

Pierre Cardin and the Legal Battle for Well-Known Marks: Insights from Indonesia and the Netherlands

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Abstract: This work is aimed at reexamining the well-known mark protection, particularly in Indonesia. It is sparked by a substantive gap, covering theoretical and practical elements in protecting well-known mark. The case rooted at the Indonesian Supreme Court decision that refers to the constitutive systems in mark registration and refused the Pierre Cardin proposal to invalidate the Indonesian local that used mark Pierre Cardin for his convection products. Normatively, the court should analyze and consider the architecture of norms in protecting well-known mark by going further into the international conventions on mark, such as TRIPs agreement and Madrid Protocol that recognize and protect the well-known mark. To analyze this case, this work will apply normative legal research. In the discussion section, this work elaborates the basic concepts of well-known mark, fundamental and core elements as well as the indicators or criteria of well-known mark. In addition, this work will compare some jurisprudences concerning the well-known mark protection. At the end, this work offers some substantive and pragmatic approaches in strengthening well-known mark protection. The substantive approach will discuss and examine some theories, norms, and policies used by judges in handling well-known mark cases. Whereas, the pragmatic approach underlines the importance of institutional networking and legal awareness improvement, particularly key society groups, e.g., university and industry, to control violation of well-known marks.

Keywords: Well-Known Trademark; Pierre Cardin; TRIPs; Legal Protection; Indonesia; Netherland

1. Introduction

Recently, experts, practitioners and commentator in intellectual property have been shocked by the Indonesian court decision that refused Pierre Cardin's demand to protect his marks in Indonesia. In this case, the judges who examined and reviewed the well-known marks case allowed and approved the local mark that used the Pierre Cardin mark in Indonesia.¹ The case showed that there is a substantive gap between theory and practical aspect in the apprehension, appreciation, implementation of well-known mark protection in Indonesia. Factually, the gap caused by many differences in understanding basic concept of well-known mark. So far, there is no general conceptual criteria on well-known mark.

¹ "The Case Pierre Cardin, Indonesian Supreme Court" (2016).

Many experts offer various different concepts on well-known marks. *Frederick Moster* indicated some criteria of well-known mark,² such as: (i) brand knowledge/recognition level; (ii) investment and output of the well-known mark; (iii) width and length of time of advertisement; (iv) recognition, advertisement, registration and maintenance of mark in certain areas; (v) distinguish capability; (vi) exclusive brand and character level; (vii) characteristics of goods and services; Mark commercial value.³

Rahmi Jened for example, indicates that well-known marks and Complexity in legal enforcement related to the utilization of mark for goods and services.⁴ Well-known mark is a mark which always becomes target material to other party to use it incorrectly and unlawful. It caused by well-known mark has high economic value and big potency to the users to win competition to grab the consumers. The fame of a mark makes it becomes interesting and "sexy", so almost everybody (the consumers) know it and even it becomes part of their lifestyle. To them, by having renowned brand, it becomes pride and gives incomparable satisfaction.

In fact, renowned brand not only functions as a mark to distinguish goods and or services, but also a priceless asset.⁵ On the other side, it also functions as *goodwill*. Basically, brand is used to distinguish typical goods and or services, so that protection which given by laws refers the use of typical goods and or services.⁶ The protection is given since rights of the brand can be considered as money. If a mark becomes well-known, so the protection is extended, not only for typical goods or services, but also for untypical goods or services.

For example, brand Toyota is a well-known mark in automotive field, it should be allowed to be used for t-shirt or shoes brand, but since Toyota has included famous brand category, so that the use of Toyota for t-shirt or shoes brand is not allowed. It means that the protection is extended, not only for typical goods but also for untypical goods. There are some reasons can be understood why protection to well-known mark is extended. The reasons relate to cost to make a brand becomes well-known mark is very big which among others are advertiser cost on various printed or electronic media, either domestic or abroad. Besides advertiser cost, brand registration cost in various countries is also big. Mark registration will make a mark becomes well-known, since the consumer

² Arviana Eka, "Perlindungan Hukum Merek Pada Kasus Extra Joss Dan Enerjos" (Universitas Airlangga, 2008).

³ Frederick W Mostert, "Well-Known and Famous Marks: Is Harmony Possible in the Global Village," *Trademark Rep.* 86 (1996): 103.

⁴ Rahmi Jened, *Hak Kekayaan Intelektual: Penyalahgunaan Hak Eksklusif* (Surabaya: Pusat Penerbitan dan percetakan Unair, 2010).

⁵ Nisrina Atikah, "Pierre Cardin Trademark Dispute," *Mulawarman Law Review*, 2019, 14–28.

⁶ Agung Sujatmiko et al., "The Legal Reform of Trademark Protection and Dispute Mitigation: Lessons From Licensing Well-Established Brands in Indonesia," *Journal of Law and Legal Reform* 5, no. 2 SE-Articles (April 30, 2024): 459–94, <https://doi.org/https://doi.org/10.15294/jllr.vol5i2.3467>.

of related mark getting numerous. The paper will elaborate some aspects related to mark issues, in particular from the protection side.

2. Impact of TRIPs and Paris Convention on the Definication and Protection of Well-Known Mark in Indonesia

Criteria of well-known mark until now is still in long debate, there is no single one unity yet. There are some criteria which given by some parties and based on Laws Number 20 Year 2016 about Mark (later abbreviated UUM). Well-known mark criteria in UUM are regulated on Explanation Article 21 subsection (1) letter b which confirms: Rejection of request which has similarity in principle or entirely with well-known mark for typical goods and/or services is done by observing common knowledge of people about the mark in related business field. Besides, also observing reputation of well-known mark gained since vigorous and massive promotion, investment in some countries in the world done by the owner, and followed by evidence of registration of the mark in some countries in the world. If those things above are considered insufficient yet Commercial Court can command institution which independent to do survey to get conclusion about famous or not the mark becomes basic of rejection.

Based on explanation Article 21 subsection (1) letter b, well-known mark criteria are:

- a. Based on knowledge of people about the mark in related business field;
- b. Reputation of well-known mark which gains since vigorous and massive promotion;
- c. Investment in some countries in the world which done by the owner, and followed by evidence of registration of the mark in some countries in the world;
- d. Based on survey which done by independent institution by the command of Commercial Court.

While based on of Article 16 number 2 TRIPs criteria about famous brand is based on Paris Convention gives criteria as follows:

Article 6 bis of the Paris Convention (1967) shall apply, mutatis mutandis to services. In determining whether a trademark is well-known, Members shall take into account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

What stated in TRIPs about the criteria of well-known mark becomes basic criteria of Well-Known brand as found in Explanation of Article 21 subsection (1) letter b UUM. Based on the TRIPs regulation, Art 6 bis Paris Convention about well-known mark is applied to unsimilar goods or services with the goods which the brand registered, and by the regulation that the use of trademark in relation to the goods or services, with the goods which the trademark registered, and also by regulation that registered brand

owner's interest will be disturbed. Later in deciding if a brand is renowned, it must be assumed the knowledge of famous brand in around certain public.

In Ahmad Zen Umar Purba's opinion, the definition of well-known is a still a topic continuously talked, since until now there is no definition yet about *well-known marks* and it back to each member countries.⁷ But, there has been guidelines are released by WIPO that the points relate factors in considering whether a brand is famous or not. The authorized must considering among others below aspects:

- a. Knowledge level or recognition about the brand in related public sector;
- b. Length of time, range and geographic area of the use of the brand;
- c. Length of time, range and geographic area of brand promotion, includes advertiser and publicity also presentation on exhibition of the goods or services of the brand;
- d. Length of time and geographic area of each registrations and each registrations application until one level so that reflects the use or recognition of brand;
- e. Successful law enforcement record of inherent rights on the brand until a level the brand recognized as famous brand by authorized official;
- f. Value related to the brand.

Rahmi Jened states that to be stated as famous brand there are some elements which must be fulfilled, such as:⁸

- a. Length of time, scope, and the use of mark area;
- b. Market;
- c. Distinguisher ability level;
- d. The quality must be good;
- e. Width spread of the use in the world;
- f. Exclusivication character of the use in the world;
- g. Trade value of the mark in the world;
- h. Protection records which succeed to get;
- i. Litigation results in determination of famous or not the mark;
- j. Registration intensity of another brand which similar with related mark

The criteria of Well-Known mark natures universal in many countries, as an example in China found in China Trademark Law 2001. The criteria are as follows:

- a. Reputation of the mark to the relevant public;
- b. Time for continued use of the mark;
- c. Consecutive time, extent and geographical area of advertisement of the mark;
- d. Records of protection of the mark as a well-known mark; and
- e. Other factors relevant to the reputation of the mark.

The criteria used by courts in China as basic to decide well-known mark dispute, as in *Starbuck vs Shang Copycat*, also some of criteria of famous brand in Indonesia, also used as basic to courts to decide famous brand dispute. Article 21 subsection (1) letter c, firmly

⁷ A Zen Umar Purba, *Hak Kekayaan Intelektual Pasca TRIPs* (Bandung: Alumni, 2005).

⁸ Jened, *Hak Kekayaan Intelektual: Penyalahgunaan Hak Eksklusif*.

stated that well-known mark get exclusively protection. The particular thing lies that the protection is not only applied for typical goods and or services but also for untypical goods and or services. The regulation is a form of special protection, since basically mark is used to distinguish typical goods and or services.

