



Analysis of Trademark Cancellation for The Protection of The First Registrant's Trademark: BIOAQUA Study

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Abstract

Due to the cancellation of the BIOAQUA case in Decision Number: 618 K/Pdt.Sus-HKI/2020, the plaintiff did not receive the legal protection that he deserved. The study's goal is to examine the legal protection afforded to the first trademark registration applicant in the BIOAQUA trademark case, followed by an examination of the judge's decision to cancel the BIOAQUA trademark. This study is normative and legal in nature. The research strategy is a case study approach. The data source is secondary data, and the data analysis is qualitative. The findings revealed that in the case of the BIOAQUA trademark, legal protection is provided to the first applicant of trademark registration against the defendant. Because the judge considers the same as the authority under Article 3 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, the plaintiff is not considered the first registrant. The judge's consideration in the BIOAQUA trademark cancellation case is based on Articles 76 and 77 of Trademarks and Geographical Indications Law No. 20 of 2016. The judge considers the content of Article 76, namely that cancellation can be made against registered trademarks, but because the element of good faith cannot be proven, the defendant's trademark is not cancelled, and the legal effect of this is that the defendant's BIOAQUA trademark is protected by registered trademarks.

A. Introduction

Technological advances are becoming more rapid in this globalisation era, and they have a significant impact on the world of national trade and investment. One of them is intellectual property development. According to Upreti, intellectual property plays a role in the national and international frameworks and is a protected investment. Because intellectual property is territorial, national intellectual property laws determine rights and obligations. Only intellectual property that is "protected" by the national regime, according to Upreti, should be treated as an investment.¹

Intellectual property is essentially the result of thought in the form of ideas or ideas that are embodied or expressed in the form of inventions, works of literary science and art, designs, symbols, or specific signs, semiconductor component layout creation, and breeding varieties.² Intellectual property can improve the innovative environment by providing recognition and economic benefits to the creator or inventor, whereas a lack of in-

and International Intellectual Property Law and Policy in Reconceptualising the Definition of Investment", *IIC*, no. 52 (2021): 103, <https://doi.org/10.1007/s40319-020-01009-7>

2 Mujiyono dan Feriyanto, *Memahami dan Cara Memperoleh Hak Kekayaan Intelektual*, (Sentra KI Yogyakarta:Universitas Negeri Yogyakarta, 2017), 1.

1 Pratyush Nath Upreti, "The Role of National



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tellectual property awareness and ineffective implementation can stymie the nation's economic, technical, and social development. As a result, any country must prioritize the dissemination and application of intellectual property knowledge.³

Taking the results of creativity in the form of intellectual property by third parties is an example of an intellectual property problem. In the field of trademarks, for example. Trademarks are frequently abused in order to capitalize on a product's association with a specific trademark. Many businesses that register trademarks purposefully resemble well-known trademarks in order to deceive consumers. This is an example of bad faith trademark registration.⁴ The hope is that intellectual property development will not be taken over by third parties.⁵ Bad faith is the polar opposite of good faith. This term is recognized by trademarks governed by Law No. 20 of 2016 on Trademarks and Geographical Indications. According to Putra, in order to obtain the right to a trademark, the first applicant to apply for registration in good faith is the party entitled to the trademark.⁶ According to Muliasari, Santoso, and Irawati, one of the principles of registered trademark protection in Indonesia is good faith. The principle of good faith does not only apply when a trademark application becomes an absolute ground, but it can also be the basis in a trademark cancellation lawsuit relating to the validity of registered trademark.⁷

3 Dhaval Chudasama, "Importance of Intellectual Property Rights", *Journal of Intellectual Property Law* 2, issue 2 (2021): 16, <http://lawjournals.celnet.in/index.php/jiprl/index>, DOI (Journal): 10.37591/JIPRL

4 Yanto, O dan Susanto, S. Sosialisasi Kekayaan Intelektual Cuna Menumbuh kembangkan Usaha Dalam Rangka Menghadapi Persaingan Global Pada Revolusi 4.0. Abdi Laksana: *Jurnal Pengabdian Kepada Masyarakat* 1, no. 2, (2020):41.

5 Mukti Fajar ND, Yati Nurhayati dan Ifrani, "Iktikad Tidak Baik dalam Pendaftaran dan Model Penegakan Hukum Merek di Indonesia, *JH Ius Quia Iustum* 23 issue 2 (2018): 220, DOI: 10.20885/iustum.vol25.iss2.art1

6 Fajar Nurcahya Dwi Putra, "Perlindungan Hukum Bagi Pemegang Hak Atas Merek Terhadap Perbuatan Pelanggaran Merek", *Jurnal Ilmu Hukum* (Edisi: Januari - Juni 2014): 97-108.

7 Ruri Suci Muliasari, Budi Santoso dan Irawati, "Pelanggaran Prinsip Itikad Baik dalam Sengketa Merek Internasional", *NOTARIUS*, vol.14 no.

