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Reconstruction of the Elements of the Criminal Offence of Using a Registered Trade Mark under the Trademarks and Geographical Indications Act

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Abstract

Based by Article 100 – 102 of the Trademark and Geographical Indication Law, the formulation of this article contains multiple interpretations or legal ambiguity (verge normen), that's was impact in issues ranging from the investigation stage to trial proceedings. These problems constitute a juridical rationale for the necessity of reconstructing the criminal offense provisions concerning the use of registered trademarks within the said law. This research is normative legal research employing a statute approach. The results indicate that the problems arising from multiple interpretations in Article 100 - 102 stem from the absence of clear and concrete boundaries regarding the criteria for the elements of the criminal act of using a registered trademark. This lack of distinction blurs the boundary between the criminal regime and civil trademark disputes—which should be resolved through civil lawsuits in the Commercial Court—thus causing judicial disparity in practice. Consequently, the findings of this normative research give rise to concepts for reconstructing the criminal provisions on the use of registered trademarks under the Trademark and Geographical Indication Law to address the deficiencies in Article 100 – 102 and optimize case resolution efforts aimed at realizing the principle of legal certainty.

Keywords: reconstructing, criminal act, registered trademark.

A. INTRODUCTION

In the enforcement of the law, every norm or rule contained in legislation must be capable of being applied in practice and must be enforceable. Otherwise, its application may result in errors, which may in turn give rise to injustice and legal uncertainty, as well as violations or misapplication of the law.

In practice, one of the causes of injustice is that not all laws applicable within society are governed by written law (*lex scripta*) or accompanied by clear provisions governing their

implementation. Ideally, however, legal provisions should be sufficiently clear in their application (*lex certa*)¹, in order to ensure legal certainty.

¹ Jan Remmelink, *Hukum Pidana: Komentar Atas Pasal-Pasal Terpenting dari Kitab Undang-Undang Hukum Pidana Belanda dan Padanannya dalam Kitab Undang-undang Hukum Pidana Indonesia*, Jakarta, PT Gramedia Pustaka Utama, 2003, Hlm. 358.

This issue relates to legal provisions governing the criminal offence of using a registered trade mark, which is classified as a prohibited act or, in criminal law, as an unlawful act (*wederrechtelijkheid*)² under Law No. 20 of 2016 on Trade Marks and Geographical Indications (State Gazette of the Republic of Indonesia 2016 No. 252; Supplement to the State Gazette of the Republic of Indonesia No. 5953). This is expressly provided for in Article 100 of the Law on Trade Marks and Geographical Indications.

The provisions concerning the elements of the criminal offence of using a registered trade mark are frequently subject to misinterpretation in practice, as they contain norms that are open to multiple interpretations. In particular, the provision does not clearly identify the objective and subjective elements of the offence, nor does it set out in clear and concrete terms what constitutes the act of using a registered trade mark. It also fails to establish clear boundaries and qualifying criteria for determining when a person may be held criminally liable under Article 100 of the Law on Trade Marks and Geographical Indications, including the criminal penalties prescribed under Article 100(1), (2) and (3).

The hypothesis and arguments advanced in this research arise from the lack of clarity surrounding the elements of the criminal offence under Article 100 of the Law on Trade Marks and Geographical Indications. These elements appear to overlap with the regime and jurisdiction applicable to civil disputes concerning the use of registered trade marks, which has contributed to disparities in judicial decisions in practice. For example, in Judgment No. 50/Pid.Sus/2023/PN.Tjk, the defendant was sentenced to two years' imprisonment and a fine of Rp10,000,000 (ten million rupiah). By contrast, in a similar case, Judgment No. 415/Pid.Sus/2025/PN Kpn in conjunction with Judgment No. 7590 K/PID.SUS/2026, both the first-instance and cassation panels of judges held that the offence had not been proven against the defendant. Accordingly, the defendant was found not to have been legally and convincingly proven to have committed the criminal offence of using a registered trade mark.

