

Biro Oktroi Roosseno

INTELLECTUAL PROPERTY NEWSLETTER – June 2021 – 39th Editions



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*the world is real, an invention!
this world is real, a wonder
wonder and invention
incarnate intimate objects:
worn ball and beloved bear
red leather shoes,*

*this world is real
the kids will be home soon
from the party*

Toeti Heraty, Jan. 67

Horizon Magazine, No. 10, Th. II
(originally written in Indonesian Language)



Toeti Heraty N. Roosseno

1933 -2021

1. Biro Oktroi Roosseno Regrets to Announce the Passing of our President Director, Toeti Heraty N. Roosseno

With great sadness, we announce the passing of our President Director, *Toeti Heraty N. Roosseno*, on June 13th, 2021, at the age of 87.

A first generation of Indonesian feminist thinker, a great Indonesian poet and writer, a philanthropist, philosopher, a humanist, a high integrity and dedicated professor and lecturer, an IP consultant, an excellent professional and a kind-hearted leader, which she consistently kept until her last moment.

We feel very fortunate to have known and worked for her for as long as we had.

In keeping with our professional nature, please be assured that this loss will not change and/or affect our commitment to serving our clients/colleagues.

2. Indonesia Trademark Update: Unilever Wins in Toothpaste Trademark Dispute

The parent company of Orang Tua Group, Hardwood Private Limited, filed a lawsuit in the Central Jakarta District Court. Hardwood's "FORMULA STRONG" trademark was registered with registration number IDM000258478 in class 3 (i.e., toothpaste, preparations for cleaning dentures, toothbrush, and mouthwash not for medical purposes, and mouth rinses for non-medical purposes). Hardwood claims it is a well-known trademark that they have used and known by the public for a substantial amount of time.

Through Orang Tua Group, Hardwood has been promoting the trademark in both printed media and online.

In a lawsuit at the Central Jakarta District Court, Hardwood, as the plaintiff, stated that the mark "STRONG" under registration Number IDM000258478 in Class 3, belonged to the them and was a well-known trademark in the Jurisdiction of the Republic of Indonesia.



They also stated that the toothpaste belonging to the Defendant (Unilever Indonesia), which used the word "STRONG", has similarity in its essential part and substantially with the plaintiff's "STRONG" Mark. They also stated that the defendant had violated the plaintiff's rights associated with this mark from 2019 to the present.

During the trial, Unilever Indonesia, as Defendant stated its defense to the lawsuit as follows:

1. The Defendant is one of the leading companies founded in 1933, a subsidiary of Unilever N.V., as a multinational company engaged in consumer products headquartered in the Netherlands.
2. The Defendant produced and distributed a wide range of consumer products, including but

not limited to various brands of toothpaste products, including the "Pepsodent" trademark.

3. The "Pepsodent" trademark has been registered by Unilever NV, for types of goods in classes 3 and 21 at the Directorate General of Intellectual Property, Directorate of Trademarks and Geographical Indications of the Ministry of Law and Human Rights.
4. The "Pepsodent STRONG" trademark was registered at the Ministry of Law and Human Rights of Indonesia in Class 3 under agenda number DID2019056670 dated September 25, 2019, and agenda number DID2019057948 dated October 1, 2019.
5. From the manner in which the plaintiff's trademark was used for the "FORMULA" product variant, the plaintiff clearly argues that the trademarks used in the plaintiff's "FORMULA" product variants are not only the "STRONG" trademark, but also for other variants such as the "FORMULA STRONG HERBAL" trademark which was filed to protect the plaintiff's "FORMULA STRONG HERBAL" product variant, as well as the "STRONG PROTECTION" trademark filed to protect the plaintiff's "FORMULA STRONG PROTECTION" product variant.
6. If the plaintiff can consistently view the trademark elements in the "PEPSODENT STRONG 12 JAM" variant, the defendant in the same way as the plaintiff, views the trademark elements in the plaintiff's "FORMULA" product variant, then the plaintiff should mention the trademark used in the product

variant "PEPSODENT" belongs to the defendant as a trademark of "PEPSODENT STRONG 12 JAM" and not the "STRONG" trademark.

