

TRADE MARKS ACT 1994

**In the matter of application no.2109511
by Yates Investment Casting Wax Inc
to register a Trade Mark in Class 1**

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**IN THE MATTER OF APPLICATION TO REGISTER
TRADE MARK NO 2109511 IN CLASS 1 IN THE NAME
OF YATES INVESTMENT CASTING WAX INC**

On 6 September 1996, Yates Investment Casting Wax. Inc, of 1615 West 15th Street, Chicago, Illinois 60008, United States of America, applied under the Trade Marks Act 1994 to register the trade mark ECOWAX in respect of:-

Chemicals for use in industry; chemical preparations; acrylic waxes for industrial use in an investment casting process.

Objection was taken under paragraphs (c) of Section 3(1) of the Act on the grounds that the mark consists of the combining form ECO (denoting ecology or ecological) and the non-distinctive word WAX being a term which other traders may legitimately wish to use on environmentally friendly wax products.

At a hearing at which the applicants were represented by Miss Rebecca Weeks, of Haseltine Lake Trademarks, their trade mark agents, the objection under Section 3(1)(c) was 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 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

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

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

3(1) The following shall not be registered -

(c) trade marks which consist exclusively of signs or indications which may serve, in the trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of the goods or services.

The mark consists of the words "ECO" and "WAX" in plain characters, and although formed into an ellipse the words are clearly evident. For ease of reference I have inserted an example of the mark below:-



At the hearing Miss Weeks argued solely on the registrability of the word and did not seek to persuade me that the stylisation was sufficient to qualify the mark for registration. For the record I take the view that the stylisation does not add the necessary surplus to qualify for registration. The Registrars practice on ECO marks is as follows:

ECO A combining form which is defined in Collins English Dictionary as denoting “ecology” or “ecological” and which is widely used in relation to the study of the environment or environmentally “friendly” products. Object under Section 3(1)(c) when appropriate.

Collins English Dictionary (Third Edition Updated 1994) provides several meanings for the words **ECO** and **WAX**, the most relevant being:-

ECO combining form. Denoting ecology or ecological: ecocide; ecosphere.

WAX any of the various viscous or solid materials of natural origin; characteristically lustrous, insoluble in water, and having a low softening temperature; any substance or object that is pliable or easily moulded.

In relation to the goods of this application I take the view that the majority of people in this country would understand ECO to be an abbreviation for the word ECOLOGICAL. In correspondence following the hearing, Miss Weeks provided promotional material showing how the applicants use the mark, stating in her letter “.the ECOWAX product has much better environmental qualities than similar products.”. The promotional material itself describes the goods sold under the ECOWAX mark using statements such as “Ecological technology for the environment”, “ecologically friendly pattern wax technology” and “environmentally friendly pattern wax technology”. From this it is evident that the applicants promote the goods as being environmentally or ecologically friendly, and also, that the term “WAX” is purely descriptive of the goods. A copy of the brochure is attached as an annex to this decision.

The applicants have not disputed that the separate elements of the mark are descriptive of, and denote the characteristics of the goods upon which it is used, relying instead on the argument that in combination they create a distinctive whole. I take the view that most people would understand the term ECO and WAX in combination as an abbreviation for an “ecological wax” or an “ecologically friendly wax” product. The bringing together of the two words does not in my view create any distinctiveness or hide the descriptive nature of the mark. It appears to me, therefore, that the mark consists exclusively of a sign which may serve, in trade, to designate the kind of goods at issue, and so does not qualify under Section 3(1)(c) of the Act.

I have already indicated my view that combining the two words ECO and WAX does not create distinctiveness. In the EUROLAMB case 1997 RPC 8 at page 287 Geoffrey Hobbs QC said:

5 “My view on what I regard as the critical point is that the word “EUROLAMB” would
be understood by persons encountering it, used in relation to the goods of interest as
defined by the specification, as being an abbreviation of the longer expression “European
Lamb”. I therefore think that the word “EUROLAMB” is no more and no less registrable
10 than the words “European Lamb”. My view is that the words “European Lamb” would
not be registrable. I therefore think that the objections which have been raised under
Section 3(1)(b) and 3(1)(c) of the 1994 Act should be upheld in this particular case, there
being no evidence of use which might be said to have educated the public to a different
perception of the word”.

15 It is my view that the mark is directly descriptive of the goods applied for, or a characteristic of
such goods. It therefore appears to me that ECOWAX is a sign which may serve in the trade to
designate the intended purpose of the goods at issue, and is therefore debarred from registration
by Section 3(1)(c) of the Act. I should make it clear that the only objection taken by the Registrar
and heard by me was under Section 3(1)(c) of the Act. However, having found the mark to be
20 directly descriptive of the goods applied for, it does I believe follow that it is devoid of any
distinctive character, the same as if objection had been taken under Section 3(1)(b). I recognise
that this is not an entirely satisfactory way of handling the matter but I believe that the registrar's
failure to take an objection under one heading does not prevent him taking objection under
another if that objection is also relevant under that other heading. In my view any sign which is
25 excluded from registration by Section 3(1)(c) of the Act is, prima facie, devoid of any distinctive
character under Section 3(1)(b).

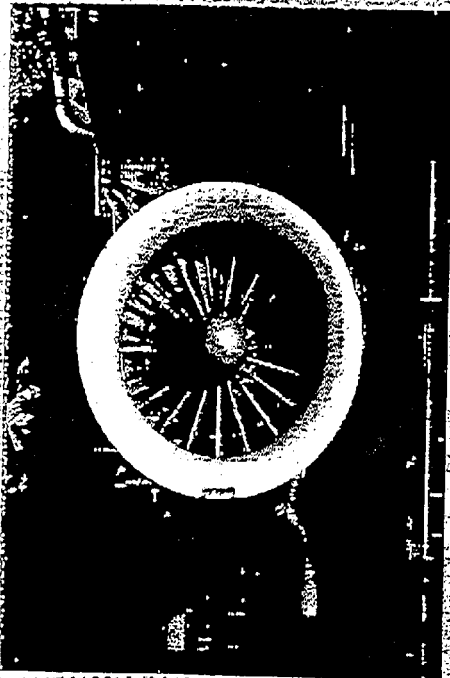
30 In this decision I have considered all the documents filed by the applicant and all the arguments
submitted to me in relation to this application and, for the reasons given, it is refused under the
terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) & (c) and
Section 5(2) of the Act.

35 Dated this 23 day of December 1998.

40 **MIKE FOLEY**
For the Registrar
The Comptroller General

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YATES

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Ecowax™ Environmentally Advanced...

- Contains no isocyanates or heavy metals
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Benefit: Better combustion properties during burnout cycle, cleaner molds, improved productivity
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