The issue of good faith protection is extremely difficult to implement. The application will be rejected if it is filed in bad faith, according to Article 21 paragraph (3). Although the explanation has been limited to the framework, the researcher believes that the issue of good faith cannot always be seen at the start of trademark registration. For example, if the article's explanation lists the elements of the party acting in bad faith, such as the intention to imitate, plagiarise, or follow the trademark of another party in order to cause unfair business competition, deceive, or mislead consumers. Thus, in order to translate these elements, at least preventive legal actions should be possible. For example, there is an opportunity to do so during the substantive examination process. Normally, the authority can determine whether or not the mark has previously existed. However, this process has been completed, though it has not been found in the database, that the Indonesian state has a special standard in the examination of trademarks, such as in the form of a guidebook. The researcher discovered data issued by the ASEAN Secretariat regarding general guidelines for the substantive examination of trademarks while browsing the Google archive,⁸ The issue of good faith protection is extremely difficult to implement. The application will be rejected if it is filed in bad faith, according to Article 21 paragraph (3). Although the explanation has been limited to the framework, the researcher believes that the issue of good faith cannot always be seen at the start of trademark registration. However, these guidelines are merely a reference to guide and focus the practice of ASEAN intellectual property offices in the short term in order to achieve common criteria and standards. These guidelines are said to be non-binding because they will not influence the outcome of a trademark application's substantive examination. Any powers and responsibilities conferred on the intellectual property office by applicable national laws are retained.

2(2021): 973, <https://doi.org/10.14710/nts.v14i2.43788>

8 Sekretariat ASEAN, *Pedoman Umum untuk Pemeriksaan Substantif Merek Dagang*, Edisi Kedua, (Jakarta: Sekretariat ASEAN, April 2020): 18

The authority's examination process, as described in the preceding paragraph, in the outcome of the examination results should then be able to see that there will be no similarities in the results of the trademark decisions that are granted trademark applications. This assertion, however, cannot be proven. Because there are several trademark cancellation lawsuits that come to commercial court, the researcher's reasoning is to use the basis of the good faith article in trademark law. The researcher assumes that if the authority in charge of trademark registration does not differ in its decision-making, then the lawsuit on this basis will not exist. To support this assumption, the researcher reviewed previous studies on the implementation of good faith or the protection of the first registrant in commercial court cases involving well-known trademarks. As in Rosanti, Salamiah, and Sugiyanto's⁹ study, This research supports the researcher's opinion that the element of good faith has existed since the beginning of the application for registration, but in the case of AAA ALSTYLE & ACTIVEWEAR in Decision Number 999 K/Pdt.Sus-HKI/2019, the authority granted the application for a trademark that has complete similarities with the plaintiff's well-known trademark. Article 21 paragraph proves the plaintiff's claim (3). Furthermore, according to Syafira's research¹⁰ related to the SUPERMAN case with Number 17/Pdt.Sus-Merek/2018/PN.Niaga.Jkt.Pst, stated that the strength of the element of one's good faith is difficult to prove at the time of trademark registration application due to the limited knowledge of trademark examiners at the Directorate General of Intellectual Property of well-known trademarks that have been registered or have not been registered, but the element of one's good faith can only be proven after there are

other As a result, there is no way to determine good faith in the implementation of trademark registration in Indonesia. Furthermore, Rumadan research¹¹ is that for the criteria of bad faith in the settlement of famous trademark disputes related to equality of justice in principle is in the Court according to the Trademark Law 2016, including knowledge of famous trademarks even though the trademark has not been officially registered at the Directorate General of Intellectual Property, and there is an element of equality in principle and/or all of them regarding words, speech sounds, and appearance, as well as misleading consumers.

Based on the foregoing, conclusions can be drawn about the differences in this study, which focuses on a case study of similar trademark BIOAQUA versus BIOAQUA. The BIOAQUA trademark, as the first registrant, was denied rights in Court Decision Number: 618 K/Pdt.Sus-HKI/2020. After the trademark examining authority granted the defendant's trademark, the plaintiff filed a cancellation request for the defendant's trademark. On 21 August 2016, the plaintiff applied for registration with the number D002016039283 of class 3 goods with the BIOAQUA trademark and logo in kanji, which was officially accepted by the Defendant on 23 August 2016. The BIOAQUA trademark, with registration number IDM000640247, registered date 27 March 2019, class of goods 3, and owner Tan Cin Jam, was accepted as a registered trademark.

