

**BRIEF AMICUS CURIAE TO INTELLECTUAL PROPERTY HIGH COURT**  
**Louis Vuitton Malletier v. Kyunghan Lee**  
**CASE NO. 2023 Na 11283**

**I. ABOUT THE AMICI CURIAE**

*Amici Curiae* are law professors with an expertise in United States trademark law and an understanding of the international intellectual property system. *Amici* seek to assist this Court in resolving this case by providing additional information and analysis of relevant United States law.

Professor Rebecca Tushnet is the Frank Stanton Professor of the First Amendment, Harvard Law School. She has written extensively on trademark and advertising law, including as a coauthor on a leading trademark casebook, Jane Ginsburg et. al., *Trademark & Unfair Competition* (as of 2022), and routinely files amicus briefs in U.S. trademark cases. Her work has been cited by courts multiple times, including in *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 136 (2014) (citing Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. Pa. L. Rev. 1305 (2011)).

Professor Jack Lerner is Clinical Professor of Law and Director of the UCI Intellectual Property, Arts, and Technology Clinic at University of California at Irvine. He has written extensively on intellectual property law including as Executive Editor on the award-winning treatise, *Internet Law and Practice in California* (CEB), and routinely files amicus briefs in U.S. trademark cases. Under Professor Lerner's supervision, students in the UCI Intellectual Property, Arts, and Technology Clinic have achieved trademark protection for in the United States Patent and Trademark Office for small businesses since 2016, including clothing and lifestyle brands. He has spoken widely on intellectual property and trademark law, including at international academic bodies such as Association Internationale por la Protection de la Propriete Intellectuelle and the Association for Teaching and Research in Intellectual Property, and has advised policymakers in the developing world on international intellectual property law.

Professor Jason M. Schultz is a Professor of Clinical Law at New York University (NYU), Director of NYU's Technology Law & Policy Clinic, and Co-Director of the Engelberg Center on Innovation Law & Policy. His writing primarily focus on intellectual property, privacy, consumer protection, and civil rights in light of new technologies. During the 2016-2017 academic year, he served as Senior Advisor on Innovation and Intellectual Property to U.S. Chief Technology Officer Megan Smith at the White House Office of Science and Technology Policy. He is the co-author of *The End of Ownership: Personal Property in the Digital Economy* (MIT Press 2016), which argues for retaining consumer property rights in a marketplace that increasingly threatens them. He is a member of the American Law Institute.

Professor Stacey Dogan is Professor and The Honorable Frank R. Kenison Distinguished Scholar in Law, Boston University School of Law. She is a leading scholar in intellectual property and competition law, with a special focus on trademark and unfair competition law. Her work has been cited many times by federal courts, including a recent citation by the U.S. Supreme Court in *Jack Daniel's v. VIP Products*, 599 U.S. \_\_\_ (2023) (quoting S. Dogan & M. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 Iowa L. Rev. 1669, 1683 (2007)).

Professor Andrew Chin is the Paul B. Eaton Distinguished Professor of Law at University of North Carolina at Chapel Hill School of Law. He writes and/or teaches in various legal fields that interface with modern technology or call for quantitative methods and insights, including the laws of intellectual property. He was the author and attorney of record on amicus briefs in *Rucho v. Common Cause* and *Gill v. Whitford*. Chin's scholarship on the calculation of short-swing insider trading liability has helped numerous plaintiffs' attorneys maximize recoveries for corporations and shareholders. In earlier work, Chin authored a strategic disclosure of 11 million isolated DNA oligonucleotides that has been cited as prior art in more than 30 issued U.S. patents.

Professor Yvette Joy Liebesman is a Professor of Law at Saint Louis University School of Law and the founder and faculty adviser of the school's Intellectual Property Law Concentration program. Her research interests focus on Copyright and Trademark law and their intersection with art, science, and technology. In 2013 Professor Liebesman was awarded the International Trademark Association's Ladas Award for writing excellence on the subject of trademarks and related matters, and was the 2015 recipient of the Sponsored Scholarship Grant administered by University of Houston's Institute for Intellectual Property & Information Law. In 2017, she was elected to the American Law Institute.

