

Legal Analysis of the IKEA Trademark Removal Dispute Case (Study of Decision Number 165 PK/Pdt.Sus/2012)

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Abstract

Brands have an important function for their owners, especially in the era of global trade. Trademarks provide an indication of the origin and quality of the goods or services traded. Trademark owners have the exclusive right to authorize or prohibit others from using the same or similar trademarks as theirs. Indonesia uses a constitutive registration system, in which exclusive rights are given to registered marks. Trademark applicants may not register the same mark as another well-known trademark. Registered trademark must be used. Trademark cancellation is carried out when the brand has not been used for three consecutive years. In general, trademark revocation occurs when a mark is not used in trade in goods and services. If the former owner still wants the same trademark rights, he/she must apply for trademark registration and go through the entire registration procedure. If the other party applies for the mark first, the old owner can object. If this effort fails, he can submit an annulment to the Commercial Court, cassation, and review.

Keywords: Brand, Mark Removal



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INTRODUCTION

The role of brands in the world of marketing is very important, because people associate the quality or reputation of goods and services with certain brands. Brands must also have adequate differentiation power, meaning they have the power to differentiate goods or services from one company's products from other companies (Khoironi, 2013). Trademark rights are a form of intellectual property rights (IPR) protection in which the holder of a trademark registration is granted the exclusive right to use a trademark in trade for registered goods or services. For example, if a trademark is registered for one type of clothing, the exclusive right of the brand owner belongs to the only person who has the right to use the mark as a clothing brand, but not for other types of goods or services (Setiadharmas, 2016).

Progress in the world of trade both domestically and internationally has caused business people to pay more attention to the subject matter of trade. Especially in the era of globalization, where the flow of goods changes very quickly and widely. The brand indicates the origin and quality of the products and services sold. By knowing the origin of goods/services, people can assess the quality of the product they will buy. The tendency of the public to buy goods based on the brand on the traded goods/services shows the economic value of the brand. As a result, retail companies attach great importance to the use of branding in business. They trade is an identity in trading with goods or services. This economic value is generated from the exclusive rights of the trademark owner.

One aspect that is protected by a brand is the protection of well-known marks. Well-known brands must be protected, among other things, so that other people do not exploit the reputation of third-party brands that are widely known to the public. If a well-known brand is used by other people who are not responsible, the reputation of the brand will be damaged

because high-quality products with inferior products circulate in society. Reputable brands are brands with high brand awareness in the retail world, which are recognized internationally or at least regionally. The reputation criterion is based not only on concern for general public knowledge but also on reputational actions achieved through reputation and confirmed by registration.

Well-known brands are brands that have a high reputation in the world of trade that are recognized internationally or at least regionally. The criteria for a well-known brand besides paying attention to public knowledge, are also based on the brand's reputation which is obtained through promotion and has been proven by registration. The use of another person's well-known mark is basically carried out in bad faith, because the unauthorized user can benefit from the fame of the brand. Irresponsible users benefit from the tendency of consumers to buy goods/services that are suspected of being of good quality because they use well-known brands. In the Trademark Law in force in Indonesia, both Law No. 20 of 2016 and Law No. 15 of 2001 (the old one) do not mention the definition of a reputation brand. Registration confers exclusive rights to trademarks, but not everything can be registered as a trademark. One of them is in the case of a mark which is principally or wholly similar to a well-known mark, the application must be rejected. This proves the protection of well-known brands.

Formulation of the problem: What are the reasons that can be used to file a lawsuit for cancellation of a registered mark? Is a condition for the mark abolished? How is the settlement of brand disputes in decision No. 165 PK/Pdt.Sus/2012 regarding the case of the IKEA brand dispute?

RESULTS AND DISCUSSION

Mark cancellation can only be filed by interested parties or brand owners, either through an application to the Director General of Intellectual Property or through a lawsuit at the Indonesian Commercial Court. Mark cancellation is carried out by the Director General of Intellectual Property by deleting certain brands from the list of main marks by stating the reason and date of cancellation. According to Article 68 of Law 15 of 2001 Concerning Marks, registered Marks can be cancelled, this is contained in articles 4, 5 and 6 paragraphs (1) and (2) of Law 15 of 2001 concerning Marks. There are several reasons that can be used to file a trademark cancellation, among others:

1. According to Article 4 of Law 15 of 2001 concerning Mark, namely the registration of a mark that is filed or carried out in bad faith.
2. According to Article 5 of Law 15 of 2001 Concerning Marks, a registered mark does not fulfill the requirements as a mark.
3. According to Article 6 paragraph (1) of Law 15 of 2001 concerning Marks, namely a mark that is registered is the same as another person's mark that is registered first for similar goods and or services.
4. According to Article 6 paragraph (2) of Law 15 of 2001 Concerning Marks, namely registered marks cannot obtain written approval from those entitled to.

Once the importance of the role of the mark in a product and/or service, it is also necessary to protect the existence of the mark. Protection of a mark is fundamental to the right of someone trying to create it, because today there are lots of fraudulent acts that are very detrimental that often occur, namely imitation or imitation of part or all of the mark in question. To obtain legal protection, a mark must first be registered at the "Directorate General of Intellectual Property Rights" at the Directorate General of Intellectual Property

Rights because Indonesia adheres to a constitutive system, namely the rights to a mark are obtained based on registration.

