

**REGULATION OF THE GOVERNMENT OF THE REPUBLIC OF INDONESIA
NUMBER 22 OF 2018
ON
INTERNATIONAL REGISTRATION OF MARKS BASED ON THE PROTOCOL RELATING TO THE
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

BY THE GRACE OF GOD ALMIGHTY

THE PRESIDENT OF THE REPUBLIC OF INDONESIA,

Considering:

that in order to implement the provision of Article 52 paragraph (4) of Law Number 20 of 2016 on Trademarks and Geographical Indications, it has been deemed necessary to establish Regulation of the Government on International Registration of Marks Based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

Observing:

1. Article 5 paragraph (2) of the 1945 Constitution of the Republic of Indonesia;
2. Law Number 20 of 2016 on Trademarks and Geographical Indications (State Gazette of the Republic of Indonesia of 2016 Number 252, Supplement to the State Gazette of the Republic of Indonesia Number 5953).

HAS DECIDED:

To establish:

REGULATION OF THE GOVERNMENT ON INTERNATIONAL REGISTRATION OF MARKS BASED ON
THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS

**CHAPTER I
GENERAL PROVISION**

Article 1

Under this Regulation of the Government, the following definitions are employed:

1. Mark is a sign which can be displayed graphically in the form of pictures, logos, names, words, letters, numbers, color compositions, and in the form of 2 (two) dimension and/or 3 (three) dimension, sound, hologram, or combination of 2 (two) or more of the said elements to distinguish goods and/or services produced by individuals or legal entities under the activities of trade of goods and/or services.
2. Collective Mark is a Mark used on goods and/or services having similar characteristics pertaining to the nature, common trait and quality, as well as the oversight, of goods or services that are going to be collectively traded by several individuals or legal entities to distinguish them from other similar goods and/or services.

3. International Bureau is the World Intellectual Property Organization.
4. International Application is the application to secure the registration of Marks originating from Indonesia according to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.
5. International Registration is the registration of international Marks that are addressed to Indonesia based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.
6. Basic Application is a Mark registration request which serve as basis for submitting an International Application.
7. Basic Registration is a registered Mark which serve as basis for submitting International Application.
8. Date of International Registration is the date of registration of a Mark at an International Mark Register.
9. Applicant is the party who submit an International Application.
10. Holder is the party whose name is recorded under an International Registration which is listed under the International Mark Register.
11. Proxy is an intellectual property consultant who permanently reside or domicile in the territory of the Unified Nation of the Republic of Indonesia.
12. Minister is the minister responsible for government affairs in the legal sector.
13. Official Gazette of Marks is the official media which is periodically issued by the Minister through electronic and non-electronic means and which contain provisions on Marks pursuant to the Law.
14. Law is Law Number 20 of 2016 on Trademarks and Geographical Indications.
15. Day is business day.

Article 2

Applications for the international registration of Marks based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks may take the form of:

- a. applications originating from Indonesia that are addressed to the International Bureau through the Minister; or
- b. applications addressed to Indonesia as one of the destination country that are received by the Minister from the International Bureau.

CHAPTER II

INTERNATIONAL APPLICATION

Divisions One

Requirements and Procedures for an Application

Article 3

- (1) International Application shall be submitted to the International Bureau through the Minister.
- (2) The International Application as referred to in paragraph (1) may be submitted electronically or non-electronically.
- (3) The International Application as referred to in paragraph (2) shall be submitted by filling out a form in English language.

- (4) The International Application as referred to in paragraph (3) can only be submitted by:
 - a. Applicants who have Indonesian citizenship;
 - b. Applicants who have domicile or legal domicile in the territory of the Unified Nation of the Republic of Indonesia; or
 - c. Applicants who have real commercial or industrial business activities in the territory of the Unified Nation of the Republic of Indonesia.
- (5) The International Application as referred to in paragraph (3) may be submitted through a Proxy.

Article 4

- (1) The International Application as referred to in Article 3 shall be charged with a fee which must be paid directly to the International Bureau.
- (2) Other than the fee which must be paid directly to the International Bureau as referred to in paragraph (1), the International Application are also charged with an administration fee.

Article 5

The submission of International Application as referred to in Article 3 can only be undertaken if an Applicant already secure a Basic Application or Basic Registration.

Division Two

Assessment of International Applications

Article 6

- (1) The Minister are required to undertake an assessment toward each International Application.
- (2) The assessment as referred to in paragraph (1) shall be undertaken toward:
 - a. the completeness and correctness of form-filling;
 - b. the conformity between an International Application to a Basic Application or Basic Registration; and
 - c. the administration fee payment receipt.
- (3) The assessment as referred to in paragraph (2) letter a and letter b shall be undertaken in accordance with the General Rules.
- (4) The assessment as referred to in paragraph (1) shall be undertaken by no later than 5 (five) Days after the date of receipt of an International Application.

