

Legal Protection of Marks in the Perspective of Property Rights Law

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Abstract: *This research aims to find out: (1) why do rights to registered trademarks end just like that? and (2) what are the effective steps in providing legal protection for registered marks? This research uses a normative juridical approach to examine and analyze the legal protection of registered marks, as well as identifying the causes of the end of their protection. The research results reveal several reasons why a trademark registration may end, including the expiration of the trademark's validity period, a request for deletion by the trademark owner, an initiative from the Minister based on the recommendation of the Trademark Appeal Commission, and a lawsuit from a third party. Trademark protection starts from registration and lasts for a certain period of time, but can be extended. Protection measures include civil lawsuits, criminal prosecution, and administrative actions such as refusal of registration or removal of a mark. In an era of increasingly fierce global competition, protecting business identity through branding has become important. This research provides in-depth insight into the role of brands as valuable assets for manufacturers and invites a better understanding of the legal challenges faced to maintain brand sustainability in a dynamic market. With this understanding, it can be seen how brand protection impacts business, the economy, the law and society in general. It can also help in formulating better policies and legal strategies that are more effective in protecting brand intellectual property.*

Keywords: *Legal Protection; Brands; Intellectual Property*

Perlindungan Hukum atas Merek dalam Perspektif Hak Kekayaan Intelektual Merek

Abstrak: Penelitian ini bertujuan untuk mengetahui: (1) mengapa hak atas merek terdaftar bisa berakhir begitu saja? dan (2) bagaimana langkah-langkah efektif dalam memberikan perlindungan hukum bagi merek terdaftar? Penelitian ini menggunakan pendekatan yuridis normatif untuk mengkaji dan menganalisis bagaimana perlindungan hukum terhadap merek terdaftar, serta mengidentifikasi penyebab berakhirnya perlindungannya. Hasil penelitian mengungkapkan beberapa alasan mengapa terdaptarnya merek dapat berakhir, termasuk berakhirnya masa berlaku merek, permintaan penghapusan oleh pemilik merek, inisiatif dari Menteri berdasarkan rekomendasi Komisi Banding Merek, dan gugatan dari pihak ketiga.

Perlindungan merek dimulai sejak pendaftaran dan berlangsung selama masa jangka waktu tertentu, namun dapat diperpanjang. Upaya perlindungan mencakup gugatan perdata, penuntutan pidana, dan tindakan administratif seperti penolakan pendaftaran atau penghapusan merek. Dalam era persaingan global yang semakin ketat, melindungi identitas bisnis melalui merek menjadi penting. Penelitian ini memberikan wawasan mendalam tentang peranan merek sebagai aset berharga bagi produsen dan mengajak untuk lebih memahami tantangan hukum yang dihadapi untuk menjaga keberlanjutan merek dalam pasar yang dinamis. Dengan pemahaman ini, dapat diketahui bagaimana perlindungan merek berdampak pada bisnis, ekonomi, hukum, dan masyarakat secara umum. Hal tersebut juga bisa membantu dalam merumuskan kebijakan yang lebih baik dan strategi hukum yang lebih efektif dalam menjaga kekayaan intelektual merek.

Kata Kunci: Perlindungan Hukum; Merek; Kekayaan Intelektual

A. Introduction

Brand protection in intellectual property rights (IPR) law is an important aspect of modern legal policy that aims to protect intellectual property rights, including ownership rights to trademarks. This brand protection has a direct impact on the economy, trade, innovation and business competition. In Islam, religion and Islamic values play an important role in shaping society's views and laws. Therefore, it is important to understand how Islam views intellectual property rights, including brand protection.

Research in an Islamic legal perspective regarding brand protection in IPR can help in exploring Islamic legal and ethical principles relating to intellectual property. It can also help in investigating the extent to which the laws of countries with a majority Muslim population reflect Islamic principles regarding intellectual property rights. Additionally, this research can provide a broader view of how brands and intellectual property rights are viewed globally, considering the impacts and challenges in today's global economy.

It is impossible to separate the concept of a mark within Intellectual Property Rights from the realization that trademark rights stem from discoveries within other disciplines of Intellectual Property Rights, such as copyrights.¹ A gorgeous logo

¹Dolot Alhasni Bakung and Mohamad Hidayat Muhtar, "Determinasi Perlindungan Hukum Pemegang Hak Atas Neighbouring Right," *Jambura Law Review* 2, no. 1 (January 28, 2020): 65–82, accessed July 29, 2023, <https://ejurnal.ung.ac.id/index.php/jalrev/article/view/2400>.

design or distinctive typography, for example, may stand out in the competitive world of companies. Despite the significance of art and invention, trademark rights serve to safeguard not just these areas but also the brand identity itself. These trademark rights, within their scope, only allow for the exclusive use of economically valuable items.² A manufacturer's brand is more than just a pretty name or catchy slogan; it's the driving force behind the company's whole operations. The brand is the identification of the product or service given by any manufacturer. A company's brand is a way to be recognized and set out from competitors.

