# Conventional and Unconventional Brand Protection in Indonesia

**Monica Olivia**
monicaolivia_gani@yahoo.com

Doctor of Law, Faculty of Law, Universitas Airlangga

***Article Info***
*Received: 27-01-2023*
*Revised: 8-02-2023*
*Accepted: 05-03-2023*

***Keywords:***
*Brand Protection,*
*Conventional Brand,*
*Unconventional Brand*

***Abstract***

*This study aims to determine the legal protection of conventional and unconventional brand registration in Indonesia. This research is normative research using legal materials to solve facts or legal issues and to obtain legal materials and analyze them through literature studies (legislation and literature). This study used 2 (two) problem approaches, namely the statutory approach and the conceptual approach. The findings revealed that conventional brand is limited to signs in the form of pictures, names, words, letters, numbers, color arrangements, or combinations of elements that have distinguishing features and are used in trading activities of goods or services. However, for a product/service that does not qualify in terms of a conventional brand, it is generally known as a unconventional brand. The regulation of non-conventional marks in Indonesia is outlined in Article 1 (1) of Law 20/2016. However, this regulation only covers marks in the form of three dimensions, sound, and holograms. Indonesia currently only regulates unconventional marks that fall under these categories. This poses a potential issue as the market is witnessing a growing variety of marks, and the regulation of position marks has not yet been addressed in Indonesia.*

## I. Introduction

Brand as a form of intellectual work has an important role for the smooth running and improvement of trade in goods or services in trade and investment activities. A brand (with its brand image) can be a sign to identify the origin of goods and services (an indication of origin) (Tarigan & Raja, 2022) and a distinctive character of the goods and/or services of one company with the goods and/or services of other companies that which can be an important and significant asset for individuals or companies in carrying out their business activities to generate profits (Rahmi, 2007)). With the existence of a brand as an individual or company asset that can generate large profits, it is very important for brand owners to register a brand in order to get protection as a first step to prevent other parties who do not have the authority to use it.

Regulations related to Brands in Indonesia are currently regulated in Law Number 20 of 2016 concerning Brands and Geographical Indications (hereinafter referred to as Law No.20/2016). In Article 1 number 1 Law No.20/2016 states that a Brand is a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in the form of 2 (two) dimensions and/or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by persons or legal entities in the activities of trading in goods and/or services. The definition provided by Law No.20/2016 is currently much broader when compared to the definition of a brand as regulated in the previous Trademark Law, namely Law Number 15 of 2001 concerning Trademarks where mentioning the definition of a Brand is a sign in the form of a picture, name, word, letters, numbers, arrangement of colors, or a combination of these elements which has distinguishing features and is used in trading activities of goods or services. In Law No. 20/2016 the development of the scope of protected brands includes sound brands, three-dimensional brands, hologram brands, referred to in terms of the category of unconventional brands.

The expansion of the definition of a brand in Law No. 15/2001 is due to the fact that it is no longer in accordance with the development of legal needs in society. In addition, the expansion regarding the definition of a brand is carried out to further improve services and provide legal certainty for the world of industry, trade and investment in facing local, national, regional and international economic developments as well as developments in information and communication technology. Amendment to Law no. 15/2001 became Law No.20/2016 also as a consequence of Indonesia's participation as a member of the WTO through Law Number 7 of 1994 concerning Ratification of the

Agreement Establishing the World Trade Organization on 2 November 1994, which contains Attachment to the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs Agreement). The purpose of the TRIPs Agreement is to provide intellectual property rights protection and enforcement procedures for fair trade and signing of the TRIPs Agreement. In addition, the Government of Indonesia has also ratified international conventions or treaties in the field of Brands such as: the Paris Convention for the Protection of Industrial Property and the Convention Establishing the World Intellectual Property Organization which was ratified by Presidential Decree Number 15 of 1997 concerning Amendments Presidential Decree Number 24 of 1979 concerning Ratification of the Paris Convention For The Protection Of Industrial Property And The Convention Establishing The World Intellectual Property Organization (hereinafter referred to as Presidential Decree No.15/1997); and the Trademark Law Treaty which was ratified by Presidential Decree Number 17 of 1997 concerning Ratification of the Trademark Law Treaty (hereinafter referred to as Presidential Decree No.17/1997).

One of the important developments in the field of Brands is protection for new types of Brands known as unconventional brands. Therefore, it is necessary to expand the definition of Brand to include the unconventional brands, including those related to: three-dimensional brands, sound and holograms. With the existence of protection for these types of Brands, the definition and scope of Brands regulated in Law no. 15/2001 is no longer sufficient so that there is a need for expansion following developments in the protection of trademark rights in Indonesia.

