



Bad Faith in the Cancellation of the Trademark Decision No. 2/Pdt.Sus-HKI/2021/PN. Niaga Sby

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ABSTRACT

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In granting a decision to cancel the trademark, the judges interpreted the existence of bad faith with different reasons in their considerations. One of the cases of trademark cancellation due to bad intentions is Case Number 2/Pdt.Sus-HKI/2021/PN. The purpose of this study is to find out the relationship between the cancellation of registered trademarks at the Directorate General of Intellectual Property of the Republic of Indonesia related to bad faith and to find out how to analyze the reasons for the judge's consideration in decision Number 2/Pdt.Sus-HKI/2021/PN. Sby's business is related to bad faith. This research is a normative legal research, with a legal approach and a case approach. From this study, it was obtained that the relationship between the cancellation of a registered trademark and bad faith was seen from the beginning of the registration application process, so that the Panel of Judges in deciding on a trademark cancellation decision, first looked at whether the element of bad faith had indeed existed from the beginning of the registration application, and regarding the juridical analysis of the decision of case 2/Pdt.Sus-HKI/2021/PN. Niaga Sby, Coffe Beer and Sari Temulawak Ngoro brands The Defendant was registered in bad faith from the beginning of the trademark registration without involving all heirs so that the Defendant hereby had bad intentions or bad faith because from the beginning of the registration, it was proven that there was bad faith by the Defendant. So juridically it has violated article 21 paragraph (3).

KEYWORDS:

Bad;faith; Trademark;
Trademark
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1. INTRODUCTION

A company's brand has built a character for its products which is expected to be able to form a business reputation for the use of the brand¹. Because of this, companies tend to seek to prevent other people or companies from using the brand in their products. Therefore, every entrepreneur will make any effort against the cancellation of the registration of a trademark that is proven to have imitated the used trademark until filing a lawsuit in court.

Trademarks based on regulations must be registered with the Directorate General of Intellectual Property in accordance with the mandate of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, so that the rights to a trademark² can be used for the trademark

registrant to anticipate in trademark disputes. Article 1 paragraph (1) of the Law on Trademarks and Geographical Indications states that a trademark is a sign that can be displayed graphically in the form of images, logos, names, words, letters, color arrangement numbers, in the form of 2 (two) dimensions or 3 (three) dimensions, sounds, holograms, or a combination of 2 (two) or more of these elements to distinguish goods and or services produced by persons or legal entities in trade or service activities.

Registration of rights to a trademark has been submitted to the Directorate General of Intellectual Property, it is possible that there are still several dispute factors that often arise and are faced by business actors in Indonesia. It should be noted that Indonesia is included in a country with a

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¹ Suyud Margono dan Amir Angkasa, *Komersialisasi Aset Komersial Aspek Hukum Bisnis*, (Jakarta: Gramedia Widiasarana Indonesia, 2002), h.147

² Karlina Perdana, *Kelemahan Undang-Undang Merek dalam Hal Pendaftaran Merek* (Studi atas Putusan Sengketa Merek Pierre Cardin)", *Privat Law Vol. V No.2* (2017), h. 84.

first-to-file registration system, namely the first registrant is the owner of trademark rights that are recognized and protected by their rights. This concept then raises another problem, namely the existence of bad faith for business competitors who know about this legal loophole and want to use it for their own benefit

Companies that infringe on trademark rights in accordance with the explanation of Article 21 paragraph 3 of the Law on Trademarks and Geographical Indications, namely having bad faith, that what is meant by "Applicant in bad faith" is an Applicant who has the intention to imitate or even plagiarize a trademark or follow the brand of another party and register it for his personal interests so as to cause the impact of unfair competition and even mislead the public. An example of bad faith is by applying for a trademark in the form of writing, painting, logo, or color arrangement that is the same as the brand belonging to another party or a brand that has been known to the public in general for many years, imitated in such a way that it has similarities in essence or all with the familiar brand. This can be assessed from the applicant because the applicant should at least know that there will be an element of intentionality in imitating a familiar brand.

Trademark infringement often occurs related to the acts of business actors who commit fraud in conducting business competition. Like a brand that wants to be registered turns out to be found to have similarities in the trademark that has been registered first, then there is bad faith and legal action can be taken, namely the cancellation of the trademark, with this the author is interested in the decision of the Surabaya District Court Number 2/Pdt.Sus-HKI/2021/PN. Niaga Sby, who decided that the defendant was proven guilty in the case of a trademark cancellation dispute on the principle of bad faith.

