
LEGAL PROTECTION OF REGISTERED MARKS CASE STUDY: RULING NUMBER 1850 K/Pdt.Sus-HKI/2022

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ABSTRACT

Trademarks are a clear part of intellectual property that plays a vital role in the economic cycle of an industry in the field of trading goods and services. One of them is that the brand becomes an image of product quality and helps attract consumer interest in new products. Brand issues are still a problem that continues to be on the court table, therefore there must be strict regulations governing this matter. apply normative juridical research methods by examining library materials, namely primary and secondary legal materials. After the legal materials are collected, analysis is carried out and appropriate conclusions are drawn regarding the problems contained in the problem formulation. This research applies data analysis techniques using deductive logic. This conclusion is based on an analysis of the regulations regarding trademarks and decision Number 1850 K/Pdt.Sus-HKI/2022. This brand dispute will be analyzed according to existing regulations, from a brand law perspective in order to understand its essence and intent in resolving the legal problems discussed in this research. Therefore, here the panel of judges is required to be fair in giving a fair decision. So that no party feels cheated and seeks legal protection in other courts. And the theory of legal protection means that when a judge examines a case in this chapter, a trademark case must look at various existing legal literature and interpret it clearly in line with the applicable arguments.

Keywords: Brand, Vans, Brand Registration

INTRODUCTION

Trademarks are a clear part of intellectual property that play a vital role in the economic cycle of an industry in the field of trading goods and services. One of them is that the brand becomes an image of product quality and helps attract consumer interest in new products¹. Considering the importance of brand benefits, legal protection is very necessary to provide legal certainty. The government has formulated special regulations regarding the brand itself to regulate it, Law Number 20 of 2016 concerning Trademarks and Geographical Indications (UU MIG) stipulates that the definition of a brand is:

"A brand is a sign that can be exhibited through graphics in the form of images, logos, names, words, letters, numbers, color arrangements, in 2 (two) dimensions and 3 (three) dimensions, sounds, holograms, aka a combination of 2 (two) then "Moreover, this aspect is to differentiate goods and/or services processed by persons or legal institutions in goods and/or trading activities"

The right of a trademark is a special (exclusive) right delegated from the state to the owner to use it himself or to authorize other people to use the trademark. The consequence of a country granting privileges is that to obtain them you must go through a registration mechanism, so the nature of the registration is mandatory. In order for trademark rights to be protected and recognized by the state, the

¹ Rahab.Penerapan Manajemen Merek Pada Usaha Kecil Dan Menengah (Ukm). Jurnal Bisnis dan Ekonomi (JBE). Vol. 16 No. 1.2009. Fakultas Ekonomi. Universitas Jendral Soedirman Purwokerto. Hlm 19

trademark owner is obliged to report it to the state. If the brand is not reported, the brand will not be protected by the state. Therefore, the sign can be applied to each person.² The difference between this article and previous research is that this article examines and analyzes how to terminate trademark protection and how to terminate registered trademark protection. Anything can end the protection of a registered mark under the Trademark and Geographical Indications Law No. 20 of 2016. So far, current research has only focused on trademark registration, trademark protection, and trademark litigation. In fact, several previous studies still tested it using Trademark Law no. 15 of 2001.

Nowadays, business strategy is no longer a way to market products or services correctly or define quality with the right standards, but also as a way to protect the brand of a product or service from other competitors. Therefore, competition in business is not only about grabbing consumers but also quickly registering a trademark for any product or service. Brands with names that are attractive, easily recognized and easy to remember are of course highly sought after by manufacturers so that their products/services are easily remembered and recognized by consumers.

"In the common law legal system, brand piggybacking (passing off) is an act of unfair competition, because this action causes other parties as brand owners who have registered their marks in good faith to experience losses due to parties who fraudulently piggyback or piggybacking on his brand to gain financial gain."³

The brand's international affairs are growing rapidly. In fact, branding problems tend to be discussed all the time, both nationally and internationally. Unfortunately, trademark crimes continue to occur. Then we all need to realize that trademarks are human creations that need to be protected by law. The development of the business world regarding the brand issues mentioned above really requires crucial attention by the government in order to provide legal protection. One form of legal protection that can be delegated is full trademark regulation. Other forms of legal protection can also be obtained through law enforcement. Legal guarantees can also be provided to avoid crimes against registered company trademark rights.

