

ANALYSIS OF SIMILARITIES IN PRINCIPLE AND RESOLUTION BETWEEN MS GLOW AND PS GLOW BRAND DISPUTES

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Abstract

This research discusses similarities in essence as regulated in Article 6 paragraph (1) letter b of Law No. 15 of 2001 concerning Trademarks in its explanation regarding the rejection of applications that have similarities in overall terms and conditions of similar goods and services but are detrimental to well-known brands. In this legal research, normative and secondary research is used, including primary legal materials and secondary legal materials. The technique of collecting legal materials is carried out by the literature and then analysis techniques are used. The results showed that it is already familiar to the public and the resolution of disputes experienced by the MS GLOW and PSGlow brands is reviewed from Law No. 20 of 2016 concerning Marks and Geographical Indications.

Keywords: Similarities; Brands; Disputes.

Abstrak

Penelitian ini membahas persamaan hakikat sebagaimana diatur dalam Pasal 6 ayat (1) huruf b Undang-Undang Nomor 15 Tahun 2001 tentang Merek Dagang dalam penjelasannya mengenai penolakan permohonan yang memiliki kesamaan syarat dan ketentuan secara keseluruhan terhadap barang dan jasa sejenis tetapi merugikan merek terkenal. Dalam penelitian hukum ini digunakan penelitian normatif dan sekunder, antara lain bahan hukum primer dan bahan hukum sekunder. Teknik pengumpulan materi hukum dilakukan oleh literatur kemudian digunakan teknik analisis. Hasil memperlihatkan bahwa sudah tidak asing lagi bagi masyarakat dan penyelesaian sengketa yang dialami oleh merek MS GLOW dan PSGlow ditinjau dari Undang-Undang No. 20 Tahun 2016 tentang Merek dan Indikasi Geografis

Kata Kunci: Kesamaan; Merek; Perselisihan.

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INTRODUCTION

The Social Insurance Employment-Agency, hereinafter abbreviated as BPJS, is a legal entity established to administer social insurance programs. In the Law of the Republic of Indonesia Number 24 of 2011 concerning the Social Security Organizing Agency describes the formation and scope of the BPJS itself, namely BPJS Health and BPJS Employment. BPJS Health organizes health insurance programs while BPJS Employment organizes work accident insurance programs, old age insurance, pension insurance and death insurance, which were later added to the new program, namely the job loss insurance program.

Intellectual Property has a legal protection system known as Intellectual Property Rights or hereinafter abbreviated as IPR. The main object in IPR protection is human work arising from intellectual ability. IPR is divided into two broad groups, namely Industrial Property Rights and Copyright. Industrial Property Rights include Patents, Trademarks, Integrated Circuit Layout Designs, Industrial Designs, Plant Variety Protection, and Trade Secrets. Meanwhile, Copyright includes books, computer programs, pamphlets, layouts of published written works, lectures, and other similar creations. Where Copyright is regulated in Article 12 paragraph (1) of Law Number 19 of 2002 concerning Copyright.¹

IPR itself has a category in the form of intangible objects or immaterial objects., which can be called property, namely every item and every right that can be controlled by ownership rights. In the BW (Civil Code) there is Article 499 which explains about property where property is every item and every right that can be controlled by ownership rights. Regarding this article, Mahadi explained that goods are material objects while rights are immaterial objects. This is further regulated in 503 BW where every property is tangible and intangible.²

IPR is human property that is intangible but deserves legal protection considering how great the contribution of intellectual work is to economic development in the world. This can be seen from simple examples, starting from advances in communication and transportation technology, various clothing models circulating on the market, various types of processed foods and household products with different brands to fulfill daily needs, to the works of artists that can be enjoyed, both written works, music, to the film industry. All of that is protected under one main legal umbrella, namely IPR, which ensures that creators, inventors, designers and breeders are motivated to work for the benefit of economic development safely, comfortably and fairly. The influence of globalization that drives the development of the world economy has had a direct impact on the increasing flow of trade in goods and services. Based on this, brands are one of the important parts of IPR in the development of trade in goods and services. Brands are part of IPR regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter abbreviated as the Trademark and Geographical Indication Law). Brands and Geographical Indications define a brand as a symbol in the form of a picture, name, word, letter, number, color pattern, or a combination of these elements. These elements have unique characteristics and are goods or services.

