



Reports of Cases

OPINION OF ADVOCATE GENERAL
PITRUZZELLA

delivered on 16 June 2022¹

Case C-175/21

Harman International Industries, Inc.

v
AB SA

(Request for a preliminary ruling
from the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland))

(Reference for a preliminary ruling – Articles 34 and 36 TFEU – Free movement of goods – European Union trade mark – Regulation (EU) 2017/1001 – Article 15 – Exhaustion of the right conferred by the European Union trade mark – Burden of proof – Effective judicial protection)

1. In an action brought by the proprietor of a trade mark to prevent the distribution of unauthorised goods, where does the balance lie between protecting the proprietor of the trade mark and the distributor of the goods pleading the exhaustion of the trade mark? Can the consent of the proprietor of the trade mark to the putting of the goods on the market in the European Economic Area (EEA) be implied? Is the general wording of the operative part of the judgment and the postponement until the enforcement stage of the identification of the goods put on the market in the EEA compatible with the principle of effective judicial protection? How should the burden of proof be allocated?

I. Legal framework

A. European Union law

2. According to Article 9 of Regulation 2017/1001:²

‘1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.’

...

¹ Original language: Italian.

² Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

3. The following, in particular, may be prohibited ...:

...

(b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

...'

3. According to Article 15(1) of Regulation 2017/1001:

'An EU trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the European Economic Area under that trade mark by the proprietor or with its consent.'

4. Article 129(3) of Regulation 2017/1001, entitled 'Applicable law', provides that:

'Unless otherwise provided for in this Regulation, an EU trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.'

5. Article 3(2) of Directive 2004/48/EC³ provides that:

'Those measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.'

B. Polish national law

6. Article 325 of the ustawa z dnia 17 listopada 1964 roku Kodeks postępowania cywilnego (Law on the Code of Civil Procedure) of 17 November 1964, consolidated text, as amended (Dz. U. of 2019, item 1460) ('the Code of Civil Procedure') provides:

'The operative part of the judgment shall contain the name of the court, the names of the judges, the registrar and the public prosecutor, if the latter has intervened in the case, the date and place of the hearing and the delivery of the judgment, the names of the parties and the subject matter of the case, as well as the court's decision on the parties' applications.'

7. According to Article 758 of the Code of Civil Procedure, the Sądy Rejonowe (District Courts, Poland) and the bailiffs attached to those courts are responsible for enforcement.

³ Directive of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45).

8. According to Article 767(1) and (2) of that Code:

‘1. Unless otherwise provided by law, the bailiff’s acts may be appealed before the District Court. An appeal shall also be possible against the omission of a document by the bailiff. The appeal shall be heard by the court in the jurisdiction of the bailiff’s office.

...

2. An appeal may be lodged by a party or another person whose rights have been infringed or threatened by the act or omission of the bailiff.

...’

9. Article 843(3) of the Code provides:

‘In the appeal, the appellant shall present all the complaints that may be raised at this stage, otherwise he or she will lose the right to assert them at subsequent stages of the proceedings.’

10. Article 1050(1) and (3) of the Code provides:

‘1. Where the debtor is required to perform an act which cannot be performed by another person and the performance of which is solely of his or her own volition, the court in whose jurisdiction the act is to be performed shall, at the request of the creditor and after hearing the parties, fix a time limit for the debtor to perform the act. Should the debtor fail to do so within that time limit, he shall be liable for a fine.

...

3. If the time limit granted to the debtor to perform an act expires without the debtor having performed that act, the court shall, at the creditor’s request, impose a fine on the debtor and at the same time fix a new time limit for the performance of the act, under penalty of an increased fine.’

11. Article 1051(1) of the Code of Civil Procedure provides:

‘Where the debtor is bound by the obligation not to perform or obstruct the creditor’s acts, the court in whose jurisdiction the debtor has failed to discharge his or her obligation shall, at the creditor’s request, order him or her to pay a fine, after hearing the parties and finding that the debtor has failed to discharge his or her obligation. The court shall proceed in the same manner in the event of a new application by the creditor.’

II. Facts, main proceedings and question referred for a preliminary ruling

12. Harman International Industries, Inc. (‘the applicant’), based in Stamford (United States), is the holder of exclusive rights to the EU trade marks registered under numbers 001830967, 005336755, 015577621, 003191004, 003860665, 0150221652, 001782523, 005133251 and 009097494.

13. The applicant's products (audiovisual equipment, including speakers, headphones and audio systems) bearing the indicated trade marks are distributed in the territory of Poland by a single entity with which the applicant concluded a distribution agreement and through which its products are sold in electronic equipment shops to end customers.

14. The applicant uses marking systems for its goods. However, in the opinion of the referring court, it is not always possible, on the basis of those marking systems, to determine whether the product was intended to be placed on the market in the European Economic Area (EEA) or outside it. The markings on some of the items bearing the applicant's trade marks do not contain the abbreviations for territorial indications, and so do not specify the place where the goods were to be first placed on the market with the applicant's consent. This means that some of the markings are present both on the packaging of items intended to be placed on the market within the EEA and on the packaging of items intended to be placed on the market outside the EEA. In order to determine the market for which those items are intended, it is necessary to use an IT tool at the applicant's disposal, which includes a database of products together with an indication of the market for which a specific item is intended.

