

O-365-07

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO
CONSOLIDATED OPPOSITION NOS: 94322 & 94323 BY KENT MUSIC TO
APPLICATION NOS. 2325924A & B IN THE NAME OF
KINDERMUSIK INTERNATIONAL, INC**

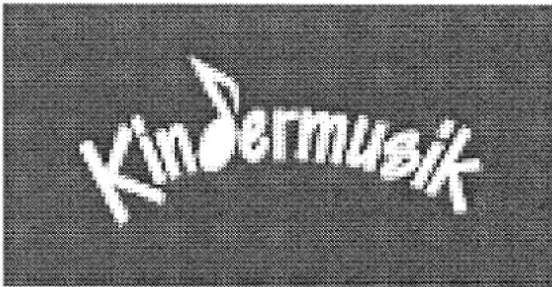
TRADE MARKS ACT 1994

**IN THE MATTER OF an interlocutory hearing
held in relation to consolidated opposition
Nos: 94322 & 94323 by Kent Music to application
Nos. 2325924A & B in the name of
Kindermusik International, Inc**

BACKGROUND

1. On 7 March 2003, Kindermusik International Inc (which I will refer to as KI) applied to register the following as a series of two trade marks:

KINDERMUSIK



The application was applied for in relation to the following goods and services:

Class 16: Printed matter, all relating to music education and/or the teaching of music and/or movement and dance; sheet music.

Class 41: Educational services, all relating to the teaching of music and/or movement and dance; information services relating to the aforesaid.

2. In order to overcome objections taken during the ex-parte examination phase, the application was divided. The part A (the plain word) and part B (the word and device) elements were advertised in Trade Marks Journal Nos: 6619 and 6622 on 3 and 24 February 2006 respectively.

3. On 2 May 2006, Kent Music (which I will refer to as Kent) filed opposition to these applications. The grounds of opposition against each are as follows:

The A element (word only)

Objection is taken under section 3(1)(a) because:

“The mark is not capable of distinguishing the goods or services as it is a generic term in the UK”;

under section 3(1)(b) because:

“2325924A is just the word “Kindermusik” in upper case letters and this word is in common use”;

and under section 3(1)(d) because:

“Kindermusik is now accepted as a generic term in the UK to describe early years music education based on principles established by Orff, Kodaly and other music educators.”

Under the heading “Give details to support your opposition” Kent also say:

“The registration of this mark would constitute an unfair restriction on trade and would be anti-competitive. The applicant should not be granted sole use of the word Kindermusik as this term has been in use in the UK for many years. In addition, we believe we probably have prior use of an unregistered mark however we would not seek to register “kindermusik” as a trade mark as the term is “customary to the trade or profession” We have been unable to establish prior use as the applicant has not provided us with a date of first use in the UK by Kindermusik International, despite being requested to do so.”

The B element (word and device)

Objection is taken under sections 3(1)(a) and 3(1)(d) on the same basis as the A element, and under section 3(1)(c) because:

“2325924B contains a quaver symbol denoting the intended purpose of the goods or services”.

Kent also repeat the first two sentences under the other details heading mentioned above.

4. On 2 August 2006, KI filed counterstatements in which the various grounds of opposition are denied, and Kent are put to proof of their various assertions.

5. On 7 August 2006, the Trade Marks Registry (which I will refer to as TMR) wrote to the parties indicating that Kent’s evidence-in-chief was due by 7 November; at that point Kent asked for the two sets of proceedings to be consolidated, a request to which KI objected. Following the TMR’s Preliminary View indicating that Kent’s request should be granted, KI requested a hearing, as a result of which, the period for Kent to file their evidence-in-chief was suspended. At that hearing I determined that consolidation was appropriate. On 10 November, KI indicated in writing that they did not intend to appeal my decision, and the period for Kent to file their evidence-in-chief was re-activated and expired on 3 January 2007.

6. Following the filing of Kent’s evidence-in-chief which consisted of a witness statement from their Chief Executive Graham Standley dated 19 December 2006 accompanied by 34 exhibits, a period expiring on 15 April was set for the filing of KI’s evidence-in-chief; this period was extended to 15 July. On 16 July, (the Monday following Sunday 15 July which was an excluded

day), KI filed their evidence-in-chief. This consisted of a witness statement from their Chief Executive Officer Michael Dougherty dated 13 July 2007 accompanied by 17 exhibits, together with in excess of 100 witness statements from third parties, educators and parents. While this evidence required some amendment, this has now been completed and I need make no further mention of it in this decision.

