

MINISTRY OF SCIENCE AND TECHNOLOGY
INTELLECTUAL PROPERTY OFFICE

No.: 152848/TB-SHTT.IP

SOCIALIST REPUBLIC OF VIETNAM
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Hanoi, 30 September 2025

NOTICE

Regarding the refusal to cancel the validity
of the international trademark registration

Based on the result of the examination of the request for cancellation of the validity of
the protection title:

Application No.: **ĐN1-2012-00023**

Filing date: **27/02/2012**

Applicant: **Motom Electronics Group S.p.A.**

(PTT366) Address: Sede Legale Foro Bonaparte 63 - 20122 Milano;
Sede Operative Via L. Porro Lambertenghi, 4/6 - 20159 Milano, Italy;

Industrial property representative: **Phạm & Associates Law Firm;**

International trademark registration requested to be cancelled: **No. 936595**

Registration date: **13/6/2007**

I. Content of the request for cancellation of validity

1. On 27/02/2012, Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) filed application No. ĐN1-2012-00023 requesting cancellation of the validity of International Registration No. 936595 in the name of Lambretta S.r.l., on the following grounds:

i) The trademark “lambretta” for goods in Classes 09, 12, 14 and 25 under International Registration No. 936595 is similar to such an extent that it is likely to cause confusion with the well-known trademark “LAMBRETTA”;

ii) The registration of the mark “lambretta” by Lambretta S.r.l. was made with the intention of taking advantage of the reputation of the well-known trademark in order to hinder the honest manufacturing and business activities of other enterprises, in particular the manufacturer Motom Electronics Group S.p.A. and its distributors in Vietnam, namely Vĩnh Phát International Trading Co., Ltd. and Vĩnh Phát Company.

After the Second World War, Ferdinando Innocenti decided to produce a revolutionary type of motor scooter. This vehicle was named “Lambretta”. In 1947, Innocenti began manufacturing Lambretta scooters and created a craze in the decades that followed. In 1972, the Indian Government purchased the Milan factory and acquired the commercial rights to Lambretta, establishing Scooters India Limited (SIL).

In Vietnam, in the 1970s, a series of Lambretta models were imported into Vietnam, such as Lambretta Special 125cc, Special 150cc, SX 200cc, etc., and they became a craze among scooter enthusiasts. Lambretta attracted particular attention from the public, from connoisseurs of motor vehicles and from communities and forums dedicated to scooters in Vietnam.

Before 13/6/2007, the filing date of International Registration No. 936595, Lambretta had already been widely known to the public as a famous mark for scooters. Five years after 13/6/2007, the results of large-scale surveys involving different groups of respondents in Hanoi, Da Nang and Ho Chi Minh City further demonstrated and confirmed the fame of the Lambretta mark for scooters in Vietnam.

On the basis of the above, it can be seen that when filing the application for the mark “Lambretta” in Vietnam, Lambretta S.r.l. could not have been unaware of Lambretta as a well-known mark for scooters. Moreover, Lambretta S.r.l. did not itself manufacture motorbikes but still proceeded to register the Lambretta mark with the intention of taking advantage of the reputation of the well-known mark in order to hinder the honest manufacturing and business activities of other enterprises, in particular the manufacturer Motom Electronics Group S.p.A. and the distributors in Vietnam: Vĩnh Phát International Trading Co., Ltd. and Vĩnh Phát Company.

2. On 06/04/2012, the Intellectual Property Office issued Official Letter No. 2125/SHTT-TTKN notifying Lambretta S.r.l. of the request by Motom Electronics Group S.p.A. to cancel the validity of International Registration No. 936595.
3. On 20/06/2012, Lambretta S.r.l. (through BANCA Co., Ltd.) submitted a written response to the notice of the Intellectual Property Office regarding the request for cancellation of the validity of International Registration No. 936595 filed by Motom Electronics Group S.p.A., with the following main content:
 - The request for cancellation of the validity of International Registration No. 936595 is based on the argument that the mark “lambretta” is similar to the well-known mark “LAMBRETTA”. However, in all the documents and information submitted to prove that the mark “LAMBRETTA” is well-known, Motom Electronics Group S.p.A. failed to provide information as to who is the owner of that mark.
 - As regards the survey results provided by Motom Electronics Group S.p.A., such results are not lawful evidence since the investigation was carried out by the very party requesting cancellation and therefore does not ensure objectivity.