In the researcher's view, this disparity arises from ambiguous or unclear legal norms (*obscur libels*)³, particularly because the use of a registered trade mark is closely associated with the criminal offence of counterfeiting. This raises a further question: what is the legal position where the party using the trade mark is unaware that it has been registered? The situation is different where the trade mark in question is a well-known trade mark, the existence and identity of which may constitute a *fait notoire*, as it is generally known to the public.

Where there is substantial similarity between trade marks, the Law on Trade Marks and Geographical Indications also provides a right of action, allowing trade mark disputes to be resolved through civil proceedings before the Commercial Court. Where a trade mark considered to be an imitation has not been registered with the Directorate General of Intellectual Property, the party concerned would, admittedly, lack tangible legal protection. Nevertheless, this situation may serve as a basis for developing a legal framework in the future.

² *Ibid.*

³ Dominikus Rato, *Filsafat Hukum Mencari, Menemukan Dan Memahami Hukum*, Laksbang Pressindo, Yogyakarta, 2010, pg.59.

It is therefore hoped that, in the future, the jurisdiction of the Commercial Court will not be limited to examining disputes between holders of registered trade mark rights where the respective marks are substantially similar. Rather, its jurisdiction could also extend to determining whether a trade mark intended for registration satisfies the applicable requirements, is eligible for registration, or, at the very least, may validly be registered with the Directorate General of Intellectual Property. If such an approach to resolving trade mark disputes is not adopted and Article 100 of the Law on Trade Marks and Geographical Indications is instead applied as the primary means of resolving such matters, this would be inconsistent with the principle that criminal law should serve as a last resort (*ultimum remedium*)⁴.

In light of these issues, the researcher is concerned that, if Article 100 of the Trademarks and Geographical Indications Act is applied improperly, criminal law may be used merely as an instrument for punishing an individual, without any clear legal implications concerning the validity of the use of the registered trade mark.

Therefore, in the researcher's view, this is significant in that, in future, cases concerning the use of registered trade marks may be resolved through alternative means (negotiation, mediation, or civil proceedings), given that Articles 79 to 88 of Law No. 20 of 2025 on the Code of Criminal Procedure provide for restorative justice measures, without prioritising criminal punishment or sanctions.

Provisions concerning the criminal offence of using a registered trade mark have, in principle, been introduced as a preventive measure under the Law on Trade Marks and Geographical Indications. The problem, however, is that the criteria defining such criminal offences are not sufficiently clear to establish their precise scope. One of the shortcomings in the implementation of Article 100 of the Law on Trade Marks and Geographical Indications is the differing interpretations adopted by criminal law enforcement authorities, including the police, public prosecutors, advocates and judges. In practice, these differences in interpretation give rise to legal uncertainty. For this reason, the author considers it necessary to reconstruct the provisions governing the criminal offence of using a registered trade mark so that the legal norms contained in the Law on Trade Marks and Geographical Indications do not give rise to multiple interpretations in their application.

The legal norms concerning, in particular, the criminal offence of using a registered trade mark therefore require reformulation. This process should begin with the preparation of an academic paper based on the statutory framework established by Law No. 12 of 2011 on the Formation of Legislation (hereinafter referred to as the Law on the Formation of Legislation). The proposed framework for this reform involves clearly categorising the elements of the criminal offence of using a registered trade mark, including defining what constitutes an intentional act, what constitutes use of a registered trade mark, and the specific criteria applicable to such conduct. Clear legal boundaries should also be established, particularly with regard to matters falling within the jurisdiction of the Commercial Court in determining the validity of trade marks. The reconstruction of the legal classification of the criminal offence of using a registered trade mark is intended to ensure that

⁴ Sudikno Martokusumo, *Penemuan Hukum Sebuah Pengantar*, Rajawali Pers, 2009, pg.128.

the relevant legal provisions do not give rise to multiple interpretations or difficulties in their application.

The findings of this research, particularly those concerning the scope and limitations of the criminal offence regulated under Article 100 of the Law on Trade Marks and Geographical Indications, are expected to benefit relevant parties. They may serve as a reference for the institution authorised to formulate legislation, namely the House of Representatives, in developing new legal provisions, as well as for law enforcement authorities, including the police, public prosecutors, judges and advocates, in carrying out their respective functions.

