

Biro Oktroi Roosseno

INTELLECTUAL PROPERTY NEWSLETTER – September 2020 – 36th Editions



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1. **Indonesia Trademark Update: Timberland and Timberlake**

TBL Licensing L.L.C. (Plaintiff), one of U.S.A. Retail Industry filed a cancellation lawsuit against a local businessman named Indra Halim(Defendant). The lawsuit was filed at the Central Jakarta Commercial Court on August 24, 2020, under the registration number 42/Pdt.Sus-HKI/2020/PN Jkt.Pst.

The case started due to the registration of the mark TIMBERLAKE under Registration No. IDM000471725, registered in August 28, 2015, under the defendant's name. According to the plaintiff, the defendant's mark has similarities in essential part,

conceptually and visually, with the well-known TIMBERLAND mark belonging to the plaintiff.

Both the plaintiff and defendant registered their respective trademarks in class 25 for goods such as clothing, footwear, and headgear. The plaintiff's TIMBERLAND trademark is a well-known trademark around the world. The company first took their products outside the United States for the first time, to Italy in 1980.

TBL Licensing L.L.C. is in the Retail industry has its headquarters in New Hampshire, U.S.A. The company creates some of the first truly waterproof leather boots by injection-

moulding waterproof technology to the footwear industry in 1968. Since then, they continued making innovations, and in 1973, they launched an original guaranteed waterproof boot called the Timberland. They continued to produce remarkable works in the world of the retail industry. Currently, they create products that are environmentally friendly by using recycled, organic, and renewable materials.



TBL Licensing L.L.C. has more than 100 trademark applications registered around the world.

Timberland, Timberland Boot Company, Timberland PRO, Air Raider, Airpath, B.S.F.P., Balm Proofer, Boot Sauce, Carbon Shield, Cast-Bond, Climapath, CovertTech, Crash Blaster, Earthkeepers, EasyDry, Ever-Guard, Exospine, FlyRoam, Gear Guard, Gridflex, Gripstick, G.S.R., HoverLite, Independent Suspension Network, ISN, Jackson Mountain, Ladder Lock, LiteTrace, MirrorFit, NXTWool, Path of Service, PowerFit, PreciseFit, PRO 24/7 Comfort Suspension, PRO 24/7 Comfort Suspension logo, RainRepel, ReBotl, ReCanvas, ReNet, Renewbuck, Renova, SafeGrip, SensorFlex, Smart Comfort, SmartHinge, Splash Blaster, StepVent, the Anti-Fatigue Technology logo, the Crash Blaster logo, the ISN logo, The Original Yellow Boot, the PRO logo, the Splash Blaster logo, TimberDry, Titan, Trail Grip, Trail Wave, Valor, WarmWeave, Waximum,

Weathergear, and WickWork are trademarks belonging to the TBL Licensing L.L.C.

In the lawsuit filed at Central Jakarta Commercial Court, the plaintiff requested the panel judges to cancel the TIMBERLAKE trademark belonging to the defendant along with all the legal consequences. They also requested the Panel of Judges to order the Directorate of Trademarks of D.G.I.P. to cancel the TIMBERLAKE trademark with Registration No. IDM000471725 on behalf of the defendant, by deleting the TIMBERLAKE trademark registration from the General Register of Marks.

Currently, this case is still at the early stages of court hearings, and the verdict of the court has not yet been made.

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

2. Indonesia Patent Dispute for Oil Palm Bunches

Firstwave Technology Sdn. Bhd. filed a patent lawsuit at the Central Jakarta District Court with registration number 46/Pdt.Sus-HKI/Paten/2020/PN Jkt.Pst. They addressed the lawsuit to the two local companies, P.T. Pancakarsa Bangun Reksa, as defendant I, and P.T. Sawit Kaltim Lestari, as defendant II.

The company, Firstwave Technology Sdn. Bhd. was established on October 13, 2005, with headquarters and warehouse facilities located in Malaysia. The company performs small scale contract manufacturing of Machines in Palm oil and tire recycling industries; these include oil palm press, digester, and material handling systems.

PT. Pancakarsa Bangun Reksa, established in 2009 in North Sumatra, Indonesia is a construction company that designs, builds and develops palm oil mills in Indonesia. The company also provides Design & Construction Services, Mechanical, Civil and Electrical including for Power Plants, Bulking Terminals, Kernel Crushing Plants, and Crumb Rubber.



