

A Legal Consequences of the Passing Off Practice of the MS GLOW Brand by the PSTORE GLOW Brand

Rezqiyah Bagus Wibowo^{1*}

¹Universitas Jenderal Soedirman, Indonesia

*Correspondence Email: rezqiyah.wibowo@mhs.unsoed.ac.id

ABSTRACT

Intellectual Property Rights are essentially rights with special and special characteristics because these rights are granted by the State. A brand as an Intellectual Property Right is basically a sign to identify the origin of goods and services from a company with the goods and/or services of another company. One of the cases regarding Passing Off occurred in the Commercial Court Decision at the Medan District Court Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn. It started when Shandy Purnamasari filed a trademark cancellation lawsuit against PT PSTORE Glow Bersinar Indonesia. This lawsuit is based on the similarity of the brands "PSTORE GLOW" and "PSTORE GLOW FOR MEN" owned by Putra Siregar with the brands "MS GLOW/for pretty skincare & LOGO" and "MS GLOW FOR MEN" owned by Sandy Purnamasari. Shandy considers that PSTORE Glow Bersinar Indonesia has imitated his brand. The main problem in this research is what the legal consequences are for the practice of passing off the MS GLOW brand by the PSTORE GLOW brand. The research method used in this research is normative juridical with a case approach and a statutory approach. The research results show that as a legal consequence of the practice of passing off, the PSTORE Glow Brand and its derivatives can no longer be used, and the registration is considered invalid. Apart from the deletion of the PSTORE Glow brand, MS Glow can also file a criminal complaint in accordance with the provisions as intended in article 100 paragraph (1) and paragraph (2) of the Trademark and Geographical Indications Law and if PSTORE Glow is still selling its products after the decision to cancel the brand.

Keywords: Intellectual Property Rights, Brands, Passing Off.

ABSTRAK

Hak Kekayaan Intelektual pada hakikatnya merupakan hak dengan karakteristik khusus dan istimewa, karena hak tersebut diberikan oleh Negara. Merek sebagai Hak Kekayaan Intelektual pada dasarnya adalah tanda untuk mengidentifikasi asal barang dan jasa dari suatu perusahaan dengan barang dan/atau jasa perusahaan lain. Salah satu kasus mengenai Passing Off terjadi pada Putusan Pengadilan Niaga pada Pengadilan Negeri Medan Nomor 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn. Bermula ketika Shandy Purnamasari mengajukan gugatan pembatalan merek terhadap PT PSTORE Glow Bersinar Indonesia. Gugatan ini didasari atas kemiripan merek "PSTORE GLOW" dan "PSTORE GLOW FOR MEN" yang dimiliki oleh Putra Siregar dengan merek "MS GLOW/for cantik skincare & LOGO" dan "MS GLOW FOR MEN" yang dimiliki oleh Sandy Purnamasari. Shandy menganggap bahwa PSTORE Glow Bersinar Indonesia telah meniru merek miliknya. Pokok permasalahan dalam penelitian ini adalah bagaimana akibat hukum terhadap praktik passing off atas merek MS GLOW oleh merek PSTORE

GLOW. Metode penelitian yang digunakan dalam Penelitian ini adalah yuridis normatif dengan pendekatan kasus (Case Approach) dan pendekatan perundang-undangan (Statute Approach). Hasil penelitian menunjukkan bahwa akibat hukum terhadap praktik passing off, maka Merek PSTORE Glow beserta turunannya tidak lagi dapat digunakan dan pendaftarannya dianggap batal. Selain dari penghapusan merek PSTORE Glow, pihak MS Glow juga dapat mengajukan gugatan pidana sesuai dengan ketentuan sebagaimana dimaksud pada pasal 100 ayat (1) dan ayat (2) UU Merek dan Indikasi Geografis dan apabila pihak PSTORE Glow masih menjual produknya setelah adanya putusan pembatalan merek.

Kata Kunci: Hak Kekayaan Intelektual, Merek, Pemboncengan Merek.

INTRODUCTION

Copyrights, Patents and Trademarks are included in the scope of Intellectual Property Rights (Sinaga, 2020). Intellectual Property Rights are essentially rights with special and special characteristics, because these rights are granted by the State. The state, based on the provisions of statutory regulations, grants these special rights to those entitled to them, in accordance with procedures and conditions that must be fulfilled. Intellectual Property Rights which are usually called IPR or Intellectual Property Rights (IPR) are basically rights that are born based on the results of someone's intellectual work (Syafrinaldi, 2008). These intellectual works can be creative works in the fields of science, art and literature, as well as inventions in the field of technology. Works in the field of intellectual property rights are produced thanks to human intellectual abilities through the sacrifice of energy, time, thoughts, feelings, and the results of intuition, inspiration and conscience.

Copyright protection is carried out in order to prevent violations of copyright itself. Copyright holders can be distinguished between individuals and legal entities. Logos can generally be understood as symbols or can be letters/arrangements of letters that contain meaning. A logo can also be formed in the form of an image or sketch that has a meaning and philosophy with the aim of creating something that stands alone (Lopulalam, 2021).

