

Trademark Dispute: Case Study of Supreme Court Decision No 161K/PDT.SUS.HKI/2023

Ahmad Janu Kurniawan ¹, Zainal Asikin ¹, Abdul Atsar ¹

¹ *University of Mataram*

Jl. Majapahit No 62 Mataram, Nusa Tenggara Barat, Indonesia

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Corresponding Author:

Ahmad Janu Kurniawan

janukurnia999@gmail.com

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Abstract. The advancement of science has resulted in human intellectual capabilities to create various works, whether in the form of technological innovations, art, or literature. The dispute between the trademarks MS GLOW and PS GLOW did not conclude in commercial court. Instead, it reached the cassation level with decision No 161k/Pdt.Sus.HKI/2023. This research aims to explain the substance of cassation decision No 161k/Pdt.Sus.HKI/2023 and analyze the considerations made by the cassation judges in that verdict. The study used a normative legal research method utilized legislative, conceptual, and case approaches. The legal materials encompass primary, secondary, and tertiary legal sources. The analysis technique involved prescriptive analysis, which was then interconnected in such a way as to create coherent and systematic writing. Subsequently, the legal materials were classified and interconnected deductively, allowing for conclusions to be drawn from the core issues formulated. The results of this study explain that the cassation judges, in deciding this case, have disregarded the principles of justice and legal certainty. Additionally, the researcher found errors by the cassation judges in providing legal considerations in this decision.

Keywords: trademark dispute; cassation decision; Legal Certainty.

INTRODUCTION

The advancement of knowledge has resulted in human intellectual capabilities to create various works, whether in the form of technological innovations, art, or literature. Works generated from this intellectual capacity require considerable effort, including sacrificing time, energy, thought, and creativity. This is because these works are expected to have economic value. Works resulting from human intelligence that can have monetary value for human life must be protected by law. The goal is to achieve justice, certainty, and utility, especially within the legal protection system for intellectual property in Indonesia.

Intellectual Property (HKI) is an exclusive right granted by a country to an individual or legal entity for their creations. One component of HKI is the right to a trademark. To safeguard trademark rights, Indonesia has established regulations through Law No 20 of 2016 concerning Trademarks and Geographical

Indications, now referred to as the Trademark and Geographical Indication Law (UU MIG). In Article 1 § 1 of UU MIG, a trademark is defined as a sign in the form of a picture, name, word, letter, number, colour arrangement, or a combination of these elements that has a distinctive character and is used in the trade of goods or services. A trademark is considered vital when the public recognizes it and has a high brand association with a product, positive market perception, and consumer loyalty to the brand. Given the crucial role of trademarks in the present day, particularly in maintaining healthy business competition, the protection of trademarks is of utmost importance.

The Trademark and Geographical Indication Law adheres to a constitutive registration system. Under this principle, the party registering their trademark is automatically considered the legitimate owner. Consequently, there is no longer a possibility of two trademarks having fundamental similarities. An example of a recent

trademark dispute is the conflict between MS GLOW and PS GLOW.

The owner of MS GLOW, Shandy Purnamasari, filed a complaint against PS GLOW in the Medan commercial court. In its verdict, the Medan commercial court ruled that Shandy Purnamasari is the sole owner, registrant, and user of the trademark "MS GLOW/for kecantikan skincare+LOGO" with No.IDM000633038. Goods/Services Class (NCL9): 3, and the trademark "MS GLOW FOR MEN" with Registration No. IDM000877377. Goods/Services Class (NCL11): 3. Shandy Purnamasari has the goods specified in the trademark certificate and has been granted exclusive rights to use the trademark in Indonesia.

Not willing to be outdone in the Medan Commercial Court, Putra Siregar escalated the situation by filing a trademark dispute lawsuit in the Surabaya Commercial Court. In its verdict, the Surabaya Commercial Court ruled that the Plaintiff (Penggugat) has exclusive rights to use the trademarks "PS GLOW" and "PSTORE GLOW" registered with the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia, for various goods and services. According to the panel of judges in the Surabaya Commercial Court, the use of the trademark "MS GLOW," which bears many similarities to the trademarks "PS GLOW" and "PSTORE GLOW" used by the defendant 1 to VI for the same category, is deemed invalid and unlawful.

The dispute from this case did not conclude at the commercial court level. The MS GLOW party pursued a cassation appeal to the Supreme Court. Based on cassation decision No 161K/Pdt.Sus-HKI/2023, dated January 30, 2023, the victory favoured the MS GLOW trademark. In the cassation, MS GLOW, the petitioner successfully refuted all arguments and statements presented by Putra Siregar, specifically related to the MS GLOW trademark.

