

LEGAL PROTECTION OF FAMOUS TRADEMARKS

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Abstract

The purpose of this study is to analyze the legal protection of well-known brands. The use of well-known brands at this time has begun to flourish, this is because it promises great benefits to be obtained when using well-known brands rather than using their own brands. Many manufacturers have got around to combining original branded goods with pirated ones, because the pirated is physically similar to the original. In this article that what determines a brand is the community because it is the public who knows that a brand is worthy of being famous. So, one way is through Preventive and Repressive Protection in accordance with Law 20 of 2016, there is a need for amendments to a definite measure for the Judge to determine the criteria for a famous mark and also provide criteria that can distinguish the similarity in essence from the overall equation and the philosophical requirements of a brand.

Keywords: Legal Protection; Law; Brands; Famous Brands.

A. INTRODUCTION

*The use of well-known brands at this time has begun to flourish, this is because it promises great benefits to be obtained when using well-known brands rather than using their own brands. Especially during a prolonged economic crisis such as today, many producers have taken precautions by combining original branded goods with pirated ones, because the pirated is physically similar to the original.*¹

Protection of intellectual property rights (IPR) is a step forward for the Indonesian nation, which in 2020 will enter the era of the free market. One of the implementations of the free market era is that the state and people of Indonesia will become an open market for the products or works of foreign (foreign) people /companies, likewise the Indonesian people can sell their products/works of creation abroad freely. Therefore, it is only proper that products or other works that are IPR and have been circulating in the global market need effective legal protection from all violations that are not in accordance with the TRIPs agreement.² as well as the conventions that have been agreed upon.³

Research on registered trademark protection conducted by Zaenal Arifin (2020) examines and analyzes how legal protection of registered marks and why protection of registered marks can end. The results of this study indicate that the registration of a mark may end due to the expiration of the mark's validity period, the deletion of the mark due to the trademark owner's own request, the removal of the registered mark at the initiative of the minister after receiving a recommendation from the Mark Appeal Commission, and the deletion of the mark due to a lawsuit from a third party. The existence of trademark protection starts from the registration of the mark, protection of

¹Law Community, "Legal Protection Against Use of Famous Trademarks", (<https://wonkdermayu.wordpress.com/artikel/perlindungan-hukum-terhadap-pemanektronik-merek-terkenal/>) accessed on 20 August 2019.

²TRIPs (Agreement on Trade-Related Aspects of Intellectual Property Rights) is "an agreement that applies to all members [World Trade Organization](#)(WTO). This agreement sets the minimum standards for regulation [intellectual property](#)in WTO member countries. The contents of the TRIPs agreement were negotiated during [Uruguay Round](#)in 1994. Taken from Wikipedia Indonesia, the TRIPs Agreement ", (https://id.wikipedia.org/wiki/Perjanjian_TRIPs), accessed on 21 November 2019.

³Prasetyo Hadi Purwandoko, The Problems of Brand Protection in Indonesia, (<https://prasetyohp.wordpress.com/problematics-perlindungan-merek-di-indonesia/>), accessed on 11 November 2019.

the mark during the period of registration of the mark for 10 (ten) years and can be extended for the same period, the existence of good civil action lawsuits,⁴

Research conducted by Rakhmita Desmayanti (2018) which examines an overview of well-known brand protection. The results of this study explain that the regulation of famous brands in Law No. 20 of 2016 on Brands and Geographical Indications, and Regulation of the Minister of Law and Human Rights No. 67 of 2016 concerning Trademark Registration do not regulate in detail the meaning and meaning of well-known brands. There is still a brand that is considered well-known by the public, but on the other hand, a registered and widely recognized trademark is not considered a well-known trademark.⁵

Further research on the legal protection of famous brands was studied by Thoyyibah Bafadhal (2018) entitled "Legal Protection of Famous Trademarks in Indonesia: The IKEA Case". This study raises the issue of the IKEA brand dispute case as a study material to analyze how well-known trademark legal protection prevails in Indonesia. In the IKEA trademark dispute case, in the end the panel of judges won the IKEA brand owned by PT. Ratania Khatulistiwa and defeating IKEA Sweden, the decision of the panel of judges is considered to ignore the goodwill of each party. The judge's decision in favor of PT. Ratania Khatulistiwa in the case of the IKEA brand dispute can set a bad precedent for the protection of famous brands in Indonesia.⁶

