

Settlement of Brand Rights Disputes Through the Commercial Court in Indonesia: Study of Surabaya Court Decision

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Abstract

Brands play a significant role in economic development because they help consumers identify the origin of a product or service. At the time of brand registration with Directorate General of Intellectual Property, brand ownership is acknowledged. The first prerequisite for registering a brand is ensuring that it possesses all of its attributes. Therefore, there are characteristics that distinguish it from other brands. Despite these regulations, brand infringements still occur. One of them is the disagreement between PT. Gudang Garam and PT. Gudang Baru, whose brands are comparable. Therefore, a study on Indonesian law enforcement in resolving brand issues is required. The current study employed normative legal research and normative juridical methodologies. Using a descriptive qualitative data analysis, the study focused on laws and regulations. The Surabaya Commercial Court determined, based on a dispute between PT. Gudang Garam and PT. Gudang Baru, that PT. Gudang Baru breached Article 21 Paragraph 1 of Law No. 20 of 2016, therefore declaring the Gudang Baru brand to be comparable to the well-known Gudang Garam brand. As a result, the Gudang Baru brand was revoked, and to ensure a deterrent effect, DGKI ordered that any application for registration of a brand that resembles PT. Gudang Garam be denied.

Keywords: Brand; Gudang Garam; Gudang Baru.

Abstrak

Merek memegang peranan penting dalam pembangunan ekonomi karena berguna sebagai pedoman untuk mengidentifikasi sumber suatu produk/jasa. Kepemilikan merek diakui pada saat pendaftaran merek di Direktorat Jenderal Kekayaan Intelektual. Dalam mendaftarkan merek, syarat utamanya adalah memastikan bahwa merek tersebut memiliki semua karakteristik. Karena itu, ada unsur yang sangat membedakannya dengan merek pihak lain. Bahkan dengan peraturan ini, ada juga pelanggaran merek dagang. Salah satunya adalah sengketa PT. Gudang Garam & PT. Gudang Baru yang memiliki merek yang dapat dikatakan serupa. Oleh karena itu, diperlukan suatu kajian untuk membahas penegakan hukum Indonesia dalam penyelesaian sengketa merek tersebut. Penelitian menggunakan metode penelitian hukum normatif serta pendekatan yuridis normatif. Penelitian menggunakan teknik analisis data kualitatif dengan memfokuskan pada peraturan perundang-undangan. Berdasarkan sengketa antara PT. Gudang Garam dan PT. Gudang Baru, Pengadilan Niaga Surabaya memutuskan bahwa PT. Gudang Baru telah melanggar Pasal 21 Ayat 1 Undang-Undang No.20 Tahun 2016 sehingga menyatakan merek Gudang Baru memiliki kesamaan dengan merek Gudang Garam

yang merupakan merek terkenal. Oleh karena itu, merek Gudang Baru dibatalkan dan untuk menjamin efek jera memerintahkan DJKI untuk menolak segala permohonan pendaftaran merek yang memiliki beberapa kemiripan dengan PT. Gudang Garam.

Keywords: Merek; Gudang Garam; Gudang Baru.



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A. INTRODUCTION

Globalization has made activities in the trade sector increase, and has even placed the world as a single common market.¹ The mobilization of goods and services on an inter-country scale requires standardization and protection, especially since countries realize that trade is a very important factor in improving the country's economy. Thus, the trade sector must be given a role if the country's economy is to progress. One of the important instruments in trade is Brand,² based on UU No. 20 Tahun 2016 on Brand and Geographical Indications explains that, Brand is "a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and / or 3 (three) dimensions, sound, 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 trading activities of goods and / or services". With the Brand, then all parties involved in the trade (Buyers, Sellers and Society) will be encouraged to do honestly, maintain the quality of the law through the Brand, including by ratifying the Paris Convention for the Protection of Industrial Property (Paris Convention) which has been ratified by Keputusan Presiden No. 15 of 1997 and Brand Law Treaty (Brand Law Treaty) which was ratified by Keputusan Presiden No. 17 of 1997.