METHOD

Based on the background above, the author was highly interested in discussing and analyzing the considerations of the Supreme Court panel of judges in deciding this case. This research adopts a normative legal methodology, employing legislative, conceptual, and case approaches. The data collection technique involved a literature

review, and the legal material was analyzed using a prescriptive analysis technique. Subsequently, the analysis was interconnected to create coherent and systematic writing.

RESULTS AND DISCUSSION

The substance of the Cassation Decision 161K/PDT.SUS-HKI/2023. The substance of a decision comprises the content of a ruling, encompassing various elements. In the cassation decision, the No 161K/PDT.SUS-HKI/2023, the substance of the decision is as follows:

Identity of the Parties Involved in the Case. Court decisions in a trial must include the identities of the legal subjects or parties involved in the case, covering both the plaintiff and the defendant or the petitioner and respondent in the cassation court. These identities should be detailed, including names, addresses, and the names of their legal representatives if appointed. In this dispute, the parties involved are:

1. PT Kosmetik Global Indonesia, represented by its director Titin Indah Wahyu Agustin, is located at Jalan Rungkud Industri III, No 9, Kutisari, Tenggilis Mejoyo District, Surabaya, East Java.
2. PT Kosmetik Cantik Indonesia, represented by its director Sheila Marthalla, is located at Jalan Komud Abdurrahman Saleh, Asrikaton Village, Pakis District, Malang Regency, East Java.
3. Gilang Widya is residing at Greenwood Golf Indah Street No 5 RT.7 RW. 10, Tirtomoyo Village, Pakis District, Malang Regency, East Java.
4. Shandy Purnamasari is residing at Jalan Greenwood Golf Indah No 5 RT.7 RW. 10, Tirtomoyo Village, Pakis District, Malang Regency, East Java.
5. Titis Indah Wahyu Agustin, as the Director of PT. Kosmetika Global Indonesia, located at Jalan Rungkud Industri III, No 9, Kutisari, Tenggilis Mejoyo District, Surabaya, East Java.
6. Sheila Marthalia, as the Director of PT. Kosmetika Cantik Indonesia, located at Jalan Komud Abdurrahman Saleh, Asrikaton Village, Pakis District, Malang Regency, East Java.

They all acted as the petitioners of cassation who were previously the defendants in the Surabaya Commercial Court. Each has granted power of attorney to Arman Hanis, SH, and colleagues, Advocates, and Legal Interns at the law firm Hanis & Hanis, located at Lippo Thamrin, 3rd

floor, MH Thamrin Street, Kavling 20, Jakarta, based on an extraordinary power of attorney dated July 18, 2022. Additionally, there is Faisal Miza, SH., MH and colleagues, lawyers at the law firm Faizal Miza & Associates, located in Menara Rajawali, 11th floor, Dr. Ide Anak Agung Gde Agung Street, Lot. 5.1, Mega Kuningan area, Jakarta, based on an extraordinary power of attorney dated September 22, 2022.

Meanwhile, PS Store Dlow Bersinar Indonesia, represented by its director, Samputri Agelina, with domicile at Almina Square R2, Condet Raya Street, RT. 5 RW. 3, Balekambang Village, Kramat Jati District, East Jakarta, acting as the respondent in cassation, who previously worked as the plaintiff in the first-level court, has granted power of attorney to Edy Hartono, SH & Waradot Law Firm, located at Gajah Mada Street, Tiban Center complex, Block C, No 4, Sekupang District, Batam City, Riau Islands, with an extraordinary power of attorney dated July 14, 2022.

Legal Considerations. Making a judgment is the duty of a judge as a legal enforcer, where the judgment is demanded by a sense of justice within society. Legal considerations need to be considered in a judge's decision so that anyone can assess whether the verdict is sufficiently grounded in objective reasons or not.

Legal considerations form the basis of a judge's decision. A judgment includes considerations regarding the factual circumstances of the case and concerns regarding the applicable law.

1. The plaintiff's lawsuit needs to be clarified and more specific. The plaintiff claims to be the owner of MS GLOW and files a lawsuit for infringement against the defendants. However, the plaintiff needs to elaborate on the plaintiff's rights as the trademark owner. For example, the plaintiff does not specify when the trademark registration was filed, the date of acceptance, or the registration number of the plaintiff's trademark. As a result, the plaintiff's legal standing in this lawsuit needs to be clarified.