The novelty of this research lies in its specific focus on examining the legal protection of both conventional and unconventional mark registrations in Indonesia. This research is crucial because new forms of marks are constantly emerging, and it is essential to establish legal protection for unconventional marks such as three-dimensional shapes, sounds, and holograms. The current Law No. 15/2001 does not adequately address these types of marks. The aim of this research is to analyze the existing legal framework and suggest necessary expansions to the definition and scope of marks in Indonesian law. These proposed changes will be in line with international advancements and the ever-evolving landscape of global trade and technology. Based on the background described earlier, this study aims to determine legal protection for conventional and unconventional brand registration in Indonesia. The results of this study will provide us with a deeper understanding of the legal protection afforded to conventional and unconventional forms of brand registration in Indonesia.

## 2. Research Method

This research was normative research using legal materials to solve facts or legal issues and to obtain legal materials and analyze them through literature studies (legislation and literature). Legal research was carried out in order to produce arguments, theories, or new concepts as prescriptions in solving the problems at hand (Mahmud, 2016). The legal research method used was aimed at finding and studying legal protection for Conventional and Unconventional brand registrations in Indonesia.

In this study, 2 (two) problem approaches were used, namely the statute approach which was carried out by examining the laws and regulations related to the legal issues being handled related to brands (Mahmud, 2016). The second approach, namely a conceptual approach that departs from the views and doctrines that have developed in the science of law (Mahmud, 2016). The Conceptual Approach was used to study the suitability of legal concepts and expert opinions regarding the concept of rights, the concept of brands as exclusive rights, concepts related to trademark registration both conventional and unconventional brands in Indonesia.

## 3. Results and Discussion

### Legal Protection for Conventional Trademark Registration

Traditional marks, also referred to as conventional marks, have restrictions in terms of their composition. They are confined to incorporating images or designs, names, words, numbers, letters, colors, or a combination of these elements (Hidayah, 2017). In 2017, the regulation for position marks was established in Article 3(3)(d) of the Commission Implementing Regulation (EU) 2017/1431. This article states that if the application pertains to one of the trademark types listed in points (a) to (j), it must include an indication to that effect. Additionally, the type of trademark and its representation should correspond to each other. Specifically, for position marks, which refer to the specific way the mark is placed or affixed to the product, a reproduction must be submitted that accurately identifies the position, size, and proportion of the mark in relation to the goods concerned (Puspa & Yanti, 2023). It is recommended to visually reject elements that are not part of the registration's subject matter. This can be done using a dotted line, accompanied by a detailed description of how the mark was affixed to the goods. The concept of protecting position marks originated from Germany's doctrine. If the mark or sign is eligible for protection, there is no need for a position mark (Rideau, 2011).

In Indonesia, the development of laws and regulations in the field of Brands has undergone many changes because they are no longer in accordance with the needs and developments in the rules contained in the TRIPS Agreement and other international conventions in the field of brands. In Indonesia, the legal protection of conventional marks is obtained by registering trademarks with the Director General

of Intellectual Property Rights (IPR) using the first-to-file principle. The country also places great emphasis on protecting well-known marks, rejecting applications that are similar to well-known marks for similar goods and services. The government actively safeguards businesses from counterfeit cosmetic product brands and recognizes the significance of Intellectual Property Rights (IPR). The legal system in Indonesia grants exclusive rights to registered trademark owners, highlighting the importance of registration rather than first use. Additionally, international trademark regulations, governed by organizations like the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO), contribute to safeguarding trademark rights in Indonesia.

Trademark Rights, a type of Intellectual Property Rights (IPR) protection in Indonesia, provide exclusive rights to the registered mark owner for its use in trade of goods and services, or for granting licenses to others. However, obtaining Trademark Rights does not automatically grant permission for the owner to use the mark. By registering a trademark, the owner gains the authority to prohibit others from using the same mark, particularly in the same category of goods or services. These rights are governed by Law No. 20/2016 on Trademarks and Geographical Indications, which aims to ensure fair business competition, justice, consumer protection, and support for Micro, Small, and Medium Enterprises (MSMEs).

The protection of well-known trademarks in Indonesia is governed by Law Number 20 of 2016 on Trademarks and Geographical Indications. This law states that if a trademark application bears similarities to an existing trademark for similar goods and/or services, it will be rejected. The legal protection for well-known marks is further explained in Article 21 paragraph (1) letter b and c, Article 83 paragraph (2), and the corresponding explanations. Indonesia follows a constitutive system for trademark registration, which means that registration is necessary to obtain protection. This system is also known as the first to file system, where the first person to register a trademark is granted the rights. However, even if a well-known trademark is not registered in Indonesia, it can still receive protection due to Indonesia's ratification of the Paris Convention and the TRIPS Agreement.

