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UPCYCLING AND TRADE MARK USE UNDER EU LAW

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Abstract

Over the past few years, the environmental toll of the fashion industry has prompted the European Union to adopt measures aimed at fostering circularity and extending product lifecycles. As a result, design methods that repurpose garments otherwise destined for landfill – most notably, upcycling – have gained momentum as both a sustainable and fashionable practice. Yet when upcycled items retain visible brand insignia, they often risk encroaching upon the scope of trade mark protection, triggering infringement claims. This article takes a step back from the already recommended approaches and revisits a more fundamental question: does upcycling even entail 'use' of a trade mark in the sense required under EU law? Re-examining the Court of Justice's case law, the main tenet of this contribution is that several forms of sustainability-oriented upcycling may not reach this threshold, as upcyclers typically do not engage in the kind of active conduct required by the law to qualify as 'use'. The article thus positions the notion of 'use' as a conceptual filter that reconciles trade mark protection with circular-economy objectives. By showing that the existing framework already contains the tools to exclude genuinely sustainable repurposing from infringement – while still capturing parasitic practices – it clarifies how EU trade mark law can reconcile environmental innovation with trade mark owners' interests and do so without the need for legislative intervention.

1. Introduction

Solve et coagula – dissolve and reassemble – encapsulates one of the core principles of alchemy: the breaking down of matter into its essential elements so it can be reborn in a higher form. This ancient formula, long associated with metaphysical transformation, speaks uncannily to a modern practice with material legal implications: upcycling. Upcycling has been

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defined[1] as 'the act of recycling something in such a way that the resulting product is of higher value than the original item'.[2]

This practice has proliferated across a wide range of industries. In the context of fashion, upcycling enacts its own kind of alchemy: disassembling garments and accessories, stripping them of prior place and meaning, and reconfiguring them into something new. As the industry confronts the environmental and ethical consequences of overproduction,[3] upcycling offers not just a design method, but a philosophy of rebirth.

The need for such alternative solutions promoting the circularity of the fashion sector has become increasingly evident over time, with fashion ranking consistently among the most polluting industries. The fast fashion industry accounts for more than 10% of global carbon dioxide emissions, surpassing those of the maritime and aviation industries combined.[4] Such findings have propelled the EU to target the fashion sector in its pursuit of sustainable development through measures designed to promote circularity and resource efficiency.[5] This also aligns with the EU's overarching objective of achieving climate neutrality by 2050[6] under the Green Deal.[7]

1. See the definition of 'Upcycle' in the *Merriam-Webster Dictionary* <www.merriam-webster.com/dictionary/upcycle> (all websites last visited 21 July 2026). See further Martin Senftleben, 'Fashion Upcycling as Protected Free Speech in Trademark Law' (2024) 31(2) University of Miami International and Comparative Law Review 349, 351, doi: 10.2139/ssrn.4964251.

2. This definition is adopted here with reference to what is described below as 'genuine upcycling'. By contrast, there are instances where the added value of the final product derives primarily from the incorporation of pre-existing valuable components. In such cases, the value does not flow from the creative transformation itself but rather from the reputation and brand image that the incorporated elements carry. The view of the author is that such practices do not properly fall within the notion of upcycling, a position also reflected in their exclusion from the scope of the recommended legal shields for upcycled products, as later discussed.

3. Ellen MacArthur Foundation, *A New Textiles Economy: Redesigning Fashion's Future* (28 November 2017) 36 <www.ellenmacarthurfoundation.org/a-new-textiles-economy>; Kate Fletcher and Mathilda Tham, *Earth Logic: Fashion Action Research Plan* (The JJ Charitable Trust 2019) 9 <katefletcher.com/wp-content/uploads/2019/10/Earth-Logic-plan-FINAL.pdf>.

4. See European Parliament, 'Fast Fashion: EU Laws for Sustainable Textile Consumption' (*European Parliament Topics*, updated 12 September 2025) <www.europarl.europa.eu/topics/en/article/20201208STO93327/fast-fashion-eu-laws-for-sustainable-textile-consumption> and Jolin Li, 'Fast Fashion and Emissions: What's the Link?' (*Earth.org*, 23 August 2025) <earth.org/fast-fashion-and-emissions-whats-the-link/>.

5. European Commission, 'A New Circular Economy Action Plan for a Cleaner and More Competitive Europe' (Communication) COM (2020) 98 final.

6. European Parliament, 'Reducing Carbon Emissions: EU Targets and Policies' (*European Parliament Topics*, 8 March 2018) <www.europarl.europa.eu/topics/en/article/20180305STO99003/reducing-carbon-emissions-eu-targets-and-policies>.

7. European Commission, 'The European Green Deal' (Communication) COM (2019) 640 final.

Textiles were accordingly identified as a priority value chain in the 2020 Circular Economy Action Plan.[8] Building on this, the 2022 EU Strategy for Sustainable and Circular Textiles was introduced to translate into sector-specific measures the broader commitments set out in the European Green Deal, the Circular Economy Action Plan, and the European Industrial Strategy.[9] These policy initiatives have been followed by concrete legislative measures – most notably the 2024 Ecodesign for Sustainable Products Regulation,[10] providing the regulatory instrument to embed durability, reusability, and recyclability requirements into the textile sector as well. A further step in this trajectory was the European Parliament's September 2025 adoption of binding rules on food and textile waste, which introduce extended producer responsibility (EPR) schemes obliging textile producers to cover the costs of collection, sorting, and recycling.[11] Most recently, the Commission adopted delegated and implementing acts under the Ecodesign for Sustainable Products Regulation, introducing a ban on the destruction of unsold apparel, clothing accessories, and footwear, accompanied by disclosure obligations concerning unsold consumer goods discarded as waste.[12]

Although these developments point to sustained regulatory attention to the circularity of the textile sector, the policy trajectory should not be presented as one of uninterrupted progress. The withdrawal, in June 2025, of the Proposal for a Green Claims Directive[13] – draft legislation designed to deliver on the Green Deal by fostering consumers' active role in this

8. European Commission, 'A New Circular Economy Action Plan' (n 5).

9. European Commission, 'A New Industrial Strategy for Europe' (Communication) COM (2020) 102 final; European Commission, 'Updating the 2020 New Industrial Strategy: Building a Stronger Single Market for Europe's Recovery' (Communication) COM (2021) 350 final.

10. European Commission, 'Ecodesign for Sustainable Products Regulation' (*European Commission*, last modified 18 July 2024) <commission.europa.eu/energy-climate-change-environment/standards-tools-and-labels/products-labelling-rules-and-requirements/ecodesign-sustainable-products-regulation>.

11. European Parliament, 'Parliament adopts new EU rules to reduce textile and food waste' (Press Release, 9 September 2025) <www.europarl.europa.eu/news/en/press-room/20250905IPR30172/parliament-adopts-new-eu-rules-to-reduce-textile-and-food-waste>.

12. Commission Delegated Regulation (EU) 2026/296; Commission Implementing Regulation (EU) 2026/2, both adopted under Regulation (EU) 2024/1781, concerning derogations from the prohibition of destruction of unsold products and disclosure of information on discarded unsold consumer products.

13. European Commission, 'Proposal for a Directive of the European Parliament and of the Council on substantiation and communication of explicit environmental claims' COM (2023) 166 final.

broader objective[14]– illustrates that sustainability-oriented initiatives may be subject to reconsideration, even when circularity remains a central EU regulatory objective.

Against this broader regulatory background, upcycling presents an alternative method of design, production, and commercialization that embodies several of the EU targets for achieving the circularity of the fashion sector – namely, the reduction of reliance on virgin materials and the minimization of textile waste.[15] Yet, upcycling practices have resulted in legal disputes focusing on the lawfulness thereof without rightholders' authorization. In the United States, for instance, both Louis Vuitton and Chanel have brought trade mark infringement actions against resellers[16] and upcyclers[17] over repurposed goods bearing their marks. Similar initiatives have surfaced in Europe, where luxury brands – including Hermès[18] and Chanel[19]– have objected to the use of their trade marks on altered or repurposed goods.

While the discourse around the lawfulness of unlicensed upcycling practices is broad and engages diverse legal considerations, the present analysis is situated within EU trade mark law and focuses on the case law of the Court of Justice of the European Union specifically. The relevant EU framework is found both in the EU Trade Mark Regulation ('EUTMR')[20] and the Trade Mark Directive ('EUTMD').[21]

Under Article 9(2) EUTMR and Article 10(2) EUTMD, prima facie trade mark infringement requires several cumulative conditions to be satisfied, including use of a sign, which occurs in the course of trade, in relation

14. See further European Commission, 'Impact Assessment Report accompanying the document Proposal for a Directive of the European Parliament and of the Council amending Directives 2005/29/EC and 2011/83/EU as regards empowering consumers for the green transition through better protection against unfair practices and better information' (Staff Working Document) SWD (2022) 85 final.

15. European Commission, 'EU strategy for sustainable and circular textiles' (Communication) COM (2022) 141 final.

16. *Chanel Inc v What Goes Around Comes Around LLC* (SDNY, No 1:18-cv-02253).

