



A legal protection for domestic well-known mark on impersonation of different kind of goods under Indonesia's trademark law

Ali Oksy Murbiantoro^(a), Rachmad Safa'at^(b), Yuliati^(c), Sukarmi^(d)



^(a) Faculty of Law, Brawijaya University, Veteran Street no. 1 Post code: 65125, Malang City, Indonesia

^(b,c,d) Lecturer, Faculty of Law, Brawijaya University, Veteran Street no. 1 Post code: 65125, Malang City, Indonesia

ARTICLE INFO

Article history:

Received 17 June 20

Received in revised form 30 June 20

Accepted 02 July 20

Keywords:

Legal Protection, Domestic Well-Known Mark, Impersonation, Trademark Law

JEL Classification:

K23, K40, K42

ABSTRACT

Indonesia's trademark law does not provide provision for legal protection to registered mark which is well-known domestically therefore, there is no legal basis in case there is another party to commit in impersonation the said registered mark in the different kind of goods. On the other hand, protection indicates the address of international well-known marks only. Referring to the trademark law regime which is common universally such as can be found in the Paris Convention and TRIPs Agreement. Otherwise, for impersonation in different kinds of goods, the protection is given for a well-known mark only. However, the said mark must be recognized within the territory where the mark is called as well-known such in certain countries. The purpose of this study is to know the legal protection for the domestic well-known mark on impersonation of different kind of goods under Indonesia's trademark law. This study is normative legal research with legislation, concept, and comparative approach. The legal material with technical analysis is done by the method of interpretation. Results of this study, The regulation of legal protection for registered trademark owners of impersonation of different kinds of goods should be reregulated (a reformulation of provisions). So that which is a well-known trademark can be in the form of domestic and internationally well-known, therefore the requirements for registration and commercializing of a mark in several countries, not as an obligation to obtain the rights and status become a well-known mark. However, when a mark is factually known and used in Indonesia, the wide scope of international well-known is no need as a mandatory.

© 2020 by the authors. Licensee SSBFNET, Istanbul, Turkey. This article is an open access article distributed under the terms and conditions of the Creative Commons Attribution (CC BY) license (<http://creativecommons.org/licenses/by/4.0/>).

Introduction

Indonesia's requirement of well-known mark which are required that should be there are registration and commercialization overseas mean that the requirement only suitable for international trademark, therefore, this requirement of provision cannot answer a situation for a trademark which is recognized and well known domestically within Indonesia's territory. In Indonesia itself has changed and added the Law of Trademark in such a way since Act No. 21 of 1961 then amended by Act No. 12 of 1992 and amended again with Law No. 14 of 1997, and amended again Law No. 15 of 2001, and the last with the enactment of Law No. 20 of 2016 This proves that the role of the brand is very important and required a more appropriate arrangement in line with the rapid development of the business world (Medina et al., 2018).

Discussing the issue of trademark law is inseparable from issues of industrial trade, business competition, intellectual property rights as well as international law. In the era of globalization of free trade, so every country in the world obliged to follow international rules made based on an agreement among the member of countries that are incorporated in World Trade Organization (WTO) (Sari & Bramantyo, 2020). However, the consequences of globalization should not be harm Indonesia's national interests considering that the aspect of economic trade does not directed and focused on the interests of international trade only. However, this policy on international trade must be balanced and harmonious with the conditions of domestic economic trade, in particular, providing opportunities for fair competition with the interests of trade and the domestic market.

* Corresponding author. ORCID ID: 0000-0002-5851-8000

The Law (hereinafter referred to as Law) of the Indonesian Trademark, which currently applies, namely Law 20 of 2016 concerning Trademarks and Geographical Indications, 2016 Republic of Indonesia State Gazette Number 252, Supplement to the Republic of Indonesia State Gazette Number 5953. (hereinafter referred to as 2016 Trademark Law), in principle adopting and constituting the harmonization of the provisions of the Trade-Related Aspects of Intellectual Agreement Property Rights (TRIPs) - World Trade Organization (WTO). In the Uruguay Round of GATT Convention in Marrakech (Morocco) on intellectual property rights in September 1990 the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs), namely concerning aspects of trade related to intellectual property rights and the formation of the WTO which has a structure in it organizations related to IPR (Praniasari, 2018).

