OPINION OF ADVOCATE GENERAL
LÉGER
delivered on 14 September 2006 [1]

1. Can a visible functional feature of a product constitute a trade mark within the meaning of First Council Directive 89/104/EEC [2] and, if so, under what conditions?

I — Legal context

A — *International rules*

3. The Agreement on Trade-Related Aspects of Intellectual Property rights (hereinafter 'the TRIPS Agreement'), which forms Annex 1C of the Agreement establishing the World Trade Organisation of 15 April 1994, was approved on behalf of the European Community, as regards matters within its competence, by Council Decision 94/800/EC of 22 December 1994. [3]

2. These are essentially the questions raised by the High Court of Justice (England & Wales), Chancery Division (United Kingdom) in a dispute between Dyson Ltd (hereinafter 'Dyson' or 'the applicant') and the Registrar of Trade Marks concerning the registration as a trade mark of the transparent dust collection bin integrated into Dyson vacuum cleaners.

4. Article 7 of the TRIPS Agreement provides:

'The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technol-

1 — Original language: French.

2 — 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, hereinafter 'the directive').

3 — OJ L 336, p. 1 and 214.

ogy, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.'

B — *Community rules*

5. The directive was adopted by the Council in order to eliminate the disparities between the laws of the Member States which were liable to impede the free movement of goods and freedom to provide services and to distort competition within the common market. [4] It limits approximation to those national provisions of law which most directly affect the functioning of the internal market. [5] Those provisions include those that define the conditions applicable to the registration of a trade mark [6] and those that determine the protection afforded to duly registered trade marks. [7]

6. Article 2 of the directive defines signs of which a trade mark may consist as follows:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings'.

7. Article 3 of the directive sets out the grounds for refusal or invalidity which may be raised against the registration of a trade mark. Article 3(1) provides:

'The following shall not be registered or if registered shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geo-

4 — First recital.
5 — Third recital.
6 — Seventh recital.
7 — Ninth recital.

graphical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

— the shape which results from the nature of the goods themselves, or,

— the shape of goods which is necessary to obtain a technical result, or,

— the shape which gives substantial value to the goods;

...'

8. Article 3(3) of the directive provides that a trade mark may not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) of that article if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character.

9. Article 5 of the directive then lays down the rights that registration of the trade mark confers on its proprietor. Article 5(1) reads as follows:

'The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public,

which includes the likelihood of association between the sign and the trade mark.'

C — *National legislation*

10. The 1994 Trade Marks Act (hereinafter 'the 1994 Act'), which transposed the directive into English law, defines 'trade mark', in section 1(1) thereof, as 'any sign capable of being represented graphically which is capable of distinguishing goods and services of one undertaking from those of other undertakings'. Under that provision, 'a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging'.

11. The grounds for refusal to register a trade mark are set out in section 3 of the 1994 Act. That provision is worded as follows:

'1. The following shall not be registered:

(a) signs which do not satisfy the requirements of Section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

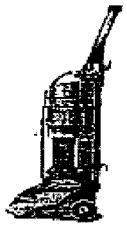
Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

...'

II — Facts and main proceedings

12. Since 1993 Dyson has manufactured and marketed the Dual Cyclone vacuum cleaner, a bagless cleaner in which the dirt and dust is collected in a transparent plastic container forming part of the machine.

13. On 10 December 1996 Notetry Ltd [8] lodged an application for registration pursuant to the 1994 Act. That application was formalised in the application form by the following representations and descriptions:



'The mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.



'The mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.

14. The application for registration was filed for goods in class 9 of the Nice Agreement [9] corresponding to the following description:

'Apparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampooers; floor polishers; parts and fittings for all the aforesaid goods'.

8 — This company is owned by James Dyson, also Chairman of Dyson.

9 — Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended.

15. By decision of 23 July 2002, the hearing officer (Registrar of Trade Marks) rejected that application on the ground that the sign in question was devoid of any distinctive character within the meaning of section 3(1)(b) of the 1994 Act. He also stated that the transparent collection chamber ultimately served to designate the kind and the intended purpose of the product in question, which was an absolute ground for refusal of registration under section 3(1)(c) of that Act.

16. Dyson brought an appeal against that decision at the High Court of Justice on 16 August 2002.

III — The questions referred for a preliminary ruling

17. In its order for reference, [10] the High Court of Justice takes the view, first of all, that the trade marks for which registration is sought are devoid of any distinctive character within the meaning of section 3(1), first subparagraph, (b) of the 1994 Act. [11]

18. It also notes that those trade marks are descriptive of the characteristics of the products in question within the meaning of section 3(1), first subparagraph, (c) of that Act [12] and do not permit consumers to identify the commercial origin of the product.

