

## Chapter 5

# FASHION WASTE, TRADEMARK PROTECTION AND THE CIRCULAR ECONOMY: TOWARDS A NEW PUBLIC DOMAIN FOR SUSTAINABLE REUSE

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### Abstract

Traditionally, the debate on trademark law and the public domain has focused on the strategic use of trademark law to artificially prolong exclusive rights after the expiry of protection in intellectual property systems with a limited term, and the grant of trademark rights covering public domain material, such as cultural signs and traditional cultural expressions. While the glamorous world of fashion offers examples of protection term extension and public domain re-appropriation cases, the following analysis focuses on a relatively new phenomenon that can be placed in a public domain context. Considering the urgent need for measures to enhance legal certainty for sustainable fashion reuse in the circular economy, the question arises whether the time has come to discuss a limitation of trademark rights and a corresponding broadening of the public domain. More concretely, it seems tempting to establish a new public domain by giving second hand and unsold fashion items the status of freely available resources for sustainable upcycling and reuse in the circular economy—even if these fashion items bear protected third-party brand insignia. Exploring options for the practical implementation of this new public domain space, the analysis will yield the insight that the termination of trademark rights is beyond reach. Alternatively, however, lawmakers and judges could consider introducing a robust principle of free reuse that shields initiatives leading to the sustainable reuse of trademarked fashion items effectively against allegations of trademark infringement.

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### Introduction

With rapid product cycles—new collections each season—the fashion industry produces a highly problematic fashion garbage heap every year.<sup>1</sup> Circular economy projects seeking to produce “new”

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<sup>1</sup> A. Riches (2022), “The Fashion Industry Is Not as ‘Green’ as It Would like You to Believe”, *Duke Environmental Law and Policy Forum* 33, 83 (84-86); A. Elia (2020), “Fashion’s destruction of unsold goods: responsible solutions for an environmentally conscious future”, *Fordham Intellectual Property, Media & Entertainment Law Journal* 30, 539 (541-551); E. Teibel (2019), “Waste Size: The Skinny on the Environmental Costs of the Fashion Industry”, *William and Mary Environmental Law and Policy Review* 43, 595 (597-598).

garments by reworking second hand and unsold fashion items have particular societal value against this background. The legal framework in the EU, for instance, explicitly recognizes the importance of environmental protection projects in Article 37 of the EU Charter of Fundamental Rights (“CFR”):<sup>2</sup>

[a] high level of environmental protection and the improvement of the quality of the environment must be integrated into the policies of the Union and ensured in accordance with the principle of sustainable development.<sup>3</sup>

Additional support for sustainable fashion reuse follows from the Circular Economy Action Plan,<sup>4</sup> which the European Commission adopted in 2020 as a pillar of the European Green Deal—Europe’s agenda for sustainable growth.<sup>5</sup> The Action Plan seeks to make the EU economy fit for a green future, strengthen its competitiveness whilst protecting the environment, and give new rights to consumers. An important element of the Action Plan is the objective to establish a legal framework that makes product policies more sustainable, in particular by enhancing the sustainability and reparability of goods in the European market.<sup>6</sup>

Evidently, legal solutions that support fashion reuse have particular relevance in the light of these goals. Initiatives, such as fashion upcycling,<sup>7</sup> add new value to worn pieces of clothing and contribute to the reduction of fashion waste.<sup>8</sup> Trademark protection of brand insignia displayed on fashion items, however, can pose particular difficulties. The more individual fashion elements and garment components enjoy trademark protection, the more legal obstacles arise. Sustainable reuse may trigger allegations of consumer confusion and unfair freeriding when fashion elements bearing third-party trademarks remain visible on “new” circular economy products made of fashion waste.<sup>9</sup>

Hence, it is important to assure fashion re-users that, as long as they do not specifically aim to mislead consumers or damage protected brand insignia,<sup>10</sup> they can rework trademarked fashion items without risking trademark infringement. Offering legal certainty, trademark law can support the sustainable reuse of fashion waste.<sup>11</sup> From this perspective, it makes sense to explore options for establishing a public domain that would make second hand and unsold fashion items available as raw materials for

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<sup>2</sup> Charter of Fundamental Rights of the European Union, *Official Journal of the European Communities* 2000 C 364, 1.

<sup>3</sup> Article 37 CFR.

<sup>4</sup> European Commission, Communication “A new Circular Economy Action Plan for a cleaner and more competitive Europe”, 11 March 2020, COM(2020) 98 final.

<sup>5</sup> European Commission, Communication “The European Green Deal”, 11 December 2019, COM/2019/640 final.

<sup>6</sup> European Commission, Communication “A new Circular Economy Action Plan For a cleaner and more competitive Europe”, 11 March 2020, COM(2020) 98 final, 7–9. Cf. A. Tischner/K. Stasiuk (2023), “Spare Parts, Repairs, Trade Marks and Consumer Understanding”, *International Review of Intellectual Property and Competition Law* 54, 26 (28); C. Vrendenburg (2023), “IE en de circulaire economie: stimulans of obstakel?”, *Nederlands Juristenblad* 2023, 971 (971–972).

<sup>7</sup> For a detailed description of different upcycling practices, see J.B. Schenerman (2020), “One Consumer’s Trash Is Another’s Treasure: Upcycling’s Place in Trademark Law”, *Cardozo Arts and Entertainment Law Journal* 38, 745 (755–762). Cf. N.Q. Dorenbosch (2022), “Upcycling – op het snijvlak van duurzaamheid en intellectuele eigendom”, *Intellectuele eigendom en reclamerecht*, 147 (147); T. Pihlajarinne, “Repairing and Re-Using From an Exclusive Rights Perspective – Towards Sustainable Lifespan as Part of a New Normal?”, in: O.-A. Rognstad/I.B. Ørstavik (eds.), *Intellectual Property and Sustainable Markets*, Cheltenham: Edward Elgar 2021, 81 (92–94); A. Bain (2020), “Dank’ Customs, Bootlegs, and Reworked Pieces”, *Journal of World Intellectual Property* 23, 375 (383–384).

<sup>8</sup> Elia, *supra* note 1, 576–577. See also the examples given by Schenerman, *supra* note 7, 755–762.

<sup>9</sup> M.R.F. Senftleben, “Fashion Upcycling and Trademark Infringement – A Circular Economy/Freedom of the Arts Approach”, in: D. Tan, *Fashion and Intellectual Property Law*, Cambridge: Cambridge University Press 2023, forthcoming, available at: <https://ssrn.com/abstract=4470873> (last visited on 31 July 2023), 1 (1).

<sup>10</sup> For a more detailed discussion of a template for this approach, see M.R.F. Senftleben (2020), *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity*, Alphen aan den Rijn: Wolters Kluwer, 432–450.

<sup>11</sup> Pihlajarinne, *supra* note 7, 97–100.

reuse even if these items bear third-party trademarks. A new public domain can offer a high degree of legal certainty and strong support for reuse initiatives. Instead of treating trademarked fashion items as special waste, a public domain approach would routinely place the activities of fashion re-users outside the scope of trademark rights. To lay groundwork for this approach, section 2 identifies the concept of “public domain” that seems most appropriate in this context. Section 3 discusses stumbling blocks in current trademark law that militate against the qualification of existing limitations of trademark rights as reliable user freedoms with public domain status. Section 4 explores avenues leading to a public domain for sustainable reuse. The concluding section 5 summarizes results. The EU trademark system—the Trade Mark Regulation (“EUTMR”) and the Trade Mark Directive (“TMD”)—will serve as a reference point for the discussion.<sup>12</sup>

## 1. Conceptual Contours of a New Public Domain

In literature, different concepts of “public domain” have arisen from reflections on the meaning and function of public domain material.<sup>13</sup> Providing an overview, Pam Samuelson distinguishes between definitions based on the legal status of public domain material, definitions including freedoms to use protected intellectual creations, and definitions focusing on the accessibility of information resources.<sup>14</sup> Legal status definitions typically require public domain material to be unencumbered by intellectual property rights. They focus on material that is ineligible for protection, or that no longer enjoys protection after the expiry of protection (section 2.1). Public domain definitions focusing on freedom of use, by contrast, allow the development of a broader concept. Instead of asking whether material is free from trademark rights altogether, they pose the question whether material can be used freely. The public domain includes robust user freedoms that are safeguarded irrespective of the existence of trademark protection. This approach takes into account the various limits set to trademark rights: inherent, conceptual limits following from the confinement of protection to use in trade and use as a trademark, limited exceptions in the sense of Article 17 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), and freedom of use following from the exhaustion of trademark rights after the first sale (section 2.2).

