

Legal Protection for Brand Buyers Related to the Use of Portrait Images on Trademarks That Have Been Transferred

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Abstract

In the era of globalization, brands play an important role in regulating the development of world trade. Brands are used in the world of commerce to differentiate one product from another. Brand owners often use self-portrait logos with the aim of letting consumers know the owner or as a sign that the product is genuine. Disputes regarding brands are common in Indonesia, one of which involves the use of a portrait of Mrs. M on the trademark used in telon oil product packaging. This happened because previously the Ny. M was transferred due to bankruptcy so that the Right to the Mark was transferred to another party. There is a portrait of Mrs. M becomes a problem because it is considered not to be an integral part of the trademark, but is a stand-alone Copyright. The transfer of rights to the mark should include all the marks on the mark because the marks on the mark have become one and cannot be separated.

Keywords

portrait image; trademark; legal protection



I. Introduction

On reality the development of today's society, economic and commercial factors have an important role in the structure of people's lives, people often face intellectual property rights problems in the form of violations, namely brand violations. This modern eramakethe competition faced by society is verystrict.This happens because many companies offer productssimilararto meet consumer needsertain, and competition is getting tougherin situationthis.

On the era of trade globalization is growing, so that business entities need expertise to see market conditions to choose the quality of goods and services that can satisfy buyers, especially brands. A brand is a symbol of a product made by a trader. Intellectual property rights (hereinafter referred to as HKI) play an important role in regulating the development of global trade which is increasingly advancing along with the times.

Intellectual Property Rights are rights that are exclusive or special because they are only owned by someone as a result of intellectual and creative activities that require thought, time, energy, and are based on awareness and emotional results. IPR is basically divided into 2 (two) things, namely Industrial Property Rights and Copyrights. The scope of Industrial Property Rights is further divided into several rights, namely: Patent Rights, Trade Secrets, Trademarks, Industrial Designs, Plant Variety Protection, Integrated Circuit Layout Designs.

In industrycommercial, brandtrade isone formintellectual property rightswhich has been used for hundreds of years and plays an important role because it is used to differentiatesourcegoods andservice.A brand can be a very valuable business asset and the brand itself often makes the price of a product expensive or even more valuable than the company itself.

Trademarks as referred to in Article 1 point 2 of the Law on Marks and Geographical Indications stipulates that: "Trademarks are marks used on goods traded by a person or several persons jointly or by legal entities to distinguish them from other similar goods". Brands have strategic and important value for producers and consumers. For manufacturers, brands need not only to differentiate their products from other similar companies' products, but also to build a corporate image, especially in marketing. For consumers, the brand is a symbol of self-esteem in addition to identity. People who are accustomed to choosing certain brand products tend to continue to use that brand's products for various reasons, including: I've known for a long time, so trust in the quality of the product.

In addition, in the retail industry, brand owners often use self-portrait logos to differentiate the product from the product of others. This is done as a sign that means to make consumers know the owner to show that this product is genuine. Brands that use portraits of their owners include Mrs. Fried Chicken, Suharti, Pak Sadi's ambengan chicken soup, Mrs Meneer's herbal medicine, and so on.

The use of portraits for commercial purposes basically must be with the permission of the subject or person in the portrait image, even if the subject has died, the permission of the heirs must be obtained because the owner of the body on the portrait has rights, namely economic rights and moral rights. Using portrait images without permission which then generates economic benefits for other parties, of course harms the subject in the portrait image as the sole subject of the creator or copyright holder.

The economic condition of the population is a condition that describes human life that has economic score (Shah et al, 2020). Economic growth is still an important goal in a country's economy, especially for developing countries like Indonesia (Magdalena and Suhatman, 2020).

One of the cases that occurred in Indonesia related to IPR was the case of using a portrait of Mrs. M on telon oil product packaging. In 2017 PT BEM is known to have purchased 72 (seventy two) trademarks of Mrs. M legally through auction and the trademark has been registered with the Directorate General of Intellectual Property (hereinafter abbreviated as DJKI). In 2020, CS as the grandson of the founder of a leading herbal medicine company, Mrs. M sued PT BEM to the court with a lawsuit related to the use of a portrait of Mrs. M on the packaging of telon oil products, because according to him, the purchase of the trademark that has occurred does not include a portrait of Mrs. M. PT BEM has used a portrait of Mrs. M is without permission.

