

Protection of Foreign Famous Brands Based on *the First-to-File* Principle in MONSTER and 4MONSTER Disputes

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Abstract

This study aims to analyze the application of the first-to-file principle in providing legal protection to trademark rights holders in Indonesia, especially in trademark disputes involving well-known brands. The background of this research is based on the fact that there is still a frequent conflict between legal certainty for the first registrant and substantive justice for those who have a reputation and use of the trademark first. The urgency of this research lies in the practice of trademark registration carried out in bad faith, which has the potential to cause unfair business competition and harm the owner of the brand in good faith. This research uses a normative juridical method with a legislative approach and a case approach, which focuses on Decision Number 12/Pdt.Sus-HKI/MemerK/2024/PN Niaga Central Jakarta related to the MONSTER and 4MONSTER trademark disputes. The novelty of this research lies in the proportional analysis of the application of the first-to-file principle in the latest commercial court decisions with an emphasis on the consideration of bad faith and the protection of well-known brands. The findings of the study show that although the Indonesian trademark legal system adheres to the principle of first to file which is constitutive, legal protection is not provided



absolutely if the trademark registration is carried out in bad faith. This article concludes that the ruling strengthens substantive justice and provides important guidelines in balancing legal certainty and fairness in trademark law enforcement in Indonesia.

KEYWORDS

Trademark Law, First Registration Principle, Legal Protection, Bad Faith

Introduction

In today's era of economic globalization and trade openness, brands have become one of the important instruments in business activities. A trademark does not solely serve as a marker of the identity of goods or services offered in commerce, nor does it serve as a representation of the reputation, quality, and trust of consumers in a business entity. For business actors, brands represent intangible assets with high economic utility and can provide a competitive advantage in the market. Therefore, trademark legal protection is an important aspect in ensuring legal certainty, justice, and the preservation of the economic rights of trademark owners.¹

In Indonesia, the regulation and legal protection of trademarks are regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Article 1 number (1) of the law defines a trademark as a sign that can be represented graphically, which includes elements represented through images, logos, names, words, and letters, numbers, color schemes in two and/or three dimensions, sound, holograms, or a combination of two or more such elements used to distinguish goods and/or services produced by natural persons or legal entities in trade activities. This law emphasizes that a trademark is an exclusive right granted by the state to a trademark owner who has been legally registered with the Directorate General of Intellectual Property (DJKI), where the right to a new trademark arises after registration.²

In the Indonesian legal system, trademark protection is regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications. This law defines a trademark as a sign that can be represented graphically and used to distinguish goods and/or services produced by natural persons or legal entities in the course of trade activities. Trademark rights are exclusive rights granted by the state to trademark owners who

¹ Selni Ardian, "First to File Trademark Principles and Rights Disputes in the First Indonesian Legislation Review to Submit Trademark Rights Principles and Disputes," *Journal of Islamic State Law and Politics* 5, No. 1 (2025): 431, <https://doi.org/https://doi.org/10.14421/jnj4gr96>.

² "Law Number 20 of 2016 concerning Trademarks and Geographical Indications," 2016.

have been legally registered with the Directorate General of Intellectual Property (DJKI), so that legal protection of trademarks is born after the fulfillment of the registration requirements.

The trademark ownership system in Indonesia is based on *the first-to-file* principle, which places registration as the main basis for the birth of trademark rights. This principle provides administrative legal certainty by making the party who first submits registration the rightful owner. However, in practice, the application of *the first to file* principle does not necessarily reflect substantive justice. Granting exclusive rights to the first registrant has the potential to overlook parties who have factually used the trademark before and have built a reputation through actual use, but have not yet registered. This condition opens up space for abuse of the registration system, especially through the practice of trademark registration in bad faith.³

This problem becomes even more complex when it comes to brands that already have a wide reputation. In Indonesian trademark law, the term used normatively is *a well-known trademark*, as stipulated in Article 21 paragraph (1) letters b and c of Law Number 20 of 2016. Although the law does not explicitly recognize the term famous trademark, in intellectual property legal doctrine the term is used to describe a brand with a very high level of reputation, broad public recognition, and a range of recognition that extends beyond a specific business sector and the territorial boundaries of a country. Conceptually, a well-known brand refers to a well-known brand in a relevant field of business, which can be proven through indicators of the level of public recognition, promotion intensity, period and region of use, sales volume, and registrations in different countries. From a doctrinal perspective, a well-known trademark is understood as an advanced qualification of a well-known brand that has *an exceptional reputation*, so it deserves broader legal protection, including for goods and/or services that are not of the same type.⁴

However, the application of the *first-to-file* principle in practice still leaves legal problems. The granting of exclusive rights to the first registrant has the potential to exclude parties who are actually the first users or original owners of the brand, but have not been registered in Indonesia. As

³ Nice Rahmanda. Damar Ramadhanna Tanjung, Rinitami Njatrijani, "Application of the First to File Principle in Famous Trademark Disputes," *Law, Development & Justice Review* Vol. 6, No (2023): 111–28.

⁴ Chairul Bariah Hasibuan, Khadijah, Okay. Saidin, Jelly Leviza, "Legal Protection of Famous Brands Against Reputational Swindling Acts (Study of Decision No.18 PK/Pdt.Sus-HKI/2021)," *Locus Journal of Academic Literature Review* 1, no. 5 (2022): 335–38, <https://doi.org/https://doi.org/10.56128/ljoalr.v1i6.84>.

a result, trademark owners who have previously used the trademark may lose their rights when the same trademark has been registered by another party. This condition ultimately harms business actors who have good faith and have built brand reputation through real use.

In such situations, the actual trademark owner is often forced to go through negotiations or assignments of rights with the party who has registered the trademark. On the other hand, DJKI does not have the authority to cancel a registered trademark directly, unless the registration is proven to be done in bad faith or by imitating a well-known trademark under the ownership of another party. Trademark cancellation can only be done through the mechanism of lawsuit in the Commercial Court and the decision of judicial consideration becomes the legal basis for the removal of a trademark from the General Register of Trademarks.

Legal remedies for aggrieved brand owners are essentially limited. Objections to trademark applications can only be filed during the registration process. If a trademark has been registered, the only legal avenue available is to file a cancellation lawsuit with the Commercial Court. This process is not simple because it takes time, cost, and complicated evidence, so it is often a burden for well-meaning brand owners.⁵

Intellectual Property Rights (IPR) represent the great potential of human creativity and innovation that is realized through various intellectual works. IPR is an intellectual resource that continues to develop and plays an important role in improving individual dignity and encouraging the progress of the nation, both from economic, social, and cultural aspects. Within the framework of IPR, brands have a strategic position and are often the object of legal debate due to their crucial function in business activities.

Conceptually, IPR is a form of ownership rights over the results of human thought that are manifested in works in various fields, such as science, technology, literature, design, and other creative sectors. Thus, IPR includes all the results of human intellectual activities that are born from the ability to think and create. Along with the times, legal problems related to IPR are also increasingly complex, from problems that were originally simple to increasingly complicated due to global economic and trade dynamics.

