



Legal protection of registered marks (juridical analysis of court decision number 2/Pdt.Sus.Hki/Merek/2020/Pn Niaga Mdn)

Yolanda Julida Simbolon¹, Ivania Chintyane Deo², Marlina Elisabeth Pakpahan³, Tajuddin Noor⁴

^{1 2 3 4}Legal Studies Program, Prima University, Indonesia. Email:marlinaelisabethpakpahan@unprimdn.ac.id

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ABSTRACT

Trademark rights are one type of Intellectual Property Rights which differentiates the origin of the goods and services. The existence of this protection shows that the state is obliged to enforce brand law, such as protecting registered brands. This type of research is normative legal research. Normative research is doctrinal law where law is often conceptualized as what is written in regulations. Legislation (Law in book) or laws decided by judges through the court process. Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn confirms that the Plaintiff's Goat Brand must be legally protected until 2025. By having a "GOAT BRAND" brand certificate, the Plaintiff deserves exclusive rights protection of ownership and use of the brand. In this decision, the judge found similarities between the brands "GOAT BRAND" and "2 GOATS", as well as the bad faith of the Defendant. The judge also referred to the principle of the first to file system in brand law in Indonesia so that the Plaintiff deserves to get protection of exclusive rights to ownership and use of the mark.

Corresponding Author:

Marlina Elisabeth Pakpahan,
Faculty of Law, Legal Sciences,
Prima University, Medan, Indonesia,
Jl. Sekip Jl. Sikambing No. Simpang, Se Putih Tim. I, North Sumatra,
20111, Indonesia.
Email: marlinaelisabethpakpahan@unprimdn.ac.id

1. Introduction

Brand rights are a type of Intellectual Property Rights (IPR) which have a very important role because by using a brand on goods and/or services it can differentiate the origin of the goods and services (Ningsih & Purwaningsih, 2023). Each producer will give unique characteristics to the goods or services produced which differentiate them from other goods or services (Indah & Indrawati, 2021).

Brands are also very important in the world of advertising and marketing because the public often associates an image, quality or reputation of goods and services with a particular brand (Kamila, 2022). A brand can be very valuable commercially. A company's brand is often more valuable in comparison with the company's real assets (Nugraha & Krisnamurti, 2019).

Brands are also useful for consumers. They buy certain products (which can be seen from the brand) because they think the brand is high quality or safe for consumption due to the brand's reputation (Nafiisah et al., 2021). If a company uses another company's brand, consumers may feel cheated because they have purchased a lower quality product.

The definition of a brand is regulated in Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications, which revises the previous Law, namely Law Nornor 15 of 2001 concerning Trademarks (YY Men, 2022). In article 1 paragraph 1 of Law Number 20 of 2016 concerning Marks and Geographical Indications it is stated: "A brand 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 differentiate goods and/or services produced by individuals or legal entities in goods and/or services trading activities."

In Indonesia there are several cases of brand infringement such as brand counterfeiting or brand imitation, one of these cases is the case of imitation of the Goat Brand, a glue brand that has been known for a very long time in the community, especially the people in Medan, North Sumatra. Even though the brand uses English, namely "GOAT BRAND = GOAT BRAND" but in general people call it "goat stamp glue" because the main image of the brand is a goat which has been registered based on the application document for registration of company marks and commercial marks, dated 3 April 1973 and continues to be extended until the Trademark Protection period in 2025 so that legally it must be protected by the state.

Goat brand glue (Goat Brand) has existed in trade in the community since the 1970s, especially in the North Sumatra region, goat brand glue (Goat Brand) is very popular in people because the price is affordable and it is a multi-purpose glue. In this case, the owner of the Goat Brand brand is suing the "2 Kambing" brand glue, which is basically similar to the Plaintiff's brand glue, namely Goat Brand glue. Protection for well-known brands is provided by the state through law, both preventive and repressive protection (Noviarni, 2022).

