

LEGAL PROTECTION OF FAMOUS TRADEMARK DISPUTES REGISTERED UNDER THE LAW (CASE OF POLO BY RALPH LAUREN TRADEMARK DISPUTE)**Tati Sri Hardina**

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Abstract : Trademarks are signs in the form of images, names, words, letters, numbers, color arrangements, or combinations of these elements that have distinguishing power and are used in trading activities for goods or services. A well-known brand is a brand that has a high reputation. This brand has the power of radiance that is mesmerizing and attractive, so that the type of goods under the brand immediately raises a touch of *familiarity* (*familiar*) and *mythical* ties (*mythical context*). The research method used is normative juridical, namely library law research conducted by examining library materials or secondary data. Protection of trademark rights in Indonesia constitutively adheres to the *first to file* system, *first to file trademark* protection system or constitutive system is a system of protection of a trademark in which the party who first applied for registration to the trademark office, then become the first party who has rights to the trademark. Of course, without exception, every application for trademark registration must pass the substantive examination process by the Trademark Examiner. In the substantive examination, it will be decided whether the person or legal entity is entitled to the trademark rights they apply for or the application for trademark rights is rejected. In order for the trademark to be protected by law.

Keywords: *Legal Protection, Trademark Disputes, Famous Trademarks*

I. INTRODUCTION**1. Background**

The definition of a trademark as defined in the provisions of Article 1 number 1 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications that a trademark is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions or 3 (three) dimensions, sound, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and or services produced by persons or legal entities in trading activities of goods and or services. A trademark must have distinguishing power and be used in the trade of goods or services. In practice, marks are used to build consumer loyalty. This can often be considered a more "strategic" protection in business.

The concept of trademark ownership in Indonesia contains the principle of "*First to File*" which means that trademark protection will arise if the trademark owner has registered it first to the Directorate General of Intellectual Property at the Ministry of Law and Human Rights. Trademark legislation in Indonesia requires it to the trademark owner to obtain legal protection and also as a basis for preventing other parties from using registered trademarks unlawfully.

Based on the concept of trademark registration, the trademark owner obtains legal protection right when the trademark is declared registered by the Directorate General of Intellectual Property at the Ministry of Law and Human Rights. Therefore, other parties who attempt to hijack the name of a registered trademark will be subject to criminal sanctions and fines in accordance with Law No. 20 Year 2016 on Trademarks and Geographical Indications.

The concept of trademark registration in Indonesia based on the principle of "*First to File*" when reviewed comprehensively there is a legal vacuum. Because the application of the principle of "*First to File*" yang gives exclusive rights to the first registrant of a trademark also affects the first trademark user and the actual owner but has not registered in Indonesia. The actual owner of the trademark can be replaced by another party who has first registered the trademark. This results in when the actual trademark owner will register his trademark it will be hindered by a registered trademark belonging to the party who has first registered the brand name. Finally, this will harm the trademark owner who has been running a business using the brand name.

In this case, the Directorate General of Intellectual Property is a unit that provides intellectual property services. The rightful trademark owner will get a trademark certificate as well as a trademark registration number recorded in the General Register of Trademarks. By having a certificate of trademark means is evidence

of ownership of trademark rights. In the constitutive system of trademark rights obtained through registration, meaning that the exclusive rights to a trademark is given because of the registration. So it can be said that trademark registration is an absolute right, because the trademark is not registered, will not get legal protection. The *first to file* principle does not apply absolutely because it can be challenged through a trademark cancellation lawsuit if it can be proven that the trademark should not be registered or refused registration, including due to bad faith.

In the history of trademark legislation in Indonesia, it can be noted that during the Dutch colonial period, the *Reglement Industriële Eigendom* (RIE) contained in Stb. 1912 No. 545 Jo.Stb.1912 No. 214, which became a reference for the regulation of trademarks. After Indonesia's independence, this regulation was also declared to continue to apply based on Article II of the Transitional Rules of the 1945 Constitution. This provision continued to apply, until finally in 1961 the provision was replaced by Law Number 21 Year 1961 on Company Marks and Trademarks promulgated on October 11, 1961. Afterwards, Law No. 19 of 1992 on "Trademarks" was enacted, further updated in 1997 with Law No. 14 of 1997 and finally replaced with Law No. 15 of 2001 on Trademarks. Currently, it has changed with the enactment of Law Number 20 Year 2016 on Trademarks and Geographical Indications. So, the protection of trademarks in Indonesia has long been applied even since the days of the Dutch East Indies has implemented a trademark protection system.

Law No. 20/2016 on Trademarks and Geographical Indications (Trademark Law) defines a trademark as a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and / or 3 (three) dimensions, sound, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and / or services produced by persons or legal entities in trading activities of goods and / or services (Article 1 paragraph 1 of the Trademark Law)." It is important to remember that a trademark must be different from existing trademarks in order to be registered. For brands that claim to be well-known brands, they must be able to provide evidence. In addition to the national legislation on trademark society is also bound by international trademark regulations such as the Paris Union Convention held on March 20, 1883, which was specifically held to provide protection to industrial property rights. In this convention Indonesia is a member of Indonesia is automatically bound to the rules in the convention.

Legal Protection of Trademark According to Act No. 20 Year 2016 on MIG is a registered trademark gets protection for a period of 10 (ten) years from the date of receipt and can be extended for the same period. The purpose of the extension of the registered trademark is to ensure that the registered trademark is actually used on goods or services that still have to be produced and / or traded, it is because the Trademark Act and MIG does not provide legal protection against trademarks that are registered but not used in the trading activities of goods and services. The approved application for change of name and/or address will be notified in writing within a maximum period of 15 (fifteen) days from the date of recording the change of name and/or address.

Trademark is a trademark right that has a special nature (*exclusive*) granted by the state to the trademark owner to use the trademark itself or give permission to others to use it. Trademark attached to an industrial product can be considered as a sign to identify the origin of goods and services (*an indication of origin*) of a company with goods and / or services of other companies. Trademark is the spearhead of trade in goods and services, because through the trademark every entrepreneur can maintain and provide a *guarantee of quality (a guarantee of quality) of goods and / or services* produced and prevent acts of dishonest competition from other entrepreneurs who intend to piggyback on reputation. Trademarks can also be used as a means of *marketing and advertising (a marketing and advertising device)* that provides certain information to consumers about a good and / or service.

Brands not only have a function as a differentiator of a product with other products, but the brand also functions as a company asset that is priceless, especially for brands that have a well-known predicate (*well-known marks*), but the brand has the ability as a sign that can distinguish the results of one company with other companies in the market, both for similar and dissimilar goods or services. In Indonesia, trademarks are juridically regulated in Law Number 20 Year 2016 on Trademarks and Geographical Indications (hereinafter simply called the Trademark and Geographical Indications Law). Trademarks juridically will get protection after the trademark owner registers with the state which in this case is represented by the Directorate General of Intellectual Property Rights under the Ministry of Law and Human Rights. Protection of trademark rights are formally registered has given juridical effect that, the parties who want to get the protection of trademark rights must follow the registration mechanism that has been determined formally, so that the nature of registration is mandatory (*compulsory*) to obtain the protection of trademark rights. This also means that unregistered trademarks will not get protection from the state, so that the trademarks can be used by everyone (the public) without the permission of the first trademark owner, because the trademark is not juridically registered is still considered as a *public domain trademark*.

