

Official Copy of

~~Copy of~~

The Decision of Commercial Case
in the Level :

- **First**
~~— Cassation~~
~~— P.K~~

From: The Commercial Court of Central Jakarta
~~Supreme Court of the Republic of Indonesia~~

Decided on : May 13, 2014

Number : 08/Pdt.Sus/Merek/2014/PN.Niaga.Jkt.Pst

Recorded herein:

- At the time the decision was pronounced by the Panel of Judges of Commercial Court at the District Court of Central Jakarta, the Plaintiff appeared its legal representatives while the Defendant did not appear.
- The Defendant was notified via *Bisnis Indonesia* Daily dated June 04, 2014

- N o t e :

- Whereas after we examining in the Registry Book intended for that purpose, neither of the two Parties appealing to the supreme court within the period specified under Law No. 15 of 2001 regarding Mark.



Made in accordance with the original on : June 30, 2014

This official copy of decision is issued on : June 30, 2014

copy

On the request of : *the Plaintiff's Legal Representatives*

On behalf of the Chairman of District /

Commercial Court of Central Jakarta

Deputy Clerk

(Stamp, signed)

WATTY WIARTI, SH. MH.

NIP. 19630327 198503 2 002

Paid in cash

On: June 30, 2014

- Writing Wage : Rp. 7,500.00
- Stamp Duty : Rp. 6,000.00

T o t a l Rp. 13,500.00

700.00

Note:

- Pick up as required, always adjust the date and the Decision Number as well as the Name - Registered Name on the Folder of Official Copy / Copy of **Decision / Determination on the First Page** to those stated on this Sheet.



D E C I S I O N

NUMBER: 08/Pdt.Sus-MEREK/2014/PN.NIAGA.JKT.PST

FOR JUSTICE BASED ON THE BELIEF IN THE ONE ALMIGHTY GOD

The Commercial Court at the District Court of Central Jakarta investigating and administering justices to the Mark case has passed the following decision in a case filed by:

DOCTOR'S ASSOCIATES INC., a limited liability company duly organized and existing under the Laws of the United States of America, domiciled in Connecticut - U.S.S., having its address on 325 Bic Drive, Milford, Ct 06461, U.S.A. in this case represented by its legal representatives, **Damar Swarno Dwipo, S.H., M.H.**, and **Miftahul Hilmi, S.H., M.H.**, the Advocates with their registered office at Kantor Hukum Dwipo, Lubis & Partners, having its address at Gedung Anakinda, Lantai 6, Jl. Prof. Dr. Soepomo, S.H., No. 27, Tebet - Jakarta 12810, Indonesia, based on the Special Power of Attorney dated September 25, 2012, hereinafter referred to as :
PLAINTIFF;

A G A I N S T :

YOHANES WENDY TJIOE, residing in North Jakarta - Indonesia, having his address on Jl. Pluit Timur Blok T



Sel/52. RT. 002/009, Jakarta Utara. Hereinafter referred to as **DEFENDANT**:

The above Commercial Court;

After reading the case files;

After examining the documentary evidences;

REGARDING THE FACTS OF THE CASE

Considering that the Plaintiff by its statement of claim dated February 19, 2014, registered with the Clerk Office of Commercial Court of Central Jakarta on February 19, 2014, under the case Register Number: 08/PDT.Sus-MEREK/2014/PN.NIAGA.JKT.PST, has filed a motion against the Defendant to cancel the mark registered in the name of the Defendant on the grounds as follows:

1. Whereas the Plaintiff is a well-known company from Connecticut, United States of America and also the sole owner and the first user of the trademark & service mark "SUBWAY" which has been **internationally well-known** (Exhibit P-1).
2. Whereas the Plaintiff's **well-known mark "SUBWAY"** has been protected by the laws and regulations applicable in Indonesia, particularly Law No. 15 of 2001 regarding Mark as well as by the international conventions, particularly



TRIPs Agreement and Paris Convention which have been ratified by Indonesia, therefore the Plaintiff obviously possesses the sole right to use the trademark & service mark "**SUBWAY**" in Indonesia, of which the function is to distinguish the products or services of the Plaintiff from the products or services of other parties.

3. Whereas the Plaintiff's **well-known mark "SUBWAY"** has also been affirmed by the Decision of the Commercial Court of Central Jakarta No. 28/MEREK/2009/PN.NIAGA.JKT.PST strengthened by the Decision of the Supreme Court of the Republic of Indonesia No. 736 K/Pdt.Sus/2009 stating that **"The Plaintiff is the sole owner and the first user of the mark "SUBWAY" which has been internationally well-known, therefore the Plaintiff possesses the sole right to use the aforesaid mark "SUBWAY" (Exhibit P-2).**
4. Whereas the word "**SUBWAY**" was invented by the Plaintiff and deliberately made as trademark & service mark by the Plaintiff, in order to enable the consumers or the public to **distinguish** the products or services of the Plaintiff coming from Connecticut, United States of America from the products or services of the other parties.
5. Whereas the Plaintiff has registered the trademark & service mark "**SUBWAY**" in many countries, among others in:



