

Post-Accession of the Madrid Protocol by Indonesia: The Roles of the Indonesian IP Attorneys

On September 30th, 2017 the Indonesian President, Joko Widodo, executed the Presidential Regulation No. 92 of 2017 on Legalization of Protocol Relating to the Madrid Agreement concerning the International Registration of Mark, 1989. In consequence, Indonesia is officially open for international registrations (of mark). It means that mark owners from Indonesia are now able to file mark applications in various contracting states directly through the International Bureau and vice versa, mark owners from any contracting states may file applications directly to Indonesia through the International Bureau. Although it seemingly eliminates the involvement of Indonesian IP Attorneys within an international registration process from or to Indonesia, in practice it has been showing the opposite. Indonesian IP Attorneys like us indeed have important roles within the international registration process, especially when Indonesia is targeted as the designated state of registration.

Generally, the mark registration process is never a straight-forward process and Indonesia is no exception. Opposition from a third party during the publication period and office action from the Indonesian trademark office are some of the obstacles that are needed to be dealt with during a registration process. Filing through the International Bureau by virtue of the Madrid Protocol will not eliminate the previously-mentioned steps since the system provided by the Madrid Protocol only covers administrative matters of a registration process, while the substantive matters of the registration process are still handled by the national office of the designated states.

Moreover, the international registration system has a fatal weakness, which is the dependency of the International Registration to the basic mark (the registration or application in the country of origin). If a basic registration or application in the country of origin is ceased (due to cancellation or refusal), hence the international registration will be affected. This is what sometimes referred to as the "central attack". However, it can be mitigated by doing the transformation of International Registration. It is done by transforming the International Registration into a series of national registrations (normal/direct registrations) or national applications (normal/direct applications) in the designated countries within 3 months after the international registration ceased. This mechanism, of course, requires the assistance of local IP Attorneys like us.

The Indonesian IP Attorneys like us also can help clients once their marks that are filed through the International Bureau are rejected by the Indonesian Trademark Office by filing appeals to the Trademark Appeal Commission.

In conclusion, there are several key roles that we can run as the Indonesian IP Attorneys within the international registration system (when Indonesia is targeted as the designated state), which are:

1. Handling the transformation of international registration subsequent to the cessation of the basic registration or application;
2. Dealing with opposition from other parties during the publication period of a mark that is filed through the International Bureau or to file an opposition during the publication period against a mark that is filed through the international bureau;
3. Dealing with office action (provisional refusal and/or permanent refusal) from the Indonesian Trademark Office during the national phase; and
4. Filing an appeal to the Trademark Appeal Commission once a mark that is filed through the International Bureau is rejected by the Indonesian Trademark Office.