2. The plaintiff filed a lawsuit for infringement against the defendants on April 12 with case No 2/Pdt.Sus.HKI/Merek/2022/PN Sby, which was decided on July 12, 2022, related to a case of trademark cancellation lawsuit.

3. In the previous case, decision No 2/Pdt.Sus.HKI/Merek/2022/PN Mdn essentially ruled that the defendant owns the MS GLOW trademark. This case is still subject to

legal remedies, indicating it does not yet have final legal force.

4. The cassation request from the first petitioner is granted, and the lawsuit is declared inadmissible. Therefore, the cassation request from the second petitioner in cassation must be rejected.

5. Since the cassation request from the first petitioner in cassation is granted, and the cassation request from the second petitioner in cassation is rejected, the respondent in cassation must be ordered to pay the litigation costs at all levels of the judiciary.

Verdict. The court's verdict typically states whether a lawsuit filed by the plaintiff is granted or denied, either in whole or in part, by the petitem based on the applicable legal considerations.

Just like in the cassation decision of the Supreme Court No 161K/Pdt.Sus-HKI/2023, the verdict is as follows:

1. Granting the cassation requests from the cassation applicants, in this case, PT. Kosmetik Global Indonesia, PT. Kosmetik Cantik Indonesia, Filang Widya Pramana, Shandy Purnamasari, Titis Indah Wahyu Agustin, and Sheila Marthalia.

2. Cancelling the verdict of the Surabaya Commercial Court with case No 2/Pdt.Sus.HKI/Merek/2022/PN Sby.

3. Sentencing the cassation respondent to pay the litigation costs at the cassation level amounting to IDR 5,000,000.00.

Analysis of Legal Considerations. The researcher disagrees with the legal considerations of the Supreme Court in cassation decision No 161K/Pdt.Sus-HKI/2023. The researcher states that the plaintiff's lawsuit is unclear and vague because the plaintiff claims to be the owner of "MS GLOW" without specifying and elaborating on the reasons for the plaintiff's rights as the trademark owner. However, in the Surabaya Commercial Court's verdict, the "PS GLOW" party never claimed that "MS GLOW" belonged to the plaintiff.

The plaintiff only argues that the "MS GLOW" trademark is fundamentally similar to the "PS GLOW" trademark. The "MS GLOW" trademark is registered as "MS GLOW/For beautiful skincare." However, in promotional activities on the marketplace, only the term "MS GLOW" is used, creating an element of similarity or resemblance

to the "PS GLOW" trademark. In the Supreme Court's decision, the researcher disagrees with the judge's consideration, stating that the plaintiff filed a lawsuit in the cancellation of the "PSTORE GLOW" and "PSTORE GLOW MEN" trademarks in the Medan Commercial Court that has not yet become final and binding.

However, the decision of the Medan Commercial Court did not discuss the "PS GLOW" trademark at all. Instead, it focused on the "PSTORE GLOW" and "Pstore Glow Men" trademarks, all of which have different classifications. As known, both decisions before the cassation decision No 160K/Pdt.Sus-HKI/2023, namely the Medan Commercial Court Class IA Special Decision with decision No 2/Pdt.Sus.HKI/Merek/2022/PN Mdn dated June 13, 2022, and the cassation decision No 160K/Pdt.Sus-HKI/2023 were decided in the deliberation meeting of the Judges' Assembly on Monday, January 30, 2023, by Dr H. Hamdi, S.H., M.Hum., a Supreme Court judge appointed by the Chief Justice of the Supreme Court as the Chairperson of the Assembly, Dr. H. Panji Widagdo, S.H., MH, and Dr Rahmi Mulyati, S.H., as the member judges.

The matter at the Surabaya Commercial Court Class IA specifically is Case No 2/Pdt.Sus-HKI/Merek/2022/PN Sby was ruled on July 12, 2022, in conjunction with the cassation decision No 161K/Pdt.Sus-HKI/2023 made during the deliberation meeting of the Judges' Assembly on Monday, January 30, 2023, by Dr H. Hamdi, S.H., M.Hum, Supreme Court Judge appointed by the Chief Justice of the Supreme Court as the Chairman of the Assembly, with members Dr. H. Panji Widagdo, S.H., M.H., and Dr. Rahmi Mulyati, S.H., MH.

