

Protection of Globally Renowned Brands Which Not Registered in Indonesia

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ABSTRACT

Kata Kunci:
*Famous,
Trademark,
Registration*

The protection arrangements for unregistered globally well-known brands are not explained in detail regarding their protection from passing off in Indonesia. This study aims to analyze how the protection of well-known marks that have not been registered in Indonesia and to prove that internationally registered marks that have not been registered in Indonesia must still be protected in Indonesia. This research is legal research that uses normative juridical research methods by emphasizing argumentation and uncovering meaning by interpreting existing laws and regulations based on the legal system relating to trademark protection. The results of the research show that Article 83 (2) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as the MIG Law) does not protect brand indications other than the indications regulated in Article 1 paragraph (1) of the MIG Law. Furthermore, with the argument that a lawsuit can only be filed after the lawsuit for cancellation has started indicates that Article 83 (2) only covers violations of the transfer of well-known marks that are not registered through third-party registration. Meanwhile, the violation of passing off by using an unregistered name without legal rights is not covered in this article. In addition, the enactment of Article 83 (2) does not fully accommodate passing off lawsuits in Indonesia.

ABSTRAK

Keywords:

Terkenal,
Merek,
Registrasi

Pengaturan perlindungan terhadap merek terkenal secara global tidak terdaftar tidak dijelaskan secara rinci mengenai perlindungannya dari tindakan passing off di Indonesia. Sehingga penelitian ini bertujuan untuk menganalisis bagaimana perlindungan merek terkenal yang belum terdaftar di Indonesia dan bagaimana pembuktian bahwa merek terdaftar internasional yang belum didaftarkan di Indonesia tetap harus dilindungi di Indonesia. Penelitian ini merupakan penelitian hukum yang menggunakan metode penelitian yuridis normatif dengan menekankan pada argumentasi, mengungkap makna dengan penafsiran terhadap peraturan perundang-undangan yang telah ada, baik penafsiran secara gramatikal maupun penafsiran berdasarkan sistem hukum yang berkaitan dengan perlindungan merek. Hasil penelitian menunjukkan berlakunya Pasal 83 Ayat (2) Undang-Undang Nomor 20 Tahun 2016 Tentang Merek dan Indikasi Geografis (UUMIG) tidak memberikan perlindungan terhadap indikasi merek selain indikasi yang diatur dalam Pasal 1 Ayat (1) UUMIG. Selanjutnya, dengan alasan gugatan baru dapat diajukan setelah gugatan pembatalan dimulai, menunjukkan bahwa Pasal 83 Ayat (2) hanya mencakup pelanggaran pengalihan terhadap merek terkenal yang tidak terdaftar melalui pendaftaran pihak ketiga. Sedangkan pelanggaran passing off dengan menggunakan nama tidak terdaftar tanpa hak yang sah tidak tercakup dalam pasal ini. Selain itu, berlakunya Pasal 83 Ayat (2) tersebut juga sangat tidak mengakomodir gugatan passing off di Indonesia.

1. INTRODUCTION

Nowadays, many business actors are increasingly promoting their merchandise or business services through posters, banners, digital advertising media, and other media containing merchandise or services followed by images, logos, names, words, letters, or accents as characteristics of the merchandise or services offered. These characteristics then make a trade item or service different from other products. The characteristics mentioned are then known as a brand (trademark). One of the main things about the product is the brand. In addition to being a differentiator, a brand can add value to a trade product or service (Rahmat & Ifrani, 2019). The use of a brand (trademark) to become a differentiating identity that separates the similarity of the end product traded by one person or group of people or business entity with the end product belonging to another person or other business entity to become a promotional media to introduce the end product only with an alternative mention of the brand (trademark), making guarantees for the reputation of its trading products, as well as being an indicator of the goods/services' origin (DJKI, 2020). Regardless of the brand's function, please note that the brand