Article 21 paragraph (3) of the Trademark Law states that "an application for registration of a trademark is refused if the trademark is or resembles the name or abbreviation of the name of a famous person,

photograph, or name of a legal entity owned by another person, except with the written consent of the entitled person.". Law Number 20 Year 2016 on Trademarks and Geographical Indications unfortunately has not clearly regulated the meaning of "name of a famous person" in Article 21 paragraph (3). There is no definite benchmark in the law regarding what criteria for a person's name to be considered a "famous person's name". In the explanation of Trademark Law Article 21 paragraph (3), there is only an explanation related to what is meant by "the name of a legal entity" is the name of a legal entity used as a trademark and registered.

The definition of a well-known trademark based on Article 1 number 1 of Law No. 20 Year 2016, the definition of Trademark is: "signs that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and / or 3 (three) dimensions, sound, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and / or services produced by persons or legal entities in trading activities for goods and / or services".

Based on these provisions there are several elements in the trademark, namely: (a) Sign, (b) Has a distinguishing power, (c) Used for trade in goods and or services. A mark can be called a trademark if it meets the absolute requirements of the existence of sufficient *distinguishing power (capable of distinguishing)*. This means that the *sign* used (*sign*) has the power to distinguish goods or services produced by a company from other companies. To have this distinguishing power, the mark must be able to provide determination or "*individualizing*" on the goods or services concerned.

Related to well-known trademarks, there are several changes in Law No. 20 Year 2016, one of the changes is the stricter rules for well-known trademarks compared to the old Trademark Law, Law No. 15 Year 2001. The new Trademark Law (Law No. 20 Year 2016) opens the opportunity for holders of well-known trademarks to file a lawsuit in court in the event of trademark infringement.

Protection of well-known trademarks, in its development has universal characteristics that are based on the consideration that the trademark has been widely promoted by the owner so that it becomes widely known in the business environment and consumers, good quality and much favored by the consumer community, and can not be registered by others who are not the owner of the trademark for both similar and dissimilar goods or services. However, the question arises whether a well-known trademark may have similarities in principle or in whole with a well-known trademark owned by another party for goods and/or services that are not similar, in the trademark law it is not allowed but must meet certain requirements that will be further stipulated in the Government Regulation (hereinafter referred to as PP), but in various cases that have been found various differences in the implementation of these regulations. In Law Number 20 Year 2016 on Trademarks and Geographical Indications (hereinafter referred to as the New Trademark Law) there is already a Ministerial regulation that replaces the government regulation. Legal protection of registered trademarks is as a legal guarantee against registered trademarks to be treated in accordance with applicable rules. The legislation of the Republic of Indonesia that regulates the trademark is the Old Trademark Law which is currently in effect the New Trademark Law.

The definition of a well-known trademark is not specifically regulated in Law No. 20 Year 2016, but the regulation of well-known trademarks can be seen in the Explanation of Article 21 paragraph (1) letter b, which states the rejection of applications that have similarities in essence or in whole with: A well-known trademark owned by another party for similar goods and/or services. In the Explanation, it is said that the refusal is done by taking into account the general knowledge of the public about the trademark in the relevant business field. In addition, it also takes into account the reputation of the trademark obtained due to vigorous and massive promotion, investment in several countries in the world made by the owner, and accompanied by evidence of registration of the trademark in several countries. If this is not considered sufficient, the Commercial Court may order an independent institution to conduct a survey in order to obtain a conclusion regarding whether or not the trademark that is the basis for refusal is famous.

The World Intellectual Property Organizations (WIPO) provides limitations on well-known marks as agreed in the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* that these factors can be used to determine whether the mark falls into the well-known category⁷, namely: (1) the level of knowledge or recognition of the mark in the relevant sector of society; (2) the duration, extent and geographical area of use of the mark; (3) the duration, extent and geographical area of promotion of the mark; (4) the duration and geographical area of any registration or application for registration of the mark; (5) the value of the mark; (6) the record of successful fulfillment of rights in the mark.

Trademarks can be divided into 3 (three) types based on the *reputation (reputation)* and renown (renown) of a brand, namely *normal marks*, *well-known marks* and famous marks. Normal marks are marks that are not considered to have a high reputation. This 'ordinary' brand is considered to be less symbolic of lifestyle both in terms of usage and technology. The consumer community sees the brand as low quality. This brand is also considered to have no *draving power* that is able to give a touch of familiarity and *mythical power (mythical power)* that is suggestive to the consumer community, and is unable to form a layer of market and users. Meanwhile, well-known brands are brands that have a high reputation. This brand has a stunning and

attractive radiant power, so that the types of goods under the brand immediately cause a touch of *familiarity* (*familiar*) and mythical ties (*mythical context*) to all consumer reports. Furthermore, the most famous brand is a brand that is so famous throughout the world, resulting in its reputation being classified as a 'world aristocratic brand'.

However, distinguishing between a famous mark and a well-known mark is very difficult in reality. The difficulty in interpretation, results in the difficulty of determining the boundaries and measures between the two. If the famous mark is based on the size of 'very famous and very high reputation', then basically the size is also owned by the famous mark. Therefore, in making the definition of a famous mark, it will be trapped with formulations that overlap with the definition of a well-known mark. To date, there is actually no widely accepted definition of a famous mark. Efforts to inventory the elements that make up the definition have yet to reach an agreement.

Related to the definition of well-known trademark, T. Mulya Lubis and Insan Budi Maulana stated that: "A trademark is declared famous if it has been registered at home and abroad, used in the country concerned, and widely known. The above requirements have covered a process of cause and effect, so that the trademark becomes and is declared a well-known trademark." While Article 16 paragraph (2) *Trade Related Aspect of Intellectual Property Rights* (TRIP's) only managed to make the criteria of the nature of the fame of a trademark by taking into account the factor of knowledge about the brand in certain circles in society, including the knowledge of participating countries about the condition of the brand in question, obtained from the promotion of the brand.

There is no definition of well-known trademark in Law Number 20 Year 2016 on trademarks and Geographical Indications, but in the explanation of Article 21 Paragraph (1) Letter b there are criteria for well-known trademarks, namely:

"The rejection of an application that is substantially or entirely similar to a well-known trademark owned by another party for similar goods and/or services is done by taking into account the public's general knowledge of the trademark in the relevant business field. In addition, it also considers the reputation of the trademark obtained due to vigorous and massive promotion, investment in several countries in the world made by the owner, and accompanied by evidence of registration of the trademark in several countries. If this is not considered sufficient, the Commercial Court may order an independent institution to conduct a survey in order to obtain a conclusion regarding whether or not the trademark that is the basis for refusal is famous."

A State party to the convention may provide for a period during which a prohibition of use may be sought in respect of a well-known mark in respect of goods or services which are not the same as those for which the mark is registered, provided that the use of the trademark is so connected with the goods or services as to show a connection between those goods and services and the registered trademark and provided that the interests of the registered proprietor are impaired by that use. In determining whether a mark is *well-known*, account must be taken of the knowledge of the well-known mark in the vicinity of the particular public including knowledge in the Member State as a result of promotion of the trademark.

A well-known trademark has exclusive rights that are obtained based on several requirements in the Trademark Law (MIG Law) and Permenkumham on trademark registration, this must be protected through written positive laws. The MIG Law has explained that "any new trademark that wants to register it with the state must not be fundamentally similar to a well-known trademark that has been recognized by the state", so if there are indications of similarity in the trademark registration application, the new trademark must be rejected considering the element of fundamental similarity especially with well-known trademarks.

