Analysis of Judge’s Decision on Registration of Trademark with The Same Naming (Study of Supreme Court Decision Number 640 K/Pdt.Sus-HKI/2020)

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Abstract
This article aims to evaluate the judge’s ruling about the namesake trademark. Two parties that registered the SAMGONG trademark through DJKI are at the focal point of the issue. This article’s articulation of the problem serves as an argument for the Panel of Judges’ discussion of the legal implications and considerations surrounding the decision rendered by the Supreme Court in Number 640 K/Pdt.Sus-HKI/2020. This article concludes that a trademark is an asset that is legally protected and has economic worth from a commercial standpoint. Indonesia uses a first-to-file system, meaning that as soon as a trademark is registered in its home country, its owners acquire the rights to it. The Panel of Judges noted in their ruling that the Plaintiff originally registered its trademark in its own nation in 2008. That the Defendant’s trademark registration is suspected of being done in bad faith because the Plaintiff’s trademark has been sold and promoted internationally, making it a well-known trademark. Additionally, the DJKI was ordered to remove the Defendant’s trademark from the General Register of Trademarks due to similarities in the naming of the trademarks owned by both parties. As a guardian of intellectual property, DJKI needs to be more cautious when examining trademarks registrations to check for essential similarities, particularly in trademark names.

Keywords: Trademarks; Law 20/2016; Trademark Similarities

INTRODUCTION
Registration of a trademark is a prerequisite for business actors to operate a business and secure legal protection for a trademark. In essence, the purpose of registration is to foster understanding and peace within Indonesia's economic system. (Dewi, 2019). In Indonesia, a concept known as constitutive stelsel, or the "first to file system," denotes that, unless proven differently, the first applicant who submits a trademark registration application in good faith is the one with complete ownership of the trademark (Jened, 2015).

This is in line with Law Number 20 of 2016 on Trademarks and Geographical Indications ("TGI Law"), which states that a trademark's rights are acquired upon registration. Well-known trademarks will still be protected even if they haven’t been registered in Indonesia in line with positive legislation. This situation arises from Indonesia’s ratification of both the Paris Union Convention and the TRIPs Agreement, which are both administered by the World Trade Organization. Even if Indonesia has a constitutive system, this nevertheless holds true (Desmayanti, 2018). Exclusive rights are a unique set of rights held by people who have legally registered their trademark in order to keep others from using it as a means of identification and profiting from it when engaging in commercial activity. Insufficient knowledge about the prerequisites and procedure for registering a trademark has led to a high number of trademark disputes in Indonesia. There are various attempts in social commerce activities to act dishonestly by cloning well-known trademarks and taking advantage of their function, quality, and popularity (Denny, Liegestu, Novika, & Patros, 2022).

"Similarities in trademarks" is the most common type of difficulty encountered. Given that there are various approaches to look at factors in trademark similarity conflicts, economic factors—such as the growth of international trade and intellectual property rights—are the most mainly discovered (Ramin, 2023).

There are two categories of trademark similarity violations: basic similarity and violation type (Permata et al., 2021). Basic similarity refers to similarities between two trademarks that are primarily caused by factors like sound, meaning, and appearance. Aside from that, the general resemblance indicates that there are characteristics that are comparable in terms of usage actors, region & market segment, maintenance approach, and letter elements. In addition to serving as a means of identification, trademarks serve as standards by which customers choose which goods and services to purchase.

This is an inherent aspect of marketing and advertising, particularly in the realm of social media, where trademarks assume a significant role in advertising and marketing endeavors to aid potential consumers in recalling product advertisements; thus, the greater the trademark's distribution, the more widely recognized the purported quality will be (Daffa Ramdhani & Masnita, 2023).

By registering trademarks that are comparable to well-known trademarks, this condition encourages new business actors to aim for the same popularity and revenues from businesses that are already well-known, or what we commonly refer to as renowned trademarks.

