

Analysis Regarding Brand Dispute Cases Based on Case Study of Decision Number 4 Pk/Pdt.Sus-Hki/2023

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Abstract

Brand is a very important thing for the business world, especially for business people, because the brand is the identity of a product or company that is very valuable. A well-known brand from the United States, namely TIMBERLAND, is in dispute with a local brand, namely TIMBERLAKE, judging from the sentence that dominates the word "TIMBER" and from its mention it can confuse consumers. The registration of the TIMBERLAKE brand had bad faith and wanted to piggyback on the well-known American brand, TIMBERLAND, because there were similarities in the brands that were detrimental to the plaintiff.

Keywords: Analysis, Dispute, Brand



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INTRODUCTION

Brand is a very important thing for the business world, especially for business people, because the brand is the identity of a product or company that is very valuable. Therefore, it is not uncommon for this brand to practice, disputes often occur. Many entrepreneurs or business people use brands that are already owned by other people or use brands that are similar in principle or in whole to brands owned by other people. One of the factors is the lack of knowledge about trademark rights, especially in terms of ownership and legal protection of trademarks, as well as the legal consequences of imitating, copying other people's brands. A brand owner or trademark licensee can sue someone without a permit, having used a mark that is similar in principle to the mark of another person engaged in the same trade or service sector (Article 76 (1) in conjunction with Article 77).

In this research, the author will examine the trademark disputes in Decision Number 4 PK/Pdt.Sus-HKI/2023. A well-known brand from the United States, namely TIMBERLAND, is in dispute with a local brand, namely TIMBERLAKE, judging from the sentence that dominates the word "TIMBER" and from its mention it can confuse consumers. The registration of the TIMBERLAKE brand had bad faith and wanted to piggyback on the well-known American brand, TIMBERLAND, because there were similarities in the brands that were detrimental to the plaintiff. So that the plaintiff filed a Mark Cancellation Lawsuit to the Commercial Court at the Central Jakarta District Court against the TIMBERLAKE brand. Indonesia is a country that has joined international organizations, one of which is the Paris Convention. In the Paris Convention it is stated that trademarks are included as objects of Industrial Property Rights, the countries participating in the convention are obliged to ensure that their citizens receive effective protection against unfair business competition. Specifically prohibited regarding all actions that are causing confusion in any way (for consumers), whether manufacturing, goods, or industrial and commercial activities carried out compared to its competitors, false accusations in trade that are discrediting establishments, goods, or industrial activities or

commercial use of its competitors and indications or alleged uses which in commerce could mislead the public as to the nature, manufacturing process, characteristics, fitness for their purpose, or quantity, of the goods. The state also grants exclusive rights to registered geographic indication rights holders, as long as the reputation, quality, and characteristics on which the protection of the geographical indication is based exist (Article 1 paragraph (7) of Law No. 20 of 2016).

The verdict at the first level, the panel of judges at the Commercial Court at the Central Jakarta District Court only partially granted the lawsuit, while the partial lawsuit that was rejected was the essence of the dispute, namely regarding Famous Marks. With the results of this decision, the Plaintiff felt that he had not received the expected justice, then the Plaintiff TBL LICENSING LLC with the TIMBERLAND brand made a legal effort, namely by filing an appeal to the Supreme Court of the Republic of Indonesia against the decision of the Commercial Court at the Central Jakarta District Court. In the process of cassation, only then did the Plaintiff obtain justice that the Cassation Petition was granted in its entirety and canceled the decision of the first degree. With the cassation decision that the TIMBERLAND brand is a well-known brand that cancels the TIMBERLAKE brand with all the legal consequences. Protection of well-known marks is given in relation to use in general and not only in relation to the types of goods for which the mark is registered. This protection is guaranteed in Article 6 (2) of the Trademark Act. In Law Number 20/2016 concerning Trademarks and Geographical Indications regarding brands that cannot be registered and are rejected. Article 21 stipulates that Marks are rejected if they are similar in principle or in whole, so that in Decision Number 4 PK/Pdt.Sus-HKI/2023 the Panel of Judges Rejects the Request for Review. Formulation of the Problem: How is the Juridical Analysis the judge's consideration of Decision Number 4 PK/Pdt.Sus-HKI/2023?