Based on the issues outlined above, the researcher is interested in conducting a normative legal study entitled: 'Reconstruction of the Elements of the Criminal Offence of Using a Registered Trade Mark under the Law on Trade Marks and Geographical Indications'.

B. DISCUSSION

1. The scope of civil disputes under the Trademarks and Geographical Indications Act

Trade mark disputes are among the most common types of disputes arising within the field of Intellectual Property Rights (IPR) in Indonesia. This is understandable, as trade marks have evolved from merely serving as distinguishing signs into strategic instruments in modern business competition.

A trade mark constitutes a commercial identity that determines consumer loyalty, reputation, and the value of a company; consequently, control over a trade mark has become a strategic asset contested by business actors. In the Indonesian context, the increase in trade mark disputes can be seen from reports issued by the Directorate General of Intellectual Property (DJKI), which indicate a significant rise in the number of trade mark cancellation claims over the past five years. Furthermore, there has been an increase in the phenomenon of bad faith registration⁵, carried out by parties seeking to prevent the genuine trade mark owner from entering the Indonesian market or seeking to obtain financial gain through the buying and selling of trade marks that have already been registered.

One of the causes of the proliferation of trade mark disputes is that the trade mark registration procedure has not yet fully adopted rigorous substantive examination, with the result that many trade marks that are substantially similar to well-known trade marks continue to pass examination and become registered. This creates opportunities for third parties to register trade marks for speculative purposes⁶.

Furthermore, the development of the digital economy has also increased the potential for trade mark infringement. Counterfeit or imitation products can be easily distributed through e-commerce platforms and social media, which have a wide reach and limited oversight. This situation presents trade mark owners with new challenges in protecting and enforcing their rights.

Consequently, the role of the Commercial Court, as the institution authorised to adjudicate trade mark disputes, is vital in ensuring

legal certainty and the protection of the exclusive rights of registered trade mark owners. However, the effectiveness of the Commercial Court is not measured solely by the speed with which disputes are resolved, but also by the consistency of its judgments, the quality of the evidence, and the accuracy with which the provisions of the Trademarks and Geographical Indications Act are applied.

Law No. 20 of 2016 on Trademarks and Geographical Indications constitutes the principal legal basis for the resolution of trade mark disputes in Indonesia. The Trademarks and Geographical Indications Act provides for several types of civil claims that may be brought before the Commercial Court, including:⁷

- a) Trade mark infringement claims (Article 83);
- b) Trade mark cancellation claims (Articles 76–77);
- c) Trade mark deletion claims (Articles 72–73);
- d) Claims for damages and cessation of unlawful acts (Article 83(2));
- e) Deletion of a trade mark on the ground of non-use for three consecutive years (Article 74);

This legal framework reflects Indonesia's commitment to providing legal protection for registered trade mark owners through civil litigation. One of the characteristics of the Commercial Court is the relatively short timeframe for resolving cases, namely no later than 90 days from the date on which the claim is registered⁸.

However, the resolution of trade mark disputes does not depend solely on statutory provisions. There are many aspects that are interpretative in nature, such as:⁹

- a) assessing substantial similarity;
- b) proving bad faith;
- c) determining whether a trade mark qualifies as a well-known trade mark;
- d) analysing the market and consumer behaviour.

These aspects require specialised expertise on the part of Commercial Court judges in order to apply legal norms appropriately. In many cases, the obstacles that arise do not stem from deficiencies in the legal norms themselves, but from inconsistencies in interpretation and differences in judicial reasoning when assessing a trade mark dispute¹⁰.

Proceedings before the Commercial Court are known for being swift and structured, in keeping with the nature of the institution, which was established to handle commercial and intellectual property disputes efficiently. The proceedings commence with the claimant reading out the statement of claim, which contains a comprehensive account of the facts of the case, the legal basis, and the relief sought. Once the statement of claim has been presented, the defendant is given the opportunity to submit a defence, which

⁷ See Articles 72 to 83 of the Trademarks and Geographical Indications Act

⁸ S.Sudaryo, Efektivitas pengadilan niaga dalam penyelesaian sengketa merek pasca UU Merek 2016, Jurnal Hukum PRIORIS, 6(2), pg.190–210.

