



INVESTOR IN PEOPLE

World Intellectual Property Organisation (WIPO)  
International Bureau  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland



29 JUL. 2005



The Patent Office  
Trade Marks Registry  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

Switchboard: 01633 814000  
Direct Line: 01633 811031  
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Minicom: 0645 222250  
Website: www.patent.gov.uk

Telephone: (44) 1633 811031  
Fax No. (44) 1633 811437  
Our ref Opp 71219/Trade Marks Law/TB  
Date 29 July 2005

*Please quote our complete reference on all correspondence*

*The Case Work Examiner for these proceedings is Miss A Povall: 01633 811036*

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN  
OPPOSITION BY THE UNITED KINGDOM PATENT OFFICE IN ACCORDANCE  
WITH ARTICLE 5 OF THE MADRID PROTOCOL**

**RE: International Registration number :842363  
For the mark :SPRING VALLEY  
Holder of the International Registration :Lidl Stiftung & Co KG  
Opposition number :71219**

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry.

We also attach:

Copies of the marks referred to in the statement of case.  
Form TM8, for any reply to this opposition to be filed.  
Form TM33 for an agent/ address for service in the United Kingdom to be appointed.  
A copy of an extract from the United Kingdom Trade Marks Act 1994.



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If the holder of the International Registration wish to file a counterstatement, they should complete the attached form TM8 and return it together with the counterstatement within **3 months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a form TM8 and counterstatement will result in the provisional refusal being upheld in accordance with article 10 of the Trade Marks International Registration Order 1996(as amended).

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further nine months by the filing of A Form TM9c.

The Form TM8 and counterstatement should be received on or before **29 October 2005** unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom on the attached TM33 within this 3 month period. If one is not provided within this time the refusal will be made final.

Yours faithfully

*T. Beecham*

Tracey Beecham  
LAW SECTION ASSISTANT CASEWORK EXAMINER

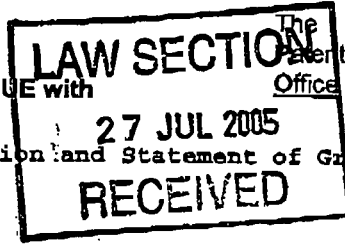
J120516/ 001 002507 TMD7.....  
26JUL05 200.00 ACCOUNT

FORM TM 7

OFFICIAL FEE £200 DUE with this form

Notice of Opposition and Statement of Grounds

71219



The Patent Office  
Trade Marks Registry  
Cardiff Road  
Newport  
South Wales NP10 8QQ

Please read the guidance notes below about filling in this form

1. Trade Mark number.	M842363
2. Full name of the applicant or registered proprietor.	Lidl Stiftung & Co. KG
3. Full name and address (including postcode) of opponent.	E. & J. Gallo Winery 600 Yosemite Boulevard Modesto, California 95354 United States of America
4. Name and address (including postcode) of the agent (if any)	R.G.C. JENKINS & CO  26 Caxton Street London SW1H 0RJ
5. Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number.	No
6. Under what sections of the Trade Marks Act are you opposing this application?	5(2)(b), 5(3), 5(4)(a)
7. Declaration	I believe that the facts stated in this notice and in the attached statement of grounds are true. See Patent Office website if not sure.
Your signature	
Your name in BLOCK CAPITALS	R.G.C. JENKINS & CO.
Date	21 <sup>st</sup> July 2005
8. Name and daytime phone number of the person we should contact in case of query.	Margaret Bonomo 020 7931 7141
Your reference.	G.51.54
Number of sheets attached to this form.	This is sheet 1 of

**Notes** You must attach a separate sheet with your statement of grounds for opposing the mark under each section of the Trade Marks Act. You must also attach a separate sheet for each earlier mark you rely on.

If there is not enough space for your answers to any section, you may use extra blank sheets.

Number every extra sheet and say in question 8 above how many sheets you have used.

(REV/MAY04)

Form TM7

Form TM7

Sheet of

Use this sheet if you are basing your opposition on section 5(1) or 5(2) of the Trade Marks Act.

Tick which section you are relying on and give details of the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Grounds for opposition based on section 5(1) or (2) of the Trade Marks Act 1994.

- 5(1) identical with an earlier mark and for identical goods or services as the earlier mark.
- 5(2)(a) identical with an earlier mark and for similar goods or services as the earlier mark.
- 5(2)(b) similar to an earlier mark and for identical or similar goods or services as the earlier mark.

