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1. **Indonesia Trademark Update: The Swiss “BMC” Lawsuit Against Local Businessman**



BMC Switzerland AG is a Swiss bicycle and cycling product manufacturer based in Grenchen, Switzerland. BMC Switzerland started as a bike manufacturing company in 1986. By 1994, the BMC brand was born. The company designs, builds and distributes road bikes, mountain bikes, and commuter bikes. The products are sold to dealers in various countries in North America, Europe, South Africa, Australia, East Asia and the United Arab Emirates. In Indonesia, BMC Switzerland AG found that the trademark of BMC has been registered by a local Businessman named Edina Nathania under registration No.

IDM000442917 at the DGIP. Pursuant to this matter, BMC Switzerland AG filed a cancellation lawsuit against the said local businessman in the District Court of Central Jakarta with a case number 76/Pdt.Sus-HKI/Merek/2021/PN Niaga Jkt.Pst.

The plaintiff did not accept the defendant's action, who imitated, plagiarized, and used the plaintiff's trademark fame. The plaintiff asked the court to declare that the plaintiff is the sole legal owner and has the right to the well-known BMC marks and their variants for the types of goods categorized in classes 12 and 25 in the territory of the Republic of Indonesia.

They also asked the court to declare the BMC trademark under Registration No. IDM0004429170, on behalf of Edina Nathania, has been registered in bad faith. The plaintiff stated that the trademark registration with registration number IDM000442917 class 12 on behalf of the defendant dated June 5, 2012, has similarities in essential part or whole with the well-known marks of BMC and variants.

The plaintiff requested the court to declare that the mark belonging to the defendant would be canceled and instruct the defendant to pay the court fees.

Currently, this case is still at the early court examination stages and awaiting the court's verdict.

(source: <http://sipp.pn-jakartapusat.go.id>;
<https://www.bmc-switzerland.com>;
https://en.wikipedia.org/wiki/BMC_Switzerland)

2. Indonesia Trademark Update: A Sip of Scotch Whisky in a Court

The Scotch Whiskey Association (SWA) filed a lawsuit against a local liquor company, PT. Industri Semak, for using a similar mark. In addition to asking for the cancellation of similar trademarks, the defendant was asked to pay immaterial compensation of Rp 2 billion. The lawsuit was filed with registration No. 78/Pdt.Sus-HKI/Merek/2021/PN Niaga Jkt.Pst in the Central Jakarta District Court on November 21, 2021.



The Scotch Whiskey Association, the plaintiff, is a trade organization that represents the Scotch whisky industry. It was formed on April 17, 1942. It became a limited company in 1960. The SWA's members represent over 95% of Scotch whisky production, which encompasses over 2,500 brands around the world.

Scotch whisky has been a significant industry for decades. Today, Scotch whisky is enjoyed in 175 countries throughout the world. Each second, 42 bottles of Scotch are shipped from Scotland across the globe.

Meanwhile, PT. Semak Industry is a company with a whiskey brandy business line with registration number 66/37100 issued in

2012. The company is located in Banten, Indonesia.

Here are the demands from the lawsuit of The Scotch Whiskey Association:

Provisional demands:

1. To accept and grant the plaintiff's provisional request in its entirety;
2. Order the defendant to stop the production and reproduction of Glen Classic products that use the SCOTCH WHISKY Geographical Indication label without rights.
3. Sentencing the defendant to pay forced money (dwangsom) of Rp. 1 million for each day of delay in implementing the contents of this provisional decision, effectively counting 7 (seven) days from the date this provisional decision was read until it was implemented;

In The Subject Matter:

1. To grant the Plaintiff's Claim in its entirety;
2. Stating that the plaintiff is the owner and the first registrar and is the party entitled to use the SCOTCH WHISKY Geographical Indication;
3. To declare that the defendant has violated the plaintiff's SCOTCH WHISKY Geographical Indication.
4. To declare that the defendant has violated the Plaintiff's SCOTCH WHISKY Geographical Indication by using Geographical Indications, either directly or indirectly, on goods and/or products that do not meet the Geographical Indication Document Description ;
5. To declare that the defendant has violated the Geographical Indication of SCOTCH WHISKY by using the

word "Scotch Whiskey" and the name "Glen Classic";

6. Order the defendant to stop all production and/or distribution activities of Glen Classic products;
7. Ordered the defendant to destroy the SCOTCH WHISKY Geographical Indication label used on Glen Classic products;
8. Punish and order the defendant to pay Material Compensation to the plaintiff in the amount of Rp. 285,480,000, - (Two hundred eighty-five million four hundred and eighty thousand Rupiah);
9. Punish and order the defendant to pay Immaterial Compensation to the plaintiff in the amount of Rp. 2,000,000,000, - (Two billion Rupiah);
10. Sentencing the defendant to pay forced money (dwangsom) in the amount of Rp. 1,000,000, - (one million Rupiah) per day to the plaintiff if he did not implement the decision in the a quo case which had obtained permanent legal force (inkracht van gewijsde);
11. To declare that the decision, in this case, can be implemented and executed first despite resistance and/or denial (verzet), appeal, cassation (uitvoerbaar bij voorraad);
12. Punish the defendant to pay the court fees that arise in this case.