⁹ Sudaryat, Sudjana, dan Rika Ratna Permata, Hukum Kekayaan Intelektual Cakupan dan Prinsip Dasar, Global Sinergi Indonesia, Bandung: 2019, pg. 110-117.

¹⁰ Ibid.

⁵ D. Kurniawan, Efektivitas gugatan perdata dalam sengketa merek di Indonesia, Yuridika, 2017, Jakarta, pg. 112-129

⁶ Ibid.

typically includes rebuttals, preliminary objections, and initial evidence in support of their position¹¹.

The next stage consists of the reply and rejoinder, namely the process by which the claimant and defendant exchange responses to each other's legal arguments. At this stage, the principal issues in dispute usually begin to crystallise, including debates concerning trade mark similarity, visual and phonetic elements, or allegations of bad faith in the filing of the trade mark.

The most crucial part of the proceedings is the evidential stage. In the Commercial Court, evidence frequently consists of documents, factual witnesses, and, more importantly, expert testimony.¹²

Commercial Court judges rely heavily on experts in the field of Intellectual Property Rights (IPR), given the technical complexity involved in assessing the degree of trade mark similarity, the existence of well-known trade marks, market behaviour, consumer perception, as well as linguistic and graphic analysis. Such expert opinions play a significant role in assisting judges in understanding technical matters that cannot always be fully established through documentary evidence alone¹³.

Once the evidential stage has been completed, the parties are given the opportunity to submit written conclusions. This stage serves to summarise all the legal arguments and factual analyses presented during the proceedings. Finally, the judge delivers a final judgment within the jurisdiction of the Commercial Court. Such judgments typically contain orders to cancel a trade mark registration, cease the use of a particular trade mark, or dismiss the claim if it is deemed unproven¹⁴.

Normatively, judgments of the Commercial Court are final and binding, particularly in trade mark disputes for which no right of appeal is available. However, the reality in practice demonstrates that the enforcement of judgments often constitutes a weak point that hinders the effectiveness of the trade mark protection system¹⁵.

One of the most common obstacles is the slow pace of the enforcement process. Although a judgment may already have acquired permanent legal force (*inkracht*), the implementation of orders to cease the use of a trade mark or withdraw products is frequently delayed for administrative and technical reasons.

Furthermore, there is also resistance on the part of defendants to complying with judgments. In some cases, defendants continue to use trade marks that have been declared infringing until the claimant submits a further application for enforcement¹⁶.

Another issue is the absence of an effective monitoring mechanism for the implementation of judgments. Monitoring the continued use of infringing trade marks should be supported by the government; however, limited resources and inadequate coordination mean that

the implementation of judgments often depends entirely on the initiative of the trade mark owner.¹⁷

Furthermore, the use of cassation proceedings by defendants is often employed as a strategy to delay enforcement. Although cassation does not automatically suspend the enforcement of a judgment, in practice many authorities await the outcome of cassation proceedings in order to avoid potential administrative errors.

Consequently, disputes that should be resolved within a relatively short period may instead become protracted.

Based on the findings of the research and analysis concerning the resolution of trade mark disputes through civil proceedings before the Commercial Court, several recommendations may be put forward to enhance the effectiveness of legal protection for trade mark owners in Indonesia. Strengthening the trade mark protection system must begin with improving the institutional quality of the Commercial Court itself.

It is therefore important for the state to provide greater support for enhancing the competence of judges handling Intellectual Property Rights (IPR) cases.

Commercial Court judges should be provided with continuous training concerning global developments in IPR law, techniques for analysing trade mark similarity, an understanding of consumer behaviour, and methodologies for assessing bad faith.

Strong analytical skills, combined with a thorough understanding of the creative industries and branding mechanisms, will improve judicial precision in adjudicating trade mark disputes, which are becoming increasingly complex alongside the development of digital commerce.

