

Analysis of Trademark Cancellation Due to Elements of Imitation

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Abstract

This study analyzed the regulations regarding the protection of foreign famous brands in Indonesia and the implementation of these regulations. This study used a normative legal research design by describing the reality and then compared it with applicable regulations or existing legal theories to answer the problem. The case analyzed in this study is the brand dispute between J Casanova and Irawan Gunawan as the owner of the Casanova brand. From the results of the study it was found that until now there has been no definite definition of famous brand in Indonesia. This is exacerbated by the weak legal structure in Indonesia, which causes the legal process regarding cases related to the brand to not be fulfilled with justice, usefulness and legal certainty. As in this case, there is confusion in determining what can cause a brand to be called a famous brand, and what kind of case is referred to as a famous brand impersonation. Law enforcers appear to be still weak in deciding whether the brand to be registered has an element of equality in principle with respect to famous brand that have been previously registered or not.

Keywords: Brand dispute, Famous brand, J Casanova

INTRODUCTION

Indonesia has explicitly declared itself a constitutional state (rechtsstaat). This is reflected in a variety of laws and regulations that serve as constitutional foundations, as well as in the implementation of legal principles in the governance of the state. The notion of a constitutional state in Indonesia is not merely formalistic but carries profound implications for the relationship between the government and the people, the protection of human rights, and the administration of governance based on law rather than arbitrary power.

In the Preamble to the 1945 Constitution of the Republic of Indonesia (UUD 1945), phrases such as “justice,” “social justice,” and “fairness” explicitly appear, demonstrating that justice is the ultimate aim of the law and the foundation for state administration. This statement is reinforced in the body of the Constitution, particularly Article 1 paragraph (3), which declares, “The State of Indonesia is a state based on law.”



Indonesia's strong philosophical, juridical, and sociological foundations affirm that the nation constitutionally adheres to the principles of a *rechstaat* (a state governed by law) while rejecting the concept of a *machtsstaat* (a state based on power). In practice, Indonesia fulfills the essential criteria of a constitutional state as articulated by various legal scholars, including the principles of legality, respect for human rights, and the existence of an independent and impartial judiciary. Other defining features include democratic governance, the supremacy of law, and proportional power distribution among state institutions.

This view is strengthened by the ideas of Philipus M. Hadjon, who emphasizes that Indonesia adopts a distinct model of constitutional state known as the Pancasila legal state. This model integrates local values and Indonesian cultural norms, emphasizing harmony between the government and its people, conflict resolution through deliberation, and a balance between rights and obligations. In the Pancasila legal state, law is not merely an instrument of power but a manifestation of the moral, social, and cultural values of the Indonesian nation.

The theoretical foundation of Indonesia's legal state also draws from classical legal philosophers such as Immanuel Kant and A.V. Dicey. Kant argued that a legal state must ensure the protection of human rights and maintain the separation of powers. A.V. Dicey, through his doctrine of the rule of law, emphasized the supremacy of law, equality before the law, and that individual rights are inherent and not granted by the state. These ideas provide a strong normative basis for Indonesia's constitutional framework.

Modern conceptions of the constitutional state are closely linked to the development of the welfare state. This evolution emerged in response to the limitations of classical liberal legal systems that focused solely on legal protection and the restriction of power. In a welfare state, law functions not only as a regulatory tool but also as a means for ensuring social justice and public welfare. Accordingly, Indonesia is not merely a rule of law state but also a social welfare state, actively playing a role in improving its citizens' quality of life.

The welfare state is characterized by the state's active role in providing basic services such as education, healthcare, and social security, as well as intervening in cases of social and economic inequality. In Indonesia, these principles are enshrined in the 1945 Constitution, especially Articles 33 and 34, which mandate state control over vital economic sectors and require the state to care for the poor and abandoned children. This shows that Indonesia's Constitution clearly directs the state to pursue the realization of social welfare for all its citizens.

The welfare state idea also underscores the importance of distributive justice, which becomes a core responsibility of the state. This concept developed as part of the shift from the "night-watchman" state which was passive in nature towards a more proactive government that attends to the public's needs. Government intervention in various societal sectors is viewed as necessary to ensure collective welfare and to prevent economic interests from overriding the social rights of the citizens.

