Teka Komisji Prawniczej PAN Oddział w Lublinie
vol. XVIII, 2025, no. 2, pp. 153–165
https://doi.org/10.32084/tkp.10247

NO OBJECTION BY THE TRADEMARK OWNER TO PARALLEL IMPORTS OF A MEDICINE – COMMENTS IN LIGHT OF THE SUPREME COURT RULING IN THE BENALAPRIL CASE

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Abstract. Parallel import of repackaged medicinal products have been a constant subject of CJEU case law since the 1970s. One might therefore assume that all relevant issues have already been clarified and that the interpretation of the legal basis of this economic phenomenon is no longer in doubt. However, even such a seemingly simple institution as the obligation to notify the intention to market a repackaged medicinal product can, in the practice and theory of industrial property law, give rise to disputes and lead to completely different rulings by the highest courts of the Member States. An example of this is the recent judgment of the Polish Supreme Court in the *Benalapril* case. The interpretation of the above-mentioned premise adopted in this judgment differs to a significant extent, as regards the determination of the consequences of the trade mark owner's failure to oppose the notification, from the decisions of the courts of other Member States. The interpretation adopted also needs to be scrupulously assessed in the light of the CJEU case law, which has adopted interpretative guidelines suggesting a different solution to the legal issue that has arisen.

Keywords: free movement of goods; parallel trade; exhaustion of IP rights; repackaging; consistent interpretation

INTRODUCTORY REMARKS

Parallel import of medicinal products is a prime example of the implementation of the principle of free movement of goods.[1] It consists in a parallel importer purchasing a medicinal product in a Member State of the European Economic Area (European Union plus Iceland, Liechtenstein

[1] The rules on parallel imports were established in the course of interpreting the current Articles 34-36 of the Treaty on the Functioning of the European Union of 25 March 1957, OJ EU 2010 No. C 83 [hereinafter: TFEU]. For more on this subject, see the European Commission document "Commission Communication of 30 December 2003 on parallel imports of proprietary medicinal products for which marketing authorisations have already been granted", COM(2003) 839.

ISSN 1899-7694
e-ISSN 2719-7379

and Norway) a medicinal product that has been legally placed on the market there by the responsible entity (usually also the owner of the trademark appearing on the packaging) in order to subsequently sell that product in another EEA Member State.[2] The economic justification for parallel imports is the price differences for specific products in the countries of export and import, which make the whole venture economically viable. The price differences for pharmaceuticals in individual national markets are due to many factors, among which the pricing policy of pharmaceutical companies plays a significant role [Skubisz 2007, 419-52].

Pharmaceutical manufacturers, primarily in order to pursue their economic interests, take measures to counteract parallel imports of pharmaceuticals.[3] One of the methods of blocking parallel imports, quite commonly used in commercial practice, is to challenge the legality of the importer's actions as infringing intellectual property rights, primarily trademarks commonly used to identify medicines in commerce.[4]

Allegations of trademark infringement, as a means of blocking parallel imports, are in practice the most common tool for protecting the economic interests of manufacturers. Such allegations have by far the widest scope of application, in the sense that they can be used in virtually every case of parallel importation. In most cases of parallel importation of medicines, the parallel importer repackages the product in order to market it in the importing country. Due to the differences in the conditions for marketing medicines that persist in individual Member States, it is extremely rare for a parallel imported medicine to be placed on the market in the importing country

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[2] In this way, parallel imports of medicinal products constitute a direct implementation of the Cassis de Dijon formula, as defined in the EU acquis, which is the thesis adopted in the grounds for one of the fundamental judgments of the CJEU establishing the interpretation of the current Articles 34-36 TFEU (judgment of 20 February 1979 in Case 120-78 *Rewe-Zentral AG v Bundesmonopolverwaltung für Branntwein*, ECLI:EU:C:1979:42).

