

Biro Oktroi Rooseno

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1. Let's Meet at the Upcoming INTA 2023!



Our team will be attending to **INTA Annual meeting in Singapore** from May 16-20, 2023. Pursuant to these matters, we are more than happy to meet with our clients, friends, and colleagues.

We will also open an exhibition booth located in the Innovation Marketplace starting on May 17-19, 2023. Please come to meet us personally in Booth Number **#P22!**

You can also contact iplaw@iprbor.com to schedule a meeting with our team.

2. Indonesia Trademark Update: The True Devil Glue

The Central Jakarta Commercial Court granted Tong Shen Enterprise Co., Ltd's lawsuit to cancel PT Inti Jaya Lemindo's trademark registration. Tong Shen Enterprise Co., Ltd is the real owner of the G Glue trademark, known as Korean glue or devil glue.

In Indonesia, the Taiwanese company has granted a license to PT Putra Permata Majuperkasa since 2017 to use the trademarks of Tong Shen Enterprise Co., Ltd. One is a trademark with the G logo on glue production goods.

The decision is registered in a civil case with several case numbers.



According to the panel of judges, the three trademarks owned by Defendant I (PT Inti Jaya Lemindo) are similar in their essential part or in whole to the registered trademarks of Tong Shen Enterprise Co., Ltd (Plaintiff) with Trademark Certificate Number IDM000236218.

The decision stated, "We Declare to cancel the Trademark Registration in accordance with the Trademark Certificate with Registration Numbers: IDM000853844, IDM000901905, and IDM000901899".

The decision also stated that Defendant I, PT Inti Jaya Lemindo, was a bad-faith applicant. Therefore, the Central Jakarta District Court also ordered Defendant II, Directorate General of Intellectual Property, to cancel and invalidate the three trademarks belonging to PT Inti Jaya Lemindo and announce them in the Official Trademark Gazette.

Tong Shen Enterprise Co., Ltd's trademark with Glue G production goods has been registered since 2010. The registration has also been extended, is valid until 2030, and has received legal protection from the government.

Tong Shen Enterprise Co., Ltd. entered the Indonesian market and registered its trademark in Indonesia in 1995. All of the company's products have also received legal protection from the DGIP.

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

3. Singapore Trademark Update: Distinctiveness Requirements to Register Slogans Under the Trademarks Act

Background

The Applicant, Schweiger, Martin Rainer Gabriel, filed an application to register a word mark "STRONG BY CHOICE" in Class 25 of the Nice Classification in respect of "Shorts; T-shirts" (the "Application").

The Examiner has raised an objection to the registration of the Mark as the Examiner was of the view that the Mark is devoid of any distinctive character for the following reasons:

- (a) The Mark was merely a “promotional slogan which conveys a laudatory connotation” as it is a “commercial tagline or an advertising phrase which simply serves to suggest that the Applicant is committed to providing shorts and T-shirts which are able to withstand wear, i.e., durable and lasting.”
- (b) The mere fact that “no one else uses the mark or the mark is not one that other traders would typically wish to use, does not make the mark automatically distinctive.”
- (c) The Mark will not be registered if at least one of its possible meanings is capable of designating a characteristic of the relevant goods or services in question.

The Examiner invited the applicant to ensure the registrability of the trademark by providing evidence that the trademark has acquired distinctiveness through use in connection with the goods for which registration is sought. But no such evidence was provided. Instead, the applicant requested a hearing to provide an opinion on the inherent distinctiveness of the Mark, and the Hearing was held before the IP Adjudicator.

Applicant’s submissions

The Applicant’s submissions before the IP Adjudicator can be summarised as follows:

- (a) The Mark is a word mark made up of three-word elements. These words must be read together and not disjunctively.
- (b) The Examiner illegitimately focused on only one word element – the word “STRONG” – in arriving at her conclusion.
- (c) The word “STRONG” is not an obvious and natural way of describing shorts and/or T-shirts that can withstand wear. One would not ordinarily refer to “strong shorts” and “strong T-shirts”.
- (d) Even by their own, “BY” and “CHOICE” make no reference to the quality or characteristics of shorts and/or T-shirts.
- (e) The message that the Examiner contends to be conveyed by the Mark, that the Applicant is committed to providing shorts and T-shirts that can withstand wear, is not clear, straightforward and unambiguous. There is a need for the average consumer to apply thought and exercise mental effort to figure out what the Mark might be referring to.

Issue Discussed

Based on the above submissions made by the Applicant, the IP Adjudicator mainly discussed in relation to if the Mark is inherently distinctive. Whether a particular mark is inherently distinctive (or inherently descriptive) should be determined by the context-specific exercise, which must be applied by reference to

- (a) The goods or services for which registration is sought; and
- (b) The perception of the average consumer of those goods or services, who is deemed to be reasonably well informed, observant, and circumspect.