7. In practice, the Plaintiff should have been well-aware that the main trademark used as the dominant element in the product, namely "FORMULA", with the trademark used to denote the variant of the "FORMULA" product. Therefore, the claim for compensation filed by the plaintiff has become vague and unclear.
8. The Defendant strongly objected against the Plaintiff's argument, which stated that the mark used in the defendant's "PEPSODENT" product was the same as the plaintiff's "STRONG" trademark registered with Registration Number IDM000258478.
9. Based on the Law and permanent jurisprudence of the Supreme Court, the defendant considered that the "PEPSODENT STRONG 12 JAM" trademarks used by the defendant clearly and convincingly had no substantive similarity to the "STRONG" trademark Registration Number IDM000258478 of the Plaintiff.
10. The "PEPSODENT STRONG 12 JAM" trademark used by the defendant was different from the plaintiff's "STRONG" trademark, considering that there is no similarity in terms of shape and combination of elements, concepts, placement, and arrangement of the elements forming the mark.

On November 18, 2020, The Commercial Court at the Central Jakarta District Court decided to grant Plaintiff's claim entirely, including the damages. However, Unilever Indonesia did not accept this decision and submitted a cassation request.

And after the Cassation proceeding, The Supreme Court has decided that Unilever Indonesia's appeal for cassation has been granted. "Granted the appeal for cassation from PT UNILEVER INDONESIA Tbk," exclaimed the Supreme Court spokesperson. "Canceled the decision of the judex facti (Central Jakarta District Court) and the Supreme Court judged itself by stating that it rejected the Plaintiff's lawsuit, HARDWOOD PRIVATE LIMITED," said Deputy Chief Justice of the Supreme Court for Judicial Affairs. The verdict was rendered on March 30, 2021.

(source: <http://sipp.pn-jakartapusat.go.id>;
<https://news.detik.com>)

3. Indonesia Patent Update: Settlement Request for Cable Patent Dispute Accepted

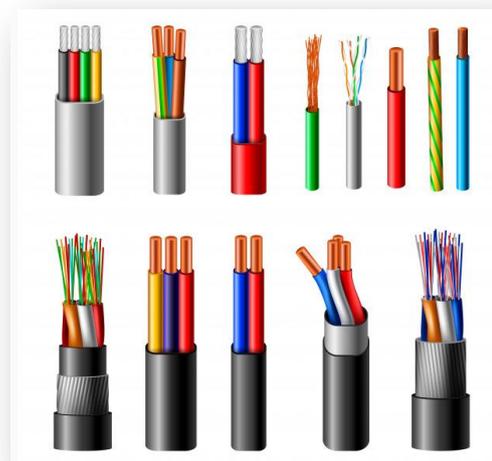
CTC Global Corporation, as the plaintiff stated, that PT Citra Mahasurya Industries has violated their patent titled "ALUMINUM CONDUCTOR COMPOSITE CORE" under registration No. IDP000023058. The plaintiff requested the panel of judges to accept and grant the plaintiff's claim entirely.

The US-based company requested PT Citra Mahasurya Industries to pay compensation for material losses of US\$ 2.9 million. The plaintiff also asked the defendant to pay compensation for immaterial losses of Rp 100 billion and requested the defendant to stop the manufacture, use, promotion, and/or trade of High Voltage Composite

Reinforced Conductor (HVCRC) cable products.

Meanwhile, suppose the defendant violates the decision. In that case, they must pay forced money (dwangsom) to the plaintiff worth IDR 100 million per day continuously every time the defendant violates the contents of the verdict.

The lawsuit was filed in the Central Jakarta District Court on February 10, 2021, with case Number 7/Pdt.Sus-HKI/Paten/2021/PN Niaga Jkt.Pst.



