

## THE LEGAL PROTECTION TO THE OWNER OF REGISTERED MARK BASED ON THE VALUE OF JUSTICE

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### ABSTRACT

*A mark in trade has dual function as a tool of competition and monopoly. This point out that the mark should be providing the legal protection in order to prevent counterfeiting created by another party. The legal basic to this matter is Law of the Republic of Indonesia Number 15 Year 2001 Regarding Marks (abbreviated as Marks Law). The concept is expected to encourage the legal enforcement of Marks infringements. A registered marks should have exclusive right of the state. That right is the legal certainty enjoyed by the owner that his right should not be duplicated by another party. The concept is also based on value of justice, fairness and procedural in realizing order and welfare in the society.*

Keywords: legal protection, registered mark, value justice.

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### A. Introduction

Mark is one of the intellectual property right.<sup>1</sup> The mark is embedded with material rights deriving from the work of brain or ratio. It is the ratio of human reasoning. Then, that work is formulated as intellectuality. Not everyone maximally can afford to employ his or her brain (logic, reason, intellectuality). Consequently, not everyone can also create IP. A person who can only employ his or her brain produces it. Surely, it get to obtain the exclusive rights.

Indonesia has internationally joined with the instruments to protect the IP since the 1950's. It has been becoming a member of International institutions such as World Trade Organization (WTO) and World Intellectual Property Organization (WIPO). Both Institutions administer the of Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, but they are different. The WIPO is a part of the United Nations, while The TRIPS is a part of the WTO or GATTs (General Agreement on Tariffs and Trade).

The TRIPS regulated standards in IP refers directly to the WIPO standards. They are more clearly developed, elaborated and implemented. Furthermore, to facilitate the implementation of the TRIPS Agreement, the Council for TRIPs concluded with WIPO an agreement on cooperation between WIPO and The WTO, which came into force on 1 January 1996.<sup>2</sup> The WIPO has been established since 1967 to take responsible the global forum for IP services, policy, information and cooperation.<sup>3</sup>

Mark shall mean a sign in the form of a picture, name, word, letters, figures of colors, or a combination of said elements, having distinguishing and used in the activities of trade in goods or services. It explicitly becomes a part of IP laid down in Considering point a of Law of the Republic of Indonesia Number 15 Year 2001 Regarding Marks (abbreviated as Marks Law), declared that in the era of global trade and in line with the international conventions that have been ratified by Indonesia, the role of Mark has be come more important, particularly in safeguarding a fair business competition.

The type of mark can be divided into three *inter alia* Trade Mark, Service Mark and Collective Mark.<sup>4</sup> Trade Mark shall mean a Mark that is used on goods traded by a person or by several persons jointly or a legal entity to distinguish the goods from other goods of the same kind. Service Mark shall mean a Mark that is used for services traded by a person or by several persons jointly or a legal entity to distinguish the services from other services of the same kind. Collective Mark shall mean a Mark that is used on goods and/or services having the same characteristics that are traded jointly by several persons or legal entities to distinguish the goods and/or services from others of the same kind. The main function of a Mark is to enable consumers to identify a product (whether a good or a service) of a particular company so as to distinguish it from other identical or similar products provided by

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<sup>1</sup>According to Presiden Regulation Number 44 of 2015 on Ministry Of Law And Human Rights. The term of rights has been removed due to follow the institutions in charge of intellectual property in other countries. Those institution does not use the word "rights" such as Korean Intellectual Property Office, Singapore Intellectual Property Office, and Malaysian Intellectual Property Office. See, <http://www.hukumonline.com/berita/baca/lt55cd5c0bcc7c9/ini-alasan-berubahnya-nomenklatur-ditjen-kekayaan-intelektual>, accessed on 12 November 2015.

<sup>2</sup> [https://www.wto.org/english/tratop\\_e/trips\\_e/intel3\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/intel3_e.htm), accessed on 13 November 2015.

<sup>3</sup> <http://www.wipo.int/about-wipo/en/>, accessed on 13 November 2015.

