

**TRADEMARK PROTECTION GUIDE IN INDONESIA  
UNDER THE AMENDED TRADEMARK LAW**

---

This article sets out below the implications and changes of the Amended Indonesian Trademark law.

**(1) Non-Traditional Marks**

Non-traditional marks such as 3D marks, holograms and sound marks can now be registered at the Directorate General of Intellectual Property in Indonesia.

**(2) Unregistrable Marks**

A mark shall not be registered if it:

- contradicts with the prevailing rules and regulations, morality, religion, or public order;
- constitutes information or related to the goods or services for which registration is requested;
- contains elements of information which may mislead the public regarding the origin, quality, type, size, purpose of use of goods and/or services for which registration is requested or is a type of a protected plant variety for the same goods/services;
- contains inaccurate information related to the quality, benefits or effects of the goods and/or services produced;
- has no distinguishing features; and/or
- has become a public property and/or a public symbol.

**(3) Electronic Filing**

The Directorate General of Intellectual Property of Indonesia will start using a fully functional electronic filing system in 2017.

**(4) Madrid Protocol**

Albeit inclusion of a provision of Madrid Protocol was considered, it is uncertain as to when it would be brought into effect.

**(5) Earlier Publication Stage**

Moving forward, a shorter time frame of a 30 day period at the Publication stage will be implemented. The public will have access of information of a trademark application within 30 days from the date of filing.

Furthermore, the Publication Stage will now come before the Substantive Examination Stage. This approach will ease the examiners' workload during the Substantive Examination Stage by relying on the oppositions (if any) during the Publication Stage.

**(6) Shorter Substantive Examination Stage**

The Substantive Examination stage would take between 6 to 12 months. The revised scheme will hopefully clear up the ever-increasing backlogs at the Directorate General of Intellectual Property of Indonesia.

**(7) Overhauled Renewal Scheme**

Under the previous practice, a registered trademark may be renewed 12 months before its expiration date and there was also no "grace period mechanism". With the Amendments, a trademark holder may renew its trademark 6 months after the expiry date with a penalty fee. However, the trademark holder may only start filing the renewal for the registered trademark 6 months before the expiry date – unlike 12 months under the previous practice.

**(8) Recordal of Change of Name and Address**

Recordal of change of name &/or address are now permitted even though a trademark application is still pending, unlike before where any kind of recordal can only be done once a trademark application has matured to registration.

**(9) Trademark Cancellation and Invalidation**

The Amendments have not significantly modified the provisions regarding the trademark cancellation and invalidation. A trademark may be cancelled by any third party with interests at the Court of Commerce if the trademark has not been used 3 years in a row from the date of registration or the date of last use.

Furthermore, a registered trademark may be invalidated at the request of any third party at the Court of Commerce if it:

- Contradicts with the prevailing rules and regulations, morality, religion, or public order;
- Constitutes information or related to the goods or services for which registration is requested;
- Contains elements of information which may mislead the public regarding the origin, quality, type, size, purpose of use of goods and/or services for which registration is requested or is a type of a protected plant variety for the same goods/services;
- Contains inaccurate information related to the quality, benefits or effects of the goods and/or services produced;
- Has no distinguishing features; and/or
- Has become a public property and/or a public symbol.

A registered Mark may also be invalidated if it has a similarity in its essential element or in its entirety with:

- a registered mark owned by another party which has previously been registered for the same kind of goods and/or services;
- a well-known mark owned by another party for the same kind of goods and/or services; and
- a registered Geographical Indication.

Kindly note that any invalidation suit can only be done within 5 years from the date of registration, unless the substance of the invalidation suit relates to bad-faith and/or contradicts with the prevailing rules and regulations, morality, religion, or public order.

#### **(10) Increased Official Fees**

The official fees for trademark filing and renewal have increased. If you would like a copy of our 2017 Indonesian Trademark Fee Schedule, please do not hesitate to contact us at mail@ipconsultants.asia.

#### **(11) Provisional Injunction to Stop the Importation of Counterfeit Goods in Indonesia**

The Amendments have set out the requirements of the temporary injunction action. The injunction action shall be requested in writing to the Court of Commerce at the location of the delict was committed (locus delicti) by providing the following:

- trademark registration certificates;
- evidence of early indications that there has been a patent infringement;
- clear explanation regarding the goods/or documents requested, sought for, collected, and secured for the purpose of verification; and
- provide collateral in cash and/or bank guarantee equivalent to the goods which will be subject to temporary injunction action.

If the above requirements are met, the registrar of the Court of Commerce shall record the request and shall give the request to the Chief of the Court of Commerce no later than 24 hours. Then, the Court of Commerce shall appoint a judge responsible for this case within 2 days and the appointed judge shall decide whether or not to grant the request for temporary injunction action within 2 days.

If the judge grants the request for temporary injunction action, the judge will decide no later than 30 days from date of the Letter of Temporary Injunction whether to uphold or cancel the temporary injunction.

Although the amendments have added new provisions regarding temporary injunction action, we still believe that in practice it is very challenging and is not very effective in deterring patent infringements.

## **(12) A New Criminal Provision and Tougher Fines**

Any person who deliberately and without rights uses a mark which is similar in its entirety or is similar in the basic element with a registered mark of another party for the same kind of goods, where such goods pose health and environment dangers, and/or may result in human mortality, shall be punished by an imprisonment of 7 (four) years and/or a maximum fine of IDR 2,000,000,000 (two billion Rupiah). The example of these goods are including but not limited to pharmaceutical products, food, electric equipment, automotive parts and machineries.

The Amendments also include tougher fines to deter the infringers from selling and distributing goods and providing services using a mark which is similar in its entirety or is similar in the basic element with a registered mark of another party for the same kind of goods.