



## Legal Protection for Registered Trademark Holders from Passing Off Actions

Kurniawan; Lalu Wira Pria Suhartana; Edwardus Bayo Sili

Lecture of Law Faculty Mataram University, Indonesia

<http://dx.doi.org/10.18415/ijmmu.v11i11.6235>

---

### **Abstract**

The purpose of this study is to determine the legal protection efforts for registered brands from passing off actions. Intellectual Property Rights are rights that arise or are born due to the intellectual ability of a person in the fields of art, literature and science. Intellectual Property Rights can generally be grouped into 2 (two) parts, namely Copyright and Industrial Property Rights which consist of: Patents, Trademarks, Industrial Designs, Integrated Circuit Layout Designs, Trade Secrets and Plant Varieties. Brands as part of intellectual property rights are rampant in the use of registered brands without permission from their owners or rights holders, usually they piggyback or piggyback on existing and well-known registered brands. This action is called Passing Off, which is an instant action to take advantage by piggybacking or imitating brands owned by other parties. Efforts to protect registered trademark owners from passing off actions can be done through 2 (two) efforts, namely: Preventive legal efforts are efforts made on actions that nature prevention. This is intended for reduce the chances of occurrence violation of the law against brand registered trade. This preventive legal effort emphasized in the supervision of the use of a brand, protection of exclusive rights holder right on brand trade which has been registered. Repressive legal efforts are efforts in the form of action taken by the brand owner to resolve an incident or event that has occurred. Occurs on the registered trademark. Repressive legal protection is provided to registered trademark owners if there is a violation of the registered trademark. The role of the government and law enforcement agencies such as the Courts, Police and Prosecutors is very necessary in order to provide protection to registered brand owners from passing off actions.

**Keywords:** *Intellectual Property; Brand; Passing Off*

### **Introduction**

Intellectual Property Rights are private rights for someone who produces an intellectual work. Basically, Intellectual Property Rights (IPR) are closely related to other legal aspects, such as technological aspects, economic aspects, and art. <sup>1</sup>Intellectual Property Rights arise or are born because of

---

<sup>1</sup> Krisnani Setowati, Efridani, dkk, Hak Kekayaan Intelektual Dan Tantangan Implementasinya Di Perguruan Tinggi, Intellectual Property Rights Office, Bogor Agricultural University, Bogor, 2005, p. 2.

the intellectuality of a person as the core or object of its regulation, so understanding this right is basically an understanding of the right to property that arises or is born from human intellectuality.<sup>2</sup>

Intellectual Property Rights can generally be grouped into 2 (two) parts, namely Copyright and Industrial Property Rights which consist of: Patents, Trademarks, Industrial Designs, Integrated Circuit Layout Designs, Trade Secrets and Plant Varieties.

As part of intellectual property rights, trademark rules have existed in Indonesia since the 1840s. At that time, the Dutch Colonial government enacted the Trademark Law (1885), Patents (1910), and also the Copyright Law (1912). Then since Indonesia's independence, the Government enacted Law No. 21 of 1961 concerning Company Trademarks and Trademarks as the first Indonesian Law in the field of Intellectual Property Rights.

On August 28, 1992, the Indonesian Government enacted Law No. 19 of 1992 concerning Trademarks (Trademark Law 1992), which came into effect on April 1, 1993. The 1992 Trademark Law replaced the 1961 Trademark Law. On April 15, 1994, the Indonesian Government signed *the Final Act Embodying the Result of the Uruguay Round of Multilateral Trade Negotiations*, which included *the Agreement on Trade Related Aspects of Intellectual Property Rights* (TRIPS Agreement). In an effort to align all laws and regulations in the field of IP with the TRIPS Agreement, in 2001 the Indonesian Government enacted Law No. 15 of 2001 concerning Trademarks. Over time and the many changes to laws and regulations by the House of Representatives (DPR) starting from the Law, until finally the latest Trademark Law is Law No. 20 of 2016 concerning Trademarks and Geographical Indications<sup>3</sup>

The problem that often occurs today is the rampant use of registered or well-known brands without permission from the owner, usually they piggyback or piggyback on existing and well-known registered brands that have a good reputation first. This action is called *Passing Off*, which is an instant action to take advantage by piggybacking or imitating the property of another party.<sup>4</sup> On this basis, the formulation of the problem raised is how to make efforts to protect holder brand registered trade from *passing off action*?

