LEGAL CERTAINTY ON COMMERCIAL COURT AUTHORITY TO EXAMINE AND ADJUDICATE MARK DISPUTE WITHOUT PRIOR APPEAL PETITION TO THE MARK APPEAL COMMISSION

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ABSTRACT

Objective: The Mark Appeal Commission has a role in examining appeal petitions against the rejection of mark registration applications. However, when the Petitioner's mark registration is rejected by the Directorate of Mark and Geographical Indication, the Petitioner immediately files a lawsuit to the Commercial Court by going through the appeal stage at the Mark Appeal Commission, there are 2 (two) verdicts that rejects and grants the lawsuit.

Method: The problem of this research is related to the legal certainty on the commercial court authority to examine and adjudicate mark disputes without a prior appeal petition to the Mark Appeal Commission. The research uses a normative juridical method with qualitative analysis.

Result: The research indicates that the legal certainty on the commercial court authority to examine and adjudicate mark disputes without a prior appeal petition to the Mark Appeal Commission is that an appeal petition at the Mark Appeal Commission is not an obligation or necessity or a formal requirement (procedural law) of filing a lawsuit to the Commercial Court.

Conclusion: The meaning of the phrase “may” is a choice for the Petitioner to use the appeal instrument at the Mark Appeal Commission or not. Since the Directorate of Mark and Geographical Indication from the beginning has rejected the mark registration application, and the instrument of the Mark Appeal Commission is not carried out, then for the sake of legal certainty, only a court order in the form of a court verdict may change the decision of the Directorate of Mark and Geographical Indication.

Keywords: legal certainty, mark, appeal commission, mark dispute.

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SEGURANÇA JURÍDICA SOBRE A AUTORIDADE DO TRIBUNAL COMERCIAL PARA EXAMINAR E JULGAR DISPUTAS DE MARCA SEM PETIÇÃO PRÉVIA DE RECURSO À COMISSÃO DE RECURSO DE MARCA

RESUMO

Objetivo: A Comissão de Recurso de Marcas tem um papel na análise de petições de recurso contra o indeferimento de pedidos de registro de marcas. No entanto, quando o registro da marca do peticionário é rejeitado pela Direção de Marcas e Indicação Geográfica, o peticionário imediatamente apresenta uma ação judicial ao Tribunal de Comércio, passando pela fase de recurso na Comissão de Recurso de Marcas, há 2 (dois) vereditos que rejeitam e concedem o processo.

Método: O problema desta investigação está relacionado com a segurança jurídica para a autoridade do tribunal comercial para examinar e decidir litígios de marcas sem um recurso prévio à Comissão de Recurso de Marcas. A pesquisa utiliza um método jurídico normativo com análise qualitativa.

Resultado: A pesquisa indica que a segurança jurídica para a autoridade do tribunal comercial para examinar e julgar litígios de marcas sem um recurso prévio à Comissão de Recurso de Marcas é que um recurso na Comissão de Recurso de Marcas não é uma obrigação ou necessidade ou um requisito formal (lei processual) de apresentar uma ação ao Tribunal Comercial.

Conclusão: O significado da frase “pode” é uma escolha para o peticionário usar ou não o instrumento de recurso na Mark Appeal Commission. Uma vez que a Direção de Marcas e Indicações Geográficas indeferiu desde o início o pedido de registro de marca e que o instrumento da Comissão de Recurso de Marcas não foi executado, só por razões de segurança jurídica uma decisão judicial sob forma de uma decisão judicial pode alterar a decisão da Direção de Marcas e Indicação Geográfica.

Palavras-chave: segurança jurídica, marca, comissão de recurso, contestação de marca.

