

# Legal Analysis of the Use of Trademarks that have Similarities at Their Core or Entirely (A Study of Decision Number 55/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst)

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**Abstract.** The legal consequences of the use of trademarks that have similarities at their core in Decision Number 55/Pdt.Sus-HKI/Trademark/2022/PN Niaga Jkt.Pst, as viewed through Law No. 20 of 2016 concerning Trademarks and Geographical Indications, were the subject of this study. The research conducted by the author was of a normative legal nature, using a literature review to explain the research findings with relevant literature. The approach used by the author was a legislative approach, particularly focusing on Law Number 20 of 2016 concerning Trademarks. The conclusion of this research is that the legal consequences of using trademarks that have similarities at their core, in this case, align with the plaintiff's claim, stating that the legitimate owner and user of the trademark in question is PT. Supra Usadhatama, and the registration of the trademark "PROVIT-C" under the name of PT. Mahakam Beta Farma should be rejected because it bears similarities at its core to the trademark "PRO-FIT."

**Keywords:** Trademark Similarities, Intellectual Property Rights, Legal Consequences

## 1 Introduction

The use of trademarks in the business world is crucial in protecting intellectual property rights and preventing unhealthy competition.[1] However, trademark conflicts often arise when a proposed trademark bears similarities in essence or entirely to an existing trademark. This issue raises legal questions that require in-depth analysis.[2]

One of the disputes regarding the similarity of the core of a trademark for two types of products and the same class was handled by the Supreme Court and decided in Supreme Court Decision Number 55/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst. In this decision, a dispute between PT Mahakam Beta Farma and the Trademark Appeal Commission was resolved. In this case, the plaintiff applied for the PROVIT-C trademark to protect dietary supplements and human dietary supplements in class 5 with the Directorate of Trademarks and Geographical Indications at the Ministry of Law and Human Rights. However, the application was rejected because the trademark was considered to have a fundamental similarity with the PRO-FIT trademark owned by another

party that had been registered earlier for medically adapted dietary or dietetic foods, also in class 5. The Trademark Appeal Commission then rejected the plaintiff's appeal on the grounds that the types of goods protected by both trademarks could be considered similar because they shared similarities in origin, nature, purpose, manufacturing method, and use. Therefore, based on the provisions of the Trademark and Geographical Indications Law, both trademarks were considered to have fundamental similarity because they contained dominant elements that created the impression of similarity in their form, placement, writing, or combinations of elements in the trademarks.

Intellectual property (IP) encompasses any original product of human intellect, spanning artistic, literary, technical, or scientific creations. Intellectual property rights (IPR) denote the legal protections granted to inventors or creators, safeguarding their innovations or creations for a specific duration. These legal rights bestow an exclusive privilege upon the inventor/creator or their assignee to fully exploit their invention or creation during this designated timeframe. It is widely acknowledged that IP plays a crucial role in the contemporary economy. Additionally, there is a well-established consensus that the intellectual efforts linked to innovation should be duly acknowledged, ensuring that the public benefits from it. [3] Intellectual Property Rights (IPR) serve as a powerful instrument for safeguarding the resources, including investments, time, finances, and effort, dedicated by the inventor or creator of intellectual property. This is achieved by granting the inventor or creator an exclusive privilege to utilize their invention or creation for a specified duration.

There have been notable expansions in the realm of intellectual property over time. While initially, only patents, trademarks, and industrial designs fell under the category of 'Industrial Property,' the scope of 'Intellectual Property' has broadened considerably. Intellectual Property Rights (IPR) play a significant role in advancing technology for several reasons: [4]

1. They offer a mechanism to address issues related to infringement, piracy, and unauthorized use.
2. They contribute to a wealth of knowledge accessible to the general public since all forms of intellectual property are made public, with the exception of trade secrets.

Protection of intellectual property can encompass a diverse range of creative endeavors, including: [5]

1. Patents
2. Industrial designs, which pertain to the characteristics of shapes, configurations, surface patterns, or combinations of lines and colors applied to an object, whether it's 2-D (e.g., textile) or 3-D (e.g., toothbrush)
3. Trademarks, which relate to any symbol, name, or logo used in the conduct of trade for a product or service and serve to identify the manufacturer or service provider. Trademarks can be bought, sold, and licensed and are intrinsically linked to the reputation and goodwill of the associated product or service

4. Copyright, which encompasses the expression of ideas in tangible form and includes literary, musical, dramatic, artistic, cinematographic works, audio recordings, and computer software
5. Geographical indications, referring to marks that identify products originating in a specific country, region, or locality within that region where the product's quality, reputation, or other characteristics are primarily linked to its geographical origin

The pharmaceutical sector is undergoing a dynamic transformation in its intellectual property (IP) strategy. With a rising likelihood of certain IP rights being deemed invalid, antitrust regulations must play a crucial role in preventing the unjust exploitation of these rights to create and sustain illegitimate, albeit restricted, monopolies within the pharmaceutical industry. Many challenges still await resolution in this complex landscape.

