

## PIERRE CARDIN TRADEMARK DISPUTE

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### ABSTRACT

Trademark is a mark of commodity or service origin indentification which related with its producers. Trademark function is not only to differ a commodity with another commodity, but it has function as priceless company asset, especially for well-known mark. A trademark which became famous will make that trademark becomes valuable assets or properties of the company, but in the other side, the fame will lure other producers to run unfair business to commit "piracy" or imitate it. One of it happens on trademark dispute on case decision No.1 557K/Pdt.Sus-HKI/2015. This research research is to know protection toward well-known mark and PIERRE CARDIN LOGO are reviewed by normative inststrument which is Law No. 15, 2001 and TRIPs Agreement along with juridical concequence of Supreme Court Decision No.1 557K/Pdt.Sus-HKI/205 toward well-known mark in Indonesia. The method used in this research is normative research with law and conceptual approaches. This research uses primary law material and secondary law material, then the law materials are analyzed qualitatively and served respectively. Research shows that: 1) Determination of court decision by the council of judges was according to valid law which is Law No. 15, 2011 regarding trademark but TRIPS Agreement aspect is not noticed entirely, justice and prosperity aspects which must consider economy and morale loss impacts by the user or owner of that well-known mark; 2) Juridical Consequence from decision No.557K/Pdt.Sus-hki/2015 is well-known marks which are enter to Indonesia must follow indonesia national law, even though sutantively it was registered in several countries and obtained fame globally.

**Keywords:** HKI, Well-known mark, Pierre Cardin.

### ABSTRAK

Merek merupakan tanda pengenalan asal barang atau jasa yang bersangkutan dengan produsennya. Fungsi merek tidak hanya sekedar untuk membedakan suatu produk dengan produk yang lain, melainkan juga berfungsi sebagai asset perusahaan yang tidak ternilai harganya, khususnya untuk merek-merek yang berpredikat terkenal (well-known mark). Suatu merek yang telah menjadi terkenal tentu akan menjadikan merek tersebut sebagai aset atau kekayaan perusahaan yang penting nilainya, tetapi di lain pihak, keterkenalan tersebut akan memancing produsen lain yang menjalankan perilaku bisnis curang untuk "membajak" atau menirunya. Salah satunya terjadi pada sengketa merek kasus putusan Nomor 557K/Pdt.Sus-HKI/2015. Tujuan Penelitian ini adalah untuk mengetahui perlindungan terhadap merek terkenal merek dagang dan LOGO PIERRE CARDIN ditinjau dari perangkat normatif yaitu Undang-undang Nomor 15 tahun 2001 dan TRIPs Agreement serta konsekuensi yuridis Putusan Mahkamah Agung Nomor 557K/Pdt.Sus-HKI/205 terhadap merek terkenal di Indonesia. Metode yang

digunakan dalam penelitian ini adalah penelitian normatif dengan pendekatan peraturan perundang-undangan dan konseptual. Penelitian ini menggunakan bahan hukum primer dan bahan hukum sekunder. Kemudian bahan hukum tersebut dianalisis secara kualitatif dan disajikan secara preskripsi. Hasil penelitian menunjukkan bahwa: 1) Penetapan putusan pengadilan oleh majelis hakim telah sesuai dengan perundang-undangan yang berlaku yaitu UU Merek No.15 Tahun 2001 tetapi aspek TRIPS Agreement tapi belum diperhatikan seutuhnya, aspek keadilan dan kesejahteraan yang seharusnya mempertimbangan dampak ekonomi dan moril kerugian oleh pemakai atau pemilik nama terkenal tersebut.; 2) Konsekuensi yuridis dari putusan No.557K/Pdt.Sus-hki/2015 adalah merek terkenal yang masuk ke Indonesia haruslah mengikuti dengan peraturan perundang-undangan nasional Indonesia, meskipun secara substantif telah terdaftar di beberapa negara dan mendapatkan keterkenalan merek secara global.

