

Consideration of the Judge's Decision Regarding the Principle of Ungood Faith in the Brand Registration Dispute Case Study Between Rso vs PT. AGBS



Tio Lucito¹, Iwan Erar Joesoef²

^{1,2}Faculty of law, Universitas Pembangunan Nasional Veteran Jakarta,

Jl. RS Fatmawati Raya No. 1, Jakarta Selatan ,12450, Indonesia.

ABSTRACT : The purpose of this study is to examine the judge's decision which overrides the first to file principle in trademark disputes. The number of piracy of these well-known brands certainly causes a loss that is not only experienced by the brand owners themselves, it is necessary to have a control mechanism in the form of methods or dispute resolution mechanisms. In deciding this case between RSO and PT. AGBS, the Judge ruled by setting aside a strong principle in Mark Registration, namely the first to file principle by prioritizing the principle of bad faith. The results of the study found that judges saw all aspects and problems of the case from the beginning, not only seeing from one point of view, but also using a theoretical approach in making decisions in order to achieve justice for the parties involved. The research was carried out in a normative juridical manner by reviewing data on court decisions, laws and regulations and related literature. The conclusion of the study is that the Judge in deciding this case by canceling the Mark on behalf of RSO is to override the First to File principle because there is a Bad Faith principle carried out by RSO to control and or confiscate the trademark from PT. AGBS. This was obtained because from the results of the Brand Ambassador agreement that bad faith began to occur by the RSO Party.

KEYWORDS : brand; first to files; bad faith

A. INTRODUCTION

Intellectual Property Rights are human assets that are not tangible but play a major role in advancing human civilization. Legal protection for IPR is given by the state to stimulate the interest of Creators, Inventors, Designers, and Breeders so that they can be more enthusiastic in producing new intellectual works for the betterment of society. Broadly speaking, IPR is divided into two groups, namely Copyright and Industrial Property Rights. Industrial Property Rights consist of Patents, Trademarks, Industrial Designs, Integrated Circuit Layout Designs, Trade Secrets, and Plant Variety Protection.¹

Indonesia cannot escape from the relationship with the issue of legal protection of intellectual property rights which has become the world's concern. Indonesia has even participated in international agreements related to IPR, so like it or not, Indonesia must participate in ratifying the agreement so that our country is not isolated in the arena of trade between nations. Based on this, Indonesia then made legislation on IPR.²

In comparison, in the United States, it is mandatory for trademarks to be registered in bona fide or good faith, but does not describe what good faith is intended for. The trademark registration process begins by submitting an application which is then followed by a substantive examination by the United States Patent and Trademark Office (USPTO) and attorney. During the process, it is carried out by checking whether the registered mark has similarities with other marks along with administrative checks. If the trademark submitted by the applicant has passed the substantive examination. Then the mark will be announced for 30 days and after that the applicant will be given a letter of approval by the USPTO. Next, the applicant fills out a letter containing a Statement of Use (SoU) to see if there is bad faith in the registration. After the SoU is reviewed and approved, the trademark registration has been completed.³

Meanwhile, in Singapore, trademark registration is relatively easy with 4 processes, namely: (1) application; (2) inspection; (3) generalization; and (4) certification. However, in contrast to Indonesia and the United States, the announcement period is only

¹ Iswi Hariyani, 2010, *Prosedur Mengurus HAKI yang Benar*, Pustaka Yustisia, Jakarta, hal. 6.

² Iswi Hariyani, *Loc.Cit.*

³ Anonim, <https://www.uspto.gov/trademarks-getting-started/trademark-process#step6> diakses pada tanggal 11 April 2021.

Consideration of the Judge's Decision Regarding the Principle of Ungood Faith in the Brand Registration Dispute Case Study Between Rso vs PT. AGBS

30 days, based on Singapore law, the announcement is made for 60 days to see if there are complaints of elements of bad faith in the registered mark.⁴

The number of piracy of these well-known brands certainly causes a loss that is not only experienced by the brand owners themselves, it is necessary to have a control mechanism in the form of methods or dispute resolution mechanisms. This can be through litigation (court) or non-litigation (out of court). Provisions regarding the settlement of trademark disputes have been specifically regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications (MIG).

