

**LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK
BETWEEN INDONESIA AND SPANISH
THESIS**



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**INTERNATIONAL PROGRAM
UNDERGRADUATE STUDY
FACULTY OF LAW
UNIVERSITAS ISLAM INDONESIA
YOGYAKARTA**

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INTERNATIONAL PROGRAM

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THESIS

Submitted To Fulfill As Requirements To Obtain A Bachelor Degree (Strata-1) at
the Faculty of Law, Islamic University of Indonesia



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INTERNATIONAL PROGRAM

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PRE-AWARENESS FINAL PROJECT APPROVAL PAGE



**LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK
BETWEEN INDONESIA AND SPANISH**

It has been checked and approved by the Final Project Supervisor for submission
in the future the Examiner Team in the Awareness Examination

on April 12, 2023



Yogyakarta, April 18, 2023
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BACHELOR DEGREE THESIS

**LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK
BETWEEN INDONESIA AND SPANISH**

This bachelor degree thesis has been approved by Thesis Supervisor to be examined by the Board of Examiners at the Thesis Examination on April

Yogyakarta, March 08, 2023

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FINAL PROJECT APPROVAL PAGE



**LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK BETWEEN
INDONESIA AND SPANISH**

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Karya ilmiah ini saya ajukan kepada Tim Penguji dalam ujian Pendadaran yang diselenggarakan oleh Fakultas Hukum Universitas Islam Indonesia. Sehubungan dengan hal tersebut dengan ini saya menyatakan:

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Selanjutnya berkaitan dengan hal di atas saya anggap menerima sanksi baik administratif, akademik ataupun pidana, jika saya terbukti secara kuat telah melakukan perbuatan menyimpang dari pernyataan tersebut. Saya juga akan bersikap kooperatif untuk hadir, menjawab, membuktikan dan melakukan pembelaan terhadap hak-hak saya serta menandatangani Berita Acara terkait yang menjadi hak dan kewajiban saya, di depan Majelis atau Tim FH UII yang ditunjuk oleh pimpinan fakultas, apabila tanda-tanda plagiat disinyalir terjadi pada karya ilmiah saya ini.

Demikian surat pernyataan ini saya buat dengan sebenar-benarnya dalam kondisi sehat jasmani dan rohani, dengan sadar serta tidak ada tekanan dalam bentuk dan oleh siapapun.

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Yang memberikan pernyataan,

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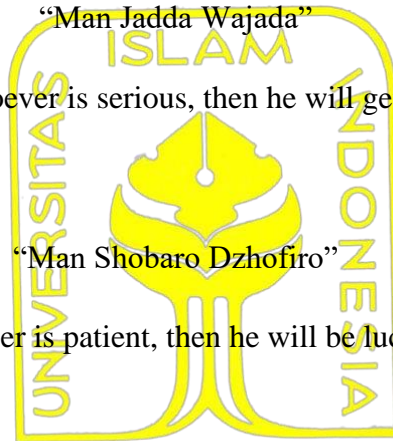
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MOTTO



“Man Jadda Wajada”

(Whoever is serious, then he will get).



“Man Shobaro Dzhofiro”

(Whoever is patient, then he will be lucky).

الجامعة الإسلامية الإندونيسية

DEDICATION



This thesis is wholeheartedly dedicated to:

Allah Subhanallah wa ta'ala,

Thanks to Allah for giving me this opportunity, strength, and patience without Allah we are nothing.

Thanks to my parents who always support me under any circumstances.

My alma mater, Indonesian Islamic University;

All lecturers and staff of the Faculty of Law at the Islamic University of Indonesia,

Who has taught me and guided me and helped me through my studies;

All friends and comrades in arms,

My moral support;



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Final Project in the form of a thesis entitled "**LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK BETWEEN INDONESIA AND SPANISH**" This is structured as one of the requirements for obtaining a Bachelor of Laws degree at the Faculty of Law, the Islamic University of Indonesia.

Thanks to the grace of Allah SWT and the help of the supervisors and the support and prayers of his beloved family, as well as the author's friends who sacrificed their time, thoughts, and energy in helping the writer overcome difficulties and obstacles in writing the thesis, so that this thesis can be completed.

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This thesis was written by the author himself using various tools references are needed by writing, so that the authenticity of this thesis can be accounted for. The author realizes that the results of this thesis in the form of this thesis still have many shortcomings, therefore the writer expects input, suggestions and constructive criticism from readers so that the writer can gain a new understanding regarding

this thesis. The author hopes that this final project can be useful for writers and readers in particular, for the development of legal science in general. May Allah SWT always give guidance to all of us.

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ABSTRAK

The diversity of the development of ideas, then someone needs to register the results of his ideas both in the form of creation and innovation. Trademark registration must be done to differentiate similar products, because they have economic value or benefits for human life. For example as happened with the Lois trademarks from Spain and Newlois from Indonesia, wherever Lois as a well-known trademark should have had trademark rights in Indonesia, but the fact is that a local Indonesian trademark with the name Newlois with the same product is widely sold in the market because the trademark is registered first. This happened because the Directorate General of Intellectual Property was negligent in registering the Lois trademark. This research brings forward the following problems: What are the similarities and differences in the legal protection of well-known trademarks between Indonesia and Spain; What are the factors contributing to the differences in the protection of well-known trademarks in Indonesia and Spain. This study uses a normative legal research method, carried out by examining literature or secondary data relating to the legal protection of well-known trademarks between Indonesia and Spain as the basic material, and then to find out the comparison between Indonesian National Law and Spanish National Law on Trademarks. The results of the discussion from the research there are some similarities between Indonesian National Law on Trademarks and Spanish National Law on Trademarks, such as regulations regarding the meaning of a trademark, first to file, and compensation in civil lawsuits. Besides, there are also differences, including the regulation regarding Geographical Indications and the application of criminal law in trademark disputes. Politics of law, legal system, and legal culture are factors that caused the distinction between Indonesian and Spain legal protection.

Keywords: *Trademark, Legal Protection, Intellectual Property Rights*

CHAPTER I

INTRODUCTION

A. Context of Study

Progressive development of business and economy has led to a rapid trade among countries and the many variants of goods and services circulating on the market, local trade provisions which provide a lot of convenience and convenience for economic actors to carry out their trading activities with various reliefs that make it easier for them to trade. Trademarks have an important role in global economic development, the existence of the trademark itself is useful for differentiating similar products. If the trademark owner has not been registered/without permission, it can be detrimental to himself, because business competition is getting tougher and there is a possibility of fraud or goods that imitate the trademark.¹

Diversity of goods and services raises awareness of the importance of legal protection of Intellectual Property Rights which includes matters concerning trademarks, patents, copyrights, industrial designs, plant varieties, and geographical indications for the protection of trade secrets. This awareness gave birth to the Trade Relations Aspects of Intellectual Property Rights agreement, which is an international agreement under the World Trade Organization in the field of Intellectual Property Rights in trade to uniform the system of Intellectual Property

¹ Rahmi Jened, *Hukum Merek (Trademark Law) Dalam Era Global & Integrasi Ekonomi*, Kharisma Putra Utama, Jakarta, 2015, pg. 3.

Rights. Indonesia itself also participated in the agreement by participating in ratifying the World Trade Organization and the GATT (General Agreement on Tariffs and Trade) agreement through Law No. 7 of 1994. TRIP's itself was part of the GATT which was negotiated at the end of the Uruguay round. Thus, effective Indonesia must harmonize Indonesian laws and regulations in the field of IPR with those specified in TRIP's.

The issue of Intellectual Property Rights cannot be separated from the world of trade and investment. Intellectual Property Rights have an important role in economic development and trade which has spurred the start of a new era of science-based economic development. Trademarks are part of intellectual property rights, so there is a need for legal protection of trademark rights. Because nowadays there are often counterfeiting or piracy of well-known trademarks which of course have violated the law by producers of goods and/or services who do not have good intentions.

The theoretical basis for justification for the protection of Intellectual Property Rights states that Intellectual Property Rights are the result of a creation or an initial invention that has not been registered as a patent, for example opening up the possibility for other parties to be able to find out or further develop the invention produced by the inventor secretly. Therefore, fundamental inventions that have not been registered or published must also be protected, although they may not be able to obtain protection under patent, copyright, and design laws, but can be categorized as trade secrets or confidential information. With the justification

for the protection of Intellectual Property Rights, this certainly further emphasizes the importance of protecting Intellectual Property Rights.²

The existence of legal protection for the owner of a legal mark is intended to provide exclusive rights for the owner of the mark (exclusive right) so that other parties cannot use the same or similar marks as their own for the same or almost the same goods or services. "Special rights tend to be a monopoly, meaning only the owner of the mark who can use the right holder can use the mark without violating the existing rules in the use of the mark, as well as prohibiting other parties from using the mark or giving permission.³

Article 1 number 1 of Law Number 20 of 2016 concerning Marks and Geographical Indications states that Mark means any sign capable of being represented graphically in the form of drawings, logos, names, words, letters, numerals, colors arrangement, in 2 (two) or 3 (three) dimensional shape, sounds, holograms, or combination of 2 (two) or more of those elements to distinguish goods and/or services produced by a person or legal entity in trading goods and/or services. From this definition, the form of a trademark can be divided into traditional trademarks, in the form of pictures, logos, names, words, letters, numbers, color schemes, or trademarks that take the form of 2 (two) dimensions and non-traditional trademarks, in the form of sound, 3 (three) dimensional trademarks, or holographic trademarks. The trademark is always identified with the

² Budi Agus Riswandi, *Selayang Pandang Hak Cipta Indonesia*, Total Media, Yogyakarta, 2009, pg. 5.

³ Agung Sujatmiko, *Aspek Yuridis Lisensi Merek dan Persaingan Usaha*, Jurnal Hukum Pro Justitia, 2008, Vol. 26/No. 2, pg. 94.

identity of a product produced by the manufacturer, which then becomes an asset for the producer.

The identity of a product also describes the quality of an item and also indicates that the item has its own characteristics. In everyday life around us, there is a lot of piracy of a trademark. Trademark piracy is often carried out with different quality goods so it has an impact on two things, namely economic stability and related to consumer protection guarantees for these goods.⁴ There is also a stipulation that the mark can be accepted and considered a well-known mark is that the well-known mark must have sufficient distinguishing power. In other words, the sign used by a trademark must have a special character as a differentiator between goods produced by a company or commercial goods (trade) or services from one person's production with goods or services produced by other people.

Whereas based on the laws of Spain, it can be said that a trademark that has received legitimacy as a well-known mark must be protected by the law of a country because well-known marks have a higher risk of being counterfeited or used as mounts by parties who are not responsible for selling their merchandise by imitating well-known trademarks because the reputation of well-known trademarks has been trusted by the public, this has a significant impact on trade in goods with trademarks that resemble well-known trademarks.⁵

The number of trademark infringements in Indonesia indicates that trademark protection in Indonesia has not been maximized, this of course causes

⁴ Hery Firmansyah, *Perlindungan Hukum Terhadap Merek*, Yustisia, Jakarta, 2001, pg. 29.

⁵ Sri Ahyani, *Perlindungan Merek Terhadap Plagiasi*, Jurnal Wawasan Hukum, Bandung, 2012, pg.54.

losses for producers whose trademarks are registered but have been imitated by other manufacturers. Many cases of trademark infringement are the result of the lack of firmness of the authorities, in this case, the Directorate General of Intellectual Property was inaccurate and less giving warnings to parties known to be distributing products whose trademarks do not match the registered marks. This is because the DJKI is passively waiting for reports from the aggrieved parties for cases of infringement of their marks to be imitated.⁶

In addition, the easy acceptance of applications for trademark registration is granted is one of the causes of violations as unfair business competition. With trademark rights, the mark used as a mark should be the monopoly of the trademark owner, so that other parties cannot use the same or similar trademarks even though the types of products produced are different. The trademark protection used by Spain is the Paris Convention and the TRIPs Agreement, which explains the protection of a mark if the mark has been registered in the country of origin, then the trademark request for the mark is accepted for submission and protected in that country. Article 6 bis of the Paris Convention states that, to the extent permitted by domestic law, the Unitary State has the right to refuse or cancel the registration or prohibit the use of trademarks that are reproductions, copies, or translations, causing confusion.

