

APPLICATION OF THE DOCTRINE OF “FOREIGN EQUIVALENTS LANGUAGE” AS THE BASIS OF TRADEMARK OWNERSHIP IN INDONESIA

Susy Tan¹, Ariawan Gunadi² & Mella Ismelina F. Rahayu³

¹Faculty of Law, University Tarumanagara Jakarta
Email: susy.208219201@stu.untar.ac.id

²Faculty of Law, University Tarumanagara Jakarta
Email: ariawang@fh.untar.ac.id

³Faculty of Law, University Tarumanagara Jakarta
Email: mellaismelina@fh.untar.ac.id

ABSTRACT

In the era of globalization, the use of foreign languages in trademarks is increasingly prevalent, including in Indonesia. Problems arise when a foreign mark that has been recognized abroad wants to be registered in Indonesia, but has been used or registered by other parties in the form of translation or transliteration. The doctrine of Foreign Equivalents (foreign translation) becomes important as it serves as a guideline in assessing the similarity of foreign and local marks based on their meaning or meaning in Indonesian. However, Indonesia has not expressly adopted or included this doctrine in the legislation, giving rise to legal uncertainty in the settlement of trademark disputes, especially in the case of seizure of rights to foreign marks translated into the local language. This research aims to analyze how the application of the doctrine of Foreign Equivalents Language in the trademark law system in Indonesia. This research is conducted using a normative juridical approach (legal research) or also known as doctrinal research. The data used was secondary data is data obtained directly through literature searches or from official documents, namely legal books on legal theory and books on copyright, especially trademarks and patents as well as document data on other countries. The data collection technique used in this research was a literature study. In the discussion of normative research results are analyzed normatively-qualitatively. The results showed that the Trademark Act of 2016 has not regulated the doctrine of Foreign Equivalents, giving rise to legal uncertainty in the registration of foreign language trademarks. Efforts to ensure fair legal protection and prevent consumer confusion, this doctrine needs to be explicitly included in the regulation of trademarks in Indonesia.

Keywords: foreign equivalents language, brand, trade

1. PREFACE

The importance of the use of Trademarks in trade has given rise to an exclusive right, which is a right granted by the state to the owner of a registered Trademark for a certain period of time. The existence of the exclusive right means that the trademark owner may use his own trademark or give permission to other parties to use it. The use of a word to be an exclusive right indirectly means the same as monopoly rights. Because the right to trademark is exclusive or monopoly, then its implementation also requires legal certainty. In the preamble "Considering" on Law Number 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as Trademark Law 2016).

Trademarks and rights to trademarks are intellectual property that must obtain legal certainty when registering. In the legal politics of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as the Trademark Law 2016) contained in the weighing consideration, it is stated, first, in the era of global trade, in line with international conventions that have been ratified by Indonesia (Tim Lindsey, 2013), licensing of Trademarks and Geographical Indications becomes very important, especially in maintaining fair business competition, justice, consumer protection, as well as the protection of Micro, Small and Medium Enterprises and domestic industries (Hidayah, 2017); second, to further improve services and provide legal certainty for the world of industry, trade, and investment in the face of local,

national, regional, and international economic developments as well as the development of information and communication technology, it is necessary to be supported by a more adequate legislation in the field of Trademarks and Geographical Indications; and third, that in Law No. 15 Year 2001 on Trademarks there are still shortcomings. 15 Year 2001 on Trademarks still has shortcomings and has not been able to accommodate the development of community needs in the field of Trademarks and Geographical Indications and has not adequately guaranteed the protection of local and national economic potential so that it needs to be replaced (National Law Development Agency, 2015).

According to Law No. 20 of 2016 on Trademarks and Geographical Indications (Trademark Law 2016), to obtain exclusive rights to the Trademark must be submitted for registration to the Directorate General of Intellectual Property, either individuals or legal entities, and must first be announced in the General Register of Trademarks by the Directorate General of Intellectual Property through the website: www.dgip.go.id by going through various stages, from the incoming application, examination of formalities, publication period, substantive examination, approval of the Director, and outgoing trademark certificate which is proof of ownership of exclusive trademark rights. However, when registering a trademark, both individuals and legal entities must also meet the criteria specified by Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law 2016), otherwise the trademark registration must be rejected.