The Plaintiff filed the cancellation lawsuit because it claims to have first applied for registration of its trademark to the Directorate General of Intellectual Property, but the trademark accepted for registration by the Directorate General of Intellectual Property is the Defendant's trademark. Article 20 letter (b) of Law No. 20 of 2016 on Trademarks and Geographical Indications has determined that a trademark cannot be registered, namely: "A mark cannot be registered if it is

9 Dewi Rosanti, Salamiah dan Dedi Sugiyanto, "Analisis yuridis Itikad Tidak Baik Dalam Pembatalan Merek Dagang Terdaftar Di Direktorat Jendral Kekayaan Intelektual Republik Indonesia (Studi Putusan Nomor 999 K/Pdt.Sus-Hki/2019) ", <http://eprints.uniska-bjm.ac.id>. (accessed Januari 14, 2023)

10 Viona Talitha Syafira, " Perlindungan Hukum bagi Pemegang Merek Superman terhadap Pelanggaran Merek", *Jurnal Suara Hukum* 3. no. 1 (Maret 2021):106

11 Ismail Rumadan, "Bad Faith's Criteria in Famous Trademark Dispute Settlement that has an Element of Equality in Prinsple in the Court", *Advances in Economics, Business and Management Research*, vol. 140, (Atlantis Press, International Conference on Law, Economics and Health (ICLEH 2020): 607

similar to, related to, or merely mentions the goods and/or services for which registration is sought". The article clearly states that infringers or bad faith registrants cannot register their trademarks and can be sued by the first registrant. The defendant is deemed to have committed trademark infringement because it imitated or falsified another's trademark in order to make a large profit by ignoring the rights to the registered trademark, which can cause significant harm to the trademark owner.

In terms of bad faith in this trademark infringement, it can be defined as an act committed with the intent to commit fraud for personal gain. According to Prameswari, Budiarta, and Arini, the quick to record standard, rather than the first come, first served rule, is in accordance with the guidelines adopted by the Indonesian Trademark Law. Given this guideline, a person who requires a mark privilege must request the mark in question. With the registration of the mark, the mark holder becomes responsible for the brand name of his product. With the goal of ensuring that every manufacturer, business owner, or broker has legal ownership of his product trademark¹². The judge considered the lawsuit, and found that the defendant's BIOAQUA trademark was carried out in accordance with the procedures and legal procedures specified in the legislation; that the Plaintiff's BIOAQUA trademark was not registered, despite the fact that the Plaintiff first applied for registration, but there was opposition from a third party (PT. Aqua Golden Missisipi, Tbk); and that in Article 21 paragraph 1 letter an of Law No. 20 of 2016, That in the case at hand, the Plaintiff as the owner of the BIOAQUA trademark was also denied approval.

Based on the foregoing, the following issues will be addressed: How is the legal protection for the first trademark registration applicant in the BIOAQUA trademark case?

12 Ni Made Ratih Prameswari, I Nyoman Putu Bidiartha dan Desak Gde Dwi Arini, "Pelanggaran Hukum Hak atas Merek dalam Hubungannya dengan Persaingan Usaha Tidak Sehat di Indonesia", *Jurnal Analogi Hukum* 3 no.1 (2021):280., <https://ejournal.warmadewa.ac.id/index.php/analogihukum>

How is the judge's analysis of the cancellation of the BIOAQUA trademark in the Indonesian trademark registration system ?

B. Research Method

This study employs normative legal research. Normative juridical research investigates the law as norms or rules that apply in society and become a reference to everyone's behavior.¹³ The standards in question are those outlined in Indonesia's trademark theory in the Trademark Act. The protection for the first registrant, or the constitutive principle of trademark, is one of the doctrines or principles established. This principle is applied in research using a case approach. This is accomplished by conducting a review of cases related to the issue at hand that have resulted in a court decision with permanent legal force.¹⁴ Researcher examined Court Decision Number: 618 K/Pdt.Sus-HKI/2020. This decision is the result of a similar mark dispute between BIOAQUA and BIOAQUA.

The section of the verdict known as *ratio decendi* is the focal point of the investigation. As is well known, *ratio decendi* is a legal principle that serves as the foundation for court decisions. The ratio of the case must be determined based on the facts, the reasons given by the court for its decision, and the decision itself. It is described as a legal statement applied to material facts. On the basis of precedent, only the ratio of cases is binding on lower courts.¹⁵ In the case of this study, the researcher then compares the ratio to the trademark principle described in the previous discussion. As a result, the data from the case that is required is secondary data. Secondary data is obtained through a literature study, which entails a series of activities such as reading, quoting, recording books, and reviewing legislation related to

13 Ishaq, *Metode Penelitian Hukum dan Penulisan Skripsi, Tesis, serta Disertasi*, (Bandung:CV. Alfabeta, 2017): 66.

14 Peter Mahmud Marzuki, *Penelitian Hukum*, (Jakarta:Kencana Prenada Media Group, 2013): 134.

15 Oxford University Press, "Oxford Reference", <https://www.oxfordreference.com/display/10.1093/oi/authority.20110803100405351;jsessionid=BBE92D2C3A61252E784EA37F2069A473> (accessed Januari 12 2023)

the research problem.¹⁶ The data will then be analyzed qualitatively, which means analyzing data sourced from legal materials based on concepts, theories, laws and regulations, doctrines, legal principles, expert opinions, or the researchers' own opinions.¹⁷ The analysis is also based on the study's objectives.