PT. Pancakarsa Bangun Reksa produces machines marketed to various regions in Indonesia, such as Sumatra, Java, Kalimantan and other areas, they have also exported to Malaysia, Singapore and Myanmar. P.T. Sawit Kaltim Lestari is an oil palm plantation company located in East Kalimantan, Indonesia.

In the lawsuit filed to the Central Jakarta Commercial Court, the Malaysian company declares themselves as the patent holder and rightful owner of the invention entitled: "a sterilizing device for processing oil palm bunches and other similar fruits". They registered the patent under registration number IDP0023361 dated on April 30, 2009. The patent for the invention relates to a sterilizer for processing palm fruit bunches and other similar fruits using steam, comprising of an extending vessel, a hinge device, and a tilting device in various tilted positions under control conditions.

The plaintiff claimed that they have the right to claim material and immaterial damages for the patent infringement.

The plaintiff also requested Defendant II to pay the reward fees for every month they use the plaintiff's invention. Moreover, The Plaintiff requested that the verdict, in this case, could be implemented first, even though there were cassations and other legal remedies.

Currently, this case is still at the early stages of court hearings, and the verdict of the court has not yet been made.

(source: <http://sipp.pn-jakartapusat.go.id/>;
<http://www.firstwave.com.my/about.htm>;
<https://www.pancakarsa.id>)

3. Singapore Trademark Update: An "intoxicating" Battle for CHAMPENGWINE

The trademark application of **Keep Waddling International Pte. Ltd.** ("the Applicant") for its

CHAMPENGWINE
" UNIQUE, BOUTIQUE, SPARKLING WINES OF CHILE "

Mark in Class 33, was opposed by **Comité Interprofessionnel du Vin de Champagne** ("the 1st Opponent") and **Institut National de l'Origine et de la Qualité** ("the 2nd Opponent") (collectively "the Opponents") in Singapore and was recently decided upon.

The Opponents argued that the Applicant's mark; (i) was deceptive, (ii) violated the Geographical Indications Act ("G.I.A."), (iii) fell afoul of the law of passing off, and (iv) was applied in bad faith.

The Applicant is a local Singaporean wine company that retails the 'PengWine' wines, a 16-year-old boutique Chilean wine label that focuses on wines blended with about nine grape varieties grown in Maipo Valley in Chile. PengWine produces about 300,000 bottles of wines annually. They are served in

restaurants in Singapore, including restaurants Esquina and Coriander Leaf. Each of the label's eight wines is named after penguins native to South America, such as Humboldt and Rockhopper.

The 1st opponent is the French trade association that represents the interests of independent Champagne producers (including growers, cooperatives, and production houses) and Champagne Houses. Its mandate is to promote the vines and wines of Champagne through a broad remit that includes: economic, technical, and environmental development; continuous quality improvement; sector management; marketing and communications; and the promotion and protection of the Champagne A.O.C. across the world.

The 2nd opponent is the French government wing that regulates French agricultural products based on geographical indications and traditional specialities. It is a part of the French Ministry Of Agriculture, and one of its most essential functions is to circumscribe the geographic area meant for producing a product. This regulatory body demarcates the vineyard and the places of processing and ageing for winemaking.

In this opposition, the opponent relied on the Trade Marks Act ("T.M.A.") read with the Geographical Indications Act ("G.I.A.").

In the opposition, four arguments were made:

(1) Deceptiveness of the Mark

The Opponents in this matter contended that the consumers in question would recognise that wines bearing the "CHAMPAGNE" geographical indication

originate (or should originate) from the Champagne region in France, and (should) adhere to a detailed set of production requirements.

However, the hearing officer clarified that the application Mark is not for the word "CHAMPAGNE" on its own, nor the (invented) word "CHAMPENG". It was for a composite of the invented word "CHAMPENGWINE" (with the first letters of each consonant in slightly larger font size than the rest of the word), and the phrase "UNIQUE, BOUTIQUE, SPARKLING WINES OF CHILE" in much smaller font and placed below the last two consonants (i.e. "PENGWINE") of the invented word.

Moreover, consumers who drink and purchase wines or sparkling wines would be familiar with the industry practices, and are also likely to know that Champagne is not spelled as "champeng".

