

RESOLUTION OF FAMOUS TRADEMARK DISPUTES IN INDONESIA**(Study of Supreme Court Decision Number 58/Pdt.Sus-Merek/2020/PN.Niaga.Jkt.Pst)**Rizqi Aulia Amanda¹, Hanifah Febriani²¹ Muhammadiyah University of Surakarta (C100190253@student.ums.ac.id)² Muhammadiyah University of Surakarta (Hf185@ums.ac.id)**ABSTRACT**

Brand is an identification or characteristic that is able to describe individuality and guarantee the quality of goods and services produced in business. Brands are very meaningful in business. Brands in certain goods or services that are well-known and selling well in the market often encourage entrepreneurs and other producers to spur their product results so they can compete with other well-known products, even though unhealthy disputes often arise. Brand ownership is recognized when the mark is registered with DJKI. Even though this has been regulated, violations of trademark rights still occur. This research will discuss the settlement of trademark disputes between Nintendo Co., Ltd as the plaintiff against PT Cardolestari Indonesia as the defendant, based on Law no. 20/2016. This study uses normative legal research methods carried out through secondary data collection, with primary and secondary legal materials and with the Nintendo Co. Case approach. Ltd against PT Cardolestari Indonesia. From the results of the research it was found that legal protection in handling disputes over registered trademarks is a legal principle of "first to file" by the first trademark registrar registered at the trademark office in Indonesia as well as for well-known brands that already exist and are registered first in other countries. The result of the decision is in accordance with the statutory regulation Number 20/2016 concerning Marks and Geographical Indications.

Keywords: Brand, Trademark Dispute, Dispute Resolution

INTRODUCTION**1.1 Background**

Brand is a very important thing in business. With the development of industry and trade, brands have become an important part of trade and marketing issues, because business operators compete to promote the products and services they offer (Disemadi, 2022). Brands play an important role because they identify the source of goods and services (Semaun, S. 2016). The function of a brand is to make it easier for buyers to identify and make purchases based on the quality and characteristics of the product or service, usually based on the uniqueness of the brand (Permata and Utama, 2019).

Brands are one of the products of Intellectual Property and are regulated in Law No.20/2016 concerning Brands and Geographical Indications. The law explains "A brand is a distinguishing mark on an item which can be in the form of an image, logo, name, number, color arrangement, in 2-dimensional and/or 3-dimensional form, or a combination of 2 (two) or more of these elements." Business actors create brands with the aim of differentiating the goods and/services they produce. Apart from that, there are also international brand regulations, namely the Paris Union Convention which focuses on ensuring the protection of property rights in the industrial sector (Rares, 2018).

In order for a brand to obtain legal protection, brand owners must register with the DJKI to obtain rights to the brand. The main requirement for trademark registration is to prove that the mark contains its own characteristics so that it can be differentiated from the marks of other parties. Therefore, DJKI cannot approve trademark registration and cannot provide appropriate legal protection (Risawandi, 2005).

The Trademark Law also regulates various legal remedies for legal trademark owners who are

infringed by other parties. Below is a dispute handling system for brand owners who want to claim their rights:

1. Civil proceedings can be filed based on article 83 of Law No.20/2016. Actions can be filed against other parties who illegally use an unauthorized mark of the same subject or a similar mark. The brand owner has the right to ask the commercial court to compensate for the losses he has caused and to ask the commercial court to decide to stop all relevant actions regarding the use of the mark.
2. Criminal proceedings, sanctions provisions for trademark infringement are regulated in articles 100-103 of Law no. 20/2016. Not having the right to use a similar mark as a registered mark is punishable by imprisonment for a maximum of 5 (five) years and/or a maximum fine of Rp. 2,000,000,000.00 (two billion rupiah). Criminal charges can still be filed in a civil lawsuit. Civil lawsuits do not eliminate the state's right to file criminal charges against parties who have bad intentions.
3. The administrative process for trademark infringement can be carried out through the national administrative body. Sanctions can be imposed on parties who do not have the right to use a brand in the form of a ban on imports, distribution permits for branded goods belonging to other partners or a ban on advertising brands that deceive consumers.

There is a case of a trademark dispute that occurred in Indonesia, namely in decision No.58/Pdt.Sus-Merek/2020/PN.Niaga.Jkt.Pst. dispute between Nintendo Co., Ltd as the plaintiff against PT.Cardolestari Indonesia and Eddy Tumewu as the defendant and the Directorate General of Intellectual Property as the co-defendant. In his lawsuit, the plaintiff requested that the defendant's Super Mario Bros. trademark be cancelled, because the brand has the same writing and pronunciation, which is pronounced in the same sound and consists of exactly the same words.

1.2 Formulation of the problem

Based on the background results above, this research will discuss how the legal protection of trademark rights in Indonesia is and discuss how to resolve trademark disputes between Nintendo Co., Ltd and PT Cardoseris Indonesia.

