



**JURIDIC ANALYSIS RELATED TO WELL-KNOWN MARK
INFRINGEMENT UNDER LAW NO 20 OF 2016 ON TRADEMARK**

THESIS

By:

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FACULTY OF HUMANITIES

LAW STUDY PROGRAM

CIKARANG

January, 2020



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**Submitted as one of the requirements to obtain Bachelor of Law (Sarjana Hukum)
degree**

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THESIS ADVISOR RECOMMENDATION FORM

I as the advisor of the Thesis entitled " **JURIDIC ANALYSIS RELATED TO WELL-KNOWN MARK INFRINGEMENT UNDER LAW NO 20 OF 2016 ON TRADEMARK**"

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Cikarang, January, 23th 2020

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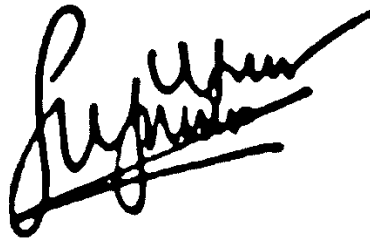
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We, the Thesis Panel of Examiners with the thesis title of “**JURIDIC ANALYSIS RELATED TO WELL-KNOWN MARK INFRINGEMENT UNDER LAW NO 20 OF 2016 ON TRADEMARK**” submitted by "Fadhil Brata Ruswanda" has been accepted and can be defended properly at 31 / 01 / 2020



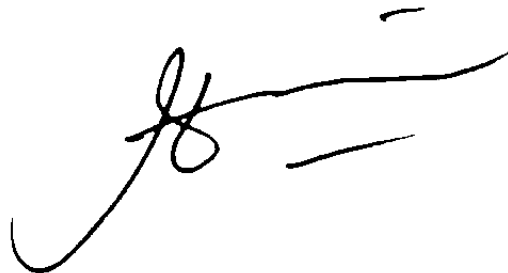
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ORIGINALITY STATEMENT

I, the undersigned below, state that the following thesis with the title of

**“JURIDIC ANALYSIS RELATED TO WELL-KNOWN MARK INFRINGEMENT
UNDER LAW NO 20 OF 2016 ON TRADEMARK”**

is my original work that has never been written by anyone else, and it has followed the requirements and rules of scientific writing that is applicable in the President University Law Study Program.

Cikarang, 24/01/2020

The Author,

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Fadhil Brata Ruswanda

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And I also present this thesis to my parents, who always look down on me in academia. Forgive me because it has been a burden in the family for a long time, especially during extended family gatherings, which requires that you are embarrassed when a person in my age has already gotten a bachelor's degree while I haven't. Thank you to my parents who have been willing to hold back the shame of having me who went to bachelor's degree took 7 years. And while this foreword was written, my younger brother had graduated from a great University and already worked at the company. Thanks to you my brother, you already treated a little bit of my parent's sadness by having you.

ABSTRACT

Name : Fadhil Brata Ruswanda

Title : **JURIDIC ANALYSIS RELATED TO WELL-KNOWN MARK INFRINGEMENT UNDER LAW NO 20 OF 2016 ON TRADEMARK**

Lots of Well-Known Marks infringement, which cause losses from the victims. Even though trademarks that have been registered receive national legal protection through Law No. 20 of 2016 about Trademarks and Geographical Indications. Infringement that usually occur are similarities, usually this happens to brands that have high popularity, because those who copy from well-known marks do not want to hard work to increase the reputation of new marks, so they imitate well-known marks. Law No. 20 of 2016 regulates in detail about trademarks ranging from how to register it to the cancellation of registered marks, all of which are regulated in order to protect the interests of trademarks in Indonesia. The method used in this thesis is to look at the applicable laws and regulations, as well as look at some examples of cases of well-known marks infringement in Indonesia and make comparisons with other countries.

Keywords : Well-Known Marks

Nama : Fadhil Brata Ruswanda

Judul : **ANALISIS YURIDIS TERKAIT PELANGGARAN MEREK TERKENAL BERDASARKAN UNDANG-UNDANG MEREK NOMOR 20 TAHUN 2016**

Banyak sekali pelanggaran terhadap merek yang sudah terkenal, yang menyebabkan kerugian dari pihak yang menjadi korban. Padahal merek merek yang sudah didaftarkan mendapatkan perlindungan hukum nasional melalui UU No 20 Tahun 2016 tentang Merek dan Indikasi Geografis. Pelanggaran yang biasanya terjadi adalah kemiripan, biasanya ini terjadi kepada merek merek yang mempunya popularitas tinggi, karena yang meniru dari merek terkenal tidak ingin susah payah menaikkan reputasi dari merek baru, sehingga mereka meniru merek terkenal. Undang Undang No 20 Tahun 2016 mengatur secara rinci tentang merek mulai dari cara pendaftaran sampai ke pembatalan merek terdaftar, semua itu diatur guna melindungi kepentingan dari merek merek yang ada di Indonesia. Metode yang digunakan dalam skripsi ini adalah dengan melihat peraturan perundan-undangan yang berlaku, serta melihat beberapa contoh kasus dari pelanggaran merek terkenal di Indonesia serta melakukan perbandingan dengan Negara lain.

Kata Kunci : Merek Terkenal

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CHAPTER 1

INTRODUCTION

A. Background

Intellectual Property Rights or IPR abbreviated synonym for Intellectual Property Rights are rights with respect to the wealth arising out of or born as human intellectual ability in the form of inventions in the fields of technology, science, art and literature.

At first the result of creative human or human creativity and also a form of business or creative results of human or human effort is spread or passed away to others as a way of worship so that everyone can use / wear even market the results of production that draws on the findings just like that. But in its development, if the work of human creative intellectual work which is the result of which will serve as land or a business activity objects, seen from a sense of justice and respect for the creative works of human invention, it is less in place. This may be due to get the results of the intellectual work of the inventor or creator has sacrificed time, energy and cost a total mind and relatively few in number.

The work of Indonesian society creativity lately a lot of that is exported to various other countries, it is certainly trigger a larger scale than simply the product of Interior can imitate by other parties. The role of IPRs is in need here to demonstrate the originality of a product that we create ourselves in order to avoid irresponsible actions which can harm us.

The role of IPR protection in this case, to protect the intellectual property rights for the creator or inventor of aspects of economic and non-economic. Non-economists will encourage them to be creative and economical will benefit materially for his work. In terms of economic, intellectual property is a force that can be used to enrich one's life and future of a nation is material, cultural, and social.¹

Interest on IPR protection law is intended to give legal clarity regarding the relationship between the creation / invention is the result of human intellectual work by the author / inventor or the holder of the rights to the users who use the results of intellectual work. The existence of legal clarity on the ownership of IPRs is a legal recognition and rewards given to someone on business and human creative works that have been created or discovered.

Given the effort to get the results of intellectual work requires capital in the form of cost, time, energy and thoughts, then this is the right material IPRs that are immaterial. Today IPR is a business asset and an integral part of business processes as well as a business strategy in the context of the success of the business or trade of the world.²

On the other hand in the business activities of the business itself occasionally terms equated with the trade. Legally known in Regulation of trade is the buying and selling of goods or services carried out continuously with a view to transferring rights to the goods or services with a reward.

¹Edy Santoso, Effect Against Globalization Era Business Law in Indonesia, Kencana, Jakarta, 2018, page 33.

²Upgrading Papers Lecturer in Civil Law and Business Law se Indonsia in UGM, September 2000.

IPR protection purposes as described in advance is to give legal clarity between intellectual property is the right material with the author / inventor or the holder of rights to users who use it. In order for the legal protection exists, then arrange the provisions of laws and regulations related to IPR.

Given IPR is a business asset that is an integral part of a business strategy that was worldwide today, then discuss IPR can no longer be separated by the approval of the establishment of the WTO in which the TRIPS or Trade Related aspect of Intellectual Property Including Trade in counterfeit goods is one outcome agreements the Uruguay round or the Uruguay round held on 1994 in Marrakech, Morocco.

8th Uruguay Round has brought countries participating in agreements affecting international trade. At the meeting it was agreed multilateral treaty called the WTO Agreement. The participating countries signed the Final Act embodying the Result of the Uruguay Round of Multilateral Trade Negotiations in 1994 in Marrakesh, Morocco. By signing the Final Act, the signatory countries agreed to sign the Treaty of WTO (World Trade Organization Agreement) and its annexes. Provisions on Intellectual Property in attachment WTO Agreement is Annex 1C, entitled Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement). TRIPS Agreement entered into force since 1995.

Importation of IPR protection into the world trading system at the time called the General Agreement on Tariffs and Trade (GATT) could not be separated from the role of the United States are proposing Proposal for Negotiations on Trade-Related

Aspects of Intellectual Property Rights. In addition, the European Community also proposes Proposal of Guidelines and Objectives. Against the proposal of these countries, India is one of the country most strongly opposed the idea of incorporating the protection of Intellectual Property Rights. However, after a debate between developing countries with developed countries, then the winner is most concerned to protect their works are developed countries.³

TRIPS is a pioneer in the birth of a new Indonesian laws on Intellectual Property Rights. Within the framework of the adjustment of legislation Intellectual Property Rights national norms TRIPs Agreement, Indonesia has taken steps to set it up systematically.⁴TRIPS Agreement is the result achieved and also have adopted two major international conventions in the field of industrial property and copyright, namely the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works. The consequences of the victory of the developed countries in the Uruguay Round of GATT negotiations relating to intellectual property rights that brought the inclusion of the concept of western countries regarding property and ownership into law in developing countries including Indonesia.