Furthermore, in the context of modern legal theory, the state is not only endowed with



authority but also obligated to maintain a balance between citizens' rights and responsibilities. John Locke's theory of the social contract emphasizes that state power originates from the people through delegated authority. Consequently, the state bears a moral and legal obligation to be accountable and to administer governance for the public good—not merely for the interests of a select few.

Indonesia's constitutional development, especially after the Reform Era and the amendments to the 1945 Constitution, has further reinforced its status as both a constitutional state and a welfare state. These amendments enhanced the checks and balances among state institutions, expanded constitutional guarantees for citizens' rights, strengthened mechanisms for public participation, and clarified state responsibilities in delivering social welfare.

However, the practical implementation of the rule of law and the welfare state in Indonesia continues to face significant challenges. These include the lack of fully independent law enforcement, socioeconomic disparities, and widespread legal non-compliance. Therefore, an ongoing conceptual and normative understanding of the legal and welfare state remains crucial, especially in the practical dimensions of governance and public service.

By comprehending Indonesia as a legal state with a welfare-oriented character, we no longer view the law solely as an instrument of control. Instead, it is seen as a tool for development and social justice. This perspective is essential to ensure that the law serves as both a protector and guarantor of justice for all, as well as a driver of national progress in achieving the ideals of independence: a just and prosperous society based on Pancasila and the 1945 Constitution.

METHOD

This study employs a normative legal research method with a descriptive-qualitative character, focusing on the analysis of legal norms, principles, doctrines, and court decisions to address the issue of legal protection for well-known foreign trademarks, specifically the trademark *J Casanova*. The research adopts both a statutory approach and a case approach by analyzing the Central Jakarta Commercial Court Decision No. 11/Pdt.Sus-Merek/2016, the Supreme Court Decision No. 968 K/Pdt.Sus-HKI/2016, and the Supreme Court Reconsideration Decision No. 197PK/Pdt.Sus-HKI/2018.

The data used in this research consists of secondary legal materials, including primary legal sources (legislation and court rulings), secondary legal sources (legal literature, journal articles), and tertiary legal sources (legal dictionaries and scholarly guidelines). Data collection was conducted through literature study and document analysis, while data analysis was carried out qualitatively by interpreting the data in light of relevant legal theories and statutory provisions.

This research aims to provide a systematic overview of the legal protection for well-known trademarks, as well as to analyze the consistency and legal reasoning within the related court



decisions. Ultimately, it seeks to draw conclusions on the legal status of the *J Casanova* trademark under Indonesian positive law and its alignment with international obligations under the TRIPs Agreement.

RESULTS AND DISCUSSION

Regulation of Well-Known Foreign Trademark Protection in Indonesia

Background and Problem Review

Philosophically, the protection of well-known trademarks is a necessity in achieving justice and legal certainty, given that trademarks hold strategic value for national interests. As a member of the World Trade Organization (WTO) and a signatory to international conventions on Intellectual Property Rights (IPR), Indonesia is obligated to protect trademark owners acting in good faith and to shield the public from the risks of counterfeiting or imitation of goods and services.

Sociologically, legal protection of trademarks represents a response to global dynamics, particularly trade liberalization and the implementation of the TRIPs Agreement. This protection must not only exist in regulation but also be enforced effectively. As a product of human intellect, a trademark holds high economic value and must be recognized and protected to promote social welfare.

Legally, Indonesia's membership in the WTO through Law No. 7 of 1994 requires the harmonization of national legislation with international standards, including trademark protection as regulated under TRIPs. The Trademark Law grants exclusive rights to registered trademark holders, specifies the duration of protection, and provides mechanisms for cancellation of registrations in cases of non use.

From an economic perspective, trademarks serve as identifiers, quality assurance, and indicators of product origin. When internationally recognized, they possess significant commercial value. Hence, legal protection of trademarks is vital to ensuring business certainty, fostering an investment-friendly climate, and enhancing the competitiveness of national products.

In practice, trademark registration serves as valid evidence of ownership and a legal basis to reject similar marks. Trademark protection can be preventive through registration, including a priority right system or repressive through dispute resolution, either litigation or non-litigation. This is essential to prevent unauthorized registration by other parties of marks that, though unregistered in Indonesia, are already well known abroad.

Overall, the protection of well-known trademarks reflects Indonesia's commitment to



upholding intellectual property rights, protecting consumer interests, and supporting national economic development in the era of free trade.