Preventive protection is contained in Articles 4, 5, 6 of Law No. 5 of 2001 concerning Trademarks which have now been revised in Articles 20, 21, 22 of Law No. 20 of 2016 concerning Brands and Geographical Indications. Meanwhile, repressive protection is contained in the criminal provisions and Articles 90 to 95 of Law no. 15 of 2001, which is in Law No. 20 of 2016 above in Articles 100 to Article 103 of Law No. 20 of 2016. The existence of this protection shows that the state is obliged to enforce trademark law. Therefore, if there is a violation of a registered trademark, the trademark owner can file a lawsuit in court, with this protection justice will be realized which is the goal and law (Sufilah, 2021).

2. Method

This type of research is normative legal research (Rifa'i, 2023). Normative research is doctrinal law where law is often conceptualized as what is written in regulations, legislation (Law in book) or law decided by a judge through a court process (Siregar & Sitorus, 2022). The nature of the research in this writing is analytical descriptive. Analytical descriptive is a method used with the aim of describing or providing answers to a research object being studied through data that has been collected and making conclusions about a research object (Waruwu, 2023). The data obtained was then analyzed qualitatively (Fadli, 2021).

3. Analysis and Results

3.1. Regulations for trademark registration according to Law No. 20 of 2016 concerning Geographical Indication Marks are regulated by decision Number 2/Pdt.Sus. IPR/Brand/2020/PN Niaga Mdn.

The current era of globalization has created many business opportunities for entrepreneurs in

Indonesia in order to advance the national economy. Entrepreneurs in Indonesia compete with each other in carrying out activities in the business world, so entrepreneurs must try to create a form of distinguishing sign that can distinguish one product from another and attract consumer interest (Y. Putra et al., 2021). This distinguishing mark is known as a brand (trademark) which is basically a sign to identify the origin of goods and/or services from a company or individual. A brand has the function of providing identification marks for goods, in order to differentiate a person's or company's goods from other people's or companies' goods (Adawiyah, 2023). In registering a mark, there are four stages that must be fulfilled, namely formality examination of the mark, substantive examination, and announcement after the process of formality examination and substantive examination of the mark is complete, then certification, this indicates that someone has the rights to the mark. A brand has the function of providing identification marks for goods, in order to differentiate a person's or company's goods from other people's or companies' goods (Adawiyah, 2023).

The right to a trademark is a special (exclusive) right granted by the state to the owner to use the trademark himself or to give permission to other people to use it (Al Manda, 2022). The granting of special rights by the state has the consequence that to obtain them one must go through a registration mechanism, so that the nature of registration is mandatory (compulsory). In order for trademark rights to receive protection and recognition from the state, the trademark owner must register it with the state. If a brand is not registered, it will not be protected by the state. As a consequence, the brand can be used by everyone (Arifin & Iqbal, 2020). Article 4 of Law of the Republic of Indonesia Number 20 of 2016 provides an explanation of the Procedures for Applications for Mark Registration.

In Article 21 Paragraph (1) letter a of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, it is stated that an application is rejected if the mark has similarities in essence or in its entirety with a registered mark belonging to another party or was applied for previously by the other party for goods and services. /or similar services. In the brand system it is known as the first to file system. Thus, whoever submits the trademark application first, the applicant will be registered and receive the filing date and registration number first. Applicants will receive a receipt date and registration number first if they meet the minimum requirements set out in the legal regulations in the field of trademarks (Sagita, 2023).

Article 4 paragraph (1) Law no. 20 of 2016 concerning Trademarks and Geographical Indications which states that "applications for trademark registration are submitted by the applicant or his proxy to the minister electronically or non-electronically in Indonesian." Trademark registration aims to obtain legal certainty and legal protection for trademark rights. That the Plaintiff's goat brand glue (Goat Brand) is a glue brand that has been known for a very long time in the community, especially people in Medan, North Sumatra, even though the brand is in English, namely "GOAT BRAND = GOAT BRAND" but in general the public calls it "cap glue goat" because the main image of the brand is a goat.

That in accordance with the legal protection system that has been determined in Law No. 20 of 2016 concerning Trademarks and Geographical Indications which determines that protection of rights to trademarks is given only based on registration (a constitutive system based on the first to file system), meaning that protection is given to those who register First, by having registered and obtained the "GOAT BRAND" trademark certificate, the Plaintiff deserves exclusive legal protection for the ownership and use of the "GOAT BRAND" trademark.(Wijanarko & Pribadi, 2022).

Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn explains that the "2 KAMBING" brand, including the existence of slight differences in the elements created by the owner of the "2 Kambing" brand, is seen as a tactic or strategy so that there are no similarities. Overall, the brand "GOAT BRAND" or Goat Brand, in other words, does not imitate it in its entirety, and making slight differences can mislead the public, that is, it can give the impression to the public as if the goods or services produced are the same as the existing brand.

The "2 GOATS" mark involves elements of things that are contrary to decency and public order, including bad intentions. The Defendant is deemed to have bad intentions in using its mark, because it is done in a way that is not appropriate and honest because it is trying to piggyback on, imitate or plagiarising another party's trademark, which had previously been used and registered by the plaintiff. The Defendant's action is seen as an action to solely benefit his business interests which can bring losses to other parties or create conditions for fraudulent transactions, defraud or mislead consumers.

3.2 Legal Protection of Rights to Marks according to Law No. 20 of 2016 concerning Geographical Indication Marks is stipulated in decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn.

The definition of a brand in Article 1 point 1 of Law Number 20 of 2016 concerning Brands, provides a definition of a brand as 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 differentiate goods and/or services produced by individuals or legal entities in the activities of trading goods and/or services. Brands are used to differentiate goods or production from one company from goods or services produced by other similar companies (Habiby et al., 2023). In other words, a brand is an identification mark of the origin of the goods and services in question with the producer, thus depicting a guarantee of the personality (individuality) of the goods and services resulting from the business when traded.

(ASNAN, 2021) Legal protection is to provide protection for human rights (HAM) that are harmed by people and this protection is given to the community so that they can enjoy all the rights granted by law. The right to a trademark is an exclusive right granted by the state to the owner of a registered trademark for a certain period of time by using the trademark himself or giving permission to another party to use it (Sulastrri & Hidayat, 2022). In this decision, the judge provided legal protection for registered trademark rights and prohibited the defendant from using a trademark that imitates the applicant's trademark (Prabowo et al., 2023).

According to Article 2 paragraph 3 of Law No. 20 of 2016, protected marks consist of signs in the form of images, logos, names, words, letters, numbers, color arrangements, in 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or combination of 2 (two) or more of these elements to differentiate goods and/or services produced by individuals or legal entities in goods and/or services trading activities. Whereas in the legal consideration of Decision Number 2/Pdt.Sus.HKI/Merek/2020 /PN Niaga Mdn, it is stated that it is in accordance with the legal protection system that has been determined in Law No. 15 of 2001 concerning Marks and Law No. 20 of 2016 concerning Marks and Geographical Indications which determines that protection of rights to marks is given only based on registration (a constitutive system based on a first to file system), meaning that protection is given to whoever registers first, then By having registered and obtained the "GOAT BRAND" trademark certificate, the Plaintiff deserves exclusive legal protection for the ownership and use of the "GOAT BRAND" trademark.

Based on the evidence submitted by the Plaintiff before the trial, namely Exhibits P-4, P-5 Jo P-1, that it has been registered since October 13 2005, the mark "GOAT BRAND" has legal protection and is guided by Article 35 paragraph (1) Law Number 20 of 2016 concerning Trademarks and Geographical Indications / Article 28 of Law Number 15 of 2001 concerning Trademarks which basically determines the period of protection for a registered mark is 10 (ten) years from the date of receipt starting November 28 2015, then The registered mark "GOAT BRAND" is still under legal protection from 28 November 2015 until 28 November 2025.

Trademark rights protection is carried out by the State, and the State is responsible for protecting the trademark rights of its citizens (Astikasari, 2024). The state protects the brand rights of its citizens through regulations that are formulated in such a way as to create order and justice in

society. Trademark rights protection is obtained after trademark registration is carried out. A trademark that has been registered is called a registered trademark (Harati, 2023).