Taking the above into account, the Hearing Officer eventually concluded that it would be fanciful to suggest that consumers would be deceived, and thus the ground of opposition under Section 7(4)(b) T.M.A. failed.

(2) Geographical Indication

Next, the Opponents made arguments that the registration of the Application Mark contravenes Section 7(5) T.M.A. read with Sections 3(2)(a), 3(4) and 4 of the G.I.A. – Objections under the Geographical Indications Act, due to the Applicant's inclusion of the terms "CHAMPENG" which they argue to be similar to the term "champagne".

To succeed in an opposition under Section 7(5) T.M.A. read with Section 3(2)(c) and

3(4), or an opposition under Section 7(7) T.M.A., an opponent only needs to establish that the mark opposed "contains or consists of a geographical indication".

In the present case, both parties were unable to locate any authorities on the interpretation of what is meant by the words "a trade mark which contains or consists of the geographical indication in question" within the meaning of Section 3(4) G.I.A., or of the almost identical words in Section 7(7) T.M.A. In the absence of any authorities, the hearing officer approached this question based on principle.

After thorough analysis, the Hearing Officer found that it is clear that it is not "identical" to "champagne". It follows that the application Mark does not "contain or consist" of the "champagne" geographical indication.

Hence, the ground of opposition under Section 7(5) T.M.A. read with Sections 3(2)(a), 3(4), and 4 of the G.I.A. fails.

3) Passing Off

Additionally, the opponent argued the grounds of passing off under Section 8(7) (a) of the Singapore Trade Mark Act (T.M.A.). To succeed under this ground of opposition, an opponent must establish the classical trinity of goodwill, misrepresentation, and damage.

In relation to the element of misrepresentation, the comparison is to be made between "champagne" and the Application Mark as a whole. However, as the Hearing Officer had found the use of the Application Mark would not result in any misrepresentation leading to deception, it followed that the Opponents would also not

suffer any damage arising from the use of the application Mark.

Therefore, as the Hearing Officer did not find any misrepresentation, she did not deal with the damages requirement.

4) Bad Faith

Finally, the Opponents argued that the Applicant's application was filed in bad faith under Section 7(6) of the Singapore Trade Mark Act and thus the Application Mark should not be registered.

While dealing with this objection, the Hearing Officer was unfortunately of the opinion that the evidence establishes that "CHAMPENG" was indisputably selected because of its similarity to "champagne", as clearly explained in paragraph [79] of the decision. Moreover, although the Application Mark includes the phrase "UNIQUE, BOUTIQUE, SPARKLING WINES OF CHILE", this phrase does not appear when the Applicant actually uses the "ChamPengWine" mark on its sparkling wine, which enabled the Hearing Officer to conclude that the subjective element in the test for bad faith (i.e. what the Applicant in this case knows) is satisfied.

When dealing with the objective element in the test of bad faith, the Hearing Officer clarified that although he believed that consumers would not be deceived or misled into thinking that wines bearing the Application Mark originate from Champagne in France, "bad faith" is a separate and distinct ground of opposition. Once bad faith is established, the application for registration of a mark must be refused; despite (i) the absence of deception, (ii) the public not

being misled, or (iii) lack of misrepresentation.

Further, the Hearing Officer found that the Applicant's attempt to deny that the "CHAMPENG" in the application Mark was inspired by "champagne", by asserting a derivation of the mark that is not supported by the evidence, worked in the favour of the Opponents instead.

Eventually, having considered the arguments advanced by both parties, the Hearing Officer found that the Opponents have made out a prima facie case of bad faith and the Applicant had not put forward any evidence to disprove it.

As a result, the bad faith argument was successful.

Overall Conclusion

After considering all the pleadings, evidence filed and the submissions made in writing and orally, the Hearing Officer eventually concluded that the opposition succeeds on the ground of bad faith under Section 7(6) T.M.A., but fails on the other three (3) grounds raised by the Opponents. The application shall therefore be refused.

To view the Grounds of Decision, click [here](https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2020/comit%C3%A9-interprofessionnel-du-vin-de-champagne-and-institut-national-de-l-origine-et-de-la-qualit%C3%A9-v-keep-waddling-international-2020-sgipos-10.pdf).
(source : <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2020/comit%C3%A9-interprofessionnel-du-vin-de-champagne-and-institut-national-de-l-origine-et-de-la-qualit%C3%A9-v-keep-waddling-international-2020-sgipos-10.pdf>)

4. Indonesian IP Update: The Importance of the Marrakesh Agreement for Copyright Protection



During the WIPO Annual Session in Geneva, Switzerland, on September 23 2020, the Director-General of Intellectual Property of Indonesia discussed the importance of the Marrakech Agreement for national and international copyright protection.