The element of "bad faith" has become an issue in the dispute over the rights to the Coffe Beer and Sari Temulawak brands with case registration number 2/Pdt.Sus-HKI/2021/PN. Niaga Sby between Mr. Yusianto, Mr. Rudianto, Mr. Tjoe Fen Lan has always been the plaintiff against Soerprayogi, DJKI cq. Directorate of Trademarks, Drs. Tjoe Hermawan Susanto, Dea Kim Fibrani Fauztina Sari, Devi Kim Feberiani Fauztina Naomi as defendants. The family business is a producer in the beverage industry. The brand products have been re-registered by the defendants without involving the names of the plaintiffs where the industry has been inherited to the children of the late Mrs. Nami and the late Mr. Tjokro Kokoh Hidayat.

Based on the background described, the problems that will be discussed are: How is bad faith related to trademark cancellation? And Whether it is in the consideration of the judge (Ratio Decidendi) in decision number 2/Pdt.Sus-HKU,2021/PN. Niaga Sby in accordance with Law Number 20 of 2016 concerning Trademarks and Geographical Indications?

2. RESEARCH METHODOLOGY

This study uses a normative juridical research method. This research is an analysis of primary legal materials and secondary legal materials. This will later be used in answering the problems that are the core of this research. A research approach is needed to obtain information from all perspectives about the problem that is an answer.

This research is carried out using an approach in terms of laws and regulations with the aim of answering or solving legal issues contained in the formulation of problems by referring to a law and a conceptual approach that focuses on legal principles.

The sources of legal materials used in this study are primary and secondary sources of legal materials. Primary legal materials are obtained from laws and regulations and judges' decisions. Meanwhile, secondary legal materials are obtained from books and journals that are relevant to the problem discussed.

3. DISCUSSION

1. Improper Faith Linkage to Trademark Cancellation

Trademark cancellation is a procedure that can be taken to eliminate the existence of registration from a registered trademark or cancel the validity of rights based on a trademark certificate. Meanwhile, trademark deletion is when a trademark is registered and not used in accordance with the purpose for which the trademark was registered. The Trademark and Geographical Indication law was established with the aim of preventing trademark owners from abusing their rights. Trademark cancellation and deregistration of a registered trademark may also end due to the expiration of the term of the trademark and not be renewed by the owner. The impact of the trademark cancellation is the end of the license agreement between the licensor and the recipient. Tables must be numbered using uppercase Roman numerals. Table captions must be centred and in 8 pt Regular font with Small Caps. Every word in a table caption must be capitalized except for short minor words as listed in Section III-B. Captions with table numbers must be placed before their associated tables, as shown in Table

Trademark cancellation is regulated in articles 68 to 71 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, trademark cancellation is carried out by the Director General of Intellectual Property Rights by crossing the trademark concerned from the general register of trademarks by providing the reason and date of trademark cancellation listed in articles 4, 5 and 6 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

There is a deadline given to file a lawsuit for five years since the trademark was registered, if the lawsuit is more than five years, it is not acceptable. However, it can also be at any time without a time limit if the brand is proven to be contrary to religious morality, morality, and public order.

Trademark cancellation submitted by the Director General of Intellectual Property Rights by crossing the trademark from the general register of trademarks by providing the reasons why the trademark was canceled and the date of cancellation. The trademark certificate held by the owner of the trademark or who has the right to the trademark is no longer valid and results in the termination of the legal protection of the trademark

Activities to register trademarks in Indonesia are based on the provisions of the Law on Trademarks and Geographical Indications, specifically regulated in Article 21. Article 21 of the Trademark and Geographical Indication Law generally requires the use of the principle of good faith in the implementation of trademark registration. If this condition is not met, then of course the brand is declared to be rejected. The meaning of good faith referred to in the Trademark and Geographical Indication Law is the absence of similarity or impromptness in most parts of the trademark to be registered. The provision that states that the registration of a trademark can be refused if it does not meet the principle of good faith, makes this principle an absolute condition that must be met and cannot be negotiated.

Protection of Intellectual Property Rights is needed because of trade. Protection is not only about trademarks but also includes trade secrets. Many aspects are very important for the protection of intellectual property, one of which is the active role of trademark rights owners. Almost all criminal or civil acts in Intellectual Property Rights cases in the field of trademarks. Infringement of fake brands that have bad faith in deceiving consumers.

