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Press and Information

Advocate General's Opinion in Case C-205/13
Hauck GmbH & Co. KG v Stokke A/S. Stokke Nederland BV, Peter Opsvik and Peter Opsvik A/S

Advocate General Maciej Szpunar considers that EU law precludes registration as trade marks of shapes which result from the functionality of the goods and shapes whose aesthetic characteristics determine the attractiveness of the goods concerned

Reserving the benefit of such shapes to a single operator amounts to allowing that operator to obtain an unfair advantage on the market, thereby undermining the objective of trade mark protection

EU law[1] prohibits, in particular, the registration of a mark consisting exclusively of the shape which results from the nature of the goods themselves or which gives substantial value to the goods.

In 1972, the Stokke group, which includes the Norwegian company Stokke A/S and the Netherlands company Stokke Nederland BV, put the Tripp Trapp high chair on the market. Peter Opsvik and the Norwegian company Peter Opsvik A/S also hold the intellectual property rights to the shape at issue.

In 1998, Stokke A/S filed an application for a three-dimensional trade mark representing the shape of the Tripp Trapp chair shown below with the Benelux Trade Mark Office:

The German company Hauck GmbH & Co. KG manufactures and distributes children's articles, including two models of high chairs for children named 'Alpha' and 'Beta'.

Stokke A/S, Stokke Nederland BV, Peter Opsvik and Peter Opsvik A/S brought a claim against Hauck, arguing that the sale of the 'Alpha' and 'Beta' high chairs infringed their copyright and their rights arising from registration of Tripp Trapp's trade mark. Hauck brought a counterclaim seeking inter alia a declaration of invalidity in respect of Tripp Trapp's trade mark. In 2000, the Rechtbank's- Gravenhage upheld Stokke and Opsvik's claim of copyright infringement and Hauck's counterclaim and declared Tripp Trapp's trade mark invalid.

The Hoge Raad der Nederlanden (Supreme Court of the Netherlands), before which an appeal in cassation was brought, referred questions to the Court of Justice relating to the grounds for refusal or invalidity of mark registration with respect to signs consisting of the shape of the goods concerned.

[1] First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which, given the time of the facts, is applicable to the present case.

In today's Opinion, Advocate General Maciej Szpunar states first[2] that the objective pursued by the Directive is, in particular, to avoid a situation where the protection conferred by the mark prevents competitors from freely offering for sale products incorporating its technical solutions or functional characteristics. Such a situation would lead to an undermining of the purpose of the system of trade mark protection.

Next, **as regards to the concept of 'shape which results from the nature of the goods themselves'**, the Advocate General proposes adopting an interpretation covering not only natural shapes and standardised shapes (shape of a banana in respect of bananas, or shape of a rugby ball) but also other shapes, namely those whose essential characteristics result from the function of the goods concerned. This relates, for example, to legs with a horizontal level in relation to a table, the shape of an oblong in relation to a brick.

The Advocate General considers that EU law precludes registration of a shape all of whose essential characteristics are determined by the practical function which those goods perform. Reserving characteristics of essential importance to the function of the goods concerned to one operator would make it difficult for competing undertakings to give their goods a shape which was equally suitable for use, thereby giving the trade mark proprietor a significant advantage, which would have an unfavourable effect on the structure of competition on the market concerned.

Regarding the ground for refusal relating to a 'shape which gives substantial value to the goods', the Advocate General states that the scope of that ground is not limited to works of art or functional art. It also relates to goods which are not usually perceived as objects which perform a decorative function but in relation to which the aesthetics of the shape constitute one of the essential characteristics determining their attractiveness and play an important role in a certain, defined segment of the market. Accordingly, that ground relates to the shape whose aesthetic characteristics constitute one of the principal reasons for the consumer's decision to purchase that product. That interpretation does not preclude the goods from having other characteristics which are important to the consumer.

The Advocate General observes that the the assessment whether a shape gives substantial value to the goods (for example through the aesthetic features of the shape) makes it necessary to take account of the perspective of the average consumer. However, the perception of the average consumer is merely one of the circumstantial elements which must be taken into consideration in assessing the applicability of the ground under consideration – inter alia in addition to circumstances such as the nature of the category of goods under consideration, the artistic value of the shape concerned, its dissimilarity from other shapes in common use on the market concerned, the substantial price difference in relation to competing products, and a promotion strategy emphasising principally the aesthetic characteristics of the goods concerned. None of those circumstances is decisive per se.

The Advocate General further states, with respect to signs consisting in the shape of the goods, that registration of a mark may be refused or a trade mark declared invalid only when at least one of the three grounds laid down in the Directive [3] applies.

NOTE: The Advocate General's Opinion is not binding on the Court of Justice. It is the role of the Advocates General to propose to the Court, in complete independence, a legal solution to the cases for which they are responsible. The Judges of the Court are now beginning their deliberations in this case. Judgment will be given at a later date.

NOTE: A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the

[2] Joined Cases C−108/97 and C−109/97 *Windsurfing Chiemsee*, and Case C-299/99 *Philips*.
[3] Article 3(1)(e) of Directive 89/104.

dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

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