

08912

2010



JUDGEMENT NO. : 8912/2010

INDEX NO. : 7043/2010

ITALIAN REPUBLIC

IN THE NAME OF THE ITALIAN PEOPLE

THE COURT OF MILAN

Specialized Section for Industrial and intellectual Property

In the following composition:

Dr. Cesare de Sapia

Pres

Dr. Paoa Gandolofi

Jud.

Dr. Claudio Marangoni

Jud. Rel.

JUDGEMENT

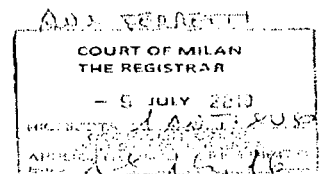
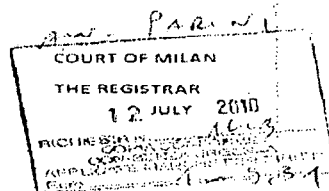
In the civil suit registered as No. 12642 of the general role for business disputes concerning the year 2008.

BETWEEN

BRANDCONCERN B. V. , In its temporary legal representative;

Elector domiciled in Milan, Italy 6 Course at the office of the prosecutor, lawyer Nicholas FERRETTI that represents and defends;

- Plaintiff-



For NAGLIA MART
Auth. Signatory

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SCOOTERS INDIA Limited, In its temporary legal representative;

Elector domiciled in Milan, Via Nino Bixio 45, at the offices of prosecutors, lawyer
Erminio PARINI and Marco ANDREOLINI that represent and defend;

- Defendant -

SUBJECT: Revocation for non-use of trademark

CONCLUSIONS

Hearing for determination of conclusions of 16.12.2009 the prosecutors of the parties
are concluded as:

For the Plaintiff: "About:

1) Find and declare that the following brands:

- No 223883 of 26.03.1968, concerning the word mark << Mini-Lambretta >> claimed
for the Class 12 (vehicles, apparatus for locomotion by land, air or water), identified
in documents with the letter. (d) and sub doc. bracket 5 plaintiff;
- No 83425 of 18.11.1948, concerning the words <<Lambretta>> for the whole
class12, identified in documents with the letter. (e) and sub doc. bracket 6 plaintiff;
- No 241546 of 24.11.1969, concerning the figurative word-mark <<Lambretta
Electronic>>, claimed responsibility for the whole class 12, identified in documents
with the letter. (f) and sub doc. bracket 7 plaintiff;

are not used by the defendant for over five years, and the effect decayed to declare
the marks do not use ex art. 24 c.p.i. ;

2) If it is found that the three brands above the defendant had already fallen for lack of
use in the last request for renewal of the same, and therefore that application for
renewal, with reference to each of the three brands, must be regarded as a new
deposit, requests a declaration of forfeiture for non-use art. 24 c.p.i. of these three
statements, So, in addition to compliance petitum previous requests a declaration
of forfeiture for non-use, respectively:

- Attestation No 788854, with reference to the trademark sub letter (d) referred to
the documents.

FOR LINGUA MART
[Signature]
[Stamp]

R.G. 12642/08

- Attestation No 829258, with reference to the trademark sub letter (e) referred to the documents.
- Attestation No 907067, with reference to the trademark sub letter (f) referred to the documents.

Finally, similarly to the above, it calls for the declaration of revocation art. 24 c.p.i. renewal of any certificate obtained by the defendant in the meantime, referring to opponents for each of the marks in question.

By way of investigating:

It confirms the document production is already reproduced in act and any possible exceptions or objections. (including the denial of conformity ex art.2719 c.c.) raised in relation to documents and generally to the inquiry proposed by the applicant.

It insists on the acceptance of applications to be excluded from plaintiff's inquiry, and in particular, among others, the instance ex art.213 c.p.c- performance of the defendant for the sale of motor vehicles, as well as the instance ex Art.210 c.p.c- performance of the courts of the invoices relating to the marketing in Italy of motorcycles or mopeds Lambretta brand. "

In any case:

rights, fees and the costs recovered fully with a request for distraction art.93 c.p.c. "

For the defendant: "at the outset, declaring the territorial jurisdiction of the Court of Milan in favour of the Court of Rome of First Deposit No. 223883, No. 83425, No. 241546;

On the merits, dismiss the claims brought by the plaintiff as unfounded;

Order the plaintiff to recover damages for increased responsibility ex art.96 paragraph 1 c.p.c-;

Costs, charges and fees due recovered.

As a trial, the defendant opposes the admission of any chapters for interrogation and trial made by the plaintiff as well as any instances of inquiry ex Art.210 and 213 c.p.c. and in the unlikely event of admission of one or more chapters trial asks to be admitted to proof to the contrary with the strained already indicated Mr. Gianluca Giombolini at Brade srl, via Pesche 537 (Cesena).