## Discussion

### A. Brand Overview

#### 1. Understanding Brands

In general, a product of goods and services made by a person or legal entity is given a certain mark, which functions as a differentiator from other similar products of goods and services. The certain mark here is an identification mark for the product of goods and services concerned, which is usually called a brand. Its form can be a picture, name, word, letters, numbers, color arrangement or a combination of these elements.<sup>5</sup>

The definition of a brand according to the Big Indonesian Dictionary, a brand is a sign worn by entrepreneurs (factories, manufacturers and so on) on goods produced as an identifier, a stamp (mark) that becomes an identifier to state a name and so on. According to Mollengraaf, a brand is “with which a

<sup>2</sup> Farida Hasyim, *Hukum Dagang*, Sinar Grafika, Jakarta, 2009, p. 184.

<sup>3</sup> Intellectual Property Rights and Their Benefits for Research and Development Institutions, Directorate General of Intellectual Property, Ministry of Law and Human Rights, 2016, p. 1.

<sup>4</sup> Muhammad Djumhana and R Djubaedilah, *Hak Kekayaan Intelektual, Sejarah, Teori dan Praktiknya di Indonesia*, Publisher Citra Aditya Bakti, Bandung, 2003. p. 265 (hereinafter referred to as Muhammad Djumhana and R Djubaedilah I)

<sup>5</sup> Rachmadi Usman, *Hukum Hak Atas Kekayaan Intelektual: Perlindungan dan Dimensi ukumnya di Indonesia*, PT Alumni, Bandung, 2003, p. 320. 25 Hery Firmansyah, *Legal Protection of Trademarks*, Pustaka Yustisia, Yogyakarta, 2011, p. 33.

certain item is personalized to indicate the origin of the goods and guarantee its quality so that it can be compared with similar goods made and traded by others”<sup>6</sup>

Brand as a part from Right Riches Intellectual (HKI) is a sign which attached on goods and/or service which produced or traded by a company aiming as differentiating similar goods and/or services produced or traded by company other.

A brand is something (an image or name) that can be used to identify a product or company in the market. Entrepreneurs usually try to prevent others from using their brands because by using brands, traders gain a good reputation and trust from consumers and can building relationships between reputations with the brand that the company has used regularly. All of the above certainly requires sacrifice of time, energy, and money.<sup>7</sup>

According to Harsono Adisumarto<sup>8</sup> define brand is an identification mark that distinguishes one person's property from another owned by someone else , such as in the ownership of livestock by giving a stamp on the back of the cow which is then released in the grazing area together with the wide. A stamp like this is indeed an identification mark for indicating that the animal in question belongs to a particular person. Usually, to distinguish a mark or brand, the initials of the name are used. owner Alone as sign distinction.

Whereas according to Prof. Molengraaf state that “brand is with where personalize it A goods certain, for show origin goods, and guarantee the quality so that can have compared to similar goods manufactured and tradedby another person or company”. HMN Purwo Sutjipto is of the opinion that “A brand can be defined as a sign by which an object is identified. Certain in personalize so that can differentiated with object other Whichs e types “<sup>9</sup>

Understanding brand Also there is in agreement TRIPs Which set up inChapter 15 paragraph (1) TRIPs is as following:

*“Any sign or any combination of signs, capable of distinguishing, the goods of services of undertakings from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numeral, figurative elements and combination of such signs, shall be eligible for registration as trademark. Where signs are not inherently capable of distinguishing the relevant goods or services, members May make registrabilty depends on distinctiveness acquired through use. Members May require, US a condition of registration, that signs be visually perceptible.”*

It means:

*“Every sign or combination from signs Which can distinguish goods and services from other businesses, can become a trademark. Signs the, specifically words including Name personal, letter, figures, figurative elements and combinations of these signs, are entitled for registered as brand trade. If sign No in a way inherentcapable differentiate goods or service Which relevant, member can make registration depends on peculiarity Which obtained through use. Member Possible need, as condition registration, that sign can seen in a way visual.”*