### 1.1. Legal Status Perspective

Under typical legal status definitions, in order for any sign used in sustainable reuse projects to be considered “public domain,” it must be completely unencumbered by intellectual property rights.<sup>15</sup> Evidently, this strict concept leaves little room for establishing a public domain. Awarding rights that may potentially last in eternity, trademark law transforms trademarked fashion items into special waste: as long as the trademark proprietor renews protection, these items are kept outside the public domain—understood in the sense of a reservoir of resources that are entirely free from intellectual property rights.

The only remaining question, then, is whether trademark protection for fashion items could be phased out to pave the way for free reuse in the circular economy. Evidently, this is a theoretical question. A new ground for revoking trademark protection because of sustainability goals could hardly be reconciled with existing international norms in the field of trademark law. As it would not fall within

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<sup>12</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (codification), *Official Journal of the European Union* 2017 L 154, 1; Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, *Official Journal of the European Union* 2015 L 336, 1.

<sup>13</sup> For a discussion of different conceptions of the public domain, see the contributions to L.M.C.R. Guibault and P.B. Hugenholtz (eds.), *The Future of the Public Domain – Identifying the Commons in Information Law*, The Hague (NL)/London (UK)/New York (USA), Kluwer Law International, 2006; J. Boyle (2003), “The Second Enclosure Movement and the Construction of the Public Domain”, *Law and Contemporary Problems* 66, 33; D. Lange (1981), “Recognizing the Public Domain”, *Law and Contemporary Problems* 44, 147; J. Litman (1990), “The Public Domain”, *Emory Law Journal* 39, 965.

<sup>14</sup> P. Samuelson (2006), “Enriching Discourse on Public Domains”, *Duke Law Journal* 55, 101 (145–154).

<sup>15</sup> Cf. S. Dusollier, “A Positive Status for the Public Domain”, in: D. Beldiman (ed.), *Innovation, Competition and Collaboration*, Cheltenham: Edward Elgar 2015, 135 (136–137).

the scope of Article 6quinquies(B) No. 2 of the Paris Convention (“PC”), it could hardly be invoked in cases of *telle quelle* protection.<sup>16</sup> As it does not presuppose the absence or loss of distinctiveness, it may also be deemed incompatible with the guarantee of indefinite renewal in Article 18 TRIPS and the description of protectable subject matter in Article 15 TRIPS. Therefore, the strict legal status approach—requiring the absence of trademark rights—does not provide a promising conceptual basis.

## 1.2. Freedom of Use Perspective

In contrast to the legal status perspective, public domain concepts focusing on freedom of use do not require that fashion items be entirely free from trademark rights. Besides material that is unencumbered by intellectual property rights, the freedom of use approach allows the consideration of areas of freedom that result from measures to keep certain forms of use outside the scope of the exclusive rights of the trademark proprietor. This approach allows the inclusion of freedoms that remain intact even though trademark rights exist.<sup>17</sup> The focus is on inherent limits of exclusive rights and defences that explicitly permit certain forms of unauthorized use.

More specifically, the freedom of use perspective requires an analysis of the interplay between inherent limits of exclusive rights as implicit safeguards of user freedoms and the development of defences as safeguards that are explicitly stated in trademark legislation.<sup>18</sup> This approach offers a broader arsenal of regulatory tools. To establish a public domain in the sense of the freedom of use perspective, however, it is necessary to neutralize trademark rights to a large extent. User freedoms must be particularly robust to justify their classification as a distinct public domain space. Public domain definitions accounting for freedom of use draw a boundary line between clear cases of freedom of use that can be seen as part of the public domain, and unclear cases that cannot be included. As Yochai Benkler explains, the freedom of use perspective of the public domain only includes “the range of uses of information that any person is privileged to make absent individualized facts that make a particular use by a particular person unprivileged.”<sup>19</sup> More concretely, the freedom of use approach only regards as public domain space:

the range of privileged uses that are “easy cases.” Uses of information commonly perceived as permissible absent special circumstances, such as a brief quotation in a critical review or lending a book to a friend, fall within the functional definition of the public domain. Uses that are privileged because of highly particularized facts would not fall within that definition.<sup>20</sup>

To establish a public domain in the sense of the freedom-of-use approach, the sustainable reuse of fashion items bearing third-party trademarks, therefore, must constitute an “easy case” that is generally deemed permissible. The rules governing fashion reuse in trademark law must delimit exclusive rights of brand owners in such a way that re-users need not fear the verdict of infringement. Inherent limits of protection and statutory defences must offer a high degree of legal certainty for fashion re-users.

## 2. Assessment of Existing Trademark Rules

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<sup>16</sup> For a more detailed discussion of this international protection mechanism, see W.L. Ng-Loy, “Absolute Bans on the Registration of Product Shape Marks – A Breach of International Law?”, in: I. Calboli/M.R.F. Senftleben (eds.) (2018), “The Protection of Non-Traditional Trademarks – Critical Perspectives”, Oxford: Oxford University Press, 147 (147-164); S.P. Ladas (1975), “Patents, Trademarks, and Related Rights – National and International Protection, Vol. II”, Cambridge, Massachusetts: Harvard University Press, 1211–1240; G.H.C. Bodenhausen (1969), “Guide to the Application of the Paris Convention for the Protection of Industrial Property”, Geneva: BIRPI, reprinted in: WIPO publication No. 611, Geneva: WIPO 2004, 113–119.

<sup>17</sup> Cf. Y. Benkler (1999), “Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain”, *New York University Law Review* 74, 354 (361–162).

<sup>18</sup> Cf. M.R.F. Senftleben (2013), “Public Domain Preservation in EU Trademark Law – A Model for Other Regions?”, *The Trademark Reporter* 103, No. 4, 775 (819); G.B. Dinwoodie (2009), “Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law”, *Lewis and Clark Law Review* 13/1, 99 (152).

<sup>19</sup> Benkler, *supra* note 17, 362.

<sup>20</sup> Benkler, *supra* note 17, 362–363.

Assessing the existing canon of trademark norms in the light of this latter public domain concept, it becomes clear that, in particular, inherent limits of trademark rights are less and less capable of providing robust safeguards against allegations of trademark infringement.<sup>21</sup> By definition, every expansion of trademark rights reduces the degree of legal certainty which inherent limits can offer. The more extensive and flexible the exclusive rights of trademark owners in advanced trademark systems, such as EU trademark law, the less efficient will be the safe harbour function of inherent limits (section 3.1). The assessment of statutory defences, however, need not yield much better results. The invocation of defences may require compliance with a complex set of requirements that makes it impossible to qualify sustainable reuse scenarios as “easy cases” in the sense of the freedom-of-use approach (section 3.2).

## 2.1 Gatekeeper Requirement of Use as a Trademark

Current EU trademark law can serve as an example of an advanced trademark system in which inherent limits of exclusive rights, such as the requirements of “use in the course of trade” and “use in relation to goods or services”<sup>22</sup> have lost much of their potential to discourage trademark infringement claims from the outset. In principle, these gatekeeper requirements could be understood to require “use as a trademark.” They may be applied to confine the scope of trademark rights to instances where another’s trademark is employed as an identifier of commercial source with regard to one’s own goods or services.<sup>23</sup> Following this approach, access to trademark protection in fashion reuse cases could be contained from the outset.<sup>24</sup> Trademark infringement claims would be doomed to fail as long as fashion re-users only make decorative use of fashion elements bearing third-party brand insignia and refrain from including third-party trademarks as indications of the commercial origin of their own products.

Instead of adopting this approach, however, the Court of Justice of the European Union (“CJEU”) opted for a much less efficient use of available gatekeeper criteria.<sup>25</sup> In *BMW/Deenik*, the Court concluded that use for the purpose of informing the public about repair and maintenance services offered with regard to trademarked products satisfied the criterion of “use in relation to goods or services” —even though Deenik had not used the trademark BMW to pass off his second-hand cars and repair services as offers stemming from BMW. In advertising, Deenik had merely referred to BMW as the owner of the car brand that was central to his own activities.<sup>26</sup> The CJEU also qualified use in comparative advertising as use in relation to goods or services on the ground that the advertiser made use of a competitor’s trademark to distinguish her own products from those of the competitor.<sup>27</sup>

Summarizing the current, broad notion of “use in relation to goods or services,” the Court stated that to satisfy this precondition for an infringement action, it was sufficient that a link was established with goods or services. This formula can also be found in the fashion-related *Céline* decision where the Court held with regard to the interface between trademark and trade name rights that once a link was established between the company, trade or shop name and the goods or services offered by the alleged infringer, trademark use in relation to goods or services could no longer be denied—even where the name was not affixed to marketed goods as such.<sup>28</sup> The formula of a link with goods or services, then, became established case law in later decisions dealing with keyword advertising. In *Google France*

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<sup>21</sup> Dinwoodie, *supra* note 18, 152.