01. United States of America, class 42, No. 1,174,608, dated October 20, 1981 (Exhibit P-3);
02. United States of America, classes 30 & 32, No. 1,307,341, dated November 27, 1984 (Exhibit P-4);
03. United States of America, class 42, No. 1,524,986, dated February 14, 1989 (Exhibit P-5);
04. United States of America, classes 35 & 42, No. 4,209,543, dated September 18, 2012 (Exhibit P-6);
05. United States of America, classes 35 & 42, No. 4,209,548, dated September 18, 2012 (Exhibit P-7);
06. United States of America, classes 9 & 35, No. 4,210,120, dated September 18, 2012 (Exhibit P-8);
07. United Kingdom, class 43, No. 5814, dated December 27, 1989 (Exhibit P-9);
08. United Kingdom, classes 30, 32 & 43, No. 6270, dated February 26, 1999 (Exhibit P-10);
09. Australia, class 42, No. 469418, dated July 22, 1987 (Exhibit P-11);
10. Australia, class 42, No. 469419, dated July 22, 1987 (Exhibit P-12);
11. New Zealand, class 42, No. 194752, dated July 17, 1989 (Exhibit P-13);



12. New Zealand, class 42, No. 295067, dated July 13, 1998 (Exhibit P-14);
13. New Zealand, class 35, No. 820758, dated March 10, 2010 (Exhibit P-15);
14. New Zealand, class 35, No. 820760, dated March 10, 2010 (Exhibit P-16);
15. Singapore, class 42, No. T95/08869Z, dated September 18, 1995 (Exhibit P-17);
16. Malaysia, class 43, No. 97018852, dated December 01, 1997 (Exhibit P-18);
17. Papua New Guniea, class 42, No. A 59, 517, dated May 28, 1996 (Exhibit P-19);
18. Philippine, class 42, No. 49768, dated January 28, 1991 (Exhibit P-20);
19. Canada, class 42, No. TMA323,814, dated February 20, 1987 (Exhibit P-21);
20. Japan, classes 29, 30 & 31, No. 2251034, dated July 30, 1990 (Exhibit P-22);
21. Islamic Republic of Iran, classes 29, 30, 31, 32, 35 & 39, No. 184497, dated April 26, 2008 (Exhibit P-23);



22. Republic of Lebanon, classes 29, 30, 35 & 43, No. 58709, dated August 21, 1992 which has been renewed on September 22, 2007 under Renewal No. 112924 (Exhibit P-24);
23. Federal Republic of German, classes 29, 30 & 43, No. 395 14 988, dated April 6, 1995 (Exhibit P-25);
24. Russian Federation, class 42, No. 96915, dated October 17, 1990 (Exhibit P-26);
25. Mexico, class 42, No. 376294, dated June 12, 1989 (Exhibit P-27);
26. Republic of Indonesia, class 30, Registration No. 280548, dated October 05, 1992 which has been renewed on October 28, 2002 with Renewal No. 519178 and renewed further on April 24, 2012 with Renewal No. IDM000368823 (Exhibit P-28);
27. Republic of Indonesia, class 32, Registration No. 280548, dated October 05, 1992 which has been renewed on October 28, 2002 with Renewal No. 519179 and renewed further on April 24, 2012 with Renewal No. IDM000368814 (Exhibit P-29);
28. Republic of Indonesia, class 43, Registration No. IDM000281385, dated November 23, 2010 (Exhibit P-30);



6. Whereas the Plaintiff's trademark & service mark "**SUBWAY**" is undoubtedly an internationally well-known mark, since in addition to their registrations in the above countries, the Plaintiff's trademark & service mark "**SUBWAY**" have also been registered in several other countries, namely: Afghanistan, Algeria, Andorra, Angola, Antigua & Barbuda, Argentina, Aruba, Austria, Azerbaijan, Bahama Islands, Bahrain, Bangladesh, Barbados, Belarus, Belize, Benelux, Bermuda, Bolivia, Bosnia-Herzegovina, Brazil, Brunei, Bulgaria, Cambodia, Canada, Cayman Islands, Chile, China, Colombia, Costa Rica, Croatia, Cuba, Cyprus, Czech Republic, Denmark, Djibouti, Dominica, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, European Community, Falkland Island, Fiji, Finland, France, Georgia, Ghana, Gibraltar, Greek, Grenada, Guatemala, Honduras, Hong Kong, Hungary, Iceland, India, Ireland, Israel, Italy, Jamaica, Jordan, Kazakhstan, Kenya, Kuwait, Kyrgyz, Laos, Latvia, Lebanon, Liberia, Liechtenstein, Lithuania, Macau, Macedonia, Madrid Protocol, Malawi, Malta, Mauritius, Moldova, Monaco, Mongolia, Montenegro, Morocco, Namibia, Netherland Antilles, Nicaragua, Norway, OAPI, Oman, Pakistan, Panama, Paraguay, Peru, Poland, Portugal, Qatar, Romania, Saudi Arabia, Serbia, Slovak Republic, Slovenia, South Africa, South Korea, Spain, Sri Lanka, St. Helena, St. Kitts-Nevis, St. Lucia, St. Vincent & the



Grenadines, Suriname, Swaziland, Sweden, Switzerland, Taiwan, Tajikistan, Tangier, Tanzania, Thailand, Trinidad & Tobago, Tunisia, Turkey, Turks & Caicos, Ukraine, United Emirates Arab, Uruguay, Venezuela, Vietnam, Yemen, Zambia, Zanzibar, Zimbabwe (Exhibit P-31).