Trademark disputes are a form of competition that often occurs in the business world. These disputes are generally triggered by the similarity of brand names or design elements, either in their entirety or in certain parts,

⁵ Rendy Alexander et al., "Application of the 'First To File' Principle on the Concept of Trademark Registration in Indonesia," *Kertha Semaya Journal* 10, no. 9 (2022): 2112, <https://doi.org/https://doi.org/10.24843/KS.2022.v10.i09.p12>.

between brands belonging to different business actors. This condition becomes increasingly potential for brands that have been widely known or categorized as well-known brands, namely brands that have met the criteria of fame, gained public recognition, and have a wide market reach.

The emergence of trademark disputes shows that brands play an important role in business sustainability. Trademarks function as a means of distinguishing between products or services of business actors and similar products on the market. More than just the identity of the manufacturer, the brand also represents the quality, value, and level of consumer trust. The ease with which consumers recognize brands influences preferences and purchasing decisions, even driving brand loyalty. Therefore, the use of trademarks must be able to enable consumers to recognize and distinguish a company's products or services from competitors' products, thus establishing a sustainable relationship between the brand and the consumer.

Basically, a trademark serves as a distinguishing identity that gives a product special characteristics. Trademarks are not only used to identify and distinguish goods or services of business actors from competitor products in the market, but also have strategic value as commercial assets, especially for brands that have been widely known or classified as well-known brands. A trademark is said to have distinctiveness if it does not show substantial similarities with other marks, either for similar or dissimilar goods. Trademark similarity is prohibited if it has the potential to cause confusion about the origin of the goods or show similarities to the legally registered trademarks of another party. This similarity can occur in its entirety or in an important part of the brand, which is determined on the basis of the presence of the dominant element that gives rise to the similarities between the brands in question.⁶

Trademark registration used to distinguish goods and/or services produced or traded by a company gives birth to exclusive rights for its owners. With registered trademark status, the trademark owner has the right to use the trademark legally and prohibits others from using it without consent. In trade practice, brands, especially those that are already widely known, have high economic value and are treated as strategic commodities. Reputation or goodwill built through relationships between brands, products, and business activities is an important foundation in trade activities, including on an international scale.

⁶ Widya Annisa Pudji Lestari, "Legal Protection of Famous Trademarks on Trademark Applications Submitted in Good Faith (Study of Decree Number 1850 K/Pdt.Sus-HKI/2022)," *Scientific Journal "Advocacy"* Vol. 13, N (2025): 779–81, <https://doi.org/https://doi.org/10.36987/jiad.v13i3.7604>.

Unauthorized use of a trademark generally occurs when a trademark has similarities, either in whole or in substance, with a trademark belonging to another party. Overall similarity refers to similarities that are identical in terms of shape and appearance, whereas similarities are basically characterized by the similarity of key elements that can create the impression of a relationship between two brands. The act of using a trademark without rights is regulated in Article 83 paragraph (1) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which provides a legal basis for registered trademark owners to demand the protection of their rights.

The act of using a trademark is declared invalid if it is done without the authorization of the registered trademark owner. Basically, the use or imitation of a registered trademark is possible as long as it is done with the permission of the trademark owner through a license agreement. On the other hand, if the use is made without the knowledge and consent of the rights holder, then the act can qualify as trademark infringement.

In the examination of trademark infringement cases, there are two main criteria that can be the basis for granting a lawsuit. The plaintiff must be able to prove that the defendant's trademark has, first, substantially resembled the plaintiff's trademark; Or second, the use of the brand has the potential to mislead consumers in the process of purchasing goods or services. This kind of violation is often associated with the concept of *passing off*, which is an act that causes unfair business competition through the use of another party's reputation.

Although the concept of *passing off* is known as a detrimental practice in the realm of Intellectual Property Rights, until now there is no specific provision in Indonesian laws and regulations that explicitly govern this act. Therefore, *passing off* has not been qualified as a stand-alone violation of the law, but rather is seen as part of fraudulent competition carried out irresponsibly by business actors.

In practice, disputes related to *passing off* are quite frequent in Indonesia. However, because there are no special regulations related to unfair business competition practices, and unlawful acts, as well as trademark infringement that explicitly includes *passing off*, the Directorate General of Intellectual Property generally only handles *passing off* cases that at the same time meet the elements of trademark infringement.⁷ However, there is a normative basis that can be used to assess these actions,

⁷ Slamet Pribadi Dwi Seno Wijanarko, "Preventive Legal Protection of Trademarks in Indonesia Based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications," *Logic: Journal of Research of Kuningan University* 13, no. 02 (2022): 194–95, <https://doi.org/https://doi.org/10.25134/logika.v13i02.7178>.

including Article 7 of Law Number 8 of 1999 concerning Consumer Protection which requires business actors to carry out their business activities in good faith.⁸

However, the practical application of *the first-to-file* principle in practice often raises legal issues, especially when trademark registration is done in bad faith. It is not uncommon for this principle to be used by certain parties to hitchhike the reputation of widely known brands, both national brands and well-known foreign brands, with the aim of obtaining economic benefits illegally. This condition has the potential to harm well-intentioned brand owners, cause unfair business competition, and weaken the purpose of brand legal protection itself.⁹

The case of the trademark dispute between Monster Energy Company (United States) and Jiangsu 4Monster Industrial Co. Ltd. (China) is a concrete example of the problematic use of *the first approach to filing* in the legal practice of trademark registration in Indonesia. In the decision of the Central Jakarta Commercial Court Number 12/Pdt.Sus-HKI/MemerK/2024/PN Niaga Jkt.Pst, which was decided on March 26, 2025, the panel of judges reasoned that the 4Monster trademark logo was proven to have substantial similarities with the well-known brand Monster and was registered in bad faith. The court affirmed that Monster is a well-known trademark that has been widely used and registered in various countries, so the registration of 4Monster is considered a form of reputation riding that harms the owner of the brand in good faith. This decision confirms that the *first-to-file principle* cannot be applied absolutely without considering the elements of similarity of brand and bad faith, and demonstrates the important role of judges in balancing the certainty of administrative law and substantive justice in the protection of well-known trademarks.¹⁰

The urgency to protect well-known brands is becoming increasingly relevant given the nature of well-known brands that have strong differentiating power and reputations that have been established through massive investments, ongoing promotions, and consumer recognition. In this regard, trademark legal protection is not solely oriented towards

⁸ "Law Number 8 of 1999 concerning Consumer Protection.," n.d.

⁹ Humaedi Abdurahman, "The first to propose the main principle in the case of trademark rights of the famous name Benu," *Legal Journal* Vol. 3 No. (2020): pp. 428-443, <https://doi.org/https://doi.org/10.29313/aktualita.v0i0.6056>.

¹⁰ Dandapala Team, "MONSTER Beverage Rolls Brand 4MONSTER From China at the Central Jakarta District Court," *Dandapala Contributors*, 2025, <https://dandapala.com/article/detail/minuman-monster-gulung-merek-4monster-dari-china-di-pn-jakpus>.

administrative certainty, but must also take into account substantive justice and the principle of good faith. Therefore, the *first-to-file* principle cannot be applied absolutely, without considering the substance and purpose of trademark law protection.