19. The High Court of Justice also points out that the application for registration in question could be refused by reason of the monopoly that would be conferred by registration of the trade mark in the use of a material which, in its view, ought to be freely available to manufacturers of bagless vacuum cleaners.

20. The referring court [13] then considers whether on the date of the application for registration, that is in 1996, and as a result of the use made of them, the trade marks in question had acquired a distinctive character within the meaning of section 3(1), second subparagraph, of the 1994 Act. [14]

21. On the basis of the witness statements produced before the hearing officer, the High Court of Justice states that in 1996 and

10 — Paragraphs 38 to 42.

11 — This provision transposes Article 3(1)(b) of the directive.

12 — This provision transposes Article 3(1)(c) of the directive.

13 — Order for reference, paragraphs 43 to 45.

14 — This provision transposes Article 3(3) of the directive.

throughout the period during which Dyson held a de facto monopoly on the market in question, consumers associated the transparent collection chamber with a bagless vacuum cleaner. It notes that consumers were informed by advertising, and the lack of any rival products on the market, that this was a Dyson cleaner. However, the referring court observes that on that date the transparent collection chamber in question had not been actively promoted as a trade mark by Dyson.

22. The referring court is uncertain whether, in the light of the Court's ruling in *Philips*, [15] holding such a monopoly, which leads the consumer to associate the sign with a single manufacturer, can suffice to confer a distinctive character on such a sign for the purposes of Article 3(3) of the directive. In this regard, the High Court of Justice asks whether or not it is necessary to require active promotion of the sign as a trade mark.

23. In the view of the referring court, this question is particularly important, bearing in mind that allowing the mark in the present case would have the effect of reserving to the applicant the exclusive right to use clear plastic as an indicator of commercial origin for the product beyond the period during which the undertaking was the sole producer of bagless cleaners.

24. In the light of these considerations, the High Court of Justice (England & Wales), Chancery Division decided to stay the proceedings and to make reference to the Court of Justice for a preliminary ruling on the following questions:

'(1) In a situation where an applicant has used a sign (which is not a shape) which consists of a feature which has a function and which forms part of the appearance of a new kind of article, and the applicant has, until the date of application, had a de facto monopoly in such articles, is it sufficient, in order for the sign to have acquired a distinctive character within the meaning of Article 3(3) of Directive 89/104/EEC, that a significant proportion of the relevant public has by the date of application for registration come to associate the relevant goods bearing the sign with the applicant and no other manufacturer?

(2) If that is not sufficient, what else is needed in order for the sign to have acquired a distinctive character and, in particular, is it necessary for the person who has used the sign to have promoted it as a trade mark?'

15 — Case C-299/99 *Philips* [2002] ECR I-5475.

IV — Analysis

A — *Observations of the parties*

25. At the outset the applicant emphasises that the signs for which registration is being sought consist not in a shape but in a transparent collecting bin. It also states that the registration sought is not for a colour, but for the absence of a colour, transparency. That transparency allows the consumer to determine the amount of dirt and dust in the collecting bin and shows him when it is full. According to Dyson, this result can be achieved by other technical means, such as by fitting an indicator window or a warning light on the surface of the vacuum cleaner.

26. The applicant further considers that it is not necessary for the sign to have been promoted as a trade mark in order to acquire a distinctive character within the meaning of Article 3(3) of the directive. In the view of Dyson, it is sufficient that a significant proportion of the relevant public has by the date of application for registration come to associate the relevant goods with the applicant and no other manufacturer. This conclusion follows not only from the wording and the objectives of the directive, but also from the Court's judgment in *Windsurfing Chiemsee*. [16]

27. In the alternative, the applicant sets out the factors which, in its view, are sufficient to recognise that a sign has a distinctive character within the meaning of Article 3(3) of the directive. There are three such characteristics. First of all, the sign must distinguish the goods for which registration is sought. The striking nature of the sign must also have caused a significant proportion of the relevant public to link the relevant goods with one undertaking. Lastly, the link with that undertaking must have continued even after the de facto monopoly has ceased and new operators have appeared on the market.

28. Conversely, the United Kingdom Government and the Commission of the European Communities, which are interveners, consider that in order for a sign to have acquired a distinctive character within the meaning of Article 3(3) of the directive it must have been used as a trade mark.