Currently, the case between the parties is still under examination.

(source: <http://sipp.pn-jakartapusat.go.id>;
<https://www.scotch-whisky.org.uk>;
https://en.wikipedia.org/wiki/Scotch_Whisky_Association)

3. Singapore Trademark Update: A Beast, Silenced

Monster Energy Company v Health and Happiness (H&H) Hong Kong Limited [2021] SGIPOS 14.

The trademark application of **Health and Happiness (H&H) Hong Kong Limited** ("the



Applicant") for its " " Mark in Class 35, was opposed by **Monster Energy Company** ("the Opponent").

The Applicant is a full-service communications agency which provides customised services such as sales promotion, marketing and advertising. This company was founded in 2012 and is headquartered in Collingwood, Victoria, Australia.

Meanwhile, the Opponent is a global leader in the beverage industry. Its core business is in "MONSTER ENERGY" energy drinks, although it also engages in a variety of other activities as well. The Opponent is notoriously known for its policy of suing companies or groups that use the word "Monster", the letter "M", or the word "beast" in their marketing for trademark infringement.

Thus, this is not the first time that the parties have crossed swords. The Opponent had previously filed an opposition based on its earlier "UNLEASH THE BEAST!" mark to the Applicant's parallel trademark application (involving the same trademark in respect of what appears to be the same services) in Korea. However, the action was dismissed on grounds that the marks are dissimilar, and the Opposition Division of the Korean Intellectual Property Office ruled in favour of the Applicant.

Moreover, when the case was set down for a hearing, both parties elected to be heard solely "on paper" without an oral hearing in order to save costs. The case was therefore decided based on the pleadings, evidence and written submissions filed. However, it was noted that the Applicant did not tender a written submission due to budget reasons. But though the Applicant did not have the benefit of submissions put forward on its behalf, its position on the key issues was deemed to be sufficiently clear from the pleadings and evidence filed.

In this opposition, the Opponent relied on only Sections 8(2)(b) 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 their earlier marks "UNLEASH THE BEAST!" and "REHAB THE BEAST!" in classes 5 and 32



to oppose the Applicant's " " application mark.

For the opposition under this ground to be successful, all three steps, as set out by the Court of Appeal in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 ("*Staywell*"), must be established. If any one step cannot be established, the opposition under this ground will fail.

Staywell also makes it clear that the proper approach is to assess the three steps in sequence. Interestingly, for this matter, the Hearing Officer decided to deal with the second step first. The main reason for this was that the Application Mark is sought to be registered in Class 35 for a variety of services relating to sales, advertising and marketing,

whereas the Opponent's Earlier Marks are registered for *goods* in Classes 5 and 32 which may be broadly described as nutritional supplements (in Class 5) and beverages (in Class 32).

Therefore, under the second step, the Hearing Officer compared the goods under each of the Opponent's Earlier Marks as against the services applied for under the Application Mark. While the Applicant's pleaded case was that the relevant "*services are totally and completely dissimilar to the Opponent's goods and there could be no likelihood of confusion*", the Opponents argued that the services under the Application Mark, namely "***Sales promotion for others; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising; Marketing***", are complementary and hence similar in nature to the goods covered under the Opponent's Earlier Marks. By complementary, the Opponent meant that the specifications have a close connection with each other in the sense that one is indispensable or important for the use of the other such that consumers may think that the goods or services originate from the same trade source

Unfortunately, the Hearing Officer was not persuaded by the Opponent's arguments in the slightest and found it "eminently clear that there is no similarity at all between the goods and services in issue". Hence, the second step of the three-step test was not established, and therefore the opposition must fail.

The Hearing Officer further clarified that he dealt with the second step prior to addressing similarity of marks because he regarded the dissimilarity between the goods and services as the most straightforward reason why this opposition should be dismissed.

As a result, the ground of opposition under Section 8(2)(b) failed, and accordingly, the applicant's mark was allowed to proceed to registration, and the applicant is also entitled to costs to be taxed.

