

Juridical Review of the Trademark Appeal Examination Mechanism in the Trademark Appeal Committee

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Abstract: One of the intellectual property regimes as part of industrial property rights which is no less important in the business world is Trademark. Trademark is a sign to distinguish between products owned by one party to another party. These signs can be images, logo, name, word, letter, number, colors, either in 2 (two) dimensions or 3 (three) dimensions, sounds, and even holograms. Trademark rights is an exclusive rights obtained by the proprietor based on a registration submitted to the Directorate General of Intellectual Property (DGIP) as the authorized office. The application for trademark registration will go through stages that are part of the trademark registration process, one of which is the Substantive Examination stage refers to the First to File system. The DGIP's decision shall to grant or to reject the application for trademark registration. If the application for trademark registration is rejected by DGIP, the applicant may submit an appeal to the Trademark Appeal Commission. The Trademark Appeal Commission is an independent special body whose organizational structure is under the

Minister of Law and Human Rights of the Republic of Indonesia which is in charge of trademarks so that it lies within the DGIP. The Trademark Appeal Commission has the duty to examine a trademark that rejected by DGIP to consider and to decide whether DGIP's decision is correct or not.

Keyword: *Trademark Appeal; Intellectual Property; Trademark Appeal Commission*



INTRODUCTION

In today's era of global trade, the role of brands is no longer just a name or product differentiator but has become a determining factor in the advantage of business competition. Many companies are successful in the market because they have a well-recognized brand in the community, and they can open markets at home and abroad with the strength of their brands. Business activists, both micro and macro scale categories, both those who are just pioneering to those who already have a reputation, continue to strive to maintain the mark embedded as a brand to get protection and increase the economic value of the product.

Brands (with their "brand image") can fulfill consumers' needs for identification or distinguishing power, which is very important, and they can guarantee product or service quality in an atmosphere of free competition. Therefore, the brand can be an asset for individuals and companies that can generate huge profits if utilized by paying attention to business aspects and good management processes. Such is the importance of the role of this Trademark, then to him attached legal protection, namely as an object against which related rights of individuals or legal entities.¹

The wider globalization in trade in goods and services requires the protection of trademarks for national products in export destination countries. With the current globalization in the field of trade, the need for international trademark protection is increasing in every country where goods and services are traded. The existence of the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (from now on referred to as the Madrid Protocol) regulates international trademark registration that provides convenience for businesses to register trademarks internationally in several member countries of the Madrid Protocol. Under the Madrid Protocol system, trademark registration in several countries that are also members of the Madrid Protocol can be done at once by filing only one trademark application, which is cheaper and more efficient.² Indonesia's adoption of international mark registration provisions was preceded by the accession to the international agreement The Protocol Relating to Madrid Agreement Concerning the International Registration of Marks or Madrid Protocol on October 2, 2017. It became effective on January 2, 2018. The accession was ratified through Presidential Regulation No. 92/2017 on the Ratification of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989, and Indonesia became the 100th

¹ Cita Citrawinda, 2015, "*Perlindungan Merek Terkenal di Indonesia*", makalah disampaikan pada "Seminar HKI dan Penegakan Hukumnya" yang diselenggarakan di kedutaan Besar Perancis bekerjasama dengan perhimpunan masyarakat HKI Indonesia (Indonesian Intellectual Property Society/IIPS), pada tanggal 19-20 September 2001, di Hotel Softel Gran Mahakam, Jakarta, hal. 1 dikutip dari Badan Pembinaan Hukum Nasional, Kementerian Hukum dan Hak Asasi Manusia Republik Indonesia, 2015, Hasil Penyelarasan Naskah Akademik RUU Tentang Merek, Jakarta, h. 12.

² Badan Pembinaan Hukum Nasional, Kementerian Hukum dan Hak Asasi Manusia Republik Indonesia, 2015, Hasil Penyelarasan Naskah Akademik RUU Tentang Merek, Jakarta, h. 5.



member of The Madrid Union.³

Trademark protection has a period of protection for 10 (ten) years from the date of receipt. It can be extended for 10 (10) years and so on as desired by the owner by applying for an extension of trademark protection before the trademark protection period expires. Regarding applying for trademark registration, it is essential to know about the trademark law system itself. The principle of trademark law adopted by the Trademark Act and Geographical Indications is First to File, which means that the party who filed the first application for trademark registration will get the rights to the Trademark, of course, through the limits of the provisions outlined in the trademark law regarding the trademarks that can be granted the application for registration, which can be rejected, or unacceptable.

