

PROTECTION FOR REGISTERED TRADEMARK UNDER INDONESIAN LAW AND THE WTO AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS)

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ABSTRACT

This study examines the legal protections available to registered trademarks, specifically focusing on trademark violations with reference to the Warkop DKI and Warkopi cases. The normative method is employed to explore the normative issues surrounding registered trademarks. The findings indicate that the legal protection of trademarks in Indonesia follows a repressive approach that aligns with the provisions of the TRIPS Agreement. In Indonesia, trademarks receive protection after being registered under the Indonesian Trademark Law of 2016. The trademark disputes between Warkop DKI and Warkopi exemplify instances of registered trademark infringement, along with other similar cases that serve as comparative legal references. The provisions of the law and the TRIPS Agreement do not condone violations of registered trademarks. Therefore, through the repressive protection framework adopted by Indonesia, Warkop DKI can pursue legal action to address trademark issues. It is crucial to establish clarity in differentiating trademarks and improve practices to prevent similarities among registered trademarks. This responsibility lies with the relevant trademark agencies, which should evaluate and respond to trademark disputes. In any trademark dispute, the involved parties must be able to comprehend and articulate the nature of the dispute that has arisen.

Keywords: *Trademark, Registration, Infringement, the Indonesian Trademark Law, TRIPS Agreement, Warkop DKI, Warkopi.*

INTRODUCTION

A trademark is a type of intellectual property that receives protection under Indonesian and international legal frameworks. The presence of trademark rights, particularly for registered trademarks, ensures that trademark holders can safeguard their trademarks in accordance with relevant regulations. It is crucial to adhere to the existing trademark rules whenever a trademark situation arises. Each trademark application will be processed for registration in accordance with the applicable regulations.

However, it is essential for registered trademark owners to recognize that any rights and benefits obtained after registration must be in accordance with the provisions outlined in the applicable rules.

In the realm of international trademark regulations overseen by the World Intellectual Property Organization (WIPO), a trademark is defined as "any sign that distinguishes the goods of a particular enterprise from those of its competitors." The concept of trademark rights has found significant relevance in the entertainment industry, which continues to expand rapidly. In this industry, trademarks play a crucial role as differentiators, ultimately becoming defining characteristics and economic assets for players within the entertainment sector.

The general regulation of the TRIPS Agreement gives freedom to each member state to be able to implement the existing rules. Article 1 of the TRIPS Agreement states the Intellectual Property Convention that the intellectual property rules contained in the TRIPS will only concern the subject matter globally. Then each specific law that member states need for the sustainability of intellectual property in their country is left to each member states with due regard to the subject matter of the rules of the TRIPS and other related international conventions.¹ All matters relating to this trademark rule about the freedom of member states are implemented by Indonesia in Indonesian Trademark Law 2016, an adaptation of part 2 of the TRIPS Agreement, which outlines the general provisions of the trademark rules.²

Indonesia, through Indonesian Trademark Law 2016, introduced two means of the legal protection of registered trademarks, namely preventive legal protection and repressive legal protection. Trademark registration is essential for marks protection. In articles 15 to Article 21, TRIPS explains the standards concerning the availability and scope, and use of intellectual property rights, in this case, the regulation of standards regarding the elaboration of understanding in general and the types of protection received after carrying out the registration procedure to the resolution of trademark disputes.³

Through articles 20 and 21 of Indonesian Trademark Law 2016, Indonesia explains the causes of a trademark not being accepted for registration, namely because the trademark cannot be registered

¹ Mitsuo Matsushita, (et.al), "*The World Trade Organization : Law, Prattice, and Policy*", Oxford University Press, 2005, p.702.

