

IN THE MATTER OF AN APPEAL TO  
THE APPOINTED PERSON  
AND IN THE MATTER OF THE TRADE  
MARKS ACTS 1938 AND 1994  
AND IN THE MATTER OF  
APPLICATION Nos. 1510886 and 200012  
BY GANDER MUSIC LIMITED TO  
REGISTER THE MARK MESSIAH FROM  
SCRATCH IN CLASS 41.

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**DECISION**

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1. This is an Appeal to the Appointed Person by Gander Music Limited, the Applicants for registration of two registered trade marks each consisting of the words "**Messiah From Scratch**" in Class 41.
2. The first application is numbered 1510886. It was applied for on 8th July 1992 under the Trade Marks Act 1938 in respect of "Organisation of musical entertainment services; advisory and consultancy services all relating to the aforesaid services; all included in Class 41. The application was subsequently assigned to Gander Music. The application was supported by a statutory declaration dated 18th November 1996 by Donald Martin Monroe, a director of Gander Music, and as a result of this evidence, the application was advertised before acceptance pursuant to section 18(1) of the Trade Marks Act 1938.
3. The second application (No. 200121) was filed on 31st October 1994, the trade mark and the description of services was the same but it was applied for pursuant to the provisions of the Trade Marks Act 1994. This application was accepted by the Registrar and published on 7th June 1995.
4. No oppositions were entered to the registration of either of these marks. However 77 written observations on the proposed registration of the trade

mark were received from members of various organisations and persons engaged in the entertainment field. As a result, the Registrar concluded:

- (a) in relation to the 1938 Act mark, that he would not accept the mark and
- (b) in relation to the 1994 mark that, having regard to the matters coming to his notice since he accepted the application, that he had accepted it in error. See Section 40(1) of the 1994 Act.

5. The Applicants accepted that it was within the power of the Registrar to take either of these courses but contended that he was wrong to do so and sought a hearing. The hearing took place before Mr. Alan James, the Officer acting for the Registrar, on 26th January 1998. The Applicants were represented by Counsel and by Trade Mark Agents. In that decision, Mr. James considered first the trade mark applied for under the 1938 Act in accordance with the provisions of that Act and then turned to consider the mark applied for under the 1994 Act and considered whether, under those provisions, that mark should be registered. In both cases he concluded that the mark did not satisfy the requirements of the relevant Acts and it is against that decision that Gander Music Limited appeals.
6. The Appeal came on for hearing before me on 6th May 1999 and the Appellants were represented by Professor Donald Monroe, a director of Gander Music, and the deponent in the Statutory Declaration of 18th November 1996.
7. He focussed his submissions to me primarily on the second mark and the 1994 Act. He sought to draw no distinction between the criteria for registration under the two Acts as applied to the facts of this case and neither did Mr. James, who appeared on the appeal for the Registrar. A similar position was taken at the hearing before him (see his Decision page 17 line 25-26). Although in his Decision Mr. James started with the 1938 Act,

having regard to the submissions of Professor Monroe, I propose to deal first with the application pursuant to 1994 Act.

8. The reason why Professor Monroe sought to focus upon the 1994 Act was because he indicated to me that he perceived there to be a difference in emphasis between Section 10 of the 1938 Act and Section 3(1)(b) of the 1994 Act.
9. Section 10 makes it a requirement for registration that, for a trade mark to be registrable in part B of the Register, it must be capable in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists whereas Section 3(1) (b) prohibits registration of a mark which is "devoid of any distinctive character". (emphasis added).
10. Professor Monroe drew my attention to the distinction between the requirement in section 10 that a mark be capable of distinguishing in order to be registered and the prohibition in section 3 against registration of any mark that was devoid of any distinctive character. He submitted that the law had been relaxed and that it was only marks which were wholly devoid of any distinctiveness which could be refused registration. In particular, he contended that the words "**Messiah From Scratch**" were not devoid of any distinctiveness.
11. I cannot accept this. Section 3(1)(b) has to be construed in the context of the Act as a whole, bearing in mind the origins of that Act in Council Directive 89/104/EEC of 21st December 1988. More specifically, it has to be read within the context of Article 3 as a whole. Article 3(1)(a) prohibits from registration any sign which does not meet the requirements of section 1 of the Act. Section 1 provides:

*"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".*

Further, the proviso to Section 3(1) permits registration of a trade mark which falls foul of section 3(1)(b), (c) or (d) 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.