The patent dispute over the aluminum conductor composite core cable between the United States company, CTC Global Corporation, and a local company, PT Citra Mahasurya Industries, settled amicably with the acceptance of a settlement request in the decision of the Central Jakarta District Court which was read out on Monday, April 12, 2021.

CTC Global Corporation began developing the patented ACCC® Conductor in 2002. After an extensive R&D, testing, and installation trials effort, the company developed ISO-certified manufacturing techniques and tooling to allow the cost-effective and continuous production of the

pultruded composite core. To date, the ACCC Conductor has been deployed to over 700 project sites globally.

PT. Citra Mahasurya Industries was established on August 19, 1992. The company manufactures electrical cable given the brand 'CITRA CABLE.' The founders of PT. Citra Mahasurya Industries are businessmen and experts with broad experience in the cable industry, together with their workforce's excellent performance, the cables manufactured by PT. Citra Mahasurya Industries should be competitive in the market.

(source: <http://sipp.pn-jakartapusat.go.id/>;
<https://www.ctcglobal.com/>;
<https://steelindonesia.com/company/index.php?id=CMP0047247>)

4. Singapore Trademark Update: A "Paintful" War – Nipped

Warrior Pte Ltd v Nippon Paint (Singapore) Co. Pte. Ltd. [2021] SGIPOS 7

The trademark application of NIPPON PAINT (SINGAPORE) CO. PTE. LTD. ("the Applicant") for its "" Mark in Class 1, was opposed by WARRIOR PTE LTD ("the Opponent"). Interestingly, the marks in issue for this matter, are both model numbers and trademarks.

The Applicant is the main Singapore distributor and an affiliate of Japanese paint and paint products manufacturing company Nippon Paint Holdings Co., Ltd., and was established in 1962 to provide a broad range of paint products and professional painting services. The Applicant's "NW1" mark was coined to represent "Nippon Water-based 1 pack" and is also used in relation to their cement strengtheners.

Meanwhile, the Opponent is a Singapore company specialising in the development and provision of industrial chemicals and waterproofing products to the construction industry and has been around since 1984. The Opponent claims that its most famous product is its "W1" brand of cement strengtheners, which has been sold for more than three decades.

In this opposition, the Opponent relied on Sections 8(2)(b) and Section 8(7)(a) of the Trade Marks Act to oppose the application mark.

Similarity of the Marks – Section 8(2)(b)

For this opposition, the Opponent relied on two of their earlier marks, "" and "" to oppose the Applicant's "" application mark.

Following assessments of the distinctiveness of the Opponent's Marks and the Applicant's Mark as a whole, the Hearing Officer found that the Application Mark had "distinguish(ed) itself sufficiently and substantially" from the Opponent's Mark due to the differences between the alphanumeric elements "NW1" and "W-1" and the wholly different structure and look of the Opponent's Mark.

Given that the similarity of the competing marks is a threshold requirement that has to be satisfied before the confusion inquiry is undertaken, the Hearing Officer's finding of overall dissimilarity between the marks sufficiently disposed the ground of opposition under Section 8(2)(b).

As a result, the ground of opposition under Section 8(2)(b) failed.

Passing Off – Section 8(7)(a)

In addition, The Opponent argued the grounds of passing off under Section 8(7) (a) of the Singapore Trade Mark Act. To succeed under this ground of opposition, an opponent must establish the classical trinity of goodwill, misrepresentation, and damage.

Having reviewed the Opponent's evidence, the Hearing Officer was convinced that the Opponent had relevant goodwill in its business in Singapore.

Next, to determine if there was any likelihood of confusion between the competing mark, the Hearing Officer took into account the foregoing factors individually:

- (i) The similarities and differences between the Application Mark and "W1"
- (ii) The reputation of "W1"
- (iii) The normal way in which the goods are purchased;
- (iv) The nature of the marks
- (v) The nature of the goods
- (vi) The price of the goods
- (vii) The frequency of purchase of the goods
- (viii) The nature of the consumers.