² Sudjhana, "Penegakan Hukum Merek dalam Hukum Indonesia Terhadap Pemenuhan Ketentuan TRIPS – WTO", *Res Nullius*, Volume 3 No.2 Juli 2021, p.139

³ Irene Calboli and Christine Haight Farley, "The Trademark Provision In The TRIPS Agreement", *Digital Commons American University Washington Collage of Law*, 2016, p.160.

or the trademark is rejected. Article 20 describes things that can cause a trademark to be unregistered such as similarities or does not have a distinguishing power from existing trademarks or contrary to state ideology, religious morality, or public order. Meanwhile, Article 21 of Indonesian Trademark Law 2016 explains that a trademark can be rejected if it has similarities with other trademarks that can resemble or imitate the name of a famous person or likeness in the abbreviation of the term until a trademark can be rejected if, in the application/registration, there is bad faith. Trademark registration carried out under applicable procedures will receive state protection afterward. This protection is, of course, to keep the registered trademark from other parties who want to take advantage without the consent of the trademark rights holder.

In line with the development of trademark protection through various regulations and details of existing rules in Indonesia, there are still violations of trademark rights that have been registered, in September 2021 a case related to violations of trademark rights in the entertainment world occurred at Warkop DKI, where a group of young men who were present with facial similarities with the original members of Warkop DKI, they were known to the public as a group that had similarities both in appearance and content shown with the original members of Warkop DKI. Warkopi began to appear in various shows on national television until their existence received a response from one of the existing members of Warkop DKI, namely Indro, for Warkopi's work which was considered to violate the intellectual property rights of Warkop DKI.⁴ Who had mastered the trademark rights registered with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia with agenda numbers IDM000047322, IDM000551495, IDM000557440, IDM000557441.⁵

In line with the developments in the Warkop DKI and Warkopi cases, various opinions were raised in the settlement. Warkopi itself has the potential to violate the exclusive rights owned by Warkop DKI if it continues to carry out any activities, both using similar group names and even continuing to produce videos that imitate the three official members of Warkop DKI to display these similarities on various National TV programs for personal gain without official permission Warkop DKI. The application of trademark law will be beneficial in the speedy resolution of disputes over registered

⁴ Hukumonline, "Ada Pelanggaran HKI di Kisruh Warkopi vs Warkop DKI", <https://www.hukumonline.com/> (access at 01/28/2022, 21:35)

⁵ <https://dgip.go.id/menu-utama/merek/pengenalannya> (access at 23/01/2022, 10:55)

trademarks, as well as the importance of understanding the protection of registered trademarks following the provisions of existing trademark laws in Indonesia to registered trademark holders so that this will be a countermeasure to registered trademark infringement.

RESEARCH METHOD

The methodology employed in this study is normative legal research, which focuses on the examination and analysis of law as a norm, rule, legal principle, legal principles, legal theory, and other relevant literature. The objective of this research is to address a specific problem by utilizing statutory, case-based, and conceptual approaches. By employing these approaches, the study will elucidate the application of the Indonesian Trademark Law 2016 and the TRIPS Agreement in addressing the legal protection issues pertaining to the registered trademark in question.

FINDING AND ANALYSIS

1) Definition of trademark

It can be interpreted that a trademark is a sign that also contains a legal meaning.⁶ The trademark provides protection to the rights holder of the trademark as long as the trademark has gone through or has fulfilled the elements to become a trademark legally. The trademark has various functions in terms of producers to consumers. Therefore, the trademark plays an essential role in the circulation of a good or service. The definition of a trademark, in general, is contained in Article 15 of the TRIPS Agreement explain that a trademark or combination of any trademark that can distinguish a good or service can be referred to as a trademark, and this trademark can be in the form of words, letters, numbers or a combination of signs - this trademark can be a condition in trademark registration. If in the elaboration of signs cannot provide distinguishing power then member states can make rules based on other distinguishing powers including by requiring a sign to be visually visible.

