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Using the New Online IP Filing System in Indonesia

The Indonesian Directorate General of Intellectual Property (DGIP) officially launched the new and mandatory e-filing system on August 17, 2019. Because of the e-filing system, it is now not possible to file IP applications manually through the filing counter at the DGIP. All new IP applications must be filed online.

The DGIP mentioned that the new system is developed in order to support Indonesia's 74th Independence Day vision—"towards superior Indonesia" (Menuju Indonesia Unggul). In addition, the DGIP claims that this mandatory system will significantly reduce corruption as it eliminates the chance for a direct meeting between the applicant and the DGIP officer.

Any party who wishes to file an IP application is therefore obliged to register their account and apply through one of the following websites:

- ▶ merek.dgip.go.id for trademarks
- ▶ paten.dgip.go.id for patents
- ▶ desainindustri.dgip.go.id for industrial designs

There is no change in the application procedure for recordation of copyright, which continues to be applied for online at e-hakcipta.dgip.go.id.

Before proceeding with the application, applicants must also order a billing code through the website simpaki.dgip.go.id for the corresponding IP and make payment through the bank. If the payment system is down, it is also possible to make the payment directly at the DGIP counter.

Mandatory Documents

Trademark application

The IP e-filing system requires the following documents to be submitted at the same time as submission, before the application is processed:

- ▶ Scanned copy of power of attorney
- ▶ E-signature of the applicant
- ▶ E-signature of the IP consultant (if filed by a representative)

Even though the current IP laws do not require the power of attorney to be submitted with the application, the new system does not allow subsequent submission of the power of attorney. Thus it is suggested that the applicant provide their IP agent with a general power of attorney with the filing instructions, so that the application can be filed soon after receiving the instructions. This is especially crucial for filing applications that claim priority.

Patent application

The requirements for filing patent applications online remain the same as they were for filing in person; required items include a power of attorney, deed of assignment, statement of ownership, and a certified copy of the priority document (if claiming priority). These documents can be filed along with the application, or within three months from the filing date, with a possible extension of two months, and one additional month subject to payment of a fee to the DGIP.

Now that the application is filed online, only scanned copies of the documents need to be uploaded upon legalization. Even so, we still encourage our clients to provide us with the originals. Based on our experience, if the application does not pass the formality stage due to missing formality requirements, the DGIP would require the documents to be re-submitted.

Design application

The requirements for filing design applications online also remain the same; these include a power of attorney, deed of assignment, statement of ownership, and a certified copy of the priority document (if claiming priority). All must be uploaded online along with the application, or within three months from the filing date, with a possible maximum extension of one month only.

The introduction of the online filing system and the requirement that all new applications use the new system, represent a big step for the DGIP, and one that has taken effect within a relatively short time.

Challenges in Filing the Application

Trademarks

Despite the noble aims of the new system, there are still a number of issues. The biggest challenge related to trademark applications is the selection of goods or services, where the applicant must choose from the list of goods available on the online system. The list of goods and services is very limited, and it is not possible to add or amend anything manually.

To overcome this, the Trademark Office provides a helpdesk team to assist the applicant in adding the goods or services not already available in the system—applicants may email klasifikasi@merek.dgip.go.id to request the addition of the desired good or service.

Continued on page 13

Nonetheless, requested goods are not all automatically added. In some cases, the helpdesk team will decline to add an item if it is not deemed to be in the proper class—sometimes with a reply to explain their reasoning, and other times without comment. Particularly in the services class, the helpdesk has seemed reluctant to add anything despite being sent supporting documents (such as the guidelines from the European Intellectual Property Office reflecting acceptance of the new service terms).

This issue has unfortunately caused a delay in processing new trademark applications. Applicants should therefore be prepared to amend the proposed goods or services to make them fit into the ones that are already listed.

The current goods and services classifications used by the new system are those found in the Madrid Goods & Services Manager (<https://webaccess.wipo.int/mgs/>), although the current implementing regulation—Article 14 (4) of Minister of Law Regulation No. 67 of 2016—specifically mentions that the registration of trademarks adopts the Nice classification.

For non-priority applications, we suggest amending or selecting the goods or services available on the list rather than waiting for a response from the helpdesk. Doing so will accelerate the application process, so that there is no chance for another party to file a similar mark during the waiting time.

If a priority is claimed while the proposed goods or services are not listed, the DGIP have stated that they will proactively help to add the unavailable goods or services. Unfortunately, if the deadline is too short and there is no response from the helpdesk, the priority cannot be claimed.

Patents

Technical issues in executing the online filing of patents have been gradually solved by the DGIP, although some minor issues still remain.

The biggest issue in filing a patent application online relates to patent annuity debts. If the DGIP finds, during the formality stage, that the applicant still has unpaid annuity debts, they will suspend the pending application. The system will be locked, and the application will not be able to proceed any further. For example, it would not be possible to submit the formality documents or the Indonesian translation of the patent specification if they were not already submitted at the time of filing.

The DGIP will keep the pending application suspended at the formality stage until the end of December 2019 unless the applicant submits an affidavit containing their commitment to pay the debt no later than the end of December 2019. If the debts have not been settled by the end of December 2019, the application will be deemed withdrawn. Accordingly, applicants should check whether they have any unpaid debts before filing a patent application in Indonesia.

Conclusion

The introduction of the online filing system and the requirement that all new applications use the new system, represent a big step for the DGIP, and one that has taken effect within a relatively short time. For now, the online filing system can only receive new trademark, patent, and design applications, recordals of change of data, and expedition of the publication of a pending patent application. The DGIP is planning to soon improve the system to accept post-filing applications such as recordals of assignment, trademark renewals, patent annuities, oppositions, and responses to office actions. These and other systems can be expected to come in the near future. 🚀