

**A SMALL NOTE ON SUPREME COURT VERDIT IN THE CASE OF RUSSEL VINCE  
WHO CLAIMS THE SIMILARITY OF TRADEMARK WITH NATIONAL EMBLEM**

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***ABSTRACT***

*This paper is based on research conducted by the author ,at a time when at the time was acted as an expert witness who testified in the trial of the case. There are some authors observe irregularities associated with the judicial process of the lawsuit " Three Les " in Indonesia. First, the case was related to a previous lawsuit filed by SBS on " Badak (Rhino) trademark cancellation by the former licensee three legs namely SBS. Second, the plaintiff did not have the right to sue " Three Legs " trademark registration in Indonesia. Third, this case involves three (3) countries, namely Singapore as the country of origin Wen Ken Drug who trademark owner., Indonesia as a country issued certificate of "Three Legs" on behalf of WKD and Britain as a colonial state Isle of Man is a symbol of the Isle of Man became the object of dispute. The same case has never happened in Indonesia and even possibly in other countries. If the case is not completed correctly will be a bad precedent for trademark enforcement in Indonesia.*

*Keywords: lawsuit, trademark, state symbol or emblem, Three Legs.*

**INTRODUCTION**

In 23 September 2016 there was Supreme Court Decision Number 582 year 2016 on the Judicial Review of Supreme Court Decision Number 582 / Pdt. Sus-Haki/2013<sup>1</sup> that

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Plaintiff is Russel Vince who claimed Trademark cancellation of Defendant Wen Ken Drugs Mark on the basis of “Three Legs” mark owned by WKD resembles the state emblem Isle of Man. It is interesting to take note this Court decision for some reasons.

## **II. SUPREME COURT CONSIDERATION**

In its legal considerations the Supreme Court declared: Section Paragraph (3) b to Law number 15 of 2001 on the Trademark states that: "The petition must also be rejected by the Directorate General, if the brand: a ... and so on, b. an imitation or resembles the name or abbreviation of the name, flag, emblem or symbol or emblem of a state or national and international institutions, unless there is approval of the authorities". In addition, the consideration stated that if there are parties who filed a trademark registration if the mark is an imitation or resembles the name or abbreviation of the name, flag, emblem or symbol or emblem of a state or national agencies or international, unless there is approval of the competent authorities, the Directorate shall reject the application for registration of the trademark, meaning without waiting for complaints by the parties who own state emblem / symbol, then the Directorate prohibited from registering unless the registrant has the permission of the relevant country. The Directorate has ignored this article, so that the registration was canceled primarily to itself or null and void. Further in fact seems clear that the Three Legs is a symbol of the Isle of Man.

## **III. TRADEMARK LAW REFERS TO PARIS CONVENTION AND TRIPS**

Article Paragraph (3 b) Law Number 15 year 2001 on Trademark stated : “application for registration of a trademark must be rejected by the Director if the mark is a clone or a resemble a symbol or emblem of the State except upon the written consent of the appropriate authorities”.

Article 6 of the Law Number 15 year 2001 refers to Article 6 ter of Paris Convention for the Protection of Industrial Property Rights<sup>2</sup>that stated:

***Article 6ter Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations***

*(1)*

*(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.*

*(b)...*

*(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.*

*(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.*

*(3)*

*(a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.*

*(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names,*

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<sup>2</sup> As mentioned in Article 3 of Agreement on Trade Related Aspects of Intellectual Property Rights Including Trade in Counterfeit Goods (TRIPs) that Paris Convention will be the minimum standard....

*of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.*

*(4) Any country of the Union may, **within a period of twelve months from the receipt of the notification, transmit its objections**, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.*

*(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.*

*(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.*

*(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.*

*(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.*

*(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.*

*(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above.*

Furthermore this Article shall be followed by Article 6 ter of the Paris Convention:

Procedural and Selected Legal Aspects which provided by Standing Committee on the Law of Trademark, Industrial Designs and Geographical Indications as follows:<sup>3</sup>

***1. In accordance with Article 6ter(3)(a) of the Paris Convention, the countries party to that Convention have agreed to communicate reciprocally the State emblems and signs falling under Article (1)(a), with the exception of flags, for which they seek protection. A similar procedure applies in respect of signs of international intergovernmental organizations under Article 6ter(3)(b). The International Bureau fulfils the role of an intermediary with regard to the communication of signs and transmits the communications to the States party to the Paris Convention and, in***

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<sup>3</sup> Seventeenth Session, Geneva May 7 to 11, 2007.

accordance with Article 3 of the Agreement Between the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO) of December 22, 1995 (the WIPO/WTO Agreement of 1995), to the Members of the WTO that are not party to the Paris Convention.

