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## RESEARCH ARTICLE

### PROTECTION OF A WELL-KNOWN MARK: JUSTICE FOR WHO?

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#### ABSTRACT

This study aims to analyze how well-known marks are protected internationally and to elaborate on whom is justice addressed when it comes to regulating a well-known mark. This research uses normative research with statutory, case, analytical, and conceptual approaches. It employs primary legal materials in the form of laws and regulations, and secondary legal materials related to similar literature or readings derived from other scientific writings. The results show that the protection of internationally well-known marks has been regulated, particularly under Article 16(2) of the TRIPs Agreement that complies with the Paris Convention. To become a well-known mark, several categories must be fulfilled, namely: a mark must already be registered in various member countries, continuous promotions need to be carried out, and by determining the knowledge of the trademark in the relevant sector of the public. After fulfilling all categories and becoming well-known marks, it can be protected in entire member countries without the need registration process. Well-known mark protection provides justice not only for well-known mark owners but particularly relevant consumers as it offers a sense of security and comfort upon such reputation attached to the said well-known mark. Further, the emerging well-known marks from other countries such as Indonesia will get the same equal treatment with reciprocity principles. In addition, the existence of well-known marks protection also will increase and open job opportunities in the countries where well-known marks are spread out to be marketed.

## INTRODUCTION

Trade is one of the vital aspects of economic growth in Indonesia. Every business actor is encouraged to innovate relentlessly to maintain the existence of their products and/or services in today's intense market competition (Indirani Wauran, 2017). Such continuous innovations are encouraged to be done to avoid imitation, piracy, and imitation of goods and/or services by unauthorized parties. This issue is closely related to the Intellectual Property (hereinafter referred to as IP) law regime. IP consisted of various types, among other trademarks, copyright, and patent. Trademark, for example, is used as distinctive power in trading goods and/or services of entrepreneurs. Cases involving IP seek to explore various technological, industrial, social, and cultural aspects, as well as various existing aspects. The law is expected to overcome various cases that arise related to these IPs. Exclusive rights attached to IP work consisted of moral and economic rights. Economic rights in IP relate to the birth of intellectual works in which the author or creator of such work already sacrificed many things, such as time, effort, and costs, to create it. Consequently, economic rights lead to economic benefits which can be enjoyed by the author or creator of such IP work (Tim Lindsey, Eddy Damian, et al. 2003).

A country with great IP protection for its citizens accelerates growth within the country. Countries with scientific and technological capital contribute wealth that far exceeds physical wealth. This wealth indirectly accelerates industrial progress, creates new jobs, advances the quality of human life which meets the needs of the community on a massive scale, provides legal protection and acts as a driving force for people's creativity, and most importantly encourages a country's economic growth. Thus, it can be said that economic growth in a country is closely related to its number of IPs. The more open a country's economic system is, the more IPR protection will play its role in supporting the country's economic growth. IP protection in Indonesia cannot be separated from the consequences of Indonesia's participation in various international agreements on IP. Starting from the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization (hereinafter referred to as the Paris Convention), the Berne Convention for the Protection of Literary and Artistic Works (hereinafter referred to as the Bern Convention), the Agreement on Trade-Related Aspects of Intellectual Property Rights 1995 (hereinafter referred to as TRIPs Agreement), Trademark Law Treaty and Protocol relating to the Madrid Agreement Concerning the International Registration of Mark (hereinafter referred to as the Madrid Protocol).

Well-known mark, as one example of IPs, is the focus of this study. Protection of well-known marks is regulated in international treaties which refer to the provisions contained in Article 6Bis Paris Convention. This article specifies the regulation of well-known marks that are not registered in a country, but protection is still provided on the condition that the mark is a well-known mark. The rules contained in the Paris Convention introduce the concept of a well-known mark to international law. Member countries that have entered into the Paris Convention agree to prevent other parties from registering marks that contain similarities in principle or similarities in its entirety with the marks of other parties or that have the potential to create confusion among consumers with well-known marks for similar or the same types of goods, even if the well-known mark is not registered in the territory of the country (Cita Citrawinda Noerhadi, 2020). A well-known mark is a mark that has a high reputation. Well-known marks have a high and attractive power of public knowledge, so that any type of product contained under a well-known mark can create a familiar attachment and mythical context to consumers. If a mark has been circulated beyond regional boundaries to international boundaries, which has been circulated outside its country of origin and has been proven through the registration of related marks in various countries, then the mark is a well-known trademark (Simangunsong, Marthin, et al, 2022).