Based on the description above, the author is interested in studying more deeply and putting it into a legal research regarding dispute resolution in the field of trademarks according to Law Number 20 of 2016 concerning Marks and Geographical Indications (MIG). The title of this legal writing is CONSIDERATION OF THE JUDGE'S DECISION REGARDING THE PRINCIPLE OF UNGOOD FAITH IN BRAND REGISTRATION DISPUTE CASE STUDY BETWEEN RSO VS PT. AGBS.

In accordance with the background that has been described above, the author will put forward some of the main problems that will be discussed as follows:

1. How did the judge decide the case between the RSO and PT. AGBS ?
2. Why did the judge prioritize the principle of bad faith in deciding between the RSO and PT. AGBS ?

B. RESEARCH METHODS

This research is a normative juridical research with descriptive analytical research specifications, meaning that the legal research method is carried out by examining library materials or mere secondary materials.⁵ So that this research was obtained through a document study of the basic data in the form of the Commercial Court Decision Number 57/PDT.SUS-MEREK/2019/PN Niaga JKT.PST then the data obtained was analyzed in a qualitative normative manner which is expected to be able to provide a detailed, systematic and comprehensive picture or disclosure of various factors that are considered closely related to the case under study.

C. RESEARCH RESULT AND DISCUSSION

1. How did the judge decide the case between the RSO and PT. AGBS.

The juridical and philosophical basis of judicial power as an independent institution and free from all forms of outside interference, as required in Article 24 of the 1945 Constitution, that judicial power is the power of an independent state to administer the judiciary to enforce law and justice based on Pancasila and the Constitution. 1945, for the sake of the implementation of the constitutional state of the Republic of Indonesia. Therefore, judges as a core element in human resources who exercise judicial power in Indonesia, in carrying out their main duties and functions of judicial power are obliged to maintain judicial independence through the integrity of the judges' freedom in examining and deciding cases as regulated in Article 39 paragraph (4) of the Law. Law Number 48 of 2009 concerning the Power of Judges.

Organizationally, judges are part of the subsystem of the judiciary, namely as officials who exercise judicial power, so that the freedom of judges must always be within the corridor of independence of the judicial power institutions as stipulated in Article 3 of Law No.48 of 2009 which states that, in carrying out duties and functions, judges are obliged to maintain the independence of the judiciary.⁶

Judicial power is regulated in Article 24 of the 1945 Constitution that :

1. Judicial power is exercised by a Supreme Court and other judicial bodies according to law;
2. The composition and powers of judicial bodies are regulated by law.

The word free has the connotation of not being bound by anything and there is no pressure from anyone. Free also means that an action should not be dependent on anything or anyone. Freedom also has the meaning of being free to do anything according to the wishes of the freedom itself. If the word free is assigned to a judge, so that it becomes the judge's freedom in carrying out his duties as a judge, it can provide an understanding that a judge in carrying out his duties of judicial power may not be bound by anything and/or pressured by anyone, but is free to do anything. Interpreting the meaning of such freedom is called individual freedom or extensional freedom.⁷

⁴ Anonim, <https://www.ipos.gov.sg/protecting-your-ideas/trade-mark/application-process> diakses pada tanggal 12 April 2021.

⁵ Soerjono Soekanto dan Sri Mamudji, *Penelitian Hukum Normatif Suatu Tinjauan*, hlm 10.

⁶ Mahkamah Agung RI, *Penemuan hukum dan Pemecahan Masalah Hukum, Proyek Pengembangan Teknis Yustisial Mahkamah Agung RI*.

⁷ Franz Magnis Suseno, *Etika Dasar Masalah-Masalah Pokok Filsafat Moral*, Jakarta: Pustaka Filsafat, 1987, hal. 33.