A trademark as an Intellectual Property Right is basically a sign to identify the origin of goods and services (an indication of origin) of a company with the goods and/or services of another company. Brands are the spearhead of trade in goods and services. Through brands, entrepreneurs can maintain and provide a guarantee of the quality of the goods and/or services produced and prevent unfair competitive actions (concurrency) from other entrepreneurs with bad intentions who intend to piggyback on their reputation. A brand as a marketing and advertising tool (a marketing and advertising device) provides a certain level of information to consumers regarding the goods and/or services produced by entrepreneurs (Janed, 2015). Brands can be divided into 3 (three) groups known to the public, including: (Natalia, 2022):

1. *Normal Marks*

Brands usually classify goods and/or services as brands that are not highly reputable. The ordinary brand group does not have more meaning regarding use or technology as a symbol of lifestyle, in other words ordinary brands are classified as low quality brands. This group of ordinary brands is unable to bind consumers and is unable to form layers of markets and users.

2. *Well Known Mark*

Well known mark is a brand with a high reputation that has a symbol with the power to attract attention. Famous brands have a lure that attracts consumers to search for, get to know, or even buy any goods under that brand. This is called a touch of familiarity (familiar attachment) and a mythical bond (famous mark).

3. *Famous Mark*

Just like the term, Famous Mark gives a sign that a brand has become a popular brand of the highest degree. Its level of popularity occurs throughout the world, so any type of goods under this brand can give more confidence to buyers.

Brands have an important role in determining a brand image for the goods or products produced, this can be used as a benchmark in distinguishing the origins of goods and services. Brands are also useful for consumers, they buy certain products because they think the brand is of high quality or safe for consumption due to the brand's reputation (Lindsey, 2022). Brands have the ability to act as signs that can differentiate the results of one company from other companies in the market, both for similar and dissimilar goods/services. The function of a brand is not just to differentiate one product from other products, but also serves as an invaluable company asset, especially for brands with well-known marks (Sadikin, 2004).

The application of trademark rights often does not comply with what is determined by law. As a result, this causes losses for the brand owner. Actions that can cause losses constitute brand infringement. The state has the responsibility to protect the application of rights to the brand (Margono, 2002). This situation results in the imitation brand being associated with the brand that has been used by the company by consumers. Every entrepreneur will make every effort to cancel the registration of a mark that is proven to have imitated the mark it uses, up to filing a lawsuit in court. Based on the author's observations, there are several brands that have similar brand names and produce in similar fields, but with different products and quality. This similarity in name is used as a tool that gives the impression of overlapping the brand image and causes confusion among consumers. Actions that appear to be riding on a brand's image are interpreted as brand piggybacking on a well-known brand which can harm the original brand rights holder, or in other terms it is called Passing Off (Yustia, 2014).

One of the cases regarding Passing Off occurred in the Commercial Court Decision at the Medan District Court Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn. It started when Shandy Purnamasari filed a trademark cancellation lawsuit against PT PSTORE Glow Bersinar Indonesia. This lawsuit is based on the similarity of the brands "PSTORE GLOW" and "PSTORE GLOW FOR MEN" owned by Putra Siregar with the brands "MS GLOW/for pretty skincare & LOGO" and "MS GLOW FOR MEN" owned by Sandy Purnamasari. Shandy considers that PSTORE Glow Bersinar Indonesia has imitated his brand. The Panel of Judges decided to accept the lawsuit filed by Shandy Purnamasari. The panel of judges considered that based on the first to file principle, Shandy Purnamasari was the legal holder of the brands "MS GLOW/for beautiful skincare & LOGO" and "MS GLOW FOR MEN" and when compared with the brands "PSTORE GLOW" and "PSTORE GLOW FOR MEN" there are basic similarities between the two brands. The panel of judges was also of the opinion that Putra Siregar had bad intentions because he had piggybacked on, imitated and plagiarized the fame of his brand. So the panel of judges granted Shandy Purnamasari's request to cancel the registration of the marks "PSTORE GLOW" and "PSTORE GLOW FOR MEN".

Based on the decision at the first level, PSTORE GLOW raised this case to the cassation level. In the Supreme Court Decision Number 160 K/Pdt.Sus-HKI/2023, the

Panel of Judges in its consideration considered that the Medan Commercial District Court Decision Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn, had appropriate legal considerations . These considerations state that the PSTORE GLOW brand has similarities, similarities in terms of shape, way of placement, way of writing or a combination of elements or similarities in the sound of speech contained in these marks, so that this will deceive, confuse and mislead, that PT PSTORE Glow Bersinar Indonesia has bad intentions, because it has piggybacked on, imitated and plagiarized the popularity of the "MSGLOW/for beautiful skincare & LOGO" brand and the "MSGLOW FOR MEN" brand. In fact, "MSGLOW FOR MEN" and "MSGLOW/for pretty skincare" had registered earlier compared to PT PSTORE Glow Bersinar Indonesia and in their decision the Judge rejected the appeal submitted by PT PSTORE Glow Bersinar Indonesia.

