

APPLICATION OF THE DOCTRINE OF FOREIGN EQUIVALENTS IN THE CASE OF BRANDS IN INDONESIA (CASE STUDY OF VERDICT NUMBER 118 PK/PDT.SUS-HKI/2014)

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Abstract

The right to a Mark is an exclusive right granted by the state to the owner of a registered Mark. However, the Trademark Law in Indonesia has not provided legal certainty regarding trademarks that cannot be registered. One of the reasons is because the 2016 Trademark Law does not clearly mention and regulate the Doctrine of Foreign Language Equivalent Matching or FDE. The issue to be raised in this study is how to apply FDE in the case of brands in Indonesia. The goal is to find out and analyze the application of FDE in the case of brands in Indonesia. This research is carried out using a normative juridical approach (legal research), the nature of this research is descriptive research, where descriptive research is also classified as normative judicial research or literature law research. Library materials and other data as the main research material will be studied in depth regarding the application of the Doctrine of Foreign Equivalents in the case of brands in Indonesia, especially in the Kopitiam Verdict. The Panel of Judges in the Case of "Lau Kopitiam" against "KOPITIAM" in this case is considered to be *khilaf* because it gives considerations that are contrary to its own considerations in the section of the CONVENTION, especially IN THE EXCEPTION, namely regarding the exception filed by the PK Applicant, where the PK Applicant declares that the PK Respondent has no legal standing or is not an interested party under the provisions of Article 68 paragraphs (1) and (2) of Law No. 15 of 2001. Doctrine of Foreign Equivalents needs to be added immediately to the laws and regulations regarding brands in Indonesia. If the doctrine is not clearly included and stated in the trademark law in the future, then legal certainty for owners of foreign-language marks registered in Indonesia will still not be guaranteed legal certainty.

Keywords: Intellectual Property Rights Law, Trademarks, Legal Certainty, Doctrine of Foreign Equivalents

1. INTRODUCTION

A brand is a naming in the trade of goods and services, which provides instructions for consumers not to make the wrong choice for the desired goods or services. A brand is part of the protection of intellectual property rights, in the form of industrial property rights, which serves as the naming of a product of goods and services. Trademark (Trademark)¹ as Intellectual Property Rights is basically a sign to identify the origin of goods and services (an Indication origin) of a company with the goods and / or services of other companies.

Brand is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and / or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and / or services produced by people or legal entities in the activities of trading goods and / or services.² The right to a Mark is an exclusive right granted by the state

to the owner of a registered Mark for a certain period of time by self-using the Mark or granting permission to another party to use it.³

Trademarks and rights to marks are intellectual property that must obtain legal certainty upon their registration. In the legal politics of Law Number 20 of 2016 concerning Brands and Geographical Indications⁴(hereinafter referred to as the 2016 Trademark Law) contained in the consideration, it is stated, first, in the era of global trade, in line with international conventions that Indonesia has ratified,⁵ Trademark licensing and Geographical Indications⁶ are very important, especially in maintaining healthy business competition, fairness, consumer protection, as well as the protection of Micro, Small, and Medium Enterprises and domestic industries; second, to further improve services and provide legal certainty for the world of industry, trade, and investment in the face of local, national, regional, and international economic developments as well as the development of information and communication technology, it is necessary to be supported by a law in the field of More adequate Brands and Geogrist Indications; and third, that in Law No. 15 of 2001 concerning Brands there are still shortcomings and have not been able to accommodate the development of community needs in the field of Brands and Geographical Indications and have not sufficiently guaranteed the protection of local and national economic potential so that they need to be replaced.⁷

In summary, Law Number 20 of 2016 concerning Trademarks and Geographical Indications is an improvement in protection for Brand owners or rights to Trademarks. The right to the Mark itself is one of the important intellectual property rights, so it is often referred to as high-value immaterril property.⁸ In article 1 paragraph

(4) Law No. 20 of 2016 on Trademarks and Geographical Indications, states that the right to a mark is an exclusive right:⁹

"The right to a mark is an exclusive right granted by the state to the owner of a Mark registered in the General Register of Marks for a certain period of time by using the Mark itself or giving permission to another party to use it."

According to Gatot Supramono, exclusive rights are the personal rights of the brand owner in the use of his brand. This means that others cannot exercise the rights to the mark without the permission of the owner of the mark.¹⁰

The development of trademark rights as an exclusive right in Indonesia is inseparable from the period after Indonesia ratified TRIPs¹¹ When it was still colonized by the Netherlands, Indonesia (Dutch East Indies) has been a member of the Paris Union since 1934. However, with its independence, Indonesia did not necessarily become a Member of the Paris Union. Therefore, in 1950 the Government of Indonesia submitted a written request to become a member of the Paris Union, to the Swiss Government as the depositor of the text of the Paris Convention. Since 1953, Indonesia has again become a member of the Paris Union.¹²

As a Member of the Paris Union, on April 15, 1994, Indonesia signed the Final Act Embodying the Result of the Uruguay Round of Multilateral Trade Negotiations, which included an Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).¹³ A few years

later, in order to harmonize the tools of laws and regulations in the field of Intellectual Property (IP) with the TRIPs Approval, the Indonesian government revised and promulgated several laws in the field of intellectual property including the 1992 Trademark Law (1992 Trademark Law). To replace the 1992 Trademark Law, the Indonesian government issued Law Number 15 of 2001 concerning Trademarks (hereinafter referred to as the 2001 Trademark Law),¹⁴ and the latest is the Trademarks and Geographical Indications Law.¹⁵

According to Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law 2016), to obtain exclusive rights to a Mark, registration must be submitted to the Directorate General of Intellectual Property, both individuals and legal entities, and must first be announced on the General Register of Marks by the Directorate General of Intellectual Property through the website: www.dgip.go.id by going through various stages, from the application for entry, examination of formalities, publication period, substantive examination, approval of the Director, and exit of the trademark certificate that is proof of ownership of the exclusive rights of the mark. However, when registering a mark, both individuals and legal entities must also meet the criteria that have been determined by Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law 2016), otherwise the registration of the mark must be rejected.¹⁶

According to Article 20 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law 2016), a mark cannot be registered if:¹⁷

- a) Contrary to applicable laws and regulations, religious morality, decency, or public order;
- b) Same with, relating to, or only mentioning the goods and/or services for which registration is requested.
- c) Contains elements that can mislead the public about the origin, quality, type, size, type, purpose of use of goods and/or services requested for registration or is the name of a protected plant variety for similar goods and/or services.
- d) Contains information that is not in accordance with the quality, benefits, or efficacy of the goods and / or services produced;
- e) It has no distinguishing power and / or ;
- f) It is a common name and/or a common property emblem.

Furthermore, Article 21 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law 2016), regulates the refusal of trademark registration as follows:¹⁸

(1) The application must be rejected if the Mark

- a) Have similarities in principal or in its entirety with other parties' brands that have been registered in advance for similar goods and / or services;
- b) Well-known brands belonging to other parties for similar goods and / or services ;

- c) Other parties' well-known brands for non-similar goods and/or services that meet certain requirements; or
- d) Geographical Indications are registered.

(2) The application is rejected if the Mark:

- a) Is or resembles the name or abbreviation of a famous person's name, photograph, or legal entity name owned by another person, unless the consent of the applicable written person;
- b) Is an imitation or resemblance of the name or abbreviation of the name, flag, lambing or symbol or emblem of a country, or a national or international Institution except with the written consent of the competent authority.

(3) The application is rejected if it is filed by an applicant in bad faith;

(4) Further provisions regarding the rejection of the Trademark Application as referred to in paragraphs (1) of letters a to c shall be regulated by a Ministerial Regulation. In article 1 paragraph 1 of Law no.20 of 2016, carrying Brands and Geographical Indications, definition: A brand is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements in 2 (two) or 3 (three) dimensions, sounds, holograms, or a combination of these elements that have differentiating power and are used in the trade of goods or services.¹⁹ Regarding marks that cannot be registered and rejected, it is regulated through Chapter IV, Part One, and Article 20 to Article 22. Article 20 of the 2016 Trademark Law reads: A brand cannot be registered if:

- a) Contrary to state ideology, legislation, morality, religion, decency, or public order;
- b) Same with, relating to, or simply mentioning the goods and/or services for which registration is requested;
- c) Contains elements that can mislead the public about the origin, quality, type, size, type, purpose of use of goods and / or services requested for registration or is the name of a protected plant variety for similar goods and / or services;
- d) Contains information that is not in accordance with the quality, benefits, or efficacy of the goods and / or services produced;
- e) It has no distinguishing power; and/or
- f) It is a common name and/or public property emblem. While Article 21 of the 2016 Trademark Law reads:

(1) "The application is rejected if the Mark has similarities in essence or in its entirety to:

- a) The registered mark belongs to another party or is requested in advance by the other party for similar goods and/or services;
- b) Well-known brands belonging to other parties for similar goods and/or services;
- c) Other parties' well-known brands for non-similar goods and/or services that meet certain requirements; or

d) Geographical Indications are registered.

