



THE EQUATION APPLIES AS AN ELEMENT OF A BRAND NAME IN A TRADEMARK CANCELLATION LAWSUIT

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Abstract: Trademark registration in Indonesia requires strong distinguishing power to differentiate a brand, which identifies the origin and characteristics of a product or service. Under Article 21, paragraph (1) of Law Number 20 of 2016, trademarks lacking this power will be denied registration. However, the inconsistency in handling trademark disputes in Indonesia often leads to a lack of legal certainty. Some judges focus only on auditory similarities, ignoring visual differences, while others consider all elements, including visual appearance and product type. This study examines the application of the principle of equality in trademark cancellation lawsuits prioritizing name elements. Utilizing normative legal methods through literature studies, legal references, and interviews, the findings reveal that a brand's distinguishing power is significantly influenced by the pronunciation of its name, which contributes unique meanings and identities, setting it apart from other registered brands.

Keywords: *Brands; Equality in Essence; Trademark Cancellation Lawsuits*

I. INTRODUCTION

Entering the reality of the market in the era of global trade in the last decade, such rapid development of international trade flows is inseparable from the progress of science, transactions, and technology, which affects one of the essential elements that contribute to the progress of science and technology comes from a free and expressive human thought called intellectual property rights (IPR).¹ One of the main things that manifests itself in the scope of intellectual property rights that must be studied further because it has a vital role in smoothing and increasing

¹ Muhammad Djumhana and R.Djubaedilah, 2011. *Hak Milik Intelektual (Sejarah, Teori, dan Praktiknya di Indonesia)*, Bandung: PT Citra Aditya Bakti, p. 17.

trade in goods or services as well as maintaining and realizing healthy business competition through adequate legal protection of trademark rights.² Given the importance of a brand function in connecting the goods and services concerned with its producers, it is very influential for the continuity of a company, as well as aiming to distinguish a company's goods or services from goods or services produced by other similar companies. This is a preventive effort to prevent fraudulent business competition from trademark infringement such as imitation, counterfeiting, or misleading trademarks registered as belonging to another party without rights.³ Therefore, it is necessary to protect a brand that has economic value for the quality of certain goods and specifics in trade or to describe the *individuality* and reputation of the goods and services that are traded in the business, and to distinguish a value or quality from similar goods or services belonging to other parties.⁴

The Unitary State of the Republic of Indonesia adheres to a constitutive system in trademark registration called *the first-to-file* principle. That is, through the *first-to-file principle* for trademark rights holders, they get legal protection and legal certainty if the trademark has been registered first through the Directorate General of Intellectual Property Rights as contained in the Provisions of Article 3 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as "Law No. 20/2016 concerning Trademarks and IG"), which reads: "*The right to the trademark is obtained after the trademark is registered*".⁵

Referring to the provisions mentioned above, it has made the right to a trademark a principle that emphasizes the exclusive right of the State to the owner of the mark to use the mark himself or give permission to other parties to use it for a certain period. Thus, of course, it provides a guarantee of legal protection and legal certainty that arises to the holder of the right to the registered trademark and who is entitled to the trademark as the first person to register. Thus, the principles of *first to file* also provide the right for the owner of the first registered trademark to file a lawsuit for cancellation against another

² Rahmi Jened Parinduri Nasution, 2013. *Interface Hukum Kekayaan Intelektual dan Hukum Persaingan (Penyalahgunaan HKI)*, Jakarta: Rajawali Press, p. 206.

³ Tomi Suryo Utomo, 2010. *Hak Kekayaan Intelektual di Era Global*, Yogyakarta: Graha Ilmu, p.209.

⁴ Muhammad Djumhana and R.Djubaedilah, 2011. *Hak Milik Intelektual (Sejarah, Teori, dan Praktiknya di Indonesia)*, Bandung: PT Citra Aditya Bakti, p. 170.

⁵ Elsa Savira and Runtung Sitepu, 2023. *Dampak Penyelenggaraan Pendaftaran Merek Berdasarkan Asas First to File*. *Jurnal Hukum Kaidah: Media Komunikasi dan Informasi Hukum dan Masyarakat* 23, no. 1, p. 4.

trademark that is the same in principle or in whole as contained based on Article 76 paragraph (1) of Law No. 20/2016 concerning Trademarks and IG.

Talking about the definition of a brand, according to the results of an interview conducted by the author with M. Hawin, a lecturer in intellectual property rights and business law, Faculty of Law, Gadjah Mada University in this thesis research, stated that brands can be understood in 3 (three) types, namely: First, a brand that consists of only one element, for example only names, words, letters, numbers, The arrangement of colors, sounds or holograms. Second, a brand that consists of two elements, for example, a word combined with an image element. Third, a trademark that consists of a combination of all aspects; for example the name is combined with pictures, numbers, and color arrangement based on Article 1 number 1 of Law No. 20/2016 concerning Trademarks and IG and one of the requirements for a trademark is that it must have *a distinctive* mark and as an indicator of the origin of goods/services with goods/services in the trademark owned by another party.⁶ Therefore, every brand should also be designed with strong differentiation and distinctive and clear pointing characteristics. The power of differentiation and the clarity of the origin of goods/services are conditions that must be created and displayed.⁷ This means that if a brand does not have a strong distinguishing power, it can create the impression that there is a similarity in essence with registered brands belonging to other parties, which confuses the consumer community through aspects of conceptual, phonetic, and visual similarities.⁸ This can qualify as a rejected trademark, and automatically, the trademark will not get legal protection either civilly or criminally through the Ministry of Law of the Republic of Indonesia c.q. Directorate of Trademarks c.q. Directorate General of Intellectual Property, because it is contrary to Article 21 paragraph (1) of Law 20/2016 of the Trademark Law and IG *junto* Article 17 of the Regulation of the Minister of Law and Human Rights Number 12 of 2021 on the amendment of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration.