According to Article 1 point 1 of Law No. 15 of 2001 concerning Trademarks (UUM), a trademark is defined as a sign in the form of a picture, name, word, letters, numbers, color arrangement or

<sup>6</sup> Muhammad Djumhana and R. Djubaedilah IV, Hak Milik Intelektual, Second Edition, PT. Citra Aditya Bakti, Bandung, 2003, p.121 (hereinafter referred to as Muhammad Djumhana and R Djubaedilah II)

<sup>7</sup> Team Lindsey et al, Hak Kekayaan Intelektual, (PT. Alumni, Bandung 2011, p. 131

<sup>8</sup> Harsono Mr. Adisumarto, Hak Milik Perindustrian, Academics Pressindo, Jakarta, 1990 .p . 44.

<sup>9</sup> Muhammad Djumhana & R. Djubaidillah I, Op.cit, p. 121.

combination of these elements which have distinguishing power and are used in the trading of goods and services.

Meanwhile, based on Article 1 paragraph (1) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, the Definition of a Trademark is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by individuals or legal entities in the trading of goods and/or services. Trademarks as human intellectual works that are closely related to economic and trade activities play a very important role. The main function of a brand is to distinguish similar goods or services produced by other companies, so that brands are said to have a differentiating function.<sup>10</sup>

The definition of a trademark according to Constitution Number 20 Year 2016 Chapter 1 (Article 2) is a brand used on goods traded by one person or several people together or a legal entity to differentiate them from other similar services.

According to M. Djumhan a and R. Djubaedillah, a brand must contain the following elements, namely:<sup>11</sup>

- a. Is a sign on goods or services (elements, images, names, words, letters, numbers, color arrangements, or a combination of these elements);
- b. Has a differentiating function (distinctive, distinguish);
- c. Does not fulfill elements that are contrary to morality and public order;
- d. Not in the public domain;
- e. It does not constitute information or relate to the goods or services for which registration is requested.

## 2. Types of Brands

Based on the business object, there are 3 (three) types of brands. stated in Article 1 of Law Number 20 of 2016 concerning Brand and Indication Geographically, namely:

a. article 1 Number 2 Law Brand, state:

*“Brand Trade, is Brand Which used on goods Which traded by a person or several people together The same or body law for differentiate with goods similar other. “*

Here the brand in its use is attached to the goods produced in question, and provides a characteristic or sign to distinguish it from other goods produced. We can see this as a trademark on the Jogja batik brand, the Pekalongan batik brand, and so on.

b. Chapter 1 Number 3 Law Brand, state:

*“Brand Service, is Brand Which used on service Which traded by a person or several people together the same or body law for differentiate with service similar other.”*

This brand is used for the services concerned, for example salon services, hotel services, consulting services and so on which are used in business activities such as services in LIA educational institutions and others.

<sup>10</sup> Amriani, Nurmaningsih, MEDIASI: Aternatif Penyelesaian Sengketa di Pengadilan, Jakarta, PT. Raja Grafindo Persada, 2012, p. 12.

<sup>11</sup> M. Djumhana and R. Djubaedillah, I. *Op.cit* , p.158.

c. Chapter 1 Number 4 Law Brand, state:

*“Collective Marks are Marks used on goods and/or service with characteristics Which The same about characteristic, characteristics general, and quality goods or services and their supervision which will be traded by a number of person or body law in a way together for differentiate with goods and or service similar other.”*

Collective Marks are used on goods and/or services with the same characteristics that are traded by several people or legal entities together to differentiate them from other similar goods and/or services.<sup>12</sup>

### 3. Registered Trademark Protection

Article 1 number 5 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications explains that after a trademark is declared accepted as a registered trademark, Thus was born the “Right to a Trademark”, namely an exclusive right granted by the state to the owner of a registered Trademark for a certain period of time by using the trademark themselves or giving permission to another party to use it.<sup>13</sup>

The history of brand protection in Indonesia adopts the *Declarative System* and the *Compulsory System. Constitutive*. Law No. 21 of 1961 concerning Company Marks and Trademarks, adopt a declaration or announcement protection system or *Declarative System*. While the Law after the 1961 Trademark uses a registration protection system or *Stelsel Constitutive*. Matter This can have interpreted that registration granting rights to a brand. The law grants rights to a brand that create brand the referred to as a user First, characteristic from registration only provides a legal assumption that the registered product or service recognized as the first user of the brand in Indonesia. If someone else can give proof Which Enough strong so right from registrant First will become weak from the third party. That is what will be recognized by the law that entitled on holder right brand.