15. AB SA, based in Magnice (Poland), which is the defendant in the main proceedings ('the defendant'), engages in the business of electronic equipment distribution. The defendant put on the Polish market goods produced by the applicant and bearing the applicant's EU trade marks. The defendant purchased the indicated goods from a seller other than the distributor of the products for the Polish market with whom the applicant had concluded an agreement. The defendant states that it received assurances from that seller that putting the products in question on the Polish market did not infringe the applicant's exclusive rights to EU trade marks in view of the exhaustion of those rights resulting from the prior putting of products bearing EU trade marks on the market within the EEA by the applicant or with its consent.

16. The applicant brought an action before the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland), as the court of first instance, requesting that the defendant be prohibited from infringing its rights to EU trade marks by preventing the importation, putting on the market, offering, advertising and stocking of speakers and headphones and their packaging bearing any of the applicant's EU trade marks which had not previously been put on the market within the EEA by the applicant or with its consent. The applicant further requested that the court order the defendant to withdraw from the market or destroy such speakers and headphones and their packaging.

17. The defendant opposed the applicant's claims by invoking the principle of exhaustion of the right conferred by the EU trade mark. Its defence was based on the assurance received from the seller that the goods in question had already been put on the market within the EEA.

18. In that regard, the referring court observes that the applicant's product marking systems do not make it possible to determine whether the goods were intended for the EEA market or not. For that reason, a defendant would be unable to prove whether an individual item of a product bearing the applicant's EU trade mark was put on the market within the EEA by the applicant or with its consent. Naturally, the defendant could approach its seller; however it is unlikely – the referring court continues – that it would be able to obtain useful information about the identity of the person from whom the supplier purchased the items in question or the persons who are part of the distribution chain of the items in Poland, as sellers are not normally willing to disclose their sources of supply so as not to lose buyers.

19. Given the situation, the referring court observes that the practice of the Polish courts, in the operative part of rulings upholding claims, of using the general phrase ‘goods bearing the applicant’s trade marks which have not previously been put on the market within the [EEA] by the applicant (the holder of rights under the EU trade mark) or with its consent’ makes it very difficult to exercise the right of defence and creates uncertainty in the application of the law. In the view of the referring court, as a direct result of this manner of drafting the operative part of rulings, it is impossible in practice to enforce them on the basis of the information they contain.

20. Whether the decision is enforced voluntarily or by the competent enforcement authority, in order for it to be enforceable in practice, further information is needed from the proprietor or the defendant to identify the specific items covered by the EU trade mark.

21. In particular, the cooperation of the applicant, the proprietor of the trade mark, is necessary in order to access the database containing the information needed to identify the goods.

22. In addition, the reasoning given in the reference for a preliminary ruling shows that the practice of enforcing judgments whose operative part is drafted in a general manner is not uniform and varies according to the nature of the judgment to be enforced. Furthermore, in many cases, it may also result in the seizure of the goods in circulation, in the absence of any infringement of an exclusive trade mark right. In essence, it may be the case that the protection of the exclusive right conferred by an EU trade mark is extended to goods for which that right is exhausted.

23. In addition, the practice in question raises further uncertainties regarding the procedural guarantees for the parties in cases concerning the protection of an exclusive right conferred by an EU trade mark. It is clear from the wording of the request for a preliminary ruling that it is very difficult for a defendant to prove in the context of litigation that a particular item was put on the market in the EEA by the applicant or with its consent.

24. Under Polish law, as mentioned by the referring court, the remedies available to the debtor in proceedings to secure claims and enforcement proceedings – that is to say, an appeal against a bailiff’s acts and objection to enforcement – preclude any effective challenge to the manner in which the judgment was enforced by the enforcement authority, thus making it impossible to identify the items to be excluded from enforcement.

25. For all those reasons, the referring court has doubts as to the compatibility of that practice of the Polish courts with the principles of the free movement of goods and exhaustion of the right conferred by the EU trade mark, and the obligation for Member States to provide the necessary remedies to ensure effective judicial protection.

26. Accordingly, the Sąd Okręgowy w Warszawie (Regional Court, Warsaw) stayed the proceedings and referred the following question to the Court of Justice for a preliminary ruling:

‘Must the second sentence of Article 36 TFEU, read in conjunction with Article 15(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, and in conjunction with the second sentence of Article 19(1) of the Treaty on European Union, be interpreted as precluding the practice of the national courts of the Member States, which is that the courts:

- when upholding claims by right holders to prohibit the importation, putting on the market, offering, advertising of goods bearing the EU trade mark, to order their withdrawal from the market or to order their destruction;
- when ruling, in proceedings to secure claims, on the seizure of goods bearing the EU trade mark,

refer in their rulings to “goods which have not been put on the market within the European Economic Area by the right holder or with its consent”, with the result that it is left to the enforcement authority, in view of the general wording of the ruling, to determine which items bearing the EU trade mark are subject to the injunctions and prohibitions granted (that is to say, which items have not been put on the market within the European Economic Area by the right holder or with its consent), while the possibility of challenging the aforementioned findings of the enforcement authority before a court in declaratory proceedings is excluded or limited by the nature of the legal remedies available to the defendant in proceedings to secure claims and in enforcement proceedings?’