Legal Foundation

The legal foundation used in this thesis is based on primary legal materials, which include the following regulations:

Law Number 15 of 2001 concerning Trademarks.

In Indonesia, trademark legislation has undergone several amendments, starting from Law Number 21 of 1961, which was amended by Law Number 12 of 1992, and subsequently replaced by Law Number 15 of 2001. From Law No. 21 of 1961 to Law No. 15 of 2001, improvements were made to align with evolving times and the provisions of the TRIPs Agreement. For instance, Article 67 of Law No. 15 of 2001, which regulates trademark cancellation lawsuits, serves as a corrective mechanism within the economic and business landscape. Therefore, the resolution of disputes related to trademark cancellation requires a specialized judicial body, namely the Commercial Court. The Commercial Court was chosen due to the relatively fast procedures for resolving trademark disputes.

Law Number 20 of 2016 concerning Trademarks and Geographical Indications introduced substantial changes to trademark law, one of which is the provision regarding the "International Trademark Registration Application." This provision allows applications originating from Indonesia to be submitted to the International Bureau and applications submitted to Indonesia as a designated country from the International Bureau. Furthermore, additional regulations regarding international trademark registration based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks are governed by government regulations.

The TRIPs Agreement regulates several key aspects. First, the General Provisions and Basic Principles chapter contains general provisions and basic principles, including the obligation for every member country to implement the TRIPs Agreement and adjust their national laws accordingly even beyond TRIPs provisions when necessary and the binding nature of member states to the Paris Convention, Berne Convention, Rome Convention, and the Washington Treaty on Integrated Circuit Layout Designs. Principles such as national treatment, most-favored-nation treatment, and the objectives of the TRIPs Agreement provide the legal basis for fair and open trademark protection and enforcement. Such regulatory concepts are crucial for facilitating product distribution while safeguarding trademark owners' rights in order to support economic welfare.



Second, the chapter on Standards Concerning the Availability, Scope, and Use of Intellectual Property Rights provides standard regulations on various types of intellectual property rights, including copyrights and related rights, trademarks, geographical indications, industrial designs, patents, layout designs of integrated circuits, protection of undisclosed information, and control of unfair competition practices in licensing agreements. The TRIPs standards emphasize limited protection with specific requirements, including the type of IPR, subject and object, substantive conditions, and formal procedures.

Third, the chapter on Enforcement of Intellectual Property Rights imposes obligations on member states to implement enforcement procedures as stipulated in TRIPs, including fast and low-cost processes, interim judicial decisions, compensation, and preventive judicial measures to avoid further harm to IPR owners, as well as customs enforcement at international borders and criminal sanctions for trademark and copyright counterfeiting.

Fourth, the chapter on Acquisition and Maintenance of Intellectual Property Rights and Related Inter Parties Procedures provides provisions and requirements for obtaining and maintaining IPR, along with permitted procedures and formalities. Fifth, Dispute Prevention and Settlement provides guidelines on dispute avoidance and dispute resolution mechanisms. Sixth, the Transitional Arrangements chapter outlines when the TRIPs Agreement becomes effective: one year after the signing of the WTO convention for developed countries, a four-year extension for developing countries, and a ten-year extension for least developed countries. Additionally, developed countries are obligated to facilitate technology transfer, technical cooperation, and financial support for developing and least developed countries.

Seventh, Institutional Arrangements and Final Provisions include the authority of TRIPs to supervise the implementation of the agreement, resolve disputes, and promote cooperation between international organizations and WIPO affiliated bodies. This final provision also includes stipulations for reviewing and amending the TRIPs Agreement, reservations by member states, and national security exceptions.

In implementing trademark protection, well-known trademarks may be protected from deceptive imitation that closely resembles the original. Although this principle is more commonly applied in common law systems, it may also be implemented in civil law countries like Indonesia. Here, the element of good faith is used as a parameter to interpret the Trademark Law in addressing infringement, as provided by the Trademark Law itself. Trademark rights are intangible movable assets of significant commercial value. These rights arise from human intellectual capability, involving substantial time, effort, and financial investment. However, there are



fundamental conceptual differences between the common law especially Anglo-American systems and civil law systems. In Anglo American jurisdictions, movable objects are governed under personal property law. Movable goods are referred to not only as property but also as "chattels," which were traditionally categorized as chattels real and chattels personal. Chattels personal are further distinguished into (a) "choses in possession" (tangible movable property), which are physically possessed (in civil law, this is referred to as *bezt*), with transfer occurring through actual delivery (in civil law known as *levering* or *delivery*, including *traditio brevi manu* or *traditio longa manu*), and (b) "choses in action" (intangible movable property), which can only be claimed through litigation and are therefore considered intangible, having long been subject to legal disputes.