In addition, it is also worth noting the responsibility of the Directorate General of Intellectual Property (DJKI) as a state agency engaged in the world of intellectual property in Indonesia such as trademarks, as an *independent* state agency and the vanguard in selecting new trademarks that want to be registered to the state, it is appropriate if there are trademarks with indications of infringement in the form of fundamental similarities directly rejected by the agency, but until now there are still many trademarks that plagiarize well-known trademarks, it is not an open secret that the state agency works less professionally and does not make the MIG Law as one of the guidelines in issuing a new trademark.

A well-known mark means "famous" according to the general knowledge of the public. A well-known brand is a brand that is widely recognized by relevant sectors of society. Promotion is the most effective means to build reputation (*image*). Reputation does not have to be obtained through registration, but can be obtained through *actual use in placing goods or services into the market*.

The World Intellectual Property Organization (WIPO) is currently initiating a new agreement in the field of trademarks designed for the protection of famous marks which contains new norms:

1. An attempt to clarify the notion of *relevant sector of the public* with a defining element.
2. Only limited to potential customers
3. Distribution network and usual business environment with the brand

4. famous in general.
5. Efforts to determine the elements of a famous brand include:
 - a. The term, scope and area of use of the mark.
 - b. Market.
 - c. Level of discriminating power.
 - d. Quality must be good (*image*).
 - e. The breadth of the registry in the world, the exclusivity of the registry.
 - f. Extent of use in the world.
 - g. Exclusivity of use in the world.
 - h. The trade value of the brand in the world.
 - i. Protection record achieved.
 - j. Litigation results in the determination of whether or not the mark is famous.
 - k. The intensity of registration of other marks that are similar to the mark in question.

A well-known mark implies "well-known" according to the general knowledge of the public. A well-known brand is a brand that is widely recognized by relevant sectors of society. Promotion is the most effective means to build reputation (*image*). Reputation does not have to be obtained through registration, but can be obtained through *actual use in placing goods or services into the market*.

Well-known brands that are very important for marketing are circulated abroad as well as by foreigners to buy goods because they trust certain familiar brands. According to Sudargo, in foreign markets, brands are often the only way to create and maintain *goodwill* with overseas consumers. These brands are the symbol by which a trader expands its overseas market and also maintains this market. Well-known brands are an important aspect of brands. The economic importance of famous marks is recognized by WIPO. The definition of a well-known mark taken by WIPO. A well-known mark is a mark that has been recognized for a considerable period of time and is considered well-known by the competent authority of the country for which protection is sought.

2. Problem Formulation

- a. What are the contributing factors to the occurrence of a statutorily registered famous mark dispute?
- b. How is the legal protection of famous trademark disputes that have been registered in Decision Number 83/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst?

II. RESEARCH METHODS

The research method that the author uses in this journal is normative legal research. Normative legal research is a process to find a rule of law, legal principles, or legal doctrines to answer the legal problems at hand. Normative juridical research method is legal research conducted by examining library materials or secondary data only.

III. RESULTS AND DISCUSSION

1. Factors Causing the Occurrence of a Famous Trademark Lawsuit Caused by Other Trademarks that Have Been Registered

Registered trademarks that are found to be similar in the trademark that was already registered, then it is said to be the basis of the registrant's bad faith. Against the registration is done on the basis of bad faith can be done legal remedies namely cancellation of the trademark. Trademark cancellation is a procedure taken by one of the parties to seek and eliminate the existence of registration of a trademark from the General Register of Trademarks or cancel the validity of rights based on the trademark certificate. Generally, a party who feels has been harmed by the registration may file a lawsuit for cancellation. The lawsuit for the cancellation of a trademark is based on the provisions in Article 20 and Article 21 of Law No.20 of 2016 on Trademarks and Geographical Indications.

According to the provisions of Article 21 paragraph (1) of the Trademark Law that the application for trademark registration will be rejected if a trademark has similarities in principle or in whole with other trademarks that have been registered in advance. In the explanation, it is determined that the similarity in essence is the existence of a resemblance to another trademark. In the Big Indonesian Dictionary "similarity" means the state of being similar, which the word "similar" itself means almost the same or similar.

M. Yahya Harahap stated that the equation in the whole is the equation of all elements. Such an equation is in accordance with the doctrine of *entires similar* or the same overall element.

To see whether a mark has similarities in essence or not, then a mark with other marks can be compared *side-by-side*. This way more see the full appearance of a brand. Therefore, the prominent and dominant elements in a mark become very relevant in determining the existence of similarities.

In addition, this method of comparison is also to see if there is a *bad faith* motive in the registration of a mark by looking at deceptively *similarity*. Deceptive similarity means that a mark is made as if it is exactly the same as the mark it is imitating so that the public thinks the two marks are the same or come from the same company. *Bad Faith* is an action taken with bad intentions. The aspect that is compared is the impression that arises based on the experience or memory of the public related to the existence of the brand with other brands.

If after comparison it turns out that a mark has no substantial difference, then the two marks can be said to have similarities, and the registration of the mark can be rejected or the mark can be canceled. Substantial difference means the difference that although it does not look prominent but when traced further can still be traced. With the existence of these similarities, the registration of the trademark there are indications of bad faith because it can be said that with the existence of similarities substantially or as a whole, the trademark is hijacking the fame of other trademarks, so that the goods with its trademark are more famous and more salable. Therefore, the trademark can be canceled even though the trademark has been registered.

Cancellation of a registered trademark can only be filed by an interested party or trademark owner, either in the form of an application to the Director General of IPR or a lawsuit to the Commercial Court. This trademark cancellation lawsuit can be filed to the Commercial Court in Indonesia by interested parties, namely: Prosecutors, foundations/institutions in the field of consumers, and religious assemblies/institutions based on the grounds that the registration of the trademark should be rejected or cannot be registered under the Act.

The action of canceling a registered trademark can only be done in a trademark dispute related to the ownership of the rights to the trademark not to the trademark dispute regarding the use of the rights to the trademark. This means that this cancellation action is only applied in trademark disputes where one of the parties has obtained rights to the trademark in bad faith.

The reason for the cancellation of a trademark registration by the Directorate General of IPR is based on the similarity in essence or in its entirety with other well-known trademarks. Arrangements regarding similarities in essence or in its entirety are contained in Article 21 Paragraph (1) of Law Number 20 Year 2016 on Trademarks and Geographical Indications, the application is rejected if the Trademark has similarities in essence or in its entirety with:

1. Registered trademarks owned by other parties or applied for in advance by other parties for similar goods and/or services.
2. A well-known trademark owned by another party for similar goods and/or services.

The determination of similarity can be based on several factors including:

1. Similarity of image equations
2. Similar or almost the same wording, color, or sound
3. It is not necessary that the goods must be of the same kind or class
4. The use of brands creates *actual confusion* or misleads (*deceives*) the consuming public.

The importance of the element "Having Distinguishing Power" in a Trademark is one of the intellectual property rights that play an important role in the industry. Trademark has a main element that has a distinguishing power. This element of "having distinguishing power" causes the trademark registration application to be rejected if it has similarities in essence.

Trademarks that have similarities in principle or in its entirety with well-known trademarks, the factors rejected by the application for trademark filing, among others:

1. Basic Provisions Trademark Application

Based on Article 21 paragraph (1) letter b of Law No. 20/2016, it is stated that the application is rejected if the trademark is substantially or entirely similar to a well-known trademark owned by another party for similar goods and/or services. Referring to Article 21 paragraph (2) of Law No. 20/2016, the provisions referred to in Article 21 paragraph (1) letter b can also be applied to goods and/or services that are not similar as long as they meet certain requirements.