Trademark registration activities may be carried out or applied for 2 (two) or more classes of goods and/or services at the same time. These provisions of course help make it easier for trademark applicants and trademark examiners which administratively and handle the examination will be easier. In addition, this provision does not contradict the provisions for the protection of persons or services of the type concerned.

Trademark cancellation is carried out by the Directorate General of Intellectual Property by crossing the trademark from the general register of trademarks by providing the reasons why the trademark was canceled and the date of its cancellation. The trademark certificate held by the owner of the trademark or who has the right to the trademark is no longer valid and results in the termination of the legal protection of the trademark

An application for trademark registration at the Directorate General of Intellectual Property of the Republic of Indonesia can be rejected due to bad faith, this is stated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications, where in Chapter IV it contains about trademark registration, the chapter discusses trademarks that cannot be registered and rejected, precisely in Article 21 Paragraph 3 of Law Number 20 of 2016, which is

said that "The application is rejected if submitted by an applicant in bad faith" means that in an application for trademark registration to the Directorate General of Intellectual Property must or must be submitted by the applicant in good faith and good faith is a mandatory thing for the applicant for registration in a trademark registration. Based on this in a trademark registration.

Trademarks that have been registered can be canceled, this is contained in article 76 of law number 20 of 2016 concerning trademarks and geographical indications which states that "A lawsuit for cancellation of a registered trademark can be filed by interested parties based on the reasons as referred to in articles 20 and/or 21", then in this case one of the things that can be a reason for trademark cancellation is the absence of good faith.

Bad faith here is the opposite of good faith. A brand owner in good faith is an honest brand owner, who conducts trademark registration in the absence of intent cheating on other people's brands such as piggybacking, imitating or plagiarizing people's brands that cause unfair competition and mislead consumers. So it can be interpreted here that a brand owner in bad faith is a dishonest brand owner, who registers a trademark in a fraudulent way, such as imitating someone else's brand, plagiarizing, hijacking the brand fame of another person which results in losses to the brand owner or the brand.

Based on this, in this case, the applicant in good faith is the registrant of the trademark registration application who registers his trademark without the intention to imitate, plagiarize or follow a mark that has been known by the public, meaning that there is honesty by the trademark registration applicant that the applicant is the owner or party who actually has the right to the trademark and does not intend to cheat to gain benefits from the fame or fame of other brands which will cause losses to other parties and harm consumers.

Bad faith is always related to the provisions of Article 21 Paragraph 1 of Law Number 20 of 2016 concerning Trademarks and Indications that the DJKI must reject the application if it occurs:

- a. The brand has similarities with other registered brands. The similarity is caused by the existence of prominent elements between brands and each other, so that there is an impression of similarity in the essence;
- b. The brand has similarities with other registered brands. There is no requirement that the well-known brand has been registered in Indonesia regarding the principal similarity to the well-known brand;
- c. Essentially, the "brand" has similarities or the whole with a familiar geographical indication. This is due to an error about the quality of the goods." In the sense of "similarity in essence" can be realized if the brand is considered.

Examination in a registration application. The examination of the registration application is intended to see

if the trademark is in accordance with the provisions and does not violate existing rules. The Directorate General of Intellectual Property is an implementing officer who carries out the task of carrying out the formulation and also as the implementer of policies in the field of intellectual property in accordance with the provisions of the law³.

The Directorate General of Intellectual Property of the Republic of Indonesia has the task to conduct a study on a trademark application to assess that the registered trademark is indeed registered by the applicant for trademark registration in good faith and not by a party in bad faith, regarding what is meant by an applicant in bad faith is an applicant who should be suspected of having the intention to imitate, plagiarizing or following the brand of another party for the sake of their business interests, creating unfair business competition conditions, deceiving or misleading consumers

The substantive examination conducted by the Directorate General of Intellectual Property of the Republic of Indonesia is an assessment of whether or not a trademark application is contrary to the rules in article 20 or article 21. A trademark that has been registered with the directorate general of intellectual property of the Republic of Indonesia means that it has passed the existing stages, including such as formality and substantive examinations by the directorate general of intellectual property of the Republic of Indonesia. A substantial examination of one of the things seen and assessed is about the good faith contained in the trademark registration application.