[3] Such actions take place despite the fact that parallel imports of medicinal products are beneficial from the point of view of patients and the budget of the importing country. The social benefits result from lower drug prices for patients and, consequently, increased availability. The economic benefits include savings for patients and the state budget, as well as the direct impact of parallel imports on the realisation of the EU (and, more broadly, EEA) pharmaceutical market. In view of these benefits, the national legislation of EU Member States contains regulations supporting parallel imports of medicinal products in various ways. A classic example is German law, which stipulates that a certain percentage of medicinal products placed on the German market must come from parallel imports. Polish law, specifically the Pharmaceutical Law Act of 6 September 2001, also contributes to an increase in parallel imports by introducing a simplified procedure for granting parallel import licences.

[4] There is no doubt that medicinal products are identified in trade by trademarks rather than by the name of the active substance or other INN markings. This applies to identification by entities holding marketing authorisations (i.e. usually manufacturers) and, consequently, also by subsequent participants in the market, i.e. doctors, pharmacists and, ultimately, patients.

in an unchanged form, i.e. without repackaging.[5] The need for a parallel importer to take such measures, consisting in broadly understood repackaging and undoubtedly constituting an interference with the original packaging of the product imposed by law,[6] opens the door to opposition from the manufacturer on the grounds of a more or less hypothetical infringement of the function of the trademark affixed to the product packaging.

Against the backdrop of parallel imports of medicines, there is therefore a conflict between two important principles: the Treaty principle of free movement of goods, on which the functioning of the EU internal market is based, and the principle of intellectual property protection,[7] implemented in EU law through secondary legislation.[8] In the case law of the Court of Justice of the EU, numerous attempts have been made to balance these two principles in relation to parallel imports of repackaged medicines,[9] with the aim of ensuring that the conflicting interests of market participants are respected and that the public interest, expressed, for example, in the right of patients to access medicines, is taken into account.[10] These attempts have led to the formulation of conditions for the admissibility of parallel imports of repackaged medicinal products, which are currently identified in parallel import practice and legal doctrine as the "BMS conditions."[11]

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5 In this regard, it suffices to refer to the provisions regulating the obligation to label medicines – both in terms of information on the packaging and information in the leaflet – in the language of the Member State concerned. For this reason alone, a medicine originating, for example, from the German market cannot be sold in the territory of the Republic of Poland without modification. This stems from provisions of Polish pharmaceutical law.

6 For the concept of "repackaging" in relation to parallel imports, see Dudzik 2022, 408-14.

7 The principle of free movement of goods may be restricted in exceptional cases to the extent justified by the protection of rights constituting a specific subject of industrial property. At the same time, the protection of industrial property rights must not lead to a disguised restriction on trade between Member States (see Articles 34-36 TFEU and the judgment of the Court of Justice in *Hoffmann-La Roche*, point 14, and the judgments of 12 October 1999 in the *Upjohn* case, points 37-38, and of 12 April 2002 in the *Boehringer* case, points 14-15, texts of the above-mentioned judgments in Polish in: Skubisz 2008, point 18, 20, 22 and 24).

8 Trademark Directive and EUTR.

9 Starting with the ECJ judgment of 23 May 1978 in Case 102/77 *Hoffmann-LaRoche & Co. AG* v *Centrafarm Vertriebsgesellschaft Pharmazetischer Erzeugnisse mbH*., ECR 1978, p. 01139; text in Polish in: Skubisz 2008, 303, point 18.

10 Recently, on the issue of the necessity to take into account the public interest, see the judgment of the Supreme Court of Lithuania of 10 January 2024, ref. no. e3K-3-46-313/2024 (available at https://www.lat.lt/byloje-spresta-del-lygiagretaus-vaistu-importuotojo-teises-perpakuoti-iskitos-es-valstybes-i-lietuva-importuojamus-to-paties-gamintojo-vaistus/1578). Importantly, this judgment was issued on the basis of facts almost identical to those in the *Benalapril* case. However, the Lithuanian Supreme Court adopted a diametrically different legal assessment of parallel imports and conclusions compared to the judgment of the Polish Supreme Court.