1 INTRODUCTION

One of intellectual work forms, namely mark, has an important role for the smooth trade of goods and services that serves as a differentiator between one product and another (Gautama, 2014). A mark is a distinguishing sign used by a business entity as a marker of its identity and the goods or services it produces to consumers, as well as to distinguish it from goods or services produced by other business entities (Munandar and Sitanggang, 2021). A mark is something affixed or placed on a product, but not the product itself, since after the goods are purchased, what the buyer enjoys is not the mark but the material object. (Masseno, 2022). Marks are only immaterial objects that cannot provide anything physically, it proves that mark is an immaterial property right (Saidin, 2013).

Mark is a part of Intellectual Property Law that has important value based on economic aspects (Gunawan, 2022). Through marks, entrepreneurs can maintain and
provide a guarantee of quality of the produced goods and/or services and prevent acts of unfair competition from other entrepreneurs who intend to piggyback on their reputation (Abdulkadir, 2001). Mark as a marketing and advertising device provides a certain level of information to consumers about goods and/or services produced by entrepreneurs (Jened, 2015).

A mark contained in a product must be registered to obtain legal protection from a country. The purpose of mark registration is that other people do not use the registered mark name for their products without the permission of the registered mark owner. A mark that does not have a registration certificate cannot be protected (Purba, 2014).

The registration of a mark in Indonesia adopts the Constitutive Stelsel system, i.e. the party that first registers a mark is the only party entitled to the mark and third parties must respect the rights of the mark registrant as an absolute right in registering a mark (Riswandi, 2015). The Constitutive Stelsel System adopts the first-to-file principle, meaning that the registration of a mark will only be given to the party that first submits a mark registration request, and the country does not provide registration for a mark similar to the mark submitted earlier to other parties, for similar goods/services (Miri, 2015). It is not usage, but registration that is considered important and determines the ownership of a mark. (Capcha Carrillo, 2022). The party that registers a mark is the only party entitled to the mark and third parties must respect the rights of the mark registrant as an absolute right (Santoso, 2019).

The mark owners of goods or services aim to register their marks to obtain legal protection and prevent other product entrepreneurs from using their mark names. This trademark registration plays an important role in marketing, and the registered mark can be recognized more widely by the public (Sudaryat, 2010).

Mark registrants whose applications are rejected by the Directorate of Mark and Geographical Indication may file an appeal to the Mark Appeal Commission as stipulated in Article 28 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication with a maximum appeal petition period of 90 (ninety) Days as of the Delivery Date of a notice on Application rejection as stipulated in Article 29 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication.

Problems occur when the Petitioner's mark registration is rejected by the Directorate of Mark and Geographical Indication. The Petitioner immediately files a lawsuit to the Commercial Court by going through the appeal stages at the Mark Appeal Commission.
Regarding the lawsuit, there is a disparity in the verdict of court judges as occurred in 2 (two) case examples, namely in the case of the Verdict of Central Jakarta Commercial Court Number 61/Pdt.Sus-Brand/2021/PN.Niaga.Jkt.Pst and the Verdict of Central Jakarta Commercial Court Number 87/Pdt.Sus-HKI/Merek/2022/PN.NiagaJkt.Pst.

Both cases have the same characteristics, related to a mark dispute case filed to the Commercial Court by going through the appeal procedures at the Mark Appeal Commission. Then, with the petitum on the cancellation of mark owned by the Defendant, it grants the mark registration submitted by the Plaintiff. The difference occurs in the verdict of the panel of judges.

In the Verdict of Central Jakarta Commercial Court Number 61/Pdt.Sus-Brand/2021/PN.Niaga.Jkt.Pst, the Panel of Judges of Central Jakarta Commercial Court chaired by Dulhusin, S.H., M.H. grants the Plaintiff's lawsuit, while in case Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Jkt.Pst, the Panel of Judges of Central Jakarta Commercial Court rejects the Plaintiff’s lawsuit on the grounds that it confounds the authority of Commercial Court, the authority of Directorate of Mark and Geographical Indication, and the authority of the Mark Appeal Commission.

According to the above background, the Writer conducts research about the legal certainty on the authority of Commercial Court to examine and adjudicate mark disputes without a prior appeal petition to the Mark Appeal Commission.