7. Whereas in addition to the trademark & service mark "**SUBWAY**" which have been registered in the countries specified above, the Plaintiff has also filed an application for registration of the mark "**SUBWAY**" to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 under Agenda No. J002012048402 to protect the services included in class 35, namely stores, wholesale agents, wholesale services and retailers relating to the services in providing foods and beverages for consumers (Exhibit P-32).

8. Whereas it has come to the attention of the Plaintiff, that the Defendant **without the prior consent** of the Plaintiff has registered the mark "SUBWAY" with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia under Registration No. IDM000349842, on February 29, 2012 to protect the services included in class 35, namely stores, department stores, supermarkets, minimarkets, wholesale agents (Exhibit P-33).



9. Whereas the Plaintiff **highly objects** the registration of mark "SUBWAY" under Registration No. IDM000349842 registered by the Defendant (Vide Exhibit P-33), since the mark "SUBWAY" of the Defendant clearly **has substantial and entire similarity for similar or unsimilar services** to the mark "SUBWAY" of the Plaintiff, either from **the shape, positioning, writing, combination of elements or from the pronunciation**. This has clearly proven **bad faith** of the Defendant to **take-over** the Plaintiff's mark "SUBWAY" and or to **share the fame, imitate, and counterfeit** the Plaintiff's mark "SUBWAY" which has been internationally well-known and registered in many Countries (Vide Exhibit P-2 to P-31), therefore the registration of mark "SUBWAY" by the Defendant should be classified as **a registration with bad faith**, and therefore **does not deserve any legal protection**, as specified in **Article 4 (as elaborated)in conjunction with Article 6 paragraph (1) letter a and b (as elaborated)in conjunction with Article 6 paragraph (2) of Law No. 15 of 2001 regarding Mark**.

10. Whereas since the Defendant's mark "SUBWAY" is very similar to the Plaintiff's mark "**SUBWAY**", if both marks are used concurrently in businesses, they will certainly create a **condition of unfair competition, deceiving, or misleading the public** as the consumers who will consider



that the services from the Defendant using the mark "SUBWAY" are services from the Plaintiff and this will certainly be very detrimental to the Plaintiff.

11. Whereas it is hard to imagine other intention of the Defendant registering the mark "SUBWAY" which is substantially and entirely similar to the Plaintiff's mark "SUBWAY", but only to **share the fame, imitate, counterfeit, and taking advantage unilaterally from the fame of the Plaintiff's mark "SUBWAY"** which has been painstakingly developed by the Plaintiff for many years at great cost, including the expenses to obtain legal protection to the mark "SUBWAY" in many countries as well as the promotional/ advertisement costs in order to introduce the products and services to the whole world (Exhibit P-34).

12. Whereas since the Plaintiff is the **soleowner and the first user** of the mark "SUBWAY" which has been internationally well-known and since the Plaintiff has also **filed an application for registration of the mark "SUBWAY"** to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 under Agenda No. J002012048402 to protect the services included in class 35, namely stores, wholesale agents, wholesale services and retailers relating to the services in



providing foods and beverages for consumers (Exhibit P-32), then the Plaintiff has a strong **legal ground** to **file a motion for cancellation of registration of the mark "SUBWAY"** under Registration No. IDM000349842 in the name of the Defendant, as referred to in **Article 68 paragraph (1) and paragraph (2) in conjunction with Article 4, Article 6 paragraph (1) letter a and b and Article 6 paragraph (2) of Law No. 15 of 2001 regarding Mark.**

13. Whereas in view of the fame of the Plaintiff's mark "**SUBWAY**" and since the Defendant's mark "SUBWAY" has similarity to the Plaintiff's mark "**SUBWAY**", it should be believed that if both marks are used concurrently in businesses, they will certainly create a **condition of unfair competition, deceiving, or misleading the public** as the consumers who will consider that the services from the Defendant using the mark "SUBWAY" are services from the Plaintiff and this will certainly be very detrimental to the Plaintiff . Based on the aforesaid matters, the Plaintiff also **has strong legal grounds to request the cancellation of registration of the mark "SUBWAY"** under Registration No. IDM000349842 in the name of the Defendant.

14. Whereas the Plaintiff pleads with the Panel of Judges of the Commercial Court of Central Jakarta to **order** the Directorate General of Intellectual Property of the



Ministry of Law and Human Rights of the Republic of Indonesia to **cancel the registration of the mark "SUBWAY"** under Registration No. IDM000349842 in the name of the Defendant from the General Register of Marks, and further to announce the cancellation of the registration of the said mark in Mark Gazette, as referred to in **Article 70 paragraph 3 in conjunction with Article 71 of Law No. 15 of 2001 regarding Mark.**

Based on the aforesaid grounds, the Plaintiff pleads with the Panel of Judges of the Commercial Court of Central Jakarta, to decide as follows:

1. To grant the Plaintiff's motion entirely;
2. To declare that the Plaintiff is the sole owner and the first user of the mark "**SUBWAY**" which has been internationally well-known, therefore the Plaintiff has the exclusive right to use the mark "**SUBWAY**";
3. To declare that the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant has both substantial and entire similarity to the Plaintiff's mark "**SUBWAY**";
4. To declare the cancellation of registration of the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant with all the legal consequences;



5. To order the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia to cancel the registration of mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant from the General Register of Marks, and further to announce the cancellation of the registration of the said mark in Mark Gazette;
6. To penalize the Defendant to pay the court costs.