7. On 6 August 2007, Field Fisher Waterhouse (which I will refer to as FFW) who are KI's professional representatives in these proceedings wrote to the TMR asking for the proceedings to be struck-out. These letters (which were identical save for the references to the grounds on which the oppositions were based) read (in relation to the B element) as follows:

“Formal application is hereby made to strike out the Opponent’s Statement of Grounds filed by the Opponent on the 25th April 2006 pursuant to sections 3(1)(a), (c) and (d) of the Act.

1. By CPR 3.4(2)(b) the Court has discretion to strike out a statement of case in circumstances in which it fails to comply with a rule practice direction or court order.

2. Further in relation to both CPR 3.4 and CPR 24, 3PD-001.1.7 stipulates:-

“A party may believe he can show without trial that an opponent’s case has no real prospect of success on the facts, or that the case is bound to succeed or fail, as the case may be, because of a point of law, is bound to fail. In such case the party concerned may make an application under rule 3.4 or Part 24 (or both) as he thinks appropriate.”

3. The Registry has applied the strike out procedures operated within the rubric of CPR which is contemplated by TPN/4 2000 paragraphs 17 and 18.3.4(2)(b) in, for example, Re: Viglen Trade Mark of 19 March 2001.

4. The Opponent seeks to support its allegation of breach of ss. 3(1)(a), (c) and (d) by reference to a Witness Statement of GC Standley a proportion of which post-dates the application date of 7 March 2003.

Particulars

5. Exhibits 1-9 inclusive, 12, 13, 14, 15, 16, 26, 28, 29-34 inclusive all relate to use of the Application after the relevant date.

6. Further, the remaining Exhibits which do relate to periods of time prior to the relevant date, as a matter of clear fact, disclose clear trade mark use of the Application and in a trade mark sense:

(a) Exhibit 10 refers to the words “...listen to and perform “Kindermusik””;

(b) Exhibit 11, refers to the words “Kindermusik Session...potential pupils for Kindermusik classes...She undoubtedly leads our Kindermusik department”;

- (c) Exhibit 17, refers to the words “May I draw your attention to the new “Kindermusik”...KINDER MUSIK (MUSICAL FUN FOR YOUNG CHILDREN);
- (d) Exhibit 18, refers to the words “Kindermusik and Junior Music Workshop...Kindermusik only”;
- (e) Exhibit 19, refers to the words “Kindermusik”;
- (f) Exhibit 20, refers to the words “Kindermusik as a First Step....and support of Kindermusik...parents that will benefit from Kindermusik”;
- (g) Exhibit 21, refers to the words “...and Mrs Jones (sic) will be taking Kindermusik (music for infants)...”;
- (h) Exhibit 22 refers to the words “Kindermusik groups will follow...”;
- (i) Exhibit 23 refers to the words “KINDERMUSIK”...Kindermusik classes are already provided...”;
- (j) Exhibit 24 refers to the words “Kindermusik classes are provided...”;
- (k) Exhibit 25 refers to the words “Another area of swift expansion has been Kindermusik – classes for...”;
- (l) Exhibit 27 refers to the word “Kindermusik”.

7. Further, various of the exhibits evidence the meaningless nature of the word Kindermusik because the meaning of the term is specifically and expressly explained, see Exhibits 2, 3, 16, 17, 21 and 25. Exhibit 16, the Opponents own pamphlet enquiries “What is Kindermusik?”;

8. Further and in the alternative, Kinder is a German word meaning “children” and musik meaning “music”. Hence, the portmanteau of those 2 words, producing “childmusic” and/or “childrenmusic”, represents a syntactically unusual juxtaposition of the 2 words and falls entirely within the judgement of the CFI in BabyDry C-383/99P.

9. The Applicant repeats the matters stated in paragraphs 1-3 above, in that the Opponent’s Statement of Grounds is liable to be struck out in circumstances described by CPR 3.4.2(b).

10. The Applicant should not be put to further legal cost in pursuing these opposition proceedings.”

8. The TMR responded to this request in an official letter dated 21 August. The relevant part of that letter reads as follows:

“The matter has been considered but it is the Registry’s preliminary view that your request be refused. The relevance of any evidence filed will be considered by the Hearing Officer at the appropriate stage of the proceedings. He/she will make that decision.”

9. A period expiring on 4 September was allowed for a hearing to be requested. In an e-mail dated 22 August, Kent commented on KI’s request for striking-out in the following terms:

“..I feel there is little need to comment further at this stage. However, the applicant’s assertion that our opposition is bound to fail shows great optimism. The submissions in my evidence that post-date the UK trademark application are relevant in that they are indicative of how the mark was being used in the UK before the application was made. It is my understanding that this is quite acceptable.

Furthermore, the references that pre-date the application clearly indicate generic use. They could not refer to the trademark as suggested, as “Kindermusik” was not at that time protected by a trade mark in the UK.”

