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System of Proof Against First to Use of Trademarks in Lawsuit for Cancelation of Trademark Registration by Bad Faith

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Abstract

This trademark dispute originated with the plaintiff who claimed to be the owner and origin user of the Tempo Gelato brand but did not register himself as the owner. On the other hand, the defendant, who was originally a business partner of the plaintiff, registered herself as the owner of the Tempo Gelato brand, while business was running by them. This dispute was examined by commercial court up to the cassation level with the object of examination being allegations of bad faith by the defendant in registering the Tempo Gelato brand. The formulation of the problem is: 1. What is the proof with the first-to-use argument in canceling the registration of mark with bad faith? How is the review of the procedural law against the decision that granted the counterclaim, while rejecting the lawsuit? This research is a normative one, by analyzing secondary data sources through qualitative analysis. The result is because the court did not find clear evidence regarding the gelato business cooperation agreement, it could not be proven that there was first to use by plaintiff, on the other hand because private procedural law seeks formal evidence, the defendant is considered the owner of the brand base on the fits to file principle. Secondly, the procedural law allows if the lawsuit is not declared unacceptable, then if it is rejected and vice versa, the counterclaim is accepted, it is legal consequence of the existence of a counterclaim which can be proven to have a causal relationship.

KEYWORDS: Commercial court decision, Evidentiary, first to use, Mark, Counterclaim.

Introduction

Basically, Trademark protection in Indonesia adheres to the constitutive principle (first to file), [1] this means that whoever registers a mark for the first time, will be designated as the owner if there is no cancellation by the court. The Trademarks only get protection if the Trademarks are registered with the Directorate of Intellectual Property.[2] The meaning of "registered" is after the application has gone through a formal examination process, an announcement process, and a substantive examination process as well as obtaining approval from the Minister to publish a certificate. Based on the first to file system, only Trademarks that are registered in good faith will receive legal protection. The trademark cannot be registered if it is contrary to article 20 and article 21 of Law 20/2016.

Theoretically, the first registrant (first to file) has the prioritized legal protection if the registration is based on good faith, but if the Trademark registration is based on bad faith, the first user (first to use) with good faith has the prioritized of legal protection even though the mark is not registered.[3] Law 21/1961 concerning Corporate Marks and Commercial Marks, which adheres to the First to use system. Based on the first to use system, those who get legal protection are the first users of the Mark. In fact, the declarative system has only been adopted by previous laws and has undergone changes to the current law, namely Law 20/2016 concerning trademarks and geographical indications. But Law 20/2016 Article 76 paragraph (2) provides an opportunity for the first user of a Mark (first to use) that is not registered, whether the mark is well-known or not, still the opportunity to file a lawsuit for trademark registration in bad faith.[4] The first owner of the Mark can use bad faith in Trademark registration as a reason for a lawsuit to cancel the Trademark registration. The reasons for proof based on equality are essentially the same as those proven in good faith in a lawsuit for cancellation of Trademark registration.[5]

The decision of the Commercial Court at the Semarang District Court Number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga Smg between Rudy Christian Festraets as Plaintiff/Applicant of Cassation, against Ema

[1] Khoirul Hidayah, *Hukum Hak Kekayaan Intelektual*, Cetakan Pertama, Setara Press, Jakarta, 2017, p .54.

[2] Andrew Betlehn and Prisca Oktaviani Samosir, "Upaya Perlindungan Hukum Terhadap Merek Industri Umkm Di Indonesia" *Jurnal Law and Justice*. Edition No.1 Vol.3, Hukum Bisnis Universitas Agung Podomoro, 2018, p. 4.

[3] OK. Saidin, *Aspek Hukum Hak Kekayaan Intelektual (Intelektual Property Rights)*, Cetakan Ke-9, PT.RajaGrafindo Persada, Jakarta, 2019, p. 512.

[4] Chandra Gita Dewi, *Penyelesaian Sengketa Pelanggaran Merek*, Cetakan Pertama, CV Budi Utama, Jakarta, 2019, p. 86.

[5] Mukti Fajar ND, Yati Nurhayati, and Ifrani "Iktikad Tidak Baik dalam Pendaftaran dan Model Penegakan Hukum Merek di Indonesia" *JH Quia Iustum*, Edition No. 2, Vol. 25, Fakultas Hukum Universitas Muhammadiyah Yogyakarta, 2018, p. 228.