17. *Chanel Inc v Shiver and Duke LLC* (SDNY, No 1:21-cv-01277); *Louis Vuitton Malletier v Sandra Ling Designs Inc* (ED Tex, No 4:21-cv-00352).

18. Tribunal judiciaire de Paris (3e ch, 1re sect), jugement du 10 avril 2025, n° RG 22/10720.

19. Tribunal judiciaire de Paris (3e ch, 1re sect), jugement du 21 mai 2026, n° RG 25/00621.

20. Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification) [2017] OJ L154/1, governing the unitary EU trade mark.

21. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast) [2015] OJ L336/1, harmonizing core aspects of national trade mark laws across the Member States.

to goods or services, and in a manner capable of affecting one of the protected functions of the trade mark. Where third-party marks remain visible on upcycled products without the rightholder's authorization, one (or more) of the three main infringement routes may be triggered: double identity, likelihood of confusion, or use that takes unfair advantage of, or is detrimental to, the distinctive character or repute of a reputed trade mark. These are considered in more detail in Section 3. These three forms of infringement reflect, and build upon, the international framework set by Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights.[22]

In light of the foregoing, the concern, then, is whether the assertion of such claims may hinder the very practice of upcycling which the EU simultaneously promotes as part of its circular economy objectives.[23] Existing scholarship has already explored several ways of accommodating upcycling within trade mark law,[24] including exhaustion (Article 15 of the EUTMR and EUTMD), defences like descriptive and referential use (Articles 14(1)(b) and 14(1)(c) EUTMR and EUTMD), the notion of due cause (Article 9(2)(c) EUTMR and Articles 10(2)(c) and 10(6) EUTMD), and a less elastic construction of the gatekeeper requirement of use as a trade mark/ use in the course of trade/ use in relation to goods or services.

22. Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted 15 April 1994, entered into force 1 January 1995) 1869 UNTS 299 ('TRIPS Agreement').

23. On the broader tension between IP and circular economy practices, see Annette Kur and Irene Calboli, 'Intellectual Property in the Circular Economy' (2023) 18 Journal of Intellectual Property Law & Practice 337, doi: 10.1093/jiplp/jpad045; Irene Calboli, 'Pushing a Square Pin into a Round Hole? Intellectual Property Challenges to a Sustainable and Circular Economy, and What to Do about It' (2024) 55 International Review of Intellectual Property and Competition Law 237, doi: 10.1007/s40319-024-01431-1.

24. On trade mark exhaustion in analogous contexts involving repair, refurbishment, and altered goods, see Annette Kur, '"As Good as New" – Sale of Repaired or Refurbished Goods: Commendable Practice or Trade Mark Infringement?' (2021) 70 GRUR International 228, doi: 10.1093/grurint/ikaa187; Simon Geiregat, 'Trading Repaired and Refurbished Goods: How Sustainable is EU Exhaustion of Trade Marks?' (2024) 73 GRUR International 287, doi: 10.1093/grurint/ikad124. On trade mark law and upcycling specifically, see Martin Senftleben, 'Developing Defences for Fashion Upcycling in EU Trademark Law' (2024) 73 GRUR International 99, doi: 10.1093/grurint/ikad131; Martin Senftleben, 'Fashion Upcycling: The Problem of Overlapping Intellectual Property Rights and How to Solve It' in Péter Mezei and Heidi Härkönen (eds), *The Cambridge Handbook of Intellectual Property and Upcycling* (Cambridge University Press 2026) 221; Bernardo Calabrese, 'Trademark Law and Upcycling: Tailoring "Old-Fashioned" Principles' in Mezei and Härkönen (ibid) 88. From a US law perspective, see Anthony M Keats, 'Trendy Product Upcycling: Permissible Recycling or Impermissible Commercial Hitchhiking?' (2020) 110 Trademark Reporter 712; Jolie Brett Schenerman, 'One Consumer's Trash Is Another's Treasure: Upcycling's Place in Trademark Law' (2020) 38 Cardozo Arts & Entertainment Law Journal 745.

The present article shifts the focus to one step earlier in the infringement analysis, asking whether there is 'use' of the sign in the first place.

Although the notions of 'use' and 'use as a trade mark' can be conflated – and the structure of the infringement criteria does not always appear clearly delineated[25] – an understanding of their distinct analytical purposes has been advanced through the Court of Justice jurisprudence. The Court does not always distinguish these notions expressly, nor does it present them as part of a rigid sequence, but its case law shows that they answer different questions within the infringement analysis.[26] The notion of 'use' concerns whether the sign is actively and independently engaged with at all so as to trigger the trade mark infringement analysis in the first place, whereas 'use as a trade mark' asks whether the mark serves an origin-indicating purpose.

These notions of 'use' and 'use as a trade mark' must also be kept separate from the other cumulative requirements within the infringement test. At the first stage, 'use' requires that the defendant has engaged in active conduct involving the sign under its direct or indirect control and within its own commercial communication, as opposed to situations in which the sign appears only incidentally or remains on the product without being invoked by the defendant, as analysed in Section 4.1. This must then be distinguished from 'use in the course of trade' which concerns whether the conduct occurs within commercial activity pursued with a view to economic advantage rather than as a private matter.[27] A further separate element is that the sign must be used 'in relation to goods or services', meaning that the use establishes a link between the sign and specific goods or services in the marketplace.[28] Only where these requirements are satisfied does the analysis proceed to whether the use is capable of affecting one of the protected functions of the trade mark.

Read in this way, the notion of 'use' serves as an entry point into the infringement analysis. As a threshold question, it may help prevent and – if needed – resolve some disputes, thereby reconciling the underlying rationale of most upcycling practices (environmental sustainability) with the legitimate interests of trade mark owners, without the need for legislative reform.

25. Annette Kur and Martin Senftleben, *European Trade Mark Law: A Commentary* (Oxford University Press 2017) 276.

26. See Case C-179/15 *Daimler AG v Együd Garage Gépjárműjavító és Értékesítő Kft* EU:C:2016:134 [40] for the general notion of 'use', and Case C-48/05 *Adam Opel AG v Autec AG* EU:C:2007:55 [24] for 'use as a trade mark'. On subsequent case law regarding 'use' see the analysis in Section 4.1.

27. Kur and Senftleben (n 25) 276.

28. Kur and Senftleben (n 25) 288.

This has a broader significance beyond the specific context of upcycling and even beyond IP law. More generally, it demonstrates that the adjustment of exclusive rights in light of evolving public objectives need not always depend on legislative intervention. This point is particularly relevant in the EU context. The core rules of trade mark infringement are harmonized across the Member States, and so the way their threshold concepts are understood shapes the boundaries of lawful commercial conduct across the internal market. At the same time, Article 11 TFEU requires environmental protection requirements to be integrated into the definition and implementation of Union policies and activities. Where the internal logic of a legal framework is applied in accordance with its structure, it may already contain the tools necessary to accommodate such shifting societal priorities. In this sense, the contribution highlights the broader capacity of EU trade mark law to respond to change within its existing doctrinal architecture, rather than through regulatory expansion.

The argument unfolds as follows. Section 2 discusses upcycling as a phenomenon, before narrowing the focus to those fashion-sector practices that may become relevant from a trade mark perspective. On that basis, Section 3 outlines the infringement routes that may be triggered where upcycled goods retain third-party brand insignia. Section 4 then shifts to the core doctrinal issue of 'use': it first sets out, by reference to Court of Justice case law, the conditions under which the presence of a sign amounts to 'use' by an alleged infringer, then examines that threshold by applying it to existing upcycling disputes, and finally assesses whether further safeguards are needed or whether the current EU trade mark framework already leaves sufficient room for sustainability-oriented upcycling and situates this approach alongside the existing proposed solutions.

2. Upcycling: From niche roots to a mainstream practice

While upcycling has gained popularity in recent years, it is by no means a novel phenomenon. From the protagonist of the 1939 film *Gone with the Wind* fashioning a dress out of curtains,[29] to Dapper Dan's rise and fall

29. The gown was in reality designed by Walter Plunkett for Vivien Leigh as Scarlett O'Hara, who was depicted ripping down curtains to make the dress. See further Beth Sullivan, 'Museum Musings – The Curtain Dress from *Gone with the Wind*' (*James Madison Museum of Orange County Heritage*, 17 January 2021) <www.thejamesmadisonmuseum.net/single-post/2017/04/19/museum-musings-the-curtain-dress-from-gone-with-the-wind>.

(or more accurately: fall and later rise under the House of Kering),[30] upcycling can hardly be described as a novel solution born of environmental concern. Nevertheless, while the term appeared sporadically in the 1990s[31] and early 2000s,[32] over the past decade it has become embedded in the narratives surrounding sustainability initiatives.[33]

Upcycling manifests across a range of sectors. In furniture, discarded wood and metals are refashioned into new pieces often carrying both functional and aesthetic value.[34] In technology, obsolete circuit boards or mechanical parts are reconfigured into new devices or even art objects;[35] in the automotive sector, salvaged car components are repurposed in innovative design projects.[36] As these examples demonstrate, upcycling is not tied to a single industry but rather reflects a wider practice of material transformation – one that extends the lifecycle of products and mitigates waste.