With the development of industry and economy, Brand has become an important aspect in the world of trade and marketing as entrepreneurs compete to market the products/services they offer. Brand plays an important role in determining the origin of a product or service. The function of a unique brand is to make it easier for buyers to recognize and buy a product or service based on its quality and characteristics, which are usually seen in terms of the uniqueness of the brand.³ For the producers themselves, the brand serves as a reputation for the products they have produced.⁴ The selection of goods and services distributed is usually considered by the brand itself. In addition to the above functions, brand is used in trade and

¹ Desak Made Dwipayani and Nurul Fazriyah, "PERKARA PENOLAKAN PEMBATALAN MEREK TERDAFTAR DALAM GUGATAN PERDATA ANALISIS PUTUSAN PENGADILAN NIAGA JAKARTA PUSAT NOMOR 02/MEREK/2002/PN.NIAGA.JKT.PST," *Ganesh Law Review* 3, no. 2 (July 7, 2021): 97–110, <https://doi.org/10.23887/glr.v3i2.445>.

² Wizna Gania Balqis and Budi Santoso, "Arti Penting Perlindungan Merek Terdaftar Bagi Komunitas Penghasil Produk Ekonomi Kreatif," *Jurnal Pembangunan Hukum Indonesia* 2, no. 2 (May 10, 2020): 205–21, <https://doi.org/10.14710/jphi.v2i2.205-221>.

³ Rika Ratna Permata, Tasya Safiranita, and Biondy Utama, "Tinjauan Kasus Tentang Dilusi Merek Di Indonesia Dan Thailand," *Jurnal Hukum Ius Quia Iustum* 26, no. 1 (April 24, 2019): 1–20, <https://doi.org/10.20885/iustum.vol26.iss1.art1>.

⁴ Laina Rafianti, "Perkembangan Hukum Merek Di Indonesia," *FIAT JUSTISIA: Jurnal Ilmu Hukum* 7, no. 1 (October 26, 2015), <https://doi.org/10.25041/fiatjustisia.v7no1.364>.

advertising because people tend to associate the image, impression, quality and value of a product or service with a particular brand.⁵ The brand reputation of a product or service is generally related to the quality offered. Therefore, there are hidden stereotypes about goods/services that implicitly influence consumers to choose a brand. Branding indirectly guarantees the value or quality of goods and services, aka it can provide protection and quality assurance of goods and services to buyers..

Sometimes consumers are confused about choosing a product or service if it is not accompanied by a brand.⁶ So, while maintaining a brand costs more than the company's actual assets, it's no wonder that businesses prioritize branding their products. Customers are more loyal to these brands, and vice versa. Some examples of such brands are the logos of large and reputable banks that have been operating in Indonesia for decades and even hundreds of years such as BCA, Mandiri, BRI, and BNI banks. Unfair business competition can also be avoided when a good or service has obtained a brand. With the emergence of a brand, the goods or services offered by business actors can be differentiated in terms of quality, assurance, and originality of a product. Sometimes, an expensive good or service is not caused by expensive production costs or human resources, but by its brand.

Therefore, so that there are no disputes over brand rights, the brand must be registered in advance to the Directorate General of Intellectual Property (DJKI), to obtain ownership of the brand.⁷ The main requirement in registering a brand is to ensure that the brand has its own characteristics in order to have a strong element of distinction with other business-owned brands.⁸ The Directorate General of Intellectual Property (DJKI) can also reject the brand registration file if the brand to be registered is similar to the brand that has been registered by other businesses.

Based on Pasal 21 Ayat 1 UU No. 20 Tahun 2016 explains that: "The application may be rejected by the Directorate General of Intellectual Property (DJKI) if the other party's brand has been registered in advance with similar goods or services, well-known brands owned by other parties for similar goods or services, well-known brands owned by other parties for non-similar goods or services that meet certain requirements, or the existence of registered geographical indications". But in fact, many companies have difficulty in avoiding plagiarism by other parties to their brands. This widespread trademark violation is caused by the consumptive attitude of society itself.⁹ The purpose of plagiarism or plagiarism of well-known brands is to market the results of a production that can be in the form of goods or services by using popularity, reputation quality assurance about the character, features, functions or quantity of other

⁵ Nertivia Nertivia et al., "Polemik Warkopi vs. Warkop DKI: Apa Yang Salah?," *Journal of Judicial Review* 24, no. 1 (June 14, 2022): 149, <https://doi.org/10.37253/jjr.v24i1.6736>.

