

**REVISTA SEMESTRAL DE  
DIREITO EMPRESARIAL**

**Nº 2**

Publicação do Departamento de Direito Comercial e do Trabalho da  
Faculdade de Direito da Universidade do Estado do Rio de Janeiro

**Rio de Janeiro  
Janeiro / Junho de 2008**

# REVISTA SEMESTRAL DE DIREITO EMPRESARIAL

**Nº 2 Janeiro/Junho de 2008**

Publicação do Departamento de Direito Comercial e do Trabalho da Faculdade de Direito da Universidade do Estado do Rio de Janeiro

## **COORDENAÇÃO CIENTÍFICA:**

Departamento de Direito Comercial e do Trabalho da Universidade do Estado do Rio de Janeiro (Prof. Alexandre Ferreira de Assumpção Alves, Prof. Eduardo Henrique Raymundo Von Adamovich, Prof<sup>ª</sup>. Glória Márcia Percinoto, Prof. João Batista Berthier Leite Soares, Prof. José Carlos Vaz e Dias, Prof. José Gabriel Assis de Almeida, Prof. Leonardo da Silva Sant'Anna, Prof. Mauricio Moreira Mendonça de Menezes, Prof. Rodrigo Lychowski, Prof. Sérgio Murilo Santos Campinho e Prof. Valter Shuenquener de Araújo).

## **CONSELHO EDITORIAL:**

José Gabriel Assis de Almeida e José Carlos Vaz e Dias (UERJ, coordenadores)

Alexandre Ferreira de Assumpção Alves (UERJ), Arnaldo Wald (UERJ), Carmem Tibúrcio (UERJ), Fábio Ulhoa Coelho (PUC-SP), Jean E. Kalicki (Georgetown University Law School), John H. Rooney Jr. (University of Miami Law School), José de Oliveira Ascensão (Universidade Clássica de Lisboa), Leonardo Greco (UERJ), Marie-Hélène Bon (Université des Sciences Sociales de Toulouse 1 e Centre de Droit des Affaires de l'Université des Sciences Sociales de Toulouse), Peter-Christian Müller-Graff (Ruprecht-Karls-Universität Heidelberg), Theóphilo de Azeredo Santos (UNESA) e Werner Ebke (Ruprecht-Karls-Universität Heidelberg).

## **CONSELHO EXECUTIVO:**

Mauricio Moreira Mendonça de Menezes (coordenador)

Julio Barreto, Leonardo da Silva Sant'Anna, Mariana Pinto, Valter Shuenquener de Araújo e Viviane Perez.

## **PATROCINADORES:**



ISSN 1983-5264

CIP-Brasil. Catalogação-na-fonte  
Sindicato Nacional dos Editores de Livros, RJ.

---

Revista semestral de direito empresarial. — nº 2 (janeiro/junho 2008)

. — Rio de Janeiro: Renovar, 2007-.

v.

UERJ

Campinho Advogados

Bocater, Camargo, Costa e Silva Advogados Associados

Semestral

1. Direito — Periódicos brasileiros e estrangeiros.

94-1416.

CDU — 236(104)

---

**REPORT – COMMENTS ON THE DECISION OF  
THE EUROPEAN COURT OF JUSTICE**

**RELATÓRIO – COMENTÁRIOS SOBRE A DECISÃO  
DA CORTE EUROPÉIA DE JUSTIÇA**

**Dyson Ltd / Registrar of Trade Marks: No Trademark Protection for Concepts**

**Judgment of the European Court of Justice (Third Chamber) of 25 January 2007 in Case C-321/03 concerning a reference for a preliminary ruling under Article 234 EC, by the High Court of Justice of England & Wales, Chancery Division (United Kingdom)**

*Christoph Gasser*

*Abstract:* The reason for the judgment of the European Court of Justice of 25 January 2007 was a reference for a preliminary ruling regarding the question whether a trademark had acquired distinctiveness through use consisting «of a transparent bean or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation.» The European Court of Justice did not address this question submitted for a preliminary ruling, but primarily examined whether the subject-matter of the trademark application may be a «sign» in the sense of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 («EC Trademark Directive»). The

European Court of Justice denied this question, arguing that a subject-matter of a trademark application, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a «sign» within the meaning of that provision and therefore is not capable of constituting a trademark.