The existence of bad faith in a trademark cancellation lawsuit can no longer be done by looking at whether or not there is a rejection from the directorate general of intellectual property against the trademark or the passing of a trademark in a substantial examination by the directorate general of intellectual property. Because the basis for a cancellation lawsuit is that the aggrieved party feels that a trademark that has been registered should not be a registered trademark, because the applicant for registration is not in good faith, meaning that the plaintiff for trademark cancellation feels that the trademark should have been rejected by the Directorate General of Intellectual Property in the first place and means that in this case the plaintiff automatically feels that the trademark should not be able to pass the stage of substantive examination conducted by the Directorate General of Intellectual Property of the Republic of Indonesia, so in this case the substantive examination It is

no longer a reference to the existence or absence of good faith in a trademark infringement lawsuit in court.

The plaintiff of trademark cancellation who states in his lawsuit that the plaintiff has bad faith, must be able to prove that the registered trademark has indeed been carried out by the applicant who applied for registration in bad faith, so that the protection from the government or the granting of trademark rights to the registered trademark owner can be canceled if the lawsuit to the commercial court or cassation to the Supreme Court regarding the absence of good faith It can be proven and the statement is justified by the panel of judges.

The author is of the opinion that in Decision Number 2/Pdt.Sus-HKU,2021/PN. Niaga Sby has bad faith in the trademark registration carried out by the applicants. Thus, it can be said that the relationship and relationship between the cancellation of a registered trademark at the directorate general of intellectual property of the Republic of Indonesia in bad faith is found in the application for a trademark registration because 58 reasons for trademark cancellation regarding the existence of bad faith are seen from the beginning of the registration application process.

2. Adjustment of judges' considerations (Ratio Decidendi) in decision Number 2/Pdt.Sus-HKU,2021/PN. Niaga Sby with Law Number 20 of 2016 concerning Trademarks and Geographical Indications

Ratio Decidendi or judge's consideration is an argument or reason used by the judge as a legal consideration to be the basis for deciding a case.⁴ The judge's consideration or ratio decidendi, according to Peter Mahmud Marzuki, is the reason used by the judge as a legal consideration that is the basis for deciding the case.⁵ According to Sudikno Mertokusumo, Ratio decidendi or judge's consideration is part of the decision of Indonesia courts that consider the legal basis used in deciding a case⁶. In using the case approach, if the verdict is seen as the determination of a legal rule, what is binding is the consideration or reason that is directly related to the subject matter of the case, namely the legal rule is the legal basis of the "Ratio decidendi" decision.⁷

Judge's consideration is one of the most important aspects in determining the realization of the value of a judge's decision that contains justice and contains legal certainty, besides that it also contains benefits for the parties concerned

³ Direktorat Jendral Kekayaan Intelektual Kementerian Hukum & HAM R.I., "Struktur Organisasi", dapat diakses online pada <https://www.dgip.go.id/tentang-djki/strukturorganisasi/direktorat-jenderal-kekayaan-intelektual>, tanggal 5 Mei 2024

⁴ I.P.M Ranuhandoko, *Terminologi Hukum Inggris-Indonesia* (Jakarta: Sinar Grafika, 2003), 475.

⁵ Marzuki, *Penelitian Hukum*, 119.

⁶ Nurdianti, Zulfikar Jayakusuma, and Ferawati, 'Penegakan Hukum Terhadap Kasus Poligami Secara Nikah Siri Berdasarkan Putusan Hakim Pada Perkara Nomor 363/PID.B/2013/PN.Tng Dan Perkara Nomor 114/PID/2007/PT.Btn', *JOM Fakultas Hukum Universitas Riau* 6, no. 2 (2019): 11.

⁷ Sudikno Mertokusumo, *Hukum Acara Perdata Indonesia* (Yogyakarta: Liberty, 2002), 203.

so that this judge's consideration must be addressed carefully and carefully.

In this study, before entering into the interpretation of the judge in the consideration of the panel of judges in decision Number 2/Pdt.Sus-HKU,2021/PN. Niaga Sby is related to the principle of good faith, of course it is necessary to first know the initial verdict of the first level verdict of this case, namely the decision of the panel of judges of the Central Jakarta Commercial Court, namely decision Number 2/Pdt.Sus-HKU, 2021/PN. Niaga Sby.

