses constitute instances that trade mark owners were previously thought able to prevent without any doubt.⁵² The CJEU has not had occasion to rule on this matter. However, in a judgment on the exhaustion of a sold poster that was transferred to a canvas with a chemical process, the Court did uphold that renewed consent of the copyright holder was required to distribute an object that had been altered after its initial marketing in such a way that it constituted a new reproduction of the work.⁵³ Similarly,

⁴⁶ Community Code on Medicinal Products, recital 29; cf *Merck Sharp & Dohme* (n 26) para 58.

⁴⁷ Thomas W Boddien in Reinhard Ingerl and others (eds), *Markengesetz* (4th edn, Beck 2023) MarkenG § 24. Erschöpfung, para 61 <beck-online.de>.

⁴⁸ *Portakabin* (n 6) paras 83-87.

⁴⁹ eg Federal Supreme Court, judgment of 28 October 1988, I ZR 5/86, [1988] GRUR 213; Benelux Court, judgment of 6 November 1992, A91/1 para 21 – *Valeo*.

⁵⁰ See also Nina Dorenbosch, ‘Upcycling - op het snijvlak van duurzaamheid en intellectuele eigendom’ [2022] IER 147, 147.

⁵¹ Anna Tischner and Katarzyna Stasiuk, ‘Spare Parts, Repairs, Trade Marks and Consumer Understanding’ (2023) 54 IIC 26, 27.

⁵² See the case law cited below, in n 61.

⁵³ Case C-419/13 *Allposters* ECLI:EU:C:2015:27, para 46.

⁴¹ *Bayer Intellectual Property* (n 26) paras 51-52.

⁴² *ibid* paras 75-76.

⁴³ *Novartis Pharma* (n 26) paras 58-74; *Bayer Intellectual Property* (n 26) paras 69-86; *Merck Sharp & Dohme* (n 26) paras 58-79; clarification added.

⁴⁴ Visser and Dack (n 17) 1219.

⁴⁵ See Community Code on Medicinal Products, recital 2.

trade mark holders will have strong arguments for action in cases where their products are remarketed as a different category of goods. Nonetheless, they would still have to prove that all the criteria of one of the grounds of infringement are met and this could raise difficulties for non-reputed marks in light of the principle of speciality.⁵⁴ This is particularly true for extreme cases, as when an old TV is turned into a terrarium, a car into a refrigerator or a shipment container into a pop-up café. In fact, it might be very difficult to prove any likelihood of confusion, dilution or free-riding in such cases.⁵⁵ More fundamentally, the question will then arise as to whether the trade mark is (still) used for its function as an indication of origin,⁵⁶ that is whether the prerequisite of ‘use as a mark’⁵⁷ is fulfilled.⁵⁸ As the CJEU established back in 2003, the use of a sign should indeed not be considered an infringement if the sign is mainly viewed as an embellishment, an ornament or basically as anything else other than an indication of commercial origin by the relevant section of the public.⁵⁹

As most traders’ interventions will probably stand midway between small repairs and a fundamental alteration, determining the threshold between minor modifications and actionable changes or impairments is key. Benelux case law is quite rightholder-friendly in this regard: unless removing a trade mark was impossible, and subject to a duty of diligence (see below), any more-than-minor changes to mark-bearing goods are sufficient to constitute legitimate reasons.⁶⁰ German case law seems to leave more leeway. To constitute a cause of action, the proper characteristics (*Eigenart*) of the product must have been altered, which means that there is a change in quality, integrity, purpose, functionality, or design, assessed from the point of view of the relevant public.⁶¹ In any event, it is irrelevant whether the changes are accompanied by a detriment to the mark’s reputation or fame because that would in itself constitute legitimate reasons.⁶²

In relation to refilled containers, CJEU, Benelux and German Supreme Court case law add that it is crucial to

determine whether average consumers consider a given container as a self-standing product with autonomous economic value and whether they thus perceive trade marks on such a container either as an indication of origin of the container itself (e.g. trade marks for cardboard boxes or jerrycans), or also as an indication of the contents within it. In the former instance, exhaustion applies to the container and refills are allowed, subject to a duty not to create a false impression of economic affiliation (see below). In the latter instance, selling refilled containers under the original trade mark would no longer be covered by exhaustion. In this assessment, trade customs⁶³ and the product type⁶⁴ seem to play dominant roles. In October 2022 the CJEU considered that, in relation to gas cylinders for liquefied gas, it is particularly important to determine whether or not a container is perceived as being ‘intended to be reused and refilled numerous times, according to the logic of recycling’.⁶⁵

Traders who intend to (re)use trade-mark-bearing goods are advised to proceed with caution. As the analysis shows, they can only act lawfully insofar as they do not compromise the function of the mark as an indication of origin. Indeed, pursuant to established CJEU case law, legitimate reasons are present when the average consumer has the false impression of an economic affiliation between the reseller and the trade mark holder. That impression requires an assessment of the facts, whereby the main question is whether resellers have put sufficient effort into ensuring that consumers can distinguish their goods from those of the rightholder.⁶⁶

1. De-branding and re-branding

To eliminate liability risks, traders of renewed goods should, first and foremost, remove all protected signs from the goods. They may or may not accompany that intervention by affixing their own sign to indicate commercial origin. Until recently, it was undisputed that de-branding and re-branding indeed rendered any trade mark claim pointless. By lack of a similar or identical sign used in the course of trade, rightholders would have no grounds for infringement.⁶⁷ That is true, at least, insofar as a reseller would not additionally continue using the omitted trade mark otherwise, for instance as a part of its advertisement strategy.⁶⁸ However, this neutralising effect of de-branding is no longer uncontested since the 2018 *Mitsubishi* judgment, where the CJEU ruled that rightholders are entitled to oppose a third party removing all

⁵⁴ Similarly, in relation to spare parts, see Tischner and Stasiuk (n 51) 33–38.

⁵⁵ cf Annette Kur, “As Good as New” – Sale of Repaired or Refurbished Goods: Commendable Practice or Trade Mark Infringement? [2021] GRUR International 228, 231–32.