10. In a letter dated 3 September, FFW requested a hearing. In an official letter dated 11 September, the TMR set a period expiring on 11 December for the filing of Kent’s evidence-in-reply. Although it forms no part of my decision, I note, for the sake of completeness, that on 5 November, Kent filed their evidence-in-reply. This consisted of a further witness statement from Mr Standley dated 2 November accompanied by exhibits A to M, together with 207 witness statements from individuals described as, for example: experts, teachers, parents, national experts, professional teachers and Heads of local authority music services.

The interlocutory hearing

11. An interlocutory hearing to consider the TMR’s preliminary view took place before me, by telephone, on 19 October. At the hearing, KI was represented by Mr Mark Engelman of Counsel instructed by FFW; Kent were not represented at the hearing, but filed written submissions dated 28 September in lieu of attendance.

Kent’s written submissions

12. As Kent were not present at the hearing, I think it is appropriate to record here the totality of their written submissions. These read as follows:

“The only feasible reason for the applicant to request to strike out our opposition, is as a last resort to prevent Kent Music from filing further overwhelming evidence that “Kindermusik” is a generic term in the UK. The timing of the applicant’s request is particularly salient since the claimed date of first use in the UK was not disclosed by the applicant, despite repeated requests, until Michael Dougherty’s recent witness statement. Now that this date has finally been disclosed, it has been a relatively straightforward matter to collect significant evidence of prior use by Kent Music and other UK providers.

This evidence already amounts to over 100 signed witness statements some which give examples of the use of “Kindermusik” in the UK since the 1980s.

In order to overcome the initial rejection to the mark by the Trade Mark Office, the applicant claimed that “Kindermusik” was not a German word and was in fact an invented word. This was a significant argument and resulted in the mark proceeding to advertisement to test the response in the UK. “Kindermusik” is in common use in Germany and this can be substantiated by a search on www.google.de which will return almost a million results from sites in the German language. “Kindermusik” has been used both in the UK and other parts of Europe for decades.

The applicant’s latest argument is that references to “Kindermusik” with an upper case initial letter signifies reference to the mark itself. This is nonsense as those familiar with the German language understand that it is customary to capitalise German nouns and this convention has frequently continued when “Kindermusik” is referred to in the UK.

In response to the evidence filed by the applicant, the forthcoming salient evidence will relate to: (1) Generic use of “Kindermusik” in the UK prior to the date of application by Kindermusik International for a UK trade mark, (2) use by Kent Music of “Kindermusik” prior to the applicant’s UK trademark application, (3) generic use of “Kindermusik” in the UK prior to the date of first use by Kindermusik International in the UK [and] (4) use by Kent Music of “Kindermusik” prior to the date of first use by Kindermusik International in the UK.

We feel it would be reasonable to be allowed to present this evidence for due consideration.”

KI’s skeleton arguments

13. The main points emerging from KI’s skeleton arguments were, in my view, as follows:

- that when considering requests for strike out, the threshold is a low one. In *Kent v Griffiths and Others* [2001] QB 36, Lord Woolf held that where the position is clear and the facts provide no assistance, the Courts are encouraged to take those issues at an early stage thus allowing the Court to focus on the real issues;
- that in relation to the A element (word only), sections 3(1)(a), (b) and (d) contemplates that the trade mark is incapable of distinguishing between undertakings, is devoid of any distinctive character or has become customary in the current language of the trade. The essence of the evidence filed by Kent is entirely replete with references which evidence use of Kindermusik as a trade mark in a trade mark sense such that descriptions are provided to assist the average consumer in understanding the word. Hence it is not itself descriptive.

KI had the following comments on Kent’s evidence-in-chief:

“Exhibit 1 – Kindermusik – non trade mark: use as a title to a CD, see *R v Johnstone* [2003] FSR 748 HL;

Exhibit 2 – Kindermusik explained to be “children for music” and then Claudia Wanner provides the true translation of those words “Musik fur Kinder” evidencing that Kindermusik is not a translation of those words.

Exhibit 3 – Andreas is similarly uncertain that the word is generic/descriptive he states “the word is not very common in daily talk” in Switzerland, he proffers the multiword equivalent “Musik fur Kinder”.

Exhibit 4 – Artemis places the name along side “Music Initiation” hardly a descriptive name.

Exhibit 5 – Marion van der Hoeven of the Netherlands expressly states the word is not common.

Exhibits 6, 7 and 8 – not evidence.

Exhibit 9 – The A mark is used as a trade mark by Kent as “Colourstrings Kindermusik”; even were it descriptive (which it isn’t) it cannot lie in the mouth of an infringer to impute descriptiveness to KI’s mark....

Exhibit 10 – provides no evidence of use of the word, it is also Kent’s brochure....

