

# Legal Analysis of The Judge's Decision on Trademark Cancellation Study of Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN JKT.PST

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## Abstract.

*This research aims to find out and understand the Regulations on Unregisterable and Rejected Trademarks based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications and the Judge's Considerations in Deciding to Cancel Registered Trademarks Based on Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst. The type of legal research used is normative legal research. The types and legal materials used are primary and secondary legal materials. The approaches used in this research are the statutory approach and the case approach. Research Results: 1. Regulations Against Unregisterable and Rejected Trademarks based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications regulated in Article 20, 21 paragraphs (1), (2), and (3), Whereas Criminal provisions for misuse of Trademark Rights are regulated in Chapter XVIII concerning Criminal Provisions regulated in Article 100 paragraphs (1), (2) and (3) and Article 101 paragraphs (1) and (2); 2. Judge's Consideration Based on Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst states that The brand in question has similarities in principle, namely similarities caused by the existence of dominant elements between one brand and another brand so that it gives the impression of similarities, both regarding the form, placement method, writing method or combination of elements, as well as similarities in pronunciation, contained in the brand, referring to the Supreme Court Decision Number 279 PK/Pdt/1992 dated January 16, 1998, stating that the brand used is the same as a whole or has similarities in principle can be described as: 1) Similar form (similarity of form); 2) Same composition (similarity of composition); 3) Same combination (similarity combination); 4) Same elements (similarity elements); 5) Similar sound (similarity sound); 6) Similar pronunciation (phonetic similarity); 7) Similar appearance (similarity in appearance).*

**Keywords:** Judge's Decision; Trademark and Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst.

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## I. INTRODUCTION

In the era of globalization, trade in goods and services, both nationally and internationally, is increasing. The existence of well-known and renowned brands has a significant interest among the public. Public interest is greatest in goods with well-known brands that are recognized as having a significant role in the quality of goods. In this era of development that is in line with international conventions, the role of brands is very important in maintaining business competition and must be adjusted to applicable brand regulations. Therefore, brands must have their own regulations in the law that can protect the merchandise from fraudulent behavior by other entrepreneurs in the same field. The Law on Trademarks is expected to provide protection to holders of registered brand rights from unlawful acts committed against registered brands as an attempt at unfair competition such as imitation, counterfeiting, or unauthorized use of brands for certain brands. Such a situation is certainly detrimental to brand owners, but will also be detrimental to consumers. As a form of intellectual work, a brand plays a crucial role in facilitating and enhancing trade in goods and services in Indonesia. It also plays a crucial role in national development in general and economic development in particular. A brand is a tool used to differentiate goods and services produced by a company. It aims to demonstrate the characteristics and origin (Indication of Origin) of a product or service, thereby differentiating it from other products and services. Furthermore, branding can demonstrate the quality of goods and services. However, in practice, unlawful acts against registered trademarks are not uncommon, leading to unfair competition, counterfeiting, or unauthorized use of certain trademarks.

Based on Article 1 number 1 of Law No. 20 of 2016 concerning Trademarks, what is meant by 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 and / or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and / or services produced by a person or legal entity in the trading activities of goods and / or services. Article 1 number 2, Trademark is a Mark used on goods traded by a person or several people together or a legal entity to

distinguish it from other similar goods. Article 1 number 3 states that a Service Mark is a Mark used on services traded by a person or several people together or a legal entity to distinguish it from other similar services. While Article 1 number 4 states that a collective Mark is a mark used on goods or services with the same characteristics traded by several people or legal entities together to distinguish similar goods or services. In brands there is the term license, namely permission given by the registered brand owner to a person or several people together or a legal entity to use the brand for goods or services.

The rapidly developing economic climate in the trade sector, accompanied by technological and communication developments that dominate, makes everyone no longer think about ethical values or even legal norms in carrying out healthy trade practices. Dishonest trade often occurs in the midst of society, namely the widespread use of trademarks without rights, especially from well-known brands, solely with the aim of making the greatest profit and carried out intentionally by irresponsible parties. This certainly has consequences for the actions carried out both morally and materially. Article 1 number 5 of Law No. 20 of 2016, Trademark Rights are exclusive rights granted by the state to the owner of a registered Trademark for a certain period of time by using the Trademark himself or giving permission to another party to use it. In addition, that trademark rights are one of the intellectual property rights that must be protected by the State, because the trademark has a function, namely as a means of distinguishing between one good or service and another good or service, especially similar goods or services. Trademark protection is granted only to registered trademark owners. Trademark protection is granted when a trademark infringement occurs by a party without the right to the trademark. In the world of commerce, trademarks play a crucial role, as a well-known brand can influence a business's success, particularly in marketing. Trademark infringement often occurs in the world of commerce. This infringement occurs when a party without the right to use a registered trademark for their own benefit.