11 The name comes from the designation of the party to the proceedings before the ECJ in which the judgment establishing the current content of these premises was issued, i.e. the judgment in the Bristol-Myers Squibb case. The conditions for parallel imports of medicines within

One of these conditions is prior notification by the importer to the trademark owner of their intention to market a repackaged product from parallel import, combined with the obligation to send a sample of the repackaged product at the request of the trademark owner.[12] The subject of this statement is an assessment of the legal consequences of the trademark owner's failure to object to the notification in the context of a subsequent allegation of trademark infringement. This issue will be analysed in the light of the position of the Supreme Court in its judgment of 6 May 2022 in the Benalapril case.[13]

1. FACTS OF THE BENALAPRIL CASE

In the case in question, a parallel importer purchased a medicinal product labelled "Berlipril" on the Lithuanian market. Acting on the basis of a parallel import licence, it marketed this product on the Polish market after repackaging it in new outer packaging and changing its name to "Benalapril". The name change, referred to in practice as rebranding, resulted from the fact that the parallel imported medicinal product was marketed in Poland under this name by the manufacturer and owner of both trademarks – Berlipril and Benalapril. The name change was therefore justified by the need to inform patients about the identity of the imported medicine (Berlipril) and the medicine already on the Polish market (Benalapril).

In fulfilling its notification obligation, the parallel importer informed the owner of the Benalapril trademark of its intention to import the medicinal product from Lithuania to Poland. In addition, the importer attached

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the European Union, in the context of possible restrictions arising from industrial property rights, have been regulated in detail in the case law of the Court of Justice of the European Union. They were originally developed on the basis of the current Articles 34-36 TFEU (cf. the above-mentioned judgment of the CJEU in Case 102/77 *Hoffmann-LaRoche*). The Court then transferred the interpretation developed in this way in its entirety to the provisions of subsequent directives harmonising trademark law. According to this case law, opposition by the proprietor of a trade mark to the offering and marketing of parallel imported and repackaged medicinal products in packaging bearing the registered trade mark constitutes a disguised restriction on trade between Member States and is therefore not permissible if five specific conditions (BMS conditions) are cumulatively met: a) raising objections concerning infringement of the trade mark protection right would create a risk of artificial partitioning of the markets between Member States; b) repackaging does not affect the original condition of the product; c) the appearance of the repackaged product does not damage the reputation of the trademark and its owner; d) the new packaging contains information about the repackager and the name of the manufacturer; e) before placing the repackaged goods on the market, the importer informed the owner and, at the owner's request, provided him with samples of the packaging. The grounds for BMS are discussed in: Skubisz 2017, 108-1094.

[12] With regard to the origin of this condition and its interpretation in CJEU case law, see: Stothers 2007, 109.

[13] Polish Supreme Court ruling of 6 May 2022, ref. no. II CSKP 457/22, OSNC 2023, No. 2, item 17.

a sample of the repackaged product to the notification. In the notification, the importer clearly indicated that the imported medicine was to be marketed in Poland under the name "Benalapril" and not under the name "Berlipril" as on the Lithuanian market. Furthermore, this circumstance was obvious in light of the markings on the repackaged sample attached to the notification, as well as the decision of the competent authority granting the parallel import licence for the medicinal product under a specific name.

In response to the notification, the trademark owner objected to the planned marketing of the imported medicinal product. He indicated only two grounds for opposition: a) there was no need to repackage the product in new outer packaging, as it was sufficient to apply new self-adhesive labels to the original packaging; b) no information about the manufacturer was provided on the sample packaging. In response to the notification, the trademark owner did not object to the change of the trade name of the medicine.

It was only in the lawsuit against the importer that the trademark owner raised the objection for the first time that "changing the name of the medicine to Benalapril is not objectively necessary to ensure that the Imported Medicinal Product has actual access to the market." At the same time, however, it should be emphasised that even with this objection, the owner did not object to the continued use of the Benalapril trademark in combination with the Berlipril trademark on the packaging of the imported product. Moreover, the trademark owner admitted that this was necessary in order to inform patients that the parallel imported medicinal product was identical to the medicinal product offered on the Polish market. Subsequently, during the proceedings before the court of first instance, the trademark owner amended the statement of claim by adding a new claim concerning the prohibition of changing the trademark (product name).