12. These interlocking provisions were the subject of consideration in the recent judgment in the Court of Appeal in ***Philips Electronic N.V. v. Remington Consumer Products Limited*** (unreported 5th May 1999). Although this judgment was referred to at the hearing, it was not the subject of any detailed observations. Nonetheless it is binding upon me and, for what it is worth, represents conclusions I would have come to in the absence of its binding effect in the light of previous decisions. However the existence of the ***Philips*** decision makes it unnecessary to refer to any other cases.
13. In his judgment in the ***Philips*** appeal, Aldous L.J. makes it plain that section 3(1)(a) is an overriding provision which prevents registration of a mark which is so descriptive or so lacking in content capable of performing the function of a trade mark that it cannot be registered. Section 3(1)(b) prevents from registration, without proof of distinctiveness, trade marks which are not so wholly lacking in trade mark content as to be registrable at all but which, without evidence of use, do not display a sufficiently distinctive content.
14. The distinction which Professor Monroe sought therefore to draw by contrasting the language of section 3(1)(b) with that of section 10 of the 1938 Act is wrong in law.

15. I must therefore consider whether, as at the date of application in 1994, the trade mark "**Messiah From Scratch**" was devoid of any distinctive character within the meaning of section 3. Professor Monroe submitted, correctly, that I must have regard to the mark as a whole and that it was wrong to dissect the mark into its individual components since it did not follow that because each component of the mark was of itself descriptive that the composite mark would be also. In an appropriate case, where the individual words or parts of a mark are descriptive, but the whole is not, appropriate disclaimers can be proposed pursuant to section 13 of the Act.
16. Nonetheless, it is permissible to have regard to the signification of the individual words making up the mark in order to determine whether the mark as a whole has a sufficient distinctive character.
17. This is a course which Mr. James adopted in his decision when considering the equivalent question under the 1938 Act. He stated :

*"It is well established that in considering whether a trade mark meets the requirement for registration the mark should be considered as a whole. However, it is clear from the condition of registration referred to above (and from the Applicant's evidence) that the word Messiah appearing in the trade mark is wholly descriptive. The case for registration must therefore depend substantially upon whether the addition of the words "**From Scratch**" to this pure description results in a trade mark which is either prima facie capable of distinguishing the Applicant's services or which has come to distinguish the Applicant's services because of the use that has been made of it.*

*I will consider the prima facie case first. Collins English Dictionary defines the term "from scratch" as an informal term meaning "from the very beginning". Chambers English Dictionary defines the term "start from scratch" as a figurative term meaning*

*"to start at the beginning". The Shorter Oxford Dictionary indicates that one of the meanings of the words "scratch" is as an adjective meaning "hastily assembled or put together".*

*This latter definition is in line with the comments made in some of the observations mentioned above, that the word "scratch" has for many years been used as a description of a hastily assembled orchestra. The Applicant's do not dispute that the term "scratch orchestra" has been used in the manner suggested above".*

*(Decision 13 lines 4-22).*

He concluded on page 13 line 35,

*"Having regard to the dictionary definitions given above, and what appears to me to be an analogous use of the word "scratch" in relation to orchestral performances, it appears to me that the words "from scratch" are an apt description of impromptu musical and concert performances".*

18. I should make two observations in relation to the above. First, Mr. James refers to the condition of registration which was required in relation to the 1938 Act application. This was a condition of registration that the mark should only be used in relation to performances of Handel's Messiah. Whilst it is to be noted that such conditions have ceased to have effect under the transitional provisions to 1994 Act, nonetheless I do not believe that it is impermissible to have regard to the fact that the Registrar required, and the Applicants were prepared to accept, a condition of this nature in order to allow the mark to be advertised.
19. Secondly, Mr. James refers to the observations. These are the 77 observations made subsequent to advertisement pursuant to section 38(3) of the 1994 Act. Professor Monroe attacked these observations in a number of significant respects. First, he pointed to the fact that they were observations which were not made on oath and which were not therefore susceptible of

being tested. Secondly he pointed to the fact that notwithstanding these observations nobody had come forward to oppose the registration of the mark in an orthodox manner. Thirdly he pointed, correctly in my view, to the fact that the filing of these observations was part of an orchestrated campaign arising out of dissatisfaction on the part of some members of the musical profession to bona fide attempts on the part of Gander Music to prevent what they saw as being unlawful attempts to use the trade marks in question under the law of passing off. I make no findings in this decision as to whether those allegations were justified. It is undoubtedly the case, however, that the making of them did result in the publication of a press release (exhibit DM8 to Professor Monroe's declaration), by an organisation known as Portfolio Management, directed by one Tano Rea, which was highly critical of the actions taken by Gander Music. Professor Monroe maintains that it was materially inaccurate, a matter I do not have to decide. Finally Professor Monroe quite properly drew attention to the fact that a majority of the observations were not directed to the trade mark "**Messiah From Scratch**" but from the use of the words "scratch" or "from scratch" in relation to musical productions.