In the description of the definition of Indonesian trademarks, implementing it in Article 1 paragraph (1) of Indonesian Trademark Law 2016 concerning Trademark and Geographical Indications,

⁶ Rahmi Jened, *Interface Hukum Kekayaan Intelektual dan Hukum Persaingan*, Jakarta: Raja Grafindo Rajawali Press, 2013, p.207

namely what is meant by a trademark is a sign that can be displayed graphically so that it can be in images, logos, names, words, letters, numbers, color arrangements, can be in the form of 2 (two) dimensions or 3 (three) dimensions, sounds, holograms, or there is a combination of 2 (two) or more elements so that it can have the power to distinguish goods and / or services that will be produced by people or legal entities in a trade activity of goods and services. The definition of a trademark in general in Indonesian Trademark Law 2016 is much broader than that contained in the TRIPS Agreement, when a trademark gets protection this is not only related to the combination of colors and the arrangement of existing phrases but also found in signs that are not directly visible when only seen with the eye (in this case it can be in the form of sounds or aromas).

2) Trademark Registration and Registered Trademark Infringement under the Indonesian Law and The TRIPS Agreement

Trademark registration is a very important thing for trademark owners to protect their trademarks from other parties who irresponsibly take advantage of registered marks.⁷ Indonesia, as one of the countries that ratified TRIPS, has applicable rules that aim to protect registered trademarks.⁸ In trademark registration, there are two trademark registration systems, namely, the constitutive system (first to file principle), where in this system a person must carry out the registration procedure first to obtain rights to the trademark, and also declaratively (first to use principle) in which one is not required to register a trademark however, the owner of the trademark must be able to show proof that he or she are the first user of the trademark. These two systems are essential in the trademark registration system in a country.

Indonesia uses a constitutive system as a regulation of trademark regulation, trademark regulation in Indonesia which is regulated in Indonesian Trademark Law 2016, where trademark owners must apply for registration in writing to the Directorate General of Intellectual Property Rights and must also complete various registration administration needs. Trademark registration in Indonesia in accordance with Indonesian Trademark Law 2016 is contained in Articles 4 to 22. In the adjustment of

⁷ Fajar Nurcahya Dwi Putra, "Perlindungan Hukum Bagi Pemegang Hak Atas Merek Terhadap Perbuatan Pelanggaran Merek", *Journal Mimbar Keadilan, Edisi Januari – Juni, Surabaya*, p.98, 2014.

⁸ Erika Vivin Setyoningsih, "Implementasi Ratifikasi Agreement on Trade Related Aspect of Intellectual Property Right (TRIPS Agreement) Terhadap Politik Hukum di Indonesia", *Journal Penegakan Hukum dan Keadilan*, Vol.2 No.2, Yogyakarta, p. 119, 2021

the enrollment period, several changes were made to maximize the assessment of registered trademarks. These changes are contained in Articles 20, 23, and 25 through Article 108 of Law Number 11 of 2020 concerning Job Creation.

The main requirement to register a trademark must have differentiating power from the registered trademark.⁹ The requirement for the distinguishing power of a trademark is stipulated in Article 20 letter e that a trademark cannot be registered if it does not have a specific ability.¹⁰ With the improvement of the existing rules, Article 20 letter e has been changed through Article 108 of Law Number 11 of 2020, explaining that a trademark only has a distinguishing power if it is simple. In addition, another amendment to Article 20, letters b and f, describes that trademarks consisting of too general wording and descriptive words cannot be registered.

Registration of a trademark consists of several stages. The trademark owner must first submit a trademark application.¹¹ To the Directorate General of Intellectual Property, wherein carrying out the application, the trademark owner must carry out the terms following the provisions of Article 4 of the Indonesian Trademark Law 2016. When the application for a trademark has been declared complete, the examiner will conduct a substantive examination. This is one of the essential stages in a trademark registration process. When the substantive examination takes place, the parties who feel that the application for a trademark has something in common with the registered trademark can object.

