

Japan Patent Office (JPO) Commissioned Survey

**Survey on the Appeal, Opposition, and  
Invalidation Procedures Related to Patents,  
Designs, and Trademarks in Indonesia**

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## **1. Introduction**

### **1.1 Objective of the Survey**

The Indonesian intellectual property (IP) system provides procedures to re-examine the validity of patents, designs, and trademarks, or final refusals in examination. However, users may lack basic knowledge of the legal and cost effectiveness of each scheme, which may lead to sub-optimal rights securement and enforcement.

Thus, the objective of this survey is to clarify the appeal, opposition, revocation, and invalidation procedures related to patents, designs, and trademarks in Indonesia order to support IP activity there.

### **1.2 Survey items**

#### **1.1.1. Research Items on Laws and Regulations (Desktop Survey)**

- 1) Subject (i.e., appeal, opposition, cancellation and invalidation)
- 2) Requirements for parties
- 3) Time limits to take actions
- 4) Scope of filings
- 5) Reasons for filings
- 6) Possibility of amendments to filings
- 7) Mode of hearings (oral or written), interviews and the criteria of choosing different modes
- 8) Structure of the bodies making the judgement, independence and intermediate procedure
- 9) Average duration from a filing
- 10) Details on the contents of the final and non-final decisions
- 11) Amendments and corrections to the scope of IP (requirements, time limits)
- 12) Challenges to a judge, removal of judge, requirements, etc.
- 13) Appeals to decisions by IP Office, numbers of appeals, percentage of reversed cases, reason for such numbers
- 14) Effect of a decision and when it is finalized
- 15) Fees
- 16) Requirements to be an administrative judge
- 17) Flow chart of procedures
- 18) Publication of decisions, method of publication
- 19) Relation with lawsuit, the possibility of a two-track dispute with IP Office

### **1.1.2. Research Items with Interview (Survey with Interviews)**

The research items cover elaborations on the procedures concerning appeal, opposition, cancellation and invalidation proceedings in Indonesia, including the practices and common strategy.

### **1.3 Survey Targets**

The survey covers analysis and elaboration of the appeal, opposition, invalidation and cancellation actions, including the process and requirements, based on the following laws and regulations:

1. Law No. 20 of 2016 on Trademarks and Geographical Indications ("Trademark Law")
2. Law No. 13 of 2016 on Patents ("Patent Law")
3. Law No. 31 of 2000 on Industrial Designs ("Industrial Design Law")
4. Law No. 49 of 2009 on the second amendment to Law No. 2 of 1986 on General Judiciary ("Law No. 49 of 2009")
5. Government Regulation No. 90 of 2019 on Procedures for Application, Examinations and Settlement of Appeal at the Mark Appeal Commission ("Regulation 90 of 2019")
6. Government Regulation No. 40 of 2005 on Organizational Structure, Duty and Functions of the Patent Appeal Commission ("Regulation 40 of 2005")
7. Ministry of Law and Human Rights ("MOLHR") Regulation No. 67 of 2016 on Trademark Registration Procedures ("Regulation 67 of 2016")
8. MOLHR Regulation No. 38 of 2018 on Patent Applications ("Regulation 38 of 2018")
9. MOLHR Regulation No. 3 of 2019 on Patent Appeal Commission ("Regulation 3 of 2019")
10. MOLHR Regulation No. 30 of 2019 on Procedures for The Granting of Compulsory Patent Licensing ("Regulation 30 of 2019")

### **1.4 Methods of Survey**

The survey was conducted by the following consultants:

Mr. Daru Lukiantono (Principal, Hadiputranto, Hadinoto & Partners)

Mr. Wiku Anindito (Associate Partner, Hadiputranto, Hadinoto & Partners)

In preparing the survey, the consultants carried out desk research and interviews with the relevant officials at the Directorate General of Intellectual Property ("IP Office") to gather relevant data and statistics for the relevant subjects of this Survey.

### **1.5 Results of Survey (Referred to Chapters Mentioned Later)**

We outline the survey results in Chapter 2 to Chapter 4 of this report, which consists of statistical number and elaboration on:

1.4.1 Appeal (Chapter [2])

1.4.2 Opposition (Chapter [3])

1.4.3 Cancellation and invalidation proceedings (Chapter [4])

## 2. Appeal Against Decision of Rejection

### 2.1 Statistics

#### 2.1.1. Numbers of Appeals (for Patent/Utilities Model, Industrial Design, TM, from 2014 to 2018)

	2014	2015	2016	2017	2018
Patent/Utility Model	8	12	17	16	25
Industrial Design right	N/A	N/A	N/A	N/A	N/A
Trademark right	83	243	298	274	316
<b>Total</b>	91	255	315	263	341

*Note: From our discussion with the relevant officials, we note that the Patent Office is still compiling information on patent cancellations for the period between 2014 and 2018. However, the information was not available at the time this report was prepared.*

#### 2.1.2. Average Required Time until the Decision is Rendered

##### Trademark

According to Article 30.(1) of the Trademark Law, the decision of the Mark Appeal Commission ("**MAC**") should be issued within three months from the filing date of the appeal. However, in practice, it may take longer.

##### Patent/ Utility Model

According to Article 70.(6) of the Patent Law, the decision of the Patent Appeal Commission ("**PAC**") should be issued by no later than nine months from the date when the examination of the appeal is commenced. However, in practice, it may take longer.

##### Industrial design

In practice, the timeframe of civil action at the Commercial Court would be ranging from three to four months. Under Article 39.(8) of the Industrial Design Law, the Commercial Court must render its decision within 90 days (although the panel of judges is entitled to extend the proceeding until 120 days, in practice).

#### 2.1.3. Number of Judgments Shown in the Table Below (from 2014-2018)

	2014	2015	2016	2017	2018
<b>Total</b>	N/A	N/A	N/A	N/A	N/A

*Note: The statistics are not publicly available with the IP Office.*

#### **2.1.4. Percentage of Acceptance (Reversed Cases)**

This scope of information is not publicly available.

#### **2.1.5. Percentage of Further Appeal Against the Appealed Decision**

This scope of information is not publicly available.

### **2.2 Procedures for Appeal Against Decision of Rejection**

#### **2.2.1 Procedures to Start the Appeal Process**

##### **Trademark**

If the Trademark Office ("**TMO**") decides to issue an official rejection to a trademark application, the TMO will issue a notification to the applicant or its proxy, informing the rejection and its reasons. Under Article 28 of the Trademark Law, the applicant would be able to file an appeal letter to the MAC in writing, comprising reasons as to why the TMO's rejection should be overruled by the MAC (e.g., the applicant's trademark is sufficiently distinctive from the cited trademarks if they both are viewed in whole from conceptual, pronunciation and visual perspectives). The appeal should be lodged within 90 days from the delivery date of the TMO's official rejection letter.

If the applicant does not file the appeal within the timeframe provided by the Trademark Law, the official rejection would become final and binding.

The appeal letter should be filed by the applicant by enclosing the following documents:

- Copy or photocopy of the rejection letter of the request;
- Proof of payment of official fee; and
- Power of Attorney (simply signed, without any notarization or legalization) if the appeal is lodged by the applicant's representative.

The applicant should pay the official fee of IDR 3 million per appeal request. The Trademark Law does not specifically outline whether the applicant is able to make any amendment to the appeal letter when the appeal examination is ongoing, hence it would be subject to the MAC's discretion to consider any amendment requested by the applicant.

The applicant would be able to withdraw the appeal as long as the MAC has not yet issued any decision to the appeal. In such case, the official fee paid to the MAC cannot be withdrawn.

##### **Patent/ Utility Model**

If a patent application is rejected, the Patent Office will notify the applicant, specifying the reasons for the rejection. The applicant may file an appeal to the PAC within the provided timeline set forth in the Patent Law. The Patent Law stipulates that an appeal can be filed in the following circumstances:

- If the Patent Office rejects the patent application (Article 68 of the Patent Law);

- If the applicant wishes to ask for correction of descriptions, claims and/or drawings after the patent has been granted by the Patent Office (Article 69 of the Patent Law); or
- The third party wishes to challenge the Patent Office's decision to grant a patent (Article 70 of the Patent Law).

For filing an appeal against the Patent Office's rejection, the applicant should submit the appeal (in writing) to the PAC within three months from delivery date of the Patent Office's notification letter to reject the patent application.

For filing an appeal to request correction of descriptions, claims and/or drawings, the applicant should submit the appeal (in writing) to the PAC within three months from the delivery date of the Patent Office's notification letter to grant a patent. The correction would be limited to seek (i) the limitation of claims coverage; (ii) correction for errors in translating the descriptions; and/or (iii) clarifications for the contents of descriptions that are unclear or vague.

As for challenging the Patent Office's decision in granting a patent in the name of a third party, the applicant should file the appeal (in writing) within nine months after the patent granted.

The applicant should also file the following documents to support the appeal filing:

- An appeal request (in writing);
- Any relevant evidence and information, describing the appeal reasons; that corroborate the reasons of filing an Appeal;
- Proof of payment of official fees;
- A copy of the descriptions, claims, and drawings approved by the Patent Office;
- A copy of the rejection letter issued by the Patent Office;
- A copy of the descriptions, claims, and drawings approved that were first proposed in the patent application;
- A copy of request letter for substantive examination at the Patent Office; and
- Power of Attorney (simply-signed, without any notarization or legalization) if the appeal is lodged by the applicant's representative.

The applicant should pay the official fee of IDR 3 million per appeal request. The Patent Law does not specifically outline whether the applicant is able to make any amendment to the appeal letter when the appeal examination is ongoing, hence it would be subject to the PAC's discretion to consider any amendment requested by the applicant.

### **Industrial Design**

If the Industrial Design Office rejects a design application, the applicant would only be able to challenge the rejection by filing a civil claim at the Commercial Court within three months from the date when the rejection letter is delivered to the applicant by the Industrial Design Office.

