

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2244225
BY SCHOTT DESAG ATKIENGESELLSCHAFT
TO REGISTER A TRADE MARK IN CLASSES 9 AND 21**

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DECISION AND GROUNDS OF DECISION

1. On 1 September 2000 Schott Desag Atkiengesellschaft of Huttenstrasse 1, D-31073 Grunenplan, Germany applied under the Trade Marks Act 1994 to register the mark **ATHERMAL** in respect of:

Class 9: Optical glasses, especially glasses for safety goggles and welding protection glasses

Class 21: Glass and glassware

2. Objection was taken under paragraphs (b) and (c) of Section 3(1) of the Act because the mark consists of the word "Athermal" being devoid of any distinctive character for and a term that other traders may legitimately wish to use for e.g. goods relating to or produced by an athermal manufacturing process.
3. At a hearing at which the applicants were represented by Mr T Gold of Kilburn & Strode their trade mark agents, the objections under Section 3(1)(b) and (c) of the Act were maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.
4. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(b) and (c) of the Act reads as follows:

"The following shall not be registered-

- (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".

5. By letter of 25 October 2000 the agent requested information which supported the objection raised under Sections 3(1)(b) and (c) of the Act.
6. In response on 31 October 2000 the agent was provided with references from the Internet which showed use of the term applied for.
7. One such reference was taken from the applicant's own website and refers to athermal characteristics of phosphate based laser glass. The Internet references show use of the term in relation to laser glass but I see no reason why the term may not be used to describe other heat resistant glass products.
8. A copy of the references is at Annex A of this decision.
9. A copy of the extract from the applicant's own website is at Annex B of this decision.
10. In addition, by letter of 9 December 2000 the agent offered to exclude goods made by an athermal process or having athermal properties from the specification.
11. The relevance of the references provided was not addressed by the agent in correspondence or at the subsequent Hearing.
12. At the Hearing the agent demonstrated that the term was being used as a trade mark by the applicant and this reference is at Annex C of this decision.
13. In addition the agent argued that in view of the specialist nature of the goods covered by the specification filed, the average consumer of such goods would perceive the term as a trade mark indicating trade origin rather than a descriptive term indicating a characteristic of the goods.
14. I was not persuaded by this argument and take the view that the mark <ATHERMAL' would be seen by the average consumer as an indication of goods with the essential characteristics of reflecting radiated heat and reducing heat and as the opposite to the term "thermal" which is defined as "of, relating to, caused by, or generating heat or increased temperature" (Collins English Dictionary 5th Edition 2000).
15. It will not be seen as an indication of trade origin because the mark clearly denotes a characteristic of the goods and because of this it is therefore excluded from registration under Section 3(1)(c).
16. In this decision I have taken into account the guidance provided by the European Court of Justice in the "BABY-DRY" Case C-383/99P on the scope and purpose of Article 7(1)(c)

of the Community Trade Mark Regulations (equivalent of Section 3(1) of the Trade Marks Act).

17. Paragraphs 37, 39 and 40 of the judgement are reproduced below:-

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. 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. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

18. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I have already taken the view that the mark at issue comprises a word which, prima facie, cannot distinguish the applicant's goods from those of other undertakings. Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods.
19. For the same reasons I consider the mark to be devoid of any distinctive character and therefore not acceptable for registration under Section 3(1)(b) of the Act.
20. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this

day of July 2002

Ian Peggie
For the Registrar
The Comptroller General