Professor Joshua D. Sarnoff is a Professor of Law at DePaul University College of Law. He leads the College's Center for Intellectual Property Law and Information Technology and a 2022 Recipient of DePaul University Excellent in Public Service Award. He also received the 2018 DePaul University Spirit of Inquiry Award. He served as 2014-2015 Thomas A. Edison Distinguished Scholar at the U.S. Patent and Trademark Office. He is Editor and co-author, *Research Handbook on Intellectual Property and Climate Change* (Edward Elgar Publishing 2016)

Professor Stacey Lantagne is a Professor of Law at Western New England University School of Law, who focuses on the intersection of digital creativity and copyright and trademark law. She is a member of the Legal Committee of the Organization for Transformative Works. She has been quoted in news outlets including Law360, The Atlantic, NPR (1A), Slate, Vox, Wired, and The Verge. Her scholarship has appeared in publications including the Harvard Journal of Sports and Entertainment Law, and other academic journals.

Professor Ashley R. Dobbs is a Professor of Law, Clinical Practice, and Director of the Intellectual Property and Transactional Law Clinic at the University of Richmond School of Law. Through the Clinic, she and participating law students provide IP and business transactional legal services to entrepreneurs, non-profits, artists, and small businesses. While in private practice at Hogan Lovells, P.C., Professor Dobbs was named a "Rising Star in Intellectual Property" by Virginia/D.C. Super Lawyers.

Professor Kyung Sin ("K.S.") Park is Professor at Korea University Law School, directing the Internet Law Clinic there, through which he has provided counseling, expert testimonies, and amicus briefs on the cases where freedom of expression, intellectual property, and privacy intersect in South Korea and globally. One such lawsuit resulted in the world's first successful damages judgment for a user of copyrighted material against the rightsholder for bad faith initiation of the notice and takedown process under South Korea's online copyright law in February 2012.

## II. INTRODUCTION

The amici here first learned of this case through Open Net Association, Inc., a digital rights organization advocating for and publishing in intellectual property and innovation in and outside South Korea. In this case, the owners of luxury brand goods, Louis Vuitton bags, requested the defendant repair shop to repair and modify the bags. Louis Vuitton sued for trademark infringement arguing that the repair shop's act of repairing and modifying infringed on its trademark rights. Already the precedent of the US, the German Supreme Court, and the recent Swiss Supreme Court have accumulated globally on the issue of trademark infringement on the owner-requested repair. We the amici saw the significance of this case as the first one in the world involving luxury bags and therefore generating the first precedent of the kind, and respectfully submit the following opinion:

With a rising concern for sustainability, there is a newfound culture of refurbishing goods rather than purchasing anew. Customers seek repair-and-reform services to prolong the life of luxury goods to enjoy the product longer. In this case, a repair shop has been punished for providing skillful services to satisfy the owners' desire to fulfill this need. Such repair shop is clearly distinguished from "upcycling" sellers that reform their own goods to sell.

It is well-established in many areas of law that the right of ownership of a particular item belongs to the owner once it is purchased, which means the owner can resell it, repair it, modify it, or even trash it. Customers throughout the world ask third parties like the appellant to do the repairs on their behalf, because they lack the skills and resources to perform the repair effectively. For this highly skilled service, the repairman is paid, and the owner goes home with the same item they brought in.

Because the item is simply returned to its original and rightful owner, with no intent to resell to a third party, there is no sale of goods, and therefore no confusion in the marketplace: the owner clearly knows the source of goods that they own. The trademark does not perform any function in the transaction between the owner and the repair-and-reform service. These kind of repairs done are essentially no different than cutting away the legs of an old pair of jeans to wear as shorts. To disallow owners to make these changes contradicts both a long and well-established history of repairing personal items. It also offends the purpose of trademark law, which is to protect consumers from being deceived regarding the source of their goods in choosing their purchases.