Article 7

- (1) The Minister shall submit any International Application that already satisfy the requirements as referred to in Article 6 to the International Bureau.
- (2) The International Application as referred to in paragraph (1) must be received by the International Bureau by no later than 2 (two) months after the date of receipt of an International Application.

Article 8

- (1) In case of an International Application not satisfying the requirements as referred to in Article 6, then

the Minister shall notify the Applicant in writing to complete the inadequate requirements by no later than 10 (ten) Days after the receipt of an International Application.

- (2) The Applicant are required to complete the inadequate requirements by no later than 15 (fifteen) Days after the date of delivery of the notice.
- (3) In an Applicant does not complete the inadequate requirements within the timeframe as referred to in paragraph (2), then the International Application shall be deemed as withdrawn.

Division Three

Notice to the International Bureau

Article 9

- (1) The Minister shall notify the International Bureau in case of:
 - a. a Basic Application being rejected or withdrawn, or
 - b. a Basic Registration being nullified, erased or not being extended.
- (2) The notice as referred to in paragraph (1) letter b is only undertaken toward any Basic Registration which was nullified, erased or not extended prior to the expiry of the 5 (five) year timeframe after the Date of International Registration.

CHAPTER III

INTERNATIONAL REGISTRATION

Division One

Receipt and Announcement of International Registration

Article 10

- (1) The Minister shall receive International Registrations from the International Bureau.
- (2) After receiving the International Registrations as referred to in paragraph (1), then the Minister shall undertake an announcement.
- (3) The announcement as referred to in paragraph (2) shall be implemented in accordance with the provisions of the Law.
- (4) Toward the International Registrations as referred to in paragraph (1), then the Minister shall receive International Registration fee from the International Bureau.

Article 11

- (1) During the period of announcement, any concerned party may submit an objection toward the International Registration.
- (2) The objection as referred to in paragraph (1) shall be submitted in writing to the Minister and be made in 2 (two) copies.
- (3) The objection as referred to in paragraph (1) may be submitted if there are sufficient reasons accompanied by evidences indicating the Mark being applied for registration as a Mark which cannot be registered or rejected according to the Law.

- (4) The submission of the objection as referred to in paragraph (1) shall be charged with a fee.

Division Two

Substantive Assessment

Article 12

- (1) The substantive assessment shall be undertaken toward International Registrations, either having objection or not having objection.
- (2) The substantive assessment shall be undertaken in accordance with provisions of the Law.

Article 13

- (1) The Minister shall submit the result of substantive assessment to the International Bureau by no later than 18 (eighteen) months after the date of notice of International Registration.
- (2) The result of assessment as referred to in paragraph (1) may take the form of registered or rejected.

Article 14

In case of the result of substantive assessment of International Registrations as referred to in Article 13 paragraph (2) are registered, then the Minister shall:

- a. submit the protection granting statement to the International Bureau;
- b. issue the certificate of Mark; and
- c. undertake an announcement in the Official Gazette of Marks.

Article 15

- (1) in case of the result of substantive assessment of International Registrations as referred to in Article 13 paragraph (2) are rejected, then the Minister shall submit the notice of rejection alongside the reasons for rejection to the International Bureau.
- (2) Toward a rejected International Registration, then the Holder may submit a response in accordance with provisions of the Law.
- (3) The response as referred to in paragraph (2) shall be submitted in writing to the Minister by no later than 30 (thirty) Days after the date of delivery of notice of rejection from the International Bureau to the Holder.
- (4) The response as referred to in paragraph (2) may only be submitted by the Holder through their Proxy.
- (5) The Minister shall submit the final decision resulting from the response as referred to in paragraph (2) to the International Bureau.

Article 16

- (1) In case of an International Registration in the form of a Collective Mark, then the Holder should submit a copy of the provisions for the use of said Collective Mark and its translation in the Indonesian language.
- (2) The copy of the provisions for the use of a Collective Mark and its translation in the Indonesian language as referred to in paragraph (1) shall be submitted to the Minister by no later than 3 (three) months after the date of notice of International Registration.

- (3) In case of a Holder does not submit the copy as referred to in paragraph (2) by no later than 3 (three) months after the date of notice of International Registration, then the International Registration shall be rejected.
- (4) The provisions on substantive assessment as referred to in Article 12, Article 13, Article 14 and Article 15 shall apply mutatis mutandis toward Collective Mark.