The absence of clear provisions on DFE in the Trademark Law 2016 may also lead to legal issues on the registration of a mark that is a combination of 2 (two) foreign language words that cannot be separated. For example, the mark "Firefox" which when translated literally into Indonesian means "Fire Fox". In fact, "Firefox" is a combination of two words into a new word that creates a new meaning. The new word with the new meaning is used as a brand for a computer program. Since the term "Firefox" is untranslatable, it should be equivalent in Indonesian.

Starting from the description and some examples of cases above, the author is of the view that DFE needs to be immediately added to the legislation on trademarks in Indonesia. If the doctrine is not included and clearly stated in the future trademark law, then the legal certainty for foreign-language trademark owners registered in Indonesia will still not be guaranteed legal certainty.

As a *state of the arts* (previous research), related to trademark rights and trademark registration, it has been done by Henny Marlyna from the University of Indonesia Doctor of Law Program on July 17, 2019 with the title *The Purpose of Trademarks to Protect Consumers: A Study of Counterfeit Drug Problems in Indonesia*. The result of Henny Marlyna's research is the application of the Trademark Law in overcoming the problem of counterfeit drugs in Indonesia to examine the purpose of trademarks in protecting consumers. This research uses socio-legal research methods, a combination of doctrinal legal research methods and empirical legal research methods. The conclusion of the dissertation is the concept of trademark objectives to protect consumers based on the development of the concept of trademark protection and economic analysis theory. Trademark law should not be forced to protect consumers because it will damage the legal protection system. In order for consumers to be protected from the dangers of counterfeit drugs, law enforcement must be carried out by the community as a form of state intervention to protect consumers by using other public laws, especially the Health Law.

Research conducted by Henny Marlyna is more inclined to the Consumer Protection Act than the Trademark Act itself.

The next research on Trademark Rights was also conducted by Inge Dwisvimiar from the Doctoral Program in Law, Sultan Ageng Tirtayasa University, Banten, in 2015 with the title of Trademark Dilution Doctrine Arrangement as a Legal Protection Effort of Famous Trademarks in Indonesia. The results of research conducted by Inge Dwisvimiar are the regulation of Trademark Dilution as a way of providing legal protection for holders of Famous Trademarks in Indonesian legislation by using the adjustment of Article 6 paragraph (2) of the Trademark Act 2001 based on Article 16 paragraph (3) TRIPs. In the prospect of improving the regulation of trademark dilution in Indonesia needs to be considered by strengthening Article 6 paragraph (2) of the Trademark Act 2001. Trademark owners can sue other parties who have diluted their trademarks by using the adjustment of Article 6 paragraph (2) of the Trademark Act 2001 which protects the use of registered trademarks of goods and or services that are not similar. This article is an adaptation of Article 16 paragraph (3) of TRIPs as ratified in Act No. 7 of 1997 on the ratification of TRIPs. The existence of the Article above can accommodate the dilution of the trademark.

However, the existence of this Article must still be complemented by the provisions of Government Regulation on Famous Marks and made relevant changes to Article 6 paragraph (2) UUM 2001. As for filling the void of Government Regulation, it can be used Article 16 paragraph (3) of TRIPs so that it can still provide protection to well-known trademarks in goods or services are not similar. Inge Dissimilar research emphasizes more on the use of the principle of trademark law, namely the principle of dilution of trademarks in the application of Article 6 Paragraph (2) of the Trademark Act 2001.

This research uses decisions that are granted as trademarks and trademark decisions that are cancelled, the decision is Decision Number 118 PK/Pdt.Sus-HKI/2014, Decision Number 722 K/Pdt.Sus-HKI/2015, Decision Number 105 PK/Pdt.Sus-HKI/2017, Decision Number 40/Pdt.Sus-Merek/2018/PN.NiagaJkt.Pst., and Decision Number 104 PK/Pdt.Sus-HKI/2019. Meanwhile, the statute approach used by researchers is to use the Trademark Law of 2001, the Trademark Law of 2016 and the Trade Marks Act 1994 USA. The emphasis of research with a statutory approach is aimed at applying the doctrine of foreign language equivalence.