Brand ownership is a legal privilege that allows the owner to exercise complete control over the trademark and license it to other parties. A registration step is required to get this benefit. By going through the process of registration, businesses get their trademarks recognized and safeguarded by the government. But remember that if a trademark isn't registered, no one can legally stop you from using it.³

Protecting one's brand against ruthless competitors is an integral part of any successful company plan in the current day. Today, businesses compete not only for the attention of customers, but also for the right to use their trademarks on a wide variety of goods and services.

The importance of branding on a global scale is rising quickly. These days, brand conversations happen all the time, on a local, national, and even international scale. However, despite the glitz of these businesses, trademark infringement remains a serious problem. Therefore, it is imperative that we acknowledge the fact that a brand is a highly original human concept that requires legal safeguards.⁴

The government's first priority in the economic sector is ensuring the legal protection of trademarks. Building a strong trademark is one way to safeguard your

²Sulastris Sulastris, Satino Satino, and Yuliana Yuli W, "Perlindungan Hukum Terhadap Merek (Tinjauan Terhadap Merek Dagang Tupperware Versus Tulipware)," *Jurnal Yuridis* 5, no. 1 (August 2, 2018): 160–172, accessed July 29, 2023, <https://ejournal.upnvj.ac.id/Yuridis/article/view/321>.

³Agung Sujatmiko, "Tinjauan Filosofis Perlindungan Hak Milik Atas Merek," *Jurnal Media Hukum* 18, no. 2 (2011), accessed July 29, 2023, <https://journal.umy.ac.id/index.php/jmh/article/view/15499>.

⁴Sudjana Sudaryat and Rika Ratna Permata, *Hak Kekayaan Intelektual: Memahami Prinsip Dasar* (Bandung: Oase Media, 2010), 5.

work. A further assurance against infringements of rights to registered marks is robust criminal enforcement.

There are two types of brands that need legal protection: those with a tight focus and those with a broader scope. In its most basic definition, a brand is a unique symbol associated with a certain product. Additionally, a brand may be anything from a logo to a name to a slogan to a certain color scheme that is utilized in the marketing and sale of a product.

In trademark infringement disputes in Indonesia, well-known companies often prevail. However, this does not imply that local companies are not impacted; unfortunately, even locally held trademarks might fall victim to unauthorized usage on occasion. The Kavera brand is only one example of the rise of creative infringement that take the shape of imitations of well-known product packaging, beverages made from aloe vera gel, syrup.⁵

It is more likely that a company's mark will be copied or abused if it has not been registered, even if the mark is well-known in the marketplace. The brand needs solid legal protection to prevent infringement. In the past, trademark infringement was often the result of direct copies, or "knockoffs," of a company's logo or other identifying mark.

But things have evolved since then. There has been a rise in the sophistication of trademark infringement, with infringers utilizing marks that are confusingly close to, or even identical to, a registered trademark. This practice, known as "passing off" or "pillaging reputation," is a common form of brand infringement. Due to its origins in the Common Law tradition, the idea of "passing off" is not well understood in Indonesian legal circles.⁶ Passing off is seen as unfair competition in common law systems. This is so because trademark owners may be harmed when others

⁵Haedah Faradz, "Perlindungan Hak Atas Merek," *Jurnal Dinamika Hukum* 8, no. 1 (January 15, 2008): 38–42, accessed July 29, 2023, <https://dinamikahukum.fh.unsoed.ac.id/index.php/JDH/article/view/27>.

⁶Fajar Nurcahya Dwi Putra, "Perlindungan Hukum Bagi Pemegang Hak Atas Merek terhadap Perbuatan Pelanggaran Merek," *Mimbar Keadilan* (June 2015): 240068, accessed July 29, 2023, <https://www.neliti.com/publications/240068/>.

fraudulently use or misuse their marks for financial benefit via a practice known as passing off.⁷

Laws protecting creators' work in Indonesia date all the way back to the 1840s. In 1844, during the Dutch colonial era, the first statute protecting intellectual property rights was enacted. Marks legislation (1885), patent legislation (1910), and copyrights legislation (1912) all followed. Both the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works include Indonesia as a member country since 1888, when the country was still known as the Netherlands East-Indies. There was no suspension of intellectual property laws or regulations throughout the years of Japanese rule (1942-1945).