The applicant should also file the following documents to support the civil claim at the Commercial Court:

- A civil claim;
- Original Power of Attorney (notarized and legalized);
- Certified copy of Articles of Association/Deed of Establishment of Applicant (notarized and legalized); and
- Any relevant evidence to support the civil claim.

The plaintiff should pay the official fee of IDR 2.5 million per civil claim lodged to the Commercial Court.

## **2.2.2 Procedures for Appeal**

### **1) Trial System**

#### **Trademark**

Once the MAC receives the appeal letter from the applicant, the MAC will deliberate and review the appeal letter before issuing its decision. To examine the appeal letter, MAC will form a panel of judges which consist of three persons and one of them is a senior examiner.

The MAC decision is written and signed by the panel of judges that examined and judged the appeal application. The chief of MAC will deliver the appeal decision to the DGIP and to the party who filed the appeal within 30 days from the decision date.

If the MAC decide to reject the appeal, the appeal applicant might file a claim to the commercial court at the latest three months from the receipt date of the rejection notification.

#### **Patent/ Utility Model**

Once the PAC receives the appeal letter from the applicant, the PAC will deliberate and review the appeal letter before issuing its decision. The PAC will form an assembly comprising either three or five members and appoint one of them to lead the assembly. The PAC should review the appeal within one month after the appeal is submitted. During the appeal process, the PAC may for more additional evidence or information if necessary. The PAC should render a judgment within nine months at the latest.

Although Regulation 3 of 2019 stipulates that the appeal process is open for public, there is no guideline on how this appeal review can be observed by or accessible to the public, particularly as there is no public trial during the appeal process.

The PAC will carry out substantive examination within nine months for any appeal against the Patent Office's decision to either reject or grant a patent. Meanwhile, the PAC will carry out substantive examination within six months for the appeal to request correction on the descriptions, claims and/or drawings.



## **Industrial Design**

Please refer to Section 4.2.2 of this Survey for the flowchart of proceedings at the Commercial Court.

## **2) Requirement for Judges**

### **Trademark**

As regulated under Regulation 90 of 2019, the structure of the MAC is as follows:

- a chairperson who also serves as the member;
- a deputy chairperson who also serves as the member;
- trademark expert; and
- senior TMO's examiner who also serves as the member.

There are 30 people who serve as the MAC members. The maximum serving term for each member is three years. Each of the members must fulfill requirements, among others as follows: (i) Indonesian citizen who domiciled in Indonesia; (ii) proficient in English; and (iii) maximum 65 years of age when appointed.

As for the MAC members who previously serve as senior TMO examiners, they should be at least examiners with the rank of Level I/Group III/d in the seniority rank of civil servants.

All MAC members are appointed and dismissed by the Minister of Law and Human Rights based on inputs from the Director General of Intellectual Property.

### **Patent/ Utility Model**

As regulated in Regulation 40 of 2005, the structure of the PAC is as follows:

- a chairperson (who also serves as the member);
- a deputy chairperson (who also serves as the member); and
- members of the PAC who comprise several experts in the required fields and also senior Patent Office's examiners.

The maximum number of members in the PAC is 15. The maximum serving term for each member is three years. Each of the members must fulfill requirements, among others as follows: (i) Indonesian citizen who domiciled in Indonesia; (ii) proficient in English; and (iii) maximum 65 years of age when appointed.

As for the PAC members who previously serve as senior Patent Office's examiners, they should be at least examiners with the rank of Level I/Group III/d in the seniority rank of civil servants.

All PAC members are appointed and dismissed by the Minister of Law and Human Rights based on inputs from the Director General of Intellectual Property.

### **Industrial Design**

All judges who serve at the Commercial Court are appointed based on a decree of the Chief of the Supreme Court. Based on Article 14 of Law No. 49 of 2009, in order to be appointed as a judge, a person should be, among others:

- an Indonesian citizen;
- a Bachelor of Law;
- graduated from judge educational course;
- authoritative, honest, fair and honorable;
- at least 25 years old and maximum of 40 years old; and
- clear from any criminal records or imprisonment based on a final and binding decision.

### **3) Disqualification/Avoidance of Judge from Hearing the Case**

#### **Trademarks**

Under Article 5 of Regulation 90 of 2019, members of the MAC can be dismissed if any of the following circumstances is met:

- The member is passed away;
- The member voluntarily resigns;
- The member resides overseas;
- The member suffers from physical or mental illness for six consecutive months;
- The serving term expires;
- The member has been convicted to the punishable imprisonment for up to five years;  
or
- The member is unable to carry out his/her duty or commits misconduct.

#### **Patent/ Utility Model**

Under the Regulation 40 of 2005, members of the PAC can be dismissed if any of the following circumstances is met:

- The member passed away;
- The member voluntarily resigns;
- The member resides overseas;
- The member suffers from physical or mental illness for six consecutive months;
- The serving term expires; or
- The member is unable to carry out his/her duty or commits misconduct.

## **Industrial Design**

Based on Article 19 of Law No. 49 of 2009, a judge can be honorably dismissed from his/her position if he or she:

- voluntarily resigns;
- is physically or mentally ill;
- has reached 65 years old (for chief, deputy and judge of district court) or 67 years old (for chief, deputy and judge of high court); or
- is not capable in performing his duties

In Article 20 of Law No. 49 of 2009, chief, deputy and judge court can be dishonorably dismissed from his/her position if he or she:

- is sentenced to imprisonment based on a final and binding court decision;
- is committing misconduct;
- is neglecting his duties for three consecutive months;
- violates his/her oath or pledge;
- violates the prevailing code of conduct and guidelines; and/or
- the judge is acting concurrently as either (i) the executor of the court's decision; (ii) trustee, guardian and official which is related to the ongoing case that he or she examines; or (iii) businessman/businesswoman.

## **4) Acceptance of Appeal Procedures**

### **Trademarks**

In general, the MAC will consider whether the TMO's decision in rejecting a trademark application is in line with the prevailing Trademark Law. For detailed reference, the relevant articles being used by the TMO to carry out substantive examination and decide to either register or reject a trademark are as follows:

- Under Article 20 of the Trademark Law, the TMO should reject a trademark application if:

- |   |
|---|
| <ul style="list-style-type: none"><li>a) it is contrary to state ideology, laws and regulations, morality, religion, norms or public order;</li><li>b) it is identical, associated with or merely a description of the applied goods and/or services;</li><li>c) it contains elements that can mislead the public about the origin, quality, type, size, kind, intended use of the goods and/or services applied for registration or is a name of a protected plant variety names for similar goods and/or services;</li><li>d) it contains information that is different from the quality, benefit or efficacy of the produced goods and/or services; or</li><li>e) it has no distinguishing features.</li></ul> |
|---|

- Under Article 21.(1) of the Trademark Law, the TMO should also reject a trademark application if it is similar to or identical with:

- |  |
|--|
| <ul style="list-style-type: none"> <li>a) a registered mark owned by another party or prior trademark application for similar goods and/or services;</li> <li>b) a well-known mark owned by another party for similar goods and/or services;</li> <li>c) a well-known mark owned by other party for different goods and/or services that has fulfilled certain requirements; or</li> <li>d) a registered geographical identification.</li> </ul> |
|--|

- Article 21.(2) of the Trademark Law also stipulates that a trademark application should be rejected if it:

- |  |
|--|
| <ul style="list-style-type: none"> <li>a) is or resembles the name or acronym of a famous person, photograph, or the name of a legal entity that is owned by another person, except with the written consent of the relevant party;</li> <li>b) is an imitation or resemble the name or abbreviation name, flag, emblem or symbol of a country, or national or international institutions, except with the written consent of the authorities;</li> <li>c) is an imitation or resemble an official sign, seal or stamp that is used by a country or government agencies, both national and international institutions, except with the written consent of the authorities; or</li> <li>d) filed in bad faith.</li> </ul> |
|--|

In addition to the above, when the MAC carries out the appeal examination, the members of the MAC will also consider (i) whether the appeal is lodged within the timeframe provided by the Trademark Law; and (ii) whether the formality requirements are met by the applicant (please refer to the Section 2.2 of this Survey for the formality requirements for filing the appeal).

If the MAC is of the opinion that the TMO's rejection is incorrect, the MAC will issue a decision to overrule the TMO's rejection.

### **Patent/ Utility Model**

In general, the PAC will consider whether the Patent Office's decision in rejecting a patent application is in line with the prevailing Patent Law. For detailed reference, the relevant articles being used by the Patent Office to carry out substantive examination and decide to either grant or reject a patent application are as follows:

- Under Article 9 of the Patent Law, the Patent Office cannot grant the patent for the following inventions:
  - a) Products and processes the use or implementation of which is contrary to law, religion, public order or morality;

- b) Methods of inspection, treatment, medication and surgery applied to humans and/or animals;
  - c) Theories and methods in the field of science and mathematics;
  - d) Living creatures, except micro-organisms; and/or
  - e) Biological processes that are essential for the production of plants or animals, except microbiological processes
- Under Article 3 (1) of the Patent Law, the Patent Office cannot grant the patent that does not satisfy the following requirements:
    - a) Novelty (an invention is considered novel if, on its filing date, it is not similar to any technology that has previously been disclosed);
    - b) Inventive steps (an invention is considered to involve an inventive step if it is not obvious to a person skilled in the relevant art); and
    - c) Industrially applicable (an invention can be applied in industry, as described in the patent application).

Under Article 3 (2) of the Patent Law, the Patent Office cannot grant the utility model that (i) is not novel; (ii) is not a development from existing products or processes; or (iii) is not industrially applicable.

In addition to the above, when the PAC carries out the appeal examination, the members of the PAC will also consider (i) whether the appeal is lodged within the timeframe provided by the Patent Law; and (ii) whether the formality requirements are met by the applicant (please refer to the Section 2.2.1 of this Survey for the formality requirements for filing the appeal).

