

## ISSUANCE OF DOUBLE CERTIFICATE OF SUPER MARIO BROS BRAND IN THE GENERAL DIRECTORATE OF INTELLECTUAL PROPERTY (Case Study Number 650 K/Pdt.Sus-HKI/2021)

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### ABSTRACT

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Business actors must apply for brand registration with a government institution where, in this case, the Directorate General of Intellectual Property Trademarks and Geographical Indications Ministry of Law and Human Rights of the Republic of Indonesia. Such shall be done so that when a product, be it goods or services, is being created and circulated in public will be protected and not claimed by another party. Registered products will have exclusive rights given by the state to the business owners. Furthermore, brands may be applied for more than one party using the same name and categories, creating a double societal brand. Such will result in legal problems and leads to dispute resolution in court. Every judge's decision should be based on the state laws to provide legal certainty for the public as the brands applied for have been through substantive examination. Therefore, for judges to hand down the decision, they should pay attention to the principles of good legislation and considerations used not only because of the well-known brand factors but also the fundamental reasons for the acceptance of the brand itself. Brand applicants are also advised to stick to something other than well-known names that have been prevalent in the public. Instead, they are advised to create and design their own brands that have selling points.

Keywords: Issuance of Brand Certificate, same and similar brand, the same brand of different classes, super Mario bros, famous brand.

### 1. INTRODUCTION

The era of digitalization affects business actors' behaviour to create various innovations in displaying various products on the market. To generate a number of profits on the goods and services marketed, of course, labelled with a variety of branded products that trigger attractiveness and competitiveness for consumers and also to be able to compete with other business actors.

The brand is very important for every business actor or industry player of goods and services products, especially to companies with a large selling value. Every brand displayed to the public will affect the attractiveness of a good and service traded to consumers. Business actors in displaying brands to the business world must have a differentiating value with other business actors or business competitors, with the aim of influencing the pattern and ease of consumers finding or accessing the desired goods and services every day so that the differentiating value must be strong and able to withstand the influence of their competitors in today's global market. With a brand with more selling value or strong global influence today, the company can survive or continue to appear and trade goods and services to consumers even though the company's products compete with global giant companies.

To be able to protect the mark and not be owned by other parties, business actors or companies that create goods and services products must certainly register the mark with government agencies, in this case it is the Directorate General of Intellectual Property, part of the Director of Brand and Geographical Indications, Ministry of Law and Human Rights of the Republic of Indonesia. In the event that it is said that the mark has value, then in article (3) "The right to the mark is obtained after the mark is registered". With the registration of the mark, it can be said that the previous registrant is the legal



owner of the mark that already has a trademark certificate from the Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia.

When an idea arises to protect intangible intellectual property rights, many experts reason why intellectual property rights need to be protected, considering that the process of creation requires much time, talent, work, and money to finance the process of creation or research.

That with such great sacrifices from creators, it is very unfair if the results of their creations or research are simply imitated and commercialized by irresponsible people. Thus, creators will lose their passion for recreating because no driving incentive can help develop new creative ideas.

Therefore, of course, legal protection is needed. Legal protection of intellectual property is very important for creators and inventors to protect their work. The creator or inventor can do certain acts on his property, and other parties have an obligation not to infringe on the holder of these rights. So in its development, IPR has been recognized as an intellectual property that needs to be protected.

Marks, as stipulated in the law, include trademarks and service marks. A trademark is a mark used on goods traded by a person or several people together or a legal entity to distinguish it from other similar goods. While service marks are marks used on services traded by a person or several people together or legal entities to distinguish from other similar services.

In addition to the two types of marks mentioned above, the Trademark Law also recognizes collective marks, which are marks used on goods and/or services with the same characteristics regarding the currency, general characteristics, and quality of goods or services, which several persons or legal entities will trade together to distinguish them from other similar goods and services. The right to a mark is an exclusive right granted by the state to the owner of a mark registered in the general register of marks for a certain period of time by using the mark itself or granting permission to other parties to use it.

At first, Nintendo Co., Ltd., which is a Plaintiff, was established in 1889 this company is from Japan and engaged in consumer goods, electronics and video game companies. The company is very well known in the market. It has many subsidiaries in parts of the world, such as in the United States and Europe, namely: Nintendo of America Headquarters, located in Redmond, Washington, United States and Nintendo of Europe Headquarters, located in Frankfurt, Germany, as well as studios spread across Japan, China and the United States.