### SUMMARY OF ARGUMENTS

1. Trademark law is not implicated because the first sale doctrine protects owners' rights to repair.
2. There is no likelihood of confusion stemming from the repair shop's activities implicating trademark law.
3. There is no "use in commerce" required under the trademark law
4. Policy considerations such as resource recycling support no liability for repair shops operating at the request of original product owners.

## III. TRADEMARK LAW IS NOT IMPLICATED BECAUSE FIRST SALE DOCTRINE PROTECTS OWNERS' RIGHTS TO REPAIR

## A. Owners Have the Right to Modify Products They Own

To prove trademark infringement under U.S. federal law, the plaintiff must show that the alleged infringer's use of the trademark in commerce is likely to cause confusion among consumers as to the source, affiliation, or sponsorship of the products. *See, e.g., KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 111–12 (2004) (“Section 1114(1) in turn requires a showing that the defendant's actual practice is ‘likely to cause confusion, or to cause mistake, or to deceive’ consumers about the origin of the goods or services in question”)(quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780); *Abitron Austria GmbH v. Hetronic International, Inc.*, 600 U.S. 412, 420 (2023) (citing 15 U.S.C. §1114).

However, the Supreme Court has consistently found that the rights of a trademark holder “to control . . . its trademarked product does not extend beyond the first sale of the product.” *Au-Tomotive Gold Inc. v. Volkswagen of Am., Inc.*, 603 F.3d 1133, 1136 (9th Cir. 2010)(quoting *Sebastian Intern., Inc. v. Longs Drug Stores Corp.*, 53 F.3d 1073, 1074 (9th Cir. 1995)); *see, e.g., Champion Spark Plug Co. v. Sanders*, 331 U.S. 125 (1947)(“A trademark gives the right to prohibit the use of it so far as to protect the owner’s good will against the sale of another’s product as his”)(quoting *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368). This gives consumers ownership rights over the product after the authorized sale by the trademark holder. *Prestonettes, Inc.*, 264 U.S. at 368 (finding that by virtue of ownership, the purchaser had a “right to compound, change, or divide the products it purchased and resell the products as modified”). Collateral use of the trademark to show the product was part of what was offered in itself does not pose problems. *Id.* at 369.

The above principle on the owner’s right on trademarked goods is encapsulated in what is called the First Sale Doctrine or equivalently the Exhaustion Doctrine. The principle, traversing all fields of intellectual property, provides that once an individual purchases a copy of the proprietary work (as in intellectual “property”) from the rightsholders or their licensees, the purchaser earns the right “to sell or otherwise dispose of the possession of that copy, without the authority of [the rightsholder].” *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 519 (2013)(citing 17 U.S.C. § 109(a)). “We do . . . recognize the right of property owners to repair or alter trademarked goods without implicating the Lanham Act. For example, if the owner chooses to buy aftermarket spare parts and do the repairs himself, there is no sale of a trademarked good in commerce, and hence no trademark infringement.” *Karl Stolz Endoscopy v. Surgical Tech*, 285 F.3d 848, 856 (9th Cir. 2002).

Numerous circuit courts have applied the “first sale” doctrine to trademark law, maintaining that the “first sale” rule provides a “stable accommodation between strong and potentially conflicting” interests. *Sebastian Intern., Inc.* 53 F.3d at 1074. On the one hand, the “producer gains the good will associated with the quality of its product, and the consumer gets . . . the genuine product of the particular producer” and on the other hand, the “rule preserves an area for competition by limiting the producer's power to control the resale of its product.” *Id.* at 1075. Courts applying the first sale doctrine have not allowed producers to “circumvent the first sale rule . . . for the express purpose of controlling the downstream distribution of its products to the ultimate consumers and eliminating “diversion” to unauthorized retailers” *Id.*

In this case, the owner of the bag should be able to modify, repair, or even dispose of this bag as they please, because the control of the trademark owner is released once the value of that mark has been paid for by the current owner of the bag. Then, the repair shop run by Kyunghan Lee, who makes that modification at the request of the owner and returns to the

owner should be also exempt from liability under trademark law. If there is no primary act giving rise to liability, a person carrying out that act on behalf of another should have no reason for liability.

