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# FILLING THE LEGAL VACUUM OF INDONESIAN MARKS LAW: THE LEGAL STANDING OF A FAMOUS PERSON IN SUING MARKS INFRINGEMENT

**Muhamad Amirulloh[a], Helitha Novianty Muchtar[b], Didin Muhtadin[c]**

**ABSTRACT**

Indonesian Marks Law in Article 21 paragraph (2) letter a has protected famous people from using their names or abbreviations as marks by other parties without permission. However, that law has not protected famous people from suing for cancellation and/or compensation against a party using the name and/or abbreviation of his name as a mark. Using the normative juridical method, the provisions on the legal basis for famous people to sue other parties who use their names or their abbreviations as marks are analyzed. This article examines legal principles and legal theories that can be used to resolve that. The results of the study conclude that the legal principles that can be used to provide a legal basis for famous people in suing other parties without permission to use their names or abbreviations as marks are the principle of good faith, the principle of legal certainty, the principle of point *d' interest*, *point d' action*, and the principle of *legitima persona* stands in *judicio*. Legal theories that can provide a legal basis for famous people in suing other parties without permission to use their names or abbreviations as marks are the welfare state theory, development law theory, and the theory of intellectual property protection from Robert M. Sherwood.

**Keywords**: good faith; famous person; legal certainty; marks; right to sue.

## INTRODUCTION

Someone can become famous for various reasons, such as exemplary behavior, intelligence, achievements, etc. The field of work or profession in which famous people are involved is also very diverse, ranging from artists, political figures, athletes, religious leaders, entrepreneurs, and others.[1] Famous people's names also have a strong and significant attraction for others or society towards information related to those famous individuals.[2]

In branding, many brands are formed based on people's names. One example is Peter F. Saerang, a famous hairstylist whose name is also used as a brand and has been registered since 1994 for several goods and/or services classes, such as cosmetics/beauty products in class 3, accessories and jewelry in class 14, educational institutions in class 41, and beauty salons in class 42. Another example is the *batik* brand ”Danar Hadi”, an acronym for the owner's name, Danarsih Hadipriyono, and started operating in Solo in 1967, then expanded nationally and internationally through exports to Europe and America.[3] Famous people in Indonesia who also promote products include Agnes Monica, Jonathan Christie, Tukul Arwana, and Bambang Pamungkas.

[a] Faculty of Law Universitas Padjadjaran, Jl. Dipatiukur No. 35 Bandung, email: muhamad.amirulloh@unpad.ac.id
[b] Faculty of Law Universitas Padjadjaran, Jl. Dipatiukur No. 35 Bandung, email: helitha.novianty@unpad.ac.id
[c] Magister Kenotariatan Universitas Padjadjaran, Jl. Hayam Wuruk No. 02 Bandung, email: didinsmart4@gmail.com

[1] Muhamad Amirulloh, "Legal Principles Related Famous Person‘s Name Protection As A Domain Names in Indonesia", *Sosiohumaniora*, Vol. 18, No. 2, 2016, p. 153-156.

[2] Amirulloh Muhamad and Helitha Muchtar, *Cyberlaw, Perlindungan Hukum Bagi Orang Terkenal Dari Cybersquatting*, Logoz, Bandung: 2018, p. 1.

[3] Danar Hadi, "Perjalanan Danar Hadi", 24 May 2017, <https://danarhadibatik.com/id/danar-hadi-world>, [accessed 06/04/2021].

Marks are one form of Intellectual Property ("**IP**"), currently regulated under Law Number 20 of 2016 regarding Marks and Geographical Indications ("**Marks Law**"). Article 21 paragraph (2) letter a of the Marks Law states that "Mark registration applications will be rejected if the mark is identical or similar to the name or abbreviation of a famous person, ...unless with written approval from the rightful owner." This provision clearly and firmly protects famous people from using their names (including their aliases or stage names), and name abbreviations, as marks by others without written consent from the famous person. This legal protection clearly implies that a famous person's name has its own reputation and attraction that can be used to gain economic benefits.

In practice, there have been instances of using the name or abbreviation of a famous person as a mark by others. For example, the case of the "Bensu" trademark for a food product consisting of chicken *geprek,* which involves two trademark disputes, namely the "Bensu = Bengkel Susu" trademark owned by Jessy Handalim, and the "I Am Geprek Bensu Sedep Beneerrr" trademark owned by PT. Ayam Geprek Benny Sujono. Actually, "Bensu" is an abbreviation of the name of the celebrity Ruben Onsu, who has long been known by the public as a television entertainment host or MC since 2006 until now. Ruben Onsu has also obtained legal rights over using the name BENSU as an abbreviation of his name, which is inseparable from his name as the plaintiff, as stated in the South Jakarta District Court Decree No. 384/Pdt.P/2018/PN.Jkt.Sel., dated May 30, 2018. Ruben Samuel Onsu's "Bensu" trademark has been registered as a trademark since September 3, 2015, with registration number IDM0006224 27 for class of goods/services 43. [4]

The problem arises when the name of a famous person is used without permission by others, and the famous person will take legal action in the form of a trademark cancellation lawsuit based on Article 76 of the Marks Law or a civil compensation lawsuit based on Article 83 of the Marks Law, to the Commercial Court. Article 76, paragraph (1) of the Marks Law states, "A registered marks cancellation lawsuit can be filed by an interested party based on the reasons referred to in Article 20 and/or Article 21." In the explanation of this article, it has been further detailed who is meant by "interested party," including the registered trademark owner, prosecutors, consumer foundations/institutions, and religious councils/institutions. Clearly, the provision does not mention "famous persons" as a legal subject in Article 21.

