
**JURIDICAL REVIEW OF TRADEMARK DISPUTES IN INDONESIA: CASE STUDY RULING NO. 92
K/PDT.SUS-HKI/2017 TRADEMARKS BETWEEN HUGO BOSS AND HUGO**

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ABSTRACT

Most people in Indonesia pay relatively high nominal prices for well-known brands. Situations like this provide an opportunity for unscrupulous businesses to approve the use of a recognizable brand. It is very detrimental for the original owners of well-known foreign brands to infringe their IPRs and thereby reduce their income from the sale of goods or services. Owners must register their trademarks to protect them legally. The problems in this research will be discussed using doctrinal method analysis. The purpose of this research is to determine the position of the owner of the Hugo Boss and Hugo trademarks in terms of Indonesian law and to determine the legal consequences following the Commercial Court decision no. 92 K/PDT.SUS-HKI/2017. Hugo's position is in accordance with Article 21 Paragraphs 1, 2 and 3 of Law Number 20 of 2016 concerning Marks and Geographical Indications. The legal consequences include granting the cassation petition submitted by the cassation plaintiff, HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. the KGs, and cancel the decision of the Commercial Court at the Central Jakarta District Court Number 30/Pdt.Sus.Merek/2016/PN Niaga on October 3 2016, in Jakarta PST.

Keywords: Brand, Hugo Boss, Hugo.

INTRODUCTION

According to David I. Bainbridge, IPR is defined as the right to ownership that originates from human industry, especially rights that originate from creative thinking so that something is created.¹

There are at least 8 IPRs that have ownership protection, namely:²

1. Copyright (Copyrights)
2. Brands (Trademarks)
3. Geographical Indications
4. Industrial Design (industrial Design)
5. Patent.
6. Lay-out Designs (topographies) of Integrated Circuits.
7. Information that is confidential in trade (undisclosed information) or what is known as trade secret.
8. Control of unfair competitive practices in licensing agreements.

According to Dwi Agustine Kurniasih, quoted by Astrid Rahma Ayu, there are 3 (three) forms of brand infringement that need to be known, namely:³

1. *Trademark piracy*(Brand piracy)
2. *Counterfeiting*(Forgery)
3. *Imitations of labels and packaging*(Imitation of labels and packaging of a product).

¹ Marali, M., & Putri, P. N. (2021). Tinjauan Yuridis Pelindungan Hukum Hak Kekayaan Intelektual Atas Hak Cipta Karakter Game Among Us Di Indonesia. *Padjadjaran Law Review*, 9(2).

² Banindro, B. S. (2015). *IMPLEMENTASI HAK KEKAYAAN INTELEKTUAL (Hak Cipta, Merek, Paten, Desain Industri) Seni Rupa, Kriya dan Desain*. BP ISI Yogyakarta.

³ Ayu, A. R. *Tinjauan yuridis terhadap merek dagang hugo boss (studi kasus: putusan Mahkamah Agung)* (Bachelor's thesis, Jakarta: Fakultas Syariah Dan Hukum UIN Syarif Hidayatullah).

In obtaining legal protection related to ownership of a private brand, the owner must register the brand to prevent brand infringement and unfair economic competition. It has been written in Article 3 of Law Number 20 of 2016 concerning Marks and Geographical Indications, with a statement of granting rights to a mark after previous registration.⁴

As explained above, there are examples of cases regarding brand disputes, namely Teddy Tan, the owner of the Hugo Sport brand and the holder of the "Hugo Boss" brand, namely Hugo Ferdinand Boss, as plaintiffs represented by the PK SHMH Justice and related parties. Hugo Boss itself is a famous brand that was founded in 1924. The owner of Hugo Boss is a businessman from Germany. Hugo Boss is the owner of the certificate for "Hugo Boss" which was traded in 1924 in Hong Kong and has also been registered in Indonesia since 1989. Class 25 brands, class 34, 35, 18, 9, 3 and 14. Hugo Boss, as a well-known brand that is very well-known and in demand by many people, saw an act of brand infringement, namely that carried out by Teddy Tan. Teddy Tan made a report to provide legality for the brand he created to the Director General of Intellectual Property Rights, where the brand he created was imitated in whole or in part by Hugo Boss. Teddy Tan's good intentions have had consequences, this could result in losses to the rights holders of Hugo Boss, on May 12 2015 Hugo Boss has registered a lawsuit for trademark cancellation at the Central Jakarta Commercial Court. Hugo Boss started suing because the registration of the trademark owned by Teddy Tan which was disputed violated the law because it had similarities in some or all of the marks to the registered mark and/or the well-known brand Hugo Boss.⁵