*Resumo:* A razão para o julgamento da Corte Européia de Justiça, em 25 de janeiro de 2007, resultou de uma decisão prejudicial relativa à indagação se uma marca consistindo de “um receptáculo ou câmara coletora transparente que integra a superfície externa de um aspirador de pó, conforme especificado na descrição” teria adquirido distintividade por meio do uso. A Corte Européia de Justiça não abordou esta questão que foi submetida como uma decisão prejudicial, mas examinou essencialmente se o objeto do pedido de marca pode ser considerado como um “sinal” no sentido do Artigo 2º. da Diretiva do Conselho 89/104/EEC de 21 de dezembro de 1988 (“EC Diretiva de Marca). A Corte Européia de Justiça negou essa questão, argumentando que o objeto do pedido de marca, que respeita a todos os formatos possíveis de um receptáculo ou câmara coletora transparente, integrante da superfície externa de aparelho de pó, não é um sinal nos termos daquela norma e portanto não é suscetível de constituir uma marca.

## **I. Facts and Legal Framework**

Since 1993, («Dyson») is producing and distributing the vacuum cleaner «Dual Cyclone», a bagless cleaner in which the dirt and dust is collected in a transparent plastic container forming part of the machine.

On 10 December 1996, the Notary Ltd, a company owned by James Dyson, lodged an application at the Registry for the registration of trademarks for the following products in Class 9 of the Nice Agree-

ment concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended: «[a]pparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampoos; floor polishers; parts and fittings for all the aforesaid goods». That application was assigned to Dyson on 5 February 2002. The trademarks were described as follows: «[t]he mark consists of a transparent bean or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation.» A picture of the bagless vacuum cleaner manufactured and marketed by Dyson was attached to each of the descriptions; however, such picture only illustrated the concept of the transparent plastic container and did not claim to be a representation of the sign to be protected as a trademark.

The application was rejected by decision of the Registrar, which was upheld by the Hearing Officer on 23 July 2002. Dyson brought an appeal against that decision before the High Court of Justice of England and Wales, Chancery Division. That court took the view that the two trademarks at issue were devoid of any distinctive character within the meaning of section 3(1), first subparagraph, (b) of the UK Trade Marks Act 1994 and that they were also descriptive of characteristics of the goods referred to in the application for registration, within the meaning of section 3(1), first subparagraph, (c) of that Act. The High Court was uncertain, however, whether on the date of the application for registration, that was in 1996, the trademarks had acquired a distinctive character as a result of the use made of them, within the meaning of section 3(1), second subparagraph, of the 1994 Act.

The High Court found that, in 1996, consumers recognised the transparent collection chamber as an indication that they were looking at a bagless vacuum cleaner and were informed by advertising and the lack of any rival products – as Dyson had at the time a de facto monopoly in that type of product – that bagless vacuum clea-

ners were manufactured by Dyson. It observed, however, that by that date Dyson had not actively promoted the transparent collection chamber as a trademark. Accordingly, in the light of paragraph 65 of the judgment of 18 June 2002<sup>1</sup>, the High Court was uncertain whether a mere de facto monopoly can suffice to confer a distinctive character, given the association between the product and the manufacturer, or whether it is necessary to require in addition promotion of the sign as a trademark.

In those circumstances, the High Court of Justice of England and Wales, Chancery Division, decided to stay proceedings and to refer the following two questions to the Court for a preliminary ruling:

«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 [the Directive], 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?»

For the time being, the European Court of Justice stayed the proceedings until such time as the European Court of First Instance had delivered final judgment in Case T-278/02, the case «Dyson v OHIM» («Vacuum cleaner»), as that case raised the same question of

---

1 Case C-299/99, «Philips v Remington», [2002] ECR I-5475.

interpretation as the present case. After Dyson had withdrawn the trademark application filed with the European Office for Harmonization in the Internal Market («OHIM»), the proceedings before the European Court of Justice resumed.

