



# The Position of a Mark That Has Not Been Used Fort Three Consecutive Years *According to Law No. 20 of 2016 Concerning Trademark and Geographical Indications*

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**Abstract.** This study examines the position of a trademark that has not been used for three consecutive years according to Law no. 20 of 2016 concerning trademark and Geographical Indications. The trademark law has regulations regarding this topic, therefore registered marks may be removed and canceled if the necessary conditions are completed. As a result, registration does not provide protection from deletion or cancellation of a mark. This research is legal research using a method that follows the scientific characteristics of jurisprudence, namely normative legal research. This research aims to examine how the registered mark is not used following the provisions of the law that regulates and the legal consequences.

**Keywords:** Legal Position · Trademark

## 1 Introduction

To identify between commodities and services generated by people or legal entities in goods and services trading activities, use dimensions, sound, holograms, or a mix of two or more elements. According to Black's Law Dictionary, a brand is a word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others [1].

Trademarks as intellectual property rights are signs to identify the origin of goods and services (an indication of origin) [2]. From a company with other goods and services. Brands are the spearhead of trade in goods and services. By using a trademark, business owners can uphold and ensure the caliber of the products they make and avoid unfair competition (concurrency) from other business owners who wish to capitalize on their goodwill. Additionally, a brand serves as a marketing and advertising tool that informs consumers to some extent about the products and services offered by business owners.

The deletion of a registered mark may be submitted by the owner of the mark or represented by his proxies for some or all types of goods and services to the Minister. At the Minister's initiative, If a registered mark is in conflict with state ideology, rules and regulations, morality, religion, decency and public order, or if it shares similarities in

principle and in whole with geographical indicators or traditional cultural expressions, it may be abolished. Name, logo, or intangible cultural heritage.

Furthermore, David I Bainbridge stated: “trademarks are closely associated with business image, goodwill, and reputation. Trademarks also provide confidence to the public regarding the quality, economic value, or origin of goods and services. A trademark often requests goods or services, and the public relies on many marks to indicate quality, value for money or origin of goods and services) [3].

In addition to the brand owner and the Minister, the deletion of a mark can also be proposed by an interested third party if the registered mark has not been used for 3 (three) consecutive years in trading. The Law on Marks and Geographical Indications in Article 74, paragraph (1) regulates the abolition of a registered mark proposed by a third party.

If a mark is registered, it must be utilized in conjunction with the registration request. The legislation that governs trademarks requires the mark’s owner to be truthful in how he uses his mark, which means that the registered mark must be used in accordance with the class of products or services for which it is being registered and must also take the same shape.

A trademark’s registration does not guarantee that it will not be removed or canceled because the law on trademarks contains provisions that allow for the removal and cancellation of registered trademarks if certain conditions are met.

## 2 Method

This type of research is legal research using a method by the scientific characteristics of jurisprudence, namely normative legal research. As normative legal research, the method used is a legal research method that aims to examine if the registered mark is not used following the law’s provisions that regulate and the legal consequences [4].

## 3 Results and Discussion

In their position as intellectual property rights, trademarks are protected by law or legislation. In Indonesia, trademark protection is regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications. Every person or legal entity that owns a mark and uses it in trade is expected to register the mark to obtain protection by law. By registering a mark, the mark owner gets a registration certificate which is then carried out by various examinations by the Ministry of Law and Human Rights (hereinafter referred to as the Minister). If it has passed the inspection process and has been declared to meet the requirements, it will obtain a trademark certificate as evidence. Trademark rights. Trademark certificates are helpful in the event of a trademark dispute and can be used as documentary evidence in court evidence.

Having a trademark certificate as proof of trademark rights by the brand owner can prevent other parties from using the mark without the brand owner’s permission. If the other party wishes to use a registered mark, it must first agree with the owner of the mark, which in law is called a license.

Trademark registration is essential, considering trademark rights as exclusive rights for trademark owners arise from registration. In other words, without registration, the owner of the mark does not get legal protection from other parties who use a similar mark [5]. It is a consequence of the constitutive system adopted by the Trademark Law. Thus, unregistered trademarks do not receive legal protection because they do not have exclusive rights.

Therefore, how important is the function of trademark registration because:

1. As evidence for the owner who is entitled to the registered mark;
2. In order to reject a mark that is identical in every respect or identical in concept but applied for registration by a different party for similar goods or services.
3. As a basis to prevent other people from using the same brand in its entirety or essentially the same in.
4. Circulation for similar goods/services) [6].