III. Legal analysis

A. *Preliminary observations*

27. By the single request for a preliminary ruling concerning the degree of precision required in the wording of the operative part of a judgment in the matter of exhaustion of the rights conferred by a trade mark pursuant to Article 15(1) of Regulation 2017/1001, the referring court expresses doubts both as to the guarantee of the free movement of goods and the effective judicial protection of the distributor, sued by the proprietor of an EU trade mark for the allegedly unlawful putting on the market within the EEA of goods protected by the trade mark.

28. Specifically, in the view of the national court, the general wording of the operative part of the judgment delivered by the court in the declaratory proceedings has the effect of making the defence of the distributor of the goods, who is the defendant in the case, excessively difficult. This raises the issue of the allocation of the burden of proof in the case, particularly at the enforcement stage, given the particular procedural system of the Member State which, by subjecting the defendant to strict requirements for bringing opposition proceedings, is unable, in the view of the referring court, to offer effective protection for the defendant.

29. Written observations have been submitted by the applicant, the defendant, the Polish Government and the European Commission.

30. The applicant considers that the request for a preliminary ruling must be answered in the negative, since any other solution would be contrary to the rule of exhaustion of the rights conferred by the trade mark. In addition to contesting the description of the facts and the interpretation of Polish legislation presented by the referring court, the applicant submits that, if the solutions suggested by the referring court were adopted – such as requiring the proprietor of the trade mark to indicate precisely on the goods ‘the markings or serial numbers’ – this would amount to discrimination against operators whose trade mark has been infringed, since that obligation is provided for neither by EU law nor by national law.

31. The applicant also disputes the claim that Harman has a sole distributor of its products in the Polish market. Consequently, the applicant does not believe a reversal of the burden of proof, as established by *Van Doren + Q*,⁴ can be permitted since – except in cases of exclusive distribution – the burden of proving the existence of consent to the putting of the goods on the market outside the EEA lies with the defendant.

32. By contrast, the defendant, the Polish Government and the Commission are of the opinion that the request for a preliminary ruling must be answered in the affirmative.

33. The defendant and the Polish Government agree with the referring court’s presentation of the facts. The defendant considers that any judgment given by a court should allow the defendant to give effect to it voluntarily without having to rely on information contained in the applicant’s databases, which the defendant cannot access. That practical problem could, in the defendant’s view, be resolved by establishing a uniform marking system requiring the intended market to be indicated on individual items of the product.

34. The Polish Government considers that, since the traditional rules on allocating the burden of proof in proceedings for infringement of an exclusive trade mark right could, in some cases, lead to a de facto restriction of the free movement of goods, its modification could be justified in accordance with the principles set out in *Van Doren + Q*. In particular, the Polish Government considers that compliance with those principles is only possible if the evidentiary procedure is conducted entirely by the court ruling on the merits.

35. Conversely, the Commission – while agreeing with the possibility of allocating to the trade mark proprietor the burden of proving consent to putting the goods on the market outside the EEA – holds that EU law does not, in principle, preclude the possibility of leaving it to the enforcement authority to determine which items bearing the EU trade mark are affected by injunctions and prohibitions issued by a court. Nevertheless, it adds that such a solution, in accordance with the principle of effective judicial protection, presupposes that the defendant in proceedings to secure claims and enforcement proceedings has all the necessary means to protect its right in court.

36. From the case file in the main proceedings, it is clear that the case at issue in the reference for a preliminary ruling mainly concerns the parallel importation of ‘mixed’ products – in other words, products for which the proprietor’s exclusive rights are exhausted and which may move freely within the EEA, and products intended to be marketed outside the EEA, the marketing of which in the EEA infringes the proprietor’s rights.

⁴ Judgment of 8 April 2003 (C-244/00, EU:C:2003:204).

37. The referring court submits that, at the time of the seizure, it is very difficult to distinguish between the two types of goods. For that reason, the only reliable information that can be used to determine the place where the goods were placed on the market often comes from the proprietor of the trade mark.

38. The general wording of the operative part, which merely reproduces the provision laid down in Article 15(1) of Regulation 2017/1001, has the effect of postponing the determination of the place where the goods were placed on the market until the time of enforcement. That postponement until the enforcement stage is problematic because, in Polish law, as inferred from the order for reference, the defendant has very limited procedural rights at the enforcement stage, largely owing to the necessary involvement of the proprietor of the EU trade mark. The necessary cooperation of the applicant, who is the proprietor of the trade mark, prevents the defendant, who is the distributor of the goods, from effectively and independently defending its position in court.

39. In my analysis, I shall focus on two questions which I consider essential to answer the question referred for a preliminary ruling by the referring court: the principle of the exhaustion of trade mark rights in relation to the rules governing the free movement of goods, and the effectiveness of the judicial protection of the defendant-distributor of the goods in those proceedings, in view of the general wording of the operative part and the allocation of the burden of proof.

B. Exhaustion of the rights conferred by an EU trade mark and the free movement of goods: the concept of consent

40. The provision laid down in Article 15(1) of Regulation (EU) 2017/1001 codified⁵ the principle of exhaustion of the rights conferred by a trade mark, according to which the trade mark proprietor, once goods bearing its trade mark have been marketed by it directly or at least with its consent, can no longer assert rights in connection with that trade mark to prevent the subsequent sale of those goods.