RESEARCH METHODS

This research uses the juridical-normative research method, which means that this research uses legal material that has been written in national institutions and is a social guideline that is used as a standard of behavior. (Marzuki, 2005). Or it can be interpreted, this research examines library materials and secondary data or regulations/regulations related to this research topic. By using a juridical approach, this research focuses on the rules or legal rules regarding the brand law which are located in "UU 20 of 2016" concerning marks and geographical indications. This study collected data using a literature approach, namely research using legal sources/materials that can be accounted for. The primary legal materials used in this study are the 1945 Constitution, Law number 13 of 2003 concerning employment, Supreme Court Decision Number 58/Pid.Sus/2013/PN.Pt. The tertiary legal materials used in this research are journals, literature, theses, articles obtained from library research and can be accounted for. The analytical method used to examine the data in this study is the qualitative data analysis method.

RESULTS AND RESEARCH DISCUSSION

Legal protection is a regulation that is made based on the decision of state officials to protect the protection of legal subjects, namely people or legal entities in the form of instruments both preventive and repressive in nature, both verbal and written. Based on Article 1 paragraph (1) of Law Number 20 of 2016 concerning Marks and Geographical Indications states that: A mark is a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in the form of 2 (two) dimensional and/or 3 (three) dimensional, sound, hologram, or a combination of 2 (two) or more of these elements

to differentiate goods and/or services produced by persons or legal entities in the activity of trading in goods and/or services.

To find out a well-known mark as mentioned in the explanation of Article 21 paragraph (1) letter b, the famous reputation of a brand can be done by taking into account the public's general knowledge about the mark in the field of business concerned, besides that it can be obtained by vigorous and large-scale promotion. investment in several countries in the world carried out by the owner, and accompanied by proof of registration of the mark in several countries. Competition in the world of trading through brands in Indonesia has of course been regulated in the Trademark Law which has undergone several changes, namely starting with Law Number 21 of 1961 concerning Company Marks and Commercial Marks which was later changed to Law Number 19 of 1992 concerning Trademarks. , Law Number 14 of 1997 concerning Marks and finally changed to Law Number 15 of 2001 concerning Marks.

In its case, Timberland under the auspices of TBL Licensing LLC filed a lawsuit against it with a lawsuit dated 24 August 2020 which was received and registered at the Registrar's Office of the Commercial Court at the Central Jakarta District Court on 24 August 2020 in Register Number 42/Pdt.Sus Merk/2020/PN.Niaga .Jkt.Pst., has filed a lawsuit for cancellation of trademark registration. The TIMBERLAND brand has been registered with WIPO International under List No. IR509706, dated 10 November 1986, to protect the types of goods included in classes 01, 03, 08, 09, 11, 14, 16, 18, 20, 21, 22, 25, 26, 28 and 34 and a name change has been proposed. Whereas in addition to registration in various countries around the world, Timberland's TIMBERLAND Mark has also received legal protection in Indonesia, because it has been registered in the General Register of Marks at the Directorate of Trademarks, namely the TIMBERLAND brand No. IDM000010344 was registered on July 9, 2004 which is an extension of the previous registration number No. 336470 was registered on June 8, 1995 and has been extended. Timberland has the exclusive right to use the mark itself, so that it may not be used again by other parties without Timberland's permission. This is in accordance with the provisions of Article 1 point 5 of the Law of the Republic of Indonesia No. 20 of 2016 concerning Brands and Geographical Indications.

Evidence regarding this matter will be submitted by Timberland at a later stage of proof. By having the TIMBERLAND brand owned by Timberland registered in Indonesia and in other countries, and supported by the circulation of products under the TIMBERLAND brand owned by Timberland in various countries and in Indonesia, this proves that the TIMBERLAND brand owned by Timberland is a well-known brand with an international reputation, in accordance with the following provisions: 1. Declare Timberland as the sole owner of the rights to the Famous Mark TIMBERLAND. 2. Declare that the brand "TIMBERJEANS" in the name of the Defendant with registration number 544169 dated 25 July 2003 has similarities in principle to the brand "TIMBERLAND" owned by Timberland. 3. Declare that the brand "TIMBERJEANS" on behalf of the Defendant with register number 544169 dated 25 July 2003 has similarities in principle to the brand "TIMBERLAND" owned by Timberland.