2. SUBSEQUENT RULINGS IN THE CASE

The court of first instance found that the trademark owner did not object to the replacement of the trademark in response to the notification. However, in the court's opinion, the fact that the claimant did not raise an objection to the replacement of the trademark on a parallel imported product in response to the notification did not deprive him of the possibility of subsequently bringing claims based on that objection. Consequently, a judgment was issued holding the importer liable for trademark infringement consisting in the unauthorised rebranding of the product.

The defendant appealed against the judgment of the court of first instance. In its judgment of 25 October 2019, the court of second instance held that the claim based on the allegation of trademark substitution was

not justified. The court found that in a situation where the trademark owner's objection, raised in response to the notification, did not concern the replacement of the trademark at all, but only the repackaging of the medicine in new outer packaging and the placement of information about the manufacturer on the new packaging, this issue could not be the subject of subsequent claims by the trademark owner. In justifying this position, the court of second instance pointed out that, pursuant to Article 296(2)(1) of the Industrial Property Law Act, infringement of a trademark protection right consists in the unlawful use in trade of a sign identical to a registered trademark in relation to identical goods. The basic prerequisite for infringement of a trademark right specified in Article 296(2) of the Industrial Property Law is the unlawful nature of the use of the mark in trade. The use of a trademark will not be unlawful if the right holder consents to its use or if the law permits a specific manner of use of another person's trademark. The Benalapril trademark is used by the claimant in Poland as the name of a medicinal product. The defendant notified its intention to use this mark also as the name of a parallel imported medicinal product, and the claimant did not object to the use of the name itself at that time, but objected to the repackaging of the medicine. The failure of the trademark owner to object to specific actions of the parallel importer within a reasonable time period constitutes de facto confirmation by the right holder that all conditions for the admissibility (legality) of commencing and conducting parallel imports of the medicinal product in question have been met. If the proprietor of the trademark subsequently claims that any of the BMS conditions have not been met, they should indicate the factual circumstances that occurred between the expiry of the reasonable period for filing an objection and the actual filing of the objection, which would justify a change in the proprietor's position. Otherwise, the holder's actions must be considered arbitrary, undermining the principle of legal certainty.[14]

Furthermore, the Court of Appeal stated that it agreed with the appellant that the objection must raise an interpretation of the relevant provisions, as resulting from the contested judgment, which boils down to a conclusion that it is permissible to raise any allegations in the action which, in the opinion of the trademark owner, justify claims against the parallel importer, regardless of whether these allegations were raised at the notification stage. This would mean admitting allegations which the defendant had no opportunity to assess at the notification stage, i.e. before the product was placed on the market in Poland. Consequently, this would deprive the parallel importer of the opportunity to adapt its planned activities (e. g. in the appearance

[14] Judgment of the Regional Court in Warsaw of 24 July 2017, ref. no. XXII GWzt 2/17, p. 55 of the grounds.

of the packaging) to the objections raised by the right holder, which, hypothetically speaking, could be assessed by the importer as justified.[15]

The decision of the court of second instance was challenged by the Supreme Court. In the grounds for its judgment of 6 May 2022, the Supreme Court adopted an interpretation according to which the notification of the intention to repackage, which is one of the criteria of the BMS test, is the obligation of the parallel importer and is primarily intended to protect the trademark owner. The Supreme Court then stated *expressis verbis* that "in the context of the findings of fact made in the case, it is difficult to see any reasons why the plaintiff's failure to specifically notify the defendant of its intention to protect the trademark would lead to the plaintiff being denied judicial protection on the grounds of abuse of subjective rights. As a rule, entities whose rights are infringed are not required to warn potential infringers about the consequences of unlawful actions, and the possibility of exercising protective claims is not dependent on prior notification of the infringer of the intention to seek protection or on opposition to the announced (notified) infringement within a specified period."[16]

The Supreme Court's ruling raises serious concerns as to its compatibility with EU law. It does not take into account in any way the case law of the CJEU, which defines the functions of the obligation to notify the intention to import in parallel, as well as the legal nature and scope of the obligations incumbent on the parallel importer and the trademark owner as the notified entity. This is clear from the cited excerpts from the judgment, as the Supreme Court did not refer to the case law of the CJEU at all. On this basis alone, it is possible to argue that the ruling in question is flawed. By disregarding the case law of the CJEU, the Supreme Court failed to fulfil its obligation to interpret national law in accordance with EU law. It is impossible to assess the decision of the national court, which concerns an issue regulated in principle exclusively by Community case law, without referring to that case law in any way.

