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**TRADE MARKS ACT 1938(AS AMENDED)
AND THE TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application Nos 1510886
and 2000102 by Gander Music Limited to register
a trade mark in Class 41**

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10 BACKGROUND

On the 8 July 1992, the Tuesday Partnership applied under Section 17 of the Trade Marks Act 1938 for the registration of the trade mark MESSIAH FROM SCRATCH in Class 41 in respect of :

15 Organisation of musical entertainment services; advisory and consultancy services, all relating to the aforesaid services; all included in Class 41.

20 The application was numbered 1510886. The Registrar subsequently received notice that the application had been assigned to Gander Music Limited.

25 As a result of objections taken by the Registrar, during the course of ex-officio examination, the applicants filed a Statutory Declaration by Donald Martin Monro who is a Director of Gander Music Limited. This evidence indicated that the applicants had been using the mark MESSIAH FROM SCRATCH continuously since 1974.

30 As a result of this evidence the application was advertised for opposition purposes in Journal No. 6072 on the 26 April 1995. The advertisement was pursuant to the Registrar's powers under Section 18(1) of the Trade Marks Act 1938, whereby the Registrar may advertise an application before it has been accepted by him.

By the time of the advertisement the applicant had agreed to a condition of registration in the following terms:

35 "It is a condition of registration that this mark shall only be used in relation to performances of Handel's Messiah."

40 On the 31 October 1994, Gander Music Limited filed a further application for the trade mark 'MESSIAH FROM SCRATCH' under the Trade Marks Act 1994. This application was given the number 2,000,102. The specification of services was exactly the same as the earlier application filed under the Trade Marks Act 1938. The application was accepted by the Registrar and published for opposition purposes in Journal No. 6078 on the 7 June 1995.

45 As a result of the publication of these applications the Registrar received 77 written observations on the proposed registration of the trade mark MESSIAH FROM SCRATCH from members of the public and various organisations engaged in the entertainment field. As a result of these observations the Registrar indicated to the applicants that he was not prepared to accept the

application made under the Trade Marks Act 1938. He further indicated that having regard to matters coming to his notice since he accepted the application made under the Trade Marks Act 1994, he was also minded to refuse the later application. The applicants do not dispute that the Registrar had the right to take this position. I do not therefore propose to say more about the basis of the Registrar's change of heart regarding these applications.

At the same time as the applicants applied for the two trade marks mentioned above, they also applied to register the trade mark 'FROM SCRATCH' in respect of the same services. These applications were numbered 1510888 and 2000104. Application No. 2000104 was published at the same time as application No. 2000102 mentioned above. Following publication of that application an opposition was filed. Application No. 1510888 was not opposed but the application was suspended pending the outcome of the opposition to No. 2000104. The opposition to No. 2000104 never reached a conclusion because the applicants withdrew that application, together with No. 1510888.

The applicants came to be heard on application Nos. 1510886 and 2000102 on 26 January 1998, when they were represented by Doctor Mary Vitoria Q.C., instructed by their Trade Mark Agents, A R Davies & Co. Following that hearing I maintained the objections to these applications and they were refused. I have subsequently been asked to give reasons for refusal, which I now do.

OBSERVATIONS

I find it convenient to start off by reviewing some of the observations that were filed following the publication of these applications. The observations fall into two main categories. Firstly, observations from large or representative organisations. Secondly, observations from individuals or smaller organisations. The following appear to me to be the most relevant of the observations that fall into the first category.

The British Association of Concert Agents wrote to the Registrar on the 21 July 1995. Mr Richard Steele, who is the Executive Director of that organisation states:

"The term 'from scratch' has become generic within the music industry and particularly within the voluntary/amateur music sector. To me make the term 'from scratch' the subject of a trade mark would be quite wrong and the British Association of Concert Agents resolutely opposes it".

The London Mozart Players wrote to the Registrar on 24 July 1995. Mr Ian Lush, who is the Executive Director of that organisation states:

"Each season we invite local musicians in Croydon to join our players and music director Mr Tobias Bamert Matthias in a rehearsal of a symphonic work. This is billed as a 'scratch rehearsal' or 'rehearsal from scratch', and prompted as such in the locality. The title is immediately understood by amateur musician and no further explanation is necessary. These events have no connection with Gander Music Limited and have been going on longer than that company has been in existence. For their attempt to register the term 'from scratch' to prevent us from promoting these events would be quite ridiculous".

The Scottish Chamber Orchestra wrote to the Registrar on 24 July 1995. Mr Barry Kempton ,

who is the Concerts Director of that organisation states:

5 “The words ‘from scratch’ have been and continue to be used by many professional and amateur bodies as a generic term for performers where the audience takes part in both the rehearsal and concert. We have staged many events of this nature in Scotland over many years and consider its description of what will happen in the evening, not of whom the promoter of the performance would be”.

10 The British Federation of Young Choirs wrote to the Registrar on 25 July 1995. Ms Susan Lansdale, who is the Director of that organisation states:

15 “It is my opinion that these are terms in general use to describe a specific format of a musical event, and have been so in the musical world for at least the last 25 years. During my own career as a musician and arts manager working in different areas of the UK, I can recall many ‘from scratch’ events organised by a variety of promoters - schools, choral and orchestral societies and organisations, which have given a great deal of pleasure to a large number of people. It is my opinion that the ‘from scratch’ terms cannot be considered as a sole promoters trade mark, any more so than terms such as ‘singing day’ and ‘choral workshop’, which are also in general use, and also describe easily recognised formats”.