2 RESEARCH METHOD

This research is basically normative juridical research, since the target of this research is law or normative rules in the form of legal principles and the legal system (Soekanto and Mamuji 2007, Suwadi, et al, 2022). The normative research in this research is a study that describes or depicts in detail, systematically, thoroughly and in depth the legal certainty on the authority of Commercial Court to examine and adjudicate mark disputes without a prior appeal petition to the Mark Appeal Commission.

This is descriptive research since it describes the applicable statutory laws and is associated with legal theories in practice related to the problems that will be scrutinized (Riyanta, 2020). The obtained data will be analysed through a qualitative analysis.
3 RESULTS AND DISCUSSION

Mark is something (image or name) that can be used to identify a product or company in the market (Usman, 2002). Entrepreneurs usually try to prevent others from using their marks since by using a mark, traders gain a good reputation and the trust of consumers and can build a relationship between the reputation and a mark that the company has used regularly. The foregoing certainly requires the sacrifice of time, effort and money (Lindsey, 2011).

Mark rights are special rights granted by the government to mark owners to use the mark or to give permission to use it to others. In contrast to copyrights, marks must first be registered in the General Register of Mark (Lindsey, 2011). One thing to be conducted to obtain legal protection for the use of a mark is to register the possessed mark to the Directorate General of Intellectual Property Rights.

Mark registration according to the Law on Mark must be based on the principle of good faith. The mark registration system in Indonesia uses the first-to-file principle, i.e. the first mark registration system. It means the party that first submits a Mark registration application to the Directorate General of Intellectual Property Rights is given priority in obtaining mark registration and is recognized as a legitimate mark owner (Lindsey, 2011). However, there are times when the party who first registers the mark performs it under bad faith, thus it may harm other parties who actually have rights over the mark through the rejection of mark registration.

With the rejection of mark registration by Directorate of Mark and Geographical Indication, an appeal may be filed to the Mark Appeal Commission. The Mark Appeal Commission is an independent special agency in the vicinity of the ministry that carries out government affairs in the field of law. The purpose of Mark Appeal Commission establishment is to receive, examine and decide appeal petitions against the rejection of Mark registration application based on the grounds as referred to in Article 20 and/or Article 21 of Law Number 20 of 2016 concerning Mark and Geographical Indication.

A question arises regarding the legality of Petitioner if he/she immediately files a lawsuit to the Commercial Court, without filing an appeal to the Mark Appeal Commission as occurred in two case examples, namely in the case of the Verdict of Central Jakarta Commercial Court Number 61/Pdt.Sus-Brand/2021/PN.Niaga.Jkt.Pst and Verdict of Central Jakarta Commercial Court Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga. Jkt.Pst.
In the Verdict of Central Jakarta Commercial Court Number 61/Pdt.Sus-Brand/2021/PN.Niaga.Jkt. Pst, the litigants are Integrated Assessment Services Private Limited and Yuwono Puguh Santoso as Defendant; PT. Inovator Asesmen Sinergis as Co-Defendant I; and Directorate General of Intellectual Property specifically Directorate of Mark and Geographical Indication as Co-Defendant II.

In the case, the party of Integrated Assessment Services Private Limited files a lawsuit for the cancellation of mark owned by Yuwono Puguh Santoso, while at the same time grants the mark registration submitted by the Integrated Assessment Services Private Limited. It is known that the lawsuit is filed without a prior appeal petition to the Mark Appeal Commission.

Regarding this lawsuit, the Panel of Judges of Central Jakarta Commercial Court rejects the lawsuit of S. Rudy Wijaya and PT. Karya Mitra Sejiwa on the grounds that:

“Considering, that the mark registration application for “Tik Tok” with Application Number JID2020049458 belonging to Plaintiff I is rejected by Co-Defendant, then according to the procedural law, Plaintiff I may submit an appeal petition to the Mark Appeal Commission within the period as stipulated in Article 29 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication. However, Plaintiff I files a lawsuit for mark cancellation where in the petitum number 6 on page 11, Plaintiff I invokes the panel of judges of the case that Co-Defendant grants the Mark registration for “Tik Tok” with Application Number JID2020049458 belonging to Plaintiff I.”