We can see that the same cassation panel made both decisions on the judges' deliberation meeting date. However, in decision No 161K/Pdt.Sus-HKI/2023, the Cassation Panel stated that case No 2/Pdt.Sus.HKI/Merek/2022/PN Mdn is still subject to legal remedies, indicating that it has yet to obtain legal force (*inkracht van gewisjde*). Meanwhile, the cassation decision for this case was made by the same cassation panel on the same day. Upon closer inspection, it was noted that the cassation case No 2/Pdt.Sus.HKI/Merek/2022/PN Mdn is 160K/Pdt earlier.Sus-HKI/2023, compared to case No 2/Pdt.Sus-HKI/Merek/2022/PN Sby is 161K/Pdt.Sus-HKI/2023. According to the

researcher, the cassation judges should not consider those considerations because of the decision in Case No 2/Pdt.Sus.HKI/Merek/2022/PN Mdn, along with the cassation decision No 160K/Pdt.Sus-HKI/2023, and the decision in Case No 2/Pdt.Sus-HKI/Merek/2022/PN.Sby, along with the cassation decision No 161K/Pdt.Sus-HKI/2023 were all made at the same time. Thus, they have obtained final legal force and are binding on the parties involved. Unless the party whose cassation request was rejected initiates a judicial review, the cassation judges are right to include those considerations in their decisions. However, the researcher has yet to find evidence that the party whose cassation request was denied has pursued a judicial review.

Furthermore, there are legal considerations in the Surabaya Commercial Court's decision, wherein one of the considerations states that the registration of the MS GLOW trademark with registration No IDM000731102 under the name of CV. KOSMETIKA CANTIK is for class 32, namely for powdered tea drinks, which are not suitable for use as a trademark for cosmetic products and thus cannot be protected by law. The use of MS GLOW differs from the actual trademark on the trademark certificate IDM000633038, namely "MS GLOW / FOR CANTIK SKINCARE," which is unjustified and, therefore, is not protected as it should be. In the example provided, if "BANANA FOR APE" in class 25 is not allowed to use a portion of the registered trademark, such as the word "BANANA" alone, it would be regrettable because it would not be protected and could confuse consumers, as the protected registered trademark is "BANANA FOR APE." However, in its cassation decision, the Supreme Court did not consider this aspect in delivering its judgment, even though the public needs certainty. In this case, the judge has set aside the principles of justice and legal certainty. Justice and legal certainty are interconnected and not contradictory. If a judge has established justice through a decision, it is equivalent to creating legal certainty.

The decisions of the Medan Commercial Court and the Surabaya District Court involve different cases. The Medan Commercial Court deals with trademark cancellation lawsuits, where the plaintiff is Shandy Purnamasari and the defendant is Putra Siregar. Meanwhile, the Surabaya District Court handles a trademark

infringement lawsuit with PT. Bersinar Glow Indonesia is the plaintiff, and Shandy Purnamasari is the defendant. Therefore, the Supreme Court judge made a mistake by conflating cases with different subjects and objects of the lawsuit.

CONCLUSIONS

In the cassation decision with case No 161K/Pdt.Sus-HKI/2023, the Supreme Court judge granted the cassation request from the respondents, in this case, MS Glow. Meanwhile, the respondent in this dispute is Putra Siregar, the PS GLOW trademark owner. There are several considerations by the cassation judge that, according to the researcher, do not reflect the principles of certainty and justice, including:

1. The consideration states that the plaintiff's lawsuit regarding the PS GLOW trademark needs to be more specific and clear. However, the PS GLOW party has never argued that "MS GLOW" belongs to the plaintiff. The plaintiff only contends that the "MS GLOW" trademark is similar to the "PS GLOW" trademark.
2. The Supreme Court judge's consideration stated that the plaintiff filed a lawsuit in the

cancellation of the "PSTORE GLOW" and "PSTORE GLOW MEN" trademarks at the Medan Commercial Court, which has not yet obtained legal force (*inkracht*). However, a cassation decision from the Medan Commercial Court was rendered simultaneously with the cassation decision No 161K/Pdt.Sus-HKI/2023.

3. The legal consideration in the Surabaya Commercial Court's decision, where one of the considerations states that the registration of the MS GLOW trademark with registration No IDM000731102 under the name of CV. KOSMETIKA CANTIK is for class 32, namely for powdered tea drink products, which are deemed unsuitable for use as a trademark for cosmetic products and, thus, not eligible for legal protection. However, in its cassation decision, the Supreme Court should have considered this in delivering its judgment despite the public's need for certainty.

In this case, the judge set aside the principles of justice and legal certainty. Justice and legal certainty are interconnected and not contradictory. If a judge establishes justice through a decision, it is equivalent to creating legal certainty.

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