

**Report Q205**

in the name of the German Group  
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**Exhaustion of IPRs in cases of recycling and repair of goods**

**Questions**

**I) Analysis of the current statutory and case laws**

1) *Exhaustion*

*In your country, is exhaustion of IPRs provided either in statutory law or under case law with respect to patents, designs and trademarks? What legal provisions are applicable to exhaustion? What are the conditions under which an exhaustion of IPRs occurs? What are the legal consequences with regard to infringement and the enforcement of IPRs?*

a) Legal Basis of Exhaustion

aa) Patents

- 1) Exhaustion of patent rights can only be found in Sec. 9 b sentence 1 PatG, which came into effect on May 28, 2005 and which exclusively relates to patents for biological materials. If patented biological materials are put on the market, the effect of the patent does not extend to such materials which were created by generative or vegetative reproduction, if the reproduction was the purpose for which the material was put on the market.
- 2) Beside that, neither the Patent Act nor any other German law contains any regulations concerning the exhaustion of patents. Instead, the rules for the exhaustion of patent rights were developed first by the Reichsgericht and then by the Federal Supreme Court. The courts then continued to develop the rules of exhaustion taking into account Art. 28 of the EC Treaty in the Amsterdam version of October 2, 1997 which came into force on May 1, 1999 (BGBl. 1998 II, 386; 1999 II, 296) (formerly Art. 30 EC Treaty). According to this article, quantitative restrictions on imports and all measures having equivalent effect shall be prohibited between Member States. Otherwise, if the patent proprietor had the right to stop the import of patented products which were put on the market in another member state by himself or with his consent, this would enable him to close off the national markets and to limit the trade between member states, although such a limitation would not be necessary in order to maintain in essence the exclusive rights he is entitled to under the parallel patents.<sup>1</sup>

bb) Other property rights

- 3) Regulations for exhaustion under Trademark Law can be found in Sec. 24 Para. 1 MarkenG. The Design Law (GeschmMG) contains a regulation of exhaustion in Sec. 48.

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<sup>1</sup> ECJ, GRUR Int 1974, 454 - Centrafarm.

b) Prerequisites of exhaustion

aa) Patents

- 4) According to consistent rulings of the courts, rights from a patent granted with effect for the Federal Republic of Germany are exhausted in any case, if the protected product has been put on the market by the patent proprietor or with his consent in Germany, a Member State of the European Union (EU) or a Member State of the European Economic Area (EEA)<sup>2</sup>. A product is considered having been put on the market if the patented product is actually transferred into the power of disposal of another person, thereby giving up one's own power of disposal.<sup>3</sup> The actual status of ownership is not important.<sup>4</sup>

It is generally necessary, that the complete product is put on the market, and not only (patent free) parts thereof<sup>5</sup>. It is not clear yet, however, where the limits of this principle are, if for example the invention is limited to the part that is being put on the market.

bb) Other property rights

- 5) According to Sec. 48 GeschMG, the same prerequisites apply with respect to the exhaustion of design rights. The product must also have been put on the market by the owner of the right or with his consent within the EU or the EEA.
- 6) According to Sec. 24 MarkenG trademark rights are exhausted if a product was put on the market under the trade name by the owner of the trademark right or with his consent within the EU or the EEA. Sec. 24 para. 2 MarkenG additionally provides for a negative condition. Exhaustion does not occur if the owner of the trademark opposes the use of the trademark in connection with the continued sale of the goods for justified reasons. This is in particular the case if the state of the goods is modified or deteriorated after they have been put on the market.

c) Legal consequences of exhaustion

aa) Patents

- 7) The legal consequence of exhaustion under patent law is the consumption of the property right with respect to the specific patented product. Generally, the acquirer of a patented device has the right to use it as intended, without requiring a permission of the property right owner<sup>6</sup>. If the invention is protected by device and method claims, both the device as well as the method become patent-free, provided that the device can only be used as intended by the protected method<sup>7</sup>.
- 8) If, however, a device is sold that is not protected by a patent, by means of which a protected method can be carried out, then there is no exhaustion of the method patent<sup>8</sup>. It has not been decided yet if this only applies if the device is designed in such a way that it does not represent a contributory patent infringement of the method claim according to Sec. 10 PatG. One argument in favour of this assumption is that otherwise no third party could market the device lawfully without the patent proprietor's consent. At least, the products produced by the method become free once they have been sold by the party

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<sup>2</sup> BGH GRUR 2000, 299 - Karate, GRUR 1997, 116, 117 - Prospekthalter.

<sup>3</sup> Benkard, Patentgesetz, 10th edition, München 2006, Sec. 9, para. 44 with further references.

<sup>4</sup> Benkard, *ibid.*, Sec. 9 para. 17.

<sup>5</sup> BGH GRUR 2004, 758, 761 - Flügelradzähler; LG München InstGE 13, 18 - Kruckenkörper.

<sup>6</sup> BGH GRUR 1998, 130, 132 - Handhabungsgerät.

<sup>7</sup> BGH GRUR 1998, 130, 132 - Handhabungsgerät.

<sup>8</sup> BGH GRUR 1970, 601, 602 - Fungizid; BGH GRUR 1980, 38, 39 - Fullplastverfahren; BGH GRUR 2001, 223, 224 - Bodenwaschanlage

authorized to do so.<sup>9</sup> In addition to that, it does not seem to agree with the principles of the free movement of goods according to Art. 28 and 30 EC Treaty, to make the exhaustion of a method patent dependent on whether there is only a method claim (no exhaustion) or also a device claim (exhaustion) for the same invention.

- 9) The exhaustion within the meaning of Sec. 9 b sentence 1 PatG concerning biological materials does, according to Sec. 9 sentence 2 PatG not comprise the exploitation of the materials obtained for further generative or vegetative reproduction. A further sale of the crops lawfully produced from the patented materials as seeds is therefore not admissible because it infringes the patent.<sup>10</sup> A repeated cultivation of the produced material is not comprised by exhaustion<sup>11</sup>.

bb) Other property rights

- 10) If exhaustion of a design right occurs, further acts of putting the design on the market are not subject to any right of prohibition<sup>12</sup>. The same applies with respect to the right of announcement.<sup>13</sup> In contrast to that, the right of reproduction is not affected by exhaustion.<sup>14</sup> Reproduction does not only comprise visual representation, but also the manufacture of products in accordance with the design<sup>15</sup>.