<sup>22</sup> Article 9(2) EUTMR; Article 10(2) TMD.

<sup>23</sup> CJEU, 25 January 2007, case C-48/05, *Opel/Autec*, para. 24, pointed in this direction. The course adopted in this judgment, however, was not followed in further decisions.

<sup>24</sup> G.B. Dinwoodie/M.D. Janis (2007), “Confusion Over Use: Contextualism in Trademark Law”, *Iowa Law Review* 92, 1597 (1599–1600); S.L. Dogan/M.A. Lemley (2004), “Trademarks and Consumer Search Costs on the Internet”, *Houston Law Review* 41, 777 (809–811).

<sup>25</sup> Cf. A. Kur (2008), „Confusion over Use? – Die Benutzung ‚als Marke‘ im Lichte der EuGH-Rechtsprechung“, *Gewerblicher Rechtsschutz und Urheberrecht – International* 2008, 1 (1–11).

<sup>26</sup> CJEU, 23 February 1999, case C-63/97, *BMW/Deenik*, para. 42.

<sup>27</sup> CJEU, 12 June 2008, case C-533/06, *O2/Hutchison*, para. 35–36.

<sup>28</sup> CJEU, 11 September 2007, case C-17/06, *Céline*, para. 23.

and Google, the CJEU confirmed that relevant use in relation to goods or services existed “in any event” where a third party used a conflicting sign in such a way that a link was established between that sign and the goods or services offered by the third party.<sup>29</sup> In *L’Oréal/eBay*, the Court found that the criterion of a link was satisfied because eBay’s advertisements created “an obvious association between the trade-marked goods which are mentioned in the advertisements and the possibility of buying those goods through eBay.”<sup>30</sup> The CJEU thus adopted a low threshold requirement with regard to the connection with goods or service: a mere “link” or “association” is sufficient.<sup>31</sup>

As a result, the gatekeeper criterion of use as a trademark does not prevent a trademark claim against references to the trademark that are only made to identify goods or services as those of the trademark owner and are not perceived by the public as indications of commercial source. The CJEU has brought several forms of referential use—references to the trademark as being the distinctive sign of the trademark owner—within the scope of EU trademark rights.<sup>32</sup> This elastic interpretation can have a deep impact on the reuse of fashion waste. In the absence of a strict requirement of use as a trademark—understood in the sense of use for the purpose of identifying and distinguishing the goods of the fashion re-user—the threshold criterion of use as a trademark loses its gatekeeper function.<sup>33</sup> The moment a mere link with trademarked fashion elements is sufficient to bring unauthorized use within the scope of trademark rights, a clear boundary line between non-actionable, decorative use and actionable, source-identifying use as a trademark is missing.<sup>34</sup> The mere use of a trademark in some relation to a circular economy product can already serve as a starting point for an infringement claim.

In the EU, fashion re-users are thus exposed to confusion and dilution claims that cannot be dismissed as evidently unfounded from the outset. The trademark owner can establish *prima facie* infringement by arguing that the display of brand insignia on circular economy products is confusing because it indicates a commercial connection with the trademark owner.<sup>35</sup> A confusion claim may also be based on post-sale confusion. Even if the true commercial origin is clearly indicated at the point of sale, the trademark owner may argue that confusion may arise once the purchaser leaves the store. The public seeing the goods outside may misinterpret third-party trademarks as indications of commercial source.<sup>36</sup> The trademark proprietor may also argue that use on circular economy products constitutes unfair freeriding because it exploits the positive image evoked by the third-party brand.<sup>37</sup> In the case of marks with a reputation,<sup>38</sup> this line of argument seems promising. In *L’Oréal/Bellure*, the CJEU confirmed that, in contrast to blurring and tarnishment, the freeriding branch of the EU dilution

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<sup>29</sup> CJEU, 23 March 2010, C-236/08-238/08, *Google France and Google*, para. 72; CJEU, 12 July 2011, case C-324/09, *L’Oréal/eBay*, para. 92; CJEU, 19 February 2009, C-62/08, *UDV North America*, para. 47–48.

<sup>30</sup> CJEU, 12 July 2011, case C-324/09, *L’Oréal/eBay*, para. 93.

<sup>31</sup> As to the debate on this development, see the summary in R. Knaak/A. Kur/A. von Mühlendahl (2011), “Study on the Functioning of the European Trade Mark System”, *Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 12–13*, Munich: Max Planck Institute, para. 2.178, available at [http://ec.europa.eu/internal\\_market/indprop/tm/index\\_en.htm](http://ec.europa.eu/internal_market/indprop/tm/index_en.htm) (last visited on 31 July 2023).

<sup>32</sup> Cf. A. Kur/M.R.F. Senftleben, *European Trade Mark Law – A Commentary*, Oxford: Oxford University Press 2017, para. 5.50–5.54.

<sup>33</sup> Kur/Senftleben, *supra* note 32, para. 5.14–5.15 and 5.49–5.56.

<sup>34</sup> Cf. I. Simon Fhima (2006), “Embellishment: Trademark Use Triumph or Decorative Disaster?”, *European Intellectual Property Review* 28, 321 (321); Kur, *supra* note 25, 12.

<sup>35</sup> CJEU, 10 April 2008, case C-102/07, *Adidas/Marca*, para. 30–34. As to the broad concept of confusion in modern trademark law, cf. Tischner/Stasiuk, *supra* note 6, 35–36; Dorenbosch, *supra* note 7, 148–149; A.M. Keats (2020), “Trendy Product Upcycling: Permissible Recycling or Impermissible Commercial Hitchhiking?”, *The Trademark Reporter* 110, 712 (713–714 and 718–719); M.A. Lemley/M.P. McKenna (2010), “Irrelevant Confusion”, *Stanford Law Review* 62, 413 (414–422).

<sup>36</sup> CJEU, 12 November 2002, case C-206/01, *Arsenal/Reed*, para. 57. Cf. Dorenbosch, *supra* note 7, 148–149; Schenerman, *supra* note 7, 766–767 and 778–79; Kur/Senftleben, *supra* note 32, para. 5.131–5.146.

<sup>37</sup> CJEU, 18 June 2009, case C-487/07, *L’Oréal/Bellure*, para. 49. Cf. Tischner/Stasiuk, *supra* note 6, 38–39. As to the additional risk of tarnishing that may arise under specific circumstances, see Keats, *supra* note 35, 719–720.

<sup>38</sup> For a comparison of this EU concept with the approach taken in the US, see M.R.F. Senftleben (2009), “The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law”, *International Review of Intellectual Property and Competition Law* 40, 45 (50–55).

doctrine does not require proof of damage<sup>39</sup>—in the sense of providing evidence of a change in the economic behaviour of the average consumer.<sup>40</sup>

The inherent limits of exclusive trademark rights in EU trademark law, thus, are no longer robust enough to preserve an area of freedom that could legitimately be regarded as part of the public domain. User freedoms for the sustainable reworking of trademarked fashion items that may result from the requirements of use as a trademark, use likely to cause confusion and use likely to cause dilution are no longer “easy cases” in the sense of public domain definitions that include robust use freedoms. Instead, the doors to trademark infringement claims are wide open.<sup>41</sup>

## 2.2. *Statutory Defences*

EU trademark law also shows how existing defences against trademark infringement claims can be deprived of their potential to create reliable breathing space for sustainable reuse. Considering the specific context in which the use takes place—the reuse of fashion items that have previously been sold with the consent of the trademark proprietor—the exhaustion of trademark rights after the first sale immediately comes to mind.<sup>42</sup> Evidently, it is tempting to jump to the conclusion that the use of second-hand clothes in the circular economy does not amount to infringement because of exhaustion. The crux, however, lies in the focus on the resale of goods in the specific form in which they have been marketed by the trademark owner. Changes can render the exhaustion doctrine inapplicable.<sup>43</sup> More specifically, Article 15(2) TMD and Article 15(2) EUTMR stipulate that exhaustion shall not occur:

where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.<sup>44</sup>

This configuration of the exhaustion rule renders the doctrine inapplicable in many fashion reuse scenarios. For instance, changes to the goods are inherent in the concept of “upcycling.” The Merriam-Webster Dictionary defines “upcycling” as the act of “recycl[ing] (something) in such a way that the resulting product is of a higher value than the original item: to create an object of greater value from (a discarded object of lesser value).”<sup>45</sup> Wikipedia describes upcycling as “the process of transforming by-products, waste materials, useless, or unwanted products into new materials or products perceived to be of greater quality, such as artistic value or environmental value.”<sup>46</sup> Obviously, the transformation of pre-existing source materials, such as second-hand clothing in the case of fashion upcycling, lies at the core of upcycling initiatives. As a result, trademark proprietors will often have the opportunity to rebut exhaustion arguments by pointing out that the condition of the goods has been changed or that elements of the original goods have become part of new and different, upcycled goods.<sup>47</sup>

These counterarguments need not always have success. As indicated above, the EU exhaustion rule requires that the trademark proprietor have a “legitimate reason” for opposing the further

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<sup>39</sup> CJEU, 18 June 2009, case C-487/07, *L’Oréal/Bellure*, para. 30 and 47–49.