The exclusively protection contains meaning that famous brand has function not only as typical goods distinguisher, but also another function. Insan Budi Maulana states brand is a "soul" of goods and services products.⁹ Word "soul" here has important meaning if it is related to continuity of related goods and services products. A product can be continuously live or can be die depends on the brand itself, since in the brand itself has quality and reputation of goods and or services. That is why the brand that has been well-known can be function as *asset* and *goodwill* to the businessman as the owner, even in the progress, Insan Budi Maulana said that nowadays in advanced Asian countries such as Japan, South Korea and Singapore well-known mark is considered as "new god". It caused by succeed of economy development in the countries and the region has change lifestyle of the people, so that no wonder if the total trade of luxurious product with famous brand in across the world reaches US\$80 billion.

From the number, United States of America reaches number 24% of total trade, Europe 35% and Asia reaches number 37%. From the numbers 62% from Japan, Hongkong 12%, also South Korea 8%, the rest are India, Southeast Asia, Taiwan and China. Furthermore, Insan Budi Maulana states that the cult of well-known markonion, unwittingly makes it as "new god" in Asian countries which the economy has established such as Japan, South Korea and Singapore, as well as those which have amazing growth of economic level such as China and India. Even includes also those averages only such as Thailand, Philippines and Indonesia. Well-known mark is often falsified and registered first by local businessman. That is why based on consideration frequency of well-known mark rights violation, so that it needs to be protected and be secured from deeds which leads to cheat competition which adverse to the owner. It caused by famous brand is very fragile to violation while the functionis so important to the continuity of goods or services of production and marketing business.

Law protection to well-known mark is known very urgent it is not only functions to distinguish typical goods and or services but also economic functions. Both functions are so important and vital to brand owner. The function as distinguisher is essential thing to the brand in goods and or services marketing. A good and or service which is sell without brand never can compete in market. On the other hand, if a good and or a service which the brand has well-known by consumers, since the reputation of the brand or the goods quality, it will be easier to win competition in market.

⁹ Insan Budi Maulana, *Perlindungan Merek Terkenal Di Indonesia Dari Masa Ke Masa* (PT Citra aditya bakti, 2018).

Economically, brand function related to property gives income to the owner. As one of income sources, so that, mark rights need to be protected from the deeds lead to violation and crime, since it will be detriment to the owner. As a property, brand rights basically become one of part of assets to the owner, it must get protection of the country becomes its obligation.

Besides as one of media to give protection to mark, license agreement also functions to make a mark becomes a well-known mark. If a mark is licensed in many countries, the related mark will be known consumers. It is initial asset is very supportive to boost a mark fame. Consumption by consumers in across the world is a concrete and practical step in order a brand can be well-known and recognized by people widely. Consumption in a long time makes the consumers finally recognizes that the quality of a mark is indeed good and finally make them will not change to other mark. The recognition is very important to get and to win competition in market. At the end the consumer will choose good quality mark. The consumer choice will continuously exist if they themselves can maintain quality reputation. Even, frequently the consumer becomes fanatic and branded to qualified recognized mark. It meets Casavera's opinion that the mark role from time to time continuously experiences development. Those among others are:¹⁰

For the first time, mark formulated as *unbranded products* characterizes one to another's commodity, the quality is difficult to be distinguished, so that, the price becomes main selling criteria. Then brand as a reference (guidance), in this case, brand is used at once as the name of company. Later, mark as personality, which is expected can be independent, which marketing communication is designed to give meaning to the related brand, meets the context which brand owner is expected. That is not less important thing, brand development later becomes icon. It is not only to be producer's freehold (*property*), but on the other side, it also belongs to consumer. It has been a part of consumer and public daily. Development for further, *brand as company*, in this case, mark reflects complex situation, so that, mark owner must be able to concern in the benefit of the name of company to various kind segment of costumers. Later, at the last development stage, it can be *mark as policy* describes harmony among company, brand and other social issues.

The mark development shows that mark has so important role to company development and support trade, at the end can give income contribution to country, moreover the mark is a well-known mark. That is why, well-known mark regulation found in UUM needs to be completed with Government Regulation (PP) as mandated in UUM. The existence of Government Regulation (GR) is very important, reminding violation cases to well-known mark is getting numerous and sometimes judges do not have the same opinion to

¹⁰ Agung Sujatmiko, "Penyelesaian Sengketa Merek Menurut Undang-Undang Nomor 15 Tahun 2001," *ADHAPER: Jurnal Hukum Acara Perdata* 2, no. 1 (2016): 169–91.

well-known mark definition. It is seen from court verdict in brands case *Intel* and *Extra Jos*. The trademarks case of *Intel* and *Extra Jos* can be examples how there is no similarity of opinion among the judges in deciding a case related to famous trademark.

Commercial Court has ever rejected *Intel Corporation's* claim to cancel *Intel Jeans* trademark, in consideration that *Intel* is in well-known mark. But, in cassation level instead Supreme Court (SC) cancels Commercial Court Verdict and cancels *Intel Jeans'* brand registration. Besides, SC also decides that *Intel* is well-known mark, so that the protection is not only limited on the same products. But different from the case experienced by local mark *Extra Joss*. At the beginning, Commercial Court upholds claim revocation of *Enerjoss* brand registration and recognizes that *Extra Joss* is a well-known mark. But, in cassation level instead Supreme Court (SC) cancels Commercial Court Jakarta Verdict, in consideration, among others, *Extra Joss* is well-known mark.

The two cases give evidences that in court level, there is no similarity of language and definition of well-known mark yet, so that the existence of GR about well-known mark can be used as guidelines to the judge, besides, it useful to mark owner themselves, whether the brand that they have is a well-known mark or not. The existence of GR in Well-Known mark field to give law protection of a mark which someone has, because in these days, violation to well-known mark is getting numerous, it will be adverse to the markholder since selling volume decreases or if the goods quality which produced by the mark forger is inadequate, so that, at the end, the mark reputation will be despoiled. It is the same also, consumer will loss guarantee (trust) of the goods quality that they buy. That is why, government should publish GR about Well-Known mark. Necessity of GR existence is not only can be an evidence of government seriousness to give protection Intellectual Property Rights holder but also as government effort to create conducive condition to businessmen.

Expectedly, the GR will be a guideline for law enforcers in interpreting Well-Known mark. Besides, Commercial Court judge and Chief Justice need to have sufficient knowledge, so that there is similarity in making decision (*predictability*). It is important since judge in Indonesia is not a bidden to previous verdict since Indonesia does not follow precedent system. Providing of law forces supported by reliable human resources is a necessity that must always be owned by government. Law protection to Well-Known mark is also a guarantee of legal certainty in economy field, that must be always get attention to maintain international relationship of Indonesia. Legal certainty achieved will motivate healthy investment and business climate, so that government suggestion to invest and to do business in Indonesia can be achieved. The condition clearly will increase international trust to law enforcement in Indonesia, which in its turn will motivate in trade sector and national business in general. Entirely, economy of Indonesia will get better if there is legal certainty.

3. Legal Protection of Well-Known Trademark in Indonesia

Article 1 number 5 UUM clearly stated that the rights of mark is an exclusive right, which given by Country to mark owner which registered in Brand General List for certain length of time by using the brand by themselves or entitling to other party to use it. The special rights basically nature exclusive only can be done by the owner, while other does not allow to use it without permission of the owner.¹¹ That is why, the rights needs to get protection. The concept that mark rights natures exclusive, it needs to be protected, it is the same way to what is stated by Soedikno Mertokusumo,¹² that the rights is an interest which protected by law, while interest is personal or group demand which expected to be fulfilled. It is the same way to what is stated by Achmad Zen Umar Purba that as a part of IPR, the mark right is part of asset (*property*), and as a right, it is a treasure or *asset* in the form of intangible object (*intangible asset*).¹³ In Keith E Maskus' opinion, between intangible object and tangible object until certain point, both rights are same.¹⁴ But, the prominent difference is on exclusivity aspect. It creates the rights, and the right, no other is compensation of all efforts that has given forth or sacrificed by the owner of the intellectual work.

Reminding that mark rights natures exclusive, so that the rights can be defenced from anyone, so that if there is other who has bad will who does the rights without permission of mark rights holder, so that it has happen rights violation which natures exclusive. In this case, lies the urgency of law protection to a mark. Commonly, the deeds which leads to mark duplication comes upon Well-Known mark which for these days has been known with good reputation by consumer.¹⁵

It happens since the Well-Known mark has good reputation in among the consumers. There are three reasons of violation happens, such as:¹⁶

- a. The breakers party will get material profit quickly and surely, without takes pains to build mark reputation;
- b. The breakers party does not want to take a risk if they must make new brand on their own, since the cost is too expensive;
- c. Profit margins gained from goods selling with false mark is much bigger if it compares to the profit gains if pays research and development cost, advertisement and promotion cost also tax.

¹¹ Anne Fitzgerald and Brian Fitzgerald, *Intellectual Property: In Principle* (Sy: Lawbook Co., 2004).

¹² Sudikno Mertokusumo, *Mengenal Hukum: Suatu Pengantar* (-, 1996).

¹³ Purba, *Hak Kekayaan Intelektual Pasca TRIPs*.

¹⁴ Keith E Maskus and Mohan Penubarti, "How Trade-Related Are Intellectual Property Rights?," *Journal of International Economics* 39, no. 3-4 (1995): 227-48.

¹⁵ James J Holloway, "The Protection of Trade-Mark Goodwill in Canada: Where We Were, Where We Are and Where We Should Be Going," *Intellectual Property Journal* 17, no. 1 (2003): 1-58.

