

**CASE NO. 1  
TRADEMARK CASE  
“ST. REGIS”**

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

<b>Case Title</b>	<b>ST REGIS</b>
<b>Summary Of Verdict</b>	<p><b>At the Commercial Court Level</b></p> <ol style="list-style-type: none"> <li>1. Reject the 1st Plaintiff, 2nd Plaintiff and 3rd Plaintiff's lawsuit entirely</li> <li>2. Sanctioned the Plaintiff I, Plaintiff II and Plaintiff III to pay legal proceeding fees as much as Rp 916.000,- (nine hundred and sixteen thousand Rupiah)</li> </ol> <p><b>At the Supreme Court Level (Cassation)</b></p> <ol style="list-style-type: none"> <li>1. Granted the Cassation Application from the Cassation Applicant (The Plaintiff)</li> <li>2. Revoked the judgment of the lower court Nomor 29/Pdt-Sus-Merek/2015/PN.Niaga.Jkt.Pst.</li> </ol>
<b>Case Number</b>	Commercial Court: Nomor 29/Pdt-Sus.Merek/2015/PN.Niaga.Jkt.Pst. Supreme Court Level (Cassation) : Nomor 7 K/Pdt.Sus-HKI/2016
<b>Regulation References</b>	Trademark Law No. 15/2001, Article 6 Paragraph (2) point a and b; Article 4; Article 6 Paragraph (1) point a and b juncto Article 68; Article 69 Paragraph (1) and (2); Article 70 Paragraph (3) juncto Article 71
<b>Keyword</b>	Well-known; trademark; similarity.

**A. CASE FACTS**

- Plaintiff's III is one of the largest hospitality companies in the world that owns the hotel ST. REGIS. Plaintiff's I buy Hotel ST. REGIS from the previous owner in 1960. In 1998 the Plaintiff's III acquired Plaintiff's I together with Hotel ST. REGIS
- Trademark ST REGIS had a history of more than a hundred years for luxury hotel and resort accommodations. In Indonesia, the current trademark of ST. REGIS has been registered on behalf the Plaintiff's I, Plaintiff's II and Plaintiff's III
- Trademark ST REGIS has been registered in 80 countries, including Indonesia for classes 43 and 46. The Plaintiff is the legal owner of the trademark ST. REGIS around the world, including in Indonesia which has been registered on behalf of Plaintiffs I under No. IDM000114829
- Trademark Defendant has similarity with the Trademark ST. REGIS which have registered in advance by the Plaintiff I.
- In 2008, Defendant filed a trademark application for the trademark REGIS@ The Peak at Sudirman.
- There are similiarity between the two trademark, namely :

- a. Both of trademark, clearly the dominant element is the word REGIS;
- b. In the Defendant's trademark, REGIS is a very prominent element than other elements because the first word inherent in the memory of anyone who saw the trademark;
- Trademark REGIS declared as the dominant element when comparing it with the trademark PARK REGIS which resulted in the rejection of trademark PARK REGIS based on invention of similarity.
- Plaintiffs have gained recognition of court decisions and official (from countries such as Singapore) which states that the protection of word REGIS in trademark ST. REGIS belongs to Plaintiffs.
- According to brief explanation of Article 6, paragraph (1) point (b) Law No. 15/2001 concerning Trademark explains the requirements of well-known trademark as follows:
  - a. The general knowledge of the public about the trademark in the field of business concerned;
  - b. Well known trademark reputation gained by a vigorous campaign and a massive;
  - c. Invest in a few countries in the world that do their owned.
  - d. The evidence of the trademark registration in some countries.
- Based on the above, the trademark of ST REGIS owned by Plaintiff are well known trademark because these trademarks meet the criteria of a well-known trademark based explanation from Trademark Law.
- Criteria for well-known trademark in addition based on Trademark Law, WIPO also has its own guidelines on the criteria of well-known trademark as follows:
  - a. The use of the old trademark;
  - b. Appearance trademark has its own characteristics inherent in the public memory;
  - c. Trademark registration in some countries;
  - d. Promotion through advertising, publications and exhibitions constantly;
- Reputation, image, high quality associated with products under trademark marketing and distribution of products under the trademark conducted in almost all countries.
- The Similarity between trademark owned by Defendant and well known trademark ST REGIS owned by Plaintiffs as follows :
  - a. Similarity in visually.
  - b. Similarity in sound
  - c. Similarity in type

## **B. JUDGES CONSIDERATION**

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

The Primary issue made as a basis by the Plaintiff to file a cancellation lawsuit is the use of a trademark namely REGIS @ THE PEAK AT SUDIRMAN considered by the Plaintiff to have similarity in its essentials with the trademark belonging to Plaintiff. For this ground, the Plaintiff filed a cancellation lawsuit towards the trademark certificate for REGIS @THE PEAK AT SUDIRMAN.