20. In his decision Mr. James reviewed the contents of the observations from page 2 line 24 through to page 6 line 26. Professor Monroe suggested that the review was of those of the observations which were most favourable to the conclusion which Mr. James was reached. I have reviewed all of the observations and do not believe that the review conducted by Mr. James was unbalanced. The point made by Professor Monroe, to the effect that the observations concentrated on the words "From Scratch" and not on "**Messiah From Scratch**" is well made by the extracts cited by Mr. James. Accordingly I do not propose to repeat Mr. James' exercise in this decision. I accept and will proceed on the basis that the observations are not directed to the trade mark "**Messiah From Scratch**" but equally I am satisfied that Mr. James' observation that the word "scratch" has for many years been used as a description of a hastily assembled orchestra (page 13 line 20-21) is an

accurate finding of fact. Indeed, as he records, the Applicants did not dispute that before him and neither did Professor Monroe before me.

21. Apart from this, I have reached the following conclusions in relation to the observations:

(1) It must be correct for the Registrar to take these observations into account - the 1994 Act directs him to do so in section 38(3).

(2) The fact that no opposition has been entered will often be the case where observations are to be relied upon. Observations may however be given less weight than the sworn evidence of a witness in opposition proceedings which can, if necessary, be tested in cross examination.

(3) The weight that is to be attached to an observation is a matter which must depend upon the circumstances of each case.

(4) In the present case, I am not disposed to attach any weight to the observations other than in relation to the use of the term "scratch orchestra". I do this because I am satisfied that they were provided as part of an orchestrated campaign in circumstances where there is plainly a considerable degree of animosity between Gander Music and organisations which they have sought to prevent encroaching upon what they perceive to be the legal rights of Gander Music.

22. I return then to consider the question of whether "**Messiah From Scratch**" qualifies for registration notwithstanding the provisions of section 3(1)(b). In my judgment it does not. It was not, nor could it be, seriously disputed that the word Messiah when used in relation to musical entertainment would be taken as a reference to Handel's Messiah. I do not believe that it needs the aid of dictionary definitions to reach the conclusion that the suffix "From Scratch" would be taken as a being a reference as some form of unrehearsed

or impromptu musical performance. This likelihood is increased when one takes into account, as in my judgment it is to proper to do, the fact that the expression "scratch orchestra" was known in the music business as a description of an informal or irregular gathering of musicians.

23. I am thus satisfied that Mr. James was correct to hold that the mark "**Messiah From Scratch**" could not be registered pursuant to the 1994 Act otherwise than on proof of a distinctive character pursuant to the proviso to section 3 having regard to the use made of it.
24. I therefore turn to consider the use made of the mark by Gander Music and its predecessors. I do this by reference of the declaration of Professor Monroe and make it plain that I have not placed any weight upon any of the observations which suggested that the expression "**Messiah From Scratch**" may have been used on infrequent occasions (either before or after the first use by Gander Music) by others who were not licenced or approved by Gander Music. That evidence is, to my mind, altogether too flimsy. Insofar as Mr. James took into account the observations in this respect, I believe he was wrong to do so.
25. Before assessing the Applicant's use, it is necessary to identify the nature of the use that is being looked for. In *British Sugar plc v. James Robertson & Sons Limited* (1996) R.P.C. 281 at 302, in a passage cited by Mr. James, Jacob J. stated

*"I have already described the evidence used to support the original registration. You have really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that use equals distinctiveness. The illogicality can be seen from an example. No matter how much a manufacturer made use of the word soap as a purported trade mark for soap the word would not be distinctive of his goods. He*

*could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a product and be able to show massive use by him alone of that word for the product. Nevertheless the word is apt to be the name of the product not a trade mark".*

26. In ***AD 2000 Trade Mark*** (1997) R.P.C. 168, Mr. Geoffrey Hobbs Q.C., acting as the appointed person, stated as follows at page 174

*"The proviso to section 3(1) indicated that the essence of the objection to registration under section 3(1)(b) is immaturity; the sign in question is not incapable of distinguishing goods or services of one undertaking from those of other undertakings, but is not distinctive by nature and has not become distinctive by nurture".*

27. It is therefore necessary to consider not only the use but the nature of that use in order to ascertain whether the use, particularly when it is in the absence of competition from others, has been such as to "nurture" the mark into distinctiveness as a trade mark namely, as indicating origin in the applicant for registration.