Substantive examination of trademark applications is regulated in Article 23 of Indonesian Trademark Law 2016, and the continuation of substantive investigations is explained through Article 12 of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration. Changes in the rules for substantive examination are carried out to minimize trademark violations through changes based on Article 108 number 6 and detailed implementation in the Regulation of the Minister of Law and Human Rights Number 12 of 2021 concerning Amendments to the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration. After the application and examination stage is carried out, a trademark will be announced

⁹ Yuliana Utama, "Perlindungan Merek Berbasis Tingkat Daya Pembeda Ditinjau dari Doktrin Dilusi Merek di Indonesia", *Jurnal Acta Diurnal Volume 5 No.1*, Bandung, p.140, 2021.

¹⁰ Article 20 of the Indonesian Trademark Law 2016

¹¹ Karlina Perdana and Pujiyono, "Kelemahan Undang – undang Merek dalam Hal Pendaftaran Merek (Studi atas Putusan Sengketa Merek Pierre Cardn)", *Jurnal Privat Law Volume V No. 2*, p.86, 2017.

to have been registered through a trademark certificate which will then be announced in the Official Trademark Gazette under the provisions of Article 25 of Indonesian Trademark Law 2016. A trademark that has obtained protection will only sometimes have this protection, and this is determined so that no market dominance will cause unfair business competition. The regulation of Article 35 of Indonesian Trademark Law 2016 stipulates a protection period of 10 (ten) years, which differs from the protection period set by TRIPS through Article 18 for 7 (seven) years.

The trademark laws in Indonesia are very closely related to international agreements relating to trademarks such as TRIPS, Paris Convention, and others. TRIPS provides an overview and firmness of trademark regulation, which is about the exclusive rights received after a person registers a trademark. This exclusive right becomes very important in trademark protection. Trademark rights holders must obtain exclusive rights aimed at preventing other parties outside the official agreement made using the registered trademark for profit,¹² Including, among others, preventing the occurrence of passing off of fame (Passing off) against a registered trademark.¹³

3) Dispute Settlement and Law Enforcement Rules under Indonesian Trademark Law and The TRIPS Agreement

Trademark infringement in Indonesia, as described in Article 83 Paragraph (1) of Indonesian Trademark Law 2016, that the owner of a registered trademark or those who obtain a license for a registered trademark can file a lawsuit against another party who, without the right to suspect has used a trademark that has the same or as a whole for similar goods or services, which can be a lawsuit for compensation and/or termination of all actions that have a connection with the use of the trademark. Dispute resolution known in intellectual property can go through two channels: the court (litigation) route and the non-litigation route. The non-litigation way is the settlement of disputes outside the court which is divided into two types, arbitration, and alternative dispute resolution, based on Law Number 30 of 1999 concerning Arbitration and Alternative Dispute Resolution. Based on Law Number 30 of 1999 in Article 1 Number 10, Arbitration and Alternative dispute resolution is a form of dispute

¹² Haryono, “Perlindungan Hukum Terhadap Merek Terdaftar”, *Jurnal Ilmiah CIVIS VOL II No 1*, Semarang, p.24, 2012

¹³ Edy Santoso, “Penegakan Hukum Terhadap Pelanggaran Merek Dagang Melalui Peran Kepabeanaan Sebagai Upaya Menjaga Keamanan dan Kedaulatan Negara”, *Jurnal Rechtsvinding Vol.5 No.1*, Jakarta : Badan Pembinaan Hukum Nasional, p.124, 2016.

resolution institution through procedures agreed upon by the parties to the dispute, which can be taken using consultation, negotiation, mediation, conciliation, and expert judgment.

Arbitration is a form of civil dispute resolution outside the general judiciary based on a written arbitration agreement made by the disputing party. Meanwhile, Alternative Dispute Resolution is a form of dispute resolution outside the court based on consensus carried out by the disputing party with the help or not of a neutral third party. Trademark infringement in Indonesia is regulated in the second part of Indonesian Trademark Law 2016. Article 93 of Indonesian Trademark Law 2016 that the settlement of trademark disputes is carried out by arbitration and alternative dispute resolution, this is in addition to dispute resolution carried out through court channels through commercial courts.¹⁴