owner cannot automatically get its protection. This is because the brand adheres to a constitutive principle. This constitutive principle is that a trademark registrant who registers a trademark for the first time or first (*first-to-file*) has the right to be granted the rights to a trademark (Abdillah, 2019). A brand pioneer who registers a trademark for the first time has the right to protect his brand if it has been registered with a competent authority, namely the Directorate General of Intellectual Property (DJKI) (Betlehn & Samosir, 2018). This is based on Article 21 paragraph (1) and (2) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law) that trademark submissions will be returned or disapproved if the trademark registered is bound to be basically or completely similar to the mark belonging to another registrant who has applied for trade products or services that are homogeneous or similar to the name of a business entity or other party. By registering a mark with DJKI, the product of the trademark registration can be used as protection for our mark and later on could be used as evidence before the court for owners who are entitled to a registered mark filed by another registrant for similar trade products or services and serves as a preventive basis preventing other parties from using a mark with similar or essentially identical indications (Heniyatun et al., 2020).

The country of Indonesia at this time found many trade products and services with brands that are widely known. Trade products and services with well-known brands can be easily found both in the market and in shops/stalls/retails in shopping centers. These well-known brands that are traded are often used as imitation objects by only printing logos or characteristics of well-known brands on trade products by an individual to gain more profit from the popularity of the brand worn. The efforts to protect against imitation of marks and forms of legal violations related to marks were formed in the MIG Law with provisions regarding criminal provisions as in Article 100, Article 102, and Article 103. Setting criminal provisions as in the MIG Law, includes protection against trademark infringement without the same brand rights in whole or in principle, to the extent that its use causes disturbance to the environment or causes human casualties, it will be subject to punishment as stipulated. All of these criminal sanctions arrangements can only be imposed if there is a complaint or report from the victim or usually called a complaint offense (Kumendong, 2017).

Under these conditions, the criminal provisions in the MIG Law are limited to the imposition of sanctions if there is an indication of a violation against a registered mark at DJKI. In other conditions, if there is a brand that is known globally, but has not been registered with the DJKI, then the imposition of criminal sanctions can not be carried out even if there is a violation of the usage of a well-known mark without trademark rights by individuals in Indonesia. It shows that the concept of Well-known trademark protection is not regulated specifically in the MIG Law and the application of the MIG Law, the practice of infringing on well-known marks often occurs (Ghuffran, 2017). In contrast to the legal supremacy of national trademark rights, international regulation of trademark rights in the Paris Convention contains an international agreement for the protection of industrial property rights and the TRIPs Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights hereinafter referred to as TRIPs) (Alfons, 2017). In general, it protects brands that are well-known and registered in a country. This protection does not necessarily only apply to registered brands. However, it is also a protector of a brand that has not been registered in another country but is used by a third party. The intended use includes the registration and use of the same or similar mark based on unfair competition (Lobo & Wauran, 2021).

The application of the principle of trademark registration in Indonesia, implementing a constitutive system in Indonesia, is not an obstacle in protecting globally well-known brands in Indonesia that have not been registered. This is a consequence of the ratification of the Paris Convention and the TRIPS Agreement by Indonesia. The use of the first-to-file principle is considered to present: (1) a legal certainty for legal subjects that must be protected (in this case, the brand owner); (2) legal certainty in the evidentiary sector. This is because the evidence acknowledged in court is based on the fact of registration, namely the mark certificate; (3) Generate legal perceptions regarding who is the most entitled trademark owner, in the sense of not triggering controversy between the first registrant and the first user, because there is a difference between the first registrant and the first user (Novianti, 2017). Although the use of the first-to-file principle has the advantages described above, in the implementation sector, it can be seen that the first-to-file principle has become an obstacle in the recent registration of marks (Valerie & Horman, 2019).

Observing the reputation of a brand in society, the law should protect legal subjects who have a reputation from other parties who intend to take advantage of their success. Although this reputation does not manifest itself, the law considers it an asset of high value that needs to be protected. Through the MIG Law, it is known that the owner of a registered mark has the right to prosecute any person or business entity that has helped or taken advantage of the mark without approval. However, what is becoming an important issue now is the protection of a well-known foreign trademark holder who has dominated a good reputation in many countries but has not yet registered his trademark in Indonesia. The practice of taking advantage of the practice of getting short-cut profits or also known as “passing off” should not have happened in Indonesia and well-known brands should be protected from this action. Competitors or rival business entities do not have the opportunity to use brands, writings, packages/covers, accents, or signs that attract buyers and convince them that the products they trade are manufactured by someone else (Lindsey et al., 2013).