Outside the jurisdiction of the Commercial Court at the Medan District Court and after reading the decision at the first instance, PT PSTORE Glow Bersinar Indonesia filed a lawsuit again at the Commercial Court at the Surabaya District Court with Case Number 2/Pdt.Sus-HKI/Merek/2022/PN.Niaga .Sby. In this case, PT PSTORE Glow Bersinar Indonesia involved PT Kosmetika Global Indonesia, PT Kosmetika Cantik Indonesia, Gilang Widya Pramana, Shandy Purnamasari, Titis Indah Wahyu Agustin, and Sheila Marthalia as Defendants. In this case, the Panel of Judges granted the lawsuit filed by PT PSTORE Glow Bersinar Indonesia.

The panel of judges considered that the registered brand for the MS Glow product was "MSGLOW/for pretty skincare", so there was a difference between the brand on the product and the brand on the brand certificate. Regarding the First Decision at the Commercial Court at the Surabaya District Court, PT Kosmetika Global Indonesia, et al., as the owner of the MS Glow trademark, filed an appeal to the Supreme Court with Case Number 161 K/Pdt.Sus-HKI/2023 which essentially canceled the Commercial Court Decision at Surabaya District Court No. 2/Pdt.Sus-HKI/Brand/2022/PN.Niaga.Sby. Panel of Judges Examining Case No. 161 K/Pdt.Sus-HKI/2023 stated that in this case the Commercial Court at the Surabaya District Court had misapplied the law by considering the Commercial Court Case Decision at the Medan District Court No. 2/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Mdn., has been terminated first. So that the case at the Commercial Court at the Medan District Court is valid and is recognized as ongoing and the case at the Commercial Court at the Surabaya District Court is dismissed.

In this study, the author tries to find, read and study previous research related to the problem that the author will research, with the hope of becoming a reference, comparison or refinement of previous research. In some of the literature that the author obtained that is related to writing this research, namely:

1. Journal written by Sari, Mieke Yustia. "Passing off in Trademark Registration". Judicial Journal Vol. 7.No. 3. 2014 and discusses Passing off which is an act of imitation of a well-known brand carried out by business actors dishonestly; And
2. Journal written by Sukro, Ahmad Yakub. "Legal Protection of Famous Trademarks for Passing Off Actions in Business Competition Practices" Syiar Hukum Journal of Legal Sciences. Vol. 16 No. 1. 2016.

Based on comparisons with previous research which is more limited to certain aspects, this research integrates the importance of the relationship between court decisions, accountability, and the consequences of the actions of business actors who practice passing off.

Based on the series of decisions as described above, in this case MS Glow has been declared as the legal holder of the MS Glow brand and the Panel of Judges is also of the opinion that PSTORE Glow has bad faith because it has piggybacked on, imitated and plagiarized the fame of the MS Glow brand. The problem that will be discussed in this research is what are the legal consequences for the PSTORE Glow brand which practices passing off of the MS Glow brand based on laws and regulations in Indonesia? So the aim to be achieved in the preparation of research is to contribute and develop legal knowledge in general, especially those related to specific economic law so that both legal practitioners and the public know the legal consequences of brand-hijacking or passing off practices.

METHODS

The research method used in this research is normative-qualitative juridical using a case approach, namely examining the Medan Commercial Court Decision No. 2/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Mdn., Surabaya Commercial Court Decision No. 2/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Sby., Supreme Court Decision No. 160 K/Pdt.Sus-HKI/2023., and Supreme Court Decision No. 161 K/Pdt.Sus-HKI/2023 to understand the application of the law and its implications for the problem being researched.

The data sources used in this research are secondary data, which includes statutory regulations, literature books, scientific works, articles and documents related to research material. Secondary data consists of primary legal materials and secondary legal materials. The legal materials used to obtain secondary data are as follows:

1. Primary Legal Materials
 - a. Law of the Republic of Indonesia Number 28 of 2014 concerning Copyright
 - b. Law of the Republic of Indonesia Number 20 of 2016 concerning Marks and Geographical Indications
 - c. Regulation of the Minister of Law and Human Rights of the Republic of Indonesia Number 67 of 2016 concerning Trademark Registration.

2. Secondary Legal Materials

Secondary legal materials are legal materials that provide an explanation of primary law. Secondary legal materials used include books/literature relevant to the topic discussed, works/articles from legal circles, research results and opinions from legal experts, legal journals and articles.

RESULTS AND DISCUSSION

In the past, the act of passing off was not generally known in Indonesian literature in terms of definitions and specific descriptions of the form of action, but it was simply concluded that passing off was the act of piggybacking on a well-known brand. However, in Anglo-American law countries (common law system) such as England, Australia, Malaysia, the United States, and former colonies or Commonwealth of the British Empire, what is meant by passing off as a form of unfair competition in the field of trade or commerce has been recognized and regulated (Sukro, 2016).