In practice, trademark disputes in Indonesia through litigation often face challenges that do not provide legal certainty. One of the leading causes is the need for more unity of interpretation or clear parameters in applying what is meant by the concept of equality in the form of brand name elements at the time of trademark disputes. This impacts the law enforcement process, inconsistent with the Appeal

⁶ Result of Interview with Prof. M. Hawin, S.H., LL.M., Ph.D.

⁷ *Ibid*, 203.

⁸ R.M. Suryodiningrat, 2013. *Pengantar Ilmu Hukum Merek*, Jakarta: Pradnya Paramita, p. 22.

Commission as an independent body within the Ministry of Law of the Republic of Indonesia *c.q.* The Directorate General of Intellectual Property will be the examiner of trademark disputes, and the judges will be the examiner of trademark disputes in the Court. Although there are often different disparities in the same case, both in the application of law in trademark disputes through the Commercial Court in the District Court and Cassation and Review at the Supreme Court of the Republic of Indonesia, there are several judges who decide the case by considering that there has been a similarity in essence to the trademark that has an element of the name is considered sufficient to be seen by focusing on the indicator of similarity of sound or sound pronunciation through words without considering the difference in other elements such as visual appearance. However, on the other hand, several judges feel that there is a similarity in principle to a brand that has an element of a name that is regarded differently by stating that the indicator of equality in principle must cover all existing elements and be reviewed thoroughly using visual appearance, similarity of types of goods, similarities and differences in concepts.

Therefore, the researcher is interested in conducting further research, which will be discussed in more detail so that readers can see the gap in the problem regarding the application of the equation in the form of the element of the brand name in the trademark cancellation lawsuit because there is no unity of view and has not provided the same parameters in applying what is meant by the equation in principle through the assessment or consideration of the trademark examiner or Interested parties.

II. RESEARCH METHODS

The type of research the author uses is a normative legal research method or a literature method using secondary data or a Laws and Regulations approach. This research is known as doctrinal research, meaning that this research it is aimed at obtaining objective laws (legal norms), namely by conducting research on existing legal problems through rules and regulations, literature, legal principles and principles, legal systematics, legal synchronization in laws and rules vertically and horizontally, legal doctrines and other reference materials, This research also uses tertiary legal materials and secondary legal materials by examining references to the subject matter of the problem along with the interviews conducted, of course, by considering various aspects and looking at the relationship between the resource person and the object of the research discussed. This study conducted interviews with academics, namely M. Hawin, a Professor of Intellectual Property Rights and

Business Law Lecturer at the Faculty of Law, Gadjah Mada University⁹ along with OK. Saidin, as an Intellectual Property Rights Academician from the University of North Sumatra¹⁰ has become an experienced legal expert in providing teaching on similar cases regarding Intellectual Property Rights, which exists in particular regarding **"The Application of Equality in the Essence of Elements of Brand Name in Trademark Cancellation Lawsuits"**.

III. DISCUSSION

As for this discussion, the author wants to reveal what goals are achieved by researcher¹¹ To solve legal issues and deepen existing legal theories/principles in connection with applying the equation in the form of elements of the brand name in a trademark cancellation lawsuit. Therefore, the author is interested in further study and analysis because there is no unity of view and has not provided the same parameters in the application of the equation in the form of elements of the brand name in the trademark cancellation lawsuit through the assessment or consideration of the owner of the trademark rights as an interested party, The Appeal Commission as an independent body of trademark examiners within the scope of the Ministry of Law of the Republic of Indonesia c.q. Directorate General of Intellectual Property and Judges as examiners of trademark disputes in the Court.

The author reviewed and found several previous research results in this study related to the main equations in the Master of Law Postgraduate Program at Universitas Pelita Harapan. These studies include Cindy Christina Gulla's 2021 thesis titled "Legal Protection of Registered Trademark Rights That Have Pronunciation Equations," Master of Law Study Program, Faculty of Law, Universitas Pelita Harapan. This thesis research discusses the legal protection of trademark rights holders when registering trademarks and the steps needed to report trademarks with similar pronunciations to protect real trademark holders.

Iqbal Baharudin's thesis, 2017, with the title "Legal Protection for Registered Trademark Owners of New Warehouses Paintings that are considered to have similarities in principle with other registered brands Gudang Garam," Master of Law Study Program, Faculty of Law, Universitas Pelita Harapan. This thesis research focuses on the discussion related to the difference in the Decision

⁹ Result of Interview with Prof. M. Hawin, S.H., LL.M., Ph.D.

¹⁰ Result of Interview with Prof. Dr. OK. Saidin., S.H., M.Hum.

¹¹ Agus Budiarto, 2023-2024, *Diktat Kuliah Program Magister Hukum Universitas Pelita Harapan*, p. 95.