This clarifies that the application for trademark registration is founded on bad faith, as stated in TGI Law Article 21 Paragraph 3, which defines applicants in bad faith as those who intend to copy or replicate for their own commercial gain, creating a rivalry that may lead to the destruction of trade.

The case between GS Yuasa Corporation and PT Gramitrama Battery Indonesia, where both registered types of goods in the same class, namely class 9, is one example of a well-known trademark
dispute based on trademark similarities. In this case, GS Yuasa, the plaintiff, and the owner of the GS trademark demanded the cancellation of the GSI trademark, arguing that the GS trademark had been registered in 1958 in both its country of origin and in several other countries. The GSI trademark registration had to be canceled since the Supreme Court ultimately decided at the Judicial Review level that the Plaintiff’s GS was the first owner and qualified as a well-known trademark.

Conversely, there was a disagreement between Ikema (Defendant) and IKEA (Plaintiff). The IKEA trademark was acknowledged as a trademark since the word “IKEA” was not used frequently and had been well-known worldwide since 1943, according to IKEA’s argument that IKEMA had pirated and replicated the success of the IKEA trademark. In addition, IKEA claimed that the class of goods in IKEMA are comparable to the IKEA trademark due to similarities in the nature, origin, and purpose of the production (herkost). Nevertheless, during the Judicial Review, the Judge Panel declared that there were no general similarities between the IKEA and IKEMA trademarks. Angsa Daya cited several reasons for this, including the fact that IKEMA is a Chinese trademark, its registered trademarks are not for similar goods, and the application of a well-known trademark is subject to government regulations and requires requirements, of which there are currently none (Decision of the Supreme Court of the Republic of Indonesia Number 165 PK/Pdt.Sus/2012).

The authors wish to examine the case known as Supreme Court Decision Number 640 K/Pdt.Sus-HKI/2020. The similarities between the Plaintiff’s 2008 South Korean trademark registration and the SAMGONG trademark owned by SAMGONG GEAR IND., CO., LTD serves as the foundation for the author’s desire to investigate this issue. The Plaintiff’s trademark is identical to that of Kusno Kosim, the Defendant and the party claiming to be the proprietor of the SAMGONG trademark. In cases where SAMGONG GEAR IND., CO., LTD.’s case and the previously discussed case examples bear resemblances, the Supreme Court declared at the cassation level that Samgong Gear Korea belonged to the party as a well-known trademark, possessing conceptual similarities to the two trademarks, declared the defendant to have registered his trademark in bad faith, canceled the defendant’s trademark registration, and directed the Co-Defendant to have Defendant’s Samgong Gear trademark removed from the General Register of Trademarks. This led the author to investigate the factors that judges take into account when determining which trademark are well-known, the fundamental similarities between the two trademarks, and the revocation or deletion of registered trademarks in trademark disputes. The research leads to the formulation of the following issues: what was the rationale for the Panel of Judges’ decision-making process in the SAMGONG trademark dispute, and what repercussions did the decision have?

RESEARCH METHODS

This research employs a normative juridical approach, examining legal principles, statutory rules, expert theories, and positive legal regulations in Indonesia that pertain to the problem topic under investigation (Benuf & Azhar, 2019).

The 1945 Constitution and TGI Law are two examples of primary legal materials that are used exclusively in this journal’s data collection. The author also uses secondary data, which can be found in books and scientific journals related to the journal’s topic of discussion, to support the primary legal materials.

Utilizing a qualitative descriptive methodology, the author conducted this study. The qualitative descriptive technique investigates the author’s understanding of meaning and subjective experience using the findings of literature studies, interviews, involvement, and
observation, rather than instrumental or formal measures (Penelitian et al., n.d.). In order to facilitate understanding between researchers and the public and prevent future trademark disputes, the author plays a crucial role in data collection. The author then analyzes the collected data to explain, explain, and describe in detail the provisions of Intellectual Property Rights, especially those pertaining to trademarks.

