**BGH Rules on Protection of a Three-dimensional Trademark**

Three-dimensional signs cannot be registered as a trademark if they consist of a shape that is necessary in order to obtain a technical result.

When registering a sign as a trademark, businesses need to be aware that there are various possible grounds for refusal of trademark protection. One such ground for refusal may be the shape in the case of three-dimensional trademarks. We at the commercial law firm GRP Rainer Rechtsanwälte note that trademark law stipulates there can be no trademark protection afforded to signs consisting of a shape that is necessary to obtain a technical result.

The Bundesgerichtshof (BGH), Germany’s Federal Supreme Court, will deliver a ruling on February 14, 2019 (reference: I ZB 114/17) on whether the shape of certain coffee capsules can be protected. The case has an extensive history. The proprietor of the trademark sells coffee capsules with a particular shape and had applied for trademark protection for “Kaffee, Kaffeeextrakte und kaffeebasierte Zubereitungen, Kaffeeersatz und künstliche Kaffeeextrakte”, i.e. coffee, coffee extracts and coffee-based preparations, coffee substitutes and artificial coffee extracts. The proprietor also owned a patent that has since lapsed for a cartridge containing ground coffee designed for a drinks machine.

In response to a claim brought by a competitor, the Bundespatentgericht, Germany’s Federal Patent Court, suspended the international trademark’s protection in relation to Germany in a ruling from November 17, 2017 (Az.: 25 W (pat) 112/14). Trademark protection was suspended to the extent that coffee, coffee extracts and coffee-based preparations, coffee substitutes and artificial coffee extracts are concerned. The Bundespatentgericht justified this decision with reference to there being grounds for refusal pursuant to sec. 3 para. 2 no. 2 of the Markengesetz, the German Trademark Act. The essential characteristics of the mark in question were said to have a technical function that make it well suited for use in a coffee capsule machine. However, it was also stated that the Markengesetz is meant to prevent trademark proprietors from monopolizing technical solutions. The proprietor of the trademark has filed a legal appeal against the Bundespatentgericht’s judgment. The BGH must now rule on the matter.

Trademark protection is of great importance to businesses. When applying for registration, it is a good idea to ensure that this will not infringe existing trademark rights and that there are no grounds for refusal of registration. Lawyers with experience in the field of trademark law can offer advice.

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