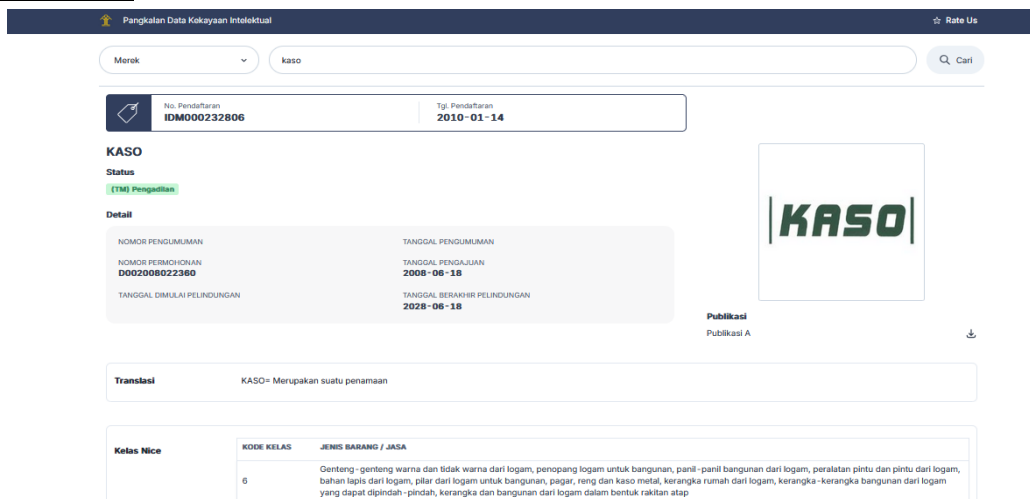
issued by the Supreme Court in the dispute between the "Gudang Garam" brand and the "Gudang Baru" brand, both civil and criminal, which resulted in two decisions that have permanent legal force and the two Decisions contradict each other against the same subject and object of the law. So, the Panel of Supreme Judges who examined and decided the case stated that the New Warehouse Brand owned by H. Ali Khosin, SE., had no similarity in essence with the Salt Warehouse Brand. Still, in a criminal case, the Panel of Judges at the Republic of Indonesia Supreme Court affirmed the Decision of the Kepanjen District Court No. 645/Pid.Sus/2012/Pn.Kpj Juncto of the Surabaya High Court No.: 297/Pid/2012/PT. Sby, who essentially sentenced H. Ali Khomsin, SE., to the use of a trademark that is essentially similar to that of another party, namely PT Gudang Garam, Tbk;

Journal of Yehuda Goodlife Nusale, 2023, with the title "Cancellation of Registered Brands That Have Similar Names in Principle," Journal of Pattimura Law Study Review: Volume 1 Number 1, August 2023, E-ISSN: 3025-22465, In this journal research, it focuses on discussions related to registered brands that have similar names in the main, namely in the brand "GOTO," "GoTo Financial" by PT Karya Anak Bangsa which has similarities in writing, pronunciation/similarity of sound and way of writing with the GOTO Brand owned by PT TFT, which in essence wants to convey the acceptance of the GoTo brand owned by PT Karya Anak Bangsa focuses on the type of goods and/or services that are not similar to GOTO owned by PT Terbit Financial Technology because goods that have similarities in essence and whole can still be used if they are not identical goods.

In the various studies that the author has described above, there are differences in this thesis research, which focuses more on the aspect of reviewing the analysis of legal certainty and legal systematics and finding theories or legal principles and doctrines in the application of equations in the form of elements of brand names in trademark cancellation lawsuits, which will be discussed in more detail so that readers can see the gaps in existing problems. In practice, there is no unity of view or the same parameters used by the owner of the right to the trademark as an interested party, the Appeal Commission as an independent body within the scope of the Ministry of Law of the Republic of Indonesia c.q. Directorate General of Intellectual Property as the examiner of trademark disputes and the judges as the examiner of the trademark, It is felt that there is still a lack of clarity in the criteria and detailed understanding in the application of the current application regarding the similarities in the central point based on Article 21 paragraph (1) of the Trademark

Law and IG *in conjunction with* Article 17 of the Regulation of the Minister of Law and Human Rights Number 12 of 2021 on the amendment of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration.

The chronology of the trademark cancellation dispute case, which is an interesting discussion for the author to study and analyze in more detail through the results of this thesis research, began when a company engaged in a light steel manufacturer that owns the rights to the KASO brand experienced a trademark cancellation dispute with the owner of the rights to the KasoMAX brand. If we pay close attention, it is found that the owner of the rights to the KASO trademark registered on January 14, 2010, which has a product in the form of mild steel that is included in the type of class 6 goods through the following screenshot attachment:



Picture 1: The chronology of the trademark
Source: <https://pdki-indonesia.dgip.go.id>

The problem began to occur when interested parties with the initials "TH" submitted an application for registration of the "KasoMAX" trademark for the types of goods covered by the types of goods in class 6 to the Directorate of Trademarks c.q. Directorate General of Intellectual Property, which is in the stage of announcement/publication in the Official Gazette of Trademarks Series-A No. 09/II/A/2019, agenda number: D002019006620, on February 8, 2019. In this regard, it attracted the attention of the owner of the rights to the KASO trademark that has been registered since January 14, 2010, to object to the application for registration of the KasoMAX trademark registered by "TH" to the Directorate General of Intellectual Property c.q. Directorate of Trademarks. Thus, on February

15, 2021, the Directorate General of Trademarks c.q. Directorate General of Intellectual Property agreed with the postulates of objection submitted by the owner of the KASO trademark as the objector by taking the stance of issuing a decision of rejection of the application for registration of the KasoMAX trademark submitted by "TH" as the Respondent to the Objection, because the refusal is contrary to the provisions of Article 21 paragraph (1) letter (a) of Law Number 20/2016 concerning Trademarks and Geographical Indications (hereinafter called the Trademark and IG Law") because it has similarities in principle or all with the registered trademark of another party or applied for first by another party for similar goods and/or services, in this case, the owner of the KASO registered trademark who has a product in the form of mild steel covered by the type of goods in class 6 that has been registered since January 14, 2010.