Trademark infringement committed by parties acting in bad faith and irresponsibly against the well-known trademark they infringe will certainly result in losses for producers or entrepreneurs holding the rights to the well-known trademark. As the injured party, the holder of the rights to the well-known trademark will certainly take legal action to resolve the trademark infringement case. This aims to ensure that the perpetrator of the trademark infringement will no longer use a trademark that is similar in essence or in its entirety to the well-known trademark or even stop its production activities. Acts of trademark infringement are not only regulated in the Trademark Law, but can also be subject to sanctions that can be reviewed under criminal, civil, and administrative law. Unauthorized use of a trademark can be sued for unlawful acts (Article 1365 of the Civil Code), namely "Every unlawful act that causes harm to another person, requires the person whose fault causes the loss to compensate for the loss." Dishonest competition is itself unlawful, because the law provides protection for orderly interactions in the business world. This dishonest competition is classified as a criminal act according to Article 382bis of the Criminal Code. Material acts are subject to a maximum prison sentence of 1 year or a fine of up to Rp. 900,000, namely committing deceptive acts to deceive the public or a particular person. This deception is used by the maker as an effort to maintain or increase the results of the maker's trade or company or another person. In addition, the provisions contained in the Criminal Code, namely the provisions of Article 393 paragraph (1) which states:

"Whoever brings into Indonesia without a clear intention to be taken out of Indonesia, sells, offers, delivers, distributes or has in stock for sale or distribution, goods which are known or should be suspected, that on the goods themselves or on the packaging are falsely attached the name, firm or those which are the rights of another person or to state the origin of the goods, the name of a certain place is added the name of an imaginary firm, or that on the goods themselves or on even with a slight change, is threatened with a maximum imprisonment of four months and two weeks or a maximum fine of six hundred rupiah." Article 393 paragraph (2) of the Criminal Code: "If at the time of committing the crime it has not yet passed five years since the conviction that has become final, for the same kind of crime, a maximum imprisonment of nine months may be imposed." In this crime it is not necessary that the brand, name or firm attached is exactly the same as the brand, name or name of the other person's firm. Law enforcement against registered trademarks from fraudulent business actors has a very important role in maintaining the interests of the rights holders of the registered trademarks. So, if law enforcement officials allow indications of piracy of brands

that are already known to the public, as part of the best quality trade products, it is very clear that it provides an assumption that is clearly disappointing to many parties, in this case, namely the registered trademark holders or with Licenses and the Public as consumers or users of merchandise.

This action is clearly an Unlawful Act, where the behavior of piracy against registered trademarks is very detrimental, namely not only entrepreneurs who own or hold the rights to the brand but also the Public as consumers of goods whose brands are counterfeited. Therefore, the role of brands is very important in encouraging economic growth both nationally and internationally, to prevent the occurrence of unlawful acts such as imitation, counterfeiting, or use of brands without rights to registered brands, it is necessary to carry out supervision and legal protection by the relevant parties in order to protect healthy trade and Rights Holders of registered Trademarks. The author conducted a research on a case where the case has been decided by the Central Jakarta Commercial Court. The Commercial Court at the Central Jakarta District Court which examined and decided the Trademark case at the first instance court, issued the following decision in the application filed by: PT Tong Shen Enterprise Co., Ltd. Addressed No. 116, LN 130, Dingcuo Rd, Linyuan District Kaohsiung City 832 Taiwan, Republic Of China (ROC) Is a Company established under the laws of Taiwan (Republic Of China), Opponent PT. Inti Jaya Lemindo, located at Laksana Business Warehouse Block F 21, Jl. Raya Kalibaru, Kel. Laksana, Pakuhaji District, Tangerang Regency, Banten Province and the Ministry of Law and Human Rights, Directorate General of Intellectual Property Rights of the Republic of Indonesia, Located at Jl. HR. Rasuna Said Kav. 6-7 Kuningan, South Jakarta as Defendant II.

## II. ABOUT THE SITTING OF THE CASE

The plaintiff in his application letter dated October 31, 2022, registered at the Commercial Court Clerk's Office at the Central Jakarta District Court, under Register Number 101/Pdt.Sus/HKI/Merek/2022/PN Jkt.Pst, dated November 1, 2022, has stated the following:

1. That Tong Shen Enterprise Co., Ltd., or the Plaintiff is a Company established under the Laws of the Republic of Taiwan (Republic of China) which produces Glue (adhesive) with a trademark that has been registered in approximately hundreds of countries in the world including the Republic of Indonesia.
2. That the glue/adhesive with the trademark belonging to the Plaintiff has been registered by the Plaintiff in accordance with the legal provisions in force in the Republic of Indonesia, since 1995 and has been extended and received legal protection from Defendant II until the filing of this lawsuit, so that the Registration of trademarks, Trademark Certificates and Extension of Trademark Certificates belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff) in the Republic of Indonesia is valid and legally binding.
3. That the trademarks of Tong Shen Enterprise Co., Ltd., which have been registered and extended and have received legal protection from Defendant II in the Republic of Indonesia are as follows:
  - A. Trademark Certificate No: IDM000498555
  - B. Trademark Certificate No: IDM000498556
  - C. Trademark Certificate No: IDM000027591
  - D. Trademark Certificate No: IDM00023621
  - E. Trademark Certificate No: IDM000174507
  - F. Trademark Certificate No: IDM000841628
  - G. Trademark Certificate No: IDM000141823
  - H. Trademark Certificate No: IDM000141824
  - I. Trademark Certificate No: IDM000214643
4. That in order to maintain and protect the Plaintiff's legal interests in the Republic of Indonesia, the Plaintiff has established a cooperative relationship with an Indonesian Company, namely PT. Putra Permata Majuperkasa, by making a License Agreement dated May 23, 2017 and a License Agreement dated January 24, 2022 which came into effect on May 23 until May 23, 2027, where the Plaintiff is the Licensor while PT. Putra Permata Majuperkasa is the Licensee, and the legal relationship is still valid until now, therefore the License Agreement between the Plaintiff and PT. Putra Permata Majuperkasa is valid and legally binding.

5. That as a Licensee, PT. Putra Permata Majuperkasa has taken legal action against Defendant I and Defendant II, however, due to a typing error in the License Agreement between the Plaintiff and PT. Putra Permata Majuperkasa, the Plaintiff decided to file a lawsuit against Defendants I and II, because the Plaintiff feels that the Plaintiff's legal interests have been violated by Defendant I and Defendant II. -
6. That the Plaintiff was very surprised, confused and extremely shocked when the Plaintiff received a report from the Licensee (PT. Putra Permata Majuperkasa) that the Company named PT. Inti Jaya Lemindo (Defendant I) on the Defendant II website, had registered trademarks that were essentially or completely similar to the registered trademarks belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff), as stated in the Plaintiff's claim in point (3) above.
7. That the trademark requested by Defendant I to be registered with Defendant II, which was sued by the Plaintiff in the a quo case is a trademark that has passed the Plaintiff's monitoring and has received a Trademark Certificate from Defendant II, namely: "Trademark with an inverted logo, with writing under the logo, which was registered by Defendant I with Defendant II and has a Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application 26 November 2019, the Trademark is:

**PT. INTI JAYA LEMINDO**



8. That the registered trademark belonging to Defendant I, has similarities with the registered trademark belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff), which was issued by the Minister of Law and Human Rights based on Law Number 15 of 2001 concerning Trademarks with Registration Number IDM000236218 which was registered on February 12, 2010 and received on July 5, 2010, valid until July 5, 2020 and has been extended the Trademark Protection Period, valid until July 5, 2030 based on Law No. 20 of 2016 concerning Trademarks and Geographical Indications.  
The brands are:

**PT. INTI JAYA LEMINDO**



9. That the Plaintiff confirms that the trademark applied for by Defendant I in Points (7) and (8) of the Plaintiff's lawsuit above is a Trademark that is essentially or wholly similar to the trademark of Tong Shen Enterprise Co., Ltd., (Plaintiff), which has been registered in the Republic of Indonesia, namely a trademark with a logo according to the Trademark Certificate with Registration Number: IDM000236218 which is valid until July 5, 2030.
10. That the actions of Defendant I in registering a trademark which is essentially or entirely similar to the trademark belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff), also turns out that the registration of said trademark is for the same or similar type of goods, namely glue or adhesive with the type of glue or adhesive belonging to the Plaintiff.
11. As a consideration for the Panel of Judges examining this case, the Plaintiff wishes to convey several important matters regarding Defendant I as follows:
  - a. Defendant I, in submitting a Trademark Registration Application, uses the address in accordance with the address in the Plaintiff's Lawsuit, but also submits two addresses for correspondence that are not the same as the address in the Plaintiff's Lawsuit (vide DJKI website: [www.dgip.go.id](http://www.dgip.go.id)), this will provide room for Defendant I to evade Defendant I's address, so that Defendant I can submit an exception related to Defendant I's address.
  - b. Defendant I from February 2020 to October 2021 has registered 12 (twelve) trademarks, with details of 5 (five) Trademark Registration Applications having been passed and certified, while 7 (seven) Trademark Registration Applications are still in the Announcement stage and have been objected to by

the License Holder, namely PT. Putra Permata Majuperkasa, with the most fundamental legal reason being that the brands requested to be registered by Defendant II are all essentially or entirely similar to the Tong Shen Enterprise Co., Ltd. (Plaintiff) brand.