However, the use of *the first to file* principle in practice is not always ideal. A number of previous studies have examined this issue with a diverse focus. The research of Marcella Abrillia, Maya Ruhtiani, and Marlia Hafny Afrilies (2025) analyzes disputes between registered trademarks KASO and KASOMAX through normative approaches and case studies with an emphasis on the application of *the principles of first to file*, discriminatory, and bad faith cumulatively, but has not focused on the legal position of the first registrant.¹¹ Widya Annisa Pudji Lestari, Yuniar Rahmatiar, and Muhamad Abas (2025) examined the protection of well-known brands against registration applications in bad faith, but have not made the *principle of first to file* the main focus of the analysis. Furthermore, Nadhila Cahya Nurmalasari and Yudho Taruno Muryanto (2024) examined the principle of *first to file* as preventive protection in the MS GLOW and PS GLOW disputes, but have not explored its application in the judge's consideration.¹² Meanwhile, Sigit Wibowo (2023) examines the protection of registered trademark holders at the cassation level, but has not examined the application of *the first-to-file principle* in the latest Commercial Court decision and its implications for the legal certainty of the first registrant.¹³

Although various previous studies have made important contributions, the focus of his research is still limited to normative analysis of legal provisions or court decisions separately. A major drawback of previous research lies in the absence of a study that specifically analyzes the enforcement of *the first-to-file* principle in recent commercial court decisions by focusing on the judge's consideration of the dominant elements, overall impression of the brand, and evidence of bad faith in well-known trademark disputes.

¹¹ Marcella Abrillia, "Juridical Analysis of Decision Number: 115/Pdt.Sus- Brand/2022/Pn.Niaga. Jkt.Pst about the trademark dispute of Kaso and Kasomax," *Journal of Law, Economics, and English* Vol. 7, No (2025): 57–58, <https://doi.org/https://doi.org/10.35960/j-lee.v7i1.1887>.

¹² Nadhila Cahya Nurmalasari, "Analysis of the Application of the First Principle Proposed for Preventive Legal Protection (Trademark Dispute Study Between MS GLOW and PS GLOW)," *Activism : Indonesian Journal of Educational, Political and Social Sciences* Vol. 1 No. (2024): 39–41, <https://doi.org/https://doi.org/10.62383/aktivisme.v1i2.191>.

¹³ Sigit Wibowo, "Legal Protection for Registered Trademark Holders with the Application of the First Submission Principle to Other Parties (Case Study of Supreme Court Decision Number 161k/Pdt.Sus-HKI/2023)," *Caraka Justitia Law Journal* 3, no. 2 (2023): 127–45, <https://doi.org/https://doi.org/10.30588/jhcj.v3i2.1675>.

Based on the research gap, this research has an element of novelty by examining in depth Decision Number 12/Pdt.Sus-HKI/Brand/2024/PN Niaga Central Jakarta in the trademark dispute between MONSTER and 4MONSTER. This decision is interesting to analyze because the panel of judges not only based its consideration on the *first-to-file* principle, but also considered the similarity of the main points, dominant elements, and indications of bad faith in trademark registration. This research aims to fill in the gaps in previous research that generally discussed normative aspects and protection of well-known brands, but has not placed the *principle of first to file* as the main focus in the context of the latest Commercial Court decision. Through a normative legal approach with a statutory approach and a case approach, this study analyzes the application of *the first-to-file* principle in the judge's consideration to provide a more comprehensive understanding of legal protection and legal certainty for the first registrant, as well as examines the implications of commercial court decisions in balancing legal certainty and substantive justice in Indonesian trademark law.

The main legal problem in this study is how to apply the principle of *first to file* in the Indonesian trademark law system when dealing with trademark registration carried out in bad faith, as well as how the judge's legal considerations in providing protection for well-known trademarks. Based on these problems, the research questions are formulated as follows: (1) how to apply the *principle of first to file* in Indonesian trademark law; (2) how the Panel of Judges considered Decision Number 12/Pdt.Sus-HKI/MemerK/2024/PN Niaga Central Jakarta to provide legal protection for well-known foreign brands in the trademark dispute between MONSTER and 4MONSTER; (3) how to assess bad faith in the 4MONSTER Brand Registration against MONSTER Foreign Famous Brands as a Form of Reputation Utilization.

Based on this description, the application of the first doctrine *proposed* in Indonesian trademark law raises crucial problems when dealing with trademark registration that is carried out in bad faith, especially for well-known brands. This condition has the potential to weaken legal certainty, harm well-meaning brand owners, and encourage unfair business competition. The novelty of this research lies in the analysis of the application of *the first-to-file principle* in the latest commercial court decision by focusing on the judge's consideration of the dominant elements, similarities in essence, and evidence of bad faith. This research specifically examines Decision Number 12/Pdt.Sus-HKI/MemerK/2024/PN Niaga Central Jakarta in the trademark dispute between MONSTER and 4MONSTER. The results of the research are expected to make a conceptual

and practical contribution in balancing administrative legal certainty and substantive justice in trademark law protection in Indonesia.

Methods

This study uses a normative legal research approach with a qualitative approach, which aims to analyze the legal protection of trademark rights holders based on *the principle of first to file*. The legislative approach is carried out by examining the legal provisions that regulate trademarks, especially Law Number 20 of 2016 concerning Trademarks and Geographical Indications, while the case approach is carried out through the analysis of Decree Number 12/Pdt.Sus-HKI/Brands/2024/PN Niaga Central Jakarta. The specification of this research is descriptive-analytical, namely describing and analyzing the application of legal norms and judges' considerations in resolving trademark disputes.¹⁴

The data used in this study is secondary data obtained through literature studies, which includes primary, secondary, and tertiary legal materials. Primary legal materials consist of laws and regulations in the field of trademarks and court decisions that are the object of research, while secondary legal materials are in the form of books, scientific journals, and opinions from related experts. Furthermore, tertiary legal material is used as a support to clarify legal concepts. The data that has been collected is analyzed qualitatively through legal interpretation and construction, by linking the applicable legal norms with the judge's consideration, so as to obtain a comprehensive understanding of the *enforcement of doctrine and the first trademark to apply* and legal protection for trademark rights holders.¹⁵

Result and Discussion

1. Application of the First to File Principle in Trademark Law in Indonesia

¹⁴ M.S. Prof. Dr. Peter Mahmud Marzuki, S.H., *Legal Research* (Surabaya: Kencana, 2021).

¹⁵ S. Soekanto, S., & Mamudji, *Noritative Legal Research: A Brief Review*. (Jakarta: RajaGrafindo Persada, 2014).

Indonesia's trademark law system adheres to the principle of *first to file*, which places registration as the main basis for the emergence of trademark rights. This principle theoretically aims to guarantee legal certainty, as it provides clarity regarding who is legally recognized as the owner of the trademark based on registration data. In the context of industrial development and increasing business competition, this system is seen as important to create administrative certainty that supports an orderly and predictable trade climate.

The rapid development of the industry encourages increased business competition in various trade sectors. This condition also raises various legal problems, one of which is the practice of using another party's trademark illegally to gain economic benefits. Brands that have become widely known are often used as counterfeit objects to support their reputation and attractiveness, thus causing unfair business competition practices.