29. They base their arguments inter alia on the reasoning followed by the Court in

16 — Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779. In its observations, the applicant makes reference inter alia to paragraphs 51 and 52 of that judgment.

Philips, cited above, according to which 'the identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings'. [17]

30. Both the United Kingdom Government and the Commission maintain that this requirement seeks to ensure that a manufacturer with a monopoly cannot prevent the introduction on the market of products using the same functional feature simply because it brought its products onto the market at a time when it was the only manufacturer to use that technology.

31. Unlike the United Kingdom Government, however, the Commission maintains that before examining those questions it is necessary to consider a preliminary issue: whether the signs in question are capable of constituting trade marks within the meaning of Article 2 of the directive. [18]

32. Firstly, the Commission asks whether the signs at issue in the present case are actually 'signs' within the meaning of that provision. The application for registration in reality seeks to obtain registration of the concept of a transparent bin in a vacuum cleaner, irrespective of its particular shape. In its view, a concept is not a sign because it cannot be perceived by one of the five physical senses and appeals only to the imagination. [19]

33. The Commission maintains that, if such an approach were to be accepted, the logic behind Article 3(1)(e) of the directive would be frustrated.

34. In any event, it considers that the graphic representation of the signs for which registration is sought by Dyson in the main proceedings does not satisfy the requirements of a graphic representation which is 'clear, precise, self-contained, easily accessible, intelligible, durable and objective', as set out by the Court in *Sieckmann*, cited above. [20] The signs do not correspond to any particular shape, but may have different shapes. Furthermore, the very notion of 'transparency' is ambiguous. Moreover, the Commission asks whether graphic representations which consist in a verbal description and pictures showing examples of the concept can be considered to be sufficiently clear and precise.

17 — Paragraph 64.

18 — The Commission bases its views inter alia on the reasoning adopted by the Court in Case C-104/01 *Libertel* [2003] ECR I-3793, paragraphs 22 and 23.

19 — The Commission refers to the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-273/00 *Sieckmann* [2002] ECR I-11737.

20 — See, inter alia, paragraphs 54 and 55 of that judgment.

B — *Subject-matter of the proceedings*

35. In the present case the referring court makes reference to the Court for a preliminary ruling on two questions relating to Article 3(3) of the directive in order to determine whether, and if appropriate under what conditions, a functional feature which forms part of the appearance of a product is capable of acquiring a distinctive character as a result of the use which has been made of it.

36. The Court has consistently held that it is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the questions which it submits to the Court. [21]

37. However, the Court considers that it is its duty to interpret all provisions of Community law which national courts need in order to decide the actions pending before them, even if those provisions are not expressly indicated in the questions referred to the Court of Justice by those courts. [22]

38. Thus, in *Libertel*, cited above, relating to the registration of the colour orange as a trade mark for telecommunications goods and services, the Court considered that in order to consider those questions it was necessary as a preliminary matter to determine whether a colour per se was capable of constituting a trade mark for the purposes of Article 2 of the directive. [23]

39. I believe that this reasoning can be legitimately applied to the present case. Like the Commission, I consider that in order to consider the questions raised by the High Court of Justice it is necessary as a preliminary matter to determine whether a functional feature like that at issue in the main proceedings is capable of constituting a trade mark for the purposes of Article 2 of the directive.

C — *The conditions laid down in Article 2 of the directive*

40. To constitute a trade mark within the meaning of Article 2 of the directive, an

21 — See, inter alia, Case C-415/93 *Bosman* [1995] ECR I-4921, paragraph 59, and Case C-419/04 *Conseil général de la Vienne* [2006] ECR I-5645, paragraph 19.

22 — See Case C-280/91 *Viessmann* [1993] ECR I-971, paragraph 17, and, by way of illustration, Case C-90/97 *Swaddling* [1999] ECR I-1075, paragraph 21.

23 — Paragraph 22.

indication must satisfy three conditions. First, it must be a sign. [24] Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings. [25] Only indications which satisfy these three conditions may be registered as a trade mark.

41. As is stated in the seventh recital of the directive, Article 2 of the directive 'lists examples' of signs which may constitute a trade mark. Those signs include '*particularly* words, including personal names, designs, letters, numerals, the shape of goods or of their packaging'. [26] As can be seen from the wording of that article, the list is not exhaustive.

42. That provision does not mention the case of a trade mark being composed of a functional feature of a product. However, it does not exclude it expressly. It must therefore be considered whether such a feature can satisfy the conditions laid down in Article 2 of the directive.