C. Result and Discussions.

1. Legal protection for the first trademark registration applicant in the case of BIOAQUA Trademark.

The BIOAQUA trademark is in decision number: 618 K/Pdt.Sus-HKI/2020, involving PT Mitra Gemilang Kosmetindo as the plaintiff and Tan Cin Jam as the defendant, with the Directorate General of Intellectual Property as a co-defendant. The plaintiff registered the mark on 21 August 2016 under the registration number D002016039283, while the defendant registered the same mark on 27 March 2019 under the registration number IDM 000640247. Because the plaintiff and defendant's trademark are similar, the plaintiff filed a lawsuit against the defendant on 11 July 2019 under Article 21 paragraph 1 letter an of Law number 20 of 2016 concerning trademarks and geographical indications. The case progressed to two levels of decision, the first being the commercial court decision number 39/Pdt.Sus-Merek/2019/PN.Niaga.Jkt.Pst., which resulted in the plaintiff's claim being rejected, and the second being the cassation decision number 618 K/Pdt.Sus-HKI/2020, which resulted in the commercial court decision being upheld.

Based on the decision of the commercial court number: 39/Pdt.Sus-Merek/2019/PN.Niaga.Jkt.Pst, in this decision, the plaintiff's provisional (preliminary) demands are unacceptable, then the defendant's exception is also unacceptable, and the main case rejects the plaintiff's trademark cancellation lawsuit for all, and the plaintiff is sentenced to pay the costs incurred in this case, amounting to Rp. 1,661,000.00, (one million six hundred sixty one thousand rupiah). As a result of the judge's decision above, which

denied the plaintiff's claim, a lawsuit was filed in the Supreme Court on December 10, 2019, with the case number 618K/Pdt.Sus-HKI/2020. The cassation decision number 618K/Pdt.Sus-HKI/2020 was issued by the judge, stating that the cassation application filed by the cassation applicant, PT Mitra Gemilang Kosmetindo, was rejected, and the cassation applicant, PT Mitra Gemilang Kosmetindo, was sentenced to pay court costs at the cassation level of Rp. 5,000,000.00. (five million rupiah).

According to the two decisions, the judge denied the plaintiff's claim at two levels of court, *judex facti* in the Commercial Court and *judex jurist* in the Supreme Court. The previous decision was upheld by the cassation decision. As in the *judex facti* decision, there are three considerations. The first is the plaintiff's argument that the BIOAQUA trademark registered under the defendant's name is similar in essence or in its entirety to the trademark that the plaintiff first applied for. The second consideration is whether the plaintiff is a good faith party entitled to the BIOAQUA trademark, which is still in the process of trademark registration in the co-name, defendant's and the third consideration is the defendant's status and legal position as the holder of the BIOAQUA trademark registered in the defendant's name. The judge mentioned 5 considerations for the cassation, but there are only two considerations for the trademark registration system, namely: To begin with, the defendant's BIOAQUA trademark was registered in accordance with the legal procedures outlined in the laws and regulations; second, Article 21 paragraph 1 letter an of Law No. 20 of 2016 on trademarks and geographical indications states that "the application is rejected if the trademark is substantially or wholly similar to a registered trademark owned by another party or applied for in advance by another party for similar goods and/or services."

The researcher sees the issue of the first registrant as the dominant material in relation to both considerations at the two judicial levels. The Indonesian government protects trademarks under the doctrine of the first

¹⁶ Ishaq, *Op-Cit*, hlm. 99.

¹⁷ Ishaq, *Op-Cit*, hlm. 69-70

registrant, also known as the constitutive principle or first to file principle. According to Desmayanti, this system requires trademark registration in order for a trademark to be protected. According to this system, the person who first registered the trademark is entitled to the trademark's rights.¹⁸ The term is not terminologically mentioned in the law, according to the articles of the law. The law begins the article by emphasizing the scope of protection as the most important aspect. This is mentioned in the section of Chapter II dealing with the trademark's scope. Article 3 asserts that a trademark will have rights over its trademark, stating that rights over the trademark are obtained after the trademark is registered. Based on this, it is possible to conclude that this right arises as a result of registration, and the registration requirement is clearly stated in the Act. This is what the term "scope of protection" refers to. The authority must legalize the registration before the right is granted. This right is not given to you right away. The elucidation of the Article then defines the term registered as meaning that a certificate will be issued after the application has gone through the formality examination process, the announcement process, and the substantive examination process and has received the Minister's approval.

Based on this explanation, the next sequence in the application process is also regulated, as in Chapter III of the law regarding the application for trademark registration, which contains the formality or administrative requirements required by the applicant. According to the data, the BIOAQUA trademark owned by the Plaintiff, which was registered on 21 August 2016, registered its trademark first from the defendant on 27 March 2019. So, if two applicants with the same mark have the same date sequence, the plaintiff is considered the first registrant, and the assumption is that the plaintiff's mark should be protected. However, because the role of the explanation must be read in its entirety, the processes begin and the articles

18 Rakhmita Desmayanti, *Tinjauan Umum Perlindungan Merek Terkenal Sebagai Daya Pembeda Menurut Prespektif Hukum Di Indonesia*, *Jurnal Cahaya Keadilan* 6, no.1, (2018): 8.

sequentially discuss the application for trademark registration in Chapter III sections one to seven, beginning with Article 4 and ending with Article 19. According to the explanation, these are referred to as the process of examining formalities, and the plaintiff has met this requirement. The announcement procedure is the next order of business. In this regard, the judge also included this matter in the content of the consideration that there was resistance or objection from a third party, namely the AQUA trademark with the number IDM000452728". As a result, the authority sees that this process cannot be completed.