⁵⁶ Similarly, see Simon Geiregat, ‘Trade Marks in Sounds and Gestures: A Critical Analysis of Two Non-Traditional Signs in the EU’ [2022] GRUR International 702, 714.

⁵⁷ See EUTMR, art 9(2) and TMD, art 10(2) and recital 18; *BMW* (n 6) para 38; Case C-17/06 *Céline* ECLI:EU:2007:497, paras 20–24; cf Case C-245/02 *Anheuser-Busch* ECLI:EU:C:2004:717, paras 59–60.

⁵⁸ In relation to spare parts, see Case C-334/22 *Audi AG v GQ* ECLI:EU:C:2023:700, Opinion of AG Medina, paras 38–40; cf Case C-48/05 *Adam Opel* ECLI:EU:C:2007:55, paras 24–25.

⁵⁹ Case C-408/01 *Adidas v Fitnessworld Trading*, ECLI:EU:C:2003:582, paras 39–41.

⁶⁰ *Valeo* (n 49); Court of Appeals of Antwerp, judgment of 17 March 1997, [1997] IRDI 205; Court of Appeals of Antwerp, judgment of 26 February 2015, [2015] Berichten Industriële Eigendom 151.

⁶¹ Federal Supreme Court, judgment of 30 October 1981, I ZR 7/80, [1982] GRUR 115; Federal Supreme Court, judgment of 28 October 1988, I ZR 5/86, [1988] GRUR 213; Federal Supreme Court, judgment of 26 April 1990, I ZR 198/88, [1990] GRUR 678; Federal Supreme Court, judgment of 14 December 1995, I ZR 210/93, [1996] GRUR 271; Federal Supreme Court, judgment of 9 June 2004, I ZR 13/02, [2005] GRUR 160; Federal Supreme Court, judgment of 6 October 2011, I ZR 6/10, [2012] GRUR 392.

⁶² *Dior v Evora* (n 6) paras 43 and 46; *BMW* (n 6) para 49; Case C-228/03 *Gillette* ECLI:EU:C:2005:177, para 44; cf *Copad* (n 22) para 57; *Portakabin* (n 6) para 79.

⁶³ *Viking Gas* (n 21) para 40; Case C-197/21 *SodaStream* ECLI:EU:C:2022:834, para 48; Benelux Court, judgment of 20 December 1993, A92/1 – *Shell*; Federal Supreme Court, judgment of 10 February 1987, KZR 43/85, [1987] GRUR 438; Federal Supreme Court, judgment of 17 October 2018, I ZR 136/17, [2019] GRUR 79; Supreme Court of the Netherlands, Case 16/5057 *Primagaz* NL:HR:2018:10.

⁶⁴ cf Federal Supreme Court, judgment of 17 October 2018, I ZR 136/17, [2019] GRUR 79, where the Court stresses that it is relevant whether consumers do the refilling themselves or not (para 34).

⁶⁵ *SodaStream* (n 63) para 49.

⁶⁶ *BMW* (n 6) paras 51, 55 and 61; *Gillette* (n 62) paras 42, 46 and 49; *Portakabin* (n 6) para 80; *Viking Gas* (n 21) para 34; *SodaStream* (n 63) para 46.

⁶⁷ *Valeo* (n 49) para 24.

⁶⁸ *Portakabin* (n 6) para 86.

the signs identical to their mark and affixing other signs on the products placed in the customs warehouse ‘such as in the proceedings at hand’, with a view to importing them or trading them in the EEA where they have never yet been marketed.⁶⁹ If these findings were to be given general application, they would run against the very fundamental condition that IP right holders can only prevent acts prescribed by the lawmaker that involve embodiments of the subject-matter of their right.⁷⁰ Although it is therefore advisable not to apply the CJEU’s findings to instances beyond the specific constellation of the case, the fact remains that it is currently unclear to what extent de-branding and re-branding are still the archetypical means to avoid liability for trade mark infringement.⁷¹

The uncertainty about de-branding aside, there are other reasons that may prompt traders not to remove the original marks from goods. Here, established Benelux case law considers it insufficient that leaving the mark was interesting from a commercial perspective. Beyond minor modifications, traders are notably only entitled to resell revised or reconditioned goods if they did everything possible to warn the public about the revision/reconditioning, and provided that they can prove that the removal was either technically or practically impossible or unreasonable.⁷² In the absence of deviating CJEU judgments, this case law can still be applied. It would allow resellers to rebut claims in relation to the increasingly prevalent cases where manufacturers affix multiple trade marks of various types, shapes, and sizes to their products which cannot be reasonably removed.⁷³ However, applying it to the market of renewal, the sting will often be in determining whether de-branding was truly ‘practically impossible’ or ‘unreasonable’. In a sustainability-friendly reading of those conditions, it is suggested that courts should not only take into account the monetary costs for resellers related with de-branding, but also the fate that the goods would face if they were not renewed by the reseller, as well as the societal and environmental costs that this fate would entail.

2. Duty of loyalty and co-branding

Whatever reason is used to justify not removing the original mark, resellers have a duty of loyalty towards the trade mark holder,⁷⁴ which includes a duty to ensure that the public is informed about the circumstance that changes were made without the trade mark holder’s consent. Whether a trader meets that duty, the CJEU teaches, requires an assessment from the viewpoint of the average

consumer and depends on the circumstances of each case.⁷⁵ Typically, consumers are informed by co-branding: adding one’s own sign(s) (whether protected or not) to the goods or their packaging, possibly accompanied by indications like ‘reconditioned’ or ‘refurbished by’ and the like. Pursuant to the CJEU, co-branding contributes to the reseller’s duty of loyalty.⁷⁶ In line with this, German case law specifies that it must be clear from the circumstances that co-branded products were refurbished by the reseller.⁷⁷ On the merits, courts seem to be rather hesitant to conclude that this criterion is met, though. As such, there is case law where it was concluded that a rightholder had legitimate reasons to act against a trader because it was not clear beyond any doubt which part of a co-branded product was made under the responsibility of the rightholder and which part was altered by the trader.⁷⁸ Although the esteemed Annette Kur has rightfully argued that co-branding is probably the ‘safest’ way to refurbish goods without infringing trade marks,⁷⁹ a caveat is thus appropriate.