"TH" as the Respondent objected and responded to the rejection decision from the Directorate of Trademarks c.q. Directorate General of Intellectual Property on the application for registration of the trademark "KasoMAX" for the types of goods covered by the type of goods in class 6 by submitting an appeal to the Trademark Appeal Commission as an independent body within the Ministry of Law of the Republic of Indonesia c.q. Directorate General of Intellectual Property. Thus, in 2021, the Trademark Appeal Commission issued Decision Number 80/KBM/HKI/2021 by granting the application and issuing the registration of the KasoMAX trademark submitted by "TH" as the Appellant by assessing that there is no similarity in the essence as referred to in Article 21 paragraph 1 letter (a) of the Trademark Law and IG, between the KASO brand and the KasoMAX brand using parameters through visual display and different and distinctive colors, and does not give the impression that there is a similarity in the main conceptually, the sound of speech, or the form of writing.

In response to this, the owner of the rights to the KASO trademark objected to the Decision of the Appeal Commission Number: 80/KBM/HKI/2021, which had granted the application and issued the registration of the KasoMAX trademark submitted by "TH" as the Appellant. Finally, on November 25, 2022, the owner of the rights to the KASO trademark took legal action through a trademark cancellation lawsuit or cassation to the Supreme Court of the Republic of Indonesia based on the Commercial Court Decision at the Central Jakarta District Court Number: 115/Pdt.Sus-Brand/2022/PN. Niaga.Jkt.Pst. was strengthened by the Decision of the Supreme Court of the Republic of Indonesia Number: 702 K/Pdt.Sus-HKI/2023, in this Decision, the Panel of Examining Judges uses parameters that are different from the Trademark Appeal Commission in assessing that there are fundamental similarities between the KASO brand and the KasoMAX brand, through

the "*Nearly Resembles Doctrine*", namely, there is a similarity (*identical*) or almost similar (*Nearly Resembles*) which both have the main prominent element, namely the writing of the letters/words "K-A-S-O" and have visual similarities caused by the similarity of the word or writing of the letters K-A-S-O on the Plaintiff's KASO brand. So the Panel of Examining Judges in *the a quo* Decision stated that the differences in the dominant figurative elements of the logo/image and color composition did not cause a significant difference.

Based on the case that occurred between the "KasoMAX" brand and the "KASO" brand in the comparison between the Appeal Commission Decision Number 80/KBM/HKI/2021 and the Commercial Court Decision at the Central Jakarta District Court Number 115/Pdt.Sus-Brand/2022/PN. Niaga.Jkt.Pst., *Juncto* Decision of the Supreme Court of the Republic of Indonesia Number: 702 K/Pdt.Sus-HKI/2023 shows how the regulation regarding equality in principle could be more precise. No unity of view provides the same parameters in applying equality in principle to a trademark that contains elements of a naming that the Panel of Judges examines in a trademark cancellation lawsuit or the Appeal Commission as an Independent Body as Independent Body trademark dispute examiners within the scope of the Ministry of Law of the Republic of Indonesia c.q. Directorate General of Intellectual Property.

a. The Application of The Equation Basically Involves Brand Name Elements

Based on the case that has been described, the "KasoMAX" brand with the "KASO" brand is a brand that is included in the category of elements of naming according to the definition of a trademark based on Article 1 number (1) of the Trademark Law and IG, in other words only 1 (one) element is objectively compared, namely the name or word. Referring to the opinion of M. Yahya Harahap, who revealed that the element of the name as a brand includes all types of cultural objects, economic goods, living things or inanimate objects, names of individuals, families, legal entities, including names taken from geographies such as mountains, cities, regions, rivers or place names must be proven to have *a strong "distinctive power"* and be able to provide additional meaning (*secondary meaning*) that can embody and emit the power of a specific identity or a specific individuality when compared to another person's brand if the name is placed as a trademark.¹²

¹² M. Yahya Harahap, 1996. *Tinjauan Merek Secara Umum dan Hukum Merek di Indonesia: Berdasarkan Undang-Undang No. 19 Tahun 1992*, Bandung: PT Citra Aditya Bakti, p. 158-204.

The view of the doctrine mentioned above is in line with and by the interview results in this thesis research on October 14, 2024, which the author has done OK. Saidin as a legal expert and intellectual property academician from the Faculty of Law, University of North Sumatra on Jln. Dr. T. Mansur No. 9, Padang Bulan, Kec. In the interview, he argued that to determine the dominant element in the application of the equation in the essence, especially for brands that have name elements, it must go through several factors considered, including:

1) Pronunciation

The name element part of the brand is often noticed by its pronunciation. In other words, if the name element has a pronunciation similar to that of another brand, the element is likely dominant because it can confuse consumers.

2) Spelling and visual form

The dominant element of similar spelling or visual form often notice the name element of the brand.

3) Meaning and Connotation

The name element that is part of the brand has a strong or direct meaning related to the product or service offered, then the name is more likely to be the dominant element because the meaning is straightforward for consumers/people to recognize.

4) General Impressions

If the element of the name or part of the name that is part of the brand gives a powerful impression in the memory, seen or heard by consumers/the public, then the element of the name is considered the dominant element.

5) Industrial Use

In some cases, is the name used a common or descriptive name in the industry? If the name element is generic, it could be that the dominant element has shifted to another element in the brand (e.g. a logo or graphic symbol). Still, if the name is unique enough, it can become the dominant element.

6) Direct Comparison

The principle of equality considers the overall similarity of the two brands being compared, not just minor elements. If the name elements in two brands give an overall impression similar to the consumer, the element can be considered dominant.