**B. The Surgical Tech- Fiber Tech Circuit Split Can Be Reconciled**

The doctrine that the owner-requested repairs cannot implicate the Lanham Act was clearly reflected by the Fourth Circuit, concerning a repair shop of medical equipment, where hospitals requested the repairs but doctors were the individual users of equipment. *Karl Storz Endoscopy-America, Inc. v. Fiber Tech*, 4 Fed.Appx. 128 (4th Cir. 2001) However, the Ninth Circuit held otherwise on a similar-looking medical equipment repair shop case. *Karl Storz Endoscopy v. Surgical Tech*, 285 F.3d 848, 856 (9th Cir. 2002)

As *amici* discuss below, the Ninth Circuit decision can be distinguished from the Fourth Circuit case and more decidedly from the instant case. The *Karl Storz* cases are two of the very few appellate level cases dealing with owner-requested repair of trademarked goods. Both appellate cases involved the repair companies modifying endoscopes at the request of the hospitals owning the endoscopes, using third-party parts but leaving intact the Karl Storz mark on the exterior of the scopes.

In *Karl Storz v. Fiber Tech*, the court held that “the Lanham Act does not apply in the narrow category of cases where a trademarked product is repaired, rebuilt or modified at the request of the product's owner [where] there is no misrepresentation of the repairer's authority to the owner and that the owner is not, to the repairer's knowledge, merely obtaining modifications or repairs for purposes of resale.” *Id.* at 131. The court distinguished the case of the “ultimate owner request[ing] modification and intend[ing] to retain ownership” from that of a repairs or modifications involving “a sale directly to the public or to dealers.” *Id.* at 131-132. The court ultimately held that the activities of the repairer do not implicate the Lanham Act “absent indications that the owner intends to sell the products to third parties.” *Id.* at 132.

On the other hand, in *Karl Storz v. Surgical Tech.*, the court held there is a likelihood of confusion stemming from the activities of the repairers by focusing on a more broad “post-sale” confusion rather than a likelihood of confusion on the purchasers only. *Id.* at 855. The court noted that, although the hospitals owning the endoscopes requested and paid for repairs, *it was surgeons who used them as the ultimate end-users.* *Id.* Not only could the surgeons “affect the hospital’s equipment purchasing decision” but there was “evidence of actual confusion” among surgeons about the origin of the parts constituting the repaired endoscopes. *Id.* Because a “material factual question as to the existence of customer confusion” had been raised, the court went on to analyze whether the trademark was used “in commerce.” *Id.* The court went on, while acknowledging the property owners’ rights to repair or alter the trademarked goods, *Id.* at 856, to rule that:

A mere repair for an owner’s personal use must be contrasted with a complete rebuild where the rebuilt product will be used by a third party [the surgeons in this case]. If the reconstructed product still bearing the original manufacturer’s trademark is so altered as to be a different product from that of the original manufacturer, the repair transaction involves a “use in commerce.” The repair company in that situation is trading on the goodwill of, or association with, the trademark holder.

Therefore, the Ninth Circuit seems to suggest that owner-requested repairs, if extensive as “rebuilt”, can also constitute “use in commerce” depending on “whether end users of the

product are likely to be misled as to the party responsible for the composition of the product” where the end users affect future purchasing decisions.

As amici discuss below, *Surgical Tech* can be distinguished from *Fiber Tech* and the prevailing rule on owner-requested repair by two elements: first, the severity of change; and second, the confusion of the non-purchaser end-user with the power to affect purchasing decisions. Where such additional non-purchaser end-user confusion is not present, as in the instant case, the trademark law should not apply.

#### **IV. THERE IS NO LIKELIHOOD OF CONFUSION STEMMING FROM THE REPAIR SHOP’S ACTIVITIES IMPLICATING TRADEMARK LAW**

##### **A. Clear Notice Removes Confusion**

The importance of notice and disclosure in refurbished goods case is clear. Below, *amici* discuss several cases about the repairers who sell them to the public—unlike the instant case. However, the same principles can be adapted to this case.

