



## Review of the Judges' Consideration of Trademark Conflict between PS Glow and MS Glow

Venny; Kadek Wiwik Indrayanti; M. Ghufron Az

University of Merdeka Malang, Indonesia

E-mail: [fvny812@gmail.com](mailto:fvny812@gmail.com)

<http://dx.doi.org/10.47814/ijssrr.v6i12.1699>

---

### **Abstract**

This article is motivated by differences in the decision of the judge at the Medan Commercial Court and the decision of the Surabaya Commercial Court regarding the trademark dispute between MS Glow and PS Glow. MS Glow considers that the PS Glow brand is similar to MS Glow, which was first present in the skincare world. That is why MS Glow sued PS Glow at the Medan Commercial Court. As a result, the Medan Commercial Court granted MS Glow's lawsuit and cancelled the PS Glow brand in the name of Putra Siregar as a defendant. Then, unsatisfied with the decision, PS Glow submitted the same case to the Surabaya Commercial Court. The results of the Surabaya Commercial Court's decision stated that MS Glow was essentially the same as PS Glow. From the case above, there are 2 (two) different court decisions resulting from the same issue, namely the Medan Commercial Court, which stated that MS Glow won over PS Glow and the Surabaya Commercial Court, which stated the opposite. Even though the legal basis used is the same, namely Law number 20 of 2016 concerning Trademarks and Geographical Indications, the problem that will be analyzed in this research is how the judge considered the two cases and whether the two decisions were by the principle of *bis in idem*. This research uses normative legal research with a case approach and an approach to statutory regulations and court decisions. This research results in the two decisions using regulations regarding geographical indications and trademarks. The weakness of this law is that there needs to be an explanation of the similarity criteria. There are no definite parameters to assess whether a trademark is similar to other previously registered trademarks. Then, the Surabaya Commercial Court's decision does not fulfil 1 (one) requirement for a case to occur in civil law or is not by the principle of *ne bis in idem*.

**Keywords:** *Conflict; Trademark; Judge's Consideration*

### **Introduction**

The beauty business, more commonly known as the skincare business, has recently experienced very rapid progress, especially in the last 2 (two) years ((Dewi, 2022)). The figures even surpass the sales

of makeup products. Looking at the numbers, this figure is very tempting to be achieved by business actors in Indonesia. According to a Statista report, the beauty and self-care market revenue will reach US\$7.23 billion or approximately Rp111.83 trillion (at an exchange rate of 1 dollar to Rp15,467.5) by 2022. The market is expected to grow at a CAGR of 5.81%, and the annual growth is estimated to increase from 2022-2027. In detail, the largest market segment is the personal care segment, with a market volume of US\$3.18 billion in 2022. This is followed by skin care at \$2.05 billion, cosmetics at \$1.61 billion and fragrances at \$39 million. In terms of population, the beauty and personal care market revenue per person in Indonesia will be US\$25.90 in 2022. In the beauty and personal care market, 15.8% of the total revenue will be from online sales by 2022. According to Euromonitor's report, the market potential of beauty and personal care products in Indonesia will reach approximately IDR 120 trillion by 2022.

Seeing these fantastic numbers, it is only natural that beauty industry players always strive to provide the best for Indonesian consumers (Ida Laela, 2020). This condition is quite beneficial for consumers because they get the best service in the field of skincare. These business actors also compete in many ways, from branding and logos to medical action services provided to consumers (Syaifulloh, 2015). Among the many competing skincare brands, 2 (two) names are prominent in the market, namely MS Glow and PS Glow. These two brands sound similar in terms of brand pronunciation. Upon further observation, it turns out that MS Glow and PS Glow are also similar in branding, logo, identity and packaging. This is what triggered the legal conflict between these 2 (two) trademarks.

