

**MINISTRY OF SCIENCE AND TECHNOLOGY
INTELLECTUAL PROPERTY OFFICE OF VIETNAM**

No.: 152849/TB-SHTT.IP

SOCIALIST REPUBLIC OF VIETNAM
Independence – Freedom – Happiness

Hanoi, 30 September 2025

NOTICE

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

Based on the results of examination of the request to cancel the validity of the
protection title:

Application No.: **ĐN1-2012-00022**

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

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

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 for cancellation: **IR No. 977372**

Registration date: **12/05/2008**

I. Content of the request for cancellation of validity

1. Filing of the request

On 27/02/2012, Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) filed application No. ĐN1-2012-00022 requesting cancellation of the validity of International Registration No. 977372 in the name of Lambretta S.r.l., for the following reasons:

- i) The trademark “**Lambretta**”, for goods in Classes 03, 09, 12, 14, 18, and 25 under IR No. 977372, 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 carried out with the intent of taking advantage of the reputation of the well-known mark to obstruct the honest manufacturing and business activities of other enterprises, specifically the

manufacturer Motom Electronics Group S.p.A. and its distributors in Vietnam: Vĩnh Phát International Trading Co., Ltd. and Vĩnh Phát Company.

Historical background referenced by the applicant

After World War II, Ferdinando Innocenti decided to manufacture a revolutionary type of scooter, named **Lambretta**. In 1947, Innocenti began producing Lambretta scooters and they became a major phenomenon for decades.

In 1972, the Indian Government purchased the Milan factory and acquired the commercial rights to Lambretta, establishing **Scooters India Limited (SIL)**.

In Vietnam, during the 1970s, various Lambretta scooter models (Special 125cc, Special 150cc, SX 200cc, etc.) were imported and became extremely popular among scooter enthusiasts. Lambretta attracted significant public attention, especially among motor enthusiasts and various scooter communities and forums.

Before 12/05/2008 — the filing date of IR No. 977372 — Lambretta was widely known to the public in Vietnam as a famous trademark for scooters. Five years after that date, extensive surveys carried out in Hanoi, Da Nang and Ho Chi Minh City also confirmed the strong recognition of the Lambretta mark for scooters in Vietnam.

From this, the requester argued that Lambretta S.r.l. must have been aware of the reputation of the Lambretta mark before filing. Furthermore, Lambretta S.r.l. did not manufacture scooters, but still proceeded to register the mark with the intention of taking advantage of the well-known reputation to hinder the legitimate business activities of Motom Electronics Group S.p.A. and its distributors in Vietnam.

2. Notification from the Intellectual Property Office

On 06/04/2012, the Intellectual Property Office issued Official Letter No. 2124/SHTT-TTKN informing Lambretta S.r.l. of the request for cancellation of IR No. 977372 filed by Motom Electronics Group S.p.A.

3. Response from Lambretta S.r.l. (through BANCA Co., Ltd.)

On 20/06/2012, Lambretta S.r.l. filed a response with the following main points:

– **The requester did not identify the owner of the “LAMBRETTA” mark**

Although Motom Electronics Group S.p.A. asserted that “LAMBRETTA” is a well-known mark, they failed to provide information identifying **who owns** that trademark.

– **Survey results submitted by the requester are not objective**

According to Lambretta S.r.l., the requester's consumer surveys were conducted by the requester itself and therefore lack objectivity. Moreover, the surveys do not demonstrate that the "LAMBRETTA" mark is well-known, as respondents merely expressed general recognition rather than linking the mark to a specific owner.

– **SIL's rights to "LAMBRETTA" are unproven and mostly cancelled**

SIL claims to be the successor to Innocenti, but:

- SIL never proved the transfer of trademark rights from Innocenti to the Indian Government, or from the Indian Government to SIL;
- Most "LAMBRETTA" registrations in India, Italy, the US, the UK, and EU countries have been **cancelled for non-use**;
- Therefore, SIL's "LAMBRETTA" mark has **never been recognized as well-known** in any jurisdiction.