FOR LINGUA MART
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The defendant states that refuse to be heard in relation to any new application, including preliminary plea or request made by the other party. "

FACT AND LAW

Plaintiff Brandconcern B.V. inferred to be the holder of some CTM applications filed between June and December 2007, all involving the word part LAMBRETTA, with or without graphic variations (Application No 5,991,599, No. 6,464,291, the first two for the class 12 of vehicles).

He noted that the defendant Scooters India Ltd. is the owner of the following records:

- National mark no 223883 of 26.03.1968 for the name MINI-LAMBRETTA for Class 12 (vehicles), renewed recently by No 788854 granted on 09.02.1999 (doc. bracket 5 plaintiff)
- National mark no 83425 of 18.11.1948 for the LAMBRETTA name for Class 12 (vehicles), renewed recently by No 829258 granted on 20.11.2000 (doc. bracket 6 plaintiff)
- National mark no 241546 of 24.11.1969 naming LAMBRETTA ELECTRONIC with figurative part for Class 12 (vehicles), renewed recently by No 907067 granted on 03.21.2000 (doc. bracket 7 plaintiff)

These brand- second plaintiff - would no longer be used by the defendant for the production of scooters at least since 1998, a time when it has ceased such production in India after buying brands and systems in 1971 by the British Motor Corporation, which had once built the Innocents, and therefore requested the Court to pronounce the forfeiture of the same for use under Article no. 24 C.P.I.

Scooters India Ltd. The defendant at the outset challenged the jurisdiction of the court, noting that if it exists for records in regeneration, however, the defendant was the owner of the original mark for first deposit and then they would be sued before the Court Rome - both sides having their headquarters abroad - in the absence of domicile (Article 120, paragraph 2, C.P.I.).

Substance concluded the enduring reputation of the brand LAMBRETTA, which rules out the applicability in each case to the case of forfeiture for non-use of the hypothesis put forward to the plaintiff and the fact that the five-year period would still not use the course for mark No 907067, having been granted on 10.9.2003.

FOR LINGUA
S. J. A. M. R. T.
Auth. Signatory

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He also argued that it is not possible to provide a new deposit by one third of a mark - even if expired or lapsed - still has the ability to connect in the mind of the consumer to sign a particular party and noted that the brand LAMBRETTA was still used in products of clothing.

At the outset it should be noted that the plea of incompetence does not seem to land properly founded, given that it is peacefully Scooters India Ltd. have just purchased in 1971 marks containing the name already registered by LAMBRETTA already deposited by the innocent, and that therefore such address at the time of filing of such registration - which is not ever been changed - in the abstract must be considered eligible to establish territorial jurisdiction of the court in relation to the assignee of the mark.

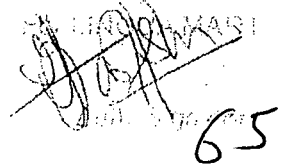
In this case, in fact, two of the three brands of first filing would have been subject to transfer to the defendant during their validity (those bearing nos. No 223883 of 26.03.1968 and 241546 of 24.11.1969) and therefore the fact that the defendant is resident abroad, as well as the plaintiff, it is entirely irrelevant to the 'proposed exception. In any case, it is clear to the Board that the application for revocation for non-use of the marks of first deposit held by the plaintiff should be dismissed for lack of standing.

Indeed, these records have long been discontinued and sold out in their effects, nor is there any ground for the plaintiff - who effected the deposit of its brands in 2007 alone, without deducting any past use of such signs to their advantage - that justified the current need preliminary dating of the request for such records.

As for brands in the ongoing renewal of application should first be noted that the registration No 907067, as granted on 10.9.2003 (Doc. Bracket 7 plaintiff) five years of non-use was not yet fully expired at the time of notification of the summons in the present judgment (14.2.2008).

This finding highlights the absence of the conditions prescribed by law in the event of forfeiture relied on for such registration, or being able to share the view of the plaintiff - also made only in the reply and therefore not subject to properly respect between the parties - according to which that term is a mere condition of the action, which may be supplemented from time to resolve the dispute.

Truly speaking course of five years stands as a condition of an item that is done and the hypothesis of the case for revocation provided for in Article .24 C.P.I., as delimiting the period of non-use law that determines the onset of the third to act and therefore must exist at the time of the proceedings.

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In any case, from all the records and documents produced in acts must be held properly tried it at least since 2002 the commercial sale of clothing bearing the mark in his characteristic handwriting LAMBRETTA already used the start of production of scooters innocent .

Indeed, the defendant has produced extensive documentation attesting to the contractual and licensing activities of the various sub-brands, in particular for the European region (see doc. 5 to 12, 21, 22 bracket conv.) and specifically in favour of Brade s.r.l. specifically as regards the Italian territory (see doc. bracket 31 conv.).