(source: [https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2021/monster-energy-v-health-and-happiness-\(h-h\)-hong-kong-2021-sqipos-14.pdf](https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2021/monster-energy-v-health-and-happiness-(h-h)-hong-kong-2021-sqipos-14.pdf))

4. Enhanced Intellectual Property Law Enforcement Through Benchmarking with IPR Center and Coordination with FBI



The Indonesian delegation consisting of the Directorate General of Intellectual Property (DGIP) and the National Police conducted benchmarking with the US National Intellectual Property Rights Coordination Center (IPR Center) located in Virginia, United States of America, on November 4, 2021. In carrying out its duties, the IPR Center takes several strategic approaches. First, the investigative strategy, namely identifying, filing charges, and dismantling criminal organizations involved in manufacturing and distributing counterfeit products.

Second, the interdiction strategy, by conducting inspections to prevent and prohibit the circulation of counterfeit goods in the United States. Third, outreach and training strategy in which the IPR Center provides domestic and international law enforcement training for IP violations.

The strategy carried out by the IPR center has actually been implemented In Indonesia to protect Intellectual Property. Until now, DGIP continues to make efforts to eradicate IP violations by providing education, supervision, and law enforcement.

In addition, DGIP had also held capacity-building training for Civil Investigators in order to have the appropriate competence in conducting supervision and law enforcement.

This step was taken by Indonesia so that law enforcement in the field of IP in the country runs effectively as an effort to protect business actors, art creators, creators, and inventors from crimes of IP infringement.

Moreover, Indonesia currently holds Priority Watch List (PWL) status. It is considered a country with a fairly severe level of IP violations based on a report released by the United States Trade Representative (USTR).

As Head of the Indonesian Delegation, the Director of Investigation and Dispute Resolution said that there needs to be proper synergy and coordination between law enforcement agencies in creating effective and efficient IP law enforcement.

This effort was attempted by establishing an Operational Task Force for the Management of PWL Status, which consists of five

institutions that have direct authority in supervision and law enforcement of IP.

These five institutions consist of the DGIP, the Criminal Investigation Police of the National Police, the Directorate General of Customs and Excise, the Ministry of Communication and Information, and the Food and Drug Supervisory Agency.

Furthermore, the Indonesian government coordinates with the US Federal Bureau of Investigation (FBI) to request information on any products that are still considered widely counterfeited in the Indonesian market.

In addition, Indonesia also plans to conduct an exploration of cooperation with the FBI to increase IP law enforcement.

According to FBI Special Agent Supervisor, in carrying out its duties, the FBI handles several cases, including computer crime, cybercrime, and IP crime.

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

5. Go International with Madrid Protocol

Trademark plays an important role in building the reputation of a product. A product that can prove its quality will gain trust and create an emotional bond with consumers. Therefore it is essential to get protection at both the national and international levels.

The Director-General of Intellectual Property conveyed this in the Madrid Protocol Webinar: Procedures and Benefits of International Trademark Registration organized by the Directorate General of

Intellectual Property (DGIP) on 15 to 16 November 2021 through an online platform.

Trademark registration through the Madrid Protocol system is a one-stop system solution for trademark owners to obtain trademark protection in the international market.



"By registering international trademarks through the Madrid system before doing business in the international market, related brands will be able to be safely used abroad, businesses can also grow and bring great benefits to the domestic economy," said Director General of Intellectual Property.

In line with this, the Director of Trademarks and Geographical Indications said that registering a trademark through the Madrid protocol can ease the registration of a trademark in many countries, simply with one application, one language, and one currency through DGIP.

"Not only that, but trademark registration through the Madrid protocol also has the impact of increasing confidence in making trade investments, making it easier for Indonesian entrepreneurs to expand trademark protection abroad and facilitate export opportunities," he added.

On the same occasion, Associate Trademark Examiner also conveyed the benefits of the Madrid system, namely the state designation

(Subsequent Designation). "The Madrid Protocol is used to expand the protected areas as well as to restrict the types of goods and services after the International registration is done," he said.

Protection on trademark registration through the Madrid protocol has coverage with protection in 125 member states of the Madrid protocol. Currently, applicants can easily apply for the Madrid protocol trademark registration online through the Intellectual Property Online application at merek.dgip.go.id.

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

6. DGIP: Workshop with WIPO and JPO In Order To Enhance Law Enforcement in IP Protection



The Directorate General of Intellectual Property (DGIP) held a National Webinar and Workshop on Building Respect for Intellectual Property in the Digital Environment for Public Prosecutors and Law Enforcement Officials on December 1st, 2021, through an online platform. The workshop was conducted in collaboration with the World Intellectual Property Organization (WIPO) and the Japan Patent Office (JPO). The purpose of the workshop

was to increase the understanding of Intellectual Property law enforcement, especially in the digital era, for law enforcement officers in Indonesia by sharing information and experiences.