Whereas, in reality, the provisions of trademark law in Indonesia which are as a part of the harmonization outcome of international conventions on trademark that are unable to accommodate the legal protection of trademark owners or do not provide legal protection for trademark when in fact the mark is used without rights by other parties on non-similar goods (Article 21 Paragraph (1) Letter a Jo Article 83 of the 2016 Trademark Law). So based on this provision the registered trademark owner can not objection or bringing lawsuit against third party who intend to imitating or using the said registered trademark having basic similarity or as a whole in different kinds of goods, for example the media owner of a newspaper / newspaper outstanding and nationally known including item class 16, then the other party uses the name of the newspaper mark which has basic similarities in the form of online goods (news portal) which is covered in class of goods 42. In this case the trademark owner of newspaper does not obtain a legal protection as the right of trademark owner of a trademark right considering that the parties who conduct imitating of marks cannot be consider has violated of the trademark law because the newspapers media are in different kinds of goods. This illustration is related to the *Republika VS Ardy Purnawan Sani* trademark on September 23, 2013 (*Suara Republika*) registered with the Central Jakarta District Court No. 444 / Pdt.G / 2013 / PN.JKT.PST.

The case ended with amicable way in front of a panel of judges (Van Dading Act) whose contents of the amicably were essentially Defendants (*Suara Republika*) apologized to the Plaintiffs of *Republika* for their mistakes and would stop using the activities of *Suara Republika* online to revoke the application for class 40 at the trademark Directorate, DG IPR, Ministry of Law and Human Rights. This settlement shows that even registered trademark holders are not included in the criteria of well-known marks according to the explanation of Article 21 of the 2016 Trademark Law, which is registered and invested in various countries, but the owner of the *Republika* trademark is a nationally circulating newspaper which is automatically recognized nationally as well. *Republika* mark owners still object if the brand is used even in other types of goods (different).

Furthermore, in the case of *Mustika Ratu VS Arif Prayudi* registered at the Registrar's Office of the Central Jakarta District / Commercial Court on July 28, 2003 in case No. 57 / Trademark / 2003 / PN.Niaga.Jkt.Pst. *Mustika Ratu* as the owner of a registered mark that includes cosmetics (class 3 goods) against *Arif Prayudi*, the registered trademark owner with registration 360628 on May 30, 1996 for the types of goods included in class 25 covering all kinds of outer and inner apparel for men, women, children and babies.

In this case *Mustika Ratu*, as the Plaintiff of the trademark owner for the kinds of goods of cosmetic goods, objected and demanded the cancellation of the Defendant's trademark even though they were in different kinds of goods (clothing). At the time the case was filed *Mustika* The Court's decision in petition granted *Mustika Ratu*, which means that the *Mustika Ratu* trademark, which was registered in the name of *Arif Prayudi*, had to be canceled because in principle the Defendant's trademark registration was filed based on bad faith.