Conceptually, a trademark is defined as a mark, whether in the form of an image, name, word, letter, number, color scheme, or a combination of both, that has distinguishing power and is used in commercial activities. Brands function as identities in marketing activities, making it easier for consumers to recognize and distinguish a good or service from other similar products. In the context of the industry, trademarks are closely related to the goods being traded and are the main instrument in distinguishing the products of one business actor from another.¹⁶

The phenomenon of trademark disputes in trade activities in Indonesia shows a fairly high intensity, reflected in the increasing number of trademark case filings. This shows that brands have an important role as a company's goodwill in attracting consumer interest. The existence of a brand not only serves as a marketing tool, but also becomes a representation of the values and beliefs inherent in a product or service.

Indonesia implements a *first to file* system in trademark registration, where the right to a trademark is born after legal registration. In this system, the party who obtains the right is the applicant who first submits the registration, as long as it is done in good faith, unless it can be proven that there are contrary circumstances. The

¹⁶ Kadek Julia Mahadewi, "Application of the First Principle Proposed in Trademark Dispute Cases: A Brand Law Perspective in Indonesia," *Open Journal System* Vol.19 No. (2025): 5970–72, <https://binapatria.id/index.php/MBI/article/view/1208>.

mechanism reflects the application of *the first-to-file* principle as the main basis for trademark protection in Indonesia.¹⁷

The *first to file* principle is a principle applied in the trademark registration system in Indonesia, where the party who first applies for registration gets priority to be recognized as the trademark owner. However, based on the provisions of Article 21 paragraph (3) of Law Number 20 of 2016 which states that the application for registration is rejected if submitted by the applicant in bad faith, it can be understood that legal protection is only given to applicants who act in good faith. Applications submitted in good faith cannot obtain protection and will be rejected. Therefore, in every trademark registration application, a substantive examination is required to assess whether the proposed trademark meets the provisions of the law and does not conflict with the applicable laws and regulations in Indonesia.¹⁸

In this case, the *principle of first to file* is in principle still relevant in the Indonesian trademark legal system because it serves to ensure legal certainty and administrative efficiency in trademark registration. By making registration the basis for the birth of rights, this principle provides clarity about who is legally recognized as the owner of a trademark, and supports administrative order in modern trade activities that demand certainty and standardization. Therefore, the *first-to-file principle* remains necessary as a general principle in trademark protection.

However, the *first to file* principle cannot be understood as an absolute principle. Under certain circumstances, this principle should be set aside in order to ensure substantive justice and prevent abuse of the registration system. Normatively, Law Number 20 of 2016 has provided a correction to this principle through Article 21 paragraph (3), which emphasizes that registration applications submitted in bad faith must be rejected or can be canceled.

In the protection of well-known brands, the *principle of first to file* should be set aside if it is proven that the registration is carried out to hitchhike reputation (*free riding*), cause brand obscuration (*dilution*), or have the potential to mislead consumers. Saidin emphasized that the protection of well-known trademarks does not solely rely on the formal

¹⁷ Good Rahmanda. Damar Ramadhanna Tanjung, Rinitami Njatrijani, "Application of the First Filing Principle in Famous Trademark Disputes," *Overview of Law, Development & Justice* Vol. 6, No (2023): 111–28.

¹⁸ Mutia Kirana Aprilia R. Rahaditya, "The Application of the Principle of Good Faith in Legal Protection for Well-Known Brands Not Registered in Indonesia Based on the Supreme Court Decision Number 600 K/PDT. SUS-HKI/2020," *Journal of Citizenship* 7, No. 1 (2023): 982.

aspects of registration, but also on the reputation and *goodwill* that has been attached to the trademark, so the law must provide broader protection for well-known trademarks from the practice of registration in bad faith, the first-to-file principle remains relevant as a general principle, but must be limited and can be set aside in the condition that there is a well-known brand, there are strong indications of bad faith, and if the application of the principle has the potential to cause substantive injustice and legitimize reputational hitchhiking. This approach affirms that trademark protection is not only oriented to the certainty of administrative law, but also to substantive justice and the protection of reputation as a legitimate economic asset.¹⁹

According to OK. Saidin, legal protection of trademarks is not only intended to give exclusive rights to brand owners, but also to protect the function of brands as a distinguishing mark, quality assurance, and economic assets that have commercial value. Therefore, trademark law must prevent the use or registration of trademarks that imitate or hitchhike the reputation of other brands, as such actions have the potential to mislead consumers and harm brand owners who already have *goodwill*.²⁰

In comparison, the application of *the first-to-file* principle in China's trademark law system shows similarities with Indonesia in placing registration as the main basis for the birth of trademark rights. Under China's Trademark Law, exclusive rights to trademarks are granted to the party who first legally registered his trademark with the competent authority, so that registration serves as the primary instrument of legal proof and certainty. This system confirms that China, like Indonesia, adheres to a system of constitutional protection, in which trademark rights are not born from use alone, but from state recognition through official registration.

The selection of China as the object of comparison in this study has a strong scientific and methodological basis. Indonesia and China both adhere to a *first-to-file* system, so they are within the framework of a comparable legal system to be analyzed comparatively. This similarity allows for an equal comparison in assessing how the *first-to-file* principle is applied and limited in practice to protect well-known brands.

¹⁹ Henry Arianto, "Responsive Law and Law Enforcement in Indonesia," *Lex Journal* Vol. 07 No (2010): p. 115.

²⁰ M.Hum. Dr. H. Ok. Saidin, S.H., *Legal Aspects of Intellectual Property Rights* (Jakarta: RajaGrafindo Persada., 2007).

In addition, both countries face serious problems related to trademark registration in bad faith (*trademark squatting*), especially against well-known foreign brands. Historically, China has been known as a jurisdiction with a high rate of *trademark squatting*, prompting trademark law reform to strengthen corrective mechanisms against registrations made in bad faith.

However, the application of *the first-to-file principle* in China is not absolute. In line with the development of international trademark law and the increasing practice of *trademark squatting*, China's trademark law is developing a corrective mechanism against registrations made in bad faith. Protection of a well-known brand, including unregistered but well-known trademarks, is granted if it can be proven that its reputation and fame can be proven, and there is an indication that the registration was made to promote the good name of another party. The relevant authorities, in particular the National Intellectual Property Administration of China (CNIPA), are authorized to refuse or cancel trademark registrations filed without a reasonable business relationship or that are potentially misleading to consumers.²¹

Based on a comparison of the trademark law system between Indonesia and China, there are several best *practices* in the Chinese trademark law system that are relevant to be considered and adopted in strengthening trademark protection in Indonesia, especially in dealing with trademark registration in bad faith and well-known brand protection.

First, China strengthens the role of administrative authorities in preventing the registration of trademarks in bad faith from the inspection stage. *China's National Intellectual Property Administration* (CNIPA) has more active authority to assess indications of *trademark squatting*, including rejecting applications submitted without a reasonable business relationship or that show a pattern of registering a well-known trademark belonging to another party. This preventive approach is important because it allows trademark protection to be carried out before disputes progress to the judicial realm. Compared to Indonesia, this mechanism is more efficient because it reduces reliance on corrections through annulment lawsuits in court.

Second, China developed more progressive evidentiary standards in assessing bad faith, including taking into account the applicant's

²¹ Teguh Hartono Triyono Adi Saputro, "Geographical Indication Protection System: A Comparison Between Indonesia and China," *Jurnal Sapientia et Virtus* Volume 8, no. Number 1 (2023): 173–76.

registration history, trademark registration patterns that mimic well-known brands, and the absence of actual brand use intentions. This approach allows authorities to identify *bad faith* more substantively, not solely on administrative formalities. This practice can be a reference for Indonesia to expand the indicators of bad faith assessment in substantive examinations at the Directorate General of Intellectual Property (DJKI).