Efforts to comparative approach, researchers use the trademark law of the United States because the doctrine of foreign equivalents derived from the trademark law of the United States which incidentally is in the common law legal system while Indonesia in the commercial court using the legal system of civil law and Japan. Based on the background of such a discussion, the author chose the title of the dissertation: "Application of the doctrine of "Foreign Equivalents Language" as the basis of trademark ownership in Indonesia".

2. RESEARCH METHOD

This research was conducted using a normative juridical approach (*legal research*) or also known as doctrinal research (Waluyo, 1991; Suratman & Dillah, 2012). The nature of this research is descriptive research, which is research conducted with an effort to understand various things related to the subject matter and then the results of the understanding are described in the form of scientific writing. The data used was secondary data that was data obtained directly through literature searches or from official documents, namely legal books on legal theory and books on copyright, especially brands and patents as well as document data on other countries. Materials

or sources of legal data are collected through inventory procedures and identification of laws and regulations, as well as classification and systematization of legal materials according to research problems. Therefore, the data collection technique used in this research is a literature study.

Literature study is done by reading, examining, noting making reviews of library materials that have to do with Trademark law, especially regarding Article 20 of the Trademark Law 2016 and the Doctrine of *Foreign Equivalents*. In the discussion of normative research results are analysed normatively-qualitatively, by first making efforts to determine the criteria for identification, classification, and systematics as well as arriving at legal discovery efforts, whether in the form of legal interpretation or legal construction to give birth to a legal argument. The qualitative analysis approach focuses on the general principles underlying the realization of units of symptoms that exist in human life (Soerjono & Mamudji, 1986).

3. RESULT AND DISCUSSION

DFE grew and developed in the United States. The DFE or Doctrine of foreign equivalents provides guidelines under which trademarks and service marks are analysed when they contain a foreign word or words (McCarthy, 2004). The policy behind the doctrine is one of international good. Since United States companies would be crippled in international trade if foreign countries granted trademark protection to generic or merely descriptive English words, the United States retaliated and denied trademark protection to words that, once translated into English, were generic or merely descriptive of the goods to which they applied (In re Pan Tex Hotel Corp, 1976). However, since the doctrine is only a guideline, and not a strict rule, courts in different jurisdictions, including the *former* United States Court of Customs and Patent Appeals (CCPA) have reached irreconcilable holdings when deciding cases by applying the doctrine (In re Pan Tex Hotel Corp, 1983). Even a leading case from the U.S. Court of Appeals for the Federal Circuit has noted that the *Trademark Trial and Appeals Board* (TTAB) (Enrique, 2000) is "inconsistent in its application of the foreign equivalent doctrine." (Palm Bay Import, 1772).

Trademark law in the United States is essentially federal law. Thus, based on the problems created and evidenced by the inconsistent application of foreign doctrines of equivalents, the adoption of national standards may be justified. It is not suggested that the doctrine should become a mechanical rule. Rather, doctrine should remain merely a guideline, but a guideline built from precise definitions and clear standards so that more consistent, reconcilable, and instructive precedential decisions result.

In Indonesia, brands function as:

- a. An identifying mark to distinguish the production produced by a person or several persons jointly or a legal entity from the production of other persons or other legal entities;
- b. As a promotional tool, so as to promote its products simply by mentioning its brand;
- c. As a guarantee of the quality of the goods;
- d. Showing the results of the goods/products of the goods/services.

Article 20 of the Trademark Law 2016 reads:

A mark cannot be registered if:

- i. Contrary to state ideology, laws and regulations, morality, religion, decency, or public order;
- ii. Same as, related to, or merely mentioning the goods and/or services for which registration is sought;

- iii. Contains elements that can mislead the public about the origin, quality, type, size, variety, purpose of use of the goods and/or services for which registration is requested or is the name of a protected plant variety for similar goods and/or services;
- iv. Containing information that is not in accordance with the quality, benefits, or efficacy of the goods and/or services produced;
- v. Does not have differentiating power; and/or
- vi. Is a public name and/or public symbol.

Although it contains more detailed arrangements regarding trademark registration, the Trademark Law 2016, in fact, has not provided convincing legal certainty regarding unregistrable trademarks. This happens, among others, because the Trademark Law 2016 does not mention and clearly regulate the *Doctrine of Foreign Equivalents*. In the provisions of Article 20 of Law Number 21 Year 2016 on Trademarks and Geographical Indications, there is no single paragraph that regulates the Doctrine of Foreign Equivalents.