In Indonesia, the regulations on trademarks have been revised many times, first with Law No. 21 of 1961, then with Law No. 12 of 1992, and finally with Law No. 15 of 2001. Law Number 20 of 2016 was passed that year to protect trademarks and GIs, demonstrating the growing importance of such legal measures.

Even if the owner registers the mark, it may still be copied by others. This is particularly true if the mark is not registered. If a previously registered trademark exists and a new trademark emerges that is substantially similar to the previously registered trademark, both trademarks may often be registered with the Directorate General of Intellectual Property (DJKI). The owner of the original mark has grounds for legal action against DGIP if he discovers similarities between the two marks. If this is established, the last registered mark will no longer enjoy legal protection.

It is vital to note that trademark law normally affords protection to the owner of the registered mark in circumstances of similarities between registered and unregistered marks. anyone who hold a registered trademark may prevent others from using confusingly similar marks and can sue anyone who do so without their consent. The owner of an unregistered mark may have rights under common law, such as "unique mark rights" or "prohibition of unfair competition," in the event of a case of

⁷Nur Hidayati, "Perlindungan Hukum Pada Merek Yang Terdaftar," *Ragam Jurnal Pengembangan Humaniora* 11, no. 3 (2011): 174–181.

use of a mark that is similar to an unregistered mark. However, the scope of this protection is often narrower than that afforded by registered trademarks.

A brand's rights may be better protected by registration. When trademark disputes arise, registered marks have more protection and clarity. The owner of a registered trademark who finds the use of a confusingly similar or imitative brand has a solid case for trademark infringement litigation. Requests for injunctions against the use of identical marks, claims for damages, and other legal proceedings are all possible under trademark law. Due to potential differences in trademark law across regions, exercising legal recourse in this matter should be approached with prudence.

In light of the above, this research seeks to respond to the following question: (1) why, exactly, may the right to a registered mark merely end? and (2) what are the most efficient means of securing trademark registration?

B. Legal Protection of Rights to Registered Marks Ends

Companies rely on brands as a means of distinguishing their wares from those of competitors. Furthermore, there are various objectives that vary from the producer's to the trader's to the consumer's. From the standpoint of the producer, a brand is employed to ensure the quality, usability, or technical superiority of the things it produces. The brand helps merchants advertise their products and reach a wider audience. Consumers place a significant emphasis on brands when deciding which products to purchase.⁸

Since the dawn of globalization and the explosion of technical advancement, the perception and significance of brands have changed considerably. To distinguish goods and services in commerce, a mark can take the form of an image, logo, name, word, letter, number, color arrangement, sound, hologram, or a combination of these and other elements, as defined by Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

⁸Ahmadi Miru, *Hukum Merek: Cara Mudah Mempelajari Undang-Undang Merek* (Jakarta: Raja Grafindo Persada, 2007), 5.

Manufacturers of consumer electronics are investing much in R&D to establish recognizable names for their gadget lines. As one example, Samsung uses audio files, color palettes, and holograms to uniquely identify its manufacturing equipment. Nokia has used the composition of tones and noises since the very first smartphones were released to serve as a unique identity. Brands need legal safeguards to ensure their hard work is not stolen or exploited in the future.

Brands and other forms of product identification are becoming more significant in today's interconnected economy. To put it simply, a brand is a promise of quality and recognition for the producer, setting it apart from competing products and services. During this time period, local firms also had to fight with international rivals on a worldwide scale. It's becoming more clear that the brand is a crucial instrument for worldwide marketing and attracting customers from all over the world.⁹

The Industriële Eigendom (RIE) Regulation, which has been in place in Indonesia since the days of Dutch colonial rule (Staatsblad 1912, No. 545, and Staatsblad 1913, No. 214), governs the protection of trademarks in the country. The Osamu Seire Number 30 Concerning Trademark Registration established guidelines for trademarks during Japan's colonial era. The government adopted Law No. 21 of 1961 regarding Company Marks and Trade Marks in an attempt to safeguard consumers against bogus products in 1961. The Paris Convention for the Protection of Industrial Property (Stockholm Revision 1967) was ratified by Indonesia on May 10, 1979.

On August 28, 1992, the government approved Law No. 19 of 1992 concerning Trademarks (1992 Trademark Law), which went into effect on April 1, 1993, after Law No. 21 of 1961 about Company Marks and Trade Marks was deemed out of date. On April 15, 1994, the Indonesian government signed the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) as part

⁹Mahfud Mu'arifin, "Standarisasi vs Globalisasi Suatu Prespektif Baru Dalam Strategi Merek," *Value Added: Majalah Ekonomi dan Bisnis* 2, no. 1 (2005), accessed July 29, 2023, <https://jurnal.unimus.ac.id/index.php/vadded/article/view/653>.

of the Final Act Embodying the Result of the Uruguay Round of Multilateral Trade Negotiations.