At the Medan District Court Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn., the judge adhered to the first to file principle, which means whoever is registered first is considered to have legal ownership of the brand. Shandy Purnamasari as the owner of the MS GLOW/for pretty skincare and MS GLOW FOR MEN brands and logos has registered the two brands with the Directorate General of Intellectual Property. These two brands have been registered for the first time in the name of brand holder

Shandy Purnamasari with No. Registration: IDM000633038 for the MS GLOW/for pretty skincare brand and logo in the goods/services class (NCL 9) and No. Registration: IDM000877377 for the MS GLOW FOR MEN mark in the goods/services class (NCL 11). This exclusive right is granted by the state until 20 September 2026 for the MS GLOW/for pretty skincare brand and logo and 5 February 2030 for the MS GLOW FOR MEN brand. Shandy Purnamasari is the legal trademark holder as referred to in the Brand Certificate.

Based on the decision at the first level at the Medan District Court which has been described above, Putra Siregar filed a legal effort at the cassation level, this decision was stated in the Supreme Court Decision Number 160 K/Pdt.Sus-HKI/2023 where the judge in his consideration considered that the Court Decision Negeri Niaga Medan Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn, has had appropriate legal considerations so as to strengthen the decision. The consequence of the Supreme Court Decision Number 160 K/Pdt.Sus-HKI/2023 is that the registration of the PSTORE GLOW trademark and its derivatives is revoked. However, this case doesn't end there. Putra Siregar then filed a counterclaim at the Surabaya Commercial Court with case number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Sby. Putra Siregar claims that Shandy Purnamasari committed unlawful acts by producing beauty products using the MS GLOW trademark without rights.

Legal action is an effort for those who feel disadvantaged by a panel of judges' decision in their case to challenge the judge's decision in accordance with the law (Sitorus, 2018). Trademark owners who feel they have been harmed because their registered trademark has experienced trademark infringement by being imitated by another mark can file a lawsuit in court, as per Article 76 of the Trademark and Geographical Indications Law. A cancellation lawsuit was filed at the Commercial Court against the owner of the registered mark. A lawsuit to cancel a trademark registration must be filed within 5 (five) years from the date of registration. When a registered trademark is proven to have similarities with other registered trademarks, it is said to be a basis of bad faith (Laela, 2020). A trademark lawsuit is the filing of a lawsuit for infringement of trademark rights attached to a person where another person uses the trademark without approval/permission by showing similarities or similarities to the trademark with the same type of product and is resolved through court. Trademark lawsuits are resolved through the commercial court according to the area where the lawsuit is filed (Lasut, 2019).

Lawful trademark owners receive civil law protection. If trademark rights are maintained, the trademark owner receives legal protection according to the Indonesian trademark law system, which means that if trademark rights are violated, the trademark owner can file a lawsuit against the infringing party. The aim of this action is to recover compensation (Kowel, 2017).

Based on the decision of the Surabaya Commercial Court, it was revealed that Shandy Purnamasari committed a violation or unlawful act as the owner of the MS GLOW trademark. After conducting a search regarding the MS GLOW brand, it was discovered that the registered brand was in class 32, namely instant powder drinks. Meanwhile, the brand registered in class 3, namely beauty products or cosmetics, is the MS GLOW For Cantik Skincare trademark. However, so far Shandy Purnamasari has only used or included the MS GLOW brand without permission. MS GLOW only applies to the skincare products it produces without including For Beautiful Skincare. This of course contradicts the policy of the BPOM (Food and Drug Supervisory Agency), where the use of brands on the products produced must be in accordance with the products registered

with the Director General of Intellectual Property Rights. From this explanation it can be understood that the use of a brand in the goods produced must be in accordance with the registered brand and in accordance with the type of class of the brand. This is done to provide legal certainty not only for brand owners. However, it is also to provide certainty, guarantees and security for the public as consumers. Furthermore, Shandy Purnamasari as the owner of MS GLOW was sentenced to pay compensation to PSTORE GLOW in the amount of Rp. 37,990,726,332.00 directly and in cash. This is given as a form of responsibility for material and immaterial losses.

Referring to decision no. 161 K/Pdt.Sus-HKI/2023, the panel of judges stated that the Commercial Court at the Surabaya District Court had made a mistake in applying the law because of the Commercial Court Case Decision at the Medan District Court with case number 2/Pdt.Sus-HKI/Merek/2022/ PN.Niaga.Mdn. has been decided beforehand. Therefore, the ongoing case at the Commercial Court at the Medan District Court is recognized as valid and results in the cancellation of the case filed at the Commercial Court at the Surabaya District Court. That in this way the PSTORE Glow Brand can no longer be used, the trademark is removed from the Brand Registration Book by the Directorate General of Intellectual Property.

The definition of a brand is given by Article (1) paragraph 1 of the Trademark and Geographical Indications Law, "A brand is a sign that can be represented graphically as an image, logo, name, word, letter, number, color scheme, 2 (two) shapes and/or 3 (three dimensions), sound, hologram or a combination of 2 (two) or more of these elements, to differentiate between goods and/or services produced by individuals or legal entities in the trade of goods and/or services." Based on this understanding, a work can be protected by a trademark license if the sign or symbol has distinctive characteristics (Sudjana, 2020).