If the PAC is of the opinion that the Patent Office's rejection is incorrect, the PAC will issue a decision to overrule the Patent Office's rejection.

### **Industrial Design**

The plaintiff has the burden of proof to demonstrate that the Industrial Design Office's decision in rejecting its design application is incorrect and not in line with the prevailing Industrial Design Law.

In general, the plaintiff should be able to demonstrate that its design is novel (not the same as prior disclosure) and is in line with the prevailing laws, public order, religious and moral values.

Under the Industrial Design Law, a design is deemed unpublished if, not more than six months before the application date, (i) it has been displayed in an official exhibition in Indonesia or overseas; or (ii) it has been used in Indonesia by the designer solely for the science, research and development purposes.

## **5) Participation of Relevant Parties to Appeal**

Third parties would not be able to intervene the appeal process at the MAC, as the MAC merely reviews the appeal based on the appeal letter submitted by the applicant.

Meanwhile, third parties would be able to file an appeal to the PAC to challenge the Patent Office's decision to grant a patent/ utility model. However, so far, based on our research at the Patent Office, so far there is no appeal lodged by third parties on the aforementioned basis, as third parties usually carry out cancellation action to the Commercial Court against the Patent Office's decision to grant a patent/ utility model.

As for industrial designs, the Industrial Design Law does not stipulate any mechanisms for the participation of relevant third parties in the proceedings at the Commercial Court.

## **6) Oral Proceedings**

### **Trademark**

According to Regulation 90 of 2019, if required, the MAC may request the party who files the appeal, trademarks expert (if necessary) and the TMO's examiners who carried out the examination of the trademark application to appear before the MAC.

### **Patent /Utility Model**

If required, the PAC may request the party who files the appeal to appear before the PAC to explain its arguments.

### **Industrial Design**

Most of the submissions made during the design appeal at the Commercial Court are in writing. Any oral proceedings or exchange of arguments in verbal would only be relevant during witness presentation sessions.

## **7) Independent Consultants/Advisory Council**

Based on elucidation of Article 2.(1)(c) Regulation 7 of 2005 and elucidation of Article 2.(1)(c) Regulation 40 of 2005, during the appeal stages, the IP Office could appoint external experts or independent consultants who have knowledge, understanding and expertise in the fields of trademark and patents.

## **2.2.3 Decision Process for Appeal Against Decision of Rejection**

### **1) Deadline for Decision Process**

#### **Trademark**

Under Article 30 of the Trademark Law, the MAC should issue an appeal decision within three months from the date of receipt of the appeal.

#### **Patent/ Utility Model**

Under Article 68 of the Patent Law, the PAC should issue an appeal decision within nine months from the examination date for any appeal against the Patent Office's decision to either grant or reject a patent/ utility model.

Meanwhile, the PAC should issue an appeal decision within six months from the examination date of the appeal for requesting correction on the descriptions, claims and/or drawings.

### **Industrial Design**

Please refer to Section 4 of this Survey for further details on the course of proceedings at the Commercial Court.

## **2) Submission of Opinion Prior To Appeal**

In practice, it is not possible to submit an opinion prior to filing the appeal. All arguments should be submitted to the appeal letters submitted to the MAC and PAC.

## **3) Content of Appeal**

In the appeal letters lodged to the MAC or PAC, the arguments should be outlined in Indonesian language. The applicants could also submit any relevant documents and evidence to support the arguments as enclosure to the appeal letters. Those documents and evidence can be in form of scanned copies/simple copies (without any notarization or legalization).

As for the trademark appeal to the MAC, the applicant may request partial deletion against the specification of goods/services covered in the trademark application in order to create distinctiveness with the cited trademark, but this would be subject to the MAC's discretion to either accept such partial deletion request in the appeal. In practice, the applicant would not be able to amend the specification (e.g., change the wording or expand the kinds of goods/services), as only deletion is possible.

## **4) Final Decision**

### **Trademark**

Based on the Trademark Law, if the MAC grants the appeal, the MAC will instruct the TMO to overturn its rejection and register the trademark application. If the MAC rejects the appeal, the applicant would still be able to challenge the decision by filing a civil claim to the Commercial Court within 3 months from the date when the applicant receives the MAC's decision.

### **Patent/ Utility Model**

Based on the Patent Law, if the PAC decides to accept the appeal, the PAC will instruct the Patent Office to (i) overturn the rejection and grant the patent/ utility model; (ii) accept the correction on descriptions, claims and/or drawings; or (iii) overturn the Patent Office's decision to grant a patent/ utility model.

If the PAC rejects the appeal, the applicant would still be able to challenge the decision by filing a civil claim to the Commercial Court within 3 months from the date when the applicant receives the PAC's decision.

### **Industrial Design**

If the Commercial Court rejects the plaintiff's claim, the plaintiff would still be able to challenge the decision by filing a cassation to the Supreme Court. Please refer to Section 4 of this Survey for further details.

#### **5) Delivery of Judgements**

The MAC and PAC's decisions are delivered through postal service to the applicants or their counsels.

Meanwhile, the decisions of Commercial Court in industrial design cases are also delivered to all parties and will be made publicly available in the Supreme Court's online database.

#### **6) Publication of Judgement/Decision**

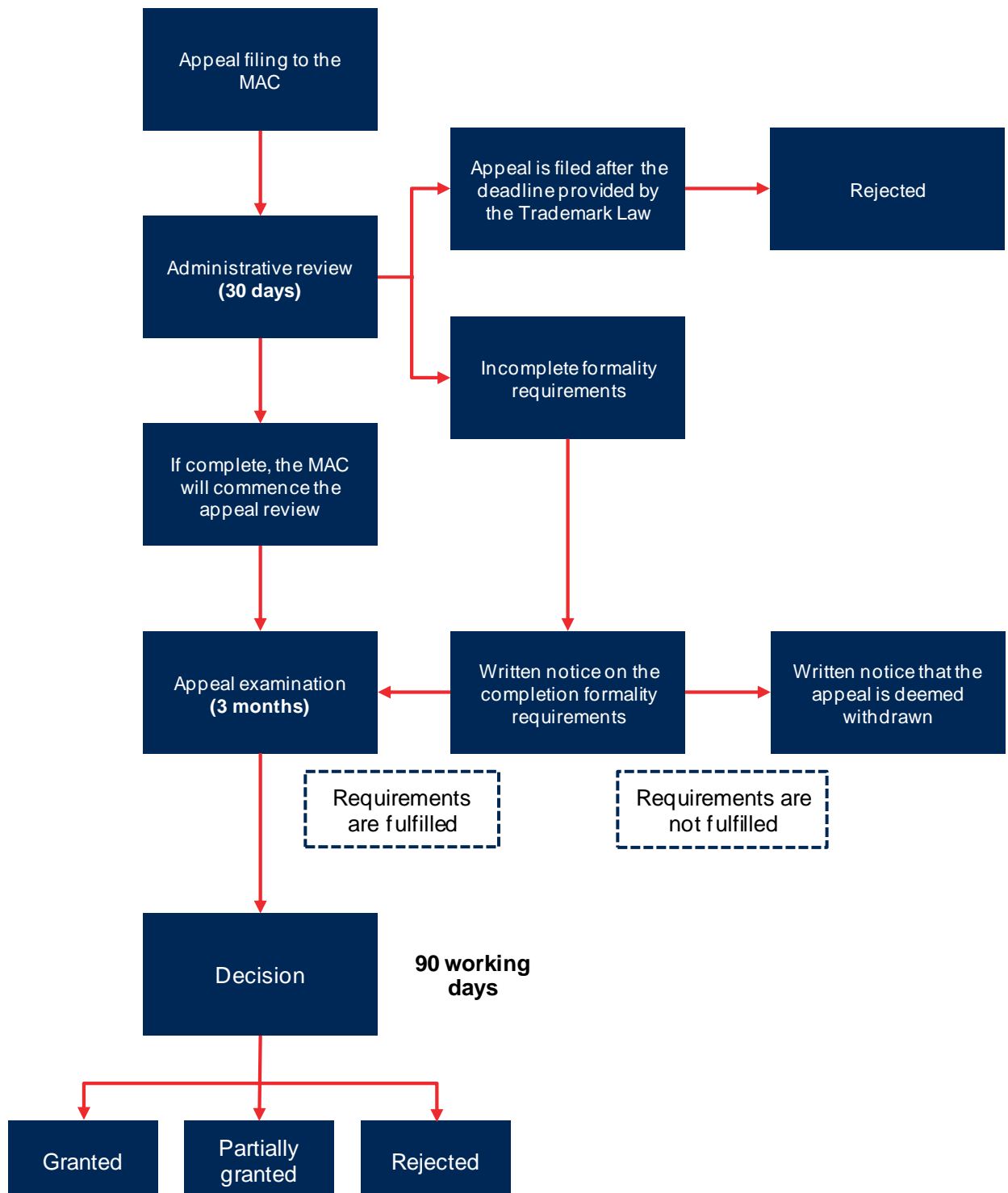
In practice, the MAC and PAC's appeal decisions are not uploaded in the online database, as they are directly issued via postal services to the applicants. They are also not publicly available in the IP Office's online database.

Meanwhile, the decisions of Commercial Court in industrial design cases are also delivered to all parties and will be made publicly available in the Supreme Court's online database.