The protection arrangements for globally well-known brands are not explained in detail regarding their protection in Indonesia. It is emphasized that the trademark registrant who registers the mark for the first time at DJKI will become the trademark owner so that even if the famous mark registrant is not the initial owner of a well-known mark, he has the opportunity to become the owner of the famous mark in Indonesia and get the benefits. This then creates confusion and a gap between national and international mark regulation, with the condition that a globally well-known mark that has not been registered in Indonesia has the opportunity to be registered by another person who is not the original owner of the mark in Indonesia (Setyoningsih, 2021). Referring to the background studied, the main discussion in this research is how to protect well-known marks that have not been registered in Indonesia and how to prove that internationally registered marks that have not been registered in Indonesia must still be protected in Indonesia.

2. RESEARCH METHODS

In conducting research, the authors use the normative juridical method, in which research is carried out by examining problems based on principles, legal principles, theories, and doctrines put forward by experts. This type of approach is an approach based on statutory regulations, where the authors

consider that this type of approach will provide maximum results in research. This is caused by using an approach that aims to strengthen arguments and reveal meaning by interpreting existing laws and regulations, both grammatical interpretations and interpretations based on the legal system relating to trademark protection. In addition to the statutory approach (Nurhayati et al., 2021), the primary legal materials included in this research include the MIG Law, Paris Convention, and TRIPs. Meanwhile, secondary legal materials come from library materials such as books and scientific journals. All legal materials that have been collected will be analyzed qualitatively by studying legal materials or literature to obtain an overview and conclusions on the main issues studied. The results of the articles are useful to the public, especially the student environment, to be used in completing studies (Disemadi, 2022).

3. RESULTS AND DISCUSSION

3.1 Protection of Globally Famous Brands That Have Not Been Registered in Indonesia from Passing Off Actions

Trademarks are one of several types of intellectual property in Indonesia. Intellectual property, according to John Locke is a right that is attached to a person, whether tangible or not, but resulting from his intellect, is automatically attached and becomes his property (Ramli et al., 2021). Intellectual property rights are usually known as rights of intellectual ownership. Property rights over an object is an existing phenomenon that is seen as an essential need in human life (Hastuti, 2019). World Trade Property Organization (WIPO), a global forum for services, policies, information, and cooperation related to intellectual property (WIPO, 2006), classifies intellectual property in Indonesia into two scopes, namely copyright; and industrial property rights. Industrial property rights themselves are categorized into patents, industrial designs, brands, integrated circuit layout designs, and trade secrets This classification is considered necessary because there are differences between creations and findings (WIPO, 1990). The creation in question is defined as a copyright that automatically obtains protection from the first time the creation appears, even though it has not been published and has not been registered at the competent authority in Indonesia, namely the DJKI. In contrast to the findings which are interpreted as industrial property rights, they do not automatically receive protection, instead, they need to be registered with the DJKI to obtain protection.

Paris Convention defines a trademark to be a sign that serves to differentiate the source of trade products from one business entity to another business entity, in which the outlined owner holds certain exclusive rights to use the brand or derivative variations of homogeneous trade products (Atsar, 2018). Marks according to Article 1 point 1 of the MIG Law are defined as accents shown in graphic form in the form of pictures, logos, names, words, letters, numbers, and color arrangements, which can be in the form of 2 (two) or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more elements that differentiate trade products and services which are the result of a person or business entity in the business activities they carry out (Law Number 20 of 2016 concerning Marks and Geographical Indications).