**Keywords:** HKI, Merek Terkenal, Pierre Cardin.

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## INTRODUCTION

In several developed countries, business law is served for the future to anticipate process and behavioral economica as law guide to prevent deviation or fraud occurred. While phenomenon which occurs in developing country , law in economy or trading cannot accomodate activity and economy process yet<sup>1</sup>. It is started by the inception of Law No. 21, 1961 which is amended to Law No. 19, 1992, it is reamanded to Law No. 15, 2001 which is the perfection of TRIPs Agreement and International Agreements and Trademark Office experience Ministry of Law and Human Right (Indonesia) and Director General of Intellectual Property)<sup>2</sup>. Indonesia always do perfection toward its national law to fulfill domestic regulation need especially in economy sector. Law which becomes attention is regarding to trademark.

Law No. 20, 2016 in more detail explains about trademark.<sup>3</sup> Trademark function is not only to differ a commodity with another commodity, but it also has function as priceless company asset, especially for well-known mark<sup>4</sup>. Priority level of a trademark or brand is producers, traders and consumers are different. From the producers side, trademark is used as value guarantee of their commodityion result, trademark is used to promote theirs commodity to search and expand their market, from consumers

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<sup>1</sup> Erma Wahyuni dkk, *Kebijakan Dan Manajemen Hukum Merek* (Yogyakarta: Yayasan Pembaruan Administrasi Publik Indonesia (YPAPI),2011) hlm. 1.

<sup>2</sup> *Ibid* hlm. 2.

<sup>3</sup> In Article 1 section 1 is explained that Mark means any sign capable of being represented graphically in the form of drawings, logos, names, words, letters, numerals, colors arrangement, in 2 (two) and/or 3 (three) dimensional shape, sounds, holograms, or combination of 2 (two) or more of those elements to distinguish goods and/or services produced by a person or legal entity in trading goods and/or services

<sup>4</sup> OK Saidin, 2004, *Aspek Hukum Hak Kekayaan Intelektual "Intellectual Property Right"*, Raja Grafindo Persada, Jakarta, hlm. 359.

side, trademark is required to do decide commodity choice which will be bought<sup>5</sup>. On certain time, sometime trademark user for consumers can cause certain image.

To make a trademark to be well-known mark which can show quality or reputation guarantee of a commodity is not easy and it requires long enough time and expensive cost. Especially if a commodity was famous will make that trademark will be valuable company assets or properties, but in the other side, fame will lure other producer to run unfair business to commit “piracy” or imitate<sup>6</sup>.

Law protection will be given to local or foreign, famous or unfamous not only to registered trademark. The law protection can be protection which is preventive or repressive. Preventive law protection is applied through trademark registration, whereas repressive law protection is applied if trademark violation occurred through civil law or criminal law accusation.<sup>7</sup>

National law regulation managed regarding law protection toward the given of exclusive right<sup>8</sup>. Exclusive law given which is given by country to registered trademark in general trademark list on certain time period by using those trademarks or giving permission to another party to use it. Then Law of Trademark adds, that registered trademark obtain law protection for 10 years and it starts to valid since its acceptance date of trademark or trademark registration<sup>9</sup>. In fact there is no obligation for somebody to register or not to register their trademark, but trademark which is registered will obtain law protection<sup>10</sup>.

Counterfeiting which is done is not only harm the well-known mark owners and consumers, but it will spread to harm society because the existence of counterfeiting can kill human creation capacity to create a new creation. Violation motive development toward trademark refers to well-known mark not only for identical or similar goods, but it spreads to famous counterfeiting for service trademarks and for good trademarks which but, it also spreads goods or service which are not similar<sup>11</sup>.

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<sup>5</sup> Dianggoro dan Wiratmo, 1997, *Pembaharuan UU Merek dan Dampaknya bagi Dunia Bisnis*, Jurnal Hukum Bisnis, Vol.2, Yayasan Pengembangan Hukum Bisnis, Jakarta.

<sup>6</sup> Maulana dan Insan Budi, 1997, *Sukses Bisnis Melalui Merek, Paten dan Hak Cipta*, Aditya Bakti, Bandung, Hlm 53.

<sup>7</sup> Erma Wahyuni, dkk., *Op.cit.* Hlm 4

<sup>8</sup> Lih, pasal 3 UU 15/2001

<sup>9</sup> Lih, pasal 21 UU 15/2001

<sup>10</sup> Erma Wahyuni, dkk., *Op. Cit.*


<sup>11</sup> The usage of “identical or similar” in provision in Paris Convention or TRIPs Agreement literally can be meant as identical or similar. However to adapt with term which is used in national law provision, which is in Law No. 15, 2001, “identical or similar” can be interpreted as “similar”.