There is an urgency to provide legal protection for well-known marks. Economic interest in well-known marks is recognized in the World Intellectual Property Organization (hereinafter referred to as WIPO) treaty, which was also regulated later by the United States, Australia, Britain, and Indonesia. The specific feature of a well-known mark is that the reputation of a mark is not limited to certain products or types. For example, *Marlboro* is not only used as a cigarette product but also used in clothing. Another example, *Panther* is not only used for vehicles but also beverage products. Reputation in trading is considered a measure of a company's success or failure. As is well known, companies intentionally place advertisements to build product reputation as well as to introduce new products on the market and maintain the reputation of pre-existing products. Under Law Number 20 of 2016 concerning Marks and Geographical Indications (hereinafter referred to as Law 20/2016), it is determined that a mark application will be rejected if it has similarities in principle or in its entirety to well-known marks for similar goods and/or services, as well as well-known marks for goods and/or services belonging to other parties not of the same type that meets certain requirements. For example, the SONNI mark which will be rejected due to similarities in its essence with a well-known mark, namely SONNY (Ni Ketut Supasti Dharmawan, et al, 2017).

This study aims to analyze how well-known marks are protected internationally and to elaborate on whom is justice addressed when it comes to regulating a well-known mark. Further, this intended to create new legal ideas on the existence of the protection of a well-known mark in order to provide certainty and fairness for all parties. In 2021, a study conducted by Muhamad Shafwan Afif and Heru Sugiyono also discussed issues on the well-known mark through a study entitled "Legal Protection for Holders of Well-Known Marks in Indonesia". However, the difference is, such a previous study focused on more protection based on Indonesian positive law with an element of equality in essence while this study focuses on the protection of a well-known mark internationally and to whom is justice addressed when it comes to regulating a well-known mark. Therefore, there is originality on this study.

## MATERIALS AND METHOD

This study employs normative legal research with library research that is carried out by reading and studying written sources (MasyitaPoiyo, 2018).As for the approach, it uses statutory, case, analytical, and conceptual approaches. Primary legal materials are in the form of laws and regulations, as well as secondary legal materials related to similar literature or readings derived from other scientific writings.

## RESULTS

**How A Well-known mark is Protected Internationally:** The legal umbrella at the international level on the protection of IP began with the establishment of the World Trade Organization (hereinafter referred to as WTO). As this study focuses on IP, the international agreement on IP that was established as a consequence of WTO establishment is the Trade-Related Aspects of Intellectual Property Right (hereinafter referred to as TRIPs Agreement). TRIPS Agreement can be found as Annex 1C under the Marrakesh Agreement Establishing the WTO which was signed back then on 15 April 1994 in Marrakesh, Morocco. WTO itself is a global international organization that deals with trade rules between countries contained under WTO agreements. Mark as a means of marketing and advertising provides a certain level of information to consumers regarding goods and/or services produced by entrepreneurs (Rahmi Janet, 2015). A mark is a symbol of reputation in the investment sector as it can elevate and promote products and/or services offered by a company in addition to promoting the company itself. Mark as a product sign that is labelled on the results of intellectual innovation and creation is an investment asset that must be maintained, starting from its image and value to its popularity. Such maintenance may affect the recognition of the entrepreneur's products and/or services in society. In other words, society will get familiar with that.