RESULTS AND DISCUSSION

The Trade Related Aspects of Intellectual Property Rights (TRIPs) as outlined in Law Number 7 of 1994 providing Approval for the Establishment of the World Trade Organization were ratified by Indonesia in 1994. Under the guidance of the World Intellectual Property Organization (WIPO), 177 nations, including Indonesia, ratified the Paris Convention (henceforth referred to as the Paris Convention).

The Paris Convention can be broadly categorized into three areas: priority rights, national treatment, and general principles. The following explanation is given by the Convention based on this classification:

1. Members of the Convention shall guarantee the nationals of other signatory nations reasonable and equal protection. This is predicated on clauses about national treatment, or just what is commonly referred to as national treatment.

2. Wherever these rights are meant to be expressed in terms of patents, Convention participants are granted Priority Rights. With this right, the primary application or those who submitted it initially will be protected. Additionally, applicants may submit an application for protection to one of the Convention's members or participants within a specific time frame, with the result that the next application will be considered submitted on the day it is submitted from the applicant’s home country.

3. Come to an agreement on a number of common regulations that every nation must follow. The most crucial of these are as follows: patents issued in a state party to a different Convention are for independent creation, and patents granted in a state party to an agreement that has already been agreed to or that have expired in a state party to another treaty, cannot be rejected, cancelled, or terminated in that state (Fajar et al., 2018).

A trademark is defined as a sign that can be displayed with an image, symbol, name, word, letter, number, color pattern, in two or three dimensions, size, sound, hologram, or a combination of two or more to distinguish goods and/or services produced by individuals or legal entities in the context of commercial goods and/or services activities. This definition is found in Article 1 of TGI Law concerning Trademarks and Geographical Indications.

Compared to the previous regulation, Law Number 15 of 2001 respecting Trademarks, which merely clarifies that a trademark is an image, name, and letters, this law offers more comprehensive and detailed protection. A new influence on trademark protection is brought about by the addition of 3D visuals, sounds, and holograms to TGI Law Number concerning Trademarks (Mayana, 2017).

The trademark and identity that the firm uses to represent itself in the form of goods or services, and the reputation that the trademark has earned in society for its use and excellence, are among its most valuable assets. Additionally, trademark rights can serve as a standard by which customers choose other trademarks. (Dr. Sujatmiko, Agung S.H., 2020) Additionally, trademark rights can be used to compare one product to another (Abdillah, 2019).
There are two different types of systems used in the trademark registration process. The first is known as the constitutive system, or first to file system, which allows rights to a trademark to be secured by registration. According to this arrangement, the people who registered a trademark first hold all rights to it (Arifin & Iqbal, 2020).

In addition to its benefits, the constitutive registration system has drawbacks for commercial actors. The primary benefit for the primary registrant is protection, while the secondary drawback is the existence of third parties who purposefully register marks in order to profit from them. In addition, many of them do not even market or present the trademark to the public in order to obtain protection from the Trademark Law without really using it (Wijaya & Kansil, 2018).

Since Indonesia has adopted a constitutive system, a trademark should be guaranteed legal protection; a mark that has been pre-registered is guaranteed legal protection as of the registration date. The constitutive system's guiding concept states that registrants must register their marks honestly and without copying or changing those that have already been registered (Chatarina, 2019).

Legal protection under the TGI Law can be classified as either repressive or preventive. (Asmara et al., 2019) Repressive protection is used in the event that a prior breach of trademark use has happened, whereas preventive protection works to stop violations of trademark rights (Nafri, 2018).

The state owes it to all parties with a stake in a trademark to safeguard them and ensure that the trademark is legitimate, good, and compliant with all applicable laws.

As a result, in the event that there are indications of bad faith, the Trademark Directorate may invalidate the mark. Then, parties with good intentions are unquestionably entitled to the trademark's protection. Broadly speaking, acting dishonestly, lying, cheating, and disobeying the law are examples of acting in ill faith.