– **Lambretta S.r.l. registered the mark under authorization from the Lambretta Consortium**

Lambretta S.r.l. stated:

- It is part of the **Lambretta Consortium**, based in Italy, the UK, Ireland, and the Netherlands;
- The Consortium was founded in Switzerland in 1979 and has registered the "Lambretta" mark worldwide;
- Trademark protection in Vietnam stands in the name of **Lambretta S.r.l.** under authorization from the Consortium.

– **Use prior to filing is not required under Vietnamese law**

Trademark rights are established by registration.

Use prior to filing is **not required**.

However, Motom Electronics Group S.p.A. had previously been a **licensee** of Brandconcern BV between 2007 and early 2011; therefore, their use during the licence period actually supports the legitimate use of the "Lambretta" mark by Brandconcern BV, Lambretta S.r.l., and the Consortium.

– **Motom Electronics Group acted in bad faith**

Lambretta S.r.l. stated that Motom:

- breached payment obligations → licence terminated on 01/01/2011;
- then attempted to register "LAMBRETTA" in the EU and Vietnam;
- attempted to cancel registrations belonging to Brandconcern BV;

- sold Lambretta-branded scooters in Vietnam without authorization;
- filed the cancellation request merely to delay enforcement against its Vietnamese distributor (Vĩnh Phát Company).

4. Notification to Motom Electronics Group S.p.A.

On 11/07/2012, the Intellectual Property Office issued Official Letter No. 5107/SHTT-TTKN informing Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) of the contents of the response submitted by Lambretta S.r.l.

5. Motom Electronics Group S.p.A.'s further response

On 15/08/2012, Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) submitted an additional response, with the following main arguments:

– Licence agreement of 14/11/2007

Motom Electronics Group S.p.A. stated:

- On 14/11/2007, they entered into a licence agreement with Brandconcern BV based on International Registration No. 977372;
- This agreement granted their company exclusive rights to manufacture and distribute Lambretta scooters in Italy, Spain, Portugal and France;
- After producing and selling Lambretta scooters in Europe, they learned that the licence agreement was deemed invalid because SIL was considered the “true owner” of the mark;
- As a result, they were forced to enter into a settlement agreement with Fine White Line (FWL), allowing them to produce and sell the **Lambretta Pato** scooters until **31/10/2009**.

– Licence agreement of 31/03/2010

Motom additionally stated:

- On 31/03/2010, they signed a licence agreement with **SIL** through a sublicense granted by **FWL** to Lambretta Scooter Limited (LSL).

– Evidence of fame in Vietnam

Motom argued:

- Numerous online articles with thousands of views show that Lambretta scooters are widely known in Vietnam;
- Lambretta scooters are still used daily on Vietnamese streets, demonstrating widespread recognition of the “Lambretta” brand.

– Accusation of Brandconcern BV

According to Motom Electronics Group S.p.A.:

- Brandconcern BV sought to profit from the “Lambretta” brand;

- Brandconcern BV aggressively registered the mark and later transferred those registrations into the name of Lambretta S.r.l.;
- This was done to give the mark an “Italian identity” and conceal the alleged real owner (SIL).

They also claimed that Brandconcern BV carried out **coordinated campaigns of intimidation**, including:

In Europe

- Sending threatening warning letters to Motom Electronics Group S.p.A. and distributors such as CLAG.

In Vietnam

- While the legal dispute had not been resolved, BANCA Co., Ltd. (representing Lambretta S.r.l.) issued warnings to Vĩnh Phát Company and its dealers;
- This occurred even though the Lambretta LN125 scooters sold by Vĩnh Phát were manufactured by Motom Electronics Group S.p.A. and were legitimate products, according to Motom.

Motom emphasized:

- BANCA Co., Ltd. referenced a court decision of **16/12/2011** from the Milan Court;
- Motom claimed this was **not a final judgment**, but rather a **Search Order** allowing information collection;
- On **29/02/2012**, the Milan Court **revoked** the Search Order.

– Decision of the Milan Court (16/07/2012)

Motom stated that on **16/07/2012**, the Milan Court issued decision No. **26011/2012 R.G.**, prohibiting Brandconcern BV and related parties from disseminating false information or holding press conferences attacking Motom Electronics Group S.p.A.

