

JUDICIAL SYMPOSIUM ON INTELLECTUAL PROPERTY

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JUSTICE of The Supreme Court of The Republic of Indonesia

JAPAN, 21 OCTOBER 2021

Q. 1. What kind of claims and allegations might XBC (Plaintiff) raise regarding trademark infringement in your country (for example, injunction and compensation for damages against the sale of the defendant's products in your country on the grounds of trademark infringement)?

Based on Indonesian trademark law, as long as the imported mark is legal and not illegal even if it is not registered in Indonesia, it can be circulated/sold in Indonesia. The plaintiff cannot file a lawsuit against the mark.

However, if the mark is not registered in Indonesia and abroad, nor is it well-known, if the mark has similarities with the Plaintiff's mark, the Plaintiff can file a trademark infringement lawsuit under the Law No. 20 of 2016 regarding Trademark and Geographical Indication (TL) 83, because the Defendant uses the same mark as the Plaintiff and does not have a right or certificate, but, it is not protected by Indonesian trademark law, because it is not registered in Indonesia.

The Plaintiff's lawsuit for compensation, injunction, and/or destruction based on TL 83, and Supreme Court Circular Letter No. 2 of 2019 (SCCL)

- Under TL 83, the owner of a registered Mark and/or the recipient of a registered Mark License may file a lawsuit against another party who unlawfully uses a Mark that has similarities in principle or in its entirety for similar goods and/or services in the form of:
 - a. claim for compensation and/or
 - b. termination of all actions related to the use of the Mark.
- Under SCCL, the owner of a registered Mark, etc. may seek destruction of infringing goods.
- The Plaintiff (XBC) can file a lawsuit for compensation, injunction, and/or destruction.

Q2 What kind of defenses and allegations might YBCM (Defendant) raise regarding trademark infringement in your country (for example, non-similarity of the trademark, cancellation of registration or invalidation of plaintiff's trademark, license, etc.)?

Based on TL 76(2), the defendant may file a lawsuit for the cancellation/invalidation of the registered mark against the plaintiff, by first registering the application for trademark registration at the trademark office (DGIP).

The Defendant may file a lawsuit for the invalidation of the Plaintiff's registered trademark based on:

- TL 21, the Defendant's mark has similarities in principle or in its entirety to the Plaintiff's registered mark.
- TL 77(2), 21(3), the registered mark belonging to the Plaintiff is registered with bad faith intentions.

Q.2 The elements of bad faith

Based on the explanation of TL 21(3)

An applicant with bad intentions is an applicant who is reasonably suspected in registering their Trademark having the intention to:

- imitate,
- plagiarize, or
- follow another party's Mark for the sake of their business interests creating conditions of unfair business competition, deceiving, or misleading consumers.

Q. 3.1. The factors that can be considered in making a decision regarding the similarity of the Plaintiff's and Defendant's marks are

Based on the explanation of TL 21 (1)

- the similarity caused by the dominant element between one Mark and another, giving the impression of a similarity regarding:
 - Form or appearance,
 - the method of placement,
 - the method of writing or
 - the combination of elements,
 - as well as the similarity of the sound of speech contained in the Mark.

Q. 3. 2. Is the similarity regarding designated goods or services considered? If so, what factors are taken into account?

Regarding lawsuit for compensation, etc. based on TL 83

The similarity between goods or services is required.

Regarding lawsuit for invalidation of a registered trademark based on TL 76 and 21

The protection of the trademarks is distinguished between well-known and not well-known trademarks.

- For well-known trademark, legal protection is provided not only for the same of goods and services, but also for goods or services which are not the same kind (TL 21(1)c).
- For trademark is not well known, legal protection is provided only for the same kind of goods or services (TL 21(1)a).

Q.3.2. Under Minister of Law and Human Rights Regulation No. 67 of 2016 concerning Trademark Registration 17(2), criteria for determining similar goods and/or services can be in the form of goods with goods, goods with services, or services with services determined based on:

- a. the nature of the goods and/or services;
- b. the purpose and method of using the goods;
- c. complementarity of goods and/or services;
- d. competition for goods and/or services;
- e. distribution channel of goods and/or services;
- f. relevant consumers; or
- g. origin of the production of goods and/or services.