- 11) Under trademark law, exhaustion occurs with respect to all acts which could constitute a trademark infringement under Sec. 14 Para. 3 and 4 MarkenG. This concerns the right to sell, import, export and newly label the merchandise with the trademark in question. The new labelling is particularly relevant in connection with the repackaging of original merchandise, in particular pharmaceutical compositions. Apart from that, the right to advertise is also affected by exhaustion. Although the advertisement must relate to the specific item for which exhaustion has already occurred, according to consistent rulings of the courts, it should be sufficient if the advertising distributor is able to dispose of the merchandise at the intended time of sale without infringing the rights of the trademark owner<sup>16</sup>.

2) *International or national exhaustion*

*Does the law in your country apply international exhaustion for patents, designs or trademarks? If yes, are there any additional conditions for international exhaustion compared to regional or national exhaustion, such as a lack of marking on products that they are designated only for sale in a specific region or country or the non-existence of any contractual restrictions on dealers not to export products out of a certain region? What is the effect of breach of contractual restrictions by a purchaser?*

*If your law does not apply international exhaustion, is there regional exhaustion or is exhaustion limited to the territory of your country?*

*In case your country applies regional or national exhaustion, who has the burden of proof regarding the origin of the products and other prerequisites for exhaustion and to what extent?*

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<sup>9</sup> BGH GRUR 1980, 38, 39 - Fullplastverfahren.

<sup>10</sup> BT-Drucks. 15/1709 p. 12, 14.

<sup>11</sup> Benkard, Patentgesetz, 10th edition Sec. 9b para. 5.

<sup>12</sup> Eichmann/von Falckenstein, Geschmacksmustergesetz, 3rd edition, § 48, para. 9.

<sup>13</sup> ECJ GRUR Int 1998, 140 (No. 36) - Dior/Evora.

<sup>14</sup> BGH GRUR 2001, 51, 53 - Parfumflakon.

<sup>15</sup> BGH GRUR 2001, 51, 53 - Parfumflakon.

<sup>16</sup> BGH GRUR 2003, 878, 879 - Vier Ringe über Audi; BGH GRUR 2003, 340, 342 - Mitsubishi.

a) Regional limits of exhaustion

- 12) An exhaustion under patent law does not occur if the patented subject matter was put on the market outside the EU or the EEA.<sup>17</sup> The same applies under design law.
- 13) According to Sec. 24 MarkenG, trademark law does not provide for international exhaustion, either. With Sec. 24 MarkenG, the German legislator implemented the provisions of Art. 7 of the First Council Directive of 21 December 1988 to the approximation of laws of the Member States relating to trademarks (89/104/EWG, OJ EC No. L40/1 dated 11.2.1989 – Trademark Directive) into national law. According to the case law of the ECJ, national statutory provisions providing for international exhaustion under trademark law violate Art. 7 para. 2 of the Trademark Directive (ECJ Coll. 1998, 4799, 4832; GRUR Int. 1998, 695, 697 – Silhouette; ECJ GRUR Int. 1999, 870 - Sabega).

b) Burden of proof

- 14) The patent proprietor has to demonstrate and prove the use of the patent in suit by the defendant in any case. Since the principle of exhaustion is an exception to the sole and exclusive right of the patent owner, the one who invokes this exception has to prove it. The burden of proving that the prerequisites of exhaustion are met therefore has to be borne by the defendant who is accused of exploiting the patent in suit<sup>18</sup>.
- 15) However, the Federal Supreme Court had some reservations that the free movement of goods protected by Art. 28 EC Treaty could be impaired, if the disclosure of the source of origin by the user accused of infringing the patent enables the patent proprietor to close this source and seal off the national markets in the Community<sup>19</sup>. This question was submitted for a preliminary ruling to the ECJ who decided that the trademark owner bears the onus of proving that the goods were put on the market outside the EEA, if he puts the goods on the market using an exclusive distribution system and the third party is able to prove that there is an actual risk that the markets are sealed off if he has to furnish that proof. If the trademark owner manages to furnish this proof, then it is up to the third party in turn to prove that the trademark owner has consented to the further distribution of the goods in the European Economic Area<sup>20</sup>.
- 16) We assume that the same principles regarding the onus of proof apply to design rights as well.

3) *Implied license*

*Does the theory of implied license have any place in the laws of your country? If so, what differences should be noted between the two concepts of exhaustion and implied license?*

- 17) The principle of granting an implied license as a basis of exhaustion does not apply under German law. Rather, exhaustion marks out the limits of the property right owner's legal power and is therefore a provision that defines the content and limits<sup>21</sup> of the legal position of the property right owner protected by the constitutional guarantee of one's property rights.

Under patent law, the courts have regularly affirmed the presence of exhaustion with reference to the "doctrine of the interrelation of the different types of use"<sup>22</sup>. According to this doctrine, every purchaser is able to freely dispose of a patented good which has

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<sup>17</sup> BGHZ 49, 331, 334 - Voran; GRUR 1975, 598, 600 - Stapelvorrichtung.

<sup>18</sup> BGH GRUR 1976, 579, 581 - Tylosin; OLG Düsseldorf Mitt. 1978, 588, 589 - Inlandsvertreter.

<sup>19</sup> BGH GRUR 2000, 299, 302 - Karate, BGH GRUR 2000, 879, 882 - stüssy.

<sup>20</sup> EuGH GRUR 2003, 512 - Van Doren + Q; see also BGH GRUR 2004, 156, 157 - stüssy II.

<sup>21</sup> Busse, Patentgesetz, 6th edition, sec 9, para. 143.

<sup>22</sup> BGH GRUR 1975, 206, 207 - Kunststoffschäum-Bahnen.

been put on the market – yet not of the inventive concept realized by it. That means he can resell the good he has purchased, or use it as intended<sup>23</sup>. According to this definition of exhaustion based on the content and scope of the property right itself, the use and exploitation of the protected subject matter neither requires an explicit nor an implied license by the patent proprietor; the additional construct of an implied license is therefore expressly rejected by case law and literature.

18) Exhaustion is based on a weighing of interests in which the patent proprietor's interest in his property right must make way for the interest of the general public in the marketability of the product which has been put on the market with the patent proprietor's consent<sup>24</sup>. This is to avoid an excessive impairment of the trade with patented goods<sup>25</sup>. As consideration for his invention, the patent proprietor receives the exclusive right to manufacture commercial products himself and to put them on the market himself or exploit the invention by granting licenses to third parties. Once the patent proprietor has exercised his sole and exclusive right by putting the products on the market, there is no reason to allow him to interfere with the fate of these products any more. The reason regularly given is that the patent proprietor has already received a remuneration for his sole and exclusive right in connection with the sale of the patented object<sup>26</sup>.