Law No. 20 of 2016 concerning Trademarks and Geographical Indications states that trademark rights adhere to the principle of protection *First to File* with meaning that which get protection is the first party to register the brand. Before do trademark registration, parties who will register a trademark with the Directorate General of Intellectual Property (Dirjen KI) must search or browse *the database* first on the official website of the Directorate General KI so that for applicant registrant brand Can have description general moreover formerly and understand what the brand criteria are which can have registered in Director General of Intellectual Property.

The trademark registration procedure is regulated in Chapter III of the Law. No. 20 of 2016 concerning Trademarks and Geographical Indications, part one concerning the requirements and order how to register a trademark (Chapter 4 to Article 8 Law on Trademarks and Geographical Indications). The trademark registration process is as follows:

1. The applicant or his/her attorney fills in and signs the registration application form, attaches, **at least**, proof of payment documents, a statement of brand ownership, and brand label and submits it to the Minister of Law and Human Rights (“Menkumham”);
2. The trademark registration application that has been received by the Minister of Law and Human Rights is then checked for complete formalities;
3. If there are any deficiencies in the completeness of the requirements, then within a period of 30 working days from the date of receipt of the application, the applicant or his/her attorney will be

<sup>12</sup> Gautama Sudargo, Segi-segi Hak Milik Intelektual, Alumni Bandung, 1990. Page 1

<sup>13</sup> <https://www.Hukumonline.com/klinik/a/perindungan-hak-brand--ini-jual-mendapathkan-cl4430/>

given time to complete them within a period of 2 months from the date of sending the notification letter to complete the requirements;

4. If it is not completed by the time period, the application is considered withdrawn;
5. Applications that meet the minimum requirements will be given a receipt date and within a maximum of 15 working days from the receipt date, the trademark application will enter the announcement stage in the official trademark news;
6. The trademark application enters **the announcement stage for 2 months**, and each party can submit a written objection/opposition to the Minister of Law and Human Rights regarding the application accompanied by the reasons;
7. The reason is that the trademark requested for registration is a trademark that according to the MIG Law cannot be registered or must be rejected. Within 14 working days from the date of receipt of the objection, a copy of the objection is sent to the applicant or his attorney;
8. If there is **an objection/opposition**, the applicant or his/her attorney has the right to **submit a rebuttal to the objection no later than 2 months** from the date of sending a copy of the objection from the Minister of Law and Human Rights.

#### 4. Sanctions for Parties Using Registered Trademarks Without Permission

Legal protection applies to intellectual property rights Already registered proven with certificate registration. Protection law in progress during term time Which determined according to field and its classification. If person want to enjoy benefiteconomic rights of other people's intellectual property rights, he is obliged to obtain permission from the authorized person. Granting of trademark rights protection, only given to brand owners whose brands have been registered only. Trademark protection is granted when a violation occurs trademarks carried out by parties who do not have rights to them a The duration of protection for a brand is 10 (ten) years and can be extended.

If it was proven that someone committed a violation right riches intellectual, so offender must in law, Good in a way criminaland also in a way civil.<sup>14</sup>

Protection of intellectual property rights is guaranteed in Article 21 of the Trademark Law. Year 2016 about Brand and Indications Geographical that is:

1. Application must have rejected Director General KI if brand the:
  - a) have similarities in principle or in their entirety with a brand owned by another party that has been registered for more than formerly for goods and/or service Which similar
  - b) have equality on the main thing is or the whole thing with brand Which Already famous
  - c) have equality on the main thing is or the whole thing with indication geographical Which Already known.
2. The provisions as referred to in paragraph (1) letter b mayalso applies to goods and/or services that are not similar as long as it meets certain requirements that will be set more continue with Regulation Government.
3. The application must also be rejected by the Director General of Intellectual Property if the brand the:
  - a) Is or resembles the name of a famous person, photo, or the name of a legal entity owned by another person, except on agreement written from who is entitled.
  - b) Is an imitation or resembles a name or abbreviation Name, flag, symbol or symbol or emblem

<sup>14</sup> Hery Mr. Firmansyah, *Perlindungan Hukum Terhadap Merek Panduan Memahami Dasar Hukum Penggunaan Dan Perlindungan Merek*, PT. Book Exciting, Yogyakarta, 2011, p. 12.

countries or national or international institutions, except for agreement written from party Which authorized.

- c) Is an imitation or resembles a mark or stamp or official stamp used by a country or institution government, except on agreement written from party Which authorized.

Law No. 20 Year 2016 about Brand and Indication Geographical Also has provided device provision criminal law Which serves to protect brand owners and consumers from the fraudulent actions of counterfeiters/imitators Which own objective negative that is take profit in on loss brand owners and consumers by falsifying/imitating traded on the market. Punishment rewards which will be charged to for counterfeiter the can in the form of sanctions criminal prison, criminal imprisonment and fines.

The imposition of legal sanctions is part of the effort to provide legal protection for legitimate brand owners, if the brand has been registered.

Further details regarding this legal protection can be seen in Articles 100 - 102 of Law No. 20 of 2016 concerning Brands and Indication Geographically, it states as follows:

Chapter 100 MIG Law, state:

- (1) Every person Which with without right use Brand Which the same in its entirety as the registered trademark of the other party other for goods and/or service similar Which produced and/or traded, convicted with criminal prison most long 5 (five) year and/or criminal fine most Lots Rp2,000,000,000.00 (two billion rupiah).
- (2) Every person Which with without right use Brand Which have equality on the main thing is with Brand registered owned by party other for goods and/or service similar Which produced and/or traded, shall be punished with criminal penalties a maximum imprisonment of 4 (four) years and/or a maximum fine Lots Rp2,000,000,000.00 (two billion rupiah).
- (3) Every person Which violate provision as meant on paragraph (1) And paragraph (2), Which type the goods result in disturbance health, disturbance environment life, and/or death of a human being, shall be punished by imprisonment imprisonment for a maximum of 10 (ten) years and/or a maximum fine Lots Rp5,000,000,000.00 (five hundred million rupiahs) billion rupiah).

Chapter 101 MIG Law, state:

- (1) Every person Which with without right use sign Which have equality on overall with Indication Geographical property of another party for goods and/or products that The same or similar with goods and/or product Which registered, convicted with criminal prison most long 4 (four) year and/or fine most Lots Rp2,000,000,000.00 (two billion rupiah).
- (2) Every person Which with without right use sign Which have equality on the main thing is with Indication Geographical rights of other parties for goods and/or products that The same or similar with goods and/or product Which registered, convicted with criminal prison most long 4 (four) year and/or fine most Lots Rp2,000,000,000.00 (two billion rupiah).

Chapter 102, the MIG Act states:

- (1) Any person who trades goods and/or services and/or products that are known or reasonably suspected to be known that goods and/or service and/or product the is results act criminal as meant in Article 100 and Article 101 are punishable by imprisonment. most long 1 (One) year or fine most Lots Rp200,000,000.00 (two hundred million rupiah).

The crime of Trademark Imitation as regulated in Article 100 – Article 102 of the Trademark Law is a Complaint Offense, not a offense normal, matter where Also has stated firm in chapter 103 Law-Invite No. 20 Year 2016 about Brand And Indication Geographical, so that in criminal cases of trademark

imitation, they must be reported in a way direct by party Which feel disadvantaged or owner brand or his power.

## B. Overview of *Passing Off*

### 1. Definition of *Passing off*

Reputation or good faith in the business world is seen as the key to success. Or failure from a company. Lots perpetrator effort to fight for get and guard reputation they with Keeping business actors spending large amounts of money on advertising and building the reputation of new products or maintaining the reputation of existing products.