Trademark registration is done so that the owner of the mark may have some kind of protection under the law. The Directorate General of Intellectual Property Rights is responsible for registering trademarks that have been filed by trademark owners. By registering their trademarks, business owners may be certain that their trademarks are safe from infringement and counterfeiting.¹⁰

Directorate General of Intellectual Property (also known as DJKI) is the new name for what was formerly known as the Directorate General of Intellectual Property Rights. Trademark registration systems may be categorized into either the constitutive system or the declarative system. Trademark rights in a constitutive system are earned by registration; hence, exclusive rights to trademarks are granted on the basis of registration. Trademark registration is mandatory under this system. A trademark is not legally protected until it is registered.

In this constitutive structure, only the registrant of a mark may claim ownership of the mark. When a trademark is registered, the registrant gains exclusive ownership of the mark. The non-registrant must recognize the registrant's trademark rights.¹¹ For robust legal protection under a constitutive system, trademark registration is a must for trademark owners. Brand owners may rest assured that their rights will be safeguarded under this approach.

Unless there is proof to the contrary, the owner of a registered mark is presumed to be the first user of the mark. Trademark rights are not recognized until the mark is registered. Legal clarity is enhanced as a result of trademark registration. If the trademark holder possesses evidence of registration, such as a Trademark Certificate, then no one else may use the trademark without permission. Therefore,

¹⁰Syahriyah Semaun, "Perlindungan Hukum Terhadap Merek Perdagangan Barang Dan Jasa," *DIKTUM: Jurnal Syariah dan Hukum* 14, no. 1 (July 12, 2016): 108–124, accessed July 29, 2023, <http://ejurnal.iainpare.ac.id/index.php/diktum/article/view/227>.

¹¹O. K. Saidin, *Aspek Hukum Hak Kekayaan Intelektual (Intellectual Property Rights)* (Jakarta: Raja Grafindo Persada, 2015), 175.

no one else may legally use that mark for competing goods and services. Here, the constitutive system offers more assurance in trademark safety.¹²

Legal protection is granted to the first person to use the mark under the declaratory system; nonetheless, this method has been criticized for missing protections for legal clarity and perhaps causing a multitude of issues and obstacles for enterprises. Under this system, the government fully protects trademarks for the benefit of their owners and consumers, ensuring uniformity between products.¹³

Law 19 of 1992 concerning Marks changed the trademark registration procedure in Indonesia from a declarative to a constitutive one, which is seen as providing better legal certainty. From the day on which an application for registration of a mark is accepted, that mark shall have legal protection.

If a trademark is registered, the owner must follow the guidelines outlined in the registration application. Owners of registered trademarks are obligated to utilize them in good faith, which means that they must be used to the same kind of products and services for which they were originally registered. The registration of a trademark may be cancelled if the mark is not utilized in compliance with the rules set out by the relevant authorities.¹⁴

Articles 20, 21, and 22 of Law No. 20 Concerning Marks and Geographical Indications outline the processes for registering the mark itself. No part of a brand may be comparable to traditional cultural expressions, intangible cultural heritage, or names or logos that have been handed down from generation to generation, nor may a brand be in contradiction with state ideology, rules and regulations, morality, religion, decency, or public order.

¹²Gossain Jotyka and I. Gusti Ketut Riski Suputra, "Prosedur Pendaftaran Dan Pengalihan Merek Serta Upaya Perlindungan Hukum Terhadap Merek Terkenal Menurut Undang-Undang Nomor 15 Tahun 2001," *Ganesh Law Review* 3, no. 2 (July 1, 2021): 125–139, accessed July 29, 2023, <https://ejournal2.undiksha.ac.id/index.php/GLR/article/view/447>.

¹³Hery Firmansyah, *Perlindungan Hukum Terhadap Merek* (MediaPressindo, 2013), 38.

¹⁴Jisia Mamahit, "Perlindungan Hukum Atas Merek Dalam Perdagangan Barang Dan Jasa," *LEX PRIVATUM* 1, no. 3 (November 10, 2013): 92, accessed July 29, 2023, <https://ejournal.unsrat.ac.id/v3/index.php/lexprivatum/article/view/3040>.