Q.4. How are infringement and damages theories asserted, proven, and refuted in the course of litigation? [For instance, are they respectively determined on two different stages?]

Regarding IP lawsuit for compensation, court proceedings are not clearly divided into two different stages ((1) the first stage for examining of infringement and (2) the second stage for examining of damages) such as Japan.

Moreover, there are no provisions regarding an order to compel a defendant to submit or produce documents which shows its sale, expenses, or profit in the HIR (Civil Procedure Law) or TL (including “Discovery System” such as the U.S).

Q.5 Please explain how damages for trademark infringement are calculated in your country.

Under the Supreme Court Circular Letter No. 2 of 2019 (SCCL)

- the amount of compensation is decided by the judge based on the details of the loss taking into account the profits obtained by the violator and the losses for the holder/mark owner

Q. 6. If the Plaintiff had registered the Plaintiff's Trademark but has not actually been used for the sale of construction machinery, would the decision in Q1 to Q5 be affected?

The registered trademark can be revoked/deleted, if the trademark has not been used for 3 consecutive years.

Under TL 74, registered marks can be deleted/revoked:

- The Defendant may file a lawsuit to the Court to delete/revoke the registered trademark of the Plaintiff if it is not used for 3 consecutive years in the trade of goods and services.
- Non-use for 3 consecutive years counted since registered or since the last use.
- The Defendant must prove since when the trademark cannot be used.

Q. 7. If this case were filed in your country, what final judgment would you expect by taking into account the Defendant's defenses available? Please briefly explain your conclusions and reasons.

The Plaintiff's Mark can be canceled/invalidated on the grounds;

- The Plaintiff registered his trademark in bad faith, even though the Defendant's trademark was not well-known or recognized in Indonesia, but the Defendant's trademark was already well known abroad.
- The Plaintiff intends piggybacking on the Defendant's well known trademark so that it can be likelihood of confusing or misleading consumers.
- In addition, before the Plaintiff registered his trademark in Indonesia, he had known the reputation of the Defendant's trademark abroad, because the Plaintiff was a former distributor of the Defendant and the Plaintiff was engaged in the same line of business.

Q8 Please explain the enactment or amendment of any trademark laws in your country within the last five (5) years, including the recent legislation to be compliant with treaty obligations (e.g., the TPP Agreement).

- Law No. 20 of 2016 concerning Trademark and Geographical Indications(TL)
- Minister of Law and Human Rights Regulation No. 67 of 2016 concerning Trademark Registration
- Article 50 TRIPs Agreement, the judicial authorities shall have the authority to order prompt and effective provisional measures:
 - Regulation of the Supreme Court of the Republic of Indonesia No. 6 of 2019 concerning Border Measure,
 - Number 5 of 2012 concerning Provisional Measures
- Supreme Court Circular Letter No. 2 of 2019 (SCCL) regarding:
 - Calculation of compensation in IPR cases
 - Destruction of goods resulting from IPR violations

IP CIVIL CASES SUBMITTED TO THE COMMERCIAL COURT AT CENTRAL JAKARTA DISTRICT COURT YEAR 2018 - 2020

YEAR	DESIGN	COPYRIGHT	TRADE MARKS	PATENT	TOTAL
2018	8	5	50	4	67
2019	6	13	59	5	83
2020	9	14	44	5	72
TOTAL	23	32	153	14	222

IP CIVIL CASES SUBMITTED TO THE SUPREME COURT YEAR 2015 - 2020 (CASATION AND CIVIL REVIEW)

YEAR	DESIGN	COPYRIGHT	TRADE MARKS	PATENT	TOTAL
2015	7	7	42	4	60
2016	3	5	39	1	48
2017	6	10	22	4	42
2018	10	16	35	5	52
2019	8	20	37	4	69
2020	6	14	41	3	64
21/10/2021 TOTAL	40	72	216	21	335

This data shows that
trademark cases are the most
cases submitted to the
Supreme Court