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1. Indonesia Trademark Update: Starbucks - Coffee or Cigarettes?

PT. Sumatra Tobacco Trading Company (PT. STTC) is one of the cigarette companies in North Sumatra, Indonesia. In 1952, The company first launched the Union brand. PT. STTC has a coffee company, namely Indocafe or PT Sari Incofood Corporation, located in North Sumatra, Indonesia.

Starbucks Company filed a lawsuit against PT. STTC at the Central Jakarta District Court for making cigarettes with the Starbucks trademark.



Starbucks is a coffee shop based in Seattle, United States; Starbucks began serving coffee on March 30, 1971. Currently, there are at least 20,000 Starbucks stores in 61 countries around the world.

In addition to selling coffee drinks, Starbucks also sells tea drinks and coffee companions, such as coffee beans, snacks, to tumblers. In Indonesia, Starbucks is operated by PT. Mitra Adiperkasa.

At the Central Jakarta District Court, one of the petitions submitted by Starbucks Corporation was to cancel the STARBUCKS with Registration No. IDM000342818 in class 34 belonging to the defendant from the General Register of Marks.

They also requested the Central Jakarta District Court to declare that the defendant had bad faith when he filed the request for registration of the STARBUCKS Mark No. Registration of IDM000342818 in class 34 belonging to the defendant, and declare the Plaintiff's STARBUCKS mark as a well-known mark.

This American coffee company requested the court to accept the plaintiff's lawsuit in its entirety.

Based on the Indonesian Intellectual Property Database of the Directorate General of Intellectual Property at the Ministry of Law and Human Rights, PT. STTC registered the mark on September 10, 2012, and holds the trademark rights until September 10, 2022, in class 34. Class 34 includes all kinds of cigarettes, kretek cigarettes, white cigarettes, cigarette paper, tobacco, matches, etc.

PT. STTC also had a trademark dispute with Harley-Davidson that occurred in 2017. Harley-Davidson USA LLC filed a lawsuit against Sumatra Tobacco Trading Company for trademarking the coffee 'Harley-Davidson Blend.'

The decision of the Central Jakarta District Court decision ruled to cancel the marks

CUSTOM HARLEY-DAVIDSON BLEND Number IDM000193094 in class 29, CUSTOM HARLEY- DAVIDSON BLEND Number IDM000193095 in class 30, CUSTOM BLEND HARLEY-DAVIDSON Number IDM000261294 in class 32, HARLEY DAVIDSON. IDM000518031 in class 29, HARLEY DAVIDSON No. IDM000518200 in class 30 and HARLEY DAVIDSON No. IDM000518198 in class 32.

PT. STTC filed an appeal (cassation) to the Supreme Court. However, the appeal (cassation) could not be processed at the Supreme Court because it did not meet the formal requirements.

(source: <http://sipp.pn-jakartapusat.go.id>:
<https://news.detik.com>)

2. Indonesia Trademark Update: A Long Fight Between German HUGO BOSS Against Local Businessman

The trademark dispute between Anthony Tan and HUGO BOSS began when the German fashion company sued the local businessman for a trademark case at the Central Jakarta Commercial Court. HUGO BOSS under the company HUGO BOSS Trade Mark Management GmbH & Co KG did not accept that Anthony Tan plagiarized its trademark.

HUGO BOSS Germany has been marketing its products since 1924. Today HUGO BOSS manufactures men's suits, jackets, coats, shirts and trousers. Meanwhile in Indonesia, HUGO BOSS has registered its trademark since 1989.

On January 4, 2021, the Commercial Court at the Central Jakarta District Court rejected HUGO BOSS's lawsuit.

“After the panel of judges examined the two marks, it can be concluded that between the Plaintiff's HUGO BOSS trademark and the HUGO BOSS trademark on the Defendant's name, there indeed a difference between the Plaintiff's mark and the Defendant's mark. Differences arise in terms of appearance and pronunciation. The trademarks being compared must be seen as a whole or as a unified whole and cannot be seen individually”, said the Central Jakarta District Court.