41. That provision reproduces, in substantially the same terms, Article 7 of Directive 89/104/EEC,⁶ which codified the case-law on the principle of exhaustion in the field of trade marks, and Article 13 of Regulation (EC) No 40/94, which codified⁷ the case-law on the Community trade mark. Directive 89/104/EEC was repealed by Directive 2008/95/EC, which in turn was repealed by Directive (EU) 2015/2436.⁸ Regulation (EC) No 40/94 was repealed by Council Regulation (EC) No 207/2009 of 26 February 2009 on the trade mark,⁹ which in turn was repealed by Regulation (EU) 2017/1001. Although Article 15 of Regulation 2017/1001 – like Article 15 of Directive 2015/2436 – is worded somewhat differently from the provisions repealed over the years, it is considered that the interpretations offered by the Court of Justice on the earlier texts may still be relevant, given that the two provisions pursue the same objective of balancing trade mark rights with the protection of the free movement of goods in the internal market.

⁵ Long before the harmonisation of intellectual property law, the Court of Justice recognised that the exercise of the exclusive right of the proprietor of that right, in the event that it did not fall within the protection guaranteed by competition rules (Article 101(1) TFEU), had to be examined in the light of the legislation on the free movement of goods.

⁶ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1).

⁷ OJ 1994 L 11, p. 1.

⁸ OJ 2015 L 336, p. 1.

⁹ OJ 2009 L 78, p. 1.

42. The institution is based on the fact that the proprietor has the right to control only the first placing of the trade-marked products on the reference market, without creating obstacles or restrictions for the further movement of the protected goods, which would be incompatible with the principle of freedom of trade.¹⁰

43. The abovementioned provision must be read and interpreted in the light of Article 36 TFEU,¹¹ considering that it ensures a complete harmonisation¹² of the rules on the exhaustion of rights conferred by a trade mark by codifying a large part of the case-law of the Court of Justice on the free movement of goods.¹³

44. Consequently, it is inconceivable that the application of the provision laid down in Article 15(1) of Regulation 2017/1001 may have the effect of legitimising or justifying obstacles to the free movement of goods and reintroducing de facto barriers and customs borders between States that were demolished with the common market,¹⁴ or of reducing the procedural guarantees for the parties in cases concerning the protection of an exclusive right conferred by an EU trade mark.

45. In the light of those considerations, and as the referring court suggests, it must be examined whether the practice of the Polish courts of drafting the operative part of the judgment in a general manner, combined with the fact that the distinction between the categories of goods appears to be made solely on the basis of the information and databases in the applicant's possession, constitutes a means of discrimination or a disguised restriction on trade between Member States within the meaning of Article 36 TFEU.

46. Indeed, from the situation described by the referring court, that practice might, albeit indirectly, maintain those restrictions and extend the protection of the exclusive right conferred by an EU trade mark to products for which that right is exhausted.

47. The Court of Justice has consistently held that Article 36 TFEU,¹⁵ and thus the prohibition of import restrictions and measures having equivalent effect, may allow derogations on grounds of the protection of industrial and commercial property rights. However, since the prohibition

¹⁰ For a detailed reconstruction of the principle from a historical perspective, Sarti, D. *Diritti esclusivi e circolazione dei beni*, Milan, 1996, pp. 17 et seq. and 73 et seq.

¹¹ Judgment of 11 July 1996, *Bristol-Myers Squibb and Others* (C-427/93, C-429/93 and C-436/93, EU:C:1996:282, paragraph 27).

¹² See judgment of 16 July 1998, *Silhouette International Schmied* (C-355/96, EU:C:1998:374, paragraphs 25 and 29).

¹³ The Court of Justice has promoted the free movement of goods by applying the provisions of the Treaties in the field of competition: judgments of 13 July 1966, *Consten and Grundig v Commission* (56/64 and 58/64, EU:C:1966:41); of 29 February 1968, *Parke, Davis and Co.* (24/67, EU:C:1968:11); and of 18 February 1971, *Sirena* (40/70, EU:C:1971:18).

¹⁴ To achieve those aims, the Court of Justice initially used the prohibition of anti-competitive agreements and then the abovementioned rules on the free movement of goods, at the time Article 85 of the Treaty, now Article 101 TFEU. See judgment of the Court of Justice of 13 July 1966, *Consten and Grundig v Commission* (56/64 and 58/64, EU:C:1966:41).

¹⁵ See judgments of 31 October 1974, *Centrafarm and de Peijper* (16/74, EU:C:1974:115); of 23 May 1978, *Hoffmann-La Roche* (102/77, EU:C:1978:108); and of 4 October 2011, *Football Association Premier League and Others* (C-403/08 and C-429/08, EU:C:2011:631, paragraph 94).

affects the exercise of the rights and not their existence, the exception is allowed only to the extent that the derogations ‘are justified for the purpose of safeguarding rights which constitute the specific subject matter’¹⁶ of the property right.¹⁷

48. The proprietor of the trade mark must put on the market itself¹⁸ or consent to the putting on the market of any product bearing its trade mark.¹⁹ The equivalence between the two scenarios – trade-marked goods being put on the market by the proprietor or with his consent – has been affirmed consistently since the first rulings laid down the principle of exhaustion.²⁰

49. Therefore, the presence of consent is a decisive factor in determining when the protection of intellectual property rights is secondary to the principle of the free movement of goods.