24 — It was in *Libertel*, cited above, that for the first time the Court made the existence of a sign an autonomous condition for capacity to constitute a trade mark within the meaning of Article 2 of the directive.

25 — See, inter alia, Case C-299/99 *Philips*, cited above, paragraph 37, and Case C-104/01 *Libertel*, cited above, paragraph 23, and Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, paragraph 22.

26 — Emphasis added.

43. Contrary to the arguments made by the applicant and the United Kingdom Government, I consider that a functional feature which forms part of the appearance of a product does not fulfil the necessary conditions under that provision to constitute a trade mark since it does not, in my view, constitute a sign capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of other undertakings.

1. The existence of a sign

44. For the purposes of applying Article 2 of the directive, it is necessary first to establish that in the context in which it is used the transparent collecting bin whose registration is sought in fact represents a sign. As the Court has noted, the purpose of that requirement is in particular to prevent the abuse of trade mark law in order to obtain an unfair competitive advantage. [27]

45. As has already been stated, Dyson is applying for the registration as a trade mark of a 'transparent bin or collection chamber forming part of the external surface of a vacuum cleaner' as shown in its application for registration.

27 — See, inter alia, Case C-49/02 *Heidelberger Bauchemie*, cited above, paragraph 24.

46. It is a bin composed of a transparent, removable body. This forms part of the external surface of a vacuum cleaner. This chamber, which is designed to collect dust and dirt vacuumed up from the floor, is first and foremost functional and utilitarian. It means that consumers do not have to purchase vacuum cleaner bags and filters. It also allows the user to see how full the collecting bin is. That container can also fulfil an aesthetic function in so far as it forms part of the appearance of the product in which it is integrated.

47. Like the Commission, I think that the applicant is actually seeking protection for a new concept for collecting, storing and emptying waste. [28] As has just been seen, this concept, developed by Dyson, avoids the use of vacuum cleaner bags and filters and lets the user know when the bin is full.

48. According to the *Dictionnaire de la langue française*, a concept is a '*[r]eprésentation mentale générale et abstraite d'un objet*' [general and abstract mental representation of an object] [29] and appeals to the imagination. In practice, when a concept is developed, it can lead to the creation of a wide range of objects.

49. In the present case the application for registration actually seeks to obtain exclusive rights over all possible appearances that the functional feature in question can take on.

50. Thus, in the application form, the container is shown in two different shapes adapted for two models of vacuum cleaner into which it is integrated. In the first drawing, which shows a vacuum cleaner in the upright vacuum cleaner range, the bin seems to form a circular envelope around the machine's vacuum column. In the second drawing, which shows a vacuum cleaner in the canister vacuum cleaner range, the container's shape and dimensions are different and it appears to form only a semi-circle around that column.

51. However, these representations are not exclusive. The protection claimed is not limited to a shape, a composition, or a particular arrangement since this feature must only form part of the external surface of the vacuum cleaner and allow the user to see through the container. There are many possibilities as regards the shape, the dimensions, the presentation and even the composition of that collection chamber in relation to the product in question, depending not only on the vacuum cleaner models developed by the applicant, but also on technological innovations. As far as transparency is con-

28 — Paragraph 6 of the Commission's observations.

29 — *Le Petit Robert, Dictionnaire de la langue française*, Paris, Éditions Dictionnaires Le Robert, 2004.

cerned, it allows many colours to be used. Thus, the proprietor of a trade mark composed of the functional feature in question could use a circular or rectangular container, with or without a handle, which, although transparent, could be in various colours.

52. As the applicant ultimately recognises in its observations, the application for registration in question does not seek to protect a shape but a transparent collecting bin per se. That application does not seek to protect a colour either, but the absence of a colour, transparency. [30]

53. Notwithstanding the Court's extensive case-law concerning signs of which trade marks may consist under Article 2 of the directive, I consider that a concept, like that developed by the applicant, cannot constitute a trade mark within the meaning of that provision.

54. As the Commission pointed out in its observations, a concept appeals only to the imagination. [31] Unlike an odour, [32] a colour [33] or a sound, [34] a concept is conceived by the mind and cannot be perceived by one of the five physical senses of human beings, namely sight, hearing, touch, smell and taste. [35] Human beings' capacity to think and to imagine is infinite and the mind's faculty for visualising an object or an image is unlimited in my view. Whilst, according to settled case-law, the essential function of the trade mark is to enable the consumer, without any possibility of confusion, to distinguish the product or service offered to him from others which have another origin, [36] it appears that this objective cannot be achieved by a sign which is capable of being perceived by human beings in such diverse ways. As a result, a concept cannot, in my opinion, constitute an indication for the consumer and, consequently, cannot be a sign capable of fulfilling a trade mark's distinguishing function.