The writer argues that an interpretation error is made by the Panel of Judges of Commercial Court that handles case Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga Jkt.Pst between S. Rudy Wijaya and PT. Karya Mitra Sejiwa with Willy Suwito. This error can be seen in the provisions of Article 28 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication which stipulate that:

“An appeal petition may be filed against the rejection of Petition based on the grounds as referred to in Article 20 and/or Article 21.”

According to the above provisions, there is a phrase “may”, meaning that the appeal petition is not an obligation or necessity or a formal requirement (procedural law) from filing a lawsuit to the Commercial Court. The meaning of phrase “may” is a choice for the Petitioner to use the appeal instruments at the Mark Appeal Commission or not.
This provision is also emphasized in Article 11 of Government Regulation Number 90 of 2019 on the Procedures of Appeal Petition, Examination and Settlement at the Mark Appeal Commission stating that:

“An Appeal Petition may be filed by the Appellant against:

a. the rejection of Mark registration application based on substantive reasons as referred to in Article 20 and Article 21 of the Law;
b. objections to the rejection of Mark extension application as referred to in Article 37 section (3) of the Law; and
c. the rejection of Geographical Indication registration application as referred to in Article 56 section (2) of the Law.”

Different matters related to the period for filing an appeal petition are expressly stipulated in Article 29 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication that its filing deadline is 90 (ninety) days from the Delivery Date of a notice on the rejection of Application. Article 29 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication stipulates that the legal consequences of not filing an appeal petition is that the rejection of Application is deemed to be accepted by the Petitioner, which if the Petitioner wishes to continue the dispute over his/her mark, then a lawsuit can be filed to the Commercial Court.

It is known that the flow of the mark dispute settlement process is carried out starting from the lawsuit registration by the owner of a registered mark and/or the licensee of a registered mark or related parties that have an interest in the registered mark. In a mark dispute, there must be the Defendant and the Plaintiff. The defendant is the owner of a registered mark where the filed lawsuit is the cancellation or removal of the mark. The lawsuit is filed since the Defendant uses a mark that has similarities in principle for the similar goods and/or services that have been registered (Gautama and Winata, 2017).

Another matter is related to the authority of Commercial Court to examine and decide on the cancellation petition of a mark owned by the Defendant, as well as to grant the mark registration submitted by the Plaintiff. It occurs in the consideration of the Panel of Judges of Central Jakarta Commercial Court in the lawsuit case of S. Rudy Wijaya and PT. Karya Mitra Sejiwa with Willy Suwito that:

“Considering, it is known that the authority to cancel a registered mark belong to the Commercial Court as stipulated in Article 76 section (3) of Law Number 20 of 2016 on Mark and Geographical Indication, while the authority to decide on a mark registration
application does not belong to the Commercial Court, but the authority of the Ministry of Law and Human Rights of the Republic of Indonesia specifically the Directorate General of Intellectual Property as stipulated in Article 24 of Law Number 20 of 2016 on Mark and Geographical Indication, and this process has been passed with a verdict of “rejected”, while a verdict declared as rejected cannot be annulled to be granted by the same institution, and the authority to annul the rejection verdict belongs to the Mark Appeal Commission, not the authority of the Directorate of Mark and Geographical Indication (Co-Defendant) that has made the verdict, in the petitum of petition point 6, Plaintiff I has confounded the authority of Commercial Court, the authority of the Co-Defendant, and authority of the Mark Appeal Commission.”

