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1. Indonesia Trademark Update: Mario and Luigi on “Super Court”

Nintendo Co., Ltd. is a Japanese multinational consumer electronics and video game company with its headquartered in Kyoto. The company was founded in 1889 by Fusajiro Yamauchi.

Nintendo Co., Ltd. globally develops, manufactures and sells home-use video game hardware and software in home entertainment business. The company also produces home-game products including cards.



Nintendo Company, Ltd. is known worldwide for the characters of Mario, Zelda, Luigi, Donkey Kong, and hundreds of Pokémon "pocket monster" characters. Nintendo's Game Boy handheld gaming systems have ruled the market since their debut, and its

gaming console, the GameCube, overtook Xbox as the second most popular console after Sony's PlayStation 2.

The company was to grow within the century into one of the biggest and most influential gaming companies in the world. Nintendo has multiple subsidiaries in Japan and abroad. Both the company and its staff have received numerous awards for their achievements.

During the peak of Nintendo's success in the video game industry during the 1990s, its name was ubiquitously used to refer to any video game console, regardless of the manufacturer. To prevent its trademark from becoming generic, Nintendo pushed the term "game console", and succeeded in preserving its trademark. Some of Nintendo's most widely recognized trademarks include Nintendo®, Nintendo 3DS™, Nintendo Switch™, Nintendo Labo™, amiibo™, Game Boy™, Pokémon™, Super Mario™, and The Legend of Zelda™. The Nintendo's trademark has been filed in many countries throughout the world and registrations have been issued in Nintendo's name in many countries.

Mario & Luigi are characters in the Mario video game franchise, owned by Nintendo and created by Japanese video game designer. The character has also registered for its own trademark in some countries.

However, in Indonesia, there is a local company named PT. Cardolestari Indonesia, and a local Businessman named Eddy Tumewu, registered trademark of Super Mario Bros at the Indonesian Trademark Office under Registration No. IDM000007313. Pursuant to this matter, Nintendo Company, Ltd. filed a cancelation lawsuit at the Central Jakarta Commercial

Court with Case No. 58/Pdt.Sus-HKI/Merek/2020/PN Jkt.Pst.

The suit filed by Nintendo Company, Ltd. as a plaintiff requests such as to cancel Super Mario Bros' trademark registration No. IDM000007313 on behalf of Defendants from the General Register of Marks with all the legal consequences; stated that trademark of Super Mario Bros, the characters Mario and Luigi and their variants belonging to the Plaintiffs are well-known marks; to declare that trademark of Super Mario Bros No. IDM000007313 has similarity substantially and/or in its entirety with the famous trademark of Super Mario Bros, the characters Mario and Luigi and their variants belonging to the Plaintiff; and to declare that trademark of Super Mario Bros on behalf of the Defendants has been filed in a bad faith; and granted the entire Plaintiff's claim in the lawsuit.

The defendants registered their respective trademarks in class 25 for goods such as apparel for men, women and children, socks, ties, hats, gloves, belts, shoes, sandals, slippers, shoe soles, veils, headbands, wristbands, knee protectors, etc.

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.referenceforbusiness.com/history2/29/Nintendo-Company-Ltd.html#ixzz6hVnIWJf>;
<https://en.wikipedia.org/wiki/Nintendo>)

2. Indonesia Trademark Update: DC Comics Wins Against Local Wafer Company's Superman

For some people who are fond of the superheroes such as Superman, Batman,

Aquaman, and Wonder Woman, surely is familiar with the famous comic strip publisher from the United States, DC Comics.

The superhero business empire of the United States, DC Comics, has succeeded to defend the Superman trademark filed by one of Indonesian wafer companies, PT. Marxing Fam Makmur.

DC Comics has taken 2 legal attempts against PT. Marxing Fam Makmur regarding the Intellectual Property rights of the Superman trademark in the Central Jakarta Commercial Court and Supreme Court in 2018. However, the Central Jakarta Commercial Court declared DC Comics' lawsuit unacceptable or *niet ontvankelijke verklaard*. Likewise, the Supreme Court considered DC Comics' lawsuit is unacceptable.