Applications for Mark Removal can be made by the brand owner or through their Proxy for all or part of the types of products and/or services. If the trademark to be deleted is still bound by a license agreement, deletion can only be done if it is approved in writing by the licensee. One of the reasons for removing a mark because the mark is not used, based on Article 74 paragraph (1) of the Trademark Law, states that: "Removal of a registered mark can also be filed by an interested third party in the form of a lawsuit to the Commercial Court on the grounds that the mark has not been used for 3 (three) consecutive years in trade in goods and/or services since the date of registration for the last usage."

In practice, the reason for canceling mark registration by reason of not being used is difficult to prove, because it is not an easy thing to prove that the mark is not used, and if this reason is used to delete a mark by the Directorate of Trademarks, of course the owner of the mark whose mark will be deleted will try to redistribute it. mark with the goods in question, or provide evidence that the owner of the mark has actually used the mark.

Deletion of this Mark will be carried out if the registered mark fulfills the following conditions: has similarities in principle and/or in its entirety with Geographical Indications; contrary to state ideology, laws and regulations, morality, religion, decency, and public order; or have in its entirety similarities to traditional cultural expressions, intangible cultural heritage, or names or logos that have been passed down through generations.

The removal of a registered mark can be requested by a third party in charge in the form of a lawsuit at the Indonesian Commercial Court. A lawsuit for deletion of a Mark can be filed on the basis that the Mark has not been used for 3 (three) consecutive years in trade in trade goods and/or services since the date of registration or last use. However, the reason for not using the Mark does not apply in the event that it exists: import ban; prohibition relating to permits for circulation of goods using the Mark concerned or decisions from the competent authority which are temporary in nature; or other similar prohibition stipulated by Government Regulation.

PT. ANGSA DAYA as the plaintiff represented by Director Lee Kok Seng, domiciled at the Building Materials Trading Center, Jalan Mangga Dua Raya, Block F2 Number 3-5, Jakarta 10730, in this case authorizes Sarmauli Simangunsong, SH., LLM.,. The plaintiff is a company that produces household and office equipment and accessories (hereinafter referred to as "goods") originating from Sweden directly to consumers or users or retail internationally using the IKEA brand and its combination, where the IKEA brand is a brand established by a citizen. Swede by the name of Ingvar Kamprad. IKEA was first registered as a trademark name or trade name in Sweden in 1943 and currently the Plaintiff's IKEA trademark and its combinations have been registered in several countries in the world from 1943 to 75 (seventy five) countries with registration 1300 (one thousand three hundred) trademark registrations. Inter IKEA Systems B.V., here as the defendant, namely a company established under the laws of the Netherlands, represented by Gabriele Olsson Skalin as MAN Dir. IKEA is a brand invented or created by the founder of the Plaintiff's company in 1943, namely by Ingvar Kamprad and currently it is a well-known brand throughout the world used for home or office purposes, while the Ikema brand is on behalf of Defendant I, if you look at the facts, that the brand Ikema is similar in whole or in principle to the plaintiff's IKEA brand.

In this lawsuit, a decision was received from the judge that rejected the plaintiff's claim in its entirety and sentenced the respondent for judicial review to pay court costs at all levels of trial and for judicial review, which in the judicial review examination was set at IDR 10,000,000.00 (ten million rupiah).

CONCLUSION

The role of brands in the world of marketing is very important, because people associate the quality or reputation of goods and services with certain brands. Brands must also have adequate differentiation power, meaning they have the power to differentiate the goods or services of one company's products from other companies. Well-known brands are brands that have a high reputation in the world of trade that are recognized internationally or at least regionally. The criteria for a well-known brand besides paying attention to public knowledge, are also based on the brand's reputation which is obtained through promotion and has been proven by registration. Well-known brands are brands that have a high reputation in the world of trade that are recognized internationally or at least regionally. The criteria for a well-known brand besides paying attention to public knowledge, are also based on the brand's reputation which is obtained through promotion and has been proven by registration.

Suggestion: In this case, to determine and see whether a trademark has been registered or not, and understand the applicable laws to avoid misunderstandings and things that are not desirable in the trademark lawsuit.

BIBLIOGRAPHY

- Adrian Sutedi, Hak Atas Kekayaan Intelektual, Sinar Grafika, Jakarta. 2013
- Erlina, B. (2013). Analisis Penghapusan Merek Terdaftar Oleh Direktorat Merek (Studi pada Direktorat Jenderal Hak Kekayaan Intelektual Kementrian Hukum dan Hak Asasi Manusia Republik Indonesia). Pranata Hukum, Bagian 8, (No. 1), hlm. 34.
- Pasal 68 Undang-Undang 15 Tahun 2001 Tentang Merek
- Pasal 74 ayat (1) UU Tentang Merek
- Perdana, K. (2017). Kelemahan Undang-Undang Merek Dalam Hal Pendaftaran Merek (Studi Atas Putusan Sengketa Merek Pierre Cardin). Privat Law, Bag. 5, (No. 2), hlm. 91
- Putusan Mahkamah Agung Nomor 165 PK/Pdt.Sus Tahun 2012
- Rahmi Jened, Hukum Merek (Trademark Law) Dalam Era Global & Integrasi Ekonomi, Prenadamedia Group, Jakarta. 2015
- Setiadharna, P. (2016). Sedikit Kisah Tentang Hapusnya Merek IKEA.
- Undang-Undang No. 20 Tahun 2016 Tentang Merek