The decision of the Surabaya Commercial Court number 2/Pdt.Sus-HKU, 2021/PN is a decision that resolves the case between Yusianto, Rudianto, Tjoe Fen Lan granting power of attorney to Dr. Uus Mulyaharja, S.E., S.H., M.H., M.Kn, CLA, Merine Harie Saputri, S.H., Kevin Lumentut, S.H., M.Kn. and Astrid Cornelia Wolkh Wagunu, S.H. the Advocates/Legal Consultants at the law office of MMP LAW FIRM which is based at Menara IGS, Jalan Embong Gayam No.17, Surabaya, based on a special power of attorney dated February 9, 2021, as the PLAINTIFFS; Against Soeprayogi, Tjoe Hermawan, Dea Kim Fibriani, Devi Kim, Ministry of Law and Human Rights, Directorate General of Intellectual Property, Directorate of Trademarks and Geographical Indications.

The occurrence of this case began when the defendants registered the Sari Temulawak and Coffee Beer brands in the Directorate General of Intellectual Property which in entering the names of the applicants for trademark registration class 30 and 32 without including the names of the plaintiffs, where this brand is the inherited brand of the plaintiffs' parents and the defendants which were inherited to their children, namely Soeprayogi, Yuwono, Tjoe Hermawan, Yusianto, Rudianto, Tjoe Fen Lan

The beginning of the case began when the defendants secretly applied for registration in their own name without consent and without the participation of other heirs by omitting the words "Sari Temulawak Agung" and the word "Coffee Beer" in the brand etiquette where the logo is exactly the same and identical to the brand, and has similarities in the whole and/or in essence, thus giving the impression of a similarity in form, the way of placement, the way of writing or the combination of elements, or the similarity of speech sounds.

Regarding the existence of bad faith at the beginning of the registration of the trademark, it began to secretly register the trademark in its own name without involving the names of other heirs, which was done deliberately considering that the defendant had previously known that the trademarks originated and were inspired by the brand "Sari Temulawak Agung + Painting Temulawak". Tegugugat was

too imposing his will by registering these trademarks without the knowledge and permission of the other heirs

The plaintiffs had made mediation efforts with the defendants but did not receive a good response from the defendants so the plaintiffs filed a lawsuit with the Surabaya Commercial Court to report the bad faith actions by the defendants so that the trademark was canceled. In this case, the plaintiff has violated article 21 paragraph 3 of the Law on Trademarks and Geographical Indications which in the registration of a trademark must be based in bad faith. This means that a registration of trademark rights registered in the act of "fraud" or "misleading" others, as well as behavior that ignores the legal obligation to obtain a reasonable advantage that is consciously done to achieve a dishonestly purpose, then such trademark application must be rejected and/or if it has been registered is canceled according to the law.

Lawsuit for registration of the trademark "Sari Temulawak Agung Ngajo Jombang + Painting" Class 32. IDM Registration No. 000752779, receipt date December 11, 2018, registration date May 20, 2020, Brand "Coffee Beer Agung Ngajo Jombang + Painting", Class 32, Registration No. IDM000752758, receipt date December 11, 2018, registration date May 20, 2020, Brand "Painting Temulawak" (opmark), Class 30 Registration No. IDM000813427, receipt date July 08, 2019, registration date December 07, 2020 and Brand "Logo Coffee Beer" (opmark), Class 32, Registration No. IDM000813429, date of receipt July 08, 2019, date of registration December 07, 2020, by the Defendant was done deliberately considering that the Defendant had previously known that the Trademarks originated and were inspired by the Brand "Sari Temulawak Agung + Painting Temulawak", Class 32, Registration No. IDM000214715 and the Brand "Coffee Beer", Class 32, Registration No. IDM000214717 in the name of Alm. Mrs. Narni (ic. The Plaintiffs). However, in this case, the Defendant imposed his will to control it by registering these trademarks without the knowledge and permission of the other heirs.

The Defendant in registering the trademarks was based on bad faith, because the Defendant knew that the trademarks were in the name of Alm. Mrs. Narni as the common property of all the heirs of Alm. Mrs. Narni, but the Defendant registered without the permission of the heirs of Alm. Mrs. Narni

Trademark cancellation is a procedure that can be taken to eliminate the existence of registration from a registered trademark or cancel the validity of rights based on a trademark certificate, while trademark cancellation is when a trademark is registered and not used in accordance with the purpose for which the trademark was registered.⁸ The