Collective marks, which are used by multiple individuals or organizations to differentiate goods and services that are identical or highly similar in terms of their nature, general characteristics, quality, and control, are also recognized. An application for registration of a mark as a collective mark must specify that the mark will be used as a collective mark in order to be approved, under Article 46 of Law No. 20 of 2016 respecting Marks and Geographical Indications. One way the government is helping Micro, Small, and Medium-Sized Businesses (MSMEs) grow is via this collective mark registration, which streamlines the registration procedure and ensures that MSMEs' trademarks are protected by law.

From the date of reception, a trademark is valid for 10 years; after that, it may be renewed for another 10 years. Electronic and non-digital channels are both open to the brand owner or their agents in the brand expansion process. In exchange for a certain fee, trademarks may be renewed up to six months before their expiry date or up to six months after they have expired. Articles 35, 36, 37, 38, 39, and 40 of Law No. 20 of 2016 governing Marks and Geographical Indications outline the procedures to be followed when renewing a trademark.

Article 36 of Law No. 20 of 2016 specifies two prerequisites for the brand extension procedure. First, the mark must be used in accordance with the information on the mark certificate, which means that the mark must be used on products and services in the manner specified therein. For instance, the trademark "Merak" for soy sauce cannot be used for any other kind of sauce, but must be used only on items containing soy sauce. The trademark may be canceled or refused renewal if it is found to be in conflict with the terms of the trademark certificate. It is still necessary to manufacture and sell products and services that bear registered trademarks. The trademark cannot be renewed if the products or services are no longer manufactured or sold.

Both (a) the Mark is still being used for the items or services listed on the aforementioned Mark certificate, and (b) production and/or trade of the aforementioned goods and/or services are ongoing. Trademark registration may be cancelled for reasons other than the expiration of the registration's validity term.

Under Article 72, paragraphs 1 and 2, of Law No. 20 of 2016, a trademark owner may seek the cancellation of their mark by filing an application with the Minister of Law and Human Rights.

The Minister of Law and Human Rights also has the authority to order the cancellation of trademark registrations if they so want. The Minister may seek the cancellation of a trademark registration based on a number of grounds. Reasons include the following:

- a. There are conceptual or substantial parallels between the Marks and the GIs.
- b. The philosophy, rules, regulations, morals, religion, decency, and public order of the state are all opposed to Marks.
- c. Brands share characteristics with hereditary names or symbols or with traditional cultural expressions or intangible cultural heritage.

With this removal system in place, genuine trademark owners can rest certain that their marks will continue to be protected under the law while also being compliant with rules and not in contradiction with public values and interests. This is a crucial move toward protecting the trademark rights of all parties involved and keeping the brand intact. After receiving a recommendation from the Mark Appeal Commission, the Minister may initiate deletion. The owner of a registered trademark who disagrees with the Minister's decision to cancel registration may appeal to the PTUN. If a registered Mark has not been used in the trade of goods and/or services for three (3) consecutive years from the date of registration or last use, a third party may petition the Commercial Court to cancel the registration.

Legal protection for registered marks is lost for four (4) reasons according to the aforementioned articles: the trademark's expiration, the brand owner's voluntary deletion of the mark, the Minister's voluntary deletion of the mark, and a third-party lawsuit.

The legal procedure in Indonesia to remove inactive trademarks from registration requires third parties to fulfill specific requirements and gives the legal brand owner a chance to defend the brand if there are good grounds for the long

period of inactivity. The following are the requirements and benchmarks for this procedure. Criteria for Requesting the Cancellation of a Dormant Trademark:

1. First, whomever wants a mark removed must show that it hasn't been used for a particular amount of time (the "proof of non-use"). The Indonesian government may legally get rid of a trademark if it hasn't been used in three consecutive years, according Article 49 of Law No. 15 of 2001 Regarding Marks.
2. Second, the third party must apply to the Directorate General of Intellectual Property (DJKI), which is part of the Ministry of Law and Human Rights of the Republic of Indonesia, for the deletion of the information in question.
3. Third, after the application is received, DJKI will notify the brand owner that they are at risk of a takedown claim.

The procedure for deleting outdated brands:

1. First, the brand owner has the option to reply to the takedown notification after they have received it. They have reasonable explanations for why their product wasn't utilized throughout that time.
2. Second, DJKI will assess the arguments and facts presented by outside parties and brand owners. DJKI has the right to decide to withdraw the mark if the brand owner does not offer sufficient documentation or appropriate grounds.
3. Third, DJKI will make a final judgment on whether or not the brand should be removed. DJKI will remove a mark from the Registered Marks List if it is decided to be deleted.