19) The presence of an implied license is assumed, however, if the proprietor of a method patent sells a device which according to the contract is intended to perform the protected method. Pursuant to the purpose of such a purchase agreement it must therefore regularly be assumed that the seller has given the acquirer permission to use the protected method by means of the device, even if an explicit agreement on such a license has neither been laid down in the purchase agreement or elsewhere<sup>27</sup>. In this case, however, the method patent is specifically not exhausted<sup>28</sup>. Rather, there is a true, implied license agreement between the parties of this particular case, and not a generally applicable legal supposition; in individual cases it is indeed also conceivable that the parties have actually not concluded such an implied license agreement.

#### 4) *Repair of products protected by patents or designs*

*Under what conditions is a repair of patented or design-protected products permitted under your national law? What factors should be considered and weighed? Does your law provide for a specific definition of the term "repair" in this context?*

##### a) Patents

20) The issue of repairing protected devices becomes relevant in particular in connection with the assessment of a contributory patent infringement according to Sec. 10 PatG which says:

The effect of the patent is furthermore that any third party is prohibited from offering or supplying within the scope of the law to persons other than those entitled to exploit the patented invention means which relate to an essential element of the invention for using the invention within the scope of this law without the consent of the patent proprietor, if the third party knows or if it is obvious under the given circumstances that these means are suitable and intended for exploiting the invention.

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<sup>23</sup> BGH GRUR 1975, 598, 600 - Stapelvorrichtung, BGH GRUR 1980, 38,39 - Tylosin; BGH GRUR 1997, 116, 117 - Prospekthalter.

<sup>24</sup> BGH GRUR 2001, 51 - Parfumflakon.

<sup>25</sup> Benkard, Patentrecht, 10th edition, sec 9, para. 18.

<sup>26</sup> BGH GRUR 1959, 232, 233 - Förderrinne; GRUR 1973, 518, 520 - Spielautomat II.

<sup>27</sup> BGH GRUR 1980, 38, 39 - Fullplastverfahren, RGZ 135, 145, 148 - Bandenreifen.

<sup>28</sup> BGH GRUR 2004, 758, 761 - Flügelradzähler.

- 21) If an essential element of the patented device is replaced by the customer and the replacement part is not purchased from the patent or license holder, this may constitute a contributory patent infringement. An essential element of the invention is already present if it is suitable to functionally cooperate with one or several features of the patent claim in the implementation of the protected inventive concept.<sup>29</sup> However, a contributory patent infringement can be ruled out, if the person was entitled to exploit the invention. The entitlement can be the result of, among other things, the fact that exhaustion has occurred with respect to the protected subject matter.
- 22) Exhaustion comprises all actions which form part of the intended use of the device. Therefore, the maintenance and restoration of the fitness for use of the patented product (however, not the restoration of the product itself) are included in the exhaustion. If the operability and functional capacity of the specific product is impaired or eliminated by wear, damage or for other reasons, it is therefore permissible to repair the product<sup>30</sup>. The reconstruction of the product, however, as distinct from the permissible repair, is not a use according to the intended purpose.
- 23) The Federal Supreme Court has recently commented on the distinction between the prohibited reconstruction and the admissible repair of a patented device by the customer/licensee in several decisions.<sup>31</sup> According to the courts, it is necessary to determine, taking into account the specific characteristics, effects and advantages of the invention, if the measures taken still maintain the identity of the specific patented product that has already been put on the market, or if these measures amount to creating a new product that implements the invention. Apart from taking into account the specific characteristics of the subject matter of the invention, it is also important to weigh the interest of the patent proprietor in commercially exploiting the invention, which merits protection, against the customer's interest in freely using the product that has already been put on the market.<sup>32</sup>
- 24) If the parts are expendable parts which can usually be expected to be replaced during the lifetime of the product, it is generally suggested that the repair is admissible. However, a weighing of interests could still result in the assumption of a reconstruction, even if the part is an expendable part which may need to be replaced several times, if this expendable part incorporates essential elements of the inventive concept. If the replacement of this part newly realizes the technical or economic advantage of the invention, the weighing of interests will be in favour of the patent proprietor, because he has not drawn the benefit from the invention he is entitled to by placing the entire device on the market for the first time.<sup>33</sup>
- 25) The Federal Supreme Court continued along the lines of this case law in its "Pipettensystem" decision which involved the replacement of a syringe in a pipette system. The syringe to be replaced was neither an expendable part in the narrow sense, nor was the replacement of the disposable syringe an act of repair. Still the comparison with an expendable part was obvious, because the syringe also has to be replaced several times during the lifetime of the pipette system. A reconstruction is to be assumed in the case of a customary replacement, if the technical effects of the invention are incorporated specifically in the replaced part, because the invention influences its function and lifetime.

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<sup>29</sup> BGH GRUR 2004, 758, 761 - Flügelradzähler.

<sup>30</sup> BGH GRUR 2004, 758, 762 - Flügelradzähler.

<sup>31</sup> BGH GRUR 2007, 769 - Pipettensystem; BGH GRUR 2006, 837, 838 - Laufkranz; BGH GRUR 2004, 761 - Flügelradzähler.

<sup>32</sup> BGH GRUR 2007, 769, 772 - Pipettensystem; BGH GRUR 2006, 837 - Laufkranz; BGH GRUR 2004, 758, 762 - Flügelradzähler.

<sup>33</sup> BGH GRUR 2004, 761, 762 - Flügelradzähler.

<sup>34</sup> BGH GRUR 2007, 769, 772 - Pipettiersystem.

In the case to be decided, however, the syringe was the mere object of the improved function of the entire device according to the invention, which is why the court did not assume a reconstruction.<sup>34</sup> For the question if the measure taken still preserves the identity of the product, one first needs to ascertain what the technical effects of the invention are and where they become manifest.<sup>35</sup>

- 26) In summary it must be noted that the replacement of parts which regularly need to be replaced or repaired generally forms part of the intended use of the patented device. The patent proprietor's rights are therefore exhausted in this respect. An inadmissible reconstruction which is not comprised by the exhaustion can still be present in these cases, if the technical effects of the invention become apparent specifically in the part to be replaced. The assessment of the repair or reconstruction under the aspect of exhaustion therefore depends on the individual case. In making this assessment, the court seems to assume that the patent in question is valid and evaluates the technical achievement based on the description and the prior art described therein.
- 27) Moreover, repair that does not involve the replacement of parts of the patented device is allowable if it is minor in relation to the entire device, such as the restoration of defective spots by welding.<sup>36</sup>

#### b) Designs

- 28) When repairing products having a certain design, it is also necessary to make a delimitation against a reconstruction. Only repairs in the context of ordinary maintenance are allowable. If the repair work has considerable impact on the distinctive features of the product, the interest of the designer in the product's integrity is affected and the measure is therefore not subject to exhaustion.<sup>37</sup> The term "distinctive features" of the product in this case refers to the characteristic properties of the product.<sup>38</sup> In the opinion of the courts, a re-dyeing of textiles can interfere with the distinctiveness of a product in such a way that a different product is created.<sup>39</sup> In the "dyed jeans" case, what mattered was, inter alia, that instead of the subdued original colour, bright colours were used for the redyeing.