According to the legal facts, MS Glow was founded in 2013 before PS Glow. MS Glow was founded by Shandy Purnamasari and Maharani Kemala. The company MS Glow, which stands for Magic for Skin, is committed to providing facial skin care so that it is healthy and naturally radiant. In the meantime, Putra Siregar and his wife Septia established PS Glow in 2021. According to MS Glow, the PS Glow brand and the MS Glow brand, which initially appeared in the skincare industry, are comparable. Hence, MS Glow filed a lawsuit against PS Glow in the Medan Commercial Court. Owner of the MS Glow brand Shandy Purnamasari's lawsuit over the trademark dispute was allowed by the Medan Commercial Court. On behalf of Putra Siregar, it said that it has canceled the registered trademark, PS Glow.

PS Glow, which did not recognize the judgement of the Medan Commercial Court, filed a counter-suit in the Surabaya Commercial Court. PT PStore Glow Bersinar Indonesia, through its lawyer Edy Hartono, sued Gilang (Shandy Purnamasari's spouse) and Shandy Purnamasari for trademark infringement. PS Glow also sued PT Kosmetika Global Indonesia, PT Kosmetika Cantik Indonesia, Titis Indah Wahyu Agustin, and Sheila Marthalia in addition to Gilang and Shandy. Case number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Sby was assigned to the lawsuit. The lawsuit requested that the six defendants pay Rp 360 billion in damages. This is predicated on the argument that MS Glow is prohibited because it utilizes the brand MS Glow, which is identical to the plaintiff's trademark, PStore..

This case continued to the cassation level of the Supreme Court. The decision of the Supreme Court was issued on January 30, 2023, with decision number 161 K/Pdt.Sus-HKI/2023. The result of the Supreme Court's decision was to overturn the decision of the Surabaya District Court. MS Glow was ordered to pay court costs at the cassation level of Rp5,000,000.00. In other words, the Supreme Court stated that MS Glow had won against PS Glow. The trademark of PS Glow was declared to be substantially similar to the trademark of MS Glow. The decision of the Supreme Court is the same as the decision of the Medan Commercial Court. In addition to the trademark dispute case between MS Glow and PS Glow, several other cases are similar to this situation.

In 2018, the owner of the Pierre Cardin trademark in France filed a lawsuit against Alexander Satryo Wibowo for allegedly using the Pierre Cardin trademark in bad faith (Hastuti, 2019). This lawsuit

was registered at the Commercial Court of Central Jakarta. As a result of this lawsuit, the Central Jakarta Commercial Court dismissed the lawsuit filed by the owner of the Pierre Cardin trademark in France. The story continues with the owner of the Pierre Cardin brand in France appealing to the Supreme Court. The decision of the Supreme Court stated that the Pierre Cardin brand belongs to Alexander Satrio Wibowo. Alexander always includes the phrase "Product by PT Gudang Rejeki" as a distinguishing feature. Thus, it was found that Alexander did not hijack the fame of other brands (see 2023).

From the description above, it appears that there are 2 (two) different court decisions, namely the Medan Commercial Court, which stated that MS Glow won over PS Glow and the Surabaya Commercial Court, which stated the opposite (PS Glow won over MS Glow). Based on the case and description of the problem above, this article will examine the reasoning behind the decisions of the Medan Commercial Court and Surabaya Commercial Court regarding the trademark dispute between MS Glow and PS Glow. The legal basis used by the 2 (two) Commercial Courts is the same, namely Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Therefore, it is necessary to conduct an in-depth analysis of why the decisions of these two courts can be different. In addition, researchers will also examine and analyze whether or not there is in idem condition in the 2 (two) Commercial Court decisions.

### ***Methodology***

The type of research used is normative legal research. This research is called normative legal research because researchers want to examine and analyze the difference in decisions between the Medan Commercial Court and the Surabaya Commercial Court in the case of the PS Glow and MS Glow feud about trademarks. The approaches used are legislation, case, and comparative law (Mardianto, 2011).

