

This Edition Newsletter contains:

1. **CABERG: Italian Helmet Vs Local Helmet**
2. **The Seagate's Trademark Dispute Goes to The Next Round**
3. **The Dispute Over PUMA Trademark in Court**
4. **Trademark Infringement Update at the Ministry of Law and Human Rights of Indonesia**
5. **Cooperation Between The European Union and DGIP of Indonesia**

1. CABERG: Italian Helmet Vs Local Helmet

Italian premium helmet manufacturer, Caberg SpA, has filed a cancellation lawsuit against a local entrepreneur at the District Court in Central Jakarta on 3 February 2020 under the case number 06/Pdt.Sus-Merk/2020/PN.Niaga.Jkt Pst.

The reason for filing the lawsuit is due to the fact that the Caberg's trademark was filed and registered by the local entrepreneur in Indonesia under registration No. IDM000381631 in Class 9.

The plaintiff objected to the defendant's registration on the basis that it was detrimental to the plaintiff as the use of Caberg's trademark by the defendant was considered as a way to "ride on their fame".

The plaintiff submitted that the Caberg's trademark registered by the defendant has similarities in its essential part to the Caberg SpA's trademark. However, the price of the defendant's helmet was sold at a cheaper rate and is alleged to have misled the consumers.



"Caberg SpA is the first user and holder of the Caberg brand in which the word Caberg is an abbreviation of the name Cashi which means helmet and Bergamo, one city in Italy, so 'Caberg' means helmet from Bergamo", said the plaintiff's attorney in a written statement.

It was also submitted that the Caberg SpA's trademark has repeatedly sponsored various automotive sporting events. Helmets with Caberg SpA's trademark have been sold since the 1970s and are currently sold in 27 countries through its official distributors.

These registrations support the plaintiff's arguments that Caberg SpA trademark is a well-known trademark.

The defendant had also been involved in a similar case previously. The case occurred in 2015 where a helmet manufacturer who also from Italy, namely Suomy, filed a lawsuit related to the plagiarism of the trademark.

(source: <http://sipp.pn-jakartapusat.go.id:www.caberg.it>)

2. The Seagate's Trademark Dispute Goes to The Next Round

In our previous newsletter, we informed that Seagate Technology LLC filed a cancellation lawsuit for "Seagate + Logo S" trademark against two young Indonesian entrepreneurs with case numbers 71/Pdt.Sus HKI/Merek/2019/PN Niaga Jkt.Pst.

The lawsuit was filed as the Defendants' trademark "Seagate + Logo S" under registration number IDM000082762 has similarities in principal with the trademark owned by Seagate Technology LLC, who claimed their trademark is a well-known trademark.

The lawsuit of the Seagate Technology LLC against the Defendants I and Defendant II was granted entirely by the panel of judges of the Central Jakarta Commercial Court on Monday, 10 March 2020.

The panel of judges granted all eight petitions of the plaintiff after considering it one by one. Apart from granting the petitions, the panel of judges further recognized that: The Plaintiff is the first Hard Disc Drive (HDD) producer in the United States.



As a result, the panel of judges declared that the "Seagate" trademark of the plaintiff's logo is a well-known trademark. After being proven in the trial, the petition was granted, on the grounds that it had been registered in 56 countries.

The panel of judges eventually ordered the defendant to cancel the "Seagate + Logo S" trademark with registration number IDM000082762 in class 9 on behalf of Defendant I and Defendant II and remove it from the General Register of Trademarks and announce it in the Official Gazette of the Trademark with all its legal consequences.

The panel of judges also rendered their decision to punish the Defendants for paying fees or costs incurred in this case and announcing it in the Official Gazette of the Trademark with all its legal consequences.

However, the plaintiff's petition concerning the request to the panel of judges to declare this decision to be carried out first even if there is Verzet, Appeals and Cassation (Uit Voer Barr Bij Voorraad) was not granted by the panel of judges.

(source: www.seagate.com; www.kabarone.com)

3. The Dispute Over PUMA Trademark in Court

The PUMA brand was created on 1 October 1948 and first registered at the German Patent and Trademark Office. In December 1948, in a letter to partners and customers, Rudolf Dassler announced his decision to name the company "PUMA Schuhfabrik Rudolf Dassler". The details of the new company were added to Germany's commercial register on 14 January 1949.

Puma SE designs manufactures and sells sporting goods and branded apparel. The company produces running, tennis, training, and basketball shoes and other products. PUMA Headquarter was in Herzogenaurach, Germany.