30 — Paragraphs 5 and 6.

31 — Paragraph 6.

32 — In Case C-273/00 *Sieckmann*, cited above, the Court ruled on the possibility of registering olfactory signs and held in particular that Article 2 of the directive did not expressly exclude signs which are not in themselves capable of being perceived visually, in that case an odour, provided that they can be represented graphically.

33 — In Case C-104/01 *Libertel*, cited above, the Court held that a colour, in that case the colour orange, although it was a simple property of things, was, however, capable of constituting a sign in relation to a product or a service (paragraph 27). That ruling was confirmed by the Court in Case C-49/02 *Heidelberger Bauchemie*, cited above, with regard to a combination of colours (paragraph 23).

34 — In Case C-283/01 *Shield Mark* [2003] ECR I-14313, the Court was asked about the validity of 14 sound marks, 11 of them using as a motif the first few bars of Ludwig van Beethoven's piano piece 'Für Elise' and the other three 'the cockcrow'. It held that the wording of Article 2 of the directive likewise did not prevent a sound from constituting a registrable sign.

35 — With regard to signs which can be perceived by the physical senses of human beings, reference is made, by way of example, to the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-273/00 *Sieckmann*, cited above (points 22 et seq.).

36 — The trade mark must therefore offer a guarantee that all the goods or services designated by it have been manufactured or provided under the control of a single undertaking which is responsible for their quality. See inter alia Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, subparagraph 2, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-299/99 *Philips*, cited above, paragraph 30.

55. In the light of these considerations, I therefore consider that a functional feature like that at issue in the present case is not capable of constituting a sign within the meaning of Article 2 of the directive.

56. In my view, such a feature likewise does not fulfil the second condition required by Article 2 of the directive, according to which a trade mark may consist only of signs capable of being represented graphically.

2. Capability of being represented graphically

57. The Court has consistently held that the graphic representation required by Article 2 of the directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified. [37] In order to fulfil that function, such a representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. [38]

58. According to the Court, the function of the graphic representability requirement is, in particular, to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor. [39] It thus contributes to legal certainty. [40]

59. As I have already explained in my Opinion in *Heidelberger Bauchemie*, cited above, that requirement meets two precise objectives. The first is to enable the competent authorities to know with clarity and precision the nature of the signs of which a mark consists in order to carry out the prior examination of registration applications and the publication and maintenance of an appropriate and precise register of trade marks. The second objective is to make it possible for economic operators to be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties. [41]

60. In those circumstances, the Court considers that a sign must, first of all, be represented unambiguously and uniformly in order to guarantee the function of the mark as an indication of origin and to determine, without any possible doubt, the subject of the exclusive rights. In the light of

37 — See the abovementioned judgments in Case C-273/00 *Sieckmann* (paragraph 46), Case C-104/01 *Libertel* (paragraph 28), Case C-283/01 *Shield Mark* (paragraph 55) and Case C-49/02 *Heidelberger Bauchemie* (paragraph 25).

38 — Case C-273/00 *Sieckmann*, cited above, paragraphs 46 to 55.

39 — Loc. cit., paragraph 48.

40 — Loc. cit., paragraph 37.

41 — Point 52 of the Opinion, reproduced by the Court in paragraphs 28 to 30 of its judgment.

the duration of a mark's registration and the fact that it can be renewed for varying periods, the representation must also be durable. [42]

61. I consider that a functional feature like that at issue in the present case does not fulfil those conditions.

62. As I stated in point 52 of this Opinion, the functionality for whose registration Dyson is applying can clearly take on a multitude of different shapes and appearances which will depend not only on the vacuum cleaner models developed by the applicant, but also on technological developments. In so far as the protection conferred by the trade mark right can be for an unlimited duration (subject to its genuine use and the payment of renewal fees for registration), it is highly likely, in my view, that the appearance of the transparent collecting bin and the way in which it is integrated into the vacuum cleaner will change over the years.

63. In these circumstances, it does not seem possible to determine precisely how the functional feature claimed will be integrated into the products for which registration is sought. The graphic representation in question does not therefore allow the competent authorities or economic operators to determine the precise subject of the protection afforded by the registered mark to its proprietor. I consider that such uncertainty is contrary to the principle of legal certainty which underlies the requirement of a capability of being represented graphically.