### ***Results and Discussion***

According to the ruling in the trademark dispute between MS Glow and PS Glow, the Medan Commercial Court (number 2/Pdt.SUS-HKI/Merek/2022/PN Niaga Medan) found that PS Glow's trademark is fundamentally similar to that of MS Glow. Because PS Glow was attempting to capitalize on the notoriety of MS Glow, a trademark that had already been registered, it was determined that PS Glow was utilizing its trademark in bad faith. The MS Glow trademark was registered in 2016, according to Intellectual et al., the Directorate General of IPR. MS Glow was so recognized as the first registrant and the proprietor of the trademark. The trademark cancellation of PS Glow was requested by the Medan Commercial Court. It is also forbidden for PS Glow to use this trademark for any kind of manufacturing, distributing, or selling of cosmetics.

In contrast, the Surabaya Commercial Court's decision (number 2/Pdt.SUS-HKI/Merek/2022/PN Niaga Surabaya) made the opposite declaration. It was decided that PS Glow was the exclusive proprietor of the trademark. Stated differently, it was determined that the MS Glow trademark and the PS Glow trademark were significantly similar. Additionally, according to the judgement, MS Glow must immediately and in cash pay damages totaling Rp.37,990,726,332, - (thirty-seven billion, nine hundred ninety million, seven hundred twenty-six thousand, three hundred thirty-two rupiahs). The Surabaya Commercial Court and the Medan Commercial Court have different opinions based on the two (two) commercial court decisions. The MS Glow trademark and PS Glow are significantly similar, according to the Medan Commercial Court.

Meanwhile, the Surabaya Commercial Court found that MS Glow is substantially similar to the PS Glow mark. The legal basis used by these two commercial courts is the same, namely Law No. 20 of 2016 on Trademarks and Geographical Indications. Therefore, it is necessary to conduct an in-depth

analysis of why these two courts' decisions could be different. Law No. 20 of 2016 on Trademarks, specifically Article 83, states that the owner of a registered trademark and the licensee of a registered trademark may file a lawsuit against other parties who unlawfully use a substantially or wholly similar trademark for similar goods and services (Wijayanti & Wauran, 2021). This lawsuit can be a lawsuit for damages and to stop all acts related to using the trademark. The lawsuit is filed with the Commercial Court (Suryadi, 2019). Law No. 20 of 2016 on Trademarks, specifically Article 84, states that while the case is still under consideration and in order to prevent more significant losses, the owner and licensee of the trademark as plaintiff may apply to the judge to stop the production, circulation, and trade of goods and services that use the trademark without right (Dwisvimiari, 2016). Suppose the defendant must deliver the goods that use the trademark without the right. In that case, the judge may order the delivery of the goods or the value of the goods to be implemented after the court decision has become a permanent legal effect (Syafira, 2016).

After conducting a study of the decision of the Commercial Court, the researcher found data that what makes the results of the decisions of these 2 (two) judicial institutions different is the action of MS Glow itself, which is considered to violate its trademark registered at the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia. The trademarks registered by MS Glow are "MS Glow for Cantik Skincare" and "MS Glow for Men". In its daily life, MS Glow does not use these trademarks but only the "MS Glow" trademark. Only the "MS Glow" trademark is registered under the CV name IDM000731102. KOSMETIKA CANTIK for class 32, namely for products in powdered tea drinks. Therefore, MS Glow is considered to have infringed its trademark and plagiarized the trademark PS Glow, which was officially registered as a cosmetic product in 2021.

The principle of *ne bis in idem* is a legal principle that prohibits a person from being brought to court for the second time for the same legal case (Alfarizi & Tien F, 2022). In other words, *ne bis in idem* is a case with the same object, parties and subject matter, decided by the court and, has permanent legal force (whether the decision is granted or denied), cannot be reviewed a second time. If someone files a lawsuit with the court and it turns out that the lawsuit contains *ne bis in idem*, the judge must declare the lawsuit inadmissible (*niet ontvankelijk verklaard*) (Lobo & Wauran, 2021). The following are the conditions for declaring an action *ne bis in idem* in civil law. These requirements are cumulative, meaning that if 1 (one) requirement is not met, the case cannot be classified as *ne bis in idem* (Haryadi, 2017).

