

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2118079 by Notetry Limited to register a trade mark in Class 9

Introduction

1. On 10 December 1996, Notetry Limited applied to register a series of six trade marks in Class 9 in respect of:

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

2. The series of marks consisted of a range of different ways of representing a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner. The marks on the application form presented the concept in a descending order of generality. The first mark consisted of just the words:

"The mark consists of a transparent area on the external surface of the goods through which the interior of the collection chamber for dirt, dust, liquid and other waste material can be seen."

- whereas the fifth and sixth marks in the series consist of the words and pictures shown below.

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.



3. The first four marks in the series were subsequently deleted.
4. The applicant has subsequently indicated that it is content to restrict its specification of goods to 'vacuum cleaners'. Hereinafter I will assume this to be so.
5. The remaining two trade marks were originally the subject of objections under Section 3(1)(a) of the Act on the grounds that the marks were incapable of distinguishing the goods of one undertaking from those of other undertakings, and under Section 3(2)(b) on the grounds that the marks consisted exclusively of a shape necessary to achieve a technical result.
6. In a letter dated 10 December 1997, the Registrar set out in some detail the reasoning behind the objection under Section 3(1)(a). The transparent bin was said to be a feature of the goods that may serve, in trade:-

- "a. to demonstrate that the vacuum cleaner is bagless, and*
- b. in a functional manner to indicate content level of container."*

With regard to the second point, the Registrar pointed out that the applicant's own promotional material drew attention to the transparent collection bin's advantage of informing the user when the bin needed emptying.

7. The applicant's Trade Mark Attorney responded in the following terms:

"We do not deny that the transparency of the collecting bin gives an added functional advantage to our client's machines by allowing the user to see into the interior of the collecting bin in order to gauge when the bin is full. However, this functionality only comes into play after the machine has been purchased and used for its intended purpose. During the time when the product is being offered for sale and sold, which is the time when trade marks are actually put to use, there is no collection of dirt and dust in the bin and therefore viewing through the transparent wall of the bin cannot tell the purchaser whether the machine is full or not. In fact, during the critical time

(i.e. during offer for sale and sale of the product), the only "function" of the clear bin is to allow the interior of the vacuum cleaner to be viewed and the only effect this has on the purchaser is aesthetic."

8. The applicant further submitted that the essential feature of the marks consisted not of a "shape", but of a transparent surface.

9. The Registrar accepted the last argument and waived the objection under Section 3(2)(b) on that basis. The objection under Section 3(1)(a) was maintained on the basis described above. The Registrar subsequently raised further objections under Section 3(1)(b) and (c) of the Act. The objection under Section 3(1)(c) was said to arise because:

"... the mark consists exclusively of a sign that may serve, in trade, to designate the kind and intended purpose of the goods in question, i.e. bagless vacuum cleaners with a collecting chamber that is visible in use in order that the user can easily see when it is full."

10. The objection under Section 3(1)(b) was raised on the same factual basis.

11. It was observed that the reasoning behind the late objections was the same as that behind the outstanding objection under Section 3(1)(a), and that it had always been implicit that these further legal objections were behind the Section 3(1)(a) objection, and would need to be addressed if it was overcome.

The Hearing

12. The matter came before me on 1 March 2002, when the applicant was represented by Mr H Carr QC, instructed by Wragge & Co.

Summary of the Applicant's Written Evidence

13. The applicant's evidence falls into three categories. Firstly, there is evidence from Mr James Dyson, the moving force behind, and sole Director of, the applicant. Mr Dyson's evidence goes to the development of the Dyson vacuum cleaner, the origins of the transparent collection bin, and the use made of the marks in the UK since 1993. Secondly, there is evidence from Gillian Ruth Smith, a Trade Mark Attorney, Michael Robert Griffin, Dominic John Nickless, Susan Elizabeth Blackwell (all Research Executives) and David Raymond Barron (a solicitor and partner in Wragge & Co), who describe how two public surveys were undertaken to establish the public's recognition of the transparent bin feature of the applicant's vacuum cleaners, and how 41 witness statements were obtained from responders in the survey. Thirdly, there is evidence from Miles Richard Pennington, Charanjit Singh Nandra, Professor John Howard Drane and Peter David Gammack (who are all designers) that goes to the role played by transparent materials in the design of new products, and the availability of other design solutions to perform the function of informing the user of a bagless vacuum cleaner when the collection bin needs emptying.

Oral Evidence

14. Five of the applicant's 41 consumer witnesses attended the hearing on 1 March to give additional oral evidence.

Evidence about the Origin and Use of the Marks

15. The evidence that I had from Mr Dyson at the hearing is contained in a statutory declaration of 3 January 1997 and a witness statement of 13 February 2001.

16. Mr Dyson is the inventor of the cyclonic technology used in the vacuum cleaners sold on behalf of the applicant by Dyson Appliances Limited (hereinafter Dyson). Mr Dyson states that:

"The first domestic vacuum cleaner I designed and which was sold to the public was called the CYCLON. I made the initial visual model for the CYCLON vacuum cleaner out of wood. By August 1983, I had made a prototype version, incorporating the cyclonic separation system as planned. This prototype version included a transparent bin in the same way that earlier development models had. I thought that a customer purchasing a vacuum cleaner using the cyclonic technology would want to be able to see inside the bin too. I also believed that it would help the customer to understand the new cyclonic technology and prove to the customer that the vacuum cleaner was doing its job of picking up dust and debris and retaining it inside the cleaner. Further, I believed that the customer would appreciate the entertainment aspect of this feature."

17. He continues that he demonstrated a vacuum cleaner featuring a transparent collection bin to 15 manufacturers of vacuum cleaners during the 1980's. Although the concept of a transparent collection bin was not a major issue at the time, he recalls that "more than one" manufacturer expressed a dislike of the "clear/smoked" bin feature. He says that when the Dyson Dual Cyclone vacuum cleaner was first made in 1993, many potential retailers expressed a dislike of the transparent bin. Despite this perceived resistance to the transparent bin, Mr Dyson decided to continue with it because he considered it to be a very important feature that a) allowed the customer to see where the dirt was collected, b) to understand how the cleaner was working, and c) to see that it was effective.

18. Vacuum cleaners carrying the transparent bin were first sold in the UK by Dyson Appliances in March 1993. Mr Dyson provides approximate figures for annual turnover in 1993 through to September 1996. These figures show that sales in 1993 were approximately £3M. By 1995, turnover had risen to £35M. In the first nine months of 1996, the turnover increased further to £60M. Vacuum cleaners bearing the transparent bin feature are sold through major electrical goods retailers and through catalogues of domestic goods. Exhibit JD2 to Mr Dyson's statutory declaration shows advertisements in various catalogues for vacuum cleaners corresponding to those shown in the representations of the marks in the application form. Most of these are dated around the date of the application in 1996.

19. Exhibit JD1 to Mr Dyson's statutory declaration consists of examples of the applicant's

own promotional material. The material comprises a booklet about the company dated 1996 entitled "Doing A Dyson", and two undated promotional brochures for the applicant's upright and cylinder type cleaners, corresponding to the vacuum cleaners shown in representations in the application. Many of the features of the cleaners are picked out for mention in these promotional brochures, including a "telescopic hose and wand", "self-adjusting head", "Triple-row brush bar" and the "Clear bin". The words "Clear bin" are followed by the letters "tm" in small font. The "Clear bin" is described like this:

"This has 3 clear advantages: you can see how well the Dyson works; you can enjoy watching it (most people find it fascinating); and you can always tell when it's full."

20. Above all, the applicant's promotional material makes it clear that the Dual Cyclone vacuum cleaners are new in that they are bagless vacuum cleaners. The strap line "Say goodbye to the Bag" is featured prominently. Exhibit JD2 to Mr Dyson's later witness statement consists of a list of design awards won by Dyson vacuum cleaners, some of which were in 1995 and 1996. Exhibit JD3 consists of samples of advertisements for the vacuum cleaners, and articles in the press about them. Most of these are from 1995 and 1996. Most of these adverts/articles include a picture of one of the two vacuum cleaners shown in the application form. The fact that the cleaners are bagless is always mentioned. There are a scattering of references to the transparent bin. For example an article in "Woman's Own" in 1995 about a comparative test of vacuum cleaners says this about the Dyson cylinder cleaner (a photograph of which is shown in the article):

"This vacuum claims to have 100 per cent suction, 100 per cent of the time because it doesn't have a dust bag. Instead, it has a clear dust bin which takes the guesswork out of deciding when it needs to be emptied."