Moreover, the survey results do not prove the fame of the opposed mark “LAMBRETTA”, because the respondents only show a general awareness of the mark and do not link it to a specific owner.

- The opposed mark “LAMBRETTA” was first used by the Italian company Innocenti for motor scooter products from 1947. In 1972, the Indian Government bought Innocenti’s factory for USD 2.4 million and established Scooters India Limited (SIL). Scooters India Limited (SIL) has never been able to produce evidence of a transfer of rights to the mark “LAMBRETTA” from Innocenti to the Indian Government or from the Indian Government to Scooters India Limited (SIL).

Currently, Scooters India Limited (SIL) holds rights to the mark “LAMBRETTA” in India, Italy, the United States, the United Kingdom and the countries of the European Community, but most of those registrations have been cancelled for non-use. Therefore, the mark “LAMBRETTA” owned by SIL has never been considered well-known in the countries where SIL registered the mark, because if it were truly famous and had reputation attached to its owner, those registrations could not have been cancelled for non-use.

- Lambretta S.r.l. is a company belonging to the Lambretta Consortium, which has offices in Italy, England, Ireland and the Netherlands, and is the holder of rights to the mark “Lambretta” worldwide, acting under the authorization of the Lambretta Consortium. The Lambretta Consortium was established in Switzerland in 1979, five years after the closure of the Innocenti factory, initially under the name Lambretta S.A. The Lambretta Consortium filed trademark applications for “Lambretta” in most countries around the world. At present, the “Lambretta” mark is protected in the name of Lambretta S.r.l.
- Under Vietnamese law, trademark rights are established on the basis of registration; therefore, use of the mark before filing is not a mandatory requirement. However, from 2007 to early 2011, Motom Electronics Group S.p.A. was a licensee under a licence agreement concluded with Brandconcern BV in relation to the use of the mark “Lambretta”. Consequently, the use of the mark “Lambretta” by Motom Electronics Group S.p.A. during the term of the licence is considered lawful use on behalf of Brandconcern BV, Lambretta S.r.l. and the Lambretta Consortium.
- The allegation by Motom Electronics Group S.p.A. that the registration of the mark “Lambretta” by Lambretta S.r.l. was intended to take advantage of the reputation of a well-known mark and to block the honest business activities of other enterprises is not true. On the contrary, Motom Electronics Group S.p.A. is the party acting in bad faith, as shown through a series of acts: breaching payment obligations, leading to the termination of the licence agreement with Brandconcern BV on 01/01/2011; thereafter unilaterally registering the mark

“LAMBRETTA” in the European Community and in Vietnam through an affiliated company; simultaneously initiating procedures to request cancellation of the mark “Lambretta” that it claims is owned by Brandconcern BV in Vietnam; and entering into distribution contracts for scooters bearing the mark “Lambretta” in Vietnam with Vĩnh Phát International Trading Co., Ltd. and Vĩnh Phát Company without the authorization of Lambretta S.r.l., the trademark owner in Vietnam.

According to Lambretta S.r.l., the request for cancellation of validity was filed merely to deliberately delay the handling of infringement acts by the importer and distributor in Vietnam (Vĩnh Phát Company) of scooters bearing the mark “Lambretta” manufactured by Motom Electronics Group S.p.A., in order to gain more time to sell the infringing goods.

4. On 11/07/2012, the Intellectual Property Office issued Official Letter No. 5104/SHTT-TTKN notifying Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) of the contents of Lambretta S.r.l.’s response.
5. On 15/08/2012, Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) submitted a written response to the notice of the Intellectual Property Office regarding the comments of Lambretta S.r.l., with the following main content:
 - On 14/11/2007, Motom Electronics Group S.p.A. entered into a contract with Brandconcern BV on the basis of International Registration No. 936595, allowing Motom Electronics Group S.p.A. to exclusively manufacture and distribute scooters bearing the mark “Lambretta” in Italy, Spain, Portugal and France. However, after concluding the licence agreement with Brandconcern BV and manufacturing/selling scooters bearing the mark “Lambretta” on the European market, Motom Electronics Group S.p.A. learned that the licence agreement of 14/11/2007 was considered invalid and that the true owner of the mark “Lambretta” was SIL. As a result, Motom Electronics Group S.p.A. was compelled to enter into a settlement agreement with Fine White Line (FWL) allowing it to manufacture and sell off the remaining Lambretta Pato scooters until 31/10/2009.
 - On 31/03/2010, Motom Electronics Group S.p.A. signed a licence agreement for use of the mark “Lambretta” with SIL, through a sublicense agreement with Lambretta Scooter Limited (LSL) granted by Fine White Line (FWL).
 - To prove that the mark “Lambretta” is well-known, Motom Electronics Group S.p.A. submitted information relating to the extensive use of the mark “Lambretta” in Vietnam, including online articles with thousands of views. In practice, Lambretta scooters are still used daily on the streets of Vietnam, so many people are aware of the “Lambretta” mark.