¹⁶ bambang Sulistyobudi, "Aspek Hukum Dalam Persaingan Usaha Tidak Sehat Atas Hak Merek (Khusus Kemasan Merek) Punish Aspect In Emulation Of Indisposed Business By Right Of Brand (Special Of Tidines Of Brand)" (Universitas Diponegoro, 2003).

The three reasons become main interest to the breaker to use other's mark without considering the risk which they have to face if the brand owner denounces it to law enforcers apparatus, for a reason that it has happened brand violation. It seen from Supreme Court Verdict Number 274 PK/Pdt/2003 about Registration Revocation of Well-Known mark PRADA.

The case analysis as follows:¹⁷ Prada S.A is a company in Italy is a mark rights right holder PRADA. The products of PRADA are clothes, shoes, bags, and clothes equipment that has been has international reputation. PRADA has advertised on many mass media which circulates internationally such as, Vogue Pelle, Elle, Harper's Bazaar are world mode magazines and also on newspaper, for an example *New York Times*. The fame of PRADA so globally is reasonable reminding that PRADA's production has top quality and has been sustainable since 1913. Prada S.A has registered mark rights PRADA in many countries, such as United State of America, Japan, Germany, Armenia, Austria, Belarus, Bosnia Herzegovina, Bulgaria, China, Croatia, Cuba, Egypt, Spain, France, South Korea, Sudan, and in many other countries. In 1993, Fahmi Babra, an Indonesian citizen, does registration at Directorate General IPR Republic of Indonesia. The registration does without notice and approval of Prada S.A is the real brand rights holder PRADA.

Based on Article 4, 5 and 6 UUM, it should be that registration that done by Fahmi Babra is rejected, since the brand rights which registered by Fahmi Babra has similarity with famous brand PRADA. The logo registered by Fahmi Babra is identical with the logo PRADA has been used first by *Prada S.A.*, suchas:

- a. Name "*Prada*";
- b. Word "*Milano*";
- c. Writing 'dal 1913; and
- d. Logo which is the rights of Italian kingdom "*prada*", which surrounds the name "*prada*", which is a knotted rope with the symbol of Italian kingdom.

Although what has done by Fahmi Babra is a deed which is cheating 100% logo of PRADA Director General IPR has uphelded registration request of Fahmi Babra's mark rights in 1995 with registration number 328996 and 329217. The giving of mark right to Fahmi Babra followed by Fahmi's deed produces the goods in Bali, among others at Discovery Mall. It creates detriment to *Prada S.A.*, either material or immaterial. The concrete example of the detriment is many people who buy Fahmi's product in Bali and on days later, the people is unsatisfied and submits a claim to *Prada S.A.*, It is indeed ruins *Prada S.A.* reputation.

In material, *Prada* is very aggrieved since the prices offered by Fahmi Babra are cheaper than prices offered by *Prada S.A.* makes many people choose to buy Fahmi Babra's product. Detriment estimation which suffered by *Prada* until 2007 because of Fahmi

¹⁷ Otto Cornelis Kaligis, *Teori Dan Praktik Hukum Merek Indonesia* (Alumni, 2008).

Babra's deed is US \$ 50.000.000,- Faces the problem, *Prada S.A.* submits a claim at Local Court Central Jakarta with case number 200/PDT. G/1998/PN.JKT.PST. But the claim is rejected by Local Court with argumentation although it is the Well-Known mark rights, *PRADA* indefinitely yet Well-Known in Indonesia. The argumentation does not make sense since the parameter of whether a mark right can be stated Well-Known, not depends on the reputation in a country, but it depends on the reputation in the world. To the verdict, *Prada S.A* submits cassation but it rejected for the same reason from Local Court. Then *Prada S.A.* submits extraordinary law effort that is Case Review has accepted by Supreme Court with case number 274 PK/PDT/2003.

In the Case Review *Prada S.A.* claims Fahmi Babra as Defendant I and Government of Republic of Indonesia cq.Ministry of Justice and Human Rights cq Directorate General IPR cq Brand Directorate as Defendant II, and in the verdict dated December 14, 2007, Supreme Court gives the verdict as follows:

- a. Upholds all Plaintiff's claims;
- b. States that Plaintiff is famous brand and logo owner in Indonesia;
- c. States that brand registration and logo Prada registered No. 328996 and 329217 in the name of Defendant I has similarity mainly with Well-Known mark and logo Prada which owned by Plaintiff;
- d. Revocates mark and logo registration *Prada* No. 328996 dan 329217 registered in the name of Defendant I from mark General List;
- e. Commands to Defendant II to subject and to obey to the Court Verdict by recording mark and logo *Prada* revocation registered No. 328996 and No. 329217 in the name of Defendant I from Mark General List and announces it in Official Mark Report.

Supreme Court Verdict based on condition since Defendant violates regulation Article 4 and 6 subsection 1a and 1 b) UUM. Brand *PRADA* registration which done by Defendant is done by bad will, which should not be done since it will be adverse Plaintiff. The bad will be seen from Defendant deliberateness to use the same mark in principle or entirely with famous mark belongs to Plaintiff has registered first. The *Prada* has registered by Plaintiff in many countries, includes in Indonesia since longtime also has advertised in various mass medias in across the world.

For that reason, *PRADA* is a Well-Known mark. The fame is recognized across the world including Indonesia. The fame of brand *PRADA* has recognized widely since the mark has got recognition from consumer, the production and marketing has done widely in the world, then also because of producer support, also the mark use and mark recognition succeed which supported by brand circulation in wide business network. Some criteria are based on standard parameter has recognized by the experts and *World Intellectual Property Organization* (WIPO) recommendation. That is why, it is really does not make sense if Defendant does not know about it, since the fame of a brand seen from who the users of the mark are.

As the businessman, Defendant is considered to know and to notice, but since they has a bad will, so that he keeps use and registers it. It obviously contradictive to Article 4 UUM obliges the presence of good will in mark registration issue. Defendant also violates Article 6 (subsection 1a and 1 b) since the mark PRADA that he registered has similarity in principal or entirely with brand PRADA owned by Plaintiff. It based on sound, word, pronunciation and logo used is exactly the same with mark PRADA owned by Plaintiff.

In the mark *Nike* case, Supreme Court by the Verdict Number 220 PK/Pdt/1986 grants *Nike International Ltd's* claim. Consideration which used by Supreme Court that mark *Nike* which registered by Lukas Sasmito is revoked since Lukas Sasmito has bad will since registers a mark that has similarity entirely or in principle by "Nike" trademark belongs to Nike International Ltd. which based in Oregon, United States of America.

Case review decision by Supreme Court has defeated and revoked brand Nike registration which has done by Lukas Sasmito, also in previous claim case. Supreme Court also has opinion that Lukas previously has requested by a letter dated September 23rd, 1982 and November 2nd 1982 which in principle requests works together in shoes making and selling field with trademark *Nike*. As a Well-Known mark owned by *Nike International Ltd.* is a mark has known for years by people with reputation has good quality. *Nike* has become brand *image* to consumer since the good quality and advertised vigorously on various mass media. *Nike* also has been registered in many countries, so that, it deserves to be considered as a Well-Known mark. The Well-Known mark predicate places *Nike* as a mark get exclusively protection in the form of, it is not allowed to be used for typical and untypical goods.

Another interesting case relates to mineral watermark AQUA. The mark has been many times experiences duplication to various marks similar, among others are CLUB AQUA, AQUARIA, and INDOQUA.¹⁸ *The first*, in the mark case CLUB AQUA, PT. Aqua Golden Mississippi as the Well-Known mark owner claims mark revocation registered by Konstantin Herry Liemen, with the reason, it has similarity in principle with mark AQUA. By the verdict number 757 K/Pdt/1989 of the date March 30 1992, Supreme Court has opinion that mark CLUB AQUA has similarity in principal with mark AQUA. Consideration that used is although word Aqua origins from Latin language that means water, but in the word Aqua known in Indonesia as mineral water goods type (drinking water) after brand AQUA circulates in Indonesia. *The second*, brand CLUB AQUA consists of two words, but word Aqua is still be dominant element, while AQUA as a mark has owned to PT. Aqua Golden Misissippi.

¹⁸ Kaligis.

For that reason, Supreme Court has opinion that between AQUA and CLUB AQUA do not have significant difference, and on the other hand, they have similarity in principal instead. For the decision, Sudargo Gautama has an opinion that Supreme Court has given a *landmark decesion*, since it has given guidance relates how to solve Well-Known mark duplication uncommonly.

The second, similar with brand CLUB AQUA is brand AQUA duplication which is done by another brand AQUARIA which registered for soft drink, coffee and tea. By the Verdict Number 980/K/ Pdt/ 1990 dated March, 30 1992, Supreme Court upholds PT. Golden Mississippi's demand and judges that mark AQUARIA which registered by PT. Idotirta Jaya Abadi has similarity in principle with mark AQUA, at once states that PT. Idotirta Jaya Abadi has got bad will by putting the fame of mark AQUA. ²⁷

The third, dispute between brand AQUA and INDOAQUA. In this case Supreme Court does not see the similarity in principle between AQUA and INDOAQUA, so that, by the verdict number 04. PK/N/HaKI/2004 dated November 4th 2004, Supreme Court rejects Case Review claim submitted by PT. Aqua Golden Mississippi. Brand INDOQUA registered in the name of H.M Mansyur Saerozi does not have similarity in principal with brand AQUA. Supreme Court verdict based on a reason that between AQUA and INDOAQUA does not have similarity the form, placement, writing, or the combination among the elements or the similarity of the pronunciation sound. The case that is against mark AQUA is an example that as a Well-Known mark AQUA has been a target to parties that have bad will to put the fame of a mark. The bad will becomes a trigger of arise of brand dispute and it is a violation to Article 4 UUM. Article 4 UUM regulation firmly requires the presence of goodwill to brand registrant which not only an obligation but also a regulation which natures forces.