In relation to co-branding and other ways of informing the public about the changed nature of a product, some important questions remain unsettled. It is unclear, for instance, whether and under what circumstances it is sufficient that the packaging of a product is co-branded rather than the product itself. As an extension of that question, current EU case law leaves room for doubt as to whether the different commercial origins must be clear for the relevant public only at the moment of resale or whether the product must also be remarketed in a way that is apt to continue signalling the changed nature to third parties following that event, that is to avoid *post-sale confusion*.⁸⁰ Take the example of independent traders specialising in selling repaired ping-pong balls: cost-wise, it makes a difference whether it is sufficient to wrap these balls in paper that contains additional indications or whether they are required to affix that information to the balls themselves.

At first sight, EU case law on co-branding hints towards an interpretation that only requires information on the origin to be provided at the transaction, as the CJEU referred to ‘the concrete wording at time of resale’ and to circumstances surrounding the transaction as elements in the assessment of the duty of loyalty of the resellers.⁸¹ In contrast, the German Federal Supreme Court (*Bundesgerichtshof*) seems to take the view that indications have to be fixed to the product in order to avoid the relevant public being misinformed about the origin; a notice in the reseller’s point of sale does not suffice.⁸² In line with this the CJEU has considered that such

⁶⁹ Case C-129/17 *Mitsubishi* ECLI:EU:C:2018:594, para 52.

⁷⁰ Boddien (n 47) para 95; Marie-Christine Janssens, *Handboek merkenrecht* (Intersentia 2022) para 1178; Kur (n 55) 233; Christian Steudtner in Annette Kur, Verena von Bomhard and Friedrich Albrecht (eds), *BeckOK Markenrecht* (31st edn, CH Beck 1 October 2022) MarkenG § 24. Erschöpfung, para 41.1 <beck-online.de>.

⁷¹ cf Dorenbosch (n 50) 148.

⁷² *Valeo* (n 49).

⁷³ cf Irene Calboli and Martin RF Sentfleben, ‘Introduction’ in Irene Calboli and Martin RF Sentfleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018) 6.

⁷⁴ See *BMW* (n 6) para 61; *Gillette* (n 62) para 46; *Merck Sharp & Dohme* (n 26) paras 126–27.

⁷⁵ *Viking Gas* (n 21) paras 39–41; similarly Federal Supreme Court, judgment of 17 October 2018, I ZR 136/17, [2019] GRUR 79, para 31.

⁷⁶ See *Viking Gas* (n 21) para 41; *SodaStream* (n 63) para 53.

⁷⁷ Federal Supreme Court, judgment of 14 December 2006, I ZR 11/04, [2007] GRUR 705, para 30.

⁷⁸ Upper Regional Court (*Oberlandsgericht*) Koblenz, judgment of 23 February 2006, 6 U 1673/05 IBC, [2006] GRUR-RR 254.

⁷⁹ Kur (n 55) 234–235.

⁸⁰ cf Dorenbosch (n 50) 149.

⁸¹ *Portakabin* (n 6) paras 83–87; *Viking Gas* (n 21) paras 39–40; *SodaStream* (n 63) paras 51–52.

⁸² Federal Supreme Court, judgment of 14 December 1995, I ZR 210/93, [1996] GRUR 271; cf Federal Supreme Court, judgment of 10 February 1987, KZR 43/85, [1987] GRUR 438.

a notice did not constitute a valid defence to an infringement consisting of an undertaking affixing a trade mark to goods marketed outside the control of its rightholder because there was a clear possibility ‘that some consumers, in particular if they come across the goods after they have been sold ..., may interpret the sign as designating [the trade mark holder] as the undertaking of origin of the goods’.⁸³ Considering this case law on grounds for infringement, it is not unlikely that, if possible at all for the goods at hand, co-branding the product itself will often be the only way for renewing resellers to meet the duty of loyalty.⁸⁴ Given the costs of such operations, this may deter entrepreneurs from developing business models of this kind.

These contested aspects mean prospective resellers will often need to skate on thin legal ice if they want to renew trade-mark-bearing goods. Despite its age, the exhaustion doctrine still has not yet divulged all its secrets. In view of the principle of legal certainty, it was therefore welcomed that the Dutch Supreme Court referred preliminary questions on the legitimate reasons exception to the CJEU in 2020. In that case, an undertaking had repaired and resold pallets while leaving the collective trade mark ‘EPAL’ visible without affixing any other indicators, even though it did not subscribe to the licensed network of EPAL producers and repairers. Among many other questions, the CJEU was asked to what extent a repair constitutes legitimate reasons, what the impact of de-branding and co-branding is, and whether it is relevant that a collective mark is at hand.⁸⁵ Unfortunately, the case was removed from the register before the CJEU had the opportunity to shine its light on these matters.

3. Alternative: renewal services versus use to indicate purpose

As an alternative to purchasing, renewing, and then reselling goods, independent traders could consider merely providing renewal services. From the perspective of the private owners of the goods, such renewals will usually amount to private use and not to a ‘use in the course of trade’.⁸⁶ For the trader, the situation is different. From German case law it appears that renewal services like car tuning and upgrading are usually assessed as instances of use of a mark ‘necessary to indicate the intended purpose of a product or service’.⁸⁷ This limitation is subject to a rather restrictive interpretation: pursuant to a CJEU judgment about spare parts, using the mark should notably be the only possible means to indicate the purpose.⁸⁸ By contrast, the Federal Supreme Court has argued that undertakings active in derivative markets should have some leeway in relation to the use of manufacturers’ marks.⁸⁹