50. The judgment in *IHT Heiztechnik and Danzinger* provided important clarification on the definition of consent, stating that this can never be implied.²¹

51. In its judgment in *Sebago*, the Court of Justice, referring to Directive 89/104/EEC on trade marks, stated that ‘for there to be consent within the meaning of Article 7(1) ... such consent must relate to each individual item of the product in respect of which exhaustion is pleaded.’²²

52. In the Joined Cases *Davidoff and Levi Strauss*,²³ which concern Directive 89/104, the Court held that the definition of consent to the placing of goods on the market within the EEA, within the meaning of Article 7(1) of Directive 89/104, should not be left to national laws because otherwise the protection would vary according to the legal system concerned.

53. As regards the possibility of ‘implied’ consent, the Court of Justice has stated that clarification is needed of the manner in which the consent of a trade mark proprietor to marketing within the EEA may be expressed. Moreover, consent must be so expressed that an intention to renounce those rights is unequivocally demonstrated. However, it acknowledged that ‘it is conceivable that consent 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’.²⁴

¹⁶ See judgment of 31 October 1974, *Centrafarm and de Peijper* (16/74, EU:C:1974:115, paragraph 7); judgment of 23 May 1978, *Hoffmann-La Roche* (102/77, EU:C:1978:108, paragraph 6). Reference is also made on this point to the Opinion of Advocate General Sharpston of 6 April 2006 in *Boehringer Ingelheim and Others* (C-348/04, EU:C:2006:235, point 9), which explains the two components of the specific subject matter of a trade mark right: ‘First, there is the right to use the mark for the purpose of putting products protected by it into circulation for the first time in the EC, after which that right is exhausted. Second, there is the right to oppose any use of the trade mark which is liable to impair the guarantee of origin, which comprises both a guarantee of identity of origin and a guarantee of integrity of the trade-marked product.’

¹⁷ By judgment of 8 June 1971, *Deutsche Grammophon Gesellschaft* (78/70, EU:C:1971:59), the Court of Justice ruled for the first time on the subject, albeit in the matter of copyright and related rights.

¹⁸ The expression ‘put on the market’, as an effect, relates to the extension of the rights conferred by the trade mark and is therefore subject to complete harmonisation, although the negotiations and measures that produce it are governed by each Member State. See judgments of 30 November 2004, *Peak Holding* (C-16/03, EU:C:2004:759, paragraphs 31 and 32); of 23 April 2009, *Copad* (C-59/08, EU:C:2009:260, paragraph 40); and of 3 June 2010, *Coty Prestige Lancaster Group* (C-127/09, EU:C:2010:313, paragraphs 27 and 28).

¹⁹ See judgment of 1 July 1999, *Sebago and Maison Dubois* (C-173/98, EU:C:1999:347, paragraphs 19 and 20).

²⁰ See judgment of 31 October 1974, *Centrafarm and de Peijper* (16/74, EU:C:1974:115, paragraph 1).

²¹ See judgment of 22 June 1994 (C-9/93, EU:C:1994:261, paragraph 43), according to which, for the purposes of exhaustion, ‘the owner of the right in the importing State must, directly or indirectly, be able to determine the products to which the trade mark may be affixed in the exporting State and to control their quality.’

²² See judgment of 1 July 1999, *Sebago and Maison Dubois* (C-173/98, EU:C:1999:347, paragraph 22).

²³ Judgment of 20 November 2001, *Zino Davidoff and Levi Strauss* (C-414/99 to C-416/99, EU:C:2001:617).

²⁴ See judgment of 20 November 2001, *Zino Davidoff and Levi Strauss* (C-414/99 to C-416/99, EU:C:2001:617, paragraph 47).

54. Implied consent to marketing cannot be inferred from the mere silence of the trade mark proprietor or from the fact that the proprietor has not communicated to all subsequent purchasers of the goods its opposition to them being imported into the EEA, or that the goods carry no warning of a prohibition, or that no contractual reservations have been imposed at the time of the sale of the goods.²⁵

55. Therefore, in certain circumstances, consent may be inferred from the unequivocal actions of the proprietor of the trade mark, even though express consent is the rule.

56. Yet which party must produce evidence of such express or implied consent in court? What type of investigations must the court carry out to determine which products put on the market are still covered by trade mark protection and which are not? Must such investigations necessarily take place during the substantive phase, or may they also be carried out at the enforcement stage?

57. These are the two aspects highlighted in the request for a preliminary ruling. Despite being conceptually separate, they both stem from the practice of the Polish courts of drafting the operative part of the judgment in a general manner. They also raise the same legal question: namely, that of the effective protection in court of the defendant-distributor of the goods who pleads the exhaustion of the right in a trade mark protection case.