4. Comparative Analysis of Well-Known Marks Protection: Insights from Australia, Japan, and USA

In some countries, law protection to Well-Known mark also gets very important attention. For example in Australia regulated in Australian Trade Mark Law 1995.¹⁹ Basically, registration and law protection which given by the country to Well- Known mark brand natures defensive with the main purpose that the protection can prevent and protect well-known mark cheat competition deed (*passing off*).²⁰ Protection regulation to well-known mark from cheat competition deed (*passing off*) is indeed so correct reminding law violation to Well-Known mark commonly based on cheat competition

¹⁹ Peter Hallett, "Certification Marks—Are They Really Worth the Hassle? An Australian Perspective," *Les Nouvelles* 48, no. 2 (2013): 99–103.

²⁰ M. Ilham Surya Dirja, "Perlindungan Merek Terkenal Pada Kemasan Produk Tiga Dimensi (Studi Banding Regulasi Brand Laws Di Amerika Serikat Dan Di Indonesia)" (Universitas Indonesia, 2012).

deed. Even in Japan, law protection of Well-Known mark regulated in two laws, there are Brand Laws and Unfair Competition Laws, which both of the laws complete to each other.

The Well-Known mark protection in Japan more leads to a protection which nature is administrative.²¹ In Well-Known brand violation cases and circulates to public, regulation and protection of the law based on unfair competition laws. It is different from in Indonesia, regulation and protection of the law is still based on mark laws. Indonesia does not have yet laws about unfair competition in particular which regulates about unfair competition in IPR and other business fields. In the future, it should be thought about that kind of laws, in order that it can complete the related laws which has been existed in order that can more complete and improve legal certainty.

While *Lanham Act*, law protection of Well-Known mark in United State of America²² is related to dilution act (*dilution*), which means in United State of America, a Well-Known mark owner tries maximize to prevent other trader uses their mark, even the protection is extended for product which is not the competitor (*non competing*). Related to protection regulation of Well-Known mark related to the dilution. The purpose is to give protection to consumer or people widely from fraud act and mark duplication. While, law protection of Well-Known mark in Indonesia, in UUM is regulated in Article 21 subsections (1c). The article in principle confirm that mark registration request must be rejected if a brand which will be registered has similarity in principle or entirely with Well-Known mark of other parties for typical goods and/ or services.

The protection of well-known marks under Article 6 subsection (2) is broadened, extending not only to similar goods and/or services but also to dissimilar goods and/or services. Application extension shows that laws former has attention and protection of Well-Known mark registered. If it observed for further, the protection to Well-Known mark nature is preventive, it means since the beginning, laws former gives protection to famous brand since the beginning when a mark will be registered, with purpose in order that mark registration candidate can know and aware that brand registration should not be contradictive to Well-Known mark which has been existed. The fame of a mark not only gives profit financially, but also legal profit.

To sum up this session, it is necessary to consider some important or legal strategic steps and proactive measures to prevent infringement and dilution of the well-known marks, in Indonesia and other countries, such as: (i) mark registration,²³ include primary

²¹ Hallett, "Certification Marks—Are They Really Worth the Hassle? An Australian Perspective."

²² Brandon Barker, "The Power of the Well-Known Trademark: Courts Should Consider Article 6bis of the Paris Convention an Integrated Part of Section 44 of the Lanham Act," *Wash. L. Rev.* 81 (2006): 363.

²³ "This Registration Could Be in the Forms of Primary Registration to Ensure That the Well-Known Marks Are Registered with the Directorate General of Intellectual Property (DGIP) in Indonesia, and International Registration That Register the Trademark Intern" (n.d.).

registration and international registration; (ii) regular renewals and maintenance; (iii) customs recordal;²⁴ (iv) active monitoring and surveillance;²⁵ (v) engage in legal actions;²⁶ (vi) promote and educate;²⁷ (vii) licence and franchise oversight;²⁸ (viii) utilizing technological solutions;²⁹ (ix) collaborating and networking;³⁰ (x) optimizing legal framework;³¹ (xi) consulting with local experts. Implementing a combination of the above legal strategic steps and progressive measures, customized according to the specific circumstances and market conditions, can bolster the protection of well-known marks in Indonesia from mark infringements. In addition, continual reviews, reassessment and adaptation of the strategies are crucial and highly relevant to navigate the evolving challenges in trademark protection.

5. Trademark Law in the Netherlands: Analysis of Protection and Enforcement Mechanisms

The Netherlands provides trademark protection through its flexible registration procedures and availability of injunctions in summary actions.³² This article provides a comprehensive and precise analysis of the potential for trademark enforcement in the Netherlands. Trademarks are symbols or indicators employed to differentiate specific products and services.³³ Trademarks typically consist of a combination of a term and/or a logo.³⁴ Trademark law also provides protection for company trade names or domain names.³⁵

²⁴ "Record the Well-Known Trademarks with Indonesian Customs to Prevent the Importation of Counterfeit Goods" (n.d.).

²⁵ "Conducting Regular Market Surveys and Online Searches to Identify Potential Infringers, and Monitoring New Trademark Applications to Oppose Any That Are Similar" (n.d.).

²⁶ "Taking Legal Actions Such as Sending Cease and Desist Letters against Infringers and Initiating Legal Proceedings to Enforce Trademark Rights, Such as Filing a Lawsuit" (n.d.).

²⁷ "Actively Promote the Well-Known Marks through Various Media and Educating the Public and Relevant Industries about the Distinctiveness of the Well-Known Marks" (n.d.).

²⁸ "Ensuring Stringent Guidelines to Prevent Misuse or Dilution and Monitoring Licensees and Franchises for Compliance" (n.d.).

²⁹ "Employing Technology to Monitor Online Infringement and Using Digital Tools to Trace and Track Counterfeit Products," n.d.

³⁰ "Collaborating with Industry Associations or Organizations Involved in Trademark Protection and Engaging with Law Enforcement and Other Authorities Proactively" (n.d.).

³¹ "Utilizing the Legal Frameworks Provided under Indonesian Law, ASEAN Frameworks, and International Conventions and Keeping Abreast of Legal Updates and Reforms" (n.d.).

³² Anna Drgová, "Appropriateness of the Forum Delicti for the European Union Trademark Online Infringement Litigations" (Tilburg University, 2019).

³³ Shukhrat Nasirov, "Trademark Value Indicators: Evidence from the Trademark Protection Lifecycle in the US Pharmaceutical Industry," *Research Policy* 49, no. 4 (2020): 103929.

³⁴ Mark A Lemley and Mark P McKenna, "Trademark Spaces and Trademark Law's Secret Step Zero," *Stan. L. Rev.* 75 (2023): 1.

³⁵ Mohammad S Al Ramahi, "Internet Domain Names & Trademark Law: Does the Current Legal Scheme Provide and Adequate Protection to Domain Names under the US & UK Jurisdictions?," in *Paper Delivered at the 21st BILETA Conference: Globalisation and Harmonisation in Technology*, 2006.

Additionally, it is feasible to safeguard more elusive indicators, such as forms or hues. Three systems regulate trademark protection in the Netherlands:³⁶ the Benelux Convention on Intellectual Property Rights, the EU Trademark Regulation, and the Trademark Directive. These laws are a component of the harmonized trademark law in Europe. Prerequisites for registration Trademarks in the Netherlands are protected exclusively if they have been registered. However, there is a special provision for widely recognized trademarks. In the Netherlands, the registration of a trademark necessitates fulfilling certain prerequisites. Trademarks must undergo registration for several categories of goods and services, such as class 9 for software and class 25 for apparel.

As per the European Court of Justice, it is necessary for the description of these products and services to be extremely accurate. A trademark registration remains valid for duration of 10 years and can be renewed indefinitely thereafter.³⁷ Granted rights upon successful completion of the registration process for Benelux trademarks or European trademarks (which are also recognized in the Netherlands), trademark holders are granted several exclusive rights by the BCIP and EU Trademark Regulation. These rights include the ability to take legal action against any trademark infringements. Trademark protection is granted to prevent a third party from using a sign in their business without the permission of the trademark holder.

This protection applies in two cases: 1) When the sign used by the third party is identical or similar to the trademark and is used for identical or similar goods or services covered by the trademark. This can cause confusion among the public; 2) When the sign used by the third party is identical or similar to the trademark but is used for goods or services that are not similar to those for which the trademark is registered. In this case, the trademark must have a reputation in Benelux territory. If the use of the sign without a valid reason takes unfair advantage of or harms the distinctive character or reputation of the trademark, it is considered infringement.

Trademarks with a reputation are also protected against the use of similar signs for similar goods and services. The BCIP also provides protection against the use of signs for purposes other than differentiating goods or services. This form of protection is unparalleled in Europe. The protection provided by this article member can be used to prevent the unauthorized use of a trademark or trade name, particularly when it is used in a manner that is not economically beneficial. Procedure for obtaining an injunction in the event of a trademark infringement, the holder of the trademark has the option to initiate what is known as a "*kort geding*" (summary proceedings) in the Netherlands. This

³⁶ Wolfgang Sakulin, *Trademark Protection and Freedom of Expression: An Inquiry into the Conflict between Trademark Rights and Freedom of Expression under European Law*, vol. 22 (Kluwer Law International BV, 2011).

