

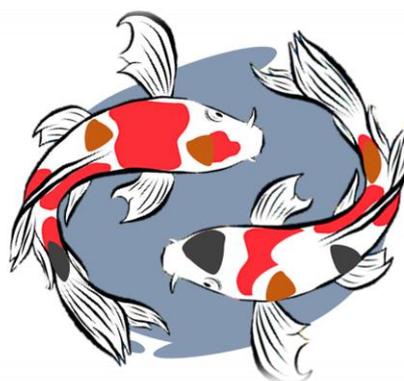
## This Edition of Newsletter Contains:

1. **Indonesia Trademark Update: Disputed Koi Fish Food**
2. **Indonesia Trademark Update: Which Battery Will Run Out of Energy in Court**
3. **Singapore Trademark Update: Singapore's IPOS Rejects Google's Opposition to "grMail" Trademark**
4. **DGIP: Establishment of Indonesia IP Academy**
5. **DGIP: The 17th Meeting of the Patent Cooperation Treaty (PCT) Working Group**
6. **DGIP: Participates in the 58th APEC-IPEG Meeting in Peru**

### 1. Indonesia Trademark Update: Disputed Koi Fish Food

A trademark dispute has arisen between the Japanese company and a local importer related to koi fish rearing over the use of the mark "HI-SILK21 KENKOKANRI" in class 31 for the goods fish food.

The Japanese company as a Plaintiff, has filed a petition seeking several remedies, including the grant of their entire claim, a declaration of their first registration and rightful ownership of the mark and its variants worldwide, and the recognition of the mark as a well-known mark. The Plaintiff alleges that the mark owned by the Defendant is having similarity in its essential part and/or in whole to their well-known mark and its variants.



They further claim that the registration of the mark by the Defendant was filed in bad faith.

As a result, the Plaintiff requested the Court to declare that the registration of the mark null and void, with all its legal consequences. Additionally, the Plaintiff has requested the Defendant to comply with and implement this

decision, and to cancel the registration of the mark "HI-SILK21 KENKOKANRI" in class 31 on behalf of Defendant from the General Register of Marks, with all its legal consequences.

This dispute highlights the importance of protecting trademarks, particularly when they are well-known and have been registered in good faith. The outcome of this case could have significant implications for the parties involved and the fish food industry as a whole.

The Japanese Company, Kawaguchi Shoten Co., Ltd., was established on January 4, 1979. The company has been buying and selling of raw materials related to silk, such as raw silk, cocoons, secondary silk, silk spinning raw materials, etc.

They are also selling of pupa and other fish feed and fishing bait materials.

In 1996, the company started manufacturing and selling high quality Nishikigoi feed "HI-SILK KENKOKANRI". Expanding markets in Japan, America, Europe, and Southeast Asia.

Mr. Kawaguchi of Kawaguchi Shoten Co., Ltd and Mr. Mamoru Kodama, author of Kokugyo books and founder of Kodama Koi Farm developed Hi Silk 21. Mr. Kawaguchi, a leading supplier of silk and silkworm, provided quality fresh silkworm pupae. Mr. Kodama, a koi expert, designed the food with the silkworm pupae creating amazing Koi growth results.

Hi-Silk 21 is the high-quality protein food. It is developed to help your Koi fish grow faster, with such a brilliant and beautiful white color as natural silk. It is being fed to many champion Koi to produce beautiful sheen in the colors, especially in the white of Nishikigoi.

Currently, this case is still in the early court examination stages at the District Court of Central Jakarta under case number 119/Pdt.Sus-HKI/Merek/2023/PN Niaga Jkt.Pst.

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

## 2. Indonesia Trademark Update: Which Battery Will Run Out of Energy in Court

The storage battery trademark dispute currently under trial at the Central Jakarta District Court involves a company from India that manufactures lead and electric storage batteries, which is the plaintiff, and a local businessman, who is the defendant.



The company, Exide Industries Limited, has ten international standard factories spread across five states in the country, out of which 8 factories are dedicated to lead-acid batteries and 2 factories manufacture Home UPS Systems. They also have manufacturing facilities in Sri Lanka, UK and Singapore and does business globally through its subsidiaries and international affiliates

They export its batteries to more than 60 countries across the globe. It has a strong 95,000+ distributor & dealer / sub-dealer network.