The distinguishing power of a trademark is a factor in determining whether a trademark can be registered or rejected. There are two categories of distinguishing power here: high distinguishing power will result in the decision to register the trademark application, while low distinguishing power will result in the decision to reject the trademark application.⁴

The rejection of a trademark application is wider than the existence of a low element of distinguishing power. As per the provisions of Act No. 20 Year 2016 on Trademarks and Geographical Indications, substantive examination as a series of processes for applying for trademark registration is conducted by the DGIP through the Trademark Examiner. In the substantive examination process, the Trademark Examiner will perform an examination in the form of a thorough assessment of a trademark filed for registration and whether it meets the elements legally categorized as a trademark that cannot be registered, rejected, or granted.

Furthermore, based on the applicable provisions of Law Number 20 Year 2016 on Trademarks and Geographical Indications, by the refusal decision on the application for trademark registration, the Applicant can submit its response within the specified time period. The refusal decision may occur in 2 (two) stages. With the determination of the final refusal decision, Article 28 Paragraph (1) of the Trademark and Geographical Indications Act gives the Applicant the right to file its response again in the form of an Appeal to the Trademark Appeal Commission. However, if the Trademark Examiner decides to accept the reason for the Applicant's objection in the submission of the response, the Trademark Examiner will decide to grant the application for registration of the Trademark so that the next flow is the issuance of a trademark certificate by the DGIP.

1.1. Research Methods

The method used in this writing is a normative legal method that is based on secondary data.⁵

³ ARISE+ bekerjasama dengan *European Union Intellectual Property Office* dan Direktorat Jenderal Kekayaan Intelektual, Kementerian Hukum dan Hak Asasi Manusia Republik Indonesia, 2018, Protokol Madrid : Jalur Menuju Pencitraan Merek Global, Jakarta, h. 5.

⁴ Direktorat Jenderal Kekayaan Intelektual, 2020, *Modul Kekayaan Intelektual Lanjutan Bidang Merek dan Indikasi Geografis*, Jakarta, h. 11.

⁵ Gunawan Rahadjo, Ketut Sukawati Lanang P. Perbawa, Putu Lantika Oka Permadhi dan Ni Putu Noni Suharyanti, 2024, Alternative Punishment Based on Restorative Justice to Reduce the Overcapacity of Indonesian Community Institutions, *Pakistan Journal of Life and Social Sciences*, Vol. 22, No. 1, E-ISSN: 2221-7630, P-ISSN: 1727-4915, h.5241-5247



Soerjono Soekanto states that legal research can be divided into two types, namely normative legal research and sociological or empirical legal research.⁶

1.3. Results and Discussion

Trademark applications that have been decided to be rejected definitively (final refusal) by the DGIP can be filed by the Applicant in the form of an appeal. The filing of this appeal is not mandatory for the Applicant as a series of trademark registration process but is an optional legal remedy if the Applicant still seeks to maintain the Trademark filed for protection. An appeal petition may be filed no later than 3 (three) months from the date of receipt of the notification of refusal to request registration of Trademark or Geographical Indications. Within a period of 1 (one) month from the receipt of the appeal request, an administrative examination is conducted. Administrative examination based on Article 16 of Government Regulation Number 90 Year 2019 includes an examination of the completeness of the required documents consisting of:

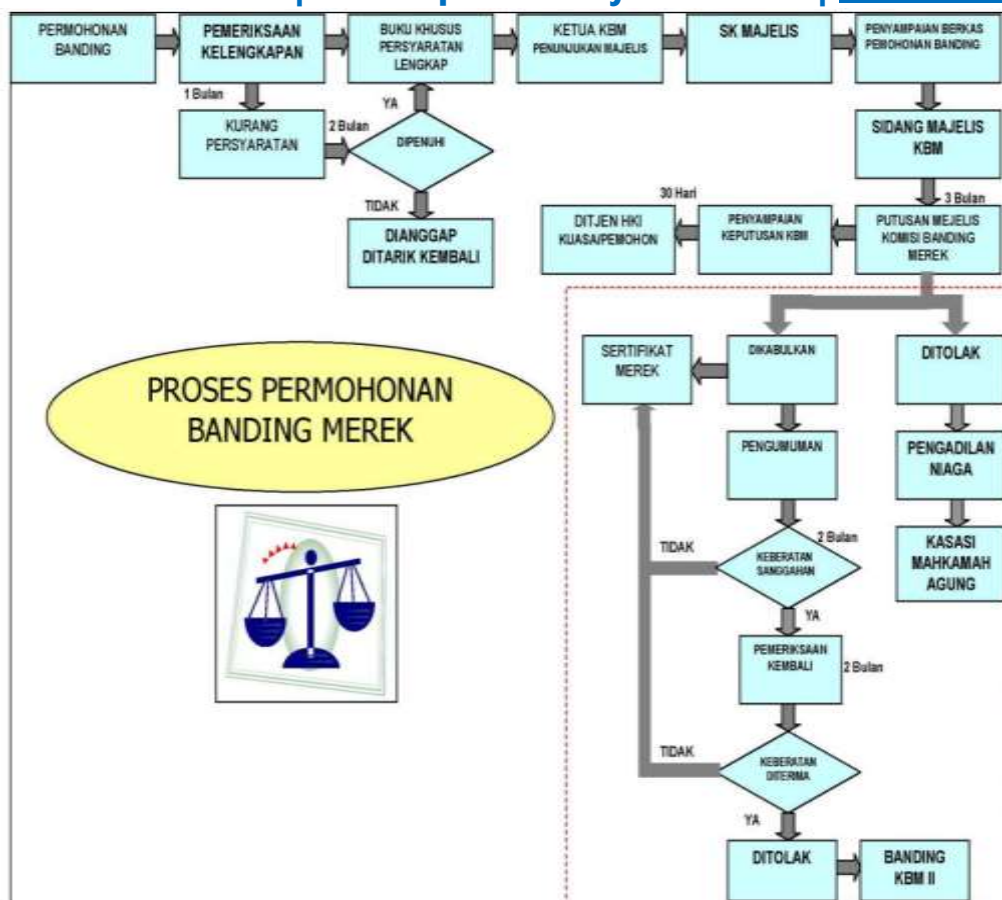
1. An appeal form or a letter of appeal is attached;
2. Power of Attorney if the appeal is submitted through a Power of Attorney (registered Intellectual Property Consultant);
3. *Final refusal* notification letter;
4. Proof of payment for the appeal application.

While the substantive examination of trademark appeals is carried out in the form of a trial as stipulated in Article 20 of Government Regulation No. 90/2019.

The flow of application, examination, and settlement of trademark appeals is as follows:

⁶ Soerjono Soekanto, 2015, *Pengantar Penelitian Hukum*, Universitas Indonesia Press, Jakarta, h. 42.





Bagan 7. Alur Permohonan Banding Merek

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From the flow picture above, it can be described as follows:

1) Filing of Trademark Appeal

An appeal is filed in writing in Indonesian by the Applicant or his attorney to the Trademark Appeal Commission with a copy submitted to the Minister by describing in full the objections and reasons for the rejection of the application and attaching at least:

- a. A copy or photocopy of the notification letter of rejection of the application;
- b. Proof of payment for the Appeal;
- c. If the Appeal is submitted through a power of attorney, it must be accompanied by an extraordinary power of attorney.

Since 2020, trademark appeals have also been able to be filed electronically (online) through an account, namely merek.dgip.go.id which can be owned by each Applicant and can be filed alone. On the account, there are forms and media provided to attach the requirements for filing a trademark appeal as an attachment.

2) Administrative Inspection

⁷ Direktorat Jenderal Kekayaan Intelektual, *Op.Cit*, hal. 51.



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In carrying out its duties, the Appeal Commission is assisted by the Secretariat led by a Secretary Based on Article 16 Paragraph (2) of Government Regulation Number 90 of 2019, the duties of the Secretary of the Trademark Appeal Commission include an examination of the administrative requirements for appeals. Administrative checks carried out in addition to the examination of the completeness of the required documents, including an examination of the administrative requirements:

- a. Purpose of application letter and documents required for trademark appeal.
- b. Time period for filling an appeal.

3) Hearing of the Trademark Appeal Commission

The term hearing in the scope of the Appeal Commission is a term that can also be interpreted as the process of substantive examination of appeals conducted by the Appeal Commission by forming a Panel. The term hearing is contained in Article 20 of Government Regulation Number 90 of 2019. From a series of administrative checks that have been carried out by the Secretary of the Trademark Appeal Commission, if the Appeal is declared to have met the completeness of the requirements, it will be given a date of receipt and a substantive examination process in the form of a trial of the Trademark Appeal Commission which will conduct a review and decide whether the Appeal can be granted or rejected.

4) Decision of the Appellate Commission

The decision of the Appeal Commission is given within a maximum of 3 (three) months from the date of receipt based on Article 23 of Government Regulation Number 90 of 2019, where from the date of receipt, the Trademark Appeal Commission is required to have decided on the Appeal filed which means that it has also gone through the substantive examination trial process. The decision of the Panel is referred to as the verdict:

- a. Grant the entire Appeal;
- b. Partially Grant the Appeal Petition;
- c. Reject the Appeal.