The MIG Law categorizes brands, including trademarks and service marks. Trademarks are usually attached to merchandise that is transacted by one person or more in groups or business entities to differentiate them from other homogeneous products. Meanwhile, service marks apply to a service offered by one person or more in groups or business entities as a differentiator (Law Number 20 of 2016 concerning Marks and Geographical Indications). In addition to functioning as a differentiator, a brand also provides an identity for a product or service and guarantees the weight or value of the product. According to PDD Dermawan, brand functions are divided into three, including; 1) as a parameter of origin, a mark as an indication where the product originates legally attached to one business category and therefore can indicate that the product was produced professionally; 2) as a weight parameter (quality), the brand is responsible for product weight, especially prestigious products; 3) as a suggestion provider, the brand gives the impression that it will become a collector of products or services (Bafadhal, 2018). Thus, a brand can be interpreted as a label that is worn on goods or services that have their uniqueness as a differentiator and have a reputation attached to the product or service.

Marks (trademarks) based on classification by WIPO are included in industrial property rights that must be registered in advance to obtain protection in Indonesia. Protection of the mark is needed as a guarantee for the brand owner to defend his rights (Wijaya & Neltje, 2020). This is because it adheres to a constitutive principle, which means that the legal instrument that protects the mark applies after the mark is registered, and this principle is often known as the first-to-file principle (Sari & Astariyani, 2016), as stipulated in

Article 3 of the MIG Law. The result of the registration, in the form of a trademark certificate, can then be submitted as legal evidence in court if a trademark dispute occurs in the future. The very first registrant will be advantaged compared to a trademark user without trademark rights because a trademark user without trademark rights will find it difficult to prove that he is the first user because there is no certificate of his trademark as proof that he is a user and owner of the brand for the first time (Asmara et al., 2019).

The current development of the Indonesian Trademark Law is the birth of the MIG Law which replaces Law Number 15 of 2001 concerning Trademarks. In this latest law on marks, well-known marks are the reason for rejecting applications for registration of marks as stipulated in Article 21 Paragraph (1) letters b and c, which explains that applications for registration of marks may be rejected if the marks registered have elements of similarity which are principally or entirely with well-known brands owned by other parties, whether in the sale of homogeneous or non-homogeneous trade products and/or services, which have certain requirements.

In the explanation of Article 21 Paragraph (1) letter b, it is further explained that the rejection of an application which in principle or wholly has similarities with another party's well-known mark for similar goods and/or services is carried out by focusing on public knowledge regarding the mark, taking into account the reputation of the brand which is obtained from smooth and massive promotions, investment in several countries in the world by the owner and must be accompanied by proof of trademark registration in several countries. If the above criteria are deemed not met, then the Commercial Court has the authority to order the authorized agency in the mark to conduct a survey. The survey obtained can be used as support for the conclusion of whether the brand is the basis for rejection or not.

Meanwhile, a detailed elaboration of the requirements for determining a well-known mark is regulated in the Regulation of the Minister of Law and Human Rights Number 12 of 2021 concerning Amendments to the Minister of Law and Human Rights Regulation Number 67 of 2016 concerning Mark Registration based on Article 18 provides criteria for well-known marks. In Article 16 paragraph (2) letter b and letter c, the parameter of a well-known mark is assessed from the public's general knowledge of the mark in a homogeneous business sector. The public's general mentioned is a user or many users who have good relations at the most basic level to the very last level

(starting from production, advertising, distribution, to sales of trade products and/or services protected by the well-known mark mentioned. The essence of considering a well-known brand includes the level of public knowledge or recognition of the brand; the products and/or services and the acquisition of margin for the use of the mark by the owner; mastery of the market for the brand such as circulation of products and/or services in the community; brand user area scale; period of use of the mark; brand enthusiasm and promotion, including the amount of investment in introducing the brand; trademark application or trademark registration in other countries; the level of success achieved by law enforcers in dealing with brand recognition by authorized institutions; and the value embedded in the brand include the reputation and quality assurance maintained by the brand.

In discussing the protection of well-known brands globally that are not registered under the MIG Law, as explained in the provisions mentioned above, the provisions relating to well-known marks under the MIG Law are focused on the registration application process, in which a well-known mark is one of the reasons for rejecting an application. In addition, the protection provided relatively only applies to registered popular brands.

