

Notification to the applicant/holder of a decision

Alicante, 17/10/2019

Wood IP Limited
2 Ivy Court
Daventry NN11 4EP
REINO UNIDO

Your reference: **Lambretta**

Opposition number: **B 001278342**

Contested trade mark number: **005849071**

Name of the applicant/holder: **Innocenti SA**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **17/10/2019**.

**Claudia ATTINA**

Enclosures (excluding the cover letter): 5 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Article 94(2) EUTMR.

OPPOSITION No B 1 278 342

Scooters India Limited, Post Bag No 23, Sarojini Nagar, 226 008 Lucknow, India (opponent), represented by **Boult Wade, S.L.**, Avda. de Europa, 26, ÁTICA 5, Planta 2, 28224 Pozuelo de Alarcón (Madrid), Spain (professional representative)

a g a i n s t

Innocenti SA, Vicolo Nasetta 2, 6900 Lugano, Switzerland (applicant), represented by **Wood IP Limited**, 2 Ivy Court, NN11 4EP Daventry, United Kingdom (professional representative).

On 17/10/2019, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 278 342 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS

The opponent filed an opposition against all the goods and services of European Union trade mark application No 5 849 071 'Lambretta', namely all the goods and services in Classes 3, 4, 8, 9, 11, 14, 16, 28, 32, 33 and 37. The opposition is based on the following earlier rights:

- 1) United Kingdom trade mark registration No 2 134 922 for the word mark 'LAMBRETTA';
- 2) European Union trade mark registration No 1 495 100 for the word mark 'LAMBRETTA';
- 3) European Union trade mark registration No 1 618 982 for the word mark 'LAMBRETTA';
- 4) word mark 'LAMBRETTA' claimed to be well-known in the sense of Article 6*bis* of the Paris convention in the United Kingdom.

The opponent invoked Article 8(1)(a) and (b) and Article 8(5) EUTMR in relation to earlier marks 1), 2) and 3) and Article 8(1)(a) and (b) in conjunction with Article 8(2)(c) EUTMR in relation to earlier mark 4).

CEASING OF EXISTENCE OF THE EARLIER TRADE MARKS 1), 2) and 3)

According to Article 46(1)(a) EUTMR, within a period of three months following the publication of an EUTM application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:

- a) by the proprietors of earlier trade marks referred to in Article 8(2) as well as licensees authorised by the proprietors of those trade marks, in respect of Article 8(1) and 8(5);

[...].

Furthermore, according to Article 8(2) EUTMR, 'earlier trade mark' means:

- (i) trade marks with a date of application for registration which is earlier than the date of application of the contested mark, taking account, where appropriate, of the priorities claimed in respect of the marks referred to in Article 8(2)(a) EUTMR;
- (ii) applications for a trade mark referred to in Article 8(2)(a) EUTMR, subject to their registration;
- (iii) trade marks which are well known in a Member State.

Therefore, the legal basis of the opposition requires the existence and validity of an earlier right within the meaning of Article 8(2) EUTMR.

In this respect, if, in the course of the proceedings, the earlier right ceases to exist (e.g. because it has been declared invalid or it has not been renewed), the final decision cannot be based on it. The opposition may be upheld only with respect to an earlier right that is valid at the moment when the decision is taken. The reason why the earlier right ceases to have effect does not matter. Since the EUTM application and the earlier right that has ceased to have effect cannot coexist any more, the opposition cannot be upheld to this extent. Such a decision would be unlawful (13/09/2006, T-191/04, Metro, EU:T:2006:254, § 33-36).

On 28/01/2008, the opponent filed a notice of opposition claiming as the basis of the opposition United Kingdom trade mark registration No 2 134 922 and European Union trade mark registrations No 1 495 100 and No 1 618 982, all for the word mark 'LAMBRETTA'.

UK trademark registration

On 25/10/2016, the opponent informed the Office that the UK trade mark registration No 2 134 922 was under revocation proceedings for non-use, but that a decision was not issued, yet, at the time. On the same date, it filed an extract from the UK Intellectual Property Office (UKIPO), with a printing date of 25/10/2016, whereby the mark appeared to be registered only for goods in Class 25 and where the cancellation action's details were given. The extract also showed that the mark was due for renewal on 04/06/2017.