Based on the existing cases as described above, can a brand consisting of various signs which are then transferred to other people be used entirely or not by the new owner? Seeing the explanation of CS which said that the trademark that had been transferred was not included in the portrait of Mrs. M so that PT BEM was deemed not entitled to use the portrait of Mrs. M on the packaging of telon oil products that have been marketed and PT BEM is considered not to have asked for permission in advance to use the portrait image of Mrs. the M.

Based on the description and explanation of the background above, the problems obtained are: "What is the form of legal protection for the use of portraits of Mrs. M on a trademark that has been transferred and registered to PT BEM?"

II. Research Method

The type of research method used is normative juridical legal research, namely legislation or other literature, with this method to examine related legal materials to answer the problems in this research. Journal writing is carried out using 3 (three) problem approaches, including the statutory approach, the conceptual approach, and the case approach. The approach to legislation is carried out by examining laws relating to the legal issues being handled to obtain the material discussed. In a conceptual approach, scholars' views or legal doctrines can be found that can be used as a basis for argumentation to give prescriptions on a legal issue. The case approach is carried out by examining cases related to the issues at hand. The legal materials used in this journal are primary legal materials and secondary legal materials. Primary legal materials, which are several laws and regulations, namely Law Number 20 of 2016 concerning Marks and Geographical Indications, Law Number 28 of 2014 concerning Copyright, and the Civil Code. Secondary Legal Materials are all literature, magazines, and information from print and electronic media that support the writing of this journal. The materials that have been collected are processed to be selected and classified according to the problems to be discussed.

III. Results and Discussion

The use of a portrait of Mrs. M in a telon oil product marketed by PT BEM is considered without written permission or approval and violates the economic rights contained in copyright. First, it is necessary to look at the notion of Copyright and portrait images. The definition of Copyright in Article 1 point 1 UUHC that: Copyright is the exclusive right of the creator that arises automatically based on declarative principles after a work is manifested in a tangible form without reducing restrictions in accordance with the provisions of laws and regulations". In connection with this provision, the copyright for the portrait of Mrs. M is owned by PT Perindustrian Ny. M which includes moral rights and economic rights. The definition of portrait according to Article 1 number 10 UUHC, stipulates that: "Portrait is a photographic work with human objects". According to this provision, portrait rights are the exclusive rights of the creator and occur automatically according to declarative principles. Creators can get rights without registering first.

The economic right to portraits is regulated in Article 12 paragraph (1) of the UUHC, which stipulates that: "Everyone is prohibited from carrying out Commercial Use, Reproduction, Announcement, Distribution, and/or Communication of portraits made for the purposes of commercial advertisements or advertising without approval written from the person photographed or his heirs. Based on the provisions of Article 12 paragraph (1) of the UUHC, it can be said that everyone must obtain prior approval when utilizing the portrait work from the person being photographed or their heirs.

Using a portrait as a copyright work and a portrait used as a mark are 2 (two) different things, because copyright and trademark rights are protected by different laws and regulations and use different registration systems. Talking about a brand, according to the KBBI, a brand is a sign used by entrepreneurs, both factories, manufacturers, and others on the goods produced as identification. According to the provisions of Article 1 point 1 of the Law on Marks and Geographical Indications, the definition of a mark is:

A sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in the form of 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to

distinguish goods and/or services produced by persons or legal entities in the activities of trading goods and/or services.

According to the provisions of Article 1 point 1 of the Trademark Law and Geographical Indications above, the definition of a mark can be said to be a combination of several designations which include images, logos, names, words, letters, numbers, and so on in accordance with the provisions of the Law on Marks and Geographical Indications. This shows that the brand Mrs. M has complied with the provisions of Article 1 point 1 of the Trademark Law and Geographical Indications because Mrs. M is a combination of several signs containing pictures, names, words, and also colors used to distinguish them from goods and/or services produced by other parties.

According to the provisions of Article 1 point 5 of the Law on Marks and Geographical Indications that: "Right to a Mark is an exclusive right granted by the state to the owner of a registered Mark for a certain period of time by using the Mark himself or giving permission to another party to use it". Right to a Mark is obtained after the Mark is registered, this is stated in the provisions of Article 3 of the Law on Trademarks and Geographical Indications. In connection with that it can be said that the registered mark can only be used by the owner of the registered trademark or any other party with the written approval of the laws governing the use of registered trademarks.