12. That in addition to that, Defendant I has also made an announcement and threatened the Plaintiff's consumers not to trade in the Plaintiff's production goods, in fact Defendant I has openly produced glue/adhesive that is the same as the Plaintiff's glue/adhesive, so that Defendant I's actions are very detrimental to the Plaintiff and the Plaintiff will file a lawsuit for compensation against Defendant I in a separate lawsuit later.
13. That in relation to the matters that the Plaintiff has described above, Defendant I is qualified as a Trademark Registration Plaintiff who has bad/bad intentions according to the law.
14. That due to the actions of Defendant I as stated in the Plaintiff's lawsuit points (6), (7), (8), (9), (10), (11), (12) and (13), it is proven that he has carried out the act of registering a trademark which has similarities in principle or in its entirety with the trademark owned by Tong Shen Enterprise Co., Ltd., (Plaintiff) and produces and trades glue/adhesive which is the same as the glue/adhesive owned by the Plaintiff, so that it is very confusing for consumers who have been using the brand and glue/adhesive owned by the Plaintiff for decades, then the registered trademark owned by PT. Inti Jaya Lemindo (Defendant I) according to Trademark Certificate No: IDM000853844, date of receipt of registration application: 26 November 2019, must be declared cancelled.
15. That Defendant II, by the provisions of the Law in force in the Republic of Indonesia, specifically Law No. 20 of 2016 concerning Trademarks and Geographical Indications, is given the authority to reject Trademark Registration Applications in accordance with the provisions of Chapter IV Trademark Registration Part One Trademarks that Cannot be Registered and Rejected, Article 20 and Article 21.
16. That Defendant II, in his position and authority, should or should have carried out careful, thorough and precise research on the Trademark registration application submitted by Defendant I and should have rejected the Trademark Registration Application from Defendant I, because the trademark requested to be registered by Defendant I is very detrimental to the Plaintiff for the following reasons:
  - a. Has similarities in essence or in its entirety with the registered trademark of Tong Shen Enterprise Co., Ltd., (Plaintiff)
  - b. The trademark requested to be registered by Defendant I is the same as the Plaintiff's goods, namely glue or adhesive.
  - c. The trademarks owned by Tong Shen Enterprise Co., Ltd., (Plaintiff) are well-known marks.
  - d. Trademark registration This is very confusing for the Plaintiff's consumers who have been using the Plaintiff's brand and glue/adhesive in Indonesia for decades.
17. That the actions of Defendant II have violated or breached the provisions of Article 20 in conjunction with Article 21 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, so that Defendant II must be ordered to cancel the registered trademark of Defendant I according to Trademark Certificate No: IDM000853844, date of receipt of registration application: November 26, 2019 and to remove the trademark from the trademark list and announce it in the Official Trademark Gazette.
18. That the Plaintiff is worried that Defendant I will continue to use, produce, distribute and trade glue/adhesive with a brand that is exactly the same as the Plaintiff's trademark, namely the trademark with the Logo, as long as this case does not have permanent legal force or *inkracht van gewisjde*, so that the Plaintiff requests the Panel of Judges who are examining and trying this case to be willing to make an interim decision prohibiting Defendant I from: "using, producing, distributing and trading Glue/adhesive according to Trademark Certificate No: IDM000853844, which has similarities in principle or in its entirety with the Plaintiff's trademark, namely the trademark with the Logo as long as this case does not have permanent legal force or *inkracht van gewisjde*".

The author formulates the problem as follows: 1. How Trademark Regulations Regarding Trademarks that Cannot be Registered and Rejected based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications. 2. What are the Judge's Considerations in Deciding to Cancel a Registered Trademark Based on Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst.

### III. METHODS

The type of legal research used is normative legal research. The types and legal materials used are primary and secondary legal materials. The approaches used in this research are the statutory approach and the case approach.

### IV. RESULT AND DISCUSSION

#### 3.1 Regulations Against Unregisterable and Rejected Trademarks based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications

##### Understanding Brands

The latest regulations on trademark provisions are set out in Law Number 15 of 2001 concerning Trademarks, which came into effect on August 1, 2001, thus completely changing the previous regulations on trademark provisions. The aim is to anticipate the development of information technology and transportation that has supported activities in the trade sector which have increased rapidly, maintain a healthy business competition climate, and accommodate several aspects of the TRIPs Agreement that have not been included in Law Number 14 of 1997 concerning Trademarks. Then in 2016 in facing the era of global trade, in line with international conventions that have been ratified by Indonesia, the role of Trademarks and Geographical Indications has become very important, especially in maintaining healthy and fair business competition, consumer protection, and protection of Micro, Small and Medium Enterprises and domestic industry, and to further improve services and provide legal certainty for the world of industry, trade and investment in facing local, national, regional and international economic developments as well as the development of information and communication technology, it is necessary to be supported by more adequate legislation in the field of Trademarks and Geographical Indications, and the regulation of trademarks in Law Number 15 of 2001 concerning Trademarks still has shortcomings and has not been able to accommodate the development of community needs in the field of Trademarks and Geographical Indications and has not sufficiently guaranteed the protection of local and national economic potential so that Law Number 20 of 2016 concerning Trademarks and Geographical Indications was born.