Based on the above provisions, a trademark application must be rejected if the trademark is substantially or entirely similar to a well-known trademark owned by another party for both similar and dissimilar goods and/or services. Refusal of a trademark because it is substantially or entirely similar to a well-known trademark owned by another party in order to be applied to goods and/or services that are not similar must meet the requirements set forth in the Ministerial Regulation.

The assessment factor of the similarity in essence or in its entirety with other trademarks and similar goods and/or services in Article 21 paragraph (1) letter b of Law No. 20/2016 is no different from Article 21 paragraph (1) letter a of Law No. 20/2016 as previously discussed. Thus, the focus of the discussion in this section 3 only focuses on how to determine the qualifications of well-known trademarks.

2. Application for Rejection of Famous Trademark in Indonesia

Article 21 paragraph (1) letter (b) of Law No. 20/2016 which states that the application is rejected if the mark is substantially or entirely similar to a well-known mark owned by another party for similar goods and/or services, has a similar method to the implementation of Article 21 paragraph (1) letter (a)

which contains the application is rejected if the mark is substantially or entirely similar to a registered mark owned by another party or applied for in advance by another party for similar goods and/or services. One significant difference is that the well-known trademark that becomes the basis for refusal does not have to be registered or filed first.

At the substantive examination stage, the objection document accompanied by evidence submitted at the announcement stage from the owner of the famous mark becomes the main reference for the examiner to refuse based on Article 21 paragraph (1) letter (b). To determine the qualification of a well-known trademark is done by taking into account the general knowledge of the public regarding the trademark in the relevant business field. The reputation of the trademark obtained due to vigorous and massive promotion, investment and evidence of trademark registration in several countries is also an assessment factor. In addition, the well-known trademark assessment factor also takes into account the success of the trademark in terms of law enforcement.

The provisions of Article 6 paragraph (2) of the Trademark Law 2001 are textually the same as the provisions of Article 21 paragraph (2) of the Trademark Law. In the practice of substantive examination, the author has not found any decision to refuse a trademark because it has similarities in essence or in its entirety with well-known trademarks owned by other parties for goods and/or services that are not similar. This is due to the legalistic approach, namely the absence of government regulations governing certain requirements related to the implementation of Article 6 paragraph (2) of Law No. 15/2001.

3. Trademarks that Have Similarities in Principal or Entirety with Registered Geographical Indications

The provision of Article 21 paragraph (1) letter (c) of Law No. 20/2016 states that the application is rejected if the mark is substantially or entirely similar to a registered geographical indication. This provision is different from the basis for refusal based on the provisions of Article 6 paragraph (1) letter (c) that the application is rejected if the mark is substantially or entirely similar to a known geographical indication. In relation to this article, the provisions of the new Trademark Law are easier to implement because the word "registered" is more measurable than the word "known". But on the other hand, a geographical indication must fulfill certain procedures to be registered and can be used as a basis for refusal of a trademark application.

The definition of geographical indication based on Law No. 20/2016 is a sign that shows the area of origin of a good and/or product which due to geographical environmental factors including natural factors, human factors or a combination of both factors gives a certain reputation, quality, and characteristics to the goods and/or products produced.

4. Trademark Applications that are Refused Because They Have Similarities in Principal or Entirety with Geographical Indications

The use of a geographical indication as a mark for certain goods or services will give the impression that there is a connection between the goods or services and the geographical area. This relationship may indicate the place of manufacture, the place of design of the goods, the source of business, or the place of provision of services. In this case, the geographical indication, although referring to the region of origin, does not function as a brand. The public will only consider it as part of the description of the goods or services. If the trademark application uses a geographical name that is already known as a producer of certain products for the same type of goods or services, consumers will consider the geographical name as the producing region or place of production. This application should be rejected because it has similarities with geographical indications. The principle of assessment of the substantive similarity of geographical indications applies in the same way as the assessment of the substantive similarity of trademarks.

5. Trademark Applications that are Registered Despite Having Similarities in Principal or Entirety with Geographical Indications

Trademark applications that are substantially or entirely similar to geographical indications can be registered as long as they are not related to the type of goods that have no relationship with the geographical indication product used. The unusual use of geographical names for certain goods will make the public consider it as a distinguishing power and not as information related to geographical indications. Such a trademark application can be registered because it will not deceive the public about the quality of the geographical indication product.

6. Trademarks that are or resemble names or abbreviations of names of famous people, photographs, names of legal entities owned by others

c. Basic Provisions

Article 21 paragraph (3) letter (a) of Law No. 20/2016 states that a trademark application is rejected if the trademark is or resembles the name or abbreviation of the name of a famous person, photograph, or the name of a legal entity owned by another person, except with the written consent of

the rightful owner. The term "constitutes" in this provision has an identical meaning, while the word "resembles" has the meaning of having similarities.

The substance of this article has actually been regulated in Article 6 paragraph (3) letter (a) of Law No. 15/2001 without any change in wording or substance. Some examples of rejection cases under Law No. 15/2001 will be described to make it easier to understand this provision.

d. Famous People's Names

A famous person's name is the personal name of a person who is popular in various circles such as artists, sportsmen, scientists, statesmen and others. Refusal under this article can be based on full names, surnames that have high distinguishing power, or abbreviated names. The name or abbreviation of the name of a famous person can refuse registration of a mark without being bound by the type of goods or services.

Within the scope of substantive examination, there were several trademark applications that were rejected because they resembled the name of a famous person. For example, the application for the mark "T.Cruise" for cosmetic products, (NCL 3), jewelry and watches (NCL 14) and clothing (NCL 25) was rejected because it resembled the name of a famous Hollywood actor "Tom Cruise". Refusal for resembling the name of a famous person also occurred in the application for the mark "B.Affleck".

The provisions of this article can also be used to cancel a registered mark. The mark "BEYONCE" which has been registered for cosmetics (NCL 3) was canceled based on the District Court Decision Number 31/Pdt. Sus-Merek/2015/PN.JKT.PST. In its consideration, it is stated that Beyonce's international fame as a singer can be seen from the number of Beyonce's music albums that have been sold in various countries in the world, including in Indonesia, where Beyonce successfully sold around 100,000 pieces of her first album in Indonesia, and approximately 11,000,000 pieces of her first album worldwide. In addition, Beyonce began to be famous in Indonesia since 2003 with evidence in the form of magazine covers, articles of the famous singer Beyonce have been widely circulated internationally.

e. Photo

In the provisions of the Trademark Law related to this article, a trademark application is rejected if it is or resembles a photograph although it is not further explained what the photograph is. In examination practice, what is meant by a photograph is a photograph of a person without assessing whether the person is famous or not. In order to be registered as a trademark, a trademark that uses a photograph must obtain permission from the person concerned. The image below is a registered mark that uses elements of a photograph.



Registered Trademark Image With Photo Element

7. Criteria for Similarity in Principal and Similarity in Whole

In many markets, *branding* strategies are used to capture the desired market share; brands are made as unique as possible so that they have distinctiveness, which ultimately becomes trust and quality assurance. Referring to Jened, *acquiring distinctiveness through use* is referred to as building *secondary meaning*. Keep in mind that the actual brand owner must be able to register and make the brand known, or make it famous, so that it is not misused by other parties in the *cybercrime* scene. If you remember *cybercrime* in commerce, you also remember *cybersquatting*, which is a case of unlawful registration of a well-known trademark by another party through *cyber*.

