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1. Indonesia Trademark Update: Chelsea FC Beat 'Local' Chelsea

A Local businessman, Hardiman, must acknowledge the victory of Chelsea Football Club Limited or as they are more commonly known, Chelsea FC's victory over the Chelsea's Trademark.

The local businessman obtained a trademark registration by the Ministry of Law and Human Rights on September 14, 1994, renewed by Hardiman.

This registration is in class 25 for the goods including apparel, i.e.: men's/women's clothing, children's clothing, sportswear, pants, suit, jackets, pajamas, swimsuit, T-shirts, socks, belts, ties, hats, gloves, shoes, sandals, etc.

In 2014, Chelsea's trademark, which belonged to Hardiman, was cancelled by the Central Jakarta District Court. The said local businessman objected because the cancellation process did not involve him. Therefore, he strongly opposed it and filed a

counterclaim (counter lawsuit). He requested the Central Jakarta District Court to cancel Chelsea FC's trademark.

Pursuant to this matter, Chelsea FC replied that Plaintiff's lawsuit had been examined and concluded or *nebis in idem*. Also, Chelsea FC considers the Plaintiff's lawsuit to be unclear and vague.



The Director-General of Intellectual Property believes that Plaintiff's objection to cancel Chelsea's trademark belongs to the Chelsea FC has expired. This is based on Article 77 paragraph (1) of Law Number 20 of 2016 concerning Marks and Geographical Indications, which states that a lawsuit for cancellation of a trademark registration can be filed within a period of 5 years from the date of registration of the mark.

Therefore, on December 3, 2019, the Central Jakarta District Court decided not to accept Plaintiff's lawsuit.

However, as Plaintiff still wanted to pursue the case, the cassation was sent to the Supreme Court, where the Supreme Court decided to reject the appeal in a decision released on January 6, 2021.

The supreme court was of the opinion that the Central Jakarta's District court decision was not incorrect in upholding the law; this is because the matters on the case have similarities, in terms of subject, object, as

well as bases of the arguments within lawsuit with a similar case that whose resulting decision is considered to have permanent legal force, the case is No. 58/Pdt.Sus/Merek/2014/PN.Niaga.Jkt.Pst.

"In the previous case, the ownership status of Chelsea's trademark, the Chelsea FC's trademark, the Chelsea Football Club's trademark, and the Chelsea Football Club's trademark and logo has been determined to be the property of the Defendant in cassation I (Chelsea Football Club Limited, represented by General Counsel, James Bonington, domiciled at Stamford Bridge Grounds, Fulham Road, England), "said the panel of judges in its deliberations.

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

2. Indonesia Trademark Update: The End of Mineral Water Trademark Dispute Between French CRISTALINE vs 'Local' CRISTALINE

The Supreme Court rejected PT Pepper Tree Investama's trademark lawsuit against a French company, Gie Cristaline. This decision confirms that Gie Cristaline is the legal holder of the mineral water trademark, CRISTALINE.

It all started when PT Pepper Tree Investama investigated and found that the CRISTALINE's trademark has not used in trading activities in Indonesia for more than three consecutive years. The information is based on the results of a survey conducted by an independent and professional survey institute. It is proven that the CRISTALINE trademark registered under the Defendant was not used in trading activities in Indonesia.

PT Pepper Tree Investama then sued Gie Cirtaline at the Central Jakarta District Court in 2016. PT Pepper Tree Investama also stated that they had registered the CRYSTALINE's trademark with the Ministry of Law and Human Rights.

Pursuant to the lawsuit of PT Pepper Tree Investama, whereas the Ministry of Law and Human Rights was acting as a co-defendant, explained that the Plaintiff's argument against the CRYSTALINE trademark with Registration Number IDM000051968 belonging to the Defendant has not been used in trading activities for more than 3 consecutive years since the date of registration is a unilateral assumption of the Plaintiff.

Based on the existing data at the Directorate of Trademarks and Geographical Indications, the Defendant's trademark has been registered since January 28, 2004, and still receives legal protection until January 28, 2024. From the first registration until the end of the protection period, it appears that the CRYSTALINE trademark belonging to the Defendant has undergone a trademark renewal.



On 2 May 2018, the Central Jakarta District Court rejected PT Pepper Tree Investama's lawsuit. The reason is the CRYSTALINE trademark was still being used by Gie

Cristaline in Indonesia and is still active in France and several other countries. The decision of the Central Jakarta District Court was upheld at the Cassation stage on November 14, 2018.

Because they did not accept this decision, PT Pepper Tree Investama submitted a Judicial Review to the Supreme Court. However, on February 24, 2021, the Supreme Court has decided to reject the Judicial Review of PT Pepper Tree Investama.