Registration at the relevant industrial property office in Spain is a prerequisite to obtaining the protection of intellectual property in Spain, for

⁶ Nurul Hidayati dan Naomi Yuli Ester S., "Trademark Protection Urgency Through The Madrid Protocol", *Jurnal Legislasi Indonesia*, Volume 14/No. 02, Direktorat Jenderal Peraturan Perundang-undangan Kementerian Hukum dan HAM, 2017, pg. 172.

example follows the “first-to-file” system, which means that the first person to apply for registration will obtain the relevant rights. The use of well-known trademarks does not confer any rights on third parties except in the case of well-known trademarks which means Registration requires payment of an official fee, the amount of which depends on circumstances such as the specific type of rights applied for, the number of classes, and territory.⁷ The registration of a trademark or a patent in the country of origin by the owner does not confer automatic protection in other countries. Consequently, protection must be sought through additional registrations in each relevant country, in Spain the principle of territoriality entails that the protection conferred by intellectual property rights is only available in the country or countries in which registration has been obtained.

In order to make it easier to protect intellectual property rights in different territories, Spain has ratified the main international conventions in this area. With rare exceptions, international intellectual property treaties allow non-Spanish nationals to protect their rights in Spain, and Spanish nationals to enjoy protection in most other countries. Spain’s membership in the European Union has also favored Spanish legislation to be in line with that of the rest of the EU Member States.⁸ Register a trademark in Spain by filing an application at the Spanish Patents and Trademarks Office the application process takes approximately between 6 and 15 months. Spanish trademarks may consist of words, names or surnames,

⁷ Garrigues, *Guide to Bussines in Spain 2022*, ICEX, Madrid, 2022, pg. 4.

⁸ Garrigues, *Op. Cit*, pg. 5.

signatures, numbers and number combinations, slogans, drawings, sounds, colors, and three-dimensional shapes, including packaging.⁹

The SPTO awards trademarks for products and services and trade names that provide legal protection for distinctive signs. Service marks can no longer be registered. Service marks awarded previously remain registered, however, until the final twenty or ten-year period they were granted or renewed for expires. The protection conferred by distinctive signs has a duration of ten years starting from the date the application was filed and can be renewed for an indefinite period. Fees must be paid to ensure that the distinctive signs remain in effect. Different fees apply to trademarks while they are being processed.¹⁰

The Lois trademark is used by the Saez company Moreno group in Spain which began production in 1950 until today. The Saez Moreno group began to develop with the production of goods in the form of jeans which then shot to expand outside Spain, namely European countries so that its products penetrated the vastness of the country itself.¹¹

The Lois trademark penetrates regional boundaries so that it can be categorized as a well-known trademark, which at first was only based on marketing in the city of Valencia and then developed in other countries. Saez Moreno group is a garment company that provides a variety of fashion products but is more famous than jeans. Lois then penetrated outside Europe into countries that are further afield,

⁹ SPTO explains “the Public Body responsible for the registration and granting of the different types of Industrial Property”.

¹⁰ Garrigues, *Op. Cit.*, pg. 6.

¹¹ on <https://loisjeans.id/> accessed on October 30, 2022.

namely, Argentina, Arabia, Hong Kong, the Philippines, Malaysia and reached Indonesia in 2003.

The Lois mark is registered as a well-known international mark to protect these countries, so the protection obtained by the Lois mark is absolutely mandatory for the respective country where the mark is registered. The entry of the Lois trademark into Indonesia through a licensing process, this licensing process is a process of transferring a trademark with an agreement to be implemented in Indonesia. The transfer process through this agreement was accepted by PT. Intigramindo Persada which is located on Jalan Marble 31 Sumur Batu Kemayoran, Central Jakarta. Licensing is basically an agreement between the two parties to agree that there has been a transfer of responsibility for a trademark with one party giving rights to the other giving the obligation to carry out the things that have been agreed upon by each party. PT. Intigramindo persada was founded in 1978 and is engaged in fashion trademarks, thus making the Saez Moreno Group believe in PT. Intigramindo to license the Lois trademark in Indonesia through PT. Intigramindo because it has similarities in the implementation of business products.¹²

It has been found pants products with the trademark Newlois and Redlois at the Gerimis Store in the Tanah Abang area on 15 until 18 April 2015 in Central Jakarta owned by Agus Salim, the registration of the Newlois and Redlois trademarks were registered in bad faith by piggybacking, imitating or plagiarizing the Lois trademark. So Intigarmindo Persada made a report to the Directorate

¹² Indo Trademark, "Pemegang Lisensi LOIS Gugat NEWLOIS", on https://indotrademark.com/baca-43-Pemegang_Lisensi_LOIS_Gugat_NEWLOIS.html?lang=id accessed on October 30, 2022.

General of Intellectual Property (DJKI) to follow up on alleged trademark crimes. Investigations related to witnesses, experts, and evidence were carried out, and the holder of the Lois trademark license, PT Intigarmindo Persada, filed a lawsuit for the cancellation of the Newlois and Redlois trademarks. The two trademarks are considered to have a fundamental similarity to the Lois trademark belonging to Lois Trade Mark-Consultores E Servicios S.A. The Director General of IP then decided to stop it on the grounds that no criminal acts were found. The agency in charge of trademark protection in Indonesia even found evidence of Agus copyright registration. Thus, the Newlois and Redlois trademarks get legal protection.

Agus trademark trademarks have been since registered on 28 July 2005, with registration numbers IDM000043020 and IDM000043201. In this case, Intigarmindo Persada also included DJKI as a co-defendant. Moreover, the Lois trademark belonging to Lois Trade Mark-Consultores E Servicios S.A was filed first, namely on May 12, 2003. Meanwhile, Agus only applied for the trademark on July 28, 2005. In its petition, Intigarmindo Persada asked the panel of judges to cancel Agus Salim's Newlois and Redlois trademarks because they have similarities in principle with Lois Trade Mark-Consultores E Servicios S.A. Based on this, the writer wants to examine the comparison of the legal protection of well-known marks that occur in Indonesia and Spain, and explain the differences and similarities in legal protection that occurs in Indonesia and Spain.

B. Problem Formulation

Based on the description of the background above, this research will discuss:

1. What are the similarities and differences in the legal protection of well-known trademarks between Indonesia and Spain?
2. What are the factors contributing to the differences in the protection of well-known trademarks in Indonesia and Spain?

C. Objective of Research

According to the problem formulation above, this research has the following objectives:

1. To determine the similarities and differences in legal protection that occurs in Spain and Indonesia, especially the counterfeiting of well-known trademarks.
2. To determine the causal factors in the legal protection of well-known trademarks in Indonesia and Spain.

D. Originality of Research

This research was conducted by referring to the preceding studies having similar topic such as in the following:

First, the research written by Astrid Rahma Ayu, Syarif Hidayatullah State Islamic University Jakarta (2019), with the title "Tinjauan Yuridis Terhadap Merek Dagang Hugo Boss Dalam Putusan Mahkamah Agung Republik Indonesia Nomor: 92K/PDT.SUS-HKI/2017". This research examines the problem of loss to one party, due to bad faith and trying to ride the fame of Hugo boss because the brand is already a trademark. Meanwhile, this study will discuss the legal protection of trademark marks in two different countries and finds the similarities and differences in legal protection.

Second, the research written by Irfan Nursalim, Syarif Hidayatullah State Islamic University Jakarta (2021), with the title “Perlindungan Hukum Pemegang Merek Terkenal Lois Internasional Tidak Terdaftar Menurut Hukum Kekayaan Intelektual Indonesia (Penelitian tentang Analisis Putusan Nomor 789 K/Pdt.sus-HKI/2016)”. The similarities between the previous researches with the current research is on the object of the research i.e. the Lois and Newlois trademarks. The Lois and Newlois trademarks. However, the difference is that the previous research only used legal sources in Indonesia, while the research that will be carried out by the author also uses Spanish legal sources as a comparison.

E. Literature Review

1. Well--Known Concept

Trademark is a product that has a very good reputation, high value, great appeal to the public, and is suggestive because it is widely known in all around the world. Regulations regarding trademark marks until the amendment of the trademark law into law number 20 of 2016 concerning trademarks and geographical indications have not defined trademarks concretely.¹³

Based on the explanation of Article 21 paragraph (1) letter b of Law Number 20 of 2016 concerning Marks and Geographical Indications, it has been explained that the determination of the recognizability of a trademark must be carried out by considering the general knowledge of the public regarding the mark in the relevant business field, and taking into account its reputation as an A trademark mark

¹³ Yulisar Ningsih, *Perlindungan dan Penegakan Hukum Merek di Indonesia*, Matraman, Jurnal Matraman, 2003, pg. 26.

obtained due to massive promotion, investments in several countries in the world by the owner, and accompanied by proof of registration of the mark in several countries in the world. If the above matters are not considered sufficient, the Commercial Court may order an independent institution to conduct a survey in order to obtain conclusions regarding the popularity of the Mark which is the basis for rejection.

If the history is drawn from the previous law, the regulation regarding trademarks in Indonesia is indeed very minimal and abstract. Therefore, a trademark is a foreign product submitted by a trademark owner who resides or is domiciled outside the territory of the Republic of Indonesia which has penetrated the Indonesian market and has been known for a long time in Indonesia and abroad.¹⁴

2. Well Known Protection System

The basis for the protection of Intellectual Property Rights on several justifying reasons, namely the theoretical approach. First, that creators in the fields of science, art, and literature, or inventors in the field of new technology, either in the form of trade secrets or patents, must be given an award and recognition as well as legal protection for the success of their efforts in producing the new work. The inventor who has spent a lot of energy, thought, time and money, deserves to be given exclusive rights to exploit intellectual property rights in order to get back the economic benefits for the hard work he has spent. Incentives are given to stimulate

¹⁴ M.Yahya Harahap, *Tinjauan Merek Secara Umum dan Hukum Merek di Indonesia*, Bandung, PT. Citra Aditya Bhakti, 1996, pg. 105.

creativity in an effort to create works in the fields of technology, art, and science because without incentives creativity will be hampered.

Second, it is different from trade secrets in other intellectual property fields, such as patents which are basically open, meaning that their inventions must describe or disclose their findings clearly and in detail as one of the requirements for registering a patent. This situation poses a potential risk because other people can learn or carry out the invention without rights. Therefore, in return, the inventor is given a special (exclusive) right to exploit his invention for a certain period of time, so any violation of this can be prosecuted civilly and criminally.

Third, Intellectual Property Rights which are the result of an initial creation or invention that has not been registered as a patent, for example, open the possibility for other parties to be able to find out or further develop the design secretly produced by the inventor. Therefore, fundamental inventions that have not been registered or published must also be protected, although they may not be able to obtain protection under patent, copyright, and design laws, but can be categorized as trade secrets or confidential information. With the justification for the protection of intellectual property rights, this indeed emphasizes the importance of protecting intellectual property rights.

3. Infringement of Well-Known Trademarks

Bad faith in registration can be interpreted as an act intentionally carried out by another party by imitating other people's trademarks that have been previously registered. If other business actors do not show any intention when registering a trademark, then the registration must also be rejected because it will have an impact

on fraudulent actions in a business. In principle, trademark registration in Indonesia is not allowed to commit fraudulent acts by using other people's marks in bad faith. Bad faith in trademark registration can be classified as follows:¹⁵

- a) Pre-existing trademarks and brand actions already have a good name among consumers.
- b) Acts committed intentionally by other parties who aim to get as much profit as possible without paying attention to the losses of business actors who have registered their trademarks.
- c) The act of registering a mark in bad faith is already classified as an act against the law, because in the Law on trademarks and Geographical Indications it is not allowed to register a mark in bad faith.

Because the trademark that is well known to the public sells quickly in the market so it will bring relatively large profits in a relatively fast time. Actions that try to gain profits through shortcuts violate business ethics, and moral norms, and even violate the law. The use of such Marks or marks includes unfair competition.