- In order to determine such similarity in its principle between the two trademarks, the judges considered the following factors:
  1. There is a similarity in its principle between the two trademark namely:
    - a. On both trademark clearly the dominant element is the word REGIS

- b. In the Defendant's Trademark, REGIS is a very prominent element than other elements because of the word at the beginning will naturally be the first word in the memories attached to anyone who saw the trademark.
- c. Another element in the Defendant's trademark is no similarity Element PEAK simply means "peak" the Indonesian people will understand right away and said "Sudirman" refers to the central business district.
- According to explanation of Article 6 Paragraph (1) point (a) Trademark Law "The meaning of similarity in its principle is similarity caused by the existence of elements that stand between one trademark and another trademark, which can lead to the appearance of good similarity in the form, ways of placement, ways of writing or a combination between elements or similarity in sound contained in those trademark "
- In accordance to evidence-P.1 through P-5 and evidence Defendant T-2 to T-8 can explain that between the two trademarks have similarity in sound. But similarity in writing is not a similarity in its principle because there is a difference between both. However, similarity in writing is not a similarity in its principle due to difference.
- Trademark Regis @The Peak at Sudirman read ST Regis, each of which consists of 22 letters, while ST. REGIS consists of 7 letters with a much different configurations, with a combination of black and red, while the ST. REGIS using black and there is a difference in the preparation of the letters. Therefore, it can not be categorized as a similarity in sound or writing. According to the judges this is no similarity in principle
- Although Plaintiff has registering the trademark to the Defendant I brand ST. REGIS (Evidence P-2) has been granted by the Defendant I (Evidence P-2, P-3, P-4) means through the verification process and substantive research by Defendants I.
- About intention of bad faith which is in argument by Plaintiffs was irrelevant because the trademark REGIS @ THE PEAK AT SUDIRMAN owned by the Defendant has been registered in the General Register of Trademarks and has gone through the processes of inspection formalities, examination of substantive and announcement as stipulated in Law 15 / 2001 concerning Trademark

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

After being unsatisfied with the previous verdict, The Plaintiff filed a Cassation to the Supreme Court, and hereby the Plaintiff is called "CA".

- Judex Facti has misapplied or violated the provision of Article 6 paragraph (1) point (b) of Law No. 15/2001 concerning Trademark on the similarity in its principle. Judex Facti apply principle of similarity which contrary to the Jurisprudence Supreme Court in rulings Supreme Court.
- According to the explanation of Article 4 Trademark Law, that the notion of similarity in its principle is the similarity caused by the existence of elements that stand between one trademark to another trademark so it can give impression the similarity form, a way of placement, ways of writing between elements or similarity in sound contained in these trademark
- According to Doctrine and Jurisprudence, there are three forms of the use of a trademark that can be categorized similarity in its principle namely :
  - a. Similarity in appearance confusing in appearance;
  - b. Similarity in sound
  - c. Similarity in concept

- Of these provisions, in determining the existence of a similarity in its principle must satisfy two elements of the law, namely :
  1. First, define the similarity between one trademark and another trademark to see the elements that stand out in the two trademark.
  2. The similarity of elements that must stand the similarities in form, ways of placement, ways of writing or a combination between elements or similarity in sound in those trademark.
- The dominant element in the trademark ST. REGIS Plaintiff is the word “REGIS”, while the element stands out in Trademark “REGIS @ The Peak at Sudirman” owned by the Defendant is the word “REGIS”, for the following reasons :
  - a. The word “REGIS” is the word at the beginning of the Trademark “REGIS @ The Peak at Sudirman” owned by the Defendant who became the first word spoken and remembered by every person or consumer.
  - b. There are six elements in the Defendant's trademark, that it is impossible for any person or consumers will be able to name all the elements of the "REGIS @ The Peak at Sudirman"
  - c. "REGIS @ The Peak at Sudirman" is intended to mention an apartment block REGIS in "The Peak", a natural element that stands out is REGIS. Even it had registered trademark PEAK AT THE SUDIRMAN filed on June 2, 2005, 3 years before Trademark REGIS @ The Peak at Sudirman who becomes the object of a lawsuit filed and registered and to obtain protection on January 20, 2007.
  - d. It is reasonable to mention of the word element of the first word "REGIS" than the combination of words long subsequent to show information about the location refers to the "REGIS located on The Peak at Sudirman"
- Although Defendants registered Trademark for "REGIS @ The Peak at Sudirman", in fact, based on the actual use of the results showed that the Defendant only use the word "REGIS" to name the building that is being developed.
- From the jurisprudence, then understanding in determining the existence of elements that stand out among that one trademark and other trademark in explaining their “Similarity in its principle” should pay attention to, among others:
  - 1) The existence of elements that stand out are the dominant word and prominent on both trademark.
  - 2) The use of a combination “small” and “large” in both trademark are not the trademark makes no similarity in its principle.
  - 3) The increase in the number of word does not make additions significant on the elements that stand out
  - 4) The similarity in the elements that stand out raises misdirection of the public about the origin of the source from production and quality of goods
  - 5) In determining similarity is by looking for similarities impression as a whole and not compare the difference in parts of trademark
  - 6) In determining similarity in the form, sound and structure are view from the effect in the community, so other trademark which are already known among the public or in a certain groups in society

Based on the above consideration, it is not necessary to consider other reasons of cassation. Further, the Supreme Court considered cancelling the ruling of the Jakarta Pusat Commercial Court No. 29/Pdt-Sus-Merek/2015/PN.Niaga.Jkt.Pst.

### **C. THE VERDICT**

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

1. Granted the 1st Plaintiff, 2nd Plaintiff and 3rd Plaintiff's lawsuit entirely
2. Sanctioned the Plaintiff I, Plaintiff II and Plaintiff III to pay legal proceeding fees as much as Rp 916.000,- (nine hundred and sixteen thousand Rupiah)

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