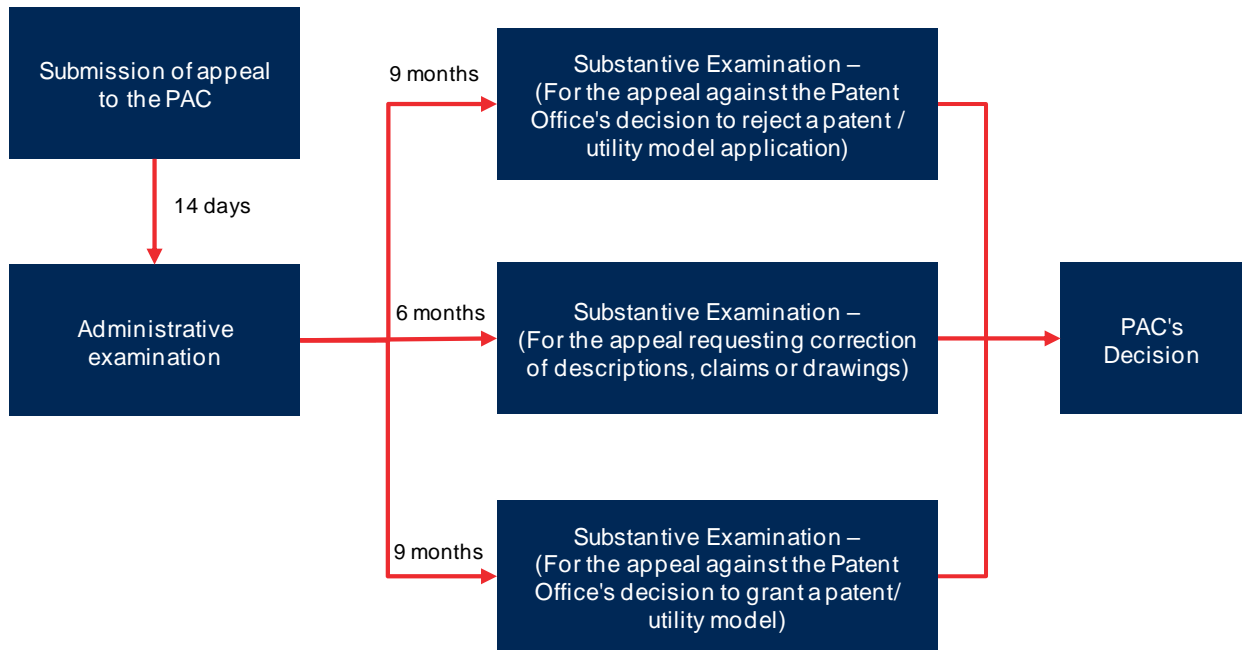


## 2.2.4 Flowcharts

### 1) Appeal Filing to the MAC (For Trademark)



## 2) Appeal Filing to the PAC (For Patent/Utility Model)



## 3) Civil action at the Commercial Court (for Industrial Design)

Please refer to the flowchart as outlined in Section 4.2.5 of this Survey.

### 3. **Oppositions**

#### 3.1 **Statistics**

##### 3.1.1. **Number of Oppositions (for Patent/Utilities Patent, Industrial Design, TM, from 2014 to 2018)**

	2014	2015	2016	2017	2018
Patent/Utility Model	78	75	67	121	132
Industrial Design right	110	143	137	197	25
Trademark right	678	943	813	920	715
<b>Total</b>	<b>866</b>	<b>1161</b>	<b>1017</b>	<b>1238</b>	<b>872</b>

##### 3.1.2. **Average Time Required until the Decision is Rendered**

1. According to Article 23 of the Trademark Law, if there is an opposition to the TMO, the TMO's must take into consideration the opposition when carrying out substantive examination. Under the Trademark Law the examination must be carried out within 30 days from the end of the publication period and must be completed within 150 days.
2. For patent opposition, under Article 49 (5) of the Patent Law, the examiners will also consider any oppositions from third parties when carrying out substantive examination of the patents. Under Article 57 of the Patent Law, the Patent Office will issue a decision within 30 months from (i) the date when the Patent Office receives the substantive examination request from the patent applicant; or (ii) the end of the publication period (if the patent applicant request for substantive examination before the end of its publication period). For utility model opposition, under Article 124 (1) of the Patent Law, the Patent Office will issue a decision within 12 months from the date when the Patent Office receives the utility model application.
3. Under Article 26 of the Industrial Design Law, the Industrial Design Office must issue an opposition decision within six months from the end of the publication period.

##### 3.1.3 **Number of Cases Decided**

	2014	2015	2016	2017	2018
Patent/Utility Model	N/A	N/A	N/A	N/A	N/A
Industrial Design right	N/A	N/A	N/A	N/A	N/A
Trademark right	N/A	N/A	N/A	N/A	N/A

*Note: The statistics are not publicly available with the IP Office.*

### **3.1.4. Number of Cases Oppositions were Accepted**

This scope of information is not publicly available.

## **3.2 Procedures**

### **3.2.1. Procedures to Start the Opposition Process**

#### **Trademark**

Under the Trademark Law, within 15 working days as of the filing date of a trademark application, a trademark application that has fulfilled formality requirements will be published for a period of two months in a Trademark Journal for opposition purposes. In current practice, the opposition is lodged using the TMO's online system.

If an opposition is filed, within fourteen days from the date when the opposition is filed to the TMO, the TMO will send the copy of opposition to the applicant or its proxy.

The applicant or its proxy is entitled to file a rebuttal within two months from delivery date of the opposition.

The opposition can be lodged based on Articles 20 and 21 of the Trademark Law. Please refer to Section 2.2.2 sub 4 of this Survey for detailed elaboration on these articles.

Under Article 23 of the Trademark Law, the TMO should consider all oppositions and rebuttal filed when the TMO carries out the substantive examination. If there is no opposition, within the maximum period of 30 days from the end of publication period, the TMO should carry out a substantive examination against a trademark application.

However, if there is an opposition, the TMO should carry out a substantive examination within the maximum period of 30 days from the deadline of submission of rebuttal by the applicant.

In addition to the opposition letter, a Power of Attorney (if the opposition is lodged by the proxy) and the copy of proof of payment of the official fee, should be lodged to the TMO.

Under Government Regulation No. 28 of 2019, the official fee for filing one trademark opposition against one trademark application is IDR 1 million.

#### **Patent/ Utility Model**

The Patent Office will publish the application within 18 months from the filing date (in practice it might take longer) and the period of publication for patent is six months. As for the utility model, under Article 123 (2) of the Patent Law, the Patent Office will publish the application within three months from the filing date (in practice, it might take longer) and the publication period is two months.

Under Article 49 of the Patent Law, during the publication period, any interested third party can submit an opposition to the Patent Office. If there is any opposition, the Patent Office should notify the applicant or its proxy about the opposition within seven days from the date when the opposition is received by the Patent Office. The applicant or its proxy would be able to submit a rebuttal within 30 days from the date when the opposition is notified to the applicant or its proxy.

In practice, the opposition can be lodged based on the grounds as outlined in Articles 3 (for patent and utility model) and 9 of the Patent Law. Please refer to section 2.2.2 sub. 4 of this Survey for detailed elaborations on these articles.

In addition to the opposition letter, a Power of Attorney (if the opposition is lodged by the proxy) and the copy of proof of payment of the official fee, should be lodged to the Patent Office.

### **Industrial Design**

Under Article 26 of the Industrial Design Law, a design application that has fulfilled formality requirements will be published for three months.

Any party would be able to file an opposition during the publication period, by arguing that (i) the design is lacking novelty (Article 2 of the Industrial Design Law); or (ii) the design contravenes the prevailing laws, public order, religion or morality (Article 4 of the Industrial Design Law).

The applicant or its proxy would be able to file a rebuttal against the submitted opposition within three months from the date when the opposition letter is received by the applicant or its proxy.

In addition to the opposition letter, a Power of Attorney (if the opposition is lodged by the proxy) and the copy of proof of payment of the official fee, should be lodged to the Industrial Design Office.

The official fee for filing one Industrial Design opposition against one Industrial Design application is IDR 500,000.

## **3.2.2. Procedures**

### **1) Trial System**

#### **Trademark**

As outlined in Section 3.2.1 of this Survey, according to Article 23 of the Trademark Law, once the TMO receives the opposition and rebuttal letters, the TMO's examiners must carry out the substantive examination within 30 days from the end of the publication period and must be completed within 150 days. There will be no oral hearings during the assessment of opposition.

#### **Patent/ Utility Model**

As outlined in Section 3.2.1, according to Article 51 of the Patent Law, the applicant can file a request for substantive examination within 36 months from the following date:

- International Filing date for an application based on Patent Cooperation Treaty ("**PCT**");  
or
- Indonesia filing date for the non PCT application (including application with priority rights)

According to Article 122 of the Patent Law, the utility model applicant can file a request for substantive examination within six months from the application filing date.

The substantive examination for patent application must be completed within 30 months from (i) the date when the Patent Office receives the substantive examination request from the patent applicant; or (ii) the end of the publication period (if the patent applicant request for substantive examination before the end of its publication period). Under Article 124 of the Patent Law, the substantive examination for utility model application must be completed within 12 months from the date when the Patent Office receives the utility model application.

There will be no oral hearings during the assessment of opposition.

### **Industrial Design**

As outlined in Section 3.2.1, according to Article 26 of the Industrial Design Law, once the Industrial Design Office receives the opposition and rebuttal letters, the Industrial Design Office's examiners must carry out the substantive examination within three months from the end of the publication period and must be completed within six months. There will be no oral hearings during the assessment of opposition.

#### **2) Requirement for Examiners**

All trademark, patent and industrial design oppositions and rebuttals will be reviewed by the examiners at the Trademark Office, Patent Office and Industrial Design Office.

#### **3) Disqualification/ Avoidance of Examiners from Hearing the Case**

The Trademark Law, Patent Law and Industrial Design Law does not specifically mention provisions on the disqualification/avoidance of the examiner from reviewing the oppositions or rebuttals. Nevertheless, in practice, the oppositions and rebuttals should be reviewed by the relevant and capable examiners. For example, oppositions against trademark applications in Class 3 should be reviewed by the examiners in Class 3 and not by the examiners for the other classes.

#### **4) Acceptance of Opposition**

In general, the Trademark Office, the Patent Office and the Industrial Design Office will issue the opposition decision (in writing) by mentioning the reasons why the opposition is granted or rejected.