Based on the provisions of Article 76 and Article 83 of the Marks Law, it is clear that famous people are not given legal standing to file a lawsuit for cancellation or compensation against parties who use their names and/or abbreviations as marks. This condition certainly creates a legal void and uncertainty regarding the protection of famous people in Indonesia, especially those who do not register their names or abbreviations as marks. The Marks Law protects parties who act in good faith and imposes sanctions on those who act in bad faith by misusing the reputation or goodwill of others.

[4] Samuel Onsu v Benny Sujono, Putusan Pengadilan Negeri Jakarta Pusat Nomor 57/Pdt.Sus-HKI/Merek/2019/PN Niaga Jkt.Pst, Pengadilan Niaga Jakarta Pusat, 13 January 2020.

In the case of the trademark dispute over "Bensu" used by Jessy Handalim and challenged by Ruben Onsu, the rejection of the lawsuit by the panel of judges indicates that the legal protection for famous names under Article 21 of the Marks Law is not strong, especially if the famous name has not been registered as a trademark by the celebrity themselves.[5] It also indicates that without a legal basis for the authority of famous individuals to sue others who use (and register) their name as a mark without permission, the protection for famous individuals in such cases is fragile.

Based on the background information, the issues to be examined are identified as follows:

1. What legal principles can be used to provide a legal basis for protecting celebrities to sue others who use their names or abbreviations as marks without permission?
2. What legal theories can be used to provide a legal basis for protecting celebrities to sue others who use their names or abbreviations as marks without permission?

## RESEARCH METHOD

This research uses a descriptive-analytic research specification, which aims to describe or provide an overview of a research object studied through collected samples or data and draw general conclusions. [6] This research will describe the practice of using the names of famous people as marks by others without their permission and examine the legal basis/rights of famous people to sue those who use their names as marks without permission. The research-approach used in this study is a juridical-normative approach, which is a legal research method that uses an approach/theory/concept and analysis method that is included in the doctrinal legal discipline[7], accompanied by a legal theory method that examines the truth or justice of a legal doctrine, namely the truth or justice regarding the rights of famous people to sue those who use their names as marks without permission.

## DISCUSSION

### Legal Principles in the Renewal of Marks Law Related to the Rights of Famous Individuals to Sue Others Who Use Their Name or Abbreviation as a Mark Without Permission.

The meaning of a name may not be important to some people, but for others, especially business owners, a name is something very significant in providing a mark for the products produced, to indicate the origin of the goods (indication of origin) so that they can be distinguished from other products and services. It also protects one company's production from other similar or dissimilar companies.[8] A mark/brand is essential in industry and commerce, especially in marketing products to potential consumers. Besides being a form of wealth that can generate profits for its owner, a mark is also a tool to protect the community as consumers from counterfeiting of specific quality. [9] Marks

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[5] Humaedi Abdurahman, "Asas First To File Principal Dalam Kasus Hak Merek Nama Terkenal Bensu", *Jurnal Hukum Aktualita*, Vol. 3, No. 2, 2020, p. 428.
[6] Soerjono Soekanto, *Pengantar Penelitian Hukum*, UI Press, Jakarta: 1986, p. 89.
[7] Ronny Hanitijo Soemitro, *Metodologi Penelitian Hukum Dan Jurimetri*, Ghalia, Jakarta: 1990, p. 45.
[8] Muhamad Djumhana and R Djubaedillah, *Hak Milik Intelektual (Sejarah, Teori Dan Prakteknya Di Indonesia)*, Citra Aditya Bakti, Bandung: 1997, p. 45-52.
[9] Khoirul Hidayah, *Hukum HKI (Hak Kekayaan Intelektual)*, UIN Maliki Press, Malang: 2013, p. 72.

play a vital role in industrial goods and services because marks are used not only as a product identification, whether in the form of goods or services, but also become a business strategy tool to win in a competitive business environment. [10] With mark, a company that produces goods will be easily recognized by the public. If the public already knows the mark, it will raise the reputation of the product mark so that if there is any infringement, such as piracy or imitation of a well-known mark, the rightful owner of the mark will be the one who is harmed. [11] A mark will be protected in its use and application as part of the Law on intellectual property rights. To protect a mark, such mark must first be registered. This registration is essential to obtain the rights to the mark. The right to the mark is an exclusive right granted by the state to the mark's owner registered in the "general list of marks" for a certain period of time. [12] Legal protection provided to registered marks can be in the form of preventive legal protection or repressive legal protection. [13]

Legally, there is indeed legal protection for famous people from others who use their name or abbreviation of their name as a mark without the famous person's permission. This provision is stipulated in Article 21, paragraph (2) letter a of the Marks Law. Unfortunately, this substantive legal provision is not accompanied by formal legal provisions that provide a legal basis for the famous person whose rights have been violated to take legal action in the form of a lawsuit for cancellation and/or compensation against others who use their name or abbreviation of their name as a trademark without permission. This situation creates a lack of harmony in marks law or even a legal vacuum to protect famous people from those who act in bad faith.