58. The referring court requests the Court of Justice to assess whether the practice of the Polish courts of using general wording for the operative part of rulings on the infringement of trade mark rights as a result of parallel imports can be considered compatible with the fundamental principles of the free movement of goods and effective judicial protection. Specifically, the referring court notes that the reference, in the grounds and operative part of the judgment, to ‘goods which have not been put on the market within the EEA by or with the consent of the proprietor’ might, depending on the circumstances, not be sufficient or precise enough.

59. The consequence of this manner of drafting the operative part of judgments, in the view of the referring court, means that it is impossible in practice to enforce them due to the missing information necessary for them to be enforced. Indeed, whether the decision is enforced voluntarily or by the competent enforcement authority, further information is still necessary to identify which goods the judgment is referring to.

60. According to the referring court, only the proprietor of the trade mark can indicate the destination of the goods that are the subject of the judgment. Therefore, the defendant – not having access to that specific information – would be unable to challenge such findings either in proceedings to secure claims or in enforcement proceedings.

61. In those circumstances, the question arises of the compatibility of Polish law with the principles expressed in Article 19(1) TEU and Article 47 of the Charter of Fundamental Rights of the European Union (‘the Charter’): can the defendant-distributor count on effective judicial protection in the Member State?

²⁵ See judgment of 20 November 2001, *Zino Davidoff and Levi Strauss* (C-414/99 to C-416/99, EU:C:2001:617, paragraph 60).

C. Effective judicial protection and procedural autonomy of the Member States

62. Effective judicial protection, under Article 19(1) TEU, must be ensured for individuals, in the fields covered by EU law, through sufficient remedies provided by Member States.²⁶

63. The principle of the effective legal protection of individual parties' rights under EU law, referred to in that provision, 'is a general principle of EU law stemming from the constitutional traditions common to the Member States, which has been enshrined in Articles 6 and 13 of the Convention for the Protection of Human Rights and Fundamental Freedoms, signed in Rome on 4 November 1950, and which is now reaffirmed by Article 47 of the Charter'.²⁷

64. Article 47 of the Charter states, in the first paragraph thereof, that everyone whose rights and freedoms guaranteed by the law of the European Union are violated has the right to an effective remedy in compliance with the conditions laid down in that article. The obligation imposed on the Member States, in Article 19(1) TEU, to provide remedies sufficient to ensure effective legal protection in the fields covered by EU law corresponds to that right.

65. As can be seen from the settled case-law of the Court, the right to an effective remedy may be invoked on the basis of Article 47 of the Charter alone, without there being a need for the content thereof to be made more specific by other provisions of EU law or by provisions of the domestic law of the Member States.²⁸

66. It follows from the case-law of the Court that the essence of the right to an effective remedy enshrined in Article 47 of the Charter includes, among other aspects, the possibility, for the person who holds that right, of accessing a court or tribunal with the power to ensure respect for the rights guaranteed to that person by EU law and, to that end, to consider all the issues of fact and of law that are relevant for resolving the case before it.²⁹

67. However, it is for each Member State, in accordance with the principle of procedural autonomy, to establish procedural rules for the remedies to be provided for individual parties, on condition, however, that those rules are not – in situations governed by EU law – 'less favourable than in similar domestic situations (principle of equivalence) and that they do not make it impossible in practice or excessively difficult to exercise the rights conferred by EU law (principle of effectiveness)'.³⁰

68. According to the settled case-law of the Court, the principle of equivalence 'requires that the national rule at issue be applied without distinction, whether the action is based on rights which individuals derive from EU law or whether it is based on an infringement of national law, where

²⁶ See, to that effect, judgment of 26 March 2020, *Miasto Łowicz and Prokurator Generalny* (C-558/18 and C-563/18, EU:C:2020:234, paragraph 32).

²⁷ See judgment of 21 December 2021, *Randstad Italia* (C-497/20, EU:C:2021:1037, paragraph 57); see also, to that effect, judgment of 15 July 2021, *Commission v Poland (Disciplinary regime applicable to judges)* (C-791/19, EU:C:2021:596, paragraph 52).

²⁸ See judgment of 6 October 2020, *État luxembourgeois (Judicial protection from requests for information in tax matters)* (C-245/19 and C-246/19, EU:C:2020:795, paragraph 54 and the case-law cited).

²⁹ See judgment of 6 October 2020, *État luxembourgeois (Judicial protection from requests for information in tax matters)* (C-245/19 and C-246/19, EU:C:2020:795, paragraph 66 and the case-law cited).

³⁰ See judgment of 21 December 2021, *Randstad Italia* (C-497/20, EU:C:2021:1037, paragraph 58).

the purpose and cause of action are similar’.³¹ Therefore, respect for that principle requires equal treatment of claims based on a breach of national law and of similar claims based on a breach of EU law.³²

69. The principle of effectiveness, on the other hand, requires that, while applying the principle of procedural autonomy, the procedural rules do not make it excessively difficult or impossible in practice to exercise the rights conferred by EU law.³³

70. However, ‘EU law does not have the effect of requiring Member States to establish remedies other than those established by national law, unless it is apparent from the overall scheme of the national legal system in question that no legal remedy exists that would make it possible to ensure, even indirectly, respect for the rights that individuals derive from EU law, or the sole means of obtaining access to a court is effectively for individuals to break the law’.³⁴

71. From the balance between the principle of effective judicial protection and the principle of procedural autonomy of the Member States, we must draw the necessary conclusions to assess whether the interpretation described by the referring court is contrary to the abovementioned principles of EU law.