Marks are differentiated into trademarks and service marks. Legal protection for marks is increasing as world trade advances. Marks are increasingly playing a role in distinguishing the origin and quality of goods to avoid imitation (Endang Purwaningsih, 2020). Internationally, the convention that regulates mark is the Paris Convention. The Paris Convention was established on 20 March 1883. It was later revised several times, such as in Brussels in 1900, in Washington in 1911, in Stockholm in 1967, and finally in Geneva in 1979. The Paris Convention has become an important foothold in IP development. It still becomes the basis for trademark protection, although, after the emergence of the Paris Convention, there are several agreements governing marks such as the Madrid Agreement, the Hague Convention, and the Lisbon Agreement. The Madrid Agreement was established based on the Paris Convention aimed at facilitating the way of registering marks in various countries directly in many countries, namely the Paris Union countries, which aim to avoid false notification of origin, international registration of marks at the international bureau in Bern, with the understanding that the marks must first become a national mark in the country of origin. Therefore, the international mark registration mechanism is one of the systems that should be used to protect national marks in the international world.

The protection of well-known marks is regulated under Article 6Bis of the Paris Convention. This article specifies the regulation of well-known marks that are not registered in a country, but the protection can still be provided on the condition that the mark is a well-known mark. The rules contained in the Paris Convention introduce the concept of a well-known mark to international law. Member countries that have entered into the Paris Convention agree to prevent other parties from registering marks that contain similarities in principle or similarities in its entirety with the marks of other parties or that have the potential to create confusion among consumers with well-known marks for similar or the same types of goods even if the well-known mark is not registered in the territory of the country (Cita Citrawinda Noerhadi, 2020). The Paris Convention regulates 3 (three) important principles, namely national treatment, priority rights, and registration. The principle of National Treatment is that each country participating in the Paris Convention can claim other participating countries so that each country is treated the same as its own citizens in terms of providing mark protection. The protection of foreign marks entering Indonesian territory with equal treatment refers to Article 3 of the Paris Convention. Moving on to the priority right, it is the Applicant's right to file an Application of which the country of origin is a member of the Paris Convention to be acknowledged that the Filing Date of

the country of origin is the priority date in the designated country which is also a member State of both agreements, provided that the application is submitted within the period defined based on such treaties. To obtain the recognition that the date of receipt in the country of origin is a priority date in the designated country which is also a member of such agreement; therefore, the submission is made within the period determined based on the Paris Convention. Meanwhile, the registration principle is global harmonization with respect to mark registration for each participant of the Paris Convention. Article 15 of the TRIPs Agreement states that the mark will get protection by registering the mark in several countries. This is also strengthened by the Madrid Protocol which regulates procedures for registering trademark rights (YatiNurhayati, Ifrani, Abdul Halim Barkatullah, dan M. Yasir Said, 2019). In the case of international mark registration, the mark owner registers his mark by using Priority rights, namely the Applicant's right to submit an application originating from a country that is a member of the Paris Convention. (Agreement Establishing the World Trade Organization) to obtain the recognition that the Date of Acceptance in the origin country is a priority date in the designated country which is also a member of one of the two agreements, as long as the submission is made within the timeframe determined based on the said international agreement (Frans H. Winarta, 2008).

Related to the registered trademark, Article 16 (1) TRIPs Agreement stipulated that the owner shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in likelihood of confusion (F. Scott Kieff & Ralph Nack, 2008). Once the mark has been registered in several countries, it will have opportunity to be well-known mark. To be well-known mark, several criteria must be fulfilled such as: (1) already registered in several countries; (2) it is known by the public who is the market for the mark; and (3) continuous promotion or marketing. Explicitly, TRIPs Agreement regulates the protection of well-known mark through Article 16. (2) TRIPs Agreement. In accordance with Article 16 (2) of the TRIPs agreement, in determining whether a trademark is a well-known mark, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark (WIPO/IP/CAI/1/03/8.A 2003). In determining whether the trademark is well-known, particularly related to the knowledge of the trademark, it is also emphasized in Article 2(2) of the WIPO Joint Resolution that provides that relevant sectors of the public shall include: actual and/or potential consumers of the type of goods and/or services to which the mark applies; persons involved in channels of distribution of the type of goods and/or services to which the mark applies; and business circles dealing with the type of goods and/or services to which the mark applies. (WIPO Joint Resolution Concerning Provisions on The Protection Of Well-Known Marks, 1999).