The first requirement is that the subject matter of the lawsuit has been litigated before. Second, a legally binding court decision must be made on the previous case (*in-kracht*). Third, the case/dispute has been entirely resolved in the previous decision. Fourth, the position of the legal subject of the litigants is the same. Fifth, the object of the dispute is the same as in the previous case. The definition of the *Ne bis in Idem* principle is contained in the provisions of Article 1917 of the Civil Code, which reads "The power of a judge's decision that has obtained absolute power is not broader than just the subject of the decision ("Legal Protection of Famous Trademarks from Infringement of Trademarks / Counterfeit Trademarks in Medan (Study of Law No. 20 of 2016 concerning Trademarks and Geographical Indications)", 2021). The *Ne bis In Idem* principle aims to maintain legal certainty for those seeking justice and to prevent different decisions (dualism) for the same case. One of the conditions for a case to be *ne bis in idem* is that there has been a legally binding judgment in the previous case. In the civil sphere, a judgment is declared final (*in kracht*) if it is not appealed or caused within 14 (fourteen) days after the judgment is pronounced or after the judgment is notified to the absent party. This is in accordance with Article 195 HIR.

The prerequisite of a judge's ruling that is legally binding on the prior case is known as *ne bis in idem*, and it is not met by the Surabaya Commercial Court's decision involving the trademark dispute

between MS Glow and PS Glow. The fact that no appeal has been filed since 14 (fourteen) days after the verdict was made indicates that the decision of the Medan Commercial Court is legally binding (in-kracht). The fact that MS Glow filed a cassation shortly after the Surabaya Commercial Court's ruling was made indicates that the ruling is not yet legally enforceable.

### Conclusions

From the legal dispute between MS Glow and PS Glow concerning trademarks, two court decisions have emerged with opposing results: the Medan Commercial Court ruled in favour of MS Glow. In contrast, the Surabaya Commercial Court ruled in favour of PS Glow. Although both courts based their decisions on the same legal foundation, specifically articles 83 and 84 of Law number 20 of 2016 concerning Trademarks and Geographical Indications. After review and analysis, the two judicial institutions reached different decisions despite sharing the same legal basis. The discrepancy was due to an error on the part of MS Glow in its use of its own trademark. In daily life, MS Glow only uses the "MS Glow" trademark rather than the entire trademark. The registered trademarks for MS Glow are "MS Glow for Beautiful Skincare" and "MS Glow for Men".

It should be noted that the trademark "MS Glow" is solely registered under IDM000731102 on behalf of CV. KOSMETIKA CANTIK for class 32, which covers tea powder drinks. Due to this, MS Glow has infringed on its trademark and imitated the PS Glow trademark, officially registered as a cosmetic product in 2021.

The Surabaya Commercial Court's decision did not meet a requirement for a ne bis in idem case in civil law. Specifically, one of the prerequisites is that the court's decision must be legally binding (in Kracht). However, the Surabaya Commercial Court's decision has not been legally binding (in Kracht) since MS Glow filed for cassation shortly after the decision was issued. Thus, according to the researcher, no ne bis in idem condition is present in either of the two Commercial Court decisions.

### References

- Alfarizi, M., & Tien F, M. A. (2022, January 7). Harmonisasi Prinsip Perlindungan Merek Terkenal Konvensi Paris Dalam Undang - Undang Nomor 20 Tahun 2016 Tentang Merek Dan Indikasi Geografis. *Jurnal Pro Hukum : Jurnal Penelitian Bidang Hukum Universitas Gresik*, 10(2), 1–9. <https://doi.org/10.55129/Jph.V10i2.1589>.
- Dewi, S. (2022, September 30). Perlindungan Hukum Pemilik Merek Terdaftar Berdasarkan Undang-Undang Nomor 15 Tahun 2001 Tentang Merek. *Jurnal Ilmiah Hukum Dan Keadilan*, 9(2), 26–41. <https://doi.org/10.59635/Jihk.V9i2.219>.
- Dwisvimiari, I. (2016, November 27). Pengaturan Doktrin Dilusi Merek Sebagai Upaya Perlindungan Hukum Merek Terkenal Di Indonesia. *Mimbar Hukum - Fakultas Hukum Universitas Gadjah Mada*, 28(2), 232. <https://doi.org/10.22146/Jmh.16720>.
- Hastuti, I. (2019, May 3). Perlindungan Hukum Bagi Pemilik Merek Terkenal Berdasarkan Undang-Undang Nomor 20 Tahun 2016 Tentang Merek Dan Indikasi Geografis. *Hukum Dan Dinamika Masyarakat*, 16(2). <https://doi.org/10.36356/Hdm.V16i2.1026>.