TRIPS Agreement are not rules concerning the protection of intellectual property rights in particular. TRIPS Agreement is an agreement that is part of the WTO

³ Hukum Online, The role of the TRIPS Agreement on Intellectual Property Rights Protection, <https://www.hukumonline.com/klinik/detail/ulasan/lt592407520f6f7/peran-trips-i-agreement-i-dalam-perlindungan-hak-kekayaan-intelektual> accessed on 15 April 2019

⁴Henry Soelistyo, Copyright Without Moral, (Jakarta Rajawali Pers, 2011) Pg. 5

Agreement signed by member countries, which requires all members to make rules regarding intellectual property rights in their respective countries.

Every country that has signed the above arrangements is subject to international agreed rules. However, the rules that exist in the international conventions are just general rules only. For the application of general rules that have been agreed, handed enforcement and setting entirely to the state that would impose such rules into national law.⁵

Indonesia itself through the Directorate General of Intellectual Property has a lot of legislation that regulates related Intellectual Property. Directorate General of Intellectual Property is a legal entity that manages the registration of Intellectual Property Rights, after the applicant filed a registration, the Director General of Intellectual Property will further examine related Intellectual Property registered beforehand whether registered or not.

Reporting from the official page of the Directorate General of Intellectual Property, Intellectual Property Law up to this writing there are 9 of the Act, one of which is related to a trademark in which Act No. 20 of 2016 on Marks and Geographical Indications.

Regulation Act No. 20 of 2016 on Marks and Geographical Indications is set on the definition of a protected mark, procedure for requesting registration of Trademark Rights, and of course on the protection of marks.

⁵ Hukum Online, The role of the TRIPS Agreement on Intellectual Property Rights Protection, <https://www.hukumonline.com/klinik/detail/ulasan/lt592407520f6f7/peran-trips-i-agreement-i-dalam-perlindungan-hak-kekayaan-intelektual> accessed on 15 April 2019

Based on the description above description it can be seen that the IPR already has its own binding rules of international and national scale, and IPR in subdivide it according to its kind, one of the marks. But in fact, there are so many infringements against IPR that occurred in this world, especially in Indonesia.

Director General of Intellectual Property Rights is a legal entity that manages the registration of Intellectual Property Rights, after the applicant filed a registration, the Director General of Intellectual Property Rights will examine whether what has been proposed already registered or not by others, if it turns out these proposals were never raised by others , the applicant is entitled to legal protection for intellectual property rights which have been obtained.

Although it has gone through the registration process and checks by the Director General of Intellectual Property, but why there are still cases we encountered related to IPR and both parties to the dispute was the same as having official certificate from the Director General of IPR. One example of a case that will be the subject of study here is the case of Trademark Rights between Gudang Baru and Gudang Garam. Both parties together bagged Official Certificate of Director General of Intellectual Property Rights⁶

There are several factors that votes held by the Director General of Intellectual Property to determine a mark with other marks whether it is plagiarism or not, but the case will be taken into the study material has a very high quality. design

⁶ Detik.com, Gudang Garam VS Gudang Baru, Not Tracing But Ali Remain Jailed, <https://news.detik.com/berita/3254190/gudang-garam-vs-gudang-baru-bukan-menjiplak-tapi-ali-tetap-dipenjara> accessed on 16 April 2019

similarities. Of course, this is detrimental to both parties if the Director General of Intellectual Property Rights to give both parties an official certificate, because there would be problems later on.

So based on the above description, although the regulations regarding the protection of marks has been made, but it's still showing acts in infringement of these rules, it appears the legal problems Yag be appointed as the formulation of the problem.

Therefore, the authors are interested in the theme of IPR on Famous Trademark Infringement entitled Analysis Related Juridical Famous Trademark Infringement Under Law No. 20 of 2016.

B. Formulation of the problem

Based on the above research, the author has two questions related to the problem, namely:

1. What elements can be the legal basis for trademark infringements?
2. How about the law protection for the infringements of Well-Known Marks by Law No. 20 of 2016 on Marks?

C. Purpose of Writing

Purpose of This research is the author expects the reader can understand:

1. The Aspects of the similarity measure of a mark with other marks, so that the author understands and can avoid plagiarism.

2. Rights of the rights protected by the Act and action to be taken when the reader becomes a victim of the breach.

D. Benefits of Writing

The author expects this study to provide benefits to the readers, such as:

1. This study aimed to find out and explain the fault of cases Gudang Garam and Gudang Baru, so that readers can more cautious in making, decide or do something.
2. This study also aims to help the reader to know more and more about plagiarism and what we should do to deal with plagiarism.

E. Framework

Current intellectual property has become a part of International issues that need protection of the Law, because it is part of the Intellectual Property Assets Individuals and Companies. In the world of commerce, intellectual property is seen as an intangible asset.⁷

Grotius found Private Property Rights as an exclusive right instead of inclusive right as disclosed Thomas. Exclusive rights are means that the owner of the goods

⁷Edy Santoso, Effect Against Globalization Era Business Law in Indonesia, Kencana, Jakarta, 2018, page 12.

has the right such that it has the authority to retain and use it exclusively with no possibility for others to demand the same rights over the goods.⁸

There are 2 types of intellectual property rights by WIPO, namely the Industrial Property Rights and Copyright. And Industrial Property Rights is further divided into 4 groups: Patents, Trademarks, Industrial Designs and Countermeasures Fraudulent Practices Competition.⁹ Indonesia itself regulates all aspects of aspects of Intellectual Property Rights through the Directorate General of Intellectual Property, one of which the author adopted a subject of research is subject Trademark Rights stipulated in Law No. 20 of 2016 on Marks and Geographical Indications.

In the existing IPR term Economic Rights, which has a meaning that any Intellectual Property generated, creator eligible for a reward if there are other parties who want to wear the creations of course after getting a permit in advance of the Right Holder. In line with the arguments of John Locke who said that the hard work of individuals will add value to a goods and provide social benefit in general. The argument is then a starting point, as Bentham's utilitarian justifications also explains: "The great happiness for the greatest number" is basically a legal purpose to provide welfare for the community.¹⁰ Hence the Economic Rights and supported by arguments and theories of John Locke, individuals and companies are not allowed to use the Intellectual Property Rights owned by others without the consent of the

⁸Edy Santoso, Effect Against Globalization Era Business Law in Indonesia, Kencana, Jakarta, 2018, page 13.

⁹Abdul Atsar, Getting more of Intellectual Property Rights Law, Deepublish, Yogyakarta, 2018, page 20.

¹⁰Edy Santoso, Effect Against Globalization Era Business Law in Indonesia, Kencana, Jakarta, 2018, page 26

holders of Rights or creator, but the facts that occurred in the community at this time a lot of infringements related to Intellectual Property Rights, one of which is a infringement of Trademark Rights stipulated in Law No. 20 of 2016 on Marks and Geographical Indications. According to Law No. 20 of 2016, the mark is divided into three, that there are Trademarks, Service Marks and Collective Marks.

The trademark is a trademark used on goods traded by a person or group or legal entity to differentiate with other similar items. Whereas service Mark is a trademark used by traded service by a person or group or legal entity to differentiate with others similar services. Collective Marks is a mark used on goods and/or services with the same characteristics regarding the nature, general characteristics and quality of the goods or services as well as supervision to be traded by several persons or legal entities together to distinguish the goods and/or other similar services.¹¹

Trademark Infringement in general is a form of plagiarism or copying other party's Mark knowingly and with the intention to commercialize a product using the results of the Mark mimic or plagiarism of marks who are already known or registered.

If the issue is not handled properly, it will hinder public's creativity so that people will not be moved to create or find something new, because it was the discovery or creation results are not protected and respected.

¹¹ Law No. 20 of 2016 on Marks and Geographical Indications Page 2.

Therefore, the authors felt it was important to discuss things into consideration basic elements of a mark can be said to be similar to the other mark, and also related to protection against infringements of Famous Trademark Law by Law No. 20 of 2016

F. Writing Methods

A. Descriptive and Analytical

The type of research method chosen is analytical descriptive, while the definition of analytical descriptive method according to Sugiono is a method that serves to describe or give an overview of the object under study through data or samples that have been collected as they are without analyzing and making conclusions that are applicable to the public.¹²

In other words, analytical descriptive research takes the problem or focuses on the problems as they were when the research was carried out, the results of the research are then processed and analyzed to draw conclusions.

1. Descriptive research context

The context of this research is to explain the elements of infringement that often occur to Well-Known Mark in Indonesia

2. Context of Analytical Research

¹² Prof.Dr.Sugiono, *Metode Penelitian Kuantitatif, Kualitatif dan R&D*, Alfabeta: 2009, p.29

The context of this research is to find out in practice how legal protection against Infringement of Well-Known Mark in Indonesia is in line with the regulations in Indonesia or not.

CHAPTER II

LITERATURE REVIEW

A. General Review of Intellectual Property

Simply put a wealth of intellectual property arising from or born of human intellectual abilities. The works raised or born of human intellectual abilities can be either works in the fields of technology, science, art and literature. The works are born or produced on the human intellectual capabilities through the outpouring of time, energy, mind, and creativity. This is what distinguishes the intellectual property with other property types which can also be possessed by humans but is not produced by the human intellect. For example, natural resources such as land and plants in nature are a creation of the Creator (God). Although the soil or plants can be controlled by humans but the soil and plants are not the result of human intellectual work. Wealth or assets in the form of the works produced from thinking or human intelligence has value or economic benefit for human life that can be considered also as a commercial asset. The works are born or produced on the human intellectual capacity either through an outpouring of energy, mind and creativity secured to develop the property law protection system which is known as the system of Intellectual Property Rights (IPR). IPR is a way to protect intellectual property by using legal instruments that exist, namely the Copyright, Patent, Trademark and Geographical Indications, Trade Secrets, Industrial Design, Layout Designs of Integrated Circuits and Plant Variety Protection.