Brand owners who believe the removal of their marks was unjustified may file an appeal or seek other legal remedies in court to protect their brands. Remember that brand owners have the ability to defend their brand throughout this process if they have a good cause for not utilizing the brand for a long period of time. This safeguards authentic brands from imposters who could utilize the removal procedure for their own ends. This procedure was established to safeguard the interests of genuine brand owners while allowing for the removal of dormant trademarks by interested parties.

C. Legal Protection of Rights to Registered Marks

Legal protection of trademark rights, both domestically and abroad, follows the principle of reciprocity, in which each member country is obliged to provide equal protection to the intellectual property of citizens of other member countries, as given to its own citizens.

Even though the requirements that must be met by the applicant in submitting an application for registration of a mark have been determined, this does not completely eliminate trademark violations committed by irresponsible parties. There are still many cases of brand use without rights on a product with the intention of taking advantage of the brand used, either through piracy (brand imitation) or by taking advantage of brand reputations that are already known by consumers by making similarities in essence.

Trademark infringement is a major concern in the business sector because it undermines the reputation of the legal brand owner and drives customers away. Accordingly, trademark rights legislation has to be consistently enhanced and improved to prevent and punish trademark infringement that causes injury to the mark's legitimate owners.¹⁵

In addition to protecting brand owners, the law also protects shoppers who want to buy genuine, officially licensed merchandise. The goal is for customers to feel safe and confident in their purchases of authentic brands, rather than being duped by fakes.

Those who have secured a certificate as evidence of trademark ownership are nevertheless afforded legal protection provided they act in good faith. The registration of a trademark may be challenged if the trademark's owner is shown to have had malicious intent.

Marks are only legally protected if they are registered, so keep that in mind. When there are other marks that are confusingly similar, it is very important to register a trademark. Although most businesspeople understand the value of

¹⁵Putra, "Perlindungan Hukum Bagi Pemegang Hak Atas Merek terhadap Perbuatan Pelanggaran Merek."

distinguishing their goods with a mark from those of rivals, some nevertheless fail to see the need to register the mark in order to preserve it.¹⁶

This guarantee implies that Mark law must be enforced by the state. Therefore, the owner of a registered Mark may seek redress in the Court of competent jurisdiction in the event of a breach. The purpose of the law is to ensure justice, and this safeguard will help make that a reality. Realizing social justice is an important objective of the law. Legitimate Mark owners have their rights protected by the law.

Images, logos, names, words, characters, numbers, color arrangements in 2- or 3-dimensional shapes, sounds, holograms, and combinations thereof are all protected trademarks under Article 2, paragraph 3 of Law No. 20 of 2016. This trademark was created to help consumers identify who made their favorite products and where they might be purchased.

If another party has already registered or proposed a mark for the same or similar goods or services, or if the applicant's proposed mark is confusingly similar to an already registered or proposed mark, or if the applicant's proposed mark is similar to an already famous mark for the same or similar goods or services, the application for registration will be denied.

Another crucial aspect of company protection is the fact that businesses cannot be registered on the basis of complaints lodged by untrustworthy complainants. This good itikad measurement has become a difficult one to gauge by eye, and fraudsters who try to register brands with similar or identical trademarks and logo designs are sometimes successful. Therefore, registration with a good itikad is one way to protect well-known brands. More specifically, trademark law has sought to protect well-known brands by dictating that applications must be denied when the applicant: (a) shares a name, logo, slogan, or other identifying feature with another trademarked business that has been registered previously to sell identical goods or services; or (b) shares a name, logo, slogan, or other identifying feature with

¹⁶ Tommy Hendra Purwaka, *Perlindungan Merek*, Cetakan Pertama. (Jakarta: Yayasan Pustaka Obor Indonesia, 2017), 39–40.

another trademarked business that has been registered previously to sell identical goods or services.¹⁷

Registration of a trademark provides legal protection for 10 years from the date of reception, as stated in Article 35 of Law no. 20 of 2016, and this protection may be extended for another 10 years. As part of the government's aim to make trademark registration simpler for the general people, trademark registration and renewal may be completed online or manually.

Providing legal protection is the execution of a legal role that must provide advantages, legal clarity, and fairness. Encourage investment and boost investor confidence in conducting business in Indonesia by enforcing legal protection for registered marks. The economy of Indonesia might suffer if investors lose confidence in the country's legal system and decide not to set up shop there. Therefore, legal protection for registered marks plays a significant role in fostering a friendly and alluring business climate in Indonesia.