<sup>4</sup> Muhamad Djumhana, *Hak Milik Intelektual, Sejarah, Teori, dan Praktiknya Di Indonesia*, Citra Aditya Bakti, Bandung, 2014, p. 169.

competitors. Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products.<sup>5</sup>

The another function is as source indicator. In the global trade, the relationship between producer and consumer has been already very far away. It means that the consumer impossibly knows who is or how the reputation is of a producer in the activities of trade in goods or services. From this point of view, a Mark on good and service can functionate as source indicator which connects products with its producer and geographical Indication.

The knowledge of the source of a Mark on product or service shall mean a guarantee for consumers that the Mark, legally and professionally, derives from a certain business unit or enterprise. In other words, it is very useful for producers to be creative not only in the activity of production and Marketing but also in the maintaining of good name, identity and reputation.

As stipulated in Article 6 of Mark Law, an Application for registration of a Mark shall be refused. The Marks Law regulates a Mark which has a similarity in its essential part or in its entirety with a Mark owned by another party which has previously been registered for the same kind of goods and/or services. Thus the owner of a registered Mark should not file a lawsuit because its Mark is emulated by another party. For instance, Mark DUNKIN' DONUTS vs DONATS' DONUTS in Yogyakarta.

DONATS' DONUTS has a similarity in a combination of word, letters, figures, composition of colours with DUNKIN' DONUTS. This can emerge a chaos on geographical Indication and take effect against the good name of DUNKIN' DONUTS as the official Mark owner.

The case was solved through the alternative dispute settlement and after getting a warning letter for the attorney of DUNKIN' DONUTS INC. The restaurant owner of DONATS' DONUTS made changes in a combination of word, letters, figures, composition of colours on the food and beverage packaging box, also on its restaurant.<sup>6</sup>

Based on a legal issue above, there must be a legal protection based on justice to the registered Mark owner from another party which uses it for the same kind of goods and/or services. This notion is aimed to provide legal certainty in order to prevent the Application of a new Mark by way of imitating Mark owned by a party who has been previously registered.

## B. Discussion

### 1. Legal protection to the Registered Mark Owner Stipulated in Marks Law

To distinguish a Mark on goods and service, we can investigate the quality and guaranty of a original product. Occasionally, the price of a product to be expensive is not the product, but the Mark. It can hardly said that the Mark is a sticked and gummed thing, but it is not only the product itself. After buying a product, its Mark can be enjoyed by the buyer. The Mark merely gives satisfaction for buyers and they can have just the material object. In other words, it reflects the material object that is fisically not real. Hence, this can prove that it is also one of intelletual or immaterial properties.

On Mark, there are such elements of creation such picture, name, word, letters, figures, composition of colours, or a combination of said elements, on the contrary there are rights in arts. In brief, Mark is not copyright but it shall mean a distinctive sign. For instance, a Mark owner of spices registered its product using a word "Ajinomoto" and a figure "red bowl" as a Mark. Another spices producer is not entitled to have a similar Mark in its essential part or in its entirety with the Mark of "Ajinomoto". If the producer uses it, so it has violate a registerd Mark of another party.<sup>7</sup> Thus, a Mark also contain the economic value.

A Mark can also be assumed as an identity of a product having certain quality and price that has been produced by its owner.<sup>8</sup> In trade, it has also a dual function as a tool of competition and monopoly. It, as a tool of competition, is in accordance with the Marketing activities and also known as a promotional tool.<sup>9</sup> With promoting Mark, enterprises can increase the brand is expected to increase the turnover of goods or services, in both the short and long term. As a tool monopoly, it point out that another person may not have or uses it withou any permitting or licensing. Thus, the only one who is entitled to monopolize is the owner of a registered Mark.

A Mark also functionate as distinguishing to differentiate goods and services of the same enterprinses. It can also guarantee the quality of traded goods and services so that people set a Marking on the quality of a product based on its Mark. This function increasingly widespread when the user of a branded product considers as prestige and in consequences people will buy it, even with a relatively high price.