Besides that, there is also a Court Decision which is in the public spotlight, namely the decision of the commercial court at the District Court of Central Jakarta no. 39 / Marak / 2011 / PN. Commerce Jkt.Pst. In the case of a trademark between *IKEA* (*Inter IKEA Systems B.V.*) originating from Sweden and the product of its goods registered as a mark in Indonesia in several classes with the Registration Number: IDM000092006 (class 21); IDM000092007 (class 24); IDM000092008 (class 11); IDM000092009 (class 35) and IDM000092010 (class 42) against *IKEMA* (PT. Angsa Daya) an Indonesian legal entity registered as a trademark with registration no. IDM 000247161 for class of goods 19, the *IKEA* mark unless registered in Indonesia is also registered in 75 countries. for the case, the court ruled in principle that: granting the lawsuit filed by *IKEA*, stating the *IKEMA* trademark registration was carried out in bad faith, stating *IKEA* as a well-known trademark and registration of the *IKEMA* mark must be canceled. In the *IKEA vs. IKEMA* Trademark Case, whose case is registered under Number: 39 / Trademark / 2011 / PN. Commerce Jkt.Pst. Then the commercial court's decision was corroborated by Indonesia's Supreme Court. MA-RI's decision No. 697 K / Pdt.Sus / 2011 (cassation's stage). However, the cassation decision was canceled by Judicial Review of Supreme Court No. 165 PK / Pdt Sus / 2012 which basically stating granted the Petitioner / Defendant I Review Request I canceled the cassation decision with the consideration that the *IKEMA* trademark is in class 19 which is different kinds of goods from the *IKEA* mark. Finally, based on this judicial review's decision showing that the imitating mark violation cannot be applied in the different kinds of goods.

Approach to the issue

In connection with this, in this study using normative legal research methods, namely legal research conducted by examining materials derived from various laws and regulations namely TRIPs, Paris Convention, WIPO Rules, Indonesia's Trademark Law, Law No 20 of 2016 concerning marks and Geographical indication and other materials from various literatures. In other words, this

research examines literature or secondary data. The study of legal normative here is due to the ambiguity of norms, namely that there is a lack of clarity about the norms in determining the terms and criteria for well-known brands contained in the Indonesia's Trademark Law related to the provisions of the international convention TRIPs, Paris Convention. Besides that, it is also related to the possibility of legal protection for registered brands if there is imitation of non-similar goods.

The approach used in this study, legislation, concept, and comparative approach are used (Marzuki, 2011). The legal material from normative research can be divided into three namely,

- Primary legal material, is the main legal material in this study, consists of laws and regulations relating to land, they are various laws and regulations namely TRIPs, Paris Convention, WIPO Rules, Indonesia's Trademark Law, Law No 20 of 2016 concerning marks and Geographical indication and other materials from various literatures.
- Secondary legal law, includes library materials that provide explanations about primary legal materials³¹ such as books, works from the legal community, literature, magazines, newspapers, electronic media as well as other data references relating to the issue of compensation for land acquisition for development in the public interest (Hermansyah, 2009).

The technique of searching primary and secondary legal materials is done by studying literature and internet searching (Rahardjo, 2000). The legal material with technical analysis is done by the method of interpretation. Comparing to the provisions of well-known mark within Indonesia's trademark law; International Trademark Convention experiences such as USA and Singapore will answers whether the understanding and definition of well-known marks in Indonesia in connection with the issues of impersonation towards registered of well-known mark domestically is already proper either for domestic or worldwide perspective.

A Redefinition of Criteria

Based on article 21 Paragraph (1) Subparagraph b and Subparagraph c of the 2016 of Indonesia's Trademark Law has stipulates that an Application of mark is rejected if the Mark has basic similarities or in entirety with:

- a. The registered mark belongs to another party or has been applied in advance by another party for similar goods and / or services.
- b. Well known mark belong to other parties for similar goods and / or services.
- c. Well known mark belong to other parties for different kind of goods and / or services which meet with the specific requirements (will be further regulated)

Referring to provision (point c) based on Supreme Court's circular letter 2012 stating that considering up until now such a regulation concerning in determining of trademark violation in terms of impersonation of the mark, including a well-known mark in different kind of goods has not been enacted therefore the legitimate owner of mark in case of well-known mark is not entitle to object or to take legal action against third parties who conduct to imitating of their mark in different kind of goods. Under Indonesia's trademark law the requirement of well-known mark must be the mark which is the product commercialized as well as registered internationally. Therefore, the registered mark with the products or services which is recognized and well known within Indonesian territory no opportunity to obtain status as a well-known mark, consequently for local registered well known mark's level impossible in obtaining protection such as to take objection and/or to bring a lawsuit against third parties who imitating their registered mark in different kind of goods. In other words based on Indonesia's Trademark Law the criteria of a well-known mark restricted to International mark only which is well-known globally. Therefore, the issue of a legal protection of registered mark against impersonation for different kinds of goods and a criteria or requirement of well-known mark is inherently or dependence between each other. Actually, this rule is not appropriate with the provisions of TRIPs and Paris Convention. Article 16 paragraph 3 and Paris Convention do not regulate such a requirements for well-known mark must be commercialized and registered internationally

Article 16 paragraph (3) TRIPs:

Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods services which are not similar to those in respect of which trademarks registered, provided that use that trademarks in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademarks and provided that the interest of the owner of the registered trademarks are likely to be damaged by such use.