HUGO BOSS continued their battle by filing an appeal/cassation to the Supreme Court. The Supreme Court granted the cassation request from HUGO BOSS with a court decision stating that the HUGO BOSS marks and their variations are the property of HUGO BOSS and the sole legal owner and holder of the trademark rights.

The court stated, "Declaring the Plaintiff as the sole owner and legal right holder of the registered and/or well-known HUGO BOSS trademarks and all variations of these marks," said the cassation panel.

Additionally, the cassation court stated, "Instruct the Co-Defendant (Ministry of Law and Human Rights) to announce the cancellation of the trademarks as mentioned below (the disputed Defendant's Marks) in the General Register of Marks," concluded the cassation panel.

HUGO BOSS trademark disputes also occurred previously with other local businessman.

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

3. Indonesia Trademark Update: COMIX Trademark Rights Dispute on Office Supplies

Shenzhen Comix Group Co., Ltd. was founded in 1991, focusing on office supplies for more than 20 years. The company now has 13 product lines and 30,000 SKUs. Today, the products have been exported to Europe, the United States, Africa, and more than 80 countries and regions.

The company also established subsidiaries in Europe and the United States. They have established a comprehensive network of Ecommerce channels both at home and abroad. They also have domestic platforms such as Comix mall, Comix Qudaobao, etc.

In Indonesia, Shenzhen Comix Group Co., Ltd. filed a cancellation lawsuit against a local businessman named Richard Lityo (defendant). The lawsuit was filed at the Central Jakarta Commercial Court on July 21, 2021, under the registration number 49/Pdt.Sus-HKI/2021/PN Jkt.Pst.

The case started due to the registration of COMIX trademark with Registration No. IDM000770297, registered in April 29, 2020, under the defendant's name. According to the plaintiff, the defendant's mark was filed in bad faith and has similarities in principle with the well-known COMIX trademark belonging to the plaintiff.

Both the plaintiff and defendant registered their respective trademarks in class 09 for goods such as scales, projection screen, projection equipment, money counting machine, slide projector, telephone, clock, time recorder, magnet, etc.

In the lawsuit filed at Central Jakarta Commercial Court, the plaintiff requested the panel judges to cancel the COMIX trademark belonging to the defendant along with all the legal consequences and declares that the COMIX trademark and its variants belong to the plaintiffs are well-known marks.



They also requested the Panel of Judges to order the Directorate of Trademarks of DGIP to cancel the COMIX trademark with Registration No. IDM000770297 on behalf of the defendant, by deleting the COMIX 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>;
<http://www.chinacomix.com>)

4. Singapore Trademark Update: A Sanitary Washout

Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel [2021] SGIPOS 10 The trademark application of **Dr. August Wolff GmbH & Co. KG Arzneimittel** ("the Applicant") for its

Dr. Wolff's Vagisan

"Mark in Classes 3 and 5, was opposed by **Combe International Ltd.** ("the Opponent"). This is the second time the parties are clashing since the Opponent succeeded in both the first hearing and appeal to invalidate the applicant's registration for the 'VAGISAN' mark last year.

The applicant is part of a family business, the Dr. Wolff Group, founded in 1905 and named after its founder Dr. August Wolff. The Applicant researches manufacture and market dermatological, medicinal, and cosmetic products that are distributed in many countries. In 1994, the Dr. Wolff Group conceived the name "VAGISAN" for use in connection with intimate care products. According to the Applicant, "VAGISAN" was conceptualized to be a portmanteau of the English word "vagina" and the Latin word "Sanitas" (which means "health").

The applicant's intimate care products, now sold in many countries, first bore the "VAGISAN" mark in 1998. Apart from referring to the founder of the Group, the term "DR. WOLFF" has been used as a trademark worldwide for several decades. The applicant is the registered proprietor of the mark "DR. WOLFF" and other "DR. WOLFF" formative marks, covering goods in Classes 3 and 5 in many countries and regions worldwide, including in the United Kingdom, Australia, Hong Kong, Malaysia, India, and the European Union.

Meanwhile, the Opponent is a personal care company founded in the United States of America in 1949, with products sold in 64 countries on six continents. Vagisil is one of the Opponent's brands that has become a trusted feminine care brand worldwide and has been a global leader in intimate health for 40 years. The Opponent commenced using the trademark "VAGISIL" in 1973 and has since been continuously using the trademark "VAGISIL" extensively worldwide in the course of trade. In Singapore, the VAGISIL trademark was used as early as 1989.