⁶ Rena Feri Wijayanti, Tri Yulistyawati Evelina, and Lina Budiarti, "ANALISIS PENGARUH PERSEPSI HARGA DAN PERSEPSI KUALITAS TERHADAP MINAT PEMBELIAN PRODUK PRIVATE LABEL," *Adbis: Jurnal Administrasi Dan Bisnis* 11, no. 2 (December 31, 2017): 161, <https://doi.org/10.33795/j-adbis.v11i2.26>.

⁷ Dedi Jaya and Hari Sutra Disemadi, "Prospects of Trademark Registration To Recover The Economic of MSMEs Actors in Service Sector after The Pandemic," *Widya Yuridika* 5, no. 2 (September 1, 2022): 265, <https://doi.org/10.31328/wy.v5i2.3504>.

⁸ Mudassir Mathar, "ASPEK HUKUM USAHA WARALABA DI INDONESIA," *Jurnal Ilmiah Al-Syir'ah* 4, no. 1 (August 26, 2016), <https://doi.org/10.30984/as.v4i1.211>.

⁹ Admin Admin, "PERLINDUNGAN HUKUM TERHADAP MEREK TERKENAL (WELL-KNOWN) DI INDONESIA," *Reformasi Hukum* 23, no. 1 (November 27, 2019): 1–18, <https://doi.org/10.46257/jrh.v23i1.54>.

production goods that meet the above conditions. Brand plagiarism can be categorized as a form of unfair business competition. Irresponsible parties often engage in such practices to increase their profits quickly. As a result, these parties do not have to bear the risk of developing products or services and paying for research, building risky brands, and reducing advertising and advertising funds.

One of the acts of brand plagiarism that occurred in Indonesia is the dispute between Gudang Garam and Gudang Baru. Judging from previous research, Gudang Garam and Gudang Baru have long been in dispute regarding the plagiarism of cigarette brand packaging. In 2012, the first lawsuit was launched by Gudang Garam against Gudang Baru and lasted for years. Until finally in 2015, Supreme Court Decision Number 104 PK/Pid.Sus/2015 was issued which was won by Gudang Baru through appeal and Supreme Court Decision Number 119 PK/Pdt.Sus-HKI/2017 which was won by Gudang Garam through judicial review. Although the owner of Gudang Baru has lost the brand dispute case, But he was not deterred and continued his Gudang Baru business by using a different brand to get around. Gudang Baru continues to use brand packaging that still has some similarities with Gudang Garam. The continuation of this action will cause chaos between Gudang Garam and the Gudang Baru. Consumers will be confused by the state of cigarette packaging that is almost the same as each other, which causes an interpretation in the community that the Gudang Baru brand is part of Gudang Garam so that it will affect the sales turnover of its products. Then, Gudang Garam decided to file a lawsuit for the cancellation of Gudang Baru's brand again on March 22, 2021. The case was processed at the Surabaya District Court with case number 3/Pdt.Sus-HKI/Merek/2021. Gudang Garam made a petitum containing the following, namely granting all of the plaintiff's claims, Gudang Garam and its paintings are well-known brands, and the Gudang Baru, Gedung Baru and Gudang Baru Origin brands along with their paintings have plagiarized in their entirety from Gudang Garam's brands. The purpose of writing this research is that the focus discussed in the content of this research, namely the latest decision that was issued in 2021, will be discussed in more detail.

B. METHOD

The research method used is normative legal research. The approach used is a statutory approach that bases its analysis on applicable laws and regulations and is relevant to the legal issues that are the focus of this research.¹⁰ This research also focuses on the use of legal norms contained in laws and regulations and court decisions as well as customary norms found in society in general which are then matched with the Gudang Garam Brand case with Gudang Baru as a reference. The research uses qualitative data analysis techniques and the law will be used as a reference in writing the article and the results of the analysis will be written qualitatively so that readers can understand the message the author wants to convey.