Regarding the right of famous people to sue others who use their name or abbreviation of their name without permission, there is actually a legal principle in Marks Law that is expressly stated or codified in the Marks Law, namely the principle of good faith. This principle of good faith is the main principle in mark registration, as explicitly stipulated in Article 21, paragraph (3) of the Marks Law, which states that "the application shall be refused if submitted by an Applicant who acts in bad faith". Misleading consumers and/or society is a form or evidence of bad faith on the part of the Applicant, as further affirmed in the Explanation of Article 21 paragraph (3) of the Marks Law, which states that “the Applicant who acts in bad faith is an Applicant who is suspected of having the intention to deceive or mislead consumers in registering their mark”. The use of the name or abbreviation of a famous person as a mark by others without permission is an indication of deception or misleading of consumers by creating the impression that there is a certain legal affiliation between the mark and the famous person, thus attracting the interest of consumers to consume products that use the mark in the form of the name or abbreviation of the famous person.

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[10] Mas Rahmah, "Perlindungan Hukum Merek Menurut UU 15/2001", *Jurnal Yuridika*, Vol. 19, No. 5, 2004, p. 388.
[11] Arfi Dyah Chatarina, "Perlindungan Pemilik Merek Pertama Pada Sistem Konstitutif", *Hukum dan Dinamika Masyarakat*, Vol. 16, No. 2, 2019, p. 115, 117.
[12] Oksidelfa Yanto, "Tinjauan Yuridis UU No. 15 Tahun 2001 Tentang Merek : Sisi Lain Kelemahan Sistem First To File Dalam Perlindungan Hukum Atas Merek Sebagai Bagian Dari Hak Atas Kekayaan Intelektual (HaKI)", *ADIL,* Vol. 3, No. 1, 2012, p. 23, 25.
[13] Haedah Faradz, "Perlindungan Hak Atas Merek", *Jurnal Dinamika Hukum*, Vol. 8, No. 1, 2008, p. 39, 40.

The Indonesian Dictionary defines goodwill as “firm belief, conviction, intention, and goodwill.” In the Fockema Andrea Law Dictionary, goodwill (*te goeder trouw*; good faith) is defined as “the intention and spirit that drives participants in a legal action or those involved in a legal relationship.” Furthermore, the principle of good faith, which is reflected in one's inner attitude, is necessary to prevent the breach of contract by the parties involved. [14] Regarding the use of the name or abbreviation of a famous person, it should be understood as evidence of an intention, desire, and spirit to use the reputation or attractiveness of that famous person to attract consumer attention and gain economic profit from the expected purchases of those consumers. Therefore, using the name or abbreviation of a famous person as a mark without their permission is considered an unjust enrichment, which is logical proof of the presence of bad faith.

Salim H.S. states that there are two types of good faith-first, relative good faith, where people observe the actual behavior and actions of the subject. Second, absolute good faith, where judgment is based on reason and justice, uses objective criteria to evaluate the situation (judgment impartially) according to objective norms.[15] Regarding the use of the name or abbreviation of a famous person without permission as a mark, it can be categorized as relative good faith by considering whether there is permission or authorization from the person registering the name or abbreviation as a mark. Similarly, good faith in the practice of using the name or abbreviation of a famous person without permission can be categorized as absolute good faith, given that the use of the name or abbreviation of a famous person as a mark by someone other than the famous person can mislead consumers about the affiliation between the famous person and the mark, leading to confusion.

In the case of the trademark dispute over “Bensu” between Ruben Onsu and Jessy Handalim, the bad faith intent is very evident from using the name abbreviation “Bensu”, which was already known to the public as Ruben Onsu’s nickname. Jessy Handalim's bad faith intent to ride on the fame or reputation of “Bensu” as Ruben Onsu's nickname can be understood from the forceful use of the “Bensu” trademark as an abbreviation of “Bengkel Susu” (Milk Workshop), since linguistically, “Beng-Su” is a syllabic abbreviation of “Bengkel Susu.”

The Supreme Court's decision in the case stated that Ruben Onsu's lawsuit was “not acceptable” on the grounds that Ruben Onsu as the plaintiff, did not exercise his right to appeal to the Mark Appeals Commission against the rejection of the registration of the “Bensu” trademark owned by the plaintiff. The decision was based on formal legal grounds rather than material law. Therefore, Ruben Onsu can substantively still take the legal action necessary to defend his right to use his name or nickname as a registered trademark.

