Limits on the improper use of third-party trademarks in the parallel import of medicinal products

Comments on Judgment No 63/2026 of 18 May and Order No 164/2026 of 8 April of the Court of First Instance of Alicante (European Union Trademark Court)

Introduction

The parallel import of medicinal products is a legitimate expression of the principle of the free movement of goods within the European Economic Area. However, this activity must be reconciled with adequate protection of the rights conferred by law on trademark proprietors.

Two recent decisions handed down by the Court of First Instance of Alicante, acting as a European Union Trademark Court, in proceedings in which we represented the proprietors of the trademarks concerned, confirm that parallel importers' use of third-party trademarks is subject to very strict conditions.

CJEU case-law: relabelling as the general rule

Since its 1996 judgment in Bristol-Myers Squibb case, the Court of Justice of the European Union (CJEU) has held that a trademark proprietor may oppose the repackaging of a parallel-imported medicinal product where repackaging is not necessary to enable the product to gain effective access to the market of the importing Member State.

In subsequent cases such as Pharmacia & Upjohn and Boehringer Ingelheim cases, the CJEU clarified that the decisive requirement is the objective necessity of the action taken by the importer. It is not sufficient to show that repackaging is commercially advantageous. A parallel importer may repackage the product and reaffix the original trademark to the new packaging only if it can demonstrate that, without repackaging, effective access to the market would in fact be hindered.

This line of case-law was reaffirmed by the CJEU in its 2022 judgments in the Novartis, Bayer, Merck and Impexeco cases. The Court again emphasised that repackaging by replacing the original packaging is an exception and that relabelling must, in principle, be regarded as the preferred solution because it interferes less with the essential functions of the trademark. Repackaging may be justified only where the importer demonstrates the existence of genuine obstacles to the marketing of relabelled products; it cannot be justified based on a general presumption that consumers are resistant to relabelled medicinal products.

Repackaging requires an objective and demonstrable necessity

The judgment of 18 May 2026 was delivered in proceedings concerning the marketing in Spain of a medicinal product originating in the Czech Republic and applies the above case-law.

The importer had entirely replaced the original secondary packaging with new packaging of its own design, to which it affixed the proprietor's trademark without authorisation. The dispute concerned whether that action was objectively necessary to market the product in Spain or whether the same result could have been achieved through relabelling operations.

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After examining the applicable EU case-law and the evidence adduced, the Court concluded that the importer had failed to establish the existence of obstacles justifying the complete replacement of the packaging. In particular, it rejected the proposition that certain operators' mere preference for repackaged products, or the commercial advantages associated with a particular presentation, could constitute genuine obstacles to the market access of the relabelled product.

The Court therefore held that, in those circumstances, the repackaging and resulting use of the original trademark infringed the proprietor's trademark rights and upheld the action in full.

The judgment is significant because it reiterates that the burden of proving the necessity of repackaging lies with the parallel importer on a case-by-case basis, and confirms that the commercial preferences of operators in the sector are insufficient to justify an exception to the general rule of relabelling.

Preliminary injunctions against the opportunistic use of a third-party trademark

The second decision is an order for preliminary injunctions issued by the Court of First Instance of Alicante on 8 April 2026.

Unlike classic parallel-import scenarios, the imported products in this case were medicinal products marketed under their generic names in EU countries by two companies. Those products had the same composition as another medicinal product marketed in Spain under a registered trademark by a third unrelated company. The parallel importer intended to purchase the generically named products in their countries of origin and place them on the Spanish market using that trademark and reproducing in full the outer packaging of the Spanish company's product.

The order of the Court of First Instance recalls that exhaustion of trademark rights necessarily requires the goods to have been put on the market in the European Economic Area by the trademark proprietor or with its consent. Where that condition is not met, the proprietor retains the right to prohibit third parties from using its trademark.

As regards periculum in mora, the Court of First Instance recalls that, in cases involving infringement of exclusive rights, the risk arising from procedural delay is inherent in the continuation of the infringement. As the infringement continues while the proceedings are pending, the harm caused becomes progressively more serious and restoration of the previous position more difficult if judgment is ultimately given in favour of the claimant.

On that basis, the order of the Court of First Instance grants a preliminary injunction prohibiting the parallel importer from using a trademark belonging to another proprietor to market those products in Spain.

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