Based on the provisions of Article 21 paragraph (1) letter b and c "The application is rejected if the Trademark is substantially or wholly similar to: b. A well-known trademark owned by another party for similar goods and/or services; c. A well-known trademark owned by another party for non-similar goods and/or services that meet certain requirements." Refusal of registration of trademarks related to the preventive protection of well-known trademarks need to pay attention to the element of bad faith, in the sense that registrants who are not owners of well-known trademarks deliberately in bad faith want to take advantage of the fame of famous trademarks of others, utilizing the promotion of famous trademarks for his own benefit for free.

Protection of holders of Famous Trademark Rights in Indonesia will be very decisive

for the development and progress of the industries in Indonesia and as a legal effort to provide a sense of security and comfort as well as legal certainty for all business actors in Indonesia.

According to Article 2 Paragraph (3) of Trademark Law No. 20 of 2016, a trademark that is protected encompasses various elements such as images, logos, names, words, letters, numbers, color arrangements in both two and three dimensions, sounds, holograms, or a combination of two or more of these elements. These elements serve the purpose of distinguishing goods and/or services produced by individuals or legal entities engaged in trade activities. The protection of trademarks is further outlined in Article 3 of Law No. 20 of 2016, which pertains to Trademarks and Geographical Indications. This article establishes that the right to a trademark is acquired through registration. The registration process involves formal examination, announcement, substantive examination, and ultimately obtaining ministerial approval to be issued a certificate.

Article 100, paragraph (1) and Article 100, paragraph (2) of the law address the issue of repressive legal protection. These provisions specifically deal with the criminal sanctions imposed on individuals or legal entities who wrongfully use a trademark that bears significant resemblance to other registered trademarks. Furthermore, Article 83, paragraph (1) outlines the procedure for initiating a lawsuit by the rightful owner or licensee of a registered trademark against parties who unlawfully utilize a similar trademark for similar goods and/or services. This procedure allows for the pursuit of compensation claims and the cessation of all activities associated with the unauthorized use of the trademark.

In addition, legal protection of trademark rights holders is also regulated in Law Number 3 of 2014 concerning Industry in Article 43 paragraph (3), which states that the government and local governments conduct consultations, advocacy guidance, and intellectual property rights protection facilities, especially for small industries.

For a brand to be protected, the brand must have differentiating power, which theoretically can be categorized (Gastinel & Milford, 2001):

1. Inherently distinctives: eligible for immediate protection upon use. (A sign which is inherently distinguishable is immediately protected through use)
2. Capable of becoming distinctive: eligible for protection only after the development of consumer association (secondary meaning). (Signs that have the ability to be differentiating, can be protected only after the development of consumer associations called the second sense)
3. Incapable of becoming distinctive: not eligible for trademark protection regardless of length of use. (A sign that does not have the ability to distinguish cannot be protected as a brand even though it has been used for a long time)

In its development, the definition of a brand in Law No.15/2001 only refers to a brand with a sign that can be seen in plain view, so it does not apply to brands other than the definition of a brand provided by law. It is necessary to understand and

remember that the distinguishing power of a brand is not only in the form of a two-dimensional sign, however, it also appears in the form of a three-dimensional sign, hologram, sound, aroma, texture and even taste. These elements also provide significant differentiating power to a product that is produced. Therefore, Law No.15/2001 has been replaced by Law no. 20/2016 with an expansion of the definition of a brand that includes unconventional brands.

## Legal Protection for Unconventional Trademark Registration

The field of Trademarks has seen a significant development with the introduction of Unconventional Trademarks. These include unique forms such as three-dimensional shapes, sounds, holograms, aromas, and more. To keep up with this progress, it is necessary to expand the scope and definition of Trademarks as stated in Act No. 15 of 2001 on Trademarks. Additionally, Act No. 15 of 2001 on Trademarks should be refined to align with the evolving legal requirements of society and to enhance services for Trademark Applicants. Replacing the current Trademark Act of 2001 requires making revisions and simplifying the registration process and procedures. Furthermore, the increasing globalization of trade necessitates Trademark protection for national products in export destinations, along with the establishment of an international Trademark registration system that is accessible, cost-effective, and efficient.

Law No. 15 of 2001 contains provisions that do not align with ratified international conventions and future conventions. These provisions pertain to the definition of trademarks, specifically "Unconventional Marks" such as three-dimensional forms, sound, and holograms (with plans to ratify the Singapore Treaty). To keep up with the evolving scope of trademarks, it is necessary to expand the definition of trademarks to include protection for three-dimensional shapes, sounds, and holograms. Currently, the definition of trademarks used is outdated, while other countries like Japan, Korea, and the United Kingdom have already adopted a definition that provides protection for "Unconventional Marks" in the form of three-dimensional or packaging, sound, and holograms. The challenge lies in improving the capabilities of Trademark Examiners to anticipate and provide services for the protection of unconventional trademarks (Setyawan et al., 2017).