The licence to use a mark to indicate intended purpose is conditional upon the requirement that the use complies with honest practices in industrial or commercial matters.⁹⁰ Hence, here too, traders owe a duty of loyalty⁹¹ and must make clear that they are not commercially linked to the rightholder.⁹² The Federal Supreme Court interprets this criterion as a strict proportionality test. Pursuant to this, traders can only use the bare minimum that the average consumer needs to understand the reference to the trade mark.⁹³ As noted in the literature,⁹⁴ this implies that service providers should confine themselves as much as possible to (re)using only word marks and the original branding and avoid using colours and figurative or typographic elements because that could go beyond what is proportional.⁹⁵ Consequently, renewal service providers are in a less favourable position than resellers of renewed goods, as the latter can use rightholders’ image marks, combined marks and so on without the threat of a trade mark holder suing by reference to legitimate reasons.⁹⁶

This German case law is interesting because the CJEU has considered that the same circumstances must be taken into account when assessing the presence of legitimate reasons and the lawfulness of purpose-indicating use.⁹⁷ The Federal Supreme Court explains its two-pronged approach by reference to the fact that exhaustion applies to authentic goods marked by the rightholder themselves, whereas the statutory licence to use a mark to indicate an intended purpose concerns goods or services of a third party.⁹⁸ Although this argument may be true in many constellations, it is not entirely convincing in cases of repair or renewal services. More importantly, case practice has shown that the borders between *buy–repair–resell* and independent repair services are blurry.⁹⁹ If economies move towards increased circularity, such borders between goods and services are soon to become obsolete,¹⁰⁰ leaving

⁸³ Case C-206/01 *Arsenal* ECLI:EU:C:2002:651, paras 57–60.

⁸⁴ Similarly, Supreme Court of the Netherlands, Case 18/04203 *EPAL* NL:PHR:2019:918, Opinion of P Vlas, para 2.14; somewhat dissenting, in relation to spare parts: Tischner and Stasiuk (n 51) 35.

⁸⁵ *EPAL* (n 84) NL:HR:2020:391.

⁸⁶ Kur (n 55) 229–30.

⁸⁷ EUTMR and TMD, art 14(1)(c).

⁸⁸ *Gillette* (n 62) para 34.

⁸⁹ See Federal Supreme Court, judgment of 12 March 2015, I ZR 147/13, [2015] GRUR 1121; Federal Supreme Court, judgment of 15 July 2004, I ZR 37/01, [2005] GRUR 163.

⁹⁰ EUTMR and TMD, art 14(2).

⁹¹ *Portakabin* (n 6) para 67.

⁹² cf Case C-334/22 *Audi AG v GQ* ECLI:EU:C:2023:700, Opinion of AG Medina, paras 60–67.

⁹³ Federal Supreme Court, judgment of 14 April 2011, I ZR 33/10, [2011] GRUR 1135, paras 24–26.

⁹⁴ See Boddien (n 47) MarkenG § 23. Benutzung von Namen und beschreibenden Angaben; Ersatzteilgeschäft, para 119; Marie-Christine Janssens, ‘In welke mate kan men zich specialist of gespecialiseerde in automeerk X noemen? Een merkenrechtelijke stand van zaken na het arrest BMW/Deenik’ [2000] IRDI 228 (note), 233; cf Paul Kretschmar in Annette Kur, Verena von Bomhard and Friedrich Albrecht (eds), *BeckOK Markenrecht* (31st edn, CH Beck 1 October 2022) MarkenG § 23. Benutzung von Namen und beschreibenden Angaben; Ersatzteilgeschäft, para 42.1 <beck-online.de>.

⁹⁵ Federal Supreme Court, judgment of 14 April 2011, I ZR 33/10, [2011] GRUR 1135, paras 25–27; dissenting, pleading in favour of a more permissible reading of this requirement: Tischner and Stasiuk (n 51) 40 and 56–57.

⁹⁶ Federal Supreme Court, judgment of 7 November 2002, I ZR 202/00, [2003] GRUR 340, at 342; Federal Supreme Court, judgment of 17 July 2003, I ZR 256/00, [2003] GRUR 878, para II.2; Federal Supreme Court, judgment of 14 April 2011, I ZR 33/10, [2011] GRUR 1135, para 28.

⁹⁷ *Portakabin* (n 6) para 81 and the many cross-references (eg, para 90) to *BMW* (n 6).

⁹⁸ Federal Supreme Court, judgment of 14 April 2011, I ZR 33/10, [2011] GRUR 1135, para 28.

⁹⁹ cf *Viking Gas* (n 21).

¹⁰⁰ See Bert Keirbilck, Evelyne Terryn and Elias Van Gool, ‘Consumentenbescherming bij servitisation en product-dienst-systemen (PDS)’ [2019] VVSR Preadviezen 11, 11–68; Vanessa Mak and Evelyne Terryn, ‘Circular Economy and Consumer Protection: The Consumer as a Citizen and the Limits of Empowerment Through Consumer Law’ [2020] JCP 227, 227–248.

a rather random differentiation between very similar business models. Indeed, it is questionable whether it makes sense to differentiate between traders that buy, repair, and then resell ping-pong balls, on the one hand, and traders that offer a ping-pong ball repair service directly to consumers.

III. Interaction with copyright and design

1. Copyright

Renewed products may include original elements subject to copyright protection, which also extends over utilitarian works.¹⁰¹ First, similarly to trade mark holders, copyright holders are no longer entitled to exercise their right of distribution over a tangible copy¹⁰² once it has been subject to a transfer of ownership with their consent in the EEA.¹⁰³ Given the absence of an origin-indicating function, this exhaustion rule is not accompanied with an exception for legitimate reasons. Hence, resellers would theoretically not have to fear infringement claims after renewing a purchased copy. Nonetheless, exhaustion is without prejudice to the reproduction right, the adaptation right and to the moral rights, which include a right to object to any distortion, mutilation or other modification prejudicial to the author's honour or reputation.¹⁰⁴ Besides, CJEU case law shows that extensive changes to a copy may, in some circumstances, undo the effects of exhaustion, notwithstanding the absence of any statutory exception for legitimate reasons.¹⁰⁵ In sum, exhaustion is not significantly more unconditional for copyright than for trade marks. Given the low threshold to claim copyright protection, traders should therefore proceed with caution when intending to resell renewed goods.¹⁰⁶ In addition, many products may simultaneously be protected by trade mark and copyright law. Whereas nothing excludes cumulation,¹⁰⁷ trade mark holders will therefore still be able to invoke legitimate reasons, even after the copyright distribution right was exhausted.

