

## Use of Similar Trademarks According to Law Number 20 of 2016 Concerning Trademarks and Geographical Indications (Case Study of Supreme Court Decision Number 162K/Pdt.Sus-HKI/2021)

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### Abstract

In this modern era, people's creativity is growing rapidly, this has led to the birth of innovative products. To be able to distinguish these products are usually called trademarks. The research method used is juridical-normative and literature approach. Trademarks are the essence of the smooth trading of goods or services. In accordance with the trademark system in Indonesia according to the National Legal Development Agency (BPHN), namely the first to file principle system, meaning that the owner of a trademark license registers his trademark with the Director General of Intellectual Property Rights first. Regulations regarding these trademarks are stipulated by the Indonesian government with the aim of avoiding similarities between products in circulation. However, there are still many disputes regarding similar trademarks, and settlement of trademark disputes can be carried out if the licensee files a lawsuit against the Commercial Court. Another alternative in dispute resolution is arbitration.

**Keywords:** Trademark, Brand License, IPR Protection and Case Analysis



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### INTRODUCTION

In this modern era, people's creativity is growing rapidly, this has led to the birth of innovative products. The product in question can be in the form of clothing and food products. The number of new innovations, resulting in a lot of trading going on. Trade itself is taken from the word trade, which according to the Big Indonesian Dictionary "trade means work related to selling and buying goods to make a profit". Particularly in Indonesia, there is a lot of trade resulting from community innovation. To be able to distinguish these products are usually called trademarks. According to Law 20 of 2016 article 1 paragraph 2 "Trademarks are marks that are used on goods traded by a person or several people together or a legal entity to differentiate from other similar goods".

Trademarks are also identification marks for the public, which affect the marketing process and the income/loss of a product. To win the trade market, a brand must provide all the advantages of the brand<sup>1</sup>. In order for the trademark to be official in the eyes of the law, it must be registered. In registering a trademark, there are several conditions that are taken into consideration for the acceptance of the mark. One of the conditions is to have brand characteristics or to have the power to differentiate from other productions. Every legal subject who has registered a mark, will get the right to the mark, along with the mark registration number. This number is a guarantee that the mark has been registered.

To provide legal certainty for Indonesian entrepreneurs, the Indonesian government has established regulations related to marks and geographical indications. Which is located in Law 20 of 2016 concerning Marks and Geographical Indications. The law has been amended four times, the law on marks was first contained in Law 21 of 1961, then changes were made to Law 12 of 1992, the third amendment was replaced with Law 15 of 2001. The last amendment was changed to Law 20 of 2016, these changes were made to increase legal protection for brand

owners and reduce similar trademark disputes. The trademark regulation was established by the Indonesian government with the aim of avoiding similarities between one product and another. But in fact in Indonesia there are many trademark similarities, because of that researchers are interested in conducting research with the aim of knowing how to resolve similar trademark disputes in accordance with established regulations.

One example of a similar trademark dispute problem can be seen from the Geprek bensu dispute with I am Geprek bensu, there was a dispute over obtaining trademark ownership rights. Trademark rights themselves are included in civil law regarding immaterial/intangible objects, these rights are often referred to as intellectual property rights, abbreviated as HKI. Consideration of decision Number 162 K/Pdt.Sus-HKI/2021 in a trademark dispute must be in accordance with the provisions of the trademark regulation. Based on this background, the authors are interested in further researching this matter. Based on the background described by the author, the problem in this research is formulated as follows: How are the judges' considerations in the decision case Number 162 K/Pdt.Sus-HKI/2021? How to resolve similar trademark disputes based on law number 20 of 2016?