In addition to improving judicial competence, there is also a need to formulate more detailed and standardised evidential guidelines. In many cases, a lack of clarity regarding evidential standards leads to inconsistent judgments and legal uncertainty for the parties involved.

These guidelines should cover the principal parameters for assessing substantial similarity, methods for evaluating well-known trade marks, standards governing the use of consumer surveys, and indicators that may be used to assess the existence of bad faith in trade mark registration. The standardisation of evidential rules will also assist the parties in preparing more relevant legal arguments and evidence, thereby enabling court proceedings to be conducted more effectively without incurring excessive time and costs.

Improvements must also be made to the mechanisms for enforcing judgments. One of the most prominent weaknesses in the resolution of trade mark disputes is the slow implementation of judgments, which ultimately diminishes the effectiveness of the legal protection itself¹⁸.

Coordination between the Commercial Court, court clerks, bailiffs, and the Directorate General of Intellectual Property needs to be

¹¹ *Ibid.*

¹² *Ibid.*

¹³ *Ibid.*

¹⁴ *Ibid.*

¹⁵ *Ibid.*

¹⁶ *Ibid.*

¹⁷ Insan Budi Maulana, et.al., Pengantar (Akta) Perjanjian Hak Kekayaan Intelektual Untuk Notaris dan Konsultan HKI, PT Citra Aditya Bakti, 2021, Bandung, pg. 77-83

¹⁸ *Ibid.*

strengthened so that judgments which have acquired permanent legal force can be implemented without delay.

A stricter monitoring mechanism is also required to ensure that the losing party genuinely ceases the use of the trade mark that has been declared unlawful.

A firm approach to the enforcement of judgments will enhance the deterrent effect on business actors who may potentially commit trade mark infringements¹⁹.

To minimise the potential for future disputes, improving the quality of substantive examination at the trade mark registration stage is also an urgent priority. Trade mark examiners, in this case the Directorate General of Intellectual Property, should be provided with additional training so that they are able to assess trade mark similarity more accurately and identify indications of bad faith from the outset²⁰.

Updating information systems, digitising the trade mark database, and integrating automated trade mark search technology can assist the Directorate General of Intellectual Property in detecting similarities between trade marks more effectively. Rigorous substantive examination will prevent the registration of trade marks that are visually, phonetically, or conceptually similar to other trade marks that have already been registered, thereby reducing the number of disputes brought before the courts. In addition, protection for well-known trade marks must be clarified both in law and in practice.²¹

Judges should be provided with clearer guidance regarding the parameters that may be used to assess the reputation of a trade mark, including sales data, promotional activities, market coverage, and public recognition at both national and international levels. Harmonisation with international standards, such as the TRIPS Agreement and WIPO recommendations, must continue to be strengthened so that Indonesia is able to implement an IPR protection regime comparable to those of other countries within the global trading system²².

Finally, improvements to the trade mark dispute resolution system cannot be pursued in isolation from developments in technology and the digital economy. Accordingly, more adaptive monitoring mechanisms are required to address patterns of trade mark infringement on digital platforms, whether in the form of the sale of counterfeit goods or the unauthorised use of trade marks on social media and online marketplaces.

Collaboration between the government, digital platform providers, and trade mark owners will be key to building a more responsive and modern trade mark protection ecosystem. Overall, these recommendations constitute complementary efforts to strengthen the legal system for trade mark protection in Indonesia.

If all of these recommendations are implemented consistently, it is expected that the Commercial Court will be able to function more effectively as an institution capable of providing legal certainty, justice, and substantive protection for trade mark owners amid the rapid development of national and international trade.

¹⁹ *Ibid.*

²⁰ *Ibid.*

²¹ *Ibid.*

²² *Ibid.*

2. Scope of the Criteria for Criminal Offences under the Trademarks and Geographical Indications Act

Trade mark rights constitute individual property rights; however, this does not extinguish the possibility of criminal prosecution against those who infringe registered trade mark rights. Therefore, in order to ensure that the exercise of such rights proceeds in an orderly manner, the state also imposes criminal sanctions for certain infringements of the Trademarks Act and other relevant statutory provisions. In other words, the right to bring a claim for damages does not diminish the state's right to institute criminal proceedings in respect of infringements of trade mark rights²³.