As a consequence, Indonesia has ratified the Convention on the Formation of the World Trade Organization (World Trade Organization) through Law No.7/1994, the Paris Convention through Presidential Decree No. 15/1997, as well as the Trademark Law Treaty which was ratified by Presidential Decree No. 17/1997, makes it obligatory for Indonesia to adapt the applicable Trademark Law to the provisions of the ratified international treaty. One of the developments in the field of Brands is the emergence of protection for new types of Brands or what are referred to as Unconventional brands.

The regulation of unconventional trademarks internationally and nationally is

regulated in several instruments. In Indonesia, they are regulated in the Trademark Law NO 20 of 2016 and the Minister of Law and Human Rights Regulation No 67 of 2016 on Trademark Registration, article 15 paragraph 1 of the agreement on Trade-Related Aspects of Intellectual Property Rights mentions that:

*Any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of another, will be capable of becoming a trademark. Such signs, in particular words including personal names, letters, numbers, figurative elements and color combinations as well as any combination of such signs, shall be eligible for registration as a trademark. Where the mark is not inherently capable of distinguishing the relevant goods or services, Members may make registration contingent on distinctiveness acquired through use. Members may require, as a condition of registration, that the mark be visually discernible.*

Article 15 paragraph (1) of the TRIPs Agreement confirms that the above arrangement shall not be understood as a rule to prevent signatory countries from refusing trademark registration on other grounds as long as they do not prejudice the provisions already stipulated in the Paris Convention for the Protection of Industrial Property ("Paris Convention"). The Paris Convention regulates the conditions and terms of registration of marks and the freedom of protection of the same mark in different countries.

In Indonesia, Unconventional Trademark Regulations are outlined in Law Number 20 of 2016, Paragraph 1 Point 1:

*A trademark is a graphical representation such as a picture, logo, name, word or phrase, letters, color arrangements in two or three dimensions, sound, hologram, or a combination of two or more elements used to distinguish specific goods or services produced or provided by individuals or business entities in commercial/trade activities.*

Paragraph 4 Point 6:

*If a trademark is in the form of a three-dimensional object, the attached label must correspond to the characteristics of the trademark.*

Paragraph 4 Point 7:

*If a trademark is in the form of a sound, the attached label must be in the form of musical notation or a sound recording.*

Indonesia only provides protection for unconventional trademark elements such as sound, three-dimensional objects, and holograms. The reason why this is the case is because such elements are more difficult to protect. Moreover, Indonesia still faces difficulties to enforce the application of protection for such elements as in some developed countries, as Indonesia is not ready, both in terms of regulations and government capabilities in this case the Directorate General of Intellectual Property.

Initially, the unconventional brands were agreed upon by the countries that signed the TRIPs Agreement through an international global forum, namely The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications formed by the World Intellectual Property Organization (WIPO). Protection of unconventional brands is seen as important in the international arena in line with the development of the need for trademark protection following the dynamics of world trade with increasingly sophisticated technological advances. At the Sixteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (WIPO) which was held on 13 November 2006, an agenda was included regarding unconventional brands to be discussed including "New Types of Brands". In this forum, the types of signs in the form of a new brand were presented which were divided into two, namely Visible and Non-Visible, namely: (Mayana, 2017)

1. Visual Unconventional Brands (Visible), such as three-dimensional brands, colors, holograms, slogans, film and book titles, multimedia signs, positions and gestures.
2. Non-visual (Non-Visible) Unconventional Brands such as sound, aroma, taste and texture

After going through discussions in several subsequent forums, on July 21, 2008, WIPO established an 'Area of Convergence' which can be used by trademark registration offices in member countries as well as by trademark owners and practitioners, who are moving into new marketing and advertising techniques at the Nineteenth Session of Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications forum, and the results of the forum present the following types of signs in the form of brands:

Included in Visible Mark are:

a. Three-dimensional marks;
b. Color of marks;
c. Holograms;
d. Motion or Multimedia of marks;
e. Position of marks;
f. Gesture of marks;
g. While that includes Non-Visible Mark are:
h. Sound of marks;
i. Olfactory of marks;
j. Taste of marks;
k. Texture or feel of marks

The inclusion of Visible Marks and Non-Visible Marks in the discussion forum for the definition of Unconventional brands is due to the fact that On March 27, 2006, WIPO member countries adopted the Singapore Treaty on The Law of Trademark (hereinafter referred to as STLT) as a form of revision of the Trademark Law Treaty made in 1994. STLT is an agreement that regulates brands with a wider scope in

terms of the process of submitting trademark registration, as well as technological developments. The STLT also explains the registration of various types of unconventional brands in the form of visible marks such as holograms, color marks and marks with movement (movement marks) as well as arrangements regarding marks which cannot be seen such as brands with aroma and sound. This is as stated in the Summary of the Singapore Treaty on the Law of Trademarks (2006) made by WIPO, that:

*"The Treaty is applicable to all types of marks, including unconventional visible marks, such as holograms, three-dimensional marks, color, position and movement marks, as well as non-visible marks such as sound, olfactory or taste and feel marks. The Regulations Under the Singapore Treaty on the Law of Trademarks provide for the mode of representation of these marks in applications, which may include non-graphic or photographic reproductions".*

In contrast to the setting of the brand definition regulated in the Trademark Law Treaty. In the Trademark Law Treaty Article 2 paragraph (1) point (a) states that: "This Treaty shall apply to marks consisting of visible signs, provided that only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks." It states that the Trademark Law Treaty applies to Marks that contain visible marks and also applies to member countries that ratify the Paris Convention and accept three-dimensional Mark registration. Further in the Trademark Law Treaty Article 2 paragraph 1 point (b) provides provisions protecting visible signs: "This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks." The definition of a mark in the Trademark Law Treaty only applies to conventional two-dimensional marks that use letters, words, numbers, colors and combinations of these elements, and does not apply to holographic brands or other brands that do not contain visible marks, especially to brands that invisible like sound and smell. Until now, Indonesia has not ratified the STLT, however, as a consequence that Indonesia has become part of the WIPO International Organization, Indonesia has an obligation to expand the scope of the definitions in the Trademark Law. Regulation Article 1 number 1 of Law no. 20/2016 states that a brand is a sign that can be displayed graphically. The word "can be displayed graphically" indicates the application of the provisions "visually perceptible". Visually perceptible provisions mean that the registration of a mark must be graphically and objectively described so that it can be easily recognized by the public (Dewi & Sukihana, 2019). This is in line with Article 15 paragraph 1 of the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPs) which defines a mark as follows:

*"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark such signs, in particular words including personal names, letters,*

*numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible" (Jened, 2015).*

According to Rahmi Jened, in Article 15 TRIPs it is stated that "... Member may require, as a condition of registration that signs be visually perceptible. " If the TRIPs provisions regarding "be visually perceptible" are implemented by a member country, then the only problem that must be addressed by the applicant for the trademark registration is how to present the mark objectively and appropriately, so that it can be identified by a third party (Jened, 2015).

The definition of a mark included in Law no. 20/2016 is a progressive effort in protecting unconventional brands by expanding the scope of brand definition by including signs in the form of 3 (three) dimensional images, sounds, holograms, with the following explanation:

**a. Brand 3 (three) Dimensions:**

A three-dimensional brand can be in the form of packaging, product form, or spatial design where services are sold. In registering a three-dimensional mark, a sign in the form of packaging, product shape, or spatial design where the service product is sold can also be combined with other brand elements such as words, logos, and/or colors (composite trademark). In addition, a three-dimensional brand can also be a two-dimensional brand that is visualized in three dimensions. In general, a three-dimensional brand of this type can be a company logo embodied in a three-dimensional form (Indriyanto & Yustina, 2017). Registration of a Mark or Brand in the form of 3 (three) dimensions, the label attached is a form of the characteristics of the mark in the form of images from various sides (Direktorat Jenderal Kekayaan Intelektual Kementerian Hukum Dan Hak Asasi Manusia Republik Indonesia, 2019).

**b. Sound Brand**

One of the signs in the form of sounds that are well known to the public so that they can identify the origin of goods or services is the sound of a lion's roar which is always heard at the beginning of films produced by Metro Goldwyn Mayer Inc. The sound is a sign that distinguishes Sari Roti company bread from other companies' bread (Indriyanto & Yustina, 2017). In the form of a mark or brand in the form of sound, the label attached to the applicant is in the form of a notation and sound recording. However, if the voice cannot be displayed in the form of a notation, then the applicant can attach a sound mark label in the form of a sonogram (type of mark as a sound mark). In submitting this voice application, in addition to notation, the applicant can include the sound of the song/poem (Direktorat Jenderal Kekayaan Intelektual Kementerian Hukum Dan Hak Asasi Manusia Republik Indonesia, 2019).

### c. Holograms Brand

With the development of technology, today's two-dimensional signs can also be displayed in the form of a hologram. Initially, this sign was widely used as a medium to ensure product authenticity or prevent counterfeit products. However, in its development, holograms are increasingly being used as brands in the market. This is because holograms can identify the commercial origin of a product or service. One of the characteristics of a hologram brand is that when viewed from different perspectives, one hologram brand can be represented by several (different) signs (Indriyanto & Yustina, 2017). In the trademark application in the form of a hologram, the applicant must attach the hologram brand label in the form of a visual display from various sides (type of brand as a hologram mark) (Direktorat Jenderal Kekayaan Intelektual Kementerian Hukum Dan Hak Asasi Manusia Republik Indonesia, 2019).