The substantive examination process, which is part of trademark registration in Chapter IV of the law, is explained in the following section, which runs from Article 20 to Article 40, section one to section six. Relevant to the *judex jurist* judge's consideration, who mentioned Article 21 when discussing the registration of the defendant's trademark. According to the article, the application is rejected if the trademark is substantially or wholly similar to: a registered trademark owned by another party, or an application for similar goods and/or services filed in advance by another party, which means that the party who registered the trademark first is considered the rightful owner of the trademark, and the first registered party receives legal protection.¹⁹ In this regard, it is stated that even if the defendant's trademark was carried out in accordance with legal procedures and laws and regulations, it is contrary to the provisions of this article, because if you want to register a trademark, it must not have similarities in principle and in its entirety with a trademark that has been applied for registration by another party. In this case, the defendant's application came after the plaintiff's BIOAQUA trademark applied for registration first. Because the trademark protection system in Indonesia adheres to the system of trademark registration with a constitutive system, or the principle of first to file, the plaintiff should re-

19 Medisita Nurfauziah Istiqmalia & Iwan Erar Joesoef, *Itikad Baik Dalam Pendaftaran Merek Studi Perlindungan Hukum Pemilik Merek Terkenal di Indonesia*, *Jurnal Penegakan Hukum Indonesia (JPHI)* 2, Issue 3 (2021): 409, <https://doi.org/10.51749/jphi.v2i3.10>

ceive legal protection for the trademark application that he made first. When it comes to legal trademark registration procedures, Article 20 letter b states that the registration cannot be registered if it is "the same as, related to, or only mentions the goods and/or services for which registration is applied," which means that the trademark is related to or only mentions the goods and/or services for which registration is applied. Whereas the defendant's registered trademark is identical in principal and entirety to the plaintiff's trademark, the consideration is illegal. Because if someone wants to register their trademark, it should not be the same or related to the trademark that has already been registered.

The refusal can also be made by taking into account Article 21 paragraph 3 because it is also related to the first consideration that the application is rejected if it is filed in bad faith. According to the article, bad faith is defined as an applicant who is reasonably suspected of registering his/her trademark with the intent to imitate, plagiarise, or follow other parties' trademarks in order to cause unfair business competition conditions, deceive, or mislead consumers. In this case, the Plaintiff registered his trademark in good faith where the plaintiff registered it before the other party so that the registration made by the plaintiff is based on good intentions and in accordance with the explanation of Article 21 paragraph 3 that the applicant who acts in bad faith intends to piggyback, imitate, or plagiarize the trademark of another party.²⁰ As a result, the plaintiff's registration is legally protected. While the defendant's trademark application is contrary to this article because the registration of the defendant's trademark indicated the existence of bad faith with the intention of piggybacking or imitating the Plaintiff's trademark. As a result, the application filed by the defendant can be said to have fulfilled this element, because it is known that the plaintiff is the first registrant of

the BIOAQUA trademark.

According to the foregoing, the existence of the first registrant doctrine, as stipulated in Article 3 of the law, is not the only reason for a trademark to be protected. In this case, BIOAQUA, claiming to be the first registrant, has followed the Trademark Law's stages, and the plaintiff should be granted because there are no other registrants in the class of goods 3. The doctrine must be supported by the doctrines of similarity in Articles 21 paragraphs 1 and 2, and good faith in Article 21 paragraph 3. According to the researcher, there is one more doctrine that is important for this support, namely the doctrine of distinguishing power in Article 20 letter e, which explains the distinguishing power in trademark registration, in this case the plaintiff's trademark has a distinguishing power in the trademark applied for registration. In terms of distinguishing power, the mark to be called different must not be similar to other marks. This is an absolute necessity. A trademark's distinguishing power serves an important and fundamental function. The existence of a brand's distinguishing power will have an impact on the brand's ability to avoid confusion during marketing.²¹ In general, the determination of distinguishing power in a trademark in Indonesia is based solely on whether the mark has similarities in essence or entirety with a well-known trademark or with a trademark that has already been registered, as well as whether the mark is generic, overly simple, or overly complicated. According to the explanation of Article 20 letter e of the Trademark Law, a mark is considered to lack distinguishing power if it is too simple, such as a single line or dot mark, or too complicated, such that it is not clear.²²

This distinguishing power was not used in this case. This case arose as a result of other registrants with the same mark who registered the BIOAQUA trademark. Other similar

20 Andre Asmara, Sri Wanly Rahayu dan Sanusi Bintang, "Studi Kasus Penerapan Prinsip Pendaftaran First To File pada Pembatalan Merek Cap Mawar (Putusan MARI Nomor:512K/PDT. SUS-HKI/2016)", *Syiah Kuala Law Jurnal* 3, no. 2 (2019):197, <https://doi.org/10.24815/sklj.v3i2.11899>.