As a general rule of thumb in intellectual property protection, TRIPS elaborates dispute resolution in the field of intellectual property, including trademarks in Part III of Article 41 to Article 61. Each member country returning to the original principles of the TRIPS Agreement is given the freedom to regulate or make rules for the protection of intellectual property rights based on the conditions in their country. Article 61 of TRIPS provides that each member state must be able to provide a procedure relating to criminality or punishment for trademark infringement or copyright piracy.¹⁵ Efforts can be made, one of which is by confiscation or setting penalties or fines following the violations committed. Of course, this must be done consistently, which can be a benchmark in preventing infringement of intellectual property, including trademarks in member countries.

In the case of the formulation of the provisions, no provision states directly whether the settlement of disputes over the trademark must be carried out in litigation or non-litigation and others. Therefore, trademark rights holders are free to choose to take legal channels to protect the trademark from violations. Against this, the holders of trademark rights can file a civil lawsuit or demand a sentence of confinement if they find that the other party is without permission to use the registered trademark.

¹⁴ Hukumonline, "Mekanisme Penyelesaian Sengketa Kekayaan Intelektual," <<https://www.hukumonline.com/klinik/a/>>, (accessed at 25/10/2022)

¹⁵ Ida Ayu Windhari Kusuman Pratiwi, "Pelanggaran Merek Terkenal dan Perlindungan Hukum Bagi Pemegang Hak Dalam Perspektif Paris Convention, TRIPS Agreement dan Undang - undang Merek Indonesia", *Journal Magister Hukum Udayana*, Vol.7 No.3, Bali, p.434, 2014.

4) Legal Protection Available Applicable Rules for Registered Trademarks under Indonesian Law and the TRIPS Agreement.

Indonesia through Indonesian Trademark Law 2016 introduced two means of the legal protection of registered trademarks, namely preventive legal protection and repressive legal protection. Preventive legal protection is when legal subjects can raise an objection or submit an opinion before a government decision on a trademark gets a definitive form. This legal protection aims to encourage the public to be able to comply with applicable legal provisions so that nothing will happen that causes harm to others.

While repressive legal protection is a form of protection that when the subject of law or the owner of a registered trademark feels that he has been harmed, then he can file a lawsuit for violation of trademark rights to the commercial court, which in this case can file a lawsuit in the form of compensation or dismissal for all activities that use the registered trademark.¹⁶ Repressive legal protection is closely related to registering a trademark adhering to the first filing principle. In this system, the right to a trademark will be granted to the first registrant and entitled to exclusive rights under the provisions of Article 16 TRIPS.

Indonesia, in carrying out the provisions of the regulation of the trademark, uses repressive legal protection, which then to the owner of the first trademark will be given a special right in the form of being able to form a single right for himself which is provided by the provisions of the applicable law and this right does not have interference from other parties without the permission of the first trademark holder. In addition, with the special rights of the owner of the first trademark, a healthy monopoly right will be granted where without the permission of the holder of the first trademark right, other people cannot use the registered trademark. For this benefit, the most superior right provides convenience for the holder of the first trademark right. The examination of trademarks registered in Indonesia has been regulated following the provisions of the trademark law. Various trademark problems become fatal when a trademark that has been registered first and other trademarks with the same mark is also registered on the official DJKI portal for trademark permission.

Trademark protection in Indonesia provides legal certainty for trademark rights holders. Protection of registered trademarks is a very special thing in the form of granting exclusive rights. The

¹⁶ Jisia Mamahit, "Perlindungan Hukum Atas Merek Dalam Perdagangan Barang dan Jasa", *Jurnal Lex Privatum Volume 1 No.3*, p.12, 2013.

exclusive right described in Article 1 Paragraph (5) of Indonesian Trademark Law 2016, where the state can only give this right to trademark rights holders who have registered for a certain period obtained by the trademark rights holder not only related to Indonesian trademark law but also, in particular, this right is contained in TRIPS as a form of international agreement that protects Intellectual Property Rights.