28. Further, in the recent decision in the European Court of Justice in Luxembourg, in a reference from the Landgericht Munchen in Germany in the case of ***Windsurfing Chiemsee v. Boots-und Segelzubehor Walter Huber*** (4th May 1999), a case to do with a geographical designation, it was made plain (see paragraph 47) that where the geographical designation had gained a new significance so that its connotation was no longer purely descriptive, it may justify registration as a trade mark. In paragraphs 51 and 52, more general guidance was given as follow:

*"51. 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 longstanding 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 of chambers of commerce and industry or other trade and professional associations.*

52. *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 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 ...."*

29. Article 3(3) is in the same form of the proviso to section 3.
  
30. Taking all this into account, the correct course in a case such as the present, where the mark in question is prima facie devoid of distinctive character because it is descriptive of an unrehearsed performance of the Messiah, is to assess whether the use made of the mark by Gander Music over the years has been such as to give the mark a secondary signification as indicating not only an unrehearsed performance of the Messiah but also the unrehearsed performance of the Messiah coming from a specific organisation. In other words, the words "**Messiah From Scratch**" must have come to indicate to a substantial body of persons origin in the applicants' organisation (even if the public do not know the name of the organisation) and not merely an unrehearsed performance. As I understand the *Windsurfing* decision it is not necessary that the secondary meaning should have displaced the former meaning, it is however necessary that it has gained a sufficient new significance as indicating origin to justify registration so as to leave third

parties who wish to use the designation in its descriptive sense to rely upon the defence provided by section 11 of the Act.

31. With this in mind I turn to the evidence. Professor Monroe's declaration runs to some 28 pages and contains 13 exhibits. The Professor and his colleagues started to use the mark "**Messiah From Scratch**" in April 1974 when a partnership, predecessors in title to Gander Music, called the Tuesday Partnership, decided to promote the first concert at the Royal Albert Hall. It has always been used in relation to performances of the Messiah (not unnaturally) but also in relation to impromptu, substantially unrehearsed performances to which members of the public can apply for tickets either as performers, singers or orchestral players, or as part as a normal audience. It has thus always been used in relation to precisely the sort of event that the mark describes. Little attempt has been made in the advertisements or the brochures to educate the public into seeing the words "**Messiah From Scratch**" as being otherwise as a description of the type of event proposed. It is correct that there has been a reference in the small print to a claim of proprietorship in the mark but the primary use has retained a significant descriptive element.
32. In addition to the evidence of actual use, evidence was given of a survey carried out on behalf of Gander Music from which it appears, perhaps not surprisingly, that a number of people over the years have come to associate performances of Messiah from Scratch with Gander Music. In exhibit DM9 Professor Monroe analysed the questionnaires that he felt were supportive of this application into two categories. 8 were said to be totally supportive of the application and 19 were supportive in that they made reference to the events. He suggested that this was important evidence and particularly drew my attention to question 5.
33. That question enquired of people who had answered "yes" to the question "have you encountered the expression "**Messiah From Scratch**"?

- (a) *"How long have you known of the expression "**Messiah From Scratch**"?"*
  - (b) *What if anything does the expression "**Messiah From Scratch**" mean to you?*
  - (c) *With which company, if any and with what services, if any, do you associate the expression, "**Messiah from Scratch**"?.*
34. Of the 8 questionnaires which Professor Monroe suggested were totally supportive of his application, the answers to question 5(b) were as follows:
- (1) Linked with performances of Handel's Messiah where choir not rehearsed. Usually at Royal Albert Hall.
  - (2) Singing the Messiah with other amateur choirs without previous rehearsal at the Albert Hall under Sir David Willcocks.
  - (3) A performance of the work by an unconnected group of people without rehearsal.
  - (4) Performing "Messiah" without rehearsal, except on the day. Venue - Albert Hall.
  - (5) Handel's Messiah sung once with no rehearsal.
  - (6) A concert without rehearsals (sic).
  - (7) The performance of Handel's Messiah and other works by the audience without prior rehearsal.

- (8) An annual performance of Handel's Messiah at the Royal Albert Hall, unrehearsed - and open to all who wish to participate - the performance being in support of a named charity.
35. I observe that the last of these was a questionnaire answered by Sir David Willcocks himself, who had been the conductor of many of the performances.
36. The responses to question 5(b) by the others that were said to be supportive were to like effect.
37. Ten of the questionnaires were the subject of sworn statutory declarations confirming that the answers in the declarations were true. None of these declarations were sworn by any of the 8 whose questionnaires Professor Monroe suggested were totally supportive of the application. These 10 responded to question 5(b) as follows:
- (1) Without rehearsal.
  - (2) A performance of Messiah starting from nothing.
  - (3) A performance of "Messiah" by amateurs brought together on the day, without previous collective rehearsal.
  - (4) A performance of "Messiah" largely unrehearsed involving musicians and singers in the audience.
  - (5) A performance of the work with either only one or no rehearsal.
  - (6) One combined rehearsal (wholly or in part) then actual performance.
  - (7) A performance of Handel's Messiah performed with little or no rehearsal.