*Passing off* is an action that tries to gain profit through road shortcut with all type method and pretext with violate business ethics, moral norms, or the law. This action usually occurs by piggybacking by imitating or making similarities to the property of others who already have a good reputation ( good will )<sup>15</sup>.

The definition of passing off is also found in the Black's Law Dictionary, namely:<sup>16</sup>

*“The act or an instance of falsely representing one's own product as that of another in an attempt to deceive potential buyers. Passing off is actionable in tort under the law of unfair competition. It may also be actionable as trademark infringement”*,

The free translation of *passing off* is an act or a false thing that displays its own product as someone else's product in an attempt to deceive potential buyers. Passing off is followed up in an unlawful act under unfair competition law. It can also be followed up as a trademark infringement.)

### 2. *Passing off* Settings

*Passing off* arrangements arise when a reputable business does not have a trademark or is unable to register the trademark. its trade (for example because its brand is too descriptive or what is imitated is not included in the things protected by trademark law) but requires legal protection from attempts by other parties to copy reputation the effort and *passing law off* This aims to protect both consumers and business actors from business practices carried out by other parties to gain profits in ways that are detrimental or endanger the reputation of the original business actor.<sup>17</sup> Anglo Saxon countries even have a doctrine that has been embodied as a legal institution that regulates the protection of Trademarks from violations. The violations in question are *Passing Off and Dilution*.<sup>18</sup>

An act of piggybacking on one's reputation is said to be an act oppose law in countries Which adhere to (*Common system Law*) like Australia, English, Malaysia, American Union and others. In countries the, *passing off* develop as a form of fraudulent competitive practice in trade or commerce.<sup>19</sup>

There is trend Which imitated No part or sign brand Which registered but parts certain from overall representation of brands and products that are not yet registered or of course No can listed as brand but real-realhave Power differentiator or at least can empowered differentiate products in trade.

<sup>15</sup> Team Lindsey et al, Op.cit , p. 152- 153

<sup>16</sup> Bryan A. Garner, Black's Law Dictionary. Eighth Edition. (St. Paul. Minn.: West Publishing Co. 2004). p. 1115.

<sup>17</sup> Muhammad Djumhana and R. Djubaedillah I, Op. cit , p. 171

<sup>18</sup> Anne Gunawati, *Perlindungan Merek Terkenal Barang dan Jasa Tidak Sejenis terhadap Persaingan Usaha Tidak Sehat*, Alumni Publisher, Bandung, 2015, p. 235

<sup>19</sup> Soedjono Dirdjosisworo, *Antisipasi Terhadap Bisnis Curang (Pengalaman Negara Maju dalam Perlindungan Hak Kekayaan Intelektual dan Pengaturan E-Commerce serta Penyesuaian Undang-Undang HKI Indonesia*, CV Utomo, p. 5



Scope protection brand No let go from Contents terms and conditions the law. From definition brand And system law brand Which adopted as well as principles Which contained seen And become guidelines boundaries protection brand success *sort of passing off* or (lawsuit) passing off ) must fulfil three element base hitchhiking reputation so that passing off can be used are:<sup>20</sup>

1. The existence of a reputation for a business actor, namely if a business actor has a good business reputation in the eyes of the public and also his business is well known to the public;
2. There is misrepresentation in this case regarding the brand owned by the business actor, so if another business actor uses the same brand, the public will be easily misled or confused in choosing the desired product;
3. There are losses that arise due to the act of piggybacking or freeloading carried out by entrepreneurs who in bad faith use a brand that is similar or identical to a well-known brand, resulting in the public making a mistake in choosing the product (*public misleading*).

In order to protect their property in the “*common law*” system, the party who feels disadvantaged usually does what is called an “*action of passing off* “. In the context of Trademark law, “action of passing off” is to protect a good name (business *goodwill*). So, a person may not piggyback on the fame of the Trademark, the good name, and the reputation of another party so that the public will be protected from fraudulent acts. Another requirement in carrying out the action of “passing off” regarding Trademarks is that the Trademark is used in the same type of class of goods.<sup>21</sup>

In Trademark Law Number 20 of 2016, the provisions regarding Passing Off are regulated in Article 83 paragraph (2) which states that the owner of a Famous Trademark can file a civil lawsuit against fraudulent acts against the Famous Trademark.

