

**CASE NO. 14  
TRADEMARK CASE  
“WELL-KNOWN TRADEMARK – “VAIO” CASE”**

**THE RULING OF JAKARTA COMMERCIAL COURT  
AND  
THE RULING OF THE SUPREME COURT OF THE REPUBLIC OF INDONESIA**

<b>Case Title</b>	<b>WELL-KNOWN TRADEMARK – “VAIO” CASE</b>
<b>Summary Of Verdict</b>	<p><b>At the Commercial Court Level</b></p> <ol style="list-style-type: none"> <li>1. Granted the Plaintiff’s lawsuit entirely;</li> <li>2. Claimed that the Plaintiff is the rightful owner of “VAIO” trademark in Republic of Indonesia and that “VAIO” is a well-known trademark;</li> <li>3. Revoked the Defendant’s registered “VAIO” trademark; and</li> <li>4. Punished the Defendant to pay for legal proceeding fees as much as Rp 916.000,- (nine hundred sixteen thousand Rupiah).</li> </ol> <p><b>At the Supreme Court Level (Cassation)</b></p> <p>-</p>
<b>Case Number</b>	Commercial Court: 02/Pdt.Sus/Merek/2014/PN.Niaga.Jkt.Pst. Supreme Court Level (Cassation): -
<b>Regulation References</b>	Trademark Law No. 15/2001, Article 2, Article 68, Article 70 paragraph (3) juncto Article 71, Elucidation of Article 4, Elucidation of Article 6 paragraph (1) point B
<b>Keyword</b>	Well-known trademark; similar trademark

**A. CASE FACTS**

In this case, the Plaintiff (Sony Kabuki Kaisha/SONY Corporation) sued the Defendat (Susanti) for the use of “VAIO” trademark in the Defendant’s production. The Plaintiff claimed to be the rightful owner of “VAIO” trademark in Indonesia base on the registration of the Plaintiff’s “VAIO” trademark in Directorate General of Intellectual Property Rights. The Plaintiff also claimed that the Plaintiff’s “VAIO” trademark is a well-known trademark and has been registered in several Countries as a trademark own by the Plaintiff. Based on those reason, the Plaintiff sued the Defendant for the usage of “VAIO” trademark that has similarities with the Plaintiff’s “VAIO” trademark, the Plaintiff worried that the Defendant’s “VAIO” trademark will be associated with the Plaintiff’s “VAIO” trademark and will bring confusion for the consumers.

Therefore, the Defendant claimed that the Plaintiff’s “VAIO” trademark cannot classified as a well-known trademark based on the fact that the Defendant didn’t know about the existence of the Plaintiff’s “VAIO” trademark and that the Defendant didn’t know that the Plaintiff’s “VAIO” trademark has been registered in several other countries. In the objection submitted by the Defendant, the Defendant also claimed that the Directorate General of Intellectual Property Rights should be a Co-Defendant in this case, because license for the Defendant’s “VAIO” trademark is given by the Directorate General of Intellectual property Rights. The Defendant also claimed that the Defendant’s trademark

and the Plaintiff's trademark is not classified on the same class (the Plaintiff's trademark used for electronic goods, while the Defendant's trademark used for household equipments), so the Plaintiff cannot claimed that the Defendant's "VAIO" trademark imitate the Plaintiff's "VAIO" trademark.

## **B. JUDGES CONSIDERATION**

### **At The Commercial Court Level**

Based on the Plaintiff's lawsuit, Motion of Dismiss from the defendant, and evidences submitted in the Court process, The Judges considered things as follows:

- According to the Defendant's objection regarding the lack of Defendant, the Judge considered that:
  - a. the Directorate of Trademark was not necessarily included as the Defendant or Co-Defendant, because the Directorate of Trademark just implemented a binding Court decision (Article 70 paragraph (3) juncto Article 71 Laws No. 15 Year 2001 regarding Trademark); and
  - b. it is the Plaintiff's right to determine the party that the Plaintiff's wanted to sue (correspond with Civil Procedural Law);
- Relating to the Plaintiff's claimant about "VAIO" trademark, the Judges considered that The Plaintiff has the right to file a termination lawsuit of the Defendant's "VAIO" trademark and that the Plaintiff's lawsuit has complied with Article 68 paragraph (2) Laws No. 15 Year 2001 regarding Trademark;
- The Plaintiff's "VAIO" trademark classified as a well-known trademark based on the Elucidation of Article 6 paragraph (1) point B regarding the well-known trademark terms. With consideration based on the evidences submitted by the Plaintiff that the Plaintiff's "VAIO" trademark has been registered in several Countries and that the Plaintiff had done promotion massively;
- The Plaintiff's "VAIO" trademark and the Defendant's "VAIO" trademark were being compared to find out whether The Plaintiff's trademark and The Defendant's trademark have similarity. The Judge considered that the Defendant's "VAIO" trademark has similarities either the physical look, the placement, the font type or the pronunciation;
- That the Defendant's "VAIO" trademark has been registered with bad faith from the defendant, because based from evidences submitted by the Plaintiff and from the Jurisprudence of Supreme Court of Indonesia regarding 'NIKE' trademark case (the registration of the trademark that has similarities with other trademark that has been registered earlier classified as bad faith.

In accordance to the consideration above, The Judges concluded that the lawsuit has to be granted and punished the Defendant to pay for legal proceeding fees.

### **At the Supreme Court Level (Cassation)**

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### **C. THE VERDICT**

#### **At The Commercial Court Level**

1. Granted the Plaintiff's lawsuit entirely;
2. Claimed that the Plaintiff is the rightful owner of "VAIO" trademark in Republic of Indonesia and that "VAIO" is a well-known trademark;
3. Revoked the Defendant's registered "VAIO" trademark; and
4. Punished the Defendant to pay for legal proceeding fees as much as Rp 916.000,- (nine hundred sixteen thousand Rupiah).

#### **At the Supreme Court Level (Cassation):**

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