- Discovering the significant profit potential in exploiting rights to the mark “Lambretta”, Brandconcern BV tried in every way to register the mark “Lambretta” and then transferred all trademark registrations into the name of Lambretta S.r.l., with the purpose of giving them an “Italian origin” appearance, while attempting to conceal the true owner of the “Lambretta” mark, SIL.

In addition to seeking registration in Vietnam and attempting in various ways to terminate the licence agreement of 31/03/2010, Brandconcern BV systematically organized a series of campaigns to disseminate false information to intimidate and pressure Motom Electronics Group S.p.A. and its partners. Specifically:

In Europe, they sent warning letters with threatening wording to Motom Electronics Group S.p.A. and its distributors such as CLAG. (Annex 10).

In Vietnam, while the dispute over the mark Lambretta S.r.l. had not yet been finally resolved, through their representative (BANCA Co., Ltd.), they issued warnings and recommendations to Vĩnh Phát Company, the exclusive distributor of Motom Electronics Group S.p.A. in Vietnam, and to Vĩnh Phát’s dealers, although the Lambretta LN125 scooters imported by Vĩnh Phát Company, manufactured and supplied by Motom Electronics Group S.p.A. for the Vietnamese market, had legitimate origin and were completely genuine goods.

This is clearly shown in Official Letter No. 1305/NH dated 29/12/2011 of BANCA Co., Ltd. addressed to Vĩnh Phát Company, referring to the licence agreement of 31/03/2010, which was said to have been terminated by the decision of 16/12/2011 of the Milan Court because Motom Electronics Group S.p.A. had not paid licence fees within the prescribed period.

However, after examining the content of the 16/12/2011 decision, Motom Electronics Group S.p.A. considered that BANCA Co., Ltd. had used a “Search Order” which merely allowed the plaintiff to collect information for further hearings before the Milan Court (and did not constitute a final judgment). In fact, on 29/02/2012, the Milan Court issued a decision to revoke the said Search Order of 16/12/2011.

Given the increasing seriousness of the matter, on 16/07/2012 the Milan Court issued decision No. 26011/2012 R.G., prohibiting Brandconcern BV and other organizations and individuals from holding press conferences and disseminating untrue information against Motom Electronics Group S.p.A.

6. On 03/10/2012, the Intellectual Property Office issued Official Letter No. 7769/SHTT-TTKN notifying Lambretta S.r.l. (through BANCA Co., Ltd.) of the content of the response of Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) to Lambretta S.r.l.’s earlier comments.
7. On 30/10/2012, Lambretta S.r.l. (through BANCA Co., Ltd.) filed a further response to the notice of the Intellectual Property Office regarding the

comments of Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm), with the following main content:

- According to the documents submitted by Motom Electronics Group S.p.A., the head licence agreement concluded between SIL and FWL is based on SIL's registrations of the mark "LAMBRETTA" in the European Community and the United Kingdom. However, Brandconcern BV asserts that these registrations have all been cancelled for non-use. Therefore, the head licence and the sublicense agreements invoked and submitted by Motom Electronics Group S.p.A. are no longer valid and cannot be taken into consideration in this case.

With regard to Motom Electronics Group S.p.A.'s reference to having to sign an agreement with Fine White Line (FWL) in order to be allowed to manufacture and sell off the Lambretta Pato scooters until 31/10/2009, Motom Electronics Group S.p.A. argues that both FWL and LSL (the company entering into the sublicense agreement with Motom) joined the Lambretta Consortium (the parent company of Lambretta S.r.l.) in 2010 after realizing that SIL was not the true owner of the "LAMBRETTA" mark and that SIL's registrations for "LAMBRETTA" had been cancelled in nearly all the countries where SIL had registered the mark, even though SIL had attempted to defend its rights by invoking (without supporting evidence) the alleged well-known character of the mark.