In the interview, he also gave an illustrative example if there are 2 (two) brands with the names "Bintang Elektronik" and "Bintaro Elektronik." However, there is a difference at the end of the word; "Bintang" and "Bintaro" can be considered the dominant element because they dramatically affect how consumers remember the

brand. Ari, the name is likely similar if both are engaged in the same industry. So, overall, the determination of the dominant element is very contextual and depends on the overall impression that is caused in the mind of ordinary consumers, not just a comparison of the elements one by one.¹³

Apart from that, he also argued that to determine the dominant element in applying the similarity in principle between 2 (two) brands being compared, there is an element of name can be done by considering the aspect of the brand concept with the element of naming as regulated in Law No. 20/2016 concerning Trademarks and IG, with some exceptions if the name as part of the brand does not have distinguishing power, The benchmark name is particular to the identity of a person, family name, or legal entity in question. For example, the surname BAKRI is very different from the surname KALLA. The two families' names have a specific identity, not vague, but have a *distinctive power* for everyone who sees and hears them.

Another exception is if the name as part of the brand contains various meanings by itself, the discriminating power becomes weak and faded; in other words, a name that can be said to have not much meaning is a name with an ordinary *meaning*. For example, SUPRAPTO is just an ordinary name with the content of ordinary meaning; it can immediately emit a unique identity for SUPRAPTO to face other names such as BADU, MARIUS, or DATUK MARINGGI. It is different with a name that contains many meanings and does not give a unique identity, for example, the HAKIM family which can be interpreted as the position of a judge who acts to adjudicate cases in the Court, as well as TOPAN, in addition to being considered as a name, but at the same time can be interpreted as a natural event in the middle of the ocean. Thus, the two names can less highlight specific identities and individualities because their distinguishing power is vague and weak. Another exception is if the name as part of the brand uses a common name the public uses, it may not be used as a brand. Suppose there is an application for trademark registration, and it turns out that the public widely uses the name of an individual or family. In that case, the trademark office must reject the registration, and other exceptions if the name as part of the trademark uses the name of a well-known person, generic *name*, descriptive, or geographical name cannot be registered as a trademark.

Thus, the element of the name that is part of the brand can have a dominant element in similar pronunciation or spelling and can confuse consumers. However, if it is considered conceptually, the impression of *the likelihood of association* for the element of the name that is part of the brand has a strong meaning or the association

¹³ Result of Interview with Prof. Dr. OK. Saidin, SH, M.Hum.

with the product is enough to assess that there is a similarity in the main thing that can be an element that can be easily recognized and remembered by consumers/society without causing confusion in the community/consumer, and the brand consisting of naming elements must also have characteristics, and unique naming elements that set it apart from other brands. If the name becomes the dominant element and creates an impression similar to an existing brand, the registration can be rejected because of the similarity in essence.

In addition, in accordance with the results of the interview in this thesis research, which the author has conducted with M. Hawin, as a professor of intellectual property rights and business law lecturer at the Faculty of Law, Gadjah Mada University. In the interview, he argued to determine the dominant element in the application of the principle of equality in the essence, especially for brands that have elements of names or words that are considered essentially the same as other brands if the sound or sound of the names or words of the two brands is similar. Thus, the similarity of the sound or sound of the name or word is the most decisive factor compared to other elements or elements in the two brands compared.¹⁴ In the interview, he also gave several examples of court decisions that have determined such matters, such as the trademark dispute between the Apollo v. Apollinaris brand based on *Rad Van Justitie Batavia*, dated October 21, 1931, the trademark dispute between Phillips v. Philco based on *Rad Van Justitie Batavia*, dated April 2, 1937, a trademark dispute between Baygon v. Flygon based on the Decision of the Supreme Court of the Republic of Indonesia Number 192 K/Sip/1983, a trademark dispute between Three Diamonds v. Daimen based on the Decision of the Supreme Court of the Republic of Indonesia Number 2140 K/Sip/1982, dated June 19, 1984, the trademark dispute between Mediker v. Medicar based on the Decision of the Supreme Court of the Republic of Indonesia Number 383 K/Pdt/1986, dated June 29, 1987, with the same consideration stated that the similarity of the voice or speech sound is the most decisive thing compared to other elements of the two brands, such as the composition of colors, images, the form of writing, and their appearance.

Furthermore, he cited several trademark disputes between Extra Joss v. Enerjoss based on the Decision of the Supreme Court of the Republic of Indonesia Number 06/PK/N/HaKI/2006; in this case, the panel of judges considered that the Extra Joss brand and the Enerjoss brand have similar sounds or pronunciation sounds. Finally, the Supreme Court of the Republic of Indonesia stated that the Enerjoss brand has essentially similarities with the Extra Joss brand without considering the difference in other words or other elements. Then, the trademark dispute between Aquaria v.

¹⁴ Result of Interview with Prof. M. Hawin, S.H., LL.M., Ph.D.

Aqua based on the Decision of the Supreme Court of the Republic of Indonesia Number 980K/Pdt/1990, dated March 30, 1992. In this case the panel of judges considered and stated that the word "Aqua" was a prominent element, so the Supreme Court noted that the "Aquaria" brand has essentially similarities with the "Aqua" brand.

b. Application of Dominant Elements to Brands That Have Name Elements

Based on the case that has been described between the KASO brand and the KasoMAX brand, if you look closely, the word K-A-S-O is a *coined word* or *invented word* that has a dominant element of strong "*distinctive power*" as a naming element in the KASO brand which was registered on January 14, 2010 in relation to the type of goods in class 6 in the form of light steel. Meanwhile, the word M-A-X on the KasoMAX brand, which is also included in the naming element registered on October 7, 2021, is an *arbitrary word*, which is a word that has a meaning and is commonly used by people but is used for brands of goods that are not related to the word, namely the type of goods in class 6 in the form of light steel. So, because the word *arbitrary word* is common or often used by many people, this word is less *distinctive* compared to *coined words*. Primarily if an objective visual comparison is carried out between the two brands with the letter K-A-S-O at the beginning of the word KasoMAX brand and the KASO brand, which tends to be of concern compared to other letters in the word. Therefore, the elements of the word/letter K-A-S-O that are in the same position as figurative elements are logically stated to be more dominant or prominent than the element of M-A-X.