Second, the InfoSoc Directive provides for an optional exception/limitation for 'use in connection with the demonstration or repair of equipment'.¹⁰⁸ The judiciary could easily use this repair exception to accommodate sustainability concerns.¹⁰⁹ Nonetheless, its effects may prove rather limited for providers of independent renewal services. As it is optional, not all Member States

have implemented it into their national copyright laws.¹¹⁰ Moreover, the references to demonstration and equipment have caused national implementations to be different from country to country¹¹¹ and it remains unclear to what extent the three steps test¹¹² excludes commercial uses. Similarly, the CJEU's rigid interpretation of the lawful use exception in the Software Directive¹¹³ applied to error correction¹¹⁴ has been criticized for facilitating the foreclosure by manufacturers of aftermarkets for the repair of computer programs and of products that have embedded software.¹¹⁵ The overall conclusion is that the effectiveness of harmonised copyright exceptions is rather limited for independent repair and renewal business models.¹¹⁶

2. Design & models

Some products protected by trade marks will also enjoy design protection. The law on designs and models includes a rule of exhaustion applicable to subject-matter incorporated in or applied to products put on the market in the EEA by or with consent of its rightholder.¹¹⁷ As in copyright, legislation does not provide for an exception for legitimate reasons. Given the possibility of cumulation, resellers should nevertheless be cautious about engaging in operations that could amount to trade mark infringements.

Repair is a long-debated issue in design law.¹¹⁸ This is because it is not only possible to protect products as models, but also components of complex products, i.e. products composed of multiple components which can be replaced permitting disassembly and re-assembly.¹¹⁹ Unlimited protection of components as autonomous models would bestow rightholders of designs in complex products with monopolies over entire derivative markets for spare parts. Therefore, protection is excluded, first, for 'features of appearance of a product which are solely dictated by its technical function' (like a screw) and, second, for *must-fit* components: that is products that need to be reproduced in their exact form and dimensions in order to connect them to or place them in, around or against another product 'so that either product may perform its function' (like the end of a hose).¹²⁰ However, the more controversial topic is *must-match* parts. These are components that need to be replaced by identical components

¹⁰¹ See, eg, Case C-833/18 *Brompton* ECLI:EU:C:2020:461.

¹⁰² Case C-263/18 *Tom Kabinet* ECLI:EU:C:2019:1111.

¹⁰³ EP & Council Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society (InfoSoc Directive) [2001] OJ L167/10, art 4(2).

¹⁰⁴ See Berne Convention for the Protection of Literary and Artistic Works (as amended 28 September 1979) 1161 UN Treaty Series 3, arts 2(3) and 6^{bis}(1); InfoSoc Directive, art 2.

¹⁰⁵ *Allposters* (n 53); similarly, see Dorenbosch (n 50) 149.

¹⁰⁶ See, critically, Dana Beldiman, Constantin Blanke-Roeser and Anna Tischner, 'Spare Parts and Design Protection – Different Approaches to a Common Problem. Recent Developments from the EU and US Perspective' [2020] GRUR International 673, 681-82; Péter Mezei and Heidi Härkönen, 'Monopolising trash: a critical analysis of upcycling under Finnish and EU copyright law' [2023] JIPLP 360, 366.

¹⁰⁷ However, *Dior v Evora* (n 6) paras 58-59.

¹⁰⁸ InfoSoc Directive, art 5(3)(l).

¹⁰⁹ Anthony D Rosborough, 'Zen and the Art of Repair Manuals: Enabling a participatory Right to Repair through an autonomous concept of EU Copyright Law' [2022] JIPITEC 113, paras 69 and 72.

¹¹⁰ The exception was, eg, not implemented in Belgium, Denmark, Ireland, Italy, France, Finland, Greece, the Netherlands, Spain or Sweden.

¹¹¹ Rosborough (n 109) paras 49-56.

¹¹² InfoSoc Directive, art 5(5).

¹¹³ EP & Council Directive 2009/24/EC on the legal protection of computer programs (codified version) [2009] OJ L111/16, art 5(1).

¹¹⁴ Case C-13/20 *Top System* ECLI:EU:C:2021:811.

¹¹⁵ Bohdan Widla, 'Circular economy versus copyright protection of computer programs in the EU: challenges and lessons from the CJEU's judgment in *Top System*' (2023) 18 JIPLP 353, 357 and 359.

¹¹⁶ cf Maria Lilla Montagnani, '(Digital) Circular Economy and IPRs: A Story of Challenges and Opportunities' (2023) 54 IIC 1009, 1010.

¹¹⁷ EP & Council Directive 98/71/EC on the legal protection of designs (DD) [1998] OJ L289/28, art 15; Council Regulation (EC) 6/2002 on Community designs (CDR) [2002] OJ L3/1, art 21.

¹¹⁸ For a detailed overview, see Beldiman, Blanke-Roeser and Tischner (n 106) 673-92.

¹¹⁹ CDR, art 3(c).

¹²⁰ CDR, art 8(1) and 8(2).

because any other solution would result in an appearance that does not match the complex products – like a car door.