Regulations regarding brands with the birth of Law Number 21 of 1961 then modified Law Number 12 of 1961 1992, then changed again in Law Number 15 of the Year 2001 concerning Trademarks and finally Law No. 20 of 2016 concerning Brands and Geographical Indications, this situation also shows that the goals and efforts to protect brands are very urgent.

For marks that have been registered by the holder, the mark itself can still be copied from other people, even if the mark is not registered. Therefore, if there is a registered brand, there is a new brand that is similar in principle or in its entirety to the registered brand, sometimes the new brand is also officially registered with the Intellectual Property General Policy Department (DJKI). If such an incident occurs, and the first owner of the brand finds out about it, he can sue the National Intellectual Property Office regarding the fact that the brand that has just appeared has similarities with his own brand. If this is proven, then the protection of rights to the last registered mark will generally cease. This is what makes the reference in this text.

RESEARCH METHODS

This research article applies normative juridical research methods by examining library materials, namely primary and secondary legal materials.⁴The data collection technique uses library research, by collecting data and information or legal materials related to the substance of the research. After the legal

² Agung Sujatmiko, "Tinjauan Filosofis Perlindungan Hak Milik Atas Merek", *Jurnal Media Hukum* Vol 18 No 2 Desember 2011, Fakultas Hukum Universitas Muhammadiyah Yogyakarta, 2011, Yogyakarta, hal 177.

³ Nur Hidayati, "Perlindungan Hukum Pada Merek Yang Terdaftar", *Ragam Jurnal Pengembangan Humaniora* Vol. 11 No 3 Desember 2011, Politeknik Negeri Semarang, 2011, Semarang, hal 180.

⁴ Khudzaifah Dimiyati & Kelik Wardiono, 2004, *Metode Penelitian Hukum, Surakarta:Fakultas Hukum UMS*, hal. 4.

materials are collected, analysis is carried out and appropriate conclusions are drawn regarding the problems contained in the problem formulation. This research applies data analysis techniques using deductive logic. This conclusion is based on an analysis of the regulations regarding trademarks and decisions that have legal force. This brand dispute will be analyzed according to existing regulations, from a brand law perspective in order to understand its essence and intent in resolving the legal problems discussed in this research.

RESULTS AND DISCUSSION

Legal Protection for Registered Marks

Rapid developments in the commercial and industrial sectors require special protection for the technology applied in the production process. If the product is then placed on the market under any brand, it is necessary to protect the goods being bought and sold from various activities. However, illegality is in the interests of maintaining the brand.

The legal protection delegated by the state to brand rights includes protection of domestic brands and foreign brands which is regulated on the principle of reciprocity, where all members must protect the intellectual property of citizens of other member countries equally.

Determining the requirements that applicants for trademark registration must comply with does not completely eliminate the occurrence of trademark crimes from irresponsible parties. Illegal use of trademarks on products for the purpose of taking advantage of the brand they use still occurs in various forms, such as copyright theft (false trademarks) or misuse of reputation (with similar characteristics to well-known brands on the market). consumer's eyes).

The legal protection granted by the state is not limited to brand holders but also customers who want to be comfortable and guaranteed the authenticity of their brand so that they are not tricked into buying fake branded products. The legal protection given to brand owners is that they are owners of the brand in good faith, meaning that even though they have a certificate as proof of brand ownership, they can be asked to remove or cancel the brand if the owner does not show trust.

Trademark legal protection only applies to registered trademarks. Registering a trademark offers greater protection, especially when it conflicts with identical or similar trademarks. Although most entrepreneurs are aware of the importance of using a brand to differentiate their products from competitors' products, not all parties are aware of the importance of brand protection through registration.

Referring to Article 2 paragraph 3 of Law No. 20 of 2016, Marks that protected are formed from signs in the form of images, logos, names, words, letters, numbers, color arrangement, in terms of 2 (two) dimensions or 3 (three) dimensions, sound, hologram, a combination of 2 (two) or more elements is useful separating goods and/or services processed from parties or entities law in goods or services trading activities.