Article 6 of the Paris Convention:

Article 6bis [Marks: Well-Known Marks] (1) Paris Convention; 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.

On the basis of the those provisions showing that there is no requirement to be a well-known mark must be commercialized and registered internationally instead of under joint recommendation of WIPO basically rules that a protection of well-known mark that means, member of country no need to protect an internationally known mark if that mark is not well known domestically. Also, the protection to be given to well-known mark at least with effect from the time when the mark has become well-known in the Member State (article 3 (1) of WIPO Joint Recommendation in September 1999. (INTA: by Burton Ong: 2005: Vol 95: 1226).

Further, the urgency to protect of domestic well-known mark due to there is an impersonation in different kinds of goods can be approached with the theory of Law and Economics, whereas in determining trade name by producer (manufacturer) is not a simple way, considering that it is as a part of strategic concept of marketing and selling. Actually, the product can be quickly recognized by the public of consumers as new producers (manufacturer) using the same name of product or having similarities with name of products which have already been known in the market previously. However, if this is done by the new producer referred to goods similar to their product, consequently will violate article 21 Paragraph (1) a of Indonesia's Trademark Law of 2016. Otherwise If the product to be marketed uses a mark/brand which has similarities with the goods in different kinds of goods (not in the same type) that means contrary to Article 21 Paragraph (1) c of the 2016 Trademark Law that is related to a well-known mark with criteria the mark must be registered and commercialized overseas. Therefore, a registered mark that is not included in to the said criteria of a well-known mark does not obtain legal protection when the mark is imitated by another producer (manufacturer). Based on perspective of Law and Economics theory stating that rationally economic actors will always effort to achieve and maximize the level of economic satisfaction even though this is related to unlawful acts, as long as the costs incurred for the settlement, it is necessary to have an economic target to be achieved. Therefore, the condition of the absence of rules/legal protection against trademark impersonation in different kinds of goods giving huge opportunity for business actors who in bad faith to shorten profits by violating the rights of registered trademark.

Then, another perspective r law and economic theories relates to applying the concept of the legal rule as a Consideration (Price). In the economy the level of illegal actions can be reduced by increasing the value of fines for the violator. If to analogize for the imitation of the mark/brand in different kinds of goods considering that there is no clear regulation imposing to violators therefore in this regards needs to be governed. (Nicholas Mercurio & Steven G. Medema: 1996: 51).

The Criteria of Well Known Mark in Singapore and USA

Regarding to the implementation article 16 paragraph 3 TRIPs and article 6 bis the Paris Convention is enforced by Singapore more precisely and consistently. According to Singapore trademark law, the definition or criteria of a well-known marks should not be an international well-known mark, for this the said of trademarks law (Singapore) refer to article 6 bis of the Paris Convention which means taking consideration of domestically recognition as a part of requirement for well-known. Indeed this law explicitly mentions and references the requirements and the criteria of well-known mark in the said convention. The same things is also occurred in the US trademark law.

Therefore, in the following below, I will make an overview of illustration addressing to the issue of protecting registered trademarks against impersonation of different kinds of goods by comparing the laws and regulations of Singapore and the United States. for the discussion of the protection of registered marks against the impersonation in the different kinds of goods, this cannot be separated from the issue of well-known trademarks where the provisions as globally regulated in Article Paragraph (3) of TRIPs 16 and Article 6 of Paris Convention which regulates issues concerning well-known marks and different kinds of goods The focus here is related to well-known registered marks refer to the provisions of the TRIPs and the Paris Convention as described above that the understanding of well-known mark between the said conventions is different with Indonesia 's trademark law in force.