Trademark registration is essential to protect a trademark against violations that occur in Indonesia. Registration of a trademark is clearly stated in Article 20 to Article 22 of Indonesian Trademark Law 2016 that trademark registration must not conflict with various provisions mentioned, such as state ideology, religious morals, and others, and of course, must have a differentiator that the owner of the trademark can prove. Trademark registration is also explained in TRIPS in Article 15 that a trademark must have distinguishing power,¹⁷ and member states must require that the conditions of registration of a trademark must be seen as visible.

Registration of a trademark must mainly be based on good faith provisions. This is applied in Indonesia, and various countries always put this forward as an initial form of forming a good trademark arrangement. Bad faith in trademark registration is related to fraud, misleading others, and all actions that ignore applicable legal provisions to obtain benefits.¹⁸ Good faith in a trademark is explained in Article 21 Paragraph (3) of Indonesian Trademark Law 2016 that an application for registration of a trademark will be rejected if the parties do not have a good faith, bad faith in the registration of this trademark has existed in every arrangement of trademark laws since the past. Proof of the existence of bad faith in registering a trademark can be a benchmark in the cancellation of a trademark based on the provisions of the applicable rules.

Several cases are related to errors when trademark registration applications continue to occur, and this is a benchmark for instability in the examination of a trademark, including the case of the Ikea System with locally owned IKEA and the issue of Pierre Cardin belonging to a French fashion designer with the Pierre Cardin trademark owned by PT Gudang Redjeki from Indonesia. The substantive examination regulated in the provisions of Indonesian Trademark Law 2016 has differences with the previous trademark law, which after an analysis is carried out on the trademark application if there is

¹⁷ Pi Chan Hu, "A Linguistic Study of The Distinctiveness of A Trademark", *NTUT Journal of Intellectual Property L & Mgmt, Volume 3 No.1*, p.3, 2014

¹⁸ Agus Mardianto, "Penghapusan Pendaftaran merek Berdasarkan Gugatan Pihak Ketiga", *Jurnal Dinamika Hukum Vol 10 No.1*, p.47, 2010.

no rebuttal or rebuttal, then after that, no re-examination is carried out because it is considered that conducting a re-examination is less effective and takes too long for the trademark registration process.

Article 16 of TRIPS explains the establishment of criminal procedures and the importance of providing penalties at least to the parties in cases of trademark forgery and copyright piracy. To realize legal sanctions for all forms of these violations, through Articles 100 – 102 of Indonesian Trademark Law 2016, Indonesia provides a criminal sanctions device that protects registered trademarks from all bad faith aimed at negative purposes against registered trademarks. The owner of a registered trademark can file a lawsuit against another party who uses the rights of the trademark without the permission of the registered trademark owner, namely in the form of a compensation case and the termination of all activities related to the circulation of the registered trademark without permission.¹⁹ Handling trademark infringement in Indonesia is given the freedom to be able to decide to resolve trademark disputes.

The rules that apply in preventing violations of registered trademarks have been arranged in such a way as to overcome various disputes that occur. Legal certainty in protecting trademarks from all forms of offenses is a form of necessity for a rule in society to regulate and protect. The ratification of the authorities carried out by Indonesia, and various updates to existing trademark law must be accompanied by balanced legal practices so that the multiple parties involved can better understand the importance of protecting a trademark.

Warkop DKI as one of the most famous comedy groups in Indonesia since the early 1980s. It consists of 3 (three) members, namely Dono (Wahjoe Sardono), Kasino (Kasiono Hardiwibowo), and Indro (Indrodjojo Kusumonegoro).²⁰ Since its inception, various works produced by Warkop DKI have greatly interested society. They can attract the public's attention from their multiple jobs that not only rely on random comedy but have many other messages that are also conveyed. The death of two Warkop DKI members, Dono and Casino, is why Warkop DKI is currently vacuumed in the Indonesian entertainment industry. However, the work they have produced continues to be aired on television and other publication media.