The protection of well-known marks that have not been registered has been explained in detail in the MIG Law and the Paris Convention, where each country is obliged to protect well-known marks even if they have not been registered. However, in practice, there are many incidents where well-known brands that have not been registered in Indonesia have been previously registered (scratched) by other parties who were not the original owners of the mark concerned. This action is considered not per the regulation that the state is obliged to protect well-known brands even though they have not been registered in Indonesia. Globally well-known brands that have been developed and maintained for their brand reputation/image by the original brand owner are harmed due to the actions of other parties who are not the initial owners. Trademark registration by other parties is accepted at DGIP because of the first-to-file system applied. On the one hand, registration of a well-known mark is based on a *first-to-file* system and conditions for the acceptance of an application for registration of a mark. On the other hand, the acceptance of trademark registration by DGIP causes losses to the initial owners of brands that are globally well-known.

Technological developments such as the widespread use of social media and the internet resulted in marketing and promotion known as digital marketing, where providing content that can be accessed on the internet or word of mouth marketing, relying on good resources and reviews to recommend products from one consumer to another via the internet such as blogs, YouTube, social media, etc., in this case, it makes it easier for entrepreneurs to market their products to larger markets around the world. In addition, the practicality of online shopping can make it easy for consumers to shop from entrepreneurs not only for domestic events but also globally, with just one click. Therefore, brands can easily become famous nowadays by using digital marketing (Cheung & Thadani, 2010).

The success of a brand or even a well-known brand is sometimes not proportional to the appropriateness of its brand protection. Because it is possible that a well-known mark is not registered for various reasons, not registered the mark in the state or the characteristics of the unregistered trademark are not recognized in the national law of another State. For example, the Trademark Law 1961 till the Trademark Law 2001 has not accommodated provisions that protect well-known unregistered brands. However, with the enactment of the MIG Law on Marks and Geographical Indications, it provides provisions that accommodate the protection and settlement of violations of well-known unregistered marks, namely:

1. Lawsuit for the cancellation of a registered mark
2. Trademark violation lawsuit

Regarding protection, brand protection is implemented through preventive and repressive measures. The main protection of preventive efforts is to prevent a well-known brand from being used or imitated by other parties to fulfill their interests. This preventive effort is carried out by the authorized agency by rejecting applications for trademark registration if there are indications of imitation of well-known registered marks. This effort is implemented to provide legal certainty for registered marks, both for the purpose of using the brand, brand extension, and transferring the brand. Repressive efforts are attempts to resolve trademark violations and/or disputes. The attempt to resolve disputes as regulated in the MIG Law can be carried out through litigation and non-litigation channels (Septarina & Salamiah, 2020).

Referring to article 83 MIG, efforts to resolve through litigation can be carried out by registered trademark owners by submitting the lawsuit to the Commercial Court against the defendant, who is another party who illegally (without rights) has used the brand of goods and/or services that are essentially the same or in whole for similar goods or services. Such litigation can claim for compensation or termination of all activities related to the use of the disputed mark (Law Number 20 of 2016 concerning Marks and Geographical Indications). The non-litigation way based on Article 93 of the MIG Law can be taken by registered trademark owners through arbitration or alternative dispute resolution (Law Number 20 of 2016 concerning Marks and Geographical Indications). In addition, if a brand owner receives a violation of the use of his trademark by another party, he can be investigated to seek compensation for using trademark rights without the consent of the registered trademark owner because the violation of the use of the mark will affect the economic and commercial value of the brand. This act is categorized as an unlawful act (PMH) as stated in Article 1365 of the Civil Code, which explains for any loss caused by a person due to his own mistakes against another person, the person is obliged to provide compensation for the mistakes that have been caused (Sanjaya & Rudy, 2018).

In Article 76 Paragraph (1) of the MIG Law, it is explained that a claim for cancellation of a registered Mark can be filed by a concerned party to the authorities based on the provisions stipulated in Article 20 (regarding the criteria for a mark that cannot be registered) and/or Article 21 (regarding Marks that are similar in principle or whole as a basis for rejecting a Mark application) to the Commercial Court. Furthermore, in Article 76 Paragraph (2) it is explained that filing a lawsuit from an unregistered mark owner can be filed after an application has been made to the Minister. In the explanation, it is further explained that what is meant by “unregistered trademark” is described as an owner who in good faith, does not register his mark.