Division Three

Legal Protection toward Marks Based on International Registration

Article 17

Legal protection toward Marks based on International Registration shall be granted for 10 (ten) years after the Date of International Registration.

Division Four

Extension of Period of Legal Protection toward Marks Based on International Registration

Article 18

Legal protection toward Marks based on International Registration as referred to in Article 17 may be undergo an extension of timeframe according to the provisions of General Rules.

Article 19

- (1) The extension of International Registrations that are addressed to Indonesia shall be notified by the International Bureau to the Minister.
- (2) After receiving the notice on extension as referred to in paragraph (1), then the Minister shall record and announce it in the Official Gazette of Marks.
- (3) Toward the extension as referred to in paragraph (2), the Minister shall receive an International Registration extension fee from the International Bureau.

Division Five

Recordation of Transfer of Right, Change of Name and/or Change of Address

Article 20

A transfer of right, change of name and/or change of address can be undertaken toward the Marks based on International Registration pursuant to the provisions of General Rules.

Article 21

- (1) The transfer of right as referred to in Article 20 may be submitted according to an application for recordation by a Holder or recipient of rights who:
 - a. have Indonesian citizenship;
 - b. have domicile or legal domicile in the territory of the Unified Nation of the Republic of Indonesia; atau

- c. have real commercial or industrial business activities in the territory of the Unified Nation of the Republic of Indonesia.
- (2) The application for the recordation of transfer of right by Holders as referred to in paragraph (1) may be directly submitted to the International Bureau or through the Minister.
- (3) The application for the recordation of transfer of right by recipient of rights as referred to in paragraph (1) may only be submitted through the Minister.
- (4) The application for the recordation of transfer of right through the Minister as referred to in paragraph (2) and paragraph (3) shall be submitted electronically or non-electronically by filling out a form in English language and enclosing the proof of transfer of right.
- (5) The application for the recordation of transfer of right as referred to in paragraph (4) shall be submitted by the Minister to the International Bureau.

Article 22

- (1) The change of name and/or change of address as referred to in Article 20 may be submitted based on an application for recordation by Holders who:
 - a. have Indonesian citizenship;
 - b. have domicile or legal domicile in the territory of the Unified Nation of the Republic of Indonesia; or
 - c. have real commercial or industrial business activities in the territory of the Unified Nation of the Republic of Indonesia.
- (2) The application for the recordation of change of name and/or change of address by Holders as referred to in paragraph (1) may be directly submitted to the International Bureau or through the Minister.
- (3) The application for the recordation of change of name and/or change of address through the Minister as referred to in paragraph (2) shall be submitted electronically or non-electronically by filling out a form in English language and enclosing the proof of change of name and/or change of address.
- (4) The application for the recordation of change of name and/or change of address as referred to in paragraph (3) shall be submitted by the Minister to the International Bureau.

Article 23

- (1) The transfer of right, change of name and/or change of address of International Registration addressed to Indonesia shall be notified by the International Bureau to the Minister.
- (2) After receiving the notice of the transfer of right, change of name and/or change of address as referred to in paragraph (1), the Minister shall record and announce them in the Official Gazette of Marks.

Division Six

License

Article 24

- (1) A recordation of license may be undertaken toward Marks based on International Registration.
- (2) The application for the recordation of license as referred to in paragraph (1) shall be submitted in writing to the Minister while being charged with a fee.
- (3) Provisions regarding the recordation of License as referred to in paragraph (1) shall be implemented in

accordance with provisions of laws and regulations.

Division Seven Annulment or Deletion

Article 25

- (1) An annulment or deletion may be undertaken toward Marks based on International Registration.
- (2) Provisions regarding the annulment or deletion as referred to in paragraph (1) shall be implemented in accordance with provisions of the Law.
- (3) The annulment or deletion as referred to in paragraph (1) shall be submitted by the Minister to the International Bureau.

CHAPTER IV TRANSFORMATION

Article 26

- (1) Any International Registration which was nullified due to the expiry of protection of Basic Registration or Basic Application in the country of origin in accordance with provisions of the Protocol Relating to the Madrid Agreement Concerning International Registration of Marks may undergo a transformation.
- (2) The application for transformation as referred to in paragraph (1) shall be submitted by the parties whose name has once been recorded as a Holder by no later than 3 (three) months after the date of annulment of International Registration.
- (3) The application for transformation as referred to in paragraph (1) shall be submitted electronically or non-electronically to the Minister by filling out a form.
- (4) The application for transformation as referred to in paragraph (1) shall be charged with a fee.