(2) The application is rejected if the Mark:

- a) is or resembles the name or abbreviation of the name of a famous person, photograph, or legal entity name owned by another person, except with the written consent of the entitled person;
- b) is an imitation or resemblance of the name or abbreviation of the name, flag, emblem or symbol or emblem of a country, or national or international institution, except with the written consent of the competent authority; or
- c) is an imitation or resembles an official mark or stamp or stamp used by a state or Government agency, except with the written consent of the competent authority.

(3) The application is rejected if it is filed by the Applicant in bad faith.

(4) Further provisions regarding the rejection of the Trademark Application as referred to in paragraph (1) letters a to c shall be regulated by a Ministerial Regulation."

Furthermore, Article 22 of the 2016 Trademark Law reads:

"Against a registered Mark which then becomes a generic name, any person may apply for a Mark by using the generic name in addition to other words as long as there is an element of distinction."

Although it contains more detailed arrangements regarding trademark registration, the Trademark Act 2016, in reality has not provided conclusive legal certainty regarding marks that cannot be registered. This happened, among others, because the 2016 Trademark Law did not clearly mention and regulate the Doctrine of Foreign Eequivalents, hereinafter abbreviated as Doctrine of Foreign Equivalents. In Chapter III, The Fifth Section (Announcement of The Application) Section 15 letter e of the Trademark Act 2001 states:

"Brand labels, including descriptions of colors and if the Brand label uses a foreign language and/or letters other than Latin letters and/or numbers that are not commonly used in Indonesian, accompanied by translations into Indonesian, Latin letters or numbers commonly used in Indonesian, and the manner in which they are pronounced in Latin spelling."

Meanwhile, Chapter IV, Part Two (Substantive Examination of Brands) Article 25 letter e of the 2016 Trademark Law reads:

"The registered Mark Label, including a description of the type of color if the Mark uses color elements, and if the Mark uses foreign languages, letters other than Latin letters, and numbers that are not commonly used in Indonesian accompanied by translations in Indonesian, Latin letters and numbers commonly used in Indonesian and the manner in which they are pronounced in Latin spelling;"

However, the two articles have not given clear restrictions on Foreign Language Equivalent Matching or translating a brand formulated in a Foreign Language into Indonesian without

changing its generic meaning. As a result, there is a problem of uncertainty related to brands derived from Foreign Languages registered in Indonesia. One example is the brand "Vermicelli". The brand "Vermicelli" is used for noodle and vermicelli products. In fact, according to Webster Cannon, Lerner's Dictionary "Vermicelli" means 'a type of paste like spaghetti, but thinner'; a kind of vermicelli. Referring to Article 20 letter (b) of the Trademark Act 2016, the "Vermicelli" mark should have been refused to be registered, as it only mentioned the type of product/goods. Moreover, if we can refer to Doctrine of Foreign Equivalents, then to be registered, the word "Vermicelli" needs to be found an equivalent or translated first into Indonesian. The problem is that the Law on Trademarks 2016, does not yet contain provisions referring to Doctrine of Foreign Equivalents.

In Indonesia, the absence of clear provisions on Doctrine Of Foreign Equivalents in the 2016 Trademark Law can also cause legal problems over the registration of a mark which is the merger of 2 (two) foreign language words that cannot be separated. An example is the brand "Kopitiam". The Minister of Law and Human Rights of the Republic of Indonesia explained that the granting of trademark rights registration for "Kopitiam" was carried out because "Kopitiam" was not the name of the type of goods/services offered (Article 20 letter b of the 2016 Trademark Law). However, when referring to the Doctrine of Foreign Language Equivalent Matching, the 'Kopitiam' mark should be registered with a mark that has received equivalent matching in Indonesian. Because, in fact, the public knows that the word 'Kopitiam' itself is a Malay word for the ethnic Hokkien Chinese language which if found an equivalent in Indonesian becomes 'Warung Kopi' or 'Kedai Kopi'. Since the Law on Trademarks 2016 does not clearly regulate Doctrine of Foreign Equivalents, the legal certainty of Koptiam's brand rights is unclear. In fact, as is known, legal issues surrounding the Koptiam brand cause legal uncertainty' because the Minister of Law and Human Rights of the Republic of Indonesia treated the brand only based on Article 20 letter b, Law on Trademarks of 2016. This means that the 'Kopitiam' brand can be registered because it is not the same as, relating to, or only mentioning the goods and/or services for which registration is requested. The case of the brand 'Kopitiam' began to surface to the public after Abdul Alek Soelystio registered his coffee shop under the name 'KOPITIAM'. Contrary to the description and some examples of cases above, the author is of the view that Doctrine of Foreign Equivalents needs to be immediately added to the laws and regulations regarding brands in Indonesia. If the doctrine is not clearly included and stated in the trademark law in the future, then legal certainty for owners of foreign-language marks registered in Indonesia will still not be guaranteed legal certainty.

The problem is how the Doctrine of Foreign Equivalents is applied in the case of brands in Indonesia (case study verdict number 118 PK /Pdt.Sus-HKI/2014). The goal is to find out and analyze the application of the Doctrine of Foreign Equivalents in the case of brands in Indonesia.

2. RESEARCH METHODS

This research is carried out using a normative juridical approach (legal research)²⁰ or also known as doctrinal research.²¹ The nature of this research is descriptive research, which is research carried out with efforts to understand various things related to the subject matter of study and then the results of the understanding are described in the form of scientific writings. Descriptive research is also classified as normative judicial research or literature law research. Library materials and other data as the main research material will be studied in depth regarding the application of the Doctrine of Foreign Equivalents in brand cases in Indonesia, especially in the Kopitiam Ruling.

3. DISCUSSION

Kopitiam Verdict Case

Decision No. 118 PK/Pdt.Sus-HKI/2014 between Abdul Alek Soelystio, residing at Pantai Mutiara Blok SA No. 3, North Jakarta, in this case authorizes Dr. J. Djohansjah, S.H., M.H., and friends, the Advocates, addressed at Wisma Slipi, 4th Floor of Room 408, Jl. Letjend S. Parman Kav. 12, West Jakarta, based on a Special Power of Attorney dated July 2, 2014, as the Defendant's prior Review Petitioner. Against Phiko Leo Putra, residing on Jl. Anggur V/15, RT/RW 012/008, Rawa Buaya, Cengkareng, West Jakarta, in this case authorized Panji Prasetyo, S.H., LL.M., and friends, advocates at the Law Office of Panji Prasetyo & Partners, addressed at Allianz Tower, 27th Floor, Jalan H.R. Rasuna Said Superblok 2, Kuningan Persada Area, Jakarta 12980, based on a Special Power of Attorney dated August 11, 2014, as the Respondent for Judicial Review first the Plaintiff; and Government of the Republic of Indonesia C.q. Department of Law and Human Rights C.q. Directorate General of Intellectual Property Rights C.q. Directorate of Brands, addressed at Jalan Daan Mogot Km. 24, Tangerang, Banten, as the Respondent for Judicial Review was also the Defendant.

In the judgment the judge stated that the marks registered by the Defendants In The Reconvening were "Lau's Kopitiam" with the letter "L" Large and the other large "K" lowercase, while those written in the numbers 3 (three) Petitem of the Plaintiff's Suit In The Reconvening were "KOPITIAM" with all uppercase letters. Thus there is a difference in the letters on the marks registered by the Defendants In The Reconvening with those written by the Plaintiffs In The Reconvening at number 3 (three) Petitem of the Plaintiff's Suit In The Reconvening, then according to the Tribunal there is a significant difference, considering that as stipulated in Article 1 (one) number 1 (one) of Law No. 15 of 2001 concerning Trademarks.

The consideration of the Panel of Judges in the Commercial Court is clearly a real error because by stating that the "Lau's Kopitiam" brand belonging to the Respondent PK (formerly the Reconvening Defendant) has significant differences with the "KOPITIAM" brand belonging to the Pk Applicant (formerly the Reconvening Plaintiff) due to the difference in uppercase letters (capital letters) and lowercase letters, then in fact the Panel of Judges in the Commercial Court has violated the provisions of Article 6 of Law No. 15 of 2001 concerning Trademarks.