**Details of earlier trade mark**

Number: 1284215

Is it a UK, community or International mark? Community

Representation of the mark: TWIN VALLEY

What goods or services are covered by this mark?

Alcoholic beverages (except beers)

State which goods or services in the application you say are identical or similar to those covered by the earlier mark.

Alcoholic beverages (except beers), in particular wines and spirits.

**Statement of use**

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time:

Form TM7

Sheet of

Use this sheet if you are basing your opposition on section 5(1) or 5(2) of the Trade Marks Act.

Tick which section you are relying on and give details of the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Grounds for opposition based on section 5(1) or (2) of the Trade Marks Act 1994.

- 5(1) identical with an earlier mark and for identical goods or services as the earlier mark.
- 5(2)(a) identical with an earlier mark and for similar goods or services as the earlier mark.
- 5(2)(b) similar to an earlier mark and for identical or similar goods or services as the earlier mark.

**Details of earlier trade mark**

Number: 2817369

Is it a UK, community or International mark? Community

Representation of the mark: SIERRA VALLEY

What goods or services are covered by this mark?

Alcoholic beverages (except beers).

State which goods or services in the application you say are identical or similar to those covered by the earlier mark.

Alcoholic beverages (except beers), in particular wines and spirits.

**Statement of use**

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time:

Form TM7

Sheet of

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act and give details of the earlier mark.

Grounds for opposition based on section 5(3) of the Trade Marks Act 1994.

5(3) identical with or similar to an earlier mark with a reputation.

**Details of earlier trade mark**

Number: 2817369

Is it a UK, Community or International mark? **Community**

Representation of the mark: **SIERRA VALLEY**

What goods or services are covered by this mark?

**Alcoholic beverages (except beers)**

State which goods or services you say this mark has a reputation for.

**Wine.**

State which goods or services in the application you say would take unfair advantage of or be detrimental to the distinctive character or reputation of the earlier mark.

**Alcoholic beverages (except beers), in particular wines and spirits.**

Why do you say this?

**The sale of a SPRING VALLEY wine in the UK will call to mind the opponent's SIERRA VALLEY wine given the unusual nature of the SIERRA VALLEY trade mark and, as such, will dilute the opponent's reputation in SIERRA VALLEY wine in the UK.**

**Statement of use**

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time:

Form TM7

Sheet of

Use this sheet if you are basing your opposition on section 5(4) of the Trade Marks Act.

Tick which section you are relying on and give details of the earlier mark.

Grounds for opposition based on section 5(4) of the Trade Marks Act 1994.

- 5(4)(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign use in the course of trade.
- 5(4)(b) by virtue of an earlier right other than those referred to in other subsections of section 5, in particular by virtue of the law of copyright, design right or registered designs; and state what type of right is involved:

Representation of the earlier mark, sign or right.

SIERRA VALLEY

How and where has the earlier right been used, and on what goods or services?

In relation to wine in the Austria, Benelux, Denmark, Estonia, Finland, France, Germany, Greece, Irish Republic, Italy, Latvia, Malta, Poland, Sweden, UK.

When was the earlier right first used on goods or services you have listed?

January 2002

State which goods or services in the application you object to.

Alcoholic beverages (except beers), in particular wines and spirits.

Form TM7

Sheet of

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

Other grounds for opposition.

- Section 56 Protection of well-known trade marks.
- Section 60 Acts of agent or representative.
- Rule 18(2) Application amended after publication.
- Rule 22 Regulations for collective or certification marks.
- Rule 23(4) Amendment of regulations for collective or certification marks.
- Rule 25(3) Alteration of registered mark.
- Rule 45(2) Removal of matter from the register.
- rule 47(1) Reclassification of specification.

Give details to support your opposition:

Form TM8

Nil Fee



## Notice of defence and counterstatement

The Patent Office  
Trade Marks Registry  
Cardiff Road, Newport  
South Wales NP10 8QQ

Please read the guidance note about filling in this form.