#### 5) *Recycling of products protected by patents or designs*

*Under what conditions is a recycling of patented or design-protected products permitted under your national law? What factors should be considered and weighed? Does your law provide for a specific definition of the term "recycling" in this context?*

- 29) Recycling is not permitted if this process is economically the same as the creation of a new product according to the invention, i.e. a reconstruction. A reconstruction is assumed if a patented device is recycled from parts of one or several objects which were destroyed or otherwise turned useless.<sup>40</sup> The same applies with respect to the recycling of patented substances from waste.<sup>41</sup> Concerning the distinction between an admissible repair and an inadmissible recycling in the sense of a reconstruction, we moreover refer to the observations under 4.).

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<sup>35</sup> BGH GRUR 2007, 769, 772 - Pipettiersystem.

<sup>36</sup> BGH GRUR 1959, 232, 234.

<sup>37</sup> RGZ 103, 359, 363 - Singer; RGZ 161, 29, 37 - Zählerersatzteile; BGHZ 82, 152, 155 - Öffnungshinweis; BGH GRUR 1988, 213, 214 - Griffband; BGHZ 111, 182, 184 - Herstellerkennzeichen auf Unfallwagen.

<sup>38</sup> BGHZ 111, 182, 184 - Herstellerkennzeichen auf Unfallwagen.

<sup>39</sup> BGH GRUR 1996, 271, 274 - Gefärbte Jeans.

<sup>40</sup> BGH GRUR 1956, 265, 267; LG Düsseldorf GRUR 1957, 599.

<sup>41</sup> Benkard, Patentgesetz, 10th edition, sec 9, para. 36.

6) *Products bearing trademarks*

*Concerning the repair or recycling of products such as reuse of articles with a protected trademark (see the examples hereabove), has your national law or practice established specific principles? Are there any special issues or case law that govern the exhaustion of trademark rights in your country in case of repair or recycling?*

30) Under Sec. 24 para. 2 MarkenG exhaustion is ruled out if the state of the product is modified or worsened after it has been put on the market. Whether a repair constitutes a modification or the product depends on the individual case. A replacement of expendable parts does not exclude exhaustion, even if no original spare parts are used for the repair.<sup>42</sup> If however, the repair involves a fundamental intervention which changes the substance of the product, then exhaustion is ruled out.<sup>43</sup> If the repair work is done exclusively by order of the customer, and for this customer only, without reselling the repaired product, then there is no relevant act of use due to the lack of a business transaction.<sup>44</sup> If the repair is not outwardly perceptible and has no objective influence on the working capacity of the product, a modification within the meaning of Sec. 24 para. 2 MarkenG has not taken place.<sup>45</sup>

7) *IPR owners' intention and contractual restrictions*

a) *In determining whether recycling or repair of a patented product is permissible or not, does the express intention of the IPR owner play any role? For example, is it considered meaningful for the purpose of preventing the exhaustion of patent rights to have a marking stating that the product is to be used only once and disposed or returned after one-time use?*

31) In order to distinguish between an admissible repair and an inadmissible reconstruction, it is important to weigh the interest of the patent proprietor in commercially exploiting the invention which merits protection, taking into account the distinctiveness of the patented product, against the customer's interest in freely using the product that has already been put on the market.<sup>46</sup> Therefore, the patent proprietor's expressly announced intentions cannot be of any importance for the assessment of whether a measure is a repair or a reconstruction. A marking as a disposable item would not change the assessment of the admissibility of a repair.

b) *What would be conditions for such kind of intentions to be considered?*

Not applicable.

c) *How decisive are other contractual restrictions in determining whether repair or recycling is permissible? For example, if a license agreement restricts the territory where a licensee can sell or ship products, a patentee may stop sale or shipment of those products by third parties outside the designated territory based on his patents. What would be the conditions for such restrictions to be valid?*

32) When concluding a license agreement, arrangements with respect to the scope of the right of exploitation can be made. The patent proprietor may impose an effective limitation of the right of exploitation with respect to the territory, time and quantity, as well as the type of use, the field of application and the group of authorized users.

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<sup>42</sup> OLG Karlsruhe GRUR 1995, 417, 419 - Rolex-Uhren; OLG Stuttgart WRP 1995, 248, 254 - Rolex, OLG München WRP 1993, 47 - aufgearbeitete Kupplungen.

<sup>43</sup> BGH GRUR 1990, 678, 679 - Herstellerkennzeichen auf Unfallwagen.

<sup>44</sup> BGH WRP 1998, 604 - Rolex-Uhr mit Diamanten.

<sup>45</sup> BGH GRUR 1988, 213 - Griffband (taking off and subsequent re-wrapping of the grip tape of a tennis racquet is irrelevant).

<sup>46</sup> BGH GRUR 2004, 758 - Flügelradzähler.

- 33) If the scope of the right of exploitation has been effectively limited, the licensee must refrain from using the patent outside this scope.<sup>47</sup> The contravention of such limitations is not only a contractual violation but also a patent infringement.<sup>48</sup> If the licensee delivers into a district outside his license territory, or if he delivers the protected invention for use in a technical field it is not licensed for, the licensee commits a patent infringement. The products the licensee has put on the market in this way do not become patent-free, because there was no putting on the market with the patent proprietor's consent. Therefore, the licensee's customers can also be sued for patent infringement by the patent proprietor, if they exploit a product commercially which has been put on the market by the licensee exceeding his right of exploitation.<sup>49</sup>
- 34) If however, the licensee contravenes other arrangements which do not relate to the subject matter and scope of the right of exploitation, e.g. agreements about accounting and bookkeeping duties, or the adherence to certain prices, this is merely a violation of contract which may result in damages claims in favour of the licensor. A patent infringement is ruled out, however. The lawfulness of the licensee putting the patented objects on the market remains unaffected by the violation of these contractual obligations. Because of the exhaustion that has occurred, the objects put on the market become patent-free.<sup>50</sup>
- 35) In order to limit the scope of the right of exploitation, an effective license agreement is necessary. German patent law does not stipulate any particular formal requirements for the conclusion of a license agreement. The necessary content of a license agreement includes an agreement on the grant of the right to exploit an invention which is or can be defined in more detail. Apart from the patent proprietor, the exclusive licensee and the beneficiary, such as the trustee or insolvency administrator, are also entitled to grant licenses.

d) *Are there any other objective criteria that play a role besides or instead of factors such as the patentee's intention or contractual restrictions?*

Not applicable.

e) *How does the situation and legal assessment differ in the case of designs or trademarks?*

36) In the case of trademarks contractual limitations also apply inter partes only, and may give rise to damages claims against the licensee or purchaser, but do not lead to a trademark infringement.<sup>51</sup> The exhaustion of the trademark therefore also occurs if the licensee violates these contractual arrangements, because the putting on the market of the marked products is still lawful.