Third, China provides more effective protection against well-known brands, including unregistered ones, by placing reputation and fame as an important basis for rejecting or cancelling brands that have the potential to piggyback on reputation. This approach strengthens the protection of *goodwill* and prevents brand dilution. In the Indonesian context, strengthening the role of reputation as the main factor from the administrative stage can reduce the space for trademark registration in bad faith.

Fourth, China's strong administrative approach allows for faster and more efficient settlement of trademark disputes, thereby reducing the burden on the courts. This is in line with the needs of the modern business world that demands fast, simple, and low-cost legal certainty. Indonesia can consider strengthening the authority and capacity of the DJKI so that it is not only administrative-formal, but also substantive in assessing potential violations and bad faith.

Overall, China's practice shows that the *first-to-file* principle can be retained as a general principle, but must be complemented by a robust, preventive, and good-faith assessment administrative mechanism. This model is relevant to be used as a reference for Indonesia to strengthen the protection of well-known brands and prevent the misuse of the trademark registration system as a means of legitimacy for reputational plagiarism.²²

This comparison shows that both Indonesia and China adopt the *first-to-file* principle as the basis for trademark protection, but complement it with corrective instruments based on good faith. The difference lies in the intensity and approach to applying corrections. In China, the assertion of the ban on the registration of bad faith is growing rapidly in response to international trade pressures and rising foreign trademark disputes. Meanwhile, in Indonesia, corrections to the *principle of first to file* are mostly carried out through judicial

²² Elfrida Ratnawati Gultom Djuliana, "Comparison of the Legal System Between Indonesia and China Related to the Protection of Famous Unregistered Trademarks," *Ensiklopedia of Journal* 5, no. 4 (2023): 581–89, <https://doi.org/https://doi.org/10.33559/eoj.v5i3.1888>.

mechanisms, as reflected in Decision Number 12/Pdt.Sus-HKI/Memerk/2024/PN Niaga Central Jakarta, which places the substantive assessment of good faith as a determining factor in the provision of legal protection.

To overcome these weaknesses, Indonesian trademark law does not apply the *principle of first to file* absolutely. Article 21 paragraph (3) of Law Number 20 of 2016 provides a substantive correction by rejecting or canceling trademark registration submitted in bad faith. With this mechanism, the protection values in the *first-to-file principle* are still implicitly adopted as an evaluative standard for the validity of trademark registration. This approach emphasizes that the *first-to-file principle* in Indonesian trademark law must be applied in a balanced manner, not only oriented towards the certainty of administrative law, but also on the protection of fairness and fair business competition.

One of the real representations of this dispute is reflected in Decision Number 12/Pdt.Sus-HKI/Memerk/2024/PN Niaga Central Jakarta. This case involves Monster Energy Company as the Plaintiff, the owner of the internationally known Monster trademark, against Jiangsu 4Monster Industrial Co., Ltd as the Defendant who registered the trademark 4MONSTER + Logo. At the heart of the problem lies in the visual, phonetic, and conceptual similarities between the two brands. The Defendant's use of the word Monster is considered capable of misleading consumers and creates a strong relationship with the Plaintiff's well-known brand.

The Panel of Judges in the decision gave a *ratio decidendi* which emphasized that the registration of a legally valid trademark administratively does not necessarily provide legal protection if it is proven to violate the aspect of good faith.

However, the *first to file* principle also has fundamental weaknesses, especially with legal certainty. Proving who is using a trademark for the first time is often complicated, requires detailed factual evidence, and has the potential to lead to protracted disputes. This condition is considered inefficient in the realm of modern and global trade that demands fast, simple, and standardized legal certainty. Therefore, many countries, including Indonesia, choose *the first filing system* as the basis for trademark legal protection to ensure legal certainty and administrative effectiveness.²³

²³ Muhammad Syahrul Maulana, "Legal Certainty of the Application of the First Submission Principle on Trademarks in Indonesia (Case Study of Court Decision No.2/Pdt.Sus.Hki.Memerk/2022/Pn.Niaga.Sby)," *Unes Legal Review*, No. 4390–4392 (2023), <https://doi.org/https://doi.org/10.31933/unesrev.v5i4>.

2. Legal Considerations of the Panel of Judges of the Commercial Court in the Monster and 4Monster Trademark Dispute

In general, trademarks are defined as the embodiment of intellectual property rights born from human creativity, just like patents in the IPR regime. Trademarks may contain elements of creation, such as designs, logos, or certain letterforms, and their use is limited to the trading activities of goods and/or services available on the market, so as to have economic value for their owners.

In practice, disputes involving well-known trademarks are generally resolved in the realm of civil law, both involving individuals and business entities. Law Number 20 of 2016 concerning Trademarks and Geographical Indications provides a legal basis for interested parties, especially well-known brand owners in good faith, to file a trademark cancellation lawsuit as stipulated in Article 76 and Article 77. A cancellation lawsuit is filed with the Commercial Court, and in the event of a dispute involving a well-known foreign trademark, the absolute authority to examine and decide the case lies with the Central Jakarta Commercial Court, as affirmed in Article 85 paragraph (2) of the Trademark and Geographical Indications Law.²⁴

This provision is concretely reflected in Decision Number 12/Pdt.Sus-HKI/Memerk/2024/PN Niaga Central Jakarta, where the Panel of Judges first considers the absolute and relative authority of the Central Jakarta Commercial Court and assesses the fulfillment of the formal requirements of the lawsuit as stipulated in Article 76 paragraph (1) and paragraph (2) of Law Number 20 of 2016. This consideration shows that the Panel of Judges has placed the principle of legal certainty as the initial basis before entering the material examination of trademark disputes, so that the judicial process runs in accordance with the provisions of procedural law and the principles of legal process.

On the subject, the Panel of Judges determined that the Plaintiff had successfully established itself as the first user and legal owner of the Monster trademark. This is based on proof of registration of Monster's trademark which has been registered in Indonesia and in various other countries long before the Defendant registered the application for

²⁴ Medisita Nurfauziah Istiqmalia, "Good Faith in Trademark Registration: A Study on Legal Protection of Famous Trademark Owners in Indonesia," *Indonesian Law Enforcement Journal (JPHI)* 2, no. 3 (2021): 413–18, <https://doi.org/https://doi.org/10.51749/jphi.v2i3.10>.

registration of the 4Monster trademark. Based on these facts, the Panel of Judges is of the opinion that the Plaintiff has a legal interest in filing a trademark cancellation lawsuit as referred to in Article 76 of Law Number 20 of 2016. The author considers that this consideration is in line with the *principle of first to file* adopted in Indonesian trademark law, where prior registration gives exclusive rights to trademark owners. Thus, the Plaintiff's claim as the rightful owner of the Monster trademark is considered reasonable under the law and reflects the state's protection of the certainty of intellectual property rights.