21. A few of the articles note that a different bin was adopted by Dyson for the Japanese market, (which it appears to have entered in 1995) as a result of the perceived preferences of the Japanese consumer.

Survey and Consumer Evidence

22. Michael Griffin of GFK Marketing Services Ltd gives evidence about the results of two public surveys conducted on behalf of the applicant in May/June 1999. The first survey was part of an omnibus survey regularly conducted by GFK Marketing. The second survey was an ad hoc survey directed at consumers who had bought a vacuum cleaner in the previous two and a half years. 1509 respondents took part in the first survey. 1005 took part in the second.

23. The same two questions were used in both surveys. The first question was:

"Are you aware of any domestic vacuum cleaner with a clear or transparent dust collection chamber or bin?"

Those that answered this positively were asked a second question:

"Could you tell me who makes this particular vacuum cleaner?"

24. Gillian Ruth Smith's evidence explains that these questions originated in an earlier survey commissioned by the applicant to show that the colours yellow and silver were distinctive of its vacuum cleaners. The questions were apparently agreed with the Examiner of the earlier application. Ms Smith notes in a letter to Dyson exhibited to her declaration, that she had *"beaten (the Examiner) into submission on the survey questions."*

25. In the first survey, 1206 of the 1509 respondents was aware of a vacuum cleaner with a transparent collection bin. In the second survey, 867 of 1005 respondents were aware of a vacuum cleaner with this feature.

26. Dominic Nickless of GFK Marketing gives evidence about how he coded the respondents answers to the second question in the surveys. He explains that those who specified Dyson definitely and with no hesitation were coded as 1. Those who specified Dyson definitely but with hesitation were coded 2. Those that specified Dyson with some uncertainty were coded 3. Those who mentioned Dyson and other manufacturers (named or unnamed) were coded 4 or 5. Those who mentioned only two other manufacturers (Electrolux and Hoover) were coded 8 and 9. 'Don't know', those who were thought to have alluded to Dyson without actually mentioning the name (which appears highly problematical to me) and "other" were coded 6, 7 and 10, respectively.

27. Of the 1206 respondents in the first survey who were aware of a vacuum cleaner with a clear bin 619 are recorded as answering the second question as "Dyson" with no hesitation. A further 88 are coded as having answered "Dyson" with some hesitation, making 707 of the original total of 1509.

28. In the second survey, 452 of the 867 who answered the first question positively are coded as having specified 'Dyson' with no hesitation in response to the second question. A further 150 are coded as having specified Dyson with some hesitation, making 602 of the original sample of 1005.

29. In the first survey 175 respondents mentioned Dyson and another manufacturer, or just another manufacturer in their answers, not including those coded under "other". In the second survey the corresponding figure was 90.

30. The verbatim responses to question 2 are exhibited to Mr Nickless's declaration.

31. Susan Blackall is a member of the Market Research Society. She has much relevant experience. Dyson asked her to review the results of their surveys. On whether the surveys were representative, Ms Blackall concludes that, assuming that both surveys were comprised of random samples, the maximum margin of error in the first survey would be 2.5% either side of percentages in the range 40 - 60%. In the second survey the margin of error is likely to be within 3.1% either side of percentages observed in the range 45 - 55%.

32. With regard to the appropriateness of the questions asked, and the sufficiency of the results, Ms Blackall says this:

"The questions actually used for the two surveys are not in themselves leading. The

first question, in particular, is not materially different from the first question suggested above.

However, the second question actually used in the surveys could possibly be construed as leading people 'into a field of speculation that they would never have embarked upon had the question not been put, since their immediate associations with the clear bin might not include the brand name. Asking the question in the way suggested pushes them explicitly in that direction, and for some people, they might have to do a deliberate memory search to produce the answer. The question could therefore lead to an overstatement of real brand name association with the clear bin. However, it does appear that this was taken into account in the way in which the response to the question were coded, so that any hesitation on the part of the respondent was recorded and such answers could be discounted if a very pure response was required."

and

"In assessing the sufficiency of the results, it must be remembered that the second question in the survey was only asked of those who said they were aware of vacuum cleaners with a clear dust collection chamber. This proved to be 80% of the omnibus sample and 86% of the ad hoc survey sample. So out of the total samples, the proportions identifying Dyson with the clear chamber were 41% for the omnibus survey and 45% for the ad hoc survey. These results cannot be said to be a majority of either sample, even allowing for margins of error.

However, the proportions making definite identification with Dyson in the two surveys are only just significantly different, and since they were obtained from two separate surveys, this gave some assurance that they are in the right ballpark."

33. David Barron of Wragge & Co gives evidence about how 41 witness statements were obtained from respondents in the first or second survey whose answers were coded 1. GFK Marketing Services were asked to work through the list of names until they had identified 60 respondents who were willing to be interviewed by Dyson's lawyers. Eventually 42 witnesses were interviewed by solicitors at Wragge & Co, some by telephone. All the potential witnesses were told that the purpose of the interviews was to collect evidence to support Dyson's trade mark application. A script was used for each interview (a copy of which comprises exhibit DRB4 to Mr Barron witness statement).

34. A note of the discussion was drafted as soon as possible and witness statements drafted by two solicitors at Wragge & Co who were present at the interview, based upon their notes. The draft witness statements were then sent to the witnesses for signature. They were given the opportunity of suggesting amendments. 41 were eventually returned, and these are in evidence. Judging from the witness statements, the most common points of discussion seem to have been:

- a) when the witnesses first became aware of the Dyson vacuum cleaners;

- b) whether the witness owns one;
- c) what the witness would look for to identify a Dyson vacuum cleaner;
- d) who the witness would think made a vacuum cleaner with a transparent collection bin;
- e) how the witness would describe a Dyson vacuum cleaner to a friend who knew nothing of vacuum cleaners;
- f) the witnesses knowledge of, and reaction to, other undertakings producing vacuum cleaners with a transparent collection bin.

35. Not all of the witnesses say something about each of these points. Some only cover three. A few cover them all. It is possible to say that 23 of the 41 witnesses owned a Dyson vacuum cleaner, and a number of others had close relative that owned one.

36. Not all the answers were clear, but as far as I can tell, 28 of the 41 witnesses claim to have been aware of the Dyson vacuum cleaner in 1996. The witness statements were made in August 2000. Understandably some witnesses were less sure than others about when they first became aware of the Dyson vacuum cleaner.

37. It is not possible to quantify the witnesses contributions on the other points as easily because the points covered in the remainder of the witness statements varies from witness to witness. It is fair to say that they all "associated" the transparent bin with a Dyson vacuum cleaner. I will return to the witnesses statements and the oral evidence I heard from 5 of the witnesses later.

Evidence about the Design

38. Professor John Drane, Miles Pennington and Charanjit Nandra, give evidence about how they, at Dyson's request, considered alternative ways (to a transparent bin) of designing a vacuum cleaner so that the user can tell when the collection bin needs emptying. However, it is convenient to focus on the evidence of Peter Gammack, a Design Engineer at Dyson Appliances, who offers opinions about which of the alternative designs identified by the external design team are feasible.

39. It is sufficient to note that he concludes that it would be feasible for alternative designs to use various forms of "viewing windows" to allow the user to see when the collection bin is full, or to use light sensors to trigger an exterior light on the casing of the vacuum cleaner when the collection bin is full.

40. Professor Drane, who is a Professor of Industrial Design at the Royal College of Art, submitted a second witness statement in which he generally reviews the use of transparent material in products. I believe that it is sufficient simply to record the following paragraphs

from his conclusions:

"Products, to be successful in the marketplace, need to have designed-in features with strong and immediate appeal to potential customers. Powerful perceptual emotions are excited by visual, tactile and general aesthetic characteristics. Contemporary design commentators describe this aspect of human/product interactions as 'emotional ergonomics'. Part of my function as a designer is to understand how these emotions, related to the attractiveness of the product, can consciously or subconsciously promote purchase decisions.

The use of transparent materials by designers, as described above, has played a significant role in this process by creating bold avant-garde product designs. The transparency conveys a unique appearance and feeling to the products in question, as they enable the consumer to see the inner workings of the product and de-mystify the technology involved. This provides a greater power of identity to the products as the experience created by the transparency is appealing and therefore memorable.