⁸ Nur Febry Rahmadhiani dan Catharina Ria Budiningsih, *ANALISIS HUKUM PENGHAPUSAN MEREK IKEA*, Syiar Hukum Jurnal Ilmu Hukum 15, no. 2 2017 h143

establishment of Law Number 20 of 2016 concerning Trademarks and Geographical Indications with the aim of preventing trademark owners from abusing their rights. Trademark cancellation and deregistration of a registered trademark may also end due to the expiration of the term of the trademark and not be renewed by the owner. The impact of the trademark cancellation is the end of the licensing agreement between the licensor and the recipient.⁹

The settlement of trademark disputes based on the Law on Trademarks and Geographical Indications consists of several lawsuits, namely: trademark removal; brand cancellation; compensation for trademark infringement against other parties who do not have the right to use the trademark with the similarity of goods or services with the registered trademark owner; the cessation of any actions related to the use of the Trademark by another party which in whole has similarities with similar goods or services by the registered trademark owner; As well as a lawsuit on the decision related to the rejection of the appeal application by the Trademark Appeal Commission.

A trademark cancellation lawsuit is only used in trademark disputes relating to the ownership of trademark rights, not against trademark disputes regarding the use of trademark rights. Trademark cancellation is generally filed through the mechanism of a lawsuit in the Commercial Court based on absolute reasons as stipulated in Article 20 of the Law on Trademarks and Geographical Indications or based on relative reasons as stipulated in Article 21 of the Law on Trademarks and Geographical Indications. The parties that have the capacity to apply for cancellation of registered trademarks include the following:

- a. All interested parties such as registered trademark owners, prosecutors, foundations/institutions in the consumer sector, and religious assemblies/institutions, as stipulated in Article 76 Paragraph 1 of the Law on Trademarks and Geographical Indications;
- b. Unregistered brand owners, i.e. brand owners in good faith but not registered or well-known brand owners but their brands are not registered. This is regulated in Article 76 Paragraph 2 of the Law on Trademarks and Geographical Indications;
- c. Parties interested in collective marks as referred to in Article 79 of the Law on Trademarks and Geographical Indications.

Trademark cancellation through filing a lawsuit in the Commercial Court is one of the legal tools provided by the Trademark and Geographical Indication Law for

interested parties or parties who object to the registration of a trademark.

The panel of judges of the Commercial Court in its consideration discussed and considered the principles known and embraced in connection with the provision of legal protection for trademarks, namely the First to File principle, which basically adheres to the principle of providing legal protection to the trademark holder based on the party who registers first, and the principle of First To Use, which basically adheres to the principle of providing legal protection to the trademark holder on the part of the owner and the first user against the brand.¹⁰

The panel of judges of the commercial court in its consideration connected the subject matter by referring to the provisions as referred to in Article 1 number 5 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which provides a description that basically the right to a Trademark is an exclusive right granted by the State to the holder of a registered trademark for a certain period of time by using the trademark itself or giving permission to other parties to Use

The consideration of the panel of judges of the commercial court refers to the provisions in Article 3 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which basically affirms that the right to a trademark is obtained after the trademark has been registered, which then in the Explanation section of article 3, it is affirmed that what is meant by "Registered" is after the application goes through the process of examining the formality, announcement process and substantive examination process and obtain the Minister's approval to issue a certificate.

The Judges' Consideration of the Central Jakarta Commercial Court argued that as referred to in Article 1 Number 5 Jo. Article 3 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, then in the a quo case, the Panel is of the opinion that the principle of First To File which provides legal protection for the trademark holder to the party who registered the trademark first, which if connected with the fixed evidence as described above, which is basically that the Defendant has registered the Sari Temulawak Agung and Coffe beer brands as described above, then the Panel is of the opinion that the one who is entitled to legal protection as the holder of the Sari Temulawak Agung and Coffe Beer brands is also the Defendant and based on this which is supported by the postulates of the Defendant as the holder of the disputed brand aforementioned.

The Panel of Judges in its consideration is of the opinion on the status of the Defendant as a party that receives

⁹ Adhi Budi Susilo, *PENYELESAIAN SENGKETA PEMBATALAN PENDAFTARAN MEREK (STUDI KASUS DUA KELINCI DAN GARUDA FOOD*, Jurnal Law Reform 6, No. 1 (2011) h 128

¹⁰ *Ibid*, h.23

legal protection as mentioned above, which is linked to the evidence submitted by the Plaintiff as mentioned in the list of evidence submitted by the Plaintiff, after the Panel examines it, then the Panel of Judges does not find any evidence that can be used as a basis to provide legal protection against the Plaintiff and on the other hand, The Plaintiff also could not prove the existence of bad faith from the application until the issuance of the trademark registration approval submitted by the Defendant to the Co-Defendant.