#### 8) *Antitrust considerations*

*According to your national law, do antitrust considerations play any role in allowing third parties to recycle or repair products which are patented or protected by designs or which bear trademarks?*

37) In the old version of Sec. 17 para. 1 GWB [*Unfair Competition Act*] which has meanwhile been deleted by the 7<sup>th</sup> amendment in 2005, license agreements relating to industrial property rights were prohibited if they imposed restrictions on the licensee in conducting

<sup>47</sup> Busse, Patentgesetz, 6th edition, sec 15, para. 65.

<sup>48</sup> RGZ 135, 145, 148 f. - Bandeisendreifen; BGH GRUR 1967, 676, 680 - Gymnastiksandale.

<sup>49</sup> Benkard, Patentgesetz, 10th edition, sec 15, para. 74.

<sup>50</sup> Benkard, Patentgesetz, 10th edition, sec 15, para. 74.

<sup>51</sup> BGH GRUR 2001, 153, 155 - OEM-Version.

his business which went beyond the scope of the industrial property right. Sec. 17 para. 2 sentence 2 GWB, old version, moreover stipulated that restrictions with respect to the type, scope, technical application, quantity, territory or period of exercising the property right do not go beyond the scope of the property right. In this respect, intangible property law applied irrespective of cartel law, i.e. cartel law was not applicable within the substance of the property right in question.<sup>52</sup> Since the scope of the right to sue for injunctive relief is relevant with respect to the substance of the property right, under the former law exhaustion was also relevant for the assessment of license agreements under cartel law aspects, because exhaustion puts a limit to this right.

- 38) Based on the case law according to which exhaustion also comprises the repair of the product as a use as intended, license agreements limiting the licensee in this respect (e.g. imposing an obligation to have repair work done by a licensed dealer) should have violated Sec. 17 Para. 1 sentence 1 GWB, old version.
- 39) With the 7<sup>th</sup> amendment of the GWB, Sec. 17 GWB was deleted without replacement. Instead, Sec. 1 GWB, new version, contains a general cartel ban. Licensing restrictions for patents and utility models are moreover assessed under the Regulation 772/2004 for technology transfer agreements. Pursuant to Sec. 2 Para. 2 GWB, new version, this Regulation also applies under the national law. In Art. 2, this Regulation contains a general exemption for all technology transfer agreements between two companies which enable the production of the products under the agreement.
- 40) Although Regulation 772/2004 is not applicable to trademarks, the provisions contained therein allow conclusions about the compatibility with Sec. 1 GBW, new version in the case of corresponding license agreements.<sup>53</sup> However, Sec. 1 GWB may be violated if restrictions are agreed upon which refer to rights of the trademark owner which have been exhausted. For example, the agreement of absolute territorial protection even for cases in which exhaustion suspends the territorial protection violates Art. 81 Para. 1 EC, and therefore Sec. 1 GWB.<sup>54</sup>

9) *Other factors to be considered*

*In the opinion of your Group, what factors, besides those mentioned in the Discussion section above, should be considered in order to reach a good policy balance between appropriate IP protection and public interest?*

41) Not applicable.

10) *Interface with copyrights or unfair competition*

*While the present Question is limited to patents, designs, and trademarks as noted in the Introduction above, does your Group have any comments with respect to the relationship between patent or design protection and copyrights or between trademarks and unfair competition relative to exhaustion and the repair and recycling of goods?*

a) Copyright law

42) Patent protection and protection under the Copyright Act (UrhG) may overlap in the case of computer programs that are based on computer-implemented inventions. Furthermore, there is an overlap of design protection and the copyright for works of applied art. There are two aspects which are relevant with respect to exhaustion: Even after embodied works have been put into circulation, their adaptation and redesign requires the author's

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<sup>52</sup> Loewenheim/Meessen/Riesenkampff, Kartellrecht, Volume 2 GWB, Sec. 1, para. 204.

<sup>53</sup> Bechtold, GWB, 4th edition Sec. 2 para. 46.

<sup>54</sup> Loewenheim/Meessen/Riesenkampff, Kartellrecht, Volume 2 GWB, Sec. 1, para. 211.

consent. In addition to that it is most controversial if exhaustion also occurs in the event of a non-physical transfer of works.

- 43) According to Sec. 17 Para. 2 UrhG, the right of distribution of the work in question is exhausted once it has been put into circulation by having been sold. Exhaustion has a Community-wide effect. As a consequence of exhaustion, anyone can freely sell the works in question or put them into circulation in any other way, except for by hiring out. However, the rest of the author's rights of exploitation are not affected by exhaustion.<sup>55</sup> To the extent that the further sale of a work generally entails certain kinds of advertising, exhaustion also applies in this respect.<sup>56</sup> In relation to the cases of repair and recycling this means that under certain circumstances, it is also permissible to use a picture of the copyrighted work in advertising.
- 44) In contrast to that, the right to adapt, i.e. modify a work which itself is the result of a creative act<sup>57</sup>, and to redesign it, i.e. any modification of the work, is not exhausted with the sale of the work.<sup>58</sup> Adapted works, or works redesigned in any other way may only be published and exploited with the author's consent according to Sec. 23 UrhG. However, not every act of repair is an adaptation or redesign, and is therefore ruled out per se in the case of work that is (inter alia) protected with a copyright. If, however, the repair involves an intervention which changes the substance of the work, this could be seen as an adaptation or redesign which requires the author's consent. It must be borne in mind here that consent to the adaptation or redesign of parts of a work is only necessary if these parts enjoy copyright protection themselves as the result of an individual, personal intellectual creation<sup>59</sup>. Regardless of whether only parts of the work are affected by the repair, the repair as such is admissible even without the author's consent. This applies at least if the repair shop performs the repair on request of the owner of the work, because in this case the adaptation/redesign would not be used within the meaning of Sec. 23 UrhG. The situation would have to be assessed differently if the repair shop were to acquire the work itself, perform a repair and subsequently sell the repaired work, or if the repaired work were to be published by the owner or the repair shop.
- 45) In connection with computer programs, a discussion is taking place whether exhaustion is able to occur at all with respect to works which are distributed in a non-physical way – in particular the transmission/download of computer programs.<sup>60</sup> The argument that the works distributed in a non-physical form would otherwise not be marketable strongly suggests that the question of exhaustion should not depend on the way the work was initially distributed.<sup>61</sup> The Hamburg Regional Court most recently followed this opinion and stated that the principle of exhaustion applies once the computer program has been made available on the internet<sup>62</sup>. In contrast to that, the Regional Court Munich I<sup>63</sup> and the Higher Regional Court Munich<sup>64</sup> have ruled that exhaustion could only occur with respect to a work embodied in an object. If one follows this opinion, then there is no exhaustion at all, so that the question if an adaptation for the purpose of repair (fault elimination) does not even arise. Moreover, according to Sec. 69c No. 2 UrhG, the creation of adaptations of a computer program without the right holder's consent is not admissible, anyway.