Some transparent products are more bold than others, and I would place the Dyson vacuum cleaner in this category. The clear bin feature allowed consumers to see the dust collected for the first time, going against industry practice."

Further Evidence filed after the Hearing

41. At the conclusion of the hearing I asked the applicant to file some further evidence setting out the extent of the applicant's use of its marks in the period 1996 - 1999. The applicant responded to this by filing a further Witness Statement from James Dyson dated 13 March 2002.

Confidentiality

42. The applicant requested that this information remain confidential because it is commercially sensitive. I take this to be a request for confidentiality under Rule 51 of the Trade Mark Rules 2000. The information in question was requested primarily to assist me in assessing the likely effect of the applicant's use after the relevant date on the outcome of the surveys conducted almost three years later in 1999. As such it appears to me that the information concerned is not central to the applicant's case that the mark had acquired a distinctive character by the relevant date. In these circumstances, I believe that the applicant's reason for confidentiality outweighs the need for the information concerned to be placed in the public domain. Consequently, I direct that this information remain confidential. Any copies of this decision placed in the public domain will be redacted accordingly so as to prevent indirect publication of the information in question. The only specific information that needs to be included in this decision (because it goes to the position prior to the relevant date) is that the applicant spent (confidential) in 1995 promoting products carrying the marks applied for. This reduced to (confidential) in 1996.

43. Despite the applicant's evidence I maintained the objections under Section 3(1)(a)(b) and

(c) of the Act. I gave the applicant a further month to file any further submissions and/or evidence. The applicant's representatives decided not to do so.

The Case for Registration based on the Inherent Distinctiveness of the Marks

44. Sections 1(1) and 3(1) of the Act are 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.”

Section 3(1)(a)

45. Mr Carr drew my attention to a passage from the Opinion of Advocate General Jacobs in the **Baby-Dry** case before the European Court of Justice (ECJ) [2001] ETMR 75 :

“Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than on absolute ground might apply. In theory, since the proviso concerning acquired distinctiveness in Article 7(3) relates only to Article 7(1)(b) to (d) and not to Article 7(1)(a), it might be thought necessary to differentiate between, say, signs which are incapable of distinguishing and marks which are devoid of any distinctive character or composed entirely of descriptive elements. In practice, however, if acquired distinctiveness can be established then there must be an underlying capacity to distinguish; if not, the question is immaterial.”

46. This was said in relation to Article 7(1) of the Community Trade Mark Regulation, which mirrors Article 3(1) of the Trade Mark Directive 104/89, and section 3(1) of the Act. Advocate General Colomer expressed a similar view in his Opinion in the **Philips v Remington** case C-299/99, which the court has recently adopted in its judgement of 18 June 2002. Consequently, there is, as Mr Carr suggests, no point in considering the section 3(1)(a) objection independently of the objections under section 3(1)(b) and (c).

Section 3(1)(b) and (c)

47. The applicant's arguments may be summarised as follows:

- i) There was considerable resistance in the industry to the use of a transparent collection bin because it was felt that customers would not want to see the dirt; a transparent chamber was therefore extremely unusual and peculiar in the industry at the application date;
- ii) In normal circumstances, a vacuum cleaner bin will be coloured; there is no reason why members of the public should regard these colours as indicators of trade origin, but a colourless bin is so peculiar and eye catching that it can and does serve as indicator of origin;
- iii) Although the *prima facie* objections raised do not require a consideration of whether the mark has acquired a distinctive character through use, the evidence can be used to test the proposition that consumers would not regard the signs as an indicator of origin, but merely as a feature of the goods;
- iv) The objection taken under section 3(1)(c), that the transparent bin has a function, is not a proper objection to take under that provision because functionality is specifically dealt with under section 3(2)(b)- but cannot apply in this case because the signs do not consist exclusively of a shape;
- v) The transparent bin has a function - to indicate when it is full - but this function is neither an indication of the kind or intended purpose of the goods, which is to remove dirt; the objection can be understood, but not accepted, if the goods are defined as the bin of a bagless vacuum cleaner, but the goods are vacuum cleaners;
- vi) The most that can be said is that some consumers will appreciate the functional aspect of the signs: but that is not enough because a) consumers do not regard the signs exclusively functional because they have origin significance, b) some consumers will not appreciate the functional aspect at all, c) some consumers will not appreciate it without a further reflection or a degree of mental effort, and d) different consumers may attach different functional significance to the signs, eg some consumers may perceive it as showing them when they have sucked something up by mistake: each of these points is sufficient to defeat the section 3(1)(c) objection;

Decision on Section 3(1)(c)

48. According to the ECJ in Baby-Dry:-

“The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought.”

49. The Registrar’s objection is that the transparent bin serves to designate the kind and intended purpose of the goods, i.e. that the *kind* of goods are bagless vacuum cleaners, and an *intended purpose* of the goods - so that the user can easily see when the vacuum cleaner needs emptying.

The Consumer Evidence of Association between the Transparent Bin and Dyson

50. The applicant seeks to rely on its survey and consumer evidence to demonstrate that the mark is not *exclusively* descriptive of any characteristic of the goods because the transparent bin also indicates trade origin. In **Kabushiki Kaisha Yakult Honsha’s Applications** [2001] RPC 39, Laddie J. stated at paragraph 10 of his judgement:

“Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is to be used for that purpose.”

51. It cannot be denied that, in principle, evidence of a consumer’s initial reaction to a mark can say something about its inherent distinctive character as a trade mark. However, I am doubtful whether evidence from consumers given in the years 2000 and 2001, all of whom claim to have been aware of vacuum cleaners with a transparent bin for some years, can be a faithful reflection of their initial reaction to the inherent properties of the transparent bin, by itself, as a trademark.

52. I do not therefore believe that the evidence that some consumers have come to associate the transparent bin with Dyson, means that the marks are *prima facie* distinctive as trade marks.

Whether Functionality and Distinctiveness are Unrelated

53. Mr Carr argues that the functional aspect of the transparent bin - the ability to see when it needs emptying - is not an essential characteristic of the goods, and cannot therefore be subject to an objection under section 3(1)(c). There are two strands to this argument. Firstly, it is argued that functionality objections can only arise in combination with an objection under section 3(2)(b). Secondly, it is argued that the ability to see when the collection bin needs emptying is not an essential characteristic of a vacuum cleaner as opposed to the bin itself.

54. If the first argument is right, no objection could be raised based upon descriptiveness or non-distinctiveness arising from the mere functionality of a sign, unless the essential features

of the sign are a shape. The question of whether the apparent functionality of a sign is a matter which may bear upon its registrability under section 3(1) of the Act was considered by Mr G. Hobbs Q.C. as the Appointed Person in **Maasland NV's Application** [2000] RPC 893. Mr Hobbs referred the case to the High Court because he thought that there was a matter of general importance involved, namely whether he could deal with objections under section 3(1) independently of objections under section 3(2). However, on the basis of paragraphs 22 and 23 of the ECJ's judgement in Case C-342/97 - **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV** [1999] ETMR 690, he concluded that:

"It would not be right.....to overlook or ignore the presence of functional or technical features in a three dimensional shape when assessing whether the shape in question possesses enough of a distinctive character to be registrable as a trade mark. Such features may serve, in trade, to designate the kind, quality..... intended purpose....or other characteristics of the relevant goods to an extent that renders the shape as a whole unregistrable under one or more of the provisions of section 3(1)(a) to (d) of the Act."

55. The case was never heard by the High Court.

56. It seems to me that the fact that a feature (shape or otherwise) is functional is very relevant to the question of whether it has any distinctive character in a trade mark sense. If consumers attach a merely functional significance to a feature they will not normally accept it as an indication of the trade origin of the goods. In this regard, I can see no reason why the average consumer's reaction should be presumed to depend upon whether or not the functional sign in question is exclusively a shape.

57. Mr Carr drew my attention to paragraphs 12-19 of the Advocate General's Opinion in the Philips' case as support for the proposition that it is important not to confuse a functionality objection with a distinctiveness objection. I accept that point, as far it goes. I do not think it means that the functionality of a feature can be isolated from the enquiry as to whether that feature has distinctive character in a trade mark sense. I see no inconsistency between this view and the Opinion of the Advocate General, who was simply making the point that if a sign is excluded by article 3(1)(e) of the Directive (section 3(2)(b) of the Act) there is no point in considering whether or not there are also objections based upon lack of distinctive character.