The explanation of Article 6 paragraph (1) letter a of Law No. 15 of 2001 concerning Brands states: "What is meant by similarities is basically similarities caused by the presence of prominent elements between one Brand and another Brand, which can give the impression of similarities both regarding the form, method of placement, way of writing or combination of elements or similarity of speech sounds contained in these brands". It is very clear that the mark being registered by Respondent PK (formerly the Reconvening Defendant) is "Lau's Kopitiam" where the prominent element in the mark is in the word "Kopitiam", clearly having similarities in speech with the registered mark belonging to the Petitioner PK (formerly the Reconvening Plaintiff) i.e. "KOPITIAM" (IDM00003089; IDM000302964; IDM000305714; and IDM00035307), as intended in the explanation of Article 6 Paragraph (1) Number A of Law No. 15 of 2001.

The consideration of the Panel of Judges at the Commercial Court is very wrong and not at all based on the law, because there is not a single jurisprudence of brand cases in Indonesia that decides that the difference in writing between capital letters (uppercase) and lowercase letters is a significant brand difference. Even the opposite Continuously or continuously, the Supreme Court of the Republic of Indonesia provides trademark law enforcement to eradicate brand imitators who deliberately and in bad faith try to register a mark that has similarities with other people's previously registered marks. If the consideration of the Panel of Judges in the Commercial Court is followed, then obviously everyone can arbitrarily register a previously registered brand (for example: the "AQUA" brand or the "Indomie" brand or the "Bank BCA" brand or the "KFC" brand or the "STARBUCKS COFFEE" brand or the "PRADA" brand) as long as it uses a different letter, , e.g. "aqua" or the "INDOMIE" or "Bank bca" brand or the "kFc" brand or the "starBucks Coffee" brand or the "praDa" brand."

The Panel of Judges of the Commercial Court has also erred or committed a real oversight because the difference between capital letters (uppercase) and lowercase letters, is not a significant difference, because even if the shape between capital letters and lowercase letters may not be the same, but both capital letters and lowercase letters will be sounded or pronounced in the same way.

In the Explanation of Article 6 paragraph (1) number a of Law No. 1 of 2001, one form of equation is basically explained as "the equation of speech sounds contained in these brands". in other words, to determine whether or not there is an equation in essence, it does not depend on whether the brands use uppercase (capital letters) or lowercase letters, as long as the sound of the speech is the same, then the brands have similarities in essence. Thus, it has been proved that there was a very real error made by the Panel of Judges of the Commercial Court, so it is perfectly reasonable for the Supreme Court to annul the judgment and grant the petitioner PK's (formerly Reconvened Plaintiff) reconvening suit in its entirety.

The Commercial Panel of Judges Has Committed A Real Oversight Because It Was Not Careful and Thorough In Examining All The Important Factors and Elements That Have Been Decided By The Supreme Court As Well As Other Judgments That Have Been Legally Binding In The Case Of Kopitiam Brand 1. That it is clear that the Panel of Judges in the Commercial

Court has committed a very real Oversight in its Judgment No. 03/ Rev.Sus.Brand/2014/PN. Niaga.JKT.PST, dated May 22, 2014, especially on the consideration of the judgment of page 91 of the 3rd and 4th paragraphs, as follows:

As in Evidence P.1 that the marks registered by the Defendants In The Reconvening are "Lau's Kopitiam" with the letters "L" Large and the other large "K" lowercase, while those written in the numbers 3 (three) Petitem of the Plaintiff's Suit In The Reconvening are "KOPITIAM" with all uppercase letters. Thus there is a difference in the letters on the marks registered by the Defendants In The Reconvening with those written by the Plaintiffs In The Reconvening at number 3 (three) Petitem of the Plaintiff's Suit In The Reconvening, then according to the Tribunal there is a significant difference, considering that as stipulated in Article 1 (one) number 1 (one) of Law No. 15 of 2001 concerning Trademarks.

The Panel of Judges of the Commercial Court has dismissed for giving considerations contrary to its own considerations in the section of the CONVENTION, particularly IN THE EXCEPTION, namely regarding the exception filed by the Petitioner PK (formerly the Reconvening Plaintiff), where the Petitioner PK (formerly the Reconvening Plaintiff) stated that the Respondent PK (formerly the Reconvening Defendant) had no legal standing or is not an interested party based on the provisions of Article 68 paragraphs (1) and (2) of Law No. 15 of 2001. In its consideration of the exoneration of the Petitioner PK (formerly the Reconvening Plaintiff), the Panel of Judges of the Commercial Court held that the Respondent PK (formerly the Reconvening Defendant) was an interested party to file a suit in a quo case.

3. That further on page 88, of the 7th and 8th paragraphs, the Panel of Judges of the Commercial Court gave the following considerations:

In Article 6 paragraph (1) letter a of Law Number 16 of 2001 concerning Trademarks states "The application must be rejected by the Directorate General if the Mark: has similarities in essence or in its entirety with the brand belonging to another party that has been registered in advance for similar goods and /or services". As in evidence P-1, it turns out that plaintiff also registered the mark "Lau's Kopitiam" which also uses the word Kopitiam, so that if the Plaintiff's mark had been registered, then of course objections if there are other parties using the brand that also use the brand with the word Kopitiam".

The consideration on the part of the Convention according to the Panel of Judges of the Commercial Court is to apply mutatis mutandis to the Section of The Reconvening As well. Thus, the Panel of Judges of the Commercial Courts is very understanding that the problem of equality lies in the word KOPITIAM (either with capital letters/all large letters or with a large "K" letter), where both the brand "LAU'S KOPITIAM" and the brand "KOPITIAM" both have similarities in essence in the form of sound equations and similarities of prominent / important elements.

This is where the real oversight or error of the panel of judges in the Commercial Court lies. If according to the Panel of Judges in the Commercial Court the brand LAU'S KOPITIAM belonging to Respondent PK (formerly the Reconvening Defendant) has significant differences

with the KOPITIAM brand belonging to the Applicant PK (formerly the Reconvening Plaintiff), then it should be that the exception of the Pk Applicant (formerly the Reconvening Plaintiff) stating that the Respondent PK has no interest in filing the suit should be accepted. for if the unregistered brand of LAU'S KOPITIAM has no similarity with the kopitiam mark belonging to the Petitioner PK (formerly the Reconvening Plaintiff) is already registered, then of course there is no reason or no legal interest for respondent PK to file a suit that invalidates the KOPITIAM mark belonging to the Registered PK Applicant (formerly the Reconvening Plaintiff).

It is proven that the Panel of Judges at the Commercial Court has not been thorough and has not examined all its considerations carefully so as to give considerations that are contrary between the considerations of the Convention and the considerations in the Reconvening, so it is very reasonable for the Supreme Court of the Republic of Indonesia to overturn the decision of the Commercial Court No. 03 / Pdt.Sus.Brand / 2014, dated May 22, 2014.

The Panel of Judges of the Commercial Court has also committed a real oversight or error because it did not carefully and carefully examine the elements related to the case a quo, especially the judgments that have permanent legal force directly related to the case a quo, namely supreme court decision No. 179 PK/Pdt.Sus/2012, dated March 20, 2013 jo. Supreme Court Decision No. 261 K/Pdt.Sus/2011, date June 21, 2011 jo. Decision of the Commercial Court at the Medan District Court No. 05/Brand/2010/PN. Niaga.Mdn, dated November 29, 2010, which has permanent legal force, wherein in the said judgment the brand "Kok Tong Kopitiam" is determined to have similarities in essence with the brand "KOPITIAM" belonging to the Applicant PK (formerly the Reconvening Plaintiff) under the provisions of Article 6 paragraph (1) letter a of Law No. 15 of 2001 concerning Trademarks.