IPR are private rights for a person who produces an intellectual work. This is where the hallmark of IPR, one is free to apply for or registering intellectual work or not. Exclusive rights granted by the state to the individual perpetrators of IPR (inventors, creators, designers and so on) is intended as a tribute to the work (creativity) it and that others are stimulated to be able to further develop it again, so that the IPR system that the public interest is determined through the mechanism market. In addition, the IPR system to support the holding of a good documentation system on all forms of human creativity that generates the possibility of technology or other similar works avoidable / preventable. With the support of good documentation,¹³

B. General Review of Intellectual Property Rights

Intellectual property rights or the rights of IPR abbreviated arising for the result of a thought that has resulted in a product or process that is useful for people at the core of IPR is the right to enjoy the economical benefits of an intellectual creation. Objects are arranged in IPR are works that arise or be born as a human intellectual abilities.¹⁴

1. General Understanding About Intellectual Property Rights

IPR is an exclusive right granted a rule to a person or group of people to the work. McKeough and Stewart defining IPR as a right that provides legal

¹³Innovation and Intellectual Property Directorate Bogor Agricultural University, "Definition of KI and Intellectual Property Rights" <http://dik.ipb.ac.id/ki-hki/> accessed on 5 November 2019

¹⁴Gadjah Mada University Directorate of Research, : Understanding IPR" <https://penelitian.ugm.ac.id/pengertian-hki/> accessed on 17 April 2019

protection for the results of human creativity that has economic benefits. Lyle Semantara Glowka define IPR are private legal rights that honors the intangible human contribution that will be used to produce a technology that is specific.¹⁵

IPR is a property that is within the scope of technology, science and art and literature. The ownership are not for the goods, but the results of human intellectual abilities, namely in the form of ideas. According W.R.Cornish protect IPR usage ideas and information that have a commercial or economic value.

The IPR exist when human intellectual abilities that have formed something that can be seen, heard, read, and used practically. David I.Bainbridge said that IPR is a right derived from the results of creative activity a power of human thought expressed to the public in various forms, which has benefits as well as useful in supporting human life, also has economic value. The real form of the ability of intellectual work can be in the field of technology, science, and art and literature.¹⁶

According to Marzuki IPR is a right arising from intellectual work of someone who profit materially. Advantages of this material to provide welfare for the owners and by Djumhana and Djubaedillah IPR is a right derived from the results of creative activity of human thinking power capabilities that are

¹⁵ Andrian Krisnawati and Gazalba Sakeh, *New Plant Variety Rights Protection In Perspective Patent and Copyright breeding Plants* (Jakarta: PT. King Grafindo Persada, 2004), p. 14

¹⁶ Muhammad Djumahana and R. Djubaedillah, *Intellectual Property Rights: History, Theory and Prakteknya in Indonesia*(Bandung: Citra Aditya Bakti, 2003), hlm.21

expressed to the public in various forms, which is beneficial in supporting the human life as it has economic value. The real form of this capability, for example in the fields of technology, science, art and literature¹⁷

C. General Review About Mark

1. Mark Regulations

Mark Regulation in Indonesia had suffered five changes to the replacement of the Act. Earlier, Indonesia using mark Colonial Act of 1912. In 1961, the colonial Trademark Act 1912 remains in force as a result of the adoption of transitional provisions in the Act of 1945 and Act RIS Act 1949 as well as 1950 ,

Trademark Law on 1961 is the replacement of mark colonial Act. But trademark Law on 1961 is actually just a repetition of the previous Law. In 1992, a new Trademark Law enacted and take effect from April 1, 1993, replacing the Trademark Act of 1961. With the new Act, the administrative decision letter which is related with trademark registration procedures were made. Due to the importance of reform Act mark, Indonesia participated ratify WIPO's International Trademark

In 1997, Act No 19 of 1992 on Marks modified taking into account the provisions of the Covenant on the aspects associated with the trade of Intellectual Property Rights (TRIPs / GATT). Such articles contain the protection of origin and geographical indications. Trademark Law successfully enacted by the

¹⁷ Muhammad Djumhana and R. Djubaedillah, *Intellectual Property Rights: History, Theory and Prakteknya in Indonesia*(Bandung: Citra Aditya Bakti, 2003), p 21

Government. The Act contains a variety of things that most of it is set in the previous Act. Some of the important change of that stated in Law No. 15 of 2001 on Marks is a provisional decision by the court, the ordinary into the offense changes to a complaint, the role of the commercial court in deciding the trademark dispute, the possibility of using alternative dispute resolution and aggravated criminal provisions.

The government has long given attention to the issue of infringement marks in Indonesia. This is evidenced by the Trademark Act which has long been applied in Indonesia. Even in 2016, the government released the Act No. 20 of 2016 on Marks and Geographical Indications which replaced Law No. 15 of 2001 on Marks. Act No. 20 of 2016 was passed on 27 October 2016 and entered into force on November 25, 2016.

2. Definition of Mark

Mark definition under Article 1 paragraph 1 of Law No. 15 of 2001 on Marks is: "The mark is a sign in the form of images, names, words, letters, numbers, color composition or a combination of these elements that have the power differentiator and is used in the trading of goods or services"¹⁸

As for the definition of a mark is based on Article 1 paragraph 1 of Law No. 20 of 2016 on Marks and Geographical Indications are: "The mark is a sign that can be displayed graphically in the form of images, logos, names, words, letters,

¹⁸ Indonesia, Marks, Law No 15 of 2001, Article No 1 Paragraph (1)

numbers, color composition, in the form of 2 (two) dimensions and / or 3 (three) dimensions, sound, hologram, or a combination of the two (2) or more of these elements to distinguish the goods and / or services produced by the person or legal entity in the trading of goods and / or services "¹⁹

The notion expand the range of signs that can be used as a mark, which in Article 1 paragraph 1 of Law No. 15 of 2001 on Marks only includes pictures, names, words, letters, numbers, color composition, or a combination of the elements, which can be used as a mark. The extent of coverage can be a sign that the mark can be defined as the narrowing the effort of businesses register his trademark in bad faith. Therefore, a mark at least contain the elements such as:

- 1) A sign. Signs that can be used as a mark of a product or service is only a sign that contained in Article 1 paragraph 1 of the Act No 20 Year 2016 on Marks and Geographical Indications, excluding them packing and aroma as the mark although both can be used as distinguishing features and used in the economy.²⁰
- 2) Have distinguishing features. Elements "has distinguishing" is a key element in the mark. Since the beginning of its development, the mark has indeed been designated as the identification and differentiation of similar products. By because the sign is used as a mark is considered no distinguishing features if it is too simple or too complicated, so that it

¹⁹ Article 1 paragraph 1 of Law No. 20 of 2016 on Marks and Geographical Indications

²⁰ Insan Budi Maulana ,, 1999, Well-Known Marks Protection in Indonesia from time to time, PT Citra Aditya Bakti, Bandung, page 102.

becomes unclear and confusing the public whether the marks are trademarks or not, so that no visible impression you want to be displayed by the mark.²¹

- 3) Used in trading activities. In this case there is the assertion that the mark can be used actively in trade in goods and services and the mark is not just registered and have distinguishing features.²² Therefore, a trademark registered to do the deletion if the trademark is not used for 3 (three) years in a row in the trade of goods and / or services since the last usage date of registration or mark in question.

3. Type of Mark

The definition of Mark form Article 1 Paragraph 1 Law No 20 of 2016 also reflected that there are two types of marks are known in Indonesia Legislation mark, namely:

- 1) The trademark is a trademark used on goods traded by a person or persons jointly or a legal entity to differentiate with other similar items.
- 2) Is a service mark mark is used for services traded by a person or keeping people together or a legal entity to differentiate with other similar services.

²¹ Gatot Supramono, *Resolve Dispute Mark According to Indonesian law*, (Jakarta, Rineka Cipta 2008), Page 16.

²² Gatot Supramono, *Resolve Dispute Mark According to Indonesian law*, (Jakarta Rineka Cipta, 2008), page 101.

Based on Article 15 (1) of the TRIPs Agreement definition of mark is as follows: "Any sign, or any combination of signs, capable distinguishing the goods or services of one undertaking from Reviews those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words Including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of Distinguishing the relevant goods or services, members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible".

Mark as Intellectual Property Rights in essence is a sign to identify the origin of goods and services from a company with goods and / or services of other companies. Mark is the spearhead of trade in goods and services. Mark through employers can maintain and guarantee the quality of goods and services produced and prevent acts of unfair competition from other employers who act in bad faith intending to piggybacking their reputation.

According Molengraaf, "where the mark is to personify a particular item, to indicate the origin of goods and the quality assurance that can be compared with similar goods are made and traded by another person or company."²³ HMN Purwo Sutjipto give the formula that the mark is a sign, with which a particular object personified, so it can be distinguished from other similar

²³Muhammad Djumhana, R. Djubaedillah. Intellectual Property Rights: History, Theory and Practice in Indonesia, (Bandung: PT. Citra Aditya Bakti, 2003_, page 164

objects.²⁴ Harsono Adisumarto, theorized that the mark is the identification that distinguishes a person belonging to the property of others, such as livestock ownership by giving stamp on the back of a cow which is then released in the spacious common grazing. Stamp as it is a badge to indicate that the animals in question are owned by a particular person. Typically, for distinguishing marks using the initials of the owner himself as a mark of distinction.²⁵ Rahmi Jened theorized that the mark is a legal definition that gives protection and efforts if a trade mark used by parties who do not have authority to do so.²⁶

From setting up the mark as well as the opinion of the scholars, in general, the authors take a conclusion that the trademark is a sign in the form of pictures, names, words, letters, numbers, color composition, or a combination of such elements as the identity of a product (including spaces scope, attributes, quality, and utilization) to consumers who, having distinguishing features, which distinguish a product or service produced by one party to the other party (competitors) with the criteria contained in it. The mark gradually became an asset of a company and is one part of the intellectual property rights protected by the Act.

