

European Court of Justice explains exclusions for three-dimensional trademarks

October 13, 2014

In its recent *Hauck v Stokke* ruling, the European Court of Justice answered preliminary questions regarding the grounds on which registration of three-dimensional trademarks may be refused or invalidated. According to the ECJ, the exclusion of shapes that give a product 'substantial value' is not limited to an exclusively ornamental value. It also includes shapes with other important characteristics. Companies wanting to protect their product designs are well advised to consider the various options – copyright, design rights, trademark rights, passing off – that are available to them.

Background

The ECJ's [ruling](#) was given in proceedings between Stokke and Peter Opsvik, the producer and the designer of the famous Tripp Trapp chairs, and Hauck, the German manufacturer of the 'Alpha' and 'Beta' chairs that resemble Tripp Trapp chairs. Stokke claimed that the sale of the Alpha and Beta chairs infringed its copyright as well as its three-dimensional trademark for the Tripp Trapp chair. Hauck brought a counterclaim, arguing that the trademark registration for the Tripp Trapp chair was invalid. A court of appeal in the Netherlands ruled that Hauck's chairs did infringe the copyright of Stokke and others, but that the registered trademark was invalid. On further appeal, the Dutch Supreme Court found that the grounds for exclusion of three-dimensional trademarks – as set out in the European trademark directive – needed to be interpreted, and it referred questions to the ECJ.

The ECJ's ruling

The ECJ held that the ground for exclusion with regard to shapes should not be interpreted narrowly. The ground for exclusion that addresses shapes which exclusively result from the *nature* of the products does not cover only natural and standardised shapes. It also applies to the presence of essential characteristics which are inherent to the generic function of the good. Functional aspects should not be monopolised by a single operator, since this would make it difficult for other companies to give their goods a shape that would be suited for the intended use of the product.

As regards the ground for exclusion of trademarks which consist exclusively of the shape that gives a *substantial value* to the goods, the ECJ pointed out that this ground may not apply only to shapes that constitute the main or predominant value in comparison to other values. It also addresses shapes where, in addition to the artistic or ornamental value, other characteristics of the goods are also substantial.

Finally, the ECJ stated that both grounds for exclusion may not be applied in combination. Any of these grounds should apply fully in

order for the trademark registration to be refused or declared invalid.

Companies wanting to protect their product design should consider the various options – copyright, design rights, trademark rights, passing off – that are available to them.

Experts



Tobias Cohen Jehoram

Partner

T: +31 20 577 1301

E: tobias.cohenjehoram@debrauw.com