20 Observations were also received from the Association of British Choral Directors, The Incorporated Society of Musicians, The British actors union Equity, The Arts Council of England, The Royal School of Church Music, and the National Concert Hall of Wales.

25 The following appear to me to be the most relevant of the observations falling in the second category. Mr Arthur Bending wrote to the Registrar on 14 July 1995 stating:

30 “My wife and I know of a Scratch Messiah at St Mary Radcliffe Church, Bristol in the late 1960's many such performances have taken place in Exeter during the last ten years”.

The Registrar also received a letter dated 16 July 1995 from a Mr John W Sumsion. Mr Sumsion states that:

35 “The term and the events typically represented are already commonplace and in common use by many organisations in the UK. Apart from the large scale events in the Albert Hall, London, I would draw your attention to many locally organised events to sing and play major musical works ‘from scratch’. The ones with which I was personally involved were organised (for the public) by the Kendall Amateur Music Society in the 1960's and by the North Yorkshire Chorus in Cleveland in the 1980's.

40 If I can help with further evidence or advice please let to me know, my experience most relevant is that of a keen amateur musician, but I was also for some years a member of the Copyright Tribunal so I have a more general interest in this matter”.

45 Mr Lesley East, who is the Publishing Director of the Novello Music Publishers, wrote to the Registrar on 18 July 1995. He states:

“Novello is the publisher of the leading and most popular musical edition of Handel’s Oratorio, ‘Messiah’ - an addition which sells in excess of 25,000 copies per year. Part of the success of this

addition in recent years has been due to the proliferation of events describing themselves as 'Messiah From Scratch'."

5 Mr Ian Liston of the Hiss and Boo Company wrote to the Registrar on the same date. He states:

“As a company we have used the term ‘from scratch’ to describe some of our theatrical performances over the 20 plus years we have been performing; we use the term ‘from scratch’ in some of our schools educational work. It is a generally accepted and universally used phrase to describe a style and form of entertainment, musical or otherwise”.

10 Mr Beryl Korman of Korman International wrote to the Registrar on 19 July 1995. Ms Korman states:

15 “The term ‘from scratch’ is a purely generic one, which has been used for audience participation concerts as long as I can remember, which takes us back to the 1950’s. It was in current use for fund raising concerts and impromptu evenings in which the audience were invited to participate, long before the Tuesday Fellowship stated its own “Messiah From Scratch” in the 1960’s”.

20 Jeremy Hamilton of the Bournemouth Orchestras wrote to the Registrar on 18 July 1995. Mr Hamilton states:

25 “It seems to us that the words ‘from scratch’ have been in popular usage in the music business to describe a certain type of performance which has been given by numerous orchestras, choral and operatic societies, both amateur and professional for a number of years. I do not believe that the general public is aware of or interested in the concept of any one individual or company owning the right to use the phrase which I am certain is perceived as purely descriptive of the nature of the performance, rather than as a trade mark per se”.

30 Mr Geoff Clarke of Opera Della Luna wrote to the Registrar on 18 July 1995. Mr Clarke says that:

35 “In my experience the words ‘from scratch’ have been used for many years to describe many performances and concerts where one starts ‘from scratch’. There have been many ‘scratch orchestras’ and concerts where no or little prior rehearsal have taken place which have used this term. I believe it is a widely used phrase within the entertainment business and the notion that it should become the property of one company as a trade mark is unacceptable to all those performers and companies who have used it in the past and who would legitimately expect to use it in the future”.

40 Mr Philip K Redfern wrote to the Registrar on 19 July 1995. He states:

45 “The term ‘from scratch’ has from time immemorial been in use in the musical world to mean any performance put on by musicians especially assembled for the occasion, or for any ad-hock group of musicians brought together for a specific event. Such terms as ‘scratch orchestra’ or ‘scratch band’ being music trade common usage (even though the former was the name of a specific ensemble at one time). Similarly, the concept of inviting singers and players to join together for rehearsal and performance of standard choral or orchestral works, or even to explore together less well known repertoire has been an important part of amateur and semi-professional musical life in Britain for many years. Certainly, I have been involved in such projects as long as I have been active as a musician - for the last 25 years - and always these events have been referred to as ‘from scratch’.”

Richard McNicoll, who is the Artistic Director of the Apollo Trust, wrote to the Registrar on 20 July 1995. He states:

5 "I have been a member of the music profession since 1969 both as a flute player (I resigned my membership of the London Philharmonic Orchestra in 1981) and as a Music Educator. I am now music animator at the London Symphony Orchestra. During this entire period I have known of and occasionally taken part in performances of music which were put together with ad-hoc groups of professionals of amateurs for the pleasure of achieving a satisfying performance in a short period of time. The term 'from scratch' has always been used as one of the ways of describing such events."

Paul Rogerson, who is the Festival Director of Chichester Festivities, wrote to the Registrar on 27 July 1995. He states:

15 "In almost every successive year of the Chichester Festivities' 21 years history there has been a 'Concert From Scratch'. We have had 'Handel's Messiah From Scratch', the 'Mikado From Scratch', HMS Pinafore From Scratch', Durufle's Requiem From Scratch'. These have always been very great fun and were first introduced to the Chichester Festivities in its first year in 1975".