The popularity of Warkop DKI in the entertainment industry makes things related to them will be known to the public easily. When three young men appeared with similar faces to the original members of Warkop DKI, these three were Sepriadi Chaniago, Alfred Dimas Kusnandi, and Alfin Dw

¹⁹ Adrian Sutedi, *Hak Atas Kekayaan Intelektual Cet II*, Jakarta: Sinar Grafika, 2013, p.95.

²⁰ Kompas.com, "Sejarah Terbentuknya Warkop DKI", <<https://www.kompas.com/>>, (accessed at 11/17/2022, 10.30)

Krisnandi. Then these three people were combined in a group called Warkopi. The presence of Warkopi in the Indonesian entertainment industry was able to attract the attention of the public, so the increasing popularity of Warkopi as a duplicate of the Warkop DKI group made them get many offers to appear in various shows on national television, that they also re-showed parody videos of Warkop DKI on social media such as Youtube.

The presence of Warkopi raises a debate that the presence of Warkopi has violated the intellectual property rights owned by Warkop DKI, one of which is the violation of Warkop DKI's trademark rights. In the international intellectual property arrangements contained in TRIPS, a person without rights cannot use a registered trademark because it is based on the exclusive rights owned by the trademark holder.²¹ Trademarks owned by Warkop DKI are registered with agenda numbers IDM000047322, IDM000551495, IDM000557440, IDM000557441,²² The four trademarks owned by Warkop DKI that have been registered have their characteristics as described in Article 1 Paragraph (1) of Indonesian Trademark Law 2016. In the trademark study, the trademark owned by Warkop DKI that has been registered has distinguishing characteristics from other registered trademarks in the trade of goods and services. Warkop DKI's registered trademarks have the right to commercialize in the entertainment industry, such as film production, education, education services for organizing exhibitions, as well as entertainment group services, besides that trademarks owned by Warkop DKI are also registered for production and also recording studios, advertisements, films, studios, presentation, and others.²³

In terms of the use of the name, Warkopi has similarities with Warkop DKI, in the sense of a trademark, it is explained that a trademark must have distinguishing power where in this case, the trademark consists of images, logos, names, words, letters, numbers, color arrangements and combinations of these elements. The various factors in another description were a mixture of form equations, writing equations, or speech or sound equations. Because of this, of course, Warkopi has similar elements of the arrangement of names and words, or there are similarities in speech but with

²¹ Article 16 Agreement on Trade-Related Aspect of Intellectual Property Rights 1994

²² Search on Pangkalan Data Kekayaan Intelektual, <<https://pdki-indonesia.dgip.go.id/>>, (accessed on 02/09/2022, 11.30).

²³ Search on Sistem Klasifikasi Merek with Nice Classification, <<https://skm.dgip.go.id/>>, (accessed on 02/09/2022, 12.45)

different writing, but when pronounced, sounds the same or homophone.²⁴ The trademark is owned by Warkop DKI, which can cause violations if there is a trademark registration and will also be related to a substantive examination of the trademark. The similarity of name elements contained in Warkop DKI and Warkopi is not in line with the regulations of Articles 20, 21, and 22 of Indonesian Trademark Law 2016, where the distinguishing elements in the trademark are also contained in article 108 of Law Number 11 of 2020 concerning Job Creation which states that a trademark cannot be registered if it does not have differentiating power,²⁵ On this basis, in the registration of a trademark, there can be no similarity with a registered trademark, so the other party must respect the registered trademark as one of the absolute rights.