Based on the existing case, PT Perindustrian Ny. M owns the trademark rights related to the Ny. telon oil brand. M because the mark has been registered with registration number: IDM0000003427. This shows that the Right to Mark owned by PT Perindustrian Ny. M is in accordance with the provisions of Article 1 point 5 of the Law on Marks and Geographical Indications and Article 3 of the Law on Marks and Geographical Indications.

PT Industry Mrs. M has the right to a registered trademark, therefore PT Perindustrian Ny. M has the right to transfer the Right to the Mark, this can be seen in Article 41 paragraph (1) of the Trademark and Geographical Indication Law which stipulates that:

Rights to registered marks can be transferred or transferred because:

- a. Inheritance;
- b. Will;
- c. Waqf;
- d. Grant;
- e. Agreement; or
- f. Other reasons justified by legislation.

PT Industry Mrs. M transferred the rights to the registered mark to PT ABN through an underhand auction where the private auction was included in the form of an agreement, thus the transfer of the rights to the registered mark from PT Perindustrian Ny. M to PT ABN in accordance with Article 41 paragraph (1) letter e of the Trademark Law and Geographical Indications. Transfer of Rights to Trademarks from PT Perindustrian Ny. M also transferred 72 trademarks to PT ABN, some of which are: trademark for Telon oil, trademark for Javanese herbal medicine, trademark for honey, trademark for balsam, trademark for aloe vera soap, and so on. The transfer is in accordance with the provisions of Article 41 paragraph (2) of the Law on Marks and Geographical Indications which stipulates that:

Based on the above provisions, PT Perindustrian Ny. M has the right to transfer the rights to his registered mark to PT ABN in accordance with Article 41 paragraph (1) letter e and paragraph (2) of the Law on Marks and Geographical Indications. Through the transfer of Rights to the Marks through an underhand auction process, PT ABN owns the Rights to the registered Marks, but PT ABN re-transfers the Rights to the registered Marks

with a sale and purchase agreement and simultaneously transfers all 72 (seventy-two) trademarks to PT BEM.

The process of transferring rights to registered marks from PT ABN to PT BEM through a sale and purchase agreement does not conflict with the provisions of Article 41 paragraph (1) letter e of the Trademark Law and Geographical Indications which stipulates that rights to registered marks can be transferred by agreement several conditions for the agreement to be valid as stipulated in Article 1320 of the Civil Code (hereinafter referred to as the Civil Code), which consists of 4 (four) conditions, namely:

1. Agree with those who bind themselves.

The word agreement in an agreement is essentially a meeting or agreement of will between the parties who make the agreement. A person is said to give consent if he really wants what has been agreed. J. Satrio said there are several ways to realize this will, namely:

- a) Strictly speaking: a) with an authentic deed; b) with a deed under the hand,
- b) Secretly.

An agreement can contain legal defects or an agreement is considered non-existent if the following events occur, namely:

- a) Coercion: any malicious act or threat that interferes with free will is considered coercion.
- b) Fraud: an act of deception. According to the provisions of Article 1328 of the Civil Code, it is clear that fraudulent acts are the basis for terminating the contract.

2. The ability to make an engagement.

According to Article 1329 of the Civil Code, it stipulates that: "Everyone is capable of entering into engagements, if he is not declared incompetent by law", but Article 1330 of the Civil Code determines as follows:

Not qualified to make an agreement are:

- a) Minors;
- b) Those who are put under custody.
- c) Women, in matters stipulated by law, and in general all persons with whom the law has prohibited making certain agreements.

3. A certain thing

An agreement has to do with a certain thing, namely what has been agreed, namely the rights and obligations of both parties. Article 1333 of the Civil Code states that "an agreement must have the subject matter of which at least the type can be determined". J. Satrio concluded that what is meant by a certain thing in the agreement is the object of agreement achievement.

4. A lawful reason

Refers to the contents and the agreement itself. May not promise anything that is prohibited by law or contrary to law, values of decency or public order.