Among its diverse applications, upcycling is also commonly discussed within the fashion and textile industries.[37] In this context, it differs from conventional textile waste recycling – which typically involves mechanical or chemical reprocessing – by adopting a design-driven circular fashion

30. Dapper Dan (Daniel Day) pioneered custom luxury-logo streetwear in Harlem from 1982 until 1992, when legal action – including a trade mark lawsuit by Fendi – forced his boutique to close. Decades later, Gucci embraced his influence, partnering with him in 2017 and opening an official Harlem atelier under Kering in 2018. Read more about Dapper Dan in Barry Michael Cooper, 'The Fashion Outlaw Dapper Dan' *The New York Times* (3 June 2017) <www.nytimes.com/2017/06/03/fashion/dapper-dan-harlem-gucci.html>. For the collaboration with Gucci, see Matthew Schneier, 'Thanks, Internet Outrage! Now Dapper Dan and Gucci Are Buds' *The New York Times* (10 September 2017) <www.nytimes.com/2017/09/10/fashion/dapper-dan-gucci-partnership.html>.

31. By mechanical engineer Reiner Pilz, as reported in Irene Calboli, 'Upcycling, the Ongoing Battle – a (Hopeful) United States Perspective' (*Verfassungsblog*, 17 April 2025) <verfassungsblog.de/upcycling-the-ongoing-battle>.

32. In the book William McDonough and Michael Braungart, *Cradle to Cradle: Remaking the Way We Make Things* (North Point Press 2002) as referenced in Reet Aus and others, 'Designing for Circular Fashion: Integrating Upcycling into Conventional Garment Manufacturing Processes' (2021) 8(1) Fashion and Textiles 34, 36, doi: 10.1186/s40691-021-00262-9.

33. Aus and others (n 32) 36.

34. 'How Upcycled Furniture Is Redesigning the Future of Interiors' (*Upcycle That*, 13 August 2025) <upcyclethat.com/upcycled-furniture-is-redesigning-the-future/>.

35. Jack Portley, 'Recycling and Repurposing Electronic Components' (*KnowHow*, 28 June 2024) <knowhow.distrelec.com/sustainability/recycling-and-repurposing-electronic-components/>.

36. Jasper Jolly and Mahika Ravi Shankar, 'Upcycling a Black Cab or Bin Lorry: Growing Industry Converts Old Vehicles to Electric' *The Guardian* (31 August 2024) <www.theguardian.com/environment/article/2024/aug/31/upcycling-a-black-cab-or-bin-lorry-growing-industry-converts-old-vehicles-to-electric>.

37. Aus and others (n 32) 36.

approach, through which pre- or post-consumer textile waste is creatively repurposed into new garments.

In recent years, the practice has gained increased visibility in the fashion industry, offering an approach to reduce textile waste and respond to sustainability demands. Increasingly, brands and designers have incorporated upcycling into their production models. Historically limited to small-scale artisanal production,[38] upcycling is now expanding into more industrialized fashion contexts, with all of this prompting somewhat novel legal considerations. What is particularly relevant from a trade mark perspective is what happens when the textiles and designs used as the raw materials for the upcycling belong to third parties and carry their brand insignia.

In the fashion context, upcycling can be categorized along different lines, depending on the entity involved or the technique applied. From a contextual perspective, commentators often distinguish between individual, consumer, community-based, and industrial forms of upcycling. Individual and consumer upcycling typically involve DIY (do-it-yourself) reuse by end-users or 'makers'.[39] In contrast, industrial upcycling refers to textile waste systematically repurposed by businesses using existing production infrastructure.[40] The latter is the form that can also be legally relevant from a trade mark perspective, while the former as a private use of a trade mark does not meet the requirement of use in the course of trade.[41] A further category, discussed through the lens of social innovation, concerns community-based clothing reuse and upcycling initiatives, such as collaborative services, participatory workshops, or local repair and remaking schemes.[42] These initiatives are not necessarily commercial. To the extent that they remain educational or otherwise non-commercial in character, they fall outside the focus of the present analysis; where they involve offering upcycled goods bearing third-party marks for sale, however, they raise the same trade mark questions as other commercial forms of upcycling.

38. Aus and others (n 32) 36.

39. Sooyoen Shim, Jisoo Kim and Youngjoo Na, 'An Exploratory Study on Up-cycling as the Sustainable Clothing Life at Home' (2018) 5(1) Fashion and Textiles 14, doi: 10.1186/s40691-018-0129-1.

40. The type of upcycling discussed in Aus and others (n 32) 34.

41. EUTMR (n 20) art 9(2); EUTMD (n 21) art 10(2); Case C-324/09 *L'Oréal SA v eBay International AG* EU:C:2011:474 [54]–[57]; Kur and Senftleben (n 25) 279–80; cf by way of analogy, Nari Lee, 'A Tale of David and Goliath in Gangnam Style?' (*The IPKat*, 3 March 2026) <ipkitten.blogspot.com/2026/03/guest-post-tale-of-david-and-goliath-in.html>, discussing Supreme Court of Korea, 26 February 2026, Case 2024Da311181 and distinguishing refurbishment returned to the owner for private use and upcycling carried out for commercial sale.

42. Duan Wu and others, 'Towards Circular Fashion: Design for Community-Based Clothing Reuse and Upcycling Services under a Social Innovation Perspective' (2022) 15(1) Sustainability 262, doi: 10.3390/su15010262.

In terms of technique, the methods that have been mapped out include subtraction (cutting or cropping garment parts), deconstruction (disassembling and reassembling), addition (of embellishments, patchworking etc), and re-functioning (transforming garments into new or different products).[43] Such approaches reflect the material-first logic of upcycling, beginning with waste rather than virgin materials. Despite their formal distinctions, all these practices involve design-led transformation aimed at extending a given material's lifecycle.

A distinct growing practice involves third-party upcyclers, unaffiliated with the original brand, who transform second-hand or surplus branded items into new goods. Far from being marginal, this trend is part of a burgeoning global market. The upcycled fashion market was valued at nearly USD 7.6 billion in 2023, with expectations to double to over USD 16 billion in 2032,[44] and European share alone stood at over 36% in 2024.[45] Its growth is closely tied to the rapid expansion of the second-hand clothing market, which reached USD 197 billion in 2023 and is expected to rise to USD 350 billion by 2028.[46] The scale of this trade underscores both the availability of raw materials and – most importantly – the cultural shift towards reuse from which upcycling directly draws.

In such instances, used garments – sourced from thrift stores or charity shops, resale platforms, or donations, etc – are reworked by third-party actors operating outside the original brand's authorized distribution or production networks, through the abovementioned techniques, to produce unique pieces. In other cases, these so-called upcyclers purchase new but unsold or off-season branded goods – usually obtained through surplus or liquidation channels – and repurpose them into one-off items before placing them back on the market. These often retain brand insignia, thereby giving rise to allegations of trade mark infringement, which have become increasingly visible as the upcycling market expands – with luxury brands in particular leading the way, as seen in the aforementioned cases concerning Chanel and Hermès.

43. Christabel Annora Paramita Parung, Viviany Viviany and Gaymas Vicka Arda Enantiomery, 'Upcycling Design Process and Classification of Upcycling Method as Innovation to Extend Product Lifecycle' (Proceedings of the IEOM 2022 International Conference on Industrial Engineering and Operations Management, Istanbul, 7–10 March 2022).

44. Approximately EUR 6.48 billion at 2025 exchange rates (with the average rate being 0.869171).

45. Fortune Business Insights, *Upcycled Fashion Market Size, Share & Growth Report, 2024–2032* (2023) <www.fortunebusinessinsights.com/upcycled-fashion-market-111476>.

46. Sarah Butler, 'Secondhand Clothing on Track to Take 10% of Global Fashion Sales' *The Guardian* (27 March 2024) <www.theguardian.com/business/2024/mar/27/secondhand-clothing-on-track-to-take-10-of-global-fashion-sales>.

3. Upcycling and trade mark challenges: Potential infringement risks

The growing tendency of trade mark owners to contest upcycling illustrates the different ways in which such practices may be framed as infringing under EU trade mark law. Building on the framework discussed in the introduction, this section outlines how these claims can unfold in practice.

A first potential ground of infringement arises under Article 9(2)(a) EUTMR and Article 10(2)(a) EUTMD, concerning situations of so-called 'double identity', that is, cases where the sign used is identical to the registered trade mark and the goods or services in question are identical to those for which the mark is protected. Although Recital 16 EUTMD refers to 'absolute' protection in such circumstances, the Court of Justice's case law has held that infringement under this provision is not automatic.[47] Beyond the strict requirement of identity – interpreted to cover reproduction without modification or with only differences so insignificant that they may go unnoticed by the average consumer[48] – the use must adversely affect, or be liable to affect, one of the functions of the trade mark.[49] This includes not only the essential function of indicating origin,[50] but also the quality, communication, investment, and advertising functions recognized in the Court's case law.[51]

The requirement of identity of goods is assessed in relation to the goods for which the trade mark is registered. In many fashion-related upcycling scenarios, the reworked item will still qualify as clothing – for example, where a branded garment is transformed into another garment. In such situations, the condition of identical goods may still be satisfied despite alterations in form. By contrast, where the transformation results in products of a different nature – such as jewellery made from branded buttons, bags fashioned from garments, or furniture incorporating textile elements – the goods may no longer qualify as identical. It should be noted, however, that trade marks – notably those of well-established brands – are often registered across multiple product categories, so that identity of goods may still arise depending on the specific registration relied upon. Where identity of the goods cannot be established, the double-identity route will not be available; the other infringement routes can nevertheless still be relied upon independently.