Furthermore, the Assembly assesses the fame of the Monster brand by referring to the criteria of well-known brands as stated in laws and regulations, including the level of public knowledge, the period of use of the brand, the area of registration and use of the brand, the intensity of promotion, and the registration of brands in various countries. Based on the evidence submitted by the Plaintiff and strengthened by the jurisprudence of the Supreme Court regarding a well-known trademark, the Panel of Judges concluded that the Monster trademark has fulfilled the elements of being a well-known trademark, this judge's conclusion is normatively appropriate because it has met the legal indicators of a well-known trademark, but it would be stronger argumentative if the consideration also explicitly affirms the influence and recognition of the Monster trademark in the Indonesian market. However, the designation of the Monster brand as a well-known brand remains relevant and legally valid, so that the brand is entitled to broader protection, both for similar and non-similar goods, as referred to in Article 21 paragraph (1) and paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications.

The Panel of Judges considered that there was a similarity in principle between the Defendant's 4Monster logo brand and the Plaintiff's Monster brand. Based on the doctrine prevalent in Indonesian jurisprudence, the assessment of equality is basically carried out through three main aspects: visual, phonetic (*sound of speech*), and conceptual. Visually, the use of the word Monster as the dominant element creates a similar visual impression, although the Defendant adds the number "4" in front of it. Phonetically, the addition of these numbers does not eliminate substantial similarities in sound when a brand is pronounced by consumers. Meanwhile, conceptually, both brands convey the same idea or message to the audience. An approach that focuses on the dominant element is judged appropriate and in line with *the essential part doctrine*, as the equivalence assessment should essentially focus on the part of the brand that has the main distinguishing power and is most memorable to the consumer. In trademark law practice,

consumers tend to remember and recognize brands based on their most prominent or dominant features, rather than on the overall composition of the brand technically. This approach is essential to maintain the integrity of the brand's function and prevent the practice of deceiving consumers through minor modifications to well-known brands.

In addition, the court also considered that there was an element of bad faith in the registration of the trademark with the 4Monster logo by the Defendant. This judgment is based on the fact that Plaintiff Monster's trademark has been registered and widely known beforehand, so it is reasonable to suspect that Defendant intends to imitate, follow, or support Plaintiff's trademark fame for undue gain. This action is considered contrary to the principle of honesty in trademark registration and is included in the category of unfair business competition as referred to in Article 21 paragraph (3) of Law Number 20 of 2016. According to the author, this consideration is not only normatively appropriate, but also important in order to foster a healthy business climate, since trademark registration must be done based on creativity and good faith, not by taking advantage of the reputation of another party.

The court considered the attitude of the defendant who never appeared at the trial even though he had been legally summoned. The absence resulted in the case being decided in a manner and was seen as the absence of a rebuttal to all the postulates and evidence submitted by the Plaintiff. The author considers that even though *the verdict is legally valid*, the Panel of Judges still shows caution while still outlining substantial legal considerations. It is important that the verdict is not based solely on the absence of the Defendant's defense, but on an objective and comprehensive legal analysis.²⁵

Based on all these considerations, the Panel of Judges based on Article 76 paragraph (1) and paragraph (2) as well as Article 21 paragraph (1) and paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, stated that the Plaintiff's lawsuit was justified according to law, granted the lawsuit in its entirety, and canceled the Defendant 4Monster's trademark from the General Register of Trademarks.

Based on the theory of legal values put forward by Gustav Radbruch, law is not solely oriented to legal certainty, but must also consider justice

²⁵ Directory of Decisions, Supreme Court, and the Republic of Indonesia, "Decision of the Central Jakarta Commercial Court Number 12/Pdt.Sus-HKI/MemerK/2024/PN Niaga Central Jakarta,," n.d.

and utility. In trademark disputes, the rigid application of the *first-to-file* principle has the potential to cause substantive injustice, especially when used to protect the party who registers the trademark in bad faith and hitchhikes the reputation of a well-known brand. Therefore, the *principle of first to file* should theoretically be placed as a principle of a relative nature, subject to correction based on the value of justice and protection of legitimate interests.

This approach shows that trademark protection in Indonesian law is not only administrative-formal, but also contains a substantive dimension that emphasizes the importance of good faith. The *first-to-file principle* remains relevant as an instrument of legal certainty, but it can and should be set aside under certain circumstances, especially when dealing with well-known brands and there are strong indications of bad faith.

In practice, the application of the *first-to-file principle* is not solely based on the order of trademark registration, but also takes into account the existence of an element of good faith on the part of the applicant. This principle correlates with the principles of legal certainty and justice, where the protection of a trademark rests not only on the administrative aspects of registration, but also on the legitimate intention to use the trademark honestly in commercial activities.²⁶

The author in principle agrees with the consideration and warning of Decision Number 12/Pdt.Sus-HKI/Memerk/2024/PN Niaga Central Jakarta. The Panel of Judges did not solely base the assessment on the administrative registration aspect, but also considered the similarities in essence, the dominant elements of the brand, and indications of bad faith in trademark registration. This approach reflects the application of substantive justice and provides proportionate protection to well-known brand owners.

Although the decision is considered to be appropriate, this research is still relevant because in practice, the principle of *first to file* is often abused through trademark registration which is carried out in bad faith. Thus, the focus of the analysis does not lie solely on the final result of the verdict, but on the corrective mechanism carried out by judges in limiting the application of *the first-to-file* principle so that it is not used as a means of legitimacy of reputational gain.

²⁶ Putri Tamara Panjaitan, "Application of the First Submission Principle as Trademark Legal Protection in the TikTok Ltd vs Fenfiana Saputra Dispute," *Journal of Welfare State Law* 4, No. 2 (2025): 283, <https://doi.org/https://doi.org/10.56013/welfarestate.v4i2.4148>.

This decision is analyzed as a concrete example of how administrative principles can be limited by the principles of good faith and protection of well-known brands, thus creating a balance between legal certainty and substantive justice. Although the verdict is considered appropriate, this decision also shows that there is room for academic study, especially regarding the limitations of the application of *the first-to-file principle* when dealing with the protection of well-known trademarks and the principle of good faith, which deserves further study in the development of trademark law in Indonesia.

According to the author, this ruling has provided adequate legal protection given to well-known trademarks and at the same time affirms the firm attitude of the commercial court towards the practice of trademark registration in bad faith, so that it can be used as an important reference in the enforcement of trademark law in Indonesia.²⁷

3. Bad Faith and Reputation Utilization in 4Monster's Trademark Registration of Monster's Famous Brand

Trademark registration without a legitimate basis of rights tends to occur in brands that already have a certain level of fame, as they have a reputation of high economic value. This condition is often taken advantage of by parties with bad intentions to gain profits by taking advantage of the other party's brand reputation. Although reputation is intangible, its existence is an important asset for brand owners and has legal significance and therefore requires protection. In trademark law doctrine, the act of taking advantage of another party's brand reputation that could potentially lead to misleading or misleading consumers is known as *passing off*.