Commercial Court Decision No. 67/Rev.Sus-Brand/2013/ PN. Niaga.Jkt.Pst, dated February 3, 2014 which has permanent legal force, wherein in the judgment the brand "QQ Kopitiam" is determined to have similarities in essence with the brand "KOPITIAM" belonging to the Applicant PK (formerly the Reconvening Plaintiff) based on the provisions of Article 6 paragraph (1) letter a of Law No. 15 of 2001 concerning Trademarks. Thus it has been proved that the Panel of Commercial Judges has committed a very obvious oversight for ignoring the elements of the element of the element which is very directly related to the case a quo, in particular to assess the existence of similarities between the "Lau's Kopitiam" marks of the Respondent PK (formerly the Reconvening Defendant) which is not registered under the "KOPITIAM" mark belonging to the Petitioner PK (formerly the Reconvening Plaintiff) which has been registered with the IDM00003089 certificate; IDM000302964; IDM000305714; AND IDM00035307. There are enough reasons for the Supreme Court of the Republic of Indonesia to annul judgment No. 03/Pdt.Sus.Merek/2014, dated May 22, 2014 and grant petitum number 3 of the petitioner PK's reconvening suit, because it has been very clearly proven that the unregistered "Lau's Kopitiam" brand of respondent PK has similarities in essence in the form of sound equations and similarities of important elements with the "KOPITIAM" brand belonging to the Applicant PK (formerly the Reconvening Plaintiff) which has been registered with the certificate IDM00003089; IDM000302964;

IDM000305714; and IDM00035307. The Consideration of the Commercial Judges Is Very Wrong Because It Ignores the Proven Facts Regarding the Similarity Between the Brand "Lau's Kopitiam" And The Brand "KOPITIAM", So That It Should Be That The Claim for Compensation and Demands For Prohibition Of The Use Of The Brand "Lau's Kopitiam" Under Article 76 Of Law No. 15 Of 2001 Concerning Brands Can Be Granted 1. That on page 90, the 8th paragraph of the Judgment of the Panel of Judges of the Commercial Court states:

As in Evidence T-13a, T-13b and Evidence P-1 it is proved that the "Lau's Kopitiam" mark belonging to the Defendant In The Reconvening has been denied registration by the Co-Defendant, then the Defendant In The Reconvening appealed to the Appellate Commission of the mark, but the appeal filed by the Defendant In the Reconvening has been rejected by the Trademark Appeal Commission, whereas neither the Defendant In The Reconvening Nor the Plaintiff In The Reconvening can prove that neither the brand "LAU'S KOPITIAM" belongs to the Defendant In The Reconvening The reconvening has been registered by the Defendants, hence the "Lau's Kopitiam" mark belonging to the Defendants In the Reconvening is an unregistered mark, hence the petitum number 2 (two) suits in the reconvening must be granted."

This is where the oversight of the Panel of Judges of the Commercial Court lies, because even considering the existence of Evidence T-13a, T-13b, even expressly stated that the Respondent PK (formerly the Reconvening Defendant) had already filed a trademark appeal with the Trademark Appeal Commission and was rejected by the Trademark Appeal Commission, but the Panel of Judges of the Commercial Court had dismissed it for not carefully and not carefully considering the reasons for the rejection of the trademark appeal set forth by the Commission Trademark appeal against the registration of the mark "LAU'S KOPITIAM" filed by Respondent PK (formerly The Reconvening Defendant). that it is very clear in the consideration of the Trademark Appeal Commission in judgment number:119/KBM/HKI/2012, dated May 2, 2012 (vide evidence T- 13b), the reason for the rejection of the Application of the Trademark Appeal Commission was because the brand "LAU'S KOPITIAM" had similarities in essence with the brand "KOPITIAM" belonging to Applicant PK (formerly Reconvening Plaintiff) who has been registered first and obtained Registration Certificate Number: 371718, dated October 18, 1996 and has been extended with certificate number IDM000030899, dated MARCH 14, 2005.

The Panel of Judges of the Commercial Court has been dismissed in its deliberations for not being careful and not thorough in assessing the true intent of the suit of respondent PK (formerly the Reconvening Defendant), namely with the intention to cancel the brand "KOPITIAM" which has been registered certificate No. IDM000305714.

Indeed, taking into account Evidence T-13b and Evidence P-1 as page 90, 8th paragraph, the Panel of Judges of the Commercial Court has deeply understood that the Respondent PK (formerly the Reconvening Defendant) himself has admitted to having an interest in filing a suit for cancellation of the mark knowing that the brand "LAU'S KOPITIAM" has similarities in essence with the brand "KOPITIAM". If the Panel of Judges of the Commercial Court

accepts and adjudicates the suit in the Convention, both in the Exception and in the Subject Matter of the Case, then the Panel of Judges in the Commercial Court has recognized the interest of the Respondent PK (formerly The Reconvening Defendant) and the "Lau's Kopitiam" brand belonged to Respondent PK (formerly the Reconvening Defendant) against the "KOPITIAM" brand belonging to the Pk Applicant (formerly the Reconvening Plaintiff).

Thus, if Respondent PK (formerly the Reconvening Defendant) himself has admitted the existence of an interest in the form of similarities in essence between respondent PK's "Lau's Kopitiam" brand (formerly the Reconvening Defendant) and the "KOPITIAM" brand belonging to the Pk Applicant (formerly the Reconvening Plaintiff), then of course there is absolutely no legal reason for the Panel of Judges of the Commercial Court to state that the "Lau's Kopitiam" brand belonging to Respondent PK (formerly the Reconvening Defendant) has a difference that significant under the brand "KOPITIAM" belonging to Petitioner PK (formerly The Reconvening Plaintiff). Since it has been proved that the Panel of Judges of the Commercial Court has committed a very fatal oversight, it is sufficient grounds for the Supreme Court at the level of Judicial Review to overturn judgment No. 03/ Rev.Sus.Brand/2014/ PN. Niaga.Jkt.Pst, dated May 22, 2014. Since it has been proven (and admitted by Respondent PK himself) of the existence of similarities between respondent PK's "Lau's Kopitiam" brand (formerly the Reconvening Defendant) and the "KOPITIAM" brand belonging to The PK Applicant (formerly the Reconvening Plaintiff), then it should be that if the petitum numbers 3, number 4, number 5, number 6, number 7, number 8, and number 9 in the reconvening suit are granted in their entirety. On the grounds of such review the Supreme Court held: as to the reasons A, B and C That the reasons for the review were justifiable, because after careful examination of the memory of the Review dated July 4, 2014 and the answer to the memory of the review dated August 20, 2014 connected with the consideration of judex Facti it turned out that there was an oversight of the judge in a quo judgment with the following considerations:

In accordance with the judgment in the relevant case filed by the Defendant/Petitioner for Review i.e. judgment No. 179 PK/Rev.Sus/ 2012 the prominent element in the KOPITIAM brand is the similarity of the word KOPITIAM so that the consideration that the use of a combination of "lowercase" and "large" in the mark belonging to the Plaintiff makes the mark have no similarity in essence with the defendant's trademark, namely KOPITIAM, is an oversight, therefore the suit of the Reconvening Plaintiff may be granted in part i.e. the 2nd, 3rd, 4th and 5th petitums, rejecting the reconvening petitum other than and the rest.

Based on the above considerations, the Supreme Court held that there were sufficient grounds to grant the application for review filed by the Review Petitioner: Abdul Alek Soelystio and overturned the decision of the Commercial Court at the Central Jakarta District Court to have given judgment No. 03/ Pdt.Sus.Merek/2014/PN. Niaga.JKT.PST dated May 22, 2014, the Supreme Court will then re-adjudicate this case with amar as will be mentioned below. Since the application for review of the Review Petitioner was granted, the Review Respondent was convicted to pay the costs of the case in all levels of the judiciary and the review examination.

The judgment stated that the Panel of Judges granted the application for review from the Said Review Petitioner : ABDUL ALEK SOELYSTIO; Annulling the decision of the Commercial Court at the Central Jakarta District Court Number 03/Pdt.Sus.Merek/2014/PN. Niaga.JKT.PST dated May 22, 2014.

RetrialIng In the convention :

In the exegesis: rejecting all the exceptions filed by the Defendant and the Co-Defendant; In the subject matter of the case: dismissing the entire claim of the plaintiff;

In the reconvening:

- 1) Grant the Reconvening suit in part;
- 2) Declaring the Reconvening Defendants: Phiko Leo Putra as the owner of the unregistered LAU'S KOPITIAM brand;
- 3) Stating that the LAU'S KOPITIAM brand belonging to the Reconvening Defendant: Phiko Leo Putra, has similarities in essence with the KOPITIAM brand (IDM000030899; IDM000302964; IDM000305714; and IDM00035307) on behalf of the Reconvening Plaintiff, for the type of service in class 43;
- 4) Declaring the Reconvening Defendants: Phiko Leo Putra has committed an unlawful act by using without rights the unregistered LAU'S KOPITIAM brand and having similarities in essence with the KOPITIAM brand (IDM000030899; IDM000302964; IDM000305714; and IDM00035307) belonging to the Reconvening Plaintiff ;
- 5) Punishing the Reconvening Defendant to stop all his business activities from opening and running a business in all outlets / cafes / restaurants owned by the Reconvening Defendants using the LAU'S KOPITIAM brand throughout Indonesia;
- 6) Reject the Reconvening suit other than and the rest; Punishing the Review Respondent/Defendant to pay the costs of the case in all levels of trial and judicial examination, which in the review examination is set at Rp10,000,000.00 (ten million Rupiah).