Following his analysis, the Hearing Officer found that points (ii), (iii), (iv), and (viii) pointed away from a likelihood of confusion, whilst points (v) and (vi) pointed towards a likelihood of confusion, and points (i) and (vii) were neutral. Moreover, he opined that there was the interconnection between points (ii), (iii), and (iv), and this group of factors, when encountered by a retail consumer of the nature described in the

analysis under (viii), would quite definitively tilt the balance away from a likelihood of confusion. Hence, any concerns of possible deception or confusion arising from points (v) and (vi) should dissipate at the point of selection and purchase when the circumstances considered under (iii) prevail in the light of (ii) and (iv).

As a result, the Hearing Officer found that there was no likelihood of confusion between the competing marks and that there could not be any misrepresentation that is sufficiently likely to deceive the public into thinking that the Applicant's goods are those of the Opponent's.

Correspondingly, since the element of misrepresentation above has not been established, the Hearing Officer is of the view that it cannot be said that there is a "real tangible risk of substantial damage", and thus the Opponent's passing off argument was not successful either.

Decision

Therefore, after considering all the pleadings, evidence filed, and the submissions made in writing and orally, the Hearing Officer concluded that the opposition failed on both Section 8(2)(b) and Section 8(7)(a). Accordingly, the Applicant's mark was allowed to proceed to registration, and the Applicant is also entitled to costs to be taxed.

To view the Grounds of Decision, click [here](#).

(By: Biro Oktroi Roosseno Singapore)

5. DGIP Investigates Alleged Violation of Yamaha Audio Mixer

The Directorate General of Intellectual Property (DGIP), through the Directorate of Investigation and Dispute Resolution, held an investigation at the Orion Plaza shopping unit, Glodok, Jakarta, on Thursday, April 29, 2021. This investigation is a form of prosecution for trademark infringement in Indonesia that continues to be intensified.

The Investigation and Dispute Resolution Department found two alleged shops to have violated the Yamaha trademark registered with number IDM000124223 in Class 09 with the sound signal equipment item type.

Civil Servant Investigators from the DGIP also confiscated several items in the form of an audio mixer and financial books.



The act of trademark infringement was carried out after the complaint offense from the trademark owner to the DGIP in November 2019. The alleged violation of the mark was contrary to Articles 100 and 102 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

"Based on Law No. 20 of 2016 paragraph 1, it is stated that suspects of violating trademarks are subject to a maximum sentence of 5 years in prison and/or a fine of Rp 2 billion. Meanwhile, in paragraph 2, if proven in court, the suspect will face a sentence of 4 years in prison and/or a fine of Rp 2 billion," said the Civil Servant Investigators.

"However, if what is proven is Article 102 of the Trademark and Geographical Indication Law, then the threat of punishment is one year in prison and/or Rp 200 million," he continued.

Previously, they had also conducted investigations by conducting supervision and observation to see that the incident could be continued and could be processed according to the applicable procedural law.

Afterward, they held a forum to conclude that a complaint on trademark rights deserves to be upgraded from an inquiry to an investigation.

"After this, we will summon the witnesses from the report. Meanwhile, the title of the case will be carried out again to ascertain who is the most appropriate according to the law to be held accountable for this criminal incident as a suspect," he explained.

"This action also shows a concrete form of DGIP's commitment to be present in providing legal protection to every registered Intellectual Property Rights holder," he concluded.

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

6. Consignment Related to the Discussion of Intellectual Property Issues in International Negotiations by DGIP

The Directorate General of Intellectual Property (DGIP) has held a consignment of IP issues to formulate a policy strategy in international negotiations on Wednesday, April 7, 2021. This activity is expected to increase awareness of national interests, secure plans, programs, and implementation of national development, particularly to increase international market access and maximize national economic growth.



According to the Director General of Intellectual Property, exploration of IP's economic value is one of the activities that can potentially move the country's economic wheels. It is an important aspect that needs to be considered in international trade and one of the key factors in trade expansion.

"I hope that we can move forward to increase the contribution of the innovation-based industrial sector, especially research and knowledge to increase national income; there is no need for leading minimal equal," he said.