International law loads law protection coverage toward well-known mark which is ratified by Indonesia.<sup>12</sup>

Indonesia which ratified Agreement Establishing the World Trade Organization related to all provision in TRIPs Agreement through President Regulation No. 15, 1997 as national provision which arranges trademark gave law protection toward well-known mark. Therefore, related with law protection expansion toward well-known mark, Indonesia must do its international obligation to protect well-known mark as law protection standard which is given on Article 16, Section (2) and (3) TRIPs Agreement.

One of trademark dispute case based on decision No. 557K/Pdt.Sus-HKI/2015<sup>13</sup> One of trademark dispute case based on decision No. 557K/Pdt.Sus-HKI/2015 in Indonesia which is decided by the commercial court regarding well-known mark dispute which is owned by a France designer, Pierre Cardin. Pierre Cardin lives in di 59, rue du Fauborg Saint Honore, F-75008, Paris, France. Pierre Cardin as the accused claimant I against Alexander Sartyo Wibowo as appeal requested I accused I and Republic of Indonesia Government c.q Director General of Intellectual Property c.q Director of Trademark, as appeal II accused II.

Claimant appealed toward Defendant I and II in front of Court Hearing of Commercial Court on District Court of Central Jakarta with several main arguments which is given to them. Claimant claims that he is a legal Exclusive Right on well-known mark with PIERRE CARDIN

( PIERRE CARDIN  Trademark”) and (“PIERRE CARDIN LOGO”), Which starts to be used from the early of March in 1974 to protect several type of commodity in class of 3, 5, 6, 8, 9, 10, 11, 14, 16, 17, 18, 20, 21, 24, 25, 33:.. For commodity type in class 3 are;” Cosmetic and Parfume.

PIERRE CARDIN TRADEMARK AND PIERRE CARDIN LOGO are registered, traded, and promoted in big and continuously in several countries in the whole world by the Claimant directly or through company owned by SARL de Gestion Pierre Cardin, as the

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<sup>12</sup> Dalam *TRIPs Agreement* Pasal 16 Ayat (2): “Article 6 bis of the Paris Convention (1967) shall apply, mutatis mutandis, to service. In determining whether a trademark is well known, members shall take account of the knowledge of the trademark in relevant sector of the public, including knowledge in the member concerned which has been obtained as a result the promotion of the trademark.” Pasal 16 Ayat (3): “Article 6 bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or service which are not similar to those in respect of which a trademark in relation to those goods or service would indicate a connection between those goods or service and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.”

<sup>13</sup> Putusan Nomor 557K/Pdt.Sus-HKI/2015 diakses melalui putusan.mahkamahagung.go.id pada tanggal 13 Maret 2017

result its rotation pass regional limits and borderless. It proves PIERRE CARDIN TRADEMARK AND PIERRE CARDIN LOGO as well-known mark are known by international society with high reputation.

In Indonesia itself, claimant registered trademark, brand, and logo to Director of Trademark – Director General of Intellectual Property on 11 November 2014. Defendant I who also owns Trademark to protect commodity type which is listed on Class 3, which are “All type of cosmetics”. Defendant I registered on Defendant II (Director of Trademark) on behalf of Defendant I who has similarity on its principle or all of it with which is owned by PIERRE CARDIN Claimant along with PIERRE CARDIN LOGO. It can be seen by logo and trade mark owned by Pierre Cardin and Alexander Satryo Wibowo as follows:



**Gambar 1 (Pierre Cardin Paris)**



**Gambar 2 (Pierre Cardin Indonesia)**

On decision No. 557K/Pdt.Sus-HKI/2015 Defendant is proved has bad faith by registering Trademark and LOGO of Class 3 unfair and dishonest and with intention to counterfeit or copy Trade Mark and LOGO PIERRE CARDIN which is owned by the designer Pierre Cardin which was famous since 1950. For business importance, Defendant I did passing off which harm the claimant or cause unfair, slack or misguide the consumers.