The first applicant for the super mario bross brand came from Japan in the form of a business entity, namely Nintendo Co., Ltd, which applied for trademark registration in 1986 In Indonesia, namely the super mario bross brand by applying for registration in classes 09 and 28 registered "Reg. No. IDM000088541, IDM000088542, and IDM000088543.with the specifications of Mario and Luigi characters and their variants as brands since 1986 in several countries, among others in Australia, India, Malaysia, Bahamas, Canada, Philippines, Singapore, etc., to protect goods and services in classes 03, 05, 08, 09, 10, 12, 14, 20, 28, 35, 36 and 41. The Super Mario Bros. brand has also been registered to protect goods in class 25 since 1989 in Canada."

The applicant for registration of the second mark, namely on January 3, 1994 from Indonesia, namely on behalf of Eddy Tumewu, has applied for registration of the Super Mario Bros. brand with Reg. No. 331295 to protect goods in class 25, namely: "all kinds of apparel for men, women and children, socks, ties, hats, gloves, waistbands, shoes, sandals, slippers, shoe soles, veils, supporters, headbands, wristbands, knee guards, and such registration was issued on April 11, 1995". From 1995 to October 22, 2013, Eddy Tumewu carried out all activities on the brand that had received his registration.

On October 22, 2013 Eddy Tumewu transferred the rights to the Super Mario Bros. brand No. IDM000007313 (formerly No. 331295) in class 25 to PT. Cardolestari Indonesia and then recorded by the Directorate General of Intellectual Property section of the Directorate of Brands and Geographical Indications of the Ministry of Law and Human Rights Manusa who is a Defendant in the General Register of Marks on April 20, 2015.

The application for registration of the mark has differences both in terms of class and in terms of form and characteristics. However, in Decision Number 58/Pdt.Sus-TBrand/2020/PN. Niaga.Jkt. Pst. The panel of judges granted the Plaintiff's lawsuit in its entirety and canceled the registration of the



Super Mario Bros mark No. IDM000007313 in class 25 on behalf of the Defendant who had obtained a trademark endorsement certificate since April 11, 1995 and the panel of judges only paid attention to the relevant laws and regulations, especially article 77 paragraph (2) of Law No. 20 of 2016 concerning Marks and Geographical Indications, not up to the substance of the laws and regulations that apply and do not pay attention to the reasons of the Directorate General of Intellectual Property, Brands and Geographical Indications for the issuance of the same and non-similar marks.

Defendant I and Defendant II filed a legal remedy for cassation. However, the judgment was still rejected by only taking into account Law Number 20 of 2016 concerning "Marks and Geographical Indications, Law Number 48 of 2009 concerning Judicial Power, Law Number 14 of 1985 concerning the Supreme Court as amended by Law Number 5 of 2004 and the second amendment by Law Number 3 of 2009, as well as other relevant laws and regulations."

So that from the subject matter above, there is no clear and appropriate basis for trademark registrant applicants from Indonesia, and the rules used by the Director General of Intellectual Property, Brands and Geographical Indications always refer to the applicable rules, laws and regulations. Article 21 Paragraph 1 letter (a) of UUMIG states that the application is rejected if the Mark has similarities in the principal or in whole with Registered marks belonging to other parties or applied in advance by other parties for similar goods and/or services;

If referring to Article 21 (1) letter (a) of the law on marks and geographical indications, "The application is rejected if the Marks are similar in principle or in whole." So in the explanation, the registered mark belongs to another party or is applied for in advance by another party for similar goods and/or services; So that the defendant must also get the same rights and has passed various examinations, so it is not appropriate if it is said to have committed duplicates or bad faith.

## 2. LITERATURE REVIEW

To support this research, the author uses Lawrence M. Friedman's theory which suggests that to be successful and or effective, law enforcement actions depend on three elements of the legal system: legal structure, legal substance and legal culture. And the next theory is Lawrence Gustav Radbruch, who suggests there are 3 (three) basic values of law which are then known as the mind of law. The three values are certainty, justice, and expediency. As a basic legal value (legal principle) , these three legal basic values are the first reference in forming laws and regulations. And for the theory of Gustav Radbruch, only two theories are linked, namely the Theory of Legal Certainty and the Theory of Legal Expediency, because these two theories are close to reality. At the same time, the Theory of Justice is philosophical.