4. Regulation of Well-Known Trademarks in Indonesia

First to File System in Providing Trademark Protection, countries with a civil law legal system including Indonesia, follow the First to file system in granting trademark rights. Based on the First to file system, the owner of a trademark including well-known marks, must register his mark at the Directorate General of Intellectual Property (DGT) to obtain exclusive rights to his mark and legal

¹⁵ Irfan Nursalim, Thesis: *Perlindungan Hukum Pemegang Merek Terkenal Lois Internasional Tidak Terdaftar Menurut Hukum Kekayaan Intelektual Indonesia*, Jakarta, UIN Jakarta, 2021, pg.61.

protection. Exclusive rights cannot be obtained by the owner of the mark only by showing evidence that he is the first user of the mark in Indonesia. The first-to-file system means that the party who first applies for registration is given priority to obtain the registration of the mark and is recognized as the legal owner of the mark.¹⁶

according to the article explains, this principle is explicitly regulated in Article 3 of Law Number 20 of 2016 concerning Marks and Geographical Indications of the MIG Law which stipulates that the right to a mark is obtained after the mark is registered. What is meant by the word "registered" is after the application goes through a formal examination process, an announcement process, and a substantive examination process and obtains approval from the Minister of Law and Human Rights to issue a certificate.

According to the explanation of Article 21 paragraph 1 letter b of Law Number 20 of 2016 concerning Marks and Geographical Indications, it has been explained that the determination of the recognition of trademarks must be carried out by taking into account the general knowledge of the public regarding the mark in the relevant business field, and also taking into account its reputation as a well-known mark obtained due to large-scale promotions, investment in several countries in the world by the owner, and accompanied by proof of registration of the trademark in several countries in the world. If the above matters are not considered sufficient, the Commercial Court may order an independent institution

¹⁶ Lucky Setiawati, S.H., "*Perlindungan Merek Terkenal yang Tidak Terdaftar di Indonesia*", on https://www.hukumonline.com/klinik/a/merek-terkenal-yang-tidak-terdaftar-cl5892#_ftnref3, accessed on August 20, 2022.

to conduct a survey in order to obtain conclusions regarding the popularity of the Mark which is the basis for rejection.¹⁷

5. Regulation of Well-Known Trademarks in Spain

Registration of a Spanish trademark through the relevant industrial property office is a prerequisite for obtaining intellectual property protection. Spain unlike the United States and Indonesia follows a “first-to-file” system, which means that the first person to apply for registration gets the relevant rights. Use does not confer any rights against third parties except in the case of well-known trademarks. Registration requires the payment of an official fee, the amount of which depends on circumstances such as the type of privileges applied to the number of classes, and the region.¹⁸

Spain uses the territorial principle to carry out registrations, which requires that the protection provided by intellectual property rights is available in principle only in the country or countries in which the registration has been obtained (or in the case of copyright, in the country where protection is sought). Thus, registration of a mark or patent in the country of origin by the owner does not necessarily provide protection in other countries. Consequently, protection must be sought through additional registration in each relevant country.

Text the Amendments made by Law 20/2003, on Legal Protection of Industrial Designs Regulation of Spain in the concept of a trademark mentioned in

¹⁷ Irfan Nursalim, Thesis: *Perlindungan Hukum Pemegang Merek Terkenal Lois Internasional Tidak Terdaftar Menurut Hukum Kekayaan Intelektual Indonesia*, Jakarta, UIN Jakarta, 2021, pg. 21.

¹⁸ *Ibid*, pg. 5.

article 4 paragraph (1) “A trademark means any sign able to be represented graphically and used to distinguish in the market the goods, or services of one company from those of other companies”. and registration prohibitions mentioned in article 8 paragraphs (1)-(3) “A sign which is identical or similar to a prior trademark or trade name may not be registered as a trademark, even though its registration is requested for goods or services not similar to those protected by said prior signs, where, since the latter is known or famous in Spain, the use of such a trademark might indicate a connection between the goods or services covered by it and the owner of said prior signs or, in general, where that use, made without just cause, might constitute improper exploitation of, or detract from, the distinctive character, notoriety or fame of said prior signs”.

Paragraph (2) “For the purposes of this Law, “known trademark or trade name” means one which, owing to its sales volume, the duration, intensity, or geographical scope of its use, its value or prestige achieved in the market or for any other reason, is generally known in the relevant public sector for which the goods, services or activities distinguishing said trademark or trade name are intended. Where all the requirements provided for in Article 1 are satisfied, the protection granted in paragraph (1) shall cover goods, services, or activities as much more different in nature as the extent of knowledge of the known trademark or trade name is greater in the relevant sector of the public or in other related sectors”.

Paragraph (3) “Where the trademark or trade name is known to the public in general, it shall be considered that they are famous and the scope of the protection shall extend to any type of goods, services, or activities”.¹⁹

F. Research Method

1. Type of research

This research is normative legal research, which according to the legal expert is referred to a process of finding a rule of law, to find a rule of law, legal principles, and legal doctrines to answer the legal problems faced.²⁰

2. Approach method

The problem approach used in this study is statutory and comparative. A statutory approach is an approach that is carried out by examining and studying the statutory regulations relating to the legal issues to be studied.²¹ While the comparative approach adopted from English comes from Latin namely comparative, which means the ability to use a method to find out similarities or differences that are determined by simultaneous testing of two or more things.²² Then, this study also uses the case approach method by examining cases that already have final and binding decisions.

¹⁹ Text Including the Amendments Made by Law 20/2003, of July 7, 2003, on Legal Protection of Industrial Designs.

²⁰ Johnny Ibrahim, *Normative Legal Research Theory and Methodology*, Surabaya, Bayumedia Publishing, 2005, pg. 5.

²¹ Peter Mahmud Marzuki, *Penelitian Hukum* (edisi revisi), pick up from Moch. Chairul Rizal, *Ragam Metode Penelitian Hukum*, Lembaga Studi Hukum Pidana, Kediri, 2022, pg. 28-29

²² Philip Babcock Gove, *Webster Third New International Dictionary*, Massachussets, Meriam Company, 1996, pg. 461.

3. Research object

The object of research that the author will examine is based on the formulation of the problem, namely:

- a) Legal protection between well-known trademark disputes that occur in Indonesia and Spain, based on law number 20 of 2016 Law on Trademarks and Geographical Indications and article 8 on Known and Famous Registered Trademarks and Trade Names, Spanish law number 17 of 2001 on trademarks.
- b) Differentiating factors and similarities that occur in the legal protection of well-known trademarks in Indonesia and Spain.

4. Research data sources

Sources of the data that will be used in this study are secondary data that will be obtained by tracing legal materials which include:

- a) **Primary Legal Sources**
Primary legal sources are legal materials that are authoritative or in other words have authority. Primary legal sources include statutory regulations and all official documents containing legal provisions, among which the authors will use, namely:
 - 1) The 1945 Constitution of the Republic of Indonesia;
 - 2) Commercial Code;
 - 3) Civil Code;
 - 4) Law Number 28 of 2014 on Copyrights;
 - 5) Law Number 20 of 2016 on Trademarks and Indications Geography;

- 6) Commercial Court at the Central Jakarta District Court's Decision Number 04/Pdt.Sus/Merek/2016/PN Niaga Jkt. Pst.;
- 7) Spanish Law Number 17 of 2001 on Trademarks;
- 8) Spanish Law Number 20 of 2003 Regarding Legal Protection of Industrial Design.

b) Secondary Legal Sources

This study will use secondary legal sources such as documents or legal materials that provide explanations of primary legal sources such as books, the internet, journals, research results, and so on that are relevant to the issues to be discussed.²³

5. Data collection techniques

The methods of collecting legal sources are library research and documentary research. The literature study was conducted to obtain materials in the form of legal theories, legal principles, doctrines, and legal rules obtained from primary legal sources, secondary legal sources, and tertiary legal sources. While the documentary study is a study that examines various documents, both related to laws and regulations and other documents that already exist.²⁴

6. Data analysis method

The analytical method that will be used in this source is qualitative analysis, which is conducted by collecting data obtained from primary and secondary data

²³ I Ketut Suardita, "Pengenalan Buku Hukum", on https://simdos.unud.ac.id/uploads/file_penelitian_1_dir/7847bff4505f0416fe0c446c60f7e8ac.pdf, accessed on November 2, 2022.

²⁴ H. Ishaq, *Metode Penelitian Hukum dan Penulisan Skripsi, Tesis, serta Disertasi*, Alfabeta, Bandung, 2017, pg. 251.

sources which are then structured systematically, so the conclusions can be made easily to help to answer existing problems.

G. Systematic of Writing

The thesis is systematically structured into 4 chapters. The systematics of this writing is as follows:

CHAPTER I Introduction

In this chapter, the author presents the background of the problem, problem formulation, objectives of the research, originality of research, literature review, and research methods.

CHAPTER II Literature Review

In this literature review, the author will explain the sources related the legal protection of well-known trademarks in Indonesia and Spain, and then a comparison between the laws in Indonesia and Spain.

CHAPTER III Research Results and Discussion

In this chapter, the author will analyze the legal protection similarity for well-known trademarks, and make a comparison between the advantages and disadvantages of applicable laws in Indonesia and Spain.

CHAPTER IV Closing

This chapter is the last part of this research or can be called the closing chapter which contains conclusions and suggestions from the results of this study. Then ends with a bibliography that has become the author's reference in conducting research.

CHAPTER II

REVIEW THEORY OF LEGAL PROTECTION FOR WELL-KNOWN TRADEMARK BETWEEN INDONESIA AND SPANISH

A. Trademark Overview

1. Definition and Types of Trademarks

According to the Big Indonesian Dictionary, the word "trademark" is defined as a sign worn by an entrepreneur on the goods he produces as an identification mark (stamp, and mark) that becomes an identifier for mentioning a name. A mark is a symbol to distinguish goods and or services produced by business actors with the aim of differentiating them from goods or services produced by other business actors. Based on the Trademark Law, an amendment to Law Number 15 of 2001, it is explained that a Mark is a sign in the form of an image, name, word, letter, number, arrangement of colors, or a combination of these elements which has distinguishing features and is used in trade in goods or services.²⁵

According to Kotler & Keller, a trademark is a product or service whose dimensions differentiate the trademark in some way from other products or services to satisfy the same need. Meanwhile, according to Tjipton, a trademark is a seller's promise to consistently deliver certain sets, characteristics of benefits, and services to buyers. Trademarks can convey six levels of meaning, namely attributes, benefits, values, culture, personality, and use.²⁶

²⁵ Harsono Adisumarto, *Hak Milik Intelektual Khususnya Hukum Paten dan Merek*, Jakarta, Akademika Presindo, 1990, pg. 19.

²⁶ Enny Mirfa, *Perlindungan Hukum Terhadap Merek Terdaftar*, Aceh, Jurnal Hukum Samudra Keadilan, 2016, pg. 67.

From this definition, it can be concluded that the definition of a trademark is an attribute that is part of a product that is useful as a sign, name, or term used to promote goods or services. With the aim of being a differentiator from competitors to become an identification of these products and designed to satisfy consumer needs such as conveying the characteristics and benefits consistently to consumers.

Accordance with the provision that the state grants recognition of trademark rights, registration of trademarks is a must if he wants to be legally considered as a person entitled to a trademark. For the person who registers the trademark, there is a legal certainty that he is the owner of the mark. Article 3 of the Trademark Law states that rights to trademarks are exclusive rights granted by the state to trademark owners who are registered in the general register of trademarks for a certain period of time by using the trademark themselves or giving permission to other parties to use it.²⁷

Regarding the validity period of the rights to a trademark according to Article 3, namely the protection provided is "exclusive" meaning as long as the trademark is registered in the general register of trademarks for a certain period of 10 years then it can be extended.²⁸

Trademark is a sign, but in order for the sign to be accepted by a community, it must have differentiate power, this is due to trademark registration, which relates to the granting of exclusive rights granted by the state on a name or symbol to a business actor. In order to have differentiating power, the trademark in question

²⁷ Sudarga Gautama, *Hukum Merek Indonesia*, Jakarta, Citra Aditya Bakti, 1993, pg. 21.