"PT. Marxing Fam Makmur received a trademark certificate from the Ministry of Law and Human Rights first in 1993 for grades 30 and 34 and renewed every 10 years," said PT. Marxing Fam Makmur's attorney at that time.

PT. Marxing then collaborated with Siantar Top to produce chocolate wafers. The wafers then flooded stalls throughout Indonesia and were widely known.

Even though they lost twice in court, DC Comics was not discouraged. They filed

another lawsuit again at the Central Jakarta Commercial Court on May 27, 2020.

After going through a series of trials since June, the panel of judges announced the verdict on Wednesday, November 25, 2020. This time, the panel of judges awarded the verdict for DC Comics.

"Granted the Plaintiff's claim in its entirety. And declared the Defendant's trademark SUPERMAN as a well-known mark," written in the verdict of the Central Jakarta District Court.

The content of the decision of the panel of judges at the Central Jakarta Commercial Court on DC Comics' lawsuit against PT. Marxing Fam Makmur, as follows:

1. To fully grant the Plaintiff's claim;
2. To declare the plaintiff's registered mark "SUPERMAN" as a well-known mark.
3. Declare that the Plaintiff is entitled to the mark "SUPERMAN" in Indonesia.
4. Declare the registered mark "SUPERMAN" Registration Number IDM000374439 in Class 30, and the registered Mark "SUPERMAN" Registration Number IDM000374438 in Class 34 on behalf of PT. Marxing Fam Makmur (as a Defendant) was registered in a bad faith.
5. Declare the cancellation of registration of the mark "SUPERMAN" Registration Number IDM000374439 in Class 30, and registration of the mark "SUPERMAN" Registration Number IDM000374438 in Class 34 on behalf of PT. Marxing Fam Makmur (as a

Defendant) with all the legal consequences.

6. Ordered the Clerk of the Commercial Court at the Central Jakarta District Court to submit a copy of this decision to the Co-Defendant to cancel the registration of the registered mark "SUPERMAN" Registration Number IDM000374439 in Class 30, and registered mark "SUPERMAN" Registration Number IDM000374438 in Class 34 on behalf of the Defendant (PT. Marxing Fam Makmur) from the General Register of Marks and announce it in the Official Gazette of Marks.

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

3. Singapore IP Update: Another “Intoxicating” Battle Over GI for Bavarian Beer

An Interlocutory hearing, related to the opposition between BAVARIA N.V., (the Opponent) and BAYERISCHER BRAUERBUND E.V. (the Applicant) took place on 19 August 2019, following the Principal Assistant Registrar’s (PAR) rejection of the Notice of Opposition filed.

The Applicant, BAYERISCHER BRAUERBUND E.V. is the umbrella organization of the Bavarian brewing industry and has the purpose of perceiving and promoting the common interests of the entire Bavarian brewing industry. It has affiliated breweries of all sizes from all regions of Bavaria. Meanwhile, the Opponent is a producer and distributor of alcoholic and non-alcoholic beverages, with customers worldwide.



On 24 May 2019, the Opponent filed a Notice of Opposition (NOP) supported by the Statutory Declaration of Peter-Jan Joost Marie Swinkels dated 22 May 2019. However, the PAR was inclined to reject the NOP as the Opponent’s Statement of Ground did not set out any grounds for refusal of registration of the GI as provided in Section 41 of the Geographical Indications Act 2014. The Opponent instead had complaints directed against “Bavarian Beer”, which it alleged is the English translation of the GI applied for.

According to the PAR, section 41 of the GIA as referred to in the Statement of Grounds does not extend to a GI’s translations., Section 4(6)(b) of the GIA (which pertains to translations) was not yet in force as at the Opposition Filing Date, as well as at the Hearing Date which would render the Notice of Opposition (and the Statement of Ground) nugatory.