#### **5) Submission of Opinion from the Applicant and the Opponent including Procedures**

Please refer to Section 3.2.2 of this Survey for the process of submitting the opposition and rebuttal letters to the Trademark Office, the Patent Office and the Industrial Design Office.

#### **6) Oral Proceedings**

All submissions to the Trademark Office, the Patent Office and the Industrial Design Office would be in writing. There will be no oral hearings carried out.

## **7) Amendment of Application by the Applicant**

The Trademark Law, the Patent Law and the Industrial Design Law do not provide any specific provisions regarding amendment of oppositions after they are lodged to either Trademark Office, Patent Office or Industrial Design Office. Hence, this would be subject to discretion to each office.

### **3.2.3. Registration Assessment / Rejection Assessment Decision**

#### **1) Registration Assessment/ Rejection Assessment Decision**

In the opposition decisions, the Trademark Office, the Patent Office and Industrial Design Office outline brief reasons of why the opposition is rejected or granted, by referring to the relevant articles in either the Trademark Law, the Patent Law or the Industrial Design Law that they use in reviewing the oppositions.

#### **2) Notification to the Opponent**

The Trademark Office, the Patent Office and the Industrial Design Office notifies the opposition decisions in writing to the applicant and the party who submits the opposition. Notification of the decisions can be done through email or postal service.

#### **3) Publication**

The Trademark Office, the Patent Office and the Industrial Design Office does not publish the opposition decisions for public on its public records.

### **3.2.4. Appeal Against Registration Assessment / Rejection Assessment Decision**

#### **1) Appeal by the Opponent**

##### **Trademark**

The Trademark Law does not provide any mechanisms or avenues for the party who filed the opposition to challenge the TMO's decision to reject the opposition.

##### **Patent/ Utility Model**

Under the Patent Law, if the Patent Office rejects an opposition, the party who filed the opposition would still be able to file an appeal against the Patent Office's rejection. Please refer to Section 2 for this Survey for further details.

##### **Industrial Design**

The Industrial Design Law does not provide any mechanisms or avenues for the party who filed the opposition to challenge the Industrial Design Office's decision to reject the opposition.

## **2) Appeal by the Applicant**

### **Trademark**

Under the Trademark Law, if the Trademark Office rejects an application based on opposition, the applicant would be able to file a response to the Trademark Office's rejection within thirty days from the date when the notification letter is delivered by the Trademark Office to the applicant or its proxy.

If the Trademark Office still rejects the trademark application, the applicant can file an appeal to the MAC. Please refer to Section 2.2.2 of this Survey for further details.

### **Patent/ Utility Model**

Under the Patent Law, if the Patent Office rejects an application based on opposition, the Patent Office will issue a notification of rejection to the applicant. The applicant would be able to respond within three months from the date of the Patent Office's official notification of rejection (which could be extended for two additional months). The applicant can further extend the deadline for an additional one month by paying official fees.

If the Patent Office still rejects the patent application, the applicant can file an appeal to the PAC. Please refer to Section 2.2.2 of this Survey for further details.

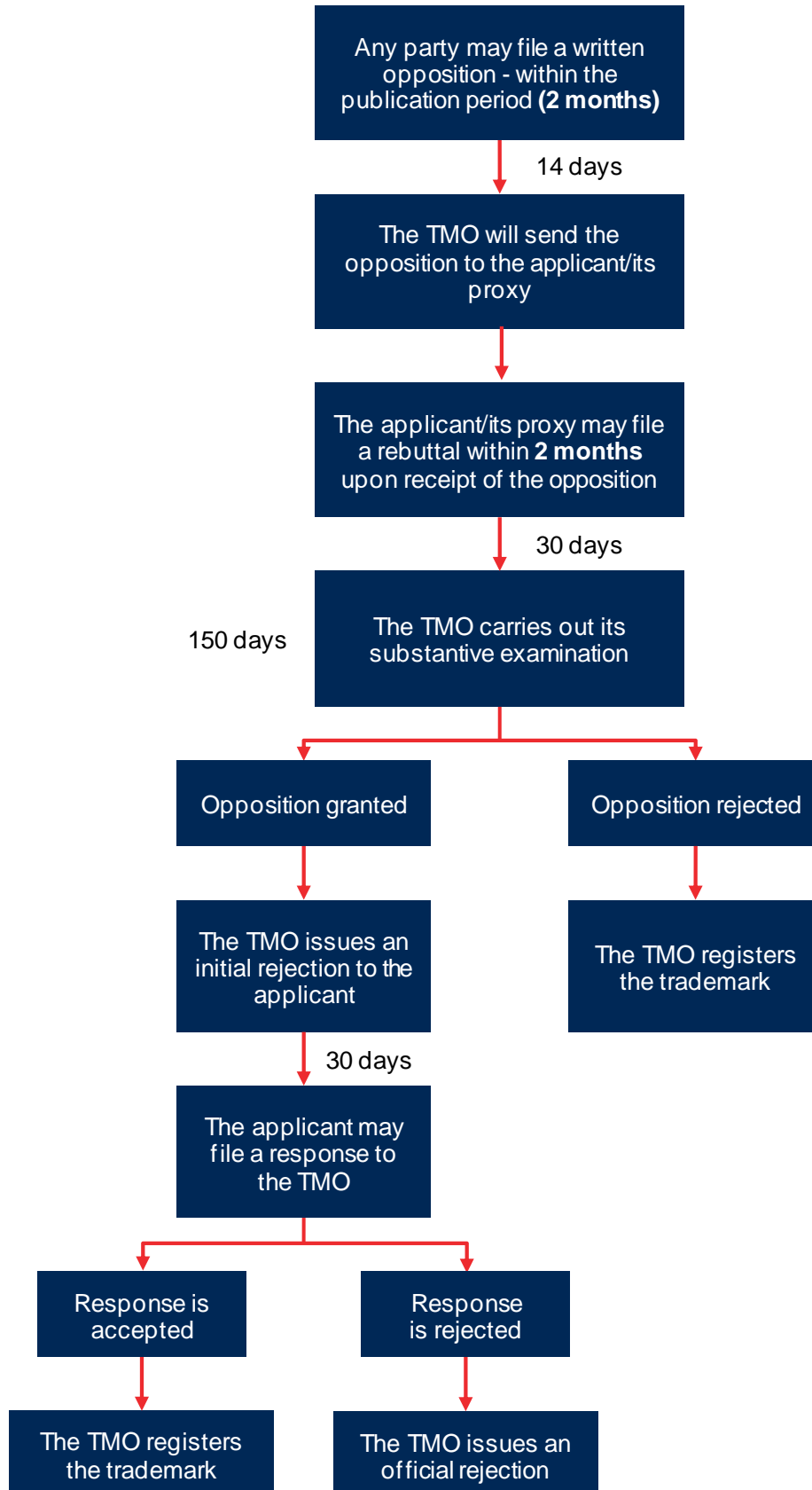
### **Industrial Design**

Under the Industrial Design Law, if the Industrial Design Office rejects an application based on opposition, the applicant would only be able to challenge the rejection by filing a civil claim to the Commercial Court. Please refer to Sections 3 and 4 of this Survey for further details.