In Article 1 number 1 of the Law Number 20 of 2016 concerning Trademarks and Geographical Indications, states that A brand is a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by a person or legal entity in the trading of goods and/or services. Furthermore Number 2: A trademark is a trademark used on goods traded jointly by a person, body, or legal entity to distinguish them from other similar goods. Number 3 A service mark is a mark used for services traded by one person or several people together or a legal entity to differentiate it from other similar services. The definition of a brand put forward by several experts, namely according to Yusran Isanaini, "a brand is a sign in the form of a picture, name, word, letters, numbers, color arrangement, or a combination of these elements which has distinguishing power and is used in the trading of goods and/or services." According to Prof. Molengraaf, "a brand is a name that is used to identify a particular item to indicate its origin and guarantee its quality so that it can be compared with similar items made and traded by other people or companies." According to HMN Purwo Sutjipto, "a brand can be defined as a sign by which a particular object is identified so that it can be distinguished from other similar objects." From the definition of a brand above, a brand is not only known as a differentiating factor between one product and another, but more than that, a brand can provide a guarantee of protection for the quality value of the product/service.

##### Types of Brands

Types of brands can be divided into three, namely: (a). Trademarks; (b). Service marks; and (c). Collective marks. Trademarks are marks used on goods traded by a person or several people together or a legal entity to differentiate them from other similar goods (Article 1 point 2 of Law Number 15 of 2001 concerning Trademarks). Service marks are marks used on services traded by a person or several people together or a legal entity to differentiate them from other similar services (Article 1 point 3 of Law Number 15 of 2001 concerning Trademarks). While collective marks are marks used on goods or services with the

same characteristics traded by several people or legal entities together to differentiate them from other similar goods or services (Article 1 point 4 of Law Number 15 of 2001 concerning Trademarks).

Based on the reputation and fame of a brand, brands can be divided into three types, as described in the table below:

No.	Brand Types	Explanation
1.	Normal Marks	A "common" brand is a brand that doesn't have a high reputation. These brands are considered to lack a symbolic sense of lifestyle, both in terms of usage and technology. Consumers perceive these brands as having low quality. These brands are also considered to lack the drawing power to convey a sense of familiarity and are unable to create a market and user base.
2.	Well Known Marks	A well-known brand is one with a strong reputation. This brand possesses a compelling and appealing power, making any product sold under this brand instantly feel familiar to all levels of consumers.
3.	Famous Marks	A famous brand is a brand with the highest degree of prestige. Its worldwide fame has earned it a reputation as a "global aristocrat." In reality, it can be difficult to distinguish between a famous brand and a famous brand. The difficulty in interpretation makes it difficult to determine the boundaries and dimensions between the two.

**Brand Function**

In the world of commerce, brands play a crucial role. Brands are essentially used by brand owners or manufacturers to protect their products in the trade of goods and/or services. The functions of brands can be summarized in the table below:

No.	Brand Function	Explanation of Brand Functions
1.	ID card	namely being able to differentiate between one good or service and another good or service produced by another entrepreneur, but having almost the same criteria.
2.	Means of trade promotion	This promotion can be done through advertising by producers or entrepreneurs selling goods or services. A brand is a symbol used by entrepreneurs to expand the market for their products or merchandise and attract consumers.
3.	Guarantee of the quality of goods and/or services (quality guarantee)	The quality of goods is determined by a particular brand or brand. If the brand is a well-known brand, then the guarantee of the quality of the goods/services cannot be doubted by consumers.
4.	Designation of the origin of goods or services produced (source of origin)	A brand is an identification mark for goods and/or services that connects the goods and/or services with the producer, or between the goods and/or services and the region or country of origin.

In Chapter IV Trademark Registration Part One mentioned that Trademarks that cannot be registered and are rejected can be seen in the following table:

No.	Chapter	Article Sound
1.	Article 20	A trademark cannot be registered if: a. Contrary to state ideology, laws and regulations, morality, religion, decency or public order; b. The same as, related to, or only mentions the goods and/or services for which registration is requested; c. Contains elements that mislead the public about the origin, quality, type, size, kind, purpose of use of the goods and/or services for which registration is requested or is the name of a protected plant variety for similar goods and/or services; d. Contains information that does not correspond to the quality, benefits or properties of the goods and/or services produced; e. Does not have distinguishing power; f. Is a common name and/or symbol belonging to the public.”
2.	Article 21	The application is rejected if the mark is substantially or completely similar to: a. The registered trademark belongs to another party or was previously applied for by another party for similar goods and/or services; b. Well-known brands belonging to other parties for similar goods and/or services; c. Well-known brands belonging to other parties for dissimilar goods and/or services that meet certain requirements;

		d. Registered geographical indications.
3.	Article 21 Paragraph (2)	An application will be rejected if the trademark: a. Is or resembles the name or abbreviation of a famous person, a photograph, or the name of a legal entity owned by another person, except with the written consent of the authorized party; b. Is an imitation of or resembles the name or abbreviation of a name, flag, symbol or emblem of a country, or national or international institution, except with the written consent of the authorized party; c. Is an imitation of or resembles an official sign or stamp or seal used by a country or government institution, except with the written consent of the authorized party.
	Article 21 Paragraph (3)	The application is rejected if it is submitted by a plaintiff who has bad intentions.