Therefore, the PAR rejected the NOP on the basis that the Opponent was seeking to oppose an alleged right of the Applicant’s which was not in existence as at the Opposition Filing Date (and the Hearing Date).

Consequently, the main issue in the interlocutory hearing was the requirements for a successful filing of a notice of opposition under the GIR, in particular, whether the NOP should be allowed as long as all the procedural requirements for filing have been

complied with, or if it was also necessary to examine whether the grounds relied on would be sufficient to succeed in the opposition.

As the determination of the above issue depended on how Rule 28 GIR is interpreted, the hearing officer set it out in full in her decision and referred to it in detail. Additionally, the Opponent relied on Application by OOO “TVM Trade” To Strike Out Notice of Opposition and Objection Thereto by Societe Des Produits Nestle SA [2014] SGIPOS 12 (“Nestle”), which was a case broadly pertaining to striking out. The Nestle case highlighted that:

(a) there is no express legislative provision [in the GI legislation] giving IPOS the power to strike out a notice of opposition;

(b) there is no provision [in the GI legislation] which confers this power on IPOS as part of its inherent jurisdiction;

(c) the lack of recourse by an opponent to an appeal from a decision by IPOS to strike out a notice of opposition is a strong indication that IPOS does not have this power.

The Hearing Officer indicated that the parties made a substantial submission to her at the interlocutory hearing; Opponent’s written submissions span 30 pages while the Applicant’s span 34 pages (including rebuttals but excluding annexes). As for the bundles of authorities, the Opponent tendered 2 volumes, totalling 376 pages while the Applicant tendered 2 volumes as well as a further bundle, totalling 683 pages.

Following the submissions from both parties, the hearing officer explained that she does not think it is necessary to debate upon such substantial and important issues pertaining to the scope of the right granted to the Applicant (and opposed by the Opponent) at this stage of proceedings, and in an interlocutory hearing intended to resolve procedural defaults.

She clarified that the issue on ‘whether the opposition should be directed at the GI itself, and not a translation of the GI’ should be dealt with at a full hearing, especially since there would be a lack of recourse by the Opponent to an appeal for the purposes of this interlocutory hearing.

Taking into account the above and the submissions by both parties, the Hearing Officer declared that she is of the view that the Notice of Opposition should be allowed as long as all the procedural requirements for the filing of a Notice of Opposition as per the GIR has been complied with. As a result, agreed with the Opponent that Rule 28 of the GIR has been complied with – as the subject matter of the Opposition has been duly identified in the Statement of Grounds.

Accordingly, the Hearing Officer confirmed that the NOP was valid, and directed the Applicant to file its Counter-Statement and supporting documents within 6 weeks from the date of the decision, i.e. on or before 21 December 2020.

Currently, the opposition between the parties is ongoing.

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

(source: <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and->

[mediation/legal-decisions/2020/application-to-file-notice-of-opposition-in-a-geographical-indication-application-by-bavaria-and-objection-thereto-by-bayerischer-brauerbund-2020-sgipos-12.pdf](#)

4. Indonesia was Elected as a Representative at the WIPO

Indonesia strived to create history by running as a Deputy Director General (DDG) at the Annual Session of the World Intellectual Property Organization (WIPO) on 21-29 September 2020 in Geneva, Switzerland.



This effort led to the Indonesian ambassador's election to the United Nations, the World Trade Organization, and Other International Organizations in Geneva with Hasan Kleib as DDG for Regional and National Development Sector of the WIPO.

The Director-General of Intellectual Property of the Ministry of Law and Human Rights of Indonesia stated that Indonesia's participation in WIPO shows Indonesia's great concern regarding intellectual Property rights and its protection efforts.

Indonesia is one of the trusted countries to hold the highest leadership position under the Director-General of WIPO.

Four candidates were selected as DDG in addition to Hasan Kleib, including Lisa Jorgenson from the United States as DDG for Patents and Technology Sector, Wang Binying from China as DDG for Brands and Designs Sector, and Sylvie Forbin from France as DDG for Copyright and Creative Industries Sector.