Trademark violation lawsuits it is regulated in Article 83 of the MIG Law, with the provision that based on a court decision, owners of well-known brands can file lawsuits against other parties which are considered to have elements of equality as previously explained as the claims for compensation and/or termination of all actions considered related to the use of the mark. Article 83 Paragraph (2) MIG explains that the right to file a civil lawsuit based on an act of unfair competition can be exercised by the owner of a well-known mark to

provide legal protection for a well-known mark even though the mark has not been registered. As regulated in Article 21 Paragraph (1) regarding the definition of equality.

3.2 Proof of an International Registered Mark that has not been registered in Indonesia regarding the Protection of Well-Known Marks in Indonesia

Indonesia's entry as a member of the WTO makes Indonesia have to ratify the products produced by the WTO. This is often referred to as a consequence arising from the joining of a country to international organizations. One of the consequences is the enactment of Law Number 7 of 1994 concerning the Ratification of the Agreement Establishing the World Trade Organization, whose scope includes WTO provisions, including the concept of IPR contained in TRIPs (Azed, 2006).

The advantage of being a TRIPs member country is that there is an obligation to provide treatment to every citizen of a country from other members. Especially in the intellectual property rights sector, citizens of other members must be treated as individuals or legal entities that meet the requirements to obtain protection. This is as regulated and determined based on the 1967 Paris Convention.

Indonesia has also officially become a participant of the Paris Convention since 1979 through Presidential Decree Number 24 of 1979, which has been renewed until now through Presidential Decree Number 15 of 1997. The Paris Convention, which was ratified by Indonesia, has the principle of national treatment for every union-participating country. This principle means the provision of equal legal protection to the colors of member countries by assuming that citizens of member countries are citizens themselves. As a concrete form of implementing the provisions of the Paris Convention, it is necessary to have ratification by member countries and actions from the governments of the Union countries that reflect the application of the contents of the provisions of the Paris Convention (Azed, 2006).

TRIPs also confirm that every trademark owner who has been registered by an authorized institution has exclusive rights. Exclusive rights are granted to prevent third parties who do not have permission for trademarks to carry out all trading activities related to trademarks that have been registered. This is based on the number of passing-off actions (plagiarism, passing-off, and cheating) in circulation.

As previously explained, regarding the criteria for a well-known mark, the MIG Law regulates it in the Explanation of Article 21 paragraph (1) letter b. This is strengthened by seeing that Indonesia as a member country of the Paris Convention, should also participate in the convention. Based on Article 6bis Paris Convention, each member country is required to take action ex-officio with the condition that there is a statutory permitting regulation. In addition, action can also be taken by member countries based on a request from a party that has an interest in rejecting and canceling mark registration within an indefinite period as long as it is based on the principle of bad faith. This is done to protect the mark that has been registered with the competent authorities of a country where the mark was created from an imitation that confuses consumers. Then in Article 41 TRIPs, it is stated that member countries should stipulate IPR enforcement procedures that have been regulated in this agreement into national law to provide effective action against IPR violators (Riwanto, 2020).

The statement that the holder of rights to a well-known mark also receives protection in the state even though he has not registered the mark is also confirmed by the Intellectual Property Rights expert, Prof. Dr. Eddy Damian, S.H., believes that if the certificate holder is a foreigner who has received a certificate abroad, then he can also market his goods in Indonesia. This is because Indonesia as a member of the community of nations (International Community), has signed various international agreements that regulate, among other things, free trade between fellow members of international agreements such as the Paris Convention for the Protection of Industrial Property and the Trademark Law Treaty which Indonesia has ratified through a Decree. Presidential Decree Number 15 of 1997 and Presidential Decree Number 17 of 1997 (Sitepu, 2015).

