

TRADE MARKS ACT 1994

5 **In the matter of application no 2234614**
by Pilkington plc
to register a trade mark in Class 19

10 **DECISION AND GROUNDS OF DECISION**

On 2 June 2000, Pilkington plc of Prescott Road, St Helens, Merseyside, WA10 3TT, applied under the Trade Marks Act 1994 to register the trade mark **GI@ss** in Class 19 of the register in respect of:

15 Building materials; glass, toughened glass, laminated glass, coated glass, radiation
shielding glass, body tinted or body coloured glass; windows; articles made wholly or
principally of glass; panels and screens made wholly or principally of glass; doors;
porches; conservatories; multiple glazing units; structural glazing units; structural glass
20 assemblies; parts and fittings for all the aforesaid goods; all the aforesaid goods for
building purposes.

Objection was taken to the mark under Section 3(1)(b) of the Act on the grounds that it was essentially the word “Glass” and was therefore devoid of any distinctive character for, eg,
25 glass and glass products.

At a Hearing at which the applicants were represented by Mr A C Halliwell the objection was maintained and the application refused under Section 37(4). Following that refusal, 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 my decision and the materials used in arriving at it.
30

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(b) of the Act reads:-

35 “The following shall not be registered-
(b) trade marks which are devoid of any distinctive character.”

The mark in question is **GI@ss**. This does not, as far as I am aware, appear in any dictionary, but I take it to be a trifling variation of the word **Glass**. This is such a well-known word in
40 everyday use, that I do not need to define it further. It is clearly descriptive of the goods for which the applicant seeks registration.

However, the mark is not written simply as the dictionary word **Glass**, but is written **GI@ss**, the letter ‘a’ being replaced by the symbol ‘@’. I am aware that this symbol is commonly used
45 in electronic communications. I am unable to find a reference to it in any printed publication, but the Online Computing Dictionary at the web site www.InstantWeb.com describes it as a “commercial at” sign, and defines it as “The sign used in an electronic mail address to separate

the local part from the hostname”. I am familiar with this use in, for example, my own electronic mail address, which is roger.evans@patent.gov.uk. Indeed, at the hearing the agent argued that the mark was a covert and subtle allusion to electronic commerce in glass and glass products. However, the mark is clearly not presented as an electronic mail address. I confirmed that I believed the mark to be so close to the descriptive word **Glass**, that the Section 3(1)(b) objection was valid.

In support of this, I rely on the decision of Mr Justice Jacob in the TREAT case [1996] RPC 281. He considered that “devoid of any distinctive character” required a mark to be considered on its own, assuming no use, and that the phrase referred to words (or other signs) “which cannot do the job of distinguishing without first educating the public that it is a trade mark.” I believe this mark is just such a sign. Although the presentation of the word **Glass** is not as it appears in the dictionary, I do not believe it is sufficiently different from the dictionary word to be recognised as a distinctive trade mark in the prima facie case. The ‘@’ symbol is only a very minor variation to the spelling of an ordinary dictionary word, which I have already said is descriptive of the goods. I believe therefore that **GI@SS** will be seen and pronounced in exactly the same way as the true spelling of the word **Glass**, and that it will fail to have any impact as anything other than a description of the goods.

Regarding the presentation of the mark, I also take note of the summary of a decision by the German Appeal Senate (GRUR 1996 Vol 5), relating to the stylised “Color Collection” mark:

“According to a decision of the twenty-fourth senate, the graphic form of words incapable of protection may provide the necessary distinctiveness only if it provides a “surplus” which justifies protection. The necessary extent of the “surplus” would then depend upon the descriptive nature of the words in question. To that extent the pictorial design of a word mark would be less likely to provide its distinctiveness the more clearly a directly descriptive reference to the goods or services claimed could be recognised..”

I perceive the mark to be little more than a trivial variation on the very descriptive word **Glass**, with little “surplus” to enhance its registrability. I therefore find the mark is not acceptable under Section 3(1)(b) as it is devoid of any distinctive character for glass and glass products.

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 Section 3(1)(b) of the Act.

Dated this 26th day of March 2001.

ROGER G EVANS
For the Registrar
The Comptroller General