Similarly, in addition to the use of the mark must be in good faith, it must not violate laws and regulations, public order, and decency. In the Explanation of Article 20 of the 2016 UUMIG, it is stated that what is meant by "contrary to public order" is that it is not in line with the existing rules in society which are comprehensive in nature such as offending the feelings of the community or group, offending the decency or general ethics of the community, and offending the peace of the community or group. Similarly, the mark should not contain misleading elements. What is meant by "contains elements that can mislead",

for example, the Trademark "Kecap No. 1" cannot be registered because it misleads the public regarding the quality of the goods, the Trademark "net 100 grams" cannot be registered because it misleads the public regarding the size of the goods. What is meant by "containing information that is not in accordance with the quality, benefits, or efficacy of the goods and/or services produced" is to include information that is not in accordance with the quality, benefits, efficacy, and/or risks of the product in question. For example, medicine that can cure a thousand and one diseases, cigarettes that are safe for health.

Entrepreneurs/investors before making and registering their trademarks should also pay attention to existing registered trademarks, as well as well-known trademarks that already exist in the market. This is necessary so that the creation of a trademark does not infringe on the 'existing' trademark, and really has a distinguishing power. Quoting the UUMIG's explanation on the matter, a mark is considered not to have distinguishing power if the mark is too simple such as a single line mark or a single dot mark, or too complicated so that it is not clear. The meaning of "common name" includes the Mark "rumah makan" for restaurants, the Mark "warung kopi" for cafes. As for "common property symbols", they include "skull symbol" for dangerous goods, "poison sign" for chemicals, "spoon and fork symbol" for restaurant services.

This distinguishing power is also to avoid similarities or similarities with other trademarks both registered and well-known, also related to geographical indications that have been registered. In the explanation of Article 21 UUMIG 2016, it is stated that what is meant by "similarity in essence" is the similarity caused by the dominant element between one Trademark and another Trademark so as to create the impression of similarity, both regarding the form, the way of placement, the way of writing, or the combination of elements, as well as the similarity of speech sounds, contained in the Trademark. The meaning of "Trademark applied for first" is an application for registration of Trademark that has been approved for registration. Rejection of an application that has similarities in essence or in whole with a well-known Trademark owned by another party for similar goods and/or services is done by taking into account the general knowledge of the public about the Trademark in the field of business concerned.

In addition, it is also noted that the reputation of the Trademark is obtained due to vigorous and massive promotion, investment in several countries in the world made by the owner, and accompanied by evidence of registration of the Trademark in several countries. If this is not considered sufficient, the Commercial Court can order an independent institution to conduct a survey to obtain a conclusion about whether or not the Trademark is famous which is the basis of refusal.

Referring to Jened, if the trademark is used by two parties then the *legal problem (legalproblem)* is no longer about the similarity in essence or overall similarity, but must be determined who is using the trademark in good faith. Regarding the similarity in essence, the UUMIG Article 21 states that the application for Trademark registration is rejected if the Trademark has similarities in essence or in its entirety with a registered Trademark owned by another party or applied for in advance by another party for similar goods and/or services; a well-known Trademark owned by another party for similar goods and/or services; a well-known Trademark owned by another party for non-similar goods and/or services that meet certain requirements; or registered Geographical Indications. The application is rejected if the Trademark is or resembles the name or abbreviation of the name of a famous person, photograph, or name of a legal entity owned by another person, except with the written consent of the rightful party; is an imitation or resembles the name or abbreviation of the name, flag, emblem or symbol or emblem of a state, or national or international institution, except with the written consent of the competent authority; or is an imitation or resembles the mark or stamp or official seal used by the state or Government institution, except with the written consent of the competent authority. An application is rejected if it is submitted by an Applicant who is in bad faith.

In the explanation of UUMIG, it is stated that what is meant by "similarity in essence" is the similarity caused by the dominant element between one Trademark and another Trademark so as to create the impression of similarity, both regarding the form, the way of placement, the way of writing or the combination of elements, as well as the similarity of speech sounds, contained in the Trademark. While what is meant by "Trademark applied for first" is an application for registration of Trademark that has been approved for registration. Similarly, the rejection of an application that has similarities in essence or as a whole with a well-known Trademark owned by another party for similar goods and/or services is done by taking into account the public's general knowledge of the Trademark in the field of business concerned. In addition, it also considers the reputation of the Trademark obtained due to vigorous and massive promotion, investment in several countries in the world made by the owner, and accompanied by evidence of registration of the Trademark in several countries. If this is not considered sufficient, the Commercial Court can order an independent institution to conduct a survey to obtain conclusions about whether or not the Trademark is famous which is the basis for refusal.

Previously in UUM 2001, the provisions regarding similarities in essence are mentioned, in Article 6; the application must be rejected by the Directorate General if the Trademark has similarities in essence or

in its entirety with the trademark owned by another party that has been registered in advance for similar goods and / or services; has similarities in essence or in its entirety with a well-known Trademark owned by another party for similar goods and / or services, has similarities in essence or in its entirety with geographical indications that are already known. In the explanation of Article 6 of the 2001 UUM, what is meant by equality in essence is the similarity caused by the presence of prominent elements between one trademark and another trademark, which can give rise to the impression of similarity either in form (painting or writing), the way of placement (i.e. the elements are arranged, in such a way that the same impression arises with other people's trademarks), the meaning and combination between the elements or the similarity of sound in speech contained in these trademarks. The definition of equality in essence described in this explanation is in accordance with the doctrine of '*nearly resembles*', which considers a trademark to have equality in essence with another person's trademark if the trademark is *identical* or *nearly resembles* another person's trademark, which can be based on the similarity of images, wording, colors or sounds. According to this doctrine, similarity in essence is not easily asserted on the similarity of all elements of the mark and is not strictly demanded on the similarity path of all elements of the mark and is not strictly demanded on the similarity path. The most important factor in this doctrine is that the use of marks that have similarities in essence can cause *actual confusion* or mislead (*deceive*) the consumer community. As if, the brand comes from the same source or producer. So that there is an element of bad faith to piggyback on the fame of other people's brands.

8. The Doctrine of Equal Treatment

Trademark is a sign that is shown to distinguish the source or producer of goods and/or services from one another. Therefore, a registered mark must have distinguishing power. A mark is considered not to have distinguishing power if the mark is too simple such as a single line mark or a single dotted mark or too difficult so that it is not clear. This level of distinguishing power affects the level of protection of a mark. Marks with high distinguishing power will receive strong protection and vice versa. This protection is the relationship with the distinguishing ability of the trademark associated with the assessment of whether or not there are similarities in essence with other trademarks. Trademark registration application to the Directorate General of IP can be based on absolute grounds and relative grounds. Absolute refusal is because it is universal and for reasons that are objective in that it must be known and examined by the trademark examiner and can also be because the provisions are contained in every trademark legislation in many countries even though it is regulated in a different arrangement. Meanwhile, relative refusal is due to subjective reasons or depending on the ability and knowledge of the trademark examiner and also because not all countries include such rules.