Legal protection to the second party, due to the absence of the regulation of the Doctrine of Foreign Language Equivalents, occurred in the case of "Kopitiam". The Minister of Law and Human Rights of the Republic of Indonesia explained that the registration of trademark rights over "Kopitiam" was granted because "Kopitiam" was not the name of the type of goods/services offered (Article 20 letter b of the Trademark Law 2016). However, when referring to the Doctrine of Foreign Language Equivalents, the mark 'Kopitiam' should have been registered with a mark that has obtained an equivalent equivalent in Indonesian.

Legal certainty in the positivist view of law is the application of law in people's lives, including the law understood as a ruler's order to all the people or in other words that the law is understood as a set of orders; made by the highest authority (the state); addressed to citizens; the law applies locally (within the jurisdiction of the state of its maker); law must be separated from morality; always available external sanctions for lawbreakers. Legal certainty depends a lot on sentence structure, wording, and the use of standardized terms. To achieve this goal, the proper use of legal language is necessary. Because the language of law is also Indonesian, legal certainty also depends a lot on the use of good and correct Indonesian. The use of Indonesian is subject to standardized language norms.

Legal certainty should contain the value of justice. Legal certainty is the enforcement of all applicable laws and regulations that are written in the life of society, nation and state. Related to the Registration of trademarks filed with the Directorate General of Intellectual Property (DJKI). The absolute requirement that must be met by the trademark owner in order for the trademark to be registered is that the trademark must have sufficient distinguishing power (Saraswati & Ibrahim, 2017). The stages of trademark registration procedures based on the latest Trademark Law are:

a. Formalities Check

This stage is conducted to ensure that the application for trademark registration has met the administrative requirements which include the application form, trademark label, proof of payment of application fee, statement of trademark ownership, and proof of priority. The application must include several things that have been regulated in Article 4 paragraph (2) of Law No. 20 Year 2016.

b. Announcements

Within a maximum of 15 (fifteen) days from the date of receipt, the trademark application will be announced in the Trademark Official Gazette for 2 (two) months. Third parties who

have objections based on the provisions of Article 20 and Article 21 of the Trademark Law can file an objection in writing to the Directorate General of Intellectual Property (DJKI).

c. Substantive Examination

The arrangements and provisions regarding the substantive examination are regulated in Article 23 and Article 24 of Law No. 20/2016. The substantive examination stage is completed within a period of 150 (one hundred and fifty) days.

d. Certificate

Trademark certificate is evidence of rights to the trademark which is an exclusive right of the state issued by the DGKI and given to the owner of the rights to the trademark for a certain period of time for its own use or for the use of other parties with the permission of the trademark owner. In this case, the trademark owner will get the rights to the trademark after registering with the DGKI, this system firmly regulates that the first party to register a trademark is entitled to the trademark (Santoso, 2016). Economic rights owned by someone for innovation and creativity, its nature can be transferred or transferred to other parties (Mulyani, 2016).

Parties who use and imitate trademarks that have been registered previously by the owner of the rights to the trademark can cause legal consequences in the form of criminal sanctions as stipulated in Article 200 paragraph (2) of the Trademark and Geographical Indications Law which determines that any person who does not have the right to use a trademark that has similarities in essence with a registered trademark owned by another party for similar goods or services produced or traded, will be punished with a maximum imprisonment of 4 (four) years and / or a maximum fine of Rp. 2,000,000,000.00 (two billion rupiah). In addition, parties who cause losses to the original owner of the trademark concerned can file a civil lawsuit through litigation (Prasetya & Ariana, 2019). However, in relation to DFE, Law Number 21 Year 2016 on Trademarks and Geographical Indications has not regulated it at all. The law that has certainty is that the law has contained articles or paragraphs that in Standard Indonesian have regulated DFE.