Act No. 20 of 2016 on Marks and Geographical Indications regulating the types of marks, among which are the trademark, service marks, and collective

²⁴H. OK. Saidin, *Legal Aspects of Intellectual Property Rights (Intellectual Property Rights)*, (Jakarta: King Grafindo Persada, 2013), page 343.

²⁵H. OK. Saidin, *Legal Aspects of Intellectual Property Rights (Intellectual Property Rights)*, (Jakarta: King Grafindo Persada, 2013), page 345.

²⁶ Rahmi Jened, *Trademark Law (Trade Mark Law) in the Era of Global and Economic Integration*, (Jakarta, Prenamedia Group, 2015), page 6.

marks. Trademark is a mark used on goods traded by a person or persons jointly or a legal entity to differentiate with other similar goods.²⁷

Services mark is the mark used for services traded by a person or persons jointly or a legal entity to differentiate with other similar services. Collective Marks is a mark that is used on the goods and / or services with the same characteristics as traded by several persons or legal entities together to distinguish the goods and / or other similar services.²⁸ For example, Coca Cola and Big Cola, Cola on the two marks are marks Collective.

Law No. 15 of 2001 regarding Trademarks only protect the mark of the conventional form of a sign in the form of pictures, names, words, letters, numbers, color composition, or a combination of these elements, having distinguishing features are identical to the logo of two dimension. While Law No. 20 of 2016 on Marks and Geographical Indications expands the mark to be registered, which are non-traditional mark that is 3-dimensional mark, Mark and Mark Hologram voice. As examples of 3-dimensional mark one of which can be found on the bottle. For mark voice, which is protected sound recordings used for marking of products and services. Everyone can make or create a model and shape the sound that will be used as marking. Every sound made marking protected. For example, the usual lion's roar displayed whenever MGM Picture showing the film. Lion's roar that became a hallmark of MGM Picture and

²⁷ Muhammad Djumhana and R. Djubaedillah. Intellectual Property Rights: History, Theory and *Prakteknnya in Indonesia*(Bandung: Citra Aditya Bakti, 2003), page 169

²⁸ Indonesia, Marks, Law No 15 of 2001, Article No 1 Paragraph (4)

considered the same as a mark, so it can be replicated by other parties is prohibited.

Hologram protected mark display will change color based on the angle of view. Mark is considered the same kind bring up the display when the same color from the same angle, and considered different if a different display colors from the same viewpoint.

4. Function of Mark

RM Suryodiningrat mark classifies into three types, namely:

- 1) A word mark consisting of words alone. For example: Good Year, Dunlop, as the mark for car tires and bicycle tires.
- 2) Painting mark is the mark which consists of paintings that never, at least rarely used.
- 3) Mark combination of words and paintings, many once used. For example: White cigarettes mark "Escort" which consisted of painting a convoy of ships with the caption "Escort" Fragrant Tea mark "Pendawa" consisting of Pendawa puppet painting with the words underneath "Pendawa Lima".²⁹

Based on the meaning of the mark and objects were protected, then the mark is used to distinguish the goods or the production of one (1) company with the production of goods or services of other similar companies. Thus, the mark is the

²⁹H. OK. Saidin, *Legal Aspects of Intellectual Property Rights (Intellectual Property Rights)*, (Jakarta: King Grafindo Persada, 2013), page 347.

identification of origin of goods and services and has the function of connecting goods and services concerned with the producer, and it represents a guarantee of personality and the reputation of the goods or services of the business results during trading. In addition, the mark also serves to stimulate the growth of a healthy economy and trade, and benefit all parties.³⁰

In one case, a court in the UK suggests that the essential function of mark is to provide consumers or end users:

"A guarantee of identity of the origin of the marked product by enabling him to extinguishing, without any possible confusion, that product from others of a different provenance".³¹

In another case, the court stated trademarks able to achieve its goal because "" they act as a guarantee to the consumer ".³²

Director General of Intellectual Property Rights notes the function of their use of the mark is as follows:

- 1) Identification to differentiate production yields resulting person or persons jointly or a legal entity with the production of another person or other legal entity;
- 2) As a promotional tool, so as to promote their products simply by calling its mark;

³⁰Mohammed Djumhana, R.Djubaedillah. Intellectual Property Rights: History, Theory and Practice in Indonesia, (Bandung: PT. Citra Aditya Bakti, 2003), .hlm. 170-171

³¹Achmad Zen Purba, the TRIPs Agreement and Some Strategic Issues, (Jakarta: PT. Alumni, 2011), pp. 58.

³²Achmad Zen Purba, the TRIPs Agreement and Some Strategic Issues, (Jakarta: PT. Alumni, 2011), pp. 58.

- 3) As a guarantee for the quality of the goods;
- 4) Show the origin of the goods / services produced.³³

According to PDD Generous, mark functions there are three, namely:

- 1) The function indicator of the source, which means the mark serves to demonstrate that a product is legally sourced at a business unit and also serves to provide an indication that the product was made in a professional manner.
- 2) The function of the quality indicators, meaning that mark serves as a guarantee of quality, especially in terms of prestigious products.
- 3) Suggestive function, meaning that the mark gives the impression will be a collector of such products.³⁴

Three functions of the mark, causing the legal protection of the mark to be so very meaningful. In accordance with the functions of the mark, as a distinguishing mark, the fitting between the marks owned by a person should not be the same as the mark owned by others.

5. Right to Mark (Trademark)

Right on the mark is an exclusive right granted by the State to the mark owner or other party members to use it. In general, in the field of intellectual

³³ General of Intellectual Property, Trademark function, <http://119.252.161.174/fungsi-merek/>, Accessed on July 15, 2019, 21:00 pm.

³⁴H. OK. Saidin. Legal Aspects of Intellectual Property Rights (Intellectual Property Rights), (Jakarta: King Grafindo Persada, 2013), p. 359

property rights do exist two ways of obtaining an intellectual property right, namely by making the transfer and licensing. A transfer from the owner or holder of the intellectual property rights of disenfranchised (except moral rights).

Diversion can occur through several legal events, such as inheritance, grant, agreement, or other reasons allowed by applicable law (such as purchase, merger, execution guarantee and others). In the transfer, the assignee can use all the rights attached to such intellectual property rights. While a license from the owner or holder of the intellectual property rights to the other party resulting in the permissibility of using all or part of intellectual property rights can still use the rights of the intellectual property. This means that intellectual property rights do not transfer to the other party, the licensee may only use the licensed rights to him, may be some of the rights or the entire rights.

The exclusive rights is the right company mark owners in order to prevent other parties to market products that are identical or similar to a trademark owned by the company concerned using the same mark or mark can confuse consumers. In addition, the mark owner's exclusive rights to registered marks also include:³⁵

- 1) The right to use the mark-related products and / or services and use for the relevant businesses.

³⁵Rahmi Jened I, Trademark Law in the Era of Global and Economic Integration, (Jakarta, Prenamedia Group, 2015), p. 196

- 2) Such exclusive rights make the registered trademark owner enjoys exclusive rights, none of the other parties had the right to use the mark that has the overall similarity in principle (similar) for goods and / or services.
- 3) The right to permit or authorize the other party to use its registered trademark licensing contract signed by means of a law suit.
- 4) The power to detain and prohibits any party from the use of the mark has the overall similarity in principle (similar) without permission.
- 5) Right to pledge a registered trademark in the business.
- 6) Rights for investment considering the registered mark is an intangible asset and make investments according to law.
- 7) Right to assign a registered trademark with or without business.
- 8) The right to transfer to heirs.

As the exclusive right then right on the mark exclude others from using its trademark without permission because it is part of one's wealth that needs to be preserved, maintained, and protected.

D. General Review About the Well-Known Marks

1. Definition of Well-Known Marks

Until now the meaning of the Well-Known Marks has not been agreed upon. Well-Known Marks has a word "famous" according to general knowledge society, well-known mark is a mark that is widely recognized in the relevant

sectors of society, it indicates that the well-known mark is a mark that has a good reputation in the community. Promotion is the most effective means to build a reputation (image). Reputation does not have to be obtained through registration, but can be obtained through actual use in placing goods or services into the market.³⁶

The concept of well-known marks evolve by interpretation of Article 6 bis of the Paris Convention in the framework of the member protection to mark owners whose mark is widely recognized in the market, but it is not registered on the same trademark registration actions by other parties.³⁷

Article 6 bis paragraph 3 said that:

"No the limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith"

Well-Known Marks is still a topic that continues to be discussed because until now there are well-known mark definition and criteria submitted to the respective member countries. The jurisprudence of the Supreme Court of the Republic of Indonesia Number 1486K / pdt / 1991 which states that:

"Well-Known Marks Understanding that if a mark has been circulated out of the regional boundaries to international borders, which have been circulated out

³⁶ Rahmi Jened, "Well-Known Marks and Rules dilution", Media IPR: Bulletin of Information and The diversity of IPRs, the Directorate General of Intellectual Property, Vol. XI, No. 5 September 2014, p. 5

³⁷ Slamet Kurnia, Legal Protection Against Well-Known Marks in Indonesia Post *TRIPs Agreement*, (Bandung: PT Alumni, 2001), p. 2.

of the country of origin and evidenced by the registration of the mark concerned in the various countries"

Well-Known Marks terms contained in the Decree of the Minister of Justice of the Republic of Indonesia Number 02 Year 1987 regarding Refusal HC.01.01 Trademark Registration Request that has Equations with Famous Trademark owned by others which Article 1 set definition that is a trademark Well-Known Marks has long been known and used in Indonesian territory by any person or entity for certain types of goods. Whereas in Article 1 of Decree of the Minister of Justice of the Republic of Indonesia No. M.03-HC.02.01 1991 as a regulation in lieu of the Minister of Justice in 1987 ruled that the Well-Known Marks trademark in general have been known and used on goods traded by a person or entity, either in Indonesia or abroad.