21 Indirani Bastian Christy Wauran & Titon Slamet Kurnia, "Confusion dan Pembatalan Merek oleh Pengadilan", *Mimbar Hukum* 27 no. 2 (2015): 276, <http://jurnal.ugm.ac.id/jmh>

22 Ana Wahyu Wijayantia, Indirani Wauran, Merek Tiga Dimensi Dalam Hukum Merek Indonesia, *Jurnal Bina Mulia Hukum*, 6 (2021): 22, <https://doi.org/10.23920/jbmh.v6i1.354>

trademarks owned by the defendant, on the other hand, should not be registered because the plaintiff registered its trademark first on 21 August 2016 and was officially accepted by the Directorate General of Intellectual Property (DJKI) on 23 August 2016 with registration number D002016039283. Furthermore, the Defendant's trademark shares significant similarities with the Plaintiff's first trademark. The existence of this, the trademark registered by the Defendant, is contrary to the requirements of the trademark registration application, which is based on the provisions of Articles 20 and 21 of the Trademark Act of 2016 concerning Trademarks and Geographical Indications, and as a result, the registration process owned by the defendant is not in accordance with the trademark registration procedure because there is no distinguishing power in the trade. And the defendant's trademark application should be declared null and void because it does not meet the legislative requirements. The existence of a mark's distinguishing power will have an impact on the mark's ability to not cause confusion or confusion when marketed. The main reason that a mark can be protected as a trademark is its distinguishability. One of the absolute requirements in a trademark registration that must be fulfilled by every person, legal entity, or business that wants to use a trademark is that the trademark have sufficient distinguishing power, which means that the mark used must be sufficiently different from the marks owned by other parties to distinguish the goods produced by business actors from goods produced by other business actors.

Based on the preceding analysis, the researcher can reiterate the importance of upholding the principles of protection in trademark law by re-reading the meaning contained in trademark law theory. The theory in which the concepts and doctrines adopted and discussed in the previous descriptions, the State of Indonesia which adheres to the protection of the registration system adopted in Indonesia which uses a constitutive system, the use of a constitutive system or first to file system, which means that the first applicant who filed the registration of his trademark is the party entitled to the trademark,

so that legal protection should be given. In this case, the plaintiff benefits from legal protection by registering his trademark. Based on this, the judge can review the defendant's trademark registration process because the trademark filed by the defendant violates the procedures outlined in the legislation. According to the articles mentioned above, the plaintiff's lawsuit is in accordance with the existing laws and regulations, and the existence of the plaintiff's lawsuit is also based on the defendant's violation in registering the trademark, and the violation committed by the defendant is also in accordance with what has been mentioned in Article 20 letter b and e and Article 21 paragraph 3. Because the lawsuit brought by the plaintiff is based on the non-fulfillment of rights that should have been obtained by the first registrant, as well as the absence of justice and legal certainty that should have been obtained by the plaintiff, the judge can provide more relevant considerations in the decision of this case.

2. Analysis of the judge's consideration of the cancellation of BIOAQUA Trademark.

According to Decision Number 618K/Pdt.Sus-HKI/2020, the plaintiff filed a lawsuit against the defendant's trademark because there are similarities in the plaintiff's essence. Furthermore, the plaintiff requested that the judge cancel the defendant's BIOAQUA mark. In relation to the term, a trademark cancellation is a procedure taken by one of the parties to seek and eliminate the existence of a trademark registration from the General Register of Trademarks or cancel the validity of rights based on the trademark certificate, generally a party believes he has been harmed by the registration, so the concerned party may file a petition for cancellation.²³ According to the data in the trademark database and relevant to the discussion of this case, the defendant's trademark was granted and registered in trademark class 3 with application number D002018044666, with an acceptance date of 12 September 2018 and a registration date of 27 March

²³ Rahmi Jened, *Hukum Merek Trade Mark Law Dalam Era Integrasi Ekonomi*, (Jakarta: Prenada Mediagrup 2015): 291.

2019. However, based on the data in the decision, the plaintiff with the same trademark name BIOAQUA applied for on August 23, 2016, with the trademark license holder Tan Cin Jam was accepted as a registered trademark.

Article 76 and Article 77 of Law No. 20 Year 2016 explain the legal basis for trademark cancellation. Article 76 states that a lawsuit for cancellation of a registered trademark may be filed by an interested party based on the grounds referred to in Article 20 and/or Article 21, and the owner of an unregistered trademark may file a lawsuit as referred to in paragraph (1) after submitting an application to the Minister. The cancellation lawsuit was filed against the registered trademark owner in Commercial Court. Article 77, on the other hand, states that the trademark registration cancellation lawsuit must be filed within 5 (five) years of the date of trademark registration. If there is an element of bad faith and/or the relevant trademark is contrary to state ideology, legislation, morality, religion, decency, and public order, the cancellation lawsuit can be filed without a time limit.