The Panel of Judges declared CRYSTALINE's trademark with Registration Number IDM000051968 in the class 32 (i.e. beer, types of beer, mineral water, sparkling water and other non-alcoholic beverage water, fruit water, syrups and the availability of water to make these drinks) with a registration date of 30 September 2005 with a protection period of 10 years starting from 28 January 2004, has been extended on 17 July 2013 therefore the protection period expires on 28 January 2024.

"The renewal has met the requirements as stated in Article 36 of Law Number 20 of 2016 concerning Marks and Geographical Indications," declared the panel of judges.

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

3. Indonesia Trademark Update: The "PREDATOR" Trademark Ownership Concluded

Acer Incorporated is a Taiwanese multinational hardware and electronics corporation specializing in advanced electronics technology which founded in 1976. Since its establishment, the company has sold a wide variety of products under various trademarks, including the Predator trademark in many countries worldwide. In

2016, the Taiwanese company intended to register the "PREDATOR" trademark in Indonesia.

However, on February 12, 2019, the Ministry of Law and Human Rights issued a letter of rejection of Acer Incorporated's application. The reason for the rejection was that the Predator's trademark was already owned by a local businessman named Wijen Chandra Tjia.

Pursuant to this matter, Acer Incorporated filed an appeal to the Trademark Appeal Commission. Acer Incorporated stated that the Defendant had registered the Predator's trademark in bad faith.

On September 9, 2019, the Ministry of Law and Human Rights issued decision Number 424/KBM/HKI/2019 regarding the rejection of Acer Incorporated's appeal. The Plaintiff did not accept it and sued the Ministry of Law and Human Rights to the Central Jakarta District Court. However, on March 10, 2020, the Central Jakarta District Court announced that they rejected the Plaintiff's lawsuit.

The Plaintiff believed that they are the Predator trademark's legal owner, and the Ministry of Law and Human Rights decision is wrong. Therefore, the Plaintiff filed an appeal. The Supreme Court then granted the Plaintiff's appeal on February 26, 2021. In addition, the Supreme Court also canceled the Ministry of Law and Human Rights's decision which ruled that the Predator's trademark was the exclusive right of a local businessman, Wijen Chandra Tjia.

"Canceled the Decision of the Mark Appeal Commission Number 424/KBM/HKI/2019 dated on June 26, 2019. Granted, the application for registration of the PREDATOR + Logo's trademark belongs to the Plaintiff, whose application for registration of the

mark was requested under Agenda Number D00.2017.047770, on September 26 2017, in Class 9, "said the head of the panel of judges.

The panel of judges explained that the word of Predator is a generic word that cannot be given as a trademark rights.



They also stated that if juxtaposed, the two trademarks, the Predator's trademark belongs to the Plaintiff consisted of the word Predator with a black logo. Meanwhile, the Predator trademark, which has been registered earlier, consists of the word Predator with a red logo.

"These two trademarks only have similarities in terms of the sound of speech, namely Predator, however the two trademarks are different in terms of the shape of the logo, the way of writing, the way of placement or the combination of the elements. On the Plaintiff's trademark the word of Predator is located under the logo, while on the previously registered trademark the word of Predator is above the logo, "said the panel of judges unanimously.

The Supreme Court also stated that Acer Incorporated had registered the Predator's trademark in several countries and products with the Predator's trademark had also been distributed and sold in Indonesia since 2008.

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

4. Singapore Trademark Update: A Pandemic Mishap – Rectified in the Nick of Time

Application for Extension of Time to File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd [2021] SGIPOS 1.

An Interlocutory hearing, related to the opposition between Biba (Zhejiang) Nursing Products Co., Ltd (the Applicant) and BEABA (the Opponent) took place on 11 December 2020, following the latter's application to file a late request for an extension of time to file evidence.

The Applicant, Biba (Zhejiang) Nursing Products Co., Ltd, is a retailer of baby care products from China. Meanwhile, the Opponent is BEABA is known worldwide for its unique ability to create innovative products for the baby care industry with a focus on design and technology.

Timeline

- 28 February 2020 – the Registrar issued deadlines concerning when parties had to file their respective evidence in the form of statutory declarations, at a Case Management Conference.
- 21 May 2020 – the Opponent filed a request for an extension of time for its deadline for filing evidence in the Opposition.
- 15 June 2020 – the Registrar acceded to the Opponent's request and granted a final 4-month extension of time of up to 28 September 2020 for the Opponent to file any evidence.
- 28 September 2020 – the Opponent did not file its evidence or any further

request for an extension of time before the expiration of the deadline.

- 8 October 2020 – the Opponent filed a late request for an extension of time, setting out the reason for the Opponent's failure to file its evidence before the expiry of the deadline.
- 12 October 2020 – the Registrar wrote to the Applicant seeking its views on the request.
- 20 October 2020 – the Applicant responded that it objected to the late request for the extension of time.
- 26 October 2020 – the Registrar declined to accept the late request for an extension of time via IPOS letter.
- 14 November 2020 – the Opponent requested for an interlocutory hearing via its letter.
- 11 December 2020 – the mentioned interlocutory hearing was held to hear parties on the issue.