### 1. Theory of Legal Certainty

Against the theory put forward by Gustav Radbruch explained, that in the theory of legal certainty put forward four fundamental things have a close relationship with the meaning of legal certainty itself, which are as follows:

- a Law is a positive thing which means that positive law is legislation.
- b Laws are based on facts, meaning they are based on reality.
- c Facts contained or contained in the law must be formulated in a clear way, so that it will avoid confusion in terms of meaning or interpretation and can be easily implemented.
- d Positive laws must be kept the same.

The opinion of Gustav Radbruch regarding legal certainty, based on his view of legal certainty means that legal certainty is one of the products of law or more specifically, a product of legislation. For the certainty of the law proposed by Gustav Radbruch, the law is a positive thing that can regulate the interests of every human being in society and must always be obeyed even though the positive law is considered unfair. Furthermore, legal certainty is a definite state, provision or provision.

### 2. Theory of Legal Expediency

The sole purpose of the law is none other than the administration of justice. On the contrary, the long-discussed opinion that law aims at three goals, namely justice, certainty and expediency, the



correct rationale is that if justice is sought then certainty and expediency will naturally follow, because both expediency and certainty are part of it. It is the law itself. So, certainty and expediency are not placed next to justice as a legal goal but as a means to achieve that justice to all parties.

Utilitarianism believes that the purpose of law is to provide benefits to as many people as possible. Expediency here is defined as happiness (happiness), so the judgment of good and bad or whether or not a law depends on whether the law gives humans happiness. Thus, it means that every preparation of legal products (laws and regulations) should always pay attention to the purpose of the law, which is to provide as much happiness as possible for the community.

The basic tenets of Bentham's teaching can be explained that the purpose of the law is that the law can guarantee happiness to individuals, then to the multitude. "The greatest happiness of the greatest number". This principle must be applied in a quantitative manner, since the quality of pleasure is always the same. To realize the happiness of individuals and society, legislation must achieve four objectives: To provide subsistence (to give life *nafka*); To provide abundance (to provide a living abundant food); To provide security; and *To attain equity*.

### 3. METHODS

Research must take all ways and forms to obtain results and conclusions on what is studied to be developed into a scientific work. In this study, the author used the Normative Juridical research method.

The normative juridical research method is literature law research carried out by examining literature materials or mere secondary data.

The normative juridical approach examines rules or norms and rules related to criminal acts of decency by means of library research literature studies, namely by reading, quoting, copying, and examining theories that are closely related to field study problems.

The research approach conducted by the author of "Publication of Super Mario Bros. Brand Dual Certificate at the Directorate General of Intellectual Property." is a type of normative juridical research supported by empirical juridical, namely research based on regulations, norms, principles, rules and other related legislation, with the function and role of the government in this case the Directorate General of Intellectual Property so as to issue two trademark certificates the same with different classes and the panel of judges in considering its decision cancelled the same mark with different classes. It set aside all rules applicable at the time of receipt of the application for registration of the mark by not paying attention to the basis and conditions applicable at that time and only considering the elements of the famous mark factor. And in this study, the research object is legal norms, both in laws and regulations with related problems.

Researchers also use secondary legal materials to develop sources for this research, namely supporting legal materials that explain primary legal materials obtained from various literary sources, books or articles in scientific journals written by experts. Other legal sources such as electronic documents obtained from the internet, will be complementary to enrich the data. The nature of the research conducted by researchers and authors is descriptive analytical, which describes the provisions contained in legal theory and regulations based on legislation, namely the government in this case the Directorate General of Intellectual Property so that it issues two certificates of the same mark with different classes and the panel of judges in considering its decision cancels the same mark with different classes and sets aside Pre-existing laws and regulations are only due to well-known brand factors.

This research is Analytical Descriptive Research, which is research that describes applicable laws and regulations associated with theories of Law and Positive Law Implementation concerning the problems studied. In accordance with the title of this study and the questions to be answered, this research was conducted using normative legal research methods to achieve useful results.

The normative juridical research method is literature law research carried out by examining literature materials or mere secondary data. This research was conducted to obtain materials in the form of theories, concepts, legal principles and regulations related to the subject matter.

In his book, Dyah Ochterina Susanti explains about normative legal research according to Soerjono Soekanto including:

- a Research into legal principles.



- b Research into legal systematics.
- c Research on the level of legal synchronization vertically and horizontally
- d Legal comparison.
- e Legal history

In this study, the scope of this research will be carried out by drawing legal principles, which are carried out on written and unwritten positive laws. This research can be used to draw legal principles in interpreting laws and regulations. In addition, this research can also be used to find legal principles that are formulated both implicitly and expressly.