The Trademarks and Geographical Indications Act does not further specify the various forms of criminal offences relating to trade mark rights; nevertheless, it is clear that acts infringing the rights of the owner of a registered trade mark constitute criminal offences in the field of trade marks, as provided for in Articles 100 to 103 of the Trademarks and Geographical Indications Act.

The Trademarks and Geographical Indications Act prescribes criminal penalties for any person who, intentionally and without authorisation, uses a trade mark that is identical in its entirety or substantially similar to a registered trade mark belonging to another party. Such conduct constitutes a criminal offence, the applicable penalties for which are provided for in Articles 100, 101, and 102 of the Trademarks and Geographical Indications Act.²⁴

Furthermore, the Trademarks and Geographical Indications Act also prescribes criminal penalties for any person who, intentionally and without authorisation, uses a sign that is identical in its entirety or substantially similar to a geographical indication belonging to another party. Similarly, criminal penalties are imposed on any person who indicates the true origin of goods resulting from an infringement, or includes wording suggesting that such goods are imitations of goods registered and protected under a geographical indication.

Such conduct also constitutes a criminal offence, the applicable penalties for which are provided for in Article 102 of the Trademarks and Geographical Indications Act. Furthermore, Article 101(2) of the Trademarks and Geographical Indications Act also imposes criminal penalties on any person who, intentionally and without authorisation, uses a sign protected as an indication of origin on goods or services in such a way as to deceive or mislead the public as to the origin of those goods or services. This type of conduct also constitutes a criminal offence.

Any person who trades in goods and/or services while knowing, or having reasonable grounds to know, that such goods or services use a registered trade mark belonging to another party or use a sign protected as a geographical indication or indication of origin is liable for an offence or for conduct deemed unlawful²⁵.

²³ Rahmi Jened, *Hukum Merk Trademark LAW Dalam Era Global Integrasi Ekonomi*, Jakarta:

Prenada Media Group, 2019 pg.6

²⁴ *Ibid.*

²⁵ See Articles 100 to 102 of the Trademarks and Geographical Indications Act.

The applicable criminal penalties are set out in Article 101 of the Trademarks and Geographical Indications Act. The full provisions concerning criminal offences in the field of trade marks are as follows:

Pasal 100

- 1) *Setiap Orang yang dengan tanpa hak menggunakan Merek yang sama pada keseluruhannya dengan Merek terdaftar milik pihak lain untuk barang dan/atau jasa sejenis yang diproduksi dan/atau diperdagangkan, dipidana dengan pidana penjara paling lama 5 (lima) tahun dan/atau pidana denda paling banyak Rp2.000.000.000,00 (dua miliar rupiah).*
- 2) *Setiap Orang yang dengan tanpa hak menggunakan Merek yang mempunyai persamaan pada pokoknya dengan Merek terdaftar milik pihak lain untuk barang dan/atau jasa sejenis yang diproduksi dan/atau diperdagangkan, dipidana dengan pidana penjara paling lama 4 (empat) tahun dan/atau denda paling banyak Rp2.000.000.000,00 (dua miliar rupiah).*
- 3) *Setiap Orang yang melanggar ketentuan sebagaimana dimaksud pada ayat (1) dan ayat (2), yang jenis barangnya mengakibatkan gangguan kesehatan, gangguan lingkungan hidup, dan/atau kematian manusia, dipidana dengan pidana penjara paling lama 10 (sepuluh) tahun dan/atau denda paling banyak Rp5.000.000.000,00 (lima miliar rupiah).*

Pasal 101

- 1) *Setiap Orang yang dengan tanpa hak menggunakan tanda yang mempunyai persamaan pada keseluruhan dengan Indikasi Geografis milik pihak lain untuk barang dan/atau produk yang sama atau sejenis dengan barang dan/atau produk yang terdaftar, dipidana dengan pidana penjara paling lama 4 (empat) tahun dan/atau denda paling banyak Rp2.000.000.000,00 (dua miliar rupiah).*

Setiap Orang yang dengan tanpa hak menggunakan tanda yang mempunyai persamaan pada pokoknya dengan Indikasi Geografis milik pihak lain untuk barang dan/atau produk yang sama atau sejenis dengan barang dan/atau produk yang terdaftar, dipidana dengan pidana penjara paling lama 4 (empat) tahun dan/atau denda paling banyak Rp2.000.000.000,00 (dua miliar rupiah).