²⁸ Insan Budi Maulana, *Kapita Selekta Hak Kekayaan Intelektual*, Yogyakarta, Pusat Studi Hukum UII, 2000, pg. 89.

must be able to provide determination or "individualization" of the goods in question. The occurrence of differences in the fame of a trademark also distinguishes the degree of fame that is owned by various trademarks. There are 2 types of trademarks recognized by the Public:

- a. Ordinary Trademarks, also known as “normal marks”, are classified as ordinary trademarks and are those that do not have a high reputation. Trademarks that fall into this category can be said to play less of a role in enlivening business competition in the market. Its marketing reach is very narrow and limited to the local area, so this type of trademark is not considered a major competitor, nor is it a target for traders or entrepreneurs to imitate or fake.
- b. Well-known Trademark, also known as a "well-known mark". This type of trademark has a high reputation because the symbol has the power to attract attention. For example, Honda products, both motorcycles, and cars, even exist in an area that mentions Honda for all motorcycle trademarks. So that the Honda trademark can be categorized as a well-known trademark, (well-known mark) because of public knowledge about this trademark both at home and abroad.

2. Trademark’s Main Function

The main function of a trademark is to differentiate similar goods or services produced by other companies so that a trademark is said to have a differentiating function, with the intention of giving an identity to goods or services that guarantees the quality of goods and services for consumers. Trademarks can also be an advertising tool to help advertise and promote a product. In addition, trademarks also have strategic and important values for producers (entrepreneurs). For

manufacturers, apart from being a trademark to differentiate it from other similar products, it is also intended to build a corporate image in marketing (market).

Another trademark function is:

- a. **Maintaining fair business competition** This applies to maintaining a balance between the interests of business actors and the public interest by creating a conducive business climate through creating fair business competition and ensuring certainty of equal business opportunities for everyone and preventing unfair business competition caused by business actors. business by creating effectiveness and efficiency in business activities.
- b. **Protecting consumers** Based on the Considerations of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, it states that one of the objectives of establishing the law is to provide protection for consumers, improve services, and provide legal certainty for business actors. With a trademark, consumers no longer need to investigate the quality of the goods. If the trademark is well-known for its quality by consumers buying the goods, consumers will be sure that the quality of the goods is as good as expected.
- c. **As a means for entrepreneurs to expand their business fields**, trademarks of goods that are already known by consumers as a sign of high-quality goods will expedite the marketing efforts of the goods in question.
- d. **As a means to be able to assess an item** Quality of goods is certainly not always good or can give satisfaction to everyone who buys it. The good or bad quality of an item depends on the producer himself and the assessment given by each buyer. A trademark can give confidence to buyers that all goods that use the

trademark are at least of the same quality as specified by the manufacturer that issued them.

- e. To introduce goods or product names, a trademark has a function as a means of introducing goods or product names (promotion) to the general public. Buyers who are familiar with the trademark name, either because of their own experience or because they have heard it from other parties when they need the product, it is enough to remember the trademark name. For example, if someone wants to buy a Fanta trademark drink, then it is enough just to mention Fanta.
- f. To introduce corporate identity There are times when a trademark is used to introduce the name of the company that uses the trademark. For example, the Djarum trademark, Djarum is the trademark used by the Djarum cigarette company.²⁹

3. Definition of Trademark Legal Protection

Legal protection has a meaning such as the means provided by law to legal subjects for all the actions that are carried out against the interests of themselves and others. In fact, legal protection is an attempt by the state to integrate and harmonize legal interests between different legal subjects within a country. This is related to a mark in the country, the state must be present in the context of protecting a registered mark as part of the legal function that must work within the trademark.

In general, legal protection for a trademark only applies to trademarks that have been registered. International protection is needed for the trademark of a

²⁹ Hery Firmansyah, *Op. Cit.*, pg. 33.

product that is traded across national boundaries. The function of the trademark, namely as the identity of a particular product or company, so that consumers can differentiate between products between one product and another for the same type of product.³⁰

Legal protection is an important part of forming a law, if the law is without a protective mechanism it will be like a norm that cannot be used in society, therefore the presence of law is solely to guarantee legal protection for parties whose rights may be suppressed or violated by others enjoy all the rights granted by law. This definition refers to the protection of rights that should be obtained by all people on the basis of protection from the law so that events that harm the rights of others do not occur.

According to Muktie, A Fadjar, the judge of the Constitutional Court of the Republic of Indonesia stated that legal protection is the protection provided by law, related to the existence of rights and obligations, in this case, owned by humans as legal subjects in their interactions with fellow humans and their environment. As legal subjects, humans have the rights and obligations to take any given legal action by the state by protecting the legal subject. So, the conclusion is that legal protection is a legal effort that can provide protection for human rights so that they feel safe physically and mentally from threats or interference from other parties. This right of protection must be felt by everyone so that events that are detrimental to each other do not occur

³⁰ Sentosa Sembiring, *Produser dan Tata Cara Memperoleh Hak Kekayaan Intelektual di Bidang Hak Cipta, Merek dan Paten*, Bandung, Yrama Widya, 2002, pg. 32.

B. Overview of Intellectual Property Law in Indonesia

1. Intellectual property Legal Base in Indonesia

Legal basis for Intellectual Property Rights in Indonesia is following the Paris Convention for the Protection of Industrial Property which was the first convention on IPR in 1883 in Paris, where trademark protection began to be regulated internationally. This convention is an international convention in the field of IPR which is very important because it lays the foundations for IPR protection and provides guidelines for the scope of IPR issues for countries around the world. Apart from that, there is also WIPO (World Intellectual Property Organization) which was founded in 1883 whose job is to promote and protect intellectual property rights around the world.³¹

Indonesia has officially entered the globalization of trade with the enactment of the Convention establishing the World Trade Organization (WTO Convention) including the Agreement on Trade-Related Aspects of Intellectual Property Rights contained in TRIPs. Article 7 of the Law states that the protection and law enforcement of Intellectual Property Rights (IPR) aims to encourage the emergence and development of innovation, transfer, and dissemination to take advantage of the economies of nations in the world. From Indonesia's participation in the WTO (World Trade Organisation) and TRIPs, the Indonesian State must adapt to these provisions as consistent with the ratification that has been carried out

³¹ Agung Sudjatmiko, *Perlindungan Hukum Hak Atas Merek*, Yuridika, Vol. 15 No. 5 September-Agust, 2000, pg. 349.

by Indonesia, changes to existing laws, and the establishment of Law no. 15 of 2001 which revised Law no. 14 of 1997.

Government of Indonesia has ratified the Paris Convention with the Decree of the President of the Republic of Indonesia Number 15 of 1997 concerning the Amendment to Presidential Decree Number 24 of 1979 concerning the Ratification of the Paris Convention for the Protection of Industrial Property and the Convention on the Establishment of World Intellectual Property Management, by revoking the requirements (reservation) of Articles 1 through Article 12. As a consequence, Indonesia must pay attention to substantive provisions which form the basis for regulation in laws and regulations in the field of marks, apart from patents and industrial designs. On May 7, 1997, the Trademark Legal Treaty was ratified by Presidential Decree No. 17 of 1997.

2. Provisions Concerning Intellectual Property Registration in Indonesia

Trademark is "a sign of distinction" for goods or services for one company from another. As a differentiating sign, the trademarks in one classification of goods/services may not have similarities with one another, either in whole or in principle. The definition of equality as a whole is if it has similarities in terms of origin, nature, method of manufacture, and purpose of use.

The definition of equality in essence is if they have similarities in terms of origin, nature, method of manufacture, and purpose of use. The definition of equality in essence is if it has similarities in form equations, equations in the way of placement, similarities in form and ways of placement, and similarities in the

sound of speech. Trademarks on goods are commonly referred to as used/attached to goods that are traded by a person or several persons, or a legal entity.

Trademark as a distinguishing sign may be in the form of a name, word, image, letters, numbers, color arrangement, or a combination of these elements. Signs that are prohibited from being used as a trademark include

- a. Signs that have no distinguishing features, for example only a piece of line, a very complicated or tangled line.
- b. Signs contrary to decency and public order, such as pornographic images or offensive religious feelings.
- c. Signs in the form of a description of the goods, for example trademark of peanuts for peanut products.
- d. Signs that have become public property, for example traffic signs.
- e. Common words, for example, the word house, city, and so on.³²

The procedure for registering a mark according to the Directorate General of Small and Medium Industries Ministry of Industry, namely:

- 1) Submit an application according to the Mark registration form in 4 copies.
- 2) Make a statement that the applicant doesn't use other people's trademarks both as a whole and in principle the same.
- 3) Make a power of attorney if the applicant approves the Mark registration application.
- 4) Application attachments such as:

³² “Direktorat Jenderal Industri Kecil Menengah Departemen Perindustrian”, accessed on 10 April 2022, Jakarta, 2007, pg. 2

- a) Legalized photocopy of KTP Photocopy of the deed of establishment of legal entity legalized by a notary for applicants on behalf of legal agencies.
- b) Legalized photocopy of joint ownership in the name of the applicant of more than one person.
- c) Legalized copy of NPWP. 24 (twenty-four) Brand Labels, 4 (four) sheets affixed to each form (4 duplicate forms), and 20 (twenty) sheets in an envelope, with a maximum size of 9 x 9 cm and a minimum of 2 x 2 cm
- d) Receipt of registration fee payment in accordance with the specified fees.
- e) Include country name and date of the first request for Mark registration for Marks with Priority Rights.³³

Applications using priority rights must be accompanied by evidence of receipt of the first application for registration of a mark giving rise to the said priority right. Meanwhile, the protection of well-known marks at the international level has actually been regulated in Article 6 bis Paris Convention which obliges all its members (countries) to protect well-known marks of other citizens for goods that are similar or the same. It is added to Article 4A Paragraph (1) of the Paris Convention concerning priority rights which stipulates that a well-known mark must receive legal protection in a country that is a member of the Paris Convention since the mark is registered in a country participating in the Paris Convention or the country of origin.³⁴

³³ *Ibid*, pg. 6

³⁴ Irfan Nursalim, Thesis: *Perlindungan Hukum Pemegang Merek Terkenal Lois Internasional Tidak Terdaftar Menurut Hukum Kekayaan Intelektual Indonesia*, Jakarta, UIN Jakarta, 2021, pg.54.

3. Intellectual Property Dispute Resolution in Indonesia

Law enforcement efforts according to the TRIPS agreement include several steps in enforcing IPR law in Indonesia, namely IPR dispute resolution, Temporary Determinations, Losses, Criminal Provisions, Other legal remedies, and provisions related to national borders, which will be explained below.

a. Law enforcement efforts

To comply with the TRIPs agreement, several provisions in the IPR laws and regulations in Indonesia have been specifically amended which resulted in several fundamental changes in procedural law in Indonesia. Some special features that distinguish it from the law in general, are:

- 1) All IPR civil cases are under the jurisdiction of the Commercial Court except for Trade Secrets;
- 2) The period for giving a decision, both at the first-level court and at a high-level court, is limited by a certain time;
- 3) The decision of the first instance judge cannot be appealed, but goes directly to the Supreme Court for cassation with the aim of avoiding time delays from the losing party;
- 4) The possibility of carrying out a temporary ruling in the form of a court order filed before the case is submitted to the Commercial Court, specifically to collect evidence and prevent goods resulting from the violation from entering the market;

5) The forms and violations of IPR are specifically mentioned in the IPR law.³⁵

The Law on Trademarks and Geographical Indications states that a lawsuit must be filed with the Commercial Court in the jurisdiction where the defendant resides or is domiciled. If the defendant is outside the territory of Indonesia, the lawsuit will be filed with the Central Commercial Court in Jakarta. The system of procedures used in lawsuits for the cancellation of trademarks and geographical indications is similar to those for bankruptcy. For example, the timeframe for resolving cases in the Commercial Court is shorter than in the District Court in the same case.

b. IPR Dispute Resolution

According to Law Number 15 of 2001 concerning Trademarks, namely in Article 76 paragraph (1), a trademark owner licensee can sue someone who without permission has used a mark that is similar in principle to the mark of another person engaged in a trade or the same services. After that, it is the Commercial Court that has the authority to hear the case (Article 76 paragraph (2) of Law Number 15 of 2001 Concerning Marks). Decisions from the Commercial Court can be appealed to the Supreme Court (Article 79 of Law Number 15 of 2001 Concerning Marks)

Article 84 of Law Number 15 of 2001 Concerning Marks provides a choice of trademark dispute resolution through arbitration or alternative dispute resolution. In the settlement of this violation can use existing institutions in

³⁵ DR. Erlina B, S.H., M.H., Melisa Safitri, S.H., M.H., Intan Nurina Seftiniara, S.H., M.H., *Perlindungan Hukum Indikasi Geografis*, Pusaka Media, Lampung, 2020, pg. 98.