The next mark laws, namely the Trademark Act of 1992 jo, Trademark Act of 1997, Trademark Act of 2001, and the Trademark Act 2016, does not regulate in detail the notion of Well-Known Marks. However, to determine a mark is a Well-Known Marks or usual mark, then there are a few things into consideration, as stipulated in the Elucidation of Article 21 Paragraph (1) letter b Trademark Act 2016, among others:

- a. Noting the general public knowledge about the mark in the field of business concerned

- b. Mark reputation is obtained from a vigorous campaign and a massive investment in some States in the World by its owner, and accompanied by proof of registration of the mark in question in some countries.
- c. A survey conducted by an independent agency on the orders of the Commercial Court of the mark in question to obtain a conclusion about whether or not Well-Known Marks is the basis of the refusal.

2. Criteria of Well-Known Marks

WIPO has issued guidelines (guidelines) with respect to the factors in considering whether a well-known mark or not. The factors that become the benchmark whether a mark Well-Known Marks categorized or not according to WIPO are:

- 1) The level of knowledge or acknowledgment of the mark in the public sector is concerned;
- 2) Period, outreach and geographical area of use of the mark;
- 3) Period, extent and geographical area of mark promotion, including advertising and publicity as well as the presentation of the exhibition of goods or services of the mark;
- 4) Period and geographical area of any registration and each registration application to a level so as to reflect the use or recognition of the mark;

- 5) Record of successful law enforcement of the rights attached to the mark to a level where the mark is recognized as the Well-Known Marks by the competent authority;
- 6) The value associated with the mark.³⁸

Criteria Well-Known Marks in addition to general knowledge based society, determination is also based on the reputation of the mark in question which have been acquired for sale by its owner and is accompanied by evidence of the trademark registration in several countries.³⁹ In Indonesia, through Article 18 Paragraph (3) of the Regulation of the Minister of Law and Human Rights No. 67 2016 states that the criteria to determine mark as Well-Known Marks made by considering:

- 1) The level of knowledge or recognition of the community towards the marks in the business field concerned as well-known marks;
- 2) The volume of sales of goods and / or services and the benefits obtained from the use of such marks by its owner;
- 3) The market share held by the trademark in relation to the circulation of goods and / or services in the community;
- 4) Marks use the area range;
- 5) Trademark usage period;

³⁸ Achmad Zen Umar Purba, *Intellectual Property Rights Post-TRIP's*, (Bandung, PT Alumni, 2005), p. 74.

³⁹ Sudargo Gauthier and Rizawanto Winata, *Trademark Law Reform Indonesia (in the framework of the WTO, TRIP's)* (Bandung, PT Citra Aditya Bakti, 1997), p. 57

- 6) Intensity and promotion of marks, including the value of the investment used for the campaign;
- 7) Registration of Trademark or Trademark registration application in other countries;
- 8) The success rate of law enforcement in the field of marks, particularly regarding the recognition of the mark as well-known marks by regulatory authorities;
- 9) The inherent value of marks acquired due to its reputation and quality assurance of goods and / or services protected by the trademark.⁴⁰

In the United States, under Article 43 (c) of paragraph (1) of the Lanham Act (Act Mark) to determine the nature of the mark has a distinctive and well-known power, the court may consider the following factors:

- 1) The degree of inherent nature or have a distinguishing characteristic of the mark;
- 2) Duration and scope of the use of the mark associated with the goods or services of the trademark is used;
- 3) Duration and scope of advertising and publicity of the mark;
- 4) Geographical scope of the trading area in which the mark is used;
- 5) Trading network of marked goods and services are being used;

⁴⁰ Klik Legal, 9 Criteria Used Well-Known Marks in Indonesia, <https://kliklegal.com/9-kriteria-merek-terkenal-yang-digunakan-di-indonesia/> accessed on 21 November 2019

- 6) The mark recognition of the degree of trade arena and the network of the mark owner and prohibition against the use of the mark's top implemented;
- 7) The general nature and scope of the use of the same mark by third parties;
- 8) The existence of the trademark registration under the Act dated February 20, 1905 or the first registration.⁴¹

While in China, set the criteria on the Well-Known Marks as follows:

- 1) The scope of the geographic area where the trademark is used;
- 2) Duration of the mark has been used;
- 3) The amount and minimum income results from the use of the mark;
- 4) Knowledge of the community about the mark;
- 5) The status of these marks are registered in other countries;
- 6) The advertising expenses of the following areas range from those ads;
- 7) Efforts have been made mark owners in protecting the mark;
- 8) The ability of mark owners to maintain good quality of the mark he uses.⁴²

In Brazil, there are in the sub-three of the implementing regulation of Article 67 of the Industrial Property Code of Brazil that to declare as a Well-Known Marks should include the following information:

⁴¹ Imam Sjahputra Single, et al, Trademark Law in Indonesia, (Jakarta, Havarindo 2005), p 46-47

⁴² Imam Sjahputra Single, et al, Trademark Law in Indonesia, (Jakarta, Havarindo 2005), p 48

- 1) The value of the mark itself in the assets of the company as shown in the cash book and tax;
- 2) Spending on advertising per year over the mark;
- 3) The scope of marketing in the country and abroad with a number of user assessment of the following goods mark marketing and positioning the large number of related sectors;
- 4) Total State - State of the trademark is registered;
- 5) When first used the mark in Brazil included with the proof of documents - legal documents.⁴³

In Germany, to express a well-known mark, the German court based on the market survey conducted objectively. If the market survey proves that more than 80 percent of people recognize and know that mark, then the mark is well-known marks. In France only based on the poll 20 percent of people who know and recognize the mark proficiency level. While in Italy the mark has been recognized by 71 percent of the wearer.⁴⁴In this case that will determine whether or not the basic equation to a mark that is Judge. The judge in his duty was generally pay attention to the impression of the general nature of the mark in question to him and also the impression given by the mark concerned to the public.⁴⁵

⁴³ Imam Sjahputra Single, et al, Trademark Law in Indonesia, (Jakarta, Havarindo 2005), p 49

⁴⁴ Imam Sjahputra Single, et al, Trademark Law in Indonesia, (Jakarta, Havarindo 2005), pp 49-50

⁴⁵ Sudargo Gautama, Trademark Law of Indonesia, (Bandung, PT Citra Aditya Bakti), 1986, p. 84

Director of mark and Geographical Indications Directorate General of Intellectual Property Law and Human Rights, Fathlurachman states that Act No. 20 of 2016 on Marks and Geographical Indications already provides for well-known marks. However, well-known mark has not formulated specific criteria. Therefore, the government made nine criteria to see that a mark is categorized as a Well-Known Marks or not.

- 1) The level of public knowledge about the mark. When most people already know a mark, the mark can be described as a Well-Known Marks
- 2) Regarding the famous volume
- 3) Markets of the mark, a mark can be categorized as a Well-Known Marks when the mark is already circulating in various places in Indonesia
- 4) Coverage of a mark
- 5) Regarding the period of a mark. When a mark has long been circulating in the community, then the mark can also be categorized as a Well-Known Marks
- 6) Regarding the intensity of mark production costs, in relation to the amount of the costs incurred for the promotion of a mark
- 7) The mark filed anywhere. The higher the number the petition to a mark, the mark can also be categorized as a Well-Known Marks as it will also increase public knowledge
- 8) Regarding the level of success, law enforcement, especially regarding the recognition of any mark

9) Regarding the inherent value of a mark. This value can be based on a several mark's reputation.

These criteria mentioned in Article 18 Paragraph (3) of the Regulation of the Minister of Law and Human Rights No. 67 Year 2016 concerning the registration of the mark.⁴⁶

E. General Review International Well-Known Marks Protection in Indonesia

Well-Known Marks is entitled to legal protection, although not registered in a State refers to the protection essentially directed against reputation attached to a mark because of process / effort to produce / obtain the actual reputation legally deserves to be appreciated. The effort required to become famous with a lot of sacrifice and hard work. The legal protection may include protection of preventive and repressive legal protection.

1. Preventive Legal Protection

The consequences of constitutive system adopted by Law No. 20 of 2016 on Marks and Geographical Indications, rights to the mark created for registration. Stated by Article 3 of Law No. 20 of 2016 that:

"Right to Trademark obtained after the registered Trademark"

⁴⁶ Klik Legal.com, 9 Criteria Used Well-Known Marks in Indonesia, <http://kliklegal.com/9-kriteria-merek-terkenal-yang-digunakan-di-indonesia/>, Accessed on October 8, 2019, at 19:44 pm

By registering, mark owners will obtain exclusive rights over the use of a particular mark or to give permission to another to use it for a certain period as well as legal protection of the State.

Yahya Harahap said that the constitutive system has the advantage⁴⁷, that is:

Legal certainty to be protected. Enough to be seen who first obtained the filing date or registered in the public register of the mark; hence proving legal certainty based on the certificate of registration; to realize the alleged law who the rightful owner of the mark, did not give rise to controversy between the first user with the first registrant, because the only law alleged facts stand on the first registrant; therefore a basis for determining who holds most major mark is only based on the principle of first registrant and verification based on the documents that are authentic, then to withdraw allegations of laws, much simpler than the declarative system. This has positive impact on the settlement of the dispute, the settlement is much more simple, fast, and inexpensive.

a. Requirements to Registered Trademark

Marks should be a sign that can be included in the relevant goods or packaging of the goods. If a goods production company does not have the power of discernment, it is considered not a mark. Therefore, not all of which fulfill the distinguishing marks may be registered as a trademark. Trademark registration application filed bad faith applicants also cannot be registered.

⁴⁷ Rahmi Jened, "Well-Known Marks and Rules dilution", Media IPR: Bulletin of Information and The diversity of IPRs, the Directorate General of Intellectual Property, Vol. XI, No. 5 September 2014, p 96.