64. It must therefore be stated that a functional feature like that which is the subject of the main proceedings does not have the characteristics of non-ambiguity and uniformity required by Article 2 of the directive.

65. In the light of all these considerations, I take the view that a functional feature which forms part of the appearance of a product and which is capable of taking on a multitude of appearances cannot be regarded as a sign capable of being represented graphically within the meaning of Article 2 of the directive.

66. I consider that such a feature likewise does not satisfy the third condition laid down in Article 2 of the directive, according to which a trade mark may consist only of signs capable of distinguishing the goods or services of one undertaking from those of other undertakings.

42 — Case C-49/02 *Heidelberger Bauchemie*, cited above, paragraph 31.

3. The existence of a distinctive character

67. The distinctive character of a trade mark means that the sign serves to identify the product as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings. [43]

68. The assessment of the intrinsic distinctive character of a trade mark is in principle independent of the use of the sign. It depends solely on whether the sign is capable in itself of having a distinctive character.

69. In the present case it must therefore be determined whether a functional feature which forms part of the appearance of a product is capable in itself of distinguishing the goods or services of one undertaking from those of other undertakings. It is therefore necessary to assess whether or not the functional feature at issue in the present case serves to convey precise information as to the origin of the product. In my view, this is not possible for two reasons.

70. First of all, as we have just seen, the application for registration in question does not make it possible to determine with any certainty how that functionality will be integrated into the products for which registration is sought. As I stated in my Opinion in *Libertel*, cited above, an assessment of whether or not a sign is capable of having a distinctive character requires that one should be able to know exactly what the sign is. [44]

71. Secondly, I do not think that a functionality like that at issue in the present case can guarantee the essential function of the trade mark. It should be noted that the Court has defined that function as seeking to 'guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin'. [45] The trade mark must therefore guarantee to the consumer the origin of the product it denotes.

72. As has already been pointed out in points 51 to 55 of this Opinion, whilst a functional feature may take on a precise shape when it is integrated into the product concerned, the application for registration in question actually seeks to obtain exclusive rights for a concept or, at the very least, for all possible appearances that such a func-

43 — See, inter alia, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, cited above, paragraph 46, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraphs 40 and 47.

44 — Point 88 of the Opinion.

45 — See the case-law law cited in footnote 36.

tionality can take on. In my opinion, a concept cannot constitute a sufficiently precise indication for the consumer.

73. In these circumstances I consider that it is not possible to take the view that a functional feature like that at issue in the main proceedings can have a sufficiently precise meaning to indicate the origin of the product without any possible confusion.

74. In the light of these considerations, I am of the opinion that a functional feature which forms part of the appearance of a product and is capable of taking on a multitude of appearances does not fulfil the necessary conditions to constitute a trade mark within the meaning of Article 2 of the directive since it does not constitute a sign capable of being represented graphically and capable of distinguishing the goods and services of one undertaking from those of other undertakings.

75. If, however, the Court were to consider that a functional feature like that at issue in the present case fulfils all the necessary characteristics to constitute a trade mark within the meaning of that provision, I consider that Article 3(1)(e), second indent, of the directive precludes the registration of such a trade mark.

D — *The existence of an absolute ground for refusal to register*

76. I consider that there is an absolute ground for refusal to register the trade mark at issue on the basis of Article 3(1)(e), second indent, of the directive. I take the view that a functionality like that at issue in the main proceedings cannot be reserved to the exclusive use of a single economic operator and must remain available to all in accordance with the purpose of trade mark law.

77. As has been stated, Article 3(1) of the directive sets out different grounds for refusal to register a trade mark. Each of those grounds is independent of the others and, according to the Court, requires separate examination. Moreover, the Court has consistently held that it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may, or even must, reflect different considerations. [46]

46 — See, inter alia, Case C-329/02 P *SAT.1* v *OHIM* [2004] ECR I-8317, paragraph 25, and Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraphs 45 and 46.

78. In particular, Article 3(1)(e) of the directive refers to three cases where signs consist exclusively of the shape of the product.[47] These cases include, in the second indent of that provision, the situation where a sign consists exclusively of the shape of goods (or of a graphic representation of that shape[48]) which is necessary to obtain a technical result.

79. The general interest which underlies that provision was identified by the Court in *Philips*, cited above.

80. In that case, the Court was asked whether a sign composed of the shape of a product could acquire a distinctive character. The sign was the graphic representation of the shape and configuration of the head of an electric shaver, comprising three circular heads with rotating blades in the shape of an equilateral triangle. Philips, which had been the only company to offer electric shavers of that shape for a long time, considered that the representation filed as a trade mark had acquired a distinctive character after it had been sold exclusively over a long period.