20 Some of the observations received by the Registrar consist of covering letters enclosing comments from other people in the trade who are concerned about the proposed registration of this trade mark. These letters are generally addressed to the person who has filed the covering letter as an observation. One of these is a letter dated 25 July 1995 from Booth & Co., Solicitors. Attached to that letter are 19 further letters from various people involved in the music business. The most relevant of these appears to me to be a letter dated 18 July 1995 by Veronica Morgan, of the North Pennine Music Agency. She states that:

30 "I am a professional horn player and brass instrumental teacher, and also run the North Pennine Orchestra and North Pennine Music Agency. Since 1967, when I entered the Guildhall School of Music and Drama, London, as a music student, I have heard the word 'scratch' used in the following ways;

[1] A 'scratch orchestra': Meaning a group of individuals, booked by a 'fixer' to form an orchestra for one off events. The musicians could be amateur, semi-professional or professional, or a mixture. The event could be an orchestral concert or a choral concert, opera or musicals with an accompanying orchestra. Both as a student and as a professional (1972 onwards) I have played the horn in many such concerts and theatrical performances including opera, musicals, ballet and plays. In addition, I have taken part in recording sessions, and other useful scratch orchestras especially in conjunction with films and videos.

35 [2] A 'scratch choir': For example the Scratch Messiah is probably the most popular work to be sung in this way. This means that individual amateurs come together at a venue. They are rehearsed (usually by a professional musician) during the day and conducted in a performance in the evening, in the presence of an audience. The accompaniment is provided by a scratch orchestra or an existing named orchestra, or various types of keyboard instrumental players. I have never heard the words 'from scratch' or 'Messiah From Scratch' used as a trade mark before and am appalled that Gander Music Limited is considering registering these words for their exclusive use".

45 Another observation dated 26 July 1995, by Steven Reed, covers a further 10 letters from various people involved in the music trade. The most relevant of these appears to me to be a letter dated 23 July 1995 by Mr & Mrs D F Barton of Kendall, Lancashire. They state:

5 “We have both been singing in amateur choirs continuously since 1966, from that year in Cambridge, and since 1983 here. We have both been aware of the performances entitled ‘from scratch’ and have always understood the title to refer to the method of production. We have not known of it having any commercial connection, and, indeed, have never heard of Gander Music Limited. In our experience the title has meant an evening performance for charity preceded by a single afternoon rehearsal. We have sung in the following performances entitled ‘Messiah From Scratch’:

10 12 September 1992 in St George’s Church, Kendall, conducted by Ian Jones

12 December 1992 in the Parish Church, Kendall, conducted by Christopher Tinker

11 December 1993 in the Parish Church, Kendall, conducted by Christopher Tinker”.

15 Another such letter is from a Mr Tano Rea of Portfolio Management dated 26 July 1995. Mr Rea explains that the applicants in this case have threatened his company with passing off proceedings if his company did not cease using the title ‘Trial By Jury - From Scratch’. He says that Portfolio Management started presenting a production under this name in 1990 and had given over 75 performances throughout Britain before he heard of Dr Monro. Attached to Mr Rea’s letter is
20 a copy of a Press Release issued around the time of his letter which explains the background to the conflict between his company’s use of the mark ‘Trial by Jury From Scratch’ and the applicants’ mark ‘Messiah From Scratch’. The Press Release encourages persons in the music business to write to the Registrar with observations on the proposed registration of the trade mark ‘Messiah From Scratch’.

25 That concludes my review of the observations that have been filed on these applications.

APPLICANTS’ EVIDENCE

30 On 22 November 1996, the applicants filed evidence in support of their applications. The evidence takes the form of a Statutory Declaration dated 18 November 1993 by Donald Martin Monro. Dr Monro states that he is a Director of Gander Music Limited trading as Concerts From Scratch. He explains that he was formerly a Partner in the Tuesday Partnership. He says that the Tuesday Partnership was formed in April 1974 by himself, Professor Reginald Garton, David
35 Burgess and Gavin Park. The partnership was dissolved and the trade mark applications which are the subject of this decision were formally assigned to Gander Music Limited on 19 January 1993. Dr Monro continues:

40 “My company and its predecessors entitled, the Tuesday Partnership, have used the trade mark “Messiah From Scratch” in connection with the promotion and organisation of impromptu musical performances of Handel’s Messiah continuously in the United Kingdom ever since April 1974. The Tuesday Partnership had provided the services under the service marks every year until 1993, when my company acquired the business of the mark”.

45 Exhibit DM1 to Dr Monro’s declaration consists of promotional material for the ‘Messiah From Scratch’ concerts. The earliest is dated 5 December 1974. It shows that a concert was held in the Royal Albert Hall on that date under the title ‘MESSIAH FROM SCRATCH. The promotional leaflets indicate that the applicants have held one or two concerts per year, the

majority under the title 'MESSIAH FROM SCRATCH'. These have all taken place in the Royal Albert Hall in London. The material shows that some of the concerts have taken place under other titles. For example a concert in March of 1978 took place under the title 'Brahm's Requiem From Scratch'. Other concerts have taken place under the names, 'The Verdi Requiem From Scratch' and 'Elijah From Scratch'. The following warning appears in the promotional material for the concerts from 1979 onwards:

"The Tuesday Partnership was formed in 1974 to organise the first 'MESSIAH FROM SCRATCH' and has now put on 10 impromptu evenings of great choral classics in the Royal Albert Hall, including 5 previous performances of Messiah. The Tuesday Partnership promotes these concerts without any kind of subsidy. It is necessary to point out that legal rights exist in these ventures and that the prior consent of the Tuesday Partnership is required before the promotion of any event which because of its similarity trades on the established reputation of the original concerts".