In Decision Number 101/Pdt.Sus-HKI/MEREK/2022/PN JKT.PST, Defendant II in his position and authority, should or should have carried out careful, thorough and precise research on the Trademark registration application submitted by Defendant I and should have rejected the Trademark Registration Application from Defendant I, because the trademark requested to be registered by Defendant I is very detrimental to the Plaintiff for the following reasons:

- a. Has similarities in essence or in its entirety with the registered trademark of Tong Shen Enterprise Co., Ltd., (Plaintiff)
- b. The trademark requested to be registered by Defendant I is the same as the Plaintiff's goods, namely glue or adhesive.
- c. The trademark owned by Tong Shen Enterprise Co., Ltd., (Plaintiff) is a well-known trademark.
- d. Trademark registration is This is very confusing for the Plaintiff's consumers who have been using the Plaintiff's brand and glue/adhesive in Indonesia for decades.

The Criminal Provisions for the misuse of Trademark Rights are regulated in Chapter XVIII concerning Criminal Provisions, which we can see in the following table:

No.	Chapter	Article Sound
1.	Article 100 Paragraphs (1), (2), and (3)	(1) : "Any person who without the right uses a trademark which is the same in its entirety as a registered trademark belonging to another party for similar goods and/or services which are produced and/or traded, shall be punished with imprisonment for a maximum of 5 (five) years and/or a maximum fine of IDR 2,000,000,000 (two billion rupiah). (2) "Any person who without the right uses a trademark which is essentially similar to a registered trademark belonging to another party for similar goods and/or services which are produced and/or traded, shall be punished with imprisonment for a maximum of 4 (four) years and/or a maximum fine of IDR 2,000,000,000 (two billion rupiah). (3) Any person who violates the provisions as referred to in paragraph (1) and paragraph (2), whose type of goods cause health problems, environmental problems and/or human death, shall be punished with a maximum prison sentence of 10 (ten) years and/or a maximum fine of IDR 5,000,000,000 (five billion rupiah).
2.	Article 101 paragraphs (1) and (2)	(1): "Any person who without the right uses a mark which has a similarity in its entirety with a Geographical Indication belonging to another party for goods and/or products which are the same or similar to the goods and/or products registered, shall be punished with imprisonment for a maximum of 4 (four) years and/or a fine of a maximum of IDR 2,000,000,000 (two billion rupiah). (2) Any person who without the right uses a mark that is essentially similar to a Geographical Indication belonging to another party for goods and/or products that are the same or similar to the registered goods and/or products, shall be punished with imprisonment for a maximum of 4 (four) years and/or a fine of a maximum of IDR 2,000,000,000.00 (two billion rupiah). Article 102 Any person who trades goods and/or services and/or products who is known or reasonably suspected of knowing that the goods and/or services and/or products are the result of a criminal act as referred to in Article 100 and Article 101 shall be punished with imprisonment for a maximum of 1 (one) year or a fine of a maximum of IDR 200,000,000.00 (two hundred million rupiah).

**3.2. Judge's Consideration Based on Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst.**

As for the Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst that in the trademark infringement case trial, witness Dr. Parulian P. Aritonang, SH,LL.M.,MPP.,CCMS., was presented, whose opinion was heard under oath, which in essence was as follows:

- Foreign companies that wish to register their trademarks in Indonesia must use a registered IPR consultant and must fulfill the administration determined by the DJKI and if a Trademark Certificate has been issued and received protection from the State of Indonesia, then the trademarks according to the trademark certificate from the DJKI are valid and legally binding.
- A License Agreement is an Agreement between the Licensor and the Licensee to grant exclusive rights to the Licensor's trademark to the Licensee.
- If the Licensor and Licensee agree to correct errors in the License Agreement or change the License Agreement, then the changes to the license agreement are valid and legally binding.
- What is meant by similarity in principle is similarity in sound, composition, form, placement or combination, or the whole thing is the overall similarity of the brand that is requested to be registered with a registered brand.
- To file a cancellation lawsuit in accordance with the requirements of Article 76 of Law No. 20 of 2016, the registered trademark owner must file a cancellation lawsuit with the Commercial Court.
- If it is proven that there is a similarity in principle or in its entirety between a registered trademark and a new trademark or one that is being applied for registration or a foreign trademark registered in Indonesia with a nationally registered trademark, then the Panel of Judges can cancel the nationally registered trademark because it has a similarity in principle or in its entirety with a foreign trademark registered in Indonesia.
- If a substantive examination has been carried out and the brand is declared accepted and has received legal protection with a Trademark Certificate, then registered brands who feel that the brand is the same as their own brand can file a lawsuit for cancellation of the brand according to Article 76 of Law No. 20 of 2016 concerning brands and geographical indications.
- The criteria for a trademark applicant with bad labels are trademark applicants who copy, imitate or imitate registered trademarks, thereby giving rise to unhealthy or imperfect competition in business and the trademark will confuse consumers.
- A trademark cancellation lawsuit cannot be filed by the Licensee even though the license agreement has given the Licensee authority to take legal action against infringement of the registered trademark belonging to the Licensor. The Licensee can file a trademark cancellation lawsuit provided the Licensee has the authority to file a trademark cancellation lawsuit.
- What is meant by a well-known brand, the elements are investment, large-scale promotion, public knowledge and it has been registered in several countries, some countries are not specified by law, but according to experts, more than two countries can be called a well-known brand and the elements of this well-known brand are alternative, not cumulative.
- All trademark cancellation lawsuits must have special power of attorney from the registered trademark owner who wishes to file a trademark cancellation lawsuit, including license holders who must also have special power of attorney to file a cancellation lawsuit, even if such power is granted in the agreement.