The doctrine of foreign equivalents is a rule applied in United States trademark law that requires courts and for the TTAB to translate foreign words in determining whether they are registrable as trademarks, or confusingly similar to existing marks. This doctrine is intended to protect consumers in the United States from confusion or deception caused by the use of terms in multiple languages. In the test applied *The Trademark Manual of Examining Procedure* ("TMEP") states to apply the foreign equivalents doctrine test is "whether, to an American purchaser familiar with the foreign language, the word would indicate its English equivalent" (US Patent and Trademark Office, 2007). This test is also applied by courts to determine "whether the foreign word would describe the product to a segment of the buying public familiar with that language." (Pizzeria Uno Corp, 1984). The Federal Circuit recently clarified the application of the foreign equivalent's doctrine in likelihood of confusion cases, stating that "When it is unlikely that American purchasers would translate the foreign mark and would accept it as what it is, then the foreign equivalents doctrine will not be applied" (Palm Bay Imports, 2005). The Federal Circuit specifically found that "it is unlikely that the average American buyer would stop and translate 'VEUVE' into 'widow'" (Popular Bank v. Banco Popular, 1998).

Cases have noted that the status given to words in foreign countries has no bearing on the registration of the mark in the U.S. For example, in *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, (Anheuser-Busch, Inc. v. Stroh Brewery Co., 1984) the court rejected the common use of the phrase "*LA beer*" in Australia as irrelevant, a low-alcohol beer. In *Seiko Sporting Goods USA*,

Inc. v. Kabushiki Kaisha Hattori Tokeiten (Seiko Sporting Goods USA, Inc. v. Kabushiki Kaisha Hattori Tokeiten, 1982) the court stated that "Although the plaintiff seeks to show that Seiko is a common term in Japanese, it is not so well known in this country. Accordingly, the mark must still be considered arbitrary and fanciful in the United States. "

Further, "a number of cases have held that terms may be common in one country and suggestive in another" (Seiko Sporting Goods USA, Inc. v. Kabushiki Kaisha Hattori Tokeiten, 1982). In *Carcione v. The Greengrocer, Inc.*, (Carcione v. The Greengrocer, Inc., 1979) the court rejected the common use of the term "*Greengrocer*" in the UK for fruit retailers as irrelevant. The defendant argued that the trademark "*Greengrocer*", which was a common term in the United Kingdom for fruit and vegetable retailers, was not entitled to protection as a trademark in the United States.

In TMEP 1209.03(g) expresses the caveat that "foreign words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for description purposes." Emphasis added. "Translation is evaluated according to the segment of the buying public familiar with that language. *General Cigar Co. v. GDM Inc*, 988 F. Supp. 647, 660 (S.D.N.Y. 1997). In that case, the court found that the strength of the Cohiba mark was not diminished by the fact that Cohiba is the Taino Indian word for tobacco, as the Taino language is an obscure language. The court noted: A word which is not in common or general use, and is unintelligible and non-descriptive to the general public, though it may be known to linguists and scientists, may be considered arbitrary and fanciful and capable of being used as a trademark or trade name (*General Cigar Co. v. G.D.M. Inc.*, 1997).

If a word is a foreign transliteration of an English mark, the TTAB has held that there is nothing to translate, and the doctrine of foreign language equivalents is not utilized. In *Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, (*Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, 2008) The TTAB considered the application of the doctrine where Green Spot sought to register "Vitamilk", and was opposed by Vitasoy, who was the owner of the senior registration. It is in this doctrine that it has been criticized in recent years. Commentators have noted that courts have "reached irreconcilable ownership" in applying the doctrine (Rest, 2006). It has also been suggested that the doctrine be abolished (Krimnus, 2010).

The basis of trademark law is the desire to guard against consumer confusion by assisting consumers in identifying the source of a product. According to the *Abercrombie* spectrum, the distinctiveness metric set forth in the seminal 1976 Second Circuit case, trademarks and service marks that are "arbitrary", "fanciful", or "suggestive" are registrable. This is because consumers will identify marks such as "Kodak" (fanciful), "Apple Computer" (arbitrary), and "Greyhound" (suggestive) as inherently distinctive at source. "Descriptive" marks, i.e. marks that describe the characteristics of the product in which they are placed, can be registered only by showing "secondary meaning". That is, a mark describing the quality of a product (e.g., "Bran-Nut" for a cereal containing bran and walnuts) will obtain registration only if the consuming public has attached a unique meaning to the descriptive term as the source of the product and not just a description of it (e.g., "Best Buy").