The bad faith intention should also be considered by the Commercial Court judge in the case between Ruben Onsu and Benny Sujono, as the fact that Ruben Onsu was made a brand ambassador and his photo was displayed in several branches or outlets of the culinary business brand ”I Am

[14] Amila Desiani (*et.al.*), "Implementasi Asas Itikad Baik Dalam Perlindungan Konsumen Atas Pembatalan Transaksi Yang Dilakukan Oleh Situs Belanja Elektronik", *Acta Diurnal Jurnal Hukum Kenotariatan dan ke-PPAT-an*, Vol. 2, No. 1, p. 56, 64.

[15] Salim H.S, *Hukum Kontrak: Teori Dan Teknik Penyusunan Kontrak*, Sinar Grafika, Jakarta: 2009, p. 11.

Geprek Bensu Sedep Bener/Beneerrr" has proven an attempt to ride on Ruben Onsu's reputation as a famous artist in Indonesia, to attract consumers to consume Benny Sujono's culinary products.

The absence of provisions in the Marks Law that give the right to famous people to sue others who use their names or abbreviations as marks apparently made the Commercial Court judge in the Central Jakarta District Court and the Panel of Judges of the Supreme Court have difficulties, so they gave a "safe" decision by accepting the defendant's exception and agreeing with the argument of "premature" lawsuit. The requirement for Ruben Onsu as the Plaintiff to first go through the administrative appeal process until the decision of the Trademark Appeal Commission is issued before filing a cancellation lawsuit shows that a famous person must first have and/or register their name as a trademark to file a cancellation lawsuit.

In the case of the "Kylee" trademark in the United States between Mimo Clothing and Kylie Jenner, bad faith was found to be proven with a registration that was only intended to be stored for use or "warehousing", without any actual sale of a particular product in society, or what is known as a ""non-use" trademark. In addition, the public's confusion or deception about the product's affiliation and origin also becomes a consideration for whether there is good faith.

In China, the names of famous people are also protected, even if the famous person is not a Chinese citizen. Article 32 of the Marks Law, last revised on May 1, 2014, [16] states that "an application for a trademark registration should not infringe the prior rights of others.." This provision states that registering a trademark must not violate the pre-existing rights of others. The term "prior rights of others" in this provision includes individual rights over their official names, abbreviations, and/or nicknames. Article 10, paragraph (8) of the China Trademark Act also states that "a trademark should not be detrimental to social morals or customs, or have another unhealthy social influence." This provision states that a trademark must not damage moral or social customs or have other unhealthy social influences. This provision has been widely used by the China Trademark Review and Adjudication Board and the courts to cancel trademark registrations that use the names of famous people in China.

In the case between Andy Lau and Jin Bai Li regarding the "Liu Denhua" trademark, which is the Chinese name of Andy Lau, it was stated that the acceptance of the "Liu Denhua" trademark registration applied by Jin Bai Li would have an unhealthy social influence on the public, since the Chinese public has widely recognized Andy Lau's name. The use of celebrities is a common way to promote cosmetic products. Thus the possibility of confusion would be high if the trademark were allowed to be used on such goods. Finally, in 2013, the trademark was invalidated by the Higher People's Court of China.

It is clear in Article 21, paragraph (2) letter a of the Marks Law that famous people are protected by prohibiting others from using their name or abbreviation without permission. This protection does

[16] World Intellectual Property Organization, "Trademark Law of the People's Republic of China", 2015, <https://www.wipo.int/edocs/lexdocs/laws/en/cn/cn195en.pdf>, [accessed 05/04/2021].

not require the famous person to register their name or abbreviation as a mark. It aligns with Article 21, paragraph (3) of the Marks Law, which states that ”an application will be rejected if it is made in bad faith”. Good faith should be prioritized in mark registration. Therefore, although mark rights are only protected after registration, examination of good faith is necessary during the mark registration process. Thus, even if a mark is registered, if it violates good faith, the registration should be canceled. In other words, celebrities must still be protected in their right to their reputation[17] from the bad faith of others who register their name or abbreviation as a mark.[18] This protection is not limited to administrative law, such as filing objections and/or protests, but should also be provided in formal civil law, such as the right to file a lawsuit for cancellation of the mark.

Article 76, paragraph (1) of the Marks Law states, ”A registered mark may be canceled by an interested party based on the reasons outlined in Article 20 and/or Article 21.” The explanation of this provision further elaborates on who is meant by ”interested party,” including, among others, the registered mark owner, the prosecutor, consumer organizations/institutions, and religious councils/institutions. This provision does not mention ”celebrities” as one of the legal subjects in Article 21.