Even though unconventional brands use unusual signs to be used as brands, these marks must still meet the definition of a mark or brand as stipulated in Law no. 20/2016 which can be displayed graphically and has differentiating power (Indriyanto & Yustina, 2017). Regarding the protection of other unconventional brands such as Motion or Multimedia signs, Position of marks, Gesture of marks, Color of marks which are included in the Visible Mark as well as aroma, touch, taste which are included in the Non Visible Mark there is still no regulation regarding legal protection in Indonesia, because the several types of unconventional brands mentioned above naturally have difficulty meeting the definition of a mark as a sign that can be displayed graphically. Unconventional brands have more difficult hurdles to be registered as a mark because of their unique characteristics. Broadly speaking, the requirements for registering a Conventional brand also apply to unconventional brands (Indriyanto & Yustina, 2017). If a Unconventional brand meets the basic qualifications for refusal to register a mark, then the unconventional brand must also be refused registration. Qualification mechanisms regarding marks that cannot be registered and brands that are rejected as stipulated in Article 20 and Article 21 of Law no. 20/2016 also applies to unconventional brands.

Registration of the unconventional brands described above is important in the future to be protected in Indonesia. Provisions in the trademark law in Indonesia currently require that a mark that is to be registered must be displayed graphically (visually perceptible) so that it can cause problems in its registration. However, this should not necessarily negate the protection of Unconventional brands, therefore it is necessary to take the right steps in registering Unconventional brands, namely: (Mayana, 2017)

1. Describe in writing the product to be registered. Applicants can describe in writing, or describe with chemical formulas or with Scientific Techniques (This technique can be done, among other things, with the Chromatography process as a way to determine the chemical components in an aroma or taste which gives

results in the form of graphic information about what elements are used, the quality as well as the quantity)
2. Include specimens or product samples at the time of registration
3. Protection of brands based on secondary meaning; Usually the proof for secondary meaning is: (Jened, 2014)
   a. Direct consumer acknowledgment (direct consumer testimony)
   b. Consumer survey (consumer survey) related to the will of other parties to imitate the brand
   c. In addition, there are evidences of exclusivity, duration and method of use
   d. The amount and amount of advertising
   e. The number of sales and consumers
   f. The number of sales and consumers
   g. Evidence of copying if competitors imitate means that the brand is quite valuable

Unconventional brands in the form of sound marks, three-dimensional brands, hologram marks must be registered in accordance with the provisions of the trademark law in Indonesia as a form of legal protection by the state for brand owners regulated in the provisions of Article 3 of Law No. 20/2016 namely the right to the mark is obtained after the mark is registered. If an Unconventional brand is not registered with the state, the owner of the brand will not be afforded any legal protections by the state. This can have consequences if the unconventional brand is used or imitated by another person without permission from the owner of the Unconventional brand, the owner of the Brand will lose the rights to his trademark and will be given the opportunity to take legal action to defend his Brand.

The regulation of non-conventional marks in Indonesia has been regulated in Article 1 (1) of Law 20/2016, but is only limited to three-dimensional, sound, and hologram forms. However, Indonesia has not regulated positional unconventional marks. When positional unconventional marks are not regulated, this may cause problems in trademark protection in Indonesia. Because, with the increasing number of types of brands on the market, position marks are becoming increasingly important in distinguishing products or services from competitors. A position mark is a mark that consists of a particular position or location on the product or packaging that distinguishes the product or service from competitors. Examples of position marks are marks located on certain parts of the product, such as logos on shoe soles or brands on bottle caps.

In some cases, position marks can possess a high level of distinctiveness, making them easily recognizable by consumers. Consequently, it becomes crucial for Indonesia to establish regulations pertaining to position marks, in order to offer sufficient legal protection for brand owners. Through the implementation of such regulations, brand owners will be empowered to safeguard their exclusive rights to the mark, prevent unauthorized usage by third parties, and uphold their competitive advantage within the market. Moreover, the regulation of position marks will also

contribute to providing legal certainty for brand owners, thereby fostering an environment conducive to investment in brand innovation. By having a well-defined legal framework in place, brand owners will feel more confident in dedicating their time, effort, and resources towards the creation of unique and distinctive position marks.

The registration of conventional and unconventional marks in Indonesia is protected by law. Trademark registration in Indonesia follows the first to file principle, which grants rights to the person who first applies for the mark, even if another party can demonstrate prior use of the mark (Tritanaya & Yulianingsih, 2022). Registered trademarks receive legal protection for 10 years from the date of receipt of trademark registration (Tritanaya & Yulianingsih, 2022). In addition, protection for batik artworks, including brands, can be provided through Law No. 19 of 2002 on Copyright (Irmansyah, 2010). The legal protection of foreign and well-known marks is also regulated in Law No. 20 of 2016 on Trademarks and Geographical Indications (Zainnullah, 2022).