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<sup>5</sup> World Intellectual Property Organization (WIPO), *Making A Mark An Introduction to Trademarks for Small and medium size Enterprises, Intellectual Property for Business Series Making A Mark Number:1*, World Intellectual Property Organization (WIPO), Switzerland, 2006, p. 4

<sup>6</sup> Direktorat Jenderal Industri Kecil Menengah Departemen Perindustrian, *Kebijakan Pemerintah Dalam Perlindungan Hak Kekayaan Intelektual dan Liberalisasi Perdagangan Jasa Profesi di Bidang Hukum*, Departemen Perindustrian, Jakarta, 2007, p. 3.

<sup>7</sup> H. Oka Saidin, *Aspek Hukum Hak Kekayaan Intelektual (Intellectual Property Rights)*, Raja Grafindo Persada, Jakarta, 2003, p. 330.

<sup>8</sup>*Id.*, p. 330.

<sup>9</sup> Adrianus Meliala, *Praktis Bisnis Curang*, Pustaka Sinar Harapan, Jakarta, 1993, p. 90.

What I mean by the Mark as stipulated in Article 1 point 1 of Marks Law, a Mark means a sign in the form of a picture, name, word, letters, figures of colors, or a combination of said elements, having distinguishing and used in the activities of trade in goods or services. Article 3 of Marks Law certifies that The right to a Mark is the exclusive right granted by the State to the owner of a Mark which is registered in the General Register of Marks for a certain period of time, to himself use said Mark or to grant permission to another party to use it.

The right to a Mark is the exclusive right. It is also granted by the State of the owner of a Mark if he applies to register his Mark in the General Register of Marks. The main function getting the exclusive right is to provide the legal protection to the Mark owner from infringement of another party and also to maintain the conducive circumstances in the global trade based on fair competition. According to Lendsford, he appropriately said that enterprises having higher reputation will gain a tremendous asset just based on good will of its Marks.<sup>10</sup> It then can said that a Mark is a reputation. Creating a Mark to be brand image is not easy because this takes much time and cost, for example a very expensive promotion cost of a new product. It can be a indicator to determine the income of a company. Of course, its reputation must always be protected and maintained.

As results of creativity, a Mark needs the legal protection in order not easily to be imitated by another party. Marks Law is a legal basic in providing the legal protection to the Mark owners. This Act also preserves *the first to file principle* in which gives protection and admission to the right to a Mark if it has been registered in the General Register of Marks at the Directorate General of Intellectual Property (abbreviated as DGIP) under the Ministry of Law and Human Rights. It is clear that the registration is to obtain the legal protection.

A Mark can be merely registered through the Application that is enrolled by the its owner or his Proxy, according to Article 1 point 8 of Marks Law, Proxy shall mean a consultant of intellectual property rights. For registration of a Mark, there are two systems, *inter alia*:<sup>11</sup> a) declarative system is a registration system which does not issue the right but just gives presumption or *presumption iuris*, in accordance with this matter, means an assumption made by one that is taken to be the first owner claiming a registered Mark unless someone comes forward to contest it and prove otherwise; b) Constitutive system is a system ruled by law and obtaining the legal certainty. Article 4 of Marks Law declares that A Mark shall not be registered on the basis of an Application by an Applicant having bad faith. It constitutes explicitly that the registration is very important to determine an legal recognition of a Mark. So the exclusive right granted by the State to the owner of a Mark because of the registration. This system is now applicable.

The administrative protection is a measure which must be taken by the Mark Office to every legal entity who breach the right to a Mark. According to its authority, the administrative measure can be performed by it, in this matter the DGIP, i.e. to refuse an Application for registration of a Mark. At this stage of process of an Application for registration of a Mark, the DGIP's role is very decisive in providing the legal protection to the owner of the registered Mark. By using the authority, it can give refusing an Application which can not meet the substantive requirements stipulated in Marks law.