The legal system theory proposed by Lawrence M. Friedman is used to examine the legal system comprehensively. As Friedman refers to it as a "subject of social science," the legal system comprises three elements: substance, structure, and legal culture. Legal protection granted to registered trademarks may be in the form of preventive or repressive legal measures. Preventive legal protection involves actions aimed at minimizing the potential for trademark violations. This approach focuses on monitoring trademark usage, protecting the exclusive rights of foreign well-known trademark holders, and encouraging trademark owners to register their marks for legal protection.

Repressive legal protection, on the other hand, is applied when trademark infringement has occurred, either through civil litigation or criminal prosecution. In this context, Article 3 of the Trademark Law states that trademark rights are exclusive rights granted by the state to registered trademark holders. Article 7 further provides that a registered trademark receives legal protection for ten years, retroactively effective from the date of application submission. In principle, there is no legal obligation for individuals to register their trademarks; however, to receive legal protection, registration is necessary.

Such legal protection can only be effective if both preventive and repressive measures are implemented properly. This implies that public education and awareness about the importance of trademark registration and protection must be promoted, while law enforcement officials must fulfill their responsibilities effectively. From a policy perspective, however, the Trademark Law does not specifically define the criteria for trademark infringement. Nevertheless, through systematic interpretation, it can be concluded that trademark infringement essentially involves the use of an identical or substantially similar trademark to a registered one, used for identical or similar goods or services, done intentionally and without legal rights. The concept of "substantial



similarity" is specifically mentioned in Article 6 of the Trademark Law and its elucidation, which emphasizes the element of resemblance. However, such regulation is still inadequate compared to Article 16.1 of the TRIPs Agreement.

Since the Indonesian Trademark Law does not require the "likelihood of confusion" as a condition, it is understandable that this element is often not considered by judges when adjudicating trademark infringement cases. Even when judges state that the use of a substantially similar mark may lead to confusion, such statements often lack a sound ratio decidendi or adequate legal reasoning.

RESEARCH FINDINGS AND ANALYSIS

According to Gustav Radbruch, ideal law must rest upon three fundamental values: legal certainty (Rechtssicherheit), justice (Gerechtigkeit), and utility (Zweckmäßigkeit). The value of legal certainty emphasizes that law must provide clear and predictable guidance for society; the value of justice relates to equal rights and treatment before the law; while the value of utility emphasizes that law must generate tangible benefits for the common good. In striving to realize the objectives of a state governed by law, the existence of judicial institutions becomes essential as a medium for upholding the law fairly and independently from external interference. Judges, as holders of judicial power, are required to explore and understand the legal values that live within society, and to base their decisions on legal facts, moral norms, and legal doctrines including in resolving trademark disputes.

Adherents of positive legal theory argue that legal certainty is the primary objective of law, as only through certainty can social order and structure be achieved. Therefore, in the context of trademark law, there must be clarity in the rules and strong protection for trademark rights through a written and structured legal system. On the other hand, natural law theorists believe that the ultimate aim of law is to achieve justice, meaning the harmonious balance of human interests. This perspective demands that trademark law should not be merely formalistic, but also reflect a sense of social justice. Consequently, the norms within the Trademark Law should be capable of guaranteeing justice, order, and balance simultaneously.

In line with the progression of time and the increasing complexity of global trade, the purpose of trademark law is no longer limited to justice and certainty alone, but is also directed toward achieving societal welfare. This view is in accordance with utilitarian theory and the concept of the welfare state, which place the utility of law as an essential component of the national legal structure. Therefore, the implementation of trademark law in Indonesia must be



grounded in the three fundamental values articulated by Gustav Radbruch certainty, justice, and utility so that law functions not merely as a normative instrument of regulation, but also as a means to achieve social justice and collective welfare.