In the Exception: Considering, that the Defendant's Exception if summarized in essence is as follows: 1. The Special Power of Attorney is Invalid and Does Not Meet the Formal Requirements as a Power of Attorney (Formally Defective Power of Attorney), for the following reasons: The Power of Attorney does not clearly state the identity of the Principal in this case Chih-Ming Chen, both the address and identity number (passport) as well as the legal standing of the Principal which is the basis for being able to act on behalf of the company; The Power of Attorney contains a clear error regarding the address and domicile of PT Inti Jaya Lemindo (in casu Defendant I) which is also the address stated on the Trademark Certificate belonging to Defendant I, the Plaintiff's Lawsuit in the aquo case; The position of the Parties is not stated and not explained in the special power of attorney; The Special Power of Attorney does not include and explain the Ministry of Law and Human Rights Cq Directorate General of Intellectual Property of the Republic of Indonesia as the party to be sued (in casu Defendant II). 2. Plaintiff's Lawsuit is Vague and Unclear, That by combining the Trademark Cancellation Lawsuit with the Ratification of the License Agreement between Tong Shen Enterprise Co., Ltd. and PT Putra Permata Majuperkasa in one lawsuit formulation, the Plaintiff's Lawsuit becomes increasingly unclear and vague because when connected with

the authority of the Commercial Court in adjudicating and examining a case, especially since PT Putra Permata Majuperkasa is not one of the parties in the aquo case. 3. Plaintiff's Lawsuit Contains Error in Persona Lack of Parties (Plurium Litis Consortium), namely: The Plaintiff asks the Commercial Court at the Central Jakarta District Court to recognize and ratify the License Agreement between Tong Shen Enterprise Co., Ltd. and PT Putra Permata Majuperkasa, which are the arguments of the lawsuit and the petitum of the lawsuit that are baseless, because the Plaintiff should have made PT Putra Permata Majuperkasa one of the parties in the aquo Case Lawsuit; The ratification of the License Agreement between the Plaintiff and PT Putra Permata Majuperkasa is not the domain of the Commercial Court and has nothing to do with the aquo lawsuit/PT Putra Permata Majuperkasa is not a party to the a quo case.

So that the Judge in his Decision Judged: In Provision Rejected the Provisional Claim from the Plaintiff. In Exception; Rejected the Exception from Defendant I in its entirety; In the Main Case, among others: 1. Granted the Plaintiff's Lawsuit in its entirety; 2. Declared the registration of Tong Shen Enterprise Co., Ltd., (Plaintiff) trademarks in the Republic of Indonesia valid and binding according to the laws of the Republic of Indonesia. 3. Declares, Trademark Certificates and Trademark Certificate Extensions of Tong Shen Enterprise Co., Ltd., (Plaintiff) in the Republic of Indonesia, according to the Trademark Certificates: A. Trademark Certificate No: IDM000498555, B. Trademark Certificate No: IDM000498556, C. Trademark Certificate No: IDM000027591, D. Trademark Certificate No: IDM000236218, E. Trademark Certificate No: IDM000174507, F. Trademark Certificate No: IDM000841628, G. Trademark Certificate No: IDM000141823, H. Trademark Certificate No: IDM000141824, I. Trademark Certificate No: IDM000214643 Are valid and binding according to the laws of the Republic of Indonesia; Declares the License Agreement between the Plaintiff and PT. Putra Permata Majuperkasa, dated May 23, 2017 and the License Agreement dated January 24, which is valid from May 23, 2022 until May 23, 2027, is valid and legally binding; 4. Declares that the Trademark with Registration Number IDM000236218, which was registered on February 12, 2010 and received on July 5, 2010, is valid until July 5, 2020 and has been extended the Trademark Protection Period, valid until July 5, 2030 based on Law No. 20 of 2016 concerning Trademarks and Geographical Indications, is legally valid and legally binding on the Plaintiff; 5.