- (8) Unrehearsed performances of Handel's Messiah by amateur singers at the Royal Albert Hall.
  - (9) Concert to sing the Messiah in public without previous rehearsal.
  - (10) Starting from the beginning without any previous practice/knowledge.
38. In my Judgment, these answers are primarily supportive of the conclusion that the expression "**Messiah From Scratch**" has retained its descriptive connotations and do not support the conclusion that that meaning has been significantly displaced. The fact that a number of people in answer to question 5(c) do associate the expression with Gander Music, or its predecessor, the Tuesday Partnership, does not assist me in reaching a conclusion that they regard the mark as being an indication of origin rather than being descriptive of the type of performance.
39. Plainly the evidence goes some way to showing that the mark is developing a distinctive character but, taking into account the nature of the use, which I regard as being primarily descriptive, and the reaction to that use of people familiar with it, which is to indicate that to them it is primarily an indication of a type of concert, even if organised by a particular organisation, I have concluded, not without some hesitation, that the use is insufficient in nature and extent to render the mark of a sufficiently distinctive character for it to be registered pursuant to the proviso to section 3.
40. Although therefore I have reached this conclusion by a different route from Mr. James, and, in particular, have placed little weight on the observations, I would dismiss this appeal in so far as it relates to the 1994 Act mark.
41. I turn then to consider the application under the 1938 Act. This must be approached in accordance with the law under the 1938 Act. I must first

assess whether the mark is "capable of distinguishing" within the meaning of section 10. For the same reasons as were given in relation to section 3(1)(b) of the 1994 Act, I am satisfied that, prima facie, the mark was not capable of distinguishing within the meaning of section 10 of the Act and thus could only be registered pursuant to section 10(2)(b) if, by reason of the use of the trade mark, the trade mark is in fact capable of distinguishing.

42. To my mind this test is the same test as is incorporated in the proviso to section 3 of the 1994 Act. If the mark was not of sufficient distinctive character for the purposes of the 1994 Act in 1994, it cannot, in my judgment, have become capable of distinguishing for the purposes of section 10 of the 1938 Act in 1992 when the 1938 Act mark was applied for. Indeed, as indicated above, I did not understand Professor Monroe to contend to the contrary and believe he was right not to do so.
43. Accordingly the Appeal in relation to the 1938 mark is also dismissed.
44. As a long stop argument, Professor Monroe contended that if I was not wholly satisfied that his marks should be registered, the correct course was for me not to dismiss the appeals but to order that the marks should be re-advertised for opposition to enable the uncertainties to be resolved in the context of a formal opposition rather than by reference to the informal observations.
45. I expressed the view at the hearing that, certainly under the 1994 Act, I did not believe that the Registrar had such a power and, if he did not, I could not have. Mr. James expressed a provisional view in agreement but indicated that he felt that position under the 1938 Act might be different. I therefore directed that he should put in writing the Registrar's concluded view within 7 days and that, if he was so advised, Professor Monroe should respond thereto within 7 days thereafter.

46. By letter dated 7th May 1999, Mr. James stated the Registrar's view to be as follows:

*"I believe that the position under the 1994 Act is clearly set out in the decision of Laddie J. in the Creola Trade Mark case (1997) RPC 507 at page 510, lines 38-47 and page 511 at lines 33-40. A second advertisement under section 38 would be a nullity and there is no such provision under section 40.*

*The position under the new 1938 Act is slightly different because the earlier application to register "Messiah from Scratch" was advertised before acceptance under Section 18(1) of the old law. That provision gives the Registrar power to advertise the mark again when it has been accepted, although he is not bound to do.*

*Consequently the Registrar could be directed to advertise the earlier application a second time, but only as a condition of accepting the application on appeal. See Section 17(5) of the old law".*

47. Professor Monroe has not responded to that letter.
48. In the light of the conclusion which I have reached, namely that the marks do not qualify for registration, it is not necessary that I should reach any concluded view on the Registrar's powers with regard to re-advertisement. Since I have not had the benefit of full argument on this aspect of the case, I prefer not to do so.
49. In the event, the appeals will be dismissed. In accordance with the usual practice there will be no order as to costs.

Simon Thorley Q.C.

17th May 1999