It is necessary to realize that registered trademark owners have the right to prevent other parties from using their trademark without permission, that there are practices that can harm business competition in Indonesia by using the passing off method used by other business actors in Indonesia and will have an impact on increasing business income. brand owner. The disputes filed by MS GLOW and PSTORE GLOW resulted in different final decisions and resulted in different legal consequences as well. At the Medan Commercial District Court, the lawsuit filed by Shandy Purnamasari or MS GLOW was successful. The judge stated that it was true that Shandy Purnamasari was the first party to use and register the MS GLOW trademark at the Directorate of Intellectual Property Rights. Furthermore, in this case it is also explained that there are indeed substantial similarities between the MS GLOW and PSTORE GLOW trademarks. Therefore, in the decision of the Medan Commercial District Court, PSTORE GLOW is required to be declared invalid. Panel of Judges Examining Case No. 161 K/Pdt.Sus-HKI/2023 stated in *Judex Facti* that the Commercial Court judge at the Surabaya District Court had misapplied the law in the Commercial Court Case Decision at the Medan District Court No. 2/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Mdn., has been terminated first. So that the case at the Commercial Court at the Medan District Court is valid and is recognized as ongoing and the case at the Commercial Court at the Surabaya District Court is dismissed.

The Trademark Registration System based on the Trademark and Geographical Indications Law continues to use a constitutive system (First to File), meaning that the first owner to apply for a Trademark still has exclusive rights. When looking at the explanation of Article 21 paragraph (3) of the Trademark and Geographical Indications Law which states that "an application is rejected if it is submitted by an applicant who

has bad intentions". Applicants who are reasonably suspected of registering a Mark with the intention of imitating, plagiarizing or following another party's Mark for the benefit of their business are in good faith as stated in the explanation of this article. The purpose of trademark registration is to create legal certainty and protect trademark rights. The Directorate General of Intellectual Property Rights is responsible for trademark registration. The trademark registration authority in charge of registering the trademark sought by the trademark owner is the Directorate General of Intellectual Property Rights (Semaun, 2016).

Legal action regarding the process of erasing and canceling registered trademarks can be carried out through lawsuits filed by parties with interests on various grounds that the trademark does not meet the requirements for registration or applications for registration that are rejected, such as the case of MS Glow and PSTORE Glow. Owners of their own unregistered marks are able to submit various lawsuits after the process of submitting a special application to the relevant Minister. The process of filing a lawsuit to cancel a lawsuit is carried out specifically at the Commercial Court regarding the ownership of a registered trademark. The process of suing the cancellation of a trademark registration can only be submitted within a period of five years from the date of the process in the trademark registration section. However, a lawsuit for cancellation can be filed without a time limit if there are elements of bad faith and the related brand is in conflict with state ideology, statutory regulations, morality, religion, decency and general legal regulations. In the Commercial Court's decision regarding the process for suing for cancellation, a cassation can be filed. The court clerk's duty is to immediately convey decisions to parties who have disputes.

Article 85 of the Trademark and Geographical Indications Law regulates the procedures for litigating cases in the Commercial Court. A lawsuit over a trademark is filed according to the jurisdiction of the commercial court according to the area of residence or domicile of the person wishing to file the lawsuit, of course in line with the provisions regulated by Article 118 HIR as procedural law. A lawsuit will be submitted to the Chairman of the Central Jakarta Commercial Court if a situation occurs that the Plaintiff or Defendant is domiciled outside the jurisdiction of Indonesia. Claims accepted by the commercial court according to its authority must be registered on the same day by the clerk. Then, the clerk will give the plaintiff a written receipt that has been signed and dated the same as the filing date. After that, the Chairman of the Commercial Court against whom the lawsuit is filed will appoint a jury to set a trial date no later than 3 (three) days after the lawsuit is filed and after the lawsuit has been reviewed. The bailiff must respond to the parties' invitations within 7 (seven) days after the case is filed. The examination hearing must be completed within 90 days and can be extended by 30 days from the time the lawsuit is received by the panel of judges. The decision on the lawsuit must include all legal factors and be made in a public hearing. The bailiff is obliged to convey the contents of the Commercial Court decision to the parties within 14 (fourteen) days after the decision on the lawsuit is pronounced. The Commercial Court's decision cannot be appealed, but only through cassation and judicial review. The Supreme Court has the highest level of power to overturn court judgments or decisions in all jurisdictions in several situations, namely:

- a. when the court does not have authority or exceeds the limits of authority;
- b. when courts misapply or violate applicable law;
- c. when the court fails to fulfill the requirements required by statutory regulations which threatens to annul the decision.