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<sup>55</sup> BGH GRUR 1993, 34, 36 - Bedienungsanleitung.

<sup>56</sup> Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, 2nd edition, München 2006, Sec. 17 para. 19.

<sup>57</sup> Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, Sec. 23 para. 3.

<sup>58</sup> Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, Sec. 23 para. 3.

<sup>59</sup> BGH GRUR 1989, 416 - Bauaussenkanten; BGH GRUR 1981, 267 - Dirlada.

<sup>60</sup> Dreier/Schulze, Urheberrecht, 2nd edition., 2006 München, Sec. 17 para. 30 and Sec. 19a para. 11.

<sup>61</sup> See also Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, Sec. 17 para. 16.

<sup>62</sup> LG Hamburg MMR 2006, 827.

<sup>63</sup> LG München CR 2006, 159 and MMR 2007, 328.

<sup>64</sup> OLG München CR 2006, 655.

46) For computer programs, the regulation in Sec. 69d Para. 1 UrhG is relevant. According to this section, an adaptation of a computer program (see Sec. 69c No. 2 UrhG) does not require the consent of the right holder, if the adaptation is necessary in order to use the computer program as intended, including fault elimination, and if no particular, deviating contractual provisions apply. Within this scope it is thus permissible to eliminate faults by adapting the work in the sense of a repair, regardless of questions of exhaustion. However, the adaptation must be performed by someone who is authorized to use the computer program (Sec. 69d 1 UrhG). Problems may occur especially in computer-implemented inventions (i) if the computer program contains errors which the acquirer cannot eliminate by adaptation himself, or (ii) if in connection with repair or recycling, the haptic, technical means were restored and this requires an adaptation of the computer program. In the former case the acquirer is not entitled to make use of the help of third parties; in the latter case, the law provides that the acquirer does not have the right to perform an adaptation of the computer program neither with the help of third parties nor by himself, if the necessity to eliminate the error is construed narrowly.<sup>65</sup> According to another opinion, an adaptation is supposed to be admissible if it is useful and covered by the purpose for which the program has been delivered, or if it is performed in the legitimate interest of the user, respectively, so that actions which serve efficiency and technical advance are covered, too.<sup>66</sup> If it is therefore necessary to decide if the use as intended would also be possible without the adaptation, then in the case of computer-implemented inventions it would have to be possible to adapt the computer program if otherwise, after a repair (which is permitted under patent law) or recycling of the technical means, the product could no longer be used.

#### b) Unfair competition

47) The Unfair Competition Act (UWG) lists the slander or disparagement of a competitor's trademarks as an example of an unfair competitive practice (Sec. 4 No. 7 UWG). A slander is the objectively unjustified diminution of the appreciation for the achievements of a competitor in the eyes of the relevant sections of the trade.<sup>67</sup> A disparagement is an increased form of slander in the form of a defamation.<sup>68</sup> The modification of a competitor's goods can also be an act qualifying as unfair competition<sup>69</sup>. However, the repair or recycling of trademarked goods alone, or the use of the trademark for advertising these products, is not a slander or disparagement. All claims in relation to these actions are determined by trademark law.

48) To the extent that exhaustion of the trademark right is ruled out according to Sec. 24 Para. 2 MarkenG, because the state of the good has been modified or has deteriorated after having been put on the market, or because the repair involves an intervention which changes its substance, it is conceivable that an advertisement of the products using the trademark could be seen as a slander or disparagement in the sense of Sec. 4 No. 7 UWG. Since, however in these cases, because exhaustion is not invoked, there is usually an infringement of the trademark and the specific subject matter of the trademark is therefore affected, there is little space for asserting an unfair trade practice.<sup>70</sup>

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<sup>65</sup> Cf. OLG München CR 1996, 11, 17 - Dongle.

<sup>66</sup> Wandtke/Bullinger, Praxiskommentar zum Urheberrecht, Sec. 69d para. 23.

<sup>67</sup> Köhler/Bornkamm, Gesetz gegen den unlauteren Wettbewerb, 26th edition, München 2008, Sec. 4 UWG para. 7.12.

<sup>68</sup> Piper/Ohly, Gesetz gegen den unlauteren Wettbewerb, 4th edition, München 2006, Sec. 47 para. 7/13.

<sup>69</sup> Köhler/Bornkamm, Sec. 4 UWG, para. 7.14

<sup>70</sup> Piper/Ohly, Sec. 4.7 para. 7/8.

11) *Additional issues*

*In the opinion of your Group, what would be further existing problems associated with recycling and repair of IPR-protected products which have not been touched by these Working Guidelines?*

49) not applicable.

**II) Proposals for uniform rules**

1) *What should be the conditions under which patent rights, design rights and trademark rights are exhausted in cases of repair and recycling of goods?*

50) The conditions under which patent rights, design rights or trademark rights are exhausted in cases of repair and recycling, should, in the opinion of the German national group, be the following:

a) Patents

51) An exhaustion of the patent in question with respect to the product must have taken place; i.e. the product in question may be used as intended without the permission of the patent proprietor being necessary.

52) Furthermore, the repair or recycling work must be a measure which forms part of the use of the product as intended. This is in particular the case if the measure taken is directed at maintaining or restoring the usefulness of a product which has been impaired in a customary way by wear or damage.

An act of repair or recycling of a patented product is not to be considered a use of the product as intended, if it is equivalent to a new creation of the product. This is in particular the case, if an act of repair or recycling leads to the replacement of a component of the product which is an essential element of the patented invention.

The distinction between an act of repair and recycling which is considered as a use as intended of the patented product on the one hand, and an act of repair and recycling which tends to be more like a new creation of the product on the other hand, therefore only seems possible by looking at the specific case at hand.

b) Designs

53) The statements regarding the exhaustion of patent rights apply to the effect of acts of repair and recycling on the exhaustion of design rights accordingly, the difference being that the distinction between measures helping to maintain a product in the customary way, and measures which are equivalent to a new creation, depends on the repercussions this has on the distinctiveness of the design of the product protected by the registered design.