Pasal 102

Setiap Orang yang memperdagangkan barang dan/atau jasa yang diketahui atau patut diduga mengetahui bahwa barang dan/atau jasa dan/atau produk tersebut merupakan hasil tindak pidana sebagaimana dimaksud dalam Pasal 100 dan Pasal 101 dipidana dengan pidana kurungan paling lama 1 (satu) tahun atau denda paling banyak Rp200.000.000,00 (dua ratus juta rupiah).

There are seven types of acts or activities categorised as criminal offences in the field of trade marks²⁶, namely:

1. using a trade mark that is identical in its entirety to a registered trade mark belonging to another party for similar goods and/or services that are produced and/or traded.

2. This trade mark offence is provided for in Article 100, and its constituent elements are as follows:
 - a. intentionally;
 - b. without authorisation;
 - c. using a trade mark that is identical in its entirety to a registered trade mark belonging to another party for similar goods and/or services that are produced and/or traded.

Using a trade mark that is substantially similar to a registered trade mark belonging to another party for similar goods and/or services that are produced and/or traded; this trade mark offence is provided for in Article 101, and its constituent elements are as follows:

- a. intentionally;
- b. without authorisation;
- c. using a trade mark that is substantially similar to a registered trade mark belonging to another party for similar goods and/or services that are produced and/or traded.
3. using a sign that is identical in its entirety to a geographical indication belonging to another party for goods that are the same as or similar to the registered goods; this type of trade mark offence is provided for in Article 102(1), and its constituent elements are as follows:
 - a. intentionally;
 - b. without authorisation;
 - c. using a sign that is identical in its entirety to a geographical indication belonging to another party for goods that are the same as or similar to the registered goods.
4. Using a sign that is substantially similar to a geographical indication belonging to another party for goods that are the same as or similar to the registered goods; this criminal offence is regulated under Article 101(2), and its constituent elements are as follows:
 - a. intentionally;
 - b. without authorisation;
 - c. using a sign that is substantially similar to a geographical indication belonging to another party for goods that are the same as or similar to the registered goods.
5. The indication of the true origin on goods resulting from an infringement, or the inclusion of wording indicating that the goods are imitations of goods registered and protected under a geographical indication; such conduct is subject to the criminal penalties referred to in Article 101(1) and (2).
6. Using a sign protected as an indication of origin on goods or services in a manner capable of deceiving or misleading the public as to the origin of those goods or services; from Article 100, which constitutes the legal basis for this criminal offence, the constituent elements may be identified as follows:
 - a. intentionally;
 - b. without authorisation;
 - c. using a sign protected as an indication of origin on goods or services;

²⁶ *Ibid.*

- d. in a manner capable of deceiving or misleading the public as to the origin of the goods or services concerned.
7. Trading in goods and/or services where it is known, or ought reasonably to be known, that such goods and/or services are the result of an infringement as referred to in Article 100, Article 101, and Article 102; this type of criminal offence is provided for in Article 102, and its constituent elements are as follows:
 - a. trading in goods and/or services;
 - b. knowing or having reasonable grounds to know;
 - c. that the goods and/or services are the result of an infringement as referred to in Articles 100, 101, and 102.

Viewed from the perspective of the offender's culpability, the Trademarks Act defines criminal offences in the field of trade marks as offences committed intentionally and without authorisation, for which the applicable penalties may be four years, five years, or ten years' imprisonment. Consequently, not all offenders are necessarily subject to detention or imprisonment. The criminal sanctions provided for are both cumulative and alternative in nature, consisting of imprisonment and fines.