Consideration of the Judge's Decision Regarding the Principle of Ungood Faith in the Brand Registration Dispute Case Study Between Rso vs PT. AGBS

According to Oemar Seno Adji: "An independent and uninfluenced court is an indispensable condition for the rule of law. Free means there is no interference or interference from the executive and legislative powers in carrying out judiciary functions. It does not mean that he has the right to act arbitrarily in carrying out his duties, he is "subordinated", bound by law."⁸

"Freedom and impartial judiciary" is the main characteristic and requirement for countries that adhere to the Anglo Saxon legal system and continental Europe that are aware of taking sides in upholding the rule of law principle.

There are three special characteristics of the rule of law in Indonesia which are outlined by legal science through the principles of the Rule of Law, namely⁹ :

1. Recognition and protection of human rights which implies equal treatment in the political, legal, social, economic, cultural, and educational fields;
2. Legality in the sense of law in all its forms; and
3. A judiciary that is free, impartial, free from all influences from other powers.

In deciding this case between RSO and PT. AGBS, the Judge decided by overriding the strong principle in Mark Registration, namely the first to file principle by prioritizing the principle of bad faith.

This is done by the judge by looking at all aspects and the situation of the case from the beginning, not only seeing from one point of view but also using a theoretical approach in making decisions, this is in order to achieve justice for the parties involved. According to Mackenzie, there are several theories or approaches that can be used by judges in considering the imposition of decisions in a case, which are as follows¹⁰ :

1. Theory of Balance The theory of balance is the balance between the conditions determined by law and the interests of the parties involved or related to the case.
2. Theory of Art and Intuition Approaches The decision making by the judge is the discretion or authority of the judge. As a discretion, in making a decision, the judge will adjust to the circumstances and a reasonable punishment for each perpetrator of a criminal act or in a civil case, the judge will see the condition of the litigating party. Theory of Scientific Approach The starting point of this science is the idea that the process of imposing a criminal offense must be carried out systematically and carefully, especially in relation to previous decisions in order to ensure the consistency of the judge's decision.
3. Theory of Experience Approach The experience of a judge is something that can help him in dealing with the cases he faces on a daily basis.
4. Ratio Decidendi theory This theory is based on a basic philosophical foundation that considers all aspects related to the subject matter in dispute and then looks for laws and regulations that are relevant to the subject matter of the disputed case as the legal basis in making decisions and judges' considerations must be based on clear motivation to enforce the law and provide justice for the litigants.
5. Theory of Wisdom The aspect of this theory is to emphasize that the government, society, family and parents are also responsible for guiding, educating, fostering and protecting the accused, so that in the future they can become useful human beings for their families, communities and nations.

1. The judge put forward the principle of bad faith in deciding between the RSO and PT. AGBS.

Law Number 20 of 2016 concerning Marks and Geographical Indications (MIG), which is a refinement of the existing Trademark Law, confirms that in the event of a dispute over a registered mark, a lawsuit for cancellation of the registration of the mark can be filed at the Commercial Court.

Brand registration is very important for consumers, because consumers will buy brands (stamps, symbols, symbols, and so on) which of course have quality and are safe for consumption.¹¹ Marks that cannot be registered are marks that are contrary to decency and public order, signs that do not have distinguishing features, signs or words of public property, and constitute information on or relating to goods or services to be registered. The absolute requirement of a brand must be fulfilled by every person or legal entity who wants to use a brand, namely that the mark must have sufficient distinguishing power. The brand as the identity of a brand will refer to the quality (quality) and price of a product or service that has been formed by the owner.¹²

⁸ Oemar Seno Adji, *Peradilan Bebas Negara Hukum*, Jakarta: Erlangga, 1987, Hal. 46.

⁹ Ibid, Oemar Seno Adji, *Peradilan Bebas Negara Hukum*, Hal. 167.

¹⁰ Ahmad Rifai, *Penemuan Hukum*, Jakarta, Sinar Grafika, 2010, Hal. 102.