This theme is taken up in the proof of an article which Dr Monro says appeared in Classical Music on the 21 March 1992. The article is also part of exhibit DM1. It includes the following paragraph:

"We don't think that the demand for these sorts of things is large enough to sustain many comparable events. The Tuesday Partnership promotes 2 choral concerts a year, with a named charity benefiting from programme sales and a collection. When we tried to extend our series, there is a definite falling off. Although we are sure we can fill the Albert Hall twice a year, there probably isn't enough clientele for a third time. We earn a lot of money for the British Heart Foundation, and the people who come to our concerts have a really good time. All of that would be blown away if we came into direct competition with people copying the idea".

Exhibit DM1 also includes a copy of the following extract from a souvenir programme issued by the applicants in 1982. It consists of an article written by Doctor Monro entitled "Why G & S from Scratch wouldn't surprise G & S."

"When HMS Pinafore was presented in London on 25 May 1878, it became a smash hit after an uncertain start. So successful was it that dozens of invitations broke out in the USA - as a newspaper report put it "There are 42 companies playing Pinafore Companies formed after 6 pm yesterday are not included" One can imagine how Gilbert & Sullivan felt about their big success making profits for someone else. (The Tuesday Partnership knows the feeling well - "Messiah From Scratch" is probably the most imitated venture since HMS Pinafore). All this transatlantic piracy was possible because the USA and Britain did not have a copyright agreement at the time. So what did G & S do about it? Well, first of all they showed the Americans the real thing. Gilbert's production of Pinafore received a rapturous reception in New York, putting the others, it was said, to shame.

The second response was to produce their next opera the 'Pirates of Penzance' in New York first, which they did on the 31 December 1879. Unpatriotic? Not a bit of it. To ensure the British Copyright - because the same problem operated in reverse - 'Pirates' was first performed the previous day, 13 December 1879 'from scratch' at the Bijou Theatre, in Paignton, Devon! A D'Oyly Carte Company just happened to be performing 'Pinafore' in Torquay at the time. There was only one rehearsal (sounds familiar) using parts sent over bit by bit from the USA, and wearing the wrong costumes. The real London production of 'Pirates' was not mounted until April 1880. The first performance 'from scratch' of a G & S opera was indeed 'Pirates' - but it wasn't ours. Gilbert and Sullivan beat us to it by 101 and a half years".

Exhibit DM2 to Dr Monro's Declaration consists of details and examples of advertising for the concerts held by his company. They show that there has been national and local advertising during the period 1985 to 1993.

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Exhibit DM3 to Dr Monro's Declaration consists of various documents setting out the way in which the applicants and their predecessors have set about protecting the trade mark 'MESSIAH FROM SCRATCH'. It includes an article entitled "Ten Messiahs From Scratch and The Tuesday Partnership" which is dated 1983. The article is by David Burgess, who appears to have been a partner in the Tuesday Partnership at that time. The following is an extract from that article:

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"Those - and there have been many - who have wanted to use the title "Messiah from Scratch" with their choir or choral society and who have asked us have always been encouraged to do so, and have been asked merely to print a short acknowledgement to the origin of the title in order to help us bring our own events here in the Royal Albert Hall to wider attention. But, there have been those who have used the title "Messiah from Scratch" for large scale events set up in direct competition (sometimes with a very direct implication that we are the organisers. "Pioneered in the Royal Albert Hall, we now bring you Messiah from scratch in..."). Regardless of statements sometimes made to the contrary, rights do exist to titles to events in English law, and they have been established in our case."

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Exhibit DM3 shows that the applicants and their predecessors have sought acknowledgement of their origination of the title 'Messiah from Scratch' over the years, and that they have sought to prevent similar large scale concerts from taking place in direct competition. For example the applicants' solicitors wrote to the Royal Marsden Hospital, Cancer Appeal on 16 December 1988 threatening to initiate passing off proceedings as a result of an apparent intention to run a concert under the name 'Haydn's Creation From Scratch'. Exhibit DM3 also includes a letter from the Malcolm Sargent Cancer Fund For Children dated 11 December 1992. The letter is signed by Miss Sylvia Darley OBE, who is the General Administrator of that organisation. Her letter refers to earlier correspondence dated 8 December 1991 from Don Monro Esq. That letter is not included in the exhibit. The reply from Miss Darley is headed "Proposed MESSIAH in the Royal Albert Hall." The letter confirms that the committee of the Cancer Fund considered their proposed concert as a "one off." It goes on to accept that the fund would come to Dr Monro before organising any further such concerts. The letter also agrees to insert an acknowledgement that the concert is being held by kind permission of Concerts From Scratch and the British Heart Foundation. A copy of the promotional material for this concert is also included. It is entitled 'Come and Sing Handel's Messiah.' The venue is stated as the Royal Albert Hall. The acknowledgement mentioned previously is included at the bottom of the promotional material.