## **II. Reasoning rendered by the European Court of Justice**

The European Court of Justice did not deal with the two questions submitted for a preliminary ruling regarding acquired distinctiveness through use, but claimed to be competent to first examine whether the subject-matter of the trademark applications constitutes a «sign» within the meaning of Article 2 of the EC Trademark Directive<sup>2</sup>, even though this question had not been raised by the national court. The European Court of Justice argued that even though «a national court directs its reference to the interpretation of certain Community provisions which might come into consideration, the Court is not thereby precluded from providing the national court with all those elements for the interpretation of Community law which may be of assistance in adjudicating on the case pending before it, whether or not that court has specifically referred to them in its questions»<sup>3</sup>.

Looking at the Articles 2 and 3(1)(a) of the EC Trademark Directive, the European Court of Justice stated that the trademark applications did undisputedly «not seek to obtain registration of a trade mark in one or more particular shapes of transparent collecting bin – the shapes represented graphically on the application form being only examples of such a bin – but rather to obtain registration of a trade mark in the bin itself»<sup>4</sup>. Those trademarks would not consist of

---

2 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks («EC Trademark Directive»), Official Journal L 040, 11/02/1989 P. 0001 – 0007.

3 Paragraph 24.

4 Paragraph 19.



a particular colour, but rather in the absence of a particular colour, namely transparency, which would enable the consumer to see how much dust has been collected in the collecting bin and to know when the bin is full. Accordingly, the European Court of Justice concluded: «It follows that the trade mark application in the main proceedings covers all the conceivable shapes of a transparent collecting bin forming part of the external surface of a vacuum cleaner.»<sup>5</sup>

Referring to its precedents,<sup>6</sup> the European Court of Justice repeated the three conditions to be satisfied in order to be capable of constituting a trademark for the purposes of Article 2 of the EC Trade-mark Directive and not to be declared void within the meaning of Article 3(1)(a) of this Directive: Firstly, it must be a sign. 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 (...).<sup>7</sup>

According to the European Court of Justice, these conditions were not satisfied. Even though it would be true that the enumeration of possible trademark subject-matters in Article 2 of the EC Trade-mark Directive would not be exhaustive, a subject matter within the meaning of that Article must be conceivable and sufficiently defined. However, the subject-matter of the application at issue would not be «a particular type of transparent collecting bin forming part of the external surface of a vacuum cleaner, but rather, in a general and abstract manner, all the conceivable shapes of such a collecting bin»<sup>8</sup>.

---

5 Paragraph 20.

6 Judgments of the European Court of Justice of 18 June 2002 in Case C299/99, «Philips / Remington», [2002] ECR I5475, Paragraph 32; of 12 December 2002 in Case C273/00, «Sieckmann», [2002] ECR I11737, Paragraph 39; of 6 May 2003 in Case C-104/1, «Libertel», [2003] ECR I-3793, Paragraph 23; of 24 June 2004 in Case C49/02, «Heidelberger Bauchemie», [2004] ECR I6129, Paragraph 22.

7 Paragraph 28.

8 Paragraph 35.

Dyson could not argue that the subject-matter of the trademark application would be perceived visually: «What consumers can identify visually is not so much the subject-matter of the application as two of Dyson's graphic representations as contained in the application. Those representations cannot be assimilated to the subject-matter of the application because, as pointed out by Dyson on a number of occasions, they are merely examples of it.»<sup>9</sup> Accordingly, the subject-matter of the trademark application would be capable of taking on a multitude of different appearances and would thus not be specific: «... the shape, the dimensions, the presentation and composition of that subject-matter depend on the vacuum cleaner models developed by Dyson and on technological innovations. Likewise, transparency allows for the use of various colours.»<sup>10</sup>

The European Court of Justice concluded that the owner of such an undetermined trademark, given its exclusive right, could obtain an unjustified competitive advantage as it could prevent its competitors from offering vacuum cleaners, «having any kind of transparent collecting bin on their external surface, irrespective of its shape»<sup>11</sup>. Hence, the European Court of Justice decided, referring to Article 2 of the EC Trademark Directive, «that the subject-matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a 'sign' within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof.»

---

9 Paragraph 36.

10 Paragraph 37.

11 Paragraph 38.

### III. Final Remarks

The decision of the European Court of Justice is in line with its precedents. The trademarks at issue were examined based on the aforesaid three-step test as developed under Article 2 of the EC Trademark Directive and failed to pass this test for lack of visual perceptibility due to a multitude of possible appearances and, hence, because of vagueness. The trademark's independence from the product could finally not be made out.