Meanwhile, Rahmadia Maudy Putri Karina and Rinitami Njatrijani (2019) in their research which examines legal protection for IKEA trademark rights holders and when PT. Sweden's Inter IKEA System BV has lost the rights to its brand. The study raised a trademark dispute between PT. Ratania Khatulistiwa which is a rattan company from Surabaya that sued the IKEA brand. PT. Ratania Khatulistiwa in 2013 registered her IKEA brand in 2013, after learning that IKEA Sweden does not have a shop and markets its products in Indonesia. This research focuses more on the legal

⁴ Zaenal Arifin, "Perlindungan Hukum Terhadap Merek Yang Terdaftar" Jurnal Ius Constituendum 5 (1), 2020, p. 47-65. DOI : [10.26623/jic.v5i1.2117](https://doi.org/10.26623/jic.v5i1.2117)

⁵Rakhmita Desmayanti, "Tinjauan Umum Perlindungan Merek Terkenal Sebagai Daya Pembeda Menurut Prespektif Hukum Di Indonesia ", Jurnal Cahaya Keadilan 6 (1), 2018, p. 1-21. DOI:<https://doi.org/10.33884/jck.v6i1.874>

⁶Thoyyibah Bafadhal, " Perlindungan Hukum terhadap Merek Terkenal di Indonesia Kasus IKEA". Undang: Jurnal Hukum 1 (1), 2018, p. 21-41. DOI<https://doi.org/10.22437/ujh.1.1.21-41>

*protection of IKEA trademark rights holders and the legal protection of brand owners in good faith.*⁷

*Based on the results of the above research, it can be understood that so far, the legal protection of well-known brands has not been maximally implemented. This can be proven that in Law no. 20 of 2016 concerning Trademarks and Geographical Indications, which are the provisions of *lex specialis derogat legi generalis* from trademark regulation, have not clearly regulated well-known brands. The difference between this study and previous research is that this study focuses more on examining how well-known trademark legal protection is in accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications. The purpose of this study is to analyze the legal protection of well-known brands.*

B. PROBLEMS

Based on the background above, we can formulate problems that will become a reference in this study, including the following:

- 1. How is the legal protection for well-known brands in accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications?*
- 2. What are the obstacles and solutions to legal protection for well-known brands in accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications?*

⁷ Rahmadia Maudy Putri Karina, Rinitami Njatrijani, “*Perlindungan Hukum Bagi Pemegang Hak Merek Dagang Ikea Atas Penghapusan Merek Dagang*”, *Jurnal Pembangunan Hukum Indonesia*, 2019, p. 194-212. DOI: <https://doi.org/10.14710/jphi.v1i2.194-212>

C. RESEARCH METHODS

Research is one of the main means of developing science and technology. This is because research aims to find, develop or test the truth of knowledge. Finding means trying to find something that fills the blanks and weaknesses. Developing means expanding or digging deeper into what already exists, whereas testing the truth is done if what already exists is still or becomes doubtful. This research uses a normative juridical approach, which is "research conceptualized based on the applicable laws or legal rules if the case comes to the surface".⁸ The juridical approach is an approach that refers to the applicable laws and regulations,⁹ whereas the normative approach is "research contains secondary data in the field of law which concerns primary legal materials, namely statutory regulations and secondary legal materials in the form of scientific works of scholars".¹⁰

Normative legal research (juridical normative) is "legal research that places law as a norm system building".¹¹ Normative legal research, law is conceptualized as what is written in legislation or law is conceptualized as a rule or norm which is a benchmark for ideal human behavior.

Normative legal research always takes the issue of law as a system of norms used to provide prescriptive "justification" about a legal event.¹² This research is categorized as "normative research because by examining the literature on secondary data sourced from literature". In the legal protection of well-known brands, the author uses the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications as a legal reference in resolving the case.

D. DISCUSSION AND RESULT

⁸ Amiruddin and H. Zainal Asikin, "Introduction to Legal Research Methods" (Jakarta, PT. Rajagrafindo Persada, 2004), p. 118.

⁹ Roni Hanitijo Soemitro, "Legal and Jurimetr Research Methodology", (Jakarta: Ghalia Indonesia, 1982), p. 20.

¹⁰ Soerjono Soekanto, "Introduction to Legal Research", (Jakarta: UI Press, 1984), p. 7.

¹¹ Mukti Fajar ND and Yulianto Achmad, "The Dualism of Normative & Empirical Legal Research", (Yogyakarta: Student Library, 2013), p. 34.

¹² *Ibid*, p. 36.

1. Legal Protection for Famous Marks In Accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications

In Article 1, paragraph 5, Law Number 20 of 2016 concerning Marks and Geographical Indications, it is stated that the right to a mark is "an exclusive right granted by the state to the owner of a Mark registered in the general register of marks for a certain period by using the mark himself or giving permission. to other parties to use it".