Another very important thing in trademark protection is that a trademark cannot be registered on the basis of an application by a malicious applicant. This measure of goodwill is difficult to measure with the naked eye, and disputes often arise from the deliberate registration of marks with similar or even identical characteristics by counterfeiting trademarks and cover designs. Therefore, registration in good faith is an effort to protect a well-known brand. In addition, the trademark law also seeks to protect well-known marks, which stipulates that an application must be rejected if: (a) It is similar in essence or in all respects to another person's mark that has been registered for goods or services (b) Has similarities in essence or in all respects. all of them on well-known brands owned by other people or similar services.

Basic Legal Considerations by Judges in Determining Decisions in Decision Number 1850 K/Pdt.Sus-HKI/2022

A judge in his considerations can be based on provisions contained in statutory regulations, case

law, legal doctrine, or customary law.⁵ Article 50 Law no. 48 of 2009 concerning the judiciary, which also emphasizes that the reasons underlying the decision and the relevant law or source of unwritten law used as the basis for the decision must be submitted for court decision. The judge's function requires him to provide all legal grounds that have not been requested by the plaintiffs.

Sub-complaints in petitions or petitions are often found in *ex aequo et bono* sentences and are often combined with decisions if the panel has a different opinion demanding a fairer decision. According to Yahya Harahap, the mention of *ex aequo et bono* as a side claim is carried out first if the main claim is not accepted by the judge, so this penalty is not absolute, is alternative and depends on the judge.

Looking at the decision number 1850 K/Pdt.sus-HKI/2022, the panel of judges issued a decision granting the cassation petition from the cassation applicant VANS, INC and then canceling the commercial court decision at the Central Jakarta District Court number 85/Pdt.Sus-brand/2021/PN Niaga .Jkt.Pst dated June 6 2022.

Referring to the position case, it can be seen that the party in dispute is VANS, INC represented by the Vice President, Christine M. Hernandez, located at 1588 South Coast Drive, Costa Mesa, California 92626, United States of America (formerly located at 6550 Katella Avenue, Cypress, CA 90630, United States of America), in this case authorized Daru Lukiantono, SH, and friends, Advocates at the Law Office of Hadiputranto, Hadinoto & Partners, with offices at Pacific Century Place, Level 35, Sudirman Central Business District Lot 10, Jalan Jenderal Sudirman, Kaveling 52-53, Jakarta, based on a Special Power of Attorney dated 18 October 2021. Then against HALIM SUHENDY, residing at Taman Kopo Indah III, E.10 Number 50, RT 002/RW 22, Mekar Rahayu Village, Margaasih District, Bandung Regency, West Java, in this case authorizing RM Tito Hananta Kusuma, SH, MM, and friends, Advocates at the Law Office Majapahit Advocates, with offices at Jalan Majapahit Number 20, Majapahit Permai Complex B24-B 25, Central Jakarta, based on a Special Power of Attorney dated 31 July 2022.

Then it refers to the trial itself by a panel of judges which includes:

1. Granted the plaintiff's claim for everything
2. Stating the plaintiff as the first user and sole valid owner of the Vans brand
3. Stating that the Vans brand is a well-known brand
4. Brand stated:
 - a. Otovansclassic with registration number IDM000640269,
 - b. The Classic And Logos with Number Registration IDM000718418, and
 - c. Autovans classic and Logo with Number registration IDM000876930
5. Canceling or declaring void marks:
 - a. Otovansclassic with Registration Number IDM000640269;
 - b. The Classic Bibs and Logos with Numbers Registration IDM000718418, and;
 - c. Autovans classic and Logo with Number Registration IDM000876930;
6. Ordering the Co-Defendants to cancel the marks:
 - a. Otovansclassic with Registration Number IDM000640269;
 - b. Auto The Classic and Logowith number Registration IDM000718418, and;
 - c. Autovans classic and Logo with Number Registration IDM000876930;
7. Sentenced the cassation respondent to pay court costs at all levels of court, which at the cassation level amounted to five million rupiah.



In fact, before the judge issued a decision to handle this case the panel of judges paid attention to Law Number 20 of 2016 concerning brands and geographical indications, Law Number 48 of 2009 concerning judicial power, Law Number 14 of 1985 concerning the Supreme Court which was modified to become Law Number 3 of 2009.