The European Court of Justice rejected the trademark applicant's attempt to monopolize its concept of transparent plastic containers – in whatever shape – as a part of the external surface of a vacuum cleaner without dust bag. Trademark law does not protect ideas.<sup>12</sup> Accordingly, even if the applicant had invoked the so-called principle of the variability of the concrete trademark usage (for instance, this principle is accepted in case of word trademarks – a word trademark can be used properly in whatever font or colour, be it on the product, in publicity, or elsewhere in commerce<sup>13</sup>), it could not have obtained trademark protection for the different surfaces of bagless vacuum cleaners.

Moreover, the trademark applicant did apparently not endeavor to apply its trademark as a so-called “position mark”. I.e., it did not try to obtain a trademark for a transparent container to be fixed always to the same specific position on the vacuum cleaner, always in the same shape and always in the same relative size.<sup>14</sup> As a consequence, the European Court of Justice was not called to examine whether a transparent container to be fixed always to the same speci-

---

12 See, e.g., FEZER Karl-Heinz, *Eine Theorie der variablen Marke*, GRUR 2005, 103.

13 FEZER (fn. 12), GRUR 2005, 105, 107.

14 Cf. STRÖBELE Paul/HACKER Franz, *Markengesetz*, treatise, 8<sup>th</sup> ed., Cologne et al. 2006, MarkenG 3 N 65, MarkenG 8 N 170; moreover EISENFÜHR Günther/SCHENNEN Detlef, *Gemeinschaftsmarkenverordnung*, treatise, Cologne et al. 2003, GMV 4 N 43, GMV 7 N 91 et seq.

fic position on a vacuum cleaner, always in the same shape and always in the same relative size, would be regarded as not technically indispensable and, moreover, as so unusual that the relevant public would deem this feature as a (position) trademark, pointing to a certain company origin, and not just as any decorative or esthetical element.

#### JUDGMENT OF THE COURT (Third Chamber)

25 January 2007 (\*)

(Trade marks – Approximation of laws – Directive 89/104/EEC – Article 2 – Concept of a sign of which a trade mark may consist – Transparent bin or collection chamber forming part of the external surface of a vacuum cleaner)

In Case C-321/03,

REFERENCE for a preliminary ruling under Article 234 EC, by the High Court of Justice of England and Wales, Chancery Division (United Kingdom), made by decision of 6 June 2003, received at the Court on 24 July 2003, in the proceedings

**Dyson Ltd v Registrar of Trade Marks**, THE COURT (Third Chamber), composed of A. Rosas, President of the Chamber, J. Malenovsky and A. Ó Caoimh (Rapporteur), Judges, Advocate General: P. Léger,

Registrar: B. Fülöp, Administrator, having regard to the written procedure and further to the hearing on 25 April 2006, after considering the observations submitted on behalf of:

- Dyson Ltd, by H. Carr QC and D.R. Barron, Solicitor,
- the United Kingdom Government, by C. Jackson, and subsequently by E. O'Neill and C. White, acting as Agents, and M. Tappin, Barrister,
- the Commission of the European Communities, by K. Banks and N.B. Rasmussen, acting as Agents, after hearing the Opinion of

the Advocate General at the sitting on 14 September 2006 gives the following

### **Judgment**

1 This reference for a preliminary ruling concerns the interpretation of Article 3(3) of 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) ('the Directive').

2 The reference was made in the context of proceedings between Dyson Ltd ('Dyson') and the Registrar of Trade Marks ('the Registrar') concerning the refusal by the latter to register two trade marks, each consisting of a transparent bin or collection chamber ('the collecting bin') forming part of the external surface of a vacuum cleaner.

### **Legal framework**

#### *Community legislation*

3 According to the first recital in the preamble to the Directive, its purpose is to approximate the laws of the Member States relating to trade marks, in order to eliminate disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market.

4 The seventh recital in the preamble to the Directive states that 'attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States' and that 'to this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings'.

5 Article 2 of the Directive, entitled 'Signs of which a trade mark may consist', provides: '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.’

