

L'esaurimento comunitario del marchio

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**Convegno AIPPI – Marchi e diritto comunitario: l'evoluzione
giurisprudenziale e le ricadute sui diritti nazionali**

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Art. 7 EC Directive 89/104 (Art. 13 EC Regulation 40/94)

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the EU under that trade mark by the proprietor or with his consent.
2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of goods is changed or impaired after they have been put on the market.

Bristol Myers/Paranova (C-427/93)

40. Article 7 of the directive, like Article 36 (now 30) of the Treaty, is intended to reconcile the fundamental interest in protecting trade mark rights with the fundamental interest in the free movement of goods within the common market, so that those two provisions, which pursue the same result, must be interpreted in the same way.

International vs. EU exhaustion

- Directive - Proposal (1980): whereas 8
- Regulation - Proposal (1980): official notes on art. 11
- Opinion of the Economic and Social Committee (1981)
- Opinion of the Parliament (1983)
- Directive - Proposal (1984)

For International exhaustion

- Trade mark function
- Opinion of Mr. Jacobs (Silhouette)
- EFTA Court, Dec. 3, 1997 (MAG)
- UK High Court, May 18, 1999 (Davidoff)
- NL, DK, CH (Chanel), JAP (Parker), CAN, Indonesia, SAF, AUS, NZ, Mercosur
- TRIPs – GATT (?)
- Economic reasons (NERA report)

EU exhaustion: Silhouette

26. The Directive cannot be interpreted as leaving it open to the Member States to provide in their domestic law for exhaustion of the rights conferred by a trade mark in respect of products put on the market in non-member countries.

27. This, moreover, is the only interpretation which is fully capable of ensuring that the purpose of the Directive is achieved, namely to safeguard the functioning of the internal market. A situation in which some Member States could provide for international exhaustion while others provided for Community exhaustion only would inevitably give rise to barriers to the free movement of goods and the freedom to provide services.

Limitations to the exhaustion doctrine

7 (1) The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the EU under that trade mark by the proprietor or with his consent

- Definition of consent
- Definition of goods
- Definition of putting on the market
- Burden of proof

7 (2) Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of goods is changed or impaired after they have been put on the market

- Conditions of goods changed or impaired
- Protection of trade mark reputation

Implied consent: Davidoff

- Consent must be expressed in such a way that an intention to renounce those rights is **unequivocally** demonstrated. **This intention will normally be gathered from an express statement of consent.** Nevertheless, it may in some cases be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market outside the EEA **which unequivocally demonstrate that the proprietor has renounced his rights.**
- Consent must be expressed **positively**; the factors taken into consideration in finding implied consent must **unequivocally** demonstrate that the trade mark proprietor has renounced any intention to enforce his exclusive rights. It follows that it is not for the trade mark proprietor to demonstrate absence of consent, but rather for the trader alleging consent to prove it.

Mere silence: Davidoff

Implied consent to the marketing within the EEA of goods put on the market outside that area cannot be inferred from the **mere silence** of the trade mark proprietor.

Furthermore, implied consent cannot be inferred from the fact that **contractual reservations were not imposed** at the time of the transfer of ownership of the goods bearing the mark, or from the fact that the trade mark proprietor has **not communicated his opposition to marketing** within the EEA or from the fact that the goods carry **no warning of a prohibition** on their being placed on the market within the EEA.

Individual items: Sebago

19. The rights conferred by the trade mark are exhausted only in respect of the individual items of the product which have been put on the market with the proprietor's consent in the territory there defined. The proprietor may continue to prohibit the use of the mark in pursuance of the right conferred on him by the Directive in regard to individual items of that product which have been put on the market in that territory without his consent.

Peak Holding (C-16/03-2004): Putting products on the market

Article 5(3)(b) and (c) of the Directive, relating to the content of the proprietor's exclusive rights, distinguishes *inter alia* between offering the goods, putting them on the market, stocking them for those purposes and importing them. The wording of that provision therefore also confirms that importing the goods or offering them for sale in the EEA cannot be equated to putting them on the market there.

Peak Holding: Import without sale, Offer for sale

Article 7(1) must be interpreted as meaning that goods bearing a trade mark cannot be regarded as having been put on the market in the European Economic Area where the proprietor of the trade mark **has imported** them into the European Economic Area **with a view to selling them** there or where he **has offered them for sale** to consumers in the European Economic Area, in his own shops or those of an associated company, **without actually selling them.**

Class/Colgate (C-405/03-2005): External transit - Offering for sale

- A trade mark proprietor **cannot oppose** the mere entry into the Community, under the **external transit procedure** or the **customs warehousing procedure**, of original goods bearing that mark which had not already been put on the market in the Community previously by that proprietor or with his consent
- ‘**Offering**’ and ‘**putting on the market**’ the goods may include, respectively, the offering and sale of original goods bearing a trade mark and having the customs status of non-Community goods, **when the offering is done and/or the sale is effected while the goods are placed under the external transit procedure or the customs warehousing procedure. The trade mark proprietor may oppose the offering** or the sale of such goods when it necessarily entails the putting of those goods on the market in the Community.