6. Notification to Lambretta S.r.l.

On 03/10/2012, the Intellectual Property Office issued Official Letter No. **7770/SHTT-TTKN**, informing Lambretta S.r.l. (through BANCA Co., Ltd.) of the response submitted by Motom Electronics Group S.p.A.

7. Further response by Lambretta S.r.l. (30/10/2012)

In this submission, Lambretta S.r.l. argued:

– SIL’s registrations are invalid due to non-use

According to Lambretta S.r.l.:

- SIL's trademark registrations in the EU and the UK had been cancelled for **non-use**;
- Therefore, both the **head licence** between SIL and FWL and any **sublicences**, including those involving LSL and Motom, were **no longer valid** and could not be used as evidence.

– **FWL and LSL joined the Lambretta Consortium**

Lambretta S.r.l. stated:

- FWL and LSL became part of the Lambretta Consortium in 2010;
- They recognized that SIL was not the true successor to Innocenti;
- SIL's registrations had already been cancelled in almost all countries where SIL claimed rights.

– **SIL has no legitimate rights**

Lambretta S.r.l. asserted:

- SIL never obtained legitimate ownership of the “LAMBRETTA” brand from Innocenti;
- Almost all of SIL's trademark registrations have been cancelled for non-use;
- Therefore, SIL **has no rights whatsoever** to the mark.

– **Lambretta Consortium's earlier rights**

They emphasized:

- The Lambretta Consortium established its rights from as early as **1958**, with Spanish Registration No. **338026**;
- Followed by Swiss Registration No. **408722** (1983),
- International Registrations No. **615996** (1994),
- No. **712094A** (1999),
- No. **715694A** (1999), etc.;
- All of which were **earlier** than SIL's registrations in the European Community (2000).

Thus, Lambretta S.r.l. argued that the **Lambretta Consortium** is the **true worldwide owner** of the “Lambretta/LAMBRETTA” marks.

They added:

- Even Motom Electronics Group S.p.A. and Vĩnh Phát Company acknowledge this in documents and on Vĩnh Phát's official website.

– **The “LAMBRETTA” mark is *not* well-known in Vietnam**

Lambretta S.r.l. argued:

- Online articles are not reliable legal evidence;
- Most articles Motom submitted were written about the **LN125 scooter model**, imported since late 2011 (after the filing date of IR No. 977372);
- Surveys submitted by Motom are not objective, as they were conducted by Motom itself.

They emphasized:

- Consumer recognition after late 2011 was likely a result of **Vĩnh Phát's heavy promotion** of the infringing scooters;
- Older Innocenti Lambretta scooters were rare and known only to a small number of older consumers;
- Motom provided **no evidence** that SIL-manufactured Lambretta products were used in Vietnam anytime after 1972.

Therefore, the claim that SIL's “LAMBRETTA” mark was well-known in Vietnam was, according to Lambretta S.r.l., **unfounded**.

8. Further notification from the Intellectual Property Office

On **02/04/2013**, the Intellectual Property Office issued Official Letter No. **2982/SHTT-TTKN**, notifying:

- Motom Electronics Group S.p.A. (through Phạm & Associates Law Firm) of the response submitted by Lambretta S.r.l. regarding Motom's rebuttal;
- And requesting both parties to provide further clarifications and evidence.

Specifically:

The Intellectual Property Office requested:

(a) Motom Electronics Group S.p.A.

→ to submit their opinions regarding the arguments raised in Lambretta S.r.l.'s submission dated 30/10/2012 (through BANCA Co., Ltd.);

(b) Lambretta S.r.l.

→ to provide documentary evidence proving that the registration of the “Lambretta”

trademark by Lambretta S.r.l. was carried out under authorization from the Lambretta Consortium.

9. Evidence submitted by Lambretta S.r.l.

On **15/05/2013**, Lambretta S.r.l. (through BANCA Co., Ltd.) submitted **copies of documents** demonstrating that the registration of the “LAMBRETTA” trademark by Lambretta S.r.l. was made **under authorization from the Lambretta Consortium**.