In addition to the above, the distinctive character of a mark is to be **assessed as a whole**.

A. Mark must be considered as whole

It is unusual to hear someone describe a T-shirt or shorts as “strong.” The complete phrase “STRONG BY CHOICE” must be taken into consideration when interpreting the term “strong.”

When taken as a whole, the typical consumer would not immediately understand that the phrase itself refers to the quality of T-shirts or shorts. The phrase is ambiguous in that various people may take it to signify different things.

In fact, the phrase “strong by choice” used by the applicant in its correspondence with the Examiner returns hits related to lifestyle, character, personality, or physical strength on the first page of a Google search. None of them directly or indirectly relate to how long clothing will last.

In these premises, even assuming that the word “strong” is by itself descriptive of the durability of T-shirts and shorts, the phrase “STRONG BY CHOICE,” when taken as a whole, constitutes a fairly “unusual combination of words” in relation to T-shirts and shorts, creating an impression that is sufficiently dissimilar from the impression created by the word “strong” simpliciter. Such compound word marks are not devoid of distinctive character.

B. A Mark shall not be registered if at least one of the possible meanings of the Mark is capable of designating a characteristic of the relevant goods or services.

Further, it is pertinent to note that the above principle is arguably correct but must be understood in the context of two other equally important legal principles.

First, that characteristic must be “easily recognisable” by the average consumer of that industry.

Second, the focus is not on every conceivable consumer; the assessment is done by reference to a “significant proportion” of consumers in that industry.

The IP Adjudicator took the view that some consumers not well versed in the English language might associate the phrase “strong by choice” with the durability of the clothing apparel, such consumers are, in his view, likely few, and they are likely to do a double take and rethink whether the phrase does indeed refer to the durability of the clothing apparel or something else. It invokes some degree of imagination and thought on the consumer’s part. The average consumer is likely to explore different possibilities as to what the phrase means and does not immediately conclude that it is related to the durability of t-shirts and shorts.

C. Degree of Originality

It is important to note that the test for assessing distinctiveness is the same for all categories of marks, and the registrability of slogans was discussed in the case of *Lidl Stiftung & Co. KG v European Union Intellectual Property Office (“Lidl Stiftung”)*. In that case, the EU court explained that the contested Mark requires the relevant public to exercise some cognitive effort and place the Mark in a certain context, and there was also a certain **originality** to the Mark that will

enable the consumers to identify the commercial origin of the goods.

The IP Adjudicator for the mark “party like gatsby” emphasised that it was not sufficient for the Mark to simply set off a “cognitive process”; it had to possess “a certain originality or resonance.” On the present facts, the IP Adjudicator mentioned that the phrase “Strong by Choice” exudes a **certain degree of originality** in relation to T-shirts and shorts, which enables consumers to identify the commercial origin of the goods.

Decision

Having considered the above requirements and legal principles, the IP adjudicator waived the Examiner’s objection and accepted the Application for publication.

(source: Biro Oktroi Roosseno Singapore)

4. Indonesia Trademark Update: When the Toy Meets Courts

The FISHER-PRICE trademark dispute between the United States company Mattel, Inc. and a local businessman is rolling in the Central Jakarta District Court with case number 20/Pdt.Sus-HKI/Merek/2023/PN Niaga Jkt.Pst.

According to the plaintiff, the mark FISHERPRICE, Class 12, under Register No. IDM000764021 in the name of Defendant is substantially similar to the well-known mark FISHER-PRICE in the plaintiff's name for similar and non-similar goods.

Mattel, Inc. requested the panel of judges to declare the FISHERPRICE Mark, Class 12, under Registration No. IDM000764021 on

behalf of Defendant to have similarity in its essential part with the FISHER-PRICE Mark under Registration No. IDM000495798 in class 28 and the FISHER-PRICE & Painting mark under Registration No. IDM000435561 in class 28 on behalf of the plaintiff.

In addition, the US company requested the panel of judges to cancel the FISHERPRICE trademark belonging to the Defendant along with all its legal consequences and declare that the FISHER-PRICE trademark and its variants belonging to the plaintiffs are well-known marks.

The plaintiff also requested the panel of judges to declare that the FISHERPRICE Mark, Class 12, under Register No. IDM000764021 in the name of the Defendant has similarities in its essential part with the name of the legal entity Fisher-Price, Inc., which is a subsidiary and wholly owned by the plaintiff, and the use of the name FISHERPRICE did not receive approval from the company;



Mattel, Inc. is an American multinational toy manufacturing company founded in January 1945 and headquartered in El Segundo, California. The company is in 35 countries and territories and sells products in over 150 countries.