According to linguistic studies, the phrase "including but not limited to” (Indonesian word: *antara lain*) actually carries a non-limitative meaning, which means that the things mentioned are just examples of its coverage. Therefore, the coverage is open to other things that are not mentioned. According to the Language Agency of the Ministry of Education and Culture, words such as ”for example” (Indonesian word: *misalnya*), ”such as” (Indonesian word: *seperti*), ”including but not limited to”already have the meaning of 'several or some'. Hence, the use of ”etc” (Indonesian word: *dsb., dll., dlsb.)* is unnecessary when "for example" or "including but not limited to” has been used. "Including but not limited to" mentions some of what is being discussed. Since it only mentions a part (as an example), "including but not limited to" should not be followed by a complete list and should not end with ”etc” For these two purposes, use ”namely” (Indonesian word: *yaitu*), ”include” (Indonesian word: *meliputi*), or "is/are” (Indonesian word: *adalah*).[19] Therefore, in fact, famous people may also be included as the legal subjects referred to in Article 76 paragraph (1) of the Marks Law, namely the legal subjects ”who have an interest” who can file a mark cancellation lawsuit based on the reasons referred to in Article 20 and/or Article 21 of the Marks Law.

The meaning of Article 76 paragraph (1) of the Marks Law is actually ”complicated” by the provision of Article 76 paragraph (2) of the Marks Law, which creates requirements that conflict with the substantive legal meaning that protects famous people under Article 21 paragraph (2) letter a. This is because Article 76 paragraph (2) of the Marks Law also states that ”The owner of an unregistered mark may file a lawsuit as referred to in paragraph (1) after applying to the Minister”. Thus, a famous person must first register their name or abbreviation as a mark to file a lawsuit to

[17] Swati Deva, ‘What’s in a Name? Disputes Relating to Domain Names in India’, *International Review of Law, Computers & Technology, Vol. 19, No. 2, 2005, p.* 165.

[18] Yee Fen Lim, ‘Internet Governance, Resolving the Unresolvable: Trademark Law and Internet Domain Names’ *International Review of Law, Computers & Technology, Vol. 16, No. 2, 2002, p.*199.

[19] Yulia Agustin, "Penguasaan Tata Bahasa Dan Berpikir Logik Serta Kemampuan Menulis Artikel Ilmiah", *Jurnal Ilimah Kependidikan*, Vol. 2, No. 2, 2015m, p. 123.

cancel a registered mark. It is certainly not in line with the purpose of Article 21 paragraph (2) letter a as a substantive law of the Marks Law that protects famous people.

Furthermore, in the explanation of Article 76 paragraph (2) of the Marks Law, it is stated that "the owner of unregistered marks" includes, among others, a well-intentioned owner of a mark that is not registered or a famous mark owner whose mark is not registered. This provision does not explicitly mention famous individuals as legal subjects but only mentions well-intentioned mark owners who are not registered. It means the same as the wording of Article 76 paragraph (2), which refers to famous individuals who must "use" their name as a mark, even if it is not yet registered.

According to Kelsen, the law is a system of norms. Norms emphasize the aspect of "should" or *das sollen*, by including several rules about what should be done. Norms are the products and actions of deliberative human beings. Laws containing general rules serve as guidelines for individuals to behave in society, both in their relationships with others and with society as a whole. These rules limit society in burdening or taking action against individuals. The existence of rules and the enforcement of these rules create legal certainty.[20]

The absence of clear and explicit norms/rules in the Marks Law that provide a legal basis/grounds for famous individuals to file for mark cancellation and/or compensation against others who use their name as a mark without permission proves that there is no legal certainty regarding protection for famous individuals.

According to Utrecht, legal certainty contains two meanings. First, general rules make individuals aware of what actions are allowed or prohibited. Second, it provides legal security for individuals from arbitrary government actions because, with general rules, individuals can know what the state can impose or do toward individuals. Based on this, the Marks Law does not guarantee legal certainty for two reasons. First, because the Marks Law does not regulate the right to sue famous individuals (formal law), even though in Article 21 paragraph (2) letter a, there is a prohibition on registering the name or abbreviation of a famous person as a mark without the permission of that famous person (material law). The absence of the right to sue famous individuals indicates that, in this case, material law is not given a basis for regulation to be enforced, thus creating a legal vacuum. In essence, formal law is to confirm material law. Material law that cannot be enforced due to the absence of formal law as the legal basis for its enforcement, according to Gustav Radbruch, is not a law that guarantees legal certainty because such law cannot be enforced.

Secondly, the Marks Law also does not ensure legal certainty for famous individuals regarding the use of their name or abbreviation by others without permission because famous individuals do not feel legally protected since the state can grant the right to others to use their name or abbreviation without their consent, while they are not given the right to file for cancellation and/or civil compensation. It can be seen in the case of the ”Bensu” trademark between Ruben Onsu and

[20] Peter Mahmud Marzuki, *Pengantar Ilmu Hukum*, Kencana Prenada Media, Jakarta: 2008, p. 158.

Jessy Handalim, which was rejected due to the lack of an administrative decision (Marks Appeal Commission) regarding Ruben Onsu's trademark application for ”Bensu”.

In line with this, Gustav Radbruch stated that legal provisions should not be open to multiple interpretations, unclear or uncertain. In this case, the protection of celebrities under the Marks Law becomes a provision that is open to multiple interpretations and unclear, thus failing to implement the principle of legal certainty regarding this matter. The current situation is unclear whether celebrities must first register their name as a trademark before they can file for cancellation and/or damages or whether the MarksLaw protects parties who act in good faith, in this case, celebrities who have a significant reputation and economic opportunities with their reputation to attract consumer interest.