Pursuant to this matter, the Indian company filed a cancellation lawsuit against the said local businessman in the District Court of Central Jakarta under case number 117/Pdt.Sus-HKI/Merek/2023/PN Niaga Jkt.Pst.

The plaintiff is seeking to establish their ownership and first use of the SF SONIC trademark, as well as its recognition as a well-known trademark.

Both trademarks protected the type of goods in class 9, such as accumulator, car battery, accumulator, uninterruptible power supply device, battery and battery cell, lithium ion battery, dry battery, electric battery, lithium battery, storage battery, solar battery, battery for vehicle, battery for electric vehicle, battery for mobile phone, rechargeable battery, Inverter, power inverter, capacitor, battery box, charger for electric battery, electric power control equipment, electric cell and battery, solar cell, solar cell and power generation panel, Renewable battery system for providing backup power, Interruption-free power supply, etc.

They argue that the defendant's registration of the mark was filed in bad faith and is substantially or entirely similar to the plaintiff's mark, and they are seeking to have the registration declared null and void. Additionally, the plaintiff is seeking damages.

Currently, this case is still in the early stages of court hearings, and the court's verdict still needs to be made.

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

### **3. Singapore Trademark Update: Singapore's IPOS Rejects Google's Opposition to "grMail" Trademark**

In a recent decision, the Intellectual Property Office of Singapore (IPOS) ruled in favour of Green Radar, an IT security firm, allowing them to register the trademark "grMail" (Trademark No. 40202109944T) for their services under class 42 and class 45.

This comes after tech giant Google filed an opposition against the mark, citing potential confusion with their own established trademark "Gmail".

The case centered around whether "grMail" was confusingly similar to "Gmail" and could potentially dilute the distinctiveness of Google's brand.

#### **Google's Arguments:**

Google opposed the registration of "grMail" on the following grounds:

##### **i. Confusing Similarity:**

Google argued that "grMail" is too similar to its well-known trademark "Gmail," leading to consumer confusion. They believed consumers might mistakenly associate "grMail" with Google's email service.

##### **ii. Dilution and Unfair Advantage:**

Google contended that allowing "grMail" would dilute the distinctiveness of its "Gmail" trademark and potentially allow Green Radar to gain an unfair advantage by riding on Google's brand reputation.

#### **IPOS Decision:**

IPOS acknowledged a moderate degree of visual similarity between the two marks.

However, they ultimately sided with Green Radar, finding the following:

i. Sufficient Distinction:

The addition of the prefix "gr" creates enough distinction for the average consumer to differentiate "grMail" from "Gmail".

ii. Dissimilar Services:

The services offered under the respective trademarks are distinct. "Gmail" is an email service, while "grMail" relates to IT security services. This difference reduces the likelihood of confusion.

iii. No Dilution or Unfair Advantage:

IPOS determined that "grMail" wouldn't likely damage the distinctiveness of "Gmail" due to Google's brand strength. Additionally, they found no evidence that Green Radar intended to capitalize unfairly on Google's reputation.

**Conclusion:**

This decision allows Green Radar to register the "grMail" trademark in Singapore for their IT security services and subsequently the mark has obtained registration in Singapore. Google was also ordered to pay Green Radar US\$12,000.

This case highlights the importance of distinctiveness in trademark selection. While some similarity might exist, clear differentiating factors can be crucial in securing trademark registration.

*(source: Biro Oktroi Roosseno Singapore)*

#### 4. DGIP: Establishment of Indonesia IP Academy

Secretary of the Directorate General of Intellectual Property (DGIP) held a meeting with Deputy Director General for Regional and National Development Sectors of World Intellectual Property Organization (WIPO) to discuss the follow-up to the establishment of the Indonesia IP Academy in Geneva, Switzerland on Friday, February 2, 2024.

On this occasion, he conveyed the preparations that had been planned and implemented by DGIP regarding the establishment of the Indonesia IP Academy, especially regarding management support and infrastructure.