On the same occasion, the Director of Multilateral Negotiations, Ministry of Trade of the Republic of Indonesia, explained that

IP has links to international trade. This is stated in the Trade-Related Aspects of Intellectual Property Rights (TRIPS). "The TRIPS Agreement not only regulates the protection of IP but also regulates an important role in facilitating trade, especially in protecting IP and ensuring that WTO member countries can achieve their national goals related to IP," he said.

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

7. Government Efforts to Provide Legal Certainty for Patent Protection in Indonesia

The Directorate General of Intellectual Property held a Focus Group Discussion in preparing the Draft Revision of Law No. 13 of 2016 concerning Patents on April 5, 2021.

This activity was carried out at the initiation of the DGIP in the context of deepening the patent protection system, particularly in relation to the obstacles in the implementation of law No. 13 of 2016 concerning Patents.

Director of Industrial Design, Patent, Design of Integrated Circuit Layout and Trade Secret, Mrs. Dede Mia Yusanti, said that the FGD was to absorb and accommodate the aspirations of the community's needs from various parties as stakeholders who observe the development of national and international law development.

According to her, with the existence of Law No. 11 of 2020 concerning Work Creation, several patent content materials need to be harmonized, such as simple patent arrangements and compulsory licenses.

"Some of the material contained in Law No. 13 of 2016 concerning Patents also requires alignment with international regulations, namely the TRIPS Agreement. Therefore, it is necessary to revise Law No. 13 of 2016 concerning Patents to provide legal certainty for patent protection in Indonesia", she said.

The revision of the Patent Law is expected to improve the quality of public services in the Intellectual Property protection system, especially commercialized domestic patents, which will lead to an increase in the economy and public welfare.

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

8. DGIP Info: Royalty Management for Song and/or Music Copyright

The issuance of Government Regulation No. 56 of 2021 regarding the Management of Copyright Royalties for Songs and/or Music raises various questions from the public especially related to the implementation mechanism.

Therefore, the Directorate General of Intellectual Property held IP Talks 1.5 with the theme "Investigate Song and Music Copyright Royalties" on April 9, 2021. The IP Talks presented several expert speakers such as a singer and songwriter, the Commissioner of the National Collective Management Institute, and the Head of the Sub-Directorate for Legal Services and the DGIP Collective Management Institute.

This Government Regulation is a strengthening of Law No. 28 of 2014 concerning Copyright. The obligation to pay royalties has existed before. Still, through this regulation, its implementation has been strengthened again, especially for the

economic rights of the creators and owners of the related rights.

Based on the regulation, there are 13 commercial, public service areas that have an obligation to pay royalties, including restaurants, cafes, music concerts, recreation centers, cinemas, karaoke businesses, and broadcasting institutions.

Business actors as commercial users of the work of rights owners are required to pay royalties to the National Collective Management Institute. As the competent authority, the National Collective Management Institute collected in accordance with the rate set and ratified in a ministerial decision and distributes it to copyright owners and related rights holders.

In the future, a centralized music data center will be established for all works created by the nation's children. This data center can be used as a basis for the National Collective Management Institute in making royalty withdrawals and a reference for the public in referring to ownership of a work.



On May 18 – 20, 2021, DGIP held a consignment of changes to the Regulation of the Minister of Law and Human Rights of the Republic of Indonesia No. 20 of 2021 concerning the implementing regulations of Government Regulation Number 56 of 2021

concerning the management of copyright royalties and/or music.

The activity discussed the draft of improving the Regulation of the Minister of Law and Human Rights of the Republic of Indonesia No. 20 of 2021, which includes the work procedures of the National Collective Management Institute; procedures for the appointment, replacement and dismissal of commissioners of the National Collective Management Institute; as well as the coordination relationship mechanism between the National Collective Management Institute and the Village Deliberative Council.

The Director General of Intellectual Property stated that this is an effort to increase efficiency in the enforcement of rights over the management of Works and related rights Products.

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



(Anno 1951)

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