RESEARCH METHODS

In this research discussion, normative legal research methods are used, carried out through secondary data collection and literature study. Descriptive-qualitative analysis. The discussion will focus on laws and regulations in the field of brands and related laws and regulations. In the discussion regarding the case issue, a case approach was used between Nintendo Co., Ltd and PT Cardoseris Indonesia. The legal materials used are primary legal materials and secondary legal materials. Primary legal materials consist of laws and regulations regarding brands and brand licensing. Secondary legal materials are obtained from textbooks or literature related to the principles of brand protection, research results, and legal writings related to brands in the form of articles or journals. Research with this approach is carried out with the aim that researchers can solve existing problems or cases and/or make decisions based on existing positive law (Dimiyati, Khudzaifah and Wardiono, Kelik, 2004).

RESULTS AND DISCUSSION

A. Legal protection of trademark rights in Indonesia

Trademarks are an element of intellectual property rights. In this case, the brand shown in intellectual property is a sign attached to the goods or services being traded to differentiate them from similar goods/services sold by other parties. A brand is an identification mark for a product that can be used to differentiate one product from another. Brands are intellectual property rights that need to be protected (Harsono Adisumarto, 1990).

Registered brands get legal protection for both local or foreign brands, known or unknown. Therefore, brand owners must register their brand with DJKI to get legal protection. The grace period is 10 (ten) years for legal protection of a registered mark, starting from the receipt of the request for mark registration. At the request of the brand owner, the brand protection period may be extended. Legal protection based on the "first to file" system is given to registered trademark owners with the character of 'good faith' in a preventive or repressive manner (Meli hertati gultom, 2001).

For a long time, brand regulations in Indonesia have been regulated, namely with the issuance of Law No. 21/1961 concerning Company Marks and Commercial Marks, which was then changed to Law No. 19/1992 concerning Brands. With Indonesia joining the TRIPs Agreement, the Trademark Law was amended in 1997 with provisions in accordance with the contents of the international agreement with the issuance of Law no. 14/1997. In 2001, the Trademark Law underwent another change with the issuance of Law no. 15/2001 and the latest revision of the Trademark Law which is in effect until now, namely Law no. 20/2016 concerning Brands and Geographical Indications.

Use of a trademark without clear rights is a violation. The party addressed here is a party not bound by or related to an agreement (license) regulated in article 1 paragraph 18 of Law no. 20/2016 is a license issued by the owner of a registered trademark to another party. Brand violations that tend to occur in Indonesia are essentially caused by people's attitudes that are too excessive in using an item. Indonesian people tend to use foreign products, especially well-known brands (Saleh Ismail, 1990).

The principle of legal protection is the principle of recognizing and safeguarding human dignity which originates from Pancasila and the principle of the rule of law based on Pancasila (Ida Nadirah, 2020). Therefore, if a trademark infringement occurs, the trademark owner can sue in court. With this protection, justice is created which is the aim of the law. One of the goals of law is to achieve social justice. With legal protection, the rights of legal brand owners are protected. The state is obliged to guarantee protection for parties who feel disadvantaged in accordance with the provisions of national law.

B. Analysis of trademark dispute resolution in the case of Nintendo Co. Ltd against PT Cardoseris Indonesia

1. Case of Brand Dispute Position between Nintendo Co., Ltd with PT Cardoseris Indonesia

Nintendo Co., Ltd is a plaintiff company founded in 1889 and originating from Japan. Which operates in the field of electronic consumer goods and video game companies. The plaintiff is the creator of the video game Super Mario Bros. The plaintiff has registered the Super Mario Bros. mark, the character Luigi and its variants since 1986 in various countries, to protect goods and services in classes 03, 05, 08, 09, 10, 12, 14, 20, 28, 35, and 41. In Indonesia, the plaintiff has also registered his Super Mario Bros. mark since 1986 in classes 09 and 28 with No. Reg. IDM000088541, IDM000088542, and IDM000088543.

This dispute is a trademark dispute between Nintendo Co., Ltd as the Plaintiff against PT Cardowisata Indonesia and Eddy Tumewu as the Defendant, as well as the Directorate General of Intellectual Property as the Co-Defendant. Trademark dispute with complaint dated 20 October 2020, received and registered in the Central Jakarta District Commercial Court register dated 20 October 2020 Registration number 58/Pdt.Sus-Merek/2020/PN.Niaga.Jkt.Pst., a lawsuit for trademark deletion was filed.

It is known that Defendant II has registered the trademark Super Mario Bros with No. IDM000007313, dated 03 January 1994 in the name of Eddy Tumewu as President Director of PT Cardolestari Indonesia and Defendant II transferred ownership of the brand, namely Super Mario Bros, to Defendant I, while the Co-Defendant was included in this matter in order to comply with the Commercial Court Decision.

Nintendo Co., Ltd is the legal owner of the Super Mario Bros. brand as well as the creator and sole party authorized to use the brand which has been attached to the Plaintiff. In order to obtain

legal protection, the Plaintiff has proposed an application for registration of the Super Mario Bros. mark to the Co-Defendant with the result that the Super Mario Bros. Mark application No. DID2020060079, was submitted under the name of the Applicant Nintendo Co., Ltd in item class 25.