Or, if the Panel of Judges of the Commercial Court of Central Jakarta has any other opinion, the Plaintiff request the Panel of Judges to decide in justice and fairness (*ex aequo et bono*).

Considering that on the pre-appointed hearing day, for:

The Plaintiff appeared its legal representatives **Damar Swarno Dwipo, S.H., M.H.**, and **Miftahul Hilmi, S.H., M.H.**, the Advocates with their registered office at Kantor Hukum Dwipo, Lubis & Partners, having its address at Gedung Anakinda, Lantai 6, Jl. Prof. Dr. Soepomo, S.H., No. 27, Tebet - Jakarta 12810, Indonesia, based on the Special Power of Attorney dated September 25, 2012;

The Defendant did not appear nor send any authorized person as its representative in the hearing, though the Defendant has been legally and dully summoned according to the court summons No.



08/Pdt.Sus/Merek/2014/PN.Niaga.Jkt.Pst dated February 08, 2014 and general summons published in Bisnis Indonesia newspaper dated March 10 and 20, 2013, this investigation is - without the presence of the Defendant - proceeded with the reading of the Plaintiff's statement of claim and for the questions of the Presiding Judge, the Plaintiff's legal representatives stated to remain on their motion arguments;

Considering that the Plaintiff has submitted documentary evidences in the form of copies of documents, duly stamped in accordance with the applicable laws and regulations, and verified against the original copy, as follows:

1. Exhibit P-1 : Original; Affidavit of the Plaintiff legalized by a Public Notary of the State of Connecticut, United States of America, dated November 21, 2013 stating that the Plaintiff is a well-known company from Connecticut, United States of America and also the sole owner and the first user of the trademark & service mark "**SUBWAY**" which has been internationally well-known.

Exhibit P-1A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-1.



2. Exhibit P-2 : Verified copy in accordance with the original; Official Copy of the Decision of the Commercial Court of Central Jakarta No. 28/MEREK/2009/PN.NIAGA.JKT.PST strengthened by the Jurisprudence/ Decision of the Supreme Court of the Republic of Indonesia No. 736 K/Pdt.Sus/2009 between the Plaintiff against the Defendant of which one of the decision points in the principal case stating that the **"Plaintiff" is the sole owner and the first user of the mark "SUBWAY" which has been internationally well-known, therefore the Plaintiff has the exclusive right to use the said mark "SUBWAY".**

3. Exhibit P-3 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, class 42, No. 1,174,608, dated October 20, 1981 legalized by the Certifying Officer under the authority of the Secretary of Chamber of Commerce of the United States



Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-3A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-3.

4. Exhibit P-4 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, classes 30 & 32, No. 1,307,341, dated November 27, 1984 legalized by the Certifying Officer under the authority of the Secretary of Chamber of Commerce of the United States Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-4A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-4.

5. Exhibit P-5 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, class 42, No. 1,524,986, dated February 14, 1989 legalized by the Certifying Officer under the authority of the Secretary of



Chamber of Commerce of the United States Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-5A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-5.

6. Exhibit P-6 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, classes 35 & 42, No. 4,209,543, dated September 18, 2012 legalized by the Certifying Officer under the authority of the Secretary of Chamber of Commerce of the United States Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-6A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-6.

7. Exhibit P-7 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, classes 35 & 42, No. 4,209,548, dated September 18, 2012 legalized by the Certifying Officer



under the authority of the Secretary of Chamber of Commerce of the United States Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-7A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-7.

8. Exhibit P-8 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United States of America, classes 9 & 35, No. 4,210,120, dated September 18, 2012 legalized by the Certifying Officer under the authority of the Secretary of Chamber of Commerce of the United States Intellectual Property and the Director of the United States Patent and Trademark Office.

Exhibit P-8A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-8.

9. Exhibit P-9 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United Kingdom, class 43, No. 5814, dated December 27, 1989 legalized by the



General Commissioner of Patent, Design and Trademark of the United Kingdom Intellectual Property Office.

Exhibit P-9A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-9.

10. Exhibit P-10 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the United Kingdom, classes 30, 32, & 43, No. 6270, dated February 26, 1999 legalized by the General Commissioner of Patent, Design and Trademark of the United Kingdom Intellectual Property Office.

Exhibit P-10A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-10.

11. Exhibit P-11 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Australia, class 42, No. 469418, dated July 22, 1987 legalized by the Trademark Registrar of the Australia Trademark Office.

Exhibit P-11A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-11.



12. Exhibit P-12 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Australia, class 42, No. 469419, dated July 22, 1987 legalized by the Trademark Registrar of the Australia Trademark Office.

Exhibit P-12A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-12.

13. Exhibit P-13 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in New Zealand, class 42, No. 194752, dated July 17, 1989 legalized by the Commissioner of Patent, Trademark and Design of the New Zealand Intellectual Property Office.

Exhibit P-13A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-13.

14. Exhibit P-14 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in New Zealand, class 42, No. 295067, dated July 13, 1998 legalized by the Commissioner of Patent, Trademark and



Design of the New Zealand Intellectual Property Office.

Exhibit P-14A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-14.

15. Exhibit P-15 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in New Zealand, class 35, No. 820758, dated March 10, 2010 legalized by the Assistant Commissioner of Trademark of the New Zealand Intellectual Property Office.

Exhibit P-15A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-15.