If an act of repair or recycling substantially changes the distinctive design of the protected product, then the product is not being used as intended.

c) Trademarks

54) An exhaustion of the trademark in question with respect to the product that has been marked with it must have occurred; i.e. the product in question may be sold, imported or exported, and advertised under the trademark without the permission of the owner of the trademark being necessary.

55) Furthermore, an act of repair or recycling must not lead to a substantial change of the product bearing the protected trademark, in particular not to a deterioration of the product.

2) *Should the repair and the recycling of goods be allowed under the concept of an implied license?*

56) As already stated, the courts have always solved repair cases in Germany on the notion that the acquirer of a protected object is entitled to use it as intended, and is therefore generally entitled to perform repairs. It must be assumed that this approach will lead to the same conclusions in most cases as an assessment of the same case applying the legal concept of an implied license.

The approach practiced in Germany that the acquirer of a protected device is entitled to perform repair and recycling measures to a certain extent because of the inherent limits of the sole and exclusive right, is well-proven in our opinion. There is therefore no need for an explicit entitlement of the acquirer to perform these measures under the aspect of an implied license.

3) *Where and how should a line be drawn between permissible recycling, repair and reuse of IP-protected products against prohibited reconstruction or infringement of patents, designs and trademarks?*

57) In the area of repair, recycling and reuse<sup>71</sup> the limit between acts which infringe a patent, design or trademark and legally unobjectionable behaviour is not rigid, but needs to be developed in each individual case. What is relevant in this case is if and how the holder of the patent, design or trademark has exhausted his exclusive rights to the protected good by having placed it on the market. In order to facilitate the answer to this question, guidelines should be developed, as case law and literature have done for the individual fields of law in the past.

a) Patent and design law

58) In patent and design law, the effect of exhaustion extends to the right to put on the market, offer and use, but not to the right of production, so that the market potential of the owner of the right is not inappropriately curtailed.<sup>72</sup> In order to determine if the repair or recycling of a product needs to be categorized as intended use or as a new creation respectively recreation, different criteria have to be assessed simultaneously: One important aspect is the scope and intensity of the repair work. There must be a distinction between measures affecting the character of the protected object and mere measures of maintenance. Measures changing the character of an object are tantamount to the creation of a new product.<sup>73</sup> It must additionally be borne in mind which types of repairs can normally be expected to become due during the ordinary lifetime of the object, in the opinion of the relevant sections of the trade; if the measure extends the lifetime to an unforeseen extent, it is obvious to assume a new creation.<sup>74</sup> According to these criteria, minor maintenance work such as the replacement of expendable parts is generally not a new creation, but a use of the object as intended.<sup>75</sup> In contrast to that, a recycling during which the object is taken apart, melted or destroyed in any other way so that its components or raw materials can be reused, is regularly a new creation in the opinion of the relevant sections of the trade.<sup>76</sup>

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<sup>71</sup> See overview: Part 1, questions 4-6.

<sup>72</sup> Scharen, in: Benkard, Sec. 9 PatG, para. 36; Rübel, GRUR 2002, 561, 562; Eichmann, in: Eichmann/von Falckenstein, Sec. 48 GeschmMG, para. 9 et seq.; Bodewig, GRUR 1992, 567, 569.

<sup>73</sup> See BGH, GRUR 2007, 769, 772 – Pipettensystem; BGH, GRUR 2006, 837, 838 – Laufkranz; BGH, GRUR 2004, 758, 762 – Flügelradzähler.

<sup>74</sup> See. BGH, GRUR 1959, 232, 234 – Förderrinne, with an approving comment by Heine, p. 235.

<sup>75</sup> See. BGH, GRUR 2007, 769, 772 – Pipettensystem; BGH, GRUR 2006, 837, 838 – Laufkranz; Scharen, in: Benkard, Sec. 9 PatG, para. 38; something different may apply if the expendable part incorporates essential elements of the inventive concept (BGH GRUR 2004, 758, 762 – Flügelradzähler).

<sup>76</sup> Rübel, GRUR 2002, 561, 565 and in more detail: Bodewig, GRUR 1992, 567, 570 et sqq.

b) Trademark law

59) According to Sec. 24 Para. 1 MarkenG, the owner of a trademark may not prohibit a third party from using it for goods which have been put on the market by the trademark owner, unless the trademark owner has good reasons (Sec. 24 Para. 2 MarkenG). As an example, Sec. 24 Para. 2 MarkenG mentions the modification of the state of the goods after their being put on the market as a good reason. If e.g. the repair of a branded good or the refill of a protected container is such a modification depends on the individual case. The guideline here is again if the measure affects the character of the trademarked product. Measures which change the character of the product always bring about a change. They are in conflict with the trademark owner's interest in being able to control, even after having put the product on the market, that his trademark is only used to mark goods which have been legitimized by him. As in the area of patent and design law, the question as to whether a modification of the character of the good is present, is decided based on the scope and intensity of the interference with the object. The strongest form of modification is the replacement of a good. Therefore the refilling of a marked original container with a foreign content infringes the trademark, unless the relevant sections of the trade do not consider the trademark on the container as an indication of the content's origin with a certain company, e.g. because the company filling it has affixed a clarifying label to the container.<sup>77</sup> Minor repair works, such as the replacement of expendable parts, however, do not regularly exclude exhaustion under trademark law, either.<sup>78</sup>

4) *What effect should the intent of IPR holders and contractual restrictions have on the exhaustion of IPRs with respect to recycling and repair of protected goods?*

60) In the opinion of the German national group, neither the expressed intentions of the patent proprietor, e.g. a marking as a disposal item, nor a contractual obligation to refrain from certain types of use, e.g. repair or recycling, should be taken into account when answering the question if an exhaustion also includes repaired or recycled products.

64) Otherwise, the property right owner could enjoin all third parties from using the product as intended, simply by making his intentions known by a corresponding marking, or by a contractual limitation of the product's use with his licensee. This would prevent a fair balance between the interests of the patent proprietor in a commercial exploitation of his patent, the interests of the customer in freely using the product, and the interest in a free exchange of goods, because only the interests of the property right owner would be given priority. The property right owner would be able to control every activity even after having placed the product on the market. The property right owner would be able to claim a royalty twice for the same product; once for the sale or manufacture of the product, and once for permitting its repair. Furthermore, the property right owner could de facto prohibit the sale of spare parts, simply by indicating his intention outwardly, or by imposing a contractual limitation.