At the same time, the Supreme Court's judgment is inconsistent with the earlier case law of Polish courts and the case law of national courts of Member States.[17] Consequently, in the light of the Supreme Court's judgment in question, a fundamental doubt arises as to the basis for its legal assessment of the effects of the trademark owner's failure to object to the notified marketing of a medicinal product under a changed trademark.

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[15] Judgment of the Court of Appeal in Warsaw of 25 October 2019, ref. no. VII AGa 1191/18, p. 56 of the justification.

[16] Ref. no. II CSKP 457/22, 13.

[17] See the judgment of the Regional Court in Warsaw of 9 August 2016, ref. no. XXII GWzt 78/16.

3. THE EFFECTS OF THE LACK OF OPPOSITION BY THE TRADEMARK OWNER IN THE LIGHT OF CJEU CASE LAW AND THE CASE LAW OF THE COURTS OF THE MEMBER STATES

When assessing this issue, it should be emphasised at the outset that there is as yet no CJEU judgment which categorically states that the scope of the objections raised by the trademark owner in response to the notification defines in any way the objections and claims of a possible lawsuit. On the other hand, there is also no ruling which would imply that the proprietor has complete freedom in shaping the scope of these objections, regardless of his response to the parallel importer's notification.

However, it is reasonable to assume that, in the light of the case law of the CJEU, there are more arguments in favour of the thesis that the prerequisite for the notification obligation should be interpreted in such a way that the manner in which the trademark owner responds to the notification (the scope of the objections raised in the opposition to the notification) is relevant to the assessment of the validity of the subsequent allegations in the lawsuit. Thus, referring to the specific issue that arose in the Benalapril dispute, it is correct to conclude that it is not permissible for the trademark owner to oppose the marketing of a parallel imported medicinal product in packaging bearing the trademark used by the trademark owner in the country of importation where the parallel importer has notified the trademark owner of its intention to replace the trademark under which the product was sold by the trademark owner in the country of export with the trademark used by the trademark owner in the country of import for the same medicinal product, and the latter did not object to such a change of trademarks in response to the notification. However, the absence of objection by the trademark owner should be understood as both a situation in which the trademark owner does not object at all to the notified intention to import a parallel medicinal product, as well as even more so a situation in which he did raise an objection, but the allegations contained in the objection did not cover the replacement of the trademark on the parallel imported product.

In justifying the validity of such an interpretation of EU law, reference should be made first and foremost to arguments concerning the function of the notification obligation and the distribution of obligations between the parties to the notification resulting from that function.

Further considerations should therefore begin with the statement that, according to established CJEU case law, a parallel importer is obliged to notify the trademark owner of its intention to market a parallel imported medicinal product in the country of importation and to provide, at the request of the trademark owner, a sample of the repackaged product. The Court has held that a parallel importer must comply with the notification obligation in order

to place repackaged medicinal products on the market in packaging bearing a protected trademark. If the parallel importer fails to comply with this obligation, the trademark owner may oppose the marketing of repackaged medicinal products.[18] The Court also held that failure to comply with the notification obligation constitutes an infringement of the trademark per se.

However, in the light of the case law of the CJEU, the position implicitly adopted by the Supreme Court that the notification of the intention to engage in parallel importation is intended solely to protect the proprietor of the trademark is incorrect. In the aforementioned judgment in Case C-143/00, the Court confirmed that the purpose of the notification obligation is to protect the legitimate interests of the trademark owner. However, in the same judgment, the Court also pointed out that "[…] the fulfilment of that obligation does not pose any practical problems for parallel importers, provided that the proprietor responds to the notification within a reasonable time. The proper functioning of the notification system therefore presupposes that both parties concerned make genuine efforts to respect each other's legitimate interests."[19] It is therefore clear from the above excerpt from the CJEU judgment that a correctly interpreted notification obligation presupposes mutual respect for the legitimate interests of both parties – the trademark owner and the parallel importer. On this basis, it can be assumed that the thesis of a completely unilateral nature of the obligation imposed on the parallel importer is not justified.[20] Consequently, the interpretation of the Supreme Court in this respect already departs from the case law of the CJEU.