Based on the judge's considerations in this decision, it is clear that there has been a violation of the use of the trademark rights of the VANS, INC brand for commercial purposes in Indonesia.



⁵ Yahya Harahap, *Hukum Acara Perdata tentang Gugatan, Persidangan, Penyitaan, Pembuktian dan Putusan Pengadilan* (Cet. VIII; Jakarta: Sinar Grafika, 2008), hal. 58

The panel of judges considered it by looking at the regulations governing trademarks and their violations. That the infringing party has used and distributed the product using the same brand as the first party. Then the panel of judges acknowledged that the first party registered had a brand that was well known throughout the country and had already been registered. The panel of judges stated that the Vans brand with registration number IDM 000229835 was chosen by the plaintiff.

That these two brands are in the same class, which are compared as follows:

VANS brand with Number Registration IDM000229835 belongs to the Plaintiff	Otovansclassic brand with Registration number IDM000640269
	

Board Design Brand Skate with Registration number IDM000395736 and Strip Design with Registration Number IDM000396488 belong to Plaintiff	Oto The Classic Brand and Logo with Number Registration IDM000718418 belongs to the Defendant
	

Vans brand with Number Registration IDM000229835 belongs to the Plaintiff	Otovansclassic brand with Registration Number IDM000876930
	

That it turns out that there are similarities in the main form of elements. What stands out is the words Vans Surfboard Design and Strip Design which are the dominant elements in the Plaintiff's and Defendant's marks, because it has been proven that the Plaintiff's mark, the Vans brand, the Surfboard Design mark and the Plaintiff's Strip Design mark are well-known marks and the Plaintiff is the first user and owner. The only valid brand is the Vans brand, the Skateboard Design mark and the Strip Design mark to differentiate the Plaintiff's goods and services from the goods and services of other parties, so the registration of the Defendant's mark was carried out in bad faith by imitating, plagiarizing or following the Plaintiff's mark. for the sake of the Defendant's business interests, creating conditions for unfair business competition, deceiving or misleading consumers, in other words, the Defendant wants to piggyback on

the popularity of the Plaintiff's brand;

Therefore, here the panel of judges is required to be fair in giving a fair decision. So that no party feels cheated and seeks legal protection in other courts. And the theory of legal protection means that when a judge examines a case in this chapter, a trademark case must look at various existing legal literature and interpret it clearly in line with the applicable arguments.

CONCLUSION AND SUGGESTION

Rapid developments in the commercial and industrial sectors require increased protection for the technology used in the production process, if the product is then placed on the market under a certain brand, it is necessary to protect the products being bought and sold from various actions. However, illegality is a necessity to protect the brand. Establishing requirements that must be fulfilled by applicants for trademark registration does not completely eliminate the occurrence of trademark crimes from irresponsible parties. Illegal use of trademarks on products for the purpose of making a profit from the brand they use often occurs in various forms, such as copyright theft (false trademarks) or misuse of reputation (with similar characteristics to well-known brands on the market).

The legal protection granted by the state is not limited to brand holders but customers who want to be safe, comfortable and guaranteed the authenticity of their brand so that they are not tricked into buying fake branded products. Trademark legal protection only applies to registered trademarks. Apart from that, the trademark law also seeks to protect well-known trademarks, which stipulates that an application must be rejected if: (a) It is similar in essence or in all respects to another person's mark that has been registered for goods or services (b) Has similarities in essence or in all respects. all of them on well-known brands owned by other people or similar services.

A judge can base his considerations on provisions contained in statutory regulations, case law, legal doctrine, or customary law. The judge's function requires him to provide all legal grounds that have not been requested by the plaintiffs. Sub-complaints in petitions or petitions are often found in *ex aequo et bono* sentences and are often combined in decisions if the panel has a different opinion demanding a fairer decision. Referring to the position of the case, it can be seen that the party in dispute is VANS, INC, represented by the Vice President, Christine M. Then the panel of judges acknowledged that the first party registered had a brand that was well known throughout the country and had already been registered. The panel of judges stated that the Vans brand with registration number IDM 000229835 was chosen by the plaintiff.

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