³⁷ Tara M Aaron and Axel Nordemann, "The Concepts of Use of a Trademark under European Union and United States Trademark Law," *Trademark Rep.* 104 (2014): 1186.

is a legal process called an injunction, in which the owner of a trademark can prevent the unauthorized use of their brand and also request a court-ordered punishment against the party that is infringing on the trademark in order to effectively enforce the injunction.

Depending on the specific trademark being referenced, it is possible to obtain either a Benelux or pan-European injunction. Typically, the initial step involves sending a cease-and-desist letter to the entity engaging in the infringement. Commencing a summary proceeding offers various advantages, including the ability for the trademark holder to get a verdict promptly. Additional data regarding the allocation, sales statistics, and supplementary assertions may be acquired in certain instances.

In accordance with Dutch legislation, the holder of a trademark is further endowed with other unique privileges, including the ability to confiscate counterfeit goods, place liens on these items, and generally enforce their trademark rights. Under certain circumstances, it is feasible to petition the courts for these legal actions without prior notification to the party in violation (various *ex parte* remedies can be pursued against infringers). Legal expenses system Under Dutch procedural laws, the prevailing party in intellectual property procedures, such as trademark proceedings, has the right to petition the court to order the losing party to cover the entirety of the actual and complete legal and procedural expenses. If the trademark proprietor prevails in the action based on trademark protection, they can recover most of the real legal expenses incurred in the matter.

Trademarks provide protection against third parties who use identical or confusingly similar trademarks in products and services.³⁸ In the Netherlands, trademark protection can be obtained through three methods:³⁹ applying for a Benelux trademark, applying for a EU Community trademark, or applying for an international trademark. Under the Benelux Convention on Intellectual Property, trademarks can be registered in Belgium,⁴⁰ the Netherlands,⁴¹ and Luxembourg,⁴² including names, logos, colors, designs, music tunes, and smells. The trademark must be registered according to the Nice Classification (NCL) and is valid for 10 years, with unlimited renewable periods. If not used for 5 years, the registration may be invalidated.

³⁸ Robert G Bone, "Rights and Remedies in Trademark Law: The Curious Distinction between Trademark Infringement and Unfair Competition," *Tex. L. Rev.* 98 (2019): 1187.

³⁹ Dirk Pieter Raeymaekers, "Assignments, Licenses and Abandonment of Trademark in the Benelux," *Trademark Rep.* 68 (1978): 15.

⁴⁰ Matthias E Storme and Jasmine Malekzadem, "Security Rights in Intellectual Property in Belgium," *Security Rights in Intellectual Property*, 2020, 119–46.

⁴¹ Paul L Reeskamp, *Intellectual Property Law in the Netherlands* (Wolters Kluwer, 2002).

⁴² Thierry Bovier et al., *Intellectual Property in Luxembourg* (Éditions Larcier, 2019).

The European Union Community Trademark Regulation allows trademarks to be applied for the entire territory of the EU.⁴³ However, the advantage of securing trademark protection for the whole EU may be offset by the possibility of having an older, identical, or similar trademark from a third party owner in the EU territory. If a trademark owner already has a trademark registration in a member state of the Madrid System, they can expand their protection to other member states of the Madrid System. China, the Netherlands, and the EU are all parties to the Madrid System, allowing Chinese registered trademarks to be easily expanded to the EU or the Benelux.

The Netherlands has a unique approach to trade mark and copyright law, which differs from the laws of Benelux and EU countries.⁴⁴ The country's largest statutory regime is the "Copyright Act" (*Auteurswet*), which protects creators of literary, scientific, or artistic works against copyright infringement.⁴⁵ The Trade Name Act (*Handelsnaamwet*) protects companies against other persons using their company name.⁴⁶ The Benelux Convention on Intellectual Property (BCIP) is applicable for the prosecution and protection of Benelux trademarks. The Netherlands is also subject to various EU regulations and directives, including the DSM Directive, which focuses on copyright and related rights in the Digital Single Market, the Infosoc Directive, the Resale Directive, the Satellite and Cable Directive, IPRED, the Term Directive, the Orphan Works Directive, Satellite and Cable II, the Digital Services Act Regulation, and the Trade Mark Regulation. These directives are implemented in the Dutch Copyright Act and contain almost identical provisions concerning the issues discussed in this chapter.

The Netherlands is also party to the Berne Convention, TRIPS Agreement, and Madrid Agreement, which govern the rights of foreign trademark or copyright holders in the Netherlands. The country recognizes various types of trademarks, including word marks, figurative marks, shape marks, color marks, sound marks, pattern marks, position marks, hologram marks, motion marks, and multimedia marks. Certification and collective marks can also be registered, with certification marking out the standard for being able to use the mark. Industrial designs are generally precluded from trademark protection insofar as they are used to protect a purely functional design. To register a trademark in the Benelux or European Union, the application must withstand relative and absolute grounds for protection.

⁴³ Verena Von Bomhard and Artur Geier, "Unregistered Trademarks in EU Trademark Law," *Trademark Rep.* 107 (2017): 677.

⁴⁴ Eric D Offner, "The Benelux Trademark Convention," *Trademark Rep.* 54 (1964): 102.

⁴⁵ Jane C Ginsburg, "Overview of Copyright Law," in *Oxford Handbook of Intellectual Property*, ed. Rochelle Dreyfuss; Justine Pila (Columbia Public Law Research Paper, 2016).

⁴⁶ Rogier W De Vrey, "Dutch Law," in *Towards a European Unfair Competition Law* (Brill Nijhoff, 2006), 79–146.

The most important threshold is that the trademark must be distinctive. The acquiring party only has a duty to prove or remedy a lack of distinctiveness if the registering office determines that this threshold is not met. Factors to consider in the assessment of distinctiveness include the trademark's ability to identify products and/or services offered by the company as distinct from those offered by other companies. Trademark owners have the right to exclusive use of the trademark, including authorize or prohibit others from using it. They can address unauthorized users by filing injunctions and/or claiming damages. These rights outlined by the BCIP and the Trade Mark Act, which persist throughout the term of a mark. The BCIP and the Trade Mark Act have incorporated an anti-circumvention right through the absolute grounds for protection, which precludes registration of trademarks with an essentially technical function.

In the Netherlands, trademarks can only be protected through registration, but it can be lost if not used for five years. Genuine use is the use of the trademark to market or sell products and/or services for which the trademark is registered. The use of symbols to denote that a mark is registered is not necessary and has no legal effect under Dutch and European trademark laws. Related rights can be protected by copyrights or related rights if they meet the respective thresholds. In case of copyright protection, the logo must be sufficiently creative and the work is the author's own intellectual creation.

The Trade Name Act protects names used in business operations, and registration is not required to receive protection for a trade name. Copyright ownership, protection, and rights are essential elements of copyright protection. Any type of work can be protected by copyright as long as the thresholds for copyright protection are met. Essential elements of copyright protection include being original, being the expression of the author's intellectual creation, and being identifiable with sufficient precision and objectivity. Authorship is not defined by statute, but the thresholds have been shaped by case law. Copyright owners hold the rights to reproduce the work and communicate it to the public.

The Netherlands recognizes moral rights within copyrighted works, such as the right of attribution (paternity right), the right to object (integrity right), the right of disclosure (publication right), and the right of withdrawal (withdrawal right). These rights are generally inalienable, meaning they cannot be transferred to others. Synchronization rights are not recognized by statute but are granted value in practice through exploitation agreements between music creators and publicists. The term of protection and termination of copyright rights grants a lifelong entitlement, extending to 70 years posthumously. Owners can lose these rights by transferring, assigning, or licensing away their rights. Notices and symbols do not have any legal meaning in relation to copyright ownership under Dutch or EU laws. Collective rights management systems, such as Buma, established by the Dutch Minister of Justice under Article 30a of the Dutch Copyright Act.

While authors are not obligated to engage Buma's services, the establishment of another organization with similar or overlapping functions is prohibited under Dutch law.

Under Dutch and EU laws, it is not possible to register a copyright. The Dutch and EU law systems do not maintain a register for copyrights, which means that applications for copyrights would not arise. However, related rights can be protected by trademark rights, database rights, design rights, and other forms of protection. Trademark rights can only be acquired through registration with the Benelux Office of Intellectual Property (BOIP) or the EU Intellectual Property Office (EUIPO) for coverage in all EU Member States. The process for registering trademarks is generally the same for each type of trademark, except for certification or collective marks.

There are two relevant trade mark registers that apply to the Netherlands: the BOIP trade mark register for registrations in relation to the Benelux and the EUIPO trade mark register for registrations pertaining to all EU Member States. These registers are both publicly available on the respective office's websites. The term for registration is ten years, which can be extended indefinitely for additional ten-year periods. Trademark owners have six months to renew their registrations after the terms have lapsed. If the trademark expired and is past the six-month revival period, the only way to retrieve the trademark registration is by reapplying for registration. It is not possible to update a trademark registration without applying for a new trademark registration.

The application process for a trademark is fairly straightforward. The BOIP and EUIPO registers offer an online form, which must be completed. The required fee must be remitted before the registration is taken into consideration by the examiners. If the application meets the absolute and relative requirements, the application will be published in the register. After these two or three months, if no oppositions have been received, the trademark will be registered.