Issues and the relevant provision

The main issue in the interlocutory hearing was whether the Opponent's late application for an extension of time to file its evidence can be allowed, and, whether Rule 83 is applicable for this matter.

As Rule 83 provides, 'any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct', and "irregularity in procedure" in Rule 83 includes matters in respect of time, the Hearing Officer decided that Rule 83 is applicable.

Arguments

The Opponent, in its appeal to allow the late extension of time, explained that there was a default on the part of the solicitor, in particular by a member of the staff, because of an oversight in noting down the applicable deadline. However, they had discovered the error and filed the late request for the extension of time within a couple of days. Moreover, COVID-19 was in the backdrop throughout the incident and was one of the contributing factors to the clerical mistake. In support of its appeal, the Opponent also filed evidence detailing the sequence of events in some detail.

The Applicant however resisted the late request stating mainly that the Applicant has and continues to suffer the prejudice of the uncertainty of whether the Application mark will proceed to registration notwithstanding that the Opposition had been deemed withdrawn. Moreover, the Applicant alleged that although Covid-19 and the Circuit Breaker undoubtedly posed difficulties, they did not give rise to any exceptional circumstances that caused the deadline to be missed. Such Covid-19 related issues had largely passed by 19 June 2020 when Singapore entered Phase 2.

Following the submissions from both parties, the hearing officer clarified that the matter should be viewed with some degree of compassion, in view of the COVID-19 pandemic.

In this regard, it was noteworthy that:

Firstly, the Opponent had itself discovered the error and attempted to rectify it within 8 days, before IPOS issued its notification of the deemed withdrawal of the opposition. Secondly, although some prejudice was suffered by the Applicant, it had to be

distinguished from cases where the relevant request was made after the Registrar had provided a written notification confirming the application of the law following a lapse. And thirdly, the advanced stage of the opposition had to be taken into account to establish that both parties should be well aware of the ongoing dispute and the intention to proceed. Moreover, the year 2020 has been an unprecedented year of hardship for many in Singapore, and the COVID-19 pandemic had very much affected everyone's daily lives and ought to be taken into consideration when assessing the present situation.

Decision

Considering the above, and the respective submissions by both parties, the Hearing Officer agreed that the Applicant had suffered prejudice due to the late request for extension. However, she declared that the prejudice suffered by the Applicant is one which can be compensated by costs, and therefore allowed the late request for extension. Accordingly, she awarded costs in the amount S\$ 1,150.00 (the maximum allowed applying the Fourth Schedule of the Rules) for preparation and the attendance at the interlocutory hearing (half day).

The Applicant was further directed to file its evidence within 3 months from the date of the decision, that is, on or before 27 April 2021.

Currently, the opposition between the parties is ongoing.

(By: Biro Oktroi Roosseno Singapore)

5. DGIP Info: Electronic Registration for IP in Indonesia

In order to improve the quality of Intellectual Property services at the Directorate General of Intellectual Property and based on the Regulation of the Minister of Law and Human Rights No. 42 of 2016 concerning IP Application Services, hereby the DGIP notified that:

- Submission of applications for IP registration (Trademarks, Patents, and Industrial Designs) can be made online
- Account registration and submission of IP registration applications can be done via website:
 - merek.dgip.go.id
 - paten.dgip.go.id
 - desainindustri.dgip.go.id

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

6. Webinar on Archives Organized by DGIP and JICA

The Directorate General of Intellectual Property (DGIP), in collaboration with the Japan International Cooperation Agency (JICA), held a Webinar on Archives on Tuesday, December 1, 2020. Archivist issues discussed in the webinar were related to the management, security, and transparency of state document.

"Archivist management in Japan aims to carry out administration appropriately and efficiently, and to carry out accountability to society both now and in the future," said Takuya Sugiyama as JICA Expert and Chief Advisor. Sugiyama said that Japan's document management system is based on a transparency system that can be accounted for by all stakeholders. Also, the system must

be safe from cyber-attacks and natural disasters. Currently, Indonesia has classified archives into several types. The archives are classified based on a certain period.

"Active archives are usually of high frequency or continuous use, while inactive archives are the opposite. There is another vital archive, an archive whose existence is a basic requirement for the archive creator's operational continuity. It is irreversible and irreplaceable," explained Andri Budi as the Ministry of Law and Human Rights' representative.

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

7. DGIP Discussion on the Draft Laws and Regulations on Mechanical Rights in the Music Sector

The Deputy Minister of Law and Human Rights and the Directorate General of Intellectual Property (DGIP) held a meeting to discuss the Draft Legislation on Mechanical Rights in Music and/or Song on February 8, 2021.