What is Meant by 'Essential Characteristics of the Goods?'

58. I accept that in considering the relevance of the functionality of a feature of a product it is necessary - at least for the purposes of section 3(1)(c) - for the function in question to be a characteristic of the goods. Mr Carr says that the goods are vacuum cleaners (although at the time the objection was raised the specification included parts of vacuum cleaners). He relies upon the judgement of the Court of Appeal in **Philips v Remington** [1999] RPC at 820, where it was held that, for the purposes of section 3(2)(a) of the Act, "*the goods*" means the goods for which registration is sought.

59. I do not believe that this reasoning can be transported to section 3(1)(c) of the Act for the very obvious reason that this provision extends to designations of *characteristics* of the goods

whereas section 3(2)(a) does not. So, for example, the primary purpose of a motor car may be to provide transportation, but the words “fuel injection”, “air con”, “leather upholstery” and “fold down rear seats” are nevertheless often used to designate essential characteristics of the vehicle, and not merely of its engine, ventilation system or seats.

60. Similarly, I believe that the average consumer would regard the features of the applicant’s vacuum cleaners, which are selected for special mention in the promotional material for its vacuum cleaners because of their functional advantages, such as the “*telescopic hose and wand*”, “*self-adjusting head*”, “*Triple-row brush*” and the “*Clear bin*”, as essential characteristics of the vacuum cleaners.

Ambiguity

61. Mr Carr says that consumers would have had a range of reactions to the transparent bin. On the basis of the judgement of the Court of First Instance (CFI) in **Doublemint** [2001] ETMR 58 (which I understand is under currently under appeal to the ECJ), and a decision of Mr Christopher Floyd QC sitting as a Deputy High Court Judge in the case of **David West v Fuller Smith and Turner Plc** (25 January 2002), Mr Carr submits that any ambiguity in the descriptive message sent to consumers is sufficient to defeat an objection under section 3(1)(c) of the Act.

62. In the Doublemint case, the CFI held that the mark was free from objection under the equivalent of section 3(1)(c) in the Community Trade Mark Regulation (CTMR), because the element “Double” was found to be ambiguous in the context in which it was used. The court held that DOUBLEMINT “*does not immediately and without further reflection allow the consumer to detect the description of a characteristic of the goods in question*” (confectionery). The mark at issue in the West case consisted of three letters, ESB for beers, and the issue was whether the public would see the sign as no more than an abbreviation for ‘Extra Special Beer’. The judge decided that the descriptive meaning was not immediately apparent.

63. I do not accept that the reasoning in these cases introduces a rule that a trade mark with two or more clear descriptive indications is free from an objection under section 3(1)(c). For example, the sign ‘32 inch’ is used to describe both the waist and inside leg measurement of trousers. It would be absurd to suggest that merely because it has two descriptive uses it is more than a mere description. I believe that the reasoning behind the cases to which Mr Carr drew my attention is that where the descriptive message in a trade mark is sufficiently ambiguous, the trade mark should not be regarded as descriptive but rather as allusive. The court’s decision on the facts in Doublemint may have surprised some. The approach itself is not radical. Trade marks that can properly be regarded as allusive have always been registrable. See, for example, the decision of the Appointed Person in **Automotive Network Exchange** [1998] RPC 885.. I do not therefore accept that the possibility of some consumers correctly assuming that the transparent collection bin serves to designate more than one characteristic of a vacuum cleaner would be sufficient to defeat the section 3(1)(c) objection.

Is the Functional Role of the Transparent Bin Discernible to the Average Consumer ?

64. Of more potential significance is the submission that some consumers would not immediately see any functional purpose in the transparent collection bin, and would not therefore see it as identifying the intended purpose or any other characteristic of the vacuum cleaner.

65. James Dyson and Professor Drane give evidence that the use of a transparent bin was against the mind set in the industry at the time that it was introduced. The applicant's vacuum cleaners were the only bagless vacuum cleaners in the market when they were first introduced in 1993, and that was still the position the date of the application. It is difficult to see how or why a transparent bin would be used with a traditional vacuum cleaner with a bag. Consequently, only those with knowledge of the views of other vacuum cleaner manufacturers about the future use of transparent collection bins in bagless vacuum cleaners can shed any light on the mind set of the industry at that time. Professor Drane is not in the industry. He says that Electrolux are amongst his list of past clients, but he does not say when this was or what work he did for them. James Dyson says that "*more than one*" of the 15 manufacturers to whom he demonstrated his prototype cyclonic vacuum cleaner with a transparent collection bin was against the idea, and that there was some resistance from retailers. He does not provide a great deal of detail about this. In any event, he persevered with the idea of a clear bin because he believed that it would help customers understand the technology and see that it was effective.

66. I do not accept that this means that a transparent collection bin was not a sign that "*may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought.*" It might have been thought by some that consumers would not want to see the dirt and dust picked up by the cleaner. However, as soon as the consumer understood what would end up in the transparent bin, it served as an effective means of telling when the vacuum cleaner needed emptying. In my judgement that is a characteristic of the vacuum cleaners in question, whether it be an intended purpose or "*other characteristic*" of the goods. The evidence that there are other technical means, such as viewing windows or a light indicator, to achieve the same result simply points to the similarly functional and descriptive nature of the transparent bin.

The Suggested Analogy with Colour

67. Mr Carr argued that the transparent collection bin was strange and peculiar at the time of its introduction. He argued that the trade marks were analogous to the registration of a single colour, which the OHIM Third Board of Appeal has said are capable of registration if they are extremely unusual and peculiar in the relevant trade. They said this in the course of refusing an application to register a shade of light green for chewing gums: **WM Wrigley JR Company' Application** [1999] ETMR 337. I do not believe that the analogy between an extremely unusual and peculiar colour for particular goods, and a transparent bin for a vacuum cleaner, holds up. Unlike a peculiar colour, the transparent bin has a functional reason for being there.

Whether New Forms of Descriptive Sign are Caught by Section 3(1)(c)

68. I accept that the transparent bin was a new feature at the time of its introduction, and that it was still unique at the relevant date. I do not accept that this means that it was not a normal means of designating a characteristic of the goods. Everything was new once. The use of the words “*may serve in trade*” (emphasis added) in section 3(1)(c) of the Act indicates that new descriptive signs are caught by the exclusion from registration. In this regard, see the decision of Mr G Hobbs QC acting as the Appointed Person in “**Cycling IS....**” **trade mark**, BL O/561/01, at paragraphs 30-32. Once bagless vacuum cleaners came on the market the use of transparent collection bins to indicate when the bin was full was, in my judgement, a normal means of designating this characteristic of the goods.

A Designation of Bagless Cleaners

69. Moreover, and perhaps of primary significance, the presence of a transparent collection bin showed the consumer that the applicant’s vacuum cleaners **were bagless**. Mr Dyson gives evidence that:

“... the clear bin was, and remains, a very important feature of the Dyson Dual Cyclone vacuum cleaners. It was this feature which allowed the potential customer to see the dust spinning in the cyclone and to see where that dirt was being collected. I believe that this helped the customer to understand how the vacuum cleaner was working. I also found that a vacuum cleaner with a transparent collection chamber in which dirt and dust was collected would draw the eye of the potential customer who could then see that the cleaner was effective.”

70. One can see that in showing the customer where the dust was being collected, the transparent collection bin served a very important role in informing the potential customer that the dust was not being collected in the traditional manner, in a bag, but in the see through chamber. It is easy to see how important this visual means of distinguishing the new **kind** of vacuum cleaner concerned from the previous technology must have been, and must still be, to a manufacturer of bagless vacuum cleaners. Whatever its other benefits, a bagless vacuum cleaner does not require the user to purchase replacement bags. The side effect of showing that the cleaner was working effectively must also have been of great benefit at the time when cyclonic vacuum cleaners were first being introduced to the market.

71. In my view the transparent collection chamber is a sign or indication that may serve, in trade, to designate the kind of goods, ie bagless vacuum cleaners.

72. It is clear that the essential feature of two trade marks before me is the transparent collection bin depicted in the marks. On the basis of my findings at paragraph 68 and 71 above, I find that the trade marks are *prima facie* excluded from registration by section 3(1)(c) of the Act.