This of course can lead to confusion among consumers by thinking that the brand on behalf of the Defendant is a brand belonging to Timberland because when they mention and see a brand, consumers will see and pronounce the dominant elements of that brand. With the similarity in the dominant element between the Defendant's brand and the Timberland brand, there is a similarity in the sound of speech between the TIMBERLAKE No. brand. IDM000471725 was registered on 28 August 2015 in the name of the Defendant under the brand TIMBERLAND No. IDM000010344 was registered on 9 July 2004 and has been extended under Agenda No. R.2991/2014 dated 26 February 2014 belonging to Timberland. Therefore, based on the legal reasons above, and supported by the available evidence, Timberland

requests the Honorable Chairman of the Central Jakarta Commercial Court to grant Timberland's lawsuit in its entirety. In addition, the respondent's cassation request was ultimately rejected in Decision Number 4 PK/Pdt.Sus-HKI/2023.

CONCLUSION

Legal protection is a regulation made on the decision of a state official to protect the protection of legal subjects, namely persons or legal entities, both preventive and repressive, both orally and in writing. Competition in the world of trading through Marks in Indonesia has been regulated in the Trademark Law which has undergone several amendments, which began with Law Number 21 of 1961 concerning Company Marks and Trade Marks which were later amended to Law Number 19 of 1992 concerning Trademarks, Law Number 14 of 1997 regarding Marks and finally changed to Law Number 15 of 2001 concerning Marks. In its case, Timberland under the auspices of TBL Licensing LLC filed a lawsuit against it with a lawsuit dated 24 August 2020 which was received and registered at the Registrar's Office of the Commercial Court at the Central Jakarta District Court on 24 August 2020 in Register Number 42/Pdt.Sus Merk/2020/PN.Niaga .Jkt.Pst., has filed a trademark registration lawsuit. Evidence regarding this matter will be submitted by Timberland at a later stage of proof. With the registration of the TIMBERLAND brand owned by Timberland in Indonesia and in other countries, and supported by the circulation of products under the Timberland brand TIMBERLAND in various countries and in Indonesia, this proves that the registered defendant's mark has an international reputation.

Suggestion: As a maker or owner of a company, you should pay more attention to brands because brands are an identity related to quality and reputation in a product in a company.

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BIBLIOGRAPHY

- Abduh, R., & Fajaruddin, F. (2021). Intellectual Property Rights Protection Function In Resolving Copyright Disputes. *International Journal Reglement & Society (Ijrs)*, 2(3), 170-178.
- Bafadhal, T. (2018). Perlindungan Hukum terhadap Merek Terkenal di Indonesia. *Undang: Jurnal Hukum*, 1(1), 21-41.
- Denny, D., Liegestu, Y. P., Novika, N., & Patros, A. (2022). Penyelesaian Sengketa Merek Di Indonesia: Studi Putusan. *SAPIENTIA ET VIRTUS*, 7(2), 148-163. *ro Law Journal*, 11(1).
- Dinata, E. (2020). Larangan Keberlakuan Surut Pada Aturan Merek Dalam Studi Kasus Sengketa Merek. *Jurnal Hukum Magnum Opus*, 3(2), 201-212.
- Kusuma, I. A. S. D., & Sugama, I. D. G. D. (2020). Upaya Arbitrase Dalam Penyelesaian Sengketa Merek Terkenal. *Jurnal Hukum Kertha Wicara*, 9(3).
- Masnun, M. A. (2021). Disparitas Putusan Mengenai Persamaan Pada Pokoknya Pada Merek Predator (Studi Putusan Nomor 1146 K/Pdt. Sus-Hki/2020). *SASI*, 27(4), 463-474.

- Perlindungan merek, Yayasan Pustaka Obor Indonesia (2018) Jakarta.
- Prof. Dr. Rahmi Jened, S.H., M.H., (2017) Hukum merek, KENCANA.
- Sujatmiko, A. (2016). Penyelesaian Sengketa Merek menurut Undang-Undang Nomor 15 tahun 2001. ADHAPER: Jurnal Hukum Acara Perdata, 2(1), 169-191.
- Tala, W. S. S. (2006). Identifikasi Faktor-faktor Penyebab Sengketa Merek Terkenal (Studi Atas Putusan Pengadilan) (Doctoral dissertation, Universitas Sumatera Utara).
- Wibipratama, D. I., Santoso, B., & Saptono, H. (2022). Analisis Yuridis Terhadap Sengketa Merek Terkenal Varivas Studi Putusan (No: 5/Pdt. Sus-Merek/2019/Pn. Niaga Jkt. Pst). Diponego
- Widyanti, Y. E. (2021). The legal instrument of protecting traditional cultural expressions ownership in intellectual property rights law. Technium Soc. Sci. J., 21, 492.