## **RESEARCH METHODS**

This research uses the juridical-normative research method, which means that this research uses legal material that has been written in national institutions and is a social guideline that is used as a standard of behavior. (Marzuki, 2005). Or it can be interpreted, this research examines library materials and secondary data or regulations/regulations related to this research topic. By using a juridical approach, this research focuses on the rules or legal rules regarding the brand law which are located in "UU 20 of 2016" "regarding marks and geographical indications". This study collected data using a literature approach, namely research using legal sources/materials that can be accounted for. The primary legal materials used in this research are the 1945 Constitution, Law 20 of 2016 (MARK ACT), Law no. 30 of 1999 concerning Arbitration and Alternative Dispute Resolution, Supreme Court Decision Number: 162 K/Pdt.Sus-HKI/202. The tertiary legal materials used in this research are journals, literature, theses, theses, articles obtained from library research and can be accounted for. The analytical method used to examine the data in this study is the qualitative data analysis method.

## **RESEARCH RESULTS AND DISCUSSION**

### **Protection of Trademark Rights according to Law 20 of 2016 concerning Marks and Geographical Indications**

Trademarks are the essence of the smooth trading of goods or services. A brand becomes an image or guarantee for the quality of goods/services, and also becomes a company asset that can determine the profit of a business. The important role that is owned by a brand requires the making of regulations/regulations that protect the Mark, in the Trademark Law, namely "Law 20 of 2016" Concerning Marks and Geographical Indications The owner of the 3a word mark is the one who previously registered the mark with the Director General of Intellectual Property Rights, to carry out inspection and registration of said mark.

Marks protected in Law 20 of 2016 consist of signs in the form of images, logos, names, words, letters, numbers, color arrangements, in 2 (two) or 3 (three) dimensional forms, sounds, holograms, or elements that can distinguish goods or services produced by legal subjects or legal entities. In order to get the 3a katas for the brand, it is necessary to go through several stages according to what is stated in the regulations on the TRADE ACT. The first stage, detailed examination of marks based on Law 20 of 2016 Chapter IV, is contrary to state ideology, contains elements of deception, has no distinguishing power, etc. After the application for

registration has complied with the formality and substantive requirements stipulated in the Trademark Law, a date for receipt of the application will be given and an announcement will be made in the official mark news. A mark can be said to be valid if the mark certificate has been issued, and if the application for registration of the mark is rejected, the applicant can file an appeal.

The brand's exclusive right granted by the state to the brand owner is a guarantee of legal protection for the brand and is the only owner who has the right to use and use it and prohibits and allows anyone to own and use it, but the brand owner can grant a license agreement in accordance with the law. 20 of 2016 Article 42. The above trademark rights protection has a term of 10 (ten) years from the date of receipt and can be extended in accordance with the provisions in article 35 paragraph 2 of the MARK ACT. The first to file principle system is a guarantee for trademark owners who register their trademarks with the Director General of Intellectual Property Rights, this system is considered a trademark principle in Indonesia according to the National Legal Development Agency (BPHN).

### **Judge's Considerations in Supreme Court Decision Number 162 K/Pdt.Sus-HKI/2021**

Primary legal material based on Supreme Court decision Number 162 K/Pdt.Sus-HKI/2021 is the basis for this research. This ruling is a de facto or real case that occurred regarding a similar trademark dispute.

1. Main case in Supreme Court Decision Number 162 K/Pdt.Sus-HKI/2021
  - a. Cancellation of rights to Food Packaging Box Industrial Design Registration No. IDD000049596 which was registered on 20 July 2018 under the name Ruben Samuel Onsu belonging to Defendant I in MA Decision NO 162 K/Pdt.Sus-HKI/2021.
  - b. Government to the Directorate of Copyright and Industrial Design to record decisions on cancellation of rights, and to make announcements in the Official Industrial Design Gazette.
  - c. Sentenced Defendant 1 to stop all actions related to using the Food Packaging Box Industrial Design Right registration number IDD000049596 dated 20 July 2018 on behalf of Ruben Samuel Onsu on the basis that the Plaintiff was the first party to implement the first to file principle system.
  - d. Punish Defendant I to pay compensation in the amount of Rp. 100,000,000,000.00 (one hundred billion rupiah) and Punish Defendants I and II jointly and severally to pay the plaintiff forced money for their respective delays in implementing this decision amounting to Rp. 50,000,000.00 ( fifty million rupiah)
2. Consideration of the Judge's Decision. Taking into account that Ruben Samuel Onsu's "GEPREK BENSU" brand has no significant difference in terms of shape or configuration with the "I Am Geprek Benu Beneerrr" brand owned by PT Ayam Geprek Benny Sujono.