Whether a section 3(1)(b) objection can apply if the Section 3(1)(c) Objection is Wrong

73. In case I am wrong in finding that the transparent collection bin is an indication of characteristics of the goods, I further find that the trade marks are excluded from registration by section 3(1)(b) of the Act because they are devoid of any distinctive character as trade marks. In this respect, I note that in case T-33/00 **Henkel KGaA v OHIM** [2002] ETMR 25, the Court of First Instance found that a dishwasher tablet with embedded coloured particles, was excluded from registration under Article 7(1)(b) of the CTMR (equivalent to section 3(1)(b) of the Act) notwithstanding that there was no objection under section 7(1)(c) (equivalent to section 3(1)(c)). The court said:

“The advertising carried out by the applicant and other manufacturers of detergents tends to highlight the fact that those particles indicate the presence of various active ingredients. The coloured particles thus suggest certain qualities, although that does not mean that they can be regarded as a descriptive indication in terms of Article 7(1)(c) of Regulation 40/94. However, it does not follow from the fact that that ground of refusal is inapplicable that the coloured elements necessarily confer a distinctive character on the mark applied for. Where, as in the present case, the target sector of the public sees the presence of coloured elements as a suggestion that the product has certain qualities, and not as an indication of its origin, there is no distinctive character. The fact that consumers may nevertheless get into the habit of recognising the product from its colours is not enough, in itself, to preclude the ground for refusal based on Article 7(1)(b) of Regulation No 40/94. Such a development in the public’s perception of the sign, if proved, may be taken into account only for the purposes of Article 7(3) of Regulation No 40/94.” (equivalent to the proviso to section 3(1) of the Act)

The Criteria to be Applied where the Mark is indistinguishable from the Appearance of the Goods themselves

74. The court went on to find that the trade mark at issue was devoid of any distinctive character. In doing so, the court noted that:

“Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the representation of the product itself are therefore no different from those applicable to other categories of trade marks.

Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three-dimensional mark not faithfully representing the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.”

The marks at issue in this case are likewise indistinguishable from the appearance of the goods themselves.

Does Uniqueness equal Distinctiveness as a Trade Mark?

75. The applicant argues that there were no other vacuum cleaners with transparent bins on the market at the relevant date, and that its use of a transparent bin was therefore distinctive. In the Yakult case referred to above, the applicant contended that the shape of its container was distinctive because it was new and unusual. Laddie J. found that:

*“The relevant question is not whether then container would be recognised on being a second time, that is to say, whether it is of memorable appearance, but whether **by itself** its appearance would convey trade mark significance to the average consumer. For the purposes of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense.”*

76. In the absence of education as to the trade origin of the goods concerned, the **average consumer** of vacuum cleaners was, in my view, likely to regard the transparent collection bin as, firstly, an indication that the vacuum cleaner was of a new bagless type, and secondly, as a functional feature intended to let them know when the machine needed emptying. I do not rule out the possibility that some consumers may have seen other functional purposes, such as seeing if something unexpected has been sucked up, or found a curiosity value in watching the machine work. Any or all of these reactions would have been natural reactions to the appearance of a new type of vacuum cleaner with visible technical and functional characteristics differing from the pre-existing technology. I do not accept that any of these reactions would have been such as to inherently identify the trade source of the product.

77. Consequently, even if I am wrong in concluding that the trade marks are excluded from registration under section 3(1)(c), I find that they are excluded from registration under section 3(1)(b) because the transparent bin, which is the essential feature of both marks, is devoid of any distinctive character as a trade mark.

The Case for Registration based upon the Evidence of Acquired Distinctiveness

The Legal Test

78. In the **Windsurfing Chiemsee** case [1999] ETMR 585, the ECJ ruled on the nature of the inquiry as to whether a mark has acquired a distinctive character under Article 3(3) of the Directive (Section 3(1) proviso). It held that the national courts may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the

proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations” (paragraph 51).

“If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.” (paragraph 52).

The Applicant’s Arguments on Acquired Distinctiveness

79. The applicant’s arguments can be summarised thus:

- i) The evidence of use prior to the relevant date, taken together with the survey evidence, show that the mark had acquired a distinctive character by the relevant date;
- ii) The evidence from the consumer witnesses supports the suggested conclusions from the surveys;
- iii) The applicant does not contend that the transparent bin has been positively promoted as a trade mark prior to the relevant date, but argues that what counts is not what the trade mark owner has or has not done, but what the public perceive in the trade mark applied for;
- iii) The totality of the evidence shows that it was no longer devoid of any distinctive character at the relevant date.

The Nature and Extent of the Applicant’s Use of the Marks

80. The applicant’s evidence indicates that vacuum cleaners carrying the transparent collection bin were first introduced to the UK market in March 1993, some 3 years and 8 months before the relevant date. Sales in 1993 do not appear to have been particularly large, but by 1995 the applicant achieved substantial sales, which increased still further in the first 9 months of 1996. Consistent with its position that the presence of the transparent bin is the essential feature of both marks, the applicant has not tried to distinguish between sales of vacuum cleaners of the two designs shown in the trade marks applied for. I have not been provided with evidence of market share, but there is some anecdotal claims in various press articles from 1995/6, exhibited to Mr Dyson’s evidence, which suggest that Dyson Dual Cyclone vacuum cleaners were among the market leaders by the relevant date.

81. The applicant spent a substantial sum promoting its products in the years 1995 and 1996, although the figure for 1996 is considerably smaller. Neither figures seems huge in comparison to the turnover in the goods, but they appear to have been supplemented by the effect of significant press coverage prompted by the innovative nature of the products.

82. Evidence of use does not prove that a mark is distinctive; increased use does not do so either: **Bach Flower Remedies v Healing Herbs Ltd** [2000] RPC 513. This must be all the more so where the applicant is not able to say that the use that it has made of the marks prior to the date of the application was overtly identified as trade mark use. In this connection, I note that the only promotional booklets in evidence - exhibit JD1 to Mr Dyson's statutory declaration - show that the applicant has at some time identified the words 'Clear Bin' as a trade mark, but the accompanying description of the bin itself speaks only of its functional benefits. Further, the material in question is not dated and may have been produced after the application was filed.

The Survey Evidence

83. The applicant claims that the surveys show that 65% and 77%, respectively, of respondents aware of a vacuum cleaner with transparent bin associated it with Dyson. However, the percentages relate only to those that were aware of the feature that the applicant contends is its trade mark. In assessing the proportion of the relevant public who identified the product as originated from a particular undertaking, it is plainly inappropriate to discount those potential customers for vacuum cleaners who were not aware of any vacuum cleaner with a transparent bin. The applicant's market research expert, Ms Blackall, indicates that proportions associating Dyson with the clear chamber were 41% in the first survey, and 45% in the second. It is appropriate to limit the relevant public to those members of the general public who are potential customers for a vacuum cleaner. I can see no reason why the relevant public should be further limited to those who had bought a vacuum in the previous 2.5 years. Accordingly, hereinafter, I intend to focus on the result of the first survey.

84. As I noted earlier, the surveys were conducted in mid 1999 whereas the relevant date is December 1996. Consequently, in interpreting the results of the survey it is necessary to discount the effect of the applicant's use in the period from December 1996 to mid 1999. This may not matter much where the mark has been in use over a very long period, but in this case the use after the relevant date is almost as long as the use prior to the relevant date. Further, without going into unnecessary detail, the applicant's annual sales and promotional expenditure in the period 1997-1999 were considerably higher than in the period 1993 to 1996. This may have had the effect of increasing the numbers who associated the transparent collection bin with Dyson in mid 1999 compared to the position at the relevant date. Having said that, I acknowledge that the applicant was firmly established in the market by the relevant date. I noted earlier that around 28 of the 41 consumer witnesses made statements that indicated that they were aware of the use of the transparent bin in 1996. There are obvious difficulties in trying to recall some years later exactly when you first encountered a feature on a something like a vacuum cleaner. However, if I were to take the consumer witnesses' evidence at face value, and I regarded them as typical of similar respondents in the survey, this would suggest that a similar survey at the relevant date would have resulted in around 28% of the respondents making an association between the transparent bin and Dyson's vacuum cleaners.

85. As Ms Blackall correctly observes, in determining what weight to attach to the survey results, it is also necessary to bear in mind that the second question put to respondents:

"Could you tell me who makes this particular vacuum cleaner?"