Furthermore, Article 35 of the Trademark and Geographical Indication Law states that a registered mark is legally protected for a period of 10 (ten) years from the date of receipt of the registration of the mark (filling date) concerned and can be extended for the same period. Thus, if a person / legal entity wants his mark to receive legal protection based on trademark law, the mark concerned must first be registered.

Trademark registration aims to obtain legal certainty and legal protection of trademark rights. Registration of marks is carried out at the Directorate General of Intellectual Property Rights. The Directorate General of IPR is "a trademark registration agency assigned to register a mark that is requested for registration by the trademark owner".¹³

An application for registration of a mark will be accepted for registration if it has met the formal and substantive requirements stipulated in the Trademark and Geographical Indication Law. An important requirement which is also the main characteristic of a brand is sufficient distinctiveness. The brand used must be such that it has sufficient strength to distinguish the goods or services of a company from the goods or services produced by other companies.

The consequence of a registered mark is that it must be used with the request for registration. The Trademark Law requires the trademark owner to be honest in using his mark, meaning that the registered mark used according to the class of goods or services registered must also be of the same shape as the mark used. If a registered

¹³Syahriyah Semaun, "Perlindungan Hukum Terhadap Merek Perdagangan Barang Dan Jasa", Jurnal Syariah dan Hukum Diktum 14 (1)1, 2016, p. 109-110.

mark is not used in accordance with the provisions stipulated in law, it will result in the registration of the mark concerned being deleted.¹⁴

Article 21 paragraphs 3 and 4 states that the application is rejected if it is submitted by an applicant with bad faith and further provisions regarding rejection of the application for a mark as referred to in paragraph 1 letter a to letter c shall be regulated in a ministerial regulation.¹⁵

The equation in its entirety is "the equation of the whole element. Such equations are in accordance with the doctrine of entires similar or the same as all elements ". In other words, the mark for which registration is requested is a copy or reproduction of the other person's mark.¹⁶ In order for a mark to be referred to as a copy or reproduction of someone else's mark so that it is qualified to contain similarities as a whole, it must at least meet the requirements.¹⁷

A mark is considered to have similarities in essence with the mark of another party which is determined based on a more flexible standard than the entire similar doctrine. Basically, this similarity is considered tangible if the brand is similar or similar, almost similar (nearly resembles) to other people's brands.

Furthermore, according to the elucidation of Article 21 paragraph 1 of the Trademark and Geographical Indication Law, what is meant by 'the same in essence' with registered marks of other people is "the same impression, among others, regarding the form, placement method, writing method or combination of elements or the sound of speech contained in the relevant mark ".

Based on Article 21 paragraph 2 the provisions as stipulated in Article 21 paragraph 1 letter b (famous mark) can also be applied to goods or services which are not similar as long as certain requirements are fulfilled which are further stipulated by government regulations. However, until now the government regulation referred to in Article 21 paragraph (2) does not yet exist.

If the application for registration of a mark has met the requirements for formality, substantive requirements, and the announcement period, then a trademark

¹⁴Jisia Mamahit, "“Perlindungan Hukum Atas Merek Dalam Perdagangan Barang Dan Jasa”, Jurnal Lex Privatum 1 (3), 2013, p. 92.

¹⁵ *Ibid*, p. 9.

¹⁶ Prasetyo Hadi Purwandoko, "The Problems of Brand Protection in Indonesia", (<https://prasetyohp.wordpress.com/problematics-perlindungan-merek-di-indonesia/>, accessed August 19, 2019).

¹⁷ *Ibid*.

certificate can be issued and then registered in the general register of marks. After the receipt of the mark certificate and the registration of the mark concerned in the general register of marks, the owner of the registered mark has the exclusive right which can be in the form of exclusive enjoyment rights to exploit benefits (exclusive financial exploitation).

*Article 83 paragraph 1 of the Law on Trademarks and Geographical Indications gives rights to registered mark owners to file a lawsuit against other parties who unlawfully use a mark of goods and or services that have substantially similarity or in whole for similar goods or services in the form of:*¹⁸

- a. claim for compensation, and / or*
- b. termination of all acts related to the use of said Mark.*

Article 25 limits the infringement of a mark to only similar goods or services. According to article 83 paragraph 3, the lawsuit must be filed through a commercial court.