1. General wording of the operative part of the judgment in trade mark protection cases

72. The question of the correct wording of the operative part and the protections afforded in trade mark protection cases is, in principle, governed by national procedural law. Under Article 129(3) of Regulation 2017/1001, an EU trade mark court must apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located, provided that the principles of equivalence and effectiveness are nevertheless respected and the fundamental right to effective judicial protection, within the meaning of Article 47 of the Charter of Fundamental Rights of the European Union, is guaranteed.³⁵

73. As the Commission has observed,³⁶ a precise wording of the operative part and adequate reasoning for the judgment are necessary to ensure effective protection of the rights guaranteed by the legal order of the European Union, although this does not mean that the enforcement authority can determine which items bearing the EU trade mark are affected by injunctions and prohibitions, as long as the remedies provided by national law allow such decisions to be challenged before a court.

74. In the view of the referring court, it appears that the defendant is unable to comply voluntarily with the injunctions and prohibitions contained in a judgment which uses general wording, and that therefore it is automatically exposed to enforcement proceedings, with limited remedies.

³¹ See judgment of 17 March 2016, *Bensada Benallal* (C-161/15, EU:C:2016:175, paragraph 29); see also, to that effect, judgment of 27 June 2013, *Agrokonsulting-04* (C-93/12, EU:C:2013:432, paragraph 39).

³² See, to that effect, judgment of 6 October 2015, *Târșia* (C-69/14, EU:C:2015:662, paragraph 34).

³³ See, to that effect, judgments of 15 March 2017, *Aquino* (C-3/16, EU:C:2017:209, paragraph 48); of 13 December 2017, *El Hassani* (C-403/16, EU:C:2017:960, paragraph 26); and of 10 March 2021, *Konsul Rzeczypospolitej Polskiej w N.* (C-949/19, EU:C:2021:186, paragraph 43).

³⁴ See judgment of 21 December 2021, *Randstad Italia* (C-497/20, EU:C:2021:1037, paragraph 62); see also, to that effect, judgment of 14 May 2020, *Országos Idegenrendészeti Főigazgatóság Dél-alföldi Regionális Igazgatóság* (C-924/19 PPU and C-925/19 PPU, EU:C:2020:367, paragraph 143).

³⁵ See judgment of 13 January 2022, *Minister Sprawiedliwości* (C-55/20, EU:C:2022:6, paragraphs 104 and 105 and the case-law cited).

³⁶ Commission’s observations, paragraphs 39 to 41.

75. In that context, one solution might be – as the national court seems to suggest – to introduce an obligation to indicate *ex ante* the market of destination on the products.

76. However, just because it is difficult for the defendant to find out information about the original supplier, this cannot, in my view, constitute the legal basis justifying such an obligation being imposed on the proprietor. Indeed, there are no textual, teleological or contextual elements of EU law that could lead to such a solution.

77. Accordingly, I do not believe that there is any scope for introducing an obligation to indicate on the goods their intended use. Not only would this create additional costs for the proprietor, but it would be a limited solution. In practice, there would be nothing to prevent the actual destination of the goods from being different from the one indicated. As a result, such an obligation might make it more complicated to transfer the distribution of a certain product from one market to another, essentially limiting the freedom of movement of goods provided for in Article 36 TFEU. Furthermore, an obligation of this type, entailing additional financial costs for trade mark proprietors, could potentially lead to illegal import practices.

78. Nevertheless, in order for the right to an effective remedy to be respected, there must be a guarantee that the court can examine the question of which products have been put on the internal market and which have not.

79. Ideally, this would be checked during the proceedings on the merits of the case, with the result that the finding is reproduced in the operative part of the judgment.

80. The identification of the products in the judgment of the court ruling on the merits would be the result of an interpretation in accordance with EU law, thus ensuring full compliance with the abovementioned principles of effective judicial protection.

81. If this is not possible, as seems clear from the representation of the referring court, because it would presuppose the prior indication by the trade mark proprietor of the final destination of the goods, that finding could also be postponed to the enforcement stage, provided that, at that time, the defendant is able to use the appropriate procedural instruments to obtain a ‘court’ ruling on the question of fact relevant for the purposes of adjudicating upon the proceedings before the court, namely the precise identification of the goods put on the market within the EEA and protected by the trade mark.

82. Lastly, the overall assessment of the adequacy of the national procedural system should consider the possible existence of a system of civil liability for unjustified seizures which, while representing an *ex post* remedy, could be deemed a satisfactory remedy for the damage suffered in the event of illegal seizures, while having a deterrent effect on the right holder, who would thus be dissuaded from applying for protective measures without evidence of the unlawful origin of the products. As the applicant pointed out in its observations,³⁷ there are already examples of domestic laws in Europe which provide for an internal procedure along the lines of the abovementioned scheme, designed to strike a balance between the free movement of goods and the prevention of infringements.

³⁷ Paragraph 21 of the applicant’s observations. Reference is also made to paragraphs 54 to 80 for a description of the procedures in force in certain Member States with regard to interim measures and enforcement.