Article 27

- (1) An application for transformation toward International Registration which has been granted with protection in Indonesia and has satisfy the provisions of Article 26 paragraph (3) and paragraph (4) shall be recorded and announced in the Official Gazette of Marks by the Minister.
- (2) Legal protection toward the registration of Marks through an application for transformation as referred to in paragraph (1) shall be granted starting from the Date of International Registration.
- (3) Toward the registration of Marks which was submitted by way of application for transformation as referred to in paragraph (1), then the Date of International Registration shall become the Date of Receipt according to the Law.
- (4) An application for transformation toward International Registration which has not been granted with protection in Indonesia and has not satisfy the provisions of Article 26 paragraph (3) and paragraph (4), then the Minister shall still continue the process for the application in question from the last stage prior to the International Registration was nullified.
- (5) The application process as referred to in paragraph (4) shall be undertaken in accordance with provisions of the Law.
- (6) In case of the nullified International Registration does not undergo a transformation, then the Minister shall record and announce the annulment in the Official Gazette of Marks.

BAB V ALTERATION

Article 28

- (1) Marks that are already registered based on provisions of the Law can undergo an alteration to become Marks that are registered based on International Registration and are addressed to Indonesia.
- (2) The alteration as referred to in paragraph (1) can only be undertaken under the following conditions:
 - a. the Mark has already been registered prior to an International Registration being addressed to Indonesia;
 - b. the owner of the registered Mark is the same with the Holder of International Registration;
 - c. the registered Mark has an overall similarity to the International Registration; and
 - d. the type of goods and/or services within the registered Mark are found within the International Registration.
- (3) The application for alteration as referred to in paragraph (1) shall be submitted in writing by the Holder to the Minister while being charged with a fee.
- (4) The Minister shall notify the occurrence of an alteration to the International Bureau.

CHAPTER VI CLOSING PROVISION

Article 29

This Regulation of the Government comes into force from the date of its promulgation.

For the purpose of public cognizance, it is hereby ordered that this Regulation of the Government be promulgated in the State Gazette of the Republic of Indonesia.

Established in Jakarta,

On 5 June 2018

PRESIDENT OF THE REPUBLIC OF INDONESIA,

Signed

JOKO WIDODO

Promulgated in Jakarta,

On 6 June 2018

MINISTER OF LAW AND HUMAN RIGHTS OF THE REPUBLIC OF INDONESIA,

Signed

YASONNA H. LAOLY

STATE GAZETTE OF THE REPUBLIC OF INDONESIA OF 2018 NUMBER 86

**ELUCIDATION OF
REGULATION OF THE GOVERNMENT OF THE REPUBLIC OF INDONESIA
NUMBER 22 OF 2018
ON
INTERNATIONAL REGISTRATION OF MARKS BASED ON THE PROTOCOL RELATING TO THE
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

I. GENERAL

Globalization already provide an impact toward economic activities and the trade of goods and services that crosses state borders. Marks as intellectual property holds very important role in the said economic and trade activities. In an attempt to support government programs, specifically to develop global Marks over Indonesian local products, and develop small and medium businesses capable of competing in the global market, there is a need for an effective and efficient international registration system for Marks. To support the said government program, an international registration mechanism for Marks is a necessity for securing legal protections that support global trade.

The international Registration of Marks based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks is a Mark registration system which provide greater ease and reach for owners of Marks to secure protection of Marks abroad. The adoption of provisions on International registration of Marks by the Government of Indonesia which was ratified through the Regulation of the President Number 92 of 2017 on the Ratification of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989. Under Law Number 20 of 2016 on Trademarks and Geographical Indications, provisions regarding the international registration of Marks based on the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks shall be regulated under Article 52 of Law Number 20 of Tahun 2016 on Trademarks and Geographical Indications. Further provisions as regards the international registration of Marks based on the said Protocol shall be regulated under a Regulation of the Government.

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks provide an opportunity for national Mark stakeholders to be able to use global intellectual property mechanisms that are able to support the strengthening of national economy. The membership in said Protocol shall also coordinate the Mark registration process in Indonesia with the Mark registration process in countries that are Indonesia's primary trade partners.

Within the international registration system of Marks, the Minister has 2 (two) extremely important role. Firstly, the Minister act as the competent authority to submit applications for the international registration of Marks originating from Indonesia to the International Bureau to be forwarded to the destination country. Secondly, the Minister act as the competent authority to receive International Registration from the International Bureau.