**2. Once an official request for protection together with 600 copies of the reproduction of the signs, for which protection is requested, are received by the International Bureau, the International Bureau sends circular letters transmitting the request to the Ministries of Foreign Affairs of the States members of the Paris Union and to the Members of the WTO not party to the Paris Convention. Simultaneously, the International Bureau sends copies of the circular letters to the respective industrial property offices for information.**

#### SELECTED LEGAL ASPECTS

**3. At its sixteenth session, the SCT noted that there were some areas relating to Article 6ter communication procedures where clarification would be beneficial and requested the Secretariat to provide further information about those areas. As regards some issues mentioned by the SCT, reference is made to document SCT/15/3, which addresses in detail a number of legal and administrative aspects of the Article 6ter communication procedure, such as the eligible subject matter (paragraphs 10 to 20), grounds of refusal (paragraph 28), effect of prior trademark rights (paragraph 33, onwards), the role of the International Bureau (paragraphs 40 to 52) and an understanding of the status of the database (paragraphs 60 to 62). This portion of the document will deal with the duration (term) of protection and the procedure for withdrawal of a communication.**

Therefore based on Article 6ter Paris Convention and its procedural and legal selected, there are legal requirements accumulatively with respect to prohibition of use the national emblem as mark as follows:<sup>4</sup>

- 1) The authority to put the prohibition of national emblem attachment into effect must be assigned to a sovereign Country, the fellow members of *Paris Convention 1967*, or the fellow members of *WTO/TRIPs*;
- 2) Such prohibition shall only be effective when the symbol attachment indicates that there is a connection between the concerned organization and things those are attributed to the

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<sup>4</sup> Rahmi Jened, *Hukum Merek Dalam Era Global dan Interaksi Ekonomi ( Trademark Law in Global Era and Economic Integration )*, Prenada Media Jakarta, 2015, p.127-128.

national emblem..., or when the attachment or registration thereof is aimed to deceive the public;

- 3) Such prohibition must be applied by serving a notification to all countries those are the members of Paris Convention and/or WTO/TRIPs to International Bureau of World Intellectual Property Organization (WIPO);
- 4) Any objections against the attachment of national symbol must be proposed within 12 (twelve) months after receiving the notification in the country where the objection is proposed.

#### **IV. SUPREME COURT RULING INJUSTICE**

There are some reasons that I thinks the Supreme court Decision was not fair. My expectations as a practitioner and lecturer of IP course, this decision if it will be concentrated in a good precedent for the enforcement of IP, but if mistaken certainly not elegant, and the resulting legal authority in Indonesia is 'meddle' by other people or other countries that are not clearly its legal right to sued.

Firstly, RV who ordinary person from Isle of Man the colony of United Kingdom claiming to represent the state of United kingdom before the court of sovereign country of Republic Indonesia. According to the opinion of the writer, who at the time becomes the expert witness and gives the following statement: “the claim of RV cannot be approved of since it does not meet the legal requirements thereof due to some arguments. First, *Isle of Man* is **not** a sovereign country, is not the member of **Paris Convention**, and is not the member of

**WTO/TRIPs** either. Even in *a-quo* case, there are some countries involved, namely: Indonesia<sup>5</sup>, Singapore<sup>6</sup>, and England (United Kingdom)<sup>7</sup>, all of which are the members of the Paris Convention and the WTO. It means that in such *a-quo* case, *Isle of Man* is not the authorized party according to Article 6 of Paris Convention.

Second, **there is not any action of WKD and its certificate as the cancellation object of *a-quo* case indicates any connection with *Isle of Man*. There is not any action of WKD and its certificate as the object of *a-quo* case has deceived the public. The claim proposed by consumers throughout Indonesia shall be the illegal reason that in fact can constitute false evidence<sup>8</sup>.** The use of symbol by WKD does not indicate any connection between the concerned company and things those are attributed to *Isle of Man*. The use of symbol by WKD does not deceive the public either. In fact, England (United Kingdom) considers there is not any substantial interest with its colony, *Isle of Man* that is found to have any connection with the symbol of *Isle of Man*. England just sees a greater interest with respect to Singapore as its ex-colony that has been developed into a sovereign Country that is thriving in Asia. It is known that WKD is a Singaporean company that already used such mark from 1935.<sup>9</sup> and already recognized as *National Heritage Corporation of Singapore*<sup>10</sup>. In addition, England does not seem

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<sup>5</sup> Republic of Indonesia is the member of *Paris Convention* by virtue of Presidential Decree No.17/1997 and becomes the member of *WTO/TRIPs* by virtue of Laws No.7/1994.

<sup>6</sup> Singapore is the member of *Paris Convention* and *WTO/TRIPs* as from November 23, 1994, which is effective on February 23, 1995.

<sup>7</sup> United Kingdom (England) is the member of *Paris Convention* as from March 17, 1884, which is effective on July 7, 1884, and becomes the member of *WTO/TRIPs* on January 1, 1995.

<sup>8</sup> There was no consumer survey. **Practically in developed countries, this is assumed as contempt of court crime.**

<sup>9</sup> The first WKD's product with glass bottle container.