The company engages consumers through its portfolio of iconic marks, including Barbie, Hot Wheels, Fisher-Price, American Girl, Thomas & Friends, UNO, Masters of the Universe, Monster High, and MEGA, as well as other popular Intellectual Properties that their own or license in partnership with global entertainment companies.

This case is still in the early stages of court hearings, and the court's verdict has not yet been made.

(source: <http://sipp.pn-jakartapusat.go.id/>; <https://corporate.mattel.com/about-us>)

5. Indonesia Trademark Update: Dispute Between RISEN and RYZEN

PT Global Elektrik Nasional was sued by Risen Energy Co., Ltd at the Central Jakarta District Court. This case began when the RYZEN trademark under registration No. IDM000734276 on behalf of the Defendant has similarities in its essential part with the RISEN trademark owned by the Plaintiff.



One of the petitions submitted by Risen Energy Co., Ltd was to cancel the registration of the RYZEN mark under registration No. IDM000734276 in the name of the Defendant

from the General Register of Marks, and further announce the cancellation of the registration of the mark in the Official Gazette of Marks. The RYZEN mark was registered in the name of the defendant under registration No. IDM000734276 in the class 9 which include antenna, ballast, electrical cable, MCB box, MCB, switch, stop contact, electrical terminal, plug contact, etc.

The Plaintiff also asked the Central Jakarta District Court to declare that the Plaintiff as the only first owner and legal right holder of the RISEN registered trademarks in Indonesia and internationally so that the Plaintiff has the exclusive right to use the RISEN trademark. Further, they asked the panel of judges to declare the Plaintiff's RISEN Trademark as a well-known mark. This Chinese company requests to accept the Plaintiff's lawsuit in its entirety.

Risen Energy Co., Ltd was founded in 1986 and listed as a Chinese public company in 2010. The company is one of the pioneers in the solar industry and has committed to this industry as an R&D expert, an integrated manufacturer from wafers to modules, a manufacturer of off-grid systems, and an investor, developer, and EPC of PV projects. The company's products include crystalline silicon solar lamps, batteries, parts, and other applications.

As for PT Global Elektrik Nasional, they are specialized in the production of electrical appliances such as LED lamps.

(source: <http://www.dgip.go.id/>; <https://en.risenenergy.com/about/brief>)

6. DGIP: Participates in APEC-IPEG Meeting in the United States

The Director of Intellectual Property Cooperation and Empowerment led the Indonesian delegation in discussing crucial issues in the field of Intellectual Property (IP) at the Asia-Pacific Economic Cooperation - Intellectual Property Rights' Experts Group (APEC-IPEG) meeting in Palm Springs, California, United States on February 19-20, 2023.



The APEC-IPEG meeting was officially opened and led by the new APEC President who will lead the IPEG meeting for the next 2 years, Atty. Gen. Rowel S. Barba.

On this occasion, the Director of Intellectual Property Cooperation and Empowerment conveyed information about the successful implementation of the Directorate General of Intellectual Property (DGIP) flagship program in 2022 and introduced the DGIP flagship program in 2023.

In addition, she also conveyed an update regarding the increasing number of IP registrations in Indonesia in 2021 and 2022.

"The achievements made by DGIP are also seen in efforts to strengthen understanding of the importance of Intellectual Property protection and the benefits that can be obtained from registering Intellectual

Property for Micro, Small and Medium Enterprises (MSMEs)," she explained.

Furthermore, all APEC Economies members continue to make efforts to improve Intellectual Property services. They hope that the contribution of all members in the success of APEC priorities and work plans for 2023-2024 will focus on three things, such as: IP Financing, IP in the Digital Economy and Interconnectivity, and IP for Sustainable and Inclusive Growth.

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

7. DGIP: ICA-CEPA Discusses Genetic Resources, Traditional Knowledge, and Traditional Cultural Expressions

DGIP represented Indonesia in the fourth round of Indonesia-Canada Comprehensive Economic Partnership Agreement (ICA-CEPA) negotiations on Intellectual Property Rights (IPR) on February 20-23, 2023.



On the first day, the discussion focused on the regulations on the protection of Genetic Resources (GR), Traditional Knowledge (TP), and Traditional Cultural Expressions (TCE). In addition to these three issues, it was also discussed The Development of IP, IP and Public Health, and Technology Transfer.

The Head of Program and Reporting of DGIP explained that these three issues provide benefits to increase Gross Domestic Product (GDP) in Indonesia. According to him, one of the sectors that utilizes a lot of IP is the creative economy.

He also said that in the fields of GR, TP, and TCE in Indonesia does not use a royalty system. However, the benefits are shared between the public or community that owns the IP and the party that collaborates with them.