The Deputy Minister of Law and Human Rights said that even though 2021 is a Patent Year, there is no harm in commencing talks on Copyright, planned to be announced in 2022. Hopefully, the regulation will be ready to be submitted to the House of Representatives once it enters the Copyright

Declaration Year. The meeting was held on a hybrid basis (online and offline).

It was attended by Indonesian singers, songwriters, music producers, the Collective Management Institute, Commissioners of the National Collective Management Institute, and Candra Darusman as the representative of World Intellectual Property Organization (WIPO).

The meeting was held due to the rapid development of digital music and song platforms in the community. Some of Indonesia's musicians and composers raised the problems in this modern era, such as a song created by a musician covered on the Youtube platform by an unknown entity. However, the musician does not receive a royalty.

During the meeting, it was also explained that mechanical rights are the exclusive rights of copyright holders given to the labels or record companies to carry out mechanical copies of musical compositions, songs or record albums, which will later be circulated in the market. However, Indonesia's mechanical rights have only regulated reproduction through physical recording media.

Therefore, the Indonesian government will try to be neutral and accommodate the needs of musicians.

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

8. Webinar by DGIP: Tips for Trademark Applications to be Accepted

In the Webinar "Is It Possible to Use Common Words (Descriptive) as Trademark, and How to Distinguish Our Trademarks?", held on February 22, 2021, the Director of

Trademarks and Geographical Indications of the Directorate General of Intellectual Property (DGIP) explained to the general audience regarding trademarks. Trademark is a mark worn by a product or service used as an identifier. He explained that a trademark has a strong distinguishing power so that consumers can distinguish the identity of a particular product from other similar products.

"When a sign is often used to indicate certain goods or services, consumers will consider it as a general sign that only indicates the product itself", he said. He also explained that a descriptive sign is a sign that has no inherent distinguishing power so that it cannot get protection. However, descriptive signs can obtain protection if they acquire another meaning or distinguishing power due to use.

"The distinguishing power is obtained because of the secondary meaning of a descriptive sign, which can then be registered as a mark", he added.



In trademark law, a sign on a mark can be classified into five groups, i.e. a sign that is created, a sign that is arbitrary, a sign that is suggestive, a sign that is descriptive, and a sign that is generic.

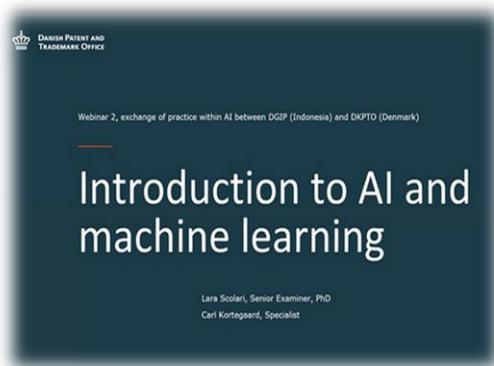
"Signs that are created, arbitrary, and suggestive are grouped into the category of

signs that have immediate distinguishing power and meet the requirements for protection when used," he explained.

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

9. DGIP and DKPTO Webinars Related to The Artificial Intelligence and Machine Learning

The Directorate General of Intellectual Property (DGIP) held an online webinar with the Danish Patent and Trademark Office (DKPTO) with the theme of Artificial Intelligence (AI) and Machine Learning (ML) on March 15 & 18, 2021.



During the webinar, DKPTO explained about the importance of AI and ML, their ability to make work easier for humans, enabling humans to work faster, more precise and well-measured.

"Machines could be considered as smart if they are capable of doing what humans do," said Lara Scolari, one of the senior examiners at the DKPTO.

AI systems are capable of applying their processing capabilities to 'consider' and accommodate large amounts of information, which is then output as the 'conclusion', and this is proven to make it easier for humans to work. "AI and ML use a number of

algorithms as 'neurons' to work together to determine and draw conclusions from certain characteristics in a data set, and this is why AI and ML are so important nowadays," said Scolari. A source from DKPTO, Carl Kortegaard, said that based on the European Patent Convention (EPC), "European patent will be granted for any invention, in all fields of technology, provided it is new, involves inventive steps and can be applied in industry,"

Pursuant to this matter, the patent examiner in charge of examining an AI-related application must ensure that the application claims relating to the incoming AI meet these requirements. If not, then the patent cannot be granted. To be sure, Kortegaard said the examiner needed to examine the technical features of the discovery, character, and the regulations' provisions.

In addition, Kortegaard also shared several examples of patent applications related to AI and ML that have registered at the DKPTO. He hopes that this example can provide an overview of the patent examiner at the DGIP on how to handle similar documents.

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



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