Susmiyati as Defendant/Defendant of Cassation, Briere Pascal Jacques Edouard as Defendant with Interest I/Defendant of Cassation, PT. Tempo Gelato Indonesia as Defendant with Interest II/ Defendant of Cassation, Ministry of Law and Human Rights RI CQ Directorate General of Intellectual Property Rights CQ Directorate of Marks as Co-Defendant/Co-Defendant of Cassation. The essence of the lawsuit is Rudy Christian Festraets (Plaintiff/Appellant of Cassation) argues that he is the first owner and user of the Mark of TEMPO GELATO for the Ice Cream/Gelato outlet business in Yogyakarta since April 7, 2015, having its address at Prawirotaman No. 43, Brontokusuman Village, Mergangsan District, Yogyakarta City through collaboration with Briere Pascal Jacques Edouard (Defendant with Interest I/ Defendant of Cassation).[6]

In this case, Defendant gave an answer which essentially stated that Plaintiff was not the first owner and first user of the TEMPO GELATO + LOGO Class (43) and TEMPO GELATO Class (30) marks.[7] The defendant is the holder of special rights in the territory of the Republic of Indonesia over a registered Mark belonging to Defendant with the certificates of TEMPO GELATO+ LOGO class (43) and TEMPO GELATO class (30).[8] Defendant has also filed a reconvention, that the Defendant/ Plaintiff of Reconvention stated that she was the first to register the TEMPO GELATO + LOGO class 43 and "TEMPO GELATO" Mark class 30.[9] Based on that Defendant/Plaintiff of Reconvention sued the Plaintiff/Defendant of Reconvention having bad faith which is exactly used a mark the same as the one registered in the name of the Defendant/Plaintiff of Reconvention.[10] To Plaintiff's Claim, Defendant With Interest I gave an answer which basically stated that Defendant With Interest I had never had a working relationship, let alone a joint business partnership with Plaintiff.[11]

The system of proof in civil cases is regulated in article 163 HIR which basically determines "Whoever claims to have a right or proposes an act or event to confirm his right, or to refute the rights of another person must prove the existence of that right or the existence of that act or event". The Plaintiff is the party who argues for a right or event in a lawsuit, then the Plaintiff is obliged to prove everything that has been stated in the arguments of his lawsuit.[12] The burden of the proof system also applies equally to the Defendants who have presented arguments, whether they are refusing a right or denying an event.[13] Based on the case above in the petition of

[6] The decision of Commercial Court at Semarang District Court (First Trial Court) Number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga SMg, p. 3.

[7] Ibid, p. 37.

[8] Ibid

[9] Ibid.

[10] Ibid.

[11] Ibid, p. 94.

[12] Achmad Rifa, "Penafsiran Hukum Sistem Beban Pembuktian Dalam Perkara Perdata (Studi Kasus Perkara Perdata No.: 12/Pidt.G/2019/PN.Pmk)", *Jurnal YUSTITIA*, Edition No1, Vol. 21, Fakultas Hukum Universitas Madura Pamekasan, 2020, p. 8.

[13] Ibid.

primary number 5 and the petition of subsidiary number 5,[14] Rudy Christian Festraets (Plaintiff/Applicant of Cassation) stated that he was the first owner and first user of the TEMPO GELATO Mark in collaboration with Briere Pascal Jacques Edouard (Defendant with Interest I/Defendant of Cassation).

If there is a close relationship or connection between the convention claim and the reconvention claim, and the decision handed down on the convention lawsuit is negative, namely the lawsuit cannot be accepted, on the grounds that the lawsuit contains formal defects (*error in personal, obscuur libel, not adjudicating, and so on*), then result:

1. The assessor's reconvention decision follows the convention decision
2. Therefore, because the convention's decision declares the lawsuit unacceptable, according to the law, the reconvention's decision must also be declared as inadmissible.[15]

Then, this research has purpose to study how to prove the first to use of the trademark in a lawsuit for cancelation of trademark registration by bad faith? And, how does the judge's consideration grant the reconvention claim while rejecting the convention lawsuit according to the applicable civil procedural law? and how the judge's consideration that grants the reconvention claim is suitable with the law of evidence based on Article 163 HIR/Article 283 Rbg/Article 1865 of the Civil Code?

Method

The type of research used in writing this scientific paper is normative legal research or commonly known as doctrinal research. To answer the formulation of the problem above, the author will present a legislative approach and a case approach.

As primary legal material is the applicable laws and regulations (positive law) and of course, court verdict. It supported by various secondary legal materials, in the form of books, journals, research reports, legal and social scientific articles, as well as seminar materials, workshops, and so on.

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Result and Discussions

The Proof of The Petition of Primary Number 5/The Petition of Subsidiary Number 5 of The Lawsuit Which Stipulates That the Mark of "Tempo

[14] Decision of the Commercial Court at the Semarang District Court, Op. Cit., p. 26.

[15] Maria Amanda "Syarat Materil Gugatan Rekonvensi" (Hukum Acara Perdata: Pengetahuan Hukum Acara Perdatadan Permasalahannya di Indonesia) 2012 https://www.hukumacaraperdata.com/gugatan/syarat-materil-gugatan-rekonvensi/ accessed on August 13, 2023.