II. Examination Results Regarding the Request for Cancellation

1. Legal basis

– Point i, Clause 2, Article 74 of the Law on Intellectual Property:

A trademark shall be deemed indistinctive if it consists of:

“A sign identical or confusingly similar to a mark recognized as well-known belonging to 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 such use would affect the distinctiveness of the well-known mark,

OR if registration is intended to take unfair advantage of the reputation of the well-known mark.”

– Point b, Clause 1, Article 96 of the Law on Intellectual Property:

A protection title shall be cancelled in whole in the following cases:

“The protected industrial property subject matter fails to meet protection conditions at the time the protection title was granted.”

2. Findings and evaluation by the Intellectual Property Office

After reviewing and verifying all information in the cancellation request and examining the documents in the case file, the Intellectual Property Office concludes as follows:

(a) Allegation of dishonesty is not a ground for cancellation

Under **Clause 3, Article 96**:

- Alleging that a protection title was granted due to dishonest conduct by the applicant

→ **is only a basis to remove the five-year time limitation** for filing a cancellation request.

It is **NOT** in itself a legal ground to cancel the validity of the trademark registration.

(b) Fame of the “LAMBRETTA” mark in Vietnam could not be established

The requesting party argued that “LAMBRETTA” was well-known in Vietnam prior to the filing date of IR No. 977372 (12/05/2008).

However, the evidence **failed to demonstrate** widespread recognition at that time.

Reasons:

- No systematic data were provided (sales, market share, distribution networks, customer service systems, advertising investments, or territorial use) prior to 12/05/2008;
- Most evidence consisted of online articles and internet materials created **after** the filing date;
- Such materials are promotional or nostalgic and **cannot be used** to infer backwards the alleged well-known status.

Ownership not clearly established

- The requesting party did not establish **who owned** the allegedly well-known mark in Vietnam prior to the filing date (SIL? Lambretta Consortium? Brandconcern? Another entity?);
 - Therefore, there is **no basis** to determine whether any particular “LAMBRETTA” mark was well-known in Vietnam during the relevant period.
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(c) Applicant’s argument about obstruction of business lacks legal basis

Motom Electronics Group S.p.A. argued that:

- Lambretta S.r.l. does not manufacture scooters;
- The trademark registration was intended to obstruct Motom’s business activities.

However:

- Vietnamese law **does NOT require** the trademark applicant to manufacture the goods itself;

- The case file shows that Lambretta S.r.l. registered the mark under **authorization from the Lambretta Consortium**, which holds global rights to the “LAMBRETTA” mark.
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(d) Disputes between SIL and the Lambretta Consortium remain unresolved

- The historical dispute between SIL and the Lambretta Consortium regarding ownership of the trademark remains unresolved;
- The licence agreements invoked by Motom were based on SIL’s registrations, many of which were later **cancelled** in the EU and the UK.

Therefore:

- It is **not possible** to determine the true right holder whose “well-known” status is being invoked;
 - As a result, the argument that the mark registered by Lambretta S.r.l. (now Innocenti S.A.) is confusingly similar to another party’s well-known mark is **unsubstantiated**.
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Conclusion of the assessment

Based on all the above, the Intellectual Property Office finds:

- The request by Motom Electronics Group S.p.A.
→ **to cancel the validity of International Registration No. 977372** in the name of Lambretta S.r.l. (now Innocenti S.A.)
→ **is not supported by sufficient evidence**
→ and is therefore **without merit**.
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III. Conclusion

Pursuant to Point i, Clause 2, Article 74, and Point a, Clause 1, Article 96 of the Law on Intellectual Property, and based on the available documents and evidence, the Intellectual Property Office concludes:

There is no legal basis to cancel the validity of International Registration No. 977372,

owned by **Lambretta S.r.l. (now Innocenti S.A.)**,
as requested by **Motom Electronics Group S.p.A.**

The Intellectual Property Office hereby notifies:

1. **The request to cancel the validity of IR No. 977372 filed by Motom Electronics Group S.p.A. is REFUSED.**
 2. The requester has the right to file a complaint **within 90 days** from the date of receipt or awareness 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.
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On behalf of the Director General

DEPUTY DIRECTOR GENERAL

Lê Huy Anh