Foreign Equivalents in Practice, in looking at how the foreign equivalents doctrine operates in practice, consider *Enrique Bernat F., SA v Guadalajara, Inc.*, 210 F.3d 439 (5th Cir. 2000). Also consider the recent case of *in re Aquamar, Inc.*, 115 USPQ2d 1122 (PTO June 25, 2015) (not precedential). *Aquamar, Inc.* appealed the Examining Attorney's decision that its mark

"MARAZUL" was likely to cause confusion with the registered mark, "BLUE SEA." The TTAB affirmed the Examining Attorney's decision, noting that consumers would be likely to "stop and translate" the marks (again, due to the prevalence of Spanish speakers in the market) and that "equivalence in the meaning of the marks outweighs differences in how the marks look and sound."

The doctrine of foreign language equivalents should be applied with equal force to all possible questions of confusion involving the comparison of two foreign word marks, whether they are of the same foreign language (*e.g.*, the French word marks TRÈS JOLIE and BIEN JOLIE) (In re Lar Mor Int'l, Inc, 1983), or different foreign languages (*e.g.*, the Italian word mark DUE TORRI and the Spanish word mark TORRES) (Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 1998), and for cases comparing foreign word marks and English-language marks (*e.g.*, the Spanish word mark BUENOS DÍAS and the English word mark GOOD MORNING) (Sutter Home Winery, Inc. v. Madrona Vineyards, L.P., 2005).

Before applying the foreign equivalents doctrine, it must be shown that the foreign language is *familiar* to a sizable segment of American consumers who are *likely to purchase* a particular good or service, and *the translation* must be one that is *likely to be made* by a significant number of potential American buyers (Kirkpatrick, 2005). The foreign equivalents doctrine recognizes the cosmopolitan character of the population and the character of international trade. As stated in the Introduction, the policy behind the doctrine is one of international benevolence. Since US companies would be disadvantaged in international trade if foreign countries granted trademark protection to generic or merely descriptive English words in their countries, the US retaliated and denied trademark protection to generic or merely descriptive foreign words (Enrique Bernat F., S.A. v. Guadalajara, Inc., 2000).

i. Guidelines That Are Rules

Under the foreign equivalent's doctrine, a mark consisting of a foreign word or words is translated into English before protection or registration analysis. Although words from modern languages are generally translated into English, the foreign equivalents doctrine is not an absolute rule, but merely a guideline. The doctrine does not apply to every foreign word that appears in a trademark or service mark (Sutter Home Winery, Inc. v. Madrona Vineyards, L.P., 2005).

ii. When to Apply

a. When Only One of the Languages is Other Than English

Marks Derived from The Trademark Manual of Examining Procedures (TMEP) suggests that the doctrine of foreign equivalents should be used only when one of the marks at issue is in English and the other in a foreign language. For example, TMEP would suggest applying the doctrine when BUENOS DÍAS is compared with GOOD MORNING, LUPO with WOLF, or EL SOL with SUN.

b. When Words Come from Foreign Languages

A typical case of the doctrine of foreign equivalents involves the comparison of one foreign word-mark with an English word-mark, and, as stated above, there is some authority to suggest that the doctrine works *only* in these circumstances (Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd., 1987).

1) Comparing Terms from the Same Foreign Language

In the first US Court of Appeals case for the Fifth Circuit to adopt the foreign equivalents doctrine in a case where both marks were of foreign origin, the court was asked to resolve a controversy between two lollipop marks that both contained

the term *chupa*, which means "lollipop" in Spanish slang. The proper Spanish translation for *chupa* is "to lick" or "to suck". In applying the doctrine of foreign equivalents, the court reasoned that although *chupa* does not literally mean "lollipop" when translated into English, the term remains generic when applied to the parties' products because *chupa* is a generic Spanish slang term for applicants for goods (Enrique Bernat F., S.A. v. Guadalajara, Inc., 2000).