Expert Opinions

Muhammad Yahya Harahap

Trademark registration under the Trademark Law grants exclusive rights to the trademark owner to protect their products from unauthorized use by others, especially in cases involving identical or confusingly similar products, whether visually or phonetically. This registration system adheres to a *constitutive system*, which has been in effect since Law No. 19 of 1992. This system provides legal protection only to the party that first registers the trademark in good faith. It offers stronger legal certainty and aims to minimize disputes over trademark rights. Registration becomes a crucial requirement, as without it, trademark rights are not legally recognized. This is reinforced by Article 4 of Law No. 15 of 2001, which stipulates that registration is invalid for parties acting in bad faith. In practice, a registration application must be accompanied by a sample of the trademark, including its colors and the class of goods or services requested.

In contrast, the *declarative system* previously regulated under Law No. 21 of 1961 prioritized the principle of first use as the basis for legal protection, rather than registration. Under this system, rights to a trademark arise from its first use, as stated in Article 2 paragraph (1). However, according to Yahya Harahap, this system led to legal dualism by simultaneously recognizing the first-to-file principle while also allowing the first user to assert stronger rights through evidence. In terms of legal protection and certainty, the constitutive system is considered more effective, as it clearly grants legal recognition to the first registrant in good faith, thereby fostering certainty in trademark ownership and use in Indonesia.

Henry Soelistyo Budi

Trademark conflicts often focus on protecting the brand's reputation, which must be proven during disputes. Issues arise due to the absence of a clear definition of what constitutes "reputation," a concept often debated and confused with mere brand recognition. Without a clear legal guideline, the subjectivity of trademark examiners or judges becomes a dominant factor in assessments. Therefore, the Trademark Law should provide firmer guidance on this issue.

Furthermore, under the previous legal regime, individuals could register foreign trademarks not yet registered in Indonesia as their own, harming the original brand owners. The



principle of first use in the prior Trademark Law allowed this to occur, which not only disadvantaged foreign trademark owners but also risked damaging international trade relations and Indonesia's global image. Constitutionally, such practice contradicts Indonesia's commitment to global order. Hence, revisions to the Trademark Law are necessary to halt the unauthorized registration of foreign trademarks. The 2016 Trademark Law, by applying the first-to-file principle, has strengthened legal protection, reduced fraudulent practices, and ensured legal certainty for legitimate trademark holders.

Summary of Normative Review and Its Impact

The normative legal analysis in this study highlights two major issues: the lack of a universally accepted definition of a "well-known mark" and divergent interpretations and understanding among law enforcers. To date, both international frameworks such as TRIPS and national laws have only provided *criteria* for well-known marks not a definitive legal definition. In Indonesia, ministerial decisions from 1987 to 1991 show the evolution of legal protection for well known trademarks, expanding from protection limited to similar goods to include dissimilar goods and recognition both domestically and internationally.

Criteria for identifying well-known marks include public recognition, brand reputation, intensity of promotion, and international registration often proven through independent surveys. Nevertheless, the absence of a standardized definition leaves wide room for subjectivity in law enforcement, frequently influenced by personal experience, individual belief, and judicial psychology. This has led to inconsistent verdicts in similar cases, undermining legal certainty.

Another issue is the lack of legal harmony, which impacts the exclusive protection that rightful trademark owners are entitled to. Although trademark holders should enjoy a monopoly over their brand, current legal barriers can weaken this protection. Therefore, a comprehensive reform of the Trademark Law is needed to resolve these issues and ensure legal certainty, fairness, and utility for business actors and the trade sector at large.

Implementation of Foreign Well-Known Trademark Protection in Indonesia

Case Chronology

General Overview

The case under review involves a legal dispute filed by the French cosmetics company J. Casanova against the registered trademark "Casanova" owned by Irawan Gunawan, brought before the Central Jakarta Commercial Court on the grounds of trademark imitation. The plaintiff,



J. Casanova, is a company established under French law and operates in the sales, export, and import of clothing, perfumes, and cosmetic products bearing the J. Casanova trademark.

The plaintiff argued that its J. Casanova mark qualifies as a well-known trademark, as it has been registered with the World Intellectual Property Organization (WIPO) and in twelve countries worldwide. This fact aligns with the explanation of Article 6 paragraph (1)(b) of Law No. 15 of 2001 on Trademarks, which considers international registrations as an indicator of a well known mark.

