



Analysis of Intellectual Property Rights Disputes Between PS Glow and MS Glow in View of Law No. 20 of 2016 Concerning Marks and Geographical Indications (Analysis of Decision of Case Number: 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Sby)

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Abstract

This study analyzes intellectual property rights disputes between PSGlow and MSGlow in terms of Law no. 20 of 2016 concerning Trademarks and Geographical Indications (analysis of case decision number: 2/pdt.sus.HKI/Merek/2022/pn.niaga Sby) which aims to explain and analyze the basic considerations of Surabaya Commercial Court judges in accepting lawsuits, explaining and analyzing how is the legal protection of trademarks that have been registered based on Law No. 20 of 2016 concerning Trademarks and Geographical Indications, explaining and analyzing whether there is an element of passing off between PS Glow and MS Glow based on Case Decision Number: 2/Pdt.Sus.HKI/Merek/2022/PN. Niaga Sby. The legal materials in this research are primary, secondary, and tertiary legal materials using normative research methods. The basis for consideration is that a lawsuit was filed from PS Glow for the use of the brand without rights against MS Glow. and legal protection for brands that have been registered under Law no. 20 of 2016 concerning Marks and Geographical Indications, namely that the penalties that will be imposed on these counterfeiters can be in the form of imprisonment, imprisonment and fines, as referred to in articles 100 to 102 of Law No. 20 of 2016 concerning Marks and Geographical Indications. and between PS Glow and MS Glow there is no element of passing off based on Case Decision Number: 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Sby, because the MS Glow brand registers its brand in HAKI in class 32 with the classification of powdered drinks and PS Glow registered their brand on Intellectual Property Rights in class 3 with a cosmetic classification.

Keywords: *IPR; Brand; Passing off*

Introduction

The rapid development of technology and trade today has caused activities in the trade sector to increase with a variety of goods and services found on the market. The goods and services produced are

the result of the ability of human creativity which can give rise to Intellectual Property Rights (IPR). Intellectual Property Rights are private rights for someone who produces an intellectual work. This is the hallmark of Intellectual Property Rights, a person is free to submit an application or register his intellectual work or not. The exclusive right given by the state to individual IPR actors (inventors, creators, designers and so on) is intended as a reward for the work and so that other people are stimulated to be able to further develop it. Besides that, (Krisnani Setowati, 2005). Basically Intellectual Property Rights (IPR) are closely related to other legal aspects, such as aspects of technology, economic aspects, and art. Intellectual Property Rights arise or are born because of the intellectuality of a person as the core or object of regulation, so the understanding of these rights is basically an understanding of property rights that arise or are born from human intellect (Farida Hasyim, 2009).

Over time, the House of Representatives has made many changes to laws and regulations, until finally the latest IPR Law is Law No. 13 of 2016 concerning Patents and Law no. 20 of 2016 concerning Brands and Geographical Indications.

Broadly speaking, IPR is divided into 2 categories, namely Copyright and Industrial Property Rights. Copyright is an exclusive right for creators or recipients of rights to announce or reproduce their creations or give permission for it without prejudice to restrictions according to applicable laws and regulations. While Industrial Property Rights are divided into several types, namely: Patents (Patent), Trademark (Trademark), Industrial Design (Industrial Design), Layout Design of Integrated Circuit (Layout Design of Integrated Circuit), Trade Secret (Trade Secret), Plant Variety (Plant Varieties).

In Indonesia, legal marks are regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications, a law that implements a constitutive registration system. According to the constitutive system with its doctrine of "prior in filling" that is entitled to a trademark is the party that registers the trademark, also known as the principle of "presumption of ownership". So the registration creates a right to the mark. The party that registers is the only one entitled to a mark and third parties must respect the rights of the registrant as absolute rights (Muhamad Djumhana and Djubaedillah, 2014). In this constitutive system, legal protection is based on the first applicant who has good faith. In the constitutive system, there is a great potential to determine legal certainty to condition who actually owns the mark that is most important to protect, legal certainty of proof, because it is only based on the fact of registration. Registration is the only main means of evidence, creating a legal allegation as to who the owner of the mark has the most rights with certainty, does not cause controversy between the first registrant and the first user. Juridically, a mark will receive protection after the trademark owner registers with the state, which in this case is represented by the Directorate General. Intellectual Property Rights under the Ministry of Law and Human Rights. Protection of trademark rights that are formally registered has a juridical effect that parties wishing to obtain trademark rights protection must follow a registration mechanism that has been determined formally, so that the nature of registration is mandatory in order to obtain trademark rights protection. This also means that brands that are not registered will not receive protection from the state, so that these marks can be used by everyone (the public) without permission from the first mark owner, because a mark that is not legally registered is still considered a mark of public property. public domain). Trademark rights are generally obtained through registration procedures, although in some countries there are also known unregistered trademarks which are protected under the common law tradition called equity. Protection of registered trademark rights must be based on the principle of good faith on the part of the trademark registrar, so that only trademark registrars who have good faith can only receive legal protection under the provisions of the Law on Trademarks and Geographical Indications (Abdulkadir Muhammad, 2010).