Substantive examination of trademark appeals is further regulated in Government Regulation 90 of 2019 concerning Procedures for Application, Examination, and Settlement of Appeals at the Trademark Appeal Commission. Article 15 of Government Regulation Number 90 of 2019 stipulates that every appeal application must be examined, including the Administrative Examination and Substantive Examination. In carrying out the substantive examination of a trademark appeal, the Chairman of the Trademark Appeal Commission organizes a trademark appeal hearing by forming a panel called the Appeal Commission Panel. This is regulated in the provisions of Article 21 of Government Regulation Number 90 of 2019. A panel is an odd number of at least 3 (three) people, and 1 () of them is a Senior Examiner who does not conduct a substantive examination of the application. The application in question is for trademark registration, which DGIP rejected during the substantive examination stage. In conducting the examination of the Appeal Application, the Chairman and members of the Panel are appointed by the Chairman of the Appeal Commission.



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The Panel conducts substantive examination proceedings as scheduled in the Decree of the Chairman of the Trademark Appeal Commission. In the implementation of the substantive examination hearing of the Appeal, the Applicant can express his opinion in the hearing before the Panel by first submitting a request to express an opinion addressed to the Chairman of the Trademark Appeal Commission as mentioned in Article 22 paragraph (5) of Government Regulation Number 90 of 2019. If the Chairman of the Trademark Appeal Commission approves, then the Applicant will be notified of the schedule of the trademark appeal hearing through the Secretary of the Trademark Appeal Commission. During the trial, with the presence of the Appellant, the Appellant can submit additional evidence needed. Likewise, from the Appeal Commission Panel, if necessary, the Appeal Commission Panel can summon and hear testimony from the Appellant, experts deemed necessary, Trademark Examiners who conduct substantive examinations of trademark registration applications, to conduct field research related to the substantive examination process of the Appeal.

The provisions of Article 21 Paragraph (1) letter a of the Trademark and Geographical Indications Act, namely, the application is rejected if the Trademark has similarities in principle or its entirety with registered Trademarks owned by other parties or applied for earlier by other parties for similar goods and services. As the Explanation of Article 21 Paragraph (1) letter a of the Trademark and Geographical Indications Act, what is meant by "Trademark applied for first" is an application for registration of a Trademark that has been approved for registration. Approved for registration means that a trademark has been subjected to substantive examination and has been approved for registration but is still in the process of granting a registration number to be issued a certificate. This is in contrast to the term "...with a registered trademark," where the Trademark in question has been certified.

The expiration of the protection period of a registered trademark after 10 (ten) years results in a registered trademark having no protection anymore. The impact of the expiry of the trademark protection period makes the legal status of the Trademark no longer a registered trademark. However, Article 35 of the Trademark and Geographical Indications Act states that the application for renewal of a registered trademark can still be filed within a maximum period of 6 (six) months after the expiration of the protection period of the registered Trademark. This means that a trademark that has been protected by law for 10 (10) years and until the date of expiration of such protection is not renewed, which according to the law is that the Trademark has ended its protection, but based on the provisions of Article 35 of the Trademark and Geographical Indications Act that the Trademark that has expired can be protected again or can be valid again if the Trademark is extended up to 6 (six) months after the protection period expires. This can create a dilemma for the Trademark Appeal Commission Panel, which is required to make a legal decision to address the issue within a time limit. However, judging from the duties of the Trademark Appeal Commission, namely conducting examination, review, and assessment of the Appeal as stipulated in Article 8 of Government Regulation No. 90 of 2019, whether what is meant by conducting review and evaluation in the substantive examination process is limited to agreeing or disagreeing with the decision of the Substantive Examiner of the rejected trademark application on the basis of rejection of the existence of a trademark that has been registered first, or can also include re-examination of the rejected and appealed trademark application because the basis of



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rejection is still getting protection at that time but has ended coincidentally when the Appeal is in process?

Then, referring to Article 9 letter a of Government Regulation Number 90 of 2019, which states that in carrying out the duties as referred to in Article 8, the Appeal Commission organizes the function of receiving, examining, and resolving Appeals against the refusal of Trademark registration applications based on substantive reasons. One of its functions is to examine the refusal of a trademark application based on substantive reasons by the DGIP here, which the author emphasizes as a concern for the subject matter that the author raises in terms of substantive examination of the Appeal by the Appeal Commission Panel.

1.4. Conclusion

The provisions of Article 21 Paragraph (1) letter a of the Trademark and Geographical Indications Act, namely, the application is rejected if the Trademark has similarities in principle or its entirety with registered Trademarks owned by other parties or applied for earlier by other parties for similar goods and services. As the Explanation of Article 21 Paragraph (1) letter a of the Trademark and Geographical Indications Act, what is meant by "Trademark applied for first" is an application for registration of a Trademark that has been approved for registration.

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Legislation:



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