Article 21 Paragraph 3 of Law No. 20 of 2016 on Marks and Geographical Indication expressed Application is rejected if submitted by the applicant that bad faith. With the existence of this provision, it is clear that a mark cannot be rejected if the owner is registered and bad faith.

The provisions of Article 21 of Law No. 20 of 2016 on Marks and Geographical Indications, which regulates the mark denied registration. Trademark registration application should be rejected by the Directorate General of Intellectual if these marks:

- 1) Request rejected if these marks have a similarity in principle or in its entirety by:
 - a. A registered trademark of another party or filed earlier by another party for goods and / or services in kind
 - b. Well-Known Marks owned by other parties for goods and / or services in kind
 - c. Well-Known Marks owned by other parties for goods and / or services are not similar that meet certain requirements
 - d. Geographical indications registered
- 2) Application is rejected if the trademark is:
 - a. Is or resembles the name or abbreviation of a famous person's name, photograph, or the name of the legal entity owned by another person, except with a written consent of the entitled.
 - b. An imitation or resembles the name or abbreviation of the name, flag, symbol, or symbols, or emblems of a State, or

national and international institutions, except upon the written approval of the appropriate authorities.

- c. Imitate or resemble the mark or seal or official stamp used by the State or government agencies, unless a written consent of the authorities.⁴⁸

According Sudargo Gautama, trademark registration application must also be rejected by the Directorate General of Intellectual Property, if these marks:

- 1) Is or resembles a famous person's name, photograph, or the name of the legal entity that is used as a mark and registered in the General Register of Trademarks owned by others, except upon the written consent of the beneficiaries;
- 2) An imitation or resembles the name or abbreviation of the name, flag, emblem or symbol or emblem of a state or national institutions (including community organizations or socio-political organization) and internationally, except upon the written approval of the competent authority;
- 3) Imitate or resemble the mark or seal or official stamp used by the state or government institutions, except upon the written approval of the appropriate authorities.

⁴⁸ Act No. 20 of 2016 on Marks and Geographical Indications, Article 20 Paragraph (1) and Paragraph (2)

b. Application for Registration

Regarding requirements and procedures for applying for trademark registration are regulated in Article 4 through Article 8 of the Act No. 20 of 2016 on Marks and Geographical Indications. Trademark registration application submitted in writing in the Indonesian language at the Directorate General of Intellectual Property by completing a form and mention the type of goods and / or services and classes that applied for registration. The trademark registration application must be signed by the applicant or attorney. Petitioners consist of one person or several persons jointly or a legal entity. The application submitted by the applicant residing or permanently domiciled outside the territory of the Republic of Indonesia shall be submitted through proxies in Indonesia as well as state and choose his legal domicile staying power as Indonesia.

Article 10 and Article 14 of Law No. 20 of 2016 on Marks and Geographical Indications determine the application for registration of the mark with the priority right shall be filed within a period of 6 (six) months from the date of receipt of application for registration of the mark first achieved in other countries is a member of the Paris Convention for the Protection of Industrial Property or member Agreement Establishing the World Trade Organization.

This provision is intended to accommodate the interest of the state only be one member of the Paris Convention for the Protection of Industrial

Property 1883, as amended several times, or a member of the WTO or the World Trade Organization. Apart from having to comply with the requirements of application for trademark registration, the request by using the right of priority, must be accompanied by evidence of receipt of application for registration of the first mark that raises the priority rights, which translated into Indonesian performed by a sworn translator. Proof of priority rights in the form of letter of application for registration of the petition along with a receipt which also provides confirmation of the date of receipt of the request. When delivered in the form of a copy or photocopy or acceptance, endorsement of a copy or a photocopy or a receipt is provided by the Directorate General of Intellectual if the petition is filed for the first time. After that, the Directorate General of Intellectual Property Rights will conduct an examination of the completeness of registration requirements that applied for trademark registration. When there is a deficiency in the examination of the completeness of a trademark registration application requirements, the Directorate General of Intellectual Property Rights requested that the completeness of the conditions are met within a period of 2 (two) months from the date of delivery of the letter of request to completeness of these requirements.

Trademark registration application is considered withdrawn, if the completeness of the desired requirements are not complied with within the time specified as mentioned above. All costs have been paid to the

Directorate General cannot be returned, even if the applicant or their proxies to cancel plans to register his trademark.

c. Substantive examination

Once the trademark registration application meets all the requirements, the Directorate General will conduct a substantive examination as provided for in Article 23 through Article 26 of Law No. 20 of 2016 on Marks and Geographical Indications. Substantive examination of the application for registration of the mark is intended to determine the can or the inability of the mark concerned are listed, which is done within a period of nine (9) months. The investigation carried out under the provisions of Article 20, Article 21 and Article 22 of Law No. 20 of 2016 on Marks and Geographical Indications.

d. Application Announcement

Announcement of the application for registration of the mark as it has been confirmed Article 14 and Article 15 of Law No. 20 of 2016 on Marks and Geographical Indications, the Minister announced the application in the Official Gazette of marks within a period of 15 (fifteen) days from the date of receipt of the application as referred to in Article 13 of Law No. 20 of 2016 on Marks and Geographical Indications.⁴⁹

⁴⁹ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 14 and 15

e. Objection and Refutation

Article 16 and Article 17 of Law No. 20 of 2016 on Marks and Geographical Indications stated during the announcement period of 3 (three) months, each party may file a written objection to the Directorate General of Intellectual Property Rights at the request of concerned with the payment of a fee. Objections may only be submitted if there are sufficient grounds accompanied by evidence that the mark is a trademark applied for registration under the Act cannot be registered marks or rejected. Directorate General of Intellectual Property Rights will deliver or transmit a copy of the letter containing the complaint within 14 (fourteen) days from the date of receipt of the objection to the applicant or his proxy. Over the objections submitted another party, applicant or their proxies are entitled petitions to objections to the Directorate General of Intellectual Property Rights in writing within a period of 2 (two) months from the date of receipt of the copy of the objection sent by the Directorate General of Intellectual Property. Objection or refutation used by the Directorate General of Intellectual Property as an ingredient (s) in the re-examination of the application for trademark registration has been completed announced.⁵⁰

2. Repressive Legal Protection

Protection laws are repressive done in case of infringement of the mark through a civil action or criminal prosecution. That the owner of the registered

⁵⁰ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 16 and 17

mark protection for infringements of the rights to the mark both in the form of tort or termination of the act relating to the use of such marks by lawsuits and criminal by law enforcement officers. The owner of a registered trademark shall have the right to apply for cancellation of registration of the mark to the mark that he had registered by another person without rights.

The provisions of Article 35 of Law No. 20 of 2016 explains that the term of a trademark registration can be renewed each time for the same time period. For the legal protection of the registered mark, valid for a period of 10 (ten) years from the date of receipt and the protection period can be extended. To request an extension of the period of protection registered trademark shall be filed in writing by the mark owners or their proxies to the Directorate General of Intellectual Property. The extension request submitted within a period of not more than twelve (12) months and submitted at least six (6) months before the end term of protection for the mark registered.

CHAPTER III
WELL-KNOWN MARKS INFRINGEMENT UNDER REGULATION IN
INDONESIA

A. Laws and Regulations Related Intellectual Property

The rule of law is a rule written invitation containing a binding legal norms in general and institutions established or designated by the State or competent authority via procedures specified in laws and regulations. That to meet the public need for good laws and regulations, it is necessary to formulate a regulation which includes the establishment of laws and regulations in a manner set method, standard and binding standards in all aspects of the competent institutions to establish laws and regulations.

Laws and regulations there are several kinds, such as the 1945 Constitution, MPR, Law, Government Regulation, Presidential Decree, the regional regulation. In matters relating to Intellectual Property, in Indonesia there are some Act relating to Intellectual Property, namely:

- 1) Law No. 20 of 2016 on Marks and Geographical Indications
- 2) Law No. 28 Year 2014 About Copyright
- 3) Law No. 14 of 2001 on Patents
- 4) Law No. 13 of 2016 on Patent
- 5) Law No. 15 of 2001 on Marks
- 6) Law No. 19 of 2002 on Copyright
- 7) Law No. 31 of 2000 on Industrial Designs

8) Law No. 30 of 2000 on Trade Secrets

9) Law No. 32 Year 2000 on Integrated Circuit Layout Design⁵¹

1. Act No. 20 of 2016 on Marks and Geographical Indications

Law No. 20 of 2016 on Marks and Geographical Indications load on various aspects of the mark, including the understanding marks, marks that cannot be registered or rejected and ordinances did lawsuit if there is a infringement of the marks.

Understanding Mark, according to Article 1 of Law No. 20 of 2016 on Marks and Geographical Indications are signs that can be displayed graphically on images, logos, names, words, letters, numbers, color composition, in the form of two (2) dimensional and / or 3 (three) dimensions, sound, hologram, or a combination of the two (2) or more of these elements to distinguish the goods and / or services produced by the person or legal entity in the trading of goods and / or services.⁵²

Not all marks are registered can be taken for granted, of course, there are marks that can be denied registration for a foul marks. According to Article 20 of Law No. 20 of 2016 on Marks and Geographical Indications of a mark can be said to be in infringement and cannot be registered if these marks:

- 1) Contrary to the ideology of the State, Laws Invitation, morality, religion, morality, or public order.