Singapore Rule

In Singapore the issue of impersonation of trademarks registered against different kind of goods is regulated in the legislation TRADE MARKS ACT (CHAPTER 332) REVISED EDITION 2005 (31st July 2005), meaning that Singapore trademark law recognizes and regulates legal protection for trademark owners of impersonation of non-identical goods in both the stage of application for registration of a mark is filed as well as when the occurrence of trademark infringement or the use of the trademark without rights by a third party as stipulated in article 8 paragraph 3 and article 27 paragraph 3. Then the act of using a registered mark without rights or what is known as infringement / violation by Singapore legislation regulates unfair competition (fraudulent competition) in the field of trademarks, dillution (dilution), passing off / tort (unlawful acts). The most important things here is the protection against the application of identification of the unrelated kind of goods can occur in registered marks both well-known and not well-known that is regulated in article 8 paragraph 1 to paragraph 3 jo article 27 paragraph 1 to paragraph 3, whereas for foreign marks that well-known is inseparable with the understanding of the notion of well-known mark as explained above that the Singapore legislation means that well-known is known in the territory of Singapore (in part 1 interpretation points a, b of trademark law). Even if there are other requirements such as registration and trading abroad it is intended only for the marks originating from abroad that claim to be well-known marks and must also fulfill the requirements that the trademark is really known in Singapore at least the mark must provide confidence to the people/public of Singapore that the said mark can be deemed well known in the Singapore area. It also shows that Singapore legislators or lawmakers in this context pay attention to national interests / local marks owners. So here, the main concern of well-known is relevance with the marks are circulating in case in the Singapore region.

Under Singapore regulation a factor that determines the impersonation of a non-similar type of product and is focused on the criteria that the presence of a marks that later (imitates) will lead to confusion to the public that means confusion about the origin of the goods; cause harm to the owner of a registered mark by the presence of a copying mark; the existence of bad faith in its use. The element of this criteria is actually does not much different from the consideration of Indonesia's Supreme Court in rendering consideration to decisions on trademark cases related to the impersonation in different kinds of goods .

Whereas regarding the criteria of well-known marks and the protection of trademark owners from impersonation in deferent kind of goods goods based on Singapore trademark office (Intellectual Property Office of Singapore / IPOS) confirmed that in Singapore the protection of registered trademarks against impersonation in deferent kind goods is indeed recognized as long as the registered mark is at least known by the public / Singapore consumers, so that the registered mark does not have to be a well-known mark with criteria for being commercialized/traded and registered abroad.

According to Singapore mark legislation, a well-known of mark does not must to be registered and commercialized and traded abroad, but both factors can be factors that support a mark to become a well-known mark, but it is not a prerequisite. Actually, this criteria is in accordance with the requirement of well-known mark set by the 1999 WIPO recommendation team (the WIPO Joint Recommendation on the Protection on Well Known Marks) article 3 (1) which basically states that the conditions for awarding a well-known mark are: "at least a mark becoming famous in a participating country (member), the participating country (member) is not obliged to protect internationally as a well-known mark, if the mark is not recognized/known domestically."

("Article 3 (1) of the WIPO Joint Recommendation. Which only requires protection to a given well-known mark" at least with effect from the time when the mark has become well known in the Member State. "Member States are not obliged to protect an "internationally known" mark if that mark is not well known domestically). From this provision means recognizing that the well-known mark may apply domestically in the case of a well-known in Singapore or local (national), or in other words a mark that is known domestically cannot automatically claim to be internationally well-known. This is different from the Indonesia's trademark legislation which defines a well-known mark with an internationally famous orientation, namely the existence of criteria for well-known that must be registered and commercialized /traded internationally.