The writer argues that the main principle in the judicial system is simple, fast and low-cost justice as stipulated in Article 4 section (2) of Law Number 48 of 2009 on Judicial Power which aims to create an effective and efficient judiciary, so as to provide convenience to people who seek justice. In civil procedural law, there may be a merger of several lawsuits, a merger of lawsuits is also called a cumulative lawsuit or samenvoeging van vordering, namely the merger of more than one lawsuit into one lawsuit, the merger is due to connectivity between one another, the merger can be justified if among each of these lawsuits, there is a close relationship and to facilitate the process, the benefit of combining lawsuits is to avoid the possibility of conflicting verdicts.

It is in accordance with jurisprudence on the merger of lawsuits, i.e. in the Verdict of the Supreme Court of the Republic of Indonesia (MA-RI) No. 1043.K/Sip/1971, dated 3 December 1974 which stipulates:

“HIR does not govern the merger of lawsuits, thus it depends on the Judge in which case it is permitted, provided that it does not conflict with the fast and low-cost principles.”

The Verdict of MA-RI No. 677.K/Sip/1972, dated 13 December 1972 stipulates that:

“According to Jurisprudence, it is possible to “merge” lawsuits if there is a close relationship among the lawsuits, but it is not appropriate that a case (No. 53/1972.G) is used as a counterclaim against another case (No. 521/1971.G).”

The mark dispute case is also stated in the Verdict of Central Jakarta Commercial Court No. 27/Pdt.Sus-Merek/2018/PN.Niaga.Jkt. Pst, reinforced by the Cassation Verdict
of Supreme Court of the Republic of Indonesia, No. 161K/Pdt.Sus-HKI/2019, and the Verdict of Central Jakarta Commercial Court, Number 41/Pdt.Sus-Merek/2019/ PN. Niaga.Jkt. whose injunctions have granted the Plaintiff's petitum as the owner of an unregistered mark, by ordering the Directorate of Mark and Geographical Indication (Co- Defendant II) to grant the Mark registration application to the owner of the unregistered mark.

The writer also argues that when observing the Verdict of Central Jakarta Commercial Court Number 61/Pdt.Sus-Merek/2021/PN.Niaga.Jkt. Pst and the Verdict of Central Jakarta Commercial Court Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Jkt. Pst, both cases invoke in its subsidiary petitum that if the Chairman of Central Jakarta Commercial Court has another argument, invoke the fairest possible decision (ex aequo et bono). The purpose of the subsidiary petitum is that if the primary claim is rejected, there remains the possibility of a lawsuit being granted based on the freedom of the judges and justice, in the verdict made by the judges.

The lawsuit filed by the Plaintiff in the two case examples above is in accordance with Article 118 HIR, that a lawsuit must be filed with a request letter, signed by the Plaintiff or his/her representatives. The difference lies only in the judge's verdict, i.e. the Judge of Central Jakarta Commercial Court that handles case Number 61/Pdt.Sus-Merek/2021/PN. Niaga.Jkt. Pst grants the Plaintiff's lawsuit, while the Judge of Central Jakarta Commercial Court that handles case Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga. Jkt.Pst rejects the Plaintiff's lawsuit.

The writer argues that the Judge of Central Jakarta Commercial Court may use their authority as stipulated in Article 5 section (1) of Law Number 48 of 2009 on Judicial Power that has the obligations to explore, follow, and understand legal values and a sense of justice that lives in society. The obligation may be carried out through legal discovery that will become jurisprudence in the future by referring to the petitum of ex aequo et bono.

According to Yahya Harahap (2005), the verdict of ex aequo et bono may not exceed the subject matter of primary petitum, thus the verdict does not violate ultra petitum partium outlined in Article 178 section (3) of HIR, while on the other hand, the verdict should not inflict loss to the Defendant in defending its interests (Kho and Adiasih, 2021: 361). The Supreme Court Jurisprudence No. 140 K/Sip/1971, dated 12 August 1972, in the case of Mertowidjojo Cs vs B. Mertodirdjo states the rule of “The judge's
verdict that grants *ex aequo et bono* must still be related to the primary petitum frameworks”.