4. ANALYSIS

a. Brand Application in Indonesia

Under UUMIG 2016, the right to a mark is an exclusive right granted by the state to the owner of a registered mark for a certain period of time by self-using the mark or granting permission to another party to use it. In essence, a brand is used by the manufacturer or brand owner to protect its products in the form of services or other trade goods. So a brand has the following functions:²²

- 1) The distinguishing function is to distinguish one company's products from the products of another company

- 2) The function of reputation guarantee is that in addition to being a sign of the origin of the product, it also personally connects the reputation of the branded product with the manufacturer, as well as providing quality assurance of the product.
- 3) The promotional function is that the brand is also used as a means of introducing new products and maintaining the reputation of the old products being traded, as well as to dominate the market.
- 4) The function of stimulating investment and industrial growth, namely brands, can support industrial growth through both foreign and domestic investment in the face of free market mechanisms.

The right to a mark is an exclusive right granted by the State to the owner of the brand for a period of 10 years by using its own mark or licensing to another party. In principle, brands are divided into trademarks, service marks, and collective brands.²³

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Brands can be divided into several types:²⁵

1. Trademarks,
2. Service marks, and
3. Collective brands.

A trademark is a mark used on goods traded by holders or several persons jointly or legal entities to distinguish from other similar goods. In the terminology of the Trademarks and Geographical Indications Law number 20 of 2016 (hereinafter abbreviated as UUMIG), a Trademark is a Mark used on goods traded by a person or several people together or a legal entity to distinguish it from other similar goods. In UUMIG terminology, a Service Mark is a Mark used on services traded by a person or several persons together or a legal entity to distinguish from other similar services.²⁶

A collective mark is a brand used on goods and/or with similar characteristics that are traded by several persons or legal entities together to distinguish from other similar goods and/or services. In UUMIG terminology, a Collective Mark is a Mark used in goods and/or services with the same characteristics regarding the nature, general characteristics, and quality of goods or services and their supervision that will be traded by several persons or legal entities together to distinguish from other similar goods and/or services.²⁶

The UUMIG lists 'geographical indications' as the title of the Act, not just in parts of the Act as it was before, it needs to be understood under the UUMIG; Geographical Indication is a sign that indicates the area of origin of an item and/or product that due to geographical environmental factors including natural factors, human factors or a combination of these two factors gives reputation, quality, and certain characteristics to the goods and/or products produced. The right to a Geographical Indication is an exclusive right granted by the state to the registered holder of the Geographical Indication right, so long as the reputation, quality,

and characteristics on which it is granted protection for such Geographical Indication still exists.²⁷

Previously in UUM 2001 it was also regulated regarding geographical indications and indications of origin. Geographical indications are protected as a sign indicating the area of origin of an item based on geographical environmental factors including natural factors, human factors, or a combination of these two things, providing certain characteristics and qualities to the goods produced. So reputation, quality and specific characteristics are generated by the presence of geographical factors. Indications of origin are protected by law but without going through registration.²⁸

b. Application of Doctrine Of Foreign Equivalents

1) The Concept and Application of the Doctrine Of Foreign Equivalents in the United States

The Doctrine of Foreign Equivalents is a trademark doctrine consisting of foreign words or words translated into English that are carried out prior to registration or analysis of trademark protection. After obtaining a translation from the court, a Mark consisting of foreign words may be denied registration or protection, if the mark is considered generic, descriptive, or misrepresents the identity of the goods or services. In addition, registration of a Mark may be denied, either a person or entity may be deemed to have committed a Trademark infringement, if the use of a foreign word and an English word, or two foreign words, is considered similar and confusing.

Although words from modern languages are generally translated into English, the Doctrine Of Foreign Equivalents is not an absolute rule, but is just a guideline. The Doctrine Of Foreign Equivalents does not apply to any foreign words appearing in trademarks or service marks. The Doctrine Of Foreign Equivalents is just a guideline. Thus, courts of different jurisdictions in the U.S. and the U.S. Trademark Trial and Appeal Board (TTAB), often render conflicting decisions when deciding cases that apply the doctrine.

One of the difficult factors is that the act of translation itself, is an imprecise task, since foreign words sometimes do not have the proper equivalent in English. Therefore, courts are permitted to rely on major and general translations in determining english equality.²⁹

A further difficulty is that there is little agreement among the courts as to what the doctrine actually dictates, and there is disagreement as to when and how it should be applied.

It should be emphasized that due to the inaccuracy of the English translation and because there is ambiguity in applying the Doctrine Of Foreign Equivalents, so there is an important need for reliable standards that can be followed by the applicant for Trademarks and Service Marks, as well as the courts, when applying such doctrines.

The only thing that the owner of the Mark can rely on, and the only thing that the courts tend to agree on, is that the examination used to analyze a foreign language brand must be based on its use accepted in the country of the user of that language.³⁰ Usually, the Doctrine of Foreign

Equivalents is only applied to situations with the assumption that the consumer public who see/hear a foreign Mark then attempt to translate it. They then discovered that the literal meaning was indeed similar (to the term in the local language), but it was still confusing, because it contained a different meaning, so they decided to stop buying products/services with the brand.

Faced with such a situation, then under the Doctrine of Foreign Equivalents, The Trademark Trial and Appeal Board (TTAB), the United States Patent and Trademark Office (USPTO) chose to translate or seek the equivalent equivalent of that foreign Mark first, and then compare it with other Marks, before accepting the application for registration.³¹

Here are some examples of cases, where The Trademark Trial and Appeal Board (TTAB) implemented the Doctrine of Foreign Equivalents. Cases, 218 USPQ 284 that TTAB handled in 1983. In this case, Hub Distrib., Inc. holds the rights to the EL SOL brand for apparel and footwear, and SUN and Design for footwear. TTAB implemented Doctrine of Foreign Equivalents because it was likely that the two brands were causing confusion among the consumer community. Then, case 2 USPQ2d 1459 which TTAB handled in 1987. In those cases, said Safety Razor Co., holds the rights to the BUENOS DIAS Brand for soap, and the GOOD MORNING and Design brand for furless shaving cream. TTAB implemented Doctrine of Foreign Equivalents because it was likely that both brands were causing confusion among the consumer community.

Another example is the case of 230 USPQ 702 which TTAB handled in 1986. It states that Ithaca Indus., Inc., holds the rights to the LUPO Brand for men's and boys' underwear, and WOLF and Design for various clothing items, tends to cause confusion, since, among other things, "LUPO" is clearly equivalent to the English word "wolf" (wolf).

The next example is the case of 79 USPQ2d 1021 which TTAB handled in 2006. In those cases it was mentioned Thomas owned the rights to the 'MARCHE NOIR' Brand for jewelry, and the BLACK MARKET MINERALS brand for retail jewelry services and mineral stores, likely causing confusion. The lawyers examining the aforementioned cases, applied Doctrine Of Foreign Equivalents to ensure that the foreign language Brand did contain a meaning that was relevant (understandable to) the local consumer community. However, the application of Doctrine of Foreign Equivalents should be based on robust analysis and evidence such as the understanding/explanations contained in the Dictionary, the Internet, and Lexis Nexis, a provider that provides computer-based legal-research applications.

One of the main purposes of TTAB implementing Doctrine of Foreign Equivalents is to address the discovery of confusion, especially before TTAB, when the company that owns the Trademark rights argued that two brands that had the same meaning when translated, consumers would not be likely to be involved in the translation. An example is the case of La Peregrina. At that time the petitioner sought to argue that consumers would not be able to translate La Peregrina into the English equivalent of "The Pilgrim", and instead they would soon think of another term that was also well known.

However, the TTAB found that not enough evidence was presented to show that the majority of the relevant public (bilingual Americans, or Americans with knowledge of Spanish) would not translate the term. Since there was not enough evidence to show that the consumer would not translate the term, the TTAB concluded that "the consumer of the petitioner's goods would translate 'La Peregrina' as 'The Pilgrim'."

In Case no. 6 of USPQ2d 1316 in 1987, the TTAB did not apply Doctrine of Foreign Equivalents when the petitioner showed evidence that the English translation was not literal and direct. After comparing the Spanish-language trademark "PALOMA" (which in English is "ME" (pigeon) with the English-language trademark language, "DOVE", the USPTO did not apply Doctrine Of Foreign Equivalents given that the Spanish-language trademark "PALOMA" does not constitute a direct translation of "DOVE".

