

Legal Protection for Well-Known Trademark That are Not Registered in Indonesia in the Supreme Court Decision Number 7 K/Pdt.Sus-HKI/2018

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ABSTRACT

The position of the trademark has an important role in the world of commerce, so it is very important to provide protection for the trademark, which if the company's trademark becomes widely known in the community, it will allow competitors who are not in good faith to commit piracy, imitate the trademark, or even by counterfeiting to enrich yourself in a short span of time. The problems faced are how the system for granting trademark protection to trademarks that are not registered in Indonesia and how the legal protection for well-known trademarks that are not registered in Indonesia in the Supreme Court Decision Number 7K/Pdt.Sus-HKI/ 2018 The research method used is normative juridical legal research. The results showed that the protection of foreign well-known marks that are not registered in Indonesia according to the Trademark Law is only protected for 5 (five) years, if the foreign well-known mark is not registered, other people can register the name and claim the mark. Of course, this is contrary to the theory of legal protection, where the state is obliged to protect a citizen/person, even though the person is a foreigner. Where there are 2 (two) kinds of protection methods, namely preventive and repressive methods. Preventive efforts are to prevent trademark infringement, while repressive efforts if there is a trademark violation are through civil lawsuits or criminal charges.

Keywords: Legal Protection, Famous Trademark, Not Listed in Indonesia

1. INTRODUCTION

Trademarks have an important role to improve the smoothness and quality of goods and services produced in trade. Trademarks need to be attached to legal protection for the rights of individuals and legal entities as objects. The advantages of a trademark are not only as an identity to distinguish the goods or services of a company from other companies, but can be a financially invaluable asset of a company. [1]

The position of the trademark has an important role in the world of trade, it is very important to provide protection for the trademark, which if the company's trademark is widely known in the community, it is possible for competitors who do not have good intentions to commit piracy, imitate the trademark, or even fake it enrich themselves in a short period of time. [2]

In order to provide protection for trademarks, provisions regarding trademarks are regulated as regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications and in order for a mark to obtain rights to a trademark, the trademark owner must register the mark at the office of the Directorate General of Intellectual Property

Rights. By registering, the trademark owner will obtain exclusive rights to the use of certain marks or to give permission to other parties to use them for a certain period of time and obtain legal protection from the state. [3]

There are two systems known in trademark registration, namely the declarative system (*first to use*) and the constitutive system (*first to file*). The Trademark Law adheres to a constitutive registration system, namely the right to a mark is obtained through registration, meaning that exclusive rights to a mark are granted due to registration, so it can be said that trademark registration is absolute, because a mark that is not registered will not get legal protection. [4]

The general principle that applies in the context of protecting IPR is essentially a territorial principle. However, with the TRIPS Agreement, an international legal regime regarding IPR has developed, although without the intention of overriding the existing legal regime, namely national law. The international legal regime on IPR cannot be effective without being transformed into national law. On the other hand, the national legal regime regarding IPR must also heed the rules in the international legal regime regarding IPR, which aims for uniformity in the regulation of IPR in the context of freedom of movement of goods, services and capital internationally. [5]

Based on this, trademark disputes in Indonesia are common, such as violations of trademark rights owned by a person or legal entity by imitating or using other parties' trademarks illegally. that the system of trademark registration changed from declarative be constitutive since the enactment of Law No. 19 of 1992, Act No. 15 of 2001 up until Act trademark New namely Law No. 20 of 2016 on Marks and Geographical Indications, trademark registered can actually be used by other parties as long as there is an agreement regarding a license or other form of cooperation, if there is no such element then the act violates the existing regulations.

In writing this thesis, the author raises a case regarding a trademark dispute between the Sharpness trademark belonging to Hubei Yuli Abrasive Belts Group Co., Ltd China as the Plaintiff and the Sharpness trademark belonging to PT Sukses Bersama Amplasindo as the Defendant. The Sharpness mark belongs to the Plaintiffs list No. 1310113 was filed in China on May 4, 1998 and registered on September 7, 1999 to protect Class 03 item types namely " emery cloth, emery paper, waterproof emery paper, emery belt ".

The plaintiff's Sharpness mark has also been registered internationally with the Madrid system of International register protocol no. 931165 and registered since 2 July 2007 for Class 03 types of goods " emery cloth; emery paper; emery; emery belt " namely in Denmark, Estonia, Finland, United Kingdom, Greece, Ireland, Lithuania, Sweden, Austria, Bulgaria, Benelux, Cyprus, Czech Republic, Germany, Spain, France, Hungary, Italy, Latvia, Poland, Portugal, Romania, Slovenia and Slovakia. In addition, the Plaintiff's trademark has also been recognized as a well known mark from The Trademark Review and Adjudication Board of the State Administration for Industry and Commerce in China.