The concept of *passing off* or utilizing the reputation of another party basically developed in the *common law* system and is not explicitly known in the civil law tradition. *Passing off* occurs when a party markets its goods or services in such a way that it gives the impression as if the goods or services come from, are related to, or receive support from other parties who are widely known and reputable. Such practices have the potential to cause infringement among consumers and result in losses for trademark owners whose reputation is exploited without rights, behavior that is in line with the characteristics of *passing off* can be qualified as an act of bad faith,

²⁷ "Law Number 20 of 2016 concerning Trademarks and Geographical Indications."

especially if the trademark registration application has substantially or overall similarities with other trademarks. This is in line with the provisions of Article 21 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications which emphasizes that the application for trademark registration must be rejected if submitted by the applicant in bad faith, namely the party who is suspected of acting in bad faith to imitate, plagiarize, or follow the trademarks of other parties in order to obtain unreasonable business profits, thus causing unfair business competition and potentially engaging in practices that mislead or deceive thinkers.²⁸

In trademark law, the principle of *good faith* is a fundamental principle that must be attached to every trademark registration application. This principle requires that each party applying for trademark registration act honestly, reasonably, and not intend to harm other parties. In the doctrine of intellectual property law, good faith is understood not only as the subjective attitude of the applicant, but also as an objective standard used to assess whether an application for registration is made in accordance with the purpose and function of trademark law.²⁹

Some intellectual property law experts assert that the principle of good faith serves as an instrument to prevent the abuse of the trademark registration system, especially in the form of free riding practices. Free riding is understood as the act of riding on the fame, reputation, and goodwill of another party's brand to gain economic benefits illegally. Such practices are seen as contrary to the main purpose of trademark protection, which is to protect *the distinctive function*, reputation, and legitimate economic interests of the trademark owner.

Rahmi Jened stated that trademark registration carried out with the intention of imitating or rigging on the reputation of another party's brand can be qualified as a registration in bad faith, so it does not deserve legal protection even though it has been formally registered. In a theoretical perspective, the principle of good faith serves as a normative constraint on the application of the *first to file* principle, which is not absolute, but must be subject to testing on the purpose and intention of registration. Thus, the theory of good faith places the substance and purpose of registration as the

²⁸ Wibowo, "Legal Protection for Registered Trademark Holders with the Application of the First Submission Principle to Other Parties (Case Study of Supreme Court Decision Number 161k/Pdt.Sus-HKI/2023)."

²⁹ Rahaditya, "The Application of the Principle of Good Faith in Legal Protection for Well-Known Brands That Are Not Registered in Indonesia Based on the Supreme Court Decision Number 600 K/PDT. SUS-HKI/2020."

determining factor in assessing the suitability of a trademark for legal protection.³⁰

This form of bad faith can be reflected in the trademark submission in the form of writing, images, logos, color schemes, or other combinations of elements that imitate the other party's trademark or trademark that has been widely known by the public, thus causing similarity in the main part or as a whole. In such conditions, the element of intentionality to imitate a brand that already has a reputation can be considered to have been met. Furthermore, Article 83 paragraph (2) and its explanation in the Trademark and Geographical Indications Law provide legal protection for well-known trademark owners who are harmed by the unauthorized use of trademarks, by providing the right to file a lawsuit in the form of compensation and/or termination of all acts related to the use of the trademark to the Commercial Court, even though the well-known trademark in question has not been registered.

The act of *passing off* implicitly fulfills the elements stipulated in Article 21 paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, especially related to actions that have the potential to deceive or mislead consumers as a result of dishonest business competition. An action can qualify as a *passing off* if it meets several key elements. First, the plaintiff must have a reputation for its trademark, because without a reputation in the region or country where the action occurred, a *pass off* claim cannot be proven. Second, there is an element of misrepresentation, namely the use of trademarks that create a false impression among the public as if there is a relationship with a well-known brand, so that it has the potential to cause consumer confusion. Third, there are losses experienced by brand owners as a result of the use of similar brands by parties with bad faith, which ultimately leads to public misunderstandings in choosing products or services.³¹

The assessment of bad faith in the registration of the 4monster trademark must be placed within the normative framework of Article 21 paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which confirms that the application for trademark registration is rejected if submitted by the applicant in bad faith. This provision is intended as a corrective mechanism to the *principle of first*

³⁰ M.H. Prof. DR. Rahmi Jened, S.H., *Trademark Law, in the Era of Global & Economic Integration*, 1st ed. (Prenadamedia Group, 2015).

³¹ Chairul Bariah Hasibuan, Khadijah, Okay. Saidin, Jelly Leviza, "Legal Protection of Famous Brands Against Reputational Fraud (Study Decision No.18 PK/Pdt.Sus-HKI/2021)," *Journal of Locust Review of Academic Literature* 1, no. 5 (2022): 335–38, <https://doi.org/https://doi.org/10.56128/ljoalr.v1i6.84>.

to file so that trademark registration is not used as a means to obtain unreasonable profits through the use of the brand reputation of another party.³²

Based on the chronology of facts in the dispute between Monster and 4monster, the Monster brand is a well-known foreign brand that has been widely known and has a strong reputation before the application for registration of the 4Monster brand in Indonesia. The fact of fame is an important indicator in assessing the existence of alleged bad faith, because 4Monster brand registrants should be suspected of knowing or at least must know the existence and reputation of the Monster brand when applying for registration.

The use of Monster's dominant element on the 4Monster brand shows that there is an effort to maintain the main appeal of the well-known brand. The addition of numbers and logos does not eliminate the potential impression of a relationship between the two brands, especially from the consumer side, so that it has the potential to cause confusion about the origin of goods or services. This condition is in line with the explanation of Article 21 paragraph (3) of the Trademark and Geographical Indications Law which links bad faith with the act of imitating or following the brand of another party for business interests that can mislead consumers.

In addition, the absence of a legal relationship, license agreement, or commercial cooperation between the owner of the Monster trademark and the registrant of the 4Monster trademark further strengthens the indication that the registration is not based on legitimate business interests. Thus, the registration of the 4Monster trademark can be analyzed as an act that meets the element of bad faith as referred to in Article 21 paragraph (3) of Law Number 20 of 2016, because it utilizes the reputation of the famous foreign brand Monster without a valid basis of rights.

Conclusion

This study confirms that the principle *of first to file* in Indonesian trademark law cannot be applied absolutely, but must be limited by the principle of good faith as a corrective instrument to maintain substantive justice. Decree Number 12/Pdt.Sus-HKI/Brands/2024/PN Niaga Central

³² Halimatul Maryani Fikri Maulana, "Legal Protection for Registered Trademarks against Passing-Off Actions Based on the Decision of the Supreme Court of the Republic of Indonesia Number 532 K/Pdt.Sus-HKI/2024," *Legal Meta Journal* 3, No. 2 (2024): 62–65.

Jakarta shows that administratively valid trademark registration can still be canceled if it is proven that it has the same principles as well-known brands and is carried out to take advantage of the reputation of other parties. The judge's consideration of the dominant elements, the overall impression of the brand, and the indication of bad faith reflected a proportionate approach in balancing legal certainty and protection for brand owners with good faith.

The implications of these findings are the strengthening of legal protection standards for well-known brands and the affirmation that trademark registration systems should not be used as a means to legitimize unfair business competition practices. Therefore, this study recommends strengthening substantive checks in the trademark registration process, especially related to the assessment of bad faith and potential reputation utilization, as well as the need for consistency in judicial considerations so that the application of *the first-to-file principle* remains in line with the purpose of trademark law protection and the principle of justice.

References

LAWS & REGULATIONS

"Law Number 20 of 2016 concerning Trademarks and Geographical Indications," 2016.

"Law Number 8 of 1999 concerning Consumer Protection.," n.d.

VERDICT

Decisions, Directory, Supreme Court, and the Republic of Indonesia.