16. Exhibit P-16 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in New Zealand, class 35, No. 820760, dated March 10, 2010 legalized by the Assistant Commissioner of Trademark of the New Zealand Intellectual Property Office.

Exhibit P-16A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-16

17. Exhibit P-17 : Verified copy in accordance with



the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Singapore, class 42, No. T95/08869Z, dated September 18, 1995 legalized by the Trademark Registrar of the Singapore Trademark Office.

Exhibit P-17A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-17.

18. Exhibit P-18 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Malaysia, class 43, No. 97018852, dated December 01, 1997 legalized by the Trademark Registrar of the Malaysia Intellectual Property Agency.

Exhibit P-18A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-18.

19. Exhibit P-19 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Papua New Guinea, class 42, No. A 59, 517 dated May 28, 1996 legalized by the Trademark Registrar of the Papua New Guinea Intellectual Property Office.

Exhibit P-19A : Certified and sworn translation in



Bahasa Indonesia of the Exhibit P-19.

20. Exhibit P-20 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Philippine, class 42, No. 49768, dated January 28, 1991 legalized by the Trademark Registrar under the authority of the Director of Trademark Bureau of the Philippines Intellectual Property Office.

Exhibit P-20A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-20.

21. Exhibit P-21 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Canada, class 42, No. TMA323,814, dated February 20, 1987 legalized by the Certifying Officer of the Canada Intellectual Property Office.

Exhibit P-21A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-21.

22. Exhibit P-22 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Japan, classes 29, 30 & 31, No. 2251034,



dated July 30, 1990 legalized by the Commissioner of Patent of the Japan Intellectual Property Office.

Exhibit P-22A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-22.

23. Exhibit P-23 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the Islamic Republic of Iran, classes 29, 30, 31, 32, 35 & 39 No. 184497, dated April 26, 2008 legalized by the Head of Registration and Intellectual Property of the Iran Intellectual Property Office.

Exhibit P-23A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-23

24. Exhibit P-24 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the Republic of Lebanon, classes 29, 30, 35 & 43 No. 58709, dated August 21, 1992 which has been renewed on September 22, 2007 under Renewal No. 112924 legalized by the Head of Lebanon Intellectual Property Office.



- Exhibit P-24A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-24.
25. Exhibit P-25 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the Federal Republic of German, classes 29, 30 & 43 No. 395 14 988, dated April 6, 1995 legalized by the Certifying Officer of the German Patent and Trademark Office.
- Exhibit P-25A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-25.
26. Exhibit P-26 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in the Russian Federation, class 42, No. 96915, dated October 17, 1990 legalized by the Head of the Russian Patent Office.
- Exhibit P-26A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-26.
27. Exhibit P-27 : Verified copy in accordance with the original; Copy of the Certificate of Registration of the Plaintiff's Mark in Mexico, class 42, No. 376294, dated June



12, 1989 legalized by the Certifying Officer of the Mexico Intellectual Property Office.

Exhibit P-27A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-27.

28. Exhibit P-28 : Copy of the Certificate of Registration of the Plaintiff's Mark in the Republic of Indonesia, class 30, Registration No. 280548, dated October 05, 1992, renewed on October 28, 2002 under Renewal No. 519178 and renewed further on April 24, 2012 under Registration No. IDM000368823 and verified as a true copy by the Head of Mark Administration Sub-Section (on behalf of the Director of Mark), the Directorate General of Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia.

29. Exhibit P-29 : Copy of the Certificate of Registration of the Plaintiff's Mark in the Republic of Indonesia, class 32, Registration No. 280548, dated October 05, 1992, renewed on October 28, 2002 under Renewal No. 519179 and renewed further on April 24,



2012 under Registration No. IDM000368814 and verified as a true copy by the Head of Mark Administration Sub-Section (on behalf of the Director of Mark), the Directorate General of Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia.

30. Exhibit P-30 : Copy of the Certificate of Registration of the Plaintiff's Mark in the Republic of Indonesia, class 43, Registration No. IDM000281385, dated November 23, 2010 and verified as a true copy by the Head of Mark Administration Sub-Section (on behalf of the Director of Mark), the Directorate General of Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia.

31. Exhibit P-31 : Original; All international registrations of the Plaintiff's trademark and service mark "**SUBWAY**" in some countries, verified as true copy and legalized by a Public Notary of the State of Connecticut, United States of



America, on February 7, 2013.

Exhibit P-31A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-31.

32. Exhibit P-32 : Verified copy in accordance with the original; Application for registration of the mark "**SUBWAY**". Agenda No. J002012048402, dated October 10, 2012 filed by the Plaintiff to the Directorate General of Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia to protect the services included in class 35, namely stores, wholesale agents, wholesale services and retailers relating to the services in providing foods and beverages for consumers.

33. Exhibit P-33 : Copy of the Certificate of the Defendant's Mark in the Republic of Indonesia, class 35, Registration No. **IDM000349842**, dated February 29, 2012 which has been verified as a true copy by the Head of Mark Administration Sub-Section (on behalf of the Director of Mark), the Directorate General of



Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia.

34. Exhibit P-34 : Original; Advertisements of the Plaintiff's trademark & service mark "SUBWAY" in various printed media **which have been published by the Plaintiff long before the Defendant who, without prior consent from the Plaintiff,** registering the mark "SUBWAY" to the Directorate General of Intellectual Property of the Department of Law and Human Rights of the Republic of Indonesia under Registration No. **IDM000349842**, dated February 29, 2012 to protect the services included in class 35, namely stores, wholesale agents, wholesale services and retailers relating to the services in providing foods and beverages for consumers.