The problem that often occurs today is the widespread use of Marks without permission by piggybacking or piggybacking Brands that are well known or have a high reputation. This action is referred to as Passing Off, which is an action that instantly tries to take advantage by piggybacking by

imitating the property of another party who has a good reputation (Muhammad Djumhana and R. Djubaedillah, 2003).

Based on the background stated above, the authors are interested in researching and analyzing what are the basic considerations of the Surabaya Commercial Court judges in accepting lawsuits, how is the legal protection of trademarks that have been registered under Law no. 20 of 2016 concerning Brands and Geographical Indications, and is there an element of passing off between PS Glow and MS Glow based on Case Decision Number: 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Sby?

Method

The type of research used in this research is normative legal research. Normative research, namely that law is often conceptualized as what is written in statutory regulations (law in books) or law is conceptualized as rules or norms which are benchmarks for human behavior that are considered appropriate (Amiruddin and Zainal Asikin, 2014). Normative legal research is research that has legal rules and regulations as objects (Mukti Fajar ND and Yulianto Achmad, 2017). Normative legal research aims to find a clear legal basis in placing issues from a legal perspective. According to Muhaimin in his book "Legal Research Methods" defines normative legal research (legal research) is usually "only" a study of documents, namely using legal material sources in the form of statutory regulations, court decisions/decisions, contracts/agreement/contracts, theories law, and opinions of scholars (Muhaimin, 2020).

The approach method used to answer the problems in this study are; a) statutory approach, namely by examining laws and regulations related to the legal issue being studied, b) conceptual approach (conceptual approach), namely an approach that departs from legal concepts and doctrines developed in the science of law related to the legal issues to be studied and the case approach, which is carried out by examining cases related to the issues studied which have become court decisions that have permanent legal force (Peter Mahmud Marzuki, 2014).

Results and Discussion

1. Commercial Court Judge Considerations in Accepting Ps Glow's Lawsuit

a. Trademark Rights as Property Rights

Trademark rights are part of property rights. According to Jhon Locke, who taught the theory of property, brand rights are related to Human Rights, (Human Rights) with his famous statement: Life, Liberty and Property. John Locke made a statement that originally in the status of naturales (state of nature) there was a peaceful atmosphere and there was no positive law that divided the ownership or authority of a certain person to govern other people. It is a moral obligation for one's behavior towards others. Which obligation is imposed by God and it can be seen from various reasons. But then, the naturalist status could not be maintained, because the country lacks judges who can provide binding translations of natural law to resolve conflicts of interest between individuals. For this reason, the people form a status civiles (state of civilized) because their authority will provide a safeguard for natural rights that are not available in a naturalist status.

Meanwhile the concept of "Right, Ethic and State" developed by Friedrich Hegel basically states that as the existence of personality (The Existence of Personality), wealth among other material things, is a means by which a person can objectively express personal and single will. Hegel defends his concept of property by distinguishing between the function of the ease of choice of property institutions inherently at

the level of abstract rights from optimum evolution in ethical life. Personality as a force that gives the ability to recognize oneself and translate externally freedom to exist as an idea. Therefore, According to Hegel a property at a certain stage must become a private thing and private wealth becomes a universal institution. This is the basis for justifying IPR. These material rights are exclusive (single right), monopoly right and superior right. These three characteristics are basically a manifestation that whoever has IPR, he can act freely to use his rights and prohibit others without his permission from using those rights. monopoly (monopoly right) and the most superior (superior right). These three characteristics are basically a manifestation that whoever has IPR, he can act freely to use his rights and prohibit others without his permission from using those rights. monopoly (monopoly right) and the most superior (superior right). These three characteristics are basically a manifestation that whoever has IPR, he can act freely to use his rights and prohibit others without his permission from using those rights.

While Jean Jacques Rousseau said that the concept of property rights departs from natural rights. Property over a limited amount, which can be cultivated by a person is a sacred right, while unlimited property which was justified by John Locke and later became a rule in modern European societies, cannot be justified because this provision deprives the most people of every property in their entirety and by doing so is contrary to natural rights and the government which upholds this is truly unfair. Rousseau's concept emphasizes that property rights must function socially. Actually even in HKI, such a concept already exists. This is proven in Copyright with the concept of the principle of fair dealing (restrictions) adhered to in Law no. 19 of 2002 concerning Copyright. Likewise in Law no. 14 of 2001 concerning Patents, which recognizes the existence of a mandatory license. Both of these are basically aimed at providing an opportunity for other parties/people to use IPR which is exclusive, which tends to be monopoly.