<sup>40</sup> CJEU, 27 November 2008, case C-252/07, *Intel/CPM*, para. 77; CJEU, 14 November 2013, case C-383/12 P, *Environmental Manufacturing/Elmar Wolf*, para. 37 and 43.

<sup>41</sup> Senftleben, *supra* note 10, 156–170.

<sup>42</sup> Article 15(1) TMD; Article 15(1) EUTMR.

<sup>43</sup> Dorenbosch, *supra* note 7, 148.

<sup>44</sup> Article 15(2) TMD; Article 15(2) EUTMR.

<sup>45</sup> See <https://www.merriam-webster.com/dictionary/upcycle> (last visited on 31 July 2023). Cf. Dorenbosch, *supra* note 7, 147; M.R.F. Senftleben (2022), “Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law”, *International Review of Intellectual Property and Competition Law* 53, 567 (572); Bain, *supra* note 7, 383; Keats, *supra* note 35, 712; Teibel, *supra* note 1, 624–625.

<sup>46</sup> See <https://nl.wikipedia.org/wiki/Upcycling> (last visited on 31 July 2023).

<sup>47</sup> Dorenbosch, *supra* note 7, 148–149; A. Kur (2021), “As Good as New – Sale of Repaired or Refurbished Goods: Commendable Practice or Trade Mark Infringement?”, *Gewerblicher Rechtsschutz und Urheberrecht - International* 70, 228 (232–233); Keats, *supra* note 35, 715–716.

commercialization of the goods after the first sale. Considering the societal interest in a circular economy, it is conceivable to declare arguments based on the change/transformation of goods illegitimate from the outset unless the trademark proprietor manages to substantiate an unusual necessity to oppose the commercialization of products containing reworked brand insignia. For instance, the trademark proprietor could be obliged to produce evidence of use that deliberately aims at misleading consumers, damaging the mark, denigrating the business of the trademark proprietor etc.<sup>48</sup> This approach could be based on the aforementioned Article 37 CFR and the European Commission's Circular Economy Action Plan.<sup>49</sup>

Nonetheless, doubts about the robustness of this solution remain. Even if particular importance is attached to the objective to protect the environment and support sustainable development, it must not be overlooked that the protection of intellectual property also enjoys protection under the EU Charter of Fundamental Rights. Article 17(2) CFR explicitly offers protection for intellectual property rights under the umbrella of the right to property.<sup>50</sup> The environmental protection clause in Article 37 CFR, thus, does not constitute a *carte blanche* for overriding trademark rules. By contrast, it follows from Article 52(1) CFR that limitations of the trademark proprietor's right to property are subject to the principle of proportionality. While Article 37 CFR shows clearly that environmental protection constitutes an objective of general interest in the EU, this interest must be weighed against the trademark proprietor's interest in trademark protection and the broader societal interest in a well-functioning trademark system.<sup>51</sup> According to the above-described rules of EU trademark law, a change of the condition of branded goods is a standard scenario in which the trademark proprietor has the opportunity to oppose the resale of goods on the basis of the exhaustion doctrine. While the societal goal of environmental protection and sustainable development supports the position of fashion re-users in trademark infringement procedures, it is unclear whether this overarching objective, which has found its way into Article 37 CFR, will allow re-users to prevail routinely in infringement cases.<sup>52</sup> In other words: it is doubtful that attempts to recalibrate the exhaustion rule will lead to an "easy case" in the sense of the freedom-of-use approach to the public domain.

Therefore, it is important to look beyond the exhaustion rule and assess the potential of other defences that may be capable of providing more legal certainty. EU trademark law contains additional limitations of exclusive rights that may support circular economy projects. Article 14(1)(b) TMD and Article 14(1)(b) EUTMR permit the unauthorized use of:

signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services.

Arguably, the inclusion of trademarked fashion elements in circular economy products can constitute permissible descriptive use in the sense of this provision. As long as consumers do not perceive a third-party trademark as an indication of commercial source, it is conceivable to qualify the use as non-distinctive or descriptive: reworked fashion elements bearing third-party trademarks appear as mere embellishments. They may also be qualified as indications of a specific product characteristic:

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<sup>48</sup> Cf. CJEU, 17 March 2005, case C-228/03, *Gillette*, para. 42–45.

<sup>49</sup> European Commission, Communication "A new Circular Economy Action Plan for a Cleaner and More Competitive Europe", 11 March 2020, COM(2020) 98 final, 7–9. Cf. Tischner/Stasiuk, *supra* note 6, 28; Vrendenburg, *supra* note 6, 971–972; European Commission, Communication "The European Green Deal", 11 December 2019, COM/2019/640 final.

<sup>50</sup> For a more detailed discussion of this provision, see J. Griffiths/L. McDonagh (2013), "Fundamental Rights and European IP Law – the Case of Art 17(2) of the EU Charter", in: C. Geiger (ed.), *Constructing European Intellectual Property Achievements and New Perspectives*, Cheltenham: Edward Elgar, 75; C. Geiger (2009), "Intellectual Property Shall be Protected!? Article 17(2) of the Charter of Fundamental Rights of the European Union: A Mysterious Provision With an Unclear Scope", *European Intellectual Property Review* 31, 113.

<sup>51</sup> For an overview of the rationales of trademark protection, see Kur/Senftleben, *supra* note 32, para. 1.06–1.15.

<sup>52</sup> Bain, *supra* note 7, 402–403.



the fact that the product contains reworked fashion components stemming from second hand or unsold garments.<sup>53</sup>

The success of this decorative use argument, however, is unclear. CJEU jurisprudence indicates that the descriptive use defence is unavailable when a third-party trademark becomes a central element of the very contents of a product. Decorative use of this nature is unlikely to fall within the scope of the descriptive use concept.<sup>54</sup> As the CJEU concluded in *Adidas/Marca*—a case about allegedly infringing use of decorative elements similar to the famous three stripes logo—the use of a two-stripe motif on sports clothing “is not intended to give an indication concerning one of the characteristics of those goods.”<sup>55</sup> Constituting design features, the stripes were not intended to indicate the characteristics of the sports and leisure garments.<sup>56</sup> Similarly, the Court denied descriptive use in *Opel/Autec* on the ground that the faithful reproduction of the Opel logo on a scale model car could not be regarded as an indication of product characteristics. Instead, the logo became part of the product itself.<sup>57</sup>

Quite clearly, this case law may render the descriptive use defence inapplicable in fashion reuse cases. It is an open question whether the Court is willing to give the second branch of Article 14(1)(b) TMD—the non-distinctive use defence—an independent meaning in circular economy contexts. The reference to signs or indications “which are not distinctive” in Article 14(1)(b) TMD is the result of the 2015 trademark law reform. It extends the scope of the traditional descriptive use concept to non-distinctive signs and indications. Theoretically, it is possible to qualify the inclusion of third-party trademarks in circular economy products as a form of non-distinctive use.<sup>58</sup> Arguable, third-party brand insignia only serve non-distinctive, decorative purposes in this specific scenario. They are not intended to indicate the commercial source of the product. The CJEU, however, has not clarified the concept of “which are not distinctive” yet.<sup>59</sup> In particular, it remains unclear whether a sign that actually enjoys trademark protection could ever be found non-distinctive in certain contexts, such as the particular circumstances arising from fashion reuse. Again, the evolution of an “easy case” status in the sense of public domain concepts that include robust user freedoms seems doubtful.

In light of these legal uncertainties surrounding descriptive and non-distinctive use arguments, it is important to explore the referential use defence. Article 14(1)(c) TMD and Article 14(1)(c) EUTMR define referential use as use “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark.” For instance, a parody using a trademark to symbolize and criticize policies of the trademark proprietor may fall within the scope of the referential use defence.<sup>60</sup> Arguably, the display of trademarked fashion elements on circular economy products can also fall within the scope of the referential use defence. Offering reworked fashion products with third-party trademarks, fashion re-users make a critical statement on the wasteful use of resources in the fashion industry.<sup>61</sup> Reworked fashion elements bearing third-party trademarks make the use of second-hand or unsold source material visible to consumers and enable them to understand the circular economy product as an exponent of an alternative, different approach: as a harbinger of an indispensable change of course in the fashion industry. Evidently, the message emanating from the sustainable reuse of trademarked fashion items carries particular weight in the current environmental crisis. It reflects the

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<sup>53</sup> Pihlajarinne, *supra* note 7, 95–98; Senftleben, *supra* note 10, 158–161.