"We are currently preparing national regulations for the establishment of the Indonesia IP Academy. Apart from that, supporting infrastructure and facilities are also being prepared, one of which is a special library for Intellectual Property," he explained.

Furthermore, he also conveyed several work plans for 2024 which had been prepared together at the WIPO office over the last five days, one of which was training activities delivered by the Indonesian Intellectual Property Training Institution (IPTI) with the WIPO Academy.

Deputy Director General for Regional and National Development Sectors of WIPO

appreciated the efforts and welcomed the progress in the development of the establishment of the Indonesia IP Academy.

"This year WIPO has also prepared several programs, we hope to collaborate again with DGIP on several activities this year," he concluded.

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

## 5. DGIP: The 17th Meeting of the Patent Cooperation Treaty (PCT) Working Group

The Indonesian delegation represented by the Director of Patents, Integrated Circuit Layout Design (DTLST), and Trade Secrets of DGIP attended the 17th Patent Cooperation Treaty (PCT) Meeting Working Group held at the World Intellectual Property Organization (WIPO) Headquarters, Geneva, Switzerland on Tuesday, February 20 2024.

"At this 17th meeting several agendas were discussed including Technical Assistance Under the PCT, PCT Online Services, Filing Medium of International Applications and Related Documents, Legal Measures to Support Electronic Processing, Personal Data Protection and the PCT, and several issues related to the implementation of the PCT," he said.



He added that at this meeting a sharing session was also held by several PCT member countries regarding experiences in

implementing the Patent Prosecution Highway (PPH). Then, on the sidelines of the series of meetings, a sharing session was also held related to the Relationship between Patent Cooperation Treaty and Patent Law Treaty (PLT).

He also said that through this meeting, Indonesia could find out about developments related to PCT. These developments can be administrative or substantive, including opportunities for Indonesia's participation in PCT such as technical assistance *or maximum capacity* building.

"This forum is very important to follow carefully and continuously because it discusses issues related to the implementation and changes to the PCT system," he explained

Indonesia has been a member of the PCT since 1997 based on Presidential Decree Number 16 of 1997 concerning Ratification of the PCT. In its implementation, to date 52% of the applications received by DGIP have been submitted through the PCT scheme.

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

## 6. DGIP: Participates in the 58th APEC-IPEG Meeting in Peru

Director of Cooperation and Education of the Directorate General of Intellectual Property participated in discussing crucial issues in the field of Intellectual Property at the 20<sup>th</sup> Asia-Pacific Economic Cooperation - Intellectual Property Rights' Experts Group (APEC-IPEG) meeting 58 in Lima, Peru from February 25 to March 1, 2024.

At the meeting, she conveyed the latest developments regarding the geographical

indication (IG) protection policy in Indonesia, developments in the revision of the Industrial Design Law and Indonesia's strategy to support small and medium businesses. On this occasion, it was also conveyed about the successful implementation of the DGIP flagship program in 2023 and introducing the DGIP flagship program in 2024.

She also explained the development of the Draft Industrial Design Law where it will increase the effectiveness of implementing the industrial design system, strengthen the Industrial Design Law, and align regulations with international developments in the field of industrial design.

"It is hoped that through the revision of this law a more conducive environment will be created for creation and innovation in the field of industrial design as part of the Intellectual Property system," she explained.

Principles on Integrating Inclusivity and Sustainability into Trade and Investment Policy.

On the sidelines of APEC-IPEC activities, bilateral meetings were also held with delegations from the United States, Canada and Korea regarding several follow-up activities or action plans. Apart from that, at the 58th APEC-IPEG meeting, Project Management Unit Training was also held which aims to guide the design and preparation of quality projects within the APEC framework.

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



During the meeting, participants of the APEC Economies conveyed the efforts that had been made to improve Intellectual Property services, as well as their contribution to the success of APEC's priorities and work plans, such as the Aotearoa Plan of Action, implementing the Putrajaya Vision; the Bangkok Goals on Bio-Circular-Green (BCG) Economy; the La Serena Roadmap for Women and Inclusive Growth; and the San Francisco



(Anno 1951)

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