In *Hamilton Int’l Ltd. v. Vortic LLC*, 13 F.4th 264 (2d. Cir. 2021), Hamilton, a manufacturer of watches, sued Vortic for trademark infringement, among other claims, for selling a watch that featured a restored original front dial bearing Hamilton’s trademark. *Id.* at 267. Each buyer of the watches received them in a wooden box *containing a booklet bearing Vortic’s own trademark and authentication documents.* *Id.* at 269. Relying on *Champion Spark Plug* which held that second-hand dealers could use the trademark so long as there is “full disclosure” and lack affiliation with the original manufacturer for “the inferior qualities . . . resulting from . . . the reconditioning,” *Id.* at 273, the appellate court agreed with the district court that when refurbishing by replacing a lever did not make the watch “an entirely new product,” the circuit takes the full disclosure as a “significant” factor when modifying genuine products. *Id.* Coupled with the fact that there was “good faith” in adopting the mark as well as the sophistication of the relevant customer base of the watches, the court found against likelihood of confusion. *Id.* at 277.

In the Ninth Circuit, in *Rolex Watch U.S.A., Inc. v. Michael Co.*, 179 F.3d 704 (9th Cir. 1999), the secondhand dealer replaced Rolex bracelets with non-Rolex bracelets that bore a similar-looking logo and sold both full-Rolex and altered-Rolex watches as “Rolex” watches. The Ninth Circuit looked to Supreme Court, Seventh Circuit, and Fifth Circuit decisions in similar cases, ultimately determining that the modification of “integral parts of a product,” as opposed to mere restoration, and “reselling the product under its original trademark *without full disclosure*” of the use of generic parts to the consumer constitutes infringement. *Rolex Watch U.S.A., Inc.*, 179 F.3d at 709–10 (emphasis added); *see Champion Spark Plug Co.*, 331 U.S. 125; *Bulova Watch Co. v. Allerton Co.*, 328 F.2d 20 (7th Cir.1964); *Rolex Watch USA, Inc., v. Meece*, 158 F.3d 816 (5th Cir.1998), *cert. denied*. The principle underpinning the decision is that the changes to the watch “are so basic they result in a new product” and that that new product is being sold under the Rolex Trademark without disclosure of the alterations. *Rolex Watch U.S.A., Inc.*, 179 F.3d at 709–10, 713. Ultimately, as supported by Supreme Court cases such as *Champion Spark Plug Co.*, 331 U.S. 125, the key distinction is whether the modifications are disclosed to the consumer purchasing the product bearing the mark. *Rolex Watch U.S.A., Inc.*, 179 F.3d 704 ; *Champion Spark Plug Co.*, 331 U.S. 125, 130 (“Full disclosure gives the manufacturer all the protection to which he is entitled”).

The instant case does not even concern the sale of Louis Vuitton bags, counterfeit or not. The petitioner’s repair shop does not re-attach the trademark in order to deceive consumers

into thinking that the source is Louis Vuitton or endorsed by Louis Vuitton. The repair shop does not set itself out as a Louis Vuitton seller. In the instant case, there could not be clearer notice of repairs done by a third party because the consumer is the one directly requesting the repairs be done by the specific shop and using the post-repair goods as well. Unlike the *Karl Storz* cases where the hospital or a third-party company was a middleman for the surgeons, there is no such middleman here. This case is also distinct from the *Rolex* case, where the secondhand dealer sold used Rolex watches (with original Rolex parts) and reconditioned Rolex watches, all under the Rolex mark, while failing to disclose that the latter contained generic non-Rolex parts.

Further, *amici* understand that there is no evidence in this case of knowledge by the repair shop owner of the customer's intent to resell or lease to others who may be confused. There is no reason to assume the end user is anyone other than the original customer requesting the reform. The purpose of a trademark is to provide assurance of quality, consistency, and reliability by indicating the source and control of the product. Infringement shall be found only when there is confusion created by the defendant and here there is no such confusion.