Indonesia. Institutions that can be used in resolving trademark violations are as follows:

1) Alternative Dispute Resolution

Alternative Dispute Resolution Institutions are regulated in Chapter II Law Number 30 of 1999 concerning Alternative Dispute Resolution and Arbitration by using this route, the parties usually want to resolve cases peacefully and not use legal channels. But usually in this case what is often discussed is only compensation and cancellation of trademark registration.

2) Arbitration

Arbitration is the settlement of disputes using arbitrators or referees. This institution is regulated in Chapter III onwards Law Number 30 of 1999. But usually in using this institution to resolve trademark dispute objects within the scope of trade.

3) Court

The court is an institution that exercises judicial power and has the task of examining and adjudicating a case submitted to it. In cases of infringement or trademark disputes, a lawsuit is usually filed with the Commercial Court in the local jurisdiction.³⁶

C. Overview of Intellectual Property Law in Spain

1. Intellectual property Legal Base in Spain

The Spanish trademark concept is regulated based on article 4 of law number 17 of 2001 which reads "Trademark means any sign that can be represented

³⁶ Irfan Nursalim, *Op.Cit*, pg. 27.

graphically and used to distinguish in the market for the goods or services of one company from another." Which has special signs in the form of words or combinations of words, images, or in the form of symbols, letters, or numbers, in three dimensions including the packaging in the form of packaging or product presentation, sound, and any combination of signs for declaration purposes.

Intellectual property means the legal rights which result from intellectual activity in the industrial, scientific, literary, and artistic fields. Intellectual property includes the exclusive right to exploit any literary, artistic, or scientific creation within the limits provided by law. Intellectual property is traditionally divided into two branches, "industrial property" and "copyright".

Spain is a Member State of the European Union, and protection from IP and the content of national legislation in this area is largely determined by EU law. First, the EU regulations that shape the industrial property rights community create rights that are unitary and encompass the territory of Spain. As far as the rights of Indigenous Peoples are concerned, their existence, registration, effect, use, transfer, duration, repeal, invalidity, legal action resulting from them, and other issues related to rights are governed by EU regulations that apply directly in all states member.

Secondly, membership in the EU requires Spanish law to implement the general standards of protection set forth by the EU directive on the approximation of national legislation in the field of intellectual property. Moreover, although the European Union regulations on IP Community rights do not impose any obligation on states to establish provisions approximating national rights to Community

Rights, Spanish legislators consider such an approach desirable, and hence many provisions of national law on trademarks and designs. derive directly from the respective EU regulations to prevent the possibility that two titles producing identical effects in Spain may be subject to completely different terms.³⁷

According to Act 17/2001, of 7 December, on Trademarks (Ley 17/2001, de 7 de diciembre, de Marcas) which is the basis legal property Any sign, especially words, including names, designs, letters, numerals, colors, the shape of goods or of their packaging, or sounds that meet the legal requirements must allow a distinction to be made between the products and services of one company from the rest. Must be capable of representation, and registration is required before the SPTO (awards trade marks for products and services and trade names that provide legal protection for distinctive signs). As an exception, unregistered renowned trademarks have some degree of, but not full, legal protection. Renowned trademarks are those that "are known to the general public".³⁸

For a trademark to be renowned, it must be known not only by a particular sector of consumers, but by the public in general, whether or not they are the recipients of the goods, services, or activities represented by the trademark in question. With a duration of Ten years from the date, the registration is published. Renewable indefinitely before the SPTO for successive periods of ten years, subject to new payment rates. The protection conferred by distinctive signs has a duration

³⁷ Pedro Alberto De Miguel Asensio, *Spain (Intellectual Property and Private Law)*, Oxford-Portland, Hart Publishing, 2012, pg. 6.

³⁸ Álvaro Bourkaib Fernández de Córdoba, Nora Oyarzabal Oyonarte and Paula Conde Castro, Cuatrecasas, *Industrial and Intellectual Property Issues (Spain)*, Thomson Reuters, Spain, 2021, pg. 3.

of ten years starting from the date the application was filed and can be renewed for an indefinite period. Fees must be paid to ensure that the distinctive signs remain in effect. Different fees apply to trademarks while they are being processed. Ask the SPTO for further details.³⁹

2. Provisions Concerning Intellectual Property Registration in Spain

Spanish state policy regulates absolute prohibition and relative prohibition, the absolute prohibition in question is a trademark that is not differentiating, a trademark that exclusively consists of signs or instructions that can be used in trade such as indicating type, quality, amount, purpose, value, geographical origin, trademarks that may signal the public, for example, the nature, quality or geographical origin of product services, trademarks exempt under EU law, or trademarks imitating the shields, flags, decorations and other symbols of Spanish.

Relative prohibition governs the Prohibition of trademarks that cannot be risked as trademarks if they are similar to previous trademarks, there is concern among the public, former trademarks, and trademarks whose application for registration has a filing date or priority date. The category referred to is Spanish trademarks, trademarks that have been the subject of international registration valid in Spain, and European Union trademarks.

The absolute prohibition of trademarks in Spain is that trademarks cannot be registered as trademarks because they are not in accordance with Article 4 paragraph 1 of this Law, which are not unique in nature, consisting exclusively of

³⁹ Ministerio De Industria, Comercio Y Turismo, "Industrial Property", occurred in, [Oficina Española de Patentes y Marcas - Industrial Property \(oepm.es\)](https://www.oepm.es), accessed on December 6, 2022.

signs or indications that can be used in trade to indicate species, quality, quantity, purpose, value, geographic origin or period of production of the goods or provision of services, or other characteristics of the goods.

Goods or services, which consist exclusively of signs or indications that have been converted into ordinary goods used to denote goods or services in the same language or in trading practice, which consist exclusively of forms determined by the nature of the goods themselves or by the form goods required to obtain technical results, and in a form that gives substantial value to goods which is contrary to law, public policy or decency.

Such goods or services may mislead the public, for example regarding their nature, quality, or geographical origin, for example identifying wines or spirits which contain or consist of an indication of geographical origin, wines or spirits which do not have such origin when the actual origin of the goods indicated and used in translation or accompanied by expressions such as “class”, “type”, “style”, “imitation” or other similar expressions.

Other examples of producing or imitating the bearings, flags, insignia, and other emblems of Spain, its Autonomous Communities, municipalities, provinces or other local entities, unless given permission have not been approved by the competent authority and must be refused under Article 6 of the Paris Convention, which includes insignia, symbols or bearings other than those provided for in

Article 6 of the Paris Convention and which are in the public interest, unless the registration is authorized by the competent authority.⁴⁰

The provisions do not apply if the mark has acquired, for the goods or services for which registration is requested, special characteristics as a result of such use. As it has been made of the trademark. as it has been made of the trademark. A combination of various signs among the signs referred to can be registered as a mark, provided that the combination has the characteristics required by Article 4 paragraph (1) of this Law.

From the laws of the Spanish state, it can be said that a trademark that has received legitimacy as a trademark must be protected by the laws of a country. Trademarks have the risk of being counterfeited or used as a hitchhiking objects by irresponsible parties for the purpose of selling their merchandise by imitating other trademarks because the reputation of the well-known trademark is known by the public, this has a significant impact on trade in goods with these parties. Signs that cannot be used as trademarks in Spain are:

- a. Items that may not be trademarked because they fail to comply with trademark requirements,
- b. undifferentiated trademarks,
- c. Things that consist exclusively of signs or indications that can be used in trade to indicate the type, quality, quantity, purpose, value, geographic origin, or time

⁴⁰ J.F. Merino Merchán y J.M. Chillón Medina, *Tratado de Derecho arbitral*, Thomson-Civitas, Madrid, 2006, pg. 402-415.

- of obtaining the product or providing the service or other characteristics of the service goods or other features of the product or service,
- d. Things that consist solely of signs or indications that have become customary in everyday language or in customs that are faithfully used in trade,
 - e. Trademarks that solely consist of forms or other characteristics that are determined by the actual nature of the product or other forms or characteristics of the product required to obtain a technical result, or by forms or other characteristics that give the impression of substantial value to the product,
 - f. Things that are against the Law, common addiction or good practice.
 - g. Matters accessible to the public, for example regarding the nature, quality or geographical origin of products or services.
 - h. Those excluded from registration under national or EU law or due to international agreements to which the EU or the State of Spain are parties providing protection of denomination or origin and geographical indications.
 - i. Those excluded from registration under EU law or international agreements to which and affiliated are parties to the protection of traditional wine terms.
 - j. Those who are excluded from registration under EU law or international agreements to which they are parties and which provide protection of guaranteed traditional privileges.
 - k. Those which consist of, or reproduce essential elements thereof, the denomination of earlier plant varieties, registered in accordance with EU legislation or national law, or international agreements to which Spain is a party

to determine the protection of plant varieties, and which refer to new plant varieties of the same or closely related species.

- l. Those who manufacture or imitate the shields, flags, decorations, and other emblems of Spain, its Autonomous Communities, municipalities, provinces, or other local entities, unless proper authorization is obtained.
- m. Things that have not been legalized by the competent authority and must be rejected under article 6 of the Paris Convention.
- n. Items including badges, coats of arms, or shields

3. Intellectual Property Dispute Resolution in Spain

In the Spanish law that regulates dispute resolution, the article 41 paragraph 1 states that an owner whose trademark rights have been violated can carry out a civil lawsuit, file a cessation of actions that violate his rights, request compensation for damages suffered, or destruction and transfer for humanitarian purposes, because the guilty party for his goods is unlawfully and identified with the trademark owned by the infringed party. Unless the nature of the goods permits any distinguishing marks to be removed without affecting the goods themselves.

Infringement of the intellectual rights is legally protected. It can be prosecuted and the prejudiced may bring civil, criminal, or administrative action before Spanish Courts.

a. Civil action:

Actions for intellectual property rights infringement are taken through the Civil Ordinary Procedure as stated by the Spanish Civil Prosecution Act (Ley de Enjuiciamiento Civil). The court may award damages in respect of the

infringement, and compensation for lost sales and markets as a result of the infringing activity. The prejudiced may claim compensation for damages within 5 years from the date on which he could bring legal action.

The person or legal entity claiming to be injured or threatened by injury may request, the previous initiation of the court proceeding, and precautionary measures provided that the existence on the market of the unlawful copies can cause considerable damages. Such measures are intended to protect the author's rights, preventing the committing, or the continuation of the committing of acts of piracy.

Such measures may consist of:

- 1) Ordering the termination of the manufacture or distribution of the unauthorized copies.
- 2) Seizure of the goods suspected to be unauthorized copies.
- 3) Seizure of the tools that could be used to manufacture or package the unauthorized copies.

b. Criminal action

Besides civil action, criminal action can be brought against infringements of intellectual property rights such as reproduction or distribution of the work without the author's authorization. Penal sanctions may include imprisonment by a term from 6 months to 2 years or fines.⁴¹

⁴¹ iAbogado, "Spanish IP Law", on, <https://www.spainlawyer.com/legal-guide/spanish-ip-law/> accessed on December 6, 2022

Article 42 paragraph 2 states that all persons who commit acts of infringement on a registered trademark are obliged to provide compensation for the losses incurred if they have been sufficiently warned by the trademark holder, and those entitled to carry out actions regarding the existence of the trademark, if the trademark appropriately identified, and infringers are asked to stop doing so, for when their actions involve errors or omissions related to well-known trademarks.

