

# LAMBRETТА...did it run?

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After some 10 years, the Lambretta saga has finally come to an end, but it might not really matter that much... anymore.

LAMBRETТА is a famous vintage brand for scooters, which has been acquired by Scooters India Ltd (yet another famous European vehicle brand that has landed in India). While the scooters as such have not been made for many years, Scooters India does produce and supply spare parts for Lambretta Scooters.

Scooters India filed an application for the mark LAMBRETТА in 2000 for classes 3, 12 and 18, indicating only the class headings. In 2007 Brandconcern filed an application for partial revocation of the mark for lack of genuine use.

The Cancellation Division upheld Brandconcern's claim and revoked the mark. On appeal the BoA after finding that the evidence submitted by Scooters India in support of that genuine use was limited to evidence relating to the sale of spare parts for scooters and did not contain any evidence relating to the sale of 'vehicles; apparatus for locomotion by land, air or water', the BoA took the view that *'it cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle'* and it confirmed the revocation.

Scooters India appealed to the GC arguing that, at the time it filed its EUTM, *"it was OHIM's practice to understand a reference to a complete class heading in an application for registration as covering all the goods listed in that class and not only the goods corresponding to the literal meaning of that heading."*

EUIPO argued instead that since the EUTM had been applied for and registered before publication of Comm. 4/03: so “...., *the applicant had not been given any assurance on its part as regards the extent of the protection conferred by the EUTM*” and could not therefore enjoy protection for all the goods in the relevant class.

The GC found for Scooters India (cf. case T-51/12). According to the GC, the reference to ‘vehicles; apparatus for locomotion by land, air or water’ in the EUTM application had to be interpreted as intended to protect the trademark LAMBRETTA in respect of all the goods in the alphabetical list in Class 12 of the Nice Agreement. It also took the view that, even if ‘spare parts for scooters’ did not actually appear in the alphabetical list of goods in Class 12, the BoA was required to examine whether there had been genuine use of that mark in respect of the many fittings and parts listed therein. Consequently, finding that the BoA had not examined the genuine use of that mark for those spare parts for scooters, the GC annulled the BoA decision.

Brandconcern appealed to the CJ, arguing that the GC had erred in law in so far as it limited the temporal effects of the IP Translator judgment (case C-307/10), for that judgment should have been applied in the present case in so far as it requires applications for registration of an EU trade mark, including those made before the delivery of that judgment, to be interpreted to the effect that only the goods expressly included in such applications are covered by the protection afforded by the EU trademark.

The CJ with its decision rendered on Feb. 17, 2017 (case C-577/14) held again in favor of Scooters India.

In essence, the CJ found that the IP Translator case does not concern the proprietors of trade marks which have already been registered, but solely applicants for trademarks. In addition, the IP Translator case limited itself to specifying the requirements to which new applicants for national trade marks remain subject, but never sought to question the validity of the approach set out in Comm. No 4/03 as regards trademarks registered before the delivery of that judgment.

The CJ also added that the correctness of the GC interpretation is “*substantiated by the amendment introduced to Art. 28(8) of Reg. 207/2009 by Reg.2015/2424*”.

Now, given that the CJ justifies (rectius “substantiates”) the conclusions reached by the GC in 2014 with ...legislation adopted in 2015, it seems a kind of “20/20 insight” argument whose relevance seems somewhat debatable.

Ten years have thus passed since the revocation action was commenced, and we know now that Scooters India’s registration claiming the class heading had to be intended as covering all goods in that class, as well as all of the EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification for which their proprietors declared, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the heading but included in the alphabetical list for that class.