<sup>10</sup> *Singapore Prestige Brand Award 2008 – Heritage Branch category (Awarded to Three Legs Brand).*

to be ignorant of the fact that Republic of Indonesia is a sovereign Country and it is not the former colony of England either. Thereby, England has a greater interest in Indonesia than in *Isle of Man*.

Third, even though when it is said that the interest of Isle of Man is represented by England (United Kingdom), the legal fact proves that England has never proposed any Notification of Isle of Man symbol as the prohibited symbol to WIPO International Bureau. England has been the member of, effectively applied Paris Convention since July 7, 1884, has been the member of, and effectively applied WTO/TRIPs since 1995. It only serves a notification for the symbol of its own.<sup>11</sup> England is recorded as the country that affairs of state practice and international association is well known among the other countries, so that it is not possible that England ignores this notification responsibility to put national symbol attachment prohibition into effect.

Fourth, **there is not any objection proposed by England (United Kingdom)** with respect to the attachment of its colony symbol, *Isle of Man*, by an organization or company in other countries of *Paris Convention* or *WTO/TRIPs* members. The objection is proposed **within 12 (twelve) months following the notification** aforementioned in **Point (3)** to other countries of fellow members of Paris Convention or WTO/TRIPs. In a-quo case, there is not any proposal of England objection within 12 (twelve) months as from the notification to the State Government of Indonesia as the country that issues the certificate with respect to a-quo. There is not any proposal of England objection within 12 (twelve) months as from the notification to the State Government of Singapore as the native country of WKD although **England, Singapore and Republic of Indonesia are fellow members of Paris Convention and fellow members of WTO/TRIPs.**

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<sup>11</sup> Based on the Legal Document of Guidelines for Trademark Examiner that provided by Directorate General of Intellectual Property Office (DGIP) Ministry of Law and Human Rights that presented by Ibu Emmawati Yunus, SH., MH that former Director of Trademark Office

Thereby, *Three Legs* certificate achieved in Singapore and Indonesia has met both formal and material requirements and both absolute and relative grounds of refusal of trademark registration. It is because there is not any single document that can be used as the standard of comparison by the Intellectual Property office (IPOS) of Singapore and the Intellectual Property General Directorate of Indonesia with respect to the *Isle of Man* symbol in the Notification List published by WIPO International Board. The list is published by referring to the notification from the country members and the lacking of objection proposal within the period of 12 (twelve) months following the notification. It shall discharge the right of the country to establish any prohibitions according to Article 6 of *Paris Convention*. In addition, RV is not the interested party since it does not have any legal standing. It is shown by the provision stated in Article 68, verse 10 of Laws No.15/2001 as follows: “A claim to cancel trademark registration must be proposed by the interested party....” The interested party according to Black’s Law Dictionary is: <sup>12</sup>

In a-quo case that is related to the applying legal principle: “**There is not any claim without any interest (Point the interest, point the action, no interest, no claim)**.”<sup>13</sup> It means that a man or a group of men can have the authority to claim if there is a legal interest, namely proprietary interest or damages directly experienced by the claimant (*injury in fact*).<sup>14</sup>

In a-quo case, because the claim is based on Article 6 Paragraph (b) of Law number 15 year 2001 with respect to the symbol of certain country, it shall be necessary to question the legal

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<sup>12</sup> Henry Campbell Black, Op. Cit. h.1122.

<sup>13</sup> Ian Mc Leod, 2006: 106 – 108.

<sup>14</sup> The claimant capacity vides Article 6, verse (3) of Laws No.15/2001 must be as the state officer of sovereign country.

interest of RV, which is made on behalf of a never land, *Isle of Man*, and even England (*United Kingdom*).

**A state officer who has the full authority as the state officer of sovereign country and is able to show legitimate state evidence must represent a sovereign country that is<sup>15</sup> :** : “the state officer who holds elective or appointive position in the state administration)”.

with the following description. In addition, according to WPO Standing Committee regarding Procedures Manual and Selected Legal Aspects to apply and perform Article 6 ter of *Paris Convention*, a state officer who acts as the authorized party shall refer to the Ministry of Foreign Affairs. The lacking of legal interest, which purposes a claim randomly, can be practically considered as a contempt of court in a developed country.

## V. CONCLUSION

The state should provide full support in case of arbitrary acts against citizens in ASEAN countries. To a rethinking of legal means to regulate the unfair competition prevention law, competition law and intellectual property law at the level of ASEAN.

It's also important a specific recommendations related to several articles that regulate the relative grounds, the absolute grounds of trademark registration and is also related to the implementation of well-known marks, collective marks and geographical indications.

in the framework of AEC, it is necessary to establish the ASEAN Court of Justice to provide the highest decision related to Intellectual Property cases among ASEAN countries,

In addition to the competition commission was to be formed ASEAN level n to supervise the IP owner not to act anti-competitive .

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<sup>15</sup> Henry Campbell Black, Op. Cit. h.1122.

It's also need for ratification of Brussel Convention on jurisdiction and Enforcement of Judgment in civil and Commercial Matters to cope in the event of conflicts of jurisdiction in IP case.