The High Court of Singapore ruling in 2009 in the case of Novelty Pte versus Safe Resort Ltd and another applies the principle as stated above, namely the court considers that the name "Safe" (owned by the Plaintiff / luxury resort name) by the High Court of Singapore is considered a well-known mark in Singapore, because the name "Safe" is owned by a Singapore's company and is located in Singapore and is known by the public of Singapore. Even the name Safe was never as a trademark and in fact the Plaintiff's registered trademark was "Amanusa". From this case, it proves that the criteria of Singapore trademark law requires that for a well-known marks are defined as a mark that should be really known by the public consumer in Singapore, and no need to be registered and traded abroad. (INTA: Op.Cit: 1228.).

US Rule

In the United States, the legal protection of registered trademarks against impersonation of different kind of goods is the same with Singapore referred to the provisions of Article 6 bis of the Paris Convention and Article 16 paragraph (3) of TRIPs. In this context means that the registered mark which receives protection here is a registered mark that is already known in the (community/county) in the United States so this level of well-known does not have to be at the federal (national) level or moreover internationally. Regarding this matter as explained by the United States Trademark Office, the United States Patent and Trademark office (USPTO) that Article 6 bis of the Paris Convention for the Protection of Industrial Property (1967) requires member countries to afford certain protections to well-known marks, regardless of whether they are registered. Specifically, member countries must refuse or cancel the registration, and prohibit the use, of a well-known mark when applied for or used by an unauthorized party for identical or similar goods, when its use or registration would likely cause confusion. Article 16.2 of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) extends Paris Convention Article 6bis to services and provides that members shall take into account that a mark is well-known to a relevant sector of the public (not the entire country) as well as promotion of the mark (not just use). Article 16.3 of TRIPs extends Art. 6bis protection to well-known marks when used on unrelated goods or services in cases where the well-known mark is registered, if such use indicates a connection to the owner and the well-known mark owner would likely be damaged.

The United States implements these standards by protecting registered as well as unregistered well-known marks, of both domestic and foreign origin, from use and / or registration by unauthorized parties through the operation of the Lanham Act § 43 (a), §43 (c), §44 (b) and §44 (h) and under the Lanham Act §2 (a) and 2 (d). (15 USC, §1125 (a), §1125 (c), §1126 (b) and (h), and §1052 (a) and (d)) US federal law protects a mark against infringement or registration by another party's similar mark for goods or services that are the same, similar, related or even unrelated if there is a likelihood of confusion, whether or not the senior mark is registered. (USPTO, accessed on November 4, 2019).

The owner of a well-known mark may bring an action in U.S. federal court for trademark infringement under Section 43(a) of the Lanham Act. A U.S. federal court will make a determination as to likelihood of confusion in deciding infringement. U.S. case law outlines a variety of non-exclusive and non-exhaustive factors that can be used in the analysis. These factors include, but are not limited to, the similarity of the marks, the relatedness or proximity of the goods and/or services, the strength of the plaintiff's mark

including the level of commercial recognition, marketing channels used including the similarity or dissimilarity between the consumers of the parties' goods and/or services, the degree of care likely to be exercised by purchasers in selecting goods and/or services, the defendant's intent in selecting its mark, the evidence of actual confusion, the likelihood of expansion in product lines, etc. In this analysis, while no one factor is determinative, a strong or well-known mark will receive broader protection than a weaker mark. A mark does not need to be registered to receive protection.

U.S. federal courts may seek to oppose or cancel another's application or registration for the mark on the grounds of dilution. Dilution is the lessening of the capacity of a famous mark to uniquely distinguish its goods, either by tarnishing (weakening through unsavory associations) or blurring (an association arising from the similarity between a mark and a famous mark) its capacity to distinguish. However, dilution may only be applied in cases where a party's well-known mark is "famous," such that it is widely known among the U.S. consuming public.

Thus, in the context of this dilution it can be interpreted that the problem with an impersonation of a registered mark that is deemed to be well known can occur in goods which are not of the same type. The effect of this impersonation can result in the reputation of the registered mark decreases. According to Thomas Mc. Carthy related to dilution includes 3 things:

1. trademark is well known or has reputation
2. similarity of trademark but goods and services are not dissimilar.
3. there is dilution or tarnishment or luring reputation without due cause.