Concepts such as copyrights and patents are also contained in trademark rights, although they are not the same, namely in the form of a brand license agreement, because the trademark license agreement is basically also to provide an opportunity for other parties/people to use brand rights without violating the exclusive rights of the brand. .

Regarding the concept of a brand as property, Jeremy Bentham argues that all property rights and government rights are based on the principle of greatest utility or happiness for mankind, happiness which is measured by the amount of pleasure that exceeds suffering. The IPR concept views that Bentham's intended use is manifested in the various benefits of ownership of an intellectual property right that is beneficial to humans in social life. For example, trademark rights are useful for differentiating between similar goods and or services, so that they greatly assist entrepreneurs in producing and marketing branded goods and or services. Jeremy Bentham's concept emphasizes more on function and benefits.

John Locke's thoughts contained in the labor theory of property and the utilitarian doctrine stated that objects produced by a person through a combination of labor and resources are the property of that person. Even so, this theory has limitations, namely there is no limit to the number of property rights that can be owned by someone as long as it will not harm other people. While the utilitarian doctrine seeks to maximize group welfare. The doctrine says that IPR compensates those who produce intellectual works. On the other hand, without IPR, intellectual works will be easily pirated and this will extinguish the motivation of the inventor/creator to produce intellectual works intended for the future.

This utilitarian doctrine is in line with Article 27 paragraph (1) of the Universal Declaration of Human Rights which states, "everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits." emphasized that everyone has the right to enjoy intellectual works, so it will be very important to gain access to the commodities that affect the lives of many people. The granting of an IPR must pay attention to improving

the welfare of the community, so that in granting an IPR application it must take into account the welfare of the community and not assign all intellectual works to the same level of protection.

In principle, brand rights as part of IPR are generated and developed on the basis of deep thought and great expense. Therefore, legal protection for trademark rights owners is seen as something reasonable. Reward theory states that the legal protection given to brand rights owners is synonymous with rewards. This award is manifested in the form of protection for brand owners against anyone who violates their trademark rights. While the incentive theory states that the award will provide a stimulus for the parties to create new, more innovative intellectual works.

The exclusive rights in the form of monopoly rights have been fully guaranteed in Article 50b of Law no. 5 of 1999 concerning the prohibition of Monopolistic Practices and Unfair Business Competition, which expressly states, "What is excluded from the provisions of this law are agreements relating to intellectual property rights such as licenses, patents, trademarks, copyrights, industrial product designs, integrated electronic circuits, and trade secrets, and agreements related to franchising". In trademark rights, because they are intellectual property rights, the benefits are not only felt by the owner, but also the wider community (Agung Sujatmiko, 2011).

b. Judge's Considerations in Accepting PS Glow's Lawsuit

The plaintiff with his lawsuit letter dated April 5 2022 which was registered with the Registrar of the Commercial Court at the Surabaya District Court on April 12 2022 in the case register Number 2/Pdt.SusHKI/Merek/2022/PN.Niaga Sby, has filed a lawsuit for the use of a brand without rights, by stating the following:

1. Whereas the legal position of each party in the dispute over the illegal use of a mark which is similar in principle to a registered mark for similar goods and/or services, is as follows:
 - THE PLAINTIFF was formerly named PT. PSGLOW COSMETICS INDONESIA is a company incorporated under the laws of the Republic of Indonesia engaged in the cosmetics business;
 - ACCUSED I is a company that has produced Class 3 cosmetic products (cosmetics) with the trademark "MS GLOW" for the benefit of ACCUSED II;
 - ACCUSED II is a company that has ordered and distributed/circulated Class 3 products (cosmetics) using the trademark "MS GLOW" whose production is carried out by ACCUSED I;
 - ACCUSED III is an individual legal subject who previously served as a director and is responsible for the business activities of ACCUSED I and ACCUSED II in producing and/or marketing/circulating Class 3 cosmetic products (cosmetics) using the trademark "MS GLOW";
 - ACCUSED IV is an individual legal subject who so far claims to have given permission and authority to ACCUSED I and ACCUSED II to produce and/or market Class 3 cosmetic products (cosmetics) using the trademark "MS GLOW";
 - ACCUSED V is an individual legal subject who currently serves as director and is responsible for the business activities of ACCUSED I which still produces Class 3 cosmetic products (cosmetics) with the trademark "MS GLOW";
 - ACCUSED VI is an individual legal subject who currently serves as director and is responsible for the business activities of ACCUSED II which still orders and distributes/distributes Class 3 cosmetic products (cosmetics) with the trademark "MS GLOW";