47. Kur and Senftleben (n 25) 295; for the role of the function theory in calibrating the trade mark infringement test, see Kur and Senftleben (n 25) 292.
48. Kur and Senftleben (n 25) 295–96.
49. Case C-206/01 *Arsenal Football Club plc v Matthew Reed* EU:C:2002:651 [51].
50. *Adam Opel* (n 26) [21]–[22]; Case C-245/02 *Anheuser-Busch Inc v Budějovický Budvar* EU:C:2004:717 [59].
51. Case C-487/07 *L'Oréal SA v Bellure NV* EU:C:2009:378 [58].

A second infringement route is likelihood of confusion. Pursuant to Article 9(2)(b) EUTMR and Article 10(2)(b) EUTMD, infringement arises where consumers may be misled – even potentially – as to the origin of goods.[52] In the upcycling context, the risk materializes where reworked items continue to display brand insignia prominently, potentially leading consumers to believe that the goods are endorsed by, or otherwise linked to,[53] the trade mark owner – particularly where the marks appear prominently and the marketing of the product does not clarify the independence of the upcycler. This concern also extends into the post-sale environment,[54] where bystanders[55] or downstream purchasers may also misattribute origin.[56] For luxury goods, even fleeting misperceptions of this kind are often portrayed as damaging, leading to 'status confusion',[57] since exclusivity and controlled distribution are central to the brand's value. Critics, however, have questioned whether such post-sale confusion truly protects consumers or instead bolsters proprietors' ability to police secondary markets – or even to enforce social class hierarchies by controlling access to exclusive status symbols.[58]

Beyond confusion, disputes have also turned on the protection of reputed trade marks. Under Article 9(2)(c) EUTMR and Article 10(2)(c) EUTMD, proprietors frequently allege that upcycling either leverages their reputation unfairly,[59] tarnishes the brand's carefully curated image,[60] or dilutes its distinctiveness.[61] The former case refers to situations where the upcycled product attracts consumers because of the appeal of the reputed mark built through the brand's investments. Tarnishment may be invoked

52. Case C-251/95 *Sabel BV and Puma AG, Rudolf Dassler Sport* EU:C:1997:528 [16].

53. Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* EU:C:1998:442 [29]–[30]; Case C-9/93 *IHT Internationale Heiztechnik GmbH and Uwe Danzinger v Ideal-Standard GmbH and Wabco Standard GmbH* EU:C:1994:261 [34], [37].

54. Post-sale confusion, however, is not actionable in all jurisdictions. At the EU level, for example, it has only been implicitly acknowledged in *Arsenal* (n 49), and later implicitly rejected in Case C-361/04 P *Ruiz-Picasso v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* EU:C:2006:25 [44]–[47].

55. Ilanah Fhima, 'Post-Sale Confusion: A Doctrine in Development' (2025) 20(4) Journal of Intellectual Property Law & Practice 265, 267, doi: 10.1093/jiplp/jpaf009; see also *Iconix Luxembourg Holdings Sarl* v *Dream Pairs Europe Inc* [2024] EWCA Civ 29 [34].

56. Fhima (n 55) 267.

57. Fhima (n 55) 268.

58. Jeremy N Sheff, 'Veblen Brands' (2012) 96 Minnesota Law Review 769, 775, doi: 10.24926/265535.1298; see also Kal Raustiala and Christopher Jon Sprigman, 'Rethinking Post-Sale Confusion' (2018) 108 Trademark Reporter 882, 892–96.

59. Case T-93/06 *Mineral Spa* EU:T:2008:215 [40]; Case T-215/03 *Vips* EU:T:2007:93 [40]; Case T-128/06 *Camelo* EU:T:2008:22 [46].

60. *L'Oréal/Bellure* (n 51) [40].

61. Case C-252/07 *Intel Corporation Inc v CPM United Kingdom Ltd* EU:C:2008:655 [29].

where luxury insignia appear on upcycled items of noticeably inferior quality, or on products whose style conflicts with the brand's aesthetic, creating associations that undermine the prestige carefully cultivated by the proprietor. Lastly, dilution arises where repeated use of the mark on reworked items gradually erodes its uniqueness in the public mind, as explained by the Court of Justice in *Intel.*[62] For this ground of infringement to succeed, however, the use must also be without due cause (Article 9(2)(c) EUTMR; Article 10(2)(c) and 10(6) EUTMD).

These forms of injury are, nevertheless, not merely theoretical. The Hermès scarf litigation[63] sets an illustrative example, demonstrating how a French court treated the deliberate incorporation of Hermès-branded materials into new garments as infringement, dismissing unpersuasive arguments grounded in environmental value.[64]

Taken together, these grounds explain the ways in which the perceived 'threats' of upcycling to brands can be framed under EU trade mark law. Regardless of whether the claim is framed under double identity, likelihood of confusion, or reputation-based protection, its success ultimately depends on the more fundamental question of whether these practices involve 'use' of the trade mark in the sense required by EU law, in the first place. Without such use, the infringement framework cannot even be triggered. The following section therefore turns to this threshold inquiry.

4. Does upcycling entail *use* of a trade mark?

4.1. *The notion of 'use' through the case law of the Court of Justice*

As noted above, the decisive issue for determining whether upcycling practices fall within the infringement framework is whether the visibility of trade marks on reworked products amounts to 'use' in the sense required by EU law. Rather than relying on environmental arguments or on the uncertain reach of exhaustion and statutory defences, the starting point must be the Court of Justice's construction of 'use'. The following analysis outlines that jurisprudence and considers how it may apply to upcycling scenarios.

To begin with, the concept of 'use', within the meaning of Article 9(2) EUTMR and Article 10(2) EUTMD, is not statutorily defined.[65]

62. *Intel* (n 61) [29], [75]–[76].
63. *Hermès* (n 18).
64. *Hermès* (n 18) [181].
65. Case C-334/22 *Audi AG v GQ and Others* EU:C:2024:123 [30]; cf Joined Cases C-148 and C-184/21 *Louboutin v Amazon* EU:C:2022:1016 [25].

Furthermore, the types of use listed in Article 9(3) EUTMR and Article 10(3) EUTMD that an EU trade mark proprietor may oppose are not exhaustive.[66] What the Court of Justice has already crystallized is that the term 'use' refers exclusively to active conduct/behaviour[67] on the part of the alleged infringer.[68] Importantly, the undertaking of this active behaviour or conduct must also be marked by a degree of (direct or indirect) control.[69] A further recurrent consideration is the existence of a situation where the alleged infringer acts on their own initiative and in their own name, so that the use forms part of their own commercial communication or occurs in the course of their own economic activities.[70]

These requirements are not always articulated by the Court as a free-standing or uniform test. Rather, they can be reconstructed from a line of cases in which the Court has assessed whether the alleged infringer's conduct was sufficiently active, subject to their direct or indirect control, and integrated into their own commercial communication to be attributable to them as trade mark use. Although much of this case law arose in situations involving three parties, where the alleged user had an intermediary role, it nevertheless assists in identifying when the presence of a sign becomes attributable to a particular person as trade mark use. In the upcycling context, this turns on whether the upcycler merely deals with goods on which a mark remains visible or instead assumes control over the sign's communicative role within their own commercial activity.

In applying this approach, the Court has treated several factual scenarios as constituting 'use'. In *Mitsubishi*, removing a trade mark from forklift trucks and replacing it with a new sign for the purpose of importation and marketing in the EEA was held to constitute use, since it involved active conduct and commercial control over the removal and replacement of the

66. *Audi* (n 65) [33]; *Louboutin/Amazon* (n 65) [27]; Case C-567/18 *Coty Germany GmbH v Amazon Services Europe Sàrl* EU:C:2020:267 [32]; and case law cited therein: Joined Cases C-236 to C-238/08 *Google France and Google* EU:C:2010:159 [65]; *Arsenal* (n 49) [38]; *Adam Opel* (n 26) [16]; and Case C-76/24 *TradeInn Retail Services SL v PH* EU:C:2025:220 Opinion of AG Spielmann at point 26 referring to EUTMD, art 10(3).

67. For the interchangeable use of these terms in the Court's vocabulary, see Eleonora Rosati, 'The Louboutin/Amazon Cases (C-148/21 and C-184/21) and Primary Liability under EU Trade Mark Law' (*SSRN*, 2022) 5 fn 20 <papers.ssrn.com/sol3/papers.cfm?abstract_id=4078987>.