<sup>54</sup> Kur/Senftleben, *supra* note 32, para. 6.23–6.27.

<sup>55</sup> CJEU, 10 April 2008, case C-102/07, *Adidas/Marca*, para. 48.

<sup>56</sup> CJEU, *id.*, para. 48.

<sup>57</sup> CJEU, 25 January 2007, case C-48/05, *Adam Opel/Autec*, para. 44.

<sup>58</sup> Cf. Tischner/Stasiuk, *supra* note 6, 39–40.

<sup>59</sup> For a more detailed discussion of the field of application of this defence, see Senftleben, *supra* note 10, 510–512; A. Kur (2018), “Yellow Dictionaries, Red Banking Services, Some Candies, and a Sitting Bunny: Protection of Color and Shape Marks from a German and European Perspective”, in: I. Calboli/M.R.F. Senftleben (eds.), “The Protection of Non-Traditional Trademarks – Critical Perspectives”, *Oxford: Oxford University Press*, 89 (101).

<sup>60</sup> Senftleben, *supra* note 45, 581–582. For non-infringement arguments based on a parallel between parody cases and upcycling, see Schenerman, *supra* note 7, 772–775.

<sup>61</sup> Senftleben, *supra* note 9, 9–14. Cf. Bain, *supra* note 7, 389.

need for strategies to reduce fashion waste and change production and consumption patterns.<sup>62</sup> Therefore, the overarching societal objective to attain environmental sustainability strongly supports an interpretation of the referential use concept that allows fashion re-users to rely on this defence argument to rebut infringement claims. Rightly understood, sustainable fashion reuse constitutes a legitimate form of use for the purpose of identifying and referring to reworked fashion products as those of the trademark proprietor. As a socially desirable and particularly important form of referential use, it falls within the scope of Article 14(1)(c) TMD and Article 14(1)(c) EUTMR.

This outcome of the inquiry, however, is not sufficient to give the all-clear and declare fashion reuse an “easy case” in the sense of public domain concepts including robust freedom of use. EU trademark law poses additional hurdles. The invocation of limitations of exclusive rights, such as the referential use defence, depends on compliance with honest practices in industrial or commercial matters. This additional, open-ended prerequisite follows from Article 14(2) TMD and Article 14(2) EUTMR. Before jumping to the conclusion that EU trademark law offers sufficiently strong defence arguments, it is necessary to explore this open-ended proviso.<sup>63</sup>

Unfortunately, the requirement of honest practices can pose substantial difficulties. The CJEU tends to determine compliance with honesty in industrial and commercial matters on the basis of the same criteria that inform the analysis of *prima facie* infringement in trademark confusion and dilution cases.<sup>64</sup> This jurisprudence has led to concerns that the inquiry into honest practices may ignore competing societal values underpinning statutory limitations of exclusive rights.<sup>65</sup> Instead of shaping the honest practices test in a way that offers room for competing policy objectives, the CJEU simply replicates standard criteria of the trademark infringement analysis.<sup>66</sup> In *Gillette*, for instance, the Court held that use would fail to comply with honest practices in industrial and commercial matters if:

- it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner;
- it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute;
- it entails the discrediting or denigration of that mark;
- or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner.<sup>67</sup>

While some of these assessment factors can be traced back to EU legislation in the field of comparative advertising,<sup>68</sup> the prohibition of use that gives the impression of a commercial connection with the trademark owner, and the ban on use that damages or takes unfair advantage of the mark’s distinctive character or repute, correspond to infringement criteria in the field of trademark protection against confusion and dilution.<sup>69</sup> The risk of circularity is obvious: by copying almost literally the criteria for establishing *prima facie* infringement, the CJEU subjects defences to additional scrutiny in the light of the same criteria that enabled the trademark owner to bring the infringement claim in the first place. This circular line of reasoning may render defence arguments, such as referential use, moot

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<sup>62</sup> Senftleben, *supra* note 9, 13–17.

<sup>63</sup> Article 14(2) TMD; Article 14(2) EUTMR.

<sup>64</sup> Kur/Senftleben, *supra* note 32, para. 6.73; M.R.F. Senftleben/L. Bently/G.B. Dinwoodie et al. (2015), ‘The Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition: Guiding Principles for the Further Development of EU Trade Mark Law’, *European Intellectual Property Review* 37, 337 (339); I. Simon Fhima (2012), ‘The Role of Legitimacy in Trade Mark Law’, *Current Legal Problems* 65, 489 (501–502).

<sup>65</sup> Senftleben, *supra* note 10, 588–590.

<sup>66</sup> Cf. Kur/Senftleben, *supra* note 32, para. 1.06–1.15.

<sup>67</sup> CJEU, 17 March 2005, case C-228/03, *Gillette/LA-Laboratories*, para. 49.

<sup>68</sup> Article 4(d), (f), (g) and (h) of Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 Concerning Misleading and Comparative Advertising (codified version), *Official Journal of the European Communities* 2006 L 376, 21. Cf. Kur/Senftleben, *supra* note 32, para. 6.72.

<sup>69</sup> Article 9(2)(b) and (c) EUTMR; Article 10(2)(b) and (c) TMD.

in practice.<sup>70</sup> In the keyword advertising case *Portakabin*, for instance, the Court did not find it contradictory to conclude that:

the circumstances under which a trade mark proprietor is, pursuant to Article 5(1) of Directive 89/104 [nowadays Article 10(2)(a) TMD], entitled to prevent an advertiser from using a sign identical with, or similar to, that trade mark as a keyword may [...] easily correspond to a situation in which the advertiser cannot claim that it is acting in accordance with honest practices in industrial or commercial matters, and cannot therefore validly rely on the exception...<sup>71</sup> (comment within brackets added)

The corrosive effect of this circular approach on defence arguments that could support the sustainable reuse of trademarked fashion items is evident. Following the current CJEU approach, the same findings that have led to the verdict of *prima facie* infringement support the denial of compliance with honest practices. In consequence, the requirement of use in accordance with honest practices in industrial or commercial matters degenerates into a torpedo which the trademark proprietor can employ to neutralize referential use arguments that support the activities of fashion re-users. The symmetry of criteria for assessing *prima facie* infringement and determining honesty in industrial and commercial matters can easily lead to a situation where a finding of a likelihood of confusion or unfair freeriding already foreshadows a finding of dishonest practices. Once again, an “easy case” that forms part of a public domain of robust user freedoms is sought in vain.

### 3. Towards a New Public Domain

The foregoing analysis shows clearly that current limitations of trademark rights in the EU—inherent limits as well as statutory defences—can hardly be deemed robust enough. The CJEU ruling in *Adidas/Fitnessworld* illustrates the status quo reached in EU trademark law. The CJEU held in this case that decorative use of a sign similar to a protected mark—as *Adidas/Marca*, the case concerned Adidas’ three stripes trademark—may already be sufficient to trigger protection against dilution.<sup>72</sup> A mere link with the trademark—in the sense of use that calls to mind the protected sign—may be deemed actionable in accordance with this assessment standard.<sup>73</sup> An elastic concept of actionable use also prevails in the context of protection against confusion. In *Adidas/Marca*, the CJEU held that the public’s perception that a sign is a decoration could not constitute a restriction on anti-confusion claims when, despite its decorative nature, the sign used by the alleged infringer was so similar to the trademark that the relevant public may assume an economic link with the trademark owner.<sup>74</sup>

The decision on actionable use as a trademark and potential infringement in fashion reuse cases, thus, depends on the marketing efforts of the trademark proprietor and the resulting degree of trademark recognition.<sup>75</sup> Even if third-party trademarks serve decorative purposes and do not constitute an indication of commercial origin, trademark proprietors may have success in arguing that a connection with their protected signs is established in the minds of consumers that amounts to infringement. Investing heavily in advertising campaigns that educate consumers to establish a link whenever they see a similar sign, the trademark owner can shape consumer perception in a way that enhances the chances of proving *prima facie* infringement.

This approach leads to a bias in favour of the trademark owner who can increase the success rate of infringement claims against fashion re-users by investing in the recognition of brand insignia applied to fashion products. To change the equation and arrive at an “easy case” status that makes it possible to speak of a public domain, it would be necessary to shape the trademark infringement analysis in a way that achieves the opposite result: a bias in favour of fashion re-users who rework trademarked

<sup>70</sup> Cf. *Kur/Senftleben*, *supra* note 32, para. 6.73. See also the literature reference, *supra* note 64.