RESEARCH METHODS

This research uses doctrinal methodology. According to Ery Agus Priyono, as quoted by Kornelius Benuf and Muhammad Azar, he believes that the doctrinal legal research methodology explains that previous legal problems can be a determinant of the problem being defined, provided that it must be based on previous doctrine that is relevant to this research.⁶This type of normative research was chosen because normative research is able to explain a phenomenon based on literature reviews and secondary data. The approach method is a case study approach which is carried out by considering cases through the problems faced and which have become court decisions regarding permanent law.⁷ The type of legal material that will support research results is in the form of literature which is obtained through various sources such as books, notes, and also reports of previous research results, as well as the writings of experts in related fields. This research data analysis was carried out qualitatively, the category data that had been collected and compiled was then analyzed, analyzing legal principles, regulations and literature related to the trademark case between Hugo Boss and Hugo.

RESULTS AND DISCUSSION

A. The Position of the Owner of the Hugo Boss and Hugo Trademarks in View from Indonesian Law

Brands have an important function and role in a business, namely as a form of advertising and a marker of special attributes originating from the production results of interest, in addition to functioning as the identity and origin of the product. As a result, dishonest business people will try to imitate other people's brands. The owner must submit a registration application to the Director General of Intellectual Property to be registered under the registered trademark law so that it can be said to be valid as a right and receive legal protection.

⁴ Undang-Undang Republik Indonesia Nomor 20 Tahun 2016 Tentang Merek dan Indikasi Geografis.

⁵ Putusan Mahkamah Agung Nomor 92 K/PDT.SUS-HKI/20

⁶ Benuf, K., & Azhar, M. (2020). Metodologi penelitian hukum sebagai instrumen mengurai permasalahan hukum kontemporer. *Gema Keadilan*, 7(1), 20-33.

⁷ Marzuki, P. M. (2013). Penelitian hukum.

Trademark registration has the following functions:⁸

1. Providing legality for entrepreneurs who have registered their personal brands;
2. Providing rejection and refutation if it is found that another entrepreneur has registered a mark similar to the one he owns, whether similar in part or in whole;
3. Providing prevention against other people who have the desire to imitate the same brand either in part or in whole in the form of goods/services.

Deletion, which is written in the Official Mark Gazette, will be written as deletion of the Mark registration and published if received advice and a Mark Appeal Commission. Removal of registered trademarks:⁹

1. Having similarities in principle or overall in geographical terms;
2. Not in line with Pancasila, not in accordance with morals, religion, morality and legal order; or
3. Has overall similarities to cultural expressions that have existed from ancient times to the present.

Therefore, if the registered mark party has an action/bad faith but this was not/is not known when applying for registration, if the application for registration of the mark is indicated to be in bad faith then the application can be rejected in accordance with Article 21 paragraph (3) of Law No. 20 of 2016 concerning Brands and Geographical Indications. Third parties who have applied for the deletion of a registered mark will be submitted in the form of a lawsuit to the Commercial Court on the basis that the existing mark has not been used in three consecutive years so that the registration period can be said to have ended until the rights can be said to have been lost.¹⁰

In contrast to the cancellation of a trademark for which registration is requested, the cancellation of a registered trademark is a trademark for which the application has been completed and a certificate has even been issued. The reasons why other people's marks were registered have been identified and have subsequently led to cases of cancellation, driven by, among other things:

1. Matters of bad faith originating from selfish registrants who allow other people's needs to be the true brand.
2. There is difficulty and inaccuracy in determining whether or not a trademark registration is accepted, this is because there is an element of bad faith on the part of the applicant and the possibility of similarity to another party's trademark.
3. In determining whether a mark can be accepted or rejected when applying for registration, there are no clear benchmarks or criteria relating to the requirements of good ethics and relating to the similarities between the mark proposed by the registrant and marks belonging to other parties.
4. In implementing the constitutive system, weaknesses are still found, namely in terms of regulation and implementation¹¹

Hugo Boss with Hugo Sport. Hugo Boss is a famous brand from Germany and was founded in 1924 by Hugo Ferdinand Boss and was registered in Indonesia in 1989.¹² Meanwhile, the Hugo Sport brand originates from Indonesia and has been registered since 2001 by Teddy Tan.

The trademark application will be rejected if the trademark has elements of similarity in essence or in its entirety to another person's trademark which has been registered and applied for previously, and has been registered in a geographical indication.