¹¹ Suyud Margono, 2011, *Hak Milik Industri: Pengaturan dan Praktik di Indonesia*, Ghalia Indonesia, Bogor, hal. 79.

¹² Ok Saidin, *Aspek Hukum Kekayaan Intelektual (Intellectual Property Rights)*, Jakarta. Raja Grafindo Persada, 2004, Hal 330.

Consideration of the Judge's Decision Regarding the Principle of Ungood Faith in the Brand Registration Dispute Case Study Between Rso vs PT. AGBS

In a Mark, the First to File Principle is known, in which the principle grants exclusive rights as a mark that has been registered or a registration application has been made to use it as contained in Article 1 number 5 of Law Number 20 of 2016 concerning Marks and Geographical Indications (MIG), namely "Rights to a Mark are exclusive rights that are registered for a certain period of time by using the Mark itself or giving permission to others who use it"

Whereas furthermore, explicitly in Article 3 of the MIG Law regulates the first registration (First to File), which states "Rights to Marks are obtained after the mark is registered".

In other words, the sign used must be such that it has sufficient power to distinguish the goods produced by one person from the goods produced by others.¹³ In practice, in this discussion, there are trademarks that are accepted for registration by the Directorate General of Intellectual Property Rights even though the registered trademarks have been registered by other parties so that they are not in accordance with the provisions of Article 1 point 5 and Article 3 of Law Number 20 of 2016 concerning Marks and Indications. Geography that governs the First to File Principle.

In the case of RSO which owns the Geprek B-S Mark, the Registration date is 07 June 2018 with PT. AGBS which owns the I Am Geprek BS brand, the registration date is May 24, 2019. As for what happened in this case, if we clash the Registration date with the First to File Principle for the "BS" brand, it is clear that the RSO party that owns the BS Geprek Mark is the winner of the case. But in reality, in the Principal Case of the Decision of the Commercial Court Number 57/Pdt.Sus-Merek/2019/Pn Niaga Jkt.Pst, the RSO Plaintiffs have completely rejected the lawsuit. From the results of the author's analysis of the decision, it turns out that previously there was an agreement between PT. AGBS with RSO for RSO to become a Brand Ambassador with an agreement that RSO will get the Golden Share as evidence of the transfer from 09 May 2017 to 14 August 2017 which was sent by PT. AGBS to RSO so that RSO should have known that his position was as a Promotional Ambassador (Brand Ambassador) for the benefit of PT. AGBS is not the owner of the trading business of the PT. AGBS .

Mark registration aims to obtain legal certainty and legal protection of trademark rights. Trademark registration is carried out at the Directorate General of Intellectual Property.¹⁴ The Directorate General conducts an examination of the completeness of the requirements for registration of marks, namely the administrative requirements as stated in the first part regarding the requirements and procedures for the application, this is stated in Articles 4-8 of Law Number 20 of 2016 concerning Marks and Geographical Indications.¹⁵

A mark cannot be registered if it does not meet the provisions in Article 20, Article 21 and Article 22 of Law Number 20 of 2016 concerning Marks and Geographical Indications. In Article 21 paragraph (3) it is stated that: "An application is rejected if it is submitted by an applicant with bad intentions" and the Regulation of the Minister of Law and Human Rights of the Republic of Indonesia Number 67 of 2016 concerning Mark Registration in Article 16 paragraph (4) states that: " An application is rejected by the Minister if the application is submitted by an applicant who does not have good intentions".

As for the judge's consideration in deciding this case by canceling the Mark on behalf of RSO, it is to override the First to File Principle because there is a Bad Faith Principle carried out by RSO to control and or confiscate the trademark from PT. AGBS due to the results of the Brand A . agreement

D. CONCLUSION

From some of the descriptions that the author has conveyed, the conclusions from this writing are:

1. The judge in making the decision between RSO and PT. AGBS really considers everything contained in the trial, so that the law and the freedom of judges in deciding a case are the basis for judges when deciding the cases they face must provide a sense of justice for all parties.
2. The judge was of the opinion that RSO in registering its trademark had the intention of imitating, plagiarizing or following the mark of PT. AGBS for the sake of its business, causing conditions of unfair business competition, deceiving or misleading consumers so that the Judge is of the opinion that RSO is an applicant with bad intentions and overrules first to file in his decision.