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40 Dr Monro goes on to state:

"Several parties have made concerted efforts to locate earlier uses of the phrase "Messiah From Scratch". These efforts include: Tano Rea trading as Portfolio Management, The National Federation of Music Societies (NFMS) and the Brewery Arts Centre. There is produced and shown to me now marked Exhibit DM4 a collection of Press Releases and correspondence."

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Document 1 in Exhibit DM4 consists of a copy of a Press Release issued by Mr Tano Rea (it is claimed) in the Autumn of 1993. The Press Release refers to Portfolio Management's production

of concerts under the titles 'HMS Pinafore from scratch' and 'Trial By Jury from scratch'. The Press Release goes on to note that Portfolio Management was being threatened with passing off proceedings by Gander Music Limited. It asks for information from persons in the music profession which shows that the term 'From Scratch' is commonplace in musical circles and that
5 'From Scratch' performances happen throughout Britain on a regular basis.

Document 2 in Exhibit DM4 is a copy of an article that appeared in the NFMS Newsletter (it is claimed) in January 1994. It is along similar lines and refers to the Press Release issued by Mr Tano Rea. Doctor Monro states that it is surprising that in view of these Press Releases not one
10 piece of documentary evidence has been unearthed of prior use of the words 'Messiah From Scratch' or 'From Scratch' in the billing of an event prior to December 1974.

Dr Monro states that in 1993 he recommenced a press clipping service, which had previously been discontinued by the Tuesday Partnership in the 1980's. As a result of this resumption a number
15 of advertisements for performances under the title 'Messiah From Scratch' came to the applicants' attention. For example there was an advertisement in the Southern Reporter which announced that a 'Messiah From Scratch' would be held on Sunday 21 November 1993 at Kelso Old Parish Church. An advertisement in the 'Telegraph and Argus' in Bradford on 1 December 1993 refers to a forthcoming 'Handel's Messiah From Scratch' at Haworth Parish Church.

Most of these advertisements were followed up by letters from Dr Monro seeking undertakings not to use the title in question as proposed and not to use the title again in future. Some of these resulted in undertakings not to use the title as proposed. Others resulted in undertakings not to use the name again. One of the advertisements announces a 'National Singing From Scratch
20 Day' for the enthusiast. This was to be held on Saturday 2 October 1993. This resulted in an exchange of correspondence between Dr Monro and a Mr John Elenor. Mr Elenor wrote to Dr Monro on 21 September 1993. The following is an extract from his letter:

30 "I gather than in calling my Oct 2nd event 'National Singing-From-Scratch Day' I have inadvertently infringed your copyright. I do apologise for this; I had no idea of treading on your toes, but the title seemed so appropriate that it never occurred to me that there might be confusion with your title".

There followed a series of exchanges between Doctor Monro and Mr Elenor which culminated
35 with Dr Monro threatening to start passing off action against Mr Elenor, and Mr Elenor taking the position that the words 'From Scratch' were purely descriptive and refusing to give the undertaking sought by Dr Monro. Also included in Exhibit DM4 are copies of correspondence between Dr Monro and Mrs Sheila Hurton of 'Voices for Hospices'. Doctor Monro wrote to her in the following terms in 1993:

40 "I am sure you will recall discussions with the Tuesday Partnership in respect of Voices for Hospices in 1991. In your letter of 21 March 1990 addressed to my former partner Mr Burgess, without replying to suggestions that the Tuesday Partnership had made about collaboration, you confirmed that you had altered your plans so that you were not using the expression 'From Scratch', and that
45 you would be performing Hayden's Creation rather than Messiah. Although Creation is one of the works we regularly perform in the 'From Scratch' manner, we took no further action at that time.

I understand that in 1994 you are planning a Voices for Hospice event in which the work to be

performed will be Messiah. I am concerned that the public may confuse this event with the several performances of 'Messiah From Scratch' that I am arranging in November 1994. I would be grateful for copies of any material that you have prepared to date about this event".

5 Mrs Hurton replied on 23 July 1993 pointing out that the event organised by Voices for Hospices in 1991 never used the phrase 'From Scratch'; instead the strap line 'Come and Sing Creation' was used. Mr Hurton explains that the choice of work for 1994 was Messiah and the chosen strap line is to be 'Hallelujah for Hospices.' Dr Monro replied on 28 July 1993 in the following terms:

10 "You and I know perfectly well that your event began as a direct imitation of Messiah from Scratch. The history of this does not reflect well on the integrity of those involved in originating Voices for Hospices, since it followed from a performance called 'Sing Messiah' in January 1988 at Southwark Cathedral which was done with the permission and assistance of The Tuesday Partnership.

15 In my view the use of yet another title, and the simultaneous holding of a number of these imitations, do not make the event distinctive from Messiah from Scratch, any more than was 'Sing Messiah' for which a license was properly sought. The general public will see the similarity clearly enough and many will conclude that it is our event that you are promoting. To use the precise legal term, in my opinion you are passing off".

20 Dr Monro continues that, as far as he is aware, not one choral society has used the title 'Messiah From Scratch' since 1993 when the Mountain Ash Choral Society put on what he describes as an 'unauthorised performance'. Dr Monro states that the Mountain Ash Choral Society has since signed an undertaking not to use the title again and he exhibits a copy of the same in DM4.