81. In its judgment, the Court ruled inter alia that a sign consisting exclusively of the shape of a product is unregistrable under Article 3(1)(e), second indent, of the directive if it is established that the essential functional features of that shape are attributable only to the technical result.[49]

82. To reach such a finding, the Court interpreted the ground for refusal to register set out in that provision in accordance with consistent case-law in the light of the public interest underlying it.[50]

83. First of all, it recognised that the grounds for refusal set out in Article 3(1)(e) of the directive seek to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional features of a product which a user is likely to seek in the products of competitors. In the view of the Court, that provision is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competi-

47 — These are signs which consist of the shape which results from the nature of the goods themselves (first indent), the shape of goods which is necessary to obtain a technical result (second indent), or the shape which gives substantial value to the goods (third indent).

48 — See Case C-299/99 *Philips*, cited above, paragraph 76.

49 — Loc. cit., paragraph 84.

50 — See, to that effect, the abovementioned judgments in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, paragraphs 25 to 27, Case C-299/99 *Philips*, paragraph 77, Joined Cases C-53/01 to C-55/01 *Linde and Others*, paragraph 71, and Case C-104/01 *Libertel*, paragraph 51.

tors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark. [51]

84. As regards, more specifically, Article 3(1)(e), second indent, of the directive, the Court considered that the public interest pursued by that provision requires that a shape whose essential characteristics perform a technical function is not reserved to one undertaking alone and may be freely used by all. The Court held that the exclusivity inherent in the trade mark right would prevent competitors from supplying a product incorporating such a function. [52] Thus, the Court considers that in refusing registration of such signs, Article 3(1)(e), second indent, of the directive 'reflects the legitimate aim of not allowing individuals to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions'. [53]

85. The Court also pointed out that a sign which is refused registration under Article 3(1)(e) of the directive can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it. [54]

86. That provision states that only trade marks which are refused registration under Article 3(1)(b), (c) or (d) of the directive may acquire, following the use made of them, a distinctive character which they did not have initially and can thus be registered as trade marks. [55] A sign which is refused registration on the basis of Article 3(1)(e) of the directive does not therefore fall within the scope of that provision.

87. Lastly, in that same case, the Court held that demonstrating that there are other shapes which could achieve the same technical result could not overcome the ground for refusal or invalidity contained in Article 3(1)(e), second indent, of the directive. [56]

88. In my view it is clear that this reasoning applies legitimately to a functional feature which forms part of the appearance of a product. Although that article refers only to signs which consist *exclusively* of the shape

51 — See Case C-299/99 *Philips*, paragraph 78.
52 — Loc. cit., paragraphs 79 and 80.
53 — Loc. cit., paragraph 82.
54 — Loc. cit., paragraph 75.
55 — Loc. cit., paragraphs 57 and 58.
56 — Loc. cit., paragraph 81.

of a product, I think that the general interest which underlies that provision requires that registration of a functionality like that at issue in the main proceedings be refused.

89. *First of all*, registration of the functionality in question would have the effect, under Article 5(1) of the directive, of reserving the exclusive use of a technical solution to a single economic operator without any time limitation.

90. Such exclusivity would grant the applicant a monopoly on a technical and functional feature which a consumer is likely to seek in bagless vacuum cleaners manufactured by competing undertakings.

91. Furthermore, in so far as such exclusive use would relate not only to the functional feature as it is reproduced in the application for registration, but could extend to a multitude of shapes which that feature could take, the competing undertakings could find themselves unable to determine precisely whether and how they may still use that feature.

92. Thus, granting and holding exclusive rights over this type of functionality could deprive competing economic operators of the possibility of integrating such a functionality, whatever the shape or appearance it might take. Granting such a monopoly would therefore be likely to restrict their freedom excessively in a sector where technical progress is based on a process of ongoing improvement of earlier innovations. It may even be legitimately thought that such a monopoly could prevent new operators from entering the bagless vacuum cleaner market and paralyse competition on the innovation market. This would therefore have harmful consequences for free competition, which is one of the objectives of the directive.

93. In these circumstances, I consider that registration as a trade mark of a functional feature like that at issue in the present case would frustrate the system of undistorted competition which the EC Treaty seeks to establish and maintain, as can be seen in particular from Article 3(g) and (m) EC. [57]

57 — Under Article 3(g) and (m) EC 'the activities of the Community shall include, as provided in this Treaty and in accordance with the timetable set out therein: ... a system ensuring that competition in the internal market is not distorted; ... the strengthening of the competitiveness of Community industry'.

