

**THE JURIDICAL REVIEW ON WELLKNOW MARK REGISTRATION
BASED ON THE INTERNATIONAL LEGAL BASIS
AND LAW NO. 15 YEAR 2001**

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**Tinjauan Yuridis Terhadap Pendaftaran Merek Terkenal Berdasarkan Hukum
International dan Undang-Undang no. 15 Tahun 2001**

(Rahmi Eliza, 04140118, 78 halaman, Hukum Internasional, Fakultas Hukum,
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ABSTRAK

Dewasa ini permasalahan perlindungan Hak Kekayaan Intelektual tidak lagi menjadi urusan satu Negara saja tetapi sudah menjadi urusan masyarakat internasional. Terlebih sejak ditandatanganinya TRIPs, perlindungan Hak Kekayaan Intelektual semakin ketat secara global dan dapat dilaksanakan melalui suatu badan yang bernaung di dalam system WTO yang disebut dengan Badan Penyelesaian Sengketa (Dispute Settlement Board/DSB). Merek dagang dan merek terkenal sebagai bagian dari Hak Kekayaan Intelektual juga memiliki beberapa peraturan, dimulai dari TRIPs dan Konvensi Paris yang mengatur tentang pengaturan umum untuk Hak Kekayaan Intelektual termasuk tentang merek dagang dan merek terkenal, dan kemudian Protokol Madrid dan Perjanjian Madrid untuk mengatur tentang pendaftaran merek. Indonesia sebagai salah satu negara yang memiliki komitmen yang sangat kuat terhadap perlindungan Hak Kekayaan Intelektual telah membuat Undang-Undang no. 15 tahun 2001 sebagai aturan tentang merek. Hukum internasional telah lama memberikan perlindungan terhadap merek terkenal. Banyaknya merek terkenal dan banyaknya kasus tentang merek terkenal di beberapa Negara dari dulu hingga sekarang mendorong masyarakat internasional untuk membuat kriteria tentang karakteristik dari merek terkenal dan pendaftaran merek terkenal. Dari hal diatas penulis ingin tau bagaimana pendaftaran merek terkenal yang diatur oleh hukum nasional dan hukum internasional. Dan penulis juga akan mempelajari TRIPs, Konvensi Paris dan Protokol Madrid apakah berhubungan dengan undang-undang no.15 tahun 2001 atau tidak, dan penulis juga ingin mempelajari tentang putusan hakim terhadap kasus merek terkenal apakah telah sesuai dengan peraturan hukum nasional dan internasional yang ada atau tidak. Untuk menjawabnya, penulis membagi empat pembahasan, yaitu bagaimanakah perbandingan hukum internasional dengan hukum nasional, apakah kriteria dari merek terkenal dan bagaimanakah perlindungan terhadap merek terkenal tersebut dan apakah hakim kita telah memberikan putusan yang baik dan sesuai dengan aturan hukum nasional serta internasional terhadap kasus pendaftaran merek terkenal atau tidak. Metode penulisan ini adalah metode normatif-yuridis.

CHAPTER I

INTRODUCTION

1.1 Background

The progress of technology, especially in information area and telecommunication area have pushed the globalization current in industrial area and commerce area. The mentioned, make world as an single market for all. In era free trade of world, Indonesia as developing countries must do the right things for anticipate all the growth, change and also the global tendency to get the target of national. Intellectual Property Rights as bearing part of law system with industry, investment and commerce, or corporated world.¹

Intellectual property protection is no longer the task of just one country, rather it has become an obligation shouldered by the international community. Since the signing of the TRIPs Agreement, international Intellectual Property Right protection has become stronger and protection standards may be enforced through the WTO's Dispute Settlement Board (DSB). To protect Intellectual Property Right in an efficient and favourable way for all WTO members, cooperation between WTO members on a regional and international level is required. ASEAN countries have established a forum to discuss Intellectual Property Right protection in the countries involved and ensure compliance with the standards of protection dictated by the TRIPs Agreement.

¹ Directorate General of Intellectual Property Rights, *Buku Panduan Hak Kekayaan Intelektual*, Directorate General of Intellectual Property Rights and JICA, Jakarta, 2007. page 3

Intellectual Property Rights defined by as protection of law given by State to someone and or a group of people and or body which is idea and his idea have been infused form a creature masterpiece (extant)². Masterpiece Create have the extant represent a individual rights and or group which need to be protected judicially, if a finding (the innovation) registered as according to existing conditions³.