6 Article 3 of the Directive, entitled ‘Grounds for refusal or invalidity’, provides in paragraphs 1 and 3:

‘1. 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, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods;

...

(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;

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply whe-

re the distinctive character was acquired after the date of application for registration or after the date of registration.’

#### National legislation

7 Sections 1(1) and 3(1) of the Trade Marks Act 1994 (‘the 1994 Act’) provide as follows: ‘1. (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

3. (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, quantity, 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.’

#### **The main proceedings and the questions referred for a preliminary ruling**

8 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.

9 On 10 December 1996, Notetry Ltd, a company owned by James Dyson, lodged an application at the Registry for the registration of six trade marks for the following products in Class 9 of the 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: '[a]pparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampoos; floor polishers; parts and fittings for all the aforesaid goods'. That application was assigned to Dyson on 5 February 2002.

10 The application was withdrawn for four of those marks but was maintained for the two others, which are described as follows: '[t]he mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'. A picture of one or other of the two versions of the bagless vacuum cleaner manufactured and marketed by Dyson was attached to each of the descriptions.

11 The application was rejected by decision of the Registrar, which was upheld by the Hearing Officer on 23 July 2002. Dyson brought an appeal against that decision before the High Court of Justice of England and Wales, Chancery Division. That court took the view that the two trade marks at issue were devoid of any distinctive character within the meaning of section 3(1), first subparagraph, (b) of the 1994 Act and that they were also descriptive of characteristics of the goods referred to in the application for registration, within the meaning of section 3(1), first subparagraph, (c) of that Act. The High Court is uncertain, however, whether on the date of the application for registration, that is in 1996, the trade marks had acquired a distinctive character as a result of the use made of them, within the meaning of section 3(1), second subparagraph, of the 1994 Act.

12 In that regard, the High Court found that, in 1996, consumers recognised the transparent collection chamber as an indication



that they were looking at a bagless vacuum cleaner and were informed by advertising and the lack of any rival products – as Dyson had at the time a de facto monopoly in that type of product – that bagless vacuum cleaners were manufactured by Dyson. It observed, however, that by that date the transparent collection chamber had not been actively promoted as a trade mark by Dyson. Accordingly, in the light of paragraph 65 of the judgment in Case C-299/99 *Philips* [2002] ECR I-5475, the High Court is uncertain whether a mere de facto monopoly can suffice to confer a distinctive character, given the association between the product and the manufacturer, or whether it is necessary to require in addition promotion of the sign as a trade mark.

13 In those circumstances, the High Court of Justice of England and Wales, Chancery Division, decided to stay proceedings and to refer the following two questions to the Court for a preliminary ruling:

‘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 [the Directive], 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?’

14 By order of 12 October 2004, the Court stayed the proceedings in accordance with the third paragraph of Article 54 of the Statute of the Court of Justice until such time as the Court of First Instance had delivered final judgment in Case T-278/02 *Dyson v OHIM (Va-*

*cuum cleaner*), as that case raised the same question of interpretation as the present case.

15 By its action before the Court of First Instance, Dyson sought annulment of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), by which the latter had refused to register a trade mark intended for '[a]pparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampooers; floor polishers; parts and fittings for all the aforesaid goods'. In the registration application form, Dyson described the mark sought as follows: 'The mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner.'

16 After Dyson had withdrawn that trade mark application, the Court of First Instance, by order of 14 November 2005, held that the action had become devoid of purpose and that, accordingly, pursuant to Article 113 of the Rules of Procedure of the Court of First Instance, there was no need to adjudicate on the action. Consequently, the proceedings before this Court resumed on the same date.

### **On the questions referred for a preliminary ruling**

17 By its questions, the national court asks, essentially, under what conditions a sign can acquire a distinctive character within the meaning of Article 3(3) of the Directive, where, as in the present case, the trader using the sign had, before its trade mark application was lodged, a de facto monopoly in the product bearing the sign.

18 It is apparent from the order for reference that those questions were raised concerning an application by Dyson to have registered two trade marks which, according to the wording of the application, consist of 'a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.