35. Exhibit P-35 : Copy of License Agreement, Assignment Agreement and Sub-License Agreement legalized by a Public Notary of the State of Connecticut, United States of America, dated June 13, 2013 stating



that the Plaintiff has licensed its subsidiary, SUBWAY INTERNATIONAL B.V., to open "SUBWAY" restaurants or outlets in many countries in the world and to promote the system of and trademark & service mark "SUBWAY" of the Plaintiff by entering into main franchise agreement, franchise agreement or development agent agreement, of which the benefits are for reputation, goodwill, and profits for the Plaintiff.

Exhibit P-35A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-35.

36. Exhibit P-36 : Original; Document of Franchise Offer for Prospective Franchisee legalized by a Public Notary of the State of Connecticut, United States of America, dated June 13, 2013 specifying the list of "SUBWAY" restaurants or outlets in many countries in the world.

Exhibit P-36A : Certified and sworn translation in Bahasa Indonesia of the Exhibit P-36.

37. Exhibit P-37 : Jurisprudence / Decision of Supreme Court of the Republic of Indonesia No. 020 K/N/HaK1/2006 downloaded by the



Plaintiff from the Official Website of the Supreme Court of the Republic of Indonesia

(<http://putusan.mahkamahagung.go.id/main/pencarian/?q=yong+ma>) of which some of the decision points stating that **"the mark YONG MA in the name of the Defendant under Registration No. 382737 and No. 424169 has substantial similarity to the mark YONG MA of the Plaintiff and stating the cancellation of the registration of the Defendant's mark under Registration No. 382737 and No. 424169 with all the legal consequences"**, despite the products protected by the mark YONG MA in the name of the Defendant under Registration No. 382737 and No. 424169 are not similar to those protected by the mark YONG MA of the Plaintiff with one of legal considerations that the mark YONG MA of the Plaintiff is **an internationally well-known mark.**

38. Exhibit P-38 : Copy of Article 68 paragraph (1) and paragraph (2), Article 4, Article 6



paragraph (1) letter a and b and Article 6 paragraph (2) of Law No. 15 of 2001 regarding Mark as elaborated which are **the legal grounds for the Plaintiff** in filing a motion for cancellation of the registration of the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant.

Considering that further the Plaintiff has offered its conclusion on April 29, 2014 and the detailed attached to this case file;

Considering that further the Plaintiff stated not to filing anything else and asked for a decision;

Considering, that to make the description of this decision brief, anything took place and contained in the minutes of proceedings of this case should be considered included and integral part of this decision;

REGARDING THE LEGAL CONSIDERATION

Considering that on the pre-appointed hearing day, the Plaintiff appeared its legal representatives, while the Defendant did not appear nor send any authorized person as its representative in the hearing, though the Defendant has been legally and dully summoned according to the court summons No.



08/Pdt.Sus/Merek/2014/PN.Niaga.Jkt.Pst dated February 08, 2014 and general summons published in Bisnis Indonesia newspaper dated March 10 and 20, 2013, therefore the Panel of Judges will decide this case without the presence of the Defendant (verstek);

Considering that before examining the principal arguments of the Plaintiff's motion, Panel of Judges will firstly examine about whether or not the Plaintiff may file a motion for cancellation of the registration of the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant as the Plaintiff's motion arguments mentioned above;

Considering that article 69 paragraph (1) of Law No. 15 of 2001 regarding Mark specifying that "A motion for cancellation of a mark registration may only be filed within 5 (five) years from the registration date of the mark";

Considering that article 68 paragraph (2) Law No. 15 of 2001 regarding Mark also specifying that "The owner of unregistered mark may file a motion as referred to in paragraph (1) after filing an application to the Directorate General";

Considering that based on Exhibit P-32, it is evident that the Plaintiff has filed an application for registration of the mark "SUBWAY" for class of products/ services 35 to the Directorate General of Intellectual Property of the Ministry



of Law and Human Rights of the Republic of Indonesia on October 10, 2012;

Considering that based on Exhibit P-33, it is evident that the Defendant has registered the mark "SUBWAY" on February 29, 2012 under Registration Number IDM000349842 for class of NCL9 35 to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia;

Considering that the Plaintiff has filed a motion with a statement of claim dated February 19, 2014 which has been registered with the Clerk Office of Commercial Court of Central Jakarta on February 19, 2014 under the case Register Number: 08/PDT.Sus-MERЕК/2014/PN.NIAGA.JKT.PST;

Whereas based on the above considerations, it is evident that the motion for cancellation of the mark "SUBWAY" of the Defendant filed by the Plaintiff is still within the period specified in article 69 paragraph (1) of Law No. 15 of 2001 regarding Mark, and the Plaintiff has filed an application for registration of the mark "SUBWAY" for class of products/ services 35 to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012, therefore this motion is formally accepted;



Considering that further the Panel of Judges will examine the Plaintiff's principal motion as follows;

Considering that the purposes of the Plaintiff's motion are as mentioned above;