This case began when the Plaintiff wanted to file a request for registration of the Sharpness mark and its logo at the Directorate General of Intellectual Property (Ditjen HKI), the Indonesian Ministry of Law & Human Rights (Kemenkumham RI) on December 14, 2016 with No. Agenda D002016061618 to protect the types of goods in Class 03. However, it has been registered on the General Register of Marks at the Directorate General of Intellectual Property Rights & the Ministry of Law and Human Rights of the Republic of Indonesia with the same trademark, namely Sharpness with a similar logo. The registered Sharpness trademark was registered by Johnny Bintoro Njoto with No. IDM000382156 on March 15, 2011 to protect the type of goods in Class 03, namely " fabric sandpaper; sandpaper " and entered in the General Register of Trademarks on DG IPR & Kemenkumham RI on January 21, 2013. Johnny Bintoro Njoto then transferred rights to the trademark Sharpness and logo to the Defendant before Notary Meri Efdi, SH, which has been requested for registration on 27 December 2016.

The transfer of rights was recorded at the Directorate General of Intellectual Property Rights, Kemenkumham RI with Number HKI.4.HI.06.04.7476572016 dated March 8, 2017. Thus, the position of the Defendant was limited to the purchaser of the mark, not the registrant. The Plaintiffs

strongly object to the registration of the Sharpness mark and the No. registration logo. IDM000382156 owned by the Defendant, because the trademark has a similarity in principle or in its entirety with the trademark Plaintiff form: equation form, how the placement, ways of writing, or a combination of the elements, nor rhyme words.

In this regard, the Plaintiff filed a lawsuit for the cancellation of the Sharpness trademark and the Defendant's logo to the Central Jakarta Commercial Court. The legal considerations used by the judges were that the Defendant's exception was primarily concerned with the following matters:

1. The Plaintiff does not have Legal Standing to file a Mark Cancellation Lawsuit;
2. The Plaintiff's Power of Attorney does not meet the Formal Requirements because it is not stamped;
3. The Plaintiff's lawsuit has expired (expired);
4. The Plaintiff's lawsuit lacks parties (excluding the Directorate General of Intellectual Property);
5. The lawsuit *obscur libel* (Lawsuit Unclear);

The plaintiff's lawsuit at the Central Jakarta Commercial Court resulted in the Central Jakarta Commercial Court Decision No. 28/Pdt.Sus-Merek/2017/PN.Niaga. Jkt.Pst dated 27 April 2017 namely:

1. Declaring that the plaintiff's claim is unacceptable;
2. Sentencing the plaintiff to pay court fees of Rp. 516,000, - (five hundred and sixteen thousand rupiah)

Furthermore, Hubei Yuli Abrasive Belts Group Co., Ltd. filed an cassation with Decision Number 7K/Pdt.Sus-Merek/2018, again the application was rejected by the Panel of Judges, namely on the basis that the Defendant's mark was a registered mark that the Defendant obtained by purchasing based on the agreement. transfer of rights from the original owner. Johnny Bintoro Njoto to the Defendant (PT. Sukses Bersama Amplasindo) on December 27, 2016 and the transfer was recorded at the Directorate of Marks on March 8, 2017 Number HKI.4.HI.06.04.7476572016, so the party from which the Defendant obtained the mark must be withdrawn as a party to this *a quo* case. Based on the above description of the background of problems in this research is b How can legal protection against trademark famous are not registered in Indonesia in the Supreme Court Decision No. 7 K/Pdt.Sus-HKI/2018?

2. METHOD

The type of research used is normative legal research, namely research that provides a systematic explanation of the rules governing a certain legal category, analyzes the relationship between regulations, explains areas of difficulty and may predict future development). [6]

Types of legal materials can be divided into 3, namely primary legal materials, secondary legal materials, and tertiary legal materials. In this study, the authors use legal sources, namely: material of primary law consists of legislation and other regulations binding, among others:

- 1) The 1945 Constitution of the Republic of Indonesia.
- 2) Civil Code (KUHPPerdata)
- 3) Law no. 15 of 2001 concerning Trademarks.
- 4) Law Number 20 of 2016 concerning Marks and Geographical Indications.
- 5) Supreme Court Decision Number 7 K/Pdt.Sus-HKI/2018.