E. BIBLIOGRAPHY

Books :

- 1) Iswi Hariyani, 2010, *Prosedur Mengurus HAKI yang Benar*, Pustaka Yustisia, Jakarta, hal. 6.
- 2) Soerjono Soekanto dan Sri Mamudji, *Penelitian Hukum Normatif Suatu Tinjauan*, hal 10

¹³ Ibid, Ok Saidin, *Aspek Hukum Kekayaan Intelektual (intellectual Property Rights)*, hal 67

¹⁴ Jisia Mamahit, "Perlindungan Hukum Atas Merek Dalam Perdagangan Barang Dan Jasa", *Lex Privatum*, Volume, 1. No. 3. Juli 2013. Hal. 92.

¹⁵ Ahmadi Miru , "*Hukum Merek : Cara Mudah Mempelajari Undang-Undang Merek*", (Jakarta : PT Raja Grafindo Persada, 2007), Hal. 34.

Consideration of the Judge's Decision Regarding the Principle of Ungood Faith in the Brand Registration Dispute Case Study Between Rso vs PT. AGBS

- 3) Mahkamah Agung RI, Penemuan hukum dan Pemecahan Masalah Hukum, Proyek Pengembangan Teknis Yustisial Mahkamah Agung RI.
- 4) Franz Magnis Suseno, Etika Dasar Masalah-Masalah Pokok Filsafat Moral, Jakarta: Pustaka Filsafat, 1987, hal. 33.
- 5) Oemar Seno Adji, Peradilan Bebas Negara Hukum, Jakarta: Erlangga, 1987, Hal. 46, Ibid, hal. 167.
- 6) Ahmad Rifai, Penemuan Hukum, Jakarta, Sinar Grafika, 2010, Hal. 102.
- 7) Suyud Margono, 2011, Hak Milik Industri: Pengaturan dan Praktik di Indonesia, Ghalia Indonesia, Bogor, hal. 79.
- 8) Ok Saidin, Aspek Hukum Kekayaan Intelektual (intellectual Property Rights), Jakarta. Raja Grafindo Persada, 2004, Hal 330, Ibid, hal 67.
- 9) Jisia Mamahit, "Perlindungan Hukum Atas Merek Dalam Perdagangan Barang Dan Jasa", Lex Privatum, Volume, 1. No. 3. Juli 2013. Hal. 92.
- 10) Ahmadi Miru, "Hukum Merek : Cara Mudah Mempelajari Undang-Undang Merek", (Jakarta : PT Raja Grafindo Persada, 2007), Hal. 34.

Legislation :

- 1) Republik Indonesia, Undang-Undang tentang Merek dan Indikasi Geografis. Undang-Undang Nomor 20 Tahun 2016
- 2) Republik Indonesia, Undang-Undang tentang Kekuasaan Hakim. Undang-Undang Undang-Undang Nomor 48 Tahun 2009.
- 3) Republik Indonesia, Peraturan Menteri Peraturan Menteri Hukum dan Hak Asasi Manusia tentang Pendaftaran Merek, Peraturan Menteri Hukum dan Hak Asasi Manusia Nomor 67 tahun 2016.
- 4) Putusan Pengadilan Niaga Nomor 57/PDT.SUS-MEREK/2019/PN Niaga JKT.PST.

Journal :

- 1) Anonim, <https://www.uspto.gov/trademarks-getting-started/trademark-process#step6> diakses pada tanggal 11 April 2021.
- 2) Anonim, <https://www.ipos.gov.sg/protecting-your-ideas/trade-mark/application-process> diakses pada tanggal 12 April 2021.