Furthermore, according to Article 84 of the Law on Trademarks and Geographical Indications, at the request of the trademark owner or registered trademark licensee as the plaintiff, as long as he is still able to order the defendant to stop trading in goods or services that use the mark without such rights. In addition, Article 84 paragraph 2 of the Law on Trademarks and Geographical Indications determines that in the event that the defendant is also required to direct goods that use a mark without rights, the judge may order that the delivery of the goods or the value of the goods is carried out after the court decision has permanent legal force.

Besides having the right to file a civil suit, the trademark owner can also resolve the dispute through arbitration or alternative dispute resolution. Other legal protection is based on the provisions of criminal law.

Another legal protection is based on the criminal provisions of the Trademark and Geographical Indication Law. Legal protection for owners is based on the criminal provisions of the Law on Trademarks and Geographical Indications contained in article 100 to article 103. Then, the sanctions stipulated in Article 101 of the Trademark Law

¹⁸Hukumonline.com, *Loc. Cit.*, p. 27.

are related to the expansion of the scope of protected marks, namely Geographical Indications and Indications of Origin. Article 103 states that "the criminal act referred to in articles 100 to article 102 constitutes a complaint offense".

2. Constraints and Solutions for Legal Protection Against Famous Marks In Accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications

The weaknesses of the Trademark Law in terms of trademark registration are:

- a. There is no philosophical requirement of a registered trademark*
- b. There are multiple interpretations of the understanding of a well-known brand and similarities in essence or in its entirety¹⁹*

Another opinion from Setyawati is that the obstacles to trademark registration, including famous trademark registration, if the brand is not advertised and promoted continuously or intensely, then the brand of a product, both goods and services will not be known by the wider community and a brand that is already well-known in a certain area. regions or provinces or countries are not necessarily known in other provinces or countries if the trademark is not registered at the Trademark Director of the Ministry of Law and Human Rights by exercising priority rights in trademark registration, especially famous trademark registration.²⁰

Another opinion from Razilu and Agung Indriyanto regarding the well-known protection obstacle is proof of this. This proof is where a well-known brand is proven by the development of the brand's time, coverage, degree of recognition, investment value in several countries so that business owners of famous brands must have clear portfolios or legal data.²¹

Solutions for legal protection for well-known brands in accordance with the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and

¹⁹ Karlina Perdana, "Weaknesses of the Trademark Law in terms of Trademark Registration (Study of the Verdict of the Pierre Cardin Trademark Dispute)", Thesis, 2017 Faculty of Law, Sebelas Maret University Surakarta, p. 89.

²⁰ Interview with Setyawati as a Lecturer at the Faculty of Law, Sultan Agung Islamic University Semarang (UNISSULA) at the Directorate General of AHU, Ministry of Law and Human Rights of the Republic of Indonesia, Jakarta on January 15, 2020.

²¹ Interview with Razilu as Expert Staff for Economic Affairs of the Ministry of Law and Human Rights of the Republic of Indonesia and Agung Indriyanto as Intermediate Trademark Examiner for the Ministry of Law and Human Rights of the Republic of Indonesia at the Directorate General of AHU, Ministry of Law and Human Rights of the Republic of Indonesia, Jakarta on January 15, 2020.

Geographical Indications include definite standards for judges to determine the criteria for a famous mark and also provide criteria that can distinguish the similarity in essence from the overall equation as well as the philosophical requirements of a mark as the completeness of the requirements for the application for registration of a mark. A trademark dispute between Tulipware and Tupperware. So that in practice there are no more famous trademark disputes such as the IKEA case and the Tupperware trademark dispute. In the Tupperware trademark dispute case, the owner of the Tupperware trademark was harmed by the Tulipware trademark registration filing a lawsuit against the commercial court. The lawsuit was filed because Tulipware was deemed to use a brand that had the same substantially or entirely for goods or services.²² Protection of brands can also be done by documenting well-known brands. In addition, well-known brand manufacturers, to anticipate registration by other producers, can immediately register their trademarks first.

E. CONCLUSION

At first, well-known brands are ordinary brands that over time through their coverage, degree of recognition and others. Because over time and things are caused by being able to maintain the quality of a brand so that people conceptualize from an ordinary brand to a well-known brand. In fact, in the Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications, there are no well-known brands. Actually, the concept of a famous brand is from the community and from academics. There are multiple interpretations of Law Number 20 of 2016 which has legal loopholes that have not yet determined a definite size limit the criteria for a well-known mark and also provide criteria that can distinguish the similarity in essence from the equation as a whole or part of a mark in essence and there is no philosophical requirement for a mark as the completeness of the requirements for the application for trademark registration.

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