**Figure 1.**

Source : Logo Geprek Benu. Wikimedia Commons



**Figure 2.**

Source: iamgeprekbensu.com

Whereas based on Figures 1 (one) and 2 (two) there has been a violation of the rights to the mark on the legal basis "UU 20 of 2016" Article 2 Paragraph (3) "Protected marks consist of signs in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and/or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by persons or entities law in trading activities of goods and/or services". Therefore, based on the first to file principle, the brand "I AM GEPREK BENSU SEDEP BENEERRR" has previously registered on May 3, 2011, which means the owner of the exclusive rights to the brand is "I AM GEPREK BENSU SEDEP BENEERRR". Considering that the "Geprek Bensu" Mark committed an event that violated the law and/or the law, the Commercial Court's decision at the Central Jakarta District Court in this dispute is deemed valid. Therefore, there was a rejection of the cassation petition by the cassation applicant.

### **Settlement and Sanctions for Similar Trademark Disputes according to Law 20 of 2016**

Trademark disputes often occur due to the development of people's creativity, therefore in "Law 20 of 2016" Article 83 Paragraph 3 "Registered Mark Owners and/or registered Mark Licensee may file a lawsuit against other parties who use the Mark unlawfully. have similarities in principle or in whole for similar goods and/or services in the form of: Claims for compensation; and/or Termination of all actions related to the use of the Mark." Therefore, a lawsuit against the Commercial Court can be filed by the brand owner, and processed by investigation, evidence based on the provisions of Article 83 "Law 20 of 2016. However, the settlement of trademark disputes can go through the process stated in ""Law Law 20 of 2016" Article 93" "Dispute resolution can be resolved through arbitration or alternative dispute resolution". Alternative dispute resolution based on Law no. 30 of 1999 there are 6 (six) techniques, namely Mediation, Arbitration, Negotiation, Consultation, Conciliation, Expert Assessment. The sanction received by the defendant if the licensor files a lawsuit against the Commercial Court based on "Law "20 of 2016" Article 100" paragraph 2, is "Any person who without rights uses a Mark that is similar in principle to a registered Mark belonging to another party for similar goods and/or services produced and/or traded, shall be punished with imprisonment for a maximum of 4 (four) years and/or a fine of a maximum of Rp. 2,000,000,000.00 (two billion rupiahs)".

### **CONCLUSION**

From the results and discussion related to similar trademarks, this research can be concluded as follows: Trademarks are the core or image of a business, the important role that a brand has requires the making of regulations/regulations that protect the Mark, in the Trademark Law, namely "Act -Law 20 of 2016" concerning Marks and Geographical Indications. In accordance with the trademark system in Indonesia according to the National Legal Development Agency (BPHN), namely the "first to file principle" system, meaning that the

owner of the trademark license registers the trademark with the Director General of Intellectual Property Rights first. The considerations made by the Judge in the decision of the Supreme Court number "162 K/Pdt.Sus-HKI/2021, are based on established regulations/rules. Whereas based on the data in the dispute, the defendant had committed an incident that was contrary to the law, namely the defendant's brand "GEPREK BENSU" did not differ in terms of shape or configuration from the brand "I AM GEPREK BENSU SEDEP BENEERRR". In the Trademark Law, trademark disputes can be resolved by means of a license owner filing a lawsuit against the Commercial Court. Another alternative in dispute resolution is arbitration.

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