68. *Audi* (n 65) [33]; *Louboutin/Amazon* (n 65) [27]; Case C-129/17 *Mitsubishi Shoji Kaisha Ltd v Duma Forklifts NV* EU:C:2018:594 [48]; *Daimler* (n 26) [40].

69. See Rosati (n 67) 5–6 fn 21; cf Case C-529/07 *MK Advokaten GbR v DDB Deutschland GmbH* EU:C:2009:343 [23]; *Coty Germany* (n 66) [37]; *Daimler* (n 26) [41]–[42]; and Opinion of AG Spielmann in *TradeInn* (n 66) points 54, 59.

70. Rosati (n 67) 5–6 fn 22; *MK Advokaten* (n 69) [27]; by analogy, *Coty Germany* (n 66) [39]–[40], *Google France* (n 66) [56]; see also AG Spielmann's Opinion in *TradeInn* (n 66) [58].

sign.[71] In *Louboutin/Amazon*, the Court confirmed that an online marketplace operator may itself be considered to use a sign where its uniform presentation of third-party offers and branding creates the impression that it is marketing the infringing goods in its own name.[72] In *Audi*, affixing a sign identical to the car manufacturer's trade mark on spare parts would qualify as use, as it formed part of the defendant's commercial strategy.[73]

By contrast, other cases indicate when 'use' is absent. In *Daimler*, the Court of Justice held that the display of a trade mark in third-party online advertisements is not attributable as 'use' to the trader where the advertisement was not placed by that trader, or – if it initially appeared with the trader's consent – where it continued to appear despite the trader having taken reasonable steps to have it removed.[74] In *Coty Germany*, the Court ruled that warehouse operators storing goods without knowledge of the trade mark status and without pursuing their marketing do not themselves use the signs.[75] Similarly, in *MK Advokaten*, an advertiser who had arranged for an infringing advertisement to appear on one website was not considered to use the sign when other websites reproduced that advertisement on their own initiative and in their own name.[76]

The Court has adopted a similar approach, regarding use in one's own commercial communication, in cases concerning the creation of technical conditions for the use of a sign. In *Google France*,[77] it held that a search engine provider does not itself use a trade mark simply by allowing advertisers to select it as a keyword. Likewise, in *Winters*[78] and in *TOP Logistics*,[79] service providers who filled, stored, or transported goods bearing allegedly infringing signs were not considered to 'use' marks where they did not integrate them into their own commercial communication.[80]

Applied to upcycling, the guidance above indicates that the focus should be on whether the upcycler's conduct can be considered to satisfy both conditions. In many cases, the answer may be in the negative. That is because the mark often remains on the product as a residual feature of the original item – for example, a stitched logo patch on denim that is still

71. *Mitsubishi* (n 68) [48].
72. *Louboutin/Amazon* (n 65) [54].
73. *Audi* (n 65) [56]–[60].
74. *Daimler* (n 26) [44].
75. *Coty Germany* (n 66) [45]–[46], [53].
76. *MK Advokaten* (n 69) [31].
77. *Google France* (n 66) [57].
78. Case C-119/10 *Frisdranken Industrie Winters BV v Red Bull GmbH* EU:C:2011:837 [30].
79. Case C-379/14 *TOP Logistics BV and Van Caem International BV v Bacardi & Company Ltd and Bacardi International Ltd* EU:C:2015:497 [45].
80. Kur and Senftleben (n 25) 277.

visible after the jeans are turned into a jacket – rather than being 'reactivated' in the upcycler's own commercial communication or used to signal origin. Where there is no such invocation or control over the mark's communicative function/as an indication of origin, the conduct may not constitute 'use' in the trade mark sense at all. In practice, this means that the typical starting point of the analysis is challenged: upcycling may not need to be justified *post hoc* through trade mark defences, as it may not trigger trade mark infringement to begin with.

As noted, upcycling can involve techniques such as subtraction (cutting or cropping), deconstruction (disassembly and reassembly), addition of embellishments, or re-functioning (transforming garments into entirely new products). From the considerations above it follows that the first three techniques are most likely of limited legal interest from a trade mark perspective, as they will often not amount to 'use' in the first place. That is to say, in both subtraction and deconstruction, the original mark usually remains on the product without being moved, altered, or (deliberately) highlighted. The upcycler does not engage with the sign in any meaningful or communicative way, nor do they incorporate it into their own commercial communication. The same holds true when there is a mere addition of decorative elements or patchworking on the original item. In these cases, what occurs is not an act of use in the trade mark sense, but what may be described as material retention: the sign remains present as part of the original material, without being actively engaged with by the upcycler.

The distinction mirrors the Court of Justice's emphasis – articulated with particular clarity in the *Daimler* case and most recently reaffirmed in the Advocate General's Opinion in *TradeInn* as well as the judgment in *Audi* – that 'use' must involve an active behaviour over which the alleged infringer has control.[81] Mere residual visibility of a mark on a product, without the upcycler exercising initiative over its presence or function, is insufficient. For example, merely embellishing a branded shirt for resale, or altering a jacket's length and silhouette while leaving a label visible in its ordinary position and without making it a particularly visible feature of the reworked product, are unlikely to amount to trade mark use, as their inclusion in the final product is incidental.[82] Similarly, even less likely to

81. The Court's judgment in *TradeInn* did not reiterate the full formulation of the test, but it did rely on the element of control, referring to direct or indirect control over the act constituting the relevant conduct and applying that reasoning, in the context of stocking, to control over the goods concerned: Case C-76/24 *TradeInn Retail Services SL v PH* EU:C:2025:593 [44]–[47].

82. cf *Chanel* (n 19), where the signs appeared on charms incorporated into jewellery and occupied a dominant position on the front side of the charm constituting the primary element of each piece of jewellery.

be considered as use is the case where a logo appears only on non-visible elements of the product – such as an inner label or care tag and is neither highlighted nor made visible in the final design or marketing of the upcycled item. In these cases, the engagement with the mark is passive and does not cross the threshold set under Article 9(2) EUTMR and Article 10(2) EUTMD. That is to say, such incidental inclusion of the sign – in the absence of an active behaviour or control over it – can hardly qualify as 'use', especially in light of the Court's jurisprudence precluding the consideration as 'use' of cases where the third party only engages in passive behaviour.[83]

On the contrary, one could argue that it is the removal of the original sign from a branded item for the upcycler's own trade mark to be affixed, that could constitute 'use', pursuant to the *Mitsubishi* decision, where the Court deemed that 'an operation consisting, on the part of the third party, of removing signs identical to the trade mark in order to affix its own signs, involves active conduct on the part of that third party, which, since it is done with a view to importing those goods into the EEA and marketing them there and is therefore carried out in the exercise of a commercial activity for economic advantage … may be regarded as use in the course of trade'.[84] This should be distinguished from cases of mere de-branding, where the original mark is entirely concealed and not commercially invoked, which has been treated as excluding use of that mark.[85]

Overall, while it is clear that in many scenarios the inclusion of the mark in the upcycled product does not constitute 'use', there are also several instances where the upcycler's conduct may satisfy both conditions of this notion. These typically involve a degree of intentionality and communicative engagement with the mark – going beyond material retention. Such would be the case where the mark is deliberately repositioned or incorporated into the aesthetic design of the upcycled piece – especially if this design forms part of the product's market appeal. Here, the mark would no longer be just residually present, but it would instead be activated within a new communicative context, which could amount to 'use' within the meaning of Article 9(2) EUTMR and Article 10(2) EUTMD. This holds even more true in situations where the 'upcycling' consists of the mark itself being 'repurposed' into a different product whose central element is the

83. *Daimler* (n 26) [39]; Case C-567/18 *Coty Germany GmbH v Amazon Services Europe Sàrl* EU:C:2019:1031, Opinion of AG Campos Sánchez-Bordona, point 39.

84. *Mitsubishi* (n 68) [48].

85. See further on de-branding in Kur and Senftleben (n 25) 278.

trade mark per se – think of Chanel buttons being removed from the original garments and being turned into earrings, as was the case in actual trade mark disputes brought by Chanel.[86]

A similar conclusion could be reached when the upcycler highlights the original mark in their promotional material – for example, by featuring it in social media content or tags. These acts not only amount to distinct acts of trade mark use per se, but also represent an exercise of control over the communicative function of the sign. This introduces the mark into their own commercial communication, indicating a conscious invocation of its origin-indicating capability.

In sum, the decisive factor is the nature of the upcycler's engagement with the sign: whether it is appropriated as part of the upcycler's own commercial narrative or it remains incidentally visible as part of the original item, without being selected, repositioned, highlighted, or otherwise made into a feature of the reworked product.[87]

Read in this way, the Court of Justice's construction of 'use' excludes from the infringement framework those forms of upcycling in which the trade mark only appears as a residual element of the original product and is neither repositioned nor invoked in the upcycler's commercial communication. This will typically cover practices involving subtraction, deconstruction, or decorative modification, where the sign persists without being activated as part of the marketing of the new item. These techniques, in their pure form, reflect the core logic of sustainability-driven upcycling and therefore fall within the range of practices that the threshold analysis advanced here is capable of accommodating.