It conforms to the limitations of the judge principles in deciding a case, namely:

### 3.1 CONTAINS CLEAR AND DETAILED REASONS

The legal considerations of the Panel of Judges of Central Jakarta Commercial Court in case Number 61/Pdt.Sus-Merek/2021/PN.Niaga.Jkt. Pst on page 71-72 that reads:

> “Considering, that if the evidence is linked to the expert opinion of Dr. Suyud Margono, S.H., M.Hum., FCIArb submitted in the trial and witnesses, the Panel concludes and argues that the Mark “IAS INTEGRATED ASSESSMENT SERVICES AND LOGO, Registration Number : IDM000655623, registered under the name of the Defendant has the same principal in terms of writing, pronunciation, and logo in the IAS Integrated Assessment Services Mark under the name of the Plaintiff, and registered by the Defendant under bad faith since previously the Defendant knows the mark belongs to the Plaintiff, that uses it together with the Defendant when the Defendant works as a franchisee and at the same time as an Auditor that provides services in the form of an ISO certificate to several companies and agencies in Indonesia, thus petitum numbers 2 and 3 of the Plaintiff's lawsuit may be granted;

> Considering, the same also goes for petitum number 3, 4 and 5, since the Defendant's mark is similar in principle or in whole, and registered under bad faith, then petitum 3, 4, 5 may be granted;

> Considering, that since Plaintiff is the actual owner of mark, petitum number 6 may be granted, and petitum number 7 since the Defendant is on the losing side, then petitum number 7 may also be granted;

> Considering, that since all the petitums of the plaintiff's lawsuit are granted, then petitum number 1 may be granted.”

### 3.2 MUST ADJUDICATE ALL PARTS OF LAWSUIT

The purpose of *ex aequo et bono* petitum is that the judge is free and has the authority to determine otherwise based on the petitum of *ex aequo et bono*, provided that it must be based on appropriateness, the appropriateness that is granted still certainly lies
within the frameworks of the primary petition and the postulates of lawsuit (Supreme Court of the Republic of Indonesia, 2019).

In the case Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Jkt.Pst, even though the authority of a mark registration application belongs to the Directorate of Mark and Geographical Indication, and the authority to annul the rejection verdict belongs to the Mark Appeal Commission, but since the Directorate of Mark and Geographical Indication from the beginning has rejected the mark registration application, and the instrument of the Mark Appeal Commission is not carried out, then for the sake of legal certainty and justice, only a court order in the form of a court verdict may change the decision of the Directorate of Mark and Geographical Indication as stipulated in Article 64 section (3) point c of Law Number 30 of 2014 on Government Administration, the decision on revocation may be carried out by order of the Court.

In accordance with the foregoing, the Panel of Judges that handles case Number 87/Pdt.Sus-HKI/Merek/2022/PN.Niaga.Jkt. Pst may grant the Plaintiff's petition as conducted by the Panel of Judge that handles case Number 61/Pdt.Sus-Merek/2021/PN.Niaga.Jkt. Pst.

4 CONCLUSION

The conclusion in this research is that the legal certainty on the authority of Commercial Court to examine and adjudicate mark disputes without a prior appeal petition to the Mark Appeal Commission is the existence of phrase “may” in Article 28 section (1) of Law Number 20 of 2016 on Mark and Geographical Indication, meaning that the appeal is not an obligation or necessity or a formal requirement (procedural law) for filing a lawsuit to the Commercial Court. The meaning of phrase “may” is a choice for the Petitioner to use the appeal instrument at the Mark Appeal Commission or not. Since the Directorate of Mark and Geographical Indication from the beginning has rejected a mark registration application, and the instrument of the Mark Appeal Commission is not carried out, for the sake of legal certainty, only a court order in the form of a court verdict may change the decision of the Directorate of Mark and Geographical Indication as stipulated in Article 64 section (3) point c of Law Number 30 of 2014 on Government Administration, the decision on revocation may be carried out by order of the Court.
COMPETING INTERESTS

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