Trademark infringement by imitating or making similarities with other trademarks can confuse consumers about the origin of an item. Things that can cause confusion is the basic concept of equality in essence of a trademark with another trademark. Similarity factors between one trademark and another trademark may include:

- a. There is a factor of *identical* or *very nearly resembles* between one brand and another which includes similarity in everything (*similar in appearance*), similarity or identical regarding sound (*sound*), identical or similar in *connotation* (*connotation*).
- b. Containing similarities *in the association* or similarity of images, making it difficult for the consumer community to distinguish between one brand and another, resulting in *actual confusion* (*actual confusion*) and similarities cause *misleading consumers* (*misleading consumers*) because it creates confidence as if the goods concerned originated and produced by the same manufacturer.

2. Legal Protection of Owners of Famous Trademarks POLOBYRALPHLAUREN Which Have Been Registered in Decision Number 83/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst

Plaintiff Mohindar H.B., against PT POLO RALPH LAUREN INDONESIA as Defendant and Director General of Intellectual Property Rights as Co-Defendant with his lawsuit dated August 22, 2022 which was registered at the Registrar of the Commercial Court at the Central Jakarta District Court on August 22, 2022, under register number 83/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Jkt.Pst, argued the following matters:

This trademark cancellation lawsuit is based on the provisions of Article 76 of the Trademark Law which states that "*A lawsuit for the cancellation of a registered trademark may be filed by any interested party based on the grounds as referred to in Article 20 and/or Article 21.*" This trademark cancellation lawsuit is based on the articles mentioned in Article 76 of the Trademark Law Article 21 Paragraph (3) of the Trademark Law, that the Defendant applied for trademark registration in bad faith.

That the Plaintiff is the Owner of the POLOBYRALPHLAUREN Trademark and the Horseman Logo in Indonesia based on a Court Decision that has been legally binding. The Plaintiff is the Right Holder of the POLOBYRALPHLAUREN Trademark and the Horseman's Logo under register No. 173934 based on the

transfer of part of the company and the trademark from Jon Whiteley in 1986, which part of the intellectual property rights of the transferred company is the Trademark transferred by Jon Whiteley to the Plaintiff in 1986.

That the Defendant previously knew very well that the Plaintiff was the legitimate right holder of the POLOBYRALPHLAUREN Trademark and the Logo of the Person Riding a Horse under register No. 173934, this was very clearly known by the Defendant which was established by the Defendant's Affiliated Company (which is also a Shareholder to date) because the Affiliated Company (which is the Founder and Shareholder of the Defendant) had already been in dispute with the Plaintiff in Case No.1776/K/PDT/1996 jo. Case No. 436/PDT/G.D/1993/PN.JKT.PST and the Decision has permanent legal force.

Despite knowing that the Plaintiff is the legitimate right holder of the POLOBYRALPHLAUREN mark and the Horseman's Logo, the Defendant has continuously registered and held registrations for the Horseman's Painting mark and marks that are similar to the POLOBYRALPHLAUREN mark for identical and similar types of goods. That the Plaintiff also found that the Defendant's trademarks not only resembled the Plaintiff's trademark, but also blatantly copied the Plaintiff's trademark. The similarity between the Defendant's trademarks and the Plaintiff's trademark is not a mere coincidence. The combination of the logo of a person riding a horse and a mark that has similarities with POLOBYRALPHLAUREN is clearly not a mere coincidence and can only occur because the Defendant was inspired and/or was well aware of and therefore imitated the Plaintiff's mark. That based on the above Decision, it has been proven that the Defendant was well aware that the Plaintiff was the Right Holder of the POLORALPHLAUREN Trademark under register No. 173934 but the Defendant ignored that fact and continued to apply for the Defendant's trademarks in bad faith, namely by imitating the Plaintiff's POLORALPHLAUREN trademark.

Based on the above facts, the Defendant cannot argue that the Defendant did not know the existence of the Plaintiff's trademark. But in fact, after there was a legally binding decision, the Defendant instead registered the Defendant's Trademarks which have similarities with the Defendant's Trademarks.

The conclusion is irrefutable that the Defendant applied for registration of the mark POLO BY RALPH LAUREN under the register No. 1.

IDM000387022 in class 25, POLO RALPH LAUREN INDONESIA mark under registration No. IDM000649482 in class 35, POLO BY RALPH LAUREN mark + Logo of Person on Horseback Playing Polo under registration No. IDM000635112 in class 25, Polo by Ralph Lauren + Logo of a person riding a horse playing Polo under register No. IDM000177954 in class 25, POLORALPHLAUREN mark under register No. IDM000052727 in class 25 in bad faith which:

1. The Defendant did not independently create the mark.
2. The Defendant is well aware that the Trademark belongs to the Plaintiff which there has been a Decision with permanent legal force against it but the Defendant still tries to get the exclusivity of the Trademark.

The legal grounds of the lawsuit below will be further explained in the lawsuit, namely the Defendant's bad faith at the time of filing the application for registration of the Defendant's trademark. The Plaintiff is the rightful owner of the polobyralphlauren mark and the logo of a person riding a horse.

Based on the permanent legal decision, the Defendant, which was only established in 2015, should have been very well aware that the "POLOBYRALPHLAUREN" Trademark and the Horse Riding Logo belonged to the Plaintiff and not to the Defendant and even this has been decided through a permanent legal decision. The defendant's trademarks have been registered in bad faith.

- a. That Article 21 paragraph (3) of the Trademark Act stipulates that legal protection can only be given to the applicant in good faith as stated in Article 21 paragraph (3) of the Trademark Act which reads "*The application is rejected if filed by an applicant who has bad faith.*"
- b. That the definition of bad faith is further regulated in the explanation of Article 21 paragraph (3) of the Trademark Act which reads: "*An applicant who has bad faith is an applicant who is reasonably suspected in registering his Trademark has the intention to imitate, plagiarize, or follow the Trademark of another party for the sake of his business interests to cause unfair business competition conditions, deceive, or mislead consumers. For example, a Trademark application in the form of writing, painting, logo, or color arrangement that is the same as the Trademark owned by another party or Trademark that has been known to the public in general since many years, is imitated in such a way that it has similarities in essence or in its entirety with the Trademark that has been known. From this example, there has been bad faith from the Applicant because at least it should be known that there is an element of intent in imitating the well-known Trademark.*" *The Defendant has copied or plagiarized the Plaintiff's trademark*

It is undisputed that the Defendant applied for registration of the mark POLO BY RALPH LAUREN under register No. IDM000387022 in class 25, the mark POLO RALPH LAUREN INDONESIA under register No. IDM000649482 in class 35, POLO BY RALPH LAUREN + Logo of a Horseman Playing Polo mark under registration No. IDM000635112 in class 25, POLO BY RALPH LAUREN + Logo of a Horseman Playing Polo mark under registration No. IDM000177954 in class 25, and POLORALPHLAUREN mark under registration No. IDM000052727 in class 25 in bad faith. In accordance with Article 21 paragraph (3) of the Trademark Law,

the Defendant's trademarks must be canceled because they have been filed in bad faith by imitating and plagiarizing the trademarks of other parties.

Being a general legal principle "Legal protection is only given to people in good faith and not given to people in bad faith". This principle is stated in Article 21 paragraph (3) of the Trademark Law which states as follows: "Trademark can not be registered on the basis of an application filed by an applicant in bad faith". Based on this Article, the Defendant's trademark registrations should be unregistrable and canceled. Furthermore, pursuant to Article 21 paragraph (3) of the Trademark Law in conjunction with Article 76 of the Trademark Law, the trademarks in the name of the Defendant must be canceled because they were registered in bad faith.