In addition, the witness confirmed that the Giombolini Brade s.r.l. - of which an administrator - is the sole distributor of clothing brand LAMBRETTA since 2001 for the Italian first licensed Dickens & Browne Ltd and subsequently Lambretta Clothing Company Ltd, and - apart from some individual invoices disputed by the plaintiff - were produced invoices showing that many acts in marketing activities for the years 2006 to 2008 (doc. From bracket 16 to 18 conv.).

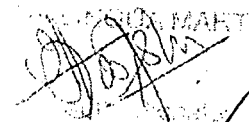
It should also be pointed out that the texts and Slave card - called by the same plaintiff in order to demonstrate the inability to use the sign in question by the defendants and heard evidence to the contrary on the chapter test relied on by defendant - have also confirmed that a knowledge of marketing in Italy of clothing bearing the mark LAMBRETTA, that they were unable pointer to which the subject was attributable to that activity.

It must therefore be derived from the documents and the instructor took place, in the opinion of the Board, on the one hand the enduring reputation of the sign which refers to the production of LAMBRETTA scooters began in Italy in World War II and continued until the early '70s, then held for years abroad, by today's plaintiff, reputation acts attested by the widespread presence of many fans who continue to celebrate, research and restoration models of those vehicles still in circulation which is associated with both the marketing of such vehicles in the used market that the spare parts.

In another area, attested also apparent for the five years preceding the establishment of this case the use of the mark in the apparel sector, carried out by use licensees and sub licensees and therefore attributable to the proprietor.

This is in point of fact, must reach a decision of rejection of applications performed by the plaintiff.

Indeed, the dr. has always reported the applicability of the difficult discipline of revocation for non-use in the case of well-known brand, where its appropriability by

A handwritten signature, possibly "D. S. B.", is written over a circular stamp. The stamp contains the text "TRIBUNALE DI ROMA" and "SEZIONE II".

third parties must be considered, however, precluded in the case of partial use of the sign due to the protection afforded to it in relation to areas not similar.

In this case, the fact that the sign in question is being used in the clothing industry and that such use is obviously aimed - as evidenced by the resumption of the original graphical elements of the sign and historical figure - to exploit the very symbolic and evocative still connected to the sign for the public is the appropriate condition for the exclusion in each concrete case of revocation of the mark for the specific area in which it originally acquired its reputation (Class 12), though for this class is not by a test direct use in the five years preceding the establishment of this case.

Beyond the obstacle to the appropriability by others of a famous mark by a new and independent storage because of lack of novelty that comes from the permanence of the connection of the previous mark with the work of the previous owner of his successors - Profile not relevant in the present case, it is not proposed by the defendant as a counterclaim any claim relating to the records of which the plaintiff is the owner - should indeed be considered that the use of the mark in the field is not known, but similar falls in an area compatible with its protection extended - as in this case, since the clothing and the sign being used because of its unique ability to purchase historically evocative - prevents the occurrence of all cases involving forfeiture of the narrow scope of products or services in respect of which the sign has achieved its reputation of peculiar characters. Applications for the plaintiff must be rejected.

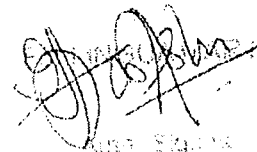
To follow an order that the unsuccessful plaintiff to pay the costs of the proceedings in favour of the party, paid as specified in the device.

P.Q.M.

The Court, finally saying, any further questions, rejected a plea or request:

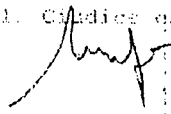
- 1) reject applications made by BRANDCONCERN B.V. against SCOOTERS INDIA Limited with a summons served on 14.2.2008;
- 2) sentencing plaintiff to reimbursement of the costs in favour of the counterparty, paid in € 10,000.00 (€ 500.00 in expenses, € 1,500.00 for rights, and € 8,000.00 for fees) over legal charges and expenses ex art.14 TF

Decided in Milan, in chambers on March 18, 2010.

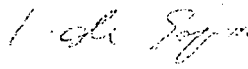
A handwritten signature in dark ink, possibly reading 'G. P. M.', is written over a circular official stamp. The stamp contains some illegible text, likely the name of the court or judge.

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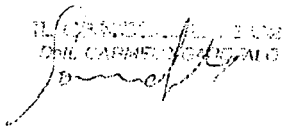
1. Giudice ost.



Il Presidente



IL CANCELLIERE
DIL CARMELO CASAFALO



TRIBUNALE DI MANTOVA
DEPOSITATO OGGI
7 LUG. 2008
IL CANCELLIERE C2
DIL CARMELO CASAFALO



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For LINDA MART
Auth. Signatory