Furthermore, the mark's reputation was reinforced by large-scale international promotional campaigns, investments in several countries, and supporting evidence of trademark registration in multiple jurisdictions. If such evidence is still considered insufficient, the Commercial Court is permitted to order an independent survey to determine whether the mark in question is indeed well-known.

Commercial Court Decision

In the trademark dispute between J. Casanova (plaintiff) and Irawan Gunawan (defendant), the plaintiff requested the cancellation of the registered trademark "Casanova" under the defendant's name. However, in its first ruling, the panel of judges rejected the claim, citing the plaintiff's failure to prove ownership over the J. Casanova mark. The court noted that the plaintiff's trademark certificates in several countries had expired and the mark was never registered in Indonesia. Additionally, the Court ruled that the mark did not meet the criteria of a well-known mark. Conversely, the defendant had legally registered the "Casanova" trademark on May 25, 2010, and it had also been registered in several countries and with Indonesia's Food and Drug Supervisory Agency (BPOM).

Although the plaintiff had attempted to resolve the dispute amicably through a formal letter, this initiative failed, and the matter proceeded to litigation. During the trial, the defendant rejected all of the plaintiff's claims, challenged the legal standing of the plaintiff's attorney, questioned the relevance of judicial precedents (*jurisprudence*) in Indonesia's civil law system, and submitted exceptions related to expiry and unclear subject matter (obscure libel).

This case illustrated the complexity of trademark protection, the importance of good faith in registration, and the limitations of jurisprudential application within Indonesia's legal framework.

Supreme Court Decision Cassation Level

The Supreme Court of Indonesia, in its cassation decision, accepted the appeal submitted by J. Casanova and overturned the previous ruling of the Central Jakarta Commercial Court. In its judgment, the Court recognized J. Casanova's trademark as a well-known mark and concluded



that the defendant's "Casanova" trademark bore substantial similarity and was registered in bad faith.

In contrast, the plaintiff was deemed to have acted in good faith and was granted exclusive rights to use the trademark in Indonesia. As a result, the defendant's trademark registration No. IDM000324610 was annulled, ordered to be removed from the General Register of Trademarks, and to be published in the Official Trademark Gazette. Furthermore, the Supreme Court ordered the defendant to pay all court costs at all levels of litigation, including IDR 5,000,000 in cassation-related costs.

Supreme Court Decision at the Judicial Review Level

In 2018, Irawan Gunawan, as the party holding the Casanova trademark, submitted a Judicial Review (PK) request against the Supreme Court Decision Number 968 K/Pdt.Sus-HKI/2016, which had previously granted the lawsuit filed by the owner of the J. Casanova trademark. In the PK, which was granted by the Supreme Court through Decision Number 197 PK/Pdt.Sus-HKI/2018, it was stated that the Supreme Court had committed a clear error or evident mistake in the previous decision.

The main reason the PK was granted was that the name "Casanova" was not an original creation of the plaintiff, but had already been widely known internationally through literary works and films, and therefore could not be exclusively claimed as a commercial trademark by the plaintiff. Furthermore, the name Casanova had also been used and registered as a trademark in various countries such as Canada and Germany, indicating that the term is generic in nature and therefore not eligible for specific legal protection by one party alone.

Based on these considerations, the Supreme Court annulled the previous cassation ruling and rejected the plaintiff's claim. In the ruling, the Supreme Court stated that the PK request was granted, and the Respondent to the PK (initial plaintiff) was ordered to pay the court fees for all levels of proceedings.

This decision was based on several statutory regulations, including: Law Number 20 of 2016 on Trademarks and Geographical Indications, Law Number 48 of 2009 on Judicial Power, and Law Number 14 of 1985 on the Supreme Court along with its amendments.

In addition, the submission of the PK was in accordance with Article 263 paragraph (2) of the Criminal Procedure Code (KUHP), which allows for a PK to be filed if there is a clear and manifest error in a court decision.

On the other hand, the provisions of Article 6 paragraph (1) letters a and b of Law Number



15 of 2001 on Trademarks state that trademarks that are substantially or wholly similar to well-known marks or previously registered marks may not be registered. However, in this case, the Supreme Court found insufficient grounds to consider the J. Casanova trademark as one that truly deserves full protection, due to the generic nature of the word "Casanova".

