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1. **Indonesia Trademark Update: DC Comics VS Superman**

In our previous Newsletter June 2018 – 27th Edition, we mentioned that DC Comics, a comic book publisher from the United States, filed a lawsuit against the local company PT. Marxing Fam Makmur, domiciled in Surabaya, at the Commercial Court of Central Jakarta. The result was that PT. Marxing Fam Makmur won against DC Comics. Thus, the local company is the party entitled to use the "Superman" trademark in Indonesia.

The Supreme Court asserted the "Superman" trademark on the Indonesia wafers PT. Marxing Fam Makmur produced had nothing to do with DC Comics who had the Superman comic character. Based on the decision of

District Court considered the plaintiff's lawsuit as vague and unclear due to the combination of their request for the cancellation of Defendant's mark, with their request to register the "Superman" mark in their name. Registration for new trademarks is not within the jurisdiction of the Commercial Court.

Further, it was established that the Defendant's wafers products have been consumed by the Indonesian consumers widely since before 2013. The "Superman" trademarks have been registered, with Registration numbers IDM000374438 and IDM000374439. The "Superman" wafers have been a trademark of PT Marxing Fam Makmur since 1993.

Unsatisfied with this result, the Plaintiff has now proceeded with the next stage of this

case again, in the Commercial Court of Central Jakarta under the registration number 29/Pdt.Sus-HKI/Merek/2020/PN Jkt.Pst.

DC Comics, the plaintiff, claimed exclusive rights to the "Superman" trademark in Indonesia. They requested the cancellation of both the defendant's marks, IDM000374439 in class 30 and IDM000374438 in class 34. DC Comics also stated that their "Superman" trademark is a well-known trademark.

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

2. Indonesia Patent Dispute in the Pharmaceutical Industry

The patent infringement lawsuit filed by Apotex Inc. was listed in the Central Jakarta Commercial Court with the number 26/Pdt.Sus-HKI/Paten/2020/PN Jkt.Pst.



The Canadian owned pharmaceutical company objected towards PT. Novell Pharmaceutical Laboratories who have made, used, sold, imported, submitted, or made available for sale or delivery Oferlod products which violate the Plaintiff's Patent. The defendant's action was considered as a violation which inflicts loss for the plaintiff.

Both Apotex Inc. and PT. Novell Pharmaceutical Laboratories were engaged in the pharmaceutical industry. Founded in 1974, Apotex Inc. has focused on research, development, manufacturing and distribution of drugs. The company has steadily grown to employ over 10,000 people located in Canada, India, Mexico, and China.

On the other side, PT. Novell Pharmaceutical Laboratories was established in 1998 in Indonesia and became the only company to have GMP license from Europe, Australia, South Africa PICS and GCC Gulf Countries. As part of its international expansion, the company has its own office and marketing team in the Philippines, Thailand and Vietnam, with more than 30 employees outside Indonesia.

Currently, this case is still at the early court examination stages. The plaintiff requested that the defendant has violated the Patent entitled "The Use of Deferipron". The plaintiff also requested the Judges for all of the Defendants' Oferlod products be handed over to the plaintiff. They also requested some amount of damages.

The plaintiff requested damages in Material Compensation of Rp 32,766,000,000 (thirty-two billion seven hundred sixty six million rupiah) for the loss of sales in Indonesia due to violations committed by the defendant.

(source: <http://sipp.pn-jakartapusat.go.id>; www.novellpharm.com; www1.apotex.com)

3. Singapore Trademark Update: A Sinking Battle for the “MARINER”

On 5 April 2018, Rolex S.A. (“the Opponent”) filed its Notice of Opposition to oppose the trade mark application of FMTM Distribution Ltd (“the Applicant”) for its “MARINER” word mark for goods in Class 14. The Opponent submitted that the Applicant’s mark was similar to the Opponent’s mark “SUBMARINER”.

The Applicant, a member of the Franck Muller group, is a company selling high-end luxury watches, and they own amongst others, the “Franck Muller” trademark for watches. The Opponent is a leading luxury watch manufacturer in the world producing over 2,000 watches per day that generate sales of over 7 billion dollars each year.

The Swiss-based Company manufactures, services, and distributes wristwatches under the Rolex and Tudor brand through authorized dealers. It was founded in 1905 by Hans Wilsdorf and Alfred Davis in England and was recently ranked 57 on the world’s most powerful brands. The brand today produces industry icons such as the Rolex Submariner, Daytona, and GMT-Master, and competes with other leading luxury watch companies like Patek Philippe, Omega, and Panerai and sponsors many major sports events in tennis, golf, yachting, and racing.