The threshold is, hence, crossed only where the upcycler assumes control over the communicative role of the sign – for example, by deliberately integrating it into the aesthetic concept of the new product or emphasizing it in promotional materials. That is to say, the decisive factor is not transformation as such, but the nature and degree of engagement with the mark.

86. See relevant discussion in Crystal Broughan, 'Chanel Files Trademark Case against Business Selling Altered Chanel Buttons' (*MarksGray*, 26 July 2023) <marksgray.com/intellectual-property/chanel-files-trademark-case-against-business-selling-altered-chanel-buttons/>; see also 'From Travis Kelce's Shirt to Button Jewelry: Unpacking the Upcycling Craze' (*The Fashion Law*, 24 April 2024) <www.thefashionlaw.com/from-travis-kelces-shirt-to-modified-rolex-watches-unpacking-the-upcycling-craze/>. See also, most recently, the French judgment in the *Chanel* case (n 19).

87. cf *Chanel* (n 19), where the components bearing the marks were not merely left visible on an existing product in an incidental fashion, but incorporated into new jewellery as front-facing charms constituting the primary element of each piece.

4.2. *Assessing the threshold of 'use' in existing upcycling cases*

Having outlined the Court of Justice's understanding of 'use', it is useful to test how this threshold applies in upcycling disputes that have already been brought. The following cases demonstrate that the 'use' threshold excludes incidental forms of retention while continuing to capture deliberate commercial activation of the mark.

Notably, a recently litigated national case on upcycling addressed the legality of the practice, without a consideration of whether the trade marks in question had been 'used' by the upcycler – although the outcome would most likely have been the same had the threshold test proposed here been applied. In its judgment of 10 April 2025,[88] concerning the unauthorized use of Hermès scarves in upcycled garments, the Paris Tribunal held that the activities of Maison R&C and Atelier R&C infringed Hermès' trade mark (and copyright) rejecting the defendants' arguments grounded, inter alia, in environmental protection and creative freedom. The court proceeded directly to assess the acts of upcycling as infringing, without engaging with the threshold question of whether the trade marks had been 'used'.

In any event, 'use' in that context was evident: not only had the defendants retained the original Hermès marks on repurposed silk scarf fragments that were intentionally selected and incorporated into new garments, but also marketed the resulting products on a dedicated commercial website and via Instagram. Their commercial communication consisted of product descriptions and hashtags explicitly referencing Hermès, press features in magazines such as Elle and L'Officiel, and even the option for customers to choose specific Hermès scarf designs to be integrated into their orders. These elements point to a conscious and controlled invocation of the Hermès brand as part of the upcycler's own commercial communication.

Both conditions of the Court of Justice's test for 'use' were therefore clearly met. This was not a case of incidental retention or passive inclusion of a mark, but of deliberate recontextualization of Hermès-branded material into products intended to signal status. Thereby, this conduct undoubtedly qualifies as 'use' within the meaning of Article 9(2) EUTMR and Article 10(2) EUTMD.

A similar conclusion may be reached in the recent Chanel upcycling judgment of the Paris Tribunal.[89] The case concerned jewellery and accessories presented as upcycled from buttons and belt buckles bearing Chanel marks. An instance where an upcycler creates jewellery from components

88. *Hermès* (n 18).
89. *Chanel* (n 19).

bearing a trade mark – more specifically, a reputed one – can hardly be considered to fall outside the threshold of 'use'. Importantly, in creating the 'upcycled' products, the components bearing the marks were removed from their original context and incorporated into new jewellery as front-facing charms forming the primary element of each piece. In the context of the likelihood of confusion assessment, the French court emphasized that the contested signs occupied a dominant position on the front side of the charm. In its assessment of harm, it further noted that the attractiveness of the products lay in the charm bearing the mark, while the remaining materials consisted of ordinary metal chains or strings of beads. These observations point to active engagement with the mark, rather than residual retention, as the components bearing them were selected, recontextualized, and made into the focal point of the new product. In such circumstances, the upcycler's conduct clearly involves control over the presence and function of the sign and its integration into their own commercial communication. The mark therefore becomes part of the design and commercial identity of the new product, and the threshold of 'use' would clearly be satisfied.[90]

This holds even more true in cases where courts have expressly equated 'upcycled' goods with infringement under their domestic laws, notwithstanding their environmental framing. A judgment[91] from outside Europe illustrates this: the Singapore High Court held that the incorporation of authentic Louis Vuitton materials into new products, without the brand's authorization, resulted in those products being deemed infringing, given the false representation arising from the application of the Louis Vuitton marks. This is also a case where it is not clear whether any upcycling took place to begin with, yet the intentional affixing of the marks definitely constitutes an active behaviour meeting the conditions set by EU law for 'use'.

Against this backdrop, it becomes clear that in most of the recently reported upcycling cases, the outcome would have been the same even if the courts had explicitly applied the test of whether the upcyclers' actions qualified as 'use'. This pattern is unsurprising: reported disputes tend to involve reputed marks and forms of upcycling in which the brand insignia is visibly and deliberately incorporated into the new product or its marketing, since these are the situations in which proprietors have the strongest

90. For a comparable non-European example, see the US litigation concerning jewellery made with Chanel buttons in *Chanel* (n 17). The dispute resulted in a consent judgment and permanent injunction, rather than a contested judgment on the merits. See further 'Chanel Settles Upcycling Suit over Jewelry Made from Logo-Bearing Buttons' (*The Fashion Law*, 18 November 2022) <www.thefashionlaw.com/chanel-settles-upcycling-suit-over-jewelry-made-from-logo-bearing-buttons/>.

91. *Louis Vuitton Malletier v Ng Hoe Seng* [2025] SGHC 122.

incentive to invoke trade mark law. That does not, however, make the threshold inquiry redundant. On the contrary, it shows that the notion of 'use' can operate as a shield only where upcycling is undertaken with a genuine commitment to sustainability – where textile waste and garments otherwise destined for landfill are repurposed into objects of higher value – rather than in cases where semi-vintage items bearing reputed trade marks are re-marketed in an attempt to free-ride on brand image under the guise of environmental consciousness.

Going forward, consistent application of these criteria in upcycling scenarios will highlight the distinction between 'use' and 'non-use' in this context. Courts should examine not only the physical incorporation of branded elements, but also whether the upcycler activates the trade mark in their own commercial communication, through marketing, labelling, or curated product presentation. Indicators such as the deliberate prominence of the brand insignia, the presence of explicit references in the marketing of the products (for example in product descriptions), or the consumers' ability to select specific branded components, can signal active engagement with the trade mark. By contrast, where brand features appear merely as residual traces of the original garment, with no deliberate invocation in the upcycler's presentation of the product, the threshold of 'use' is not met.

Ultimately, this analysis suggests that the notion of 'use' provides a workable filter: active, controlled, and communicative engagement with a mark will qualify as trade mark use, while incidental or residual appearances will not. What remains important is that courts maintain this distinction in a principled and coherent manner. Such consistency would not only enhance legal certainty but also clearly delineate the boundary between permissible repurposing and conduct that falls within the scope of infringement. The remaining question is whether this legal construction per se is sufficient to accommodate the EU's sustainability ambitions, or whether broader policy measures are still required – an issue to which the next section turns.

4.3. *Does unauthorized upcycling need additional safeguards?*

Having examined the doctrinal dimensions of trade mark law in relation to upcycling, the foundation has been laid to consider whether additional intervention is required. This assessment must be read against the EU's broader sustainability agenda (as outlined in Section 1) aiming at extending product lifecycles and reducing textile waste. The question, therefore, is whether trade mark law, as currently construed, allows sufficient room for

upcycling to take place within this framework, or whether further legislative or regulatory adjustment is needed instead.

Despite the variety of doctrinal routes proposed to reconcile upcycling with trade mark law – ranging from exhaustion to defences and rights-based arguments – the inherent constraints as well as the Court of Justice's restrictive interpretation of these mechanisms leave little space for them to operate meaningfully. A closer look at each reveals why their practical effectiveness appears to be limited.[92]

Starting with the doctrine of exhaustion, it is true that once a trade mark proprietor has placed the goods on the EU market, exclusive rights may no longer be relied on to oppose their further commercialization (Article 15(1) EUTMR/EUTMD). In principle, therefore, an upcycler who acquires genuine second-hand goods should benefit from exhaustion. However, Article 15(2) EUTMR/EUTMD provides that the proprietor may nevertheless oppose further commercialization where there are 'legitimate reasons' to do so, including in the non-exhaustively[93] mentioned example where the condition of the goods has been altered after they have been put on the market.[94]

As in the context of repaired and refurbished goods, the assessment under Article 15(2) turns in particular on whether the post-sale interventions affect the 'identity' of the product placed on the market with the proprietor's consent. Where such identity change occurs, the proprietor may legitimately object to further commercialization.[95] The notion of upcycling inherently entails such alteration and may therefore be met in practice with objections based on Article 15(2).[96] That is because upcycling typically involves cutting, reassembling, combining, or otherwise transforming garments into products that differ from those originally marketed under the trade mark. Indeed, transformation into a new product of higher perceived value lies at the definitional core of upcycling. In that sense, identity change is constitutive of the practice itself. Conversely, where no such transformation occurs, the activity would more accurately be characterized as mere repair

92. In this regard, see also Martin Senftleben, 'Fashion Waste, Trade Mark Protection, and the Circular Economy' in Eleonora Rosati and Irene Calboli (eds), *The Handbook of Fashion Law* (Oxford University Press 2025) 115, 127.