The data taken in conducting this research is secondary data, namely data obtained from literature or literature materials, including official documents, books, research results, reports and diaries, in addition to secondary data to support existing data as well as primary data, namely data obtained by conducting direct interviews with the Directorate General of Intellectual Property Directorate of Brands and Geographical Indications of the Ministry of Law and Human Rights which is located at Jl. HR. Rasuna Said, Kavling 8-9, South Jakarta.

For the research conducted by the author, the research data is carried out qualitatively, namely on secondary data obtained through data sources to the literature, which will be analyzed comprehensively and objectively based on existing data and those that have been obtained recognizing existing problems related to the issuance of double certificates of the super mario bros brand at the Directorate General of Intellectual Property of the Directorate of Brands and Geographical Indications.

In data collection, the data collection tool used is a literature study in order to find secondary data, which includes:

- a Primary Law material, in this case, consists of:
  - 1) Constitution of the Republic of Indonesia of 1945
  - 2) Law Number 20 of 2016 concerning brands and geographical indications
  - 3) Law No. 48 of 2009 concerning Judicial Power
  - 4) Regulation of the Minister of Law and Human Rights no 67 of 2016 concerning Trademark Registration
  - 5) Ministerial Regulation No. 12 of 2021 concerning Amendments to Ministerial Regulation No. 67 of 2016 concerning Trademark Registration
  - 6) Other implementing regulations related to this study.
- b Secondary Legal Material is data obtained from books, papers, law magazines, law journals related to the subject matter discussed in writing papers.
- c Tertiary Law materials are materials or information obtained from mass media and others that contain writings that can be used as information for this research consisting of:
  - a General Dictionary Indonesian
  - b Dictionary of Legal Terms

The data that have been obtained are then analyzed through a qualitative analysis approach, namely by observing the data obtained and linking each of the data obtained with the provisions and legal principles related to the problem under study with inductive logic, namely thinking from specific things to more general things, using normative devices, the interpretation and construction of laws and then analyzed using qualitative methods so that conclusions can be drawn with deductive methods that produce a general conclusion on the problem and research objectives.

The data collected during the field research were analyzed using the three-stage guidelines of data analysis of the Miles and Huberman model, as quoted by Sugiyono revealed that activities in qualitative data analysis were carried out interactively and took place continuously at each stage of the research to completion. The data analysis activities are data reduction, data presentation (data display) and conclusion drawing/verification.

#### 4 RESULT AND DISCUSSION

##### The Directorate General Of Intellectual Property Issues Two Super Mario Bros. Brand Certificates





Trademark registration that fully refers to the laws and regulations in the field of marks is based on the continental European legal system (civil law system) adopted by Indonesia. The competent authority, in this case, the DJKI, only refers to laws and regulations in the field of brands as a source of law that becomes a reference. For countries that adopt the Continental European legal system (Civil Law System), the main legal reference is the codification (Written Law) of laws and regulations that have been determined and promulgated by the state through state bodies or institutions authorized to do so. In Indonesia, the bodies or institutions of the state that are given such authority are the House of Representatives and the President.

The trademark registrant applicant has the right to have the right to the mark if it has fulfilled the registration requirements both administratively and substantively and approved the registration of the application after going through an examination process both administrative examination and substantive examination. There is no objection from other parties. To trademark registrants whose application is approved by the Directorate General of Intellectual Property Rights will obtain a Trademark Certificate as proof of registration of the Trademark.

Indonesia's positive law adheres to a first-to-file system that confirms that the mark does not belong to the trademark applicant but there must be an application for registration of the mark at the Directorate General of Intellectual Property in order to have exclusive rights that other applicants cannot own.

The existence of a First-to-file system, the trademark registrant applicant gets priority rights so that the trademark applied for can be recognized because it has been registered. With the registration of the trademark requested, the registrant applicant gets exclusive rights so that it can be used as a brand for goods and services published or disseminated to the wider community or transferred to other parties who want to use the mark.

Trademark registration in Indonesia is entirely based on positive law, namely by referring to the trademark law that has been passed by the government, in this case the House of Representatives and the government. Guidelines for all trademark registration starting from the terms and processes (formality checks, announcements, substantive checks, certifications), post-trademark registration management (renewal, transfer of rights, change of name and/or address, license) and deletion/cancellation of marks and settlement of trademark disputes.