The Supreme Court, as the highest judicial authority in accordance with Article 24A of the 1945 Constitution and the Law on the Supreme Court, has the authority to annul incorrect court decisions and re-rule on cases if there is a misapplication of law. Therefore, this decision reflects the exercise of the Supreme Court's authority in upholding justice and legal order through the judicial review mechanism.

Legal Case Analysis

As previously discussed in subsection 4.1, up to now there has been no universally accepted definition of a well-known trademark. Efforts to inventory the elements that constitute such a definition have not yet reached consensus. Therefore, if a party insists on imposing their own interpretation on others, it is often purely driven by the interest of the trademark owner concerned. This issue is exacerbated by the weak legal structure in Indonesia, which results in legal proceedings concerning trademarks failing to fulfill the principles of justice, utility, and legal certainty.

In the present case, there was confusion over what qualifies a trademark to be considered well-known, and what constitutes imitation of a well-known trademark. Additionally, trademark imitation remains widespread in Indonesia. The supervision by the Directorate General of Intellectual Property appears weak, particularly in evaluating whether a trademark application contains elements of substantial similarity to a previously registered well-known trademark. This is evidenced by the numerous trademarks that share essential similarities with existing well-known marks, yet their registration applications are still granted and included in the General Trademark Register.

The modus operandi of trademark infringement has now evolved into a more sophisticated form. This type of infringement is referred to as passing off the unauthorized use of a brand's reputation. In Indonesian legal literature, passing off is not yet widely recognized, and the term itself remains relatively foreign. This is because passing off is a concept rooted in the Common Law legal system, where it is considered an act of unfair competition.

Passing off is harmful because it results in financial losses for the legitimate owner of a registered trademark, who registered the mark in good faith. The infringing party exploits the



established reputation of a well-known mark to gain financial benefits without investing in building their own brand identity. This practice misleads consumers and creates public confusion about the origin of a product. Such actions violate the fundamental provisions of Articles 3, 4, and 5 of the Trademark Law. In addition to these specific provisions on trademarks, passing off can also be subject to criminal sanctions, as it involves clear elements of fraudulent behavior.

The Legal System Theory proposed by Friedman states that the law consists of three components Legal Substance, Legal Structure, and Legal Culture. These three components are interrelated and mutually influential, and can be examined through how the law functions in practice. Law reflects the culture of society, and therefore cannot be studied in isolation neither through a single component nor through dual perspectives without considering the social system in which the law operates. Friedman's legal system theory analyzes the application of legal substance, structure, and culture. Legal substance includes rules, norms, and actual patterns of human behavior within the legal system, including products generated by people operating within it, such as decisions they issue or new regulations they create.

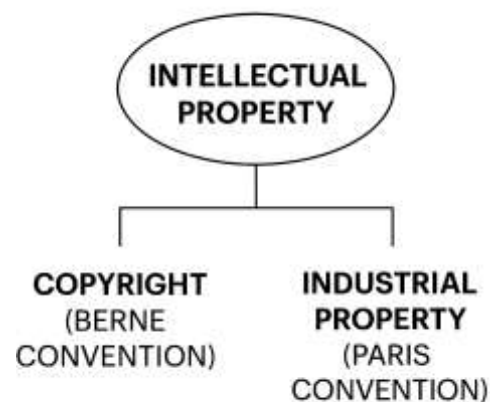


Figure 1. Framework of Intellectual Property Rights in Indonesia in View of International Agreements

From Figure 1, it is understood that Intellectual Property Rights (IPR) in Indonesia have become an integral part of positive law as a consequence of ratifying several international covenants, notably the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works. Based on these two conventions, intellectual property is divided into two main categories: Industrial Property Rights and Copyright. In addition, there are also national laws enacted based on Indonesia's ratification of the

Agreement Establishing the World Trade Organization (WTO), which includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

In the three court decisions involved in this case, the most contested legal substance revolved around whether J. Casanova constitutes a well-known trademark and whether it is entitled to legal protection under Indonesian law. In the first ruling, the defendant explicitly rejected the plaintiff's argument asserting that J. Casanova was a well-known mark. This rejection was based on the fact that the trademark certificates submitted by the plaintiff had already expired. Under Indonesian law, a trademark certificate is valid for 10 (ten) years from the date of registration. The defendant submitted evidence of ten expired trademark certificates belonging to J. Casanova.