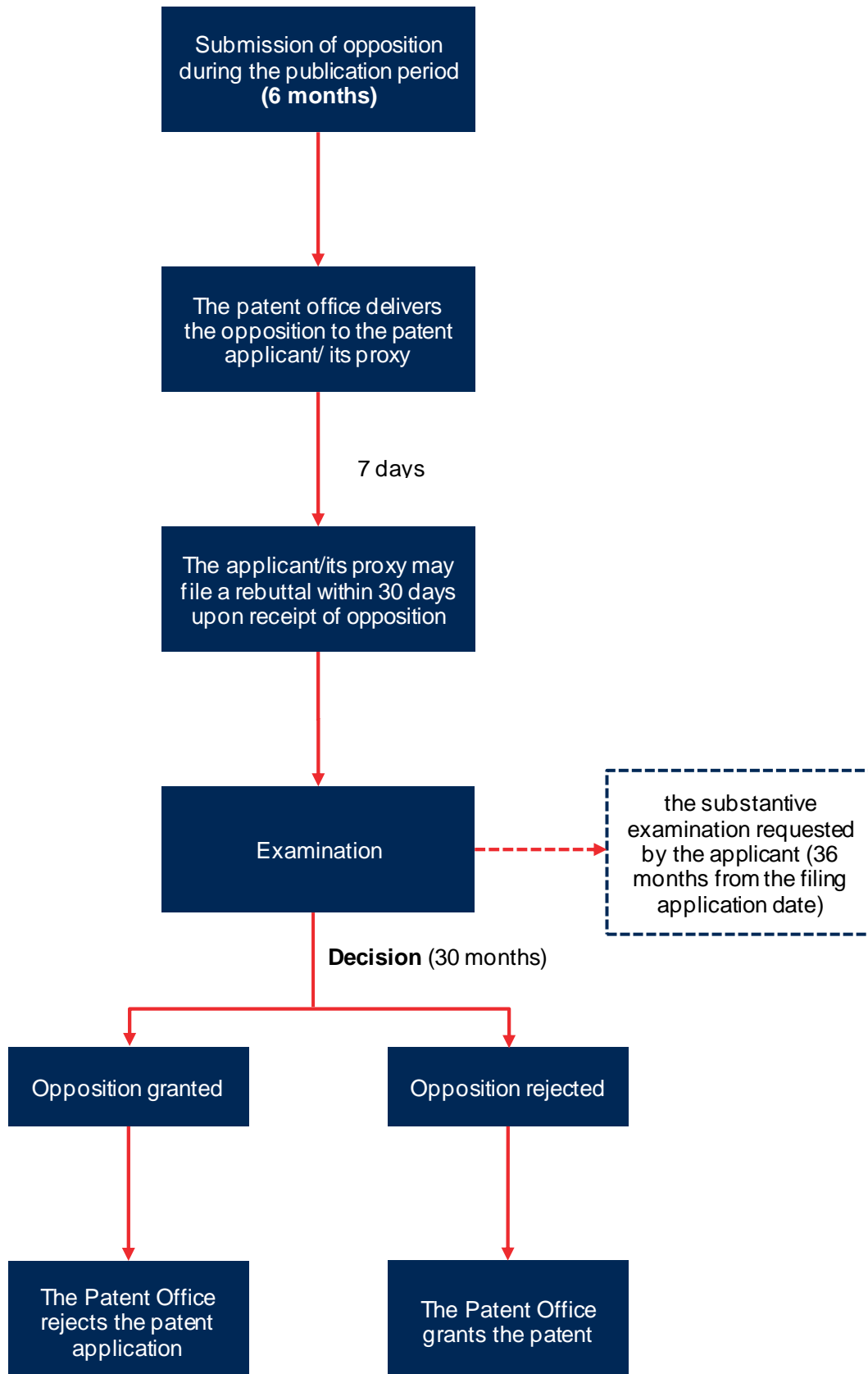


### 3.2.5. Flowchart of Opposition Procedures

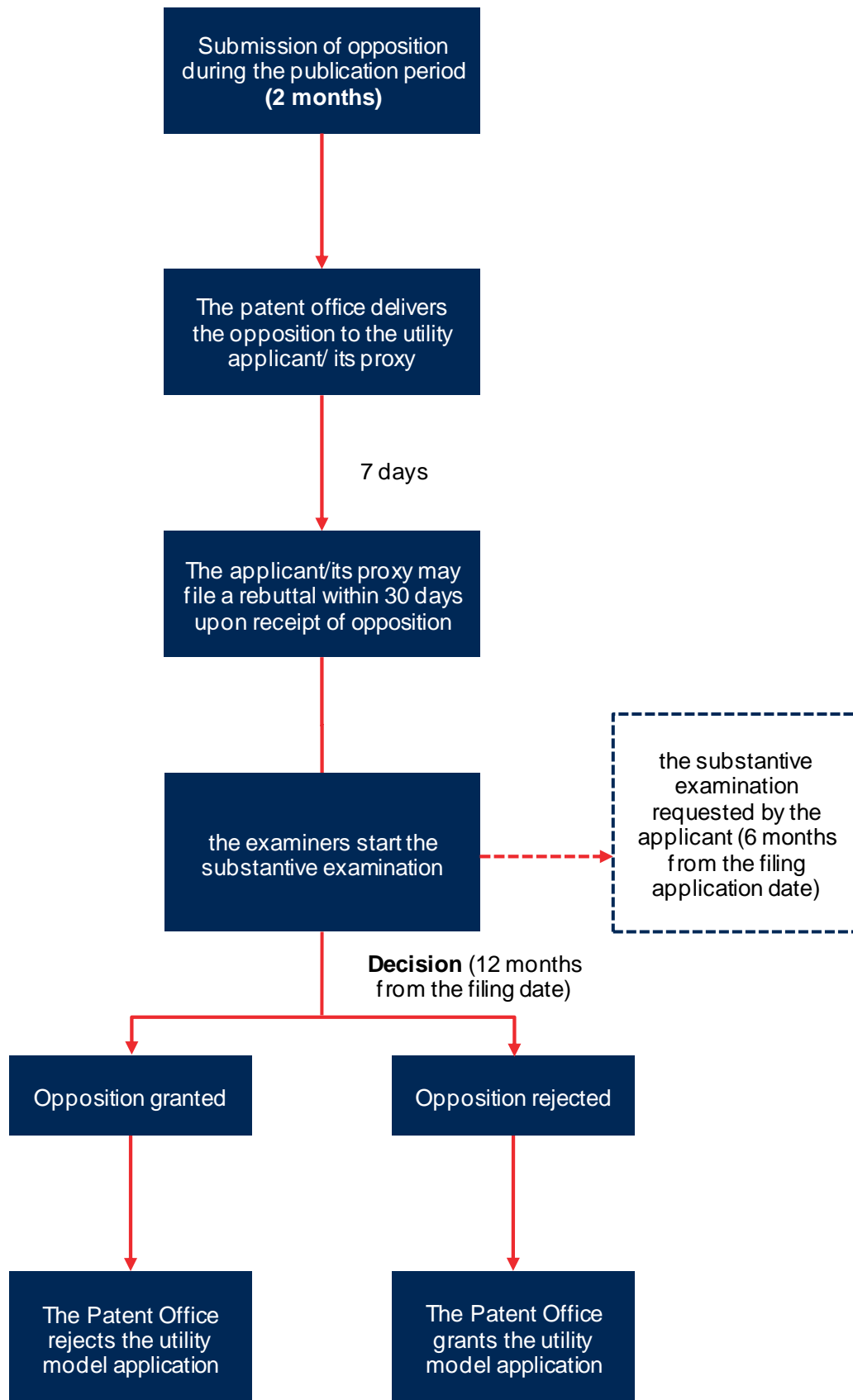
#### 1) Flowchart of Trademark Opposition



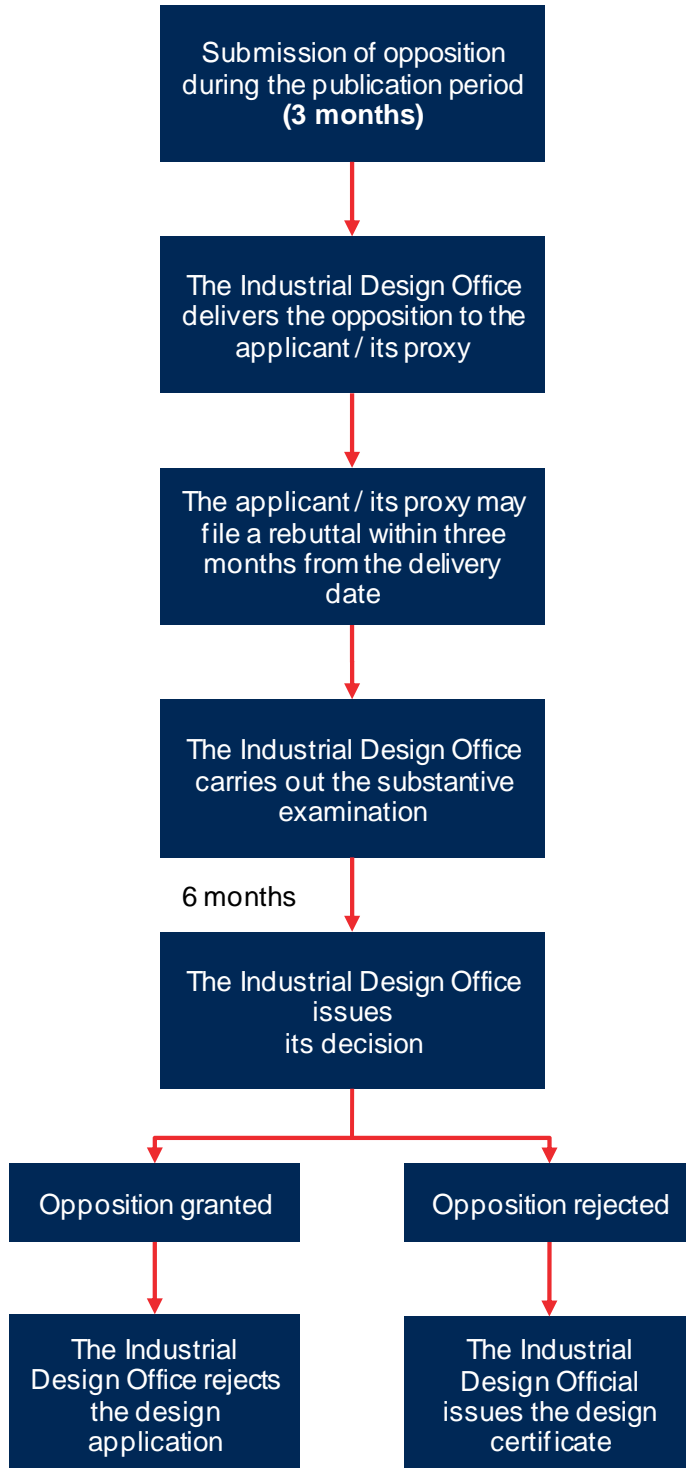
2) Flowchart of Patent Opposition Procedures (given that the patent applicant submits the request for substantive examination after the publication period ends)



### 3) Flowchart of Utility Model Opposition Procedures



#### 4) Flowchart of Industrial Design Opposition Procedures



#### 4. **Invalidation Trials / Cancellation Trials**

##### 4.1 **Statistics**

##### 4.1.1. **Number of Claims (for Patent/Utilities Patent, Industrial Design, TM, from 2014 to 2018)**

	2014	2015	2016	2017	2018
Patent/Utility Model	N/A	N/A	N/A	N/A	N/A
Industrial Design right	N/A	N/A	N/A	7	13
Trademark right	79	86	135	127	125
Total					

*Note: From our discussion with the relevant officials, we note that the Patent Office is still compiling information on patent cancellations for the period between 2014 and 2018. However, the information was not available at the time this report was prepared.*

##### 4.1.2. **Average Time Required**

###### **Trademark**

Under Article 85.(7) of the Trademark Law, the Commercial Court must render its decision within 90 days (although the panel of judges is entitled to extend the proceeding until 120 days).

###### **Patent**

Under Article 146 of the Patent Law, the Commercial Court must render its decision within 180 days.

###### **Industrial Design**

Under Article 39.(8) of the Industrial Design Law, the Commercial Court must render its decision within 90 days (although the panel of judges is entitled to extend the proceeding until 120 days).

##### 4.1.3. **Number of Cases Decided**

	2014	2015	2016	2017	2018
Total	188	53	352	251	247

*Note: This number is obtained through the Supreme Court's online database and only a ballpark figure (estimate). Since the online database may not be updated, the number may be different from the Supreme Court's manual records.*

#### **4.1.4. Percentage of Cases where Accepted**

There is no specific statistics on this available on the Supreme Court's online database. This scope of information is not publicly available.