Article 21 (1) letter (a) of Law Number 20 of 2016 concerning Marks and Geographical Indications states "An application is rejected if the Mark has similarities in principal or in whole with the registered Mark owned by another party or is applied first by another party for similar goods and/or services"

Similarities in essence" is a similarity caused by the presence of dominant elements between one Brand and another Brand so as to give the impression of similarity, both regarding the form, way of placement, way of writing or combination of elements, as well as the similarity of speech sounds, contained in the Brand.

Article 16 (1) An application for trademark registration cannot be registered if:

- a. contrary to state ideology, legislation, morality, religion, decency, or public order
- b. is the same as, relates to, or simply mentions the goods and/or services for which registration is requested;
- c. contains elements that may mislead the public about the origin, quality, type, size, type, purpose of use of goods and/or services for which registration is requested or is the name of a protected plant variety for similar goods and/or services;
- d. contains information that is not in accordance with the quality, benefits, or efficacy of the goods and/or services produced;
- e. has no discriminating power; and/or
- f. is a common name and/or symbol of public property.

Article 17 also explains in detail the similarities in a mark that can be refused registration, which is as follows:

1. The assessment of similarity in essence, as referred to in Article 16 paragraph (2) is carried out by taking into account the similarity caused by the presence of dominant elements between one



Brand and another Brand so as to create the impression of similarity, both regarding the form, way of placement, way of writing or combination of elements, as well as the similarity of speech sounds, contained in the Mark.

2. The criteria for determining similar goods and/or services as referred to in Article 16 paragraph (2) point a and letter b can be goods with goods, goods with services, or services with services determined based on:
  - a. the nature of the goods and/or services;
  - b. purpose and method of use of the goods;
  - c. complementarity of goods and/or services;
  - d. competition for goods and/or services;
  - e. distribution channels for goods and/or services;
  - f. relevant consumers; or g. the origin of production of goods and/or services.

The trademark law has regulated the application and substantive examination to the issuance of the trademark certificate, which is basically connected with the legal theory put forward by Hart, quoted by Ahmad Syahrus Sikti in his book Muchsin states that views that basically positivism contains various meanings, which are as follows:

- a) The law is a commandment.
- b) Analysis between legal concepts is a business that has value to be done. The analysis is different from sociological and historical studies and different from critical assessment.
- c) Decisions can be logically deduced from existing rules without necessarily pointing to social, policy, and moral goals.

In essence, the law is an obligatory norm. Obligations that lie in legal rules are juridical obligations that have the following meanings:

- First, that the juridical obligation expresses an external necessity only. The law must be obeyed because anyone who disobeys it will be punished. Thus, juridical obligations arise with legal rules in the form of external threats without any personal relationship with someone.
- Second, juridical obligations are treated as internal obligations. If so, people obey the law because they feel a necessity inside.

Legal certainty is also very important in law. Without legal certainty, people never understand whether the actions that society will do are right or wrong and without legal certainty will cause various problems, namely the emergence of unrest in society. With legal certainty, the community gets protection from arbitrary actions from various law enforcement officials in carrying out their duties in the community. Legal certainty is a benchmark in the clarity of their rights and obligations in a law. Legal certainty must be able to prioritize proof so that the law can be accounted for.

The government in this case through the Directorate General of Intellectual Wealth accepts the registration process of the Super Mario Bros Brand requested by 2 (two) different parties at different times. The parties who apply for registration of the super mario bross brand are as follows:

- First was Nintendo co.,Ltd., which originated in Japan and in 1989 the company applied for registration of the super mario bross brand in terms of "protecting goods in classes 09 and 28 with register numbers IDM000088541, IDM000088542, and IDM000088543". The legal basis used by the Directorate General of Intellectual Property to accept applications for trademark registration is in article 4 paragraph 1 of Law Number 21 of 1961 concerning Company Marks and Commercial Marks which states "that applications for trademark registration must be submitted to the office owned by the industry with a duplicate letter written in Indonesian and accompanied by:
  - a. examples of goods that bear the mark or at least information about the goods
  - b. A brand cliché in question
  - c. 10 strands of etiquette of the brand concerned".

So the application for registration of the super mario bross brand submitted by Nintendo, co., Ltd. is very accepted because the trademark has not been applied for in classes 09 and 28.