¹ Iswi Hariyani, *Correct Procedures for Managing Intellectual Property Rights* (Jakarta: Rajawali Pers, 2010).

² OK. Saidin, *Legal Aspects of Intellectual Property Rights* (Jakarta: Rajawali Pers, 2013).

Brands allow consumers to know the identity, origin and provenance of a product, and serve as a differentiator for all brand manufacturers who use the brand as a symbol. Brands are very important in the world of advertising and marketing because people often associate the image, quality or reputation of products and services with certain brands, which makes brands a very valuable commercial asset for consumers.³ If a company uses another company's brand, consumers may feel cheated because they have purchased a low-quality product.⁴

The function of a brand is considered very strategic and also important in trade because it is not only used to differentiate a product from other products, but also functions as one of the company's invaluable assets in the industry, especially for brands that have been given the title of well-known marks. Nowadays, the level of consumer satisfaction is not only determined by the quality of goods or services consumed, but also by the status of a brand because it is considered to indicate the social status of the brand user. The more famous the brand, consumers will indirectly believe that the goods and services owned by the famous brand are proven to be of quality and can be trusted. In addition, users of famous brands will not worry about using the product because they believe that the reputation of the famous brand that has been built with great difficulty must continue to maintain its quality and credibility. Owners of famous brands must protect their brand rights as much as possible because famous brands tend to be vulnerable to being used by other business actors who are considered to be piggybacking on the reputation of famous brands by registering brands that have similarities in principle or in whole with famous brands. The existence of brand imitation is basically based on malice in exploiting the popularity of other brands to harm the brand owner, because the conversion of some consumers will likely reduce sales of similar brand products.⁵

One of the most important aspects of trademark law is the protection of well-known trademarks. Protection of well-known trademarks is contained in Article 21 paragraph (1) letters b and c of the Trademark and Geographical Indications Law. Article 21 paragraph (1) letter b explains that an application must be rejected by the Directorate General of Intellectual Property if the trademark in question has similarities in principle or in its entirety to a well-known trademark owned by another party for similar goods and/or services. Then, Article 21 paragraph (1) letter c also explains that applications must also be rejected for dissimilar goods and/or services as long as they meet certain requirements. The specific requirements referred to in Article 21 paragraph (1) letter c are further contained in Article 19 paragraph (3) letters a and b of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration (hereinafter abbreviated as Permenkumham 67/2016), namely including objections submitted in writing by the owner of the well-known trademark to the application and the well-known trademark must have been registered.⁶

The objection in question must contain reasons and be accompanied by sufficient evidence that the other brand has similarities in principle or in its entirety to goods and/or services that are not of the same type as the well-known brand. Based on the explanation of Article 21 paragraph (1) letter b in the Trademark and Geographical Indications Law, to measure whether a brand is well-known or not which

³ Julius Rizaldi, *Protection of Famous Brand Product Packaging Against Unfair Competition* (Bandung: Alumni, 2009).

⁴ Tim Lindsey et al., *Intellectual Property Rights: An Introduction* (Bandung: Alumni, 2011).

⁵ *Ibid*, p. 151

⁶ Fitrisiah, "Legal Review of Registered Trademark Disputes Due to Similarity to Well-Known Trademarks (Study of Supreme Court Decision Number 281 K/Pdt.Sus-HKI/2020 and Decision Number 197 PK/Pdt.Sus-HKI/2018)."

is the basis for rejection, it is seen from the general knowledge of the community regarding the brand in the relevant business sector. In addition, it is also necessary to pay attention to the reputation of the brand obtained due to intensive and large-scale promotion, investments made by the owner of the well-known brand in several countries in the world and accompanied by evidence of brand registration in several countries. If this is considered insufficient, the Commercial Court can order an independent institution to conduct a survey to determine the conclusion whether a brand is well-known or not. In addition to national laws and regulations regarding brands, Indonesia is also bound by international brand regulations of which Indonesia has become a member, such as the Paris Union Convention held on March 20, 1883, which was specifically held to provide protection for industrial property rights. Apart from the Paris Convention, there are several other international conventions, namely the Madrid Protocol regarding international trademark registration throughout the world, the Trademark Registration Treaty and the Nice Agreement which regulates the grouping of classes of goods