During the workshop, the director of IP Cooperation and Empowerment stated that a country's ability to provide IP protection determines its position in global technology and social aspects; therefore, developing an IP protection system in Indonesia is now very significant.

"The development of an Intellectual Property protection system in Indonesia has become very important to support economic development because the elements of technology, industry, and culture are vital elements in the country's economic activities," he said.

He hopes that this opportunity can improve the performance, especially of law enforcement in Indonesia, so that it can build world trust and encourage national economic growth.

On this occasion, the Director of Investigation and Dispute Resolution also introduced the legal framework of IP protection in Indonesia. He explained the measures in legal protection in Indonesia, one of which is constantly updating the applicable regulations. This aims to be in line with the latest developments in society, information technology, as well as international agreements to provide legal certainty to IP owners.

The State Police of the Republic of Indonesia is also involved in terms of law enforcement related to IP in Indonesia.

In addition, DGIP has also cooperated in law enforcement with four agencies, namely, the

Criminal Investigation Agency of the Police, the Directorate of Customs and Excise, the Ministry of Communications and Informatics, and the Food and Drug Administration.

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

7. The World Intellectual Property Indicators 2021 by WIPO

The World Intellectual Property Organization (WIPO) has published the World Intellectual Property Indicators 2021. The World Intellectual Property Indicators is the annual survey of Intellectual Property (IP) activity worldwide from WIPO, the United Nations specialized agency for innovation and IP.

This authoritative report analyzes IP activity around the globe. Drawing on 2020 filing, registration, and renewals statistics from national and regional IP offices and WIPO, it covers patents, utility models, trademarks, industrial designs, microorganisms, plant variety protection, and geographical indications. The report also draws on survey data and industry sources to give a picture of activity in the publishing industry.

The new publication of the World Intellectual Property Indicators (WIPI) 2021 can be accessed through the following link:

<https://www.wipo.int/publications/en/details.jsp?id=4571>

(source: <http://www.wipo.int/>)

8. Update Status of Some Dispute Cases in Indonesia

Pursuant to our previous newsletter, whereas we informed you of several interesting IP related cases, herewith we would like to provide you with the results of some of the cases as follows:

The Cancellation Law Suit Against Trademark “TIMBERLAKE”

After losing their lawsuit at the Commercial Court level, TBL Licensing LLC filed a cassation to the Indonesian Supreme Court on the cancellation lawsuit. The Indonesian Supreme Court has rendered their decision to grant TBL Licensing LLC’s cassation to cancel the trademark “TIMBERLAKE,” which belongs to a local businessman named Indra Halim.

The Cancellation Law Suit Against Trademark “SUSHI TEI”

The Commercial Court has rendered its decision to grant Sushi Tei PTE LTD (Singapore) and PT. Sushi Tei Indonesia’s lawsuit to cancel the trademark “SUSHI TEI” belonging to PT Boga Inti and Kusnadi Raharja.

They declared that the revocation of the trademark lawsuit by the Plaintiffs was legal. They also ordered the Clerk of the Central Jakarta Commercial Court at the Special Class 1A Central Jakarta District Court to strike out the trademark lawsuit case with case number 59/Pdt.Sus-Merek/2019/PN.Niaga.JKT.PST from the Case Register.

The Cancellation Law Suit Against Trademark “CABERG”

After losing their lawsuit at the Commercial Court level, Caberg SpA filed a judicial review to the Indonesian Supreme Court. Their judicial review was granted, and the panel Judges also granted the plaintiff’s claim in its entirety.

They declared to cancel the trademark “CABERG,” which belongs to a local businessman named Arifin Daniel. They also declared that the plaintiff was the first and only legal owner of the “CABERG” trademark to distinguish the plaintiff’s products from other products.

Furthermore, we inform you the update of some IP Lawsuit cases in 2021 and ends of 2020 newsletter edition as follows:

1. Trademark Cancellation lawsuit of “STARBUCKS”: still under court hearings;
2. Trademark Cancellation lawsuit of “COMIX”: still under court hearings;
3. Trademark Cancellation lawsuit of “SUPER MARIO BROS”: still under cassation stage ;

We will keep updating the IP-related cases at the Indonesian court.

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



(Anno 1951)

BIRO OKTROI ROOSSENO

SEASON'S GREETINGS



Have a Happy and Prosperous
New Year 2022!

Tugu Tani (The Heroes Monument), Jakarta, Indonesia

Inagurated in 1953 by the first president of Indonesia, Soekarno
Sculptors : Matvey Manizer and Ossip Manizer



(Anno 1951)

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