Exhibit 11 – evidences use of the word in a trade mark sense “Kindermusik Session” except the word used is Kindermusiç not Kindermusik, (further Kent’s own brochure...)

Exhibit 12 – Again such use is (i) in a trade mark sense and (ii) by Kent itself...

Exhibit 13 – the mark is used as a trade mark “Kindermusik” (sic) within the context of words primarily in lower case evidencing recognition as a trade mark.

Exhibit 14 – sworn by Kent to “show generic use of the term”, but there is no use of the word Kindermusik in the exhibit.

Exhibits 15 & 16 – Kent’s own document, mark used with a capital “K” and importantly goes on to explain what the word means, which would be unnecessary if the word was immediately descriptive,....

Exhibit 17 – refers to “Kindermusik” (sic) in a trade mark sense. Within the context of other words in lower case and provides a explanation “musical fun for young children”. Why would one need a description if the mark is immediately descriptive?

Exhibits 18, 19, 20, 22, 23, 24 and 27 – the mark is used in a trade mark sense as “Kindermusik” within the context of words in lower case.

Exhibit 21– refers to “Kindermusik” (sic) in a trade mark sense. Within the context of other words in lower case and provides a explanation “music for infants”. Why would one need a description if the mark is immediately descriptive?

Exhibit 25 – Kent’s own document, mark used with capital letter “K” and importantly looks as if it goes on to describe what the word means, which would be unnecessary if the word was immediately descriptive...

Exhibit 29 – extract from German web page provides no information as to alleged descriptiveness/genericness of the mark.

Exhibit 30 – unsworn 2nd hand hearsay evidence from David Marcou referring to Richard Hickman’s explanation. But the explanation is not a description but the very description of the educational “process” identified by the trade mark. Further the word is always used in a trade mark sense within the context of other words in lower case.

Exhibit 31 -.....is a hearsay unsworn assertion as to the generic nature of the word but the mark is always used in a trade mark sense and with the context of other words in lower case which questions whether Mr Sullivan truly understands the meaning of the word generic.

Exhibit 32 – is a hearsay unsworn assertion as to the generic nature of the word but the mark is always used in a trade mark sense and with the context of other words in lower case which questions whether Mr Cox also truly understands the meaning of the word generic. How can Mr Cox refer to KI’s product if the term is incapable of distinguishing between undertakings?

Exhibit 33 – Mr Jones is a user of the mark. He refers to it always in a trade mark sense and in italics. It again represents third party unsworn hearsay evidence.

Exhibit 34 – Mr Morris unsworn hearsay evidence places the term in quotation marks, thus uses it in a trade mark sense.”

- that in relation to the B element (word and device), the evidence filed by Kent does not support its case under 3(1)(a), 3(1)(c) and 3(1)(d);
- that not one of the materials supplied by Kent makes reference to the device, merely the word of which it comprises;
- that in order to succeed under section 3(1)(a) in relation to the B element, it would be necessary for Kent to establish that the device elements present in the mark i.e. the stylisation of the letters, formed in an arc with the quaver added nothing to the word;

- that the displacement of the word into an arc taken together with the replacement of the central letter “d” with a note makes such a finding impossible;
- that there can be no issue that the device mark does not operate as a sign, nor is the mark applied for the common name for the goods – see *Jeryl Lynn* [1999] FSR 491;
- that there can be little doubt that the 3 device elements take the device mark beyond the word Kindermusik, even were it the case that the word was wholly descriptive; the 3(1)(a) case must fail;
- that in relation to the ground based on section 3(1)(c) of the Act, and in view of the decisions in *BabyDry*, *Doublemint*, *Postkantor*, *Golf USA*, *Celltech* and *LokThread*, none of the evidence filed by Kent points to the generic nature of KI’s device mark within the trade. Nor is the device mark descriptive of the goods and services for which registration is sought;
- that in relation to section 3(1)(d) of the Act, the decisions in *Merz & Krell GmbH & Co* [2002] ETMR 21 and *STASH trade mark* (BL 0-281-04) should be borne in mind. None of the evidence filed by Kent establishes the generic nature of the use of the Kindermusik device mark; this ground must also fail;
- that section 3(1)(a) as it relates to the word mark and all of the grounds as they relate to the word and device mark should be struck from the Grounds of Opposition.

The decision following the hearing

14. At the hearing I reserved my decision. I communicated my decision to the parties in a letter dated 30 October 2007. The substance of that letter was as follows:

“..Notwithstanding the conclusions reached in paragraph 54 of his skeleton argument, at the conclusion of the hearing Mr Engelmann confirmed that your client was seeking to strike-out both oppositions in totality. Having heard Mr Engelman’s detailed submissions, I chose not to give a decision on the day, preferring instead to review my notes and to reflect on the respective parties’ positions before issuing a decision; my letter of 24 October 2007 refers.