Gelato+Logo" is An Idea Used by Rudy Christian Festraets and Briere Pascal Jacques Edouard Based on The Principles of First to Use

The system of proof in civil cases is regulated in Article 163 HIR which basically determines "Whoever claims to have rights or proposes an act or event to confirm his rights, or to refute the rights of others must prove the existence of that right or the existence of such an act or event". The Plaintiff is the party who argues for a right or event in a lawsuit, then the Plaintiff is obliged to prove everything that has been stated in the arguments of his lawsuit.[16] The burden of the proof system also applies equally to Defendants who have submitted arguments, both those who deny a right or who deny an event.[17] Especially in civil cases, not all events must be proven, but only the arguments denied by the opposing party must be proven.[18]

The Plaintiff in his lawsuit argues that Plaintiff is the first owner and first user of the Mark of TEMPO GELATO+LOGO Class 43 and the Mark of TEMPO GELATO Class 30 through his collaboration with Defendant with interest I. Defendant has denied by stating the argument that Defendant is the first registrant in good faith and the legal owner of the mark. The defendant with interest I also gave a rebuttal argument that Plaintiff and Defendant with interest I are just ordinary friends and have never had cooperation in any field of business.[19]

The idea for the name "TEMPO GELATO" came from the Plaintiff's wife and then suggested to the Plaintiff that the Ice Cream / Gelato business be named "Il Tempo del Gelato" or "Tempo del Gelato" or simply "Tempo Gelato". This idea arose because the word "Gelato" comes from Italian, and according to the Plaintiff's Wife, it is better to juxtapose it with the word "Tempo" which is also from Italian which means "Time". The word "Tempo" in Spanish also means time. In addition, the Plaintiff's wife said that "Tempo" in Indonesian also means "Waktu".[20]

Making designs in the form of: Logo design to be installed at the Ice Cream / Gelato Business Outlet, Business Card Design, Member Card Design, V.I.P Card Design, Sticker Design, Display Design for Doors with the assistance of a Plaintiff in Bali named FERRY via his email ferrytrijata@yahoo.com, on Sunday, January 11, 2015, to the Plaintiff's email: rudy_festraets@yahoo.com. That all the design processes are always informed by the Plaintiffs to Defendant with interest I via email of the defendant with interest I: plebosco@hotmail.com on Tuesday, 13 January 2015, and Monday, 16 February 2015, and vice versa.

The defendant was not involved at all with the idea of the TEMPO GELATO ice cream Mark, this was postulated by evidence of a short message from NINA REGINA MONIQUE on March 14, 2018, which stated that Defendant did not know about the TEMPO GELATO business name

[16] Achmad Rifa, Loc. Cit, p. 8
[17] Ibid
[18] Ibid
[19] The decision of commercial court at semarang district court, Loc. Cit, p. 94.
[20] Ibid, p.7.

used by the Plaintiff and the Defendant with interest I for a joint venture. ICE CREAM / GELATO.

The evidence of social media accounts as promotional tools for Tempo Gelato outlets, namely Facebook and Instagram which were registered using the Plaintiff's email with the name "Tempo Gelato Yogyakarta" and an account on Instagram with the name "tempogelato" and only the plaintiff knew the password.[21] Based on this evidence, Defendant denied that Plaintiff was only operational on the two accounts because Plaintiff most often took photos of customers.[22] According to the author, it is impossible for someone who is only operational to use an email and password that he knows personally. If the account really belongs to the Defendant as stated in the argument of his rebuttal, then of course the defendant knows more about the account.

The evidence presented by Plaintiff above is electronic evidence. Where the first regulation of electronic evidence is in Law no. 8 of 1997 concerning Company Documents. The law does not explicitly state the word electronic evidence, but article 15 states that data stored on microfilm or other media is considered as legal evidence. Then with the enactment of the ITE Law, there is a new arrangement regarding electronic document evidence. In Article 5 paragraph (1) of the ITE Law, it is determined that electronic information and/or electronic documents and/or their printouts are legal evidence. Furthermore, in Article 5 paragraph 2 of the ITE Law, it is determined that electronic information or electronic documents and/or their printed results as referred to in paragraph 1 is an extension of legal evidence and is in accordance with procedural law in force in Indonesia. Thus, the ITE Law has determined that electronic documents and/or their printouts are valid evidence and are an extension of legal evidence in accordance with procedural law that has been in force in Indonesia so that they can be used as evidence in court.[23]

In refuting Plaintiff's argument in the lawsuit, Defendant stated that he was the first owner and first registrant of the TEMPO GELATO mark. With evidence of Mark Certificate "TEMPO GELATO+LOGO" Number IDM000608304, Class: 43 on 25 September 2017 and Mark Certificate "TEMPO GELATO" Number IDM000668163, Class: 30 on behalf of the Defendant on 29 January 2020.[24] According to positive law, an authentic deed is contained in the Civil Code Article 1868, an authentic deed is a deed whose form is determined by the law and made by or before an official

[21] Ibid, p. 11.

[22] Ibid, p. 128.