SIL is not the owner of the "LAMBRETTA" mark transferred from Innocenti. Moreover, as of now, most of SIL's "LAMBRETTA" registrations have been cancelled for non-use. Therefore, SIL no longer has any rights to this mark.

Meanwhile, the Lambretta Consortium (the parent company of Lambretta S.r.l.) established rights to the mark "LAMBRETTA" as early as 1958 with Spanish registration No. 338026, followed by Swiss registration No. 408722 in 1983, International Registration No. 615996 dated 17/02/1994, International Registration No. 712094A dated 30/03/1999, International Registration No. 715694A dated 23/03/1999, etc., all earlier than the time when SIL registered "LAMBRETTA" in the European Community (in 2000).

At present, the Lambretta Consortium is the worldwide owner of the "LAMBRETTA" mark. This information is also reflected in trademark materials for "LAMBRETTA" provided by Motom Electronics Group S.p.A., and is further shown on the official website of Vĩnh Phát Company, Motom Electronics Group S.p.A.'s distributor in the Vietnamese market.

Thus, from the above-mentioned evidence and from the admissions of the party requesting cancellation (Motom Electronics Group S.p.A. and Vĩnh Phát Company), it can be affirmed that the Lambretta Consortium is the true owner of the "Lambretta" mark at the present time. The fact that the registrations in Vietnam stand in the name of Lambretta S.r.l. is based on authorization from the Lambretta Consortium.

- The “LAMBRETTA” mark of SIL is not a well-known mark in Vietnam:

Online articles are not considered evidence with legal value because the information contained in them cannot be guaranteed for accuracy. Most of the online articles submitted by Motom Electronics Group S.p.A. relate to the LN125 scooter model bearing the “LAMBRETTA” mark (of a promotional nature), which was imported and distributed in Vietnam from late 2011 (after the filing date of International Registration No. 936595).

The survey results cannot be considered evidence with legal value because the surveys were conducted by the party requesting cancellation itself, which does not ensure objectivity.

The surveys were conducted after Vĩnh Phát Company had carried out intensive promotional activities to introduce the allegedly infringing Lambretta scooter model in Vietnam (late 2011). Thanks to these activities, the “LAMBRETTA” mark became known to Vietnamese consumers. It is also possible that some Vietnamese consumers know of the “LAMBRETTA” mark, but as the “LAMBRETTA” of the Lambretta Consortium, as reflected in the internet articles submitted by Motom Electronics Group S.p.A.

In reality, scooters bearing the “LAMBRETTA” mark manufactured by Innocenti were known only to a very small number of older Vietnamese consumers, and only a small number of such vehicles were present in Vietnam through unofficial distribution channels. As for motorcycles bearing the “LAMBRETTA” mark produced by SIL, Motom Electronics Group S.p.A. has not provided any evidence that these products were used in Vietnam since SIL acquired Innocenti's factory in 1972, let alone that they were widely known throughout the territory of Vietnam before the filing date of International Registration No. 936595.

Therefore, the assertion by Motom Electronics Group S.p.A. that SIL's “LAMBRETTA” mark is a well-known mark widely used in Vietnam is unfounded and illogical.

8. On 02/04/2013, the Intellectual Property Office issued Official Letter No. 2981/SHTT-TTKN notifying Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) of the content of Lambretta S.r.l.'s response to Motom Electronics Group S.p.A.'s rebuttal, and requested the parties as follows:
 - Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) to inform the Intellectual Property Office of its opinion regarding the issues raised in Lambretta S.r.l.'s Official Letter of 30/10/2012 (submitted through BANCA Co., Ltd.);
 - Lambretta S.r.l. (through BANCA Co., Ltd.) to provide evidence proving that the registration of the “Lambretta” mark by Lambretta S.r.l. was undertaken under authorization from the Lambretta Consortium.