According to Zen Umar Purba, the reasons why Intellectual Work Rights (HKI) need to be protected by law are as follows:¹⁸

- a. The "non-economic" justification is that creators of intellectual works will be encouraged to keep creating by the guarantee of legal protection. This will help people become more of their true selves. This will be helpful for the community as a whole, allowing them to go farther.
- b. To safeguard the creators of intellectual works, so that they may reap financial rewards from their labor, is a "economic" goal. However, it safeguards legitimate works from being copied, pirated, plagiarized, or otherwise misappropriated.

Meanwhile, Philipus M. Hadjon claims that There are two types of legal protection available: preventative measures and punitive measures. By providing safeguards before a government action becomes final, preventive law aims to head

¹⁷ Edy Santoso, "Penegakan Hukum Terhadap Pelanggaran Merek Dagang Melalui Peran Kepabeanaan Sebagai Upaya Menjaga Keamanan Dan Kedaulatan Negara," *Jurnal Rechtsvinding* 5, no. 1 (2016).

¹⁸ Anne Gunawati, *Perlindungan Merek Terkenal Barang Dan Jasa Tidak Sejenis Terhadap Persaingan Usaha Tidak Sehat* (Bandung: Alumni, 2015), 83.

off potential conflicts before they ever begin. While preventive legal protection is not specifically regulated in Indonesia, the necessity of following preventative principles might motivate the government to exercise caution when making discretionary judgments.

Means of coercive legal protection, meantime, are geared on settling existing disagreements. General courts and administrative courts in Indonesia hear cases involving legal protection. Human rights and the rule of law are the bedrock on which the idea of legal protection rests. The rule of law concept establishes the purpose of the state to provide justice and legal clarity, while human rights serve as the primary foundation for recognizing and safeguarding government activities.

In the past, trademark infringement usually included a near-identical knockoff of an existing brand or emblem. In recent years, however, trademark infringement has gotten more complex, with instances of utilizing a trademark that is confusingly similar to a previously registered mark or even employing the same brand. It is known as "passing off" or "pillaging reputation" when someone steals the identity of another person. With these increasingly complicated and sophisticated brand infringements, it is more vital than ever to take legal action to safeguard trademarks.¹⁹

Since the existence of this practice of passing off means that counterfeiters do not have to create the image and brand of the production themselves from scratch, the existence of counterfeit goods can lead to consumers who intend to purchase or use the original brand purchasing or using the counterfeit product instead. equivalent or very close in meaning. People won't be able to tell which brand is which because of this.

Falsely using another person's trademark without permission is considered unfair competition under common law because it harms legitimate trademark owners who have invested time and money into registering their marks and seeing them protected from infringement.

¹⁹Putra, "Perlindungan Hukum Bagi Pemegang Hak Atas Merek terhadap Perbuatan Pelanggaran Merek."

Article 382 of the Criminal Code states, in relevant part: "Anyone who, in order to obtain, maintain, or expand the proceeds of a trade or company owned by himself or another person, commits a fraudulent act to mislead the general public or a particular person, is threatened, if the act can cause harm to the concurrent concurrent or concurrent others because of unfair competition, with a maximum imprisonment of one year and four months or a maximum fine of one thousand dollars." This passing off is a violation of

In addition, genuine brand owners are afforded civil legal protection. If trademark rights are owned, the owner is afforded legal protection under Indonesian trademark law in the event of a violation of those rights; this means the trademark owner has the option of bringing legal action against the offending party. The plaintiff seeks monetary damages and an end to further trademark infringement for filing this complaint. The action is submitted to the Commercial Court with the complete name of the petitioner. In a similar vein, please include the name and contact information for the applicant's power of attorney. When the program makes use of the color element, the color is also specified. Also required are the date and name of the country where the trademark was requested, a detailed explanation of the goods or services being trademarked, and evidence of payment.²⁰

The trademark dispute between PT Phapros, a Semarang-based firm, and Merck KGaA, a German pharmaceutical giant, dates back to the beginning of September 2015. at January of 2015, Merck first filed a complaint at the Central Jakarta District Court, requesting that the Commercial Court hear the issue. Merck claims that PT Phapros has utilized the trademarked word "Bioneuron" without authorization, even though the two names are visually, phonetically, and phonologically similar. Merck warned that customers could be unable to tell which firm really owned the brand if this kept happening.

²⁰Fandy H. Kowel, "Perlindungan Hukum Terhadap Penerima Lisensi Merek Di Indonesia," *LEX ET SOCIETATIS* 5, no. 3 (April 21, 2017), accessed July 29, 2023, <https://ejournal.unsrat.ac.id/v3/index.php/lexetsocietatis/article/view/15575>.