Multi-class trademark applications can be applied for, with filing fees for the BOIP being EUR244 for a regular application and EUR440 for an accelerated application. The EUIPO filing fees are EUR850, with additional fees for the second class and more classes. No requirement is placed on the applicant to use its trademark in commerce before the registration is issued. The BOIP and EUIPO offices evaluate the relative grounds for protection of a trademark by considering existing prior rights that predate the trademark application. Owners of these prior rights are entitled to challenge a trademark application by presenting various forms of evidence to support their claim.

Opposition proceedings filed by third parties once the application is published in the registers. The opposition can be based on various grounds, such as the similarity of the trademark to existing trademarks, likelihood of confusion, lack of distinctiveness, or violation of earlier rights. The trademark applicant has the opportunity to respond to the opposition by submitting counterarguments and evidence supporting the registration of

the trademark. The BOIP/EUIPO examines the opposition, response, and supporting evidence before making a decision. During the application process, it is possible to revoke, change, amend or correct a trademark application. This can relate to material alterations, such as the applicable classes or the mark itself. However, while narrowing the scope of the application is permissible, broadening it is not allowed. Dividing a trademark application requires an application to divide the application, which must be filed in writing in accordance with the respective form provided on the website of the BOIP and EUIPO. The administrative fee for division is EUR250. Incorrect information in an application could result in the invalidation of a registration or rejection of an application. In practice, if the incorrect information was provided inadvertently, the examiner will provide an opportunity to correct the information.

Trademark registration can be refused based on several absolute grounds. These include lack of distinctiveness, descriptiveness, generic terms, deceptive marks, shape of goods or their packaging, contrary to public policy or accepted principles of morality, national emblems, official signs, and hallmarks, and geographical indications and designations of origin. The applicant may file for an appeal within two months of the decision, which must be made with the respective office (BOIP or EUIPO). The process depends on whether one or more parties are involved. In case of an inter-partes appeal, both parties will be heard. The appeal will be examined by the board of appeals, will ultimately issue a decision. This decision may be appealed within two months of notification of such decision. The appeal proceedings of this decision will be conducted by the CJEU.

The Netherlands is a party to the Madrid system, which does not provide for any specific additional requirements aside from holding a valid registration to base the international registration on. Parties are permitted to file an opposition to a trademark application within two (BOIP) or three (EUIPO) months of the publication of the trademark application in the relevant register. However, the filing of an opposition does not immediately require substantiating of the opposition. Upon expiration of the opposition period, the applicant and opposing party enter into a cooling-off period of two months to reach an amicable solution.

In conclusion, the application process for a trademark application can be revoked, changed, amended, or corrected, but broadening the scope is not allowed. The application process also includes the possibility of dividing a trademark application, presenting evidence of deceptiveness, and addressing the Madrid system's requirements. The Netherlands has a unique legal system for trademarks and copyrights, with opposition proceedings being based on relative and absolute grounds such as similarity to existing trademarks, likelihood of confusion, lack of distinctiveness, or violation of earlier rights. Opposition can also be based on dilution, which involves the "whittling away" of a trademark's distinctiveness that does not cause confusion.

The opposition procedure is described in 4.8 Consideration of Third-Party Rights in Registration, with no discovery phase and a "closed universe" of evidence. Parties can appeal the decision by the respective office within two months of notification, filing the appeal with the board of appeals. Revocation/cancellation proceedings are available for trademarks, as copyrights are not registerable in the Netherlands. The grounds for invoking revocation and cancellation are similar to those in opposition proceedings, with processes bearing resemblance. Re-examination is available only through an appeal of an examiner's decision, taken to the board of appeals of the respective office.

Revocation/cancellation actions for trademarks can be brought before both civil courts and the respective office. Partial revocation/cancellation is possible if a request for cancellation of a trademark is deemed overly broad. Amendment in revocation/cancellation proceedings is not possible, as it is not possible to make material changes after registration of the trademark. Combining revocation/cancellation and infringement is only possible in cases heard before the civil courts. Bad faith filing is considered an absolute ground for invalidation by the BOIP and EUIPO. If the trademark application makes to registration, the cancellation must be requested by a third party (i.e., not the office itself). If the applicant is found to have filed a trademark application in bad faith, this will lead to the rejection of the application or the invalidation of the registration. Assignments and licensing are different for trademarks and copyrights.

For trademarks, a written agreement is required, stating the assigned rights and indicating the trade mark(s) this pertains to. The assignment agreement must be filed with the respective trademark office for third-party effect. For copyrights, the assignment agreement alone is sufficient for third-party effect, but it is particularly important to be as precise about the subject matter assigned. Both trademarks and copyrights are transmissible upon death. The procedures for licensing trademarks or copyrights are similar to assigning the rights thereto, with various possible licenses and applications available. Trademarks can be assigned or granted during the application process without specific restrictions. Assignments and licenses must be recorded with the respective trademark office, and if not carried out, third-party effect will not occur.

Trademarks and copyrights can be given as security, lien, subject to rights in rem, or otherwise levied in an execution. For trademarks, such security must be recorded with the respective trademark office, and the pledge to support this recordation must be provided. Copyrights are non-registerable, but the subject matter is still relevant for copyrights. Initiating trademark and copyright lawsuits is crucial, and claims of infringement must be brought within 20 years from the moment when they are first discovered. The IPRED (International Protection of Trade Marks and Copyrights) provides harmonized legal claims available to trade mark owners and copyright holders.

Key enforcement options include injunctions, damages, corrective measures, publication of judgments, preservation of evidence, information, provisional and precautionary measures, and costs of enforcement. For trade mark infringement, the rights-holder must prove that there is either (i) use of an identical mark for identical goods or services; (ii) use of a confusingly similar mark for confusingly similar goods or services; or (iii) use of an identical or similar mark for different goods or services, but where the mark takes an unfair advantage of the invoked trade mark's reputation. For copyright infringement, the rights-holder must prove that they hold the rights (e.g., in case of prior assignment, the chain of title), the scope of the copyright protection, and the infringement thereof by the other party.

Factors in determining infringement are established by statute for trademarks, and case law for copyright infringement. Parties to an action for infringement are the rights-holder and the (alleged) infringer, but it is also possible for a third party, such as the license holder, to initiate an action for infringement. Trademark owners cannot invoke an application for a trademark, since no rights have been granted before registration is recorded. The Netherlands allows for representative or collective actions for trademark or copyright proceedings, with a clear power of attorney in place to initiate an action on behalf of the represented parties.

The Dutch legal system allows for the filing of trademark or copyright claims in civil courts, subject to forum rules. The costs that typically arise before filing a lawsuit include advice, warning letters, collecting evidence, and negotiating with the infringer. Parties need to be represented by an attorney in order to litigate a trademark or copyright lawsuit. There are no restrictions as to the nationality or country of residence of the trademark owner or copyright holder in bringing an infringement claim in the Netherlands. The pleading standards for a trademark or copyright lawsuit do not differ from other lawsuits but must clearly articulate the specific infringing behavior. After filing the claim, it is possible to bring supplemental arguments during the court hearing or on request and with approval by the other party and the court. A defendant can make a counterclaim in the same proceeding or initiate a separate lawsuit.

Defendants can start declaratory judgment proceedings without restrictions on the circumstances for this. Small claims courts (*kantonrechter*) hear claims under EUR25,000. The civil courts are bound by the decisions of the respective trademark office. Counterfeit marks are treated as a trade mark infringement, while copyright counterfeiting is treated as a copyright infringement. There are special procedures for counterfeiting and are dealt with by customs authorities pursuant to Regulation (EU) 608/2013 concerning customs enforcement of intellectual property rights (IPR). Bootlegging is not specifically defined in legislation or case law, and is typically treated in the same manner as regular copyright infringement. Trademark and copyright proceedings follow the regular procedural rules

as set out by the Dutch Code of Civil Procedure. The parties only have an influence on the decision-maker when they decide to engage in arbitration.

Another Dutch alternative is the Netherlands Commercial Court, which does have specific expertise in intellectual property rights but is generally more expensive and must be chosen by mutual agreement. The trademark registration owner is presumed to hold the rights thereto, but in case of copyrights, this must be proven by the party asserting such rights. Whether the alleged infringer must be using a mark for the same goods and services as those listed in the registration is contingent on the claim for infringement. Expert witnesses and/or surveys are allowed for trademark and copyright infringement actions in the Netherlands. Courts will assess the trustworthiness of these types of evidence and often play a decisive role in the outcome of the case. Criminal liability for trademark or copyright infringement is possible under Dutch law, covered by the Dutch Penal Code. Penalties may include fines and imprisonment, and the severity of penalties can vary based on factors such as the commercial scale of infringement.

The Netherlands has a limited copyright protection system, with a finite duration of 70 years. This includes "fair use" or "fair dealing," which allows for the use of copyrighted material for purposes such as criticism, review, use by handicapped people, artworks, news reporting, education, research, and parody. A balance must be struck between copyright and freedom of expression, based on the circumstances of the case. Works in the public domain are not protected by copyright, but they may enter the public domain if the copyright has expired, if the author has explicitly waived their rights, or if the work was never eligible for copyright protection. Private copying of copyrighted material is allowed in the Netherlands, and a private copying levy may be applied to certain media and devices. Dutch copyright law includes a provision for "quotation rights," allowing the use of short excerpts from copyrighted works for purposes such as criticism or review, as long as proper attribution is given.