Meanwhile, the reasons for review based on Article 67 of the Supreme Court Law are:

- a. the existence of new facts or new evidence that became known after the case was decided, which was based on evidence that was later deemed false by the criminal judge;
- b. if after the case has been decided, very important documents of evidence are found that could not be found during the previous examination of the case;
- c. if something has been granted that was not demanded or more than was demanded;
- d. if any part of the claim has not been decided without considering the reasons;
- e. if there is a clear error or mistake in a decision made by the judge.

The absence of provisions regarding appeals at the Commercial Court aims to speed up the process of resolving cases in accordance with the principles of simplicity, speed and low costs. To carry out a trademark cancellation based on a court decision, it can only be done after the Minister (Kemenkumham) receives a copy of the court decision in the case in question which has permanent legal force. After the Minister has received an official copy of the decision, the cancellation of the mark will be announced through the Official Mark Gazette. This aims to provide information to the public that there is use of a brand that has been canceled and there is no legal protection for the brand. In the event of the cancellation of the mark, the mark will be removed from the Mark Registration Book, where a note will be made regarding the reason for the cancellation and the date of cancellation of the mark starting from when the mark was crossed out of the Mark Register Book.

To cancel or delete registration, several conditions must be met, one of which is filing a lawsuit in a commercial complaint. This provision directs applicants to have a clear indication of the legal consequences when requesting cancellation of a registered mark, so that the Trademark and Geographical Indications Law can provide legal protection. On the other hand, filing a lawsuit is an effort to achieve justice and legal certainty for the protection of legally valid brand owners.

A trademark certificate is a non-licensing document issued by the Minister when a trademark is registered. Brand ownership as a result of registration obligations follows the constitutive premises of the MIG Law. The registered mark will automatically become the right of the person registering the mark or what is called the principle of presumption of ownership which is in line with the prior in filling doctrine in the mark registration system in Indonesia. In other words, registration gives the right to use the mark. The right to use the mark is only for the person who registered it, and other parties must recognize the registrant's ownership rights as absolute rights. Based on Article 25 paragraph (2) Law No. 20 of 2016 Jo. Article 108 of Law No. 11 of 2010 concerning Job Creation, Brand certificates include the following information:

- a) full name and address of the owner of the registered Mark;
- b) full name and address of the Proxy in the case of an Application by Proxy;
- c) Date of Receipt;
- d) name of the country and date of receipt of the first application in the event that the application is submitted using priority rights;
- e) registered Mark label, including information regarding the type of color if the Mark uses color elements, and if the Mark uses a foreign language, letters other than Latin letters, and/or numbers that are not commonly used in Indonesian accompanied by their translation in Indonesian, Latin letters and numbers commonly used in Indonesian and how to pronounce them in Latin spelling;

- f) registration number and date;
- g) class and type of goods and/or services for which the Mark is registered; And
- h) the validity period of the Mark registration.

The legal certainty that a brand owner has is in the form of and provided in a brand certificate. The brand certificate given will give rise to rights and obligations for the brand owner as a form of justice and legal benefit. In connection with the legal traps that will befall the perpetrators, it is stated in Article 100-103 of the Trademark and Geographical Indications Law Number 20 of 2016 concerning criminal sanctions, namely:

Article 100

- (1) Any person who without right uses a Mark that is completely the same as a registered Mark belonging to another party for similar goods and/or services produced and/or traded, shall be punished by imprisonment for a maximum of 5 (five) years and/or criminal a maximum fine of IDR 2,000,000,000.00 (two billion rupiah).
- (2) Any person who without right uses a Mark which is substantially similar to a registered Mark belonging to another party for similar goods and/or services produced and/or traded, shall be punished by imprisonment for a maximum of 4 (four) years and/or a maximum fine of IDR 2,000,000,000.00 (two billion rupiah).
- (3) Every person who violates the provisions as intended in paragraph (1) and paragraph (2), whose type of goods causes health problems, environmental problems and/or human death, shall be punished with imprisonment for a maximum of 10 (ten) years and /or a maximum fine of IDR 5,000,000,000.00 (five billion rupiah).

Article 101

- (1) Any person who without right uses a sign that is completely similar to a Geographical Indication belonging to another party for goods and/or products that are the same or similar to the goods and/or products listed, shall be punished by a maximum imprisonment of 4 (four) year and/or a maximum fine of IDR 2,000,000,000.00 (two billion rupiah).
- (2) Any person who without right uses a sign that is substantially similar to a Geographical Indication belonging to another party for goods and/or products that are the same or similar to the goods and/or products listed, shall be punished by a maximum imprisonment of 4 (four) year and/or a maximum fine of IDR 2,000,000,000.00 (two billion rupiah).

Article 102

Every person who trades goods and/or services and/or products who knows or is reasonably suspected to know that the goods and/or services and/or products are the result of a criminal act as intended in Article 100 and Article 101 shall be punished with a maximum imprisonment of 1 (one) year or a maximum fine of IDR 200,000,000.00 (two hundred million rupiah).

Article 103

"The criminal act as intended in Article 100 to Article 102 is a complaint offense."