The TGI Law's article 21 paragraph 3 (three), which states that applicants whose applications contain elements of ill faith may have their applications rejected, is related to the requirement of good faith in trademark registration.

The Applicant must act in good faith when registering a trademark or service mark, particularly for legal purposes. This can be demonstrated by presenting evidence of ownership of an intangible good, such as a trademark certificate authorized by the Republic of Indonesia's Directorate General of Intellectual Property Rights. The Applicant does not have to be concerned about trademark legal protection while using a trademark certificate.

One of a company's most valuable assets is its trademark, which has a high economic value due to its reputation for excellence, public recognition, and acknowledgment (Muhib Nidzom & Gultom Elfrida Ratnawati, 2023). Undoubtedly, this has a significant impact on the business of the organization, particularly on sales, as increased awareness of the trademark increases its potential to become a well-known trademark (Darmiwati & Rahmah Siti, 2023).

As the plaintiff, Samgong Gear Ind., Co., Ltd. claimed that the SAMGONG GEAR trademark, which it owns, has been manufactured and sold in a number of nations, including Germany, the United States, and Japan. It has also been used by a number of well-known car trademarks, including:

a) Mercedes-Benz, Volvo, and Scania used these production results on the European continent;
b) Chrysler & Ford employed this gear on the American continent.
c) The Hyundai, Ki, and Ssyangyong trademarks in Korea contain it (4) In
Japan, Toyota, Mitsubishi, Hino, and Isuzu all use this kind of equipment. The Plaintiff filed a trademark application on May 14, 2008, and it has been registered since August 2, 2010, with the Defendant being an Indonesian businessman who has worked with multiple companies and spare parts sales shops in Indonesia. The Defendant’s trademark is registered in class 12.

**Primary Case**

Despite the fact that the Defendant’s SAMGONG trademark was likewise registered in the General Register of Trademarks ("GRT"), the Plaintiff objected to its existence, claiming that the two trademarks bore precise resemblance. The procedure of registering the trademark that the plaintiff wishes to register may also be hampered by the defendant's trademark. The following table allows you to compare the trademarks that both sides own:

<table>
<thead>
<tr>
<th>Trademarks that the plaintiff holds</th>
<th>Trademarks that the defendant holds</th>
</tr>
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<tr>
<td>SAMGONG</td>
<td>SAMGONG GEAR</td>
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Table 1: The Parties own the Trademarks and Logos.

His party has taken the Plaintiff's arguments into consideration and has decided to file a lawsuit to prevent any misunderstandings that could affect both the Plaintiff and the consumers.

According to the defendant, there was no malice involved in the SAMGONG mark registration. In order to sell car spare parts, the defendant claimed to be an entrepreneur who had partnered with other businesses and spare parts retailers. The Defendant claimed in his exception that the Plaintiff’s complaint and power of attorney were legally defective. Additionally, the Defendant said that the Defendant's lawsuit had either expired or had gone beyond the five (five) year period that had passed after the Defendant's registration date. The defendant further claimed that the lack of a precise and unambiguous legal foundation in the lawsuit rendered it ambiguous (Obsuur Libel).

The Co-Defendant claims that formal flaws render the Plaintiff’s Legal Standing power of attorney void. The defendant went on to say that the Plaintiff’s complaint has run its course in line with TGI Law’s Article 77 regarding Trademark and Geographical Indications.

**Judicial Decision**

The plaintiff’s claim was dismissed in the Central Jakarta District Court’s court of first instance on the grounds that its principal argument was either rejected or could not be accepted. The lawsuit from the Reconvention Plaintiff/Convention Defendant is then not admissible in Reconvention.

However, the Judge at the Cassation level accepted all of the Plaintiff’s claims in their entirety, dismissed the Defendant’s and Co-Defendants’ objections, and sentenced the Defendant and Co-Defendants to reimburse the costs of this action after taking into account the Plaintiff’s evidence.