93. Case C-427/93 *Bristol-Myers Squibb v Paranova*; Case C-429/93 *C.H. Boehringer Sohn et al v Paranova*; Case C-436/93 *Bayer Aktiengesellschaft and Bayer Danmark v Paranova* EU:C:1996:282 [39]; Case C-337/95 *Parfums Christian Dior SA and Parfums Christian Dior BV v Evora BV* EU:C:1997:517 [54].

94. Eg in the case of repackaging; see Case C-102/77 *Hoffmann-La Roche & Co. v Centrafarm* EU:C:1978:108 [8], [14].

95. Kur (n 24) 233.

96. Geiregat (n 24) 289.

or refurbishment rather than upcycling. The practice, thus, moves beyond mere resale of the same goods and enters a space in which the proprietor may plausibly invoke legitimate reasons to object.[97]

For that reason, exhaustion cannot be assumed to provide a comprehensive or automatic shield for upcyclers – although it has been suggested that, in appropriate cases, a context-sensitive assessment may allow the continued circulation of altered goods, particularly where adequate accompanying information clarifies the nature and source of the third-party intervention.[98] In this respect, a more expansive reading of exhaustion has also been advocated in the context of circular-economy practices, according to which intellectual property rights should be considered exhausted where this promotes sustainability and circularity unless consumers are genuinely deceived or harmed.[99] More specifically in relation to upcycling, a recent 'tailored' approach to exhaustion proposes that alteration should not automatically amount to a legitimate reason for opposition under Article 15(2). In line with this approach, the assessment should instead turn on whether the alteration actually prejudices the trade mark proprietor's interests, also taking into account whether the upcycler has clearly signalled the nature of the intervention and its independence from the trade mark proprietor.[100] Such solutions are, nevertheless, situated within the infringement-exhaustion framework and presuppose that the upcycler's conduct qualifies as 'use' of the mark in the first place.

Turning to the statutory defences provided by the trade mark legislation, their interpretation by the Court of Justice has so far been restrictive in ways that do not appear favourable for upcycling. The descriptive use defence (Article 14(1)(b) EUTMR/EUTMD), which concerns signs or indications describing characteristics of goods and services, as interpreted in *Adidas*/*Marca*[101] and *Adam Opel*,[102] has been applied rather narrowly, leaving limited room for reuse practices. Only the 'non-distinctive use' exception remains open to interpretation and could, in principle, be explored

97. Kur (n 24) 228, 232–33; see also Senftleben (n 24) 102.

98. Kur (n 24) 235–37; cf Case C-46/10 *Viking Gas A/S v Kosan Gas A/S* EU:C:2011:485 [36]–[41].

99. Calboli (n 23) 245.

100. Calabrese (n 24) 93–96.

101. The Court held that the use of two parallel stripes on sportswear for purely decorative purposes fell outside the descriptive use exception, since the motifs were not intended to indicate any characteristic of the goods. See Case C-102/07 *adidas AG and adidas Benelux BV v Marca Mode CV and Others* EU:C:2008:217 [48].

102. The Court found that the reproduction of the Opel logo on scale model cars was not descriptive of their characteristics but instead constituted use as a trade mark, as it could suggest a commercial link with Opel. See *Adam Opel* (n 26) [48].

in this context[103] – though this remains untested. The referential use defence (Article 14(1)(c) EUTMR/EUTMD), which covers use of a trade mark to identify or refer to the proprietor's goods or services, has also been advanced as a promising ground for upcycling,[104] but can face similar difficulties. That is also because in all cases, the effectiveness of these statutory defences is further constrained by the proviso of 'compliance with honest practices in industrial or commercial matters' (Article 14(2) EUTMR/EUTMD), which has been rendered particularly problematic by the Court's approach towards its assessment. As demonstrated in *Gillette*, the Court's test for compliance with honest practices essentially employs the same criteria as those applied to determine prima facie infringement.[105] Such circular reasoning[106] leaves little to no space for consideration of the competing societal interests that statutory limitations on exclusive rights are supposed to balance.[107]

A further proposed route[108] is to read these defences, the doctrine of exhaustion, as well as the notion of 'due cause', in light of fundamental rights and principles – more specifically, freedom of expression (Article 11 Charter of Fundamental Rights ('CFR')), freedom of the arts (Article 13 CFR), particularly in relation to cultural-theoretical accounts of upcycling as a form of artistic and communicative reuse,[109] and the CFR's provision on environmental protection (Article 37 CFR), so as to reinforce the protection of sustainability-oriented uses.[110] Insofar as artistic expression and fundamental rights are concerned, this approach is also consistent with Recital 21 of the EUTMR and Recital 27 of the EUTMD, which recognize the relevance of artistic expression and require EU trade mark law to be applied with full respect for fundamental rights and freedoms.[111] In relation to 'due cause' specifically, it is also supported by Advocate General Szpunar's

103. Senftleben (n 24) 103.

104. Senftleben (n 24) 107.

105. Case C-228/03 *The Gillette Company and Gillette Group Finland Oy v LA-Laboratories Ltd Oy* EU:C:2005:177 [49].

106. See more in Kur and Senftleben (n 25) 432.

107. See more in Martin Senftleben, *The Copyright/Trademark Interface – How the Expansion of Trademark Protection Is Stifling Cultural Creativity* (Wolters Kluwer 2020) 157–59.

108. Senftleben (n 1) 349–87.

109. Martin Senftleben, 'Fashion Upcycling and Trademark Infringement: A Circular Economy/Freedom of the Arts Approach' in David Tan, Jeanne C Fromer and Dev S Gangjee (eds), *Fashion and Intellectual Property* (Cambridge University Press 2025) 217, 232–39.

110. See Elena Izyumenko, 'Intellectual Property in the Age of the Environmental Crisis: How Trademarks and Copyright Challenge the Human Right to a Healthy Environment' (2024) 55 International Review of Intellectual Property and Competition Law 864, 870 and 889–91, doi: 10.1007/s40319-024-01478-0, arguing for an environmentally informed interpretation of exhaustion.

111. EUTMR (n 20) Recital 21; EUTMD (n 21) Recital 27.

Opinion in *IKEA*, pending before the Court of Justice at the time of writing, which presents 'due cause' as a case-by-case balancing mechanism capable of reconciling the protection of reputed trade marks with competing fundamental rights and interests.[112] The Opinion further clarifies that conduct riding on the reputation of a mark cannot constitute due cause absent another valid justification. Such justification may arise from objectively overriding considerations or from the subjective interests of the third party, provided that these can be weighed against the proprietor's interest in a way that justifies requiring the proprietor to tolerate the use.[113]

Nevertheless, the invocation of these interests does not in itself displace the protection of intellectual property as provided by Article 17(2) CFR. The relevant exercise is therefore one of fair balancing between the protection of intellectual property, on the one hand, and freedom of expression or environmental protection, on the other, carried out in accordance with Article 52(1) CFR, which requires both necessity and proportionality. This can be difficult to substantiate in the case of upcycling, not only because several brands have taken initiatives to upcycle their own products[114] – weakening the necessity of third-party repurposing – but also because the inclusion of brand insignia on the upcycled product is sometimes hard to justify. This holds even more true in cases where the trade mark in question is a reputed one – raising suspicions that under the guise of upcycling lies an underlying will to free-ride on the commercial appeal of a certain undertaking and its brand identity. This view has also found support in the first European cases decided on upcycling and involving luxury products, such as Hermès scarves[115] and Chanel mark-bearing components, including buttons and belt buckles,[116] previously discussed in Section 4.2.

Lastly, the Court's current approach to the gatekeeper requirement of use as a trade mark, advanced as one of the most prominent shields for fashion upcycling, has so far proved unduly elastic.[117] Such elasticity risks

112. Case C-298/23 *Inter IKEA Systems BV v Algemeen Vlaams Belang VZW and Others EU:C:2025:886,* Opinion of AG Szpunar, points 99–108.

113. Opinion of AG Szpunar in *IKEA* (n 112), points 116–117.

114. See eg Coachtopia, a sub-brand of Coach, developed from materials 'that were destined for landfill', in Rachel Cernansky, 'Coach Rolls out Coachtopia, a New Line Made from Material Waste' (*Vogue Business*, 20 April 2023) <www.vogue.com/article/coach-rolls-out-coachtopia-a-new-line-made-from-material-waste>. See also Vivienne Westwood's 'Reimagining Waste' initiative at <www.viviennewestwood.com/en-de/contentsearch/?fdid=reimagining-waste>.

115. *Hermès* (n 18).

116. *Chanel* (n 19).