Article 21 paragraph 3 No. 20 of 2016 concerning Trademarks and Geographical Indications

⁸ Ibid

⁹ Safri, A. (2018). *Perlindungan Hukum Terhadap Pemegang Hak Merek Dagang Yang Digunakan Pihak Lain Sebagai Nama Domain* (Doctoral dissertation).

¹⁰ Karina, R. M. P., & Njatrijani, R. (2019). Perlindungan Hukum Bagi Pemegang Hak Merek Dagang Ikea Atas Penghapusan Merek Dagang. *Jurnal Pembangunan Hukum Indonesia*, 1(2), 194-212.

¹¹ R. Murjiyanto. (2017,52). Konsep Kepemilikan Hak Atas Merek di Indonesia (Studi Pergeseran Sistem "Deklaratif" ke dalam Sistem "Konstitutif"), *Jurnal Hukum Lus Quia Iustum : Jurnal Hukum* (No. 1 Vol. 24 Januari 2017), 52- 62.

¹² Andi Saputra – detikNews Jumat, 10 Sep 2021 13:32 <https://news.detik.com/berita/d-5717910/hugo-boss-german-menang-lawan-merek-serupa-dari-jakut-di-kasasi>.

explains that an application will be rejected if the application is made by an applicant who does not have good faith. If a brand is registered in bad faith, it will be removed from the trademark register according to law. If a mark similar to another mark is registered for a comparable product or service in whole or in part, then the mark application must be rejected.¹³

Apart from that, Hugo Boss's position in law in Indonesia is in accordance with Article 35 No. 20 of 2016 concerning Brands and Geographical Indications, namely:

1. Registered marks will be given legal protection for a period of 10 years from the date of receipt.
2. The 10 year period can be extended for the same period.

Legal protection will still be given to brand owners who have good intentions, meaning that even though the owner has a brand ownership certificate, he can still be asked to remove or cancel it, if the owner's actions are later proven to be in bad faith.¹⁴

B. Legal Consequences After Commercial Court Decision No. 92 K/PDT.SUS-HKI/2017 Regarding the Trademark Similarity Dispute Between Hugo Boss and Hugo.

Prior to decision Number 92 K/PDT.SUS-HKI/2017, Hugo Boss filed a trademark cancellation lawsuit against Teddy Tan on May 9 2016 with decision number 30/Pdt.Sus.Merek/2016/PN.Niaga.Jkt.Pst. Because Hugo Boss considers that Teddy Tan's Hugo Sport brand has similarities with the striking components of Hugo Boss's brand. Similarities are directed starting with the form, way of placement, way of writing, elements, sound, speech and appearance. The disputed brands owned by Teddy Tan are:

1. HUGO HUGO SPORT on behalf of Defendant in class 25 was dated January 28 2009 with registration extension number IDM000191519;
2. HUGO in the name of Defendant in class 25 was dated March 3 2008 with registration number IDM000345958;
3. HUGO HUGO SPORT on behalf of Defendant in class 25 has been registered starting from January 19 2012 with registration number IDM000345958;
4. HUGO SPORT + PAINTING in the name of Defendant in class 25 was registered on May 24 2010 with registration number IDM000248526;
5. HUGO SELECT LINE on behalf of the Defendant in the class was registered on June 4 2010 with registration number IDM000250836; And
6. HUGO on behalf of the Defendant in class 35 with registration number IDM000250934 registered on June 7 2010.¹⁵

The "HUGO" brand is the object of a joint lawsuit in this case. The lawsuit is because the "HUGO" mark being disputed in this case has violated the regulations, where registration activities have been carried out and/or extended with bad intentions because the defendant is similar in essence and in its entirety to a registered mark which is a well-known mark owned by the Plaintiff. However, the Commercial Court at the Central Jakarta District Court did not give a decision or reject the lawsuit.¹⁶ Because the Panel of Judges observed the two brands, it can be concluded that the HUGO BOSS trademark owned by the Plaintiff and the HUGO trademark owned by Teddy Tan have elements that differentiate them from those owned by Teddy Tan. Hugo Ferdinand Boss with the brand owned by Teddy Tan, therefore, these differences result in differences in appearance, pronunciation,

¹³ Choerurizal, R. *AKIBAT HUKUM TERHADAP PEMBATALAN MEREK Studi Kasus Putusan Nomor: 1333 K/Pdt. Sus-HKI/2021 Tentang sengketa merek INTERCO dan INTERCO FOOD WRAPPER* (Bachelor's thesis, Fakultas Syariah dan Hukum Universitas Islam Negeri Syarif Hidayatullah Jakarta).