1. Trade Mark number.	(Lowest) Class
2. Full name of the applicant or registered proprietor.	
3. Opposition, invalidation, revocation, or rectification number.	
4. Name and address (including postcode) of the agent (if any).	
5. If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement?	
6. If you answered "No" to question 5, do you want the other side to provide proof of use of the earlier marks? If you want the other side to provide proof of use you must state in your counterstatement for which earlier marks and for which goods and services you require that proof.	
7. Counterstatement	

## Counterstatement (continued from previous sheet)

8. Declaration	I confirm the truth and accuracy of the information in this notice of defence and counterstatement.
Your signature	
Date	
9. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	

Note If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

Form TM33



No official fee due

**Request to appoint or change an agent or to enter or change an address for service**

The Patent Office  
Trade Marks Registry  
Cardiff Road, Newport  
South Wales NP9 1RH

Please refer to notes for guidance on completing this form

<p>1. Give details of the applications or registrations this will affect</p> <p>or</p> <p>the designation under the Madrid Protocol to which this request relates</p>	<table border="1"> <tr> <td data-bbox="861 492 973 526">Number(s)</td> <td data-bbox="1053 492 1181 526">(Lowest) Class</td> <td data-bbox="1228 492 1404 526">Licensee Numbers</td> </tr> <tr> <td data-bbox="861 649 973 683">Number(s)</td> <td data-bbox="1053 649 1181 683">(Lowest) Class</td> <td data-bbox="1228 649 1404 683">Licensee Numbers</td> </tr> </table>	Number(s)	(Lowest) Class	Licensee Numbers	Number(s)	(Lowest) Class	Licensee Numbers
Number(s)	(Lowest) Class	Licensee Numbers					
Number(s)	(Lowest) Class	Licensee Numbers					
<p>2. Full name of</p> <p>(a) proprietor</p> <p>(b) opponent</p> <p>(c) licensee</p> <p>(indicate a) to c) as appropriate)</p>							
<p>3. On behalf of the proprietor, grantor, licensee or opponent we notify you that we are the authorised:</p> <p>a) agent and address for service</p> <p>or b) address for service</p> <p>or c) agent</p> <p>(indicate a) to c) as appropriate)</p>							
<p>4. Is the agent or address for service authorised for:</p> <p>a) all transactions</p> <p>or</p> <p>b) this transaction only</p> <p>(indicate a) or b) and if b) provide details of transaction)</p>							
<p>5. New address for service or agent's details to be recorded</p> <p>Trade Marks ADP number (if you know it)</p> <p>Your reference</p>							
<p>Signature</p>							
<p>Name (block capitals)</p>							
<p>Date</p>							
<p>Name and daytime telephone number of person to contact</p>							
<p>State number of sheets attached to this form</p>							



# RELEVANT SECTIONS OF THE UNITED KINGDOM TRADE MARKS ACT 1994



## SECTION 1

(1) In this Act "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see Section 49) or certification mark (see Section 50).

## SECTION 2

(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.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is—

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community Law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in Section 4 (specialty protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

## SECTION 4

(1) A trade mark which consists of or contains—

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any emblem or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,

(b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has recently had Royal patronage or authorisation,

shall not be given unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of—

(a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

shall not be registered if it appears to the registrar that the use of the trade mark would be likely to be mistaken for that of the flag.

(3) A trade mark shall not be registered in the cases specified in—

(a) Section 57 (national emblems etc. of Convention countries), or

(b) Section 58 (emblems etc. of certain international organisations).

Provision may be made by rules prohibiting in such cases as may be prescribed the imitation of a trade mark which consists of or contains—

(a) a trade mark to which a person is entitled by virtue of a grant of arms by the Crown, or

(b) a trade mark which is so nearly resembling such arms as to be likely to be mistaken for them,

if it appears to the registrar that consent has been given by or on behalf of that person.

(5) A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995 shall not be registered unless it appears to the registrar—

(a) that the application is made by the person for the time being appointed under Section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympic Association Right), or

(b) that consent has been given by or on behalf of the person mentioned in paragraph (a) above.

## SECTION 5

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered design.

A person first entitled to prevent the use of a trade mark is referred to in this Act as a proprietor of an "earlier right" in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

## SECTION 6

(1) In this Act an "earlier trade mark" means—

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade mark,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the World Trade Organisation Agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was bona fide use of the mark during the two years immediately preceding the expiry.

## SOURCES OF PROFESSIONAL HELP AND ADVICE

You may obtain details of where to seek independent professional help/advice from either of the following:

The Institute of Trade Mark Attorneys  
Chartered House -  
15 Abchurch Lane  
LONDON  
EC4A 3DF

tel: +44(0)20 5526 2422  
fax: +44(0)20 5526 5723

The Chartered Institute of Patent Attorneys  
Patent House Building  
25 Abchurch Lane  
LONDON EC4A 3DF