Moving on, it is necessary to determine what constitutes the legitimate interest of the parallel importer, in relation to which the Court finds that the trademark owner has an obligation to respect. In this context, it should be assumed that since the purpose of the notification obligation is to enable the trade mark proprietor to carry out a preventive assessment of the legality of parallel imports on the basis of the information provided by the parallel importer, the parallel importer may reasonably assume that, in the event of proper notification, such an assessment is actually carried out by the trade mark proprietor. Consequently, the parallel importer may reasonably expect that if the trademark owner accepts the objections, he will be informed of those objections in the form of an opposition to parallel importation. This is important because in such a case, taking into account the legitimate

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18 Judgment of the CJEU of 23 April 2002 in case C-143/00, *Boehringer Ingelheim and others*, ECR 2002, p. I-3759, point 63; text in Polish in: Skubisz 2008, para. 24.

19 Ibid., para. 62 of the grounds.

20 The Court confirmed this in subsequent case law (judgment of the CJEU in Case C-276/05 – *The Wellcome Foundation Ltd.,* ECLI:EU:C:2008:756, para. 34); similarly, Advocate General E. Sharpstone in his Opinion of 6 April 2006 in Case C-348/04 Boehringer II, ECLI:EU:C:2006:235, paras 67-80.

objections of the trademark owner, the parallel importer may abandon its intention to market the parallel imported product or modify the appearance of the repackaged product, including the use of the relevant trademark.

It should also be noted that in the absence of a response from the trademark owner, the basic purpose of the notification obligation, i.e. the preventive assessment of the legality of parallel imports and, consequently, the prevention of the marketing of parallel imports that do not meet the conditions for admissibility, cannot be achieved. It should also be obvious that the preventive assessment of notified parallel imports is not an end in itself. It is merely a means to achieve the proper objective, i.e. to prevent the marketing of products that infringe the trademark right. This objective cannot be achieved at all if the trademark owner does not raise any objections to the notified parallel imports or raises objections other than those which subsequently form the basis of his claims.

In view of the above, it should be confirmed that, firstly, the procedure for notifying the intention to import parallel imports is based on the principle of mutual respect for the legitimate interests of both parties. Secondly, the notification of parallel imports presupposes the existence of two interrelated obligations. The first obligation is imposed on the parallel importer. It concerns the notification of parallel imports and the presentation of a sample of the product at the request of the trademark owner. The second obligation is imposed on the trademark owner. It concerns informing the parallel importer of the objections to the notified parallel imports.

The position that the trademark owner has such an obligation stems from the case law of the CJEU. This can be inferred from the Court's position on the time limit within which the trademark owner should present its objections to the notified parallel import. In its judgment in Case C-143/00 Boehringer I, the Court stated that "[…] finally, the Court has not yet ruled on the time limit available to the proprietor to take action against the intended repackaging of a medicinal product bearing his trade mark. In that regard, there is no doubt that, although in the light of the objective pursued by the notification obligation it is reasonable for the proprietor to have a reasonable period of time to take action against the intended repackaging, the interests of the parallel importer in being able to place the medicinal product on the market as soon as possible, after obtaining the necessary authorisation from the competent authority. In the present case, it is for the national court to determine, in the light of all the relevant circumstances of the case, whether the proprietor of the trade mark had sufficient time to take action against the intended repackaging."[21] On that basis, the Court

[21] Judgment of the CJEU of 23 April 2002 in Case C-143/00, *Boehringer Ingelheim and Others*, paras 66-67.

set a period of 15 working days as a reasonable period for the trade mark proprietor to respond.

Applying the interpretation *a maiori ad minus*, it should be assumed that since the Court indicated, even if only approximately, the deadline for the owner of the trademark to respond to the notification, it also established the existence of an obligation on the part of the trademark owner to provide such a response – the obligation to present objections. Otherwise, the Court's position on the deadline would be irrelevant.