Secondary legal materials, namely materials that provide an explanation of primary legal materials, such as opinions or doctrines of experts, articles, seminars, etc. Non-legal materials are supporting materials other than primary and secondary legal materials such as the General Indonesian Dictionary and encyclopedias.

The data collection technique that the author uses in this study is a literature review or (*library research*). Collection of legal materials from secondary legal materials derived from articles, journals, and interviews with several related sources. The approaches used by the author from the several approaches above are the *statute approach* and the *case approach*. The statutory approach is an approach taken by examining all laws and regulations related to the legal issues being handled. The case approach is an approach taken by examining cases related to the issues at hand which have become court decisions that have permanent legal force, namely Supreme Court Decision Number 7 K/Pdt.Sus-HKI/2018. The analysis is carried out by examining cases related to the issues at hand which have become court decisions that have permanent legal force, namely Supreme Court Decision Number 7 K/Pdt.Sus-HKI/2018 and then take an inventory and identify laws and regulations. invitation, then performed an analysis of the relevant cases and legislation with an interpretation of the law - laws, to then be deduced from the results of the analysis.

3. DISCUSSION

Before discussing the legal protection of famous trademark "*Sharpness*" are not listed in Indonesia in the Supreme Court Decision No. 7 K/Pdt.Sus-HKI/2018, the writer first explain the aspects of trademark protection in Indonesia as stipulated in Law No. 20 2016 concerning Trademarks and Geographical Indications. Trademark protection in Indonesia is regulated in the new trademark law which replaces the previous regulation, namely Law no. 15 of 2001 concerning Trademarks. Even though there is a regulation, trademark disputes in Indonesia still often occur, especially similarities in essence.

The provisions for protecting well-known marks above apply to all member countries of the Paris Convention and signatories to the TRIPS Agreement (the World Trade Organization's TRIPS Agreement). Every member of the World Trade Organization (WTO) is a member of the World Intellectual Property Organization (WIPO), the Paris Convention and the TRIPS Agreement are attached to WIPO. So that every WIPO and WTO member country, including Indonesia must comply with the two treaties.

(Nur, 2011) Indonesia ratified the Paris TRIPS Agreement through Presidential Decree Number 24 of 1979 concerning Ratification of the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization as amended by Presidential Decree Number 15 of 1997 concerning Amendment to Presidential Decree Number 24 of 1979 concerning Ratification of the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization and Law Number 7 of 1994 concerning Ratification of Agreement Establishing the World Trade Organization (Agreement on the Establishment of the World Trade Organization).

"An agreement is valid only between the parties who make it."

So, when it is associated with the above theory, the state is obliged to provide preventive and repressive efforts to protect other people's trademarks. One form of the State's preventive efforts in protecting foreign well-known trademarks is by making related laws. Because Law no. 15 of 2001 against the Paris Convention, as a form of Indonesia's commitment to world organizations, Indonesia has updated Law No. 15 of 2001 on Marks by enacting Law no. 20 of 2016 concerning Trademarks and Geographical Indications (Trademark Law 2016). The 2016 Trademark Law improves the provisions of Article 69 paragraphs (1) and (2) of Law no. 15 of 2001 as regulated in Article 77 paragraph (2) of the 2016 Trademark Law as follows:

"A lawsuit for cancellation can be filed indefinitely if there is an element of bad faith..."

This provision has made the 2016 Trademark Law more stringent on the existence of registered trademarks due to bad faith, thus, Article 77 paragraph (2) provides an opportunity without time limit for the plaintiff to file a lawsuit due to bad faith.

The principles of good faith, fair dealing, fairness, and propriety are fundamental principles in the business world. Good faith reflects the community's standards of justice and propriety. With this meaning, it makes good faith a universal *social force* that regulates their social relations, that is, every citizen must have an obligation to act in good faith towards all citizens.

The period of filing a lawsuit for the cancellation of registration of a trademark registered in bad faith is not limited. This is in accordance with Article 6 bis of the Paris Convention which states as follows:

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an

imitation liable to create confusion therewith.”