¹⁴ Arifin, Z., & Iqbal, M. (2020). *Perlindungan Hukum Terhadap Merek Yang Terdaftar*. *Jurnal Ius Constituendum*, 5(1), 47-65.

¹⁵ Direktori Putusan MA Republik Indonesia Putusan Nomor: 30/Pdt.Sus.Merek/2016/PN.Niaga. Jkt. Pst. Hlm. 2

¹⁶ Adryani, V., & Kansil, C. S. (2020). *Perlindungan Hukum Merek Terkenal Terhadap Pengaturan Prinsip Persamaan Pada pokoknya yang Diajukan dengan Itikad Tidak Baik (Studi Putusan Mahkamah Agung Nomor: 92K/Pdt. Sus-HKI/2017)*. *Jurnal Hukum Adigama*, 3(2), 874-895.

placement and sound of speech, so it is impossible to say that these brands are essentially the same because to determine whether the two brands are in principle the same must be compared as a whole, and cannot be examined carefully, because he does not accept the judge's decision. Hugo Boss filed a cassation with decision number 92 K/Pdt.Sus-HKI/2017, then Hugo Boss submitted a cassation memo to the Supreme Court, memory cassation is explaining the plaintiff's reasons for filing an appeal to the Supreme Court. The Supreme Court of Justice will consider the Cassation Memorandum when deciding to accept or reject the Cassation.¹⁷

Disputes regarding the similarity of trademarks between Hugo Boss and Hugo give rise to legal consequences, namely:

1. The cassation request was granted: HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO. The KG;
2. Cancel the commercial court decision at the Central Jakarta District Court Number 30/Pdt.Sus.Merek/2016/PN Niaga. Jkt. Pst., date. October 3, 2016.¹⁸

Judge for yourself:

1. Grant all of the plaintiff's claims;
2. Deciding that Hugo Boss owned by the Plaintiff is a well-known brand;
3. Confirms that the Plaintiff is the sole owner and legal holder of the registered rights to the Hugo Boss mark (and its variations);
4. Determines that the Defendant committed acts in bad faith when registering and/or extending the disputed "Hugo" mark
5. Determining that the HUGO mark is substantially or wholly similar to the registered Hugo Boss mark (and its variations); belongs to the Plaintiff.
6. *Registration* and/or the disputed extension of the "Hugo" mark must be canceled or declared invalid
7. Order the defendant to remove the disputed mark "Hugo" from the general register of marks as soon as possible.

CONCLUSION

The position of the owner of the Hugo Boss and Hugo trademarks is reviewed from Indonesian law, namely that the trademark lawsuit application was not accepted because it was similar in essence or in its entirety based on article 21 paragraph 1 No. 20 of 2016 concerning Brands and Geographical Indications. Article 21 paragraph 3 No. 20 of 2016 concerning Trademarks and Geographical Indications, "Applications are rejected if submitted by applicants who have bad intentions." Bad faith according to Law no. 20 of 2016 is an applicant who has the previous intention to imitate and follow the product brand of another party for his personal business interests, thus creating competition in the business and being able to mislead consumers.

The legal consequences following the Commercial Court decision Number 92 K/PDT.SUS-HKI/2017 regarding the trademark similarity dispute between Hugo Boss and Hugo are:

1. Providing acceptance of the cassation request from the cassation applicant or in other words the cassation request has been granted: HUGO BOSS TRADE MARK MANAGEMENT GMBH & CO.KG;
2. The decision of the Commercial Court at the Central Jakarta District Court has been annulled with Number 30/Pdt.Sus.Merek/2016/PN Niaga. Jkt. Pst., date. October 3, 2016.

¹⁷ Wardana, Y. W. (2017). Kasasi Oditur Militer Terhadap Putusan Judex Facti Yang Menghilangkan Pidana Tambahan Berupa Pemecatan Dari Dinas Militer Dalam Perkara Penipuan. *Verstek*, 7 (2).

¹⁸ Wiyoto, D. A. S., & Inayah, S. H. (2022). *Perlindungan Hukum Terhadap Pemegang Merek Dagang Asing Terkenal Di Indonesia (Studi Kasus Putusan Mahkamah Agung 27/Pdt. Sus-HKI/2020 dan Putusan Mahkamah Agung No 520 K/Pdt Sus-HKI/2021)* (Doctoral dissertation, Universitas Muhammadiyah Surakarta).

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