Therefore, the plaintiff's Super Mario Bros brand already includes the requirements for a famous brand based on Article 21 Paragraph b of Law no. 20/2016 concerning Brands and Geographical Indications.

The Plaintiff submitted to the Panel of Judges, among other things, to:

1. So that the Plaintiff's lawsuit is granted in its entirety
 2. States that the Super Mario Bros brand, Mario and Luigi characters and their variants are well-known brands
 3. Declaring the No. 1 Super Mario Bros brand. IDM000007313 class 25 in the name of Defendant I (previously requested registration by Defendant II) is in principle and/or completely the same as the well-known brand Super Mario Bros, Mario and Luigi characters and their variants belonging to the Plaintiff
 4. Declaring the No. 1 Super Mario Bros brand. IDM000007313 was submitted in bad faith in class 25 on behalf of Defendant I (previously requested registration by Defendant II)
 5. Declare the cancellation of the registration of the Super Mario Bros. trademark No. IDM000007313 in class 25 in the name of Defendant I (previously requested registration by Defendant II) with all the legal consequences
 6. Requesting the Defendant to submit and implement the decision
 7. Requesting the Defendant to delete the registration of the Super Mario Bros. mark No. IDM000007313 from the General Register of Marks with all its legal consequences in class 25 in the name of Defendant I (previously requested registration by Defendant II);
- 2. Juridical Analysis of Supreme Court Decision Number 58/Pdt.Sus-Merek/2020/PN.Niaga.Jkt.Pst**

Supreme Court Decision Number 58/Pdt.Sus-Merek /2020/PN.Niaga.Jkt.Pst is the result of legal action proposed by Nintendo Co., Ltd as the Plaintiff, against PT Cardowisata Indonesia and Eddy Tumewu as the Defendant, as well as the Directorate General of Property Rights Intellectual as Co-Defendant.

The Central Jakarta Commercial Court won the case of the Plaintiff, namely Nintendo Co., Ltd, that the Plaintiff was the first registrant and owner of the Super Mario Bros, and Luigi and its variants, and had submitted an application for registration to the Directorate General of Intellectual Property (Co-Defendant). The Panel of Judges said that the Super Mario Bros brand owned by the Plaintiff was a well-known brand and stated that the Super Mario Bros brand with No. IDM000007313 in the name of Defendant I has fundamental and even complete similarities with the Super Mario Bros brand and the brand in the name of Defendant I was complained about through the respondent who intended to act in bad faith.

Super Mario Bros. trademark registration statement No. IDM000007313 is null and void with the name of Defendant 1 in the General Register of Trademarks, at the Directorate General of Intellectual Property, with all its legal consequences and orders the Directorate General of Intellectual Property (Co-Defendant) to comply with all decisions of the Central Jakarta Commercial Court to take action to cancel the Super Mario Bros. brand No. IDM000007313 on behalf of Defendant I from the General Register of Trademarks and ordered the Defendant to pay court costs.

Based on this decision, trademark registration means that the first applicant is considered the trademark owner. Therefore, the decision was fair and correct, the judge decided that Nintendo Co., Ltd as the owner and first licensee of the famous game Super Mario Bros. The plaintiff's Super Mario Bros brand meets the requirements for a well-known brand in accordance with the provisions of Article 21 Paragraph b of Law no. 20/2016 concerning Brands and Geographical Indications. From the explanation above, Nintendo Co., Ltd as the owner of the Super Mario Bros.

Brand has long registered its Super Mario Bros. brand in many countries and proposed a registration application, therefore Nintendo Co., Ltd. must be the legal owner of the Super Mario Bros. Brand.

We can see that based on this decision it is in accordance with Law no. 20/2016 concerning Trademarks and Geographical Indications, because the state provides legal protection in handling trademark disputes. Trademarks are proposed as a "first to file" legal principle, the first trademark registration is registered at the trademark office in Indonesia as well as for well-known trademarks that previously existed and were registered in other countries. Even though the mark has not been registered, the judge in his decision still considered the famous mark.

CONCLUSION

Based on the discussion above, it can be concluded that regulations regarding brands in Indonesia have been regulated for a long time, starting from Law no. 21/1961 concerning Company Brands and Business Marks. Then it was changed into Law no. 19/1992 concerning Brands. After Indonesia joined the TRIPs Agreement, the Trademark Law was revised in 1997 with the contents of this international agreement issued as Law no. 14/1997. Then, in 2001, the Trademark Law was amended by passing Law no. 15/2001 and the latest amendment to the Trademark Law which has been in effect until now, namely Law no. 20/2016 concerning Brands and Geographical Indications.

This decision is in accordance with the Trademark Law. Because the state has provided legal protection measures for the resolution of registered trademark disputes based on the legal principle of "first to file" for registrants who are first registered at the trademark office in Indonesia, as well as for well-known trademarks that already exist and were registered earlier in other countries. The judge is of the opinion that Nintendo Co., Ltd is the legal owner and first registrant of the Super Mario Bros. Famous Mark, so the above decision is correct and correct.

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