83. Evidently, the national court is responsible for the assessments in each case. It will therefore have to establish whether, in the light of the principles of EU law set out above, the national procedural order specifically grants the defendant in a case relating to the protection of the EU trade mark the right to full judicial protection.

2. *The burden of proving the consent of the trade mark proprietor*

84. As a general rule, the burden of proving the consent of the trade mark proprietor lies with the party alleging consent. Indeed, the Court of Justice has consistently held that the burden of proving the consent of the trade mark proprietor lies with the party alleging such consent.³⁸

85. However, situations may arise in which that rule must be modified. According to *Van Doren + Q*, proof of compliance with the conditions for the exhaustion of trade mark rights lies with the proprietor if the application of the general rule – that is, proof by the defendant – could have the effect of allowing the proprietor of the right to partition national markets,³⁹ a risk that, as the Court of Justice held in that judgment, exists ‘in situations where ... the trade mark proprietor markets [its] products in the EEA using an exclusive distribution system’.⁴⁰

86. Indeed, if the defendant were unable to obtain the information needed to determine whether the product in question was intended by the proprietor of the EU trade mark to be put on the EEA market, negative effects such as fragmentation of the internal market could occur. In such cases, the burden of proof could be reversed with the effect that it would be ‘for the proprietor of the trade mark to establish that the products were initially placed on the market outside the EEA by [it] or with [its] 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 EEA’.⁴¹

87. Therefore, proving that the proprietor of the trade mark uses an exclusive distribution system is sufficient for the burden of proof to be reversed in those circumstances.

88. Nevertheless, it is unclear from the evidence provided by the referring court whether that criterion is satisfied in the present case: on the contrary, the applicant denies using an exclusive distribution system, although it claims that only one operator has the status of authorised distributor in Polish territory and that, alongside the distribution network set up jointly with Harman, various other operators distribute Harman products in Poland – indeed the defendant itself had that role.⁴²

89. Accordingly, it will be for the national court to establish whether, in the present case, the distribution by the applicant can be regarded as exclusive. If so, according to *Van Doren + Q*, the burden of proof could be reversed, with the result that the applicant, the proprietor of the trade mark, would have the burden of proving that the right had not been exhausted.

³⁸ See judgment of 20 November 2001, *Zino Davidoff and Levi Strauss* (C-414/99 to C-416/99, EU:C:2001:617, paragraph 54).

³⁹ See judgments of 20 November 2001, *Zino Davidoff and Levi Strauss* (C-414/99 to C-416/99, EU:C:2001:617, paragraph 54); of 8 April 2003, *Van Doren + Q* (C-244/00, EU:C:2003:204, paragraphs 37 and 38); and of 20 December 2017, *Schweppes* (C-291/16, EU:C:2017:990, paragraph 52).

⁴⁰ Judgment of 8 April 2003, *Van Doren + Q* (C-244/00, EU:C:2003:204, paragraph 39).

⁴¹ Judgment of 8 April 2003, *Van Doren + Q* (C-244/00, EU:C:2003:204, paragraph 41).

⁴² Observations of the applicant in the main proceedings, paragraph 6.

90. If no exclusive distribution is found to exist, the modification of the traditional rules of evidence could be allowed in proceedings for infringement of an exclusive trade mark, depending on the specific circumstances in which the goods are marketed. If there is no indication on the goods of where they were first put on the market, the court – having determined that there are no practical remedies that can overcome that evidentiary problem – will modify the burden of proof in accordance with the abovementioned principle of effective judicial protection.

91. The investigation to be carried out by the national court will seek to verify that the defendant is not in a situation of '*probatio diabolica*', because the factual elements that can demonstrate the exhaustion of the trade mark right are completely outside its sphere of influence and knowledge.

92. I would point out, however, that just because it is difficult for the defendant to obtain information from its supplier, that cannot be the only factor justifying the modified burden of proof.

93. If the exclusive distribution is not established by the proprietor of the trade mark, the modification of the burden of proof relating to the exhaustion of the trade mark right should only be considered feasible if it is impossible in practice for the defendant to adduce evidence of that circumstance which is the basis of the right asserted.

IV. Conclusion

94. On the basis of all the foregoing considerations, I propose that the Court answer the question referred for a preliminary ruling by the Sąd Okręgowy w Warszawie (Regional Court, Warsaw, Poland) as follows:

Article 15(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, read in the light of the second sentence of Article 36 TFEU, Article 19(1) TEU and Article 47 of the Charter of Fundamental Rights of the European Union,

must be interpreted as meaning that EU law does not preclude the practice whereby, in proceedings for the protection of the EU trade mark, the court uses general wording in the operative part of the judgment, thus leaving it to the enforcement authority to identify the goods covered by the ruling. This is on condition that the defendant is allowed to challenge the identification of the goods put on the market in the enforcement proceedings and that a court can examine and determine which goods have actually been put on the market in the EEA with the consent of the trade mark proprietor. In a case relating to the protection of the EU trade mark, where the defendant relies on the exhaustion of rights but does not have access to the necessary information, the national court must consider the possibility of modifying the allocation of the burden of proof both in the event that the distribution is found to be exclusive, and in the event that proof of the factual circumstances in support of the defendant's pleas is impossible in practice.