25 Doctor Monro further states that a small commercial organisation, called Bath Sinfonia Limited used the title in December 1993. However, they have since also signed a consent order, a copy of which is also exhibited within DM4. Doctor Monro says that others were detected after the event. Those who have given undertakings to the applicants are Marlborough College and Exning Parish Church. Doctor Monro states that it is with regret that his organisation pursues these small organisations but that they do so because they recognise the need to maintain the distinctiveness of the mark. He says that 5 other small performances in local churches between July 1993 and the publication of the mark in 1995 have not been pursued.

35 Exhibits 9, 10, 11 and 12 to Dr Monro's Declaration consist of the results of a survey conducted between November 1993 and January 1994. Exhibit DM12 consists of 10 Statutory Declarations completed by persons who had responded to letters from the applicants' trade mark agents in November 1993. The Statutory Declarations confirm the answers to a questionnaire sent to each of our participants. The questionnaire was sent out under cover of a letter from A R Davies & Co, in the following terms:

40 "We are trade mark agents acting on behalf of clients who are endeavouring to satisfy the Registrar of Trade Marks as to the significance of the expressions 'From Scratch' and 'Messiah From Scratch'.

45 We understand that you are familiar with the above expressions and accordingly, we would be grateful if you would kindly complete and return to us the enclosed questionnaires as soon as possible".

The questionnaire asks for information about the person to whom it is addressed and then asks the following questions:

5 “In the course of your business have you encountered the expression ‘Messiah From Scratch’?

If so, (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’?”

10 There is no indication as to how the persons concerned have been selected to give evidence by way of this survey. Some of the participants in the survey are members of Choral Society’s or hold office in such organisations. One of the persons involved in the survey, Marion Herrod, describes herself as the Royal Albert Hall Secretary and Lettings Manager until 1983. It appears obvious why she was chosen. In other cases there is no obvious explanation.

15 In answer to the question “Which company, if any, and with what services, if any, do you associate the expression ‘Messiah From Scratch’?”, all 10 persons completing Statutory Declarations as a result of the survey identified the applicants or their predecessors the Tuesday Partnership.

20 The responses to the question “What, if anything, does the expression the ‘Messiah From Scratch’ mean to you?” are more equivocal. None of the 10 respondents identified the term as a trade mark. Irene Florence Saunders states that the term means to her “A performance of Messiah, starting from nothing”. Marion Herrod states that to her this expression means “without rehearsal”. Ann Elizabeth Ellson says that to her, the expression means “A performance of

25 Messiah by amateurs brought together on the day, with no previous collective rehearsal”.

Exhibits DM9 to 11 consists of a further 44 questionnaires which were sent out and returned to A R Davies & Co as a result of their survey. None of these are covered by Statutory

30 Declarations. Dr Monro’s Statutory Declaration indicates that these were all the questionnaires that were returned as a result of the exercise. Of these respondents, a further 14 identified the term ‘Messiah From Scratch’ with Gander Music, Concerts From Scratch, The Tuesday Partnership or Doctor Monro personally. None of these respondents identified the term ‘Messiah From

35 Scratch’ as a trade mark. Nearly every respondent indicates that the term ‘Messiah From Scratch’ means a performances of Handel’s Messiah performed with little or no rehearsal.

The remaining 30 respondents did not identify the term ‘Messiah From Scratch’ with the applicants or their predecessors. Some of these respondents did not associate the term with any one particular company. Others made a point of saying that they associated the term with a

40 number of different organisations, particularly local Choral Society’s. One of these respondents, Anabel English, states that she realises the term ‘Messiah From Scratch’ is a trade mark but she does not know whose trade mark it is.

Doctor Monro concludes his Declaration by stating that because of the:

45 1. applicants long use of the mark ‘MESSIAH FROM SCRATCH’;

2. extensive advertisement of the concerts held under that name;

3. media attention that the concerts have attracted;

5 4. geographical spread of participants at these concerts (which are generally attended by around 5,000 people);

- the trade mark 'MESSIAH FROM SCRATCH' had acquired a distinctive character as a trade mark for the services stated in the applications prior to the dates they were filed.

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With this evidence and the observations in mind I now turn to the reasons for my decision.

DECISION

15 Application No. 1510886 was filed under the Trade Marks Acts 1938. By the time this matter came to be heard that Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. However, in accordance with the transitional provisions set out in Schedule 3 to the 1994 Act, I must continue to apply the relevant provisions of the old law to the proceedings insofar as they affect application No. 1510886.

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Later application No 2000102 falls to be determined under the provisions of the Trade Marks Act 1994. I intend to deal with the earlier application first. I will then consider the extent to which the change in the law or the later filing date affect the outcome of the later application.

25 Sections 9 and 10 of the 1938 Act set out the requirements for registration in Parts A and B of the Register maintained under that Act. The 1994 Act has ended the division of the Register into two parts. Further, the transitional provisions provide that any registrations that arise from applications previously made under the 1938 Act will now all go onto the new single part Register. In consequence the provisions of Section 9 of the 1938 Act are of little practical
30 significance. If application No. 1510886 meets the requirements for registration set out under Section 10 of the old law it will qualify for registration on the new Register in precisely the same way as would be the case if it qualified for registration under Section 9. In practice therefore I only needed to consider whether that application meets the requirements of Section 10.