A brand that has similarities in principle or in its entirety with a brand that has been previously registered could occur with a brand that existed first or was even well-known in the community.⁷The cause of this can happen is the existence of a bad faith factor from another party who deliberately registers its brand. This raises a question and problem, namely why the registration effort can escape the selectiveness carried out by the Director General of KHI.⁸

According to the Trademark Law, the application of bad faith in the registration of a trademark can be used as a basis for rejecting a trademark registration, if in the trademark registration there are elements of similarity in principle or in their entirety to a trademark that has been registered earlier and is well-known.⁹In conducting evidence of bad faith is not the obligation of the Director General of Intellectual Property Rights, but it is the obligation of the court judges. The panel of judges has a benchmark to declare the applicant has bad faith through evidence whether it shows that there is an element of similarity in principle or in its entirety.

Bad faith actions violate the provisions in Article 6 paragraph (1) of Law Number 15 of 2001 concerning Trademarks, namely trademark registration, which is a fraudulent act to boost a brand by piggybacking on a brand that is already well-known to the public, where by using the well-known brand, a registered product will become well-known among the public. This action is of course not in accordance with the intellectual ethics regulated by law.¹⁰Where trademark registration can be rejected if it contains basic or overall similarities with another party's trademark that has been registered previously for similar goods and/or services, with a well-known trademark belonging to another party for similar goods and/or services, and also with geographical indications that are already known.

It is also explained in Article 6 paragraph (1) of Law Number 15 of 2001 concerning Trademarks that the indicator that makes similarities in principle is that there are similarities caused by the presence of visible or prominent elements between one trademark and another, where there is an impression of

⁷ Siti Marwiyah, "Legal Protection of Famous Trademarks," *De Jure Jurnal Syariah Dan Hukum* 2, no. 1 (2010), p. 3.

⁸ Mellisa Yanwar, "Elements of Similarity in Principal in Case of Cancellation of Registered Trademark (Case Study of PT. Krakatau Steel Trademark and PT. Perwira Adhitama Sejati Trademark)," *Journal of Chemical Information and Modeling* 53, no. 9 (2016), pp. 1–13.

⁹ RR. Putri Ayu Pramsari, "Application of Good Faith as a Reason for Trademark Cancellation According to Law Number 15 of 2001 Concerning Trademarks (At the Review Level)" (Diponegoro University, 2010).p.1.

¹⁰RR. Putri Ayu Priamsari, *Op. cit.*, p. 125

similarities regarding the placement method, form, combination of elements or writing method, or similarities in the pronunciation contained in the trademarks.

In Law Number 15 of 2001 concerning Trademarks, there is one difficulty that arises from the provisions of this Law due to the lack of clear guidelines for determining the criteria for well-known trademarks, which can be said that the Trademark Law Indonesia does not regulate in detail regarding this famous brand. However, in the provisions of Article 6 paragraph (1) letter b of Law Number 15 of 2001 concerning Brands in its explanation regarding the rejection of applications that have similarities in principle or in whole with famous brands for similar goods and/or services is carried out by considering the general knowledge of the community regarding the brand in the relevant business sector. In addition, attention is also paid to the reputation of the famous brand obtained due to intensive and large-scale promotion, investment in several countries in the world carried out by its owner, and accompanied by proof of registration of the brand in several countries.

METHOD

The research method used is a qualitative research method because the author wants to describe, investigate, explain, find the quality of the brand problems that exist at this time. The specifications of this study use descriptive analysis which aims to provide a picture of a particular community or population, or a picture of symptoms or between two or more symptoms. This study examines secondary data, namely data obtained from library studies including laws and regulations, papers related to the problems studied, official data from government agencies, and data from archives.

The research method used is a qualitative research method because the author wants to describe, investigate, explain, find the quality of the current brand problems. The specifications of this study use descriptive analysis which aims to provide an overview of a particular community or population, or a description of symptoms or between two or more symptoms. This study examines secondary data, namely data obtained from literature studies including laws and regulations, papers related to the problems studied, official data from government agencies, and data from archives. The method used in analyzing and processing the collected data is qualitative analysis. Qualitative analysis emphasizes the deductive method as the main reference, especially using library materials as sources of research data. Data analyzed qualitatively, in this case the relationship between theories obtained from literature studies will be analyzed and studied, then conclusions will be drawn using the deductive method, namely a method that applies general things first, then connected to specific parts, then systematized into data analysis arranged in the form of legal writing.¹¹