The rejection to an Application for registration of a Mark can be applied by the DGIP with regard to Article 5 and 6 of Marks Law, and also objection and rebuttal may previously be filed by any person or legal entity, an objection to an Application in writing to the DGPI. Furthermore, pursuant to Article 4 of Marks Law, a Mark shall not be registered on the basis of an Application by an Applicant having bad faith. It has been said that the system has not yet been effective because it is impossible carried out by Applicant who has bad faith. In other words, he will be trying to file for registration of a Mark and in the process of Substantive Examination, possibility, his Mark has a similarity in its essential part or in its entirety with a Mark owned by another party which has previously been registered.

Article 6 paragraph (1) of Marks Law regulates An Application for registration of a Mark shall be refused by the DGIP if the relevant Mark: a. has a similarity in its essential part or in its entirety with a Mark owned by another party which has previously been registered for the same kind of goods and/or services; b. has a similarity in its essential part or in its entirety with a wellknown Mark owned by another party for the same kind of goods and/or services; and c. has a similarity in its essential part or in its entirety with a known geographical indication.

The substantive examination shall be conducted by the Examiner at the DGPI. Where the Examiner concludes the result of the substantive examination that an application can be approved for registration, the DGIP with the approval of the DGIP shall announce the Application in the Official Gazette of Marks. Where the Examiner concludes the result of the substantive examination that an Application cannot be registered or shall be refused, the Directorate General with the approval of the Director General shall notify in writing the Applicant or his Proxy stating the reasons therefore. It can be stated that this measure, currently, is very effective in providing legal protection for the owner of the registered Mark in according to *counter fighting* or Mark piracy. However the measure in fact could not be enough maximally for protecting because there are many Marks which have a similarity in its essential part or in its entirety with a Mark owned by another party which has previously been registered and approved with certificate of Mark.

From the research, the purpose of the legal protection to a registered Mark is not to discontinue monopoly, otherwise it is to boost or encourage one or the owner of a registered Mark in developing his work or creativity. The infringements will diminish

<sup>10</sup> M. Yahya Harahap, *Tinjauan Merek Secara Umum dan Hukum Merek di Indonesia Berdasarkan Undang-Undang Nomor 19 tahun 1992*, Citra Adhitya Bhakti, Bandung, 1996, p. 3.

<sup>11</sup>R. Soerjatin, *Hukum Dagang I dan II*, Cetakan ketiga, Pradnya Paramita, Jakarta, 1980, p. 96.

him so that his creative products would never have found on the Market. As a result there will be trade barriers which can give influence on the economy.

In fact, there are still many serious infringements to the registered Marks either domestic or international Markets. Cases of Mark imitation or counterfeiting are examples that occurs to IP. The Infringement of a Mark is a complaint offense. This matter is also a weakness in Marks law. Consequently, the owner of a registered Mark usually are too late to know that his imitation or counterfeiting Mark are available on Markets, or maybe it has been so long. Therefore the DGIP should precisely examine new Marks in application. The law enforcer such police, probably consumers, must be active to fight against Mark imitation or counterfeiting.

The DGIP is authorized to perform the substantive examination according to Marks Law. its Examiner concludes the result of the substantive examination that an Application cannot be registered or shall be refused, the DGIP with the approval of the DGIP shall notify in writing the Applicant or his Proxy stating the reasons. Where an Application is refused, all fees that have been paid to the DGIP cannot be reimbursed.

The Examiner shall be the official who, due his skills and qualifications, is appointed and dismissed as functional official by the Minister on the basis of certain requirements. It shall be given a functional rank and allowances in addition to other rights in accordance with prevailing laws and regulations. It concludes the result of the substantive examination that an application can be approved for registration.

Where the Applicant or his Proxy submits an objection or a comment as and the Examiner concludes that such objection or comment can be accepted, the DGIP with its approval shall announce the relevant Application in the Official Gazette of Marks. Where the Applicant or his Proxy submits an objection or a comment and the Examiner concludes that such objection or comment cannot be accepted, the DGIP with its approval shall decide on the refusal of the Application. The refusal as referred to shall be notified in writing to the Applicant or his Proxy, stating the reasons therefore.

Within a period of at the latest 10 (ten) days as of the date of approval for registration, the DGIP shall announce the Application in the Official Gazette of Marks. The announcement shall last for 3 (three) months and be conducted by placement in the Official Gazette of Marks that is published periodically by the Directorate General, and/or placement in a special medium, which can be easily.