**Consideration of the Judges’ Deliberations at the Level of Cassation**

Aside from the Plaintiff’s legal entity name and company logo in the Convention, the judge noted in her initial consideration that the SAMGONG trademark had also been previously registered in South Korea in 2008, whereas the Defendant’s trademark mark had only been registered on August 2, 2010.
The panel of judges made the right consideration based on the table above, taking into account that the principles defined in the Paris Convention and the first-to-file system that Indonesia has implemented both respect priority rights. If a country is already a member of WIPO, Priority Rights might be interpreted as a guarantee for each individual who registers their trademark in their own country.

Priority Rights are the rights of individuals or legal entities to apply for trademark registration from nations that are members to the Agreement on the Establishment of the World Trade Organization or the Paris Convention on the Protection of Industrial Property. These rights are meant to guarantee the certainty of legal protection by ensuring that the date of receipt in the applicant's home country is a priority date in the destination country and that the destination country is a member nation to one of the two agreements mentioned above (Makka Zulvia & Roisah Kholis, 2023).

The Plaintiff's trademark has been widely promoted in numerous countries, including the United States, Italy, England, Canada, the Philippines, Taiwan, and Indonesia since 2008; additionally, the Plaintiff's mark has been registered in numerous countries, including the United States, Italy, England, Canada, PRC, Philippines, and Taiwan. This led the judge to conclude that the Plaintiff's trademark is a well-known trademark.

A phrase or emblem that embodies the firm identity and is recognizable to the general public is considered a well-known trademark. A well-known trademark in general knowledge indicates that people are already aware of the uses or contents of the trademark and suggests that the trademark is genuinely one of the highest-quality products available (Kirana Aprilia & Rahaditya, 2023).

TGI Law Article 21, Paragraph 1, Letter (b), states that an application may be denied if the mark is identical to another person's name or product.

Article 18 of the Minister of Law and Human Rights Regulation Number 67 of 2016 regarding the registration of famous marks further explains the requirements for famous marks. These requirements include consideration of the degree of sales, distribution, and public awareness of the business actor's products.

Given that the Plaintiff's goods have been marketed and sold in numerous nations, the Judge's factors in the aforementioned ruling support the validity of the Plaintiff's trademark.

And given that it is already available in many nations, it is reasonable to assume that the product's pricing already has unique value. In order to avoid irresponsible usage of the trademark that could devalue the goods, protection must also include its current selling worth (Marwiyah, 2010). Additionally, these goods have been traded internationally (Prameswari, 2021).

Subsequently, the judge took into account that the Defendant's SAMGONG trademark was virtually identical to the Plaintiff's famous trademark in terms of pronunciation, sound, and letter arrangement, as well as item class 12. Accordingly, the registration process executed by the Defendant was purportedly conducted with discourteous intent, as it involved mimicking, replicating, and copying the renowned mark. In order to identify if one of both parties is acting in
bad faith, there should be a certain level of equality (Adawiyah et al., 2023).

It is evident from the two trademarks that belong to each party that they are inseparably similar in terms of the dominant form, the number and style of letters used in the trademark's writing, the location of the trademark's printing, and the pronunciation of the trademark's words (Adryani & Kansil. T, 2020).

A trademark that is comparable to goods or services shall be rejected, according to Law No. 20 of 2016's Article 21. The purpose of this is to provide registered trademarks with legal precedence over those of unregistered applicants. It should be noted that the owner of the first registered trademark acquires exclusive rights and may utilize this as a justification for denying registration (Christiangie et al., 2019).

According to the judge, the Defendant's trademark was registered by repeatedly mimicking and copying the Plaintiff's trademark. This was done by the Defendant in order to profit from the Plaintiff's trademark's success without considering the potential negative effects. Given that well-known companies are more likely to produce dishonest competitors, it seems sense for them to have legal protection (Abrianti & Hermono, 2016).