Thus, from the comparison of the Defendant's trademark with the Plaintiff's trademark, the following similarities are obtained:

1. The Horseman logo of the Plaintiff's mark and the Defendant's Horseman logo are entirely similar;
2. The manner of mentioning POLO BY RALPH LAUREN, which is the dominant element in the Defendant's mark is identical to a substantial part of the Plaintiff's mark POLOBYRALPHLAUREN;
3. The visual appearance of the Defendant's marks is substantially the same as the visual appearance of the Plaintiff's marks.
4. The overall impression of the Defendant's marks is very similar to the Plaintiff's marks.

With the legal facts from the comparison between the Defendant's trademark and the Plaintiff's trademark, the Panel of Judges concluded that the Defendant's trademark and the Plaintiff's trademark are substantially similar. Because the Defendant's trademark and the Plaintiff's trademark have similarities in essence as has been considered above, it will then be considered whether the Defendant registered its trademark in bad faith as argued by the Plaintiff which states that the Defendant's trademark has been registered in bad faith.

Legal protection can only be given to applicants in good faith as stated in Article 21 paragraph (3) of the Trademark Law which reads *"The application is rejected if filed by an Applicant who has bad faith."* The definition of bad faith is further regulated in the explanation of Article 21 paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications which reads: *"An applicant who has bad faith is an applicant who is reasonably suspected in registering his Trademark has the intention to imitate, plagiarize, or follow other parties' Trademarks for the sake of his business interests to cause unfair business competition conditions, deceive, or mislead consumers. For example, a Trademark application in the form of writing, painting, logo, or color arrangement that is the same as the Trademark owned by another party or Trademark that has been known to the public in general since many years, is imitated in such a way that it has similarities in essence or in its entirety with the Trademark that has been known. From this example, there has been bad faith from the Applicant because at least it should be known that there is an element of intent in imitating the well-known Trademark."*

Thus, since PT MANGGALA PUTRA PERKASA (an affiliated company of the Defendant) has wanted the POLOBYRALPLAUREN trademark and the Logo of People Riding Horses Playing Polo owned by the Defendant to be canceled by filing a lawsuit for cancellation of the trademark, it is evident that PT. MANGGALA PUTRA PERKASA knew that the POLOBYRALPLAUREN trademark and the Logo of People Riding Horses Playing Polo at that time had been registered under the name of Mohindar HB (plaintiff in the case *a quo*), it has been proven or at least reasonably suspected that the registration of the POLOBYRALPLAUREN trademark and LOGO OF PEOPLE RIDING HORSES PLAYING POLO by PT. MANGGALA PUTRA PERKASA is done with bad intentions, as explained in Article 21 (3) NUMBER 20 YEAR 2016 ABOUT BRANDS AND GEOGRAPHICAL INDICATIONS, which states: What is meant by "Applicant in bad faith" is an Applicant who is reasonably suspected in registering his Trademark has the intention to imitate, plagiarize, or follow the Trademark of another party for the sake of his business interests to cause unfair business competition conditions, deceive, or mislead consumers.

With the proof that the registration of the trademarks of the object of the *a-quo* lawsuit was carried out in bad faith as considered above, then with the granting of the application for registration of the *a-quo* trademarks by the Defendant, there has been a real mistake made by the Defendant where the same trademark POLOBYRALPLAUREN and the Logo of People Riding Horses Playing Polo have been registered on the application of 2 (two) different parties, namely the Plaintiff and PT. MANGGALA PUTRA PERKASA which then transferred it to the Defendant.

The Panel of Judges then considered the arguments of the Defendant and Co-Defendant as follows: Against the argument that states, the Defendant (PT. POLO RALPH LAUREN INDONESIA), has owned and used 5 (five) registered Trademark Etiquettes. The Trademarks/Equettes were issued by the Co-Defendant in accordance with the prevailing laws and regulations. Since the Plaintiff's lawsuit regarding the cancellation of the Defendant's trademark is based on the reason that the trademarks were registered in bad faith, then based on the provisions of Article 76 of Law No. 20 Year 2016 on Trademarks and Geographical Indications that the

lawsuit for the cancellation of registered trademarks can be filed by any interested party based on the reasons as referred to in Article 20 and/or Article 21. Furthermore, Article 77 paragraph (2) of Law No. 20 Year 2016 on Trademarks and Geographical Indications determines "Cancellation lawsuit can be filed indefinitely if there is an element of bad faith and/or the relevant Trademark is contrary to the state ideology, legislation, morality, religion, decency, and public order."

Based on the above provisions, although the Defendant's trademark has been registered under the provisions of the Act, however, because the registration of the trademark is proven to be based on bad faith as has been considered above, it can still be canceled so that the Defendant's rebuttal on this matter must be rejected.

As the Defendant's rebuttal is rejected, the remaining evidence of the Defendant's letter need not be considered and is therefore set aside. Regarding the other Defendant's arguments, they have been considered in the consideration of the arguments of the Plaintiff's lawsuit which are proven according to the law, so the arguments must also be rejected. Because the Plaintiff has been able to prove the arguments of his lawsuit, next will be considered the Plaintiff's petition which is basically as follows:

Based on all of the above considerations, the petition of the Plaintiff's lawsuit in number 2 (two) which demands to state that the Plaintiff is the owner and the first registrant and is the party entitled to use the POLOBYRALPHLAUREN trademark and the Logo of People Riding Horses in class 25 is legally reasonable and can be granted. Because petition number 2 (two) is granted, then petition numbers 3 (three) through 12 must also be granted. That to ensure legal certainty and the implementation of the Plaintiff's rights, then petition number 13 through petition number 17 has legal grounds so that it can be granted. With the granting of the plaintiff's petition as mentioned above, then petition number 1 (one) which demands to grant the plaintiff's claim in its entirety can be granted. Because the Plaintiff's claim is granted, the Defendant must be ordered to pay court costs. Noting Article 20, Article 21, Article 22 Article 76 paragraph (1) and Article 77 paragraph (2) of Law Number 20 of 2016 concerning Trademarks and Geographical indications in conjunction with Law Number 11 of 2020 concerning Job Creation, Article 18 of the Regulation of the Minister of Law and Human Rights of the Republic of Indonesia Number 67 of 2016 concerning Trademark Registration, as well as other relevant regulations.

The judge gave the following legal decision:

Adjudicate, rejecting the Defendant's and Co-Defendant's exceptions. In the merits of the case decided to grant the Plaintiff's claim in its entirety, stating that the Plaintiff is the owner and the first registrant and is the party entitled to use the POLOBYRALPHLAUREN mark and the Horseback Riding Logo in class 25, stating that the Defendant acted in bad faith at the time of filing the request for registration of the POLO BY RALPH LAUREN mark under the register number IDM000387022 in class 25, which is substantially and/or completely similar to the POLOBYRALPHLAUREN mark and the logo of a person riding a horse owned by the Plaintiff in the office of the Defendant due to the intention to imitate the Plaintiff's mark, stating that the Defendant acted in bad faith when applying for the registration of the POLO BY RALPH LAUREN INDONESIA mark under registration No. IDM000649482 in class 35, owned by the Defendant, which has similarities in essence and/or in its entirety with the POLOBYRALPHLAUREN Trademark and the Logo of the Person Riding a Horse owned by the Plaintiff in the office of the Defendant because it was based on the intention to imitate the Plaintiff's trademark.