## **2 Method**

The research method employed is a normative or doctrinal approach with an emphasis on library research, which is divided into primary data (including judicial decisions and court records) and secondary data (referring to legal sources and literature).[6] Literature review serves as the primary technique for data collection, and a conceptual approach is used to analyze existing issues by integrating legal science and legal theory perspectives, making legal views and doctrines the foundation for a comprehensive understanding of the researched issues.[7]

## **3 Result and Discussion**

In Indonesia, trademark rights are acquired through a process of registration, which is often referred to as a constitutive or "first to file" system. According to this legal principle, it is assumed that the first person who submits a registration application in good faith is the legitimate owner of the trademark, unless evidence proves otherwise. The objective of this regulation is to simplify the previous rule, which restricted one trademark registration to a single category of goods or services. The aim is to make it easier for trademark owners to use their marks for various goods or services across multiple categories without the need for separate administrative procedures for each category. However, it's important to note that the registration fees are still determined by the number of categories of goods or services for which the registration is sought. [8]

Epistemologically, the legal reasoning used to address a problem consists of five stages:[9]

1. Identifying the potential sources of law, typically statutes and court decisions (identify the applicable sources of law).
2. Analyzing these sources of law to determine the possible legal rules and policies within them (analyze the sources of law).

3. Synthesizing these legal rules into a coherent structure, grouping specific rules under general principles (synthesize the applicable rules of law into a coherent structure).
4. Examining the available facts (research the available facts).
5. Applying this structure of rules to the facts to ascertain the rights or obligations that arise from those facts in accordance with the legal rules, especially when dealing with complex cases (apply the structure of rules to the facts).

In this case, the steps taken by the Central Jakarta Commercial Court were as follows: In the first stage, which involves identifying the potential sources of law, the court referred to Law Number 20 of 2016 concerning Trademarks and Geographical Indications. For the second stage, the court did not use any other sources or legal rules because there was only one regulation in use. The third stage was not performed because there were not many rules that needed to be grouped. In the fourth stage, an examination was conducted on the facts presented in the court proceedings by both the plaintiff and the defendant. In the fifth stage, in the final decision of the legal reasoning process, the court determined the rights and obligations of the parties involved in the dispute.

The court's analysis of the judgment reveals that the court decided that the trademark PROVIT-C has fundamental similarities with the trademark PRO-FIT. These similarities are assessed in terms of visual aspects, writing style, pronunciation, appearance, and the types of goods protected by the trademarks. The court believes that these similarities can potentially confuse consumers, especially since the trademarks are used for similar goods falling under class 5.

In the context of fundamental or complete trademark similarities, the court refers to the legal provisions, namely Article 21 paragraph (1) letter a of Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Fundamental similarity refers to resemblance caused by dominant elements between one trademark and another, which can create an impression of similarity in terms of form, placement, writing style, or pronunciation in these trademarks.

In this case, the court also considered the Supreme Court's jurisprudence, which recognizes trademark similarities if there is resemblance in form, composition, combination, element components, sound, pronunciation, or appearance. Based on this, the court concluded that the PROVIT-C trademark has fundamental similarities with the PRO-FIT trademark.

Cases of disputes like this one apply ethical theory. This is because the regulations used for trademark disputes like this are nearly the same. This ethical theory ensures genuine fairness for every trademark owner who feels aggrieved by trademark infringement. [10] If ethical theory is not applied in every similar case or violations involving similar goods, it can create legal disparities in the courts. This is due to the absence of legal consistency in deciding the same disputes.

## **4 Conclusion**

The case with Judgment Number 55/Pdt.Sus-HKI/Merek/2022/PN Niaga Jkt.Pst illustrates the importance of enforcing the law regarding the use of trademarks that have fundamental or complete

similarities. The court's decision emphasizes that trademark similarities should be assessed from various perspectives, including visual, written, auditory, and the types of protected goods. The judge consistently supports the legal protection of trademarks that were registered first and have fundamental similarities with later-registered trademarks. They believe that these similarities can be both in the content of the trademark and in how it sounds when spoken. This means that if a later trademark is very similar to an earlier one, it should not be allowed, and any products using that trademark should be taken off the market by a court order. This case underscores the significance of avoiding attempts to imitate, copy, or follow the trademarks of others in order to maintain fair business competition and protect the rights of trademark owners who were registered first. In conclusion, enforcing the law on trademarks with fundamental or complete similarities is a crucial step in preserving brand integrity and safeguarding consumers from confusion.

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