

IN THE MATTER OF THE 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**

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1. On the 1<sup>st</sup> September 2000 Schott Desag Atkiengesellschaft (“the Applicant”) applied to register the mark ATHERMAL in respect of the following goods:
  - Class 9: Optical glasses, especially glasses for safety goggles and welding protection glasses
  - Class 21: Glass and glassware.
2. The Registry took objection to the application under section 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”).
3. On the 25<sup>th</sup> October 2000 Kilburn & Strode, the trade mark agents acting for the Applicant, requested information which supported the objections raised. In response, the Registry provided references from the Internet, including one taken from the Applicant’s own website.

4. The matter proceeded to a hearing at which the objections were maintained. The Hearing Officer had no evidence of use before him and he had, therefore, only the prima facie case to consider. By a written decision dated the 4<sup>th</sup> July 2002 he decided the application must be refused because it failed to qualify under section 3(1)(b) and (c) of the Act. He reasoned as follows:

*"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 5<sup>th</sup> Edition 2000)."*

The Hearing Officer then cited the guidance provided by the European Court of Justice ("the ECJ") in Case 383/99P *Procter & Gamble v. OHIM (BABY DRY)* [2002] RPC 17, and in particular paragraphs 37, 39 and 40 of the judgment. He continued:

*"18. These paragraphs indicate that only marks which are no different from the usual way of designating 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 could 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."*

5. The Applicant gave notice of appeal to an Appointed Person under section 76 of the Act. At the hearing of the appeal the Applicant was represented by Mr.

T. Gold of Kilburn & Strode and Mr. A. James appeared on behalf of the Registrar.

**Section 3(1)(c)**

6. In BABY DRY the ECJ made it clear that the purpose of the prohibition under section 3(1)(c) of the Act is 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, cannot fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function (paragraph 37). Further, the signs or indications which are prohibited are 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 (paragraph 39). The determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance (paragraph 42).
  
7. The Applicant submitted that the word ATHERMAL, albeit not invented, is nevertheless extremely unusual. I was referred to the Collins English Dictionary, 5<sup>th</sup> Edition 2000, and the Shorter Oxford English Dictionary, 2002. In neither of these does the word ATHERMAL appear. There are two entries in the Chambers Science and Technology Dictionary, namely for "athermal solutions" and "athermal transformation". The former means solutions formed without production or absorption of heat on mixing the components. The latter

means a reaction in which thermal activation is not required. Neither contains a reference to glass.

8. On behalf of the Registrar it was pointed out that although the word ATHERMAL may not appear in the general dictionaries, the word thermal is well known and understood and, further, there are references in the dictionaries to the letter 'a' as a prefix which, for example, in the Collins Dictionary is identified as a prefix which means "not", "without" or "opposite to". The examples 'atonal', and 'asocial' are given.
9. These were not the only materials before the Hearing Officer. He also had the benefit of a number of references obtained on the Internet search.
10. The first related to an associated company of the Applicant, Schott Glass Technologies Inc. This company has used the word ATHERMAL to describe its laser glass. In particular, it issued a product and applications leaflet referring to its phosphate based laser glass as having "athermal characteristics". It seems to me that these goods do fall within the scope of the application insofar as registration is sought in respect of glass in Class 21.
11. The second item found on the search and relied on by the Hearing Officer is a promotional leaflet relating to devices called STC Series Collimators produced by a company called Santa Barbara Infrared. These collimators are described as having an "athermal design" which gives them immunity from the effects of ambient temperature changes. The athermal design is also said to allow

boresight accuracy to be maintained over widely varying temperatures. These devices apparently incorporate a series of mirrors and are used for infrared system testing. I believe they do fall within Class 9, although not within the specification of goods the subject of the application.

12. Finally, the Hearing Officer also had regard to the use of the Applicant. It has clearly used the mark *ATHERMAL* as a trade mark in relation to welding protection glass. But it was pointed out on behalf of the Registrar that the Applicant has described such glass as having a gold mirror coating which reflects 90% of the infrared radiation (radiated heat) and particularly reduces the heat to which the eyes are exposed.
  
13. In the light of all these materials, I have come to the conclusion, albeit not without some hesitation, that the Hearing Officer was wrong to maintain the objection under section 3(1)(c). The specification of goods covers specialist glasses, such as laser glass in Class 21 and technical equipment and similarly goods of a technical nature in Class 9. This has a bearing on the average consumer of such goods, who must be assumed to be a person with some technical knowledge and understanding. Nevertheless I accept the submission made on behalf of the Applicant that, applying the *BABY DRY* test, the materials before the Hearing Officer do not establish that the word *ATHERMAL* is a word which is normally used to refer to the goods. Similarly they do not establish that the word *ATHERMAL* is used in common parlance to represent the essential characteristics of the goods.

### Section 3(1)(b)

14. In “*Cycling IS ...*” *Trade Mark Applications* [2002] RPC 37 Mr Geoffrey Hobbs QC, sitting as the Appointed Person, explained that section 3(1)(b) and section 3(1)(c) of the Act provide different objections and that signs which are not wholly descriptive may nevertheless not be regarded as distinctive. Mr Hobbs reached the same conclusion in “*SURFUNLIMITED*” *Trade Mark*, a decision of 31<sup>st</sup> October 2002, having taken account of the decision of the ECJ in *COMPANYLINE*, Case C-104/00, dated the 19<sup>th</sup> September 2002.

15. In the case of *Philips Electronics NV –v- Remington Consumer Products Ltd* [2003] RPC 2 the ECJ explained what distinctive character means, at paragraph 47:

*“First, it is clear from Art.2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”*

16. On the materials before me, I have come to the conclusion that the mark ATHERMAL fails to satisfy this test in relation to any of the goods the subject of the application. I think it likely that the average consumer of technical goods falling within the scope of the specification applied for would be well aware of both the word thermal and the use of the letter “a” as a prefix to denote “the opposite”, “not” or “without”. These are so well known that I believe that the mark ATHERMAL would instantly be recognised by the average consumer as a combination of the two. I accept that the word

ATHERMAL has not been shown to be used in common parlance, but nevertheless I think that the consumers would be so familiar with the components of the mark that they would take the mark as a whole to denote that the goods to which it is applied are unaffected by heat or are heat resistant.

17. I feel supported in this conclusion by the materials revealed by the Internet search which show the circumstances in which the word AATHERMAL has been used in relation to goods falling within the specification applied for or in relation to similar goods. All of these uses indicate to me that the word AATHERMAL would be understood by the average consumer to be referring to the goods and their capacity to deal with heat.
18. In my view the average consumer of glass for technical applications and optical glasses, such as glasses for safety goggles and welding protection glasses, would not regard the combination AATHERMAL as sufficiently striking to function as an indication of trade origin. I do not believe that the average consumer would conclude that all such goods bearing the mark AATHERMAL originated under the control of one proprietor.
19. For all these reasons I have reached the conclusion that the Hearing Officer's rejection of the application for registration must be upheld.

David Kitchin QC

24 February 2003