- (2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.
- (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith” (“The Paris Convention,” nd) Article 6 paragraph 3 of the Paris Convention provides a time limit for the cancellation of registered marks not limited if it contains bad faith. Previously in Article 69 paragraph (1) of Law no. 15 of 2001 concerning Marks states that the time limit for filing for cancellation of registered marks is only five years, in Article 69 paragraph (2) the filing of a petition for cancellation of trademark registration is not limited if the mark is contrary to religious norms, decency, and public order. Bad faith is not included in this article, then the provisions in paragraph (1) of Article 69 paragraph (1) apply. Of course, this is contrary to Article 6 paragraph 3 of the Paris Convention. When viewed from the aspect of justice, Article 69 paragraph 1 of the Trademark Law is very detrimental to the actual trademark owner, as a result, the protection of foreign well-known marks in Indonesia is not protected optimally.

The 2016 Trademark Law, in particular Article 77, states that the time limit for filing a lawsuit against a trademark registered in bad faith is not limited, this is in accordance with Article 6 paragraph 2 of the Paris Convention. The principle of good faith is contained in Article 4 of Law No. 15 of 2001 concerning Marks, namely:

"Marks cannot be registered on the basis of an application submitted by an applicant with bad intentions".

This article protects the existence of well-known marks, so that every trademark that has similarities in principle must be rejected by the Director General of Intellectual Property Rights. Rejection of a mark that does not have good intentions is a form of prevention from the Theory of Legal Protection, while filing a lawsuit and removing a mark is a form of repression. Changes deadline for filing a trademark registration on bad faith in the Trademark Act 2016 is a commitment of Indonesia as country of WTO members, in which each member must carry out the regulations for the trademark in the Paris Convention. Where the 2016 Trademark Law is expected to prevent the occurrence of trademark infringement, on foreign well-known trademarks and local well-known trademarks, both those that have been registered, have not been registered, or are in the process of registering a mark. It should be noted that the Plaintiff's "SHARPNESS + Logo" trademark which has been painstakingly built by the Plaintiffs over the years with great efforts and costs, including efforts and costs to obtain legal protection for the "SHARPNESS + Logo" trademark in various countries, and the effort and expense to market and promote its products sold under the "SHARPNESS + Logo" trademark

worldwide, including in Indonesia, consistently since at least 2008.

This means that the trademark "SHARPNESS + Logo" lists No. IDM000382156 not be registered under good faith, Article 21 paragraph (3) of the Constitution - No. 20 of 2016 concerning Marks and Geographical Indications, as well as piggybacking on the fame of the Plaintiff's trademark, Article 21 paragraph (1) letter b of the 2016 Trademark Law, the mark "SHARPNESS + Logo" is listed No. IDM000382156 which is currently registered in the name of the Defendant does not deserve to be protected. However, in this case, at the first instance court level the plaintiff lost in the Central Jakarta Commercial Court, then at the level of appeal or cassation the application for trademark lawsuit was rejected by the Supreme Court Judges, namely Supreme Court Decision Number 7K/Pdt.Sus-HKI/2018. After examining the evidence is just a form of citation trademark registration and not the form of the certificate of registration of the mark which it did not explicitly mention that Trademark SHARPNESS has been registered with a certificate in several countries, so therefore proof certificate of trademark registration Plaintiff in several countries not be shown proof in the original hearing as his case with evidence of the registration in the country PRC demonstrable evidence of the original certificate, and such evidence is not there attestation / legalization of authorized official in country origin, so that by the Assembly evidence P- and P-2.1b 2.1a can't be used as evidence that a criminal offense and not enough prove that trademark Plaintiff has had a registration certification in various countries.

After the Assembly examined the evidence is mainly the form of a copy of the print out, and can't be shown in the original trial, according to the Council of the evidence is not sufficient to prove that the trademark of the Plaintiff is a well-known trademark, and by the Assembly although Plaintiff argues that trademark Plaintiff famous country, it is not automatic that trademark automatically become a famous trademark in country other states. In addition to the requirements of famous trademark has been registered in various countries, one important requirement is reputation trademark Plaintiff because doing vigorous campaign large scale in various country with the volume of sales and profit from the use of the trademark and also general knowledge of the public about the trademark.

In this case, the judges have a special legal considerations related to this case, and in conjunction with the famous trademark criteria of Article 21 paragraph 1 b Trademark Act 2016 and Regulation of the Minister of Law and Human Rights No. 67 of 2016 in conjunction with the Regulation of the Minister of Law and Human Rights No. 05 of 2017 concerning Mark Registration in Article 18 stipulates 9 criteria that must be met in order to be called a well-known mark, the Panel of Judges is of the opinion that the Plaintiff's Mark SHARPNESS + Logo with No. 1310113 cannot be categorized yet as a well-known trademark in Indonesia and internationally.