- is leading respondents to speculate about matters that they may never otherwise have speculated about. The applicant points out that it agreed this question with the Examiner of an earlier application in relation to a survey to be carried out to prove the distinctiveness of that mark. The Examiner agreed to an earlier version of the same question in a letter dated 30 April 1997 after several exchanges with the applicant's advisors. I think he was wrong to do so. He attached to his letter a copy of the Registrar's published guidance on surveys, which makes clear that open non-leading questions are to be preferred, such as "*do you recognise this sign?*" and "*What, if anything, does it mean to you?*" By contrast, the second question in the applicant's survey was plainly intended to encourage people to think of the transparent bin only as a designation of trade source. It is not unusual for the Registrar's Hearing Officers to be asked for an informal view on whether a question proposed to be included in a survey is likely to be regarded as fair and non-leading. However, applicant's advisors should not expect to be able to cloak a leading question with a veneer of official sanction as a result of having, to use Ms Smith's own words, "*..beaten (the Examiner) into submission on the survey questions.*" Ultimately, responsibility for the fair conduct of surveys remains with those that commission them.

86. Ms Blackall points out that the deficiency with the second question may have been offset, to some extent, by the method used to code the answers. I do not agree with that because a large number of those whose answers were coded 1 - 'answered Dyson definitely and with no hesitation' - gave one word answers. It is not possible to exclude the possibility of artificial speculation from such a short response. I accept that the coding is helpful in eliminating those coded 2 whose 'association' of the transparent bin with Dyson was hesitant and therefore unlikely to be concrete enough to amount to recognition of this feature as a trade mark. 619 of the 1509 respondents in the first survey were coded 1.

87. I have been through the verbatim answers and found the coding generally reliable. However, among those that gave more than one word answers, I found at least 19 responses coded 1, such as "*What like Dyson*", "*Dyson is it*" (which I also found code 2 and 3), "*Dyson make one*", "*Well Dyson is probably one*", "*Dyson is one of them*", "*I am aware of the Dyson and things like that*" that do not suggest that the respondent regarded the transparent bin as a feature which identified only Dyson vacuum cleaners. I also found that the level of association of the transparent bin with other manufacturers was under reported because 21 responses naming manufacturers other than Hoover or Electrolux (the only other makers of bagless vacuum cleaners with transparent bins in 1999) had been coded under "other". This probably has little significance because the applicant was the only maker of bagless cleaners in 1996. If anything, it confirms that the second question encouraged respondents to undertake guesswork as to the "right" answer.

88. It is clear from the ECJ's judgements in **Sabel BV v Puma AG** [1998] RPC 224 and **Marca Mode CV v Addidas AG & Others** [2000] ETMR 723, that in assessing whether there is a likelihood of confusion between two trade marks., the mere fact that one mark brings the other to mind is not enough to constitute a likelihood of confusion, even where the earlier mark has a reputation with the public. By contrast, in **Canon v MGM** [1999] ETMR 1, the ECJ indicated that the sort of association that leads consumers to believe that the similarities

between two trade marks indicates that they are used by the same or by an economically linked undertaking, is sufficient to constitute a likelihood of confusion.

89. I believe that the same reasoning should be applied when determining whether a trade mark has acquired a distinctive character. When the court referred to the trade mark identifying “*the goods as originating from a particular undertaking*” in its judgement in *Windsurfing Chiemsee*, it meant that the trade mark has come to foster a concrete expectation among consumers that the goods originate from one undertaking, not just that consumers may be caused to wonder whether or not this might be the case or simply be “reminded” of the undertaking concerned. A similar point is made in Kerly’s (13th Edition), paragraph 7-127 at page 189, referring to my own decision in **Dualit Ltd’s Application**, 1999 RPC 303.

90. Because of the leading question and the timing of the survey, it is not possible, despite the coding, to fully test the nature of respondents association of the transparent bin with Dyson vacuum cleaners at the relevant date. Further, the ECJ points out in its judgement in *Windsurfing*, that the matter cannot be determined solely by reference to pre-determined percentages. Rather the matter should be judged on the basis of the presumed expectations of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect. This was the approach taken by the Court of Appeal in *Bach Flower Remedies*, supra. And this approach appears to have been endorsed by the ECJ in their recent judgement in Case C-299/99 **Philips v Remington**, at paragraphs 62 and 63.

The Consumer Witnesses’ Evidence

91. It is therefore necessary to look carefully at the evidence from the consumer witnesses. The following extracts from the consumer witnesses’ statements gives a flavour of their evidence. A number of the witnesses give evidence which indicates that they regard the transparent bin feature as a means of identifying the trade source of a vacuum cleaner. For example, Alexander Smith, a police constable, says:

“I can confirm that if I were to glance at a vacuum cleaner with a clear bin feature from a distance, I would automatically think it was a Dyson vacuum cleaner. If I did not already own a Dyson vacuum cleaner and wanted to purchase one, I would recognise it in the shop by its clear bin feature. I would specifically look for the clear bin feature to identify a Dyson vacuum cleaner. That would certainly have been the case in December 1996, but I am now aware that there are other manufacturers making vacuum cleaners with clear bins. Now, I would have to make sure that I was not buying a copy of the Dyson vacuum cleaner.”

92. Elizabeth Gilchrist, a retired Care Assistant, says:

“When I see a vacuum cleaner with a clear bin I automatically think that it is a Dyson vacuum cleaner. To me, a clear bin means a Dyson vacuum cleaner. If someone were to say to me “I have got a vacuum cleaner with a clear bin”, I would automatically say to them “Oh, so you have a Dyson then?”

If I were to go into a shop and see a vacuum cleaner with a clear bin amongst a row

of standard vacuum cleaners, I would initially think that it was a Dyson vacuum cleaner, for example, when I first saw the new Electrolux vacuum cleaner, I thought it was made by Dyson until I saw the name "Electrolux".

If I were to help a friend to recognise a Dyson vacuum cleaner I would first say that it was the vacuum cleaner with a clear bin and secondly that it was yellow and grey in colour, as this is what my vacuum cleaner looks like."

93. Other witnesses seem to place rather more weight on the role that particular colours play, in combination with the transparent bin, in identifying a Dyson vacuum cleaner. William Carter, a retired quantity surveyor, says:

"I understand that Dyson applied to register the clear bin feature of their vacuum cleaner as a trade mark in December 1996. If, at that time, I had seen a row of vacuum cleaners and one of these had a clear bin, I would have automatically thought that it was a Dyson vacuum cleaner. The clear bin together with the two bright colours are features which, to me, represent Dyson and so help me to identify a Dyson vacuum cleaner. Consequently, if I were to describe a Dyson vacuum cleaner to someone who knew nothing about them, I would say that it is a vacuum cleaner with a clear bin and is either yellow/grey or purple/grey in colour."

94. A number of witnesses make statements which suggest they see a functional purpose in the transparent cylinder. Mr Peter Landi, who is also retired, says:

"I purchased my Dyson vacuum cleaner purely on the basis of its performance, although I was drawn to it because of the clear chamber and the fact that I could see how much was in it. I like the clear chamber and the fact that there are no bags to buy for the vacuum cleaner.

I would definitely recognise the Dyson vacuum cleaner amongst all other vacuum cleaners because of the clear chamber. In other words, if I were to see a clear cylinder vacuum cleaner without any brand name on it, I would automatically think that it was a Dyson vacuum cleaner, irrespective of its colour. I would therefore describe the Dyson vacuum cleaner to a friend who had never seen one by explaining it to be the vacuum cleaner with a transparent cylinder."

95. Elizabeth Weston, a teacher, says:

"It is the bagless feature of the Dyson vacuum cleaner that helps me to recognise a Dyson vacuum cleaner. Looking at it from this point of view, I would say that I would immediately associate the clear bin with a Dyson vacuum cleaner because it tells me that the vacuum cleaner doesn't have a bag. However, the rest of the design is so distinctive that I think that this is what I would register first.

If I were to describe a Dyson Vacuum Cleaner to someone who had never seen one before, the main thing that I would point out would be that it is a vacuum cleaner that has a clear cylinder. I do consider the clear cylinder to be something that is

distinctive of the Dyson vacuum cleaner and so this is a good way of identifying it.