The problem in the lawsuit for a well-known Internationally Registered Mark registered by a party that is not the original owner/pioneer in Indonesia regarding the Protection of a Well-Known Mark in Indonesia lies in the problem of proof and the judge's consideration of the lawsuit. The intended proof as written in Article 18 of Permenkumham Number 67 of 2016, can be described as follows:

- a. Public acknowledgment and level of knowledge about business marks that are considered to have links with well-known brands;

- b. Total sales of goods and/or services along with profits derived from the use of said mark;
- c. The relationship between the circulation of goods and/or services in society and the market share controlled by the mark;
- d. The territorial coverage of the use of the mark;
- e. Term of use of the mark;
- f. Investment value that has been invested in the brand, including intensity and promotion, etc.;
- g. Mark Registration or application for Mark registration in other countries;
- h. How high the level of success that can be achieved by law enforcement in dealing with brand recognition by authorized institutions;
- i. The value embedded in the brand includes the reputation and quality assurance maintained by the brand.

In addition, there are several important points in the judge's consideration of a well-known brand case that is proposed as a problem. As in the case of the French Pierre Cardin Mark against Pierre Cardin Indonesia, there is a dissenting opinion from the Supreme Court Judge regarding the protection of a well-known mark that needs to be highlighted namely, on the one hand, the Supreme Court Judge thinks that based on the first-to-file principle and the principle of good faith Pierre Cardin Indonesia first registered the mark in Indonesia and at that time the mark was never registered and known and there was no resemblance or similarity with the existing mark at that time so passing off the mark owned by Pierre Cardin France did not qualify as having bad faith, From an ethical and moral point of view, the registration of the Pierre Cardin Indonesia mark cannot be justified because the trademark registration by Pierre Cardin Indonesia has imitated or plagiarized using the name "Pierre Cardin" which was previously registered in its country of origin and is well-known in various countries. However, in the end, Pierre Cardin France was still defeated at the trial by making a majority vote decision by the Panel of Judges.

Based on this decision, the main problem that arises regarding the protection of well-known brands in Indonesia is the ineffectiveness of protecting well-known brands other than registering their brands in Indonesia, there is only an alternative to filing a lawsuit. So that in cases of well-known brands, a well-known brand owner risks losing in court even though he has provided valid evidence that he is the original owner/pioneer of the famous mark. An important point that needs to be reviewed in the protection of well-

known marks in Indonesia is the definition of the well-known mark itself, and details regarding well-known marks which are not limited to paying attention to “general public knowledge about well-known brands”, “brand reputation in several countries in the world” and “trademark registration in several other countries”. The lack of a detailed explanation as above will cause the struggle for a well-known brand by the original owner to be disadvantaged in court in Indonesia. Reviewing cases similar to Pierre Cardin, even though their validity has been proven by the original owner/pioneer of a well-known brand, the original owner/pioneer of a well-known brand in case of a well-known brand can still be harmed if they lose a trial in court if the court decision is not in favor of the owner of the famous mark due to the first-to-file principal without any assessment of the bad faith of the registrant of the Pierre Cardin Indonesia brand.

4. CONCLUSION

Based on the analysis carried out, the authors found a common thread as a conclusion from this research. The author concludes that the enactment of Article 83 Paragraph (2) of the MIG Law is not an exception to the constitutive system adopted in protecting Indonesian brands, this is due to the reason that owners of unregistered famous or well-known brands cannot immediately file a civil lawsuit, for reasons of a civil lawsuit for unregistered famous or well-known brands requires a court decision, by all means as referred to in Article 76 paragraph (2) as a lawsuit for trademark cancellation. However, to be able to file a lawsuit for cancellation, a brand that is not registered must apply for registration first. Therefore, the enactment of Article 83 (2) does not protect brand indications other than the indications regulated in Article 1 paragraph (1) of the MIG Law. Furthermore, the argument that a lawsuit can only be filed after the lawsuit for cancellation has started indicates that Article 83 (2) only covers violations of the transfer of well-known marks that are not registered through third-party registration. Meanwhile, the violation of passing off by using a well-known brand name that is not registered without legal rights is not covered in this article. In addition, the enactment of Article 83 (2) also does not fully accommodate passing off lawsuits in Indonesia. Due to varied interpretations of a well-known mark definition in Indonesia and the polemic of jurisprudential considerations on the first-to-file principle that may have missed the registration reference based on the good faith or bad faith of the

applicant which caused the well-known mark recognized and registered by who was not the original owner/initial pioneer of the mark.

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