In the judge's final analysis, the judge found that even though the plaintiff in his petitum demanded that the defendant be ordered to remove the registration of the marks from the GRT, namely SAMGONG Number IDM000261790 and SAMGONG GEAR Number IDM000646806, the defendant was also ordered to remove the trademark registrations from the Trademark Collection, namely SAMGONG Number IDM000261790 and SAMGONG GEAR Number IDM000646806, because this authority is shared by the Co-Defendant.

**Legal Repercussions of No. 640 K/Pdt.Sus-HKI/2020 Supreme Court Decision.**

In the event of a trademark dispute, the licensee may sue another party for unauthorized use of a mark that is, in theory, the same or a whole series of marks in the form of: a. claiming Losses and; b. terminating all work related to the Mark. This is based on Article 83 of the TGI Law, which governs the conditions for trademark infringement.

In reference to the analysis of the legal ramifications of Supreme Court ruling No. 640 K/Pdt.Sus-HKI/2020, the authors provide the following explanation:

**a) Trademark's removal from GRT**

Article 78 of the TGI Law stipulates that a request for deletion as specified in Article 76 paragraph 3 may be appealed against the Commercial Court's decision. Once the date of the ruling is established, the clerk promptly forwards the contents of the court decision to the Directorate General of Intellectual Property Rights. The applicable trademark is then deleted from the GRT and announced at the Service Office by the Director General of Intellectual Property Rights, who then cancels the trademark registration upon obtaining the ruling of the court authority and permanent legal repercussions (inkrach van gewijsde). The Trademark Notification explicitly specifies the cancellation date and cause.

**b) Loss of Legal Protection for Trademark**

Given the ruling in the a quo case by the Supreme Court of the Republic of Indonesia, it is
indisputable that the Defendant failed to register the trademark in good faith. One of the requirements for registering a mark is good faith, which necessitates the mark’s removal from the GRT (Sri Hardina & Ismelina, 2023).

Thus, in addition to the order to take the trademark down from GRT, the Defendant is now not granted any legal protection at all. The rights of the Defendant are thus likewise gone. Revocation or deletion of the trademark, as determined by the panel of judges based on legal certainty for the winning party, shall be the consequence applied to the losing party when a trademark is canceled by a court ruling. (Yuliyanto, 2020)

CONCLUSION

It can be concluded from the prior description and explanation that a trademark is a highly valuable asset with significant financial worth to its owner, who may be an individual or a legal entity. A trademark is the invention or creative endeavor of its proprietor, whose ultimate objective is to have the trademark become a symbol of the caliber of products or services, obtain social recognition, and, from a business standpoint, turn a profit for themselves. Another way to think of a trademark is the proprietor's identity when selling products or services. Given that it must be assumed that the trademark would be known to the general public, trademark registration must be considered from both a legal and administrative standpoint. In order to ensure that newly issued trademarks do not have any resemblance to previously registered trademarks and that they comply with the provisions of TGI Law on fundamental similarities, the Directorate General of Intellectual Property needs to closely supervise the registration process. The author disagrees with the Panel of Judges' considerations regarding the "famous trademark criteria". Seldom may people realize that the trademark they own genuinely has similarities with a well-known trademark. The author proposes that one should not judge a well-known trademark based on how often it is "promoted" or how many countries its products or services are sold in. What may occur if it comes out that the Plaintiff’s trademark, which he claims has been sold in various countries, has not been registered by the Defendant, who has also been promoted in many more countries? The Paris Convention’s recognition of the Priority Rights principle ought to be given greater consideration by the Judge Panel. It emphasizes the first-to-file principle for Indonesian trademark registration, in order for the general public to comprehend the principles and legal foundation of intellectual property rights in the event that this issue recurs. Since that there are still a lot of trademarks disputes with the primary goal of "piggybacking" on the success of a well-known trademark, the government must also take an active and protective stance when it comes to trademark protection.

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BIBLIOGRAPHY


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