IV. CONCLUSION

This dispute began because Mr. Mohindar H.B as the plaintiff felt disturbed because of the use of the Polo trademark by other parties. The other party in question is PT Polo Ralph Lauren Indonesia (PT PRLI), Defendant I and the Directorate General of Intellectual Property Rights as Co-Defendant II. This lawsuit was processed simultaneously in 2022. The essence of Mr. Mohindar's request is that the DJKI wants the brand to cancel the registration of the Polo brand by the two companies. This is because Mr. Mohindar claims to be the first legitimate owner of the Polo trademark.

Mr. Mohindar claimed to have obtained the Polo brand based on the transfer of the brand from Jon Whiteley in 1986 with registration number 173934. In fact, according to Mr. Mohindar as the plaintiff, PT PRLI already knows that the Polo trademark is his. This is because before the lawsuit number 83 of 2022 which is now running was filed, between Mr. Mohindar and PT PRLI had previously been disputed in court as well.

In Decision Number 83/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst, furthermore, because according to Mr. Mohindar PT PRLI did not act in good faith in registering the trademark, Mr. Mohindar filed a lawsuit on August 22, 2022. The bad faith referred to by Mr. Mohindar was because PT PRLI had previously been in dispute with the plaintiff but continued to register new trademarks with similar names. However, based on the statement of the Defendant or PT PRLI, the Polo trademark was first owned by Jon Whiteley which was then transferred to Mr. Fong Franky. Furthermore, Mr. Fong Franky never transferred this brand to anyone. This

means that, according to the Defendant, the claim to transfer the brand from Jon Whiteley to the Plaintiff has never happened before. This statement is contained in a statement signed by Jon Whiteley.

With this statement letter, it proves that the Polo By Ralph Lauren trademark was only transferred to Fong Franky as the Director of PT MPP who also became the defendant against Mr. Mohindar. Then, around 2016, PT MPP transferred its trademark rights to PT PRLI. Which based on this transfer, resulting in the rights to the trademark has been legally transferred to PT PRLI. The end of this long dispute against PT PRLI resulted in a good outcome for Mr. Mohindar. The panel of judges finally decided that the Polo By Ralph Lauren trademark was legally owned by Mr. Mohindar. This also proves that the trademark transfer agreement between Jon Whiteley and Mr. Mohindar is a valid agreement.

Giving an order to cancel the Trademarks and remove them from the Trademark Register. The problem between Mr. Mohindar and PT PRLI was basically due to a misunderstanding that occurred regarding the transfer of rights to the trademark. Mr. Mohindar, according to the judge's observation, has legally obtained trademark rights based on the transfer. Meanwhile, PT PRLI also obtained the transfer of trademark rights from the same person, namely Jon Whiteley.

About Trademark Transfer, basically the right to a trademark can be equated with movable objects. That is, just like other objects, the trademark can also be transferred. This is stated in Article 41 of Trademark Law Number 20 Year 2016. Anyone who has rights to the trademark, can transfer his rights in ways that are allowed by law. The transfer of trademark rights by Jon Whiteley must comply with the following provisions of the law:

The transfer of the trademark can only be done for the same person, if the trademark owner owns several trademarks at once. The transfer of rights to the trademark must be recorded with the Minister. At the time of recording, the trademark owner must attach supporting evidence. Every time a trademark transfer is recorded, this transfer will be publicized through the Official Trademark Gazette. Any transfer of trademark that is not recorded, it will not have legal consequences against third parties.

However, since the trademark transfer process between Jon Whiteley and Mr. Mohindar occurred long before this law came into effect, it is likely that this provision has not been applied by both of them. For example, as explained in point number 2, the registration with the Minister. When the transfer occurs, this transfer is recorded to the Ministry of Justice Directorate General of Law and Legislation Directorate of Patents and Trademarks. Meanwhile, the recording of the transfer of trademark rights between Jon Whiteley and Mr. Fong Franky has also been carried out at the Indonesian Ministry of Justice Directorate General of Copyright, Patents and Trademarks. The records that occur between the two both have evidence from the authorized body at the time of transfer. If this is the case, how will the judge judge the transfer of rights to the trademark?

The Concept of Trademark Grant According to the law, trademark rights are rights that can be obtained by the sole owner of the trademark. This sole phrase means that it is very crucial in this Polo trademark dispute case. The reason is that Mr. Mohindar, who hopes to enjoy all the profits from the sale of Polo products independently, must accept that there are other companies that produce it in bulk. Legally, an entrepreneur can obtain rights to a trademark based on two ways, namely through registration and through trademark transfer.

The Polo brand was first registered by Jon Whiteley in 1983. So based on the registration, Jon Whiteley is entitled to the trademark. The rights possessed by Jon Whiteley are in the form of using his own brand name or transferring the rights to the brand. Because as the owner of the mark Jon Whiteley could transfer the rights to the mark, in 1986 Jon Whiteley sold his mark to Mr. Mohindar. Thus, based on the concept of granting trademark rights, the ownership rights of the Polo brand currently belong to Mr. Mohindar. Through the judge's decision in favor of the plaintiff Mr. Mohindar in court number 83/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst

then the researcher will outline the following conclusions:

1. In Article 21 paragraph (3) of Law Number 20 Year 2016 on Trademarks. That the defendant filed an application for trademark registration in bad faith, as explained in Article 21 (3) of Law Number 20 Year 2016 on Trademarks and GEOGRAPHICAL INDICATIONS, which states that what is meant by "Applicant in bad faith" is an Applicant who is reasonably suspected in registering his Trademark has the intention to imitate, plagiarize, or follow other parties' Trademarks for the sake of his business interests to cause unfair business competition conditions, deceive, or mislead consumers.
2. Based on all of the above considerations, the petitum of the Plaintiff Mr. Mohindar H.B. in number 2 (two) which demands to state that the Plaintiff is the owner and first registrant and is the party entitled to use the POLOBYRALPHLAUREN trademark and the Logo of the Horseman in class 25. is legally grounded and can be granted and takes into account Article 20, Article 21, Article 22 Article 76 paragraph (1) and Article 77 paragraph (2) of Law Number 20 of 2016 concerning Trademarks and Geographical indications jo Law Number 11 of 2020 concerning Job Creation, Article 18 of the Regulation of the Minister of Law and Human Rights of the Republic of Indonesia Number 67 of 2016 concerning Trademark Registration, as well as other relevant regulations.

Sugestion

1. The need for revision of Trademark Law Number 20 Year 2016. If it is not possible to be implemented immediately, the Ministry of Law and Human Rights of the Republic of Indonesia can issue a Ministerial Regulation that can be an explanation of the clauses in the Act that regulates the word mark that has elements of the sentence of an individual entity or legal entity that can be categorized as a famous person.
2. The need for thoroughness of the Directorate General of Intellectual Property as the recipient of trademark registration in order to more thoroughly examine the application for registration of trademarks substantively and consider the terms of the provisions of trademark registration in detail so that there is no similarity of trademarks in filing with the previous trademark owner, which led to the occurrence of prolonged trademark disputes in the Commercial Court because it is not in accordance with the provisions of the applicable provisions.
3. The panel of judges in giving a decision on a trademark dispute should not only look at the juridical factors alone. However, it must fulfill 3 elements in law enforcement, namely legal justice, legal protection, expediency, and the principle of justice. And supervision after the court's decision on the occurrence of trademark disputes should be done in order to avoid problems such as the registration of trademarks that have been registered but canceled by the court.

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