According to the above-mentioned trademark cancellation regulation, a registered trademark can still be cancelled if sufficient evidence shows that the trademark is registered despite not meeting the absolute or relative grounds.²⁴ The explanation above, regarding the trademark cancellation lawsuit, the cancellation lawsuit is based on the non-fulfillment of absolute grounds (articles 20 and 21), considering that if the trademark does not meet the absolute grounds, registered and granted exclusive rights by the state means that the state has arbitrarily granted an out-of-place right, which will provide excessive monopoly. While the cancellation lawsuit is based on non-compliance with relative grounds, (Article 21), because if the trademark is still registered, it means that the state does not provide legal certainty or legal protection for senior trademark owners, or owners of well-known trademarks, or

24 Sudjana, "Akibat Hukum Penghapusan dan Pembatalan Merek Terdaftar Terhadap Hak Atas Merek (*Eletion and Cancellation of Registered Marks in The Perspective of Legal Certainty*), *Jurnal Law Res Nullius* 2 no. 2, (2020): 135

owners of geographical indications, and the state does omissions that can lead to conflict with the right holder who first registered the trademark.²⁵

Based on the findings of this study, it is known from the judge's decision that the plaintiff filed a lawsuit for cancellation of the trademark due to the registration of the same trademark as the plaintiff's trademark, namely the BIOAQUA trademark, in the same class of goods 3, and resulted in the trademark being registered; on the other hand, the plaintiff first registered his trademark on August 21, 2016, whereas the defendant's registration was on August 21, 2016. This lawsuit is being brought in order to obtain the rights that the plaintiff is entitled to, as well as the justice that the plaintiff is entitled to in the registration of the trademark.

The judge then decided that the cancellation lawsuit was not granted, as described in the Commercial Court decision Number: 39/Pdt.Sus-Merek/2019/PN.Niaga. Jkt.Pst. one of them that the judge rejected the trademark cancellation lawsuit filed by the Plaintiff for the entire. Based on the findings of the cancellation research, there are two considerations in Cassation Decision Number: 618 K/Pdt.Sus-HKI/2020 that are relevant to this research. The first is that the BIOAQUA trademark owned by the Plaintiff has not been registered, despite the fact that the Plaintiff first applied for registration but was met with opposition from a third party, namely (PT. Aqua Golden Missisipi, Tbk). Second, in the case at hand, no approval has been found for the plaintiff as the owner of the BIOAQUA trademark, so no legal protection should be provided to the Plaintiff.

Based on these facts, the plaintiff's trademark registration has been declared invalid due to opposition from third parties. The plaintiff is alleged to have made a mark that has similarities in essence, namely the word AQUA, while the plaintiff's mark applied for is the BIOAQUA mark, which has no similarity in terms of both the type of goods and

25 Delila Pritalia Cantika, "Pembatalan Hak Merek yang telah dijaminan Jaminan Fiducia", *Jurnal Jurist* 5 no. 1 (2018):8, <http://dx.doi.org/10.35586/v5i1.314>

the relevance of the goods and the mark, as described in the previous section. If we look at the history of the plaintiff's BIOAQUA trademark application, we can see that it was submitted to the Directorate General of Intellectual Property on August 23, 2016, with the registration number D002016039283. As a result, there is a 14-month wait for the next registration application. If it is calculable, the plaintiff's registration application was made ahead of time from the defendant. Because trademark protection begins on the date of receipt until the trademark application is granted and rights to the trademark are granted based on the doctrine of the first registrant in Article 3 of the law, the existence of this can be used as a reference for the judge to consider in the cancellation lawsuit filed by the Plaintiff.

If there is only one applicant and one trademark, the arrangement is made. However, there is a trademark that was registered again after the plaintiff made his application, but the previous trademark is being challenged by other parties due to the alleged similarity in the word AQUA. The question then becomes whether the defendant's BIOAQUA mark is not confusingly similar to the plaintiff's BIOAQUA mark. The answer is that there is some similarity. Thus, it is important to emphasize that with regard to the application of formalities from the beginning, until the registration of the trademark until then the trademark is registered, the trademark can be protected not only when it has been registered, but also during the registration process, as long as the trademark is applied for registration in accordance with legal procedures and does not conflict with the law. Because articles 20 and 21 describe the conditions for trademark registration, including when a trademark cannot be registered or is rejected. Article 20 letter b states that a trademark cannot be registered if it is "similar to, related to, or only mentions the goods and/or services for which registration is requested", and Article 21 paragraph 1 letter a states that "the registered trademark belongs to another party or is applied for first by another party for similar goods and/or services. In this case, the plaintiff's registration process follo-

wed legal procedures and was in accordance with the legislation; thus, this matter should be sufficient for the plaintiff to file a lawsuit against the Defendant for cancellation of the trademark.