35 The relevant parts of Section 10 are as follows:

10.(1) In order 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
40 of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal
45 may have regard to the extent to which-

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

5 It is well established that in considering whether a trade mark meets the requirements 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 applicants' 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 result in a trade mark which is either *prima facie* capable of distinguishing the applicants' services, 10 or which has come to distinguish the applicants' services because of the use that has been made of it.

15 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 word 'scratch' is as an adjective, meaning 'hastily assembled or put together'.

20 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 applicants do not dispute that the term 'scratch orchestra' has been used in the manner suggested above.

25 However, the applicants contend that the words 'from scratch' are not an appropriate way to describe an impromptu concert performance. Dr Vitoria, on behalf of the applicants, pointed out that there were many other possibly more appropriate ways of describing such performances. However, as Hugh Laddie QC (as he then was) said in the PROFITMAKER trade mark case (1994 RPC at page 616 lines 38 to 44):

30 "The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were then all these alternative ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the Register to ensure that common descriptions or laudatory words or not unusual combinations of them, have been monopolised by others".

35 Having regard to the dictionary definitions given above, and what appears to me to be 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. It follows from that finding that the words 'MESSIAH FROM SCRATCH' are not, *prima facie*, capable 40 of distinguishing such services as those of one undertaking. I conclude that application No. 1510886 does not meet the requirements of Sections 9 or 10 of the Trade Marks Act 1938.

45 The applicants contend that, even if the mark is not distinctive *prima facie*, it had come to distinguish the applicants' services in fact before the date of application. It is therefore claimed that the trade mark qualifies for registration under Section 10(2)(b) of the Act.

That contention does not sit well with the observations set out above. The applicants say that the observations, or at least the majority of them, have been prompted by a Press Release issued by

Mr Tano Rea which was picked up and reported in Classical Music on 15 July 1995. It is claimed that this Press Release initiated a campaign against the registration of this trade mark. The campaign is claimed to have been based upon false information that the applicants, Gander Music Limited, were a recently formed organisation, and that the objective of the applications was to prevent others from performing impromptu performances of the Messiah, and not just protection for the words 'Messiah From Scratch'.

It does appear from a number of the observations received, that some persons (but not in my view those quoted above) have been confused into thinking that the applications, if they proceed to registration, will have the effect of preventing impromptu performances of 'The Messiah' without some form of license from the applicants.

The applicants' evidence suggests to me that they may have contributed to this confusion. The correspondence between Doctor Monro and Voices for Hospices (referred to above) suggests that, in the past, the applicants have themselves believed and encouraged others to believe, that their claim extended to protecting the 'idea' underlying their concerts, and not just their title. I accept that this confusion may have muddied the waters to some extent. I also accept that a number of the observations filed on the applications may have been prompted by the Press coverage mentioned above. However, I see no reason to doubt that the vast majority of those filing observations have done so in good faith.

It is clear from the extracts reproduced above that many of those making observations regard the words 'From Scratch' as descriptive and in common use in the music profession. A significant number of the observations come from well established and reputable organisations in the entertainment profession. Although the observations do not consist of sworn evidence, I see no reason to believe that the vast majority of people who filed observations have said anything other than what they believe to be true.

The applicants point out that, although the observations contain many assertions and claims, there is no actual evidence of any use of the term 'From Scratch' prior to their first established use of the term in 1974. I accept that. However, even if the applicants or their predecessors were the first to use the words 'From Scratch' in relation to musical performances, I do not think it necessarily follows that they are entitled to register the trade marks which is the subject of this application.

Application No. 1510886 was filed on 8 July 1992. The matter must be judged at this date. There are plenty of examples of trade marks which were coined by their proprietors but which could not be protected because they were descriptive of the goods or services, or had become descriptive or generic. See, for example, the OVEN CHIPS passing off case (McCain International Limited v Country Fair Foods Limited and another 1981 RPC page 69.)

The applicants contend that the mark was not generic at the date of application. They point to the strenuous efforts made by them to prevent their mark becoming generic. The evidence does indeed show numerous attempts to prevent others from using the terms 'Messiah From Scratch' and 'From Scratch'. Much of this activity is relatively recent. It appears to me that the attitude of the applicants changed somewhat from 1992 onwards. The article written by David Burgess (one of the partners in the applicants' predecessors) in 1983 (see page 8 above) suggests that the

applicants' predecessors took a relatively relaxed view about use of the term 'From Scratch' by local choirs and other small scale users. Indeed Mr Burgess's article indicates that they actively encouraged such use, provided the users of the term acknowledged the Tuesday Partnership as the originators. This is consistent with the claims of many of the observers to have used the term 'From Scratch' in many local musical performances.

It appears to me that an acknowledgement that the applicants, or rather their predecessors, originated the term 'From Scratch' - and there is little evidence on this point - falls well short of the sort of control normally associated with licence arrangements. I do not think that such acknowledgements (even if they occurred) can be regarded as having maintained or established an *origin* link between the services provided and the applicants or their predecessors.

The applicants and their predecessors appear to have made efforts over many years to prevent the use of the term 'From Scratch' by organisations which they regarded as competitors. It appears that from 1992 these efforts were extended to smaller users of this term.