"The Marrakesh Agreement is important, as one of the first multilateral copyright agreements dealing with exceptions and limitations", he said. The granting of such exceptions relates to reproducing, distributing and making printed works available in a format accessible to persons with disabilities without violating copyright and related rights.

"The successful implementation of this treaty demonstrates that despite the differences in national copyright laws, the international community can have a copyright exemption and limitation regime that is standardized, effective, and gives legal certainty", he added.

Indonesia hopes that WIPO continues to create more international legal frameworks on copyright exceptions and restrictions,

such as for educational and research purposes.

Indonesia has submitted the ratification instrument of the Marrakesh Treaty to facilitate access for people with blindness or visual disabilities, or disabilities in Reading Printed Works on January 28 2020. The ratification is a reflection of Indonesia's commitment to a balanced and effective international Intellectual Property system.

Indonesia is also one of the countries that signed the Beijing Agreement on Audiovisual Performances. The agreement ensures the rights of performers to be the same in all WIPO member countries that have ratified it.

Indonesia is the 30th party to ratify the Beijing Treaty on January 28 2020, determining the effectiveness of this treaty for the 30 parties that signed the Treaty on April 28, 2020, and ensures economic rights and protection of moral rights for actors around the world.

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

5. Indonesia Participates at The 61st ASEAN Working Group on Intellectual Property Cooperation Meeting

On 9th and 10th of September 2020, the representatives of the Directorate General of Intellectual Property (DGIP) of the Ministry of Law and Human Rights participated at the 61st ASEAN Working Group on Intellectual Property Cooperation (AWGIPC) online meeting.

The meeting discussed the IPR Action Plan of 2016-2025. The said action plan concerns the aims of ASEAN countries to achieve strategic goals to contribute to the collective

transformation of ASEAN into an innovative and competitive region through the use of Intellectual Property.

This meeting also discussed the development of priorities in the IP sector in 2020, including general guidelines for patents, comprehensive guidance on geographic indications, a mid-term review of the 2016-2025 ASEAN IP Action Plan, and the establishment of the IP Academy.



Consultations were also held with ASEAN Dialogue Partners to discuss the implementation of the Intellectual Property Action Plan, including with World Intellectual Property Organization (WIPO), The ARISE Plus Intellectual Property Rights (ARISE+ IPR), Japan Patent Office (JPO), China National Intellectual Property Administration (CNIPA), European Patent Office (EPO), AIPA (ASEAN Inter-Parliamentary Assembly), dan United Kingdom Intellectual Property Office (UKIPO).

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

6. DGIP Joined the Discussion of Trade Policy Review for WTO

The Directorate General of Intellectual Property (DGIP) recently participated in a video conference with the Trade Policy Review (TPR Division) which is under the

World Trade Organization (WTO). The video conference was held over three consecutive days, from 17 – 21 July 2020, with participants from different Ministries and Institutions each day.



The conference discussed the concept of the 7th Secretariat Report on the Trade Policy Review (TPR) of Indonesia year 2020. TPR was a WTO forum where all aspects relating to a country's trade policies are specified by all other member countries, in order to ensure transparency of WTO member countries.

TPR contains policies related to all kinds of trade in WTO member countries to be evaluated and reported regularly. The results of the TPR will be used as an input in increasing Indonesia's economic growth and competitiveness in the global economy. Regulations related to the Intellectual Property Rights as one of the driving forces for the nation's economy will also be included in the report.

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

7. Indonesia Dispute Update: Trademark Cancellation Case “Buff vs Ruff”

In our previous Newsletter September 2019 – 32nd Edition, we mentioned about the trademark cancellation case between Original Buff, S.A against Jemmy Setioyuwono for the marks BUFF vs RUFF.

At first instance, the court had initially rendered their decision to cancel the registration of trademark RUFF belonging to the Defendant on grounds of bad-faith. However, the Defendant file an appeal to the Supreme Court (cassation) on August 2020, and the Supreme Court decided to reject the cassation of the Defendant and the registration of “RUFF” mark has indeed been cancelled.

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



(Anno 1951)

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