Violators are required to make Compensation because article 1 states "Anyone who, without the approval of the trademark holder, commits one of the actions referred to in letter (a) "any sign identical to the trademark for goods or services identical to those for which the trademark is registered", article 34 (3) and (4) in economic activity, as well as those who are responsible for the first marketing of the product or services that are unlawfully tagged, however, shall be liable for any damages caused.

The law further provides for coercive compensation, if a person is ordered to stop an act that infringes on a trademark, the court will determine a compensation of not less than 600 euros per day until such time as the violation actually stops. The amount of this compensation and the day of commencement of the compensation obligation is determined at the time the decision is implemented

D. Intellectual Property Rights an Islamic perspective

The terminology of intellectual property rights is indeed unknown in Islamic discourse, so it is difficult to find a literal equivalent. Terminology issues often lead

to different perceptions of a particular concept. Intellectual Property develops when the creative process of writing and creating deals with the industrialization of knowledge. Developed countries have an interest in the issue of Intellectual Property, as one of the good indicators of investment in developing countries. So developed countries often require the protection and enforcement of Intellectual Property Rights in their investment transactions.

The themes of Intellectual Property in Islam are more related to the relationship of ownership and *tasarruful amwal*. This discourse can be found both in the Qur'an, hadith, or the opinion of the *fuqaha*. Intellectual property/property is discussed as part of the issue of property and ownership in *fiqh muamalah*. As part of property and ownership, copyright is seen as part of the problem of using other people's rights in a *ma'ruf* manner.⁴²

The following are several verses that form the legal basis for the use of other people's property right:

a. Qs. An-Nisa [4]: 29

This means "This verse talks about general rules regarding the utilization of property in a good way. The previous verses also discuss the issue of *mu`amalah maliyah* in the context of orphans and the obligation to provide dowries for women." The verse explains that it gives a signal that respecting the rights of others means respecting one's own rights and violation of other people's property is a form of violation and a crime against humanity.

⁴² Mufliha Wijayati, *Intellectual Property Rights In The Perspective of Islamic Law Study of Qs. An-Nisa [5]: 29, el-Qist*”, STAIN Jurai Siwo Metro, 2014, pg. 828.

At this point the prohibition of taking other people's property, Qs. An-Nisa [5]: 29, becomes very relevant in the context of the prohibition against violating other people's property rights. Copyright as part of property rights in fiqh terminology can be categorized as amwal or assets. The terminology of wealth (mal/amwal) according to jumhur fuqaha other than Hanafiyah is something that is needed and obtained by humans, both in the form of visible objects (gold, animals, plants) and invisible (in the form of benefits of something).⁴³

In this context, the jumhur opinion regarding the definition of property seems to be used more as a reference in the development of modern muamalah fiqh. Thus, Copyright is categorized as property owned even though the material side is intangible, because it is more dominant in the aspects of the benefits of the results of his thoughts compared to material aspects (paper/sheets/books). Likewise regarding amwal or assets as objects that can be owned, controlled, authorized, and transferred, both tangible and intangible objects, both registered and unregistered objects; both movable and immovable objects and rights that have economic value.

From the explanation above, it can be concluded that the right of authorship (Haq at-ta'lif) as part of IPR includes assets that can be legally owned, and the owner has full rights over the property. The scope of wealth in Islam is not only limited to material things but also includes benefits from an object. And as legally owned property, copyright (authorship) is an asset protected by syara'. Thus, anything that

⁴³ Wahbah az-Zuhaili, *Al- Fiqh al-Islam wa Adillatuhu Juz V*, Damascus, Beirut, 1989, pg. 40.

is harmful and tyrannical to the copyright owner is prohibited. Piracy of copyright can be categorized as taking other people's property in vain.⁴⁴

⁴⁴ *Ibid*, pg. 385.

CHAPTER III

SIMILARITY AND DIFFERENCES LEGAL PROTECTION FOR WELL-KNOWN TRADEMARKS BETWEEN INDONESIA AND SPANISH ALSO FACTORS THAT MAKE THE DIFFERENCE

A. Similarities and Differences of Legal Protection of Well-Known Trademarks Between Indonesia and Spain

Trademark registration is carried out at the request of the owner mark or those entitled to the mark or through their counselor, mark registration aims to obtain certainty and legal protection regarding rights to their trademark. Registration is absolutely necessary for the rights of a mark to occur however, local trademark registrations often intersect with well-known trademarks that already existed. As happened between two jeans trademarks named Newlois originating from Indonesia and Lois originating from Spain, where the Directorate General of Intellectual Property had neglected to grant the trademark application by Lois trademark made in Spain which has a similar type of goods and trade name as Newlois from Indonesia.

Directorate General of Intellectual Property is considered negligent because Lois is considered a well-known trademark that has been recognized by several countries around the world. Both countries Indonesia and Spanish, certainly have different regulations regarding trademarks. The Indonesian National Law uses Law Number 20 of 2016 on Trademarks and Geographical Indication, while the Spanish national law uses Law Number 17 of 2001 on Trademarks, to answer the first

problem formulation, the author will make a comparison between the two regulations which of course have similarities and differences.⁴⁵

The definition of a well-known trademark in the current trademark law in our country, the size of a trademark can be said to be well-known marks can be seen in Article 18 of Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration, Criteria the determination of well-known Marks as referred to in Article 16 paragraph (2) letters b and c shall be carried out by taking into account the public's general knowledge regarding said marks in the business field concerned. The community as referred to in paragraph (1) is the consumer community or the public in general who have good relations at the level of production, promotion, distribution, and sales of goods or services protected by the said well-known mark.

The criteria for a brand as a well-known mark are the sales volume of goods or services and the profits derived from the use of the mark by the owner, the market reach controlled by the mark in relation to the circulation of goods or services in society, the area of use of the trademark, the term of use of the trademark , the intensity and promotion of trademarks, including the value of the investment used for the promotion, trademark registration or applications for trademark registration in other countries, the level of success of law enforcement in the field of trademarks, especially regarding the recognition of said trademark as a well-known trademark by an agency that authorized or the value attached to the trademark obtained

⁴⁵ Irfan Nursalim, *Op.Cit*, pg. 47.

because of the reputation and guarantee of the quality of goods or services protected by the trademark.

The first similarity between Spanish law and Indonesian law regarding regulations prohibiting trademark registration, in Article 20 letters (e) and (f) Law number 20 of 2016 Marks and Geographical Indication states "that a mark which has no distinguishing features and/or is a common name and/or public property symbols may not be worn". The same thing is also regulated in the Spanish Law Article 5 paragraph (1) point (b) Law Number 17 of 2001 on Trademarks, it is stated "that those which are not distinctive in nature may not be registered as trademarks". Then, based on Article 3 Law of Number 20 of 2016 Marks and Geographical Indication, Indonesia adheres to a constitutive registration system (first to file), namely whoever first registers a mark has the right to the mark. Spain also has the same regulations in Article 2 paragraph (1) Law of Number 17 of 2001 on Trademarks which states "The right of ownership in a trademark and a trade name shall be acquired by means of valid registration in accordance with the provisions of this law".

Furthermore, in Article 21 paragraph (2) letter (a) Law Number 20 of 2016 on Trademarks and Geographical Indication, which is equivalent if an application for a trademark can be rejected because it is in the form of or resembles the name or abbreviation of a famous person's name or a photo belonging to another person, except with the approval of the rightful person. The Spanish law also mentions the same thing in article 9 paragraph (1) parts (a) and (b) Law Number 17 of 2001 on Trademarks, which states that "Without a valid permit, the following trademarks

cannot be registered if they resemble the exact name or image that identifies a person other than the applicant trademark". Whereas Part b describes the prohibition of trademarks that resemble first names, last names, pseudonyms, or other signs which, in the eyes of the general public, identify someone other than the applicant.

Further similarities in laws regarding legal protection between Indonesia and Spain are contained in Article 35 paragraphs (1) and (2) Law Number 20 of 2016 on Trademarks and Geographical Indication, concerning the term of protection and extension of trademarks which states "Registered marks receive legal protection for a period of 10 years and can be extended for the same period". Then the Spanish law states in article 31 Law Number 17 of 2001 on Trademarks, regarding duration, namely "trademarks are given for ten years and can be renewed for a period of ten consecutive years.

Furthermore, there are similarities in lawsuits for trademark infringement in article 83 paragraph (1) letters (a) and (b) Law Number 20 of 2016 on Trademarks and Geographical Indication which states "You can submit a lawsuit for similar goods or services in the form of a lawsuit for compensation and termination of all related to the use of the mark". This can be detrimental to owners of well-known trademarks, and in an effort to prevent greater losses, trademark owners in Indonesia can apply for the termination of the production or distribution of trademarks that are not entitled to use the rights to well-known trademarks. And Spain states the same thing in article 41 paragraph (1) Law Number 17 of 2001 on Trademarks "Owners whose rights to trademarks have been violated can submit

civil lawsuits, namely in the form of terminating acts that violate their rights and compensation for damages suffered.

Well-known trademark classification is a product or service grouping system used to register a particular trademark. This classification system is a standard that has been harmonized globally, namely by referring to the Nice Classification, which functions as a limit for the rights granted by a trademark. The definition of a trademark in Indonesia is explained in law number 20 of 2016 concerning marks and geographical indications article 1 paragraph 2 "Trademarks are marks used on goods traded by a person or several persons jointly or a legal entity to differentiate from other similar goods".

Common trademarks are trademarks that are classified as not having a high reputation. This 'ordinary' brand is considered to lack a symbolic radiance of lifestyle, both in terms of usage and technology. Consumers see the brand as low quality. Whereas in the regulations of the Spanish state, the meaning of an ordinary trademark is not explained in its laws and regulations, in the law in article 4 paragraph 1 which explains the concept of trademark, namely any sign able to be represented graphically and used to distinguish in the market goods or services of one company from those of other companies.

The similarities between Indonesia and Spain are that they both ratified the Paris Convention and the TRIPS Agreement which require member countries to protect well-known trademarks even if the trademark is not registered or used in that country. Under the TRIPS Agreement, protection may even be provided for

different goods or services if connected to a well-known registered trademark owner, or if it is probable that the well-known trademark owner will incur losses caused by market confusion. However, enforcement under these agreements is not the same in every country. Thus, if a mark is not used in a particular jurisdiction but the owner can prove that the trademark is well known or recognized elsewhere in the world, then the owner of the well-known trademark can often prevent third parties from using or registering the trademark in that particular jurisdiction.

The next similarity is that Indonesia and Spain are included in the World Intellectual Property Organizations (WIPO) where the organization provides limitations regarding well-known brands as agreed in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks that factors can be used to determine whether the mark is included in the category that is, the level of knowledge or recognition of the trademark in the sector relevant to society, the duration of the level and geographical area of use of the trademark, the duration of the level and geographical area of promotion of the trademark, the duration and geographical area of any registration or application for trademark registration, records the successful fulfillment of the rights to the trademark, and the value of the trademark.

The first difference in legal protection for well-known trademarks between Indonesia and Spain regulates in Article 21 paragraph (1) letter (d) Indonesian Law Number 20 of 2016 on Trademarks and Geographical Indication which regulates "registered Geographical Indications". Whereas in article 6 concerning prior trademarks and article 7 concerning prior trade names Law Number 17 of 2001 on

Trademarks, where there are no detailed rules regarding Geographical Indication, but are regulated in international agreements or Europe Union legislation. The Europe Union regulation on geographical indication trademarks is an intellectual property right (IP) that functions to identify a product that originates from a certain geographical area and has quality, reputation, or other characteristics that can basically be linked to its geographical origin which only regulates agricultural products, foodstuffs, spirit drinks, flavored wines.

In subsequent differences in legal arrangements, Spanish law regulates prohibitions into two (2) parts, namely Relative Prohibitions and Absolute Prohibitions contained in articles 5 and 6 of Law Number 17 of 2001 on Trademarks where there are many provisions in these articles. In comparison, Indonesia regulates mark registration regarding Non-Registrable and Refused Marks in article 20 letter (a) until (f) Law number 20 of 2016 concerning geographical indication marks.