In this opposition, the Opponent relied on Sections 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii) and Section 7(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

In the opposition, three arguments were made:

1) Similarity of the Marks

In their written submissions, the Opponent submitted that the marks share a common distinctive and dominant feature of “MARINER”, whereas the Applicant argued that the respective dominant and distinctive components were “SUBMARINE” for the Opponent’s Mark and “MARINE” instead for the Application Mark. However, by the time of the hearing, the Applicant was submitting instead that the prefix “SUB” was the dominant component of the Opponent’s Mark. Following assessments of the distinctiveness of the Opponent’s Mark as a whole, the Hearing Officer found that Opponent’s Mark possessed only a medium degree of inherent distinctiveness, and does not enjoy a high threshold before a competing sign will be considered dissimilar to it. However, he found that the Application Mark is visually, aurally, and conceptually more similar than dissimilar to the Opponent’s Mark.

Moreover, as both parties had applied for protection for “horological instruments”, the element of goods-similarity was satisfied. Thus, the Hearing Officer concluded that the marks are more similar than dissimilar and that the similarity was substantial.

Next, in assessing the likelihood of confusion, the Hearing Officer took into account the factors relating to the impact of the marks-similarity and the factors relating to the impact of the goods-similarity, and concluded that there is a likelihood of confusion between the Application Mark and the Opponent’s Mark, both over the origin of the goods and in the belief that the users of the competing marks are economically linked. As a result, the ground of opposition under Section 8(2)(b) therefore succeeded.

2) Well-known Mark

Next, the Opponent argued that its marks are well known in Singapore and well known to the public at large in Singapore, and thus taking into account Sections 8(4)(a) of the Singapore Trade Mark Act, the Application Mark should not be registered.

To succeed under the above-mentioned ground, the Opponent had to establish that: (1) the Application mark was similar or identical to its earlier marks, (2) its earlier marks are well known in Singapore and well known to the public at large in Singapore, (3) the use of the Application Mark would indicate a connection between the Applicant's goods/service with the Opponent's goods/services, and that (4) the use of the Application Mark would damage the interest of the Opponent, by causing dilution or unfair advantage.

While the Opponent was able to convince the Hearing Officer that the marks were substantially similar, they struggled to prove that their earlier mark was well known in Singapore as the Opponent's evidence did not support a finding that the Opponent's Mark is well known in Singapore. Notwithstanding this, given that the likelihood of confusion was established above, the element of confusion was satisfied.

As for the third requirement, the likelihood of damage, the Hearing Officer decided that since there was an overlap between the goods and it is clear that the parties are in direct competition with each other, he would have found that a real likelihood of damage to the Opponent's interests existed, had the Opponent established all the

preceding elements of this ground of opposition.

Moreover, the Hearing Officer felt that the Opponent's submissions amounted to a bare assertion that "the Applicants may benefit unfairly from the reputation, attraction, and prestige associated with the Opponent's "SUBMARINER" mark as no evidence has been adduced by the Opponent in support of this claim, whilst the Applicant had been using its mark in Singapore for the past ten years.

In view of the above, the ground of opposition under Section 8(4)(b)(i) and 8(4)(b)(ii) failed.

3) Passing Off

Additionally, 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, the opponent must establish the classical trinity of goodwill, misrepresentation, and damage. Having reviewed the same evidence the Opponent provided for the supposed acquired distinctiveness of the Opponent's Mark, the Hearing Officer was satisfied that the Opponent's evidence – particularly concerning its established network of retailers throughout Singapore – demonstrates goodwill in the Opponent's business as a whole.

Further, given the Hearing Officer's findings above that the element of "connection" under Section 8(4)(b)(i) is made out, he was satisfied that, on a balance of probabilities, there is a likelihood of misrepresentation that the Applicant and the Opponent are the same or that they are economically linked.

Lastly, the Hearing Officer clarified that a likelihood of damage by blurring is readily inferred where parties are in direct competition with each other, as the Opponent and the Applicant are, and accordingly accepted that since the Opponent succeeded in establishing goodwill, there would have been a real likelihood of damage to that goodwill.

Therefore, the Hearing Officer found that the ground of opposition under Section 8(7)(a) succeeds.

Conclusion

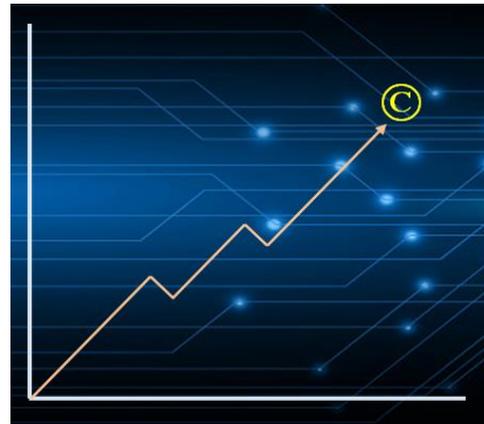
After considering all the pleadings, evidence filed, and the submissions made in writing and orally, the Hearing Officer concluded that the opposition succeeds on Section 8(2)(b) and Section 8(7)(a). Accordingly, the Application Mark shall not proceed to registration. The Opponent is to have 70% of the costs of the opposition, having regard to the fact that the opposition succeeds under Section 8(2)(b) which formed a larger part of the opposition as well as Section 8(7)(a) but failed under Section 8(4)(i) and Section 8(4)(b)(ii).