At the start of the hearing I indicated to Mr Engelman that I accepted that as a matter of principle the Registrar has the authority to strike-out all or part of a statement of case or defence. That being the case, Mr Engelman then addressed me, by reference to the comments of Lord Woolf in *Kent v Griffiths and Others* [2001] QB 36, and in particular by reference to paragraph 38 of that decision, on the criteria one should apply when considering strike-out applications. As I indicated at the hearing, I accept that those comments together with the comments of Sir Andrew Morritt VC in *Celador Productions Ltd v Melville Boon and Others* [2004] EWHC 2362 (Ch) are all relevant considerations.

Having determined that the Registrar does have the authority to strike-out proceedings and the criteria to be applied when considering such a request, the question is whether in

the circumstances of these consolidated proceedings I should accede to the Applicant's request and strike-out the proceedings in totality; in my view, I should not.

Although at the hearing Mr Engelman placed great reliance on the comments in paragraph 8 of Mr Standley's witness statement namely: "...It does appear that "KINDERMUSIK" has been "invented" more than once", and "...when Adrian and Valerie Davies "coined" the word to describe music education..." as an indication that KINDERMUSIK (in both the word only and device form) were not susceptible to the objections based on sections 3(1)(a), (b) and (c) of the Act (as appropriate), when read in context, Mr Standley's witness statement does not, in my view, support the conclusions for which Mr Engelman argued.

Having reached that conclusion, I am of course mindful of Mr Engelman's detailed submissions on the evidence filed by the Opponent to date to support the objections based on section 3(1)(d) of the Act. However, even on this evidence Mr Engelman fairly accepted that a number of the exhibits were equivocal. Despite Mr Engelman urging me to consider the position on the basis of "the propensity of the evidence filed", I am not satisfied that as matters stand, and in the words of Sir Andrew Morritt in *Celador*, that the Opponent "...has no real prospect of success..." In reaching this conclusion I bear in mind that the evidential rounds in these proceedings are not yet complete, together with Mr Engelman's very helpful indication at the hearing that given the Opponent's unrepresented status, the Applicant was unlikely to oppose any request by them to re-file evidence currently in the proceedings (albeit in unsworn form) in the correct evidential format.

In summary having applied the criteria indicated to the Applicant's request for the total striking-out of these proceedings, I have concluded that (i) given the nature of the evidence filed to date, (ii) the possibility that evidence already filed by the Opponent may be re-filed in proper evidential form and (iii) the fact that the evidential rounds are still to be completed, that the objections (as currently pleaded) should remain against both applications."

15. The parties were allowed a period of one month from the date of this letter to file Form TM5, and in so doing to request a written statement of reasons for my decisions as a precursor to launching an appeal. KI filed Form TM5, following which I now give the reasons for my decisions below.

DECISION

16. At the hearing, I accepted that as a matter of principle the Registrar has, in appropriate circumstances, the power to strike-out all or part of a statement of case or defence. This power stems from the Registrar's inherent jurisdiction to regulate proceedings before him (see in this regard the comments of Mr Justice Pumfrey (as he then was) in *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536), a power which Kent has never sought to challenge. To confirm the position I took at the hearing, I note that paragraph 8.8 of the TMR's Law Section Work Manual reads as follows:

“8.8 Summary judgement/abuse of process

Although there is no mention in the rules of “summary judgment” it is considered, in appropriate circumstances, to be within the Registrar’s inherent jurisdiction - both on application by one of the parties and on her own volition. The Registrar herself may strike-out a case if she considers that there is no case to answer (see e.g. TPN 4/2000 on Statements of Case). Alternatively, a party may apply for summary judgement if for example they consider that the proceedings are an abuse of process. Under the broad term “abuse of process”, circumstances such as an estoppel or binding contract may arise (see e.g. *Omega SA’s Application* (BL O-554-01)).”

17. Having established that the Registrar has the power to strike-out, one then needs to determine how this power should be exercised. At the hearing Mr Engelman, by reference to the Civil Procedure Rules and the practice in the Court, referred me to the comments of Lord Woolfe in *Kent v Griffiths and Others* [2001] QB 36, and in particular to paragraph 38 of that decision when Lord Woolfe said:

“In so far as the Osman case [1999] 1 FLR 193 underlined the dangers of a blanket approach so much the better. However, it would be wrong for the Osman decision to be taken as a signal that, even when the legal position is clear and an investigation of the facts would provide no assistance, the courts should be reluctant to dismiss cases which have no real prospect of success. Courts are now encouraged, where an issue or issues can be identified which will resolve or help to resolve litigation, to take that issue or those issues at an early stage of the proceedings so as to achieve expedition and save expense. There is no question of any contravention of article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (1953) (Cmd 8969) in so doing. Defendants as well as claimants are entitled to a fair trial and it is an important part of the case management function to bring proceedings to an end as expeditiously as possible. Although a strike out may appear to be a summary remedy, it is in fact indistinguishable from deciding a case on a preliminary point of law.”

