

## **ENFORCING TRADE DRESS IN INDONESIA – Is it worth the effort?**

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The term “Trade Dress”<sup>1</sup> is not defined in Law No. 20 of 2016 on Trademark and Geographical Indication (the “**Trademark Law**”). However, the Trademark Law provides protection to non-traditional marks, such as shape/3D mark, sound mark, color composition, and the combination of the aforementioned. This means that the protection of Trade Dress, which consists of more than one element, such as word, shape, colors, etc. are covered in the Trademark Law. Then, the million-dollar question is – whether Trade Dress can be enforced effectively in Indonesia?

The below are the available legal actions provided by the Trademark Law that can be utilized to enforce Trade Dress infringement in Indonesia:

### **Criminal enforcement**

Criminal enforcement in Indonesia has never been a straight-forward matter. The pre-trial process is rather lengthy. Meanwhile, the court trial process may take months or a year to obtain a final and binding decision. In terms of criminal penalty, a fine of up to 5.000.000.000 IDR (approximately USD320,000) and/or up to 10 years of imprisonment can be imposed to a trademark infringer. It is also important to note that the criminal provisions in the Indonesian Trademark Law is based on complaint by holder of the infringed registered trademark.

### **Civil enforcement**

Compared to the criminal enforcement, the process of civil enforcement (trademark infringement lawsuit) can be shorter, although this is a case by case basis.

In a trademark infringement lawsuit, the following remedies can be requested in the relief:

- a. claim for damages; and/or
- b. cease of all actions relating to the use of the mark(s).

It is also possible to request for preliminary injunction since The Indonesian Trademark Law provides the mechanism to do so, however, cases where such mechanism have been used are scarce.

Aside from trademark infringement lawsuit, the Trademark Law also provides on trademark cancellation and non-use deletion. Below is a peek of both:

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<sup>1</sup> <https://www.merriam-webster.com/legal/trade%20dress> - the overall image of a product used in its marketing or sales that is composed of the nonfunctional elements of its design, packaging, or labeling (as colors, package shape, or symbols).

### **Cancellation action**

Just like its name, this action can be taken to cancel a registered mark which is the same or substantially similar to a priorly registered trademark. A latter trademark application may be used as a basis to cancel an earlier registration if the reputation of the latter application can be proven. Cancellation action can be filed within five (5) years commencing from the registration date of the registration that would like to be cancelled (Target Mark). Exemption may apply if bad faith of the Target Mark holder can be proven.

### **Non-use deletion**

A non-use deletion lawsuit can be filed to delete a trademark registration which has not been used for three (3) consecutive years. Proofing non-use in Indonesia is rather challenging since finding an objective and representative evidence of such non-use is not easy. There are cases of successful non-use deletion but since the Indonesian law does not implement the *stare decisis* doctrine, thus the success of the previous cases cannot always be used as the main references in court.

### **DLBP Comments**

Despite the above provided actions, in terms of Trade Dress enforcement, aiming for amicable settlement with the infringing party is an attempt that is worth to try before taking a further legal action.

In this case, to have spot-on registrations is fundamental (make sure that the elements which the infringer are copying are ready in your arsenal to strengthen the base of your argument). Strategizing on which action(s) to take is also an important matter.

A sample of Trade Dress infringement in Indonesia is the case of a popular cookie product, namely OREO vs RODEO and OREO vs ORIORIO. Wherein OREO has filed a cancellation action against RODEO and ORIORIO in separate lawsuits. However, in this case, the cancellation actions that have been taken cannot stop the other party from using a similar color tone and design on their packaging (Trade Dress).

Conclusively, cancelling trademark registration(s) is sometimes insufficient to stop the circulation of the Trade Dress infringing goods in the market. A well-thought approach and strategy is required in this kind of case. Discussion and consultation with a **well-versed Intellectual Property Attorney** are therefore recommended to ensure the effectiveness of Trade Dress enforcement.

*Note: This article does not constitute as a legal advice. Shall you need any legal assistances, please reach out to [dlp@dlplawoffices.com](mailto:dlp@dlplawoffices.com).*