Educational use exceptions allow the use of copyrighted material in educational contexts without requiring permission, provided certain conditions are met. Orphan works, on the other hand, refer to copyrighted materials whose owners cannot be identified or located, posing challenges for obtaining usage rights. Government works created by the Dutch government or public authorities may not be eligible for copyright protection or may have limited protection. The Netherlands provides an exception for private copying of copyright-protected works, with no additional remuneration required. Intermediaries are exempt from liability for mere conduit services, caching services, and hosting without active monitoring.

A trademark is exhausted when products containing the trademark are first put on the market within the European Economic Area and with the consent of the trademark owner, unless there are legitimate reasons to object to the use after exhaustion. Further

selling of a copyright-protected work after the first sale on the market within the European Economic Area and with the consent of the copyright holder will also lead to exhaustion of the copyright holder's rights to that copy. Library and archive rights are limited on the rights to reproduce and distribute copyright-protected works with respect to qualified libraries and archives, and certain digital works can only be consulted through a terminal at the physical location of the library or archive.

Injunctive remedies include preliminary proceedings to request injunctive relief, product recall, further information on the infringement, and precautionary seizure. The court must decide whether the claim is likely to succeed in substantive proceedings and has a reasonable discretion to grant the preliminary relief. If the injunction is later overruled in appeal or proceedings on the merits, the defendant could claim damages as a result of this injunction. Trademark and copyright owners in the Netherlands may be compensated for lost profits, which can be calculated based on the size of the infringement or as a lump sum based on elements such as the amount of royalties or fees that would have been due if the infringer had requested authorization to use the trade mark or copyright. There are no specific rules or restrictions on the type and/or number of damages awarded, as this is highly contingent on the facts and background of the case.

The losing party will generally be required to pay the cost of litigation for trademark and copyright claims, including court fees, expenses, and attorneys' fees. This includes the reimbursement of the prevailing party's attorney's fees up to an amount determined by the judge based on the predetermined "indicated tariffs" (*Indicatietaariefen*). Ex parte relief is not possible for a trademark or copyright owner to seek relief without notice to the defendant.

Customs procedures for the seizure of counterfeits and parallel imports are governed by EU regulations, including Regulation (EU) No 608/2013 concerning customs enforcement of intellectual property rights. Under this regulation, intellectual property rights (IPR) holders, including trademark and copyright owners, can take advantage of customs procedures to protect their rights. The process typically involves the following steps:

- a. Application for Action (AFA): The trademark or copyright owner must submit an AFA to the customs authorities in the EU member state(s) where they seek protection;
- b. Customs monitoring: Once the application is accepted, customs authorities will monitor incoming and outgoing shipments for potential infringements, including goods in transit through the EU;
- c. Notification of suspected goods: If customs officials suspect that goods entering or leaving the EU infringe intellectual property rights, they shall notify the rights-holder and provide an opportunity to confirm whether the goods are counterfeit or unauthorized parallel imports;

- d. Detention and seizure: If the rights-holder confirms the infringement, customs official can detain or seize the goods. In some cases, the rights-holder may be required to initiate legal proceedings to determine the infringement.

Trademark or copyright defendants have the opportunity to settle the case when they first receive a cease-and-desist letter or other type of warning letter. Once litigation is initiated, the parties can enter into a settlement until the moment that a decision is rendered by the court. Alternative dispute resolution methods include mediation, (binding) arbitration, or the Netherlands Commercial Court. Other court proceedings, such as parallel, revocation, or infringement proceedings, may impact the current proceedings and may decide to stay the case if necessary. Appellate procedure is possible for trademark or copyright infringement decisions, following the regular proceedings before the civil courts as set out by the Dutch Code of Civil Procedure. The typical timeframe for an appeal from a trial court decision is between 9-12 months. Additional considerations include rights of publicity and personality, unfair competition, trademark and copyright use on the Internet, and trademark and copyright use in business.

6. The Pierre Cardin Case: Critical Review of Protecting Well-Known Brand in Indonesia

6.1. Case Position

Pierre Cardin filed a cassation lawsuit to the Supreme Court, because its trademarks registration rejected by the Directorate General of Intellectual Property Rights, because it considered as not the first user by the Office of Directorate of Trademarks. At the Office of the Directorate of Trademarks, Pierre Cardin Trademark was registered on behalf of Alexander Satria Wibowo and it was registered with IDM Number 000223196 dated April 28, 2010 to protect the type of goods of class 03. That rejection made Pierre Cardin file an appeal for cancellation of trademark registration of Alexander Satria Wibowo, but it rejected by the Jakarta Commercial Court. Then a cassation lawsuit was filed with the Supreme Court, but the Supreme Court also rejected it.

6.2. Judges Analysis

The reasons and objections of the cassation petitioner cannot be justified, because *judex facti* has correctly applied the law. The main issue in the *a quo* case appeal is the petition from the Cassation Petitioner to file an appeal for the cancellation of Pierre Cardin mark in class 03 from the general list of marks with the argument for mark use and registration have bad intentions of imitating and raising the appellant's mark fame registered in many countries. Based on the evidence, it is known that the cassation appellee/appellee was the first user and registrant in Indonesia for the Pierre Cardin mark that registered the

mark on July 29, 1977. When registering the mark, it has never been registered and known, so basically the registration can be accepted.

To maintain the commercial commodity of Pierre Cardin, the appellee has a distinctive feature by always including the words Product by PT. Gudang Rejeki as the distinctive feature, in addition to other information as Indonesian products. So it strengthens the rationale that the mark does not raise the fame of other marks. Based on this, the appellee's submission and cancellation of the Pierre Cardin mark cannot be accepted, moreover in this case the submission of the appeal is the second appeal, after the first cancellation of the submission of the appeal rejected by *Judex Yuris* on December 22, 1981. Thus, the trademark registration has no intention to raise the appellee's mark, so that in accordance with Law Number 15 of 2001 trademark registration cannot be qualified to have bad intention. Therefore, the registration of the Appellee's mark is in accordance with the processes of applicable law, in accordance with the existing legislation and the applicable provisions of the first to file principle. In addition, there has been a previous appeal for cancellation filed by the Appellant (cassation petitioner) on December 22, 1981 has permanent legal force.

6.3. Judge's Decision

In giving a decision, there was a dissenting opinion from one of the Supreme Court Justices, with the following opinions:

- a. That the reasons for the cassation of the Cassation Petitioner (formerly appellant) can be justified, because based on the existing facts, *Judex facti* did not give sufficient consideration;
- b. That it is true the appellant's original name is Pierre Cardin;
- c. That the appellant's original name is the name used as the Appellant's Trademark with the Pierre Cardin logo which is well-known and registered in many countries;
- d. That it has been already a general knowing the Pierre Cardin mark is a well-known and famous trademark in various countries.

Considering that the trademark of a product does not only mean merely a name or writing, but also further meaning and purposes that can relate directly to the related product, besides, they know the name written on a product can also be a characteristic or distinctive feature from which area (domestic) or from which country (overseas) is the origin of the product, which is in the case of a quo the name or writing of the product used by the appellant is Pierre Cardin which is the appellant's original name, while the name or writing of the product used by the Appellee is also Pierre Cardin which is proved to be the same in principle, and it was also proven that those two names or writings were not Indonesian language or Indonesian writing, but were foreign language or foreign writing which was the language of the appellant's country of origin.

Considering that based on those matters, without having to prove the existence of bad intention, in terms of ethics and morals; Pierre Cardin trademark registration of the appellant under the plea of being the first and previously registered user in Indonesia cannot be justified, because Pierre Cardin trademark registration by the Appellant has automatically been proven in bad intention by duplicating, or imitating or copying the fame of the Pierre Cardin mark, the appellant's own as well as original name that has been registered in his country of origin as well as in various countries and from the beginning has not been proven to be a collaboration between the Appellant and the Appellee and/or the Appellant's permission to the Appellee in the use of the trademark with the Pierre Cardin logo, so that is illegal.

Considering based on the aforementioned considerations, in fact the appellant has succeeded in proving the truth of the argument for appeal, instead the Appellee has not succeeded in proving the truth of the argument for objection. For this reason, the cassation petition can be granted, by canceling the Judex Facti decision (Commercial court in the Central Jakarta District Court), adjudicating itself, granting the Appellant's appeal. Considering that due to dissenting opinion in the panel of judges and having been seriously endeavored but not reached a consensus, according to Article 182 paragraph 6 of the Criminal Procedure Code, the panel of judges after deliberation made the decision with the most votes, that is to reject the appeal. Based on that, the Commercial Court Decision in the Central Jakarta District Court in this case does not conflict with the law and/or the laws, so that the cassation petition filed by the cassation petitioner must be rejected and punish the cassation petitioner to pay court fees.

6.4. Gap Problems in Protecting Well-known Mark

Generally, the gap problems in protecting well-known marks in Indonesia could be classified into three main issues: (i) normative problems; (ii) conceptual problems; and (iii) practical problems. Normative problems in protecting well-known marks in Indonesia refer to issues related to the legal norms, principles, and regulations governing trademark protection. These issues may involve the inadequacy, ambiguity, or inefficiency of legal norms in effectively protecting well-known marks. In detail, normative problems could be visualised into some issues: (i) Clarity and Precision in Legal Definitions and Provisions;⁴⁷ (ii) Scope of Protection;⁴⁸ (iii) Procedures for Recognition;⁴⁹ (iv) Prevention of Bad Faith

⁴⁷ "The Legal Texts Might Lack Clear Definitions and Criteria for Determining What Constitutes a 'Well-Known' Mark, Which Can Lead to Inconsistency and Uncertainty in Their Protection" (n.d.).