RESULT AND DISCUSSION

1. Analysis of the Similarities in the PSGlow and MS Glow Brands

Child grooming is a sexual crime in which a potential abuser manipulates and gains a child's trust for the purpose of sexual exploitation.¹² According to the literature, grooming can be categorized into three forms: self-grooming, grooming the environment and significant others, and grooming the child directly. The process typically involves both psychological and physical manipulation. Perpetrators

¹¹Pelita Harapan Surabaya, "LIMITED COMPANY RESPONSIBILITIES IN LIQUIDATION" *Journal of Notarial Law*, Unpad Faculty of Law, Vol.4 No.2, 2021.

¹² Alisdair A. Gillespie, "Child Protection on the Internet Challenges for Criminal Law," *Child and Family Law Quarterly* 14, no. 4 (June 17, 2002): 411–425.

first establish a relationship with the child, creating a sense of trust and affection. Over time, they gradually violate boundaries, transforming the trust into a means of engaging in sexual or physical interactions.¹³ Perpetrators may also manipulate important individuals in the child's life—such as parents, siblings, other relatives, caregivers, and community members—to facilitate or sustain the abuse.¹⁴ Psychological grooming is particularly damaging, as it conditions the child to remain silent about the abuse through tactics like isolation, instilling a sense of guilt, offering bribes, or issuing threats.¹⁵

In Law No. 15 of 2001 which is further regulated in Article 21 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, it has included the definition of similarity in principle, it is explained that the application must be rejected by the Directorate General of Intellectual Property Rights, if the trademark has similarities in principle or in its entirety with a well-known trademark owned by another party for goods and/or the like. Well-known trademarks that have not been registered in Indonesia will still receive protection because Indonesia has ratified the Paris Convention and the TRIPS Agreement (the World Trade Organization's TRIPS Agreement).

Similarity in principle is a similarity caused by the presence of prominent elements between one brand and another. The prominent elements in both brands can give the impression of similarities in: shape, placement, writing, combination of elements, or similarity of pronunciation. So, an application for registration of a brand that has similarities in principle as mentioned above must be rejected.

Problems then arise related to the unity of view among judges and trademark examiners (and of course for the public in general) regarding the concept of similarity in principle. The concept of similarity in principle is still considered to be less clear and has not provided a detailed understanding of what is actually meant by similarity in principle. The unclear concept. The understanding factor of each trademark examiner who is not all the same in deciding whether to accept or reject also affects the problem of trademark lawsuits which are increasingly being received by the Commercial Court at the District Court.

In order to provide a guide for all brand owners, IPR consultants and brand examiners, the law must clearly detail what is meant by similarity in principle, accompanied by all testing mechanisms so that the public can immediately know clearly which brands are piggybacking on other people's brands and which are not. For brand examiners, this clarity and detail can minimize the passing of trademark registration applications based on bad intentions. The brand filter door is at the Directorate of Trademarks.

Similarities can basically be found in their parameters, namely if there are visual similarities, similarities in types of goods, and similarities in concepts. If there are two brands that are juxtaposed, then the prominent elements in the brands can be observed, whether they give the impression of

¹³ Aisha K Gill and Karen Harrison, "Child Grooming and Sexual Exploitation: Are South Asian Men the UK Media's New Folk Devils?," *International Journal for Crime, Justice and Social Democracy* 4, no. 2 (July 1, 2015): 34–49.

¹⁴ Professor Patrick O'Leary, Emma Koh, and Andrew Dare, *Grooming and Child Sexual Abuse in Institutional Contexts* (Sydney, 2017), accessed October 12, 2024, <https://www.icmec.org/wp-content/uploads/2018/04/Research-Report-Grooming-and-child-sexual-abuse-in-institutional-contexts-Prevention.pdf>.

¹⁵ Samantha Craven, Sarah Brown, and Elizabeth Gilchrist, "Sexual Grooming of Children: Review of Literature and Theoretical Considerations," *Journal of Sexual Aggression* 12, no. 3 (November 2006): 287–299, accessed October 12, 2024, <https://www.tandfonline.com/doi/abs/10.1080/13552600601069414>.

similarities in: shape, placement, writing style, combination of elements, and similarities in pronunciation.