¹⁰ Kornelius Benuf and Muhamad Azhar, "Metodologi Penelitian Hukum Sebagai Instrumen Mengurai Permasalahan Hukum Kontemporer," *Gema Keadilan* 7, no. 1 (April 1, 2020): 20–33, <https://doi.org/10.14710/gk.2020.7504>.

C. RESULTS AND DISCUSSIONS

1. Settlement of Brand Rights Disputes Based on Indonesian Regulations

The law governing brands is UU No. 20 Tahun 2016 on Brands and Geographical Indications revoking UU No. 15 Tahun 2001 on Brands. According to the Act, "The right to a brand is an exclusive right granted by the State to the owner of a brand registered in the General Register of Brands for a certain period of time by using the brand itself or granting permission to other parties to use it." Brand protection can be implemented with a constitutive protection system that requires registration first in order to obtain rights to a brand. Brand registration aims to provide status that the registrant is considered as the first user until someone else proves otherwise.^{11,12} Rights to the brand does not exist if without registration.¹³ Registration of the brand can be used as a basis for obtaining a legal certainty and legal protection of the rights to the brand.¹⁴ If there is a dispute arising due to a dispute over the ownership of the brand, the government will use the brand certificate as a reference that can prove the ownership of rights to the brand formally. Brand registration is done to the Direktorat Jenderal Hak Kekayaan Intelektual which has now changed its name to the Direktorat Jenderal Kekayaan Intelektual or DJKI. Brand registration procedures are carried out with the first step is to apply for brand registration by filling out a duplicate form by the applicant or his attorney to the Minister of Law and Human Rights. Provisions for uploading the application form pay attention to the description of the classification of the class of goods/services must attach documents, such as proof of payment of application fees, information about fees, brand labels totaling three sheets and a statement of ownership of the brand, power of attorney, if the application is submitted through a power of attorney, and proof of priority. Then, an application for brand registration will be accepted if the application has passed the requirements specified by the Brand Law. If it has passed the substantive examination and there are no problems from the application for brand registration, the brand will be officially registered with evidence of the issuance of a brand certificate by the Minister of Law and Human Rights.¹⁵

Based on Pasal 21 UU No. 20 Tahun 2016, the brand application should be rejected if it has similarities with other brands, substantially or entirely.¹⁶ Then if the brand application resembles the name of another person or legal entity, flag, emblem, symbol, or emblem of the state and its institutions, or official marks and seals used by the state. And also an application

¹¹ Rouf Fajrin Widiantoro, "Pendaftaran Merek Sebagai Sarana Perlindungan Hukum," *Jurnal Lex Renaissance* 7, no. 2 (April 1, 2022): 416–26, <https://doi.org/10.20885/JLR.vol7.iss2.art14>.

¹² Gossain Jotyka and I Gusti Ketut Riski Suputra, "PROSEDUR PENDAFTARAN DAN PENGALIHAN MEREK SERTA UPAYA PERLINDUNGAN HUKUM TERHADAP MEREK TERKENAL MENURUT UNDANG-UNDANG NOMOR 15 TAHUN 2001," *Ganesha Law Review* 3, no. 2 (July 1, 2021): 125–39, <https://doi.org/10.23887/glr.v3i2.447>.

¹³ Trisadini Prasastinah Usanti, "GADAI ATAS JAMINAN SERTIFIKAT MEREK PADA BANK SYARIAH," *Mimbar Hukum - Fakultas Hukum Universitas Gadjah Mada* 29, no. 3 (January 12, 2018): 413, <https://doi.org/10.22146/jmh.26795>.

¹⁴ Zaenal Arifin and Muhammad Iqbal, "PERLINDUNGAN HUKUM TERHADAP MEREK YANG TERDAFTAR," *Jurnal Ius Constituendum* 5, no. 1 (May 13, 2020): 47, <https://doi.org/10.26623/jic.v5i1.2117>.