[23] Anisah Daeng Tinring, Dachran Bustahmi & Ahyuni Yunus "Kedudukan Dokumen Elektronik sebagai Alat Bukti Dalam Hukum Acara Perdata di Indonesia", *Celebes Cyber Crime Journal,* Edition No. 2, Vol. 1, Megister Ilmu Hukum Universitas Muslim Indonesia, 2019, p. 124.

[24] The decision of the commercial court at Semarang district court, Op.Cit, p. 35.

authorized to make the deed.[25] An authentic deed is perfect evidence as regulated in article 1870 of the Civil Code, so it does not need to be proven again and for the judge it is "mandatory evidence" (*Verplicht Bewijs*), therefore whoever declares that the authentic deed is fake then he must prove the falsity of the deed, for that reason, the authentic deed has the power of proof both outwardly, formally and materially.[26]

In this case, the plaintiff argues that the plaintiff is the first owner and first user of the TEMPO GELATO Mark through cooperation with the Defendant with interest I, so that the registration of the mark of "TEMPO GELATO+LOGO" and " TEMPO GELATO" has been registered in bad faith. In this case, Plaintiff argues the defendant's authentic deed in the form of a Tempo gelato Mark certificate is invalid because it was registered in bad faith considering that the plaintiff and the defendant with interest I being the first owner and the first user of the Tempo gelato mark, therefore according to the author there should be evidence of the Defendant's rebuttal to the plaintiff's claim stating that the mark was registered in bad faith, namely proof of ownership and the first use of the Tempo Gelato mark, but in the argument of his refutation the Defendant only stated his ownership with proof of certificate (authentic deed) without any evidence of first ownership of the mark to prove that the registration of the mark is carried out in good faith.

In the lawsuit, Plaintiff argues that the place of business of the TEMPO GELATO brand of Ice Cream/Gelato was rented by Plaintiff and Defendant with interest I from the owner, NOVI ASTUTI. This can be proven by the Lease Agreement dated November 8, 2014, which was legalized by IRMA FAUZIAH, Notary in Bantul Regency No: 2638/LEG/XI/2014, dated November 08, 2014, and the Lease Agreement (additional) dated August 22, 2015, between Plaintiff, Defendant with interest I as the tenant party and NOVI ASTUTI as the lessor party.[27] Based on the argument stated by Plaintiff, Defendant with interest I stated that the rebuttal argument that the inclusion of Plaintiff's name in the lease deed was not because Plaintiff had business capital in TEMPO GELATO, but rather Defendant with interest I borrowing money from the Plaintiff and then as collateral for his debt to the Plaintiff furthermore the Defendant with interest I including the Plaintiff in the lease agreement.[28]

According to Article 1874 civil code and 286 R.Bg, a private deed is a deed signed underhand, letters, lists, household affairs and other writings

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[25] Mohd. Afnizar, devinsyah nasution, and muksin putra haspy, "Kedudukan Akta Autentik Notaris Sebagai Alat Bukti Menurut Pasal 1886 Kuh Perdata The Position Of Authentic Notary Deed as Evidence According to Article 1886 of The Civil Code", p. 10. https://docplayer.info/169530923-Kedudukan-akta-autentik-notaris-sebagai-alat-bukti-menurut-pasal-1886-kuh-perdata.html accessed on August 14, 2023.

[26] I Ketut Tjukup and friends, "Akta Notaris (Akta Otentik) Sebagai Alat Bukti dalam Peristiwa Hukum Perdata", *Jurnal Ilmiah Prodi Magister Kenotariatan*, Edition No. 1, Vol 2, Fakultas Hukum Universitas Udayana, 2015 – 2016, p. 185.

[27] The decision of the commercial court at Semarang district court,Op Cit, p. 9.

[28] Ibid, p. 44.

made without the intermediary of a public official because that is the power of proof of the deed. under the hand is not as strong as the power of proof of an authentic deed which has perfect and binding proving power. However, an underhand deed can have perfect and binding evidentiary power if it is legalized by an authorized official.[29] Legalization is the ratification of underhand letters,[30] in the legalization process, all parties who made the letter come before a notary and the notary reads and explains the contents of the letter, then the letter is dated and signed by the parties and finally legalized by a notary. The legalized underhand deed has a definite date, the signature affixed under the letter really comes from and is affixed by the person whose name is listed in the letter and the person who puts his signature under the letter, cannot say that he does not know what the content of the letter was, because its contents had been read to him first before he signed his signature in front of the official.