The term similarity is basically when two similar brands are placed side by side. In practice, this often becomes a problem when one brand is considered to be infringing another brand.

Finally, the trademark dispute between MS Glow and the PS Glow and PS Store Glow brands ended at the Surabaya District Court Number 2/Pdt.Sus.Hki/Merek/2022/PN.Niaga Sby, where based on Article 46 of Law Number 3 of 2009 concerning the Supreme Court, because the lawsuit was not continued based on the lapse of the submission of legal remedies to the cassation 14 days since the issuance of the decision on July 12, 2022 at the Surabaya Commercial Court so that it became a decision that has permanent legal force. In this decision, the case between the MS Glow brand and the PS Glow and PStore Glow brands was won by the PS Glow brand, which decision was filed when the lawsuit process was still in progress at the Medan Commercial Court with Decision number 2/Pdt.Sus.Hki/Merek/2022/PN.Niaga, which court was won by MS Glow over the PStore Glow brand, a brand in one company with PS Glow.

According to the provisions of Article 21 paragraph (1) of the Trademark Law, an application for trademark registration will be rejected if a trademark has similarities in principle or in its entirety to another trademark that has been registered first. In the explanation, it is determined that similarities in principle are the existence of a similarity to another trademark. In the Big Indonesian Dictionary, "similarity" means a state of being similar, where the word "similar" itself means almost the same or similar.¹⁶

To see whether a brand has similarities in principle or not, one brand can be compared with another brand side-by-side.¹⁷ In this way, it is more about seeing the whole appearance of a brand. Therefore, the prominent and dominant elements in a brand become very relevant in determining the existence of similarities. In addition, this comparison method is also to see if there is a bad faith motive in registering a brand by looking at deceptively similarity or deceptive similarities.¹⁸ Deceptive similarity means that a brand is made to look exactly the same as the brand it imitates so that people think that the two brands are the same or come from the same company. Bad Faith is an act carried out based on bad intentions. The aspect being compared is the impression that arises based on people's experience or memory related to the existence of the brand with other brands.

If after comparison it turns out that a brand does not have a substantial difference, then the two brands can be said to have similarities, and the registration of the brand can be rejected or the brand can be canceled. Substantial differences mean differences that, although not prominent, can still be traced if traced further. With the existence of these similarities, the registration of the brand indicates bad faith because it can be said that with the existence of similarities both substantially and overall, the brand is piggybacking on the fame of other brands, so that goods with its brand are better known and sell better.

According to the explanation of Article 20 of the Trademark Law, a trademark can also be said to have no distinguishing power if a trademark is too simple such as a single line or a single dot, or too

¹⁶ Sedy Anugrah, "Elements of Similarity in Basic Terms in Trademark Registration According to Law Number 20 of 2016 Concerning Trademarks and Geographical Indications and Its Implementation in Practice in Connection with Violations of Famous Trademarks," *Aktualita (Jurnal Hukum)* 2, no. 1 (2019): 18–37, <https://doi.org/10.29313/aktualita.v2i1.4663>.

¹⁷ Henry Soelistyo, *Badfaith in Trademark Law* (Yogyakarta: PT Maharsa Artha Mulia, 2017).

¹⁸ Henry Soelistyo.

complicated so that the trademark tends to be unclear. A trademark must have distinguishing power when it is to be registered. This distinguishing power can be tested during registration, or when within the period of registered trademark protection through the cancellation procedure in the test of the validity of registered trademark rights or when it is suspected that there is a trademark crime.

Based on the results of the Medan and Surabaya Commercial Court decisions, in which the Medan Commercial Court stated:

“PStore Glow Brand. Registration Number: IDM000943834. Goods/Services Class: 3, 44, has similarities in principle with the MS Glow/for cantik skincare+ Logo brand Registration Number IDM000633038 registered in the name of the Plaintiff, Declaring the trademark registration in the name of the Defendant, namely the Pstore Glow Men brand. Registration Number: IDM000943835. Goods/Services Class: 3, has similarities in principle with the MS Glow For Men brand Registration No. IDM000877377, registered in the name of the Plaintiff.”

And the Surabaya Commercial Court stated:

"Declaring that Defendant I, Defendant II, Defendant III, Defendant IV, Defendant V and Defendant VI are using the MS Glow trademark without rights and unlawfully, which is essentially similar to the PS Glow trademark and the PStore Glow trademark used by the Plaintiff for class 3 goods/services (cosmetics)"

Based on the judge's decision, the author does not agree with the decision which states that the PStore Glow brand is essentially similar to the MS Glow brand, and conversely MS Glow is essentially similar to PStore Glow.