As the defendant, PT Phapros claims the complaint is without merit and denies any wrongdoing. However, the first panel of judges concluded that Merck's arguments might be improved, and the court ruled in favor of Merck. PT Phapros thought the judges had sided with Merck, so they filed an appeal with the highest court in the land, the Court of Cassation. According to its written cassation petition, PT Phapros contends that the Commercial Court's ruling at the Central Jakarta District Court was unjust and went against the concept of hearing both parties in the case (Horen van Beide Partijen).

The panel of judges reviewing PT Phapros' appeal, however, ruled that the first level panel of judges did not make an error in their interpretation of the law and so dismissed the case. Both the cassation memorandum and the counter cassation memorandum were reviewed by the Commercial Court of the Central Jakarta District Court, which ultimately determined that the lower court's rulings were proper under Indonesian law. The text of the panel's statement in the ruling for case 409 K/Pdt.Sus-HKI/2015.²¹

Brand PT's legal dispute. Phapros has conceded to Merck's lawsuit because the two companies' Bioneurons are so similar. The packaging for both products is dominated by blue and white, and both feature shapes and logos that are strikingly similar to those used by Merck. The Supreme Court agreed to hear the case, and the Bioneuron brand was struck from the trademark database.

PT Phapros first refused to comply with Merck's requests, but later admitted that Merck's Bioneuron brand was identical to their own. This may indicate that the firm has come to terms with the fact that it used a name too similar to that of a major competitor, such as Merck. In addition, a small business like PT Phapros may find the time and money spent on this drawn-out and intricate legal procedure to be a significant impost. This raises concerns about whether or not the brand legal system can be made more user-friendly and cost-effective, particularly for the industry's

²¹KlikLegal.com, "Lima Kasus Merek Terkenal Di Pengadilan Indonesia," *KlikLegal*, July 14, 2017, accessed July 29, 2023, <https://kliklegal.com/lima-kasus-merek-terkenal-di-pengadilan-indonesia/>.

smaller participants. Several measures may be implemented to improve the efficacy and accessibility of the brand legal system, particularly for smaller companies in the industry:

1. Educate entrepreneurs about the value of trademarks and other forms of intellectual property and the steps they should take to safeguard them. The procedure for registering a trademark, as well as the fees and advantages of doing so, may be confusing for company owners.
2. The trademark application procedure should be streamlined for greater efficiency. By streamlining registration processes and making them available online, we are making it easier for entrepreneurs to get their brands registered.
3. Thirdly, the Affordable Cost, it provides make brand registration more accessible, particularly for newer businesses. For small and medium-sized enterprises, this might mean a reduction or elimination of registration expenses altogether.
4. To help small company owners navigate the trademark registration procedure and get sound guidance on protecting their intellectual property, a number of organizations provide legal consulting services.
5. Centralized Information System: Create a centralized information system that provides small company owners with easy access to necessary manuals, paperwork, and legal information.
6. Fast Registration Time: Reduces the amount of time it takes to register a trademark, making it more accessible to startups and other small businesses.
7. For small company owners who want to start protecting their brand right away but don't have time to wait for permanent registration to be finalized, there is an option for "temporary brand protection."
8. Giving preference: Giving brand owners who already have local trademarks preference over registering the brand worldwide if they have one.
9. Effective Law Enforcement: Make sure brand owners, even smaller companies, have access to effective enforcement of brand law in order to prevent trademark infringement.

10. International collaboration: Promote international collaboration in trademark protection to ensure that small company owners who sell their wares internationally are afforded the same level of protection as their larger counterparts.

Marks that are no longer in use or that are used unlawfully must be removed from circulation, hence it is important to establish a reliable system for doing so.

D. Conclusion

According to Law no. 20 of 2016 regarding Marks and Geographical Indications, the legal protection afforded to registered marks may be lost for a variety of different causes. One of these procedures is the deletion of a trademark from the General Register of Marks once the registration period for the brand has expired at the Directorate General of Intellectual Property. If the owner of a mark voluntarily submits an application to have the mark erased, the legal protection afforded to the mark may also lose its validity.

Legal protection afforded to a registered mark may also be revoked by the Minister without the need for a reference from the Mark Appeal Commission. Legal protection might also be nullified in the event that an unrelated third party initiates legal action against the brand. Registering your brand as a trademark is one strategy you may use to protect your brand. When a trademark is registered, the owner has legal protection for a period of ten years, during which time the registration may be extended for an additional ten years. To defend their trademark rights, the owner of the mark may choose to take legal action (such as a lawsuit or criminal prosecution), or they may choose to take administrative action (such as refusing to register the mark or canceling it) to stop others from using the mark.

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