Regarding the judge's considerations, they have not found any evidence that relates to one another, especially the cooperation agreement between Plaintiff and Defendant with Interest I, both in writing and orally. The legal terms of agreement according to Article 1320 of the Civil Code states that the legal terms of an agreement are that those who bind themselves can make an agreement regarding a certain matter and a lawful cause. This article also does not state that the agreement must be in written form. Also based on the provisions of the civil partnership regulated in article 1618 of the Civil Code. According to Article 1618 of the Civil Code, a civil partnership is an agreement between two or more people who bind themselves to enter something (*inbrengen*) into the partnership with the intention of sharing the profits obtained because of it. From the provisions of Article 1618 of the Civil Code, several elements contained in a civil partnership can be drawn, namely:

1. The existence of a cooperation agreement between two or more people

   Article 1618 of the Civil Code states that there is an agreement, regarding its form, the law does not regulate that it must be in written form, meaning that it can be carried out in an unwritten form, even silently. As for saying this agreement must be in writing, it is clearly a non-binding doctrine. Based on evidence P-12 to P-17 and P-19 to P-21 which are emails showing intense communication between Plaintiff and Defendant with interest I regarding the design concept and business plan of the Ice Cream. This evidence is corroborated by the testimony of witness Sunu Prihanto who confirmed that the email he sent to Defendant with interest I had been forwarded to Plaintiff.[31] Then, based on evidence P-22, Defendant was consciously interested in sending

[29] Sita Arini Umbas, " Kedudukan Akta Di Bawah Tangan Yang Telah Dilegalisasi Notaris Dalam Pembuktian Di Pengadilan", *Lex Crimen*, Edition No. 1, Vol. VI, Fakultas Hukum Unsrat, 2017, p. 81.

[30] M. Yahya Harahap, *Hukum Acara Perdata,* Sinar Grafika, Jakarta, 2005, p. 597.

[31] The decision of the commercial court at Semarang district court, Loc.Cit, p. 142.

photos related to the renovation progress of the TEMPO GELATO I PRAWIROTAMAN outlet.
Witness Sunu Prihanto also confirmed that the witness sent photos of the progress of the renovation work on Tempo Gelato's business premises on Jl Prawirotaman as P-22 to Defendant with interest I through his email on February 25, 2015, which was then forwarded to Plaintiff.[32] Whereas in discussing the design concept and ice cream business plan, the discussion only involved Plaintiff and Defendant with Interest I, while Defendant did not take part at all.
The existence of the above evidence gives rise to a legal suspicion that there is a cooperation agreement between Plaintiff and Defendant with interest I. This is in accordance with Article 1618 of the Civil Code that the agreement does not have to be in written form but can be orally or even secretly. Whereas in fact the communication about the business plan, logo design plan, and other plans related to the operation of the Tempo gelato outlet only occurred between Plaintiff, Defendant with interest I and the designer. There is no evidence of Defendant's participation in the mark discussion, which strengthens the suspicion that Defendant is not the owner and the first user of the Tempo gelato mark.
The silent agreement between Plaintiff and Defendant with Interest I was also strengthened by the evidence that TB I - 8 and TB I -10 were both Deeds of Notary Irma Fauziah, August 22, 2015, and January 15, 2016, respectively. In the Notary Deed, it was stated that Plaintiff and Defendant with interest I were the Lessee and NOVI ASTUTI, as the Leasing Party. The argument of Defendant with interest I states that the inclusion of the name of Plaintiff in the deed is a guarantee for the debt of Defendant with interest I to Plaintiff. Henceforth, Defendant with interest I did not have other evidence that could strengthen his argument so that there was no other suspicion other than the existence of a silent cooperation agreement between Plaintiff and Defendant with interest I.
Likewise, in the principles of cooperation agreements, one of which is the principle of freedom of contract contained in article 1338 paragraph (1) of the Civil Code. Freedom in making agreements where the parties can freely arrange the rights and obligations in the agreed agreement. According to Subekti in his book The Law of Agreements, the Principle of Freedom of Contract is a principle which states that basically everyone can make a contract (agreement) which contains and of any kind if it

[32] Ibid

does not conflict with law, decency and public order.[33] The principle of freedom of contract. Where this principle states that the parties are given the freedom to make agreements, according to the wishes of the parties. If connected to the case, then the agreement does not have to be made in black and white / In written form. Thus, if the agreement is made by email or mutual report. In my opinion, this is an agreement, which we can analogize with a sale and purchase agreement in an online shop between the seller and the buyer. In the online shop agreement, the seller and the buyer do not enter into a black and white agreement.

2. Each party must enter something into the partnership (*inbreng*)
   As evidence P-29 to P-32, Plaintiff enters *inbreng* in the form of money, while Defendant with interest I is carrying out an *inbreng* in the form of both physical and thought energy as Exhibits TB I - 8 and TB I - 10 are in accordance with Exhibit P-34.
3. Intending to share the profits
   Based on Article 1633 of the Civil Code, it is stated that if in the civil partnership agreement there is no share of the profits and losses of each, then it is divided according to the balance of income (*inbreng*) of each partner. So based on article 1633, although the agreement between the plaintiff and the defendant with interest I doesn't regulate the distribution of profits and losses, it can be carried out according to the amount of their respective *inbreng*. This is in accordance with the evidence of Exhibit P-44 that profit sharing has been carried out in the period July 2016 to November 2017. So that the elements of Article 1618 of the Civil Code have been fulfilled that they both have entered into a silent agreement.