In relation to procedural law or formal law, according to the principle of *point d'interest*, *point d'action*,[21] it is clear that celebrities have the authority or right to file a lawsuit for cancellation and/or compensation against other parties who use their name or nickname without permission[22]. It is because based on the substantive law contained in Article 21 paragraph (2) letter a of the Marks Law, the name or nickname of a celebrity is already protected as an object that is prohibited from being registered by other parties as a trademark without the permission of the celebrity concerned. It is by the point d'interest, point d'action principle, where only the party with the right and whose rights have been violated has the right to file a lawsuit. It is reasonable to require that there must be an interest to make a claim. A party who does not suffer any loss does not have an interest and, therefore, cannot be accepted, but not every interest can be accepted as the basis for a lawsuit. Only sufficient, reasonable interests and having a legal basis can be accepted as the basis for a claim.

Likewise, a person who feels they have rights and wishes to defend or assert them can act as a party, both as a plaintiff and a defendant (*legitima persona stands in judicio*). [23] Based on this principle, an individual who is famous and whose name or abbreviation is recognized and protected under Article 21 (2) letter a of the Marks Law should be granted the right to file a lawsuit for cancellation and/or damages against any party who uses their name or abbreviation without permission.

The party that uses the name of a famous person without proper authorization as a mark can be categorized or qualified as having committed an unlawful act, as referred to in Article 1365 of the Civil Code. This party has fulfilled the elements of an unlawful act as follows:

1. The element of an unlawful act, in this case, is an act that contradicts, opposes, or violates the provisions of Article 21 paragraph (2) letter a and Article 21 paragraph (3) of the Marks Law.
2. The element of fault, which is intentionally and without the permission of the famous person using the name or abbreviation of the famous person, or negligence in knowing that the registered mark is the name of a famous person. There are two types of faults, intentional or

[21] Muhamad Amirulloh, "Legal Principles Related Famous Person‘s Name Protection As A Domain Names in Indonesia", *Sosiohumaniora*, Vol. 18, No. 2, 2016, hlm. 158.
[22] Ryan R Owens, "Domain-Name Dispute-Resolution after Sallen v. Corinthians Licenciamentos & Barcelona.Com, Inc. v. Excelentisimo Ayuntameiento De Barcelona", *Berkeley Technology Law Journal*, Vol. 18, No. 1, 2003, p. 257, 273.
[23] Muhamad Amirulloh, "Legal Principles Related Famous Person‘s Name Protection As A Domain Names in Indonesia", *Sosiohumaniora*, Vol. 18, No. 2, 2016, hlm. 155.

negligent. Intentional means that there is the awareness that normal people would know the consequences of their actions, which would harm others. Negligence means that there is an act of ignoring something that should have been done or being careless or not careful enough, resulting in harm to others.

3. The element of a causal relationship between the harm and the act (Causality). It means a causal relationship exists between the act performed and the consequences that arise. In this case, various damages occur by registering a mark in the form of the name or abbreviation of a famous person without their permission. These damages would not occur if the perpetrator did not register or use the name or abbreviation of the famous person as a mark without their permission.
4. The element of harm. The perpetrator's actions result in harm. This harm is divided into two types: material and immaterial. Material harm includes losses due to car accidents, loss of profits, shipping costs, expenses, etc. Immaterial harm includes fear, disappointment, regret, pain, and loss of the will to live, which would be evaluated in monetary terms. In this case, for the famous person, the harm suffered is the inability to register or use their name as a mark, the failure to receive royalties for licensing or permission to use their name, and also the potential harm to their reputation, which could be damaged or diminished as a result of the use of their name or abbreviation as a mark, which could later turn out to be of poor quality or even dangerous. For the community, the harm could be confusion, misguidance, and even deception in consuming products that bear the name of a famous person as a mark.

Specifically, foreign celebrities whose names are used as marks in Indonesia can file a mark cancellation and/or compensation lawsuit in Indonesian court based on the *actor sequitur forum rei* principle, considering this is already a case of international civil law. Therefore, the court where the defendant resides should be used to file the lawsuit. Moreover, suppose the foreign celebrity's name has already been registered as a mark in Indonesia and is based on the qualification of property law (where a mark of a famous person's name is considered a property). In that case, the principle of *forum situs/forum sitae* can be applied to sue in the Indonesian court because the mark, considered a property, is located in Indonesia as the place of registration. It is also in line with the principle of the jurisdiction in *rem/res* in the Indonesian Intellectual Property Law.[24]

The principle of alter ego can also be used to protect famous people whose names are used as marks by others. Under this principle, the use of a famous person's name as a mark[25] should be the right of that person to reflect themselves and their name as a mark that will be used in the trade of goods and/or services. Thus, there is unity between the famous person and the mark that is their name, especially considering that the famous person has gained a reputation based on their ability in

[24] Helitha Novianty Muchtar (*et.al.*), "Penerapan Prinsip Yurisdiksi In Rem (Forum Rei Sitae) Dalam Gugatan Orang Terkenal Terhadap Cybersquatter Di Indonesia", *Jurnal RechtsVinding*, Vol. 7, No. 2, 2018, hlm. 229,240.