Accordingly, judges may impose criminal sanctions. Trade mark imitation is frequently caused by trade mark applicants who register their trade marks in bad faith. It is difficult to establish whether an individual has acted in good faith because Indonesian law applies the principle that the first person to register is the person entitled to the trade mark, rather than the first person to use it, commonly referred to as the 'first come, first served' principle²⁷.

However, many first users of a trade mark have not yet registered their trade marks, or have attempted to register them but were preceded by another party. Accordingly, it must be demonstrated that the registrant acted in good faith and was not merely seeking to take advantage of the reputation of an existing trade mark²⁸.

Accordingly, the benchmark for good faith in trade mark registration is that the application is made properly and honestly, without any intention to take advantage of, imitate, or copy another party's trade mark for the applicant's own business interests in a manner that causes loss to another party or misleads consumers, and that the trade mark does not bear substantial or overall similarity to a trade mark already registered in the name of another party²⁹.

However, in practice, it is not easy to conclude that bad faith exists in the registration of a trade mark. In the business world, a trade mark is not merely a distinguishing feature between one product and another³⁰.

For business owners, a trade mark constitutes a highly valuable asset. Bad faith constitutes conduct which, in addition to being unlawful, also causes economic loss to other parties.

Trade marks are highly beneficial both to producers, as trade mark owners, and to consumers. For producers, trade marks serve as a

means of promotion in the marketing of the goods or services they produce, whereas for consumers, trade marks are useful for identifying, or providing assurance as to, the quality of the goods they intend to use.

In light of these legal issues, the researcher's analysis indicates that the provisions concerning unlawfulness under the Trademarks and Geographical Indications Act require reformulation, particularly with regard to the boundaries of matters falling within the scope of civil law and the establishment of clear boundaries concerning criminal offences within the scope of the Trademarks and Geographical Indications Act.

C. CONCLUSION

Based on the research and analysis conducted by the researcher, the following conclusions may be drawn:

1. The resolution of trade mark disputes through litigation reveals complex dynamics. Such disputes concern not only the assessment of whether substantial similarity exists, but also the understanding of fundamental concepts such as bad faith, the protection of well-known trade marks, the use of trade marks in commerce, and the impact of consumer behaviour in assessing the likelihood of confusion;
2. Within the civil sphere, the quality of Commercial Court judgments continues to show considerable variation, particularly in relation to the interpretation of substantial or overall similarity, which frequently lies at the heart of trade mark disputes.
3. This inconsistency results in a low degree of legal predictability in practice and may create uncertainty for business actors; evidential issues also constitute a substantial obstacle in the resolution of trade mark disputes.
4. One of the principal weaknesses of the trade mark dispute resolution system is the slow pace of enforcement, or even the failure to enforce judgments despite their having become *inkracht* (final and binding). This diminishes the practical value of court judgments and may undermine public confidence in the judicial process.
5. Although the resolution of trade mark disputes through civil litigation essentially rests on a strong normative foundation, improvements are still required in relation to implementation, interpretation, evidential matters, and enforcement. Strengthening these four aspects constitutes a strategic measure to ensure that the trade mark protection system in Indonesia operates not only procedurally, but also substantively, effectively, and fairly, in line with global economic developments and the needs of business actors.
6. There is a need to reconstruct the relevant legal norms in order to reassess the effectiveness of the criminal sanctions provided for under the Trademarks and Geographical Indications Act.
7. Furthermore, consideration should be given to revising the legal character of complaint-based offences in certain cases involving broader public interests, such as the counterfeiting of pharmaceutical or food trade marks, so

²⁷ *Ibid.*

²⁸ *Ibid.*

²⁹ *Ibid.*

³⁰ *Ibid.*

that the state may act proactively without awaiting a complaint from the trade mark owner; offences that were previously complaint-based should therefore be reclassified as public offences.

The Trademarks and Geographical Indications Act also does not further specify the various forms of criminal offences relating to trade mark rights; however, it is clear that acts infringing the rights of the owner of a registered trade mark constitute criminal offences in the field of trade marks, as provided for in Articles 100 to 103 of the Trademarks and Geographical Indications Act.

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