The Tribunal is of the opinion that the Plaintiff has not succeeded in proving the postulates of the lawsuit, while on the other hand, the Co-Defendant has succeeded in proving the postulates of its rebuttal, so that therefore, the petition of the Plaintiff requesting the Panel to declare the cancellation and declare that the Defendant has bad faith in submitting the application for registration of the trademarks of Sari Temulawak Agung and Coffe Beer under registration numbers IDM000752779 and IDM000813427, the registration date of May 20, 2020 and 07 December 2020, which is included in class 32 "beer, mineral water and soda water and other non-alcoholic beverages; drinks and fruit juices; syrup and other preparations for making beverages" to the Co-Defendant, must be declared rejected, and according to the panel of judges because the main petitum of the Plaintiff's lawsuit has been declared rejected, the postulates and proofs and the petitum of the Plaintiff's lawsuit are further considered unnecessary for further consideration, so the Plaintiff's lawsuit must be declared rejected in its entirety.

In this case, the first-instance decision of the Surabaya Commercial Court is as follows:

1. Grant the Plaintiffs' lawsuit in its entirety;
2. Declare that the Plaintiffs and/or all heirs of the deceased Mrs. Narni are the legal owners of the brands "Sari Temulawak Agung + Lukisan Temulawak" and "Coffee Beer" belonging to the late Mrs. Narni and its variants;
3. Declares that:
 - a. Brand "Sari Temulawak Agung Ngaro Jombang + Painting", class 32, Registration No. IDM000752779, in the name of the Defendant;
 - b. Brand "Coffee Beer Agung Ngoro Jombang + Painting", class 32, Registration No. IDM000752758, in the name of the Defendant;
 - c. Brand "Temu Lawak Painting", Class 30, Registration No. IDM000813427, in the name of the Defendant;
 - d. Brand "Logo Coffee Beer", class 32, Registration No. IDM000813429 in the name of the Defendant;has similarities in essence and/or all with the Brand "Sari Temulawak Agung + Painting Temulawak", Class 32, Registration No.

IDM000214715 and Brand "Coffee Beer", Class 32, Registration No. IDM000214717 registered in the name of the late Mrs. Narni;

4. Declaring that the registration of trademarks on behalf of the Defendant is based on bad faith, namely:
 - a. Brand "Sari Temulawak Agung Ngaro Jombang + Painting", class 32, Registration No. IDM000752779, in the name of the Defendant;
 - b. Brand "Coffee Beer Agung Ngoro Jombang + Painting", class 32, Registration No. IDM000752758, in the name of the Defendant;
 - c. Brand "Temu Lawak Painting", Class 30, Registration No. IDM000813427, in the name of the Defendant;
 - d. Brand "Logo Coffee Beer", class 32, Registration No. IDM000813429 in the name of the Defendant
5. Canceling the registration of trademarks on behalf of the defendant from the public register with all legal consequences, namely:
 - a. Brand "Sari Temulawak Agung Ngaro Jombang + Painting". Class 32 Registration No. IDM000752779, on behalf of the Defendant;
 - b. Brand "Coffe Beer Agung Ngoro Jombang + Painting", class 32 Registration No. IDM00813427, in the name of the Defendant;
 - c. Brand "Temu Lawak Painting", Class 30, Registration No. IDM000813427, in the name of the Defendant;
 - d. Brand "Logo Coffee Beer", class 32, Registration No. IDM000813429, on behalf of the Defendant;
6. Order the Authorized Registrar to submit a copy of the decision that has permanent legal force to the Co-Defendant I in order to carry out the cancellation of registration and the crossing out of the Trademarks on behalf of the Defendant from the General Register of Trademarks and announced in the Official Gazette of the Trademarks, namely: a.
 - a. Brand "Sari Temulawak Agung Ngaro Jombang + Painting", class 32, Registration No. IDM000752779, in the name of the Defendant;
 - b. Brand "Coffee Beer Agung Ngoro Jombang + Painting", class 32, Registration No. IDM000752758, in the name of the Defendant;