The Law on Marks and Geographical Indications affirms that if a registered trademark dispute occurs, one of the legal remedies can be taken by filing a lawsuit to delete the registered mark to the Commercial Court.

Law No. 20 of 2016 Regarding Marks and Geographical Indications, some things can remove a mark from the General Register of Marks, and anyone who can delete and file a lawsuit for the deletion of a registered mark [7]. There are 3 (three) parties who can apply for the deletion of a mark, namely the owner of the mark itself, on the initiative of the Minister, and on the lawsuit of a third party. The reasons for each party wanting to remove the registered mark are as follows:

1. The Trademark owner's initiative because he no longer uses the mark in trading activities
2. Ministerial initiative: there are 3 (three) things that become the basis for the Minister to remove a registered mark, namely:
  - a. Have similarities in principal and/or overall with IG
  - b. Not in accordance with state policy, the law, morality, religion, decency, or the public order; or
  - c. Resemble traditional cultural expressions, intangible cultural treasures, names, or emblems that have been handed down from one generation to another in its totality.
3. Filed by an interested third party in the form of a lawsuit to the Commercial Court because the mark has not been used for 3 (three) consecutive times in the trade of goods and/or services from the date of registration or last use.

As previously explained, 3 (three) parties can apply for the abolition of a registered mark, namely the owner of the mark, on the initiative of the Minister and because there is a lawsuit from a third party. Therefore, the Minister will remove the mark from the DUM based on these three things.

In the old Trademark Law, the Minister CQ, the Directorate General of Intellectual Property Rights, had the authority to remove a registered mark from the DUM if the mark was not used for 3 (three) consecutive years. It means it is purely an initiative of the Directorate General of Intellectual Property Rights. However, in UUM and IG, the

reason for the non-use mark can only be used by a third party to file a trademark deletion lawsuit.

According to the law, although there is no lawsuit from a third party with the non-use of the mark for 3 (three), the mark has lost its legal force, meaning that the exclusive rights of the brand owner have ended. Thus, the brand owner should no longer be allowed to use the mark. At the same time, he should no longer have the right to sue parties that he considers having used his trademark without permission.

The deletion of a registered mark from DUM either by the owner of the mark in question, on the initiative of the Minister, or because the period of legal protection for the mark has expired and a third party files a litigation as a result in question is recorded and announced in the Official Gazette of Trademarks. It is intended for the public, especially interested parties, can know.

## 4 Conclusion

Based on the description of the writing of this study regarding the Legal Position of Marks Not Used for Three Years in a row, it can be concluded that the owner of a registered mark must use a registered mark because it will result in a lawsuit from another party. The fact that a mark is registered does not mean it is immune from deletion or cancellation because the trademark law has provisions regarding this subject that allow registered marks to be erased and canceled if certain conditions are met.

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## References

1. B. A. Garner, "Black's Law Dictionary, eight edition," USA: West, a Thomson Business, 2004.
2. R. Jened, *Hukum merek (trademark law): dalam era global dan integrasi ekonomi*. Prenada-media Group, 2015.
3. D. Bainbridge, "Intellectual Property, 3rd edn." Pitman Publishing UK, 1996.
4. P. M. Marzuki, "Telaah Filosofis Terhadap Undang-undang Larangan Praktek Monopoli dan Persaingan Usaha Tidak Sehat," *Yuridika*, vol. 16, no. 4, pp. 505–527, 2001.
5. I. Yusran, "Buku Pintar HAKI (Tanya Jawab Seputar Hak Kekayaan Intelektual)." Bogor: Ghalia Indonesia, 2010.
6. Indonesia. D. J. H. K. Intelektual, *Buku panduan hak kekayaan intelektual*. Direktorat Jenderal Hak Kekayaan Intelektual, Departemen Hukum dan Hak Asasi Manusia, Republik Indonesia, 2009. [Online]. Available: <https://books.google.co.id/books?id=Of7UXwAACAAJ>
7. Pemerintah Pusat, *Undang-undang (UU) tentang Merek dan Indikasi Geografis*. Indonesia: <https://peraturan.bpk.go.id/Home/Details/37595/uu-no-20-tahun-2016>, 2016.

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