2. Whereas the PLAINTIFF as the right holder for the use of the Class 3 cosmetic product trademark based on the product classification registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia has been advertising and marketing cosmetic products, which among others use the trademark "PS GLOW" and the trademark "PSTORE GLOW", where the use of each of these trademarks is in accordance with applicable law;
3. Whereas it turned out that ACCUSED I, when his business activities were still led and under the responsibility of ACCUSED II as the director, was found to have produced Class 3 cosmetic products with the trademark "MS GLOW" on the orders of ACCUSED II which was originally also led and under the responsibility of ACCUSED II as the director;
4. That the use of the trademark "MS GLOW" for Class 3 cosmetic products manufactured and/or marketed by ACCUSED I and ACCUSED II in fact has the same principal as the trademarks "PS GLOW" and "PSTORE GLOW" for goods and/or similar services legally used by the PLAINTIFF according to legal provisions; whereas the PLAINTIFF has never given any permission and/or approval for the use of the trademark "MS GLOW" by the DEFENDANTS which is similar in principle to the trademarks "PS GLOW" and "PSTORE GLOW" used by the PLAINTIFF;
5. Whereas in fact the use of the "MS GLOW" trademark by the DEFENDANT which has the same principality as the "PS GLOW" and "PSTORE GLOW" trademarks used by the PLAINTIFF was based on the granting of permission from ACCUSED IV, while ACCUSED IV had absolutely no rights or authority over the "MS GLOW" trademark;
6. Whereas ACCUSED I, whose management is currently under the responsibility of ACCUSED V, has replaced ACCUSED III as director since the change in position that occurred on October 6, 2021 until now, is still producing Class 3 cosmetic products with the trademark "MS GLOW", so that ACCUSED V should be legally responsible for the use of the "MS GLOW" mark which is similar in principle to the "PS GLOW" and "PSTORE GLOW" trademarks used by the PLAINTIFF; Likewise, ACCUSED II, whose management is currently under the responsibility of ACCUSED VI, replaced ACCUSED III as a director based on the replacement of the position of directors since December 30, 2021 until now, still ordering and distributing Class 3 cosmetic products with the trademark "MS GLOW" so that ACCUSED VI would be legally responsible for the use of the "MS GLOW" brand which is similar in principle to the "PS GLOW" and "PSTORE GLOW" trademarks used by the PLAINTIFF;
7. That based on the provisions of Article 83 paragraph (1) of the Law of the Republic of Indonesia Number 20 of 2016 concerning Marks and Geographical Indications reads: "Registered Mark owners and/or registered Mark Licensee may file a lawsuit against other parties who unlawfully use a Mark that has the same in principle or in whole for similar goods and/or services in the form of:
 - a. compensation claim;
 - b. termination of all actions related to the use of the Mark.

Thus, the PLAINTIFF has the legal right to file this lawsuit and demand compensation and / or demands for termination of activity using the "MS GLOW" brand which is similar in principle to the trademarks "PS GLOW" and "PSTORE GLOW" used by the PLAINTIFF;

8. Whereas the actions of the DEFENDANTS who without rights have used the trademark "MS GLOW" which is similar in principle to similar products with the trademarks "PS GLOW" and "PSTORE GLOW" used by the PLAINTIFF are very detrimental to the PLAINTIFF, where to enlarge these trademarks the PLAINTIFF has financed the advertising process which spent a lot of money, however, the DEFENDANTS directly or indirectly benefited from the similarity of trademarks that were used without these rights, namely in the form of cosmetic product sales

- turnover of Rp. 600,000,000,000.- (six hundred billion rupiah) every month or the equivalent of Rp. 3,600,000,000,000.- (three trillion six hundred billion rupiah) within 6 (six) months; Therefore, for the violation in the form of the unauthorized use of the MS GLOW brand which has a resemblance in principle to the brand used by the PLAINTIFF, it is appropriate and reasonable if the PLAINTIFF demands compensation from the DEFENDANTS jointly and severally in the amount of Rp. 360,000,000,000.- (three hundred sixty billion rupiah) in cash and immediately, namely the value of 10% (ten percent) of the turnover of 6 (six) months which is calculated as a fee for the benefits of using the trademark which has been heavily advertised by the PLAINTIFF with no small cost;
9. That apart from compensation for the use of a trademark that is similar in principle to the trademark used by the PLAINTIFF, it is appropriate and reasonable for the PLAINTIFF to demand the cessation of all actions related to the use of the trademark "MS GLOW" which is similar in principle to the trademark "PS GLOW" and "PSTORE GLOW" trade includes but is not limited to production, distribution and trading of all cosmetic products with the brand "MS GLOW" within the jurisdiction of the Republic of Indonesia accompanied by DWANGSOM of Rp. 1,000,000,000 (one billion rupiah) for each day of delay by the DEFENDANTS in carrying out the termination of said activity;
 10. Whereas in order to avoid an illustrative decision, it seems reasonable that the PLAINTIFF requests the placement of collateral for the assets of the DEFENDANTS to pay legal obligations based on the decision of this case, the type and amount of which will be specifically requested in court;
 11. Whereas because this lawsuit was filed as a result of the actions of the DEFENDANTS who were considered to be against the law for the use of a mark without rights, it seems reasonable enough if the DEFENDANTS were sentenced to pay court fees;