### **B. Confusion Found In *Surgical Tech* Does Not Apply Here**

Even the cases limiting the first sale doctrine such as *Surgical Tech* are limited to the exceptional circumstances found there. Despite the seeming circuit split, both the Ninth and Fourth Circuit share the same underlying fundamental concern of preventing confusion among the people who will make future purchasing decisions—namely, “post-sale confusion.” In both *Karl Storz* cases, there was no way for surgeons to know that the refurbished endoscopes had incorporated non-Karl Storz parts based on outward appearance where they were the ones affecting the purchasing decisions of the hospitals.

The Fourth Circuit in *Fiber Tech* focused on the fact that there was no intent on the part of the repairer to mislead the surgeons as to the source, *Id.* at 129:

This disclosure [by the repairer] is included on paperwork returned to the hospital, in duplicate. The documentation contains a written request that the end-user be provided with a copy of the documentation of the repair.

Therefore, the resulting confusion by surgeons does not implicate fault on the defendant repairer's part. If there is fault at all, it would rest with the hospital/owner that did not relay this information/documentation to the surgeons.

In contrast, any efforts made by the repairer defendant to prevent confusion were absent in *Surgical Tech* and therefore not considered in those cases. In other words, the repair defendant, taking advantage of the confusion on the surgeons' part, was “trading on the goodwill of. . . the trademark holder”, *Id.* at 856.

In the instant case, the defendant's repair service should be interpreted similar to the Fourth Circuit, because likelihood of confusion in the end user cannot be established. In the instant case, the end user is precisely the luxury bag owner who is requesting refurbishing services specifically from this repair shop. There is clear notice that the resulting good does not come from Louis Vuitton nor is the new build the quality endorsed by Louis Vuitton. There is no confusion by the customer at the time services are rendered, because they are the ones requesting such services.

There is yet another type of confusion courts sometimes consider, that “of non-purchasers, such as those who simply observe the purchaser wearing the accused article” referred to *Surgical Tech* in passing, *Id.* at 854. Even if the defendant-refurbished bags confuse

the third parties simply sighting the refurbished product and make them think that those are original Louis Vuitton products or have been serviced by Louis Vuitton, the repair shop would not be profiting or attracting new customers on account of that confusion. It is because the repair shop does not sell any of the refurbished products or advertise itself as in any way associated with Louis Vuitton. Potential customers interested in Louis Vuitton goods or services will not come to the defendant repair shop.

The repair shop cannot be found to be diverting sales from Louis Vuitton because the repair shop cannot engage in their business without a consumer first purchasing a product from Louis Vuitton. A Louis Vuitton sale is a pre-requisite to the defendant's revenue, so there is no damage to Louis Vuitton. As a result, ironically, if the viewers of the defendant's refurbished bags are interested in buying the products identical or similar to them, they would be drawn to none other than genuine Louis Vuitton shops. If at all, the defendant would be contributing to the increased revenue of the trademark holder.

## **V. THERE IS NO "USE IN COMMERCE" AS REQUIRED UNDER THE TRADEMARK ACT**

A cause of action under the Lanham Act requires a "use in commerce" to qualify as a trademark infringement. 15 U.S.C. § 1114(1)(a) or 1125(a)(1). In the case of owner-requested repair cases, trademark violations are not implicated because there is no sale of an item or any use "in commerce" of the trademark. The owner of the product brought it to a repair shop with repairs/modifications in mind. Payment is made in exchange for labor, with the item remaining under the same ownership. There is no resale directly to the public or other dealers, nor any intent to resell.

If there is no use in commerce, trademark law is not implicated. This is in line with the current international norms. Leaving aside United States law, it is a general consensus around the world that trademarks are for use in trade, and not every transaction involving a physical object constitutes use of the trademark on the object. Recently, the Swiss Supreme Court's holding in *Rolex (2023)* (FSC 4A\_171/202 of January 19, 2024) solidly announced that "the right to exclusive use of a trademark is limited to use in business" and the "private use of a trademark" is lawful, finding no trademark implication in a customization shop that modifies Rolex watches for their owners. The Swiss Court based its decision on a German precedent to hold that even if the repairer is paid, if he does not place the product back into the market, the trademarked good is not used "in business" for the purpose of the trademark law (Federal Supreme Court, 12.02.1998, I-ZR-241/95).