I am aware that other vacuum cleaner manufacturers are now using the same method and technology for their vacuum cleaners. However, Dyson were the only manufacturer on the market with this type of vacuum cleaner at the time of launch. The other manufacturers tend to make their vacuum cleaners in mono colour and not bright at all, and this helps to make them different from Dyson vacuum cleaners.”

96. Other witnesses, whilst giving evidence to the effect that the transparent bin is associated with a Dyson vacuum cleaner, nevertheless indicate that they are not confused when other vacuum cleaners with the same feature appeared on the market. Helen Hartley, a retail manager, says:

"If I were in a shop and saw a vacuum cleaner with a clear bin amongst a row of other vacuum cleaners, I would first think it was a Dyson vacuum cleaner. I am aware that there are other manufacturers producing vacuum cleaners with clear bins as I used to work for House of Fraser and recall seeing them there. I have also seen them advertised in magazines. I did not think that these vacuum cleaners were Dyson vacuum cleaners as they are of a different style and do not have the bright colours.”

97. Michael Howe, a retired civil servant, says:

"I would certainly say that I associate the clear chamber with Dyson vacuum cleaners. This is primarily because Dyson was the only manufacturer with a clear cylinder vacuum cleaner on the market initially. I would say that the garish colours, the bagless feature and the improved suction were other features that I would also identify with Dyson vacuum cleaners.”

He goes on to say:

"I am aware that there are other vacuum cleaners on the market now with clear cylinders, copying Dyson. Although I think this might seem to be unfair, this is definitely how business works. I always look closely at things like this and look at the specification. So, when I saw the other clear cylinder vacuum cleaners, I knew immediately that they weren't made by Dyson.

If I were to describe a Dyson vacuum cleaner to someone who did not know anything about them, I would say it was a plastic bright vacuum cleaner with no bags and a clear cylinder.”

98. Twenty three of the 41 witnesses are owners of Dyson vacuum cleaners, which I doubt is representative of the vacuum cleaner owning public at large. This may be accounted for by the fact that all of the witnesses were selected from those whose answers were coded 1 in one or other of the surveys, which as I have already noted, places them in a minority of the relevant public. Furthermore, the witnesses statements were drafted for them following discussions with the applicant's lawyers, so inevitably their responses were not triggered by a normal shopping experience but by the questions and topics on the applicant's script.

99. There is not much doubt that the 41 consumer witnesses associated the transparent bin with the Dyson vacuum cleaner in 2000, and many claim that they would have done so in 1996, but it is not easy to understand the nature of the association from their written evidence. In particular, it is not easy to understand whether the witnesses, or how many of them, regard the transparent bin as functioning, by itself, in a trade mark sense.

Oral Evidence

100. The applicant asked for leave to bring 5 of the 41 people who had made witness statements to the hearing in order that they might supplement their written evidence with oral evidence and afford me the opportunity of asking any questions that I might have. I do not envisage that this will often be necessary. The Registrar's Hearing Officers are normally perfectly able to evaluate evidence of acquired distinctiveness from written evidence alone. However, because I could see that there was likely to be some difficulty in deciding what weight to attach to the witnesses written evidence in this case, I agreed to exercise the Registrar's discretion to hear oral evidence under Rule 55(2) of the Trade Mark Rules 2000.

101. I heard oral evidence from Mr William John Fearn, an IT Consultant, Mr Peter Russell Cook, a retired merchant navy officer, Mr Steven Philip Watkins, a mechanical and electrical technician, Nancy Edwards, a retired Senior Nursing Officer, and Mrs Hazel Bond, a Cardiac Technician. All the witnesses gave their evidence under oath.

102. All the witnesses stated that if they had seen a vacuum cleaner with a transparent collection bin in 1996 they would have expected it to be a Dyson Vacuum cleaner. However, the witnesses more detailed answers are quite revealing. Mr Fearn answered Mr Carr's first two questions like this:

- Q. Mr Fearn, can you explain please what a clear bin on a vacuum cleaner meant to you in 1996?*
- A. At the time I would have said it was a very distinctive feature of a Dyson cleaner.*
- Q. Again in late 1996, if you had seen a row of vacuum cleaners in a shop and one had a clear bin, what would you have thought?*
- A. I would have thought that it was very different to other cleaners available at the time and I would have associated that with Dyson.*

103. I subsequently asked the witness a number of questions, the most relevant ones, and Mr Fearn's answers, are re-produced below:

- Q. If you were looking for a bagless vacuum cleaner in an electrical shop and you could not see anything else other than the products themselves, what would you look for to be able to select a bagless one?*
- A. I think I would go on the impression that I have got from looking at bagless vacuum cleaners. The Dyson to me seems to stand out because of the sort of overall functionality of the design. Other ones that I have seen look very much as if the bagless containers has been grafted into a standard upright design whereas with the Dyson I am left with the impression that that is the bit that does the business and it has been designed outwards from there rather than being grafted into an existing*

product.

- Q. What is it about the other bagless ones that let you know they are bagless.*
A. I do not actually spend a lot of time studying vacuum cleaners but
Q. Take your time.
A. The ones that I would think of as being bagless cleaners have some sort of clear container.
Q. So if you saw one without a clear container, would you still imagine it might be bagless?
A. I would tend to think of vacuum cleaners without the clear container as being conventional paper bags.

104. Mr Cook answered Mr Carr's questions like this:

- Q. Mr Cook, could you please explain what a clear bin on a vacuum cleaner meant to you in 1996?*
A. Well, the first I ever saw of it was when the Dyson was being advertised in the shops. To me when I first saw it, I associated it with Dyson.
Q. In late 1996, if you had seen a row of vacuum cleaners in a shop and one had a clear bin, what would you have thought?
A. Well, I would have thought that would have been the Dyson, this vortex one.
Q. How would you describe a Dyson vacuum cleaner to a friend who knew nothing about them?
A. I would say it was an upright vacuum cleaner and instead of having a bag it had a clear cylinder on it which collected the dust via a vortex instead of having a bag with a filter.

105. After checking that Mr Carr had no objection, I showed Mr Cook a photograph of four upright vacuum cleaners with transparent bins that are on sale today, only one of which was a Dyson vacuum cleaner. Mr Cook thought that they were all "similar" to a Dyson cleaner, but he was doubtful whether two of them were Dyson cleaners. Of the two he thought were Dyson cleaners, one was a Dyson, and the other used a colour scheme that is similar to one used by Dyson.

106. Mr Watkins answered Mr Carr's first three questions like this:

- Q. Mr Watkins, can you explain what a clear bin on a vacuum cleaner meant to you in 1996?*
A. Basically, being able to see all the dirt and everything that went into a vacuum cleaner.
Q. Did it indicate to you anything about who made the vacuum cleaner?
A. Yes.
Q. Who?
A. Dyson. It just showed up that they were the only ones that were doing it.

107. Mr Carr subsequently showed the witness the photograph of the four vacuum cleaners referred to above. Mr Carr's next questions and the witness' answers were as follows:

- Q. Imagine in 1996/1997 you had gone into a shop and you had seen those vacuum cleaners, and you had noticed the clear bin. Who, if anyone, would you have thought made them?*
- A. I first would have thought they were Dyson to start with, and then obviously you start looking and finding names on them whatever, but initially first it would be Dyson.*
- Q. Why?*
- A. Because they have got clear bins on them. They are cyclones.*

108. A few of my own questions and the witness' answers are shown below:

- Q. If you were describing to a colleague or a friend of yours, who had no technical understanding of the way vacuum cleaners work, what to look for if they wanted to collect a bagless vacuum cleaner, what would you tell them to look out for in order that they could recognise one when they saw them.*
- A. Basically, the make. "Look out for a Dyson. They are all bagless. With all the other ones, some are; some are not. Some look like they are not, but they are, whatever. All the Dyson ones were bagless. Just look out for the make and it is going to be a bagless one".*
- Q. That would depend on the brand maybe?*
- A. In a way, yes. Apart from the brand you would say, if it is a clear cylinder you can see then there is no bag fitted in it because that is the only place where a bag could go in one. So look for a clear cylinder as well.*
- Q. You say in your witness statement that you associated it – indeed you were fairly clear to Mr Carr's question – and you would have expected those vacuum cleaners to have come from Dyson if you had seen them in 1996/1997.*
- A. Yes.*
- Q. Would that still be your view today?*
- A. No, because loads of different people now make clear cylinder ones.*
- Q. I see. If I asked you today whether you could tell me concretely whether any of those are Dyson vacuum cleaners, what would you say?*
- A. I would know that No. I is definitely a Dyson. The other ones I would say are not Dyson, but I cannot tell you what make they are.*