9. On 15/05/2013, Lambretta S.r.l. (through BANCA Co., Ltd.) submitted copies of documents proving that the registration of the “LAMBRETTA” mark by Lambretta S.r.l. was carried out under authorization from the Lambretta Consortium.
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II. Result of the examination of the request for cancellation of validity

1. Legal basis:

- Point i, Clause 2, Article 74 of the Law on Intellectual Property stipulates that a trademark is considered indistinctive if it is:
“A sign identical with or confusingly similar to a mark recognized as well-known of another person, used for identical or similar goods or services to those bearing the well-known mark, or used for dissimilar goods or services if the use of such sign would be likely to affect the distinctiveness of the well-known mark or if the registration aims at taking advantage of the reputation of the well-known mark.”
- Point b, Clause 1, Article 96 of the Law on Intellectual Property stipulates that a protection title shall be cancelled in whole in the following cases:
“The protected industrial property subject matter fails to satisfy the protection conditions at the time the protection title was granted.”

2. Findings and assessment:

After checking and verifying the information given in the request for cancellation of validity and examining the documents in the case file, the Intellectual Property Office finds that:

- Under Clause 3, Article 96 of the Law on Intellectual Property, the allegation that a trademark registration was granted as a result of dishonesty on the part of the applicant is only a basis for excluding the five-year limitation period for exercising the right to request cancellation of the validity of a mark that has been registered for more than five years. It is **not itself** a substantive ground for cancelling the validity of the protection title.
- Regarding the argument by the requesting party that “LAMBRETTA” was a well-known mark in Vietnam before the filing date of International Registration No. 936595 (13/6/2007), based on the history of the brand, the appearance of Lambretta scooters in Vietnam in the 1970s, various online articles/forums and a sociological survey conducted many years after the filing date, the evidence submitted does **not** prove widespread recognition throughout the territory of Vietnam at the time of filing.

There are no systematic data on sales volume, market share, distribution and customer-service networks, advertising expenditure, or stable territorial scope of use

before 13/6/2007. Most of the evidence consists of promotional or commemorative articles and online content that arose after the filing date and therefore does not have sufficient evidentiary value to infer backwards the alleged well-known status at the relevant point in time.

The documents submitted also fail to identify which entity's reputation the mark is associated with in Vietnam before the filing date (SIL or the Lambretta Consortium/Brandconcern or another entity). The failure to clarify who was the owner of the mark during the relevant period means there is no basis to determine which mark, if any, is a well-known mark in Vietnam through use.

The requesting party also argues that Lambretta S.r.l. does not manufacture scooters and that its registration was intended to prevent the business activities of Motom Electronics Group S.p.A./Vĩnh Phát Company. However, the law does not require that the applicant must directly manufacture the goods for which the mark is registered. The case file shows that Lambretta S.r.l. filed the registration under authorization from the Lambretta Consortium, which holds global rights to "LAMBRETTA".

The historical dispute over rights to the mark between SIL and the Lambretta Consortium/Brandconcern has not been conclusively resolved; the licence agreements invoked by Motom Electronics Group S.p.A. are also contested by Lambretta S.r.l. on the grounds that they are based on registrations that have been cancelled in the EU and the UK. Since it is not possible to clearly determine the right holder to the mark that the requesting party claims to be well-known (if any), there is insufficient basis to conclude that the mark registered by Lambretta S.r.l. (now Innocenti S.A.) is identical or confusingly similar to a well-known mark of another party.

From the above findings and assessment, the Intellectual Property Office considers that the request by Motom Electronics Group S.p.A. to cancel the validity of International Registration No. 936595 in the name of Lambretta S.r.l. (now Innocenti S.A.) is unfounded.

III. Conclusion

On the basis of Point i, Clause 2, Article 74 and Point a, Clause 1, Article 96 of the Law on Intellectual Property, and in view of the documents and evidence currently available, the Intellectual Property Office finds that there is **no ground** to cancel the validity of International Registration No. 936595 in the name of Lambretta S.r.l. (now Innocenti S.A.) as requested by Motom Electronics Group S.p.A.

In light of the above considerations and legal grounds, the Intellectual Property Office hereby notifies as follows:

1. The request to cancel the validity of International Registration No. 936595 in the name of **Innocenti S.A.** is **refused**.

2. The requester has the right to lodge a complaint in accordance with the law within **90 days** from the date of receipt of, or the date of becoming aware of, this Notice.
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Recipients:

- Applicant;
- Innocenti S.A. (via BANCA Co., Ltd.) (for information);
- CDNH (for information);
- Archives: Office, Case file.

On behalf of the Director General

DEPUTY DIRECTOR GENERAL

Lê Huy Anh

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