The company's segments include Europe, Middle East and Africa (EMEA), the Americas (North and Latin America) and Asia/Pacific. The company markets and distribute its products across the world, primarily through its subsidiaries. The company distributes its products in approximately 120 countries. For various product segments, such as fragrances, eyewear and watches, the Company issues licenses authorizing independent partners to design, develop and sell these products.

In Indonesia, Puma SE recently found out that the trademark "PUMA" was registered by a local businessman under registration No.IDM000109229 at the DGIP. Pursuant to this matter, Puma SE filed a cancellation lawsuit against the said local businessman to the District Court of Central Jakarta with a case number 7/Pdt.Sus-HKI/2020/PN Jkt.Pst.

The trademarks in dispute were in class 12 for the type of goods such as bicycles and their parts (spare parts), bicycle tires outside, bicycle tires inside, etc. The plaintiff stated that they were the first registrant and legal owner of the PUMA trademark and its variants in various countries in the world. They also stated that their PUMA trademarks are considered to be well-known marks and that the PUMA trademark belonging to the defendant has similarity in principle with the plaintiff. The plaintiff accordingly requested the Court to cancel the defendant's mark and also instruct the defendant to pay the court fees as well.

(source: <http://sipp.pn-jakartapusat.go.id>; www.reuters.com)

4. Trademark Infringement Update at The Ministry of Law and Human Rights of Indonesia

The Directorate General of Intellectual Property (DGIP) received 47 cases of Intellectual Property infringement throughout 2019. The total number of infringement cases in 2019 increased by 11 cases, compared to the 36 cases in 2018.

The infringement cases submitted to DGIP were mostly trademark infringement (34 cases), followed by copyright infringement (7 cases), industrial designs infringement (4 cases), and patents infringement (2 cases). Trademark

infringement was also the most widely objected matter at the Ministry of Law and Human Rights.



The DGIP recommended blocking 199 sites indicated to have violations of Intellectual Property. The cases of this violation include hundreds of illegal streaming movie sites. Last year, DGIP recommended blocking 390 similar sites.

Head of Administration Subdivision of the Directorate of Investigation and Dispute Resolution DGIP said that the type of infringement of the streaming sites was included in copyright infringement.

In resolving the streaming site infringement, the DGIP sent a letter of recommendation to close the illegal film site. Then, they handed over the closure of the illegal streaming film site to the Ministry of Communication and Information. DGIP also verified the complaint handling process by inviting the reporters and the Ministry of Communication and Information to discuss further complaints.

(source: www.cnnindonesia.com)

5. Cooperation Between The European Union and DGIP of Indonesia

On Tuesday, 14 January 2020, The Minister of Law and Human Rights, Mr Yasonna H. Laoly, held a meeting with the European Union Ambassador for Indonesia, Mr Vincent Piket, and sixteen EU member states in Kuningan, South Jakarta. At the

meeting, it was discussed regarding the Indonesia-EU Comprehensive Economic Partnership Agreement (IEU-CEPA) which has been negotiated since 2016.

Indonesia has added and submitted 21 geographical indication products to the European Union in early 2020. Yasonna hopes that Indonesia can add more geographical indications to facilitate and create new market access and increase trade between Indonesia and the European Union.

They also discussed regarding the Intellectual Property update. At present, the government is trying to establish an omnibus law to simplify regulations by revising and combining several laws at once. One of the regulations that will be changed in the omnibus law is Law No. 13 of Year 2016 regarding patents. The Minister has aligned the new Ministerial Regulation regarding patents with the applicable World Trade Organization (WTO) regulations and provisions.

"There are several concerns and objections to the implementation of Article 20 of Law no. 13/2016, which requires patent holders to make products in Indonesia with obligations for technology transfer and employment. To overcome this problem and while waiting to amend this law through our Parliament, I have issued Ministerial Regulation No. 15/2018 regarding the postponement of Article 20", said the Minister.

This regulation was previously considered burdensome because it was considered to violate the provisions of Article 27 of the TRIPS Agreement that had been ratified by the Government through Law No. 7 the Year 1994 regarding the Ratification of the Agreement Establishing the World Trade Organization.



The article was also considered burdensome for patent holders to produce goods that already have a patent or use the process of patents that have been registered in Indonesia, where if not fulfilled then the patent will be revoked. However, these obligations apparently cannot be carried out easily due to limitations in the mastery of technology, Human Resources, and so on.

(source: <http://www.djip.go.id>)



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