#### **4.1.5. Percentage of Appeal Against the Decision**

There is no specific statistics on this available on the Supreme Court's online database. This scope of information is not publicly available.

### **4.2 Procedures / Flow**

#### **4.2.1. Procedure to Start the Trial**

##### **Trademark**

Cancellation claim can be filed by any interested third parties within five years from the registration date of the trademark subject to the cancellation. However, the Trademark Law and various jurisprudence stipulates that this deadline can be waived if the trademark was filed in bad faith, or contrary to the state ideology, moral and religious values, decency and public order.

Invalidation (non-use action) can be filed by any interested third parties against a trademark registration that is not being used within three consecutive years from its registration date or date of last use. In practice, before filing the non-use claim, the plaintiff should carry out investigation to find indications that the trademark is not being used, as well as to initiate market survey in major Indonesian cities to gather non-use statements from various parties (e.g., consumers, industry associations, landlords) to confirm that the trademark is indeed not being used.

Cancellation or invalidation claims can only be filed by any interested third parties to the Commercial Court, and not to the TMO or any other local courts in Indonesia.

The procedures for lodging the cancellation or non-use claim to the Commercial Court are as follows:

- The Plaintiff must lodge the cancellation claim to the Commercial Court whose jurisdiction covers the defendant's domicile. If one of the parties resides overseas, the claim can be filed in the Commercial Court of Jakarta.
- On the filing date of the claim, the clerk registrar will provide the plaintiff with the written receipt as proof of registration. The clerk registrar should deliver the claim to the Head of Commercial Court by no later than two days after the claim is filed.
- Within three days from the date when the claim is delivered to the Head of Commercial Court, the Head of Commercial Court should appoint a panel of judges to determine the first hearing date. Within seven days from the filing date of the claim, the bailiff will deliver summons letters to the parties.

## **Patent/ Utility Model**

Under Article 132 of the Patent Law, any interested third party can initiate a patent invalidation claim by arguing that the patented invention does not meet the patentability requirements as follows:

- The patent is not novel, not contain any inventive steps and not industrially applicable. According to Article 4 of the Patent Law, the invention should not include:
  - esthetic creation;
  - scheme;
  - rules and methods for conducting activity:
    - involving mental activity
    - games
    - business
  - rules and methods containing computer programs
  - presentation concerning an information
  - discovery in the form of:
    - new usage for existing and/or recognized products
    - new form from existing compound which does not produce any escalation on the benefit and there is difference in the related chemicals that already known from the compound

Based on Article 9 of the Patent Law, invention which cannot be given patent includes:

- process or product whose publication, usage or implementation is contrary to the rules and regulations, religion, public order or decency;
  - methods of examination, maintenance, treatment and/or surgery which applied to human and/or animals;
  - theory and methods in the field of science and mathematics;
  - living creatures, except for microorganism corpse; or
  - biological process which essential for producing plants or animals, except for non-biological or microbiological processes.
- Patent which originated from genetic resources and/or traditional knowledge that the source of those genetic resources and/or traditional knowledge must be clearly and truthfully described in the description, the information regarding the source of those two is determined by the government institution.
  - The patent is similar to other granted patent owned by other parties for the same invention
  - The granted compulsory licensing was proven unable to prevent the continuation of the implementation of patent in the form and in the way that is detrimental to the interest of society within two years from the date of the compulsory licensing is granted or the first date of compulsory licensing granted in the case of several compulsory licensing is applied.

- The patent holder does not create the product or use the process in Indonesia which not support the transfer of technology, the absorption of investment and jobs creation.

### **(Comparison between an Objection to the PAC and an Invalidation Claim to the Commercial Court)**

Any interested third party may file an objection to the PAC within maximum nine months from the granted date of a patent. If the third party wishes to challenge the Patent Office's decision in granting a patent after nine months from the granted date, then the invalidation claim should be filed to the Commercial Court.

In general, the reasons to be used in the appeal letter and the civil claim to the Commercial Court would be similar, but the main differences would be on the procedures, as elaborated as follows:

<b>Patent Appeal Commission</b>	<b>Commercial Court</b>
The objection regarding decision to grant a patent should be filed within 9 months from the granted date of the patent.	The invalidation claim could be filed any time after the granted date of the patent, as long as the patent protection is not yet expired.
The judges of the PAC are patent experts and patent examiners.	The judges of Commercial Court do not necessarily have patent backgrounds.
The examination process should be started at the latest one month from the appeal's filing date and the decision should be issued at the latest 9 months.	The trial process could take 180 days from the filing date of the claim.

### **(Patent Invalidation Claim by Patent Licensee)**

A patent licensee can also initiate a patent invalidation claim by arguing that the licensed patent is similar to another patent granted to different party for the same scope of invention.

### **(Application for Compulsory Licensing)**

Other than initiating a patent invalidation claim, based on Regulation 30 of 2019, any interested third party could also file an application for compulsory licensing for the following reasons:

- The patent holder fails to perform the obligation to produce a product or utilize a process in Indonesia within 36 months after the patent was granted. The procedures for filing a compulsory licensing application based on these reasons are as follows:
  - The application can be lodged via electronic and non-electronic means after the 36 months period has passed starting from the date when the patent is granted. Applicants should upload the following documents:
    1. copy of valid identity card or immigration documents, if the compulsory licensing application is submitted by an individual;



2. certified copy or duplicate of the deed of establishment of a business entity or legal entity, if the compulsory licensing application is submitted by a business or legal entity;
  3. power of attorney, if the application is submitted through representatives;
  4. payment receipt of the compulsory licensing application;
  5. proof that the applicants
    - a. have the ability to implement the relevant patent by themselves comprehensively;
    - b. have a private facility to implement the relevant patent as soon as possible; and
    - c. have taken measures within 12 months at the latest to obtain a license from the patent holder based on reasonable requirements and conditions, but have not obtained any results; and
  6. statement letter from the relevant agency
- DGIP will examine the completeness of the application within 19 days of receipt of the application. DGIP then has to notify the result of the examination within 30 days of the examination result.
  - Substantive examination should be conducted within 70 days at the latest from the date when the expert team is formed. No later than 30 days after the examination notification date, the expert team must hear the information of the patent holder or their representatives and the compulsory licensing applicants or their representatives. The result of the substantive examination should be reported to the Minister of Law and Human Rights within three days at the latest after the examination is finished.
  - The decision must be made within 90 days at the latest starting from the compulsory licensing application submission date.
  - The Patent implemented by the patent holder or licensee in the form of and in a way which is detrimental to the public interest and patent resulting from the development of a patent that has been granted previously cannot be implemented without utilizing other parties' patents that are still in protection. The procedures for filing a compulsory licensing application based on these reasons are as follows:
    - The application can be lodged via electronic and non-electronic means and submitted any time after the patent is granted. Applicants should upload the following documents:
      1. copy of valid identity card or immigration documents, if the compulsory licensing application is submitted by an individual;
      2. certified copy or duplicate of the deed of establishment of a business entity or legal entity, if the compulsory licensing application is submitted by a business or legal entity;
      3. power of attorney, if the application is submitted through representatives;
      4. payment receipt of the compulsory licensing application;
      5. proof that the patent has been implemented by the patent holder or the licensee in the form of and in a way which is detrimental to the public interest;

6. proof that the applicants have made efforts to take measures within 12 months at the latest to obtain a license from the patent holder based on reasonable requirements and conditions, but have not obtained any results; and
  7. statement letter from the relevant agency.
- DGIP will examine the completeness of the application within 19 days of receipt of the application and has to notify the result of examination within 30 days of the result.
  - Substantive examination should be conducted within 70 days at the latest from the date when the expert team is formed. No later than 30 days after the examination notification date, the expert team must hear the information of the patent holder or their representatives and the compulsory licensing applicants or their representatives. The result of the substantive examination should be reported to the Minister of Law and Human Rights within three days at the latest after the examination is finished.
  - The decision must be made within 90 days at the latest starting from the compulsory licensing application submission date.

### **(Patent Invalidation Claim by the Public Prosecutor)**

The public prosecutor could also file a patent invalidation claim on the basis that the patent is harmful to the public, based on the provisions set forth in the Patent Law.

The procedures for lodging the patent invalidation claim at the Commercial Court are as follows:

- The Plaintiff must lodge the cancellation claim in the Commercial Court whose jurisdiction covers the defendant's domicile. If one of the parties resides overseas, the claim can be filed in the Commercial Court of Jakarta.
- On the claim filing date, the clerk registrar will provide the plaintiff with a written receipt as proof of registration. The clerk registrar should deliver the claim to the Head of Commercial Court by no later than two days after the claim is filed.
- Within 14 days from when the claim is delivered to the Head of Commercial Court, the Head of Commercial Court should appoint a panel of judges to determine the first hearing date. Within 14 days from the claim filing date of the claim, the bailiff will deliver summons letters to the parties.

### **Industrial Design**

Under Article 38 of the Industrial Design Law, any interested third party can initiate a design cancellation by arguing that the design does not meet the requirements as set forth in the Industrial Design Law (please refer to Section 2.2 sub. 2.2.2 of this Survey for further details).

The procedures for lodging the cancellation or non-use claim to the Commercial Court are as follows:

- The Plaintiff must lodge the cancellation claim to the Commercial Court whose jurisdiction covers the defendant's domicile. If the defendant resides overseas, the claim can be filed in the Commercial Court of Jakarta.

- On the filing date of the claim, the clerk registrar will provide the plaintiff with the written receipt as proof of registration. The clerk registrar should deliver the claim to the Head of Commercial Court by no later than two days after the claim is filed.
- Within three days from the date when the claim is delivered to the Head of Commercial Court, the Head of Commercial Court should appoint a panel of judges to determine the first hearing date. Within seven days from the filing date of the claim, the bailiff will deliver summons letters to the parties.