The judge's consideration regarding the evidence against Defendant is the first user based on evidence T-2 and T-3 concerning the Photocopy of UD's Restaurant/Drinking House (Cafe) Business Development Trip. BANGUN JAYA ABADI with the Mark "TEMPO GELATO/ IL TEMPO DEL GELATO" is linked to the testimony of witness Sunu Prihanto. The things that the judge did not consider in this regard are that in fact the TEMPO GELATO Mark has been proven to have been used, used, for business activities or commercial activities for the first time on April 7, 2015, by the Plaintiff together with the Defendant with Interest I before UD BANGUN JAYA ABADI was established by Defendant. This is based on evidence P-26, P-27, P-28, and the testimony of Witness Rahel Mat Tya Karimata, Witness Sinta Mayasasari, and Witness Syarial Afwan. Since the beginning of the establishment of the Ice Cream Tempo Gelato business on Jl. Prawirotaman, the owner of the mark of Ice Cream Tempo Gelato business from the beginning of its operation by Plaintiff and Defendant with interest.

[33] Subekti, *Pokok-Pokok Hukum Perdata*, Cet. ke-33, PT. Intermasa, Jakarta, 2005. p. 13.

Against the testimony of Witness Sinta Mayasari and Witness Syahrial Afwan, both are employees at the Tempo Gelato ice cream/gelato outlet, which basically states that all decisions including the acceptance of employees are in the hands of the Plaintiff. Because the plaintiff has another business in Bali, the operational management of the Tempo Gelato business is left to Defendant. This is consistent with Exhibit P-36 to Exhibit P-43 that all operational processes of the ice cream outlet are always informed via email to Plaintiff, including the provision of employee salaries/wages. So, based on article 1354 of the Civil Code.

"If a person voluntarily without being assigned, represents another person's business, with or without the knowledge of that person, then he is secretly binding himself to continue and complete the business so that the person he represents his interests can take care of the business himself".

So the results of the author's research that there is strong evidence that shows the existence of a first to use of a mark belonging to the plaintiff through cooperation with the Defendant with interest I, namely the existence of a silent agreement between the Plaintiff and the Defendant with interest I, which can be proven based on facts, especially regarding the lease deed for the first time gelato business outlet, evidence of an email conversation between the Plaintiff and the Defendant with interest I, the existence of a gelato tempo social media account as a promotion site whose management and password only the plaintiff knows, and the testimony of the plaintiff's witness. In the end, this evidence is not conclusive, so they need to be correlated with one another. Thus, the results of the author's research that the Plaintiff's first to use can be proven, then the Defendant's first registrant must have his trademark canceled based on the provisions of Article 21 paragraph 3 of the Trademark Law 20/2016.

Based on the two principles of justice John Rawls[34] which is the solution to the main problem of justice. First, principle of greatest equal liberty. Second, it consists of two parts, namly the difference principle and the prinsiple of fair equality of opprtunity. If we align Rawls' principles of justice with the constitution, then the two principles of justice which are the main premise of Rawls's theory are also contained in the Indonesian constitution, the 1945 Constitution.[35] Therefore, according to Rawls, between morals and constitution, both need each other to realize the basic order of social and state life. That is, the constitution must be based on

[34] John Rawls, Uzair Fauzan and Heru Prasetyo (Translator), *Dasar-Dasar Filsafat Politik untuk Kesejahteraan Sosial dalam Negara/Jhon Rawls,* Yogyakarta: Pustaka Pelajar, 2006. Quoted from: Damanhuri Fattah, "TEORI KEADILAN MENURUT JOHN RAWLS", *Jurnal TAPIs* Vol.9 No. 2, Program Studi Ilmu Filsafat, Universitas Gadjah Mada, Jogjakarta, 2013. p. 35

[35] John Rawls, Uzair Fauzan and Heru Prasetyo (Translator), *Dasar-Dasar Filsafat Politik untuk Kesejahteraan Sosial dalam Negara/Jhon Rawls,* Pustaka Pelajar, Yogyakarta, 2006. Quoted from: Pan Mohamad Faiz," Teori Keadilan Jhon Rawls" *Jurnal Konstitusi*, Vol. 6, No. 1, Constitutional Court of Indonesia, 2009. p. 146.

moral values and vice versa to be effective, moral values must be supported by the constitution.[36]

If we relate this case to the principle of justice according to John Rawls, in the first to use evidence in court over the TEMPO GELATO Mark, that although the evidence argued by the plaintiff is not perfect evidence according to the constitution, the evidence has a mutually reinforcing relationship with one another. other. So, there is a strong suspicion that the Plaintiff and Defendant with Interest I are the first owners and first users of the TEMPO GELATO Mark. Between morals and the constitution must be mutually compatible with each other, but this was not considered by the judges in deciding this case.