In this opposition, the Opponent relied on Sections 8(2)(b), Section 8(4), and Section 8(7)(a) 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 five of their earlier "VAGISIL" marks in classes 3, 5, and 10 to oppose the applicant's

The logo for Dr. Wolff's Vagisan, featuring the text "Dr. Wolff's" in a smaller font above "Vagisan" in a larger, bold font, with a stylized leaf or petal graphic to the right.

application mark. Following meticulous assessments of the Opponent's Marks and the Applicant's Mark as a whole, the Hearing Officer found that the Application Mark and Earlier Marks are visually dissimilar, aurally dissimilar, and conceptually dissimilar.

Given that the similarity of the competing marks is a threshold requirement that has to be satisfied before the confusion inquiry is undertaken, the Hearing Officer's finding of overall dissimilarity between the marks sufficiently disposed of the ground of opposition under Section 8(2)(b).

As a result, the ground of opposition under Section 8(2)(b) failed.

Well-Known Mark – Section 8(4)

Next, the Opponent made arguments that its marks are well known to a relevant sector of the public in Singapore (females who use intimate care products) and well known to the public at large in Singapore, and thus taking into account Sections 8(4)(b)(i) and Section 8(4)(b)(ii), of the Singapore Trade Mark Act, the Application mark should not be registered.

To succeed under the abovementioned 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.

However, given the Hearing Officer's views that the Application Mark and Earlier Marks are dissimilar, this ground of opposition would therefore fail too – even if it can be established that the Earlier Marks are well known to a relevant sector of the public or well known to the public at large.

Hence, the ground of opposition under Section 8(4) read with 8(4)(b)(i) and 8(4)(b)(ii) failed.

Passing Off – Section 8(7)(a)

Lastly, the Opponent relied on the grounds of passing off under Section 8(7) (a) of the Singapore Trade Mark Act. To succeed under this ground of opposition, an opponent must establish the classical trinity of goodwill, misrepresentation, and damage.

On the issue of goodwill, the applicant did not dispute that the Opponent had acquired goodwill in its business in Singapore.

Next, the Hearing Officer went on to determine if there was any likelihood of confusion between the competing marks and took into account the foregoing factors individually to do so:

- i. The similarities and differences between the marks
- ii. The reputation of the marks
- iii. The impression given by the marks
- iv. The possibility of imperfect recollection of the marks
- v. The normal way in or the circumstances under which consumers would purchase goods of that type
- vi. The price of the goods
- vii. The nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers
- viii. The nature of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

Following his analysis, the Hearing Officer found that points (i), (iii), and (iv) pointed away from a likelihood of confusion, whilst points (v), (vii) and (viii) pointed towards a likelihood of confusion, and point (ii) was neutral or at best only pointing slightly towards a likelihood of confusion.

Having considered and weighed the factors that point towards a likelihood of confusion and those that point away from a likelihood of confusion, the Hearing Officer found that there was no likelihood of confusion between the competing marks and that the use of the Application Mark is not likely to result in

consumers being deceived or confused into thinking that the applicant's goods are, or emanate from a source that is linked to, the Opponent's.

Correspondingly, since the element of misrepresentation above had not been established, the Opponent's passing-off argument was unsuccessful either.

Decision

Therefore, after considering all the pleadings, evidence filed, and the submissions made in writing and orally, the Hearing Officer concluded that the opposition failed on all grounds. Accordingly, the applicant's mark was allowed to proceed to registration, and the applicant is also entitled to costs to be taxed.

To view the Grounds of Decision, click [here](#).

(source: Biro Oktroi Rooseno Singapore)

5. Domain Name Dispute in Indonesia



The growth of online business in Indonesia is accompanied by the increasing number of registered domain names. However, domain name registration does not yet require the ownership of trademark rights on the name use as the domain name. Therefore, it often causes conflict.