⁵¹ the Directorate General of Intellectual Property Law and Human Rights Ministry, Regulations Related KI, <https://dgip.go.id/peraturan-terkait-ki> accessed November 19, 2019

⁵² Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 1

- 2) Same with, related to, or simply call the goods and / or services applied for registration
- 3) Contains elements that could mislead the public about the origin, quality, type, size, kind of, the intended use of the goods and / or services applied for registration or the name of the protected plant varieties for goods and / or services in kind.
- 4) Containing information that does not match the quality, benefits, or efficacy of goods and / or services produced.
- 5) No distinguishing features
- 6) Is a common name and / or public property.⁵³

Furthermore, Article 21 Paragraph (1) and Paragraph (2) of Law No. 20 of 2016 on Marks and Geographical Indications discusses the elements that form the basis of a mark can be denied the petition. Article 21 Paragraph (1) and Paragraph (2) states that:

- 1) Request rejected if these marks have a similarity in principle or in its entirety by:
 - a. A registered trademark of another party or filed earlier by another party for goods and / or services in kind
 - b. Well-Known Marks owned by other parties for goods and / or services in kind

⁵³ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 20

- c. Well-Known Marks owned by other parties for goods and / or services are not similar that meet certain requirements
 - d. Geographical indications registered
- 2) Application is rejected if the trademark is:
- a. Is or resembles the name or abbreviation of a famous person's name, photograph, or the name of the legal entity owned by another person, except with a written consent of the entitled.
 - b. An imitation or resembles the name or abbreviation of the name, flag, symbol, or symbols, or emblems of a State, or national and international institutions, except upon the written approval of the appropriate authorities.
 - c. Imitate or resemble the mark or seal or official stamp used by the State or government agencies, unless a written consent of the authorities.⁵⁴

B. Trademark Infringements in Indonesia

Every registered trademark protected by law. The protection is valid for 10 years and applies retroactively from the date of receipt and the protection period can be extended for the same period.⁵⁵ In fact, despite legal protections still are those who

⁵⁴ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 21 Paragraph (1) and Paragraph (2)

⁵⁵ Article 35 Paragraph (1) and (2) of Law No. 20 of 20 on Marks and Geographical Indications

commit infringements of the right marks. Types of infringements that often occur in Indonesia is:

1. Infringement of Similarity

Infringement Similarity substantially or wholly with well-known marks into the issues that have taken place not only in Indonesia, but also outside the State. Similarity in principle to make consumers become confused because this offense is a infringement of a mark that has elements of resemblance is so precise, as an example the case of a dispute marks include Gudang Garam and Gudang Baru which has been won by Gudang Garam after a fierce battle that ended by PK who has permanent legal strength.

This case began when PT Gudang Garam Tbk not accept Ali Khosin Gudang Baru producing cigarettes through the PR firm Jaya Makmur. Ali dared to produce cigarettes with names similar to having pocketed Registration Number IDM000032226 dated March 21, 2005 and No. IDM000042757 dated July 14, 2005 for the type of goods in class 34 of the General Register of Marks Directorate General (DG) IPR.

Gudang Garam in 2012 and then penalize Gudang Baru boss, Ali Khosin. On March 8, 2012 PN Kepanjen Khosin Ali sentenced to 10 months in prison and fined Rp 50 million subsidiary 2 months in prison.

In 2013 the turn of the mark Gudang Garam filed to the Commercial Court in May 2013 Surabaya ago. After fighting for four months, the panel chaired

Surabaya Commercial Court Syarifuddin Ainor Rafiek with members of Superior Ahmadi and Suhartoyo was then granted the request Gudang Garam. Assembly Surabaya Commercial Court canceled the registration of the mark Gudang Baru and Painting at the 12 September 2013 last.

For this defeat, Ali filed an appeal. On April 22, 2014, Supreme Court reversed the situation by winning the Gudang Baru. In a trademark dispute, the Supreme Court (MA) state Gudang Baru is not plagiarism Gudang Garam. But in a criminal case, the Gudang Baru boss, Ali Khosin, remained in jail because it is considered plagiarized Gudang Garam. In consideration of the Supreme Court, a similarity in principle very imprecise when examined mark and images used Gudang Baru was no equation form, how placements and rime (similarity in sound) that can lead to the confusion.

Does not accept the Supreme Court verdict, Gudang Garam finally filed for PK. One reason PK namely Ali has been executed in a criminal case mark, which is sufficient reason Ali was not acting in good faith in terms of use of the mark new barn. "Declare salt warehouse mark is a Well-Known Marks. Declare Gudang Baru marks have similarities in principle with the mark Gudang Garam. Unenrolling mark new barn,"

2. Infringement Passing Off

The terms Passing Off is an attempt / action / actions that lead to the existence of an infringement in the field of intellectual property rights, in this

case mark law. So in the case of the infringement has not occurred, then the efforts that led to the infringement.

Passing off can also be regarded as unfair business competition, because these actions include the creation of a mark that is very similar and do not represent the original mark that could damage the reputation of the original mark.

Passing off is a form of action against the law in the common law system that can be used to enforce trademark rights are not and those already registered. Tort related to passing off is intended to protect the reputation of a mark from a mark that is very similar and do not represent the original mark that can damage mark reputation legal. Prevention of infringement of law passing off is to prevent the rights owner of the efforts of people who emulate, thus avoiding the effort to take advantage of the mark, this term is not known in Indonesia. In Indonesia is often known as "Piggybacking Reputation" where acts are trying to grab the advantage with a free ride on the reputation of other marks that have been successful

3. Infringement of Principle Missue

Another infringement is related to Missue. In case of infringement of trademark law generally will charge a one-way obligations, requiring offenders to pay compensation to the holder of a trademark for the infringements that they do. This is different from a doctrine of "trademark missue" will revise this regime by allowing liability for damages in two ways, for those who feel harmed

by this infringement and for trademark holders. Thus, this principle will also memungkinkan people who feel aggrieved by the mark will be able to sue.⁵⁶

C. Comparison with the US Trademark Law

The United States also adopts the same registration with Indonesia, namely the registration by mark inspection in advance. Prior to registration, the mark concerned must first be examined regarding the terms of the petition as well as the mark itself. Only marks that qualify and have no similarity in whole or in principle with the mark that has been registered for similar goods on behalf of another person can be registered for similar goods on behalf of another person can be registered.

As for some of the provisions governing the Trademark infringement in the United States are as follows:

- 1) In cases involving the use of false alerts <as defined in section 1116 (d)> in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may choose, at any time before the end of the assessment given by the court, to recover, instead of damages actual and profits in paragraph (a) of this section, an award of statutory damages for such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of: (1) not less than \$ 1,000 or more than \$ 200,000 per fake mark per type of goods or services sold, offered for sale, or distributed, as the court considers (2) if the court finds that the use

⁵⁶Edy Santoso, "Law Enforcement Against Famous Trademark Infringement Through Role of Customs as an Effort to Maintain Security and State Sovereignty", (Volume 5 No. 1, April 2016), pp 8-11

of counterfeit mark was deliberate, not more than \$ 2,000.000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers only).

2) (In cases involving infringement of section 1125 (d) (1) of this title, the plaintiff may choose, at any time before final judgment is given by the court, to recover, instead of actual damages and profits, an award of statutory damages in an amount not less than \$ 1,000 and not more than \$ 100,000 per domain name, as the court considers only).⁵⁷

D. Similarity

Infringement Equation substantially or wholly with well-known marks into the issues that have taken place not only in Indonesia, but also outside the State. Similarity in principle to make consumers become confused because this offense is a infringement of a mark that has elements of resemblance is so precise.

Much of the debate related to similarity in principle, as for the determination of similarity can be based on several factors, namely:

- 1) Similarities equation image;
- 2) Almost similar or almost the same wording, color, or sound;
- 3) Not absolute goods must type or class;

⁵⁷ Steven, Judicial Review Concerning Trademark Rights Protection Law in Comparative Perspective Indonesia and the United States, (UIB Repository, 2015), page 55-56

4) The use of mark real cause confusion or mislead the consumer society.⁵⁸

And based on the jurisprudence of the Supreme Court RI Number 217 K / Sip / 1972 states that "a Mark have similarities with other marks if the shape or structure, or sounds and for the people has the impression, so do not need to be 100% the same";⁵⁹

The jurisprudence of the Supreme Court RI No. 2279 K / Pdt / 1992 dated January 6, 1998 which states that "Marks that have similarities in whole or in essence can be described as having equation form, the composition of the equation, the equation and the equation element combination of elements";

The jurisprudence of the Supreme Court RI No. 2451 K / Pdt / 1987 dated April 13, 1991 and the jurisprudence of the Supreme Court RI No. 1053 K / Sip / 1982 dated December 22, 1982 had mentioned "that to determine whether there is a second equation Trademark dispute, must be seen as a whole and not by detailing how one by one the elements or parts that became the trademark, meaning that ratings similarity in principle is based on their impression of the total (total indruk) and not by comparing the differences in the parts Mark "⁶⁰

Similarity in principle based on the elucidation of Article 21 paragraph 1 of Law No. 20 of 2016 on Marks and Geographical Indications is defined as "similarity in principle" is the similarity caused by the presence of the dominant element between

⁵⁸Yahya Harahap, Mark Overview General and Trademark Law in Indonesia Based on Law No. 19 of 1992, (Bandung, PT Citra Aditya Bakti, 1996), p. 417.

⁵⁹ Indonesia Supreme Court, Decision Number 119 PK / Pdt.Sus-HKI / 2017 page 9-10

⁶⁰ Indonesia Supreme Court, Decision Number 119 PK / Pdt.Sus-HKI / 2017 page 9-10

marks of the Trademark another so that the impression equality, either on the form, placement means, ways of writing or a combination of elements, as well as rhyme words, contained in said mark. While marks foul similarity in principle be denied registration, pursuant to Article 21 Paragraph (1) of Law No. 21 of 2016 on Marks and Geographical Indications, the mark will be rejected if it has a similarity in principle to:

- a. A registered trademark of another party or filed earlier by another party for goods and / or services in kind;
- b. Well-Known Marks belonging to another party for goods from / or similar services;
- c. Well-Known Marks belonging to another party for goods darr / or services are not similar that meet certain requirements; or
- d. Registered geographical indication.