¹⁵ Andrew Betlehn and Prisca Oktaviani Samosir, "UPAYA PERLINDUNGAN HUKUM TERHADAP MEREK INDUSTRI UMKM DI INDONESIA," *Law and Justice* 3, no. 1 (November 2, 2018): 1–11, <https://doi.org/10.23917/laj.v3i1.6080>.

¹⁶ Rinitami Njatrijani, "PERLINDUNGAN MERK BAGI PENGUSAHA UMKM DI KECAMATAN JUWANA KABUPATEN PATI," *Gema Keadilan* 8, no. 1 (May 12, 2021): 50–62, <https://doi.org/10.14710/gk.2021.11002>.

can also be rejected if it is known that there is a bad intention behind the brand registration application.

If there is a plagiarism of a brand by a party who does not have rights to the brand, then the dispute resolution can be done through two channels, namely the court and non-judicial channels or also known as Alternative Dispute Resolution ("APS").¹⁷ Some forms of APS that have been known are negotiation, mediation, conciliation and arbitration.¹⁸ For litigation, any person who feels that their rights have been violated can file a lawsuit with the Commercial Court for violations committed by other parties against their intellectual property. As for settlement in non-litigation or APS, Indonesia has a law that regulates APS, namely Undang-Undang Nomor 30 Tahun 1999 concerning Arbitration and Alternative Dispute Resolution ("Law 30/1999"). This law regulates the settlement of disputes or disagreements between parties in a certain legal relationship who have entered into an arbitration agreement which expressly states that all disputes or disagreements arising or which may arise from the legal relationship will be resolved by arbitration or through alternative dispute resolution. In the case of the brand dispute experienced by Gudang Garam and Gudang Baru, Gudang Garam prefers to resolve the dispute through litigation.

2. Settlement of Gudang Gaaram Trademark Dispute Case with Gudang Baru

The dispute over the cancellation of the brand that occurred between the Gudang Garam cigarette brand and the Gudang Baru cigarette brand originated from the non-acceptance of PT Gudang Garam Tbk. with the image or logo of the Gudang Baru brand which has elements of similarity in essence with the Gudang Garam brand. Based on this, PT Gudang Garam Tbk. as the applicant filed a lawsuit for brand cancellation on H. Ali Khosin S.E in the Commercial Court at Surabaya District Court on May 29, 2013.

The brand cancellation lawsuit is based on Pasal 68 UU Merek which states that: "A lawsuit for cancellation of brand registration may be filed by any interested party based on the grounds as referred to in Article 4, Article 5, Article 6 of the Brand Law." The plaintiff strongly objected to the registration of the Gudang Baru brand on the grounds that the Gudang Baru brand and paintings registered under registration numbers IDM000032226 dated March 21, 2005 and IDM000042757 dated July 14, 2005 are substantially similar to the Gudang Garam brand, the type of Gudang Baru brand and paintings are also the same or similar and are included in the same class as the Gudang Garam brand, namely class 34 in the form of tobacco, other smoking goods.

The objection to the registration of Gudang Baru and paintings due to the existence of bad faith based on Pasal 4 UU Merek, it is assumed that the idea to create the Gudang Baru and painting brands was inspired by the Gudang Garam brand which was registered in Indonesia. The bad faith of the Gudang Baru mark which intends to piggyback on the fame of the Gudang Garam mark. The fame of the Gudang Garam brand is evidenced by its registration in several

¹⁷ Lompoh Egia Nuansa Pinem and Ni Luh Dwik Suryacahyani Gunadi, "Analisis Penyelesaian Sengketa Terhadap Hak Merek Atas Putusan Gepek Benu Melawan I Am Gepek Benu," *Jurnal Pacta Sunt Servanda* 2, no. 1 (July 1, 2021): 24–35, <https://doi.org/10.23887/jps.v2i1.452>.

¹⁸ Indah Sari, "KEUNGGULAN ARBITRASE SEBAGAI FORUM PENYELESAIAN SENGKETA DI LUAR PENGADILAN," *JURNAL ILMIAH HUKUM DIRGANTARA* 9, no. 2 (June 3, 2014), <https://doi.org/10.35968/jh.v9i2.354>.

countries in the world, including Japan, Singapore, Argentina, Malaysia, Brazil, Brunei Darussalam, Chile, South Korea, Paraguay, Saudi Arabia, Europe, the Philippines, Qatar, and Taiwan since 1989. This is based on the provisions of Pasal 6 ayat (1) huruf b UU Merek.