The application of Doctrine of Foreign Equivalents is also associated with confusion over brands derived from two non-English words. An example is case no. 49 of USPQ2d 2018. In the case involving Miguel Torres SA v. Casa Vinicola Gerardo Cesari SRL, the TTAB stipulates that the doctrine must be applied, since the relevant consumer society does not need to be fluent in either language "to be ready to understand the connotations "of the two signs in question: DUE TORRI (Italian for "Two Towers") and TRES TORRES (Spanish for "three towers"). In applying the doctrine, TTAB suggests that consumers who are aware of TRES TORRES wine and brandy may be confused by the use of DUE TORRI for wine products as well.

But TTAB does not always apply the doctrine when dealing with two brands in a foreign language, not English. For example, at Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd., TTAB refused to apply the Doctrine and translate the French BEL AIR and the Italian Bell ARIA. According to TTAB, Doctrine of Foreign Equivalents does not need to be applied when words in those brands "have more than one recognized meaning."

Mulholand argues that as national boundaries weaken, especially in the era of cyberspace, Doctrine of Foreign Equivalents plays an even more important role. The purpose of this legal principle is to protect consumers from confusion or misperceptions when dealing with a brand in commerce.³²

2) Not Applicable to Brand Names

For example, the brand is a Spanish personal name, RICARDO. The TTAB acknowledges that RICARDO is the Spanish equivalent of the English name RICHARD and that Doctrine Of Foreign Equivalents is routinely applied to Spanish-language signs. However, in general Doctrine Of Foreign Equivalents should not be applied to first names such as RICHARD and RICARDO which are widely recognized by American consumers, unless there is evidence that consumers will 'translate' the names. However, so far the TTAB has found no such evidence.

The TTAB reasoned that, even if some people used their English name in some circumstances and by the Spanish version in other contexts, the owner of the personal name mark would not be possible to do so, nor would the consumer "stop and translate" the common personal name

sign. TTAB further emphasizes that the purpose of a trademark is to indicate the source of the goods and/or services and to distinguish such goods and/or services from others. Therefore, TTAB argues that "generally consumers will not 'stop and translate' personal name tags, because doing so will not only show different people or people (whether real or fictional), but also to different sources, and until the sign of loss of 'instant recognition'".

In summary, the TTAB states that, in cases involving "two first names that would be recognized as ordinary American consumers - it is unlikely that an American buyer would translate a foreign brand, but would instead accept it as it is".³³

3) Doctrine Of Foreign Equivalents Outside the United States

The application of Doctrine Of Foreign Equivalents outside the US, can be seen from data from the International Association for Intellectual Property Protection (AIPPI) which conducted a survey on the status of Doctrine Of Foreign Equivalents in various countries. Survey responses from forty states show that the majority recognizes a form of doctrine, but few have applied the doctrine in actual case law.³⁴

Doctrine Of Foreign Equivalents, perhaps because it is difficult to apply in IPR, so that only one field of IPR applies it, as a result of which it is not consistent enough. In part, these inconsistencies are driven by national traditions. Some countries, including Japan and the United Kingdom, have traditionally interpreted claims very literally, and to date have no doctrines analogous to the U.S. equivalent doctrine. In contrast, other countries, including Germany, interpret claims broadly and include doctrines similar to the doctrine of equivalents. The U.S. into their approach to determining literal violations.

Even among countries that recognize Doctrine Of Foreign Equivalents, tests to determine non-literal violations are not identical. Interestingly, the AIPP notes that among the E.U. countries that are supposed to have identical laws under the European Patent Convention, there are many differences in the interpretation of patent claims.

With the exception of the TRIPS treaty, countries interested in harmonization have not made international patent treaties affecting substantive rules. Attempts to negotiate a Patent Harmonization Agreement failed in 1995. The recently concluded Patent Agreement mainly affects procedural (filing) issues. Further, the efforts behind the so-called substantial Legal Agreements may be fruitless.

Interestingly, despite failed attempts to harmonize Doctrine Of Foreign Equivalents, countries are increasingly 'united' in dealing with substantive patent law. There is a significant convergence between the US, the European Union, and Japan in the interpretation of claims and the application of Doctrine Of Foreign Equivalents. Although Japan generally did not implement Doctrine Of Foreign Equivalents for a decade ago, it now adheres to Doctrine Of Foreign Equivalents and moves in harmony with the US. Similarly, the European Union uses the concept of Doctrine Of Foreign Equivalents written into the Revised European Patent Convention, to determine infringement. The Europe-Asia regional treaty also calls for equal use in determining patent infringement.

Indeed, many countries are trying to follow in the footsteps of other countries in developing IP laws, including brand law. For example, the European Union adopted the European Patent Convention (EPC) which establishes the general rules of patent interpretation. Despite having different views on the scope of intellectual property law, EU members refer to cross-border decisions to achieve an interpretation generally an interpretation of IP law. Despite some uncertainty over whether Doctrine Of Foreign Equivalents is allowed under the EPC, a million EU countries have defined Doctrine Of Foreign Equivalents and tried to implement it. Instead, Japan is hesitant to codify Doctrine Of Foreign Equivalents because it feels it does not fully understand the use and application of Doctrine Of Foreign Equivalents both in the US and in the European Union. Accordingly, Japan allows Doctrine Of Foreign Equivalents to be developed on the basis of each legal case. Although legal protections for non-literal offences can be said to differ in different countries, there is clearly already widespread recognition of the general principles underlying Doctrine Of Foreign Equivalents. In the Asian region, Doctrine Of Foreign Equivalents responds differently. Singapore for example refused to impose Doctrine Of Foreign Equivalents.³⁵ While Japan initially tried to implement according to its own understanding, but the rear moved in harmony with the US. Meanwhile, the Philippines and India enacted it referring to Doctrine Of Foreign Equivalents as implemented in the US.

The legal basis for the application of Doctrine Of Foreign Equivalents in the Philippines is contained in Section 75.2 of Intellectual Property Code No.8293 effective from January 1, 1978. However, in deciding actions for patent annulment and infringement, the Philippine Intellectual Property Office (IPOPHL) as well as the Supreme Court are heavily referring to the intellectual property laws in force in the US. The most recent patent infringement case of Eddie T Dionisio v Visita International Phils, Inc. and Lal K Tulsiani (IPV No 10-2013- 00034, July 28, 2016) cites the cancellation case also between the parties indicating this.³⁶

The Indian Court of Justice, since 1997, has borrowed the principles of Doctrine Of Foreign Equivalents whenever dealing with the issue of registration and trademark infringement relating to foreign language marks.

A study revealed, in the past the Trade Marks Registry (TMR) of India accepted many foreign words which are common terms in their native language. However, in recent times India has more often implemented Doctrine Of Foreign Equivalents and translated foreign words into their English equivalents. If it is found that the applicant for the trademark registrant does not meet the criteria as provided for by Sections 9 (1) (a) and (b) of the Trademark Act, 1999, TMR India will refuse to register a mark using foreign words.

In 1997 for example, a brand dispute arose between Aktiebolaget Volvo of Sweden vs. Volvo Steels Ltd. of Gujarat (India). In this regard, the Hon'ble Bombay High Court has discussed the Doctrine of Foreign Equivalents and its application in the following terms. The dispute in this case relates to the use of the VOLVO trademark by the defendant (Volvo Steels Ltd, Gujarat). One of the defendants' opinions in favor of the adoption of the mark was that the word 'Volvo' was not a word invented by the plaintiff and it became a Latin word meaning, 'roll back', 'roll',

'to unite' and 'shape by rolling' and as the defendant's products would eventually be used to roll the word 'Volvo' was chosen by the defendants as part of their company name.

However, in 2014, in a brand dispute between C Kamani Oil Industries Pvt. Ltd. vs Bhuwaneshwar Refineries Pvt. Ltd, the Bombay High Court did not apply the Doctrine Of Foreign Equivalents. When deciding the case, the Bombay court was of the view that signs borrowed from foreign languages and commonly used in India could be kept descriptively in India but not vice versa. Foreign words in signs (brands) that are not commonly used in India or where people who buy products with the mark are unlikely to know the meaning of the foreign word, the sign cannot be said to be descriptive.

