

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2241966  
BY SCOTTISH & NEWCASTLE PLC  
TO REGISTER A TRADE MARK IN CLASSES 25, 33 AND 42**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 90375  
BY LAMBERT GFA**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST THE DECISION OF MR. D. LANDAU  
DATED 12 MAY 2003**

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**DECISION**

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1. In June 2003, Scottish & Newcastle plc (“S & N”) gave notice of appeal under section 76 of the Trade Marks Act 1994 against the refusal of its Application No. 2242966 for registration in Class 33 of the designation LAMBERT’S BAY for use as a trade mark in relation to “wines, spirits, liqueurs and cordials”.
2. The application for registration was refused in relation to such goods under section 5(2)(b) of the Act in the context of opposition proceedings brought by Lambert GFA (“LGFA”) under No. 90375. The grounds for refusal were contained in a decision issued by Mr. D. Landau on behalf of the Registrar of Trade Marks dated 12 May 2003. The Hearing Officer directed S & N to amend its Class 33 specification from “wines, spirits, cordials, liqueurs, cocktails, alcoholic extracts and alcoholic essences” to “cocktails, alcoholic extracts and alcoholic essences” within the time specified or the application would be refused for the entire Class 33 goods. [LGFA made no objection to the goods and services in Classes 25 and 45.]
3. In letters dated 13 November 2003, S & N and LGFA informed the Treasury Solicitor’s Department that a settlement had been reached between them. Under the settlement, S & N and LGFA effectively agreed that LGFA would withdraw its opposition and S & N’s application should be allowed to proceed in Class 33 for “still table wines” only. S & N and LGFA further agreed that each party would bear their own costs of the opposition and the appeal.

4. By letter dated 8 January 2004, the Registrar signified that he would have no objection to:
  - (a) The decision of Mr. Landau being discharged by consent to the limited extent of allowing the application for registration to proceed in respect of “still table wines”.
  - (b) The opposition filed under No. 90375 being withdrawn by consent in accordance with the agreement between the parties mentioned at paragraph 3 above.
  
5. I therefore direct and determine with the consent of the parties as envisaged by their settlement that:
  - (i) The decision issued by Mr. Landau on 12 May 2003 in opposition No. 90375 be discharged by consent to the limited extent of allowing trade mark application No. 2241996 to proceed in Class 33 in respect of "still table wines".
  - (ii) S & N’s appeal from the decision of Mr. Landau now stands withdrawn with no order as to costs.
  - (iii) LGFA’s opposition No. 90375 to S & N’s trade mark application No. 2241996 now stands withdrawn with no order as to costs.
  - (iv) S & N should file at the Trade Marks Registry within one month of this decision (if they have not already done so) a Form TM21 to amend the Class 33 specification to read:

“still table wines”.

If no Form TM21 is filed within the period set the Class 33 specification will be refused in its entirety.
  
6. For the sake of clarity, I confirm that the order for costs made by Mr. Landau in opposition No. 90375 is discharged.

Professor Ruth Annand, 3 March 2004