Considering that the Plaintiff's motion arguments substantially stating that the Plaintiff is a well-known company from Connecticut, United States of America and also the sole owner and the first user of the trademark & service mark "SUBWAY" which **has been internationally well-known** (Exhibit P-1) by registering the trademark & service mark "SUBWAY" in many countries in the world, and the Plaintiff's **well-known mark "SUBWAY"** has been protected by the laws and regulations applicable in Indonesia, particularly Law No. 15 of 2001 regarding Mark as well as by the international conventions, particularly TRIPS Agreement and Paris Convention which have been ratified by Indonesia, therefore the Plaintiff obviously possesses the exclusive right to use the trademark & service mark "SUBWAY" in Indonesia, of which the function is to distinguish the products or services of the Plaintiff from the products or services of other parties. Where the Plaintiff also has filed an application for registration of the mark "SUBWAY" to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 under Agenda No. J002012048402 to protect the services included in class 35, namely stores,



wholesale agents, wholesale services and retailers relating to the services in providing foods and beverages for consumers (Exhibit P-32). However, it has come to the attention of the Plaintiff, that the Defendant **without the prior consent** of the Plaintiff has registered the mark "SUBWAY" with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia under Registration No. IDM000349842, on February 29, 2012 to protect the services included in class 35, namely stores, department stores, supermarkets, minimarkets, wholesale agents (Exhibit P-33).

That the Plaintiff **highly objects** the registration of mark "SUBWAY" under Registration No. IDM000349842 registered by the Defendant (Vide Exhibit P-33), since the mark "SUBWAY" of the Defendant clearly **has substantial and entire similarity for similar or unsimilar services** to the mark "SUBWAY" of the Plaintiff, either from **the shape, positioning, writing, combination of elements or from the pronunciation**. This has clearly proven **bad faith** of the Defendant to **take-over** the Plaintiff's mark "SUBWAY" and or to **share the fame, imitate, and counterfeit** the Plaintiff's mark "SUBWAY" which has been internationally well-known and registered in many Countries (Vide Exhibit P-2 to P-31), therefore the registration of mark "SUBWAY" by the Defendant should be classified as a **registration with bad faith, and therefore does not deserve**



any legal protection, as specified in Article 4 (as elaborated)in conjunction withArticle 6 paragraph (1) letter a and b (as elaborated)in conjunction withArticle 6 paragraph (2) of Law No. 15 of 2001 regarding Mark.

It should be believed that if both marks are used concurrently in businesses, they will certainly create a condition of unfair competition, deceiving, or misleading the public as the consumers who will consider that the services from the Defendant using the mark "SUBWAY" are services from the Plaintiff and this will certainly be very detrimental to the Plaintiff. Based on the aforesaid matters, the Plaintiff also has strong legal grounds to request the cancellation of registration of the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant;

Considering that to strengthen its motion arguments, the Plaintiff has submitted Exhibits marked P-1 to P-38;

Considering that Article 68 paragraph (1) of Law No. 15 of 2001 regarding Mark specifying that: "A motion for cancellation of a registered mark may be filed by an interested party based on the reasons specified in Article 4, Article 5 or Article 6";

Considering that article 6 paragraph (1) of Law No. 15 of 2001 regarding Mark specifying that an application shall be rejected by the Directorate General if the Mark:



a. has substantial and entire similarity to the Mark of other parties which has already been registered before for similar products and/or services;

b. has substantial and entire similarity to certain well-known Mark of other parties for similar products and/or services;

c. has substantial and entire similarity to the indication-geography which has already known by public;

Considering that when viewing the provisions of article 6 paragraph (1) letter b of Law No. 15 of 2001 regarding Mark mentioned above, the application for registration of a mark shall be rejected if it has substantial and entire similiarity to a well-known mark of other parties for similar products and/or services;

Considering that since the meaning of a well-known mark is not regulated in Law No. 15 of 2001 regarding Mark, the definition of a well-known mark can be concluded from the explanation of Article 6 paragraph (1) letter b of Law No. 15 of 2001 regarding Mark explaining that the Rejection of Application of a mark with substantial and entire similarity to a well-known Mark for similar products and/or services is based on the public awareness of the Mark in the relevant industry. In addition, this rejection should also considering the reputation of a mark gained by intensive and massive



promotion, investment in some countries in the world by the owner, and enclosed with Mark registration evidences in many Countries;

Considering that whether or not the Plaintiff's mark "SUBWAY" is classified as a well-known mark and has substantial and entire similarity to the Defendant's mark "SUBWAY";

Considering that based on Exhibits P-1, P-3 to P-26A, it is evident that the Plaintiff's mark "SUBWAY" has been registered in many Countries in the world;

Considering that based on Exhibits P-31 to P-31A connected to Exhibits P-34 and P-35 to P-36A, it is evident that the Plaintiff's mark "SUBWAY" has been used and promoted in some Countries in the world;

Considering that based on Exhibits P-28, P-29 and P-30, it is evident that the Plaintiff has also registered the mark "SUBWAY" with the Directorate General of Intellectual Property - the Ministry of Law and Human Rights of the Republic of Indonesia under registration number IDM000368823 on October 5, 2012 for class of products/ services 30 registered since October 5, 1992, under registration number IDM000368814 on October 5, 2012 for class of products/ services 32 registered since October 5, 1992, under registration number IDM000281385 on November 22, 2010 for class of products/ services NCL9 43;



Whereas based on the above considerations, it is also evident that the Plaintiff has registered the mark "SUBWAY" for various classes of products/ services in Indonesia;