- The second is Eddy Tumewu who comes from Indonesia and on January 03, 1994 applied for the Super Mario Bros brand registration with register number 331295 to "protect goods in class 25. The types of items protected in class 25 are all kinds of apparel for men, women and children, socks, ties, hats, gloves, belts, shoes, slippers, shoe soles, veils, supporters, headbands, wristbands, knee protectors". So that the application was accepted by the Directorate General of Intellectual Property based on Law number 19 of 1992 concerning marks because there was no trademark registrant applicant in class 25 submitted by the applicant in this case Eddy Tumewu.

The trademark registration application is always based on *first to file* so that for applications submitted by other parties, there is a basis for rejection, but because it is based on Law number 19 of 1992 concerning trademarks because there is no applicant, registrant and the Directorate General of Intellectual Property in conducting examinations, of course, must pass a formality and/or substantive examination in order to obtain approval and Protection of the mark because by applying, it becomes the basis of good faith for substantive examination.

2. The panel of judges considered the registered Super Mario Bros brand

The Supreme Court gave the following considerations:

- The plaintiff is the owner of "SUPER MARIO BROS" + paintings of Mario and Luigi characters and their variants for goods and services in classes 03, 05, 08, 09, 10, 12, 14, 20, 28, 35, 36 and 41, which have been registered in several countries since 1986, including in Australia, India, Malaysia, Bahamas, Canada, Philippines, Singapore, and others;
- That Defendant II applied for registration of the Super Mario Bros. mark on January 3, 1994, which was then registered on April 11, 1995, under Reg. Number 331295 to protect goods in class 25;

The results of interviews in Brand and Geographical Indications confirmed that:

- First was Nintendo Co.,Ltd., which originated in Japan and in 1989 the company applied for registration of the super mario bross brand in terms of protecting goods in classes "09 and 28 with register numbers IDM000088541, IDM000088542, and IDM000088543". The legal basis used by the Directorate General of Intellectual Property to accept applications for trademark registration is in Article 4 paragraph 1 of Law Number 21 of 1961 concerning Company Marks and Commercial Marks, which states "that applications for trademark registration must be submitted to the office owned by the industry with a duplicate letter written in Indonesian and accompanied by:
  - a) examples of goods that bear the mark or at least information about the goods
  - b) A brand cliché in question
  - c) 10 strands of the etiquette of the brand concerned"

So the application for registration of the super mario bross mark filed by Nintendo, co., Ltd. is very welcome because the trademark has not yet been applied for in classes 09 and 28.

- The second is Eddy Tumewu, who comes from Indonesia and on January 3, 1994 applied for registration of the Super Mario Bros brand with register number 331295 to protect goods in class 25. The types of items protected in class 25 are "all kinds of apparel for men, women and children, socks, ties, hats, gloves, belts, shoes, slippers, shoe soles, veils, supporters, headbands, wristbands, knee protectors". So that the application was accepted by the Directorate General of Intellectual Property based on Law number 19 of 1992 concerning marks because there was no trademark registrant applicant in class 25 submitted by the applicant, in this case, Eddy Tumewu.

The next considerations are as follows:

- That when juxtaposed with Plaintiff's SUPER MARIO BROS + PAINTING with Defendant's SUPER MARIO BROS brand, there is an overall similarity between the two models;
- That there is a dominant resemblance either in form, manner of placement, writing or combination of elements between the Claimant's Mark and the Plaintiff's mark;
- That, in terms of the utterance of the word Super Mario Bros", there is a similarity in the sound or utterance of the Defendants' Marks with the pronunciation of the Plaintiffs' marks. Only the





- form of writing and colour is different, Plaintiff uses blue, while Defendant uses red colour, but the way the sound and speech are the same, namely 'Super Mario Bros';
- That the use of paintings with the characters "Mario and Luigi there is a similarity between the Plaintiffs' Marks and the Plaintiff's merek, where the Defendants' Marks use a combination of red wama on hats, blue shirts and green colours, etc
  - That it is thus reasonably suspected that the Defendants registered the mark "Super Mario Bros" Number IDM000007313 in class 25 with the intention to imitate, plagiarize, or follow the Plaintiff's "Super Mario Bros" Mark for the benefit of its business unfair business competition conditions, deceive, or harm consumers;
  - That since it is proven that the Defendants registered their marks in bad faith, as stipulated in Article 77 of Law Number 20 of 2016 or Article 69 paragraph (2) of Law Number 15 of 2015 that claims for cancellation of trademark registration can be filed indefinitely;