There is no evidence that any of the resulting disputes have come before a Court, except in one instance whereby the Bath County Court issued an Order against Bath Sinfonietta Limited on the 17 October 1994. However, this Order was issued by consent after agreement between the parties. The applicants advised the Registrar that they have commenced passing off proceedings against Tano Rea, trading as Portfolio Management, and the Brewery Arts Centre. I was further advised at the hearing that such proceedings have been stayed by agreement between the parties pending the outcome of these trade mark applications.

The relevant question appears to me to be whether the trade mark 'MESSIAH FROM SCRATCH' had become capable of distinguishing the applicants' services by 8 July 1992 when application No. 1510886 was filed. By that date the applicants had used the mark 'MESSIAH FROM SCRATCH' for nearly 18 years as a title for the majority of their no doubt novel impromptu performance held once or twice a year in the Royal Albert Hall. Some of the concerts held within that period were, as the evidence shows, held under related titles such as 'Elijah From Scratch'. The use of the term 'From Scratch' in association with the names of other major choral works appears to me to further undermine the applicants' contention that the combination of the word 'Messiah' and 'From Scratch' have become distinctive of their services, even if the words 'From Scratch' have not.

The nature of the applicants use of the mark 'MESSIAH FROM SCRATCH', is generally in association with other words. For example much of the pre-1992 promotional material and advertising is under the heading 'The Tuesday Partnership Presents Messiah From Scratch'. From 1992 onwards the nature of the use changes somewhat and the words 'Messiah From Scratch' tend to be used in association with the words 'Concerts From Scratch'.

In the case of *British Sugar PLC v James Robertson and Sons Limited* (1996 RPC 281) 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 spoken an 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 new 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.”.

It appears to me from the evidence before me, that the public have taken the words ‘From Scratch’ as denoting a particular style of performance. I think this is very likely to have come about because people have equated the meaning of the long established phrase ‘From Scratch’ with the unrehearsed or little rehearsed style of performance which is the defining characteristic of the applicants’ concert services. It may also be that the long standing use of the word ‘scratch’ in relation to unrehearsed orchestral performances has contributed to the words ‘From Scratch’ and ‘Messiah From Scratch’ being seen as descriptive of the type of services organised by the applicants.

This finding is not only consistent with the observations referred to above; it is consistent with the results of the applicants’ own survey. Although the survey results establish some level of association of the words ‘Messiah From Scratch’ with the applicants, they do not appear to me to establish that these words are widely regarded as a trade mark; as a sign which denotes services provided by a single undertaking. Despite the covering letter from the Trade Mark Agents making it clear that the survey was intended to assist with a trade mark application, only one respondent identified the term ‘Messiah From Scratch’ as a trade mark.

On my reading of the survey results, a majority of the persons involved did not associate the mark wholly with the applicants or with any one particular organisation. I also bear in mind that the applicants’ evidence does not provide an explanation of the method chosen to select the participants in the survey. Consequently, I cannot be sure that even the degree of association of the term ‘Messiah From Scratch’ which is established is necessarily representative of the trade as a whole.

The applicants contend that the results of the survey were affected by a Press Release circulated by Mr Tano Rea in the Autumn of 1993, which was around the time that their survey was conducted. However, I see no reason to believe that the Press Release and subsequent media attention has resulted in the participants in the survey giving answers which they do not believe to be true.

I conclude that by the date of application No 1510886 (8 July 1992) the words ‘MESSIAH FROM SCRATCH’ had not become factually distinctive as a trade mark for the services specified. In my judgement, the application does not satisfy the requirements of the Sections 9 or 10 of the Trade Marks Act 1938. It is therefore refused under Section 17 of that Act.

There remains the question of application No. 2000102. This application is made under the Trade Marks Act 1994. The mark and the services are the same. I must therefore decide whether the case for registration was stronger as at the date of the later application, that is 31 October 1994, or whether the case for registration can succeed under the Trade Marks Act 1994 where it failed under the previous legislation.

On the first point it appears to me that the case for registration on the facts is no stronger as at 31 October 1994 than it was as at 8 July 1992.

The relevant provision of the new Law is Section 3(1) which is as follows:

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3.(1) The following shall not be registered-

(a) signs which do not satisfy the requirements of section 1(1),

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(b) trade marks which are devoid of any distinctive character,

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(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,

20

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above 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..

25

At the hearing, Dr Vitoria did not contend that the applicants' *prima facie* case for registration was significantly different under the new law to the old. In this case I think that is right. I have already found that the mark consists of words which are an apt description of the kind of concert services provided by the applicants. It follows from that that these are words which *prima facie* may serve in trade to designate this kind of concert service. The trade mark is therefore debarred from registration by Section 3(1)(b) & (c).

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The leading authority on the meaning of the proviso to Section 3(1) is the TREAT case mentioned above. In that case Jacob J. stated:

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“The proviso really means ‘has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark’. In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish this. And in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a substantial majority of persons as a trade mark.....”

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I have already found that the applicants' evidence has not established that the words 'MESSIAH FROM SCRATCH' has become accepted by a majority of the relevant public as a trade mark. I conclude that application No. 2000102 does not qualify for registration under the proviso to Section 3(1) of the Trade Marks Act 1994.

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The later application is therefore also refused under Section 37(4) of the Trade Marks Act 1994.

Dated this 7th Day of April 1998

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Allan James

For the Registrar

10 **The Comptroller General**

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