Moreover, the name J. Casanova was argued to be derived from a generic or common term, based on the historical figure Giacomo Casanova, widely recognized as a legendary lover. Therefore, it was argued that the term cannot be claimed or monopolized by a single party and does not fulfill the criteria of a well-known trademark as stipulated in Law No. 15 of 2001 on Trademarks. The defendant also submitted evidence of four other trademarks that used the name Casanova.

A well-known trademark must be recognized as such within the Indonesian legal jurisdiction, as required under Article 6(1)(b) of Law No. 15 of 2001 on Trademarks. A trademark that is only well-known globally cannot automatically be deemed well-known in Indonesia. Since J. Casanova was not registered in Indonesia, it does not meet the criteria for recognition as a well-known mark. This aligns with the TRIPS Agreement and Paris Convention, both of which emphasize that fame or recognition must be acknowledged within each respective jurisdiction.

The lack of clarity in the legal substance particularly the definition of a well-known trademark has further affected the legal structure. In practice, the focus of legal interpretation has shifted from domestic recognition to global reputation and international registration, often supported by Supreme Court jurisprudence, such as the KNIRPS and Cornetto cases. Varying interpretations and judicial subjectivity have only worsened legal uncertainty in trademark cases.

Indonesia's legal culture, grounded in the constitutive system, requires that trademarks be registered to gain protection. However, awareness and enforcement of IPR violations remain low, both among the public and law enforcement institutions. The competence of law enforcement in IPR-related matters is still uneven, and enforcement procedures rely entirely on the discretion of the judges. Inconsistent decisions across court levels are often caused by regulatory changes and case overload in the Commercial Court. Therefore, it is recommended that Indonesia adopt the



model of other countries by establishing a specialized IPR court with judges who have specific expertise in intellectual property law.

RESEARCH FINDINGS

The findings of this research reveal a significant gap between the normative goals of trademark protection law and its practical implementation in Indonesia. Although the Trademark Law is intended to ensure protection, legal certainty, utility, and justice, its application often contradicts these aims due to the influence of Indonesia's legal culture. This gap reflects the classic distinction between *das sollen* (what ought to be) and *das sein* (what is). In practice, trademark owners or license holders may bring legal action against parties using similar marks in the same trade or service sector, provided that two conditions are met: the existence of substantial similarity and the potential to mislead consumers. The core purpose of trademark law is to prevent the exploitation of a brand's reputation commonly referred to as *passing off* and to safeguard consumer trust.

While the concepts of passing off and protection of well-known marks are more prevalent in common law jurisdictions, they remain relevant within Indonesia's civil law framework. However, due to the absence of a precedent-based legal system in Indonesia, there is a pressing need for more detailed statutory guidelines to aid judicial decision-making. As a comparative example, China offers legal protection for well-known trademarks by setting out clear criteria, such as the length of use, geographical reach, sales volume, public recognition, and promotional efforts. To bridge the implementation gap, Indonesia must improve its regulatory framework, particularly by clarifying the definition of a well-known trademark and strengthening the registration system to prevent confusion and infringement. Additionally, increasing public and business awareness of the importance of trademark registration is essential, especially given Indonesia's adoption of the first to file principle. This awareness is key to preventing brand piracy or unauthorized use of trademarks by parties acting in bad faith.

CONCLUSION

Legal protection for foreign well-known trademarks in Indonesia is based on the country's commitment as a member of the World Trade Organization (WTO), having ratified the TRIPS Agreement through Law No. 7 of 1994, which subsequently prompted a reform of Indonesia's trademark legal system. This reform included the replacement of Law No. 15 of 2001 with Law No. 20 of 2016 on Trademarks and Geographical Indications. The new law affirms the first-to-file



principle, granting legal protection to the first registrant acting in good faith, and provides a cancellation mechanism for trademarks that infringe upon existing trademark rights. However, in practice, the protection of foreign well-known trademarks continues to face challenges, as demonstrated by the dispute between J. Casanova and Irawan Gunawan, which exposed inconsistencies in legal enforcement, even at the level of judicial review. Based on an analysis using Lawrence M. Friedman's legal system theory, it is evident that Indonesia's legal system remains weak in all three components: the substantive law, which still lacks explicit criteria for defining a well-known trademark; the legal structure, which remains unstable; and the legal culture, which tends to be permissive toward intellectual property violations. This illustrates a clear discrepancy between the ideal objectives of trademark law and its actual implementation in society.

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