19 As Dyson has stated on a number of occasions both in its written observations and at the hearing, and as the national court itself noted in its order for reference, the application does not seek to obtain registration of a trade mark in one or more particular shapes of transparent collecting bin – the shapes represented graphically on the application form being only examples of such a bin – but rather to obtain registration of a trade mark in the bin itself. It is, moreover, common ground that those marks consist not of a particular colour, but rather in the absence of any particular colour, namely transparency, which enables the consumer to see how much dust has been collected in the collecting bin and to know when the bin is full.

20 It follows that the trade mark application in the main proceedings covers all the conceivable shapes of a transparent collecting bin forming part of the external surface of a vacuum cleaner.

21 In its written observations and at the hearing, the Commission of the European Communities has argued that the subject-matter of such an application does not constitute a ‘sign’ within the meaning of Article 2 of the Directive and that it therefore cannot be registered as a trade mark. Accordingly, in its view, even if this question was not raised by the national court, it is necessary, before proceeding where appropriate with an interpretation of Article 3 of the Directive, to ascertain whether the subject-matter of that application fulfils the conditions laid down in Article 2 of that directive.

22 According to Dyson and the United Kingdom Government, it is not for the Court, in the context of a reference for a preliminary ruling pursuant to Article 234 EC, to raise of its own motion a question which was not touched on by the national court. At the hearing, Dyson and the United Kingdom Government stated on this point that, during the administrative proceedings, the Registrar, after having voiced objections on the issue of whether the subject-matter of Dyson’s application was a sign capable of constituting a trade mark, withdrew those objections when Dyson withdrew the application in respect of four of the six trade marks for which registration was initially sought.

23 It should be borne in mind that, according to settled case-law, the referring court alone can determine the subject-matter of the questions it proposes to refer to the Court. It is solely for the national courts before which actions are brought, and which must bear the responsibility for the subsequent judicial decision, to determine in the light of the special features of each case both the need for a preliminary ruling in order to enable them to deliver judgment and the relevance of the questions which they submit to the Court (see, to that effect, Case C-159/97 *Castelletti* [1999] ECR I-1597, paragraph 14, and Case C-154/05 *Kersbergen-Lap and Dams-Schipper* [2006] ECR I-0000, paragraph 21).

24 However, even though, strictly speaking, a national court directs its reference to the interpretation of certain Community provisions which might come into consideration, the Court is not thereby precluded from providing the national court with all those elements for the interpretation of Community law which may be of assistance in adjudicating on the case pending before it, whether or not that court has specifically referred to them in its questions (see, to that effect, Case C-387/01 *Weigel* [2004] ECR I-4981, paragraph 44, and Case C-152/03 *Ritter-Coulais* [2006] ECR I-1711, paragraph 29).

25 Moreover, under Article 3(1)(a) of the Directive, signs which cannot constitute a trade mark are not to be registered or if registered are liable to be declared invalid. That provision thus precludes the registration of signs which do not meet the conditions imposed by Article 2 of the Directive, the purpose of which is to define the types of sign of which a trade mark may consist (see, to that effect, *Philips*, paragraph 38).

26 In those circumstances, contrary to the contentions of Dyson and the United Kingdom Government, even though the wording of the questions from the national court relates solely to Article 3 of the Directive and that court did not, in the main proceedings, touch on the issue of whether the subject-matter of the application in ques-

tion may be viewed as a sign of which a trade mark may consist within the meaning of Article 2 of that directive, it is necessary as a preliminary matter to consider that question (see, to that effect, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 22).

27 Article 2 of the Directive provides that a trade mark may consist of any sign, provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings (*Philips*, paragraph 32, and Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 39).

28 It follows that, to be capable of constituting a trade mark for the purposes of Article 2 of the Directive, the subject-matter of any application must satisfy three conditions. First, it must be a sign. 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 (see, to that effect, *Libertel*, paragraph 23, and Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, paragraph 22).

29 According to the Commission, the application lodged by Dyson does not fulfil the first of those conditions because it relates to a concept, in this case, the concept of a transparent collecting bin for a vacuum cleaner, irrespective of shape. Since a concept is not capable of being perceived by one of the five senses and appeals only to the imagination, it is not a 'sign' within the meaning of Article 2 of the Directive. If a concept were able to constitute a trade mark, the logic behind Article 3(1)(e) of the Directive, namely to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product, would be frustrated. Accordingly, it should not be possible to achieve that advantage by registering all the shapes which a particular functional feature might have, which would be the result of allowing the registration of a concept which can cover many physical manifestations.