The application of the Doctrine of Foreign Equivalents in the case of brands in Indonesia, it must be seen first how before applying the Doctrine Of Foreign Equivalents. Before applying the doctrine of foreign equivalents, it should be pointed out that the foreign language is one that is familiar to a fairly large segment of consumers who tend to purchase certain goods or services, and its translation should be one that a large number of them potential buyers may make. This should not be considered one way or another, by the courts. Instead, courts and other reviewing entities should use competent sources to investigate the familiarity of potential buyers with the language as well as possible translations. Competent sources may include: dictionary definitions, research databases, newspapers, and other publications, expert witness testimony in the field of among others: others, language, society and culture, survey evidence of potential buyers, market research, consumer reaction studies, and other useful and relevant evidentiary methods.³⁷

This doctrine should only be applied when a large enough number of buyers of certain goods or services in the country, who speak English as well as the foreign language in question, will understand the meaning of the foreign word mark in question, and will actually translate the sign into its English equivalent. Defining "buyer" should not be an abstract concept, but should be defined only to refer to the actual or prospective class or classes of the buyer over a particular item of the applicant or service. Whether this buyer will understand and truly translate the sign should not be considered, one way or another. Instead, courts and review agencies should require a demonstration of the buyer's understanding and actual translation with reference to competent sources.

Furthermore, before applying the doctrine, it should be pointed out that the translation is one that a significant number of potential buyers may make for the product- the product is a good or service. In other words, it is very likely that the consumer in question will stop and translate the word into English equivalent. After this analytical evaluation is completed by utilizing and relying on competent sources, if it is proved likely that the buyer of a particular good or service will understand and then stop and actually translate foreign word signs, the doctrine of foreign equivalents should be applied.

However, if it is found that the sign is a sign that is impossible for the relevant consumer to understand or translate who speaks English and the associated foreign language, the doctrine should not apply. For example, if it can be shown that a consumer of a particular good or service

will take the mark "as is," the doctrine of foreign equivalents should not be applied and the mark should not be translated into English.

In the Supreme Court Decision Number 118 PK/Pdt.Sus-HKI/2014, in Indonesia, "KOPITIAM" as an ethnic coffee shop typical of Hainan immigrants, China also developed in the 19th century as can be found in North Sumatra and West Kalimantan. This is also as stated by Samsudin Berlian, Observer of the Meaning of the Word as contained in his article published on page 15 of the Kompas newspaper on March 9, 2012 entitled "Kopitiam": "Kopitiam began to develop in the late 19th century as an ethnic coffee shop typical of Chinese immigrants in Singapore, Malaysia, Northern Sumatra, and West Kalimantan." "In Southeast Asia, including Indonesia, kopitiam in the last two generations has begun to be more prestigious and develop modern concepts, more standardized services, multientical and multicultural menus and customers, as well as covering women and foreigners."

The word "Kopitiam" is a descriptive word that has developed and is commonly used as part of the language that lives in Indonesia. "KOPITIAM" is a descriptive word consisting of a combination of 2 (two) languages, namely Malay and ethnic Chinese - hokkien, which means "coffee shop". It is recognized as part of both the official language and the language that lives in a country, as a result of the migration of ethnic Chinese to Southeast Asia.

As stated by Leo Suryadinata in his book entitled "The State and Ethnicity of Chinese. The Case of Indonesia", First printing, Pustaka LP3ES Indonesia, November 2002, page 7: "Ethnic Chinese, who used to be often called Chinese Overseas or overseas Chinese, are scattered everywhere. It numbers approximately 23 million people, more than 80 percent of whom are in Southeast Asia."

The word "KOPITIAM" in Malaysia has been recognized as an official language. This can be proven by the presence of the word "KOPITIAM" in the 4th Edition of the Council Dictionary published by the Malaysian Language and Library Council. The word "KOPITIAM" in Singapore is not a word derived from an official language, because it is not contained in the official dictionary of the State of Singapore. However, the word "KOPITIAM" has been recognized as part of the language that lives in the State of Singapore. This can be seen from the consideration of the Intellectual Property Office of Singapore (hereinafter referred to as the "IP Office Singapore") in its decision on the case between Pacific Rim Industries Inc. against Valention Globe B.V. (2008) SGIPOS 6 (hereinafter referred to as the "KOPITIAM Case"), as can be obtained from the official website of ip office Singapore. Ethnic Chinese culture (including language) also influences the intermingling of ethnic Chinese culture in Indonesia. When compared to Malaysia and Singapore, which have recognized the word "KOPITIAM" as both a living language and an official language, Indonesia has a larger ethnic Chinese population than the two countries.

If you look at the development of the existence of ethnic Chinese in Indonesia, it has been enough to prove that the word "KOPITIAM" which comes from the mixing of Malay and ethnic Chinese languages has become part of the language that lives in Indonesia; That in addition, the use of another foreign language, namely English, is recognized as a language living in

Indonesia, although the foreign culture of the English-speaking country is not manifestly recognized by the Indonesian nation. An example is the word "Espresso". The foreign language was previously not widely known by the Indonesian people, but now it has become a commonly used word in languages that live in Indonesian society at large. The real evidence of the recognition of the word "Espresso" as part of the language that lives in Indonesia is the Supreme Court Decision Number 023 K / N / HaKI / 2005 dated January 23, 2006 as will be described in more detail in argument number 37 below, where the Panel of Judges held that the word "Espresso" cannot be monopolized by certain parties, because the word "Espresso" means "Sari Kopi" or "Kopi Pekat".

Based on the description above, it can be concluded that "KOPITIAM" is a brand that has become public property or is a generic name because it is commonly used in trade and is part of the language that lives in Indonesia, so it should not be monopolized by any party. Because the word "KOPITIAM" is a word that has become a public property or generic name, the word no longer has the uniqueness or distinguishing power that is included in the brand qualification as referred to in Article 1 paragraph (1) of the Trademark Law, namely: "a sign in the form of an image, name, word, letters, numbers, color arrangement, or a combination of these elements that have differentiating power and are used in trade activities for goods or services".

The "KOPITIAM" mark belonging to the Defendant is a mark that cannot be registered because it is in the form of information or related to the services registered as referred to in Article 5 letter (d) mentioned above. That the provisions of Article 5 letter (d) are also regulated in Article 6 quinquies B paragraph 2 of the Paris Convention as quoted in postulate number 15 above, which in essence states that a mark that cannot be registered is a mark indicating the type, quality, quantity, intended intent, value, and place of origin of the goods. The Trademark Law explains the application of what is meant by 'information or relating to the goods or services for which registration is requested' as stated in the explanation of Article 5 letter (d) of the Trademark Law, namely: "The mark is related to or only mentions the goods or services for which registration is requested, for example a Coffee Brand or a picture of coffee for a type of coffee goods or for a type of coffee product."

According to the legal doctrine of Suyud Margono in his book entitled "Industrial Property Rights-Regulation and Practice in Indonesia", Ghalia Indonesia, First Printing, Bogor, July 2011 page 72, states that: "To find out whether a word to be used as a brand, is the type name of the goods concerned or not, a dictionary can be used as a guide. If the word is contained in a dictionary with a sense that indicates the goods themselves or that are closely related to the goods, then the word cannot function as a brand of the goods in question because it does not have the distinguishing power to distinguish the origin or source of similar goods of different origins. For example: "sugar" can not be a brand of granulated sugar or confectionery." The word "KOPITIAM" is contained in the Council Dictionary Edition 4, which is interpreted as "coffee shop".

The defendant's "KOPITIAM" brand registered with registration number IDM000305714 in class 43 with a description of services in providing food and beverages, restaurant restore an,

canteen services, café, coffee shop, food-court, catering, temporal temporary accommodation, hotels, temporary lodging rentals, groups of brokerage agencies / marketing agencies for lodging accommodation, marketing of hotel rooms. Furthermore, in terms of the food menu that is usually provided at kopitiam (coffee shop) which has been mixed with customary objections, kopitiam usually provides a breakfast menu consisting of coffee with toast given sarikaya jam, and half-cooked eggs with soy sauce. The menu offered by the Defendant under the trademark "KOPITIAM" is essentially the same, which is to provide coffee with toast with sarikaya jam and half-cooked eggs.

After the decision of the Commercial Court at the Central Jakarta District Court which has permanent legal force was pronounced with the presence of the Plaintiff, Defendant and Co-Defendant on May 22, 2014, against the judgment, by the Defendant with the intercession of his attorney based on a Special Power of Attorney dated July 2, 2014, an application for judicial review was filed at the Registrar of the Commercial Court at the Central Jakarta District Court on July 4, 2014 as it turned out. from the Deed of Application for Review Number 07 PK/Pdt.Sus- HAKI/2014/PN. Commerce.Jkt.Pst jo. Number: 03/Rev.Sus-Brand/2014/ PN. Niaga.Jkt.Pst., the application was followed by his reasons which were accepted at the Registrar of the Commercial Court at the Central Jakarta District Court on July 4, 2014.