Merek Gudang Garam merupakan kata yang diciptakan oleh penggugat yang juga merupakan nama badan hukum penggugat yaitu PT Gudang Garam Tbk. yang telah beroperasi di Indonesia sejak tahun 1958. Penggugat sangat keberatan jika merek Gudang Garam yang telah identik dengan nama badan hukum penggugat tersebut ditiru dengan itikad tidak baik oleh tergugat dengan sedikit dimodifikasi, sehingga menjadi menjadi merek Gudang Baru beserta lukisannya. Berdasarkan putusan Pengadilan Niaga pada Pengadilan Negeri Surabaya Nomor 04/HKI-MERREK/2013/PN- NIAGA.SBY, tanggal 12 September 2013 sengketa pembatasan merek antara Gudang Garam dengan Gudang Baru dimenangkan oleh penggugat yaitu PT Gudang Garam Tbk sehingga pendaftaran merek milik PT. Gudang Baru dibatalkan.

The Gudang Garam brand is a word coined by the plaintiff which is also the name of the plaintiff's legal entity, PT Gudang Garam Tbk. which has been operating in Indonesia since 1958. The plaintiff strongly objected if the Gudang Garam brand which has been identical to the name of the plaintiff's legal entity was imitated in bad faith by the defendant with a slight modification, so that it became the Gudang Baru brand along with the painting. Based on the decision of the Commercial Court at the Surabaya District Court No. 04/HKI-MERREK/2013/PN- NIAGA.SBY, dated September 12, 2013, the dispute over the brand between Gudang Garam and Gudang Baru was won by the plaintiff, PT Gudang Garam Tbk, so that the registration of the brand owned by PT Gudang Baru was canceled.

PT Gudang Garam filed a judicial review against the decision. After the examination, it was found that there was an error or mistake from the Panel of Judges. So in essence, the Gudang Garam brand is a well-known brand and was registered earlier than the Gudang Baru brand in 1979 while Gudang Baru was registered in 2005. By registering the Gudang Baru mark, the mark plagiarized the Gudang Garam mark thus misleading consumers. Therefore, the Supreme Court decided to revoke the previous decision on April 22, 2014 and cancel the registration of the Gudang Baru brand from the general register of brands at the Directorate General of Brands with all legal consequences.

Although the dispute has been decided before, the dispute between PT Gudang Garam and PT Gudang Baru is not finished. In 2021, PT Gudang Garam again sued PT Gudang Baru as the 1st defendant on the same basis, namely because the Gudang Baru Origin, Gudang Baru and Gedung Baru brands are similar to the Gudang Garam brand and the Ministry of Law and Human Rights cq Directorate General of Intellectual Property as the 2nd defendant. The result of the Surabaya District Court's decision is that it states that the Gudang Baru brand along with paintings, Gedung Baru along with paintings and Gudung Baru Origin along with paintings have similarities in essence and as a whole with the well-known Gudang Garam brand. Therefore, the Court declared the registration of defendant 1's brand void and ordered defendant 2 to remove the registration of defendant 1's brand from the public register of brands with all legal consequences and ordered defendant 2 to refuse all applications for registration of brands based on the words Gudang Baru, Gudang Baru Origin and Gedung Baru filed by defendant 1, companies owned by defendant 1 and its affiliates and heirs as well as those filed

by third parties to defendant 2 which have similarities in essence and as a whole with the well-known Gudang Garam brand.