The benchmark for a brand that has an element of the name having a similarity in principle with the other party's brand or applied for first by another party is also determined through the "impression of similarity," as explicitly stated in the explanation of Article 21 paragraph (1) letter (a) of Law No. 20/2016 concerning Trademarks and IG, carried out by paying attention to the impression of similarity in form, way of placement, the way of writing, or the combination of elements, or the similarity of speech sounds, contained in the brand.

Furthermore, as part of this thesis research, the author interviewed OK Saidin, a legal expert and intellectual property rights academic from the University of North Sumatra. The interview was conducted on October 14, 2024, at the Faculty of Law, University of North Sumatra, on Jln. Dr. T. Mansur No. 9, Padang Bulan, Kec.

1) Shape Equation

The impression of a form similarity in the element of the name is part of the brand can be determined if the word shape, letter form or typographic style,

the form of meaning in the brand name being compared is similar or almost the same, even though the name is slightly different. Still, it can give the impression of a similar shape. In addition, a brand that can be categorized as a brand with the impression of a similar shape only adds a word or letter to a brand. In addition, the letter at the beginning of the word will tend to be of concern compared to other letters. In assessing the fundamental similarities between two brands that contain name elements it is done by looking at the difference at the beginning of the word can make a brand have more differences in visual form compared to the variation in one of the letters in the middle, and word length and word separation are also factors that affect the perception of visual form in name brands that contain word elements. For example, an illustration between the Pokemon brand in the type of goods registered in class 30 and the Yokemon brand in the kind of goods registered in class 30, where there is a word in it consisting of 7 (seven) letters and the only difference is the letter "Y" in the Yokeman brand and the letter "P" in the Pokemon brand. Of course, it can be confusing for the consumer community to see and choose the two brands if they are compared objectively because they have similar shapes.

2) How to Deploy

The impression that there is a similarity in the way of placement/placement in the name elements that are part of one brand with other brands can be determined through the placement of name elements in the logo, the placement of similar designs such as the position of letters, writing, and the name of the brand, can give the impression that the two brands are identical. For example, in the case of a brand in the form of a name element that has the impression of similarity in the way of placement, the Ray-Ban brand is registered in grade 9 with the Ray-Bon brand, the brand applied for in grade 9, has a similar way of placement. The word "RAY" in these two brands is the first word of the brand. In addition, in the writing of the Ray-Ban brand and the Ray-Bon brand, the position of the word elements looks the same from the order of letters, letter models, figurative elements, and characters in the brand, so the two brands that are compared have similarities.

3) How to Write

The impression of a similarity in the way of writing in the elements of a name that is part of a brand with another brand can be determined through a brand that is almost the same, a slight variation in writing has nearly the same

number of letters or words in a brand, or a brand that sounds similar (spelling). Like a brand that adds a word or one or more letters in a brand, it can be considered identical if it is difficult for consumers to distinguish it at first glance. He also gave an example of a brand illustration in the form of a name element that has the impression of similarity in the way of writing, namely the GUESS brand registered in grade 9 and the GLIESS brand applied for in grade 9, which has almost the same way of writing, even what distinguishes these two brands is the letter "LI" in GLIESS products. In addition, the writing format of the two brands is similar, where these two brands start with larger fonts that get smaller and smaller.

c. Equations of Combinations Between Elements

The impression of a combination of the same in the elements of a name that is part of a brand with another can be determined through a combination of name elements, shape equations, placement equations, writing equations, pronunciation sounds or other visual elements that are the same or almost the same also contribute to the impression of the equation. He also gave an example of a brand illustration in the form of a name element that has the impression of similarity in the combination of the elements are the KitKat brand and the KicKer brand, between the two brands consists of 6 (six) letters and also capital letters these two products are found in the letter "K", there is a similarity in the number of letters in the brand. In addition, there are also similarities in the red and yellow color elements in the two products have a similar combination of letters and images that can confuse consumers.

d. Speech Sound Equations

The impression of the similarity of pronunciation sounds in the elements of a name that is part of one brand with another can be determined through hearing if the two brands that have the element of the name are pronounced very similar or confusing when heard. Usually, this speech equation is always related to the similarity of almost the same way of writing and the similarity of placement because it sounds similar and has elements of writing letters or words nearly the same as the location of the writing. However, speech similarities can also occur in brands with different writing but with the same sound or a homophone. In other words, even though the spelling is different, the impression of similarity can still occur, especially in verbal communication. He also gave an example of a brand illustration in the form of a name element that has the impression of similarity in the pronunciation sound equation is the Ishine brand and the Ice Shine brand; the two brands, when read, will be a sound similarity because the two words contained from these two brands

sound the same or homophone.

He concluded that the impression of similarity in a brand with name elements is determined by the overall similarity, including the shape, writing, placement, combination of elements, and the sound of speech. These elements are considered in terms of whether they can confuse ordinary consumers. In addition, the author also interviewed M. Hawin, as a professor of intellectual property rights and business law lecturer at the Faculty of Law, Gadjah Mada University. The interview was conducted on October 20, 2024; in the interview, he argued that the term "impression of similarity" means that the two brands that are compared as a whole, not in detail, do not have to be precisely the same, but by looking at the dominant or prominent elements of the two brands, the public has the impression that there is a similarity between the two brands.