Must-match components can be protected as models. However, a provision in the Community Design Regulation teaches that ‘protection as a Community design shall not exist for a design which constitutes a component part of a complex product used ... for the purpose of the repair of that complex product so as to restore its original appearance’.¹²¹ By lack of agreement, the Design Directive left it to the Member States to decide whether to maintain or introduce such an exception in their national legislation on the protection of design and models.¹²²

Given the rationale of avoiding consumer lock-in, the CJEU argues that the *must-match* exception entitles traders to produce and market component parts in a protected shape without the rightholder’s consent when the shape is necessary for the repaired product to be aesthetically pleasant.¹²³ However, further requirements include that the component part is visually identical to the original part as placed on the market and that the part is essential to the extent that, if it were faulty or missing, this would prevent the normal use of the complex product.¹²⁴ Moreover, spare part manufacturers and intermediaries are under ‘a duty of diligence as regards compliance by downstream users’, entailing an obligation to inform users about the fact that a component part incorporates protected design and that that part can only be used to restore the original appearance. This obligation ensures, preferably by contractual means, that users will not use the parts for reasons other than repair, as well as an obligation to refrain from selling components when they can reasonably expect that buyers will use them beyond repair.¹²⁵

Considering all this, the repair clause offers little comfort for traders who want to engage in renewing protected products. The scope of the exception is limited to very specific components and the surrounding conditions are interpreted narrowly: spare parts cannot deviate from the original appearance and case law explicitly excludes that component parts be used for ‘reasons of preference or purely of convenience’, e.g. for refurbishment or customisation.¹²⁶ Moreover, the modalities to put the exception into effect are paradoxically so detailed and vague at the same time that they deter independent traders.¹²⁷ Despite the repair exception’s rationales, the rightholder largely remains in control of the spare parts market and could thus perfectly well develop a business strategy that encourages consumers to buy new complex products instead of replacing broken components.

Finally, CJEU case law leaves no doubt that the repair exception in design law is without prejudice to trade marks. Even when the exception applies, the purpose of restoring the original appearance of the product does not

entitle traders to copy and paste trade marks present on the original part.¹²⁸ Neither trade mark exhaustion, nor the exception to indicate the intended purpose applies here.¹²⁹ In other words, consumers with a broken wheel cover will either have to content themselves with a cover without the car manufacturer’s logo if they decide to have it replaced by an independent spare part producer, or they will need to replace all the wheel covers, or simply turn to the car manufacturer’s network. This, in turn, risks incentivising manufacturers to increasingly affix their marks to their goods, in ever more shapes and sizes.

Interestingly, the CJEU will soon have the occasion to bring more clarity on the relation between trade mark and the design of spare parts at the occasion of a 2022 reference for preliminary judgment on trade marks embedded in the shape of radiator grilles – an automotive part.¹³⁰ In this respect, Advocate General Medina suggests that the Court uphold that there is no infringement when an independent spare part producer includes the shape of a car manufacturer’s figurative trade mark in a grille.¹³¹ Referring to CJEU case law permitting toy producers to reproduce third-party trade marks for automobiles on scale model cars, she principally argues that the purpose of the reproduction of the silhouette of the *Audi* rings in the case at hand is merely technical in nature and does not therefore amount to a ‘use of the sign in the course of trade’.¹³² She adds that, although the repair exception in design law is not applicable to marks as such, any opposite interpretation would deviously result in the foreclosure of the aftermarket for spare parts through trade mark law, which is exactly what the EU legislator wanted to avoid by introducing the repair exception in design law.¹³³ Nonetheless, a judgment in this sense would require a U-turn in CJEU case law, which tends to grant a broad interpretation to the ‘use as a mark’ prerequisite¹³⁴ and to confirm the mutual independence of IP rights. Alternatively, the Advocate General recommends concluding that reproducing the shape does not constitute an instance of permitted use of a mark ‘necessary to indicate the intended purpose of a product or service’.¹³⁵ It is yet to be seen how the CJEU will assess the case.

IV. Future EU policy

In its 2020 New Circular Economy Action Plan, the European Commission announced that it would propose an IP strategy to ensure that IP would remain a crucial factor for the circular economy.¹³⁶ Since then, it has been

¹²¹ CDR, art 110(1).

¹²² DD, art 14 and recitals 19–20.

¹²³ Case C-397/16 *Acacia* ECLI:EU:C:2017:992, paras 34–39, 50 and 53.

¹²⁴ *ibid* paras 69–75.

¹²⁵ *ibid* paras 85–89.

¹²⁶ *ibid* para 70.

¹²⁷ Beldiman, Blanke-Roeser and Tischner (n 106) 691.

¹²⁸ Case C-500/14 *Order in Wheeltrims* ECLI:EU:C:2015:680, paras 42–45.

¹²⁹ Beldiman, Blanke-Roeser and Tischner (n 106) 680–81.

¹³⁰ Request for preliminary ruling in Case C-334/22 *Audi AG v GQ*, [2022] OJ C318/27; for an analysis of the case as referred, see Tischner and Stasiuk (n 51) 54–58.

¹³¹ Case C-334/22 *Audi AG v GQ* ECLI:EU:C:2023:700, Opinion of AG Medina, paras 46 and 68.

¹³² *ibid* paras 38–40.

¹³³ *ibid* para 44.

¹³⁴ See *Céline* (n 57) paras 20–24.

¹³⁵ EUTMR and TMD, art 14(1)(c); see above.

¹³⁶ European Commission, ‘A new Circular Economy Action Plan: For a cleaner and more competitive Europe’, COM/2020/98, para 6.3.

silent about IP and sustainability. In March 2023, the Commission published a proposal for a Directive on a Right to Repair.¹³⁷ As expected,¹³⁸ that proposal focuses on the obligation for producers of certain goods to repair them for consumers, on information on repairing and on the standardisation of independent repair services, as well as on the preference of repair over replacement as a remedy for non-conformity of goods sold business-to-consumer. Despite suggestions made during the preparatory phase,¹³⁹ no references to IP topics appear to have made it to the final text of the proposal. This is unfortunate, as the analysis above shows that repairing will often inevitably require the use of materials protected by third parties' IP rights.¹⁴⁰

In the 2022 Design Package proposals, the Commission explicitly addresses the repair exception.¹⁴¹ It considers that EU-wide harmonisation of the exception is necessary and cites the liberalisation of the spare parts market as a policy objective favourable for SMEs, individual designers and consumers, which will complement existing efforts to strive towards 'promoting repairs and the circular economy'.¹⁴² On scrutiny, however, the proposals are anything but innovative. Besides becoming a mandatory exception complemented with a transition period¹⁴³ in the recast Directive, the repair clause will remain substantively unaltered. Indeed, the exception will still only apply to *must-match* components¹⁴⁴ and the Commission even proposes to lay down the detailed modalities to make use of the exception, as interpreted by the CJEU.¹⁴⁵ The Council is expected to honour the text proposed by the Commission in this respect, as the proposed approach, 'based on many years of comprehensive consultations and preparatory work, was considered by the Commission to constitute a balance between the objectives of market liberalisation and the consumer and business interests involved'.¹⁴⁶ On the relationship between design repair and trade mark use, the Proposals remain silent. In light of this it is hard to see how the Design Package will contribute to a more circular economy in practice.