Generally trademark cannot be registered by the request which is appealed by the claimant who is passing off and can misguide the consumers (a likelihood of confusion). A trademark similar to concept on one of doctrine which mentions “a likelihood of confusion”. The most important factor that trademark usage has “a same principle” that causes a like hood confusion<sup>14</sup>. Based on explanation above, then law issue that the authors chose is decision No. 557K/Pdt.Sus-HKI/2015 was according to Law No. 15, 2001 regarding Trademark and TRIPs Agreement and how is juridical consequence of Supreme Court Decision No 557K/Pdt.Sus-HKI/2015 toward the well-known mark in Indonesia.

## **DISCUSSION**

### **Review of Decision No. 557K/Pdt.Sus-HKI/2015 toward Law No. 15, 2001 about Trademark and TRIPs Agreement**

Explanation of trademark is arranged in Article 1 No. 1 regarding Trademark, which mentioned that trademarks in form of picture, name, word, letters, numbers, color

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<sup>14</sup> Rahmi Jened, 2015, *Hukum Merek Trademark Law Dalam Era Global dan Integrasi Ekonomi*, Jakarta Kencana, hlm 183.

pattern or combination from those elements which have differentiator and are used in trading or service activity. Trademark as Intellectual Property basically is a mark to identify commodity and service origin from a company with commodity and/or service from another company. Trademark is the spearhead of commodity and service. Through trademark, entrepreneur can keep and give a guarantee of commodity and/or service qualities which are produced and to prevent unfair competition from other passing off company to raise their reputation. Trademark as a marketing and advertising device to give certain information level to consumers regarding commodity and/or service which are produced by the entrepreneurs<sup>15</sup>. Trademark which is supported by the advertisement media make entrepreneurs have ability to stimulate consumers request and keep the customer's loyalty) on commodity and/or service which are produced by them. It makes trademark as a competitive advantage and ownership advantages to compete in global market<sup>16</sup>. Trademark holds important role in trading. Trademark functions are divided into 3, as follows<sup>17</sup>, Mark to differ distinctive function, quality commodity function; and function as promotion and impression function. Well-known mark explanation nowadays does not have permanent definition, because until now it still debateable about well-known mark related with its definition and criteria. A trademark which becomes well-known mark has interesting and impressive attractiveness then it is created the fame of that trademark. Furthermore with advertisement development, national or international nowadays and in order to distribute commodity and/or service to make trademark value is has higher value.

In Indonesia, registered trademark owner has exclusive right to use their trademark and give permission to another party to use their trademark<sup>18</sup>. Based on TRIPS Agreement is affirmed that registered trademark owner has exclusive right to prevent third party who does not have the owner permission, to use it on trading activity, signs which have similarity, for the same commodity or service or similar with commodity or service on registered trademark, where it must be predicted before that is usage can cause a likelihood of confusion<sup>19</sup>. If a trademark is agreed to be registered, then registered trademark owner has exclusive right to use that registered trademark. There are two systems which are believed in trademark registration which are declarative system and constitutive system (attributive). Trademark law in its

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<sup>15</sup> Rahmi Jened, 2007, *Hak Kekayaan Intelektual Penyalahgunaan Hak Eksklusif*, Airlangga University Press, Surabaya, hlm.160-161.

<sup>16</sup> Rahmi Jened, 1998, *Implikasi Persetujuan TRIPs Terhadap Perlindungan Merek di Indonesia*, Yuridika, Hlm. 8-13.

<sup>17</sup> Suyud Margono, 2016, *Hak Milik Industri, Pengaturan dan Praktik di Indonesia*, Ghalia Indonesia, Bogor, hlm. 27

<sup>18</sup> Rahmi Jened, *Op.Cit.*, hlm 193.

<sup>19</sup> *Ibid.*

registration believes constitutive system. Trademark registration is to give status that registrant is considered as the first user until another party did it vice versa. It is different with declarative system, on new constitutive system will make right if it is registered by the holder. Registration is an obligation.

In this law also arrange about priority law, as follows that the claimant right to appeal the petition which comes from the countries which are corporated in Paris Convention for the Protection of Industrial Property atau Agreement Estabilishing the World Trade Organization to obtaind acknowledgement that priority date in destination country which is one of both agreements while its submission in certain time which is considered based on Paris Convention for the Protection of Industrial Property<sup>20</sup>. In Indonesia trademark registration with Priority Right is arranged in Article 11 and 12 of Law of Trademark.