The legal consequence of canceling the PSTORE GLOW Brand is the loss of legal protection for the brand and PSTORE GLOW must withdraw its products that have been marketed. In this case, if PSTORE GLOW continues to sell its products on the market, it may be subject to criminal sanctions as regulated in Law Number 8 of 1999 concerning Consumer Protection. Criminal prosecutions regarding products that are still circulating

on the market after a decision to cancel a brand as regulated in the Law on Consumer Protection are as follows:

Article 61

"Criminal prosecution can be carried out against business actors and/or their management."

Article 8 verse (1)

"Does not meet or does not comply with the required standards and statutory provisions"

Article 62 verse (1)

"Business actors who violate the provisions as intended in Article 8, Article 9, Article 10, Article 13 paragraph (2), Article 15, Article 17 paragraph (1) letters a, letter b, letter c, letter e, paragraph (2) , and Article 18 is punishable by a maximum imprisonment of 5 (five) years or a maximum fine of Rp. 2,000,000,000.00 (two billion rupiah)."

With the protection of brands through civil and criminal law, it is a legal consequence for people or legal entities who do not have good intentions by making, copying, imitating or trading without permission without permission. Trademark rights are rights owned by the registered trademark owner which are granted by the state within a certain period of time to be able to use the trademark on their goods and/services or to be able to give approval/permission to other parties to be able to use the trademark. Each has a reputation with moral, material and commercial significance. Property rights are tied to their reputation. Reputation in the business world is seen as the key to the success or failure of a company, especially in terms of trademark violations which are increasing day by day and cannot be stopped by existing standards. To prevent this from happening, special protection is needed for copyrighted works in the form of trademarks. Trademark cancellation may occur due to bad faith trademark registration. Bad faith in trademark registration can be declared if the absolute and relative reasons are met (Cantika, 2018).

By filing a trademark lawsuit in a commercial court, the result will be that the judge will order a decision in such a way that the cancellation of a registered trademark by court order has the legal consequence that the decision must be implemented by the losing party in the trial. From the decision in case no. 161 K/Pdt.Sus-HKI/2023 we know that a judge can order the Directorate General of Intellectual Property of the Republic of Indonesia, Ministry of Law and Human Rights, to remove a brand from the Brand Registration Book of the Directorate General of Intellectual Property Rights and with various legal consequences.

Even though the brand owner registers his/her brand to obtain protection for the rights to his/her brand, there is no complete guarantee that the brand that has been registered by the brand owner will be safe and permanent in the Trademark Registration Book and avoid being deleted or canceled. This happens because the law provides a reason to be used for the deletion and cancellation of a brand, where if the elements are met then the brand can be removed and cancelled. Of course, in the event of brand cancellation there will be legal implications for the parties involved in the protection of the brand, who may face a trademark lawsuit such as a certificate of ownership. or trademark certificate.

Cancellation of a trademark by order of a court decision can only be carried out when the Minister has received a copy of the decision which has permanent legal force and the cancellation will be official if it has been announced in the Official Brand Gazette. This explains that the authority granted by Article 92 of the Trademark and

Geographical Indications Law has been determined in a limited manner which includes 3 (three) things, namely:

- a. Attach a note containing an explanation regarding the reason and date of cancellation when crossing out the mark.
- b. Since the trademark certificate has been invalidated, the trademark owner or his/her attorney can be notified in writing stating that the trademark has been declared no longer valid, as well as stating the reasons for the cancellation.
- c. The brand delisting was announced in the brand's official newsletter.

According to the author's analysis, referring to Article 92 of the Trademark and Geographical Indications Law, determining the limits on executorial actions that can be taken against brands that have been invalidated, this will certainly influence the judge in every decision, because this regulation strictly binds the judge. Other judges cannot make a decision to take executive action in the form of an order to the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia to carry out an execution action outside of what has been stipulated in Article 92 of the Trademark and Geographical Indications Law. In addition, limited action can give rise to new legal problems arising from action that does not provide a prohibition on reusing a brand that has been canceled or an invalid mark, which can give rise to unfair competition and failure to implement consumer protection if the brand is still used in a product. A registered trademark will lose its exclusive rights if the trademark has been canceled and removed from the general register of trademarks, as well as losing the legal protection provided by statutory regulations regarding trademarks, therefore other parties can also use the canceled trademark (Yulianto, 2020).

PSTORE GLOW has committed a fraudulent act of brand infringement by carrying out the practice of passing off or brand piggybacking on a previously registered mark, namely MS GLOW. The legal consequences that arise after the Supreme Court Decision Number 161 K/Pdt.Sus-HKI/2023 are the annulment of the Decision at the Surabaya Commercial Court Number 2/Pdt.Sus.HKI/Merek/2022PN.NIAGA.Sby. Thus, the Supreme Court Decision Number 161 K/Pdt.Sus-HKI/2023 also strengthens the Medan District Court Decision which determines the cancellation of the PSTORE GLOW Brand Registration in the name of the Defendant, namely Putra Siregar, so that legal protection for the PSTORE GLOW brand is also lost.