3. Decision Analysis.

There are similarities between the Gudang Baru Origin, Gudang Baru and Gedung Baru brands with the Gudang Garam brand starting from the shape and composition of letters, color composition, spelling, writing style to the way of placing pictures/paintings. Because the similarity can mislead consumers to the detriment of PT Gudang Garam. Based on Pasal 21 Ayat 1 UU No. 20 Tahun 2016 states: "What is meant by "similarity in essence" is similarity caused by the existence of dominant elements between one brand and another brand so as to create the impression of similarity, both regarding the form, method of placement, method of writing or a combination of elements, as well as the similarity of speech sounds, contained in the brand." Therefore, it can be concluded that PT Gudang Baru has violated the article. Because in the dispute, the plaintiff filed a lawsuit to the Commercial Court, the verdict was decided by canceling the registration of the Gudang Baru brand and refusing to register the Gudang Baru brand in the future which has similarities with Gudang Garam, this is in accordance with Pasal 76 UU No.20 Tahun 2016.

In addition, the dispute can also be reviewed in the aspect of criminal law. Based on pasal 100 Ayat 1 dan 2 UU No.20 Tahun 2016 , it states that: 1) Any person who unlawfully uses a brand that is similar in its entirety to a registered brand owned by another party for similar goods and/or services that are produced and/or traded, shall be punished with a maximum imprisonment of 5 years and/or a maximum fine of Rp2 billion; and 2) Any person who without right uses brands which are substantially similar to registered brands owned by other parties for similar goods and/or services which are produced and/or traded, shall be punished with imprisonment of not more than 4 years and/or a maximum fine of Rp2 billion.

If the goods/products are traded, they can be charged with Article 102 of pasal 102 UU No.20 Tahun 2016 which states that: "Any person who trades goods and/or services and/or products knowing or reasonably suspecting that the goods and/or services and/or products are the result of a criminal offense as referred to in pasal 100 and 101 shall be punished with a maximum imprisonment of 1 year or a maximum fine of Rp200 million." So the plaintiff can continue the dispute with a criminal lawsuit based on this article. Because the plaintiff has been harmed by the defendant's actions, it is necessary to take legal action to have a deterrent effect on the defendant.

The decision of the commercial court in the dispute has provided strong legal protection for PT Gudang Garam. This is because the Supreme Court Decision No. 119 PK/Pdt.Sus-HKI/2017 only ordered the cancellation of the Gudang Baru brand so that it does not rule out the possibility of future brand infringement. The verdict does not cause a deterrent effect for violators, so that legal protection of the brand owner is not guaranteed. Whereas in the decision of the Surabaya District Court Number 4/Pdt.Sus-HKI/Merek/2021/PN Niaga in addition to ordering the cancellation of the Gudang Baru brand, also ordered the DJKI to deny the brand to be registered with the words Gedung Baru, Gudang Baru Origin, and Gudang Baru by anyone who has similarities/similarities with the Gudang Garam brand. With the decision can

anticipate no future violations so as to provide strong legal protection for the owner of the Gudang Garam brand.

D. ENDING

1. Conclusion

Brand is a sign that serves to provide uniqueness to a product/service by a person or legal entity in trading activities with products/services owned by others. With a brand, the products/services offered by business actors can be distinguished in terms of quality, assurance, and originality of a product. Sometimes, an expensive item/service is not caused by expensive production costs or human resources, but is caused by the brand. Ownership of the brand will be recognized after registering the brand to the Directorate General of Intellectual Property. But inevitably, there are violations of the law that harm the brand owner due to plagiarism of well-known brands.

The dispute between PT Gudang Garam and PT Gudang Baru has been tried in Surabaya Commercial Court and successfully secured legal protection to PT Gudang Garam due to the similarity between Gudang Garam and Gudang Baru brands. The verdict is in the form of cancellation of registration of the Gudang Baru brand and refusal to register the Gudang Baru brand in the future which has similarities with Gudang Garam. With this decision, it has ensured legal certainty for PT Gudang Garam and is a legal protection of intellectual property.

2. Suggestion

Efforts to minimize the occurrence of brand disputes, the Directorate General of Intellectual Property should be more careful in accepting the registration of brands in the general register of brands. The existing system in the Directorate General of Intellectual Property should be improved immediately, so that the brands that have been registered in the general register of brands can be accessed easily and quickly and obtained the right information before accepting a brand registration whether it has similarities in essence or in its entirety with other brands that have been registered in advance. Judges in the commercial court who examine brand disputes should be more careful in providing legal considerations. Judges should be able to explore the law and legal events.

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