"Decision of the Central Jakarta Commercial Court Number 12/Pdt.Sus-HKI/Brand/2024/PN Niaga Central Jakarta.," n.d.

BOOKS

Prof. Dr. Peter Mahmud Marzuki, S.H., M.S. *Legal Research*. Surabaya: Kencana, 2021.

Soekanto, S., & Mamudji, S. *Normative Law Research: A Brief Overview*. Jakarta: RajaGrafindo Persada, 2014.

Dr. H. Ok. Saidin, S.H., M.Hum. *Legal Aspects of Intellectual Property Rights*. Jakarta: RajaGrafindo Persada., 2007.

JOURNAL

- Alexander, Rendy, Study Program, Master of Science, Faculty of Law, and University of Indonesia. "The Application of the 'First To File' Principle to the Concept of Trademark Registration in Indonesia." *Kertha Semaya Journal* 10, no. 9 (2022): 2112. <https://doi.org/https://doi.org/10.24843/KS.2022.v10.i09.p12>.
- Ardian, Selni. "First to File Principle and Trademark Rights Disputes in Indonesian Legislation Review First to File Principle and Trademark Rights Disputes." *Journal of Islamic State and Political Law* 5, no. 1 (2025): 431. <https://doi.org/https://doi.org/10.14421/jnj4gr96>.
- Damar Ramadhanna Tanjung, Rinitami Njatrijani, Bagus Rahmanda. "Application of the First-to-File Principle in Trademark Disputes." *Law, Development & Justice Review* Vol. 6, No (2023): 111–28.
- Djuliana, Elfrida Ratnawati Gultom. "Comparison of the legal system between Indonesia and China regarding the protection of well-known trademarks is not registered." *Encyclopedia of Journal* 5, no. 4 (2023): 581–89. <https://doi.org/https://doi.org/10.33559/eoj.v5i3.1888>.
- Dwi Seno Wijanarko, personal salvation. "Preventive Legal Protection of Trademarks in Indonesia Based on Law Number 20 of 2016 concerning Trademarks and Geographical Indications." *Logic: Journal of Research at the University of Kuningan* 13, no. 02 (2022): 194–95. <https://doi.org/https://doi.org/10.25134/logika.v13i02.7178>.
- Fikri Maulana, Halimatul Maryani. "Legal Protection For Registered Well-Known Trademarks Against Passing-Off Action Based On The Decision Of The Supreme Court Of The Republic Of Indonesia Number 532 K/Pdt.Sus-Hki/2024." *Jurnal Meta Hukum* 3, no. 2 (2024): 62–65.
- Hasibuan, Khadijah, Okay. Saidin, Jelly Leviza, Chairul Bariah. "Legal Protection of Famous Brands Against Reputational Swindling Acts (Study of Decision No.18 PK/Pdt.Sus-HKI/2021)." *Locus Journal of Academic Literature Review* 1, no. 5 (2022): 335–38. <https://doi.org/https://doi.org/10.56128/ljoalr.v1i6.84>.
- Henry Arianto. "Responsive Law and Law Enforcement in Indonesia." *Lex Journal* Vol. 07 No (2010): p. 115.
- Humaedi Abdurahman. "The First To File Principal Principle In Bensus's Famous Name Trademark Rights Case." *Legal Journal* Vol. 3 No. (2020): p. 428-443. <https://doi.org/https://doi.org/10.29313/aktualita.voio.6056>.

- Yours truly, Julia. "Application of the First-to-File Principle in Trademark Dispute Cases: A Perspective of Trademark Law in Indonesia." *Open Journal Systems* Vol.19 No. (2025): 5970–72. <https://binapatria.id/index.php/MBI/article/view/1208>.
- Marcella Abrillia. "Juridical Analysis of Decision Number: 115/Pdt.Sus-Brand/2022/Pn.Niaga. Jkt.Pst on the trademark dispute of Kaso and Kasomax." *Journal of Law, Economics, and English* Vol. 7, No (2025): 57–58. <https://doi.org/https://doi.org/10.35960/j-lee.v7i1.1887>.
- Maulana, Muhammad Syahrul. "Legal Certainty of the Application of the First to File Principle on Trademarks in Indonesia (Case Study of Court Decision No.2/Pdt.Sus.Hki.Merek/2022/Pn.Niaga.Sby)." *U.S. Law Review*, no. 4390–4392 (2023). <https://doi.org/https://doi.org/10.31933/unesrev.v5i4>.
- Medisita Nurfauziah Istiqmalia. "Good Faith in Trademark Registration: A Study of Legal Protection of Famous Brand Owners in Indonesia." *Indonesian Law Enforcement Journal (JPHI)* 2, no. 3 (2021): 413–18. <https://doi.org/https://doi.org/10.51749/jphi.v2i3.10>.
- Nadhila Cahya Nurmalasari. "Analysis of the Application of the First to File Principle to Preventive Legal Protection (Study on Trademark Disputes Between MS GLOW and PS GLOW)." *Activism: Journal of Indonesian Educational, Political and Social Sciences* Vol. 1 No. (2024): 39–41. <https://doi.org/https://doi.org/10.62383/aktivisme.v1i2.191>.
- Prof. DR. Rahmi Jened, S.H., M.H. *Trademark Law, in the Era of Global & Economic Integration*. 1st ed. Prenadamedia Group, 2015.
- Tamara Panjaitan's daughter. "Application of the First to File Principle as Brand Legal Protection in the Dispute of TikTok Ltd vs Fenfiana Saputra." *Welfare State Journal of Law* 4, no. 2 (2025): 283. <https://doi.org/https://doi.org/10.56013/welfarestate.v4i2.4148>.
- Rahaditya, Mutia Kirana Aprilia R. "The Application of the Principle of Good Faith in Legal Protection for Famous Brands That Are Not Registered in Indonesia Based on the Supreme Court Decision Number 600 K/PDT. SUS-HKI/2020." *Journal of Citizenship* 7, no. 1 (2023): 982.
- Triyono Adi Saputro, Teguh Hartono. "Geographic Indication Protection System: A Comparison Between Indonesia and China." *Journal of Sapientia et Virtus* Volume 8, no. No. 1 (2023): 173–76.
- Sigh, Sigit. "Legal Protection for Registered Trademark Holders with the Application of the First to File Principle to Other Parties (Case Study of

Supreme Court Decision Number 161k/Pdt.Sus-HKI/2023)." *Journal of Law Caraka Justitia* 3, no. 2 (2023): 127–45. <https://doi.org/https://doi.org/10.30588/jhcj.v3i2.1675>.

Widya Annisa Pudji Lestari. "Legal Protection of Famous Trademarks for Trademark Applications Submitted in Good Faith (Study of Decision Number 1850 K/Pdt.Sus-HKI/2022)." *Scientific Journal of "Advocacy"* Vol. 13, N (2025): 779–81. <https://doi.org/https://doi.org/10.36987/jiad.v13i3.7604>.

WEBSITE

Dandapala Team. "MONSTER Drink Rolls 4MONSTER Brand from China at the Central Jakarta District Court." *Dandapala Contributor*. 2025. <https://dandapala.com/article/detail/minuman-monster-gulung-merek-4monster-dari-china-di-pn-jakpus>. Retrieved 21 October 2025