Considering that based on the above considerations, the Panel of Judges found that the Plaintiff's mark "SUBWAY" has met requirements as a well-known mark as referred to in the explanation of article 6 paragraph (1) letter b of Law No. 15 of 2001 regarding Mark;

Considering that the subsequent issue is to determine whether or not between the Plaintiff's mark "SUBWAY" of which the application for its registration has been filed to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 under Agenda No. J002012048402 to protect services included in class 35 has substantial and entire similarity to the Defendant's mark "SUBWAY" which has been registered with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia under registration number IDM000311168 on June 20, 2011 in class of products/ services 35;

Considering that article 6 paragraph (1) letter a of Law No. 15 of 2001 regarding Mark specifying that "An application shall be rejected by the Directorate General if the mark:



a. has substantial and entire similarity to the mark of other parties which has already been registered for similar products and/or services”;

Considering that what is meant by substantial similarity is a similarity caused by some prominent elements between one mark to another, which can create the impression of similarity either from the shape, positioning, writing, combination of elements or from the pronunciation in those marks;

Considering that based on Exhibit P-32 connected to Exhibit P-33, it is evident that the Plaintiff has filed an application for registration of the mark “SUBWAY” for class of products/ services 35 to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 which is similar to the Defendant’s mark “SUBWAY” registered with the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on February 29, 2012 under registration number IDM000349842 for class of NCL9 35 with the the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia, when viewing from the wording in those Exhibits, both containing the letters S, U, B, W, A and Y and also when pronounced, both marks containing the word “SUBWAY”, in addition, as the considerations above, the Plaintiff’s mark “SUBWAY” has been



declared as a well-known mark which has been registered in many Countries, even in the same class including in Indonesia long before the Defendant registering its mark "SUBWAY" in Indonesia;

Whereas based on the above considerations, it is evident that between the Plaintiff's mark "SUBWAY" of which the application for its registration has been filed to the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on October 10, 2012 for class of products/ services 35 and the Defendant's mark "SUBWAY" which has been registered with the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on February 29, 2012 under registration number IDM000349842 for class of NCL9 35 has substantial similarity;

Considering that since the Plaintiff's mark "SUBWAY" as a well-known mark which has been registered, promoted and marketed in some Countries including in Indonesia long before the Defendant's mark "SUBWAY" is registered with the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia, therefore the Defendant has shared the fame of the Plaintiff's mark "SUBWAY", and therefore the Defendant also obtain profits from it, the Panel of Judges



found that the Defendant who has registered the mark "SUBWAY" with the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia on February 29, 2012 under registration number IDM000349842 for class of NCL9 35 as bad faith;

Whereas based on the above considerations, it is reasonable if the Panel of Judges cancelling the registration of the Defendant's mark "SUBWAY" with the Directorate of Mark of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia under registration number IDM000349842 on February 29, 2012 for class of NCL9 35 with all legal consequences;

Considering that relating to other evidences which irrelevant to the Plaintiff's motion arguments, the said evidences will be excluded;

Considering that since the Panel of Judges has granted all of the Plaintiff's motions, and the Defendant is the losing party, it is reasonable if the Panel of Judges penalize the Defendant to pay the court costs, of which the amount will be specified in the injunction below;

In view of Law Number 15 of 2001 regarding Mark and other relevant laws and regulations;

ADMINISTERING JUSTICES



1. To declare that the Defendant did not appear nor send any authorized person as its representative in the hearing, though the Defendant has been legally and dully summoned;
2. To grant the Plaintiff's motion entirely with verstek;
3. To declare that the Plaintiff is the sole owner and the first user of the internationally well-known mark "**SUBWAY**", so that the Plaintiff has the exclusive right to use the mark "**SUBWAY**";
4. To declare that the mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant has substantial and entire similarity to the Plaintiff's mark "**SUBWAY**";
5. To declare the cancellation of the registration of mark "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant with all legal consequences;
6. To order the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia to cancel the registration of the mark of "SUBWAY" under Registration No. IDM000349842 in the name of the Defendant from the General Register of Marks, and further to announce the cancellation of the registration of the said mark in Mark Gazette;
7. To penalize the Defendant to pay the court costs of Rp. 26,116,000.00 (twenty-six million one hundred and sixteen thousand rupiah);



Passed in the assembly of the Panel of Judges of the Commercial Court at the District Court of Central Jakarta on Tuesday, May 13, 2014 by us, H.R. IIM NUROHIM, S.H. as the Presiding Judge, ASWIJON, S.H. and GOSEN BUTAR-BUTAR, S.H., M.Hum. respectively as Member Judge, which decision was pronounced in the hearing open for public by the Presiding Judge accompanied by the Member Judges assisted by WIJI ASTUTI, S.H., acting as the Substitute Clerk in the presences of the Legal Representatives of the Plaintiff without the presence of the Defendant;

Member Judges :

(SIGNED)

ASWIJON, S.H.

Presiding Judge,

(SIGNED)

H.R. IIM NUROHIM, S.H.

(SIGNED)

GOSEN BUTAR-BUTAR, S.H., M.Hum

Substitute Clerk,

(SIGNED)

WIJI ASTUTI, S.H.

Dengan ini menerangkan bahwa dokumen diatas adalah terjemahan yang benar dan akurat dari Bahasa Inggris ke Bahasa Indonesia.

Jakarta, 22 Januari 2014


Fatchurozak
Sworn & Authorized Translator