⁴⁸ "There Might Be a Lack of Clarity Regarding the Scope of Protection Afforded to Well-Known Marks, Such as the Rights and Remedies Available against Infringement or Dilution" (n.d.).

⁴⁹ "45 The Procedures for Recognizing a Mark as Well-Known Might Be Unclear or Cumbersome, Potentially Hindering the Ability of Trademark Owners to Secure Protection Swiftly" (n.d.).

Registrations;⁵⁰ (v) Evidence and Burden of Proof;⁵¹ (vi) Conflict Resolution and Dispute Mechanisms;⁵² (vii) Inclusion of Technology and Digital Platforms;⁵³ (viii) International Conformity and Cooperation;⁵⁴ (ix) Public Awareness and Education;⁵⁵ and adaptability and flexibility issues.⁵⁶ While, conceptual problems in protecting well-known marks refer to fundamental issues related to the concepts, theories, and fundamental understandings that underpin the legal and practical aspects of well-known mark protection.

Some conceptual issues that might be related to well-known marks protection in Indonesia, such as: (i) definition and criteria of well-known marks;⁵⁷ (ii) balance between protection and competition;⁵⁸ (iii) determining similarity and likelihood of confusion;⁵⁹ (iv) global vs. local marks;⁶⁰ (v) digital and online protection;⁶¹ (vi) territoriality;⁶² (vii) bad faith and ethical considerations;⁶³ (viii) consumer perception;⁶⁴ (ix) economic and

⁵⁰ “Normative Frameworks Might Be Insufficient in Preventing the Registration of Trademarks That Are Identical or Confusingly Similar to Well-Known Marks in Bad Faith” (n.d.).

⁵¹ “Legal Norms Might Not Provide Clear Guidelines on the Types of Evidence Required and the Burden of Proof to Establish a Mark as Well-Known” (n.d.).

⁵² “Norms Related to the Resolution of Disputes, Such as Opposition Proceedings, Cancellations, and Litigation, Might Be Lacking in Effectiveness or Efficiency” (n.d.).

⁵³ “Legal Norms Might Not Be Adequately Updated to Address Issues Related to Digital Platforms and Online Infringement of Well-Known Marks” (n.d.).

⁵⁴ “There Might Be Discrepancies between Domestic Norms and International Agreements or Best Practices in the Protection of Well-Known Marks, Affecting Cross-Border Enforcement and Cooperation” (n.d.).

⁵⁵ “Norms Relating to Public Awareness, Education, and Respect for Well-Known Marks Might Be Underdeveloped, Affecting the Overall Ecosystem of Trademark Protection” (n.d.).

⁵⁶ “Normative Frameworks Might Not Be Adaptable and Responsive to Evolving Market Dynamics, Technological Advancements, and Emerging Challenges in Trademark Protection” (n.d.).

⁵⁷ “A Clear and Universally Accepted Definition and Set Criteria for What Constitutes a ‘Well-Known’ Mark Might Be Lacking or Ambiguous” (n.d.).

⁵⁸ “Striking a Proper Balance between Granting Robust Protection to Well-Known Marks and Maintaining Fair Competition in the Market Might Be a Conceptual Challenge” (n.d.).

⁵⁹ “There Might Be Conceptual Difficulties in Determining When a Mark Is Similar Enough to a Well-Known Mark to Cause a Likelihood of Confusion or Association” (n.d.).

⁶⁰ “Conceptual Conflicts Might Arise between the Global Recognition and Reputation of Well-Known Marks and Local Business Interests and Trademarks” (n.d.).

⁶¹ “Conceptual Frameworks Might Be Outdated or Inadequate to Effectively Address the Complexities of Online Infringement, Cybersquatting, and Digital Misuse of Well-Known Marks” (n.d.).

⁶² “Considering Trademarks Are Territorial Rights, There Might Be Conceptual Issues Regarding the Extent of Protection Afforded to Well-Known Marks That Are Recognized Globally but May Not Have Extensive Local Use” (n.d.).

⁶³ “The Concept of ‘Bad Faith’ Might Be Challenging to Delineate and Apply Consistently in Cases Involving Well-Known Marks” (n.d.).

⁶⁴ “Understanding and Evaluating Consumer Perception, Recognition, and Association with Well-Known Marks Might Be Conceptually Challenging” (n.d.).

commercial factors;⁶⁵ (x) cross-sectoral and cross-jurisdictional protection.⁶⁶ In addition to the above normative and conceptual problems, there are some practical problems as well as challenges in protecting well-known marks in Indonesia. Those practical challenges are ranging from enforcement difficulties;⁶⁷ to issues with public awareness and education;⁶⁸ and language and cultural gap and barriers⁶⁹, such as: (i) judicial procedures;⁷⁰ (ii) online infringements;⁷¹ (iii) registration and recognition;⁷² (iv) access to legal resources and expertise;⁷³ (v) market surveillance;⁷⁴ (vi) cross border enforcement;⁷⁵ (vii) administrative and bureaucratic hurdles;⁷⁶ (viii) documentation and evidence.⁷⁷ Clearly that all the above normative, conceptual and practical problems have strongly influence the quality of legal endeavour in Indonesia, including in protecting well known marks in Indonesia.

To measure the fame of a mark must be based on the principle of territoriality, it means in the Country where the case exists and is tried. By referring to Indonesian trademark law, the fame of a mark is composed by a number of people who know the mark; the quality of mark reputation, and product promotions. Based on the above consideration, the appellee believe that Pierre Cardin mark is not a well-known mark, because the mark is less well-known in Indonesia and rarely promoted in various mass media. Notwithstanding, the appellant, Pierre Cardin is a well-known mark, because it has been

⁶⁵ “How to Consider and Weigh Economic and Commercial Factors Such as Sales, Advertising, and Market Share in Determining the Well-Known Status of a Mark Might Be Conceptually Unclear” (n.d.).

⁶⁶ “Conceptualizing the Breadth and Limits of Protection for Well-Known Marks across Different Sectors and Jurisdictions Might Be Complex and Uncertain” (n.d.).

⁶⁷ “Law Enforcement Agencies Might Lack the Resources, Training, or Expertise to Effectively Combat Infringements of Well-Known Marks, Making Legal Enforcement Cumbersome and Ineffective at Times” (n.d.).

⁶⁸ “There Might Be a Lack of Public Awareness and Understanding of Intellectual Property Rights, Including the Special Status and Protection Accorded to Well-Known Marks” (n.d.).

⁶⁹ “Language Differences and Varying Cultural Understandings of Trademarks and Branding Might Pose Practical Issues in the Effective Protection and Enforcement of Well-Known Marks” (n.d.).

⁷⁰ “Legal Proceedings Might Be Lengthy, Costly, and Complex, Hindering the Swift and Effective Resolution of Disputes Involving Well-Known Marks” (n.d.).

⁷¹ “Given the Proliferation of Online Platforms, There Might Be Practical Difficulties in Monitoring and Combating Online Infringements, Counterfeit Products, and Unauthorized Use of Well-Known Marks on Digital Platforms” (n.d.).

⁷² “The Processes for Registering Trademarks and Getting Them Recognized as Well-Known Might Be Bureaucratic, Slow, or Unclear, Posing Practical Hurdles for Mark Owners” (n.d.).

⁷³ “Mark Owners, Particularly Smaller Businesses or Foreign Entities, Might Face Challenges in Accessing Qualified Legal Professionals and Expertise in Indonesian Trademark Law” (n.d.).

⁷⁴ “It Might Be Challenging to Conduct Effective Market Surveillance to Detect and Prevent Infringements, Unauthorized Uses, or Imitations of Well-Known Marks” (n.d.).

⁷⁵ “Practical Difficulties Might Be Encountered in Enforcing the Rights of Well-Known Mark Owners across Borders, given the Global Nature of Commerce and Trademark Use” (n.d.).

⁷⁶ “Navigating Administrative Procedures, Government Agencies, and Bureaucratic Processes Related to Trademark Protection Might Pose Practical Challenges” (n.d.).

⁷⁷ “Gathering the Necessary Documentation and Evidence to Support Claims, Prove the Well-Known Status of Marks, or Establish Infringements Might Be Practically Challenging.” (n.d.).

registered in various countries. The above disputes describe the problems at the normative and conceptual problem in apprehending the well-known marks in Indonesia.

7. Conclusion

With respect to the Supreme Court's decision, there was a gap concerning the definition of a well-known mark that was indeed still under debate between Countries and experts. Therefore, the decision of the judge of Supreme Court cannot be unanimous, and it can cause injustice for justice seekers. To address this, it takes a unity about the definition of a well-known mark, so that it can address the gap between legal theory and practice. In the light of the low level of legal awareness of society in understanding, appreciating, respecting and protecting well-known marks in Indonesia, it is necessary to improve the legal awareness of society, particularly in key society groups, such as in universities, and industries or producers. In this point, the government may integrate and link the above related parties in socializing and developing their attention to control and protect their well-known marks. This can be visualized and manifested through educational approach, such as short courses, training, and dialogues, discussion with society, particularly the industries, or producers, and universities, and so forth.

In the near future, government should strengthen the well-known marks protection to ensure legal certainty and attract investments in Indonesia. This requires addressing normative, conceptual, and practical challenges through legislative reforms, regulatory updates, and collaboration with stakeholders. Practical efforts should include capacity building, public education, international cooperation, and improving administrative efficiency. Additionally, leveraging technology and enhancing legal resources are essential to support comprehensive protection.

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