Based on the existing case, PT BEM's legal consultant said that PT BEM bought Mrs. M from PT ABN through a legal and correct legal process, namely through a sale and purchase agreement. This means that the trade mark sale and purchase agreement made by PT ABN and PT BEM has fulfilled 4 (four) legal requirements for an agreement, namely:

- a) There is an agreement between PT ABN and PT BEM in terms of the sale and purchase agreement for the Ny. M.
- b) The ability of the parties to represent PT ABN and PT BEM, which means that the representatives from PT ABN and PT BEM are adults and are not under supervision.
- c) There is a certain matter related to the transfer of the mark, namely regarding the rights and obligations of each party, namely PT ABN submitting 72 (seventy two) trademarks of Mrs. M to PT BEM and received a sum of money from the sale of the trademark, while PT BEM paid a sum of money to PT ABN to obtain the trademark Ny. M.
- d) A lawful cause is that the contents and agreements between PT ABN and PT BEM are in accordance with applicable laws and do not conflict with the law, the values of decency or public order.

Based on the explanation above, it can be said that the sale and purchase agreement of Mrs. M carried out by PT ABN and PT BEM is true and legally valid in accordance with the provisions of Article 1320 of the Civil Code and the Transfer of Rights to Marks carried out by PT ABN to PT BEM is in accordance with and complies with the provisions of Article 41 paragraph (1) letter e and paragraph (2) Trademark and Geographical Indication Law.

Trademark Mrs. M, owned by PT BEM and used in packaging for telon oil products, has been registered with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia with registration number: IDM000660270 and the owner is PT BEM, besides the registered brand name is Telon Oil Ny. M and Painting. About the painting in question is a portrait of Mrs. M and the picture of a small child on the telon oil product packaging. This can be seen on the packaging of Ny. Telon oil product. M which is registered with the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia, there is a portrait of Mrs. M next to Mrs. M and also a picture of a small child, so that PT BEM as the owner of the Ny. M has the right to use the trademark and all marks on the trademark are an inseparable unit. This explanation shows that the portrait of Mrs. M which is on the packaging of Telon oil products marketed by PT BEM is valid because the portrait image is a sign on the trademark of Mrs. M and is an integral part of the trademark Ny. M in the form of words, colors, portraits of Mrs. M, and a picture of a small child.

Apart from the above, PT BEM has the right to use a portrait of Mrs. M on the telon oil product packaging and does not violate the permit stated by CS because it has been proven that there is a sales contract between PT ABN and PT BEM. This shows that based on the sales contract, PT BEM has the right to use the trademark along with a portrait of Mrs. M which has become an integral part of the trademark. Based on this explanation, the basis for CS's lawsuit is not correct because the portrait in the existing case is a portrait image which is included in the image criteria within the scope of the definition of a brand and not the definition of a portrait within the scope of copyright.

Trademark registration carried out by PT BEM is a form of preventive legal protection, especially PT BEM takes the initiative and realizes the need for legal protection for the mark in accordance with the existing system in the Law on Trademarks and Geographical Indications, namely the constitutive system. This shows that the state has guaranteed legal protection for PT BEM on the basis of having registered, especially with the registration number: IDM000660270.

IV. Conclusion

Based on the description of the discussion in the previous chapter, it can be concluded that trademark registration using a portrait of Mrs. M for telon oil products can provide legal protection to PT BEM as the buyer of the Ny. M with the following description:

- a. PT BEM owns the trademark Mrs. M through the procedure for transferring Rights to Marks through a sale and purchase contract between PT ABN and registered with registration number: IDM000660270, this is in accordance with the provisions of Article 1 number 5 and Article 3 of the Law on Marks and Geographical Indications.
- b. Transfer of Rights to Mark Mrs. M from PT ABN to PT BEM includes 72 (seventy two) trademarks of Mrs. M and one of them is telon oil product.
- c. Trademark Mrs. The registered M is an integral part of all the marks on the trademark in the form of a combination of words, colors, portraits of Mrs. M, and a picture of a small child.

Suggestion

The suggestions given by the author are as follows:

1. It should be in the agreement on the transfer of brands between PT Perindustrian Ny. M with PT ABN and between PT ABN and PT BEM further clarified the criteria for the brand to be transferred so as not to cause problems in the future.
2. At the time of the transfer of rights to a mark, registration of the mark should be carried out immediately to the Directorate General of Intellectual Property, Human Rights and the Republic of Indonesia to obtain legal certainty and legal protection for the recipient of the transfer of rights to a mark.

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