¹³⁷ European Commission, 'Proposal for an EP & Council Directive on common rules promoting the repair of goods and amending Regulation (EU) 2017/2394, Directives (EU) 2019/771 and (EU) 2020/1828', COM/2023/155.

¹³⁸ See European Commission, 'Call for evidence for an impact assessment', Ares/2022/175084.

¹³⁹ cf M Möslinger and others, 'Towards an Effective Right to Repair for Electronics: Overcoming legal, political and supply barriers to contribute to circular electronics in the EU' (2022) European Commission JRC Technical Report 24-27; Tischner and Stasiuk (n 51) 30.

¹⁴⁰ Widla (n 115) 354 and 357.

¹⁴¹ See European Commission, 'Proposal for an EP & Council Regulation amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002', COM/2022/666, at art 20a; European Commission, 'Proposal for an EP & Council Directive on the legal protection of designs (recast)', COM/2022/667, at art 19.

¹⁴² European Commission, Explanatory Memorandum to COM/2022/667 (n 141) 2-3.

¹⁴³ European Commission, Directive Proposal COM/2022/667 (n 141) art 19(3).

¹⁴⁴ European Commission, Explanatory Memorandum to COM/2022/667 (n 141) 10.

¹⁴⁵ European Commission, Regulation Proposal COM/2022/666, art 20a(2); European Commission, Directive Proposal COM/2022/667 (n 141) art 19(2).

¹⁴⁶ Council, Note from the Permanent Representatives Committee to the Council No 12714/23, dated 13 September 2023, para 18.

V. Conclusions

The trade mark exhaustion doctrine traditionally reconciles the main function of marks as indicators of commercial origin on the one hand, with the socio-economic need for tradable goods on the other. In some constellations, these socio-economic needs are aligned with the pursuit of a more sustainable society. Such is the case, for instance, when traders offer used goods on the second-hand market. However, as soon as traders intend to proceed to more substantive renewals, either as a service or by *buying-renewing-reselling*, the analysis shows that they enter a legal minefield and that ecological motives are hardly (if ever) considered.¹⁴⁷ Similarly, sustainability concerns have rarely, if ever, been considered to date in the (legislative policy) debate on parallel imports from non-EEA countries and in the case law on parallel imports of products for which packaging plays an important role for consumer trust, and medication in particular. In these debates, centre stage is taken by other interests instead – including public health concerns, the need to avoid anti-competitive partitioning of the internal market to the detriment of the European consumer, as well as international political interests.

Originally developed to serve the traditional, linear *take-make-use-dispose* business models,¹⁴⁸ IP law currently often entitles rightholders to prevent others from using their marketed products in circular business models, leaving it at their discretion whether to elaborate ecological post-sale solutions for their products.¹⁴⁹ In other words, they control the aftermarkets for repair and renewal.¹⁵⁰ This often remains true, even when copyright and/or design rights in a product are exhausted, because multiple IP rights can cumulatively apply to the same product, so that the trade mark doctrine on legitimate reasons *de facto* entitles rightholders to excavate the effectiveness of the exhaustion of other IP rights.¹⁵¹ Conversely, about a quarter of a century ago, the CJEU did find that the lack of copyright exhaustion could not be invoked to overturn the effectiveness of the exhaustion of trade mark rights in the same goods.¹⁵² Hence, it is not inconceivable that the Court will one day apply a similar reasoning the other way around, thereby taking into account sustainability arguments (see below).

The IP-related unattractiveness of independent renewal businesses is further aggravated by the use of open norms left to case-by-case assessments. Admittedly, the CJEU has recently considered that trade mark holders must tolerate greater interference with their prerogatives by third-party undertakings following exhaustion if they marketed

¹⁴⁷ Dorenbosch (n 50) 151; Annette Kur and Irene Calboli, 'Intellectual property in the circular economy' (2023) 18 JIPLP 337, 337; cf Montagnani (n 116) 1010.

¹⁴⁸ Montagnani (n 116) 1009.

¹⁴⁹ Hans-Wolfgang Micklitz and others, 'Right to Repair' (2022 SVRV) 35 <https://www.svr-verbraucherfragen.de/wp-content/uploads/2022_SVRV_PB_Right_to_Repair.pdf> accessed 1 March 2023.

¹⁵⁰ Widla (n 115) 353 and 359.

¹⁵¹ cf Charlotte JS Vrendenbarg, 'IE en de circulaire economie: stimulans of obstakel?' [2023] Nederlands Juristenblad 1072, 1077.

¹⁵² Dior v Evora (n 6) para 58; Geiregat, *Supplying and Reselling Digital Content: Digital Exhaustion in EU Copyright and Neighbouring Rights Law* (n 3) 169.

their product in a packaging intended to be recycled.¹⁵³ However, it cannot be ignored that the primordial role attributed to common practices in a given sector is particularly problematic. To assess the lawfulness of a trader's action, the CJEU notably considered that national courts should consider whether it is *common* for consumers to encounter refilled packaging¹⁵⁴ and that common practices codetermine whether the use of internet keyword advertisements was legitimate.¹⁵⁵ Likewise, trade mark exceptions depend on 'honest practices in industrial or commercial matters'. On the one hand, this implies that the eco-friendly liberties granted by the CJEU in relation to some products are also applicable for other recyclable products.¹⁵⁶ But on the other hand, if established practices keep determining what is allowed, one cannot escape the question of how the EU will be able to 'transform its economy and society to put it on a more sustainable path' as postulated in the Commission's Green Deal?¹⁵⁷ Indeed, it is questionable whether benchmarking against the past can effectively contribute to future sustainability policy.