117. See eg Case C-63/97 *BMW v Deenik* EU:C:1999:82 [42]; Case C-533/06 *O2 Holdings Ltd and Others v Hutchison 3G UK Ltd* EU:C:2008:339 [35]–[36]; Case C-17/06

blurring the boundary between actionable and non-actionable use, thereby undermining the intended gatekeeping function this requirement was meant to perform.[118] To restore this role, it has been suggested that a recalibration is needed: use should only be deemed relevant – from a trade mark perspective – where the upcycler employs the sign to indicate the commercial origin of their own products. This clarification would preserve the integrity of trade mark protection while ensuring reuses undertaken in a circular economy context are not automatically drawn into infringement disputes unless there is evidence of misleading or exploitative conduct.[119]

Against this uncertain background, the question arises whether legislative or regulatory intervention is required. In short, the answer is no. Rather, the focus may simply need to shift one step earlier in the infringement analysis – to the threshold question of whether the upcycler's conduct amounts to 'use' of a trade mark at all. This approach preserves the internal coherence of trade mark law while also ensuring that the evidential burden remains with the proprietor, not the upcycler.

As the analysis of the 'use' threshold, in Section 4.1, demonstrated, a substantial part of 'genuine' upcycling – where garments otherwise destined for landfill are repurposed without any deliberate activation of the trade mark – will not satisfy the Court of Justice's threshold for trade mark use in the first place. In such cases, the foundation to even begin the assessment of prima facie infringement is absent, rendering additional legislative measures unnecessary. At the same time, cases where the trade mark is intentionally highlighted, repositioned, or leveraged as part of the upcycler's commercial communication – such as the litigation concerning the Hermès scarves – are precisely the scenarios where liability arises. Hence, the current framework seems to be sufficiently calibrated: it excludes incidental inclusion of the marks – in the context of sustainability-driven repurposing – from infringement, while capturing conduct that crosses into deliberate exploitation of the mark's commercial appeal, operating as a 'filter' to different upcycling scenarios.

It is also worth noting that the interpretative approaches proposed in the literature would not extend protection to instances of upcycling carried out with a view to parasitism either. Senftleben's abovementioned emphasis on a stricter reading of the gatekeeper requirement of use as a trade mark,[120] inspired by Dogan and Lemley's configuration with a focus on 'misleading

Céline SARL v Céline SA EU:C:2007:497 [23]. See also Senftleben (n 24) 100–101; Kur and Senftleben (n 25) 289.

118. See more in Senftleben (n 24) 105.
119. Senftleben (n 24) 110.
120. Senftleben (n 24) 110.

branding',[121] also operates as a filter – excluding decorative or incidental uses while ensuring that cases involving deliberate attempts to suggest affiliation with the trade mark owner remain actionable. In this sense, under this proposal as well, upcycling undertaken with the intention of exploiting brand value would fall outside the ambit of any available safeguard. Such a limit is essential to prevent 'upcycling' from becoming a green-washing label for practices that simultaneously aim at free-riding on the investments of brand owners and misleading consumers as regards the commercial origin of the product.[122]

Building on these approaches, the focus on the threshold notion of 'use' can be understood as complementary to, yet logically (and structurally) preceding, Senftleben's proposal regarding the gatekeeper requirement of use as a trade mark. Read together, the two perspectives could establish a sequential filter: first, whether the upcycler's conduct constitutes *use* at all; and, second, whether any such use occurs *as a trade mark.* This cumulative reading enhances the coherence of the infringement analysis, ensuring that only acts genuinely capable of affecting the mark's functions are captured within its scope. In practice, most sustainability-driven upcycling will be filtered out at the first step (not qualifying as *use*), as discussed in Section 4.1 and illustrated through the examples in Section 4.2. Where a court nonetheless finds 'use', the second step screens out conduct that does not perform a trade mark function in relation to the defendant's goods. Only if both steps are satisfied do the statutory defences (descriptive/non-distinctive or referential use) and 'due cause' become relevant. As these positions are doctrinally sequential, a party (that is, the upcycler) may argue, in the alternative, (i) no *use* (ii) no use *as a trade mark* – intended to indicate origin; and only then, where such use is established, resort to the statutory defences or negative condition of 'due cause' to address the limited category of cases in which sustainability-motivated upcycling still meets the threshold of trade mark use.

In broader terms, this means that EU trade mark law already accommodates the overarching sustainability objectives reflected in Article 11 TFEU and pursued through the Green Deal and related initiatives. Far from creating an obstacle, the jurisprudential construction of use ensures that circularity can flourish without undermining the integrity of trade mark protection. Accordingly, there is no need for additional legislative

121. Stacey Dogan and Mark A Lemley, 'Trademarks and Consumer Search Costs on the Internet' (2004) 41 Houston Law Review 777, 798, doi: 10.2139/ssrn.560725.

122. See from a US law perspective, Keats (n 24) 720–26, discussing luxury-product upcycling as a form of commercial hitchhiking where the appeal of the upcycled product depends on the reputation and commercial value of the original branded product.

intervention. As the tools are already in place, the remaining task lies in applying them consistently – distinguishing sustainability-driven repurposing from opportunistic parasitism.

5. Concluding remarks

Upcycling, often presented as a novel response to sustainability imperatives, has deep roots in older practices of repair and remaking. Before prêt-à-porter, garments were routinely altered and repurposed, reflecting a culture in which clothes were expected to last and in which economic burden made replacement less feasible. What once stemmed from necessity has now evolved into a trending design philosophy that not only responds to environmental concerns but also reimagines fashion's role in a circular economy. From small-scale necessity to mainstream sustainability practice, this shift has brought upcycling under closer legal scrutiny, particularly as regards the risk of potential trade mark infringement.

In this context, the article set out to answer a simple but consequential question: does upcycling require new legislation or policy intervention under EU trade mark law, or can existing doctrine already accommodate it? The analysis shows that the answer lies not in new carve-outs or rights-based overrides, but in a doctrinal feature the case law already supplies – namely, the threshold notion of 'use'.

The main takeaways are as follows. First, the piece moves from the premise that infringement in EU law rests on cumulative conditions and that 'use' is the indispensable first prerequisite. Read through Court of Justice jurisprudence, 'use' requires active, controlled engagement with a sign within one's own commercial communication. That standard draws a clear distinction between incidental retention of brand elements that persist as residual features of a reworked item and deliberate activation of the mark – by repositioning or leveraging it in marketing or labelling – to trade on the brand's communicative power. Only the latter crosses the threshold into trade mark use.

Second, applied to the heterogeneous reality of upcycling, this threshold operates as a workable filter. Where upcycling repurposes garments otherwise destined for landfill without activating the mark, the foundation for assessing prima facie infringement is absent. Conversely, where the mark is intentionally highlighted, curated, or repurposed as a selling point, the conditions for use are met and the infringement analysis can proceed in the ordinary way. In short, the current framework already excludes

incidental, sustainability-driven repurposing, while capturing conduct that amounts to misleading branding or free-riding.

Third, this doctrinal route offers an answer on the policy dimension. By resolving many disputes at the 'use' threshold, EU trade mark law already aligns with the Union's circularity objectives, without diluting core brand protection, thereby making additional legislative intervention unnecessary.

Read against the EU sustainability initiatives outlined in Section 1 and the scholarly responses to upcycling discussed in Section 4.3, the contribution of this article lies in relocating the analysis to an earlier point in the infringement inquiry. While much of the relevant debate on upcycling so far has concentrated on exhaustion, defences, due cause, rights balancing under the CFR, or the recalibration of the gatekeeper requirement of use as a trade mark, this article re-centres the discussion on the threshold notion of 'use'. In doing so, it reduces reliance on contestable balancing and avoids creating sustainability-specific exceptions that could be over- or under-inclusive. Importantly, it also filters out opportunistic practices: where upcycling is carried out with a view to parasitism or to suggest unauthorized affiliation, it will typically satisfy the 'use' threshold and remain actionable.

Looking ahead, the article offers practical guidance to consolidate adjudication and compliance. That is to say, when dealing with upcycling, decision-makers should ask: (1) Is the sign merely residual, or has it actively been re-positioned or made prominent? (2) Is the sign invoked in the upcycler's own marketing, labelling, product descriptions, or channel tags? Additional indications that would assist in answering the question of whether there is 'use' in the affirmative would include consumers getting to select specific branded components, signalling that the brand identity is a selling point. Clear answers to these questions will reliably separate non-use from use, bringing predictable outcomes – in other words, the legal certainty for sustainability-oriented upcycling to flourish – without new legislation.

Lastly, the implications reach beyond fashion, as several circular economy practices raise similar questions. The same 'use'-first screening can help reconcile intellectual property enforcement with sustainability across sectors, while preserving space to act robustly against practices that mislead consumers or free-ride on reputation. This, in turn, suggests a wider regulatory point: when established legal frameworks are confronted with socially valued change, the answer may lie not in expanding those frameworks, but in the reconstruction of their existing requirements and in the space they may already leave for new practices. Ultimately, much like upcycling, the law's role is not to reinvent from scratch but to adapt what is already in place to new demands of sustainability – to find new value in what already exists.