On the same occasion, Kenichiro Natsume from Japan was also selected as ADG for Infrastructure and Platforms Sector, Edward Kwakwa from Ghana as ADG for Global Challenges and Partnerships Sector, Marco Aleman from Colombia ADG for Intellectual Property and Innovation Ecosystems Sector, and Andrew Staines from England as ADG for Administration, Finance and Management Sector.

Indonesia is known to have joined WIPO in 1979 or 12 years after this organization was founded. Indonesia has also ratified a number of agreements managed by WIPO, including the WIPO Convention, Berne Convention, Patent Cooperation Treaty, Trademark Law Treaty, WIPO Copyright Treaty, WIPO Performers and Phonogram Treaty, Marrakesh VIP Treaty, Madrid Protocol, and Beijing Protocol.

Indonesia also officially became member of the 100 Madrid Protocol in October 2017. The Beijing Treaty on Audiovisual Performances was ratified by Indonesia earlier this year.

(source: <http://www.dgip.go.id>;
<https://kabar24.bisnis.com>)

5. DGIP Officially Signed MoU with Danish Patent and Trademark Office Regarding IP

In a virtual meeting on Friday, November 6, 2020, the Directorate General of Intellectual Property (DGIP) discussed strategic partnership plan to advance the Intellectual Property system in Indonesia together with Denmark. The work plan also aims to strengthen the protection of Intellectual Property rights in Indonesia.



The DGIP said that with the Memorandum of Understanding (MoU) between the DGIP and the Danish Patent and Trademark Office (DKPTO), the two countries could work together on training programs and technical exchanges to increase capacity, raise awareness and better protection on Intellectual Property rights, and collaborative activities that may be carried out by both parties with mutual understanding.

After the meeting, Indonesia through the DGIP officially signed MoU with DKPTO regarding Intellectual Property rights. The MoU for Bilateral Cooperation was signed by the Director General of Intellectual Property, Freddy Harris, on Monday, December 7, 2020, at the Oemar Seno Adjie Hall, DGIP Office, DKI Jakarta.

The agreement aims to improve the patent examination process, improve the trademark and industrial design inspection process, and increase the awareness and cooperation in law enforcement relevant to DGIP stakeholders.

This agreement covers several technical areas in the IP field. The technical areas of patents are related to artificial intelligence, information technology, and quality management systems. Meanwhile, the trademark area relates to the basis for rejection of a trademark that contains operability, and procedures and management system for the appeal commission.

And for the area of industrial design and copyright includes protection of designs and non-physical goods, protection of designs for "materials" and copyright royalty schemes.

Moreover, the MoU also contains cooperation in increasing awareness and law enforcement which contains specific campaign strategies, development and cooperation.

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

6. DGIP Collaborate with African Regional Intellectual Property Organization in IP Protection

The Director General of Intellectual Property, Freddy Harris, with the Director General of the African Regional Intellectual Property Organization (ARIPO), Fernando Dos Santos, signed a cooperation agreement on Thursday, December 10, 2020 in Harare City, Zimbabwe.

This collaboration assists ARIPO in adopting an innovative electronic recording system of

copyright and the electronic recording system of communal Intellectual Property developed by DGIP.



As of 31 December 2016, ARIPO was comprised of 19 Member States. ARIPO was mainly established to pool its member's countries resources in industrial property matters together to avoid duplication of financial and human resources. Thus the preamble to the Lusaka Agreement clearly states that member states are "aware of the advantage to be derived by them from the effective and continuous exchange of information and harmonization and co-ordination of their laws and activities in industrial property matters".

From this collaboration, ARIPO can implement an electronic recording system for copyright, as well as an electronic recording system for genetic resources, traditional knowledge, and traditional cultural expressions (SDGPTEBT) for ARIPO member states.

Moreover, DGIP will also provide the source code for the software developed in the project to ARIPO in January 2021.