An example of the Dilution case is the Kodak mark (a famous brand) for types of camera items, this brand was taken / imitated for types of bicycle goods. Then the Xerox mark for the type of photocopy machine item is emulated for cigarette products or types of goods. Both of these cases are types of dilution which is a decrease. Whereas examples of dilution associated with confusion are the secret victoria's mark for lingerie items imitated by the secret cathy brand for child clothing items. So, in relation to the protection of registered owner marks against unauthorized use in different kind of goods in the United States is governed under US Federal Trade Mark Dilution Act 1995 which was revised with the 2006 Trade Mark Dilution Act. However, well-known marks in the United States are well-known marks which are included in the jurisdiction of the United States. No requirements that the marks must be commercialized/ traded and registered abroad. Therefore it is different governing from Indonesia trademark law which requires commercialization/trading and registration of mark in several countries. Hence, both the United States and Singapore govern their marks appropriate with article 16 paragraph 3 TRIPs and article 6 bis the Paris Convention.

Applying Dilution and Unfair Competition Concept to Impersonation For Different Kinds of Goods

The application of the concepts of dilution and unfair competition in Indonesian trademark law is one of the reasons as a proper solution in providing justification and argumentation basis, in terms of to answer the issue of impersonation of trademarks on different kinds goods, particularly for impersonation of domestic well known mark obtains sufficient legal basis due to the existence of protection and legal certainty for the trademark owner which is impersonated thereof. Considering that actually the concept of dilution and unfair competition basically reflect to the understanding of unlawful act (tort) which stating in the article 1365 Indonesia's civil code. However, this understanding is not covered in Indonesia's Trademark law instead of it is enforced in Indonesia's civil law and civil procedure. Hence, if there is a trademark impersonation dispute in the different kinds of goods, the resolution of the dispute will refer to unlawful act and that the lawsuit will be examined by regular district court, even though based on trademark law for trademark lawsuit should be examined by commercial court. Therefore, no ensuring that the district court will accept in examining this lawsuit under civil action's category because probably it is considered as a trademark dispute issue, meanwhile under Indonesia's trademark law for a provision thereof is not specifically regulated. Further, it is reasonable that by analogizing the two concepts into Indonesia's trademark law would be useful to provide sufficient legal basis regarding the resolution of the issue of impersonation of trademarks on registered mark that are domestic well-known (national wide) due to impersonation of different kind of goods. (INTA: Op.Cit: 1236-1237.).

Conclusions

The regulation of legal protection for registered trademark owners of impersonation of different kind of goods should be reregulated (reformulation of provisions). According to this regulation the definition and scope of a well-known mark should be interpreted that the mark is factually used and known by the public consumer in Indonesia. Therefore, a famous of mark is oriented to well-known within in region where the mark is definitely known and used in Indonesia. So that which is a well-known trademark can be in the form of domestic and international well-known, therefore the requirements for registration and commercializing of a mark in several countries not as an obligation to obtain the rights and status become well-known mark. Thus it also needs to be certainty regulated concerning the criteria of well-known mark in Indonesia's trademark law. However, when a mark is factually known and used in Indonesia, the wide scope of international well-known is no need as a mandatory. The basis of the argument is in accordance with and is based on the provisions of article 6 bis of the Paris Convention and article 16 paragraph 3 TRIPs and WIPO recommendations. Besides the application of these provisions are enforced by other countries such as Singapore and the United States. Eventually, applying the provisions are founded by law an economics theory.