He gave the example of Bali. The tourism sector in Bali contributes to Indonesia's GDP through its utilization. Further, Endek Fabric from Bali which has collaborated with a world-class brand, Dior. The cooperation not only provides mutual economic benefits, but also the resulting promotion. Balinese Endek Fabric can be famous all over the world.

The Sub-Coordinator of Legal Considerations and Litigation of DGIP also explained that the Article 26 Paragraph 1 of Law No. 13/2016 on Patents states if the invention is registered and/or derived from Genetic Resources, and/or Traditional Knowledge, it must be clearly and correctly mentioned in the patent description.

The consequence of not including it in the patent description is that third parties or other parties can take it to the court and it is possible to invalidate the patent. However, mediation can be implemented first before going to court if the patent owner can cooperate with the owner of the Genetic Resources.

Currently, Indonesia is paying full attention to the protection of GR, TP, and TCE to be included in regulations in Indonesia.

On this occasion, Canadian representatives presented the draft cooperation that will be established with Indonesia, especially in the field of IP. Furthermore, he also welcomed the fourth meeting of the ICA-CEPA. He realized that what was conveyed by Indonesia was a step to protect its IP.

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

8. DGIP: Drug Licenses in the Patent System in Indonesia

The Indonesian delegation through the Directorate General of Intellectual Property (DGIP) attended a meeting with the Head of the Patent and Technology Division of the World Intellectual Property Organization (WIPO) on Thursday, 2 March 2023 in Geneva.



On this occasion, DGIP along with a team from WIPO discussed the TRIPS agreement, especially the explanation of Article 31 paragraph (e) TRIPS which stated:

Where the laws of the Member permit other uses of the subject matter of the patent without the permission of the right holder, including uses by the government or third parties authorized by the government, the following provisions must be respected: (such use shall not be transferable, except with the share of the company or goodwill enjoying such use).

"Therefore, the impact of the article on the implementation or patent system by the Indonesian government is the implementation of compulsory licenses, especially those related to drug access in the community", said the Coordinator of Legal Services and Facilitation of the Patent Appeal Commission.

Furthermore, the Head of the Legislative, Policy, and Technology Advice Section of the Patent and Technology Division of WIPO explained that in essence Article 31 of TRIPS related to 'Other Use Without the Authorization of the Right Holder' must be implemented in accordance with the provisions listed in paragraphs (a) to (l), especially for the implementation of patents by the government and compulsory licenses.

"Basically, Article 31 paragraph (e) TRIPS is specifically intended to maintain the reputation of patented products and to prevent the issuance of other licenses or subsequent licenses that cannot be accounted for," he explained.

He also stated that the phrase 'part of the company' in Article 31 paragraph (e) TRIPS means that a compulsory license can be granted to a subsidiary that obtains a compulsory license but remains in one field.

Moreover, he added that for the phrase 'goodwill' in Article 31 paragraph (e) of TRIPS, it is intended that developing countries must be able to regulate in the implementing regulations certain standards that can maintain the reputation of their own products, for example that products resulting from compulsory licenses must not use the trademark of the originator and must meet all the qualifications of the patented product or process.

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

9. DGIP: Domestic Patent Applications Almost Reach 40 Percent

Director of Patents, Layout Design of Integrated Circuits and Trade Secrets, revealed that the increase in patent applications from domestic inventors almost reach 40% of all patent applications to the Directorate General of Intellectual Property (DGIP) of the Ministry of Law and Human Rights in 2022.



"Patent applications in the world will generally only increase 15-20 years after the patent system is built. Thankfully, our local patent applications have begun to experience a significant increase over the past few years, even reaching 39.6% in 2022," he explained at the Regional Office of the Ministry of Law and Human Rights East Java on March 7, 2023 in Surabaya at the Workshop on Substantive Completion of Post-Registration Management Patents with Universities, R&D Institutions, and Business Actors in the Regions.

Most Indonesian inventors register patents in the classes of human necessities, metallurgy, and physics. The DGIP has recorded that the number of patent applications in Indonesia from both domestic and foreign countries in 2022 was more than 14,000. Whereas in the previous year, there were 12,400 applications. The number has also increased from 10,000 applications in 2020.

"However, we hope that the inventions from universities whose research have been based on patents do not stop at the application because many of them are like that so that many are withdrawn or only reach the substantive examination," he added.

He encouraged patent applicants not only to look at the three important elements in a patent application, which are new, innovative and applicable in the industry. However, he hopes that innovators will also see the economic potential of the proposed patent so that the patent holder can pay the cost of maintaining the patent regardless of existing incentive programs.

To continue increasing local patent applications and utilization, the Directorate of Patents, DLTST, and Trade Secrets held several workshops for consultation and communication with stakeholders.

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



(Anno 1951)

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