Concerning the objections of other parties, the plaintiff responded with a response that essentially "rejects the assumption put forward by the co-defendant a quo because there is no similarity in essence or in its entirety with the AQUA trademark with the number IDM000452728," and the submission of responses to the response was completed within the time limit stipulated in articles 23 and 24. The existence of this should not be used as a basis for dismissing the plaintiff's trademark cancellation lawsuit. If there is an objection, it can be filed within 30 days from the date of the deadline for submission of objections, which will then be subject to substantive examination, and in Article 24 paragraph 3 it is explained that the applicant or his attorney may submit his response in writing within a maximum period of 30 (thirty) days from the date of sending the notification letter as referred to in paragraph (2). Based on this, the plaintiff has submitted his response to the authority in order to continue the substantive examination, but the process of registration of the plaintiff's trademark is still ongoing, and the results of the substantive examination have not been issued as to whether the plaintiff's trademark can be accepted or rejected, despite the fact that the plaintiff submitted a response on 20 February 2019 until 11 July 20. so that the Plaintiff gets clarity about the registration of the trademark.

The judge's second consideration, in the consideration mentioned that there has been no approval to the plaintiff as the owner of the BIOAQUA trademark, is because the plaintiff is still in the process of registering the trademark, so there has been no approval to the plaintiff as the owner of the trademark, but it is not an obstacle for the plaintiff in filing a lawsuit for cancellation to the defendant because Article 76 explained about the cancellation in wh Article 76 paragraph 1 states that "the lawsuit for cancellation of a

registered trademark may be filed by any interested party based on the reasons referred to in article 20 and/or article 21," implying that the lawsuit filed by the plaintiff is based on the existence of the elements mentioned in article 20 and 21. According to Article 20 letter b, a trademark cannot be registered if it is identical to, related to, or only mentions the goods and/or services for which registration is sought. Article 20 letter e states that a trademark cannot be registered if it lacks distinguishing power. Furthermore, Article 21 paragraph 1 letter a states that the application is rejected if the trademark shares similarities in principle and in its entirety with a registered trademark owned by another party or previously applied for by another party for similar goods and/or services. Furthermore, Article 21 paragraph 3 states that an application filed in bad faith is rejected. Based on the elements of article 20 and 21 mentioned in paragraph 1 of article 76, it is sufficient to file a lawsuit for trademark cancellation, because the elements mentioned are used as a reference or an absolute requirement in registering a trademark, and because the registration of the trademark made by the defendant is contrary to article 20 and 21, it can be used as the basis for trademark cancellation filed by the Plaintiff to the Defendant.

According to the Article mentioned above, the second consideration in Article 76 paragraph 2 also strengthens the explanation of Article 76 paragraph 1 as discussed above, in Article 76 paragraph 2 is explained about "the owner of an unregistered trademark may file a lawsuit as referred to in paragraph (1) after submitting an application to the Minister," with the existence of this, even though the plaintiff's trademark has not been registered, it can still file The trademark will be cancelled as a result of the cancellation lawsuit. And the lawsuit filed by the plaintiff is also filed within the time period as specified in Article 77 paragraph 1 which states that "the lawsuit for cancellation of trademark registration can only be filed within a period of 5 (five) years from the date of registration of the trademark". With the above-mentioned legislative regulation, the plaintiff's trademark cancellation lawsuit is appropriate, and the

judge can give consideration and decision in accordance with the plaintiff's rights and interests. The plaintiff's legal efforts in filing a lawsuit for trademark cancellation will result in legal consequences for the defendant, namely the cancellation of the trademark and the abolition of trademark registration, resulting in the termination of legal protection for the trademark in question. The rights to a cancelled trademark revert to the state's authority and become a free right, and the sign that created the cancelled trademark becomes a free sign that can be requested for registration by other parties in accordance with the procedures and procedures for obtaining rights through trademark registration applications. As a result of this decision, the trademark cancellation lawsuit based on Article 76, in particular, cannot be granted. However, because the defendant's application was granted, the rights to the trademark were attached to the defendant, and the existence of this can be seen in the database on the existence of this trademark still exists, so the protection of the BIOAQUA trademark is on the defendant as the owner of the rights to the registered trademark.

D. Conclusion

In the case of the BIOAQUA mark, legal protection was granted to the first applicant for registration of a mark against the defendant with registration number IDM000640247, registered date 27 March 2019, class of goods 3, and Tan Cin Jam as the owner of the mark. Even though the plaintiff has the same mark and class as the defendant and filed the application before the defendant, the plaintiff is not considered the first registrant. This is because the judge shared the same opinion as the authority. Article 3 of Law No. 20 Year 2016 on Trademarks and Geographical Indications specifies the terminology of the first registrant. In the judge's opinion, however, the application of the first registrant doctrine in the practice of trademark law can be supported by the doctrines of trademark equality, trademark good faith, and trademark distinguishability, thus providing legal protection for the first registrant of the trademark, in this case the plaintiff.

The judge's consideration in the BIOAQUA trademark cancellation case is based on Articles 76 and 77 of the Trademarks and Geographical Indications Act of 2016. The judge considered the content of Article 76, namely that registered trademarks can be cancelled, but the judge did not consider evidence of alleged bad faith by the defendant. As a result, the doctrine cannot be proven, and the defendant's trademark cannot be cancelled. The legal ramifications of this are that the defendant's BIOAQUA trademark is protected by registered trademarks.

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