The Director of Brands and Geographical Indications stated, "If there is a similarity between a party's registered mark and a domain name owned by another party and one of the parties wishes to cancel or abolish the registered mark or domain name of the other party, then a settlement can be made from a trademark legal perspective based on the Trademark Law and the domain name perspective referring to the Law on information and electronic transactions".

There is a term Cyber-squatters for people who register famous brands, names or businesses that have nothing to do with the registrar, and then they sell the domain names directly to related companies or parties at a much higher price.

On the other hand, there are also Cyber-parasites for people or parties who take advantage of the fame of a particular brand or name, by registering or using a domain name that has connotations with the famous brand or name.

The chairman of the Advisory Board of the Association of Intellectual Property Rights Consultants (AKHKI) revealed that domain names have conflicts with trademarks since there is no link between the trademark registration system and domain name registration.

Associated with domain names are usually handled by the Indonesian Internet Domain Name Manager (PANDI). This non-profit organization incorporated as an association which since June 29, 2007 has officially been delegated to process the .id domain administration by the Indonesian Ministry of Communication and Information Technology.

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

6. DGIP Efforts to Fight Book Piracy in E-Commerce

The Directorate General of Intellectual Property (DGIP) is currently drafting a Regulation with the Minister of Law and Human Rights related to literary works/books.

This regulation will regulate royalty payments for the use of books/literacy works for commercial purposes and anticipates other forms of violation. It is meant to minimize book piracy on digital platforms, especially in e-commerce.

DGIP also cooperates and coordinates with relevant ministries/institutions in dealing with book piracy. Relevant ministries/agencies include the Ministry of Communication and Information, the Ministry of Trade, the Indonesian National Police, and others.

Mr. Syarifuddin, as the Director of Copyright and Industrial Design, believes that with adequate regulations, the respect and recognition of creators and the protection of their economic rights can be achieved.



In article 55 of the Copyright Law states that anyone who is aware of any copyright and/or related rights violations through electronic systems or over the internet for commercial use can report to DGIP.

After DGIP has verified the report and finds sufficient evidence of copyright infringement, the DJKI will provide a recommendation letter to the Ministry of Communication and Information to close some or all of the content that violates copyright in the electronic system or make the electronic system services inaccessible.

Currently, DGIP has recorded that it has closed/blocked 800 websites that violated copyright since 2015. Some of them are related to copyright infringement in the field of books.

Penalties for violators are regulated in Article 114 of the Copyright Law. It is stated that any person who manages a trading place in all its forms and knowingly allows the sale and/or reproduction of goods resulting from copyright infringement and/or related rights in the trading place he manages as referred to in Article 10, shall be punished with a fine of at most IDR 100 million. The criminal provisions impose sanctions on the manager of the trading place in all its forms, which can also be interpreted as a form of trading on the marketplace.

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

7. The Improvement of Industrial Design Registration Business Process

The Directorate General of Intellectual Property (DGIP) held a meeting in connection with the Business Completion process for the Completion of Industrial Design Registration Applications in Jakarta on 8-10 September 2021.

This activity is a follow-up step to the DGIP Performance Evaluation Semester I of 2021. The Directorate of Copyright and Industrial

Design is committed to improving the quality of electronic-based public services at the DGIP, particularly the registration of industrial designs.

Since IPROLINE was launched to process services in the intellectual property sector on August 17, 2019, the electronic service for industrial design registration has experienced a transition from manual-based to electronic-based services.

This transition is a process and needs to be continuously developed for its improvement. Its evaluation and improvement are needed to create quality, effective and efficient services.



The expected output in this activity is the document for the industrial design registration application's flow process. This document will be used as a guide for preparing improvements to standard operating procedures (SOPs) and electronic-based service standards, and an evaluation document for the application system for industrial design registration.

After the new industrial designs' business registration application process has been finalized, the Directorate of IP Information Technology can immediately implement it in the applications.

"The business process at DGIP has changed from offline to online, then from online to

digital. This business process adapts to the views and needs of the community, so it must always be updated and perfected,” said the Director General of Intellectual Property.

Previously, the Directorate of Copyright and Industrial Design held an internal virtual meeting on August 24, 2021 regarding the database validation process for 19,000 data on copyright applications and industrial designs from 2011 – 2019.

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



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