In general, the principle of *nebis in idem* is known in Indonesian procedural law. Based on Article 1917 of the Civil Code (KUHPer) it states that a case with the same object, parties and subject matter that has been decided by a court and has permanent legal force (*inkracht*) cannot be examined or filed again for a second time. This is to ensure that there are no two or more different court decisions regarding the same case. However, the most important thing in applying the principle of *nebis in idem* is that a court decision has permanent legal force.

Things to watch out for in the PS Glow and MS Glow cases, the lawsuit filed by PT. PSTORE GLOW BERSINAR INDONESIA at the Surabaya Commercial Court was carried out when the case at the Medan District Court regarding the same case was still under examination, namely on April 12, 2022 while the decision at the Medan Court was dated June 13, 2022. This means that no decision has been issued from the Court Niaga Medan on April 12, 2022 against the same case. This causes the principle of *nebis in idem* not to apply to this case when it is filed at the Surabaya Commercial Court.

2. Legal Protection of Trademarks That Have Been Registered Under Law No. 20 of 2016 concerning Brands and Geographical Indications

Law Number 20 of 2016 Concerning Trademarks and Geographical Indications defines a mark as 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) dimensions and or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more of these elements to differentiate goods and/or services produced by legal entities in trading activities of goods and/or services. So a brand can be just an image, just a word, just a letter, just a number or a combination of these elements.

Protection of a mark or rights to a mark is an exclusive right granted by the State to owners of registered marks in the general register of marks. For a certain period of time, the holder of the rights to the mark can use the mark himself or give permission to someone, several people jointly or a legal entity to use it. Protection of registered marks, namely the existence of legal certainty over registered marks, both for extended use and as evidence in the event of a dispute over the implementation of a registered mark.

Legal protection applies to intellectual property rights that have been registered and proven by a registration certificate. Legal protection lasts for a period of time determined according to the field and classification. If people want to enjoy economic benefits from other people's intellectual property rights, they must obtain permission from the rightful person. Protection of trademark rights is only given to trademark owners whose trademarks have been registered. Trademark protection is provided when there is a trademark infringement committed by a party that does not have the rights to a mark.

Intellectual property legal protection is a legal system consisting of the following system elements (Hery Firmansyah, 2011):

1. Protection subject
2. Protection object
3. Protection registration
4. Protection period
5. protective legal action.

This protection is guaranteed in Article 21 of the 2016 Trademark Law concerning Marks and Geographical Indications namely:

1. The application must be rejected by the Directorate General if the mark:
 - a) having similarities in substance or in whole with the mark of another party which has been previously registered for similar goods and/or services
 - b) having similarities in principle or in whole with well-known brands
 - c) having similarities in substance or in whole with known geographical indications.
2. The provisions referred to in paragraph (1) letter b can also be applied to goods and/or services that are not of the same type as long as they meet certain requirements which will be further stipulated in a Government Regulation.
3. The application must also be rejected by the Directorate General if the mark:
 - a) constituting or resembling the name of a famous person, photo, or name of a legal entity owned by another person, except with the written consent of the person entitled.
 - b) constitutes an imitation or resembles a name or abbreviation of a name, flag, symbol or symbol or emblem of a state or national or international institution, except with written approval from the competent authority.
 - c) constituting an imitation or resembling an official sign or stamp or stamp used by a state or government agency, except with written approval from the competent authority.