94. Such registration would also run counter to the objective laid down by Article 7 of the TRIPS Agreement, according to which the protection and enforcement of intellectual property rights should contribute not only to the promotion of technological innovation and to the transfer and dissemination of technology, but also to a balance of rights and obligations between the different economic operators present on the market. In so far as both the Member States and the Community, as regards matters within its competence, [58] have acceded to that Agreement, Article 3(1)(e), second indent, of the directive must be interpreted so far as possible in the light of the wording and purpose of that Agreement.

95. *Secondly*, registration of such a feature could result in a situation where exclusive rights are acquired or perpetuated through trade mark law over inventions which are in reality patentable, contrary to the legitimate objective pursued by Article 3(1)(e), second indent, of the directive.

96. It is essential that trade mark law is not diverted from its function in order to obtain an unfair competitive advantage. As the referring court rightly points out, 'it is not the function of a trade mark to create a monopoly in new developments in technology'. [59]

97. It should be noted in this regard that, as the Court has consistently held, trade mark rights are 'an essential element in the system of undistorted competition which the Treaty seeks to establish and maintain'. [60] Through its action, the Community legislature has succeeded in safeguarding this system by ensuring that trade marks are able to fulfil their essential function. As has been stated, that function is to guarantee the identity of the origin of the marked product to the consumer by enabling him to distinguish the product from others which have another origin.

98. So that that function can be ensured, Article 5(1)(a) of the directive reserves for the trade mark proprietor the exclusive right to use the distinctive sign and protects him against competitors wishing to take advantage of the status and reputation of the trade mark by selling products illegally bearing that trade mark. [61]

58 — Case C-53/96 *Hermès* [1998] ECR I-3603, paragraph 28, and Case C-49/02 *Heidelberger Bauchemie*, cited above, paragraph 20.

59 — Order for reference, paragraph 26.

60 — See Case C-10/89 *HAG GF* [1990] ECR I-3711, paragraph 13, and Case C-63/97 *BMW* [1999] ECR I-905, paragraph 62.

61 — The Court's case-law calls this the 'specific subject-matter' of the trade mark right. The specific subject-matter designates the substance of the intellectual and commercial property right. See Case 16/74 *Centrafarm and Others* v *Winthrop* [1974] ECR 1183.

99. However, unlike the protection granted by other intellectual and industrial property rights, the protection conferred by trade mark rights can be for an unlimited duration subject to genuine use and the payment of renewal fees for registration.

100. It is therefore to be feared that some people will seek, through trade mark rights, not to protect a distinctive sign, but to protect industrial creations or innovations, which are covered by other intellectual property rights and whose term of protection is generally limited in time.

101. Thus, in the present case, whilst Dyson may legitimately be rewarded for its research and innovation work and claim to enjoy exclusive rights to exploit its invention, I consider that such protection may be granted, in the case of a technological innovation, only through the grant of a patent and not through a trade mark.

102. Consequently, and in the light of the foregoing, I consider that Article 3(1)(e), second indent, of the directive precludes the registration as a trade mark of a functional feature which forms part of the appearance of a product.

103. Accordingly, I believe that the sign at issue in the present case cannot acquire a distinctive character following the use made of it within the meaning of Article 3(3) of the directive.

104. As has been pointed out in points 85 and 86 of this Opinion, it follows from the wording of that provision and from consistent case-law that only trade marks which are refused registration under Article 3(1)(b), (c) or (d) of the directive may acquire, following the use made of them, a distinctive character which they did not have initially and can thus be registered as trade marks. [62]

105. In view of this answer, there is no need in my view to examine the conditions which must be satisfied by a functional feature like that at issue in the present case for it to be capable of acquiring a distinctive character within the meaning of Article 3(3) of the directive.

62 — See footnote 55 of this Opinion.

V — Conclusion

106. In the light of the foregoing, I propose that the Court give the following answers to the questions asked by the High Court of Justice (England & Wales), Chancery Division:

'(1) A visible functional feature of a product which is capable of taking on a multitude of appearances does not fulfil the necessary conditions to constitute a trade mark within the meaning of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks since it does not constitute a sign capable of being represented graphically and capable of distinguishing goods and services of one undertaking from those of other undertakings.

(2) In any event, Article 3(1)(e), second indent, of First Council Directive 89/104/EEC precludes the registration as a trade mark of a visible functional feature of a product.'