<sup>71</sup> CJEU, 8 July 2010, C-558/08, *Portakabin*, para. 69.

<sup>72</sup> CJEU, 23 October 2003, case C-408/01, *Adidas/Fitnessworld*, para. 39.

<sup>73</sup> German Federal Court of Justice, 3 February 2005, case I ZR 159/02, ‘Lila Postkarte’, *Gewerblicher Rechtsschutz und Urheberrecht* 2005, 583 (584).

<sup>74</sup> CJEU, 10 April 2008, case C-102/07, *Adidas/Marca*, para. 34.

<sup>75</sup> German Federal Court of Justice, 24 November 2011, case I ZR 175/09, “Medusa”, para. 23.

fashion items in the context of circular economy initiatives. As the above discussion of public domain concepts has shown, the sustainable reuse of trademarked fashion items would have to constitute a case that is commonly deemed non-actionable unless there are “individualized facts that make a particular use by a particular person unprivileged.”<sup>76</sup>

To achieve this result, the gatekeeper requirement of use as a trademark could be recalibrated. Instead of asking whether fashion products in the circular economy call to mind a sign which the public recognizes as a third-party trademark, it should be decisive that the public understands that the trademark has become part of a “new” product consisting of reworked fashion items that served as raw materials. This finding should tip the scales in favour of the fashion re-user in the circular economy and reverse the burden of proof (section 4.1).<sup>77</sup> Alternatively,<sup>78</sup> it could be considered to introduce a more robust referential use defence that shields fashion reuse more reliably against the verdict of infringement by positing that fashion reuse, presumably, constitutes permissible, decorative use. This referential use approach, however, is weaker and offers less legal certainty than an approach based on the upfront denial of relevant use as a trademark (section 4.2).<sup>79</sup>

### 3.1 *Easy Case Because No Use as a Mark*

To implement the first approach—an upfront test of use as a mark that prevents the trademark owner from establishing *prima facie* infringement—the work of Stacey Dogan and Mark Lemley can serve as a source of inspiration. They propose trademark claims be limited from the outset to situations where the alleged infringer deliberately uses another’s mark to market her own goods or services:

[L]imiting trademark rights to a right to prevent confusing uses of the mark as a brand helps to ensure that trademark rights remain tied to their search costs rationale – only those individuals or companies who are using the mark to advertise their own products or services have the motive and opportunity to interfere with the clarity of the mark’s meaning in conveying product information to consumers, and so only those uses ought to be of concern to trademark law.<sup>80</sup>

The benefits of this approach for fashion re-users in the circular economy are obvious. A trademark use requirement with this configuration focuses on instances of “misleading branding.”<sup>81</sup> Dogan and Lemley understand their trademark use concept to cover only “those who themselves use marks in a way that suggests some affiliation between themselves and the trademark holder.”<sup>82</sup> The central point here is the behaviour of the fashion re-user. As long as the fashion re-user does not deliberately employ a third-party trademark to mislead consumers, the use should be qualified as purely decorative: a form of use that does not constitute actionable use as a trademark.

This approach offers the chance of recalibrating the *Adidas/Marca* approach. As discussed, the CJEU saw the risk that, despite a decorative context, the consuming public may assume an economic link with the trademark owner if the degree of similarity between the decorative sign and the registered trademark was high.<sup>83</sup> The CJEU concluded that the appreciation of a likelihood of confusion in the case of decorative use depended

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<sup>76</sup> Benkler, *supra* note 17, 362–363.

<sup>77</sup> For a similar approach in EU trademark law, see Article 9(3)(f) EUTMR and Article 10(3)(f) TMD. Cf. Senftleben, *supra* note 45, 568–570; Pihlajarinne, *supra* note 7, 98–100.

<sup>78</sup> For a critique of the trademark use approach creating legal certainty upfront, see Dinwoodie/Janis, *supra* note 24, 1599–1600. However, see also the counterarguments focusing on the merits of this approach discussed by Senftleben, *supra* note 10, 469–474.

<sup>79</sup> Senftleben, *supra* note 10, 474–476.

<sup>80</sup> Dogan/Lemley, *supra* note 24, 798.

<sup>81</sup> S.L. Dogan/M.A. Lemley (2008), “The Trademark Use Requirement in Dilution Cases”, *Santa Clara Computer & High Technology Law Journal* 24, 541 (542, 555); Cf. Senftleben, *supra* note 10, 429–431.

<sup>82</sup> Dogan/Lemley, *supra* note 24, 799.

<sup>83</sup> CJEU, 10 April 2008, case C-102/07, *Adidas/Marca*, para. 34.

not solely on the degree of similarity between the trade mark and the sign, but also on the ease with which the sign may be associated with the mark having regard, in particular, to the recognition of the latter on the market.<sup>84</sup>

Obviously, the mechanical reliance on the degree of trademark recognition as a yardstick for identifying actionable trademark use neglects the individual context in which the use takes place. Instead of aligning the test of trademark use with the degree of trademark recognition, the decorative context arising from the reworking of fashion items in the circular economy should play a decisive role. When the fashion re-user ensures that consumers become aware of the specific circular economy context and the use of second hand or unsold fashion items as raw materials for “new” sustainable products, use with trademark relevance should be denied from the outset. The trademark use concept that has evolved in Australia can serve as a reference point in this regard. As Michael Handler explains, a judgment in the light of the specific use context should be made:

by reference to likely consumer reaction, taking into account the particular manner and context of the defendant’s use. The converse of the trademark use requirement is that other types of use, such as nominative, descriptive, or decorative use, will not infringe.<sup>85</sup>

Hence, the individual circumstances and behaviour—“the particular manner and context” —should play a decisive role. If an allegedly infringing use is made in connection with the reworking of fashion items bearing third-party trademarks, this specific context should allow the fashion re-user to escape the verdict of actionable use as a trademark even if the reuse concerns a sign which consumers can easily recognize as a trademark. The decorative use may still call to mind the trademark. Nonetheless, the specific circular economy context—a trademarked fashion item receiving a second life—should prevent a finding of actionable use as a trademark.

Dogan and Lemley come close to this result when they propose to focus attention on the “non-branding way”<sup>86</sup> of use. Hence, an approach focusing on the circular economy context surrounding the fashion reuse seems capable of creating an “easy case” and offering fashion re-users sufficient legal certainty. The trademark owner may emphasize that consumers are likely to see not only a decorative element but also an indicator of commercial source. However, this argument no longer tips the scales in favour of a finding of actionable use as a mark. Once the decorative nature of the use and the specific context arising from the reworking of fashion items in the circular economy are the kingpin of the analysis, it becomes possible to arrive at a general presumption of non-infringement and an effective shield against trademark infringement claims: presumably, reuse of a trademarked fashion item in the circular economy does not amount to trademark infringement.

At the level of policy considerations, it can be posited that, as a rule, the public interest in the reduction of fashion waste and the protection of the environment must prevail over the trademark proprietor’s protection interests when a trademarked fashion item is reworked in the circular economy. This is only different in the exceptional situation where the fashion re-user deliberately uses the third-party trademark to mislead consumers about the commercial origin or specifically aims at damaging or exploiting the trademark’s distinctiveness and repute. As explained, the adoption of this legal presumption seeks to introduce a bias in favour of fashion re-users. In confusion as well as dilution contexts, the legal presumption of non-actionable use is intended to pose a hurdle which the trademark owner must first surmount before she can bring a claim against fashion reuse in the circular economy: the trademark proprietor must convincingly rebut the presumption of permissible use. Only if the trademark owner succeeds in demonstrating that—despite the circular economy setting—a fashion re-user specifically aims at causing consumer confusion or damaging and unfairly exploiting the

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<sup>84</sup> CJEU, 10 April 2008, case C-102/07, Adidas/Marca, para. 36.

<sup>85</sup> M. Handler, ‘What Should Constitute Infringement of a Non-Traditional Mark? The Role of “Trademark Use”’, in: I. Calboli/M.R.F. Senftleben (eds.) (2018), “The Protection of Non-Traditional Trademarks – Critical Perspectives”, *Oxford: Oxford University Press*, 165 (170), referring to High Court of Australia, 23 November 1961, *The Shell Co. of Australia Ltd./Esso Standard Oil (Australia) Ltd.*, [1963] 109 CLR 407, 422 (Kitto J.).

<sup>86</sup> Dogan/Lemley, *supra* note 81, 542.

trademark's distinctiveness or repute, she can rebut the legal presumption of use in a decorative, non-branding<sup>87</sup> way. Only then, the trademark owner can save the infringement claim from being dismissed as unfounded from the outset.