CHAPTER 4

THE BASIC ELEMENTS OF TRADEMARK INFRINGEMENTS AND THE LAW ENFORCEMENT

A. The Basic Elements Of Trademark Infringements

As discussed in the previous chapter about the types of infringements that often occur mark in Indonesia is Equation substantially Piggybacking reputation and Principles Missue. Similarity in principle and Piggybacking reputation are two things that cannot be separated. Each mark who violate Equation substantially or mimic of a mark that is well-known it is certain that the mark wants to make a profit or gain rapid and greater than imitate a mark that is well-known, because of imitating Well-Known Marks will get more attention from consumers because consumers will thinks that the new mark is the continuation or the latest product of the Well-Known Marks.

1. The basic elements of similarity

Viewed from the case between Gudang Garam and Gudang Baru. Gudang Garam very objection to the registration of the mark new barn assessed mimic of Gudang Garam, which are described in Decision No. 119PK / Pdt.Sus-IPR / 2017 said that Gudang Garam states strongly objected because it can be known for certain that the idea of creating Mark Gudang Baru and painting on the packaging Gudang Baru inspired from the mark Gudang Garam as the mark that is well known. And not the good faith of the parties enrolled Mark Gudang Baru and painting is the purpose of piggybacking reputation owned by Gudang Garam

has been built painstakingly over decades with cost, power and mind, in the form of promotion and investment.

And based on the jurisprudence of the Supreme Court No. 021 K / IP / 2003 in the case of Mark Giojien Co. states that "The act of bad faith enrolled Mark Gio Jeans Co. is an attempt to mislead the public about the origin of goods, as well as an act which cannot be justified to achieve the goal dishonest so that if it is allowed to be contrary to the public order".

And based on the jurisprudence of the Supreme Court No. 046 K / N / IPR / 2006 in the case of marks between Love and My Love with My Lowe which states that "should the defendant be able to create words or other signs as a trademark without having to emulate or use a mark My Lowe, for writing My Lowe have similarities shape, composition and how the placement of the letters, the way of writing and the voice of the mark Love & My Love already registered earlier for similar items. It is thus clear mark registration My Lowe constituted bad faith"⁶¹

Losses received from parties that have well-known mark is that consumers will move in part to Mark dummies being fooled from the mark, as well as the quality of goods / services resulting from counterfeit marks are not the same or worse than the Well-Known Marks products, so the loss of consumer confidence against such well-known marks.

⁶¹ Indonesia Supreme Court, Decision Number 119PK / Pdt.Sus-HKI / 2017

Be inspired that infringements of similarity in principle have some trigger factor, a number of factors or elements that form the basis of mark infringement. Equation substantially or elements that form the basis of similarity is as follows:

1. More quickly and surely get profit, as the inimitable mark usually are very in demand in the market;
2. Do not want to bear the costs to be incurred in an attempt to create a new mark became famous through advertising or promotion must be made widely and continuously;
3. Difference in benefits will be greater to sell products using imitation marks, because manufacturers do not need to pay extra for market research, promotion costs so that products can be sold more cheaply and attract more consumer attention.

Article 21 Paragraph (1) on Law No 20 year 2016 on Marks and Geographical Indications said that trademarks cannot be registered if it have similarity. There are still many people who don't know the elements of similarity, based on the explanation section on Article 21 Paragraph (1) on Law No 20 Year 2016 on Marks and Geographical Indications said that "Similarity is the resemblance caused by the existence of a dominant element between one Trademark with another Trademark giving rise to the impression of similarities, both regarding the form, method of placement,

method of writing or a similarity of combination the elements or the similarity of speech sounds, contained in the Mark.”

Based on Jurisprudence of Supreme Court Indonesia No. 2279 PK/Pdt/1992 on 6th January 1998 said that “marks that have similarity can described as similarity of form, similarity of composition, similarity of combination and similarity of goods elements.

And based on Jurisprudence Supreme Court Indonesia No. 217 K/Sip/1972 said that “a trademark has similarities with other marks, if form or composition, or sound and for the community has caused impression, so it doesn't need to be 100% the same”. So it don't need to be 100% same like other marks, it just need to take the consumer's viewpoint.

So based on the description above, the elements of similarity can be divided into:

- 1) Similarity of form
- 2) Similarity of writing or placing method
- 3) Similarity of combination the elements
- 4) Similarity of sounds

B. Law Enforcement for Well-Known Mark Infringements

The consequences of constitutive system adopted by Law No. 20 of 2016 on Marks and Geographical Indications, rights to the mark created for registration. Stated by Article 3 of Law No. 20 of 2016 on Marks and Geographical Indications that the "Right to Trademark obtained after the registered Trademark"⁶², By registering, mark owners will obtain exclusive rights to use a particular mark or to give permission to another to use it for a certain period of time as well as get legal protection from the state. Yahya Harahap said that the constitutive discount system advantages, that are:

1. Legal certainty to be protected. Enough to be seen who first obtain a filing date or registered in the public register of the mark;
2. Hence proving legal certainty based on the certificate of registration; to realize the alleged law who the rightful owner of the mark, did not give rise to controversy between the first user with the first registrant, because the only law alleged facts stand on the first registrant;⁶³

Law No. 20 of 2016 on Marks and Geographical Indications load on procedures for registration of the trademark to attempt a rebuttal or objection from the other party to the mark in the register, until the abolition of the mark proved to have violated.

⁶² Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 3

⁶³ Rahmi Jened, Trademark Law (Trade Mark Law) in the Era of Global and Economic Integration, (Jakarta: Prenamedia Group, 2015), p 96.

Pursuant to Article 72 Paragraph (7) of Law No. 20 of 2016 on Marks and Geographical Indications stated that the Abolition of registered marks on the initiative of the Minister may be made if:

- a. Has a similarity in principle and / or in its entirety with Geographical Indications
- b. Contrary to the ideology of the State, rules and regulations, morality, religion, morality and public order
- c. Having the same on the whole with the traditional cultural expressions, intangible cultural heritage, or the name or logo that has been a tradition for generations.

The lawsuit shall be filed Registered Trademark Commercial Court in accordance with Article 76 to Article 78 of Law No. 20 of 2016 on Marks and Geographical Indications which states:

Article 76:

- (1) Registered Trademark lawsuit for cancellation may be filed by an interested party on the grounds referred to in Article 20 and / or 21.
- (2) Own marks are not registered may file a lawsuit as referred to in paragraph (1) after applying to the Minister.

(3) A lawsuit for cancellation submitted to the Commercial Court against a Registered Trademark⁶⁴

Article 77:

(1) The lawsuit for cancellation Trademark registration can only be filed in period of 5 (five) years from the date of registration of Marks.

(2) A lawsuit for cancellation may be filed indefinitely if there is an element of bad faith and, 'or the relevant mark contrary to the ideology of the state, laws, morality, religion, morality and public order.⁶⁵

Article 78:

(1) Against the decision of the Commercial Court on the lawsuit as referred to in Article 76 paragraph (3) can be appealed.

(2) The Clerk of the court immediately convey the decision to the parties to the dispute.⁶⁶

So the Law Enforcement of the mark who are victims of Trademark Infringement clearly protected and regulated by Law No. 20 of 2016 on Marks and Geographical Indications.

Parties who have objections to directly sue a registered mark for unregistered to the Commercial Court, if less satisfied with the decision of the Commercial Court

⁶⁴ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 76

⁶⁵ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 77

⁶⁶ Indonesia, Mark and Geographical Indications, Law No 20 of 2016, Article No 78

can proceed to the stage of Cassation Supreme Court, if still not satisfied with the result, it can apply for PK to the Supreme Court as happened in the case of Gudang Garam VS Gudang Baru. That is related to Article 83 Paragraph (1) and (3) Law No 20 Year 2016 of Mark and Geographical Indication. That article said:

(1) The owner of the registered mark and/or the licensee of the registered mark may file a lawsuit against another party who without the right to use the mark which has similarity in principle or in whole for goods and/or service of a similar type, with:

- a. Claim for compensation and/or
- b. Termination of all acts related to the use of the mark.

(3)The lawsuit as referred in Paragraph (1) was submitted to the Comercial Court.

CHAPTER 5

CLOSING

A. Conclusion

From the explanation above, the case examples, and the problems faced by well-known marks most are similarities that befall well-known marks made by parties who are not responsible. There are also elements that form the basis similarity, not necessarily 100% similar to other marks, but by having similarities that can fool the consumers. The basic elements of similarity are similarity of form related to explanation section on Article 21 Law No 20 Year 2016 of Mark and Geographical Indication and to Jurisprudence of Supreme Court Indonesia No. 2279 PK/Pdt/1992 on 6th January 1998. The second is similarity of writing related to explanation section on Article 21 Law No 20 Year 2016 of Mark and Geographical Indication. The third is similarity of combination that still related to Article 21 Law No 20 Year 2016 of Mark and Geographical Indication and to Jurisprudence of Supreme Court Indonesia No. 2279 PK/Pdt/1992 on 6th January 1998. And the last is similarity of sound related to Article 21 Law No 20 Year 2016 of Mark and Geographical Indication. Such as Gudang Garam and Gudang Baru, they are not 100% same, but have similarities so that it scams consumers into thinking that 2 marks are the same.

As well as legal protection and procedures for obtaining justice for victim marks, law enforcement can be reached with submit a lawsuit to the commercial court, this is related to Article 83 Law No 20 Year 2016 of Mark and Geographical Indication

B. Suggestions

The government must socialize more frequently to the public, especially to producers, so that there are no further infringement of marks anymore. And also the institution in charge of checking in the process of trademark registration must pay more attention to the basic elements of infringement, especially in similarity. Because a case like this is detrimental to all parties. From the producers, consumers, to related institutions also got the impact from this infringement.