The last difference is in the criminal provisions, Spain does not regulate criminal provisions and does not provide criminal sanctions against violators of well-known trademarks, but owners of well-known trademarks whose brands are registered can take civil action according to what they have violated and request actions that need to be determined to protect their trademarks before the jurisdictional authority. Spain regulates the possibility of taking civil and criminal action in article 40, Law Number 17 of 2001 on Trademarks, but no clear criminal provisions such as imprisonment or fine arrangements are given. Whereas in Indonesia it regulates criminal provisions which are regulated in Article 101

paragraph (2), law number 20 of 2016 concerning geographical indication marks which states "Any person who without rights uses a sign that has similarities in essence with Geographical Indications belonging to other parties for goods or products that are the same or similar to the goods or products registered, shall be punished with imprisonment for a maximum of 4 (four) years or a fine of up to Rp. 2,000,000,000.00 (two billion rupiahs)".

In Indonesia, a trademark owner can use his mark if he has exclusive rights (rights to the mark) granted to the trademark owned by the state and is the only owner entitled to the mark and prohibits other people from using and owning the mark. In this case, the use of the Lois trademark was given to PT. Intigramindo Persada, as the licensee and power of attorney for Lois Trade Mark-Consultore e Servicos. This right can be infringed upon with permission from the trademark owner, namely in the form of granting a license through a licensing agreement.

Then the actions committed by Newlois were acts in the absence of good faith because Newlois intentionally imitated, whether or not in its entirety, the fame of another person's trademark that has been widely known by many people, and the act of impersonating the brand was considered to have misled the wider community in choosing and know the goods from the actual trademark. Moreover, if the use of someone else's trademark is without rights with the aim of unfairly seeking profit / economic wealth (unfair competition).

In the case of trademark infringement by Newlois, according to researchers, this was included in the act of violating the law and accompanied by bad faith. The

definition of faith cannot include acts of fraud, circuits that mislead other people, as well as behaviour that ignores legal obligations to gain profit. It can also be interpreted as an act that is not consciously justified to achieve dishonest goals.

No.	INDONESIAN LAW	SPANISH LAW	description
1.	Art. 20 point e & f : “undifferentiated” & “is a common name and/or a symbol resembling public property.”	Art. 5 paragraph (1) point b : “Those which are not distinctive in nature.”	Similarity
2.	There is no more special division.	Prohibitions are divided into Relative Prohibitions and Absolute.	Difference
3.	Art. 21 paragraph (1), The application is rejected if: a. Registered trademarks belong to other parties or are applied for in advance. b. Well-Known trademark for c. similar goods/services. d. Well-known trademarks for goods/services that are not of the same kind. e. registered Geographical Indication.	Art. 6 paragraph (1) point b, signs may not be registered if they are identical or similar to a prior trademark. paragraph (2) → well- known trademarks in Spain. Art. 7 paragraph (1) point b, signs may not be registered if they are identical or similar to a prior trade name.	Similarity
		There are no detailed rules regarding Geographical Indication, regulated in international agreements or EU legislation.	Difference

4.	<p>Art. 21 paragraph (2) point a. the application is rejected if it is or resembles the name or abbreviation of a famous person's name or a photo owned by another person, except with the consent of the person entitled.</p>	<p>Art. 9 paragraph (1), without due authorization, the following may not be registered as trademarks:</p> <ul style="list-style-type: none"> a. The proper name or image which identifies a person other than the trademark applicant. b. The first name, surname, pseudonym, or any other sign which, in the eyes of the general public, identifies a person other than the applicant. 	<p>Similarity</p>
5.	<p>Art. 35:</p> <ul style="list-style-type: none"> (1) A registered mark shall receive legal protection for a period of 10 years. (2) Can be extended for the same period of time. 	<p>Art. 31 → a trademark shall be granted for ten years and may be renewed for successive ten-year periods.</p>	<p>Similarity</p>
6.	<p>Art. 83 paragraph (1), Can file a claim for similar goods/services in the form of:</p> <ul style="list-style-type: none"> a. Compensation lawsuit b. Termination is all related to the use of the mark. 	<p>Art. 41 paragraph (1) : Owner whose right to a trademark is infringed may in a civil action claim</p> <ul style="list-style-type: none"> a. The cessation of the acts infringing his right b. Compensation for the damage suffered 	<p>Similarity</p>
7.	<p>Art. 101 Paragraph (2) Any person who unlawfully uses a sign that is similar in principle to a Geographical Indication belonging to another party for</p>	<p>Spanish law does not provide for criminal sanctions, only that the owner of a trademark whose mark is registered may, before the jurisdictional authority, take</p>	<p>Difference</p>

	<p>goods or products that are the same or similar to the goods or products registered shall be punished with imprisonment for a maximum of 4 (four) years or a fine of up to Rp. 2,000,000,000.00 (two billion rupiah).</p>	<p>appropriate civil or criminal action against those who infringe on their rights and request measures necessary for the protection of the trademark, without prejudice to submission case to arbitration</p>	
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The legal protection mechanism for well-known trademarks is regulated in Article 4 and Article 6 of Law no. 20 of 2016 concerning trademarks comply with and implement legal provisions governing the exclusive rights of trademark owners, the Paris Convention and the TRIPS Agreement, which basically stipulates that well-known trademarks are protected even though they have not been registered in Indonesia because they meet the criteria of well-known trademarks by taking into account public knowledge, are registered in several countries in the world, and are carried out investment in several countries by the owner.

Well-known trademarks have two ways of protecting them, namely preventive protection through trademark registration with priority rights where protection before an infringement of a trademark is obtained through registration. Trademark protection through registration is essentially aimed at legal certainty over a registered mark, both for use, extended, transferred and abolished as evidence in the event of a dispute over the infringement of a registered trademark and in the usual way as well as repressive protection in the form of efforts to settle disputes which are pursued either through non-litigation or litigation.

B. Factors that Cause Differences in The Protection of Well-Known

Trademarks in Indonesia and Spain

People in general may only know well-known trademarks in terms of the difference between European and Asian countries that make a trademark and product famous, but in fact there are elements of differences in names, terms, signs, symbols, designs, or some other identifying characteristics. A trademark manufacturing company It should also be noted that every business actor or company from various countries has laws governing differences in legal protection that must be understood there is no carrying of a well-known trademark that causes economic loss to owners of well-known trademarks. One of the criteria for a trademark can be said to be a well-known trademark, namely that it has penetrated or has been in several countries and the trademark has been widely known by almost every community in that country. Indeed, until now there have been no rules or agreements between countries that regulate and explain specifically because it tends to produce subjective judgments.

Regarding the minimum limit of how many countries know the trademark has entered an agreement, there is no agreement on this matter. However, according to researchers, a trademark cannot be said to be a well-known trademark if it only refers to how much the trademark has penetrated various countries. So that the conditions mentioned above must complement each other in order to be assessed objectively. Because this often happens, the author will provide an explanation of several factors that influence differences in the protection of well-known marks between Indonesia and Spain, namely:

1. Legal Policy

As a modern country, Indonesia in the constitution or the 1945 Constitution of the Republic of Indonesia has principles as a democratic country and a rule of law that aims the welfare of society, so there are 2 (two) basic foundations that must become pillars in the implementation of legal development in Indonesia, that is⁴⁶ :

- a. The foundation of justice is the basic norm of national and state life, namely the law which has the character of Pancasila.
- b. Operational Basis, namely:
 - 1) Fair and prosperous laws;
 - 2) Laws that strengthen democracy;
 - 3) Laws that protect human rights;
 - 4) Laws that strengthen the Unitary State of the Republic of Indonesia;
 - 5) Laws that are diverse in diversity; and
 - 6) Laws that protect the nation and the homeland of Indonesia.

Basic of the foundation has become the basis for the implementation of Indonesian national legal politics because legal politics determines the direction of national development policies in Indonesia as a whole which will be carried out in a certain period. Legal politics is basically an idea that forms the basis for state intervention through state instruments (government, DPR, and others) in law. The House of Representatives holds the power to form laws and each bill is discussed by the House of Representatives and the President for mutual approval. See Article

⁴⁶ Pusat Perencanaan Pembangunan Hukum Nasional, *Perencanaan Pembangunan Hukum Nasional 2015-2019*, Jakarta, Badan Pembinaan Hukum Nasional, 2012, pg. 56

20 paragraphs (1) and (2) of the 1945 Constitution, similarly, the President has the right to submit bills to the House of Representatives.⁴⁷

So the ratification of a Draft Legislation to become Law is a form of mutual agreement between the President (Executive) and the People's Representative Council (Legislative). This is the current legal politics as mandated by the Constitution. State interference with its instruments in the law, in terms of:⁴⁸

- a) Law creation, motivated by the state's obligation to maintain justice and order.
To maintain justice and order, the state creates law;
- b) Implementation of Law, motivated by the obligation of the state to provide state equipment in charge of implementing or enforcing the law in a certain way determined by the state, including through the courts.
- c) The development of law, namely that the law is prepared based on the legal awareness of society. The state seeks to influence the development of public legal awareness so that the state influences legal development.

Legislation is the main door in carrying out legal politics in Indonesia, as a country that upholds the law (nomocracy) and democracy in administering the country. For this reason, building the quality of national and regional legislation products is very important to realize the goals of the state as a welfare state as mandated in the constitution, so producing quality legislation products is a big responsibility.⁴⁹

⁴⁷ *Ibid.*

⁴⁸ *Ibid*, pg. 67.

⁴⁹ F. Putuhena, *Law Politics of Legislation in Efforts to Improve Quality Product Legislation*, Jurnal Rechtsvinding, Volume 1 Number 3, 2012, Jakarta Timur, pg. 344-345.

Contrast to the Spain state, having a *Cortes Generales* (the Spanish legislature is a bicameral parliament, consisting of the Congress of Deputies, and the Senate. *Cortes Generales* has the power to pass all laws and to amend the constitution) establishes the principle of separation of powers of the state, which is divided into three branches: the legislative, executive and judicial. Several checks and balances are carried out to ensure that a branch does not exceed its authority.⁵⁰

- a. The Cortes Generales oversees government action. It can put formal questions to the government and each of its members and appoint fact-finding committees (*Comisiones de Investigación*). The Cortes Generales also proposes certain high officers of the state who are formally appointed by the King (for example, judges of the Supreme Court and Constitutional Court and members of the governing body of the judiciary).
- b. The Congress of Deputies can challenge government policy by passing a motion of censure, which is approved on a vote by an absolute majority of its members.
- c. The government can:
 - 1) Propose legislation and constitutional amendments;
 - 2) Lodge an appeal for its declaration as unconstitutional (*recurso de inconstitucionalidad*);
 - 3) Dissolve the Cortes Generales in certain circumstances.

⁵⁰ Antonio Tapia Frade and Amalia del Campo Pastor, “*Legal System in Spain, Overview, Thomson Reuters Practical Law*”, on, [https://uk.practicallaw.thomsonreuters.com/7-634-0207?transitionType=Default&contextData=\(sc.Default\)&firstPage=true#co_anchor_a488905](https://uk.practicallaw.thomsonreuters.com/7-634-0207?transitionType=Default&contextData=(sc.Default)&firstPage=true#co_anchor_a488905), accessed on December 19, 2022.

- d. In addition to handing down judgments, the judiciary can request the execution of judgments. It is also involved in governmental and administrative functions regarding parliamentary control and the requirement of government liability.

The general legislative process is regulated by the Cortes Generales and completed by the standing orders of the houses of the (*Reglamentos de las Cortes Generales*). Proposal and drafting, Legislation can be proposed by Article National Spain 87, CE):

- a) The government. The government participates in the legislative process by filing a bill of law (*Proyecto de Ley*). Legal bills proposed by the government are passed by the Council of Ministers, which then submits them to the Congress of Deputies, accompanied by a statement setting out the necessary grounds and facts for them to reach a decision.
- b) The Congress of Deputies and the Senate. These bodies can make a proposal of law (*Proposición de Ley*). Proposals of law are regulated in the standing orders of the houses. Non-governmental bills that are considered by the Senate are referred to the Congress of Deputies for enactment.
- c) The assemblies of the autonomous communities. The assemblies can request that the government pass a bill or refer a non-governmental bill to the Congressional Steering Committee (*Mesa del Congreso*).
- d) Popular initiative. Such an initiative requires at least 500,000 authenticated signatures and cannot relate to certain matters, such as taxation, international affairs, or the prerogative of granting pardons.