In the interview, he also gave several examples of court decisions comparing brands as a whole or outline, not in detail in determining the impression of similarities, such as the trademark dispute between the Aqua brand v. the Aquaria brand based on the Decision of the Supreme Court of the Republic of Indonesia Number 980K/Pdt/1990, dated March 30, 1992, in which the Supreme Court of the Republic of Indonesia compared the two brands as a whole, not in detail. This means that, as a whole or broadly, the "Aquaria" brand has similarities with the "Aqua" brand. The same happened in the trademark dispute between Three Diamonds v. Daimen based on the Decision of the Supreme Court of the Republic of Indonesia Number 2140 K/Sip/1982, dated June 19, 1984; in that case, the Supreme Court of the Republic of Indonesia also compared the two brands in whole or in general and stated that the "Daimen" brand has essentially similarities with the "Three Diamonds" brand.

e. Application of The Impression of Similarity To Brands That Have Name Elements

Based on the case that has been described between the KASO brand and the KasoMAX brand, if you pay close attention the letter K-A-S-O is a more prominent and dominant word, when the two brands are compared or viewed as a whole, not in detail, then there is clearly an impression of similarity between the two brands and when viewed in terms of the similarity of the sound or speech between the KasoMAX brand and the KASO brand as explained above. The similarity of the sound or pronunciation more determines other elements of the brand, such as the form of writing and/or appearance. In this case, even though the KasoMAX brand and the KASO brand are written with different shapes and appearances, the similarity of the sound or speech of the two brands determines the basic similarity between the two brands.

As the results of the interview in this thesis research, the author conducted an interview with M. Hawin, as a professor of intellectual property rights and business law lecturer at the Faculty of Law, Gadjah Mada University. In the interview, he argued that the occurrence of public confusion determines the existence of similarities in principle, although Law Number 20 of 2016 concerning Trademarks and IG, does not define in detail the term confusion ("*Confusion*"), but several Supreme Court Decisions of the Republic of Indonesia have determined that confusion is a crucial thing to determine the existence of similarities in essence between the brands being compared. For example, in the case of the *Aqua v.s. Brand. Aquaria* brand (MA No.980K/Pdt/1990, March 30, 1992), the Supreme Court stated that the "Aquaria" brand confused the public with the "Aqua" brand. Thus, the "Aquaria" brand is similar to the "Aqua" brand. Similarly, in the case of *Three Diamonds v. Daimen* (MA, 2140k/Sip/1982, June 19, 1984), the "Daimen" brand was confused with the "Three Diamonds" brand, so it was stated that the "Daimen" brand was essentially the same as the "Three Diamonds" brand.

Based on the case described between the KASO brand and the KasoMAX brand, if carefully considered related to *confusion*, the impression that there is a similarity in voice or pronunciation between the KasoMAX brand and the KASO brand confuses the community. As mentioned above, in the case of the Aqua brand v. the Aquaria brand based on the Decision of the Supreme Court of the Republic of Indonesia Number 980K/Pdt/1990, dated March 30, 1992, in that case the Supreme Court of the Republic of Indonesia stated that due to the similarity of the sound or pronunciation of the two brands, the Supreme Court considered that there had been confusion in the community so that the "Aquaria" brand was declared essentially the same as the "Aqua" brand. Likewise, in the trademark case between the Three Diamonds brand v. the Daimen brand Based on the Decision of the Supreme Court of the Republic of Indonesia Number 2140 K/Sip/1982, dated June 19, 1984, in that case, the Supreme Court of the Republic of Indonesia considered that there had been confusion in the community so that the "Daimen" brand was declared essentially the same as the "Three Diamonds" brand. Therefore, the similarity of the voice or speech of the KasoMAX brand with the KASO brand confuses the public.

f. Analysis of Brands That Have Essentially Similarities to Registered Brands

In principle, a trademark can be registered and protected if it has an inherently *distinctive mark* that is used for the trade of goods and/or services.¹⁵ This is in accordance with Article 1 number (1) of Law Number 20 of 2016 concerning Trademarks and IG, which reads:

"The trademark is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, or color arrangements in the form of 2 (two) dimensions and/or 3 (three) dimensions, sounds, 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 the trading of goods and/or services".

Based on the description of the provisions mentioned above, the primary function of the brand must be the ability to distinguish the origin and characteristics of a good and/or service owned by a specific manufacturer. This means that as a distinguishing mark, a brand cannot be registered if it does not have distinguishing power, and a trademark will be rejected if it has the same as the whole (identical) or has similarities in principle (similar) or with a brand that has been registered first.¹⁶ Regarding the indicator of assessment of relative ground in the rejection of a registered trademark is rejected if it is considered to have similarities in principle or all with the registered trademark belonging to another party as stipulated in the provisions of Article 21 paragraph (1) of the Trademark and IG Law and its explanation, which reads as follows:

"The application is rejected if the trademark has a similarity in principle or all with: a. Registered trademarks belonging to other parties or applied for in advance by other parties for similar goods and/or services".

In assessing whether or not there is a "similarity in principle", refer to the explanation of Article 21 paragraph (1) of the Trademark and IG Law *in conjunction with* Article 17 of the Regulation of the Minister of Law and Human Rights Number 12 of 2021 on the amendment of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration, which reads:

"What is meant by "equality in essence" is a similarity caused by the existence of dominant elements between one brand and another so that it creates the impression of similarity, both in terms of form, placement, writing or combination of elements, as well as the similarity of speech sounds, contained in the brand".

¹⁵ Rahmi Jened Parinduri Nasution, 2013. *Interface Hukum Kekayaan Intelektual dan Hukum Persaingan (Penyalahgunaan HKI)*, Jakarta: Rajawali Press, p. 162.

¹⁶ Adrian Sutedi, 2013. *Hak Atas Kekayaan Intelektual*, Jakarta: Sinar Grafika, p. 91.