Perhaps an Applicant can make an agreement with the owner of a registered Mark for a license that it will use the Mark either all or parts of the kinds of goods or services. The recording of a licensing agreement must be requested at the DGIP with the payment of a fee and the legal consequences of the recording of the licensing agreement shall apply to all parties concerned and to any other third party. A licensing agreement shall be recorded by the DGIP in the General Register of Marks and shall be announced in the Official Gazette of Marks. This way is more dignified to realize the legal order because they have the legal certainty and can used in the trade.

## 2. Legal Protection of a Registered Mark Based on Value of Justice

A trade Mark may satisfy a number of functions. Its main function is indicated in the definition given above, namely, to differentiate one trader's goods or services from those of another. As mass production and self-service in the wholesale and retail Markets have replaced limited product ranges and personal service, the trade Mark allows the consumer to distinguish between similar products. A good trade Mark can be an essential tool for selling goods. As such, it is invaluable to the producer. In a Market swamped by competing goods, the trade Mark is a shorthand description for the product. Without a trade Mark it would be necessary, each time a purchase is contemplated, to compare products by reference to ingredients, function and consumer experiences, which would be very long-winded.<sup>12</sup>

The trade Mark is useful to the consumer as she will choose goods based on personal or vicarious experiences of a product and the trade Mark allows easy identification of the product which previously gave satisfaction, thus leading to repeat purchases. This leads to another possible function of the trade Mark: its guarantee function. Once a customer has tried a product with a particular name and found it satisfactory, repeat purchases of goods bearing that name will guarantee repetition of that satisfaction. Equally, where a consumer has had a bad experience with a product, the trade Mark can act as a warning against further purchases. Traders thus have an interest in protecting the good name of their Mark by only attaching it to quality goods. Provided that the Mark is imbued with this good reputation, the trader can use it to increase and generate sales by investing in promotions and advertising, and by using the Mark.<sup>13</sup>

From the philosophical point of view as said by Peter Drahos, Intellectual property offers personality the possibility of a qualitative shift in its powers to extend itself into the world. Ideas, knowledge and all forms of information circulate in the world in a way that blocks of land and chattels do not. By the positing of property laws in abstract objects, the personality, in Hegelian terms, gains a proprietary hold over the production and distribution of physical objects in undreamt of ways. The very act of

<sup>12</sup> Tina Hart, *et. al*, *Intellectual Property Law*, Palgrave Macmillan, London, 2009, p. 80.

<sup>13</sup> *Ibid*.

communicating an abstract object becomes the subject of a property relation. Moreover, since abstract objects are not territorially bound, it becomes meaningful for personality to begin to contemplate property laws that have a global reach.<sup>14</sup>

Through property, personality imposes itself on its immediate social world and local community. Through a global system of intellectual property law, personality has the potential to reach into other social worlds, other communities. The possibility of a global system of property to regulate relations between states is hardly a possibility that Hegel could have foreseen. Yet his theory does carry a warning for this kind of development. Within Hegel's system, property remains the embodiment of freedom because he clearly assumes that property relations occur within the context of a community which has its own distinctive ethical life. Property is a way of taking a participatory position in that life. This is not necessarily true of a global system of property that regulates access to the abstract objects of art and science. Property rights in abstract objects facilitate trade in culture between states. To the extent that such trade promotes the homogenization of culture it threatens the survival of local cultural forms and therefore local communities. There is another problem. The very fact that the global system of property regulates access to abstract objects means that it has the potential to separate some individuals from those objects. This separation occurs when individuals cannot meet the demands of the commerce in culture and information that a global system of property rights in abstract objects creates.<sup>15</sup>