In general, this system simplifies the process for Mark registration. The simplification of said process encompass the application and post-registration stages. At the application stage, the owner of a Mark are only required to submit one application in one choice of language through the Minister that are addressed to the International Bureau to be forwarded to the destination country. At the post-registration stage, the owner of a Mark may undertake a centralized Mark protection management with one International Registration number. Thus, this system has a strategic role in realizing an effective and efficient Mark registration system, as well as providing greater opportunities for national Marks to compete in the international realm.

Based on the said matters, it has been deemed necessary to establish a Regulation of the Government which provide guidelines for stakeholders in the sector of Marks as regards the procedure and mechanisms for the registration Marks through the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

This Regulation of the Government shall contain the following substances:

- International Application which regulate the requirements and procedures for International Application, assessment of International Application and notice to the International Bureau;
- The International Registration which regulate the receipt and announcement of International Registration, substantive assessment, legal protection toward Marks based on International Registration, extension of period of legal protection towards Marks based on International Registration, recordation of transfer of rights, change of name and/or change of address, license and annulment or deletion;
- Transformation; and
- Alteration.

II. ARTICLE BY ARTICLE

Article 1

Self-explanatory.

Article 2

Self-explanatory.

Article 3

Self-explanatory.

Article 4

Self-explanatory.

Article 5

Self-explanatory.

Article 6

Paragraph (1)

Self-explanatory.

Paragraph (2)

Self-explanatory.

Paragraph (3)

"General Rules" are the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.

Paragraph (4)

Self-explanatory.

Article 7

Self-explanatory.

Article 8

Self-explanatory.

Article 9

Paragraph (1)

Self-explanatory.

Paragraph (2)

The notice under this provision include the annulment or deletion of Basic Registration whose process of annulment or deletion lawsuit already started prior to the expiry of the 5 (five) year period starting from the Date of International Registration, even though the decision on annulment or deletion shall only become final and binding after the expiry of the said period.

Article 10

Paragraph (1)

Self-explanatory.

Paragraph (2)

Self-explanatory.

Paragraph (3)

Self-explanatory.

Paragraph (4)

The sum of charged fee are equivalent to the application fee for the national registration of Marks.

The fee equivalent to the application fee for the registration of Marks shall be determined by the International Bureau based on a notice from the Indonesian government and the said fee shall be received by the International Bureau in Swiss Franc currency.

The fees received by the International Bureau shall then be sent by the International Bureau to the Indonesian government in Indonesian currency based on the official exchange rate of the United Nations.

Article 11

Self-explanatory.

Article 12

Self-explanatory.

Article 13

Self-explanatory.

Article 14

Self-explanatory.

Article 15

Self-explanatory.

Article 16

Self-explanatory.

Article 17

Self-explanatory.

Article 18

"General Rules" are the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.

Article 19

Paragraph (1)

Self-explanatory.

Paragraph (2)

Self-explanatory.

Paragraph (3)

The sum of charged fee are equivalent to the fee for the extension of period of national Mark protection.

The fee equivalent to the fee for the extension of Mark registration shall be determined by the International Bureau based on a notice from the Indonesian government and the said fee shall be received by the International Bureau in Swiss Franc currency.

The fees received by the International Bureau shall then be sent by the International Bureau to the Indonesian government in Indonesian currency based on the official exchange rate of the United Nations.

Article 20

"General Rules" are the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.

Article 21

Self-explanatory.

Article 22

Self-explanatory.

Article 23

Self-explanatory.

Article 24

Self-explanatory.

Article 25

Self-explanatory.

Article 26

Paragraph (1)

"Transformation" is an action to alter the statuses of International Registrations into the registration of Marks in Indonesia caused by the expiry of protection of Basic Application or Basic Registration in the country of origin.

Paragraph (2)

Self-explanatory.

Paragraph (3)

Self-explanatory.

Paragraph (4)

Self-explanatory.

Article 27

Self-explanatory.

Article 28

Paragraph (1)

"Alteration" is a situation where an International Registration is considered to be substituting the registration of Marks in Indonesia. An alteration does not physically substitute the registration of Marks in Indonesia into International Registrations and does not nullify the registration of Marks in Indonesia. Both of the registration may be registered side by side. By undertaking the alteration, then the Holder of an International Registration may continue to acquire the protection which is obtained from the initial right to registration of Marks in Indonesia if its registration of Mark in Indonesia is not extended.

Paragraph (2)

Self-explanatory.

Paragraph (3)

Self-explanatory.

Paragraph (4)

Self-explanatory.

Article 29

Self-explanatory.

SUPPLEMENT TO THE STATE GAZETTE OF THE REPUBLIC OF INDONESIA NUMBER 6213

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