The use of the Warkop DKI trademark by Warkopi is also a problem with other parties' cooperation contracts with Warkop DKI. Warkopi, which continues to display various entertainment content from Warkop DKI's works, will cause losses to production houses that have to cooperate with Warkop DKI, one of which is Falcon Pictures, where this production house collaborates with Warkop DKI in making Warkop DKI films. If Warkopi wants to continue working with the use of the Warkop DKI trademark, it must be based on a license or permission to use the registered trademark by the registered trademark owner against other parties. The license does not transfer the trademark rights, but the second-party license can legally use the "trademark rights." The use of a license is the best alternative in reaching an agreement to avoid trademark infringement, where the license uses a contract in writing/agreement that contains evidence of granting permission for the use of a registered trademark following the provisions of the legal principles of the agreement in *Burgerlijk Wetboek (BW)*²⁶ Article 1320 and as contained in the provisions of Articles 42, 43, 44, and 45 of Indonesian Trademark Law 2016, as well as the granting of licenses officially, can be recognized if it has been requested for listing and announced in the official trademark news.²⁷

The trademark registration carried out by Warkop DKI has a protection period as stated in Article 35 of Indonesian Trademark Law 2016, where trademark rights holders will get a protection

²⁴ Marselinus manik Marthin Simangunsong and Roida Nababan, "Analisis Yuridis Pemakaian Merek yang Memiliki Persamaan Pada Pokoknya atau Seluruhnya (Studi Putusan No.57/Pdt.Sus-HKI/Merek/2019/PN.Niaga)", *Jurnal Hukum Patik Volume 08 No.01*, Medan : Fakultas Hukum HKBP Nommensen, p.9, 2019.

²⁵ Yuliana Utama, *Op.cit*, p.140.

²⁶ Agung Sujatmiko, "Peran dan Arti Penting Perjanjian Lisensi dalam Melindungi Merek Terkenal", *Jurnal Mimbar Hukum Volume 22 No.1*, Yogyakarta, p.124, 2012.

²⁷ Article 42 Agreement on Trade-Related Aspect of Intellectual Property Rights 1994

period of 10 (ten) years calculated from the time of receipt and can be extended with the same period.²⁸ This protection period has differences with the arrangements in TRIPS Article 18, which states that the protection period of a trademark is 7 (seven) years, and when renewing the registration, is not less than 7 (seven) years and can be extended indefinitely during the trademark protection period must be under the provisions of Article 36 of Indonesian Trademark Law 2016.²⁹ Based on the provisions regarding this protection period, Warkop DKI during the protection period has full rights to the use of trademark power, so in the case of this protection period, Warkopi as a group using the brand without permission may be subject to prosecution for the use of the trademark without permission.

CONCLUSION

There are two primary forms of legal protection for trademarks: preventive legal protection and repressive legal protection. Preventive legal protection allows the concerned party to express their opinion or raise objections before the institution has the authority to make a final decision on a trademark. This type of protection aims to prevent trademark disputes from arising. Government institutions responsible for trademarks play a crucial role in decision-making during the preventive protection process. On the other hand, repressive legal protection serves as a means of resolving trademark disputes and can involve legal sanctions such as fines, imprisonment, or other penalties. Repressive legal protection is typically pursued through court proceedings, resulting in judgments on trademark disputes.

In cases involving disputes over trademark similarity, the likelihood of trademark infringement is significant. Therefore, Warkopi's claim of ownership over the Warkop DKI trademark is unacceptable to Warkop DKI. Throughout the protection period granted to Warkop DKI, Warkopi is prohibited from using the trademark for commercial purposes. Any form of publication undertaken by Warkopi, including the display of parody performances of Warkop DKI on national television or the profits gained from advertising, infringes upon the economic rights associated with the registration of Warkop DKI's trademarks. While Warkopi's career may be connected to Warkop DKI, it must be done with proper

²⁸ Article 35 Indonesian Trademark Law 2016

²⁹ Zaenal Arifin and Muhammad Iqbal, "Perlindungan Hukum Terhadap Merek yang Terdaftar", *Jurnal Ius Constituendum Volume 5 No.1*, Semarang, p. 55, 2020.

permission. In addition to violating Warkop DKI's exclusive rights, the presence of Warkopi may result in a lawsuit filed by Warkop DKI, potentially leading to violations of Article 100 to Article 103 of the Indonesian Trademark Law 2016.

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