5) *Should antitrust issues be considered specifically in cases of repair or recycling of goods? If so, to what extent and under which conditions?*

61) In cases of repair and recycling of goods, the cartel law provisions against anticompetitive agreements and the abuse of a dominating market position must be considered. Otherwise, the property right owner would be able to exclude the effects of exhaustion described above, and the limited possibility to repair or recycle the products, by corresponding agreements.

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<sup>77</sup> Cf. BGH, GRUR 2005, 162, 163 – SodaStream.

<sup>78</sup> Sack, WRP 1999, 1088, 1096; the example mentions Fezer, Sec. 24 MarkenG, para. 48.

- 62) In compliance with the cartel-law judgments in Secs. 1, 19, 20 GWB and Art. 81 Para. 1 and Art. 82 EC, respectively, all agreements should be invalid with which the property right owner is trying to directly or indirectly impose contractual limitations or impediments in connection with the repair and recycling of the products, provided the measures do not newly create the product. This relates to the obligation of the contracting partners to have the acquired products, or products produced under a license, exclusively repaired by the property right owner or a third party authorized by him. The same applies with respect to the linking of warranty services to the performance of all repair works by the property right owner. Correspondingly, any regulations have to be considered invalid with which the property right owner obligates third parties not to perform any repairs (for their own purposes or for third parties) at all.
- 63) But (contractual or factual) restrictions which limit the performance of repair work or recycling only indirectly also need to be comprised. For example, the execution of the repair must not be made difficult or practically impossible, because information protected as know-how (for the property right owner), or devices or tools protected by intellectual property rights are needed for the repair. Yet this only applies if the property right owner has chosen the design of the product in an abusive way, i.e. without technical necessity, specifically in order to participate in any repair or recycling, beyond the exhaustion occurring with the sale. To the extent that these prerequisites are met, the property right owner would also be obliged to provide the necessary information and devices (against a reasonable fee) for the purposes of a permissible repair or recycling. The property right owner must therefore restrict neither its own sales nor those of its partners in such a way that no supply (without discrimination) of information or devices to third parties takes place.
- 6) *The Groups are invited to suggest any further issues that should be subject of future harmonization concerning recycling, repair and reuse of IP-protected products.*
- 64) Not applicable.
- 7) *Based on answers to items 1 to 6 above, the Groups are also invited to provide their opinions about how future harmonization should be achieved.*
- 65) A harmonization should take place according to the explanations under II.1 – 4 above.

### **Summary**

The proposals are in line with principles developed under the German law. Exhaustion of IPRs in relation to a product put into circulation must mean that the product can be used as intended. This includes reparation of the product for maintenance of usability but not the re-manufacturing of the product which is not covered by exhaustion. The differentiation between reparation and re-manufacturing depends on the facts of the individual case. Important criteria are the scope and intensity of the restoration work. Measures changing the nature of the product or its durability suggest a re-manufacturing.

Intentions expressed by the IPR owner, such as a marking according to which the product is to be used only once or the obligation not to use the product in a certain way, should be irrelevant for the question of exhaustion. Direct restrictions in relation to repair and recycling are invalid. Indirect restrictions should be prohibited if the IPR owner has- without technical need - chosen an embodiment that allows him to participate on repair as well. If the embodiment requires the use of an apparatus protected by IPRs, he should be obliged to provide the third party with this apparatus for the purpose of repair.

## **Résumé**

Les propositions du groupe s'orientent autour de la loi allemande déjà en vigueur. L'exhaustivité du droit de propriété intellectuelle par rapport à un produit déjà mis en circulation doit donc signifier que le produit en question peut être utilisé conformément à son usage prévu. Cela comprend également la réparation du produit par sa remise en état. Il faut en délimiter la re-fabrication du produit qui n'est pas couvert par l'exhaustivité. La délimitation entre "réparation" et "re-fabrication" s'opère au cas par cas. Les critères de délimitation les plus importants sont l'ampleur et l'intensité de la remise en état. Des mesures qui sont de nature à changer le caractère du produit ou sa durabilité de façon imprévisible suggèrent une re-fabrication.

Doivent être considéré comme indifférentes pour l'exhaustivité du droit de propriété intellectuelle les intentions du titulaire exprimées vers l'extérieur, comme l'identification du produit comme produit à usage unique ou des stipulations contractuelles excluant des utilisations définies. Des limitations directes du titulaire du droit de propriété intellectuelle relatives à la réparation et au recyclage sont sans effet légal. La prohibition de limitations indirectes s'applique si le titulaire du droit de propriété intellectuelle a choisi, sans nécessité technique, un arrangement du produit visant à lui faire participer à la réparation. Si, en cas de réparation, l'arrangement rendra nécessaire un appareil protégé, le titulaire du droit de propriété intellectuelle devrait être obligé de le mettre à disposition en vue de la réparation.

## **Zusammenfassung**

Die Vorschläge der Gruppe orientieren sich an dem bereits geltenden deutschen Recht. Die Erschöpfung des Schutzrechts in Bezug auf ein in Verkehr gebrachtes Produkt muss dazu führen, dass das Produkt bestimmungsgemäss gebraucht werden darf. Dies umfasst auch eine Wiederherstellung der Gebrauchsfähigkeit des Produkts durch Reparatur. Davon abzugrenzen ist die nicht von der Erschöpfung erfasste Neuherstellung. Für die Abgrenzung ist eine Einzelfallbetrachtung geboten. Wichtige Abgrenzungskriterien sind der Umfang und die Intensität der Instandsetzungsarbeiten. Massnahmen, die das Wesen des Produkts oder in unvorhergesehenem Masse dessen Lebensdauer verändern, sprechen für eine Neuherstellung.

Nach aussen kenntlich gemachte Absichten des Schutzrechtsinhabers, z.B. die Kennzeichnung als Wegwerfartikel oder vertragliche Verpflichtungen, bestimmte Verwendungsweisen zu unterlassen, sollen für die Erschöpfung keine Rolle spielen. Direkte Beschränkungen des Schutzrechtsinhabers im Zusammenhang mit Reparatur und Recycling sind unwirksam. Das Verbot der indirekten Beschränkung soll gelten, wenn der Schutzrechtsinhaber durch die Wahl einer bestimmten Ausgestaltung des Produktes, die nicht auf technisch bedingter Notwendigkeit beruht, auch an der Reparatur partizipieren möchte. Wäre aufgrund der Ausgestaltung für die Reparatur eine geschützte Apparatur notwendig, müsste der Schutzrechtsinhaber verpflichtet sein, diese zum Zweck der Reparatur zur Verfügung zu stellen.