18. In addition, Mr Engelman agreed that the comments of Sir Andrew Morritt VC in *Celador Productions Ltd v Melville Boon and Others* [2004] EWHC 2362 (Ch) when he said:

“7. From these sources I derive the following elementary propositions:

- a) it is for the applicant for summary judgment to demonstrate that the respondent has no real prospect of success in his claim or defence as the case may be;
- b) a "real" prospect of success is one which is more than fanciful or merely arguable;
- c) if it is clear beyond question that the respondent will not be able at trial to establish the facts on which he relies then his prospects of success are not real; but

d) the court is not entitled on an application for summary judgment to conduct a trial on documents without disclosure or cross-examination.”,

were also relevant considerations.

19. In my view, the comments of Lord Woolfe and Sir Andrew Morritt indicate that given the need to save time and reduce costs in litigation, I should be slow to allow these proceedings to continue if, in my view, Kent had no “real prospect of success”. It is clear that the burden of justification rests with KI, and that a real prospect of success means a potential for success which was more than fanciful or merely arguable.

20. In these proceedings Kent are relying on grounds based on sections 3(1)(a), (b), (c) and (d) of the Act, although I note that the basis of the oppositions varies slightly between the A and B elements of the application. Section 3(1) reads as follows:

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

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

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

(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,

(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.”

21. Notwithstanding Mr Engelman’s detailed analysis of the exhibits filed by Kent in their evidence-in-chief i.e. in both his initial request to strike-out, in his skeleton argument and which he developed in his submission at the hearing, I came to the very clear conclusion that these consolidated proceedings should not be struck-out. At this point in my decision, it is, I think, important to keep in mind that the evidential rounds in these proceedings have not been completed. Notwithstanding the comments in Mr Engelman’s skeleton argument to the effect that:

“...Any evidence in reply has to be filed by Kent “strictly in reply” and therefore cannot add to the evidence it has already filed, Rule 13(C)(5),”

it was not, in my view, appropriate for me to pre-judge what (if any) evidence-in-reply Kent might file, whether that evidence would be deemed evidence strictly-in-reply, and if it was not, whether Kent would seek leave to file further evidence.

22. In explaining why I reached the conclusion I did in relation to KI's request for striking-out, I do not think it is necessary for me in this decision to carry out a review of the case law as it relates to section 3(1) of the Act; this is well known and requires, in my view, no further comment.

23. The issue before me was simply whether, at this stage of the proceedings, Kent had a realistic prospect of succeeding in their claims that Kindermusik (in both word only and word and device forms) were susceptible to the pleaded grounds of opposition.

24. I will deal with the A element (word only) first, objection to which has been taken under sections 3(1)(a), (b) and (d) of the Act. At the hearing, Mr Engelman said that in view of the comments in a range of recent cases, he would not be placing too much reliance on the dates of the various exhibits (see paragraph 7, point 5 above). He then took me through the exhibits to Mr Standley's witness statement (see paragraph 13 above), concluding that the grounds should be struck-out in totality. I do not propose to deal with all of Mr Engelman's comments on the exhibits. In some cases, for example, exhibits 6, 7 and 8 (which consist of e-mails (i) to Mr Standley from his solicitor, (ii) from Mr Standley to FFW and (iii) from KI's attorney to Mr Standley, respectively), Mr Engelman is clearly correct that this is not evidence which supports Kent's grounds under section 3(1). In relation to a range of other exhibits, Mr Engelman placed great reliance on the manner in which the word Kindermusik was presented and the nature of the surrounding text in which it appears. Some examples which, given Mr Engelman's comments on the use of the word Kindermusik by Kent I have disregarded (paragraph 13 above and the reference to exhibit 9 refers), will, I hope, assist.

25. Exhibit 10 consists of an Ofsted inspection report dating from October 1997 which contains the following sentence:

“... A music teacher attends weekly when the children listen to and perform “Kindermusik””.

Exhibit 13 consists of an extract from the Survey of Local Authority Music Services 2005. The word Kindermusik appears in the following contexts:

“...The least common were Gamelan (33%), Steel pans (23%), Kindermusik (7%), and other groups (31%). The ages ranged from nought to ten for Kindermusik..”;

“...were on average string ensembles (7.6), theory groups (7), pop/rock groups (6.3 groups), vocal groups (6.1), mixed bands (6), Kindermusik (6), wind bands (5.7)..”;

“Young music/kindermusik”, “Young musician/kindermusik” (appears in two tables in which, *inter alia*, the following entries also appear): “Samba bands, Samba, Steel pan ensembles, String ensembles, Wind bands, Woodwind ensembles, Folk groups....”;

“...Young musician/Kindermusik groups were most numerous in the Unitary authorities and London while Steel pan ensembles were least well....”