[25] World Intellectual Property Organization, "Trademark Law of the People's Republic of China", 2015, <https://www.wipo.int/edocs/lexdocs/laws/en/cn/cn195en.pdf>, [accessed 05/04/2021].

a particular field, such as an artist, athlete, politician, and so on. Based on this, it can be understood that legal protection should be given to famous people to maintain their rights to their name, which has a reputation based on their performance and achievements, by providing a legal basis for the authority to sue others who use their name as a mark without permission. [26]

**Legal Theory in Marks Law Reform Related to the Rights of Famous Individuals to Sue Other Parties who Use their Name or Initials as a Mark Without Permission**

The rule of law adopted by Indonesia is not only in a formal sense but in a material sense, also referred to as a welfare state. It means that the state is not only responsible for maintaining public order but also required to actively participate in all aspects of people's lives and livelihoods. The existence of the Marks Law, which provides a legal basis for famous individuals to file cancellation and/or compensation lawsuits against other parties who use their name or initials as a mark[27], without their permission, not only helps to maintain public order by preventing the use of famous names or initials without permission but also provides welfare in the form of a legal framework for resolving disputes when other parties use famous names or initials without permission. Additionally, it seeks to protect the public from fraud or deception.

In line with this, Sunaryati Hartono also stated that our nation's founding fathers aspired for the Republic of Indonesia to become a democratic state under the rule of law (*rechtsstaat*), where the law is obliged to strive towards increasing the welfare and intelligence of the nation, in line with the goal of the Welfare State (*welvaartsstaat*) ideology. In relation to this, comprehensive legal protection for famous individuals against the bad faith of others and protection for the public from deceptive or fraudulent use of marks derived from the names or initials of famous individuals without permission can improve public welfare and educate the nation. Indonesian society will not easily be deceived by marks bearing famous individuals' names or initials. The society and mark registrants will also be wise enough to realize that the names or initials of famous individuals should not be registered without their prior permission.[28] It means that mark registrants will be spared from being categorized as acting in bad faith and avoid cancellation and/or compensation lawsuits filed by famous individuals who feel aggrieved.

In line with what Sri Soemantri Martosoewignjo stated, the Marks Law that provides a legal basis for famous individuals to file for cancellation and/or compensation against others who use their name or abbreviation as a mark without their permission is a manifestation of the rule of law in Indonesia based on Pancasila. It is because a legal basis for famous individuals to file for cancellation and/or compensation against others who use their name or abbreviation as a mark without their

[26] *Ibid.*

[27] Sumanjeet Singh, "The State of IP Protection, Exploitation and Valuation: Evidence from Select Indian Micro, Small and Medium Enterprises (MSMEs)", *Journal of Enterpreneurship and Innovation in Emerging Economies*, Vol. 4, No. 2, 2018, p. 159.

[28] Grace Chan, "Domain Name Protection in Hong Kong: Flaws and Proposals for Reform", *International Journal of Law and Information Technology*, Vol. 13, No. 2, 2005, p. 206, 223.

permission proves that the Marks Law has indeed protected human rights and citizenship rights, especially for famous individuals.

The name or abbreviation of a famous individual, which was initially only a personal right, has also evolved into a form of property right, with the reputation of the famous individual becoming a tool for commercial and/or business activities, especially as a mark for goods or services. Therefore, the protection of famous individuals by granting them the right to file for cancellation and/or compensation against others who use their name or abbreviation as a mark without their permission is a manifestation of the protection of human rights as intended in Article 28C paragraph (1) of the 1945 Constitution, which states that ”Every person shall have the right to develop themselves through the fulfillment of their basic needs, the right to education and to benefit from science and technology, arts and culture to improve the quality of their life and for the welfare of humankind.”

Similarly, based on Article 28G paragraph (1) of the 1945 Constitution, which states that ”Everyone has the right to protection of their self, family, honor, dignity, and possessions under their control, as well as the right to security and protection from the threat of fear to do or not to do something that is a human right.” This provision is the constitutional basis for making regulations that protect the rights of celebrities to sue others who use their name or abbreviation as a mark without permission. This protection must be comprehensive between substantive law and procedural law so that what becomes the right of celebrities as stipulated in substantive law can be truly protected, fought for, and enforced through the right to sue in procedural law.

It is also in line with Article 28H paragraph (4) of the 1945 Constitution, which states that ”Everyone has the right to private property and that no one can arbitrarily take over property rights.” This constitutional provision can be used as a juridical basis for renewing the Marks Law to provide more protection to celebrities from others who use their name or abbreviation as a mark without their permission. Using a celebrity’s name or abbreviation as a mark without permission should be classified as an unlawful act that can be the subject of a mark cancellation lawsuit and/or civil damages. This is also in line with Article 3 paragraph (2) of Law Number 39 of 1999 regarding Human Rights, which states that ”Everyone has the right to recognition, guarantees, protection, and fair treatment under the law, as well as obtaining legal certainty and equal treatment before the law.”