Subsequently, on 24/09/2018, the opponent informed the Office that all the earlier trade mark registrations mentioned above, among which the abovementioned UK trade mark, had been revoked and the respective decisions have become final.

On 04/09/2019, the Office invited both parties to the proceedings to provide evidence on the status of the earlier UK trade mark registration No 2 134 922. The applicant submitted evidence in this respect, on 13/09/2019, which consists of two decisions in the revocation for non-use proceedings and an extract from the UK Intellectual Property Office database.

As stated in the documents filed by the applicant, earlier UK trade mark registration No 2 134 922 has, firstly, been partially revoked by decision of the UK Intellectual Property Office No O-099-15 of 06/03/2015. This revocation was also reflected on

the extract from the UK IPO submitted by the applicant on the same day, whereby the mark appeared to be still valid only for goods in Class 25. Ultimately, the mark was cancelled in its entirety by decision No O-480-17 of 05/10/2017, which has now become final.

European Union trade mark registrations

As regards the earlier European Union trade mark registration No 1 495 100, it was revoked in its entirety by decision of the Cancellation Division No 18125 C, of 25/05/2018, which is now final.

Lastly, with regard to earlier European Union trade mark registration No 1 618 982, this was revoked in its entirety by decision of the Cancellation Division No 2555 C, of 24/09/2010, which has become final.

As it is apparent from the facts stated above, the earlier trade mark registrations mentioned above ceased to exist and thus cannot constitute valid trade marks on which the opposition can be based within the meaning of Article 46(1)(a) EUTMR (formerly Article 41 EUTMR in the version in force at the time of filing of the opposition) and Article 8(2) EUTMR.

The opposition must therefore be rejected as unfounded, as far as it is based on these earlier marks.

The Opposition Division will continue to examine the opposition in light of the remaining earlier right, namely word mark 'LAMBRETTA' claimed to be well-known in the sense of Article 6*bis* of the Paris Convention in the United Kingdom.

SUBSTANTIATION OF THE WELL-KNOWN MARK

According to Article 76(1) EUTMR (in the version in force at the time of commencement of the adversarial part, now Article 95(1) EUTMR), in proceedings before it the Office will examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office is restricted in this examination to the facts, evidence and arguments submitted by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Rule 19(1) EUTMR (in the version in force at the time of commencement of the adversarial part), the Office will give the opposing party the opportunity to submit the facts, evidence and arguments in support of its opposition or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Rule 19(2) EUTMR (in the version in force at the time of commencement of the adversarial part), within the period referred to above, the opposing party must also file evidence of the existence, validity and scope of protection of its earlier mark or earlier right, as well as evidence proving its entitlement to file the opposition.

In particular, if the opposition is based on a well-known mark within the meaning of Article 8(2)(c) EUTMR, the opposing party must submit evidence showing that this

mark is well known in the relevant territory — Rule 19(2)(b) EUTMIR (in the version in force at the time of commencement of the adversarial part).

In the present case, the notice of opposition was not accompanied by any evidence as regards the earlier well-known trade mark on which the opposition is based.

On 19/03/2008, the opponent was given two months, commencing after the ending of the cooling-off period, to submit the abovementioned material. The initial time limit expiring on 20/07/2008 was extended, after a suspension of the proceedings, until 10/12/2018, and ultimately ended on 10/02/2019.

The opponent did not submit any evidence whatsoever concerning the substantiation of this earlier well-known trade mark.

According to Rule 20(1) EUTMIR (in the version in force at the time of commencement of the adversarial part), if until expiry of the period referred to in Rule 19(1) EUTMIR (in the version in force at the time of commencement of the adversarial part), the opposing party has not proven the existence, validity and scope of protection of its earlier mark or earlier right, as well as its entitlement to file the opposition, the opposition will be rejected as unfounded.

The opposition must therefore be rejected as unfounded in respect of this earlier right.

It follows that the opposition must be rejected in its entirety.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMIR (former Rule 94(3) and Rule 94(7)(d)(ii) EUTMIR, in force before 01/10/2017), the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Zuzanna STOJKOWICZ

Claudia ATTINÀ

Cynthia DEN DEKKER

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.