Exhibit 14 consists of what appears to be an undated (but after 2000-2001) website entry for the Associated Board of the Royal Schools of Music which contains the following entries:

“Group sessions covering a variety of topics including Tension in Performance, Use of Music Technology, Kindermusik, Motivation, Group Teaching and teaching students with special needs”;

“...for example, Alexander Technique, Dalcroze Eurhythmics, Kod’ly, Kindermusik and improvisation...”

Exhibit 17 consists of a newsletter from the South Berkshire Music Centre dating from Spring 1983 and contains, *inter alia*, the following entries:

“...May I draw your attention to the new “Kindermusik” classes which will..”;

““Kindermusik” – New groups for infant children””;

““KINDERMUSIK (MUSICAL FUN FOR YOUNG CHILDREN)”””;

“These new groups will follow in the European Music Education tradition of the eminent composers Zoltan Kodaly and Carl Orff, who believed that children are never too young to become interested in music.....”.

Exhibit 18 consists of a prospectus for the South Berkshire Music Centre from 1985-86 which contains the following entries:

“Kindermusik and Junior Music Workshop”;

“Scale E £8 – Kindermusik only”;

“KINDERMUSIK”.

Exhibit 19 consists of a flyer for the East Berkshire Music Centre dated September 1990 which contains, *inter alia*, the following entries:

“KINDERMUSIK CLASSES”;

“OPPORTUNITIES FOR YOUNG CHILDREN

Kindermusik
Junior Music Workshop
Choirs

Recorder”;

“KINDERMUSIK

This is a name borrowed from the German to describe a particular approach to the musical education of young children. It is based on the ideas of Kodaly....”

Exhibit 20 consists of three letters from West Sussex County Council. The first is date stamped 4 October 2001, and the other two are dated 8 and 30 November 2001. *Inter alia*, the following entries appear:

“National Foundation for Youth Music – “Kindermusik as a First Step””;

“...all children and parents that will benefit from the Kindermusik activities provided through this grant”;

““Kindermusik as a First Step”;

“..to the content of the Kindermusik classes...”;

“..for your help and support of Kindermusik activities in West Sussex”;

“Dear Kindermusik Teacher”.

Exhibit 21 consists of a newsletter from the South Downs Music Centre dated March 1988 in which the following entries appear:

“...and Mrs Johns will be taking Kindermusik (music for infants) at SDMC in Lewes.”;

“...has taken over as director of the Junior Choir.form a natural continuation to that started in Kindermusik classes...”.

Exhibit 22 consists of an extract from a South Downs Music Centre prospectus dated 1986 in which the following entry appears:

“Kindermusik groups will follow the music education concepts...”;

Exhibits 23 and 24 consist of letters dated 5 January and 5 November 1984 from the Royal County of Berkshire’s Department of Education to Heads of primary schools in the South Berkshire area in which, *inter alia*, the following entries appear:

“Kindermusik classes are already provided...”;

“KINDERMUSIK IN SERVICE COURSE”;

“The principles of Kindermusik are consistent with other in-service courses in music..”

Exhibit 27 consists of an extract from a programme for the Central Berkshire Music Centre for a concert which took place in July 1987 in which the following entry appears:

“Kindermusik
directed by Lorna Heyes and Tina Tizzard”.

26. As pointed out in Mr Engelman’s skeleton argument, exhibits 30 to 34 consist of unsworn statements from a range of individuals; similar considerations apply to exhibits 2 to 5. In my letter following the hearing I noted that:

“...together with Mr Engelman’s very helpful indication at the hearing that given the Opponent’s unrepresented status, the Applicant was unlikely to oppose any request by them to re-file evidence currently in the proceedings (albeit in unsworn form) in the correct evidential format.”

27. Equally I note the comment in FFW’s letter of 9 November in relation to the above in which they say:

“Although it is not suggested in Mr Bowen’s decision, we take this opportunity to emphasise that Mr Engelman did not have instructions in relation to whether or not the Applicant would oppose any such request and we would like it known for the record that should the Opponent file any evidence which is not confined to matters strictly in reply to that filed by the Applicant...instructions will be taken and opposition may be filed.”

28. A number of decisions of the TMR most notably that in *Ashford Property Services Ltd and APS Project Management Limited* (BL O-301-07 at paragraphs 11 and 12) have highlighted the importance of filing evidence of the type contained in these exhibits in the correct evidential format. Although KI did not object to the admission of these statements at the time they were filed, given the challenge raised in Mr Engelman’s skeleton argument, it would, in my view, be unsafe for me to rely upon this evidence.