Petition by using priority right must be appealed the lates six months counted since petition acceptance of the first trademark registered in another country, which is a member of Paris Convention for the Protection of Industrial Property atau anggota Agreement Estabilishing the world the world Trade Organization<sup>21</sup>.

In Paris convention, priority right is arranged in Article 4 Paris convention, every person which appeals claimant or trademark usage in one of member country of convention member or their heir will obtain priority right in petition appeal on another country member during period of tie which will be considered later. Priority is a form of National Treatment and Most Favoured Nation principles which is arranged in TRIPs agreement that based on Paris and GATT Conventions<sup>22</sup>. Priority right must be acknowledged on every registration nationally based on valid law in each country of Paris Convetion or after bilateral agreement. With national registration then trademark registration in country will be considered<sup>23</sup>.

In PIERRE CARDIN trademark dispute, claimant names Pierre Cardin is a designer from France defendant Alexander Sartyo Wibowo as defendant I and Director General of Intellectual Property c.q Director of Trademark as Defendant II. Basic element defendant the defendant I and defendant II because the registration of PIERRE CARDING trademark by defendant I is considered have “bad faith” to raise Pierre Cardin fame, then it should be not registered by the Director of Trademark or rejected, if it is review from Article 4, Article 5 section a, and Article 6 Paragraph 1 and 3 Law of Trademark No. 15 , 2001. The amandement which is considered by the Law of

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<sup>20</sup> Ahmadi Miru, 2005, *Hukum Merek: Cara Mudah Mempelajari Undang-undang Merek*, PT.Rajagrafindo persada: Jakarta, hlm.46.

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

<sup>22</sup> Rahmi Jened, *Op.Cit.*, hlm.162.

<sup>23</sup> *Ibid*,hlm.163.

Trademark No. 20, 2016 for petitioner to have bad faith then it must be rejected according to Article 21 Paragraph 3, there are differences between non-amendment Law of Trademark emphasizes it cannot be registered whereas amendment Law of Trademark emphasizes it must be rejected. Claimant has good faith is a claimant who registers their trademark properly and honestly without intention to imitate or copy another party's trademark fame for their business that causes impact on another party and causes unfair competition, deceive or misguide the consumers.<sup>24</sup>

Therefore, law juridical based on Republic of Indonesia Supreme Court decision No.150K/Pdt/1984 states that toward the registrant/user of the same trademark, on letter or words with another trademark is classified as bad faith registrant<sup>25</sup>. Based on the Claimant who mentions that defendant I registered Trademark and Logo with PIERRE CARDIN name and same with the claimant name (Pierre Cardin) toward defendant II (Director of Trademark) which has similarity on its principle or entirely, then it is clear the defendant has bad faith as it mentions on Article 4 and Article 6 regarding Law of Trademark. Considering that<sup>26</sup>

PIERRE CARDIN and PIERRE CARDIN Logo is not ordinary words but logo which are used in Indonesian conversation, then it is irrational if Defendant I which is Indonesian registered the trademark with PIERRE CARDIN and PIERRE CARDIN Logo on behalf of Defendant, it has the similarity on its principle or entirely with trademark and PIERRE CARDIN Logo and there are similarities on arrangement and letter character/syllable and pronunciation along with logo on trademark with words PIERRE CARDIN on behalf of claimant, it has the similarity principle or entirely with trademark who is owned by the Claimant which is well-known mark and registered in several countries all over the world, which mostly also part of well-known claimant name.<sup>27</sup>

Article 4,5, 6 Law of Trademark determined that trademark cannot be registered with bad faith, trademark is also cannot be registered if that trademark has one of element which againsts valid law, religion morality, morality or law and order, and is an explanation or related with commodity or service which is appealed by the registrant. Trademark appeal must be rejected if that trademark has similarity on its principle or

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<sup>24</sup> Ahmadi Miru, Op. Cit, hlm.15.

<sup>25</sup> Casavera, 2009, *8 Kasus sengketa merek di Indonesia*, Graha Ilmu: Yogyakarta, hlm.94.