30 By contrast, Dyson, supported on this point by the United Kingdom Government, takes the view that, even if it is true, as it stated at the hearing, that a concept is not a sign capable of being registered as a trade mark, its application does relate to a 'sign' within the meaning of Article 2 of the Directive. The concept of a 'sign', which is defined broadly by the case-law, in fact covers any message which may be perceived by one of the five senses. It is apparent from the main proceedings that consumers associate the transparent collecting bin which is the subject-matter of the application with Dyson. Moreover, consumers are able, first, to see that collecting bin, which is a physical component of the vacuum cleaner, and, second, to see that it is transparent. The transparent collecting bin is thus perceptible by sight and therefore cannot be considered to be a product of consumers' imagination.

31 It should be borne in mind that, according to Article 2 of the Directive, a trade mark may consist of any sign, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging.

32 Although that provision mentions only signs which are capable of being perceived visually, are two-dimensional or three-dimensional and can thus be represented by means of letters or written characters or by a picture, it is however clear from the language of both Article 2 of the Directive and the seventh recital in the preamble thereto, which refers to a 'list [of] examples' of signs which may constitute a trade mark, that that list is not exhaustive. Accordingly, the Court has held previously that Article 2 of the Directive, although it does not mention signs which are not in themselves capable of being perceived visually, such as sounds or smells, does not expressly exclude them (*Steckmann*, paragraphs 43 and 44, and Case C-283/01 *Shield Mark* [2003] ECR I-14313, paragraphs 34 and 35).

33 However, if that condition is not to be deprived of all substance, it cannot be accepted that the subject-matter of any trade mark application necessarily constitutes a sign within the meaning of Article 2 of the Directive.

34 As the Court has held previously, the purpose of that requirement is in particular to prevent the abuse of trade mark law in order to obtain an unfair competitive advantage (*Heidelberger Bauchemie*, paragraph 24).

35 In the present case, it is common ground that the subject-matter of the application in the main proceedings is not a particular type of transparent collecting bin forming part of the external surface of a vacuum cleaner, but rather, in a general and abstract manner, all the conceivable shapes of such a collecting bin.

36 In that regard, Dyson cannot maintain that the subject-matter of its application in the main proceedings is capable of being perceived visually. What consumers can identify visually is not so much the subject-matter of the application as two of Dyson's graphic representations as contained in the application. Those representations cannot be assimilated to the subject-matter of the application because, as pointed out by Dyson on a number of occasions, they are merely examples of it.

37 It follows that, unlike the applications which gave rise to the judgments in *Sieckmann* and *Shield Mark*, the subject-matter of the application in the main proceedings is capable of taking on a multitude of different appearances and is thus not specific. As pointed out by the Advocate General in point 51 of his Opinion, the shape, the dimensions, the presentation and composition of that subject-matter depend both on the vacuum cleaner models developed by Dyson and on technological innovations. Likewise, transparency allows for the use of various colours.

38 Given the exclusivity inherent in trade mark right, the holder of a trade mark relating to such a non-specific subject-matter would obtain an unfair competitive advantage, contrary to the purpose pursued by Article 2 of the Directive, since it would be entitled to prevent its competitors from marketing vacuum cleaners having any

kind of transparent collecting bin on their external surface, irrespective of its shape.

39 It follows that the subject-matter of the application at issue in the main proceedings is, in actual fact, a mere property of the product concerned and does not therefore constitute a ‘sign’ within the meaning of Article 2 of the Directive (see, to that effect, *Libertel*, paragraph 27).

40 Accordingly, the answer to be given to the national court must be that Article 2 of the Directive is to be interpreted as meaning that the subject-matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a ‘sign’ within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof.

41 In those circumstances, it is not necessary to interpret Article 3(3) of the Directive.

### **Costs**

42 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

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 is to be interpreted as meaning that the subject-matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external



surface of a vacuum cleaner, is not a 'sign' within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof.

[Signatures]

\* Language of the case: English.