However, the plaintiff's claim was rejected until this case reached the cassation stage with decision number 473 K/Pdt.Sus-HKI/2021 essentially rejected the cassation application because the reasons for the cassation could not be justified in the examination at the cassation stage. Based on Article 30 of Law Number 14 of 1985 concerning the Supreme Court as amended by Law Number 5 of 2004 and the second amendment by Law Number 3 of 2009.

The Judge's Consideration That Grants the Reconvention Claim That Ema Susmiyati is The Holder of The Mark of Tempo Gelato+Logo Based on Good Faith While Rejecting The Convention Lawsuit, According to The Applicable Civil Procedural Law

Reconvention comes from the word convention; convention is a term to refer to the original lawsuit or lawsuit. Reconvention is known as retaliation, which is a right given to the defendant to file a claim against or retaliation. The meaning of reconvention is a lawsuit filed by the defendant as a counterclaim to the lawsuit filed by the plaintiff. This makes the counterclaim plaintiff fight without the need to register a new lawsuit. According to M. Yahya Harahap, the term of reconvention is regulated in Article 132a of the Revised Indonesian Reglement (HIR) which means a lawsuit filed by the defendant as a reply to the lawsuit filed by the plaintiff.[37] The legal basis for the reconvention lawsuit is regulated in articles 132 a and 132 b which is inserted in the HIR with stb.1927-300 which is taken over from articles 244-247 B.Rv, while in the Rbg on this reconvention it is regulated in articles 157 and 158, in the procedural law this reconvention lawsuit is also known as a " counterclaim".[38]

If there is a close relationship or connection between the convention claim and the reconvention claim, and the decision handed

[36] Ibid. p. 147.

[37] Nazyela El Rahma Hadi, "Rekonvensi Atas Rekonvensi Harta Bersama Terhadap Perkara Cerai Talak (Studi Perkara Nomor 0569/Pdt.G/2020/PA.BL.)" Thesis, Fakultas Syariah Universitas Islam Negri Malang, 2021, p. 29.

[38] Abdul Manan, *Penerapan Hukum Acara Perdata di Lingkungan Peradilan Agama*, kencana, Jakarta, 2005, p. 54.

down on the convention lawsuit is negative, namely the lawsuit cannot be accepted, on the grounds that the lawsuit contains formal defects (*error in personal, obscuur libel, not authorized to judge, and so on*), then result:

1. The assessor of the reconvention decision follows the convention decision.
2. Therefore, because the convention's decision declares that the lawsuit is unacceptable, according to the law, the reconvention's decision must also be declared as inadmissible.

According to M Yahya Harahap, a reconvention lawsuit is a lawsuit that is individual or stand-alone, but in practice the reconvention lawsuit is merged with the convention lawsuit so that in its administration it is superimposed or attached to the concession lawsuit.[39] M Yahya Harahap reaffirmed that the reconvention lawsuit is not an assessor or derivative of a convention claim. The existence of reconvention does not depend on convention claims. The convention is essentially independent and can be submitted separately in different settlement processes. It's just that, exceptionally, the law gives the Defendant the right to incorporate it into a convention claim. Therefore, basically its existence is not an assessor with a convention claim.[40]

If the reconvention claim does not have a relationship with the convention claim, the position of the claim for reconvention in a case file must be maintained, if the convention claim is declared unacceptable by the court, the reconvention claim cannot be declared unacceptable either. This opinion is reinforced by Supreme Court Decision Number: 1057K/SIP/1973 which states "Because the lawsuit in the reconvention is not based on the essence of the lawsuit in the convention but stands alone, with the inadmissibility of the claim in the reconvention, the claim in the reconvention does not follow to not acceptable too."

If the defendant files an exception and a convention, it means that there are 3 (three) main cases that must be resolved in the decision, namely convention, exception, and reconvention.[41] If it turns out that the results of the examination of the convention lawsuit are not proven, the exception has no basis and the reconvention lawsuit is also not proven, the verdict that must be handed down is:[42]

In convention

a. In exception

   Exception rejected or unacceptable

b. In the subject

   Reject the lawsuit in its entirety

[39] M. Yahya Harahap, *Op.Cit.*, p. 468.
[40] Ibid.
[41] Ibid., p. 812.
[42] Ibid.

In reconvention

Reject the reconvention in its entirety

As is the case in the decision of the Commercial Court at the Semarang District Court with case number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga SMG examines and hears cases at the first level over trademark disputes. In this case, the Commercial Court Judge Council at the Semarang District Court stated that the lawsuit filed by the plaintiff in the convention was rejected because according to the judge's consideration, Plaintiff in the Convention lawsuit could not prove the existence of cooperation between Plaintiff and Defendant with interest I mainly regarding the cooperation agreement between Plaintiff and Defendant with interest I in oral or written form. The exception submitted by the defendant was rejected with the judge's consideration that the contents of the exception submitted by Defendant had entered the main realm of the case because to determine whether the argument put forward by Plaintiff had legal grounds or not, an examination of the subject matter must be carried out. In the reconvention, the judge granted the reconvention in part with his consideration that because the Plaintiff/Defendant of reconvention was not proven to be the owner and the first user of the "Tempo Gelato" mark, Defendant/Plaintiff of reconvention must be viewed as the first registrant and the sole owner of the mark.