<sup>26</sup> Decision No. 557K/Pdt.Sus-HKI/2015 page 6-7 was accessed via [putusan.mahkamahagung.go.id](http://putusan.mahkamahagung.go.id) on 13 March 2017.

<sup>27</sup> PIERRE CARDIN Trademark with Registration No. IDM000223196 Class 03, PIERRE CARDIN TRADEMARK and Logo Registration No. IDM0000234122 Class. 03, PIERRE CARDIN Trademark and Logo "P" with Registration No. IDM000028783 Class 03 on behalf of defendant used Claimant name element (Pierre Cardin), whereas there were no licence or agreement from the claimant to its usage.



entirely with another party's trademark which is registered first for the same type of commodity or service, it has similarity on its principle or entirely with

Claimant (Pierre Cardin) is a designer and his name is very famous in several countries which are more than 50 countries. It fame started since 1950, as designer with his futuristic model on woman's clothes. Beside woman's clothes model which is created by the Claimant developed to furniture design, interior design, jewelry and including perfume which was launched for the first time in 1972 with trademark (Pierre Cardin Por Meonsieur". Claimant contribution which was nicknamed as Master of Invention for six decades and claimant was also person who introduce retail and licence strategies on world model, then he is awarded with Superstar Award by Fashion Group International (FGI). Claimant also consider the Claimant has exclusive right on trademrk and PIERRE CARDIN Logo which starts to be used since March 1974 to protect several classs which are: 3,5,6,8,9,10,11,14,16,17,18,20,21,24,25, dan 33. In Indonesia, Trademark and PIERRE CARDIN LOGO are registered on Director General of Intellectual Property in several classes which are: 3,9,10,12,16,18,20,21,23,24,25,30,32,33 dan 34 and for commodity type in class 3.

PIERRE CARDIN Trademark and Logo on behalf of Claimant were registered and still on registration appealing process on Director of Trademark, Director General of Intellectual Property, which is : PIERRE CARDIN Trademark class 3 is under Registration No. IDM000192198 which is lengthen with No. R002008005130 on 6 February 2009, Registration Appealing of PIERRE CARDIN TRADEMARK on Agenda No. D00.2014.051659 class 3 on 11 November 2014, Registration Appealing of PIERRE CARDIN Logo on Agenda No. D00.2014.051658 class 3 on 11 November 2014. Registration evidence of PIERRE CARDIN Trademark is symbol in front of society who recognize the original product from the Claimant with good quality. Registration appealing of PIERRE CARDIN Trademark and Logo are not general world used in Indonesian conversation, then it is irrational if Defendant I who is Indonesian register PIERRE CARDIN Trademark and Logo as his product. Defendant I commit passing off to raise his fame which cause harm to Claimant party because of unfair competiton, slack and misguide the consumers. It is explained on Republic of Indonesia Supreme Court No. 220PK/Pdt/1986 on 16 December 1986 that clearly explain : "Indonesian must emphasize the need of trademark usage which shows national identity and not to use foreign trademark, furthermore not to imitate well-known foreign trademarks"

There is exception which is appealed by the Defendant I and Defendant II are:

Defendant I exception is the petition of Claimant was outdate because claimant appeal the petition which is registered on case register on 4 March 2015, with petition object was trademark nullification. It based on provision Article 69 Paragraph (1) Law of