### C. Efforts for Protect Holder Brand Registered and Well-known Trade

The existence of law enforcement can be seen as the process of making legal desires a reality. Legal desires are the thoughts of the legislators formulated in legal regulations.

Law enforcement requires legal institutions such as judges, services, advocates, and the police. These institutions are classical elements in realizing the objectives of law. Institutions require organizations such as: the prosecutor's office, the police, the community, and the legal regulatory body.

According to Sajipto Raharjo, law enforcement in Indonesia is full of complexity and intricacy. One of the complexities and intricacies can be stated as “law enforcement is pushed into the slow lane”.<sup>22</sup>

In frame for more give certainty and legal protection to owner brand registered trade, required the following efforts:

#### 1. Effort Preventive

Preventive efforts are efforts that lead to preventive actions. The aim is to minimize the chances of trademark infringement occurring. This step emphasizes supervision usage brand, protection to right exclusive rights holders of registered trademarks and recommendations to trademark owners to register their trademarks so that their rights are protected.

<sup>20</sup> Effendi Hasibuan, *Perlindungan Merek Studi Mengenai Putusan Pengadilan Indonesia dan Amerika Serikat*, FH UI, Jakarta, 2013, p. 39

<sup>21</sup> Muhamad Djumhana, R.Djubaedillah, 2014, *Hak Milik Intelektual (Sejarah, Teori dan Praktiknya di Indonesia)*, Citra Aditya Bakti, Bandung, 2014, p. 282

<sup>22</sup> Sajipto Raharjo in David Shah, *Hukum dan Keadilan (Aspek Nasional dan Internasional)*, PT. Rajagrafindo Persada, Jakarta, 2013, p. 227

For foreign brands, rights holders receive special treatment to submit trademark registration applications using priority rights which must be submitted within a maximum of 6 (six) months from the date of receipt of the registration application. brand Which First time accepted Country other which is a member of the Paris Convention on the Protection of Industrial Property (*Paris Convention for the Protection of Industrial Property*) or member of the Agreement Establishing *the World Trade Organization*.

With the enactment of Trademark Law Number 20 of 2016 concerning Trademarks and Geographical Indications, it is hoped that it will provide more legal protection for rights holders. on brand registered or well-known Actually No There is obligation for a person to register a brand that he owns. Even if the brand which owned the has in register in Directorate Brand, so will get protection law.

In this regard, Article 20 of the Trademark Law stipulates that a trademark cannot be registered if:

- a. Contrary to state ideology, laws and regulations, morality, religion, decency, public order;
- b. The same as, related to, or only mentions the goods and/or services for which registration is requested;
- c. According to elements that can mislead the public about the origin, quality, type, size, kind, purpose of use of goods and/or services for which registration is requested or which are the name protected plant varieties for similar goods and/or services;
- d. Contains information that does not correspond to the quality, benefits or properties of the goods and/or services produced;
- e. No own Power differentiator; and/or
- f. It is Name general and/or symbol owned by general.

Article 21 adds that:

“The application must be rejected by the Directorate General if the mark is substantially or completely similar to a well-known mark belonging to another party for similar goods and/or services. Is an imitation or resembles a name or abbreviation of a name, flag, symbol or symbol the emblem of a country, or national or international institution, except with the written consent of the competent authority.”

## 2.Repressive Efforts

Repressive efforts are efforts made to resolve or overcome an event or incident that has occurred. Repressive legal protection is provided if a trademark violation has occurred. This means that the role of the courts and other law enforcement agencies such as the police, civil servants (PPNS) and the prosecutor's office is very much needed.

Enforcement right on brand famous foreign although not registered yet to receive exception for to obtain protection law against violations of trademark rights, both in lawsuits for cancellation and criminal lawsuits through law enforcement officers.

Lawsuit cancellation brand submitted after owner registered trademarks or foreign famous trademarks apply for trademark registration to the Directorate General. In addition, if it turns out that a registered trademark has similarities in principle or in its entirety with a famous trademark; the Directorate General will reject the extension of the trademark registration.