The imposition of legal sanctions is part of an effort to provide legal protection for legal mark owners. If the mark has been registered, it will receive legal protection. Law no. 20 of 2016 concerning Trademarks and Geographical Indications has also provided a set of criminal law provisions that function to protect brand owners and consumers from fraudulent acts by counterfeiters/copycats who have the negative aim of taking advantage of the losses of brand owners and consumers by counterfeiting/copying traded on the market. The penalties that will be imposed on the counterfeiters can be in the form of

imprisonment, imprisonment and fines, as referred to in Articles 100 to 102 of Law No. 20 of 2016 concerning Marks and Geographical Indications

3.Elements of Passing Off Between Ps Glow and Ms Glow Based on Decision on Case Number: 2/PDT.SUS.HKI/Merek/2022/PN.Niaga SBY

pass offis an act of trying to gain profits through shortcuts in all kinds of ways and pretexts by violating business ethics, moral norms, and the law. This action usually occurs by copying or resembling the property of another person who has a good reputation (good will).Lindsey Tim, 2013).

The Chronology of the PS Glow and MS Glow Cases Based on the Decision on Case Number: 2/Pdt.Sus.Hki/Merek/2022/Pn.Niaga Sby is as follows PT. PSGLOW COSMETICS INDONESIA is a legal entity established according to the laws of the Republic of Indonesia engaged in the cosmetics business. As the rights holder, PT. PSGLOW COSMETICS INDONESIA based on the classification of class 3 cosmetic products that have been registered with the Directorate General of Intellectual Property Rights of the Ministry of Law and Human Rights of the Republic of Indonesia which has advertised and marketed cosmetic products, including using the PS GLOW trademark as well as the PSTORE GLOW trademark, for the use of the trademark PT. PSGLOW COSMETICS INDONESIA complies with applicable law. Meanwhile, MS GLOW is a beauty brand under PT. INDONESIAN BEAUTIFUL COSMETICS was founded in 2013. In carrying out its business PT. KOSMETIKA CANTIK INDONESIA adopts the MS GLOW mark which is similar to that of PT. PSGLOW COSMETICS INDONESIA, namely PS GLOW and the trademark PSTORE GLOW.

Therefore, the trademark has been disputed by both parties who feel that PT. KOSMETIKA BEAUTIFUL INDONESIA by using the MS GLOW trademark has violated the intellectual property rights of PT. PSGLOW COSMETICS INDONESIA because it is considered to have harmed the company where to raise the trademark PT. PSGLOW COSMETICS INDONESIA has financed the advertising process which has spent a lot of money, but PT. KOSMETIKA BEAUTIFUL INDONESIA has directly or indirectly benefited from the similarity of trademarks that are used without rights, namely in the form of cosmetic product sales turnover of IDR 600,000,000,000 (six hundred billion rupiah) every month or the equivalent of IDR 3,600,000,000 000,- (three trillion hundred six hundred billion rupiah) within 6 (six) months.

Therefore, for the violation in the form of unauthorized use of the MS GLOW brand which has a resemblance in principle to the brand used by PT. PSGLOW COSMETICS INDONESIA is appropriate and reasonable if PT. PSGLOW COSMETICS INDONESIA demands compensation against PT. INDONESIAN BEAUTIFUL COSMETICS jointly and severally in the amount of Rp. 360,000,000,000.- (three hundred sixty billion rupiah) in cash at the same time, namely the value of 10% (ten percent) of the turnover of 6 (six) months which is calculated as a fee for the benefits of using the trademark which has been heavily advertised by PT . PSGLOW COSMETICS INDONESIA at no small cost.

Apart from compensation for the use of trademarks which are basically the same as the trademarks used by PT. PSGLOW COSMETICS INDONESIA, it is appropriate and reasonable if PT. PSGLOW COSMETICS INDONESIA demands the cessation of all actions related to the use of the MS GLOW trademark which is basically the same as the PS GLOW and PSTORE GLOW trademarks including but not limited to production, distribution and trading of all cosmetic products with the MS GLOW brand in jurisdictions The Republic of Indonesia accompanied by a dwangsom of Rp. 1,000,000,000 (one billion rupiah) for every day PT. KOSMETIKA BEAUTIFUL INDONESIA in carrying out the termination of these activities.

There are similarities in principle or overall in the case between PS GLOW and MS GLOW. Where there are doctrines that can be used in determining the presence or absence of brand similarities, namely the enteritis similar doctrine and the nearly resembles doctrine. The enteritis similar doctrine assumes that the equality of all elements is standard, in this case the mark requested to be registered is a replica of another person's mark. Meanwhile, the nearly resembles doctrine considers a brand to have similarities in principle with other people's brands if the brand has similarities (identical) or is almost similar to other people's brands, which can be based on image similarities, word order, color or sound. The most important factor in this doctrine is the use of brands that have similarities in essence, this can cause real confusion or mislead the consumer public. It is as if the brand comes from the same source or manufacturer, so that it shows an element of bad faith to piggyback on someone else's fame.¹