The applicant should pay the official fee of around IDR 2.5 million per civil claim lodged to the Commercial Court (but the total amount of official fee for each case may vary, depending on the domicile of the defendant in the case).

Cancellation claim can only be filed by any interested third parties to the Commercial Court, and not to the Design Office or any other local courts in Indonesia.

#### **4.2.2. Procedure for Proceedings**

In practice, the proceedings as outlined in Section 4.2.1 of this Survey would consist of the following hearings at the Commercial Court:

- First hearing - verification of the Plaintiff's Power of Attorney;
- Second hearing - verification of the Defendant's Power of Attorney and the reading of the Plaintiff's claim;
- Third hearing - the submission of the Defendant's written answers (Replies) to the Plaintiff's cancellation claim;
- Fourth hearing - the submission of the Plaintiff's written answers (Counterplea) to the Defendant's Replies;
- Fifth hearing - the submission of the Defendant's written answers (Rejoinder) to our Counterplea;
- Sixth hearing - the submission of the Plaintiff's evidence;
- Seventh hearing - the submission of the Plaintiff's witness (if any);
- Eight hearing - the submission of the Defendant's evidence;
- Ninth hearing - the submission of the Defendant's witness (if any);
- Tenth hearing - the submission of the Plaintiff's and the Defendant's Conclusions;
- Eleventh hearing - the presiding Judges render their decision.

The exchange of arguments are made in written submissions. However, arguments can also be addressed verbally in some hearings, such as during witness presentation hearings. The aforementioned hearings are open to the public.

#### **4.2.3. Decision**

The decisions for the proceedings as outlined in Section 4.2.1 will be announced by the Commercial Court's judges in public hearings. The copies of decisions are also delivered to all parties and will be made available in the Supreme Court's online database.

The decisions issued by the Commercial Court are issued by considering all facts, arguments and evidence submitted and presented by the parties during the whole proceedings. The Commercial Court's decisions outline the considerations as to why the cancellation or invalidation is granted or rejected, by making reference to the relevant arguments and sets of evidence presented before the proceedings. For ease of reference, please refer to Section 2.2.2 sub. (4) of this Survey for the requirements that need to be fulfilled to obtain trademark, patent and industrial design protections.

Based on the Commercial Court's decisions, the Trademark Office, the Patent Office and Industrial Design Office would then cancel or invalidate the trademarks, patents and industrial designs subject cancellation/invalidation.

As for patent invalidation, if the invalidation is granted to only one or several claims, the Patent Office needs to remove the invalidated claims based on the Commercial Court's decision. In such case, the patent holder must seek adjustment to the Patent Office for the remaining claims that are not invalidated.

#### **4.2.4. Appeal**

The decisions for the proceedings as outlined in Section 4.2.1 can only be challenged by way of cassation at the Commercial Court.

As for filing the cassation against the Commercial Court's decision, the process is as follows:

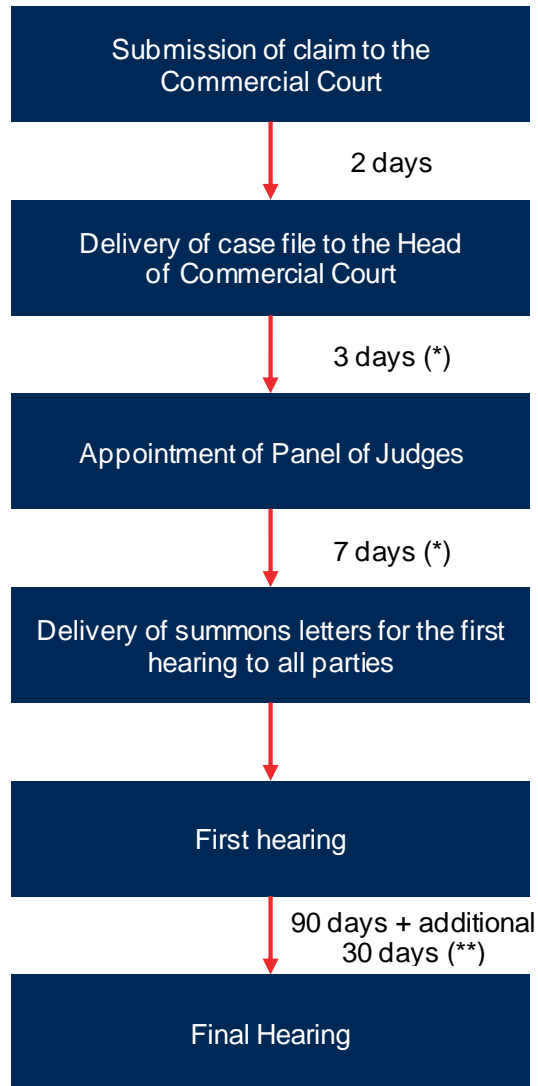
- Either party should declare the request of cassation to the Commercial Court within fourteen days from the date when the decision is declared or informed to all parties.
- The Commercial Court's clerk registrar should notify the counterparty about the declaration of cassation within seven days from the date when the cassation request is declared.

The party who declared the cassation must submit a memorandum of cassation through the Commercial Court's clerk registrar within 14 days from the date when the cassation request is declared. The Commercial Court's clerk registrar will deliver the memorandum of cassation to the counterparty within two days after the memorandum of cassation is lodged.

Theoretically, the Supreme Court's cassation decision is final and binding, but any party could still challenge by way of civil review based on limited reasons.

#### 4.2.5. Relationship with Court

Flow chart



Note:

(\*) for patent the period for this process is 14 days

(\* \*) for patent the period for this process is 180 days

### 4.3 Case Study

Summaries of trademark, patent and design cancellation action cases as taken from the Supreme Court's online database are shown below.

#### 4.3.1. Patent Invalidation Case

In 2017, the Commercial Court issued a decision on patent invalidation of "installation of vertical in-line pumps for condenser pumps". The plaintiff is a local company acting as an agent of an air cooling system manufacturer product based in Canada, while the defendant is a local individual who holds a patent for the invention, who was the former sales agent of the product in Indonesia before the Canadian company appointed the plaintiff as its authorized agent in Indonesia.

The plaintiff filed a patent invalidation claim against the defendant's patent by arguing that the defendant's patent is not novel and does not contain inventive steps as it copied the technology used in the product manufactured by the Canadian company.

The Commercial Court judges rejected the plaintiff's cancellation claim based on (among others) the following reasons:

- The plaintiff's expert and evidence presented during the proceedings were not able to demonstrate that the technology in the defendant's patent was copying the technology used in the Canadian company's product.
- The judges considered that the defendant's patent was more related to the piping installation of the pump rather than the pump itself, which is not related to the Canadian company's product, and hence should be deemed as patentable.

The above decision was upheld by the Supreme Court in 2018.

#### 4.3.2. Design Cancellation Case

In 2013, the Supreme Court issued a decision on "ballpoint" industrial design. The plaintiff is a local individual acting as an agent of a ballpoint product distributor of a Chinese company, while (i) the first defendant is a Korean company who holds an industrial design for that design; and (ii) the second defendant is the designer of the "ballpoint" design registered by the first defendant.

The plaintiff filed a design cancellation claim against the first defendant's design by arguing that the first defendant's design is not novel as it copies the design in the product manufactured by the Chinese company.

The Supreme Court judges rejected the plaintiff's cancellation claim based on (among others) the fact that the plaintiff is not the rightful holder of the industrial design used as the basis to initiate the design cancellation action. Moreover, the plaintiff could not show evidence that it is the authorized licensee of the Chinese company that owns the industrial design used as the basis of design cancellation action.

The decision was upheld by the Supreme Court in its Judicial Review in 2014.

### **4.3.3. Trademark Cancellation Case**

In 2017, the Commercial Court issued a decision on cancellation of a trademark used for beauty products. The plaintiff is a Korean manufacturer of beauty products, while the defendant is a local individual who registered a trademark that is identical with the Korean company's trademark.

The plaintiff filed a trademark cancellation claim against the defendant's trademarks by arguing that the defendant's trademark is identical with the plaintiff's trademark and the defendant's trademark was filed in bad faith by imitating the plaintiff's well-known trademark which has been extensively used and registered in various countries.

The Commercial Court judges granted the cancellation against the defendant's trademark as the judges believe that the trademark was filed in bad faith as it is confusingly similar to the plaintiff's trademark which has been extensively used and registered in various countries prior to the filing date of the defendant's trademark.

The decision was upheld by the Supreme Court in 2018.

## 5. **List of References.**

1. Law No. 20 of 2016 on Trademarks and Geographical Indications ("Trademark Law")
2. Law No. 13 of 2016 on Patents ("Patent Law")
3. Law No. 31 of 2000 on Industrial Designs ("Industrial Design Law")
4. Law No. 49 of 2009 on the second amendment to Law No. 2 of 1986 on General Judiciary ("Law No. 49 of 2009")
5. Government Regulation No. 90 of 2019 on Procedures for Application, Examinations and Settlement of Appeal at the Mark Appeal Commission ("Regulation 90 of 2019")
6. Government Regulation No. 40 of 2005 on Organizational Structure, Duty and Functions of the Patent Appeal Commission ("Regulation 40 of 2005")
7. Ministry of Law and Human Rights ("MOLHR") Regulation No. 67 of 2016 on Trademark Registration Procedures ("Regulation 67 of 2016")
8. MOLHR Regulation No. 38 of 2018 on Patent Applications ("Regulation 38 of 2018")
9. MOLHR Regulation No. 3 of 2019 on Patent Appeal Commission ("Regulation 3 of 2019")
10. MOLHR Regulation No. 30 of 2019 on Procedures for the Granting of Compulsory Patent Licensing ("Regulation 30 of 2019")



Japan Patent Office (JPO) Commissioned Survey

**Survey on the Appeal, Opposition, and Invalidation  
Procedures Related to Patents, Designs, and Trademarks  
in Indonesia**

Published by

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