The Spanish government is here to exercise oversight, after a bill or proposed law is presented and accepted by the full plenary session of the Congress of Deputies, it is discussed by the members to determine whether it will be accepted, rejected, or amended. Bills and legal proposals are forwarded to the Standing Legislative Committee for review the Standing Legislative Committee appoints a committee (*ponencia*), which prepares summaries of the text (*Dictamen*), these are discussed and voted on in the plenary sessions of the Congress of Deputies. Once the text of a bill or bill proposal is approved, it is submitted by the President of the Congress of Deputies to the Senate, which follows a similar procedure.⁵¹

The Government of Spain also carried out the enactment of the process which ended with the approval and approval of the law. Within 15 days, the King approved a law passed by the *Cortes Generales*. He then promulgated the law and ordered its immediate publication. The law comes into force 20 days after it is announced in the Official Gazette unless the State Gazette stipulates otherwise.⁵²

2. Legal System

The legal system in Indonesia that refers to court decisions are the applicable laws and regulations, namely the UUD 45, MPR Decree, Laws/Perpu, Government Regulations, Presidential Decrees/Presidential Decrees, Supreme Court, Ministerial Decrees, and others. So, the court's decision is flexible (changing) depending on the judge who decides based on the facts/evidence available.⁵³ The legal system

⁵¹ Ricardo Juan Sánchez, *The Administrative Justice in Spain*, Current Situation and Challenges, BRICS Law Journal, Volume 3, Number 2, 2016, pg. 115.

⁵² Aniceto Masferrer, *Plurality of Laws, Legal Traditions and Codification in Spain*, Journal of Civil Law Studies, Volume 4, Number 2, 2010, pg. 429.

⁵³ Rizqy Sultan Alfaroby, "Sistem Hukum", on <https://alfaroby.wordpress.com/2009/01/13/sistem-hukum/>, accessed on December 19, 2022.

adopted by Indonesia has a complete unity of orders consisting of parts or elements that are interconnected and closely related to one another. Achieving a unitary goal requires cooperation between the parts or elements according to a certain plan and pattern.

Indonesian legal system is a legal system characterized by the existence of various systematically codified (compiled) legal provisions which will be further interpreted by judges in their application. The system adopted by the Indonesian state which is based on Roman law is referred to as the Civil law system, the Civil Law system has characteristics, namely codification, judges are not bound to the president so that laws become the main source of law, and the judicial system is inquisitorial which gives understanding that in that system, judges have a major role in directing and deciding cases. Judges are active in finding facts and careful in assessing evidence. The forms of legal sources in the formal sense in the Civil Law legal system are in the form of statutory regulations, customs, and jurisprudence.⁵⁴

While in Spain has a civil law system based on comprehensive legal codes and laws rooted in Roman Law. Civil law is applied throughout the entire territory of Spain, but there are autonomous communities that have their own civil law system, which is applied in relation to certain legal issues. The sources of Spanish law are statutes, customs, and general legal principles. Case law complements the legal system as the Supreme Court upholds legal doctrine in its interpretation of the

⁵⁴ Fajar Nurhardianto, "*SISTEM HUKUM DAN POSISI HUKUM INDONESIA*", Jurnal TAPIs, Edision No. 1, Vol. 11, Media Neliti, pg. 5.

various sources of law. The opinions of legal experts also provide interpretations and clarifications of the law.⁵⁵

A hierarchy of legal provisions exists (Spain National Law Article 9.3, CE). Any provision that contradicts another of higher rank is invalid according to article 1.1, Spanish Civil Code. Customs are considered to be supplementary law, as they only apply in the absence of applicable statutes, provided that they are not contrary to morals or public order. On the other hand, general legal principles apply in the absence of applicable statutes or customs and may help to shape the law. Exceptions to the hierarchy principle exist in relation to certain areas of the law. For instance, commercial law establishes that commercial customs rank more highly than other non-commercial laws. The Cortes Generales has priority over all other sources of the law because it is the fundamental law of the state, The hierarchy of Spanish law is (in descending order), and The Cortes Generales which is the supreme law of Spain.⁵⁶

European Union legislation, which is directly applicable as part of the national system once passed, international treaties organic laws and ordinary laws passed by the Cortes Generales, Decree-laws and legislative decrees, passed by the government regulations (*Reglamentos*), which is a legislation of a lower status. International treaties form part of the law of Spain once they are officially published in Spain (Spain National Law Article 96.1, CE) as a result, legal rules contained in

⁵⁵Antonio Tapia Frade and Amalia del Campo Pastor, “*Legal System in Spain*, Overview, Thomson Reuters Practical Law”, on [https://uk.practicallaw.thomsonreuters.com/7-634-0207?transitionType=Default&contextData=\(sc.Default\)&firstPage=true](https://uk.practicallaw.thomsonreuters.com/7-634-0207?transitionType=Default&contextData=(sc.Default)&firstPage=true), accessed on December 19, 2022.

⁵⁶ *Ibid.*

international treaties have no direct application in Spain until they have been published in full in the Spanish Official State Gazette.⁵⁷

3. Legal Culture

Culture in Indonesia or better known as customary law is the forerunner of law because indeed this law arises by adjusting the conditions of the local community, what the behavior of the people is like and in the end the law adjusts it. So that the law that is formed in accordance with and does not conflict with the culture and habits of the local community becomes a reflection of the socio-cultural values of a society, in its development, it can turn into an adherence that is inherent in each of these communities and can further develop into a rule and what is called customary law.

Legal culture is a response that is acceptance or rejection of a legal event, it shows the attitude of human behavior towards legal issues and legal events that are carried into society. The legal system is a linking relationship between humans, society, power and rules, so the focus of legal anthropology is on human behavior involved in legal events. The link between human legal behavior and its legal culture lies in its response to ideological law and practiced law from an eclectic point of view. Conceptually, legal culture refers to attitudes and actions that are clearly visible, which are a reflection of the values and orientations, and expectations of a person or group. So any attitudes and actions taken by anyone, especially those related to law, are formulated and accepted as a legal culture.⁵⁸

⁵⁷ *Ibid.*

⁵⁸ Muh. Sudirman Sesse, “*Budaya Hukum dan Implikasinya Terhadap Pembangunan Hukum Nasaional*,” *Jurnal Hukum Diktum*, Volume 11, Nomor 2, 2013, pg. 171 – 179.

According to the relationship that occurs between law and socio-culture is born from the habits of people who have to interact between one community and another, and give rise to compliance and become rules (customary law) and in its development, customary law becomes one of the references for Indonesian positive law. Legal texts are never out of context, in the process when a law is formed, for example by the People's Legislative Assembly and the Government as legislators, the draft law must accommodate the needs of the community which is the target of the legal norms. That is, the law that is made must be in line with the demands of the needs of society.⁵⁹

The demand for this need is not something that is in the air, but a need that actually exists in people's lives and is seen as urgent to be regulated into positive law. This means that when a law, specifically in the form of a statute, is enacted, then there is already a guarantee that this positive law can apply sociologically (because the community really needs it) and apply philosophically because the community views it as necessary to make rules. Thus, it is the duty of the state to stipulate these arrangements into positive law, so that these regulations apply juridically.

Whereas Spanish Legal Culture is based on various historical influences, primarily based on the culture of ancient Rome, Spain follows a civil law tradition and is guided by the Spanish Constitution as its primary source of law. When the interpretation is made, the Constitutional Court will deal with the problem. The

⁵⁹ Dimas Rijalul Ahmad, "*Hubungan Budaya Dengan Kebudayaan Hukum*", on <https://osf.io/5sp6a/download>, accessed on December 19, 2022.

court system includes the Supreme Court, national courts, provincial courts, municipal courts, and courts that serve civil purposes in autonomous communities. From a religious and linguistic point of view, there is no doubt the enduring legacy of Ancient Rome in Spain, but after the fall of the Roman Empire, the course of subsequent Spanish history added many other cultural elements and traditions. Due to its deep Roman heritage, Spanish culture is often described as Latin, but it has also been heavily influenced by other European and Mediterranean countries.⁶⁰

Spanish culture was a reflection of the Christian values deeply held by the people of the region values that would later be incorporated in the Reconquista of 1492. Moorish, or Muslim, the influence was particularly strong during the Middle Ages. And it can still be seen in some of the country's art and architecture, Spanish is derived directly from Vulgar Latin, although there is also minor influence from Iberian and Celtic languages, as well as Gothic and Arabic. Religion has always been a defining element of Spanish culture. Following the defeat of the Moors during the Christian Reconquista, the period between 1000 and 1492, Spain became almost entirely a Roman Catholic nation, which remains to this day.

Rules and cultural authority in the Spanish state are uncertain, usually having a preference for rules. While this may have happened in Spain, there is no respect to follow them. The expression, "*Quien hizo la ley, hizo la trampa*" (Whoever makes laws makes loopholes) encapsulates the attitude of many

⁶⁰ Study Country, "Budaya, Tradisi, dan Warisan Spanyol", on https://www-studycountry-com.translate.google/guide/ES-culture.htm? x_tr sl=en& x_tr tl=id& x_tr hl=id& x_tr pto=sc, accessed on December 25, 2022.

Spaniards, that rules are made for the benefit of legislators rather than the people. For example, it is commonly assumed that the political environment is corrupt and that people's taxes are being sucked into the wrong places. Spaniards' hatred of the government is particularly strong among the younger generation, a recent study by the European Foundation for Progressive Studies found that the majority of young people believe politicians are more interested in their own generation than their own.⁶¹

There is a cultural affection for the role of the rogue or anti-hero (*el pícaro*) in Spain. Spaniards often like to support the oppressed. Many folktales follow the adventures of low-class outsiders, such as bandits, who can overcome the corrupt system of society. In fact, very few Spaniards like to be targeted by pickpockets. However, these stories reflect general skepticism of the government system and distrust of authority figures. This attitude can encourage spontaneity and a mild disregard for law and order in everyday life.⁶²

⁶¹ Nina Evason, “Budaya Spanyol”, on https://culturalatlas-sbs-com-au.translate.google.com/translate/g/spanish-culture/spanish-culture-core-concepts?x_tr_sl=en&x_tr_tl=id&x_tr_hl=id&x_tr_pto=sc, accessed on December 25, 2022.

⁶² *Ibid.*

CHAPTER IV

CONCLUSIONS AND SUGGESTIONS

A. Conclusions

Taking off from the discussions above, the Author would like to draw the following points of conclusion:

1. It can be concluded that there are several similarities between the Indonesian National Trademark Law and the Spanish Trademark Law, such as arrangements regarding the first to file system, both ratifying the Paris Convention and the TRIPS Agreement which oblige member countries to protect well-known trademarks even though the trademark is not registered or used in that country, has a preventive protection mechanism through trademark registration with priority rights and by means of repressive protection in the form of dispute resolution efforts taken both non-litigation and litigation, and compensation in civil lawsuits. In addition, there are also differences, including regulations regarding Geographical Indications and the application of criminal law in trademark disputes.
2. The differentiating factors that lead to differences in the protection of well-known trademarks between Indonesia and Spain are the Politic of Law factors in Indonesia is Democracy while in Spain Monarchy, the Indonesian Legal System factor refers to the 1945 law while the Spanish civil law rooted in Roman law, and the Legal culture factor of Indonesia believes in the customs

of the local community while the Spanish people do not like the rules of cultural authority.

B. Suggestions

From deviant events where imitating well-known and registered trademark for personal interests in order to enrich/benefit oneself in economic affairs. Therefore, some suggestions are given by the author for parties that play the role in determining:

1. The Directorate General of Intellectual Property should be more thorough and careful when registering a trademark so that there are no mistakes in registering well-known trademarks.
2. If any sign is deemed as suitable to be registered as a trademark, therefore it is recommended to start the registration immediately to avoid unwanted intentions from a person and/or a group of persons toward the product.

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