In practice, the application of this upfront test of use as a mark means that the trademark owner must first overcome the hurdle of demonstrating that fashion reuse in the circular economy has trademark relevance *at all*. Even if a fashion item bears a trademark with a strong distinctive character, the legal presumption of non-actionable use in a decorative circular economy context remains an obstacle to the assertion of trademark rights and functions as a barrier to infringement claims. As a result, the sustainable reuse of trademarked fashion items becomes a robust user freedom: an “easy case” that is commonly deemed non-actionable unless there are “individualized facts that make a particular use by a particular person unprivileged.”<sup>88</sup> More concretely, the trademark owner must show that fashion reuse in the circular economy is a pretext for explicitly misleading or deliberately diluting use. As long as the sign is not explicitly employed as a misleading badge of origin in respect of the circular economy product itself, the trademark owner cannot rebut the legal presumption of non-confusing, non-actionable use other than as a mark. A similar change can be observed in the area of protection against dilution. Instead of accepting the traditional trademark logic of anti-dilution claims based on mere association—the fact that the sign used in a circular economy setting calls to mind the protected mark<sup>89</sup>—the trademark owner must demonstrate that the fashion re-user deliberately selected the trademark for a different reason, namely with the specific aim of damaging or unfairly exploiting the distinctiveness or repute which the sign has acquired as a trademark.<sup>90</sup>

### 3.2 *Easy Case Because Permissible Referential Use*

Alternatively, it is possible to develop a robust statutory defence. Considering the described decorative use context arising from the reworking of trademark fashion items, the referential use defence in EU trademark law can be a promising basis for this second approach.<sup>91</sup> At the outset, however, it is important to highlight an important difference between the gatekeeper requirement of use as a mark that has been discussed in the preceding section, and traditional defences against infringement claims: the distribution of the burden of proof. In a trademark system with a strict threshold requirement of use as a mark, the trademark proprietor must argue and demonstrate that the allegedly infringing use constitutes actionable “use in a branding way”<sup>92</sup> before judges lend weight to more specific infringement arguments based on confusion or dilution. Hence, the burden of proving that fashion reuse has relevance under trademark law—and allows the invocation of trademark rights—rests on the trademark proprietor. Ideally, this leads to a situation where legal counsels, from the outset, advise against claims targeting sustainable reuse in the circular economy. If the upfront refusal of trademark claims because of missing trademark relevance becomes established case law, attempts to assert trademark rights against fashion re-users appear futile indeed. In addition, the imposition of the burden of proof on the trademark owner leads to a situation where the latter must make the trademark claim plausible. The trademark owner must justify the invocation of trademark rights against use in the circular economy. Even if the fashion re-user remains silent and does not submit counterarguments, the trademark claim will still be dismissed unless the trademark owner manages to provide convincing proof of use with trademark relevance: explicitly misleading or deliberately diluting use, as discussed in the preceding section.

In comparison with this *ipso facto* immunity,<sup>93</sup> a mere defence against infringement claims is less effective.<sup>94</sup> A trademark system relying on statutory defences in favour of fashion reuse gives the

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<sup>87</sup> Dogan/Lemley, *supra* note 81, 542.

<sup>88</sup> Benkler, *supra* note 17, 362–363.

<sup>89</sup> CJEU, 23 October 2003, case C-408/01, Adidas/Fitnessworld, para. 39.

<sup>90</sup> For a similar approach in existing case law in the EU, see Benelux Court of Justice, 14 October 2019, case A2018/1/8, Moët Hennessy/Cedric Art, para. 9.

<sup>91</sup> Senftleben, *supra* note 9, 7–17.

<sup>92</sup> Dogan/Lemley, *supra* note 81, 542.

<sup>93</sup> Dinwoodie/Janis, *supra* note 24, 1600.

<sup>94</sup> Senftleben, *supra* note 10, 474–476; Pihlajarinne, *supra* note 7, 97–100.

trademark proprietor the opportunity to establish *prima facie* infringement and send cease-and-desist letters without any need to justify these enforcement measures. In principle, the infringement action is legitimate despite the specific circular economy context in which the allegedly infringing use takes place. In consequence, the fashion re-user must bear the burden of proving that the use falls within the scope of a valid defence against the trademark infringement claim. She carries the burden of demonstrating circumstances that neutralize the infringement action which, *prima facie*, appears legitimate. As a result, the fashion re-user faces a less robust legal position. Even critics of upfront filtering on the basis of a trademark use requirement concede that the defence scenario is less favourable and enhances the risk of a deterrent effect of trademark protection:

At the same time, it is surely true that our approach is subject to one drawback that is characteristic of standards-based approaches: it achieves flexibility at the cost of trading away some certainty, and it therefore has the potential to chill some valuable social and commercial activity.<sup>95</sup>

In light of the objective to support fashion reuse in the circular economy, the adoption of a strict gatekeeper requirement of use as a mark is preferable. The development of reliable defence arguments only constitutes the second-best option.

Considering that a defence-based approach offers weaker support, the question arises whether the explicit recognition of a defence for sustainable fashion reuse could still be sufficient to speak of an “easy case” in the sense of public domain concepts that take robust user freedoms into account. As discussed above, the referential use defence could serve as a prototype for a robust defence in favour of fashion re-users. The above discussion of current court practice showed that there is only one stumbling block that should be removed: the honest practices test. A first signpost for achieving this goal came to light during the debate on the amendment of EU trademark law. Seeking to provide guidance for the 2015 law reform, the “Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law”<sup>96</sup> proposed to solve the problem of circularity in honest practices jurisprudence as follows:

The only way to make sense of the wording would be to clarify that although the basic concepts (likelihood of confusion, abuse of reputation) informing the evaluation of honest business practices are the same as those governing infringement, their application is different in that the leeway for using a basically conflicting mark is much broader where applications or limitations apply, thereby confining the proprietor’s right to oppose such use to cases of disproportionate harm.<sup>97</sup>

The argument, thus, runs as follows: even if the assessment of honesty in industrial and commercial matters rests on the same criteria that have previously been used to establish *prima facie* infringement, the outcome can still be different when the criteria are applied in a more flexible way.<sup>98</sup> The required flexibility can be derived from the values underlying the defences in EU trademark law, such as freedom of referring to trademarked fashion elements for the purposes of environmental protection in cases of decorative use in the circular economy. Operationalizing this approach, a proposal can be put to good use which Annette Kur has made in the discussion about the marketing of repaired and refurbished products. She argues for a “context-sensitive evaluation of infringement”<sup>99</sup> that devotes sufficient attention to the behaviour of the alleged infringer<sup>100</sup> and, in particular, to information

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<sup>95</sup> Dinwoodie/Janis, *supra* note 24, 1663.

<sup>96</sup> Senftleben/Bently/Dinwoodie et al., *supra* note 64, 341–343. Cf. Kur, *supra* note 59, 105; Kur/Senftleben, *supra* note 32, para. 6.74.

<sup>97</sup> Senftleben/Bently/Dinwoodie et al., *supra* note 64, 339.

<sup>98</sup> Kur, *supra* note 59, 105. Cf. also Kur/Senftleben, *supra* note 32, para. 6.74.

<sup>99</sup> Kur, *supra* note 47, 235–236.

<sup>100</sup> For a further plea for a stronger focus on the concrete behaviour of the alleged infringer, see A. Anemaet (2021), “Which Honesty Test for Trademark Law? Why Traders’ Efforts to Avoid Trademark Harm Should Matter When Assessing Honest Business Practices”, *Gewerblicher Rechtsschutz und Urheberrecht – International* 70, 1025 (1037–1038).

surrounding the allegedly infringing product, including labelling that clearly indicates the changed status of the product and the person that has carried out the repair or refurbishment.<sup>101</sup>

For the development of appropriate labelling rules, the CJEU decision in *Viking Gas* can serve as a reference point.<sup>102</sup> The case concerned composite gas bottles which were intended for reuse a number of times. Against this background, the Court was satisfied that the bottles did not constitute mere packaging, but had an independent economic value which made them goods in themselves. Purchasers would be prevented from fully enjoying this property if the trademark proprietor could restrict their rights even after the first sale with her consent.<sup>103</sup> For this reason, the Court held that the sale of a composite bottle exhausted trademark rights and transferred to the purchaser the right to use that bottle freely, including the right to exchange it, or have it refilled, by an undertaking of his choice, including competitors of the trademark proprietor. As a corollary of this right of purchasers, competitors had the right to refill and exchange empty bottles as long as they kept their activities within the limits of the honest practices proviso following from Article 14(2) TMD.<sup>104</sup>