Other uncertainties for traders result from references to *all circumstances* and the use of open wording like *legitimate* reasons and *unfair* advantage. Similarly, it remains unclear where the line is between repairing and refurbishing, or between presenting one's independent products or services and giving the impression of a commercial link with a rightholder. Combined with the chilling effect caused by the threat of lawsuits by major undertakings (strategic lawsuits against public participation, SLAPPs),¹⁵⁸ these sources of ambiguity constitute a sword of Damocles, disincentivising entrepreneurs from engaging in circular economy start-ups.¹⁵⁹

Besides having clearer guidance on what is and what is not allowed, it is suggested that a balancing test be incorporated into the exception for legitimate reasons, not only taking into account the rightholders' and third parties' economic interests but also ecological arguments.¹⁶⁰ As ancillary legal bases, courts could perhaps even refer to the UN Sustainable Development Goals¹⁶¹ read jointly with the duty in EU Primary Law to promote sustainable development.¹⁶² On a concrete level, courts could, for instance, broaden the debate by investigating the fate that goods will have if they are *not* renewed by third parties,

as far as allowed by national procedural rules. Similarly, the judiciary could take account of the ecological impact of repackaging modalities and of requested corrective enforcement measures as part of the 'third party interests'¹⁶³ which the CJEU requires to be considered on a case-by-case basis¹⁶⁴ – especially in instances where authentic products are at hand. Courts in the Benelux area have already been taking such considerations into account in infringement proceedings.¹⁶⁵ Nonetheless, the CJEU could provide for an extra push towards a more sustainable future if it would explicitly list ecological interests among the factors that national judges ought to take into account in IP cases.

For the sake of clarity, this is not a plea to sacrifice every IP holder's rights in the interest of sustainability.¹⁶⁶ It is rather a suggestion to embed sustainability as an argument in the discourse, similarly to how the CJEU has, over the years, embedded arguments of fair competition¹⁶⁷ and the objective need to avoid market partitioning caused by strategic behaviour of company concerns¹⁶⁸ and/or by lack of drug price harmonisation¹⁶⁹ in its doctrine on trade mark limitations and exhaustion.¹⁷⁰ The pursuit of sustainable development is a universal interest that could easily complement that list. Authors Dirk Visser and Simon Dack even consider that this interest is a matter of *ordre public* that courts could and should raise on their own motion.¹⁷¹ Even if one considers that this is one step too far,¹⁷² it seems fair to conclude that courts do have tools to pay more attention to sustainability motives in trade mark case law,¹⁷³ even without a change in legislation. So, the door is open for the judiciary to 'act now'.¹⁷⁴

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¹⁵³ *SodaStream* (n 63) para 49; see also Case C-197/21 *SodaStream* ECLI:EU:C:2022:387, Opinion of AG Pitruzzella, notably at paras 1 and 50.

¹⁵⁴ *Viking Gas* (n 21) para 40; *SodaStream* (n 63) para 48; similarly, see *SodaStream* (n 153) Opinion of AG Pitruzzella, para 56.

¹⁵⁵ *Portakabin* (n 6) para 71.

¹⁵⁶ Visser and Dack (n 17) 1222.

¹⁵⁷ European Commission, 'The European Green Deal', COM/2019/640, 2.

¹⁵⁸ cf Irene Calboli, 'Hands Off "My" Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation' in Irene Calboli and Martin RF Sentfleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2018) 293.

¹⁵⁹ Kur (n 55) 228-29.

¹⁶⁰ cf Tischner and Stasiuk (n 51) 36 and 58-59; similarly, in relation to copyright, see Mezei and Härkönen (n 106) 364-66.

¹⁶¹ UN General Assembly, resolution 'Transforming our world: the 2030 Agenda for Sustainable Development', 25 September 2015, A/RES/70/1.

¹⁶² Treaty on the Functioning of the European Union, art 11; Charter of the Fundamental Rights of the EU, art 37.

¹⁶³ Similarly, see Visser and Dack (n 17) 1220; Vrendenburg, 'IE en de circulaire economie: stimulans of obstakel?' (n 151) 280-82.

¹⁶⁴ *Perfumesco.pl* (n 18) para 41.

¹⁶⁵ See Commercial Court of Ghent, judgment of 3 October 2019, [2020] *Revue de droit intellectuel - l'ingénieur conseil* 111, para 4.91 – *X v Renson*; Court of the Hague, C/09/593157, NL:RBDHA:2022:3653, paras 4.90-4.91 – *T.O.M. v Prijskiller*; also see the suggestions for alternative actions by Vrendenburg, 'Duurzamer vorderen en veroordelen in IE-zaken' (n 17) 277-79.

¹⁶⁶ cf Kur and Calboli (n 147) 338.

¹⁶⁷ *Gillette* (n 62) para 36.

¹⁶⁸ Case C-291/16 *Schweppes* ECLI:EU:C:2017:990; *Novartis Pharma* (n 26).

¹⁶⁹ *Winthorp* (n 25) paras 16-18; *BMS* (n 22) para 46.

¹⁷⁰ See also Vrendenburg, 'Towards a Judicial Sustainability Test in Cases Concerning the Enforcement of Intellectual Property Rights' (n 17) 1129-1130.

¹⁷¹ Visser and Dack (n 17) 1220.

¹⁷² Vrendenburg, 'Duurzamer vorderen en veroordelen in IE-zaken' (n 17) 281-82; Vrendenburg, 'IE en de circulaire economie: stimulans of obstakel?' (n 151) 1074.

¹⁷³ See Vrendenburg, 'Towards a Judicial Sustainability Test in Cases Concerning the Enforcement of Intellectual Property Rights' (n 17) 1127-1128; cf Henning Grosse Ruse-Khan, 'Is IP Good for Our Planet?' [2022] *GRUR International* 683, 684.

¹⁷⁴ cf United Nations campaign material available at <www.un.org/en/actnow/> and <act4sdgs.org/actnow/> accessed 1 November 2023.