Challenges may arise in Indonesia when it comes to applying legal protection for unconventional marks. These challenges can be attributed to a lack of comprehension regarding the regulations that govern unconventional marks, such as Government Regulation No. 51/2007 on Geographical Indications. Furthermore, obstacles may also arise during the registration and protection process for unconventional marks, particularly in terms of acknowledging and safeguarding marks that have not been formally registered. Additionally, even though batik is acknowledged as Indonesia's cultural heritage, ensuring sufficient legal protection for batik as an unconventional mark may still pose challenges.

The distinction in legal safeguarding between conventional and unconventional trademarks in Indonesia is primarily attributed to the process of registration and the level of trademark protection. In Indonesia, conventional trademarks can be acquired by registering them with the Directorate General of Intellectual Property Rights (DJHKI), whereas unconventional trademarks do not necessitate such registration (Gunawan, 2010). The duration of legal protection for conventional trademarks is typically 10 years, starting from the date of trademark registration. Conversely, unconventional trademarks are granted the same duration of legal protection, but it commences from the date of the trademark's manufacture (Gunawan, 2010). The regulation of legal safeguards for traditional trademarks is governed by Law No. 15 of 2001 on Trademarks (Irianti et al., 2015). Law No. 19 of 2002 on Copyright governs the legal framework for the protection of unconventional trademarks (Gunawan, 2010). Legal protection of unconventional trademarks can be provided through legislation on geographical indications, such as Government Regulation No. 51 of 2007 on Geographical Indications of Pekalongan Batik (Gunawan, 2010). Conventional trademark registration requires several steps, such as applying for registration, authorizing registration, and validating

registration. While unconventional trademark registration does not require the same steps (Suparmin, 2018).

The distinction in legal safeguarding between conventional and unconventional trademarks in Indonesia can be observed in terms of registration, protection, and legislation. Conventional trademarks necessitate registration with the Directorate General of Intellectual Property Rights (DJHKI) and are granted legal protection for a duration of 10 years from the date of trademark registration. Conversely, unconventional marks do not require registration and also receive legal protection for 10 years, but the regulations pertaining to unconventional marks are governed by Law No. 19 of 2002 concerning Copyright. Furthermore, the safeguarding of batik artworks, including trademarks, can also be ensured through Law No. 19 of 2002 on Copyright. Consequently, disparities exist in the registration process, governing bodies, and forms of protection for conventional and unconventional trademarks in Indonesia.

The Trademark Act offers legal safeguards for trademarks and well-known trademarks, employing a combination of preventive and repressive measures as outlined in Article 6, paragraphs (3) and (4). These measures align with the provisions set forth in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), encompassing the protection of goods or services that are both similar and dissimilar to the registered trademark. Furthermore, the Act also addresses repressive measures pertaining to trademark protection.

In order to obtain legal protection for a trademark, it is necessary for the trademark to be registered with the Directorate General of Intellectual Property Rights. This requirement is stipulated in the TRIPs agreement and further elaborated in Article 1, number 5 of Law No. 20 of 2016 on Trademarks and Geographical Indications. According to this law, the owner of a registered trademark holds the exclusive right to use the trademark or grant permission to others for its use. The objective behind granting exclusive rights to trademarks and treating them as property rights is to facilitate the provision of legal protection guarantees for trademark owners.

## 4. Conclusion

Conventional brands are typically limited to visual elements such as pictures, names, words, letters, numbers, color arrangements, or combinations thereof, which are used to distinguish goods or services in trade. On the other hand, products or services that do not meet the criteria of a conventional brand are commonly referred to as unconventional brands. The Government of Indonesia has established legal provisions to protect unconventional brands, as outlined in Article 1 point 1 of Law No. 20/2016. This law expands the definition of marks or brands to include sound, three-dimensional shapes, and holograms, all of which fall under the category of unconventional brands.

However, the protection and registration of unconventional brands face a significant challenge in terms of visually perceptible requirements. It is difficult to describe the distinctive characteristics of a product belonging to the unconventional brand category. To address this issue, several solutions can be implemented to safeguard unconventional brands. These include providing a written description of the product during the registration process, submitting a specimen or sample of the product, and establishing trademark protection based on the secondary meaning it holds in the minds of consumers in the market.

The objective of these measures is to ensure that brand protection aligns with the primary purpose and function of a brand, which is to differentiate a company's product and prevent unauthorized parties from imitating or copying the brand. It is important to note that in Indonesia, the registration of marks or brands follows the first-to-file principle. Therefore, both conventional and unconventional brands can only receive protection if they have been registered with the Directorate General of Intellectual Property (DGIP) in accordance with the prevailing trademark laws in Indonesia.