The integrative role of property is critically dependent on the condition of permission being elaborated and utilized within a given social system. The structural problem that seems implicit in Hegel's analysis is that the fulfilment of this condition within the context of civil society becomes increasingly problematic. Once there is a widespread realization by the members of civil society that it is control and monopoly of the abstract intellectual object which is the real source of economic wealth then, because individuals within civil society are universally driven by self-interest, the permission mechanism increasingly becomes the target of ownership forces. Permission to use the abstract intellectual object becomes conditional upon the capacity to pay for the use of that object. The possibility of creating many new property forms through law has the possible effect that the task of social integration becomes that much more difficult. Because of its individualistic and antagonistic nature, civil society is disposed to press home the advantages of new property forms at the expense of the value of communal integration and this in turn is not likely to do much which is positive for the problem of poverty. Participation in culture more than ever becomes conditional upon the payment of a fee to intellectual property owners. Intellectual property turns out to be the potential assassin of community.<sup>16</sup>

Departure from the view above, so IP is very worth to provide the legal protection to the owner of registered Marks based on value of justice is underlying on the theory of justice. The theory should apply act or treatment with fairness which means impartial. The judge must also implement it in his decision. If a Mark has previously been registered at the DGIP, that is a new Mark has a similarity in its essential part or in its entirety with it should be refused. The lawsuit by a registered Mark should be accepted based on Article 5 and 6 of Marks Law and have compensation because its exclusive right was violated.

The Judge may also interpret or find the law unless he does not deviate from the existing rules. He can use the moral value, or maybe historical value. Roscoe Pound called juristic pessimism, a conviction of the futility of legislation and impossibility of improving the law through conscious effort. The law was thought of as evolving in a necessary course through an inherent power of the idea of freedom to unfold or realize itself. It had moved and must continue to move away from institutions and rules and doctrines in which one's legal rights and duties were consequences of a condition in which he found himself, toward institutions and rules and doctrines in which rights flow from a conscious, free willing individual and legal duties are consequences of willed action.<sup>17</sup> Thus, the judge should not be fixated to the institutions, rules and doctrines to decide according to conviction and morality.

Frederick Pollock referring to Aristotle, he emphasized justice in the point of view of natural law. He said that "natural law", "law of nature" or "natural justice", when we mean such rules as are universally accepted, or in our opinion ought so to be. The term "law of nature" has a long history, beginning with the distinction made by Greek ethical philosophy from Aristotle downwards between natural and conventional justice. It came to mean so much of the rules of justice as can be discovered by man's reason apart from either specific revelation or local or temporary ordinances; it was identified with the law of God; and it followed, in the medieval view, that the law of nature, once being ascertained, was of universal and paramount obligation. It never meant (as some later writers have assumed) the arbitrary speculative opinion of an individual as to what is right and wrong.<sup>18</sup> Therefore, the judge *ex officio* should not be arbitrary by only relying on the applicable law but also on morality the process of adjudication.

According to Dworkin, the adjudicative principle of integrity instructs judges to identify legal rights and duties, so far as possible, on the assumption that they were all created by a single author – the community personified – expressing a coherent conception of justice and fairness. What rights and duties flow from past political decisions, by restating of this construction as thesis about the grounds of law. Dworkin called it law as integrity that the proposition of law are true if the figure in or follow from the principles of justice, fairness, and procedural due process that provide the best constructive interpretation of the community's legal practice.<sup>19</sup>

<sup>14</sup> Peter Drahos, *A Philosophy Of Intellectual Property*, Dartmouth Publishing Company Limited, England, 1996, p. 99.

<sup>15</sup> *Ibid.*

<sup>16</sup> *Ibid.*, P. 100.

<sup>17</sup> Roscoe Pound, *The Formative Era of American Law*, Little Brown and Company, Boston, 1938, p. 115

<sup>18</sup> Frederick Pollock, *First Book of Jurisprudence*, Macmillan And Co., Limited St. Martin's Street, London, 1918, p.13

<sup>19</sup> Ronald Dworkin, *Law's Empire*, Belknap Press of Harvard University Press, Cambridge, Massachusetts, 1986, p. 225.