However, in this collaboration, the Director General of Intellectual Property emphasized that ARIPO is not allowed to modify the software source code that has been provided

without written consent from the DGIP during a three-year maintenance period starting from January 1, 2021 to December 31, 2023.

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

7. DGIP Discusses ASEAN Patent Scope at the 62nd ASEAN Working Group on Intellectual Property Cooperation Meeting

On November 25-26, 2020 the ASEAN Working Group on Intellectual Property Cooperation (AWGIPC) Online Meeting was held. In this meeting, the Directorate General of Intellectual Property was represented by the Head of the Sub Division of the Directorate of Foreign Cooperation.



He discussed the patent database for the Association of Southeast Asian Nations (ASEAN) currently stationed in Indonesia. He also explained that the database was still running well and obtained data from nine ASEAN countries, such as Brunei Darussalam, Cambodia, Indonesia, Laos, Malaysia, Philippines, Singapore, Thailand, and Vietnam.

Currently, Indonesia is processing data transfer from IPAS to IPROLINE to improve public services and simplify the processing of

Intellectual Property applications. During the data transfer process, there are still a number of obstacles that are being overcome so that it goes according to the plan.

Moreover, the AWGIPC meeting also discussed the 2016-2025 IPR Action Plan. The next AWGIPC meeting is planned to be held virtually in March 2021.

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

8. Update Status of Some Dispute Cases in Indonesia

Pursuant to our previous newsletter whereas we inform you 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 "KINCO"

After losing their lawsuit in the Commercial Court level, Kinco Group Company filed a cassation to the Indonesian Supreme Court on the cancellation lawsuit. The Indonesian Supreme Court has rendered their decision to grant Kinco Group Company's cassation, to cancel trademark "KINCO" belonging to PT Holicindo Dasa Anugerah. Kinco Group Company already uses and owned the mark "KINCO" since the early 1980's, therefore Holicindo's registration considered to have similarities in its essential part with Kinco Group Company's mark and further considered having bad-faith in the said mark registration.

The Cancellation Law Suit Against Trademark "SUPRA"

After losing their cancellation lawsuit at the Indonesian Commercial Court, K-Swiss Inc. filed a cassation to the Indonesian Supreme Court on their cancellation lawsuit.

And the Indonesian Supreme Court has rendered their decision to grant K-Swiss Inc.'s law suit, to cancel trademark "SUPRA" belonging to a local businessman named Rusdy Haryono.

The Cancellation Law Suit Against Trademark Painting "ARCUATE PAINTING"

The Commercial Court has rendered their decision to grant Levis Strauss & Co's law suit in part. They stated that the Levis Strauss was the owner and first registrant and was the party entitled to use the mark. They also ordered the Defendant to stop all acts and activities related to the use of the stitched painting on the back pocket of the pants which has the same in essence and in its entirety with the Plaintiff's trademark.

Furthermore, we inform you the results of some IP Lawsuit cases in 2020 newsletter edition as follows:

1. Trademark Cancellation lawsuit of "PUMA": still under court hearings;
2. Patent dispute of "Apotex Inc.": still under court hearings;
3. Trademark Cancellation lawsuit of "CABERG": the lawsuit from Caberg SpA declared unacceptable;

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

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





(Anno 1951)

BIRO OKTROI ROOSSENO

Indonesia Office

Kantor Taman A9, Unit C1 & C2
Jl. Dr. Ide Anak Agung Gde Agung (Mega Kuningan),
Jakarta 12950, Indonesia
P.O. Box 4585, Jakarta 10001

Phone No. : (62-21) 576 2310 (Hunting System)
Fax. No. : (62-21) 576 2301, (62-21) 576 2302,
eFax. No. : (65) 6826 4084
E-mail : iprlaw@iprbor.com
Website : www.iprbor.com

Singapore Office

6 Eu Tong Sen Street The Central
SOHO 1 #07-14
Singapore, 059817

Phone No. : (65) 69621329
Fax. No. : (65) 69621332
E-mail : mail@borinternational.com
Website : <https://www.borinternational.com/>