Declares that Defendant I is a Plaintiff who registered the trademark in bad faith/not good; 6. Declare that the Trademark Registration belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019, has similarities in principle or in its entirety with the registered Trademark belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff) according to the Trademark Certificate with Trademark Registration Number: IDM000236218, receipt of Trademark Registration Application dated February 12, 2010, valid until July 5, 2030; 7. Declare, cancel the Trademark Registration according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019; 8. Order Defendant II to cancel and delete the registered trademark belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019, from the trademark list and announce it in the Official Trademark Gazette. 9. Sentenced Defendant I and Defendant II to pay all costs incurred in this case amounting to Rp. 2,790,000.00 (two million seven hundred and ninety thousand rupiah).

From the description above, it can be seen that in the decision of the Judge at the Central Jakarta District Court, the Judge Granted the Plaintiff's Lawsuit in its entirety and Declared that the registration of the trademarks of Tong Shen Enterprise Co., Ltd., (Plaintiff) in the Republic of Indonesia was valid and had binding force according to the laws of the Republic of Indonesia and Declared that the Trademark Certificates and Extension of the Trademark Certificates of Tong Shen Enterprise Co., Ltd., (Plaintiff) in the Republic of Indonesia were valid and binding according to the laws of the Republic of Indonesia. In addition, the Judge in his decision Declared that the License Agreement between the Plaintiff and PT. Putra Permata Majuperkasa, dated May 23, 2017 and the License Agreement dated January 24 which was valid from May 23, 2022 to May 23, 2027 was valid and binding according to the law. Trademark with Registration Number IDM000236218 which was registered on February 12, 2010 and received on July 5, 2010, is valid until July 5, 2020 and has been extended for the Trademark Protection Period, valid until July 5, 2030 based on Law

No. 20 of 2016 concerning Trademarks and Geographical Indications according to law is valid and binding on the Plaintiff.

Furthermore, the Judge decided that Defendant I was the Plaintiff for trademark registration who had bad/bad intentions and Declared that the Trademark Registration belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019, had similarities in principle or in its entirety with the registered Trademark belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff) according to the Trademark Certificate with Trademark Registration Number: IDM000236218, receipt of Trademark Registration Application dated February 12, 2010, valid until July 5, 2030. So that the judge in his decision stated, canceled the Trademark Registration according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019 and Ordered Defendant II to cancel and strike out the registered trademark belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: 26 November 2019, from the trademark list and announced it in the Official Trademark News.

## V. CONCLUSION

1. Regulations Against Unregisterable and Rejected Trademarks Based on Law Number 20 of 2016, it is regulated in Chapter IV Trademark Registration Part One, namely Article 20, 21 paragraphs (1), (2) and (3). Meanwhile Criminal provisions for misuse of Trademark Rights are regulated in CHAPTER XVIII concerning Criminal Provisions regulated in Article 100 paragraphs (1), (2) and (3) and Article 101 paragraphs (1) and (2).

2. Judge's Consideration Based on Decision Number 101/Pdt.Sus-HKI/Merek/2022/PN Jkt.Pst, namely the Judge Granted the Plaintiff's Lawsuit in its entirety and Declared that the registration of Tong Shen Enterprise Co., Ltd., (Plaintiff) trademarks in the Republic of Indonesia was valid and had binding force according to the laws of the Republic of Indonesia and Declared that the Trademark Certificates and Extension of Tong Shen Enterprise Co., Ltd., (Plaintiff) Trademark Certificates in the Republic of Indonesia were valid and binding according to the laws of the Republic of Indonesia. In addition, the Judge in his decision stated that the License Agreement between the Plaintiff and PT. Putra Permata Majuperkasa, dated May 23, 2017 and the License Agreement dated January 24 which was valid from May 23, 2022 to May 23, 2027 was valid and binding according to the law. Trademark with Registration Number IDM000236218 which was registered on February 12, 2010 and received on July 5, 2010, is valid until July 5, 2020 and has been extended for the Trademark Protection Period, valid until July 5, 2030 based on Law No. 20 of 2016 concerning Trademarks and Geographical Indications according to law is valid and binding on the Plaintiff.

Furthermore, the Judge decided that Defendant I was the Plaintiff for trademark registration who had bad/bad intentions and Declared that the Trademark Registration belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019, had similarities in principle or in its entirety with the registered Trademark belonging to Tong Shen Enterprise Co., Ltd., (Plaintiff) according to the Trademark Certificate with Trademark Registration Number: IDM000236218, receipt of Trademark Registration Application dated February 12, 2010, valid until July 5, 2030. So that the judge in his decision stated, canceled the Trademark Registration according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: November 26, 2019 and Ordered Defendant II to cancel and strike out the registered trademark belonging to Defendant I according to the Trademark Certificate with Registration Number: IDM000853844, date of receipt of registration application: 26 November 2019, from the trademark list and announced it in the Official Trademark News.

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