In the case of PS Glow vs MS Glow, the brand registered by the Defendant was "MS GLOW FOR CANTIK SKINCARE" in the cosmetic class. Meanwhile, in the practice of running a business, the brand that is often used is MS GLOW where this brand is actually registered in Intellectual Property Rights in class 32 with the classification of powdered drinks. Referring to the expert testimony in the decision of the Surabaya Commercial Court, namely Dr. Suyud Margono and Adi Sopanto, a mark cannot be protected if only a fragment is used and its use must also be in accordance with the class registered. Therefore, the Defendant should use the brand "MS GLOW FOR CANTIK SKINCARE" if he wants to carry out business activities in the cosmetic class. Furthermore, the brands owned by the Plaintiff, namely "PS GLOW" and "PSTORE GLOW", have been registered in the cosmetic class. In accordance with the trademark law, a mark may not have the same basic characteristics as other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow.

Regarding the same shape, the composition of PS GLOW's writing is similar to MS GLOW, and also on the PS GLOW MEN brand there is a resemblance to MS GLOW FORMEN from the writing style. So it can be seen as a whole that PS GLOW and MS GLOW have similarities based on the style of writing, the sound of words, and the composition of the writing so that when aligned it can cause real confusion or mislead consumers or the public who use it as if the brand is from a different manufacturer. same. Based on material data at the Directorate General of Intellectual Property Rights, PS GLOW registered its trademark on August 11, 2021 with No. Applicant DID2021053069 is in class 3, while MS GLOW registered its mark on September 20 2016 with No. Applicant D002016044408 in class 3, so that based on the constitutive system in force in Indonesia, MS GLOW is entitled to the trademark because MS GLOW was the first to register the trademark, thus PS GLOW has an element of bad faith by piggybacking on MS GLOW's fame. based on the author's analysis, the author's opinion differs from the decision of the Surabaya Commercial Court which stated that PS GLOW has exclusive rights to the use of the PS GLOW trademark and the PSTORE GLOW trademark which are registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia for the type of goods / services class 3 (cosmetics). So it is appropriate for the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to cancel the trademark rights of PS GLOW. based on the author's analysis, the author's opinion differs from the decision of the Surabaya Commercial Court which stated that PS GLOW has exclusive rights to the use of the PS GLOW trademark and the PSTORE GLOW trademark which are registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia for the type of goods / services class 3 (cosmetics). So it is appropriate for the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to cancel the trademark rights of PS GLOW. based on the author's analysis, the author's opinion differs from the decision of the Surabaya Commercial Court which stated that PS GLOW has exclusive rights to the use of the PS GLOW

¹Insan Budi Maulana, Protection of Famous Brands from Time to Time, 1st Printing, Citra Aditya Bhakti, Bandung, 1999, p. 34.

trademark and the PSTORE GLOW trademark which are registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia for the type of goods / services class 3 (cosmetics). So it is appropriate for the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to cancel the trademark rights of PS GLOW. The author's opinion differs from the decision of the Surabaya Commercial Court which states that PS GLOW has exclusive rights to the use of the PS GLOW trademark and the PSTORE GLOW trademark which is registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia for class 3 types of goods/services (cosmetics). So it is appropriate for the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to cancel the trademark rights of PS GLOW. The author's opinion differs from the decision of the Surabaya Commercial Court which states that PS GLOW has exclusive rights to the use of the PS GLOW trademark and the PSTORE GLOW trademark which is registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia for class 3 types of goods/services (cosmetics). So it is appropriate for the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to cancel the trademark rights of PS GLOW.



Based on the picture above, you can see the similarities between the two brands, namely MS GLOW and PS GLOW:

1. Both use the letter logo, which stands for the brand owner's name, then the word "Glow" is added.
2. Both of them released the "Whitening Series" product (for women), with the predominant gray color packaging.
3. Both of them released products for men, which consisted of Facial Wash, Cream, and Serum.
4. Both released "Red Jelly" products, but with different ingredients.
5. *Facial Wash*(for women) both use gray bottle packaging with a pump on the lid.



Equation of second the logo can be seen from the line under the letter "E" in the word "MEN", so that it can mislead consumers that the product is from the same manufacturer.