Registration of the SHARPNESS + Logo mark belonging to the Defendant, in accordance with the procedures and principles of trademark registration, namely *FIRST TO*

FILE as stipulated and in accordance with the Trademark Law. With the fulfillment of all the requirements and provisions of the Trademark Law no. 15 of 2001 as well as Law no. 20 of 2016, the Defendant is entitled to receive recognition from the government by obtaining a trademark certificate from the Ministry of Law and Human Rights, the Directorate General of Intellectual Property with a Mark Certificate dated January 21, 2013 with IDM Number 000382156 with a protection period of 10 (ten) years. Based on Article 1 point 5 Trademark Act 2016 states that the right on trademark is right exclusively given by country to owners trademark registered for a specified period by using the trademark's own party or give permission to others to use it.

The author basically agrees with the respondent's answer, Dr. Sibarani, S, H, MH in the case of a trademark dispute between Hubei Yuli Abrasive Belts Group Co., Ltd. against PT Sukses Bersama Amplasindo. Hubei owns the Sharpness emery cloth trademark and was first registered in China in 1999, and to date has been registered in 25 countries. PT Sukses Bersama Amplasindo owns the Sharpness emery cloth trademark in Indonesia which was acquired by transfer of rights from Johny Bintoro Njoto. Johny Bintoro Njoto registered the Sharpness trademark in 2011, and was registered in 2013. The Sharpness trademark and logo belonging to Hubei PT Sukses Bersama Amplasindo have similarities in essence. Hubei sued for the cancellation of the Sharpness trademark because it was registered in bad faith, and has similarities in essence with its own trademark. However, the Judge of the Central Jakarta Commercial Court did not accept the lawsuit from Hubei, because Hubei did not withdraw Johny Bintoro Njoto as a defendant, while PT Sukses Bersama Amplasindo only served as a trademark buyer, not a trademark registrar. The judges of the Central Jakarta Commercial Court did not discuss the main points of the case, only discussing exceptions. This is very unfortunate because in fact there are similarities in essence, it's just that the judge only discussed the exceptions.

The author appreciates the opinion of the judge who has absolute authority in deciding a case. Although there is still a gap to apply for a PK to the Supreme Court, in order to obtain justice and essential legal benefits. On the other hand, if a trademark has been categorized as a well-known trademark, it will be necessary to have a legal protection so that the mark is not hijacked by others or imitated. Trademarks are often misused to ride the fame of a product with a particular trademark. Many business actors who register trademarks intentionally resemble well-known trademarks in an effort to deceive consumers. This can be considered as trademark registration in *bad faith*.

There are 2 kinds of ways of protection by way of preventive and repression f. The preventive way is to focus on efforts to prevent the famous trademark from being used and imitated by others wrongly. Repressive protection may include mediation as stipulated in the provisions of the Act trademarks, it can be pursued Litigation (courts) as well as through non-litigation which is set in the P origin 93 regarding arbitration or alternative settlement of disputes.

In relation to well-known marks, in many cases courts have expanded the legal protection of the mark, which includes legal protection for well-known marks for goods of the same type or not. The seriousness of the government in an effort to protect the property rights of intellectual, especially trademark rights in Indonesia has been proven to enhance the rule of law that applies one of fact is with the birth of the Trademark Law in 2016, which in the provision of law new about trademark the already better than the old Trademark Law, especially in the effort to protect well-known trademarks that are not registered in Indonesia.

The Trademark Law regulates 2 ways of registering a mark, namely registration with priority rights and registration in the usual way. Priority application for rights is regulated in Articles 9 and 10 of the Trademark Law. While the meaning is regulated in P origin 1 letter, what is meant by the right of authority is the right of the applicant to submit an application originating from a country that is a member of the *Paris Convention for the Protection of Industrial Property or Agreement Establishing the World Trade Organization* with the approval period being a maximum of 6 months. as from the date of receipt of the first application for registration of a mark received in another country which is a member of the Paris Convention or a member of the agreement for the establishment of the World Trade Organization”.

In addition to the Paris convention, there are also other conventions such as the Madrid agreement of 1891. The Madrid agreement was formed in April 1891. The purpose of its establishment is to facilitate the registration of trademarks in various countries at once, namely in countries participating in the Paris Convention to avoid false notification of the origin of goods (*Madrid Agreement. Concerning the Repression of False Indication of False Origin*), international registration of national marks at the international bureau in Bern with the understanding that these marks must first become national marks in their country of origin.