CONCLUSIONS

Legal consequences for the PSTORE Glow brand which carries out the practice of passing off the MS Glow brand based on Indonesian laws and regulations after Supreme Court Decision No. 161 K/Pdt.Sus-HKI/2023 which cancels the Surabaya Commercial District Court Decision No. 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Sby, the result is that the PSTORE Glow Mark and its derivatives can no longer be used and the registration is deemed to be cancelled. The cancellation was carried out by the Director General of Intellectual Property by crossing out the PSTORE Glow brand from the general list of brands, with the decision to cancel the PSTORE Glow brand bringing legal consequences to the end of legal protection for the PSTORE Glow brand, this is in accordance with the provisions of Article 68 paragraph (5) of the Trademark Law and Geographical Indication. Apart from the deletion of the PSTORE Glow brand, MS Glow can also file a criminal complaint in accordance with the provisions as intended in article 100 paragraph (1) and paragraph (2) of the Trademark and Geographical Indications Law and if PSTORE Glow is still selling its products after the decision to cancel the brand

then criminal prosecution can be carried out as regulated in Article 61, Article 62 (1) and Article 8 paragraph (1) of Law no. 8 of 1999 concerning Consumer Protection.

REFERENCES

- Desmayanti, Rakmita. Tinjauan Umum Perlindungan Merek Terkenal Sebagai Daya Pembeda Menurut Prespektif Hukum di Indonesia, Vol.6. No.1. *Jurnal Cahaya Keadilan*, 2018
- Dewi, Nourma. Kasus Sengketa Merek Prada S.A Dengan PT. Manggala Putra Perkasa Dalam Hukum Perdata Internasional. Vol 4 No 1. *Jurnal Ius Constituendum*, , Magister Hukum Universitas Semarang, 2019.
- Fahmi Syafrinaldi dan M. Abdi Al Maksur, *Hak Kekayaan Intelektual*, (Pekanbaru: Suska Press, 2008).
- Kowel, Fandi H. "Pelindungan Hukum Terhadap Penerima Lisensi Merek Di Indonesia". Vol. 5. No. 3, *Jurnal Lex et Societatis*, 2017
- Lasut, Patrichia Weyni. "Penyelesaian Sengketa Gugatan atas Pelanggaran Merek Menurut Undang-Undang Nomor 20 Tahun 2016 tentang Merek dan Indikasi Geografis".. *Lex Et Societatis*. Vol. 7. No. 1, 2019.
- Laela, Fitri Ida. Analisis Kepastian Hukum Merek Terkenal Terdaftar Terhadap Sengketa Gugatan Pembatalan Merek. Vol.7. No.2. *Jurnal Ilmiah Hukum dan Keadilan*. 2020.
- Lopulalan, Yunus Marlon. Et al. Hak Cipta Logo Yang Didaftarkan Sebagai Merek. Vol. 1. No. 1. *TATOHI: Jurnal Ilmu Hukum*. 2021.
- Natalia, Abigail. Fenomena Produk dengan Merek Palsu: Perlindungan Konsumen. Vol. 7. No.1. *Sapientia Et Virtus*. 2022.
- Rahmi Janed, *Hukum Merek Trademark Law*, (Jakarta: Kencana Prenadamedia Group, 2015).
- Sitorus, Syahrul. Upaya Hukum Dalam Perkara Perdata (Verzet, Banding, Kasasi, Peninjauan Kembali dan Derden Verzet). Vol. 15, No. 1. *Hikmah*, 2018.
- Sinaga, Niru Anita. Pentingnya Perlindungan Hukum Kekayaan Intelektual Bagi Pembangunan Ekonomi Indonesia. Vol.6. No.2. *Jurnal Hukum Sasana*. 2020.
- Tim Lindsey, dkk., *Hak Kekayaan Intelektual Suatu Pengantar*, (Bandung: Alumni, 2022),
- Sadikin O. K., "Aspek Hukum Hak Kekayaan Intelektual" *Intellectual Property Right*, cet. 4, (Jakarta: RajaGrafindo Persada, 2004),
- Suyud Margono dan Amir Angkasa, "Komersialisasi Aset Intelektual" *Aspek hukum bisnis*, (Jakarta: PT Gramedia Widiasarana Indonesia, 2002).
- Mieke Yustia Ayu Ratna Sari, "Passing off Dalam Pendaftaran Merek", *Jurnal Yudisial*, Vol. 7. No. 3, 2014,
- Sudjana, "Akibat Hukum Penghapusan Dan Pembatalan Merek Terdaftar Terhadap Hak Atas Merek", *Rei Nullius Law Jurnal, Fakultas Hukum Universitas Padjadjaran*, Vol. 2. No 2, 2020.
- Delila Pritaria Cantika, "Pembatalan Hak Merek Yang Telah Dijadikan Jaminan Fidusia", *Jurnal Yuridis* Vol. 5, No. 1, 2018.
- Eko Yuliyanto, "Eksekutorial Putusan Pembatalan Merek Terdaftar", *Indonesian Private Law Review. Fakultas Hukum, Universitas Lampung*, Vol.1, No.1, 2020.