There is no formal defect in the convention lawsuit, so the rejection of the convention lawsuit does not result in the reconvention lawsuit being rejected too. So that the judge's decision in the decision of the Commercial Court at the Semarang District Court with case number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga Smg is have been matched with the Supreme Court's Decision Number: 1057K/SIP/1973 which states "Because the lawsuit in the Reconvention doesn't base on the essence of the lawsuit in the convention but standing alone, with the inadmissibility of the convention claim, the reconvention claim does not automatically become unacceptable." However, the rejection of the convention lawsuit does not mean that the judge can immediately grant the reconvention, but that both must be tested and proven.

In accordance with the Decision of the Commercial Court Judges at the Semarang District Court which tried and decided on Case Number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga Smg decided that the lawsuit filed by the Plaintiff of Convention was rejected and made the rejection of the convention suit as the basis for granting the reconvention claim so that it is clear that the judge in considering his decision has overridden the law of proof which is clearly regulated in Article 163HIR/Article 283 Rbg/Article 1865 of the Civil Code which regulates the principle of proof in civil cases, where the party who claims to have certain rights or mentions something actions to strengthen their rights or to dispute the rights of others, then the party must prove the existence of such rights or events.

In judicial practice each party, Plaintiff and Defendant must prove their arguments or rebuttals. From the explanation above, in imposing a judge's decision in a civil court, there must be a balance between the Plaintiff and the Defendant, in this case a convention claim and a reconvention claim.

In the reconvention lawsuit, the plaintiff of reconvention (Ema Susmiyarti) sued the defendant of reconvention (Rudy Christian Festival) for registering the Mark of TEMPO GELATO+LOGO class 43 and the mark of TEMPO GELATO class 30 which is the same as the registered mark under the name Ema susmiyarti with registration number IDM000608304 For Class 43 on 26 August 2017 and the TEMPO GELATO+LOGO MARK class 30 with registration number D002018060136 on 19 November 2018.

Based on Article 21 paragraph (1) letter a of Trademark Law 20/2016 which reads:

1) The application is rejected if the Mark has similarities in principle or in its entirety with:
   - **a. A registered mark belonging to another party or previously requested by another party for similar goods and/or services.**
   - b. Well-known marks belonging to other parties for similar goods and/or services.
   - c. Well-known marks belonging to other parties for goods and/or services of a different kind that meet certain requirements; or
   - d. Registered Geographical Indications.

Based on article 21 paragraph (1) letter a above, because the trademark belongs to the plaintiff of reconvention that has been registered beforehand, the defendant of reconvention can be categorized as an applicant with bad faith.

In fact, what has been discussed in problem formulation 1 (one) is that the Defendant/Plaintiff of reconvention does not have proof of ownership and the first use of the Tempo Gelato mark. Even in the evidence presented by Plaintiff/ Defendant of reconvention and Defendant with Interest I, there is no evidence stating the participation of Defendant/Plaintiff of reconvention in seeking business ideas, brand naming ideas, making brand logos, even the plan to operate the ice cream outlet. That the existence of a brand must first have thoughts/ideas before being realized in the form of the brand itself. The existence of trademark registration, of course, must go through careful planning in advance considering that the trademark registration process is not an easy thing, so it is certain that those who want to register their trademarks have planned for a long time and gradually. Moreover, in this case there is a cooperation between the parties so that communication between them is certain which can be proven.

So, if it is adjusted to Yahya Harahap's If it turns out that the results of the examination of the convention lawsuit are not proven, the exception has no basis and the reconvention lawsuit is also not proven, the verdict that must be handed down is:[43]

In convention

a. In exception
   Exception rejected or unacceptable

b. In the subject
   Reject the lawsuit in its entirety
   In reconvention
   Reject the reconvention in its entirety.

Conclusion

Based on the evidence and the applicable evidentiary law, between Plaintiff/ Rudy Christian Festraets and Defendant with an interest I/ Briere Pascal Jacques Edouard it was concluded that there had been a silent agreement based on the concept of a civil partnership in Article 1618 of the Civil Code. It is thus proven that Plaintiff/ Rudy Christian Festraets and Defendant with interest I/ Briere Pascal Jacques Edouard are the owner or the first to use of the Tempo Gelato Mark.

The reconvention claim in this case has fulfilled the formal and material requirements. There is no formal defect in the convention lawsuit, so the rejection of the convention suit does not result in the reconvention lawsuit being rejected too. So that the judge's decision in the decision of the Commercial Court at the Semarang District Court with case number 6/Pdt.Sus-HKI/Merek/2020/PN Niaga SMG is in accordance with the Supreme Court's Decision Number: 1057K/SIP/1973.

[43] Ibid

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