Van Doren (C-244/00-2003): Burden of proof

Where a third party against whom proceedings have been brought succeeds in establishing that there is a real risk of partitioning of national markets if he himself bears the burden of proving that the goods were placed on the market in the EEA by the proprietor of the trade mark or with his consent, it is for the proprietor of the trade mark to establish that the products were initially placed on the market outside the EEA by him or with his consent. If such evidence is adduced, it is for the third party to prove the consent of the trade mark proprietor to subsequent marketing of the products in the EEAW

Merck/Paranova (C-433/99-2002): Re-labelling

17. The national court states that Austrian consumers are not accustomed to being offered pharmaceutical products which have clearly been put on the market in another State, where **a different language is used**. It states that it is perfectly conceivable that a significant number of **consumers would regard such a product with the same suspicion as products with untidy or poor-quality packaging**. Even **attaching labels**, in particular in the case before it, **would scarcely mitigate that suspicion**. If it were to emerge that a significant proportion of consumers would in fact be suspicious in that way, it would be entirely possible, in the view of the national court, to consider that prohibition of the repackaging would contribute to artificial partitioning of the markets.

Boehringer (C-143/00-2002): Repackaging

Replacement packaging of pharmaceutical products is objectively **necessary** within the meaning of the Court's case-law if, **without such repackaging, effective access to the market concerned, or to a substantial part of that market, must be considered to be hindered as the result of strong resistance from a significant proportion of consumers to relabeled pharmaceutical products.**

Re-branding: (*Pharmacia & Upjohn/Paranova*)

37. There is no objective difference between reaffixing a trade mark after repackaging and replacing the original trade mark by another which is capable of justifying the condition of artificial partitioning being applied differently in each of those cases.

Interpretation of Art. 7(2) EC Directive (*Bristol Myers/Paranova*)

Article 7(2) of Directive 89/104 must be interpreted as meaning that the trade mark owner may legitimately oppose the further marketing of a pharmaceutical product where the importer has repackaged the product and reaffixed the trade mark unless:

- reliance on trade mark rights by the owner would contribute to the artificial partitioning of the markets between Member States;
- the repackaging cannot affect the original condition of the product inside the packaging;
- the new packaging clearly states who repackaged the product and the name of the manufacturer;
- the presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark;
- the importer gives notice to the trade mark owner before the repackaged product is put on sale, and, on demand, supplies him with a specimen of the repackaged product.

Boehringer: Prior notice

61. According to the Court's case-law, a parallel importer which repackages a trade-marked pharmaceutical product must give **prior notice** to the trade mark proprietor that the repackaged product is being put on sale (see *Hoffmann-La Roche*, paragraph 12). At the request of the trade mark proprietor, the importer must also **supply it with a sample of the repackaged product before it goes on sale**. That requirement enables the proprietor to check that the repackaging is not carried out in such a way as directly or indirectly to affect the original condition of the product and that **the presentation after repackaging is not such as to damage the reputation of the trade mark**. It also affords the trade mark proprietor a **better possibility of protecting himself against counterfeiting** (see *Bristol-Myers Squibb and Others*, paragraph 78).

Boehr. Ingelheim/Dovelhurst (C-348/04-2007): Failure of Prior

- 60 For the trade mark proprietor to be able lawfully to oppose further marketing of a repackaged pharmaceutical product it is sufficient that one of the conditions of *Bristol-Myers Squibb and Others* is not fulfilled.
- 61 It follows that the trade mark owner's right to prevent parallel importation of pharmaceutical products which, while not spurious, have been marketed in breach of the requirement to give prior notice to that proprietor is not different from that enjoyed by the proprietor in respect of spurious goods
- 62 In both cases, the products ought not to have been marketed on the market concerned.
- 63 Thus, a national measure under which, where a parallel importer has marketed goods which are not spurious without giving prior notice to the trade mark proprietor, that proprietor is entitled to claim financial remedies on the same basis as if the goods had been spurious, is not in itself contrary to the principle of proportionality. However, it is for the national court to determine the amount of the financial remedies according to the circumstances of each case

Protection of the reputation of the trademark in re-labelling

Ballantine: “A third party who re-labels the product must ensure that the reputation of the trade mark - and hence of its owner - does not suffer from an inappropriate presentation of the relabelled product. The national court must take into account in particular the interest in protecting the luxury image and the considerable reputation they enjoy”.

Protection of the reputation of the trademark in advertising

Dior: “The reseller must endeavour to prevent his advertising from affecting the value of the trade mark by detracting from the allure and prestigious image of the goods and from their aura of luxury, (as it happens where) the use of the trade mark in the reseller's advertising seriously damages the reputation of the trade mark”.

Are those principles a real threat to parallel imports?

Custom retentions and anti-piracy rules are not applicable to goods which have been put on the market **everywhere** under the trade mark by the proprietor or with his consent

E-commerce

On-line auctions

(On-line) outlets

Circulation of copyrighted materials not included in a physical product

The revenge of International exhaustion?



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