Trademark consider : “petition nullification of trademark registration only can be appealed in 5 (five) years after the trademark registration”. Therefore the intention Law of Trademark should give legal certainty for the registration of their product in general list of trademark. That defendant I trademarks which are Trademark and Logo are the legitimate owned by Wenas Widjaja based on provision of Republic of Indonesia Supreme Court Decision Registration No. 120180 on 29 July 1977 by the decision of District Court of Central Jakarta, then it was lengthened with Registration No. 199049 on 24 October 1985 then it was lengthened again with with Registration No. 367691 on 24 October 1995. There were right’s transision toward Raimin on 24 October 1985 registrered in general list with No. 199049, which later there were right’s transference to Eddy Tan and recorded on 18 May 1987, it was recorded the right’s transference from Eddy Tan to Alexander Sartyo Wibowo as exclusive right holder of PIERRE CARDIN Trademark and Logo. Defendant validated there were range of 30 (thirty) years for Defendant I trademark registration mentioned by registration number along with its right’s transference on PIERRE CARDIN Trademark and Logo. Trademarks which was registered considered fulfill the qualification and did not violate law and order considering there were no element of Defendant I who violate law and order. The limitation of time can affect Republic of Indonesia Government credibility c.q Republic of Indonesia Ministry of Law and Human Rights c.q Director General of Intellectual Property c.q Director of Trademark. It is according to Article 3 jo. Article 28 Law or Trademark, which determine on Article 3 “Trademark’s right is exclusively give by the country to registered trademark owner for certain period of time by using that trademark for themselves or giving permission to other party to use it”, furthermore Article 28 considers “Registered trademark get protection for 10 (ten) years since acceptance date and protection time period can be lengthened”. Beside the outdate time period, Defendant I stated that their product had differentiator which always attach PT. Gudang Rejeki, therefore if it was analyzed there was element which allowed the registration to be done according to Article 5 of Law of Trademark and Amandement Law of Trademark on Article 20 section e.

Defendant II exception of Ministry of Law and Human Rights c.q Director General of Intellectual Property c.q Director of Trademark mentioned that Claimant’s petition was outdate/expired, it because the claimant appealed the petition on 4 March 2015, whereas petition object of Claimant was registered trademark nulification of Defendant 1 which are: PIERRE CARDIN Trademark with Registration No. IDM000223196 on 20 October 2009 filling dtae 28 April 2010 with the first trademark registration on 18 February 2004 to protect class 3 commodities, that the provision and purpose given to time limitation as arranged in provision of Article 69 Paragraph (1) of Law No. 15, 2001 regarding Trademark to give legal certainty on the trademark registration can affect toward Director General of Intellectual Property.

From validation of the Claimant to accuse Defendant I and II along with Defendant's Exception I and Defendant II above then author evaluated that element which was validated by the Claimant as the appeal who had bad faith to Defendant I is a bad faith because PIERRE CARDIN Trademark and Logo which owned by a famous designer from France which his name known in more than 50 countries and it imitates the principle or entirely with which was owned by Defendant which was appealed its registration to Defendant II with legal ownership proof of evidences for Claimant with PIERRE CARDIN trademark which was registered by Defendant I, even it was based on Defendant II (Director of Trademark) was extravagant because to evaluate a well-known mark then there were other indicators. One of the Supreme Judge has dissenting opinion on council of judge discussion. Judge implied (bad faith) by the Defendant I was proper, it was true that it was bad faith. Judge consider, that appeal claimant, Claimant can be justified, because of several proof of evidences:

- a. It is true the original name of Claimant is "PIERRE CARDIN"
- b. That is true the original name which is used as trademark and logo of claimant is "PIERRE CARDIN", which already famous and registered in many countries
- c. That is general knowledge that "PIERRE CARDIN" trademark is trademark which is known and well-known in many countries.

Considering, that trademark of a product is not only a name or words, but further it contains meaning and intention which related directly with related product, beside that trademark or written name on a product also can be characteristic or origins differentiator from which region or from which country, also product's trademark and logo is the original name of Claimant which was proved with legal proof of evidences in front of court and also supported by Pierre Cardin which is not from Indonesian, but foreign language or writting. Republic of Indonesia Supreme Court Decison No. 220 PK/Pdt/1986 on 16 Desember 1986 clearly mentioned: "Indonesian must emphasize the need of trademark usage which shows national identity and not to use foreign trademark, furthermore not to imitate well-known foreign trademarks"<sup>28</sup>. It is according to Indonesia Government ambition with the amandement of Law of Trademark No. 20, 2016 about Trademark and Geographical Indication, it is added geographical indication on law's title then it is expected can guarantee the suffice of local and national enocomy potention.