In view of the above, an attempt can be made to assess the legal consequences of the trademark owner's failure to fulfil the obligation to present objections to the notified intention of parallel importation. In this context, it should be noted that the specific conditions for the admissibility of parallel imports (BMS conditions) serve to determine whether there is an infringement of the trade mark right within the meaning of Articles 10 and 15 of Directive 2015/2436.

Article 5 of Directive 2008/95 clearly states that the general condition for trademark infringement is the unlawful nature of the actions of a third party, i.e. actions taken without the consent of the trademark owner. In view of the above comments on the nature and scope of the obligations of the importer and the trademark owner, it should be assumed that if the latter does not object to the notified parallel import, it is reasonable to assume that the subsequent marketing of the parallel imported product in the notified form is undertaken with the consent of the trademark owner. Thus, the general prerequisite for trademark infringement – the unlawful nature of the third party's actions – is not met.[22]

This interpretation is confirmed by the case law of the national courts of the Member States. This follows in particular from the judgment of the German Federal Court of Justice in Aspirin II case.[23] In that judgment, it was expressly held that the proprietor of a trade mark cannot effectively bring an action for an injunction against a parallel importer if he has not raised an objection within a reasonable time to the parallel importer's activities notified to him or has raised an objection only to certain aspects of those activities, and then justifies his claim in a different way in the

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[22] The same applies to a situation where the proprietor of a trade mark has lodged an objection to the notified intention to import parallel goods, but has not indicated in the objection the ground on which it subsequently bases its claims against the parallel importer. In this case, the purpose of the notification of parallel import is not fulfilled to the same extent as in the absence of an opposition.

[23] Judgment of the Federal Court of Justice (BGH) of 12 July 2007 in case I ZR 147/04 *Aspirin II*, available at https://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&nr=38148&pos=0&anz=1, together with the case law cited therein.

statement of claim. This follows in particular from recital 27 of the grounds for the judgment, in which the German BGH stated as follows: Like any legal relationship, this legal obligation is subject to the principles of good faith (see BGH, judgment of 19 June 1986 – I ZR 65/84, GRUR 1987, 54, 55 = WRP 1986, 672 – Obligation of the warned party to provide information; judgment of 19 October 1989 – I ZR 63/88, GRUR 1990, 381 = WRP 1990, 276 – obligation of the warned party to respond). The purpose of prior notification is to quickly clarify between the parties whether the manner in which the imported medicinal product is to be marketed, as announced by the parallel importer, raises objections on the part of the trademark owner, as a result of which the parallel importer can rely to a certain extent on the trademark owner's response. If the latter does not object to the intended repackaging in the form notified or only objects to it from a certain point of view, the parallel importer may rely on the fact that the trademark owner will not bring any future claims against him based on the trademark from the factual or legal point of view to which he has not yet objected. If the trademark owner nevertheless asserts a claim, citing a circumstance to which he did not object within a reasonable time after prior notification, he is acting in bad faith (para. 242 BGB), because in doing so he contradicts his own behaviour in response to the prior notification (see BGHZ 94, 344, 354; 154, 230, 238).

In view of the above ruling of the BGH, it is reasonable to take the position that, firstly, the procedure for notifying the intention to import parallel imports is based on the principle of mutual respect for the legitimate interests of both parties. Secondly, the notification of parallel imports presupposes the existence of two interrelated obligations. The first obligation is imposed on the parallel importer. It concerns the notification of parallel imports and the presentation of a sample of the product at the request of the trademark owner. The second obligation is imposed on the trademark owner. It concerns informing the parallel importer of the actual allegations concerning the notified parallel imports. The notification obligation creates a special legal relationship between the trademark owner and the importer, which includes a reasonable expectation on the part of the latter that the absence of objection or limited objection to the notified intention on the part of the former means consent to the notified actions or no objection to other aspects of the notified action (i.e. those aspects that have not been explicitly objected to by the trademark owner).[24]

[24] In this respect, the position of the BGH is largely identical to the interpretation adopted in the case under analysis by the Court of Appeal in Warsaw in its judgment ref. no. VII AGa 1191/18.

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