The Fourth Circuit in *Fiber Tech* correctly reasoned that, in the "category of cases where the challenged activity involves repair or rebuilding of a trademarked product, without advertising or other distribution efforts suggesting authorization or endorsement by the owner of the mark," the "use in commerce" requirement is equivalent to the "sale" requirement. The court found that the repair person was not selling anything and found no possibility of infringement.

In contrast, the Ninth Circuit in *Surgical Tech* noted that repairs done by outside contractors requires an analysis of whether "the trademarked product is so altered that the substance of the transaction is a sale." *Surgical Tech*, 856. The court focuses on the fact that 20% of the repairs done by the defendant were "complete rebuilds," where all essential parts were replaced with third party sources and that the repair charges "include the cost of the parts."



So, if the proportion of the cost of the parts in the total repair charges is substantial, repairing for money actually becomes the sale of those parts.

This is a distinguishing feature not present in *Fiber Tech*. Also, in the instant case, the “essential parts” are the leather constituting the main part of the bag, and that leather still constitutes the main part of the refurbished bag at the end of requested repairs/modifications. So there are no essential parts the cost of which are included in the repair fee that the defendant charges to the bag owners—and therefore there is no “sale”.

Furthermore, in the context of owner-requested repairs, a “sale” perceived in the way the Ninth Circuit envisioned will normally not involve confusion on the part of the owner because the owners specifically request use of the generic parts. The requirement of “use in commerce” is not separate from “likelihood of confusion”. As the United States Supreme Court has held, “[The] conduct [constituting “use in commerce”], to be sure, must create a sufficient risk of confusion, but confusion is not a separate requirement; rather, it is simply a necessary characteristic of an offending use.” *Abitron Austria GmbH v. Hetronic International, Inc.*, 600 U.S. 412 (2023)

What the court in *Surgical Tech* did was to focus on the confusion on the part of the surgeons who actually use the endoscopes and make the choices about what endoscope brand they will use in the future. It is through this reasoning that the Ninth Circuit found a triable issue of material fact on an offending “use in commerce”. Indeed, when the court lists the factors to be weighed in deciding whether there is “use in commerce”, one of the factors is “whether end users of the product are likely to be misled as to the party responsible for the composition of the product.” *Id.* at 857.

In the instant case, there is no disparity between the owners and the users. The end-users of the LV products are the owners of the product, who are directly requesting repairs or rebuilds. Therefore, even if the court were to find a sale here, a “trading on the goodwill of the markholder” as in *Surgical Tech* is not implicated and thus the trademark law does not apply.

## **VI. POLICY CONSIDERATIONS SUPPORT NO LIABILITY FOR REPAIR SHOPS OPERATING AT THE REQUEST OF ORIGINAL PRODUCT OWNERS**

### **A. Violation of Freedom of Expression**

Allowing Louis Vuitton to prevail on these types of claims against repair shops would infringe on the exceptionally important right of freedom of expression. To express one’s individuality is a basic right to “life, liberty, and pursuit of happiness” in many constitutions around the world. Intellectual property laws, such as copyright laws, exist to incentivize such creativity. There are two kinds of expressions implicated in these repair shop cases: that of artistic expression rights of the repair shop owner as well as that of the bag owner.

First, the repair shop’s act of reforming products is an act of artistic expression, no less valuable than an artisan. Second, the products owners have the right to express themselves in choosing how they present themselves to society, what they wear, and what brands they purchase and use. Through this basic freedom, people can communicate their personal taste, style, and status to society. Christine Haight Farley and Lisa P. Ramsey, “Raising the threshold for trademark infringement to protect free expression”, Digital Commons @ American University Washington College of Law, April 2023, available at

[https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=3220&context=facsch\\_lawrev](https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=3220&context=facsch_lawrev))

## **B. Benefit to the Trademark holder**

As *amici* discuss above, the repair shop is not diverting sales from the trademark. The services of repair or customization require the initial purchase of a bag from the trademark holder, Louis Vuitton. Thus, there is no competition or diversion of sales away from the trademark holder. A plaintiff bringing a trademark infringement alleging a likelihood of confusion must show damages incurred as a result of the alleged infringer's diversion of sales from the mark-holder and producer. Louis Vuitton has not and cannot make any such showing.