Justice as fairness was also conceived by John Rawls. The problem of the choice of principles, however, is extremely difficult. He does not expect the answer he shall suggest to be convincing to everyone. It is, therefore, worth noting from the outset that justice as fairness, like other contract views, consists of two parts: (1) an interpretation of the initial situation and of the problem of choice posed there, and (2) a set of principles which, it is argued, would be agreed to. One may accept the first part of the theory (or some variant thereof), but not the other, and conversely.<sup>20</sup>

The concept of the initial contractual situation may seem reasonable although the particular principles proposed are rejected. To be sure, he wants to maintain that the most appropriate conception of this situation does lead to principles of justice contrary to utilitarianism and perfectionism, and therefore that the contract doctrine provides an alternative to these views. Still, one may dispute this contention even though one grants that the contractarian method is a useful way of studying ethical theories and of setting forth their underlying assumptions.<sup>21</sup>

Justice as fairness is an example of what he has called a contract theory. Now there may be an objection to the term "contract" and related expressions, but he thinks it will serve reasonably well. Many words have misleading connotations which at first are likely to confuse. The terms "utility" and "utilitarianism" are surely no exception. They too have unfortunate suggestions which hostile critics have been willing to exploit; yet they are clear enough for those prepared to study utilitarian doctrine. The same should be true of the term "contract" applied to moral theories. As he has mentioned, to understand it one has to keep in mind that it implies a certain level of abstraction. In particular, the content of the relevant agreement is not to enter a given society or to adopt a given form of government, but to accept certain moral principles. Moreover, the undertakings referred to are purely hypothetical: a contract view holds that certain principles would be accepted in a well-defined initial situation.<sup>22</sup> So, the theory of utility contracts must be based on morality. It has been made between the government and people that the government should protect the legal rights and duties. This conception can be applied to the owner of a registered mark to be given for the legal protection.

There are many opinions of justice according to jurists because the idea of law can be none other than justice conceived by Gustav Radbruch. He then declared that "*Est autem justa justitia, sicut a matre sua, ergo prius fruit justitia*" means but law issues from justice as from its mother, as it were, so there has been justice prior to law. Justice reflects the moral good appears as in Ulpianus's words "*constans ac perpetua voluntas jus suum cuique tribuendi*" or "the constant and perpetual will to allot to everyone his right".<sup>23</sup> Justice is harmonization between legal certainty and the principle of proportionality in law.<sup>24</sup> Justice is certainly a relative concept. According to Majjid Khadduri, justice can be found in the implementation of legal enforcement through judges, or justice is fairness and truth.<sup>25</sup>

Referring to Islamic law, justice is inseparable from its philosophy and theories about its purpose. In general justice is how to realize "utility" to all humanity both in the life of the world and the hereafter. Justice should be upheld include justice to the personal, legal, social, fairness and world justice.<sup>26</sup> Moreover, the theories of justice become a compass in implementing law and solving legal cases in accordance with the legal protection to the owner of registered Marks based on value of justice. Ultimately, this notion should be realized in order to have such protection from the legal enforcer regarding Marks Law recently has not been effective.

Based on theories of justice above, briefly I conclude the legal protection in this matter is to protect the individual, the right to a owner of a registered Mark, and communal rights, society as consumers from any violence or infringement. The protection will be given by law i.e. Acts or juridical decisions. Furthermore, the role of Indonesian juridical institutions is very important to settle the dispute of Mark cases based on principle of justice, fairness and procedural.

In practice of legal cases in connection with the registered Mark, the official owners of Mark filed lawsuits and their claims were rejected or accepted by the court. Of course, without any lawsuit, the DGIP should refuse to an Application for registration of a Mark. This approves that the legal protection regulated by Marks Law, in Article 4 and 6, has not yet been effective because the criteria of a similarity in its essential part or in its entirety with a Mark owned by another party which has previously been registered for the same kind of goods and/or services emerges confusion and uncertainty. In fact, recently judges interpreted those articles in different ways, consequently the lawsuit of the official owner of a registered Mark was sometime rejected by the court.

It has been proven from the juridical decision of the Indonesian Supreme Court or Mahkamah Agung Republik Indonesia (MARI) No. RI No. 3485K/Pdt/1992 in the case of GUCCI. This highest court firmly applied the Article 6 Paragraph 3 of Paris Convention constituting that a lawsuit for the cancellation of a registered Mark may be filed by any interested party based on the grounds as referred to in Article 4 of Marks Law, a Mark shall not be registered on the basis of an Application by an Applicant having bad faith.