(source: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2020/rolex-v-fmtm-distribution-2020-sqipos-6.pdf>)

4. The Increased Intellectual Property Registration at DGIP during the COVID-19 Pandemic

Public awareness for the protection of Intellectual Property has increased during the COVID-19 pandemic. This could be seen from the number of IP

assets registration in the Directorate General of Intellectual Property (DGIP) compared to last year. DGIP recorded a surge to Rp250 billion of the income of intellectual property registration fees. Last year, this number was only around Rp130 billion in the same period. The online system that has been implemented may have also made it easier for the public to register their IP.



According to the Director-General of Intellectual Property, Freddy Harris, it could be a good sign that Indonesian people are more concerned with their Intellectual Property.

They are starting to recognize the value of art, brand, industrial design, and other elements that can be protected by law and their economic potential. "In copyright registration, just a few years ago, only around 3,000 copyrights were registered and now there are approximately 21,000 copyrights. The same thing happened for domestic patent registrations, which used to be only 10 percent, now slowly going up to 15 percent," remarked the Director-General.

Ira Aprilianti, a researcher at the Center for Indonesian Policy Studies (CIPS), said that protection of copyrights could encourage economic growth because copyright owners have economic rights that enable them to

obtain financial rewards from the use of their work by others. Copyright protection can promote creativity and innovation. In addition to economic rights, they also have moral rights that protect non-economic interests.

The Director General of Intellectual Property was also aware that foreign companies still dominate the number of patent registration in Indonesia, unlike trademark. Based on the DGIP database, patent registration by foreign parties in Indonesia was still around 80-90 percent. Therefore, it takes the role of many parties in encouraging Indonesian people to value their intellectual property.

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

5. The Commemoration of the 20th Intellectual Property Day

The World Intellectual Property Organization (WIPO) began to commemorate World Intellectual Property Day since 26 April 2001. The selection of the commemoration date was chosen based on the date when WIPO became active on 26 April 1974. Thereafter, people from around the world began to commemorate World Intellectual Property Day on April 26th, every year.

On the 20th anniversary of the Intellectual Property Day this year, WIPO went with the theme 'Innovate for a Green Future'. It means that every innovation created must be oriented to the good of the global environment.

In Indonesia, the Directorate General of Intellectual Property (DGIP) chose a special theme in commemoration of the 20th Intellectual Property Day, namely

"Celebration from Home: Be Healthy in the Unity Keep Creative and Innovative". The theme was based on the current condition of the COVID-19 pandemic, where people must keep their distance and stay at home, whilst reminding the public that these conditions should not halt the creativity and innovation of every person in the country.



DGIP also held IP Talks from Home for three days in a row with the theme "Protection of Intellectual Property in the Middle of Pandemic" via Live Streaming Video Conference on YouTube channel and DGIP's official Instagram, from April 24 to April 26, 2020.

The program consisted of discussions and education in terms of copyright protection, specifically related to royalty issues, patents, industrial designs, and Communal Intellectual Property (KIK).

KIK is a way for the government to protect Indonesia's cultural and biological diversity, including strengthening its ownership and prevent it from being hijacked or stolen by a foreign party. The manifestations of communal intellectual property are traditional knowledge, traditional cultural expressions, genetic resources, and geographical indications.

Indonesia's diverse cultures in the form of traditional knowledge can be patented and it can be authorized capital in the development of the country. Therefore, DGIP also held a "Nusantara Culinary Photo Competition" to raise awareness of the protection of KIK in society.

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

6. 2020: The Mapping of Intellectual Property Violations in Indonesia

The Directorate General of Intellectual Property (DGIP) through the Directorate of Investigation and Dispute Resolution has created the mapping of Intellectual Property violations in Indonesia as the main focus.

In the Webinar of the Directorate of Dispute Investigation and Settlement on Friday, 12 June 2020, Police Brigadier General, Edison Sitorus, said that data monitoring and violations of Intellectual Property (zone area) is very important for law enforcement.

"The function of prevention and enforcement of IP laws is inherent in every Regional Office through the Legal and Human Rights Services Division (specifically the IC Services Sub-Section)", he mentioned.

Law enforcement for quality intellectual property rights is part of the DGIP's vision and mission and is also part of the joint commitment of the Ministry of Law and Human Rights. He hoped that all regions, especially DKI Jakarta must be able to prepare data on IP violations and coordinate the law enforcement through pre-emptive, preventive and repressive activities.

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



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