Author thinks Exception of Defendant I and Defendant II should be analyzed where the author observe that, expire which is inteded to the Defendant can be accepted

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<sup>28</sup> Supreme Court Decision of Republic of Indonesia No. 220 PK/Pdt/1986 Putusan menyebutkan: "Indonesia must emphasize the need of mark usage to show national identity and not using foreign marks, moreover imitate foreign well-known marks".

after pass 5 years from the proper provision according to Law of Trademark No. 15, 2001 which can be applied on Supreme Court Decision No. 557K/Pdt.Sus-HKI/2015. Consistency and Credibility of Director of Trademark based on Author opinion should be improved start from society service to keep credibility while the inspect administratively and substantively to all exist trademark appeal, and it is according to valid law in Indonesia such as Pierre Cardin case determination, and it is required to be remember that Indonesia becomes TRIPS Agreement means Indonesia must adjust trademark regulation of Intellectual Right especially (trademark) on section 2 TRIPS which consist on 7 articles to realize international trading system which are open, fair and order along with free from obstacle or restriction which nowadays are considered do not give profit on international trading development. Author evaluates that Defendant II just keep reputation, without seeing objectively of an appeal which is appealed by the claimant if it can give wider impact or not or it can kill creativity along with economy and morale loss to user or the first owner which is originated from another country.

Explanation regarding Law No. 7, 1994 about Legalization of Agreement Establishing The World Trade Organization explains that Trade Related Aspects of Intellectual Property Rights including Trade in Counterfeit Goods/TRIPs. Convention in this sector aims<sup>29</sup> to improve protection toward Intellectual Property implementation prochedure which does not obstacle trading activity, to formulate regulation and discipline, regulation and international cooperation mechanism to handle commodities trading counterfeit or piracy for Intellectual Property

### **Juridical Consequences of Supreme Court Decision No. 557K/Pdt.Sus-HKI/2015 toward well-known mark in Indonesia**

Juridical Consequences of Council of Judge who decide that case by rejecting the appeal and nullification of PIERRE CARDIN Trademark which is appealed by the Claimant for the second time after the appeal of petition nullification that Defendant I is user and first registrant in Indonesia fro PIERRE CARDIN Trademark which was registered on 29 July 1997, that on its registration that trademark was not registered and known, basically that registration could be accepted. Defendant I also registered PIERRE CARDIN by always attach the differentiator with claimant's trademark, by attaching PT. Gudang Rejeki and additonal Indonesia worlds as differentiators. Council of Judge thinks it did not improve the fame of other trademark. Therefore that trademark registration was according to Law of Trademark, and the trademark registration cannot be qualified as bad faith, even thogh the opinion differences by one of Supreme Judge for this decision.

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<sup>29</sup> Law No. 7, 1994 regarding the Legalization *Agreement Estabilishing The World Trade Organization*

Based on decision, author thinks juridical consequences which has potency to whoever easily can improve foreign trademark fame which is very clear has similarity on its entirely or principle and can misguide Indonesian consumer, even though foreign trademark (PIERRE CARDIN) which is on Supreme Court decision states its trademark was not known on the first registered by the Defendant I according to law regulation which consider first to file. Author thinks the Council of Judge which later placed to handle trademark dispute case can give objective consideration while handling trademark dispute without ignoring justice aspect. Proof that the fame of Claimant (Pierre Cardin) was clear with many countries which becomes that product user, and was proved in front of court with several evidences.

### **CONCLUSION**

Judge in deciding Pierre Cardin trademark dispute consistently by applying valid law in Indonesia which is Law of Trademark No. 15, 2001. It shows that judicial institution was consistent and has impact to protect Indonesia from trademark dispute on the other day, but TRIPS Agreement becomes basic and reference for Law of Trademark invention in Indonesia should be noticed, because that decision consequences has effect toward economy and trading activity in transitional which has potency to be appealed the obliteration or nullification on registered trademark. Judge decides by put Article 16 Paragraph 2 and Paragraph 3 of TRIPS Agreement aside, Article 6 Convention of Paris, which should consider trademark knowledge in public sector if that sector was famous or not, because it gives a likelihood of confusion to society to differ Pierre Cardin trademark.

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Surat Keputusan Menteri Hukum dan Perundang-undangan tersebut didasari pula dengan Keputusan Presiden Republik Indonesia Nomor 144 Tahun 1998 tanggal 15 September 1998, tentang perubahan nama Direktorat Jenderal Hak Cipta, Paten,

dan Merek berubah menjadi Direktorat Jenderal Hak Atas Kekayaan Intelektual (Ditjen HKI) Kemudian berdasar Keputusan Presiden Nomor 177 Tahun 2000 Ditjen HKI berubah menjadi Ditjen HKI.