Referring to the explanation of the Laws and Regulations mentioned above, the word or term similarity is basically a similarity. The similarity in the Great Dictionary of Indonesian (KBBI) comes from the word "similar" which means almost the same or similar.¹⁷ One of the most talked about issues about brands is the one that concerns the "similarity" of one brand with another. Thus, the terminology "equality in principle" in Law Number 20 of 2016 concerning Trademarks and IG, referring in accordance with the doctrine of "*nearly resembles*", gives meaning that a brand has in principle similarities with other brands if the brand has similarities or "almost the same" or "similar" in form, not necessarily "exactly the same" or "the same in whole", which considers that a brand has similarities in principle with other brands if the brand There is a similarity (*identical*) or almost similar (*nearly resembles*) to other people's brands which is based on sound similarity (phonetic), appearance (visual), meaning and conceptuality.¹⁸ A brand can be compared *side-by-side* with other brands to find out if there are any fundamental similarities between the two or not.

In addition, according to Emmy Yuhassarie's opinion in assessing whether there is a similarity between one brand and another, parameters are used through two theories, namely holistic approach theory and dominance theory. Based on the theory of a holistic approach, brand similarity assessment should consider overall aspects such as sound, meaning, spelling, and appearance. Meanwhile, according to the domination theory, only the most dominating elements are the focus.¹⁹ So, in the opinion of Tim Lindsey, the parameters that can be used in determining a brand to have similarities with other brands by comparing the two brands by paying attention to the essential characteristics and the impression of similarity between the two by the presence of dominant and prominent elements which in this case can also be understood as the primary and most essential elements of the brand which include images, names, words, letters, numbers, color arrangements, or a combination of the elements of the two brands that have distinguishing power and are used in trading activities of goods or services by the provisions of Article 1 number 1 of Law Number 20 of 2016 concerning Trademarks and IG. This means that the equation arises because of the similarity in the shape, meaning, and sound of the brands being compared. This form equation consists of words, names, letters, numbers, colors, or combinations according to the provisions of Article 1 number 1 of Law Number 20 of 2016 concerning Trademarks and IG.

¹⁷ Departemen Pendidikan Nasional, 2008. *Kamus Besar Bahasa Indonesia*, Jakarta: PT Gramedia Pustaka Utama, p. 920.

¹⁸ Emmy Yuhassarie, 2005, *Hak Kekayaan Intelektual dan Perkembangannya*, Jakarta: Pusat Pengkajian Hukum, p. 184 – 207.

¹⁹ *Ibid.*

In addition, in reality there is no benchmark that determines factors in the sense of "similarity", but there are details of factors that can cause similarities, or the existence of "the same impression" through prominent elements in the brand can be done by looking at the similarities and differences as well as paying attention to the important characteristics of the impression caused between the two,²⁰ including *similarity of form*, *similarity of composition* in the way of placement or writing, *similarity of combination*, *similarity of elements*, sound similarity, and *phonetic similarity*) which deceives the public by assuming that there is a connection with each other and assuming that both are sourced from the same producer as referred to based on the explanation of Article 21 paragraph (1) of the Trademark Law and IG *juncto* Article 17 of the Regulation of the Minister of Law and Human Rights Number 12 of 2021 on the amendment of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration.

Therefore, if there is a similarity in the essence in the trademark that has been registered first with another person's brand, it is appropriate that the trademark that has been registered first can apply for the cancellation of trademark registration if there is a similarity in the subject based on relative reasons (*relative grounds*)²¹ based on Article 21 number (1) letter (a) of Law No. 20/2016 concerning Trademarks and IG to the Directorate of Trademarks c.q. Directorate General of Intellectual Property through a trademark cancellation lawsuit filed with the Commercial Court as explained in Article 76 number (1) and (3) *Juncto* Article 77 number (1) of Law Number 20 of 2016 concerning Trademarks and IG.

IV. CONCLUSION

This study concludes that in trademark cancellation lawsuits, the concept of similarity, particularly regarding brand names, hinges on strong "distinctive power." A brand name should convey additional meaning (secondary meaning) that reflects a specific identity through its wording, pronunciation, or similar spellings. This distinctiveness is essential when comparing brands with similar name components. The perception of a potential association tied to a brand name is crucial, as it should be recognizable and memorable for consumers without causing confusion. A brand must have unique naming elements that set it apart; otherwise, its registration may be denied due to similarity with existing brands. When evaluating brand similarity, it is crucial to consider factors such as shape, placement, writing style, phonetic sounds, and the potential for consumer confusion, which can lead to erroneous associations between brands and harm the rightful owner.

²⁰ Tim Lindsey, 2005, *Hak Kekayaan Intelektual: Suatu Pengantar*, Bandung: PT. Alumni, p. 147.

²¹ Eko Yuliyanto, 2020, *Executorial Decision of Registered Brand Cancellation*. Indonesian Private Law Review 1, no. 1, p. 14.

In Indonesia, the increase in trademark cancellation disputes is primarily attributed to litigation, which suffers from a lack of legal certainty due to inconsistent interpretations and criteria among trademark examiners. This inconsistency leads to varying decisions in both the Commercial Court and the Supreme Court concerning trademarks, particularly those that incorporate elements of names. To achieve fairness and legal certainty in trademark disputes, future recommendations stemming from this study should involve government participation in designing and implementing specialized instruments aimed at strengthening Trademark Law and Intellectual Governance (IG). Additionally, the Regulation of the Minister of Law and Human Rights should provide clear and concrete guidelines and criteria for the definition and limitations of trademarks. It is essential to align these frameworks with international conventions recognized by member states of the Paris Convention, as well as to establish a definitive mechanism for assessing trademark equality that is thoroughly communicated to all stakeholders, including entrepreneurs, government agencies, and brand examiners. This approach is crucial, particularly given the prevalent issue of the subjective nature of the term "similarity" between brands, which can heavily influence brand examiners' decisions.

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