29. As I mentioned above, I have for the purpose of determining KI’s request for striking-out, disregarded all the references to Kindermusik appearing in Kent’s own literature. The application in these proceedings was filed on 7 March 2003, with Michael Dougherty the Chief Executive Officer of KI commenting in paragraph 14 of his witness statement of 13 July that:

“KI began providing services and selling products in the UK in 1996..”

30. Even if one disregards Kent’s own use (exhibits 9, 11, 12, 15, 16 and 25), ignores all the references which are either undated or post date 1996 (exhibits 10, 13, 14 and 20) or have been provided in the wrong evidential format (exhibits 2, 3, 4, 5, 30, 31, 32, 33, and 34), there was still, in my view, sufficient evidence remaining (exhibits 17, 18, 19, 21, 22, 23, 24 and 27) to provide Kent with a “realistic prospect of success”; indeed at the hearing Mr Engelman accepted that the use shown in, *inter alia*, exhibits 18, 19, 22 and 27 was equivocal. In reaching this conclusion, I am of course mindful of Mr Engelman’s submissions regarding the manner in

which the word Kindermusik is presented in the exhibits appearing, for example, with the letter K presented in upper case, with the word in quotations marks or italics, and where the surrounding text appears in lower case, all of which, in his view, pointed to the word being used in a trade mark sense. However, I am far from convinced that those using the word Kindermusik in the exhibits mentioned have approached its presentation in the manner Mr Engelman suggests.

31. As examples, the words Junior Music Workshop appear in title case in exhibits 18 and 19, as do the words Choirs and Recorders in exhibit 19. In addition, the fact that the word Kindermusik is presented with a capital letter K may, as Mr Standley suggests in his written submissions (see paragraph 11 above), stem from the word's apparent German origins. Its presentation in quotations marks or italics, may simply be to ensure that that it stands out and is easily identified. Insofar as Mr Engelman's relied on an explanation being provided as to the meaning of the word Kindermusik as an indication that the word is being used in a trade mark sense (exhibits 15, 16, 17, 21 and 25), this was also, in my view, a far from convincing argument. In my experience it is common place for a writer when introducing a word with which he thinks the reader may be unfamiliar to adopt such an approach; it does not, in my view, suggest use in a trade mark sense.

32. In light of these conclusions, I determined that on the basis of the evidence provided by Kent, they still had, in the words of Sir Andrew Morritt, a "realistic prospect of success" in relation to all of their pleaded grounds. While the Hearing Officer making the final determination may take a different view on the evidence, and conclude, for example, that one (or indeed all) of the pleaded grounds are not made good, I did not think it appropriate to strike-out any of the pleaded grounds at this stage, as the evidence rounds had not yet been completed. In the circumstances of this case such an approach was not, in my view, appropriate, nor was it, in my view, likely to result in a significant saving in either time or expense for the parties.

33. Turning now to the B element (word and device), objection to which has been taken under sections 3(1)(a), (c) and (d) of the Act. In his skeleton argument Mr Engelman concluded that to succeed under section 3(1)(a), it would be necessary for Kent to establish that the device and stylisation present in the B element added nothing to the word Kindermusik alone, even if that word was wholly descriptive. I have already concluded that on the evidence filed to date, Kent have a realistic prospect of success in establishing that the word Kindermusik when presented alone may be open to objection.

34. If they are able to do that, presenting the word Kindermusik in a stylised script and replacing the letter "d" with a device indicating musical notation, may not be considered sufficient, given the nature of the goods and services for which KI seek registration, for the application to escape the objection based on section 3(1)(a) of the Act. Section 3(1)(c) of the Act refers to trade marks which consist exclusively of signs or indications which may serve in trade to designate, for example, the kind or intended purpose of goods or services; once again, if Kent are able to establish that the word Kindermusik when presented alone is objectionable, then in my view similar considerations to that under section 3(1)(a) above may apply to this ground of opposition. Finally in relation to the objection based on section 3(1)(d) of the Act, Mr Engelman is correct when he says that to date Kent have not filed any evidence which shows the word and device trade mark used in the trade. If no evidence is ultimately filed to support this ground, then it may

be prudent for Kent to consider abandoning it. However, as I mentioned above, given that the evidential rounds were not yet complete, striking-out this ground at this stage in the proceedings was unlikely, in my view, to result in significant savings in either time or expense, and I declined to do so.

Conclusion

35. In summary, I concluded that at this stage of the proceedings none of Kent's grounds of opposition should be struck-out, and that the consolidated opposition to KI's applications should continue.

Dated this 14th day of December 2007

**C J BOWEN
For the Registrar
The Comptroller-General**