109. The vacuum cleaner Mr Cook identified as a Dyson vacuum cleaner was made by Dyson.

110. Mr Carr showed Mrs Edwards the same photograph. He asked her to imagine that she had seen these cleaners in a shop in 1996 and that she had noticed the clear bin. He then asked her who she thought would have made them. The witness answered "Dyson". An extract from my own subsequent dialogue with the witness is shown below:

- Q. If you were telling one of your friends how they should recognise a bagless cleaner and distinguish those from the traditional bagged cleaners, when they went into a shop, other than by reference to the brand names, what would you tell them to look for?*
- A. I would say to look for the clear bin.*
- Q. I see.*
- A. The transparent bin, yes.*

- Q. Would you say the clear bin was one where you would identify the bagless cleaner?*
- A. Most definitely. Most definitely.*
- Q. Would that have been the case in 1996?*
- A. Yes.*
- Q. Obviously, it is still the case now?*
- A. Yes.*
- Q. Are you aware that other people have now produced ----*
- A. I did actually. I was looking through a catalogue. I noticed it was a different name. I actually remember saying, "Oh they've jumped on the bandwagon gone to Dyson". I did actually say that.*
- A. Yes.*
- Q. You would nevertheless still regard all those vacuum cleaners as Dysons today?*
- A. Yes. If I looked at the cylinder, yes. I honestly thought that was sort of the patent anyway, sort of the clear cylinder. I know it was the two cyclones, and that, but I thought that was sort of part of the patent as well.*
- Q. Why do you mention the patent?*
- A. You know when somebody brings out a new product.*

111. Mrs Bond was also shown the photograph mentioned above. Mr Carr also asked her to imagine that she had seen these vacuum cleaners in a shop in late 1996, and to suppose that she had noticed the clear bin. He then asked her who, if anyone, she would have thought made the four vacuum cleaners in the photograph. The witness answered "Dyson".

112. Mr Carr continued his questioning of the witness as follows:

- Q. How would you describe a Dyson vacuum cleaner to a friend who knew nothing about them?*
- A. Well, I did recommend them to my friends and family. I described it as something that looked ultra-modern to me. It was really different to anything I had ever seen, and this wonderful clear bin on it. You could see how it was working, how much dust you had picked up and when it was full. I liked it very much.*

113. I subsequently asked the witness whether she would still today expect the four vacuum cleaners shown in the photograph to be made by Dyson. She answered that they looked like a Dyson. She thought that one was a Dyson (which it was). She was unsure about the other three (which were not).

The de facto Monopoly Point

114. I was left with the impression that the witnesses' association of the transparent collection bin with Dyson in 1996 was as a result of their association of that feature with bagless cyclonic vacuum cleaners, and their association of that type of vacuum cleaner with Dyson. There has been numerous instances in the past where the name of a new type product becomes temporarily associated in the minds of some of the public with the first undertaking to bring that product to the market. The English courts have been slow to accept that this sort of association amounts to recognition of the sign in a trade mark sense: see, for example,

McCain International v Country Fair Foods [1981] RPC 69. The same reasoning can apply

where the sign in question is not the name of the new product but a means of visually distinguishing it from the pre-existing technology. I believe that the witnesses' association of the transparent collection bin with Dyson's cyclonic bagless vacuum cleaners falls into this category.

115. The applicant would say that the reason that some witnesses may now associate the transparent bin with bagless vacuum cleaners per se is because other manufacturers have copied Dyson's clear bins since the date of the application. I reached the conclusion in considering the *prima facie* objections to the marks, that the transparent bin was a highly effective way of designating the type of cleaner involved, and that the feature had other functional benefits. I believe that that view is consistent with the evidence. If it is right, there would be obvious reasons for other manufacturers to adopt transparent collection bins when bringing competing bagless vacuum cleaners to the market, which had nothing to do with identifying those products as Dyson cleaners.

Conclusion on the Claim of Acquired Distinctiveness

116. As I noted earlier, the ECJ has confirmed that the matter must be judged on the basis of the presumed expectations of an average consumer of the goods concerned who is reasonably well informed, observant and circumspect. In my view, such a consumer would recognise that a feature which identifies a new type of vacuum cleaner, and which is functional, is not a **trade mark** that identifies the goods of a particular undertaking. At the very least such a consumer would not regard such a sign as a trade mark until the proprietor had taken steps to educate the consumer to that perception, and that would be very unlikely to occur before the product had been on the market for a lengthy period.

117. In this connection, it is highly relevant that vacuum cleaners bearing the marks had only been on the market for some three years and eight months prior to the relevant date, and the applicant is unable to point to any promotion of the transparent collection bin as a trade mark during that period. As the ECJ stated in the Windsurfing case, the expectation that the goods originate from a particular undertaking must be "*because of the trade mark.*" It is difficult to see how that could be the case where there has been no use of the signs applied for as trade marks prior to the relevant date.

118. Mr Carr argued on the basis of **Chocosuisse v Cadbury** [1998] RPC 117, that it was sufficient if the signs in question had a perceived distinctive quality. The judge in that case was not considering a trade mark case at all. He was considering a claim based upon the extended form of passing off. The facts were very different to those in this case.

119. The ECJ has recently re-stated the position it took in Windsurfing in the course of giving its judgement in the Philips v Remington case. Although the court accepted that it may be possible to demonstrate the acquisition of trade mark character during a period in which a party is the only supplier of goods to the market, it emphasised (in paragraph 65 of its judgement) that this must be because "*the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark.*" There is no evidence of that.

120. For the reasons given above, I have come to the conclusion that the applicant has not discharged the onus which is upon it to demonstrate that the trade marks applied for had acquired a distinctive character through use before the date of the application.

Discrimination

121. Mr Carr drew my attention to **Reg v Licensing Authority** [1990] 1 AC, a judgement of the House of Lords, in which consideration was given to the obligations of a statutory body with a very wide area of discretion - the licensing authority which grants product licences in respect of pharmaceuticals. Lord Templeton observed (at page 103 of the report) that the authority had a duty to treat all applications fairly and equally. He said this in the course of a judgement about whether the authority had the right to rely upon confidential information provided by the patentee of a drug, when determining whether to grant other licences for the drug under the Medicines Act 1968.

122. Mr Carr submitted that similar principles applied to the Registrar. In this connection, he drew my attention to the acceptance by the Registrar of a number of other trade marks consisting of a colour or colours in respect of a range of different goods and services. He argued that unless there was a fair and rational basis for distinguishing between these applications and the one before me, this application should be allowed to proceed.

123. In my view, Mr Carr's submission is wrong in principle and in fact. It is wrong in principle to consider whether a trade mark is registrable by reference to the facts of other cases. The Registrar has a duty under section 37 of the Act to decide whether an application meets the requirements for registration laid down in the Ac. Unlike the licensing authority, the Registrar does not have a wide area of discretion. The Registrar must make a judgement as to whether the application meets the requirements for registration, taking account of the evidence filed in support of it. Registrability should not be determined on a relative basis by weighing the merits of one mark, and the evidence in support of it, against the merits of different trade marks, and the evidence on those applications.

124. If authority be needed to support this position, it is to be found in **Treat** [1996] RPC 281, where Jacob J. stated that the state of the register is, in principle, irrelevant to the question of whether a particular trade mark should or should not be registered. The Court of First Instance has rejected similar arguments in respect of Community trade marks on at least five separate occasions, the last time on 27 February 2002 in case T-106/00, **Streamserve v OHIM** (paragraphs 66-68).

125. As to the facts, the trade marks on Mr Carr's list are all colour marks registered for different goods and services. I have already explained why I do not consider the applicant's marks to be analogous to a colour mark. I see no point whatsoever in considering the merits and evidence on other applications for different types of mark, and for different goods and services.

Outcome

126. The application is refused because the trade marks do not meet the requirements for

registration laid down in section 3(1)(a) of the Act, and are excluded from registration by paragraphs (b) and (c) of section 3(1). Further, the applicant has not proven that the trade marks had acquired a distinctive character through use prior to the relevant date, and cannot therefore rely upon the proviso to section 3(1).

Dated this 23RD Day of July 2002

**Allan James
For the Registrar**