- c. Brand "Temu Lawak Painting", Class 30, Registration No. IDM000813427, in the name of the Defendant;
 - d. Brand "Logo Coffee Beer", class 32, Registration No. IDM000813429 in the name of the Defendant
7. Declare the application for registration of Trademarks on behalf of the Plaintiffs, namely:
- a. Sari Temulawak Agung Brand + Temulawak Painting, Class 30, Agenda No. DID2020069306, on behalf of the Plaintiffs;
 - b. Sari Temulawak Agung Brand + Temulawak Painting, Class 32, Agenda No. DID2020069309, on behalf of the Plaintiffs;
 - c. Coffee Beer Brand + Logo, Class 30, Agenda No. DID2020068930, on behalf of the Plaintiffs;
 - d. Coffee Beer Brand + Logo, Class 32, Agenda No. DID2020069836,
- on behalf of the Plaintiffs is the property of all heirs of the deceased Mrs. Narni so that it can be transferred to all heirs in accordance with the provisions of the applicable laws and regulations;
8. To order Co-Defendant I, Co-Defendant II, Co-Defendant III and Co-Defendant IV to participate in submitting and complying with the implementation of the decision of this case;
9. Sentence the Defendant to pay the cost of the case which until today is calculated in the amount of Rp. 6,589,000 (six million five hundred and eighty-nine thousand rupiah);

According to the Author, in this case, the legal efforts carried out by the plaintiff have yielded favorable results for the applicant, because the application submitted by the plaintiff was accepted by the Panel of Judges, this application in its decision to adjudicate itself to accept and grant the Plaintiff's lawsuit in full, so that according to the Author, this decision has been won by the Plaintiff because in its decision the panel of judges has decided to cancel the registered trademark from the defendant and declares that the Plaintiff/Applicant's trademark is a well-known brand and the Defendant/Respondent has bad faith.

Which in the judge's consideration and interpretation of bad faith in this case is as follows: That according to the panel of judges of the Supreme Court, the applicant's reason can be justified, because it applies the principle of First to File absolutely without regard to the bad faith of the Defendant/Respondent and without valid reasons to override the status of the Plaintiff's well-known trademark.

In the subject matter of the lawsuit, the Plaintiff stated that the registered trademark belonging to the

Defendant was in bad faith, so that later because of the lawsuit, the registration application made by the defendant to the co-defendant was then questioned, whether it had been done in good faith or it turned out to be in bad faith.

According to the author from the above descriptions, the author concludes that the bad faith of the Plaintiff as the defendant has certainly existed since the beginning of the application for trademark registration to the Directorate General of Intellectual Property of the Republic of Indonesia, because from the beginning the Defendant intended to register the trademark without including the names of other heirs so that from the beginning of the registration application the defendants had bad faith.

So juridically it is proven that at the time the defendant applied for trademark registration, the defendant had violated article 21 paragraph 3 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications.

Thus, this is an analysis conducted by the author regarding the reasons for the judge's consideration related to good faith in the decision of Decision Number 2/Pdt.Sus-HKU,2021/PN Niaga Sby.

4. CONCLUSION

Based on the description above, it can be concluded that:

1. The Relationship of Bad Faith in the Cancellation of the Trademark of Coffe Beer and Sari Temulawak is found in the application for registration of a trademark because the reason for the cancellation of the trademark regarding bad faith is seen from the beginning of the registration application process. In accordance with the Law on Trademarks and Geographical Indications No. 20 of 2016 article 21 paragraph 3 so that the panel of judges in deciding a decision to see whether the element of bad faith has indeed existed since the beginning of the registration application. Trademark registration registered in Indonesia, namely the cancellation of a registered trademark can be submitted by interested parties or trademark owners in the form of an application to the Directorate General of Intellectual Property. The cancellation of a registered trademark is in the background with bad faith at the time of registering the trademark where Indonesia adheres to the principle of First To File.

2. The judge's consideration (Ratio Decidendi) in decision number 2/Pdt.Sus-HKU,2021/PN Niaga Sby has been in accordance with Law no. 20 of 2016 concerning Trademarks and Geographical Indications, there is a dispute over the cancellation of the trademarks of Sari Temulawak Agung and Coffe Beer. Juridical analysis according to the author that the trademarks of Sari Temulawak Agung and Coffe Beer have been registered with the plaintiff applicant without involving the plaintiffs where this is an inheritance property so that all heirs including in this case the Panel of Judges decided this with article 21 paragraph 3 of the Law on Trademarks and Geographical Indications with bad faith on the defendants so

that the registration of the trademarks of Sari Temulawak Agung and Coffe Beer is canceled.

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