The repair shop does not sell goods, but rather offers owners a way to increase the lifespan and versatility of the trademarked product; thereby contributing to brand awareness and value. Without the repair shop's services in offering an increased lifespan to Louis Vuitton goods, the consumer-owners of the products would not be able to continue to use the product, removing the Louis Vuitton mark out of the public eye entirely. Additionally, there is no indication that the owners intend to resell the repaired products, but if there were, the repair would not be relevant to that proceeding or remedy.

## **C. Sustainability should be prioritized over profit motive.**

The longevity of consumer products is desirable for increased sustainability and maximizing the value of consumer spending. However, Louis Vuitton seeks to decrease the lifespan of their products by barring repair shops from fulfilling requests made by their own clientele. Their profit motives are obvious here, and it is inappropriate to allow a luxury brand that consumers pay substantial amounts of money for to strategically block their customers' ability to give old products new life. As Louis Vuitton asks the court to block customers from repairing their own products, unless they possess repair skills themselves, it is also ensuring that their old products, worth thousands of US dollars, are thrown away – effectively barred from being repaired and reused. Louis Vuitton is acting in direct contradiction to the majority of the luxury brands, which are actively working towards increasing sustainability through an acceptance of repairing, upcycling and refurbishing.

In 2023, the Kering group, which owns various luxury brands, including Gucci, Saint Laurent, and Balenciaga, announced the launch of the Gucci Circular Hub. (<https://www.voguebusiness.com/sustainability/gucci-and-kering-launch-circularity-hub-in-sustainable-manufacturing-push>) The project, kickstarted with a 15 million-euro investment, aims to integrate sustainability throughout the brand's infrastructure, including a reuse of materials. Gucci's "circular vision" includes a "made to be made again" section, which not only accepts, but optimizes disassembly for "leftover or damaged inventory to better enable the reuse of our products and materials and our fabric." (<https://equilibrium.gucci.com/guccis-circular-vision/>) While the international luxury industry moves towards a more sustainable future, enforcing Louis Vuitton's attempts to exclude itself from industry-wide efforts towards sustainability are unjust.

## **VII. CONCLUSION**

Under the exhaustion doctrine, the owners of the products bearing intellectual property have the absolute right to modify or dispose of the unit that they own, in any way they would

like. The person such as the defendant who assists the owners in making such modification cannot be imposed any liability for such assistance where there is no primary liability.

The Ninth Circuit in *Surgical Tech* did find a triable issue of confusion on the repairer of medical equipment but only because the owners of the products relied on the actual users of the medical equipment, the surgeons, in making the purchasing decisions. However, where the repair shop made efforts to notify the surgeons as in *Fiber Tech*, the court did not find the possibility of such confusion. In the instant case where the owner and the user are the same person, there is no possibility of confusion.

Furthermore, the instant case lacks the element of “use in commerce”, or equivalently “trading on the good will of the markholder” as the defendant is not selling any product under the Louis Vuitton trademark but simply returning the product back to the owner. The Ninth Circuit in *Surgical Tech* did find a “sale” in the medical equipment repairer only because the equipment was altered so substantially, i.e., sometimes all its “essential parts” replaced with generic parts, that the repair service for a fee amounted to the sale of those generic parts. There is no such substantial change in *Fiber Tech*, which found no “use in commerce”. Likewise, in the instant case, the most essential part of the product, the leather, is not replaced, so there is no possibility of finding a “sale”.

There is no trademark law implication in the owner-requested repair of trademarked products. The Ninth Circuit found an exception only when the repair company was practically selling generic replacement parts of the medical equipment packaged in the original body bearing the original trademark, to the surgeons who were not privy to the fact of the replacement. In the instant case, there is no such element.

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