**Parties Receiving Benefit and Justice Through Well-Known Mark Protection:** Robert M. Sherwood argues that IP, including marks, must be protected. Based on Reward Theory, rewards in the form of incentives act as a driving force for the creation of innovative works (Hector Mac Queen, Charlotte Waelde and Graeme Laurie, 2007). In addition, creators, inventors, and designers who have spent time and money, and energy in producing their intellectual work must obtain back what they already issued based on Recovery Theory (Abdul Bari Azed, 2005). Further, according to reward and risk theory, the fairness in returning investment sacrificed by the author and/or creator and/or investor is important in protecting human beings' creative work (Waelde, Laurie, Brown, Kheria and Cornwell. J, 2014). Therefore, based on those theories, it is relevant to provide protection to the mark owners, specifically well-known mark owners, with the many sacrifices that have been made by them. This protection is to ensure that no other party in bad faith exercises the economic rights of the well-known mark without permission and causes harm to well-known mark owners as well as confusion for consumers who will use the

mark (Robert G. Bone, 2015). Of course, this will provide a sense of justice for well-known mark owners who will invest and conduct trading activities in Indonesia. As already mentioned previously, the protection of a well-known mark will create a sense of security or comfort for the well-known mark owners. This is in accordance with the theory of justice initiated by Aristotle. Such a theory consisted of distributive and commutative justice. Distributive justice is justice that is given to each according to his services (Van Apeldoorn, 2001), while commutative justice is protection given to people who are creative or who can create something (R. Otje Salman, 2000). Therefore, taking by not providing compensation or reciprocity for the mark owner is an action that cannot be justified as it violates good moral teachings. From an Indonesian perspective, legal protection of a well-known mark will provide a sense of justice not only for well-known mark owners who will invest in Indonesia but also protect various interests. First, well-known mark protection serves justice for well-known mark owners. For example, in the case of export-import trading, with reciprocity and equal treatment principles, well-known mark owners in Indonesia who export their products to other countries will receive the same treatment from other countries as Indonesia treats well-known mark owners from other countries who invest in Indonesia. Second, well-known-marks protection provides justice not only to well-known mark owners but also to the consumers as it offers a sense of security and comfort upon such reputation attached to the said well-known mark. Such mark reputation needs to be maintained due to the sales of products and/or services, one of which, is based on reputation. Because of the mark's reputation, more and more consumers will recognize the mark, which in the end the said mark can be categorized as a well-known mark. So, consumers will not hesitate to choose products and/or services coming from such a well-known mark. Thus, such a well-known mark will become consumers' first choice as it serves as an ideal product and/or service for them. In addition, consumers have in-depth knowledge of the products and/or services they use. Also, because of a good reputation attached to a well-known mark, consumers will also continue to buy these well-known products and/or services so as to create an economic climate in Indonesia that runs well. Hopefully, no disputes will occur as using well-known mark products and/or services provides a sense of security for consumers that such products and/or services that they use are the original ones. Third, related stakeholders, such as government and society, will also feel a sense of justice through well-known protection as investments made by well-known mark owners will lead to economic development and tourism; therefore, creating more job opportunities.

## CONCLUSION

The protection of well-known marks is regulated by various international legal instruments. Article 6 Bis Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization in harmony with the Agreement on Trade-Related Aspects of Intellectual Property Rights, especially Articles 15 and 16. At first, the mark will get protection by registering the mark in several countries. Once the mark has been registered in several countries and the mark becomes well-known and already known by the public which is the target of the mark, then it allows marks that have become well-known to invest in other countries to be addressed without registering by having criteria such as: (1) already registered in several countries; (2) it is known by the public who is the market for the mark; and (3) continuous promotion or marketing. Well-known mark protection will provide justice namely for (1) well-known mark owners by providing a sense of security when they conduct investment as well as export activities; (2) consumers as it offers a sense of security and comfort upon such reputation attached to the said well-known mark; and (3) related stakeholders, such as government and society, will also feel a sense of justice through well-known protection as investments made by well-known mark owners will lead to economic development and tourism; therefore, creating more job opportunities.

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