Registration of a mark that consists of a name or abbreviation is a fundamental right for anyone. However, if the object is the name or abbreviation of a famous person, the right to obtain a mark must respect and honor the rights of others, in this case, the rights of the famous person. The prohibition on using the name or abbreviation of a famous person as a mark is a restriction on the right to obtain a mark. It is in line with the provisions of Article 28 J of the 1945 Constitution, which states that:

> ”(1) Every person shall have the duty to respect the human rights of others in the orderly life of the community, nation and state.

(2) In exercising his/her rights and freedoms, every person shall have the duty to accept the restrictions established by law for the sole purposes of guaranteeing the recognition and respect of the rights and freedoms of others and of satisfying just demands based upon considerations of morality, religious values, security and public order in a democratic society."

Based on the legal development theory proposed by Mochtar Kusumaatmadja, the renewal of mark law (Marks Law) which explicitly contains the rights of famous individuals to sue for cancellation and/or compensation against others who use their name or abbreviation as a mark, will lead society to respect these rights by not using them as a mark without permission. With this in mind, society, especially in mark registration, is directed to creatively and positively create its own brand to be used in trading goods and/or services so that economic activities can run smoothly and contribute to development. From another perspective, the renewal of mark law (MarksLaw), which explicitly and contains the rights of famous individuals to sue for cancellation and/or compensation against others who use their name or abbreviation as a trademark, will direct society to avoid mark disputes that will only hinder business activities and development in general.

Based on Robert Sherwood's theory of intellectual property protection, in relation to this research, the reputation of a famous person's name must be protected and respected. According to the theory of recovery[29], the creator or inventor who produces a creation or discovery by expending energy, time, and cost should be allowed to recover what they have expended. In relation to this research, the reputation contained in a famous person's name has been hard-earned through their performance and achievements, and therefore, special protection is needed, particularly the right to sue others who use their name as a mark without permission, so that the famous person can regain the right to use their name freely.

Based on the incentive theory, it is stated that to attract interest, efforts, and funds for the implementation and development of creative inventions, as well as to produce something new, an incentive is needed to stimulate research activities to occur again. In this regard, granting famous individuals the right to sue and receive compensation serves as its own incentive, restoring the famous individual's right to use their name freely, including registering their name as a mark.

The theory of risk[30] states that intellectual property is a risky endeavor, so it is reasonable to protect activities that involve such risks. The reputation of a famous person's name is highly risky to be used by others as a mark to attract attention, interest, and customers. Therefore, it needs special protection, especially in the form of the right to sue those who misuse their name. The name or abbreviation of a famous person is at high risk of being counterfeited or imitated by unscrupulous parties who deceive or mislead the public, using the reputation of the famous person. China[31], for instance, is aware of this risk and has created restrictions on mark registrations that should not cause

[29] Mostafa Bakhtiarvand, "Legal Nature and Protection of Domain Names with Emphasis on Iranian Law", *Journal of Intellectual Property Rights,* Vol. 21, No. 1, 2016, p. 166.

[30] Sumanjeet Singh, "The State of IP Protection, Exploitation and Valuation: Evidence from Select Indian Micro, Small and Medium Enterprises (MSMEs)", *Journal of Enterpreneurship and Innovation in Emerging Economies*, Vol. 4, No. 2, 2018, p. 159.

[31] Peter K Yu, "When the Chinese Intellectual Property System Hits 35", *Queen Mary Journal of Intellectual Property*, Vol. 8, No. 3, 2018, p. 3.

moral damage or social customs or other unhealthy social influences, as stated in Article 10 paragraph (8) of the China Trademark Act. This provision is widely used by the Chinese Trademark Review and Adjudication Board to cancel trademark registrations that use the names of famous people in China.

## CLOSING

Based on the analysis of the identified problems, it can be concluded that the legal principles that can be used as a basis for providing legal protection for celebrities to sue those who use their names or initials without permission as marks include the principle of good faith as stated in Article 21 paragraph (3) of the Marks Law and its Explanation, the principle of legal certainty, the *point d' interest* principle, the *point d' action* principle, and the legitima persona stands in *judicio* principle.

The legal theories that can be used as a basis for providing legal protection for celebrities to sue those who use their names or initials without permission as marks include the welfare state theory, the law and development theory as proposed by Mochtar Kusumaatmadja, and the theory of intellectual property protection as proposed by Robert Sherwood.

The *point d' interest* principle, *point d' action* principle, and legitima persona stands in judicio principle and should be incorporated into the legislation that regulates celebrities, specifically the Marks Law. These principles should be transformed into norms embodied in the revised Marks Law. The welfare state theory supports the norm for celebrities to sue for using their names in the revised Marks Law. With a strong legal basis, the proposed revision of Marks Law can be firmly supported

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