3.3. The judge's considerations in deciding the decision case according to Law No. 20 of 2016 concerning Geographical Indication Marks are tied to decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn.

A trademark that has been registered and accepted by a related institution will give rise to trademark rights held by the party who owns the trademark (Rajagukguk et al., 2022). The party who owns the brand will of course also have legal rights attached to it in the form of legal protection for their creative work. The brand holder can also file a trademark cancellation lawsuit against the brand they consider. If it is similar to the brand it owns, not only will there be a lawsuit, but the brand holder can also take criminal action. In addition, the trademark holder also has the right to obtain compensation for the trademark cancellation lawsuit he/she files (Rajagukguk et al., 2022).

The decision of the judge who examined and decided the case in Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn was *Judex Facti*, that is, it was considered correct and did not conflict with the law in the *quo case*. The legal considerations of the Panel of Judges in the *aqua case* stated that there were similarities in essence between the mark "GOAT BRAND" which in the Indonesian translation is "Cap Kambing" or "Brand Kambing" (owned by the Plaintiff), and the mark "2 GOAT" owned by the Defendant which has a class / goods of the same type, is closely related to bad intentions in the case of dishonest dealing by attempting to use a brand by imitating a previously existing brand, so that the brand on the goods or services produced is essentially the same and gives the impression to the public as if the goods or the services it produces are the same as existing brands.

In Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn, the judge considered Based on the Decision of the Commercial Court at the Medan District Court in case Number: 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn, dated 02 March 2021 jo. Supreme Court Decision Number: 1093 K/Pdt.Sus-HKI/2021, dated September 8 2021, "The '2 Kambing' brand was declared to be substantially similar to the Goat Brand and the "2 Kambing" brand was declared invalid by the Court,"

Whereas based on the evidence presented by the Plaintiff, the Defendant's actions are deemed to be in conflict with the protection of the rights to the "GOAT BRAND" brand which the Plaintiff owns in order to protect goods or services in Class 1 in the form of Glue for industry, and from the whole The existing evidence can apparently be proven that the Plaintiff is actually the first user and legal owner of the registered mark "GOAT BRAND", on the other hand, the defendant is deemed to have failed to prove that the activities he carries out are in fact no different from goods and/or services. belongs to the Plaintiff in class 1.

Whereas the Trademark Law applies the principle of the First to File system, which states that a mark registered first by its user in good faith and in accordance with applicable procedures will receive legal protection, therefore the owner of a registered mark has the right to prevent other parties from using his mark. without permission. Therefore, based on the First to File principle adopted in the Brand Protection System in Indonesia, "it is clear that the owner of the Goat Brand has the right as the party who first registered the word "GOAT or GOAT" as a brand for Class Code 1 (one) goods at the Brand Directorate ."

That based on the considerations of the Panel of Judges who examined and decided the case with Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn regarding the application of Article 6 paragraph (1) letter b and paragraph (2) of Law of the Republic of Indonesia No. 15 of 2001 on Brand Jo. Article 21 paragraphs (1) and (3) of Law No. 20 of 2016 which includes the Explanatory Article, is sufficient reason for the Panel of Judges to partially grant the Plaintiff's claim.

4. References

Based on the results of research and discussion in Court decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn) several conclusions can be drawn; Law Number 20 of 2016 concerning Trademarks and Geographical Indications applies a constitutive system, meaning that the right to a trademark is obtained through a registration process. The registered mark must meet the requirements and the applicant must have good intentions. Decision Number 2/Pdt.Sus.HKI/Merek/2020/PN Niaga Mdn confirms that the Plaintiff's Goat Brand must be legally protected until 2025. Legal protection for marks only applies to marks that have been registered in accordance with the Law. Law No. 20 of 2016. This system is based on the first to file system principle, which means that protection is given to those who register first. By having a "GOAT BRAND" trademark certificate, the Plaintiff deserves exclusive rights protection for the ownership and use of the trademark. In the decision, the judge found similarities between the brands "GOAT BRAND" and "2 GOATS", as well as bad faith on the part of the Defendant. The judge also referred to the first to file system principle in brand law in Indonesia.

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