- Haryadi, R. E. (2017, October 4). Perlindungan Hukum Bagi Pemegang Merek Terhadap Pelanggaran Merek Menurut Uu Merek Indonesia. *Yuriska: Jurnal Ilmiah Hukum*, 2(1), 124. <https://doi.org/10.24903/Yrs.V2i1.79>.
- Ida Laela, F. (2020, September 1). Analisis Kepastian Hukum Merek Terkenal Terdaftar Terhadap Sengketa Gugatan Pembatalan Merek. *Jurnal Ilmiah Hukum Dan Keadilan*, 7(2), 182–201. <https://doi.org/10.59635/Jihk.V7i2.38>.
- Lobo, L. P., & Wauran, I. (2021, January 31). Kedudukan Istimewa Merek Terkenal (Asing) Dalam Hukum Merek Indonesia. *Masalah-Masalah Hukum*, 50(1), 70–83. <https://doi.org/10.14710/Mmh.50.1.2021.70-83>.
- Mardianto, A. (2011, September 25). Akibat Hukum Pembatalan Pendaftaran Merek Terhadap Hak Penerima Lisensi Merek Menurut Uu No. 15 Tahun 2001. *Jurnal Dinamika Hukum*, 11(3). <https://doi.org/10.20884/1.Jdh.2011.11.3.174>.
- Perlindungan Hukum Terhadap Merek Terkenal Dari Tindakan Pelanggaran Merek/Merek Tiruan Di Medan (Studi Undang-Undang No. 20 Tahun 2016 Tentang Merek Dan Indikasi Geografis). (2021, September 30). *Iuris Studia: Jurnal Kajian Hukum*. <https://doi.org/10.55357/Is.V2i3.185>.
- Syafira, V. T. (2021, March 9). Perlindungan Hukum Bagi Pemegang Hak Merek Superman Terhadap Pelanggaran Merek. *Jurnal Suara Hukum*, 3(1), 85. <https://doi.org/10.26740/Jsh.V3n1.P85-114>.
- Suryadi, A. (2019, June 19). Pembatalan Merek Terdaftar Dihubungkan Dengan Asas Kepastian Hukum Bagi Pemilik Merek. *Aktualita (Jurnal Hukum)*, 2(1), 233–251. <https://doi.org/10.29313/Aktualita.V2i1.4688>.
- Wijayanti, A. W., & Wauran, I. (2021, September 30). Merek Tiga Dimensi Dalam Hukum Merek Indonesia. *Jurnal Bina Mulia Hukum*, 6(1), 19–33. <https://doi.org/10.23920/Jbmh.V6i1.354>.
- See, B. R. (2023, January 9). Perlindungan Hukum Bagi Konsumen Dan Pemegang Merek Terdaftar Dari Pemanfaatan Merek Terkenal. *Jurnal Hukum Caraka Justitia*, 2(2), 141. <https://doi.org/10.30588/Jhcj.V2i2.1403>.
- Syaifulloh, A. S. (2015, May 27). Analisa Hukum Putusan Nomor: 28/Merek/2011/Pengadilan Niaga Jakarta Sengketa Merek Antara Merek Calcimax Dengan Merek Calcimex. *Perspektif*, 20(2), 118. <https://doi.org/10.30742/Perspektif.V20i2.135>.

## Copyrights

Copyright for this article is retained by the author(s), with first publication rights granted to the journal.

This is an open-access article distributed under the terms and conditions of the Creative Commons Attribution license (<http://creativecommons.org/licenses/by/4.0/>).