Intellectual Property Rights have the nature of, that is:⁴

- a. Having a given time period or is limited

Its meaning after finished a period of its protection the invention or creation will become property of public, but there is also which after finished a period of/to its protection can be lengthened again, for example mark's law.

- b. Have the character of absolute and exclusive

Its intention that the rights can be defended to whoever. Owner of rights can claim to collision conducted by whoever. Owner or owner of intellectual property rights have a monopolistic rights, that is right owner or owner can utilize its rights prohibited whoever without its approval to make finding or creation and or using it.

² Andriana Krisnawati dan Gazalba Saleh, *Perlindungan Hukum Varietas Baru Tanaman dalam Perspektif Hak Paten dan Hak Pemulia*, PT RajaGrafindo Persada, Jakarta, 2004, page 13-14

³ The principle of Intellectual Property Rights is a law protection for all product which made by someone or organization that make economic valuable and expanding to be a law institution (Intellectual Property Rights)

⁴ Directorate General of Intellectual Property Rights and JICA, Jakarta, 2007..., *Op.cit.* page 5

Beside that, Intellectual Property Rights have subdividing and also law and regulation, that is⁵ :

- a. Copyrights
- b. Industrial Property Rights
 - Patent
 - Trademark
 - Trade Secrets
 - Design of Industries
 - Circuit Lay Out
 - Plant Variety

Law and regulation of Intellectual Property Rights in Indonesia are⁶ :

- a. Law No. 19 Year 2002 about Copyrights
- b. Law No. 14 Year 2001 about Patent
- c. Law No. 15 Year 2001 about Trademark
- d. Law No. 30 Year 2000 about Trade Secrets
- e. Law No. 31 Year 2000 about Design of Industries
- f. Law No. 32 Year 2000 about Circuit Lay Out
- g. Law No. 29 Year 2000 about Plant Variety

⁵ Saidin, *Aspek Hukum Hak Kekayaan Intelektual (Intellectual Property Rights)*, RajaGrafindo Persada, Jakarta, 1997, page 10-12

⁶ Directorate General of Intellectual Property Rights and JICA, Jakarta, 2007..., Op.cit. page 6

CHAPTER IV

CLOSING REMARKS

4.1 SUMMARY

4.1.1. The Comparison of International Legal Basis with National Legal Basis

Intellectual Property Rights have some regulation such as TRIPs, Paris Convention and Madrid Protocol (that's international legal basis), for our national legal basis law no. 15 year 2001 is a regulation for trademarks which arrange about Scope of Mark, Marks That Cannot Be Registered and Marks That Are Rejected, Application for Registration of Mark, Period of Protection of Registered Marks, Licensing, Collective Marks, Geographical Indication and Source of Origin, Deletion and Cancellation of Registration of a Mark, until Settlement of Disputes.

TRIPs arranged about all of a part of intellectual property, and especially for trademark, TRIPs arranged about Protectable Subject Matter, Rights Conferred, Exceptions, Term of Protection, Requirement of Use, Other Requirement, until Licensing and Assignment. That's only a fundamental rights for all of the member states to make them own regulation.

Paris Convention also arranged about all of a part of Intellectual Property, but it's more detail. Such as about trademark, Paris Convention arranged about Conditions of Registration; Independence of Protection of Same Mark in Different Countries, Well-Known Marks, Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations, Assignment of

Mark, Protection of Marks Registered in One Country of the Union in the Other Countries of the Union, Service Marks, Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization, Nature of the Goods to which the Mark is Applied, Collective, Trade Names, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name, False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer, Unfair Competition, Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue, Inventions, Utility Models, Industrial Designs, and Temporary Protection at Certain International Exhibitions.

Madrid Agreement and Madrid Protocol is different with TRIPS and Paris Convention. Because, Madrid especially arranged about The System of International Registration of Marks. The system makes it possible to protect a mark in a large number of countries by obtaining an international registration which has effect in each of the Contracting Parties that has been designated.

4.1.2 The Criteria of Wellknown Mark Based On The Regulation

Until now, no definition of wellknown mark yet, which to be accepted in general. Article 16 (2) TRIPS only make the nature of popularity criteria, with look the knowledge factor from the society to that mark, include knowledge of the member state about the mark condition which obtained from promotion.

Indonesia tried to give the criteria of wellknown mark. Beside concern in society knowledge, the determination also based on reputation of mark which related with a big promotion by the owner, investment in some country and with registration evidence in some country.

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