According to the author, the word "Glow" contained in the MS Glow brand and the women's logo on the PS PStore Glow brand is a general word so that anyone can register and use it as a brand as long as there are additional words that are distinguishing elements as regulated in Article 22 of Law No. 20 of 2016 concerning Brands and Geographical Indications which reads:

"For registered trademarks that later become generic names, anyone can submit a trademark application using the generic name in question with the addition of other words as long as there are distinguishing elements."



Figure 1. MS Glow Brand



Figure 2. PStore Glow Brand

Furthermore, if the brands are compared as a whole, they look different in terms of shape, placement, writing style or combination of elements. Except for the Women's logo on MS Glow and PStore Glow which at first glance have similarities but still have differentiating power, where the MS Glow Brand is written MS Glow and the Women's Logo and there is writing for beautiful skincare also MS Glow For Men with the label of written elements,

In addition, the similarity of pronunciation is also different in the MS Glow and PStore Glow brands, where MS is an abbreviation of Maharani sandy with PStore Glow, where PS is an abbreviation of Putra Siregar, which is contained in the Brand. So that overall, these brands can still be easily distinguished by the public and consumers. In the Supreme Court decision Number 380 K / Pdt.Sus-HKI / 2018 between the Vermicelli + Kanji Letters brand and the Shandong Vermicelli FyF + Kanji Letters brand where there are similarities in the word Vermicelli in both brands, however in the Ratio decidendi the Judge stated that the defendant's Shandong Vermicelli FyF + Kanji Letters brand does not have similarities in principle / overall with the Vermicelli FyF + Kanji Letters brand owned by the plaintiff because there are differences in dominant elements, both regarding the form, placement method, writing method or combination of elements and similarities in sound and pronunciation between the two brands. This is in line with the Holistic Approach theory, which states that to determine whether or not there is a brand similarity, it must be viewed as a whole, both in terms of sound, meaning, spelling, and appearance.¹⁹

So based on the comparison of the MS Glow and PS Glow brands, it can be said that they have similarities in principle based on the similarity of sound and similarity of appearance on the products in circulation. Where as previously described by the author based on Article 1 paragraph (1) of the Trademark Law, the dominant elements are 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. So if only one element is fulfilled, where with this element between one brand and another there are similarities, then it can be said that the brand has similarities in principle. In this case, according to the theory of intellectual property rights protection in trademark law, distinctiveness can be tested during the registration phase through the objection procedure, or when during the period of registered trademark protection through the cancellation procedure in the test of the validity of registered trademark rights or when it is suspected that there is a trademark crime. This type of trademark violation is having similarities in principle with the risk of confusion (a likelihood of confusion) due to the existence of one confusing similarity.²⁰

The author also agrees with the judge's ratio decidendi regarding the bad faith of the owner of PS Glow and PStore Glow in the Medan Commercial Court decision where the owner of PS Glow is a close friend of the owner of MS Glow and once asked about the process of having a business in beauty products as stated in the Posita according to MS Glow's statement as the Plaintiff. Based on this, the author is of the opinion that the use of the word "Glow" in the PS Glow and PStore Glow brands aims to "piggyback" on the reputation of the MS Glow brand which has been circulating first and is known to the public or consumers, so that there is an element of bad faith to piggyback on the fame of someone else's brand. The similarity of the word glow also causes actual confusion or misleads the public or consumers as if the brand comes from the same source or production. This is in line with the Supreme

¹⁹ Eko Yuliyanto, "Executorial Decision of Registered Brand Cancellation," *Indonesia Private Law Review* 1, no. 1 (2020): 11–22, <https://doi.org/10.25041/iplr.v1i1.2044>.

²⁰ MH Prof. Dr. Rahmi Jened, sh, *Trademark Law* (Jakarta: Kencana, 2014).