From the above considerations, it can also be seen in paragraph (2) of Article 6 bis of the Paris Convention in essence, determines the period for applying for trademark cancellation with at least 5 (five) years from the date of registration of the mark concerned. However, in paragraph (3) itself, it is added that there is no period of time to request cancellation or prohibition of the use of marks that have been registered or used in bad faith. In relation to the provisions of Article 6 bis of the Paris Convention, there are regulations regarding marks in Indonesian law which are regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications. If it is related to the time of the first application, then the law has allowed the application to be accepted, so there is no legal certainty on this consideration.

In the context of the Indonesian legal state, laws and regulations as a written norm (law) become the basis for state administration and as a guideline for organizing the government. Every product of laws and regulations must be a reflection of Pancasila and the Constitution.

In the legal system in force in Indonesia, laws and regulations rank first in the application and enforcement of the law. Laws and regulations can only be set aside by judges if their application will lead to violations of the fundamentals of justice or are no longer in accordance with social reality or because, in certain societies, other laws and regulations apply in reality outside the laws and regulations (such as customary law and religious law).

The first to file system requirement applied to each registrant must also apply the principle of good faith to the registered mark as Article 21 point (3) of the Trademark and Geographical Indication Law states related to the requirements that must be registered with the Directorate General of IPR, namely: "An application is rejected if it is submitted by an applicant in bad faith. The provisions of Article 21 paragraph (3) of the Law on Marks and Geographical Indications in the Constitutive registration system but still protect owners in good faith. Only requests made by brand owners in good faith are acceptable to register. Thus, the aspect of legal protection is still given to brands in good faith. The explanation of Article 21 point (3) of the Law on Marks and Geographical Indications states the qualifications of owners in good faith, one of which is the owner of a well-known brand who can be known with basic knowledge of the public in recognizing the brand in the business field.

The judge's consideration of the super mario bross brand is only based on law number 20 of 2016 concerning Marks and Geographical Indications. Still, it does not look at the basis of previous laws and regulations, thus ignoring the non-retroactive principle, which in its understanding, is a principle that states that a law cannot be retroactive. This means that laws and regulations can only take effect after they are enacted or passed as law. Until the law is passed, legal events that occurred before it are not subject to the law.

The judge in considering the super mario bros brand then if it is related to the Ikea case with its decision Number 264/K/PDT. SUS-HKI/2015, which is basically a famous brand, is inversely proportional to the decision of case Number 650 K/Pdt.Sus-HKI/2021 because it is not based on a famous brand but is based on a first-to-file system.

Early Lumopa et al stated that in registering Intellectual Property Rights (IPR), Trademark Rights are special rights. These special rights are basically exclusive and monopolies that are only exercised by the rights owner, while others may not use without the owner's permission. Trademark registration

is a mark can only be registered on the basis of a request submitted by the owner of a trademark in good faith or known as the principle of Good Faith. Although the government has applied the principle of good faith, it regulates the procedure for registration of a mark that must be rejected and cannot be registered as well as legal protection for the owner of the registered mark.

Based on this good faith assessment, Wirjono Projodikoro argues that the definition of good faith according to article 1338 (3) BW is an objective and dynamic sense. So good faith here is dynamic that pervades the entire trademark application and registration process. Good faith in the sense of being dynamic also means that one party must not harm the other party or must not use the negligence of the other party to benefit himself, because honesty must run in the heartstrings of the party applying for and registering a trademark.

## 5 CONCLUSION

An application for registration of the same and non-similar marks requested by more than one party can be accepted by the Directorate General of Intellectual Property if the trademark applied for is not a well-known mark. Indonesia's positive law adheres to a first to file system that confirms that the mark does not belong to the trademark applicant but there must be an application for registration of the mark at the Directorate General of Intellectual Property in order to have exclusive rights that cannot be owned by other applicants and also for the mark applied to get protection against the registered mark is Preventive protection and Repressive Protection

The judge's consideration of the super mario bross brand is only based on law number 20 of 2016 concerning Marks and Geographical Indications, but does not look at the basis of previous laws and regulations, thus ignoring the non-retroactive principle, which in its understanding is a principle that states that a law cannot be retroactive. This means that laws and regulations can only take effect after they are enacted or passed as law. Until the law is passed, legal events that occurred before it are not subject to the law.

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