## References

Dewi, N. P. W. P., & Sukihana, I. A. (2019). Pendaftaran Suara Sebagai Merek Non Tradisional Berdasarkan Undang–Undang Nomor 20 Tahun 2016 Tentang Merek. *Kertha Semaya: Journal Ilmu Hukum*, *7*(10), 1–13.

Direktorat Jenderal Kekayaan Intelektual Kementerian Hukum Dan Hak Asasi Manusia Republik Indonesia. (2019). *Modul Kekayaan Intelektual Bidang Merek Dan Indikasi Geografis*.

Gastinel, E., & Milford, M. (2001). *The legal aspects of the community trade mark*. Kluwer law international.

Gunawan, M. S. (2010). *Pelaksanaan Peraturan Pemerintah No. 51 Tahun 2007 Tentang Indikasi Geografis Pada Batik Pekalongan Sebagai Upaya Hukum Dalam Mempertahankan Ciri Produk Batik*. Universitas Muhammadiyah Surakarta.

Hidayah, K. (2017). *Hukum Hak Kekayaan Intelektual*. Setara Press.

Indriyanto, A., & Yustina, I. M. (2017). *Aspek Hukum Pendaftaran Merek*. Rajawali Pers.

Irianti, A. K., Winarno, B., & Alam, M. Z. (2015). *Perlindungan Hukum Bagi Merek 3 Dimensi Menurut Undang-Undang No. 15 Tahun 2001 Tentang Merek*. Universitas Brawijaya.

Irmansyah, R. A. (2010). *Penerapan Hukum Hak Cipta Seni Batik Pekalongan (Studi Hukum pada Dinas Perindustrian, Perdagangan, Koperasi, dan UMKM Kota Pekalongan)*. Universitas Muhammadiyah Surakarta.

Jened, R. (2014). *Hukum Hak Cipta (Copyright Law)*. PT. Citra Aditya Bakti.

Jened, R. (2015). *Rahmi Jened, Hukum Merek (Trademark Law) dalam Era Global dan Integrasi Ekonomi*. Rajawali Pers.

Mahmud, P. M. (2016). Pengantar Ilmu Hukum Edisi Revisi. *Jakarta: Kencana Pranada*.

Mayana, R. F. (2017). Perlindungan Merek Non Tradisional Untuk Produk Ekonomi Kreatif Berdasarkan Undang-Undang Nomor 20 Tahun 2016 Tentang Merek, Indikasi Geografis dan Perspektif Perbandingan Hukum. *Jurnal Bina Mulia Hukum*, *2*(1), 26–41.

Puspa, P. M., & Yanti, A. A. I. E. K. (2023). Perlindungan Hukum Konsep Position Mark Sebagai Merek Non-Konvensional Di Indonesia. *Jurnal Kertha Wicara*, *12*(11), 575–583.

Rahmi, J. (2007). *HKI. Penyalahgunaan Hak Ekslusif*. Airlangga University Press.

Rideau, C. (2011). *POSITION MARK-A category of signs eligible for trade mark protection? Different*

*standards of examination, different scope of protection?, 2009/2010, s. 5 f*.

Setyawan, A., Sulistianingsih, D., & Yudistira, I. B. (2017). Non-Traditional Trademarks in Indonesia: Protection under the Laws and Regulations (An Intellectual Property Law). *Journal of Indonesian Legal Studies*, *2*(2), 123–130.

Suparmin, A. (2018). Asuransi Syariah Di Indonesia Hukum Prospek Dan Tantangan. *El-Arbah: Jurnal Ekonomi, Bisnis Dan Perbankan Syariah*, *1*(01), 1–30.

Tarigan, A. N., & Raja, P. L. (2022). Influence of Celebrity Endorser and Brand Image on Purchase Decision of Erigo Products: (Study on Erigo consumers in Medan City). *Journal Of Management, Accounting, General Finance And International Economic Issues (MARGINAL)*, *2*(1), 282–298. https://doi.org/10.55047/marginal.v2i1.415

Tritanaya, N. I., & Yulianingsih, W. (2022). Perbandingan Perlindungan Hukum Merek antara Prinsip First to File Hukum Indonesia dan Prinsip First to Use pada Hukum Australia. *Yustisia Tirtayasa: Jurnal Tugas Akhir*, *2*(3), 229–243.

Zainnullah, A. (2022). *Perlindungan Hukum pada Merek Asing dan Terkenal (Wellknown Mark) atas Passing Off di Platform Marketplace Indonesia*. UIN Kiai Haji Achmad Siddiq Jember.