References

- Ball, E. (2016). *Trademark Owners May Find Dilution Claims Out of Reach*, Fenwick & Wess LLP, Almost Famous.
- Gunawati, A. (2015). *Perlindungan Merek Terkenal Barang dan Jasa Tidak Sejenis Terhadap Persaingan Usaha Tidak Sehat*. Malang. Brijwijaya University.
- Janed, R. (2006). *Penyalahgunaan Hak Eksklusif Hak Kekayaan Intelektual*. Surabaya. Airlangga University.
- LaFrance, M. (2011). Passing Off and Unfair Competition: Conflict and Convergence in Competition Law. *Scholarly Works*. 784. <https://scholars.law.unlv.edu/facpub/784>.
- Mark D. Robins (2004). *Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence*, 2 Nw. J. Tech. & Intell. Prop. 1 <https://scholarlycommons.law.northwestern.edu/njtip/vol2/iss2/1>.
- Marzuki, P.M. (2011). *Penelitian Hukum*, Jakarta: Kencana Prenada Media Group.
- Medina, S., Husni, A., & Sili, E.B. (2018). Legal Protection Of Famous Brand "Hugo Boss" (Study Of Supreme Court Decision NO. 92 / K /PDT.SUS.HKI / 2017). *International Journal of Humanities, Religion and Social Science*, 2(6), 49-63. <http://www.doarj.org/ijhrss/wp-content/uploads/2018/IJHRSS/06/5.pdf>
- Mercurio, N. & Steven G. Medema. (1996). *Economics and the Law From Posner to Post-Modernism*. New jersey, Princeton University Press.
- McCarthy, J. T. (1996). McCarthy on trademarks and unfair competition (Vol. 1). Clark Boardman Callaghan.
- Ong, B. (2005). Protecting Well-Known Trade Marks: Perspective from Singapore. *INTA: The Law Journal of the International Trademark Association, November-December*, Vol. 95 TMR. No. 6. 1221-1272. https://www.inta.org/TMR/Documents/Volume%2095/vol95_no6_a4.pdf.
- Praniasari, L. (2018). Legal Analysis Of The Trademark Registration Gayo Coffee Mountain As A Geographical Indication Products In Indonesia. Yogyakarta, Universitas Islam Indonesia. <https://dspace.uui.ac.id/handle/123456789/10399>
- Rahadjo, S. (2000). *Ilmu Hukum*. Bandung: Citra Aditya Bhakti.
- Sari, A.G. & Bramantyo, R.Y. (2020). Legal Practices In Trademark Violation And Protection Of Local Companies In Indonesia. *Journal of Xi'an University of Architecture & Technology*, 11(3), 3542-3550. <http://www.xajzkjdx.cn/gallery/305-mar2020.pdf>
- Sommers, Mark. (1999). *Taking an Aggressive Stance Against Counterfeiters: An Overview of Trademark Counterfeiting Litigation under the Lanham Act*, September/October.
- Walker, Jeremy T. (2017). *Beware of Facilitating Counterfeiting and Trademark Infringement*. Published in NH Bar News.
- Hermansyah, N. (2009). *Metodologi Penelitian dan Penulisan Hukum*, Banjarmasin, STIH-SA Press.

Internet

- Cornell Law School, Trademark infringement. Available at https://www.law.cornell.edu/wex/trademark_infringement Accessed on January 2019.
- International Trademark Association, Trademark Dilution (Intended for a non-legal audience). (2017). Available at [https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-\(Intended-for-a-non-legal-audience\).aspx](https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-(Intended-for-a-non-legal-audience).aspx). Accessed on January 2019.
- International (Nice) Classification of Goods and Services, Wikipedia, the free encyclopedia, Available at [https://en.wikipedia.org/wiki/International_\(Nice\)_Classification_of_Goods_and_Services](https://en.wikipedia.org/wiki/International_(Nice)_Classification_of_Goods_and_Services), Accessed on February 2020.
- Wellknown trademark criteria in malaysia and japan. Available at <https://open.mitchellhamline.edu/cgi/viewcontent.cgi?article=1142&context=fach>. Accessed on January 2019.
- United States Paten and Trademark office (USPTO), Well-known marks Available at <https://www.uspto.gov/ip-policy/trademark-policy/well-known-marks>, Accessed on November 2019.
- Word Intellectual Property Organization (WIPO). Available at www.wipo.int. Accessed on February 2020.