The provisions related to the protection of well-known marks are mainly regulated in the *Paris Convention for the Protection of Industrial Property* (“*Paris Convention*”) and also in the *Agreement on Trade-Related Aspects of Intellectual Property Rights* (“*TRIPS Agreement*”). In Article 6bis paragraph (1) *Paris Convention* stipulates that:

“The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration , and to prohibit the use , of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.” Article 16 paragraph (2) of the *TRIPS Agreement*, which then complements Article 6bis of the *Paris Convention* above, stipulates as follows:

“In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.”

The provisions for protecting well-known marks above apply to all member countries of the *Paris Convention* and signatories to the *TRIPS Agreement (the World Trade Organization's TRIPS Agreement)*, including Indonesia which also ratified the two *treaties* respectively through Presidential Decree No. 24/1979 on Ratification of the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization as amended by Presidential Decree Number 15 of 1997 concerning Amendment to Presidential Decree Number 24 of 1979 concerning Ratification of the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization and Law Number 7 of 1994 concerning Ratification of the Agreement Establishing the World Trade Organization.

For owners of well-known marks but unregistered marks who can show evidence of the trademark's recognizability, the MIG Law provides a mechanism for the cancellation of registered trademarks through the Commercial Court, if their famous trademark has already been registered or an application for registration in Indonesia is submitted by other parties with bad intentions.

To fulfill its commitment as a member country of the Paris Convention and a signatory to the TRIPS Agreement, the Indonesian government since 1992 has made changes or repeals to the laws governing trademarks and complemented them with articles that authorize the relevant authorities, namely the DJKI, in this case. Directorate of Marks and Geographical Indications, to protect well-known marks by refusing applications for registration of marks that contain similarities both in principle and in general with well-known marks belonging to other parties for similar or dissimilar goods and/or services that meet certain requirements.

As has been explained part of the elucidation of Article 21 paragraph (1) letter b Trademark Act 2016 stated that the rejection of applications that have a similarity in principle or in whole with trademark famed another party for goods and / or services of the kind carried out with due regard to the general knowledge of society regarding m the securities in the relevant line of business.

Keep in mind that before the enactment of Law No. 20 of 2016 on Marks and Geographical Indications regarding right trademark been regulated in Law No. 15 of 2001. However, both the rule of law there is no provision in particular contain rules regarding criminal against well-known unregistered marks. **Whereas the Paris convention is mandated to provide protection for well-known trademarks, both registered and unregistered.**

This means that the protection of foreign well-known marks that are not registered in Indonesia, especially in Decision Number 7K/Pdt.Sus-HKI/2018 that according to the Trademark Law is only protected for 5 (five) years, if the foreign well-known mark is not registered, then someone

else can register the name and claim the mark. Of course, this is contrary to the theory of legal protection, in which country obliged to protect citizens / person, although the person is a stranger. This provision is contrary to the rules of the Paris Convention, where a mark registered in bad faith can be canceled indefinitely, so the case for the Sharpness mark must be decided fairly based on the 2016 Trademark Law.

4. CONCLUSION

Based on the description above, from the previous chapters, it can be concluded that the protection of well-known marks is mainly regulated in the *Paris Convention for the Protection of Industrial Property ("Paris Convention")* and also in the *Agreement on Trade-Related Aspects of Intellectual Property Rights. ("TRIPS Agreement")*. The act of registering a mark used by another party that has not been registered without the user's permission is an act of registering a mark which is contrary to the principle of good faith. Protection of foreign famous trademarks that are not registered in Indonesia, particularly in the Decision MA Number 7 **K/Pdt.Sus-HKI/2018** that potential protective foreign famous trademarks that are not registered in Indonesia according to Law No. 15 of 2001 is only protected for 5 (five) years, if the foreign well-known mark is not registered, then someone else can register the name and claim the mark. Of course, this is contrary to the theory of legal protection, where the state is obliged to protect a citizen/person, even though that person is a foreigner. This provision is contrary to the rules of the Paris Convention, where a mark registered in bad faith can be canceled indefinitely. Of course, regulations like this make the Indonesian state worse in the eyes of the international community in the context of protecting Intellectual Property Rights. With the promulgation of Law No. 20 of 2016 concerning Marks and Geographical Indications in addition to adjusting trademark protection to the times, it is also a form of Indonesia's seriousness in protecting Intellectual Property Rights, especially trademarks so that the Sharpness trademark case that occurred after Law No. 20 of 2016 was enacted, the dispute over the Sharpness trademark case can resolved fairly.

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