<sup>20</sup> John Rawls, *A Theory of Justice*, Revised Edition, Harvard University Press, Cambridge, Massachusetts, 1999, p. 14

<sup>21</sup> *Ibid.*

<sup>22</sup> *Ibid.*

<sup>23</sup> Peter Mahmud Marzuki, *An Introduction to Indonesian Law*, Setara Press, Malang, 2011, p. 38.

<sup>24</sup> A. Ridwan Halim, *Pengantar Ilmu Hukum dalam Tanya Jawab*, Ghalia Indonesia, Jakarta, 2005, p. 176.

<sup>25</sup> Mahmutarom, *Rekonstruksi Konsep Keadilan*, Undip, Semarang, 2009, p. 31.

<sup>26</sup> Muhammad Abuzahrah, *Ushuul al-Figh, Mathba'ah Mukhaimar*, Cairo, 1975, p. 350-352.

Priority Right shall mean the right of an Applicant to file an Application originating from a member country of the Paris Convention for the Protection of Industrial Property or the Agreement Establishing the World Trade Organization in order to get recognition that the Filing Date of the country of origin be the priority date in the country of designation that is also a member country of the two agreements, provided that the filing of the Application is made during the period prescribed in the Paris Convention for the Protection of Industrial Property.

A request for the extension of protection period shall be refused by the Directorate General, if the relevant Mark has similarities in its essential part or its entirety with a well-known Mark of another person. Rejection of the application which has the overall similarity in principle or with well-known brands for goods and / or services carried out by observing the kind of common knowledge in the community about the brand business fields concerned. In addition, attention is also well-known brands earned a reputation as a vigorous campaign and a massive investment in several countries around the world carried out by the owner and accompanied by proof of registration of the tradeMark in several countries.

If the things above is not considered sufficient, the Commercial Court may order an institution that is independent to conduct a survey in order to obtain a conclusion about whether or not the famous brands on which the refusal. Rejection of the application for registration of the well-known Marks that are similar to famous brands belong to another person or other entity. This regulation can be regarded as imposing the principles of Article 4 paragraph (1) Paris Union Convention on the Right of Priority Principle. This principle is stipulated in Decree of the Minister of Justice No. M.03.HC.020.1 Year 1991.

Such protection can only be effective with a means to give priority to the rights of well-known Marks of the foreigner. Thus, in the event of competition for enrollment between Marks owner foreigners and domestic regarding Mark of the type of goods and the same class should be the main legal frame to foreigners in connection with th protection in the global trade. It will also be carried out by other countries to treat Indonesia' Marks.

The development of global business must be a serious attention by the Government in providing the legal certainty to the owners of registered Mark. The legal guarantee is necessary to enforce infringements to the right to a Mark. In legal practice, there are many legal cases in accordance with the violation of the registered Mark, however the owner has been filed at the DGIP. This fact has what might appear to be roots of problems within the law enforcement to protect the right of the registered Marks. If the Government does not take care about this matter, it then does not take law seriously either.<sup>27</sup> It is important to notice from the start that the Government should be providing the legal protection based on justice.

### C. Conclusion

The legal protection to a registered Mark regulated by Marks Law has not yet been effective because of the weakness of Article 4, 5 and 6. In legal practices, through court's decisions, the judge must be impartial and fair. He must also interpret the articles based not only on the positivism norms but also on the moral and historical principles. It should be based on value of justice armed with the principle of justice, fairness and procedural. By waf of this concept, there must be a reconstruction to those articles. The Marks Law, as soon as possible, should be amended in harmonization with the principles, norms, regulation in accordance with the international legal instruments.

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<sup>27</sup> Dworkin says if the Government does not take rights seriously, then it does not take law seriously either. See, Ronald Dworkin, *Taking Right Seriously*, Harvard University Press, Cambridge, Massachusetts, 1978, p. 205.

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