The memory of the appeal from the Defendant was notified to the Plaintiff on July 25, 2014, then the Review Respondent/Plaintiff submitted an answer to the memory of the review received at the Registrar of the Commercial Court at the Central Jakarta District Court on August 20, 2014. Because in (Law Number 15 of 2001 concerning Trademarks is not regulated regarding judicial review, the Supreme Court refers to the provisions of Articles 68, 69, 71, and 72 of Law Number 14 of 1985 concerning the Supreme Court as amended by Law Number 5 of 2004 and the second amendment to Law Number 3 of 2009.

The application for a quo review examination and its reasons have been carefully notified to the opposing party, filed within the grace period and in the manner prescribed in the statute, therefore the application for such review examination is formally acceptable. The Review Petitioner has filed the following grounds of review: In the Convention, that the Petitioner PK (formerly the Reconvening Plaintiff) is essentially in line with the consideration of the Panel of Judges in Judgment No. 03/ Rev.Sus.Brand/2014/PN. Niaga.Jkt.Pst, dated May 22, 2014, and has no objection to the content of the considerations or judgments in the section of the CONVENTION.

In the Reconvening stated that the Commercial Magistrate's Panel Had Erred In Consideration Of Judgment No. 03/ Rev.Sus.Brand/2014/PN. Niaga.JKT.PST, dated May 22, 2014, Specifically Stating That The Brand "Lau's Kopitiam" belonging to Respondent PK (formerly The Reconvening Defendant) Has Significant Differences with the KOPITIAM Brand belonging to the Pk Petitioner (formerly the Reconvening Plaintiff). This is found on page 91, 3rd and 4th paragraphs, the Panel of Judges in the Commercial Court gave the following consideration: "Considering, that as in Evidence P.1 that the mark registered by the Defendants In The Reconvening is "Lau's Kopitiam" with the letter "L" Large and the other large "K" is

lowercase, while the one written in the numbers 3 (three) Petition of the Plaintiff's Suit In Reconvening is "KOPITIAM" with all uppercase letters.

Thus there is a difference in the letters on the marks registered by the Defendants In The Reconvening with those written by the Plaintiffs In The Reconvening at number 3 (three) Petitions of the Plaintiff's Suit In The Reconvening, then according to the Tribunal there is a significant difference, considering that as stipulated in Article 1 (one) number 1 (one) of Law No. 15 of 2001 concerning Trademarks.

In the consideration of the Panel of Judges in the Commercial Court, it is clearly a real error because by stating that the "Lau's Kopitiam" brand belonging to the Respondent PK (formerly the Reconvened Defendant) has a significant difference with the "KOPITIAM" brand belonging to the Applicant PK (formerly the Reconvening Plaintiff) due to the difference in uppercase letters (capital letters) and lowercase letters, then in fact the Panel of Judges in the Commercial Court has violated the provisions of Article 6 of Law No. 15 of 2001 about Brands. Explanation of Article 6 paragraph (1) letter a of Law No. 15 Year 2001 About Brand states: : "What is meant by similarity is basically a similarity caused by the existence of prominent elements between one Brand and another Brand, which can give the impression of similarities both regarding the form, way of placement, way of writing or combination of elements or similarity of speech sounds contained in these brands". It is very clear that the mark being registered by Respondent PK (formerly the Reconvening Defendant) is "Lau's Kopitiam" where the prominent element in the mark is in the word "Kopitiam", clearly having similarities in speech with the registered mark belonging to the Petitioner PK (formerly the Reconvening Plaintiff) i.e. "KOPITIAM" (IDM00003089; IDM000302964; IDM000305714; and IDM00035307), as intended in the explanation of Article 6 Paragraph (1) Number A of Law No. 15 of 2001.

The consideration of the Panel of Judges at the Commercial Court is very wrong and not at all based on the law, because there is not a single jurisprudence of brand cases in Indonesia that decides that the difference in writing between capital letters (uppercase) and lowercase letters is a significant brand difference. Even on the contrary continuously or continuously, the Supreme Court of the Republic of Indonesia provides enforcement of brand law to eradicate brand imitators who deliberately and in bad faith try to register a mark that has similarities with other people's previously registered brands. If the consideration of the Panel of Judges of the Commercial Court is followed, then obviously everyone can arbitrarily register the marks, which have been previously registered (for example: the "AQUA" brand or the "Indomie" brand or the "Bank BCA" brand or the "KFC" brand or the "STARBUCKS COFFEE" brand or the "PRADA" brand) as long as it uses a different letter, for example "aqua" or the "INDOMIE" or "Bank bca" brand or the "kFc" brand or the "starBucks Coffee" brand or the "praDa" brand).

The Panel of Judges of the Commercial Court has also erred or committed a real oversight because the difference between capital letters (uppercase) and lowercase letters, is not a significant difference, because even if the shape between capital letters and lowercase letters

may not be the same, but both capital letters and lowercase letters will be sounded or pronounced in the same way. In the Explanation of Article 6 paragraph (1) number a of Law No. 1 of 2001, one form of equation is basically explained as "the equation of speech sounds contained in these brands". In other words, to determine whether or not there is an equation in essence, it does not depend on whether the brands use uppercase (capital letters) or lowercase letters, as long as the sound of the speech is the same, then the brands have similarities in essence. Thus, it has been proved that there was a very real error made by the Panel of Judges of the Commercial Court, so it is very reasonable that the Supreme Court of Justices overturned the judgment and granted the reconvening suit of the Petitioner PK (formerly the Reconvening Plaintiff) in its entirety. From this description, the meaning of the word "KOPITIAM" which means a coffee shop or coffee shop or coffee shop describes the services that have been registered in the application for registration and are also related to selling food menus that are usually provided by kopitiam or other coffee shops so that this violates the provisions of Article 5 letter (d) The Trademark Law, which explains or relates to the services for which registration is requested. In the author's view, indirectly the Panel of Judges has applied the Doctrine of Foreign Equivalents to the Brand case in Indonesia, as in its decision the Panel of Judges Granted the application for review from the Review Petitioner: Abdul Alek Soelystio.

4. CONCLUSION

The Doctrine of Foreign Equivalents itself is a doctrine of a mark consisting of one or more words consisting of foreign words translated into English which is carried out before registration or analysis of trademark protection. After obtaining a translation from the court, a Mark consisting of foreign words may be denied registration or protection, if the mark is considered generic, descriptive, or misrepresents the identity of the goods or services. In addition, registration of a Mark may be denied, either a person or entity may be deemed to have committed a Trademark infringement, if the use of a foreign word and an English word, or two foreign words, is considered similar and confusing.

The Panel of Judges on commercial appellants in the case of "Lau Kopitiam" against "KOPITIAM" in this case is considered to be *khilaf* because it gives considerations contrary to its own considerations in the section of the CONVENTION, particularly IN THE EXEGESIS, namely regarding the exception filed by the PK Petitioner (formerly the Reconvening Plaintiff), where the PK Petitioner (formerly the Reconvening Plaintiff) stated that the Respondent PK (formerly the Reconvening Defendant) had no legal standing or was not a party to which interested based on the provisions of Article 68 paragraphs (1) and (2) of Law No. 15 of 2001.

The meaning of the word "KOPITIAM" which means a coffee shop or coffee shop or coffee shop describes the services that have been registered in their registration application and are also related to selling food menus that are usually provided by kopitiam or other coffee shops so that it violates the provisions of Article 5 letter (d) of the Trademark Law, namely explaining or relating to the services requested for registration. According to the author's view, indirectly the Panel of Judges has applied the Doctrine of Foreign Equivalents to brand cases in Indonesia, even though the Doctrine of Foreign Equivalents itself does not have its own special regulations

in Indonesia. The author in this case is of the view that the Doctrine of Foreign Equivalents needs to be immediately added to the laws and regulations regarding brands in Indonesia. If the doctrine is not clearly included and stated in the trademark law in the future, then legal certainty for owners of foreign-language marks registered in Indonesia will still not be guaranteed legal certainty.

5. SUGGESTION

Indonesia in this case has not included or added the Doctrine of Foreign Equivalents to the laws and regulations regarding brands in Indonesia, this can certainly cause legal uncertainty if it is related to brand dispute cases in Indonesia in the future, therefore the author feels that in this case Indonesia can follow the example of countries that have adapted the Doctrine of Foreign Equivalents as one example is the United States. Because also in the United States when discussing the Doctrine Of Foreign Equivalents also gives an ambiguous nature due to the inaccuracy between the English translation and also the words to be used in the use of the mark, then under the Doctrine Of Foreign Equivalents, The Trademark Trial and Appeal Board (TTAB), the United States Patent and Trademark Office (USPTO) chose to translate or search for the equivalent equivalent of the foreign Mark first, and then compare it with other Marks, before accepting the application for registration.

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