Conclusion

The basis for the consideration of the judges at the Surabaya Commercial Court in accepting PS Glow's lawsuit was that PS Glow filed a lawsuit against MS Glow for the use of the trademark without rights, and the lawsuit filed by PT. PSTORE GLOW BERSINAR INDONESIA at the Surabaya Commercial Court was carried out when the case at the Medan District Court regarding the same case was still under examination, namely on April 12, 2022 while the decision at the Medan Court was dated June 13, 2022. This means that no decision has been issued from the Court Niaga Medan on April 12, 2022 against the same case. This causes the principle of *nebis in idem* not to apply to this case when it is filed at the Surabaya Commercial Court. Legal protection for trademarks that have been registered under Law no. 20 of 2016 concerning Marks and Geographical Indications, namely providing legal certainty over registered marks, both for extended use and as evidence in the event of a dispute over the implementation of a registered mark. The imposition of legal sanctions is part of an effort to provide legal protection for legitimate trademark owners. If the mark has been registered, it will receive legal protection. The element of passing off between PS Glow and MS Glow is based on the decision of case number: 2/PDT.SUS.HKI/MEREK/2022/PN.NIAGA SBY, namely in the case of PS Glow vs MS Glow, that the brand registered by the Defendant is "MS GLOW FOR BEAUTIFUL SKINCARE" in cosmetic class. Meanwhile, in the practice of running a business, the brand that is often used is MS GLOW where this brand is actually registered in Intellectual Property Rights in class 32 with the classification of powdered drinks. Referring to the expert testimony in the decision of the Surabaya Commercial Court, namely Dr. Suyud Margono and Adi Sopanto, a mark cannot be protected if only a fragment is used and its use must also be in accordance with the class registered. Therefore, the Defendant should use the brand "MS GLOW FOR CANTIK SKINCARE" if he wants to carry out business activities in the cosmetic class. Furthermore, the brands owned by the Plaintiff, namely "PS GLOW" and "PSTORE GLOW", have been registered in the cosmetic class. In accordance with the trademark law, a mark may not have the same basic characteristics as other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow. Suyud Margono and Adi Sopanto, a mark cannot be protected if only a fragment is used and its use must also be in accordance with the class registered. Therefore, the Defendant should use the brand "MS GLOW FOR CANTIK SKINCARE" if he wants to carry out business activities in the cosmetic class. Furthermore, the brands owned by the Plaintiff, namely "PS GLOW" and "PSTORE GLOW", have been registered in the cosmetic class. In accordance with the trademark law, a mark may not have the same basic characteristics as other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow. Suyud Margono and Adi Sopanto, a mark cannot be protected if only a fragment is used and its use must also be in accordance with the class registered. Therefore, the Defendant should use the brand "MS GLOW FOR CANTIK SKINCARE" if he wants to carry out business activities in the cosmetic class. Furthermore, the brands owned by the Plaintiff, namely "PS GLOW" and "PSTORE GLOW", have been registered in the cosmetic class. In accordance with the trademark law, a mark may not have the same basic characteristics as other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow. Therefore, the Defendant should use the brand "MS GLOW FOR CANTIK SKINCARE" if he wants to carry out business activities in the cosmetic class. Furthermore, the brands owned by the Plaintiff, namely "PS GLOW" and "PSTORE GLOW", have been registered in the

cosmetic class. In accordance with the trademark law, a mark may not have the same basic characteristics as other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow. a mark may not have similarities in its essence with other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow. a mark may not have similarities in its essence with other trademarks. The decision of the Surabaya Commercial Court also stated that the holder of the exclusive rights to the brand was PS Glow.

References

- Agung Sujatmiko, *Jurnal Media Hukum Tinjauan Filosofis Perlindungan Hak Milik Atas Merek*, Yogyakarta, Desember 2011.
- Amiruddin dan Zainal Asikin, *Pengantar Metode Penelitian Hukum*, Ed. 1, Cet.VIII,PT. Raja Grafindo Persada, Jakarta, 2014.
- Farida Hasyim, *Hukum Dagang*, Sinar Grafika, Jakarta, 2009.
- Hery Firmansyah, *Perlindungan Hukum terhadap Merek*, Pustaka Yustisia, Yogyakarta, 2011.
- Insan Budi Maulana, *Perlindungan Merek Terkenal dari Masa ke Masa*, Cetakan ke-1, Citra Aditya Bhakti, Bandung, 1999.
- Krisnani Setowati, Efridani, dkk, *Hak Kekayaan Intelektual Dan Tantangan Implementasinya Di Perguruan Tinggi*, Kantor Hak Kekayaan Intelektual, Institut Pertanian Bogor, 2005.
- Lindsey Tim dkk, *Hak Kekayaan Intelektual*, PT. Alumni, Bandung, 2013.
- Muhaimin, *Metode Penelitian Hukum*, Mataram University Press, Mataram, 2020.
- Muhammad Djumhana dan R. Djubaedillah, *Hak Milik Intelektual (Sejarah, Teoridan Prakteknya di Indonesia) Edisi Revisi*, Citra Aditya Bakti, Bandung, 2003.
- Peter Mahmud Marzuki, *Penelitian Hukum*, Edisi Revisi, Kencana, Jakarta. 2014.

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