Court Decision Number 382 K/Pdt.Sus/2012 between the SOPHIE MARTIN brand and the SOPHIE brand, where the Judge's Ratio decidendi stated that the defendant had bad intentions because he was inspired to create the SOPHIE brand name to piggyback on the fame of the plaintiff's SOPHIE MARTIN brand, so that the similarity of the word SOPHIE in the two brands causes confusion or misleads buyers/consumers as if the defendant's brand is the same as the plaintiff's brand. With the Supreme Court Decision Number 606.k/pdt.sus-HKI/2018, it has a very important impact on parties who will create and register their brands to first look at brands that have been registered first so that there are no similarities in principle, either in part or in whole when registering their brands and to avoid bad intentions because they want to piggyback on brands that are already known to the public/consumers and have been registered first at the Directorate General of Intellectual Property Rights.²¹

According to the holistic approach theory, to determine whether or not there is a similarity of a brand, it must be viewed as a whole, both from the sound, meaning, spelling, or appearance. While according to the dominance theory, only the most dominant element. Courts in other countries such as the United States, determine the existence of a similarity in principle in a brand based on sound, appearance, and meaning. While in Japan, determining the existence of similarities in the main elements is based on three criteria, namely sight or appearance, pronunciation and understanding. So based on the dominance theory and comparison with the indicators used in the Court in the United States, PS Glow can be declared to have similarities in principle.²²

In addition, with the Decision, registered trademark owners must always protect their trademarks by paying attention to any bad intentions from other trademark owners. If there are other trademarks that are essentially similar and have been registered and announced in the General Trademark News, then the trademark owner who feels aggrieved can file an objection and cancel the trademark. This is based on Article 76 paragraph 1 of the Trademark Law, namely that a lawsuit for cancellation of a registered trademark can be filed by an interested party based on the reasons referred to in Article 20 and/or Article 21.

2. *Settlement of PS Glow and MS Glow Trademark Disputes Based on Law No. 30 of 1999 concerning Arbitration and Alternative Dispute Resolution*

Once more, a trademark is a brand used by individuals or legal entities to distinguish goods traded together from other similar goods. The regulation of the brand itself is regulated in the Trademark Law, Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

So one brand needs to be differentiated from another brand, because it is a distinguishing mark in the field of trade and services.²³The differences themselves can be explained as follows:

²¹ By Esti Aryani, "Trademark Rights Violations and Their Settlement Mechanisms in Indonesia," Legal Discourse 10, no. 1 (nd): 117–32, <http://ejurnal.unisri.ac.id/index.php/Wacana/article/view/269%0Ahttp://garuda.ristekdikti.go.id/journal/article/14773>.

²² Fransisca Glovany, Legal Analysis of Compensation for Infringement of Trademarks of Non Synonymous Goods in Indonesia, *Jurnal Bimbingan dan Konseling Keluarga*, Vol.6(2) 2024, p. 2131

²³ Rosyidah, Trademark Dispute Resolution According to Law No. 30 of 1999 Concerning Arbitration and Alternative Dispute Resolution, *Novum Jurnal Hukum*, Vol. 1 (2) 2014, p. 55

a. Brand reputation

Brand reputation is closely related to public opinion regarding the good or bad reputation of the brand. Brand improvement can certainly be supported by advertising and publicity, but also on the quality and performance of its products. A good brand reputation builds customer trust if the brand is able to meet customer expectations.

b. Brand predictability

Brand predictability is to predict the character of other groups. A predictable brand is a brand where consumers can predict how the brand will behave each time the brand is used. Predictability is a cause in product quality. Consumer trust can increase the Predictability of a brand. Increase trust in the brand because it is likely to create positive expectations.

c. Brand power

A brand's reputation is related to other people's opinions that the brand is good and trustworthy. Brand reputation does not only depend on advertising and publicity, but also on the quality and performance of its products. A good brand reputation builds customer trust if the brand is able to meet customer expectations.

The trademark system is intended to anticipate any trademark disputes in the future, between trademark owners with each other. So there is one intellectual dispute that will arise if there is a struggle between Intellectual Property Rights owners, Trademark disputes can occur, if there are similarities with other brands in various types of businesses. Products can not be distinguished from other products.²⁴

Trademark disputes are common, therefore there are methods to resolve them, namely through the court or out of court, Articles 76-84 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, trademark disputes are generally resolved in 2 ways: litigation and non-litigation. Both Article 84 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, Article 84 states that trademark disputes can be resolved non-judicially, therefore the path that can be taken is arbitration, an alternative mechanism, one of the alternative mechanisms for resolving disputes.