The imposition of clear and firm sanctions for perpetrators of violations of registered trademarks in accordance with the applicable Trademark Law must also be carried out consistently so that more give guarantees legal certainty for holders of rights to registered trademarks and holders of well-known trademarks in Indonesia.

## Conclusion

Efforts to protect registered trademark owners from *passing off actions* can be made through 2 (two) efforts, namely:

### 1. Preventive Legal Efforts

Preventive legal efforts are efforts made in response to actions that nature prevention. This is intended for reduce the chances of occurrence violation of the law against brand registered trade. This preventive legal effort emphasized in the supervision of the use of a brand, protection of exclusive rights holder right on brand trade which has been registered.

### 2. Repressive Legal Efforts

Repressive legal efforts are efforts in the form of action taken by the brand owner to resolve an incident or event that has occurred. occurs on the registered trademark. Repressive legal protection is provided to registered trademark owners if there is a violation of the registered trademark. The role of the government and law enforcement agencies such as the Courts, Police and Prosecutors is very necessary in order to provide protection to registered brand owners from passing off actions.

## References

- Amriani, Nurnaningsih, 2012, *MEDIATION: An Alternative to Dispute Resolution in Court*, PT. Raja Grafindo Persada, Jakarta.
- Anne Gunawati, 2015, *Protection of Famous Trademarks for Dissimilar Goods and Services against Unfair Business Competition*, Alumni Publisher, Bandung.
- Bryan A. Garner, 2004, *Black's Law Dictionary*. Eighth Edition. (St. Paul. Minn.: West Publishing Co.).
- David Shah ,2013, *Law and Justice (Aspect National and International)*, PT.
- Effendi Hasibuan, 2013, *Trademark Protection: A Study of Indonesian and United States Court Decisions*, FH UI, Jakarta, 2013.
- Farida Hasyim, *Commercial Law*, 2009, Sinar Grafika, Jakarta.
- Gautama Sudargo, 1990, *Aspects of Intellectual Property Rights*, Bandung Alumni.
- Harsono Adisumarto, 1990, *Right Owned by Industry*, Academics Pressindo, Jakarta.
- Hery Firmansyah, 2011, *Protection Law to Brand Guide Understand Base Law Use and Protection Brand*, PT. Book Exciting, Yogyakarta.
- Intellectual Property Rights and Their Benefits for Research and Development Institutions, 2016, Directorate General of Intellectual Property, Ministry of Law and Human Rights.
- <https://www.Hukumonline.com/klinik/a/perlindungan-hak-brand--ini-jual-mendapatkan-cl4430/>.
- Krisnani Setowati, Efridani, et al., 2005, *Intellectual Property Rights and Challenges of Their Implementation in Higher Education*, Intellectual Property Rights Office, Bogor Agricultural University, Bogor.

Muhammad Djumhana and R. Djubaedilah, 2003, *Intellectual Property Rights*, Second Edition, PT. Citra Aditya Bakti, Bandung.

-----, 2013, *Intellectual Property Rights, History, Theory and Practice in Indonesia*, Publisher Citra Aditya Bakti, Bandung.

Rachmadi Usman, 2003, *Intellectual Property Rights Law: Protection and Legal Dimensions in Indonesia*, PT Alumni, Bandung, 2003, p. 320. 25 Hery Firmansyah, *Legal Protection of Trademarks*, Pustaka Yustisia, Yogyakarta.

Soedjono Dirdjosisworo, *Anticipation to Business Cheat (Experience Country Advances in Intellectual Property Rights Protection and E-Commerce Regulation and Adjustment of Indonesian Intellectual Property Rights Law*, CV Utomo.

Team Lindsey et al., 2011, *Right Riches Intellectual*. PT. Alumni, Bandung.

Law Number 20 of 2016 concerning Trademarks and Geographical Indications.

## Copyrights

Copyright for this article is retained by the author(s), with first publication rights granted to the journal.

This is an open-access article distributed under the terms and conditions of the Creative Commons Attribution license (<http://creativecommons.org/licenses/by/4.0/>).