2) Comparing Terms from Different Foreign Languages

When comparing marks from *different* foreign languages, courts, including the TTAB, have applied the doctrine of foreign equivalents in some cases, but not in others. In one case, the TTAB found it inappropriate to apply the doctrine of foreign equivalents and took the French expression BEL AIR and the Italian expression BEL ARIA and converted them into English translations before comparing them (Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 1998). The TTAB distinguished the previously cited decision comparing BEL AIR with BEL ARIA on the grounds that the objector in that case did not argue that the marks had similar connotations, so there was no need to consider the English translation.

iii. When Mark is a Combination of Foreign and English Words

As a general proposition, the doctrine of foreign language equivalents does not apply when a mark is a combination of a foreign and English word (French Transit v. Modern Coupon Sys., 1993). The doctrine of foreign equivalents also becomes unnecessary for foreign language-English combination marks because when a mark consists of all foreign components, translation of the entire mark by consumers is more likely than if only a portion of the mark is in a foreign language (In re Johanna Farms, 1988).

iv. Teaching Applied Languages

a. Common Modern Languages

There is some consensus as to which foreign languages the foreign language equivalent doctrine applies to. The TMEP states that only foreign words from "common modern languages" that are "familiar to a meaningful segment of American consumers" need to be translated into English before examination and analysis. Courts have even translated (to the extent translatable) slang terms from modern foreign languages (Le Blume Import Co. v. Coty, 1923). However, even words from familiar modern languages which are not common or commonly used, and which are incomprehensible and non-descriptive to the general public, though perhaps known to linguists or scientists, should not be translated into English under the doctrine of foreign equivalents (General Cigar Co. Inc. v. G.D.M. Inc., 1997).

b. Dead, Ancient and/or Obscure Language

Words of "dead or obscure" language may be so foreign to the American buying public that they should not be translated into English. The determination of whether a language is "dead or obscure" should be made on a case-by-case basis, based on the meaning that the term must have for the relevant buying public. TMEP uses Latin as an example of a dead language, but includes the caveat that if there is evidence that the Latin term is still used by the relevant buying public, the Latin term will not be considered dead. TMEP is encouraged by that this same analysis should be applied to other uncommon languages.

Moreover, in deciding registration and likelihood of confusion, the court must assess the commercial impression of the mark, as well as the overall impression created. The PACIFIC TELESIS case was decided in 1993, when telecommunications, including telephones and television, were prevalent in American society (Pacific Telesis Group v. International Telesis

Communications, 1993). Based on the common understanding (as opposed to a literal translation) of the prefix tele in American society in 1993, and consequently the commercial impression created by a mark for a telephone company including the term, the mark should have been considered merely descriptive.

4. CONCLUSIONS AND RECOMMENDATIONS

Based on the analysis, it can be concluded that the Trademark Law of 2016 has not provided adequate legal certainty regarding the registration of trademarks containing foreign terms, because it does not explicitly regulate the Doctrine of Foreign Equivalents. In fact, this doctrine is important to prevent consumer confusion or fraud due to the similarity of meaning between languages in trademarks, as has been applied in the United States. The absence of this arrangement in the Trademark Law causes legal uncertainty, as seen in the case of the registration of the "Kopitiam" trademark which, despite its similarity in meaning, is still legalized because it is not explicitly regulated in the articles of the law. Therefore, in order to ensure fair and comprehensive legal certainty in the era of global trade, this doctrine needs to be immediately incorporated expressly into the trademark legislation in Indonesia, in line with the principle of development law that makes law a tool of social engineering to create an orderly and prosperous society.

Acknowledgement

Researchers express their gratitude to all those who contributed to this study.

REFERENCE

- Anheuser-Busch, Inc. v. Stroh Brewery Co., 750 F.2d 631, 641–642 (8th Cir. 1984).
Badan Pembinaan Hukum Nasional. (2015). *Naskah Akademik Rancangan Undang-undang Merek dan Indikasi Geografis*. Jakarta: Badan Pembinaan Hukum Nasional, 49-51.
Carcione v. The Greengrocer, Inc., 205 U.S.P.Q. (BNA) 1075 (E.D. Cal. 1979).
French Transit v. Modern Coupon Sys., 818 F. Supp. 635, 636 (S.D.N.Y. 1993).
Hidayah, K. (2017). *Hukum HKI, Hak Kekayaan Intelektual* (Malang: setara Press, 2017), 54 dan 62.
Kirkpatrick, R. L. (2005). *Likelihood of confusion in trademark law* (Vol. § 4:3). Thomson Reuters.
Krimnus, S. (2010). The doctrine of foreign equivalents at death's door. *North Carolina Journal of Law & Technology*, 12(1), 159–193.
Le Blume Import Co. v. Coty, 293 F. 344, 358 (2d Cir. 1923).
McCarthy, J. T. (2004). *McCarthy on trademarks and unfair competition* (4th ed., § 11:35, p. 11-69). Thomson Reuters.
Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 49 U.S.P.Q.2d 2018, *6–7 (T.T.A.B. 1998).
Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 49 U.S.P.Q.2d 2018, *6–7 (T.T.A.B. 1998).
Mulyani, S. (2016). Realitas pengakuan hukum terhadap hak atas merek sebagai jaminan fidusia pada praktik perbankan di Indonesia. *Jurnal Hukum dan Dinamika Masyarakat Universitas 17 Agustus 1945 Semarang*, 11(2), 135–148.
Pacific Telesis Group v. International Telesis Communications, 994 F.2d 1364, 1370 (9th Cir. 1993).
Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369 (Fed. Cir. 2005).

- Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1377 (Fed. Cir. 2005).
- Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1531 (4th Cir. 1984).
- Popular Bank v. Banco Popular, 9 F. Supp. 2d 1347, 1359 (S.D. Fla. 1998).
- Prasetya, I. M. D., & Ariana, I. G. P. (2019). Pengaturan merek produk makanan (berdasarkan Undang-Undang No 20 Tahun 2016 tentang Merek). *Kertha Semaya: Journal Ilmu Hukum Universitas Udayana*, 7(1), 1–14.
- Rest, E. J. (2006). Lost in translation: A critical examination of conflicting decisions applying the doctrine of foreign equivalents. *The Trademark Reporter*, 96, 1211–1245.
- Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd., 5 U.S.P.Q.2d 1980, 1982 (T.T.A.B. 1987) (quoting McCarthy, J. T. (1984). *McCarthy on trademarks and unfair competition* (2nd ed., § 23:14, p. 80)).
- Santoso, E. (2016). Penegakan hukum terhadap pelanggaran merek dagang terkenal melalui peran kepabeanan sebagai upaya menjaga keamanan dan kedaulatan negara. *Jurnal Rechts Vinding: Media Pembinaan Hukum Nasional*, 5(1), 117–134.
- Saraswati, I. A., & Ibrahim, R. (2017). Pembatalan merek karena adanya kesamaan konotasi dengan merek lain yang telah terdaftar. *Kertha Semaya: Fakultas Hukum Universitas Udayana*, 7(1), 1–15.
- Seiko Sporting Goods U.S.A., Inc. v. Kabushiki Kaisha Hattori Tokeiten, 545 F. Supp. 221, 226 (S.D.N.Y. 1982).
- Seiko Sporting Goods USA, Inc. v. Kabushiki Kaisha Hattori Tokeiten, 545 F. Supp. 221, 226 (S.D.N.Y. 1982).
- Soerjono Soekanto & Sri Mamudji, *Penelitian Hukum Normatif*, (Jakarta: Rajawali, 1986), 14.
- Suratman, dan Philips Dillah, *Metode Penelitian Hukum*. Jakarta: Alfabeta, 11.
- Sutter Home Winery, Inc. v. Madrona Vineyards, L.P., 2005 U.S. Dist. LEXIS 4581, 20–21 (N.D. Cal. 2005).
- Sutter Home Winery, Inc. v. Madrona Vineyards, L.P., 2005 U.S. Dist. LEXIS 4581, 18 (N.D. Cal. 2005) (quoting *In re Pan Tex Hotel Corp.*, 190 U.S.P.Q. 109, 110 (T.T.A.B. 1976)).
- TMEP § 1207.01(b)(vi).
- Tim Lindsey, (Ed), *Hak Kekayaan Intelektual, Suatu Pengantar*, Cetakan ke 7, Bandung: Alumni, 2013, hlm. 26.
- United States Patent and Trademark Office. (2004, March 3). *About the TTAB*. U.S. Department of Commerce. <http://www.uspto.gov/go/dcom/ttab/about.htm>
- United States Patent and Trademark Office. (2007). *Trademark manual of examining procedure (TMEP)*. U.S. Department of Commerce.
- Waluyo, B. (1991). *Penelitian hukum dalam praktek*. Sinar Grafika.