The settlement of the trademark is a trademark case, as happened in PT PSGLOW KOSMETIK INDONESIA with PT KOSMETIKA CANTIK INDONESIA is a case caused by trademark infringement of PT. KOSMETIKA CANTIK INDONESIA using the MS GLOW brand, this is similar to PS GLOW. This makes PS GLOW file a litigation lawsuit through the commercial court.

This time the author will discuss the settlement of disputes outside the court by an arbitration body. Arbitration has been explained in the Arbitration Act and Articles 27 to 58 of the APS. Article 6 clearly does not regulate the flow of procedures for each method included in the alternative dispute resolution. Article 5 Paragraph (1) of the Arbitration Law and the provisions of the APS limit dispute resolution through arbitration to commercial disputes and disputes over law and rights under the full control of the disputing parties.

Article 4 Paragraph (2) of the Arbitration and APS Law states that in resolving trademark disputes, the parties to the arbitration must fulfill essential requirements, such as in the case study above which stipulates that if a dispute is to be resolved through arbitration, the parties to the dispute must include an arbitration clause in the contract agreed to by both parties.

In the Arbitration process that has been taken by both parties, both PS GLOW and MS GLOW, it was obtained information that in the examination of documents and witnesses, and directed to the

²⁴Ibid.

mediation process, a solution could not be obtained, so that the Mahleis arbitration issued an arbitration decision and the arbitration decision was registered at the district court where the defendant is domiciled in accordance with Article 59 of Law No. 30 of 1999. This is indicated if the PS GLOW and MS GLOW peace process is unsuccessful, it will be forced to continue to the arbitrator or arbitration panel to consider the main points of the dispute in accordance with Article 46 Paragraph (1). In this case, the steps for examining evidence and witnesses must first examine new evidence before continuing to the examination of witnesses. Therefore, the arbitrator will consider both evidence and witnesses will provide a decision to PSGLOW and MSGLOW submitting evidence and only trying witnesses and experts. So the Arbitrator must be very careful in examining witnesses and evidence so that in issuing a decision he can obtain a fair conclusion. The deadline for the announcement of the decision by the arbitrator is 30 days after the completion of the examination in accordance with Article 57 of the Arbitration Law.

Furthermore, regarding the decision of Article 60 of Law No. 30 of 1999, the decision issued by the arbitrator is final, with permanent legal force and is binding on the parties. The arbitration panel can also make a temporary decision if necessary. The arbitration panel can also make a temporary decision if necessary. The arbitration panel also has the right to make a decision again regarding valuables, orders to deposit goods with third parties, or the sale of goods for a short period of time within a specified time, in accordance with Article 19 Paragraph (5) of the BANI Regulations and Rules of Procedure.

CONCLUSION

The meaning of similarity is basically in a brand name, namely the existence of similarities/similarities of prominent elements that are characteristic of the brand in the form of images, logos, names, words, letters, numbers, color arrangements, in 2 (two) dimensions and/or 3 (three) dimensions, sound, holograms or a combination of these elements, both for similar or dissimilar goods or services which are based on the reputation of the brand which is obtained either through large-scale promotion or because the brand has been registered and circulated beforehand, and the general knowledge of the public about the brand. Based on the judge's decision, the author does not agree with the decision which states that the PStore Glow brand has similarities in principle with the MS Glow brand, and vice versa MS Glow has similarities in principle with PStore Glow in accordance with Article 22 of Law No. 20 of 2016. However, on the other hand, the author agrees with some of the ratio decidendi where there are similarities in principle between the MS Glow and PS Glow brands in the Surabaya Commercial Court decision in terms of the sound of the words and elements of the products in circulation using gray packaging and related to the bad faith of the owners of PS Glow and PStore Glow at the Medan Commercial Court.

Settlement of disputes outside the court or through arbitration. This is in accordance with Article 84 which discusses the settlement of trademark disputes through the Arbitration Institution. To go through this non-litigation process, the most important thing is that both parties must agree to go through this arbitration process, so that Article 59 of Law Number 30 of 1999 concludes that there will be an examination and witnesses after mediation efforts fail. The arbitration panel is then required to issue an arbitration decision and the arbitration decision is registered with the local District Court where the defendant is domiciled. The arbitration decision is final and legally permanent and binds the parties (Article 30, Article 60 of Law 1999).

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