Arriving at this conclusion, the Court had the opportunity to formulate guidelines for meeting the honest practices test in refill cases. As a general rule, the Court emphasized the obligation to act fairly in the light of the legitimate interests of the trademark proprietor. More concretely, competitors offering refill services had to avoid the erroneous impression of a commercial connection with the trademark proprietor. To assess whether this condition was met, it was necessary to take into account the labelling of the bottles, the circumstances in which they had been exchanged, the practices in the sector concerned, and, in particular, whether consumers were accustomed to empty containers being filled by other dealers.<sup>105</sup> In *Viking Gas*, it was established that the composite gas bottles at issue bore word and figurative marks made up of the name and logo of the original producer and trademark owner Kosan Gas, and that these marks remained visible when the competitor Viking Gas affixed additional labels indicating that it had refilled the bottles.<sup>106</sup> According to the Court, this additional product labelling constituted a proper means of reducing the risk of an erroneous impression of a commercial connection and escaping the verdict of trademark infringement.<sup>107</sup>

In the more recent *Soda-Club* case, the Court confirmed these guidelines.<sup>108</sup> In particular, the Court stated again that a finding of non-infringement is possible even if the trademark of the original seller remains visible on the refilled product. As long as additional product labelling ensures clarity about the commercial source of the refilled product in the light of the practices in the sector and consumer awareness, the use can be permitted without prior authorization of the trademark proprietor.<sup>109</sup>

Applying these guidelines to the sustainable reuse of trademarked fashion items, it can be said that the behaviour of the fashion re-user is decisive. In particular, it is important to assess the effort made to avoid the impression of a commercial connection with the trademark proprietor.<sup>110</sup> Appropriate labelling of circular economy products—clearly indicating the logo of the fashion re-user—plays a central role. To give fashion reuse in the circular economy a chance and realize the societal benefits of environmental sustainability,<sup>111</sup> it can be assumed that the reuse of trademarked fashion elements is an accepted and increasingly widespread practice in the fashion industry.<sup>112</sup> Moreover, it should be

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<sup>101</sup> Kur, *supra* note 47, 236.

<sup>102</sup> Cf. Dorenbosch, *supra* note 7, 148–149; Kur, *supra* note 47, 235–236.

<sup>103</sup> CJEU, 14 July 2011, case C-46/10, *Viking Gas*, para. 30–33.

<sup>104</sup> CJEU, *id.*, para. 35.

<sup>105</sup> CJEU, *id.*, para. 39–40.

<sup>106</sup> CJEU, *id.*, para. 11.

<sup>107</sup> CJEU, *id.*, para. 39–41.

<sup>108</sup> CJEU, 27 October 2022, case C-197/21, *Soda-Club*, para. 54. For a discussion of underlying circular economy considerations, see Vrendenburg, *supra* note 6, 973–974.

<sup>109</sup> CJEU, *id.*, para. 54.

<sup>110</sup> Cf. Anemaet, *supra* note 100, 1037–1038 and 1041.

<sup>111</sup> Articles 11, 13, 37 CFR. As to the need for a proper balance that gives room for circular economy initiatives, see Vrendenburg, *supra* note 6, 973–974.

<sup>112</sup> For a similar line of argument in the area of repaired goods, see Tischner/Stasiuk, *supra* note 6, 35–36.



assumed that consumers are well aware that trademarked fashion pieces may be reworked and included in circular economy products.<sup>113</sup> Third-party trademarks that remain visible as a result of sustainable reuse may be reminiscent of the original fashion items that served as raw materials. Consumers, however, are unlikely to misinterpret these references to the original products as indications of the commercial source of circular economy products.<sup>114</sup> Instead, consumers will look for additional labelling, such as the fashion re-user's logo on clothes, tags showing the logo on the inside, logos displayed on packaging, in shops etc. Indicating the fashion re-user's logo clearly on the products themselves and offering appropriate information in connection with their sale, the fashion re-user can thus dispel concerns about (post-sale)<sup>115</sup> confusion, and avoid a finding of blurring, tarnishment or unfair freeriding.<sup>116</sup> In light of the overarching policy objective to support environmental sustainability, the assessment must be based on the perception of an average consumer who knows about the sustainable reuse of fashion items and looks actively for indications of commercial origin which the fashion re-user adds to ensure transparency.<sup>117</sup>

In line with the CJEU approach in *Viking Gas* and *Soda-Club*, these guidelines bring the behaviour of the fashion re-user into focus.<sup>118</sup> For a trademark infringement action to have success, more is necessary than some likelihood of confusion, risk of damage, or a likelihood of exploiting the magnetism of an iconic fashion trademark. The fashion re-user must deliberately aim at misleading consumers, causing damage or deriving unfair profit.<sup>119</sup> Unless the circumstances of the fashion reuse project indicate clearly that the fashion re-user specifically aimed at harming consumers or the trademark owner, or at exploiting the third-party brand in an unfair manner, no dishonesty can be found.<sup>120</sup> Hence, appropriate labelling is decisive. The sustainable reuse of trademarked fashion elements constitutes permissible referential use when customary modes of labelling are used to indicate the true commercial origin of circular economy products. Using this rule consistently as a guideline for applying the referential use defence, courts can transform the sustainable reuse of trademarked fashion elements into an “easy case”—a user freedom that is robust and reliable enough to be qualified as a public domain.

## Conclusion

The reuse of second hand and unsold fashion items in the circular economy has particular societal importance. Considering the environmental crisis fuelled by the wasteful use of resources in the fashion industry, it is desirable to develop legal solutions that allow fashion re-users to routinely prevail in trademark infringement cases. To arrive at a public domain status offering fashion re-users a robust “easy case” position in the trademark arena, it is advisable to first explore options for recalibrating the gatekeeper requirement of use as a trademark. In the case of circular economy products displaying a sign which the public recognizes as a third-party trademark, it should be decisive that the public understands that the trademark has become part of a “new” product consisting of reworked fashion items that served as raw materials. This finding should tip the scales in favour of the

<sup>113</sup> Cf. Tischner/Stasiuk, *supra* note 6, 41–42.

<sup>114</sup> Schenerman, *supra* note 7, 765–766. Admittedly, a study of consumer responses to repaired goods bearing the logo of the original manufacturers yielded mixed results and showed that, in this specific case, consumers may be misled. See Tischner/Stasiuk, *supra* note 6, 53. The situation in the field of upcycled products, however, is different because third-party trademarks will appear on reworked, modified products. It is not the purpose of upcycling to restore the original appearance of products. The consumer perception will thus be different.

<sup>115</sup> Schenerman, *supra* note 7, 778–780;

<sup>116</sup> Tischner/Stasiuk, *supra* note 6, 33–34; Kur, *supra* note 47, 235; Anemaet, *supra* note 100, 1037–1038 and 1041; Schenerman, *supra* note 7, 766–769; Keats, *supra* note 35, 717–718.

<sup>117</sup> As to the inclusion of normative considerations in the consumer concept and the determination of the consumer's level of knowledge, see Senftleben, *supra* note 10, 352–355; G.B. Dinwoodie/D.S. Gangjee (2016), “The Image of the Consumer in European Trade Mark Law”, in: D. Leczykiewicz/S. Weatherill (eds.), “The Images of the Consumer in EU Law: Legislation, Free Movement and Competition Law”, *Oxford and Portland, Oregon: Hart Publishing*, 339 (367).

<sup>118</sup> Cf. Anemaet, *supra* note 100, 1037–1038.

<sup>119</sup> Cf. Senftleben, *supra* note 10, 468–469.

<sup>120</sup> Cf. Senftleben, *supra* note 45, 598–600.

fashion re-user and reverse the burden of proof. The trademark proprietor should only be able to rebut the presumption of permissible use by producing evidence that the circular economy setting is a mere pretext for explicitly misleading or deliberately diluting use.

Second, it can be considered to introduce a robust referential use defence. The logic would be identical to the described first solution based on a strict gatekeeper criterion of use as a mark: the trademark proprietor should only be able to rebut the assumption of permissible use by furnishing evidence that there are unusual, individualized facts that support a finding of infringement. The difference lies in the fact that a solution based on the referential use defence does not prevent the trademark proprietor from establishing *prima facie* infringement. Hence, allegations of infringement and cease-and-desist letters are not unfounded and pointless from the outset. The referential use approach, thus, offers less legal certainty than an approach based on the upfront denial of use with trademark relevance. Appropriate labelling guidelines, however, can further strengthen the position of the fashion re-user. For instance, the use of the re-user's own logo on (the inside of) garments, on packaging, in shops etc. could be accepted as evidence that the re-user has no intention of misleading consumers, bringing damage or deriving unfair profit. In this way, trademark law could reassure fashion re-users that, using customary modes of indicating the commercial origin of fashion products, they can ensure compliance with honest practices in industrial or commercial matters and reliably escape the verdict of trademark infringement.

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