

Cumulative Claims in Mark Disputes under Civil Procedural Law as it relates to Protecting Against International Marks

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In the global trade era, in accordance with the ratified international conventions, Marks play essential roles, particularly in sustaining fair and equitable business competition. This requires adequate regulation of the brand in order to provide improved services to the community. Regulations on Trademarks in Indonesia are currently regulated in Act Number 20 of 2016 concerning Marks and Geographical Indications (UUM). In addition, national regulation concerning marks, Indonesia is also bound by international regulations on marks such as the Paris Convention. Trademark protection is essential because marks as Intellectual Property Rights can generate economic benefits to the owners of the property rights, and can also work as a tool to protect public consumers from the occurrence of fraud. Related to the cancellation of a trademark according to the UUM, entered into the absolute competence of the Commercial Court. Based on Article 300 paragraph (1) of Law Number 37 of 2004 concerning Bankruptcy and PKPU, the Commercial Court is not only authorized to examine and decide on bankruptcy and PKPU cases, but also to handle disputes in other commercial fields such as IPR. Based on Article 68 of the UUM, claims for the cancellation of trademarks are filed to the Commercial Court. With the cancellation of marks, the legal protection of the mark concerned is terminated. Related to the claim for trademark infringement, according to Article 76 UUM, the registered trademark owner can file a claim in the form of compensation and/or in the termination of all acts related to the use of the mark. In the case of drafting a lawsuit in trademark disputes, the legal issues to be examined in the filing of a lawsuit in a trademark dispute includes the claim for cancellation of trademark and the claim for trademark infringement according to the perspective of the Formality Civil Code.

Key words: *Cumulative claims, trademark dispute, blurred lawsuit (obscuur libel).*

A. Introduction

1. Background of the study

In the global trade era, in accordance with the ratified international conventions, Marks and Geographical Indications play essential roles in sustaining fair, equitable business competition, consumer protection, as well as protection for domestic Micro Small Medium Enterprises and Industries (Indonesia, Law of the Republic of Indonesia Number 20 of 2016).

Trademark means any Mark used for goods traded collectively to identify a product or company on the market. Entrepreneurs will usually prevent others from using their marks because it is through this mark that entrepreneurs develop their reputation and the trust of their consumers (Lindsey et al., 2013). Thus, the mark is essential in trade because it is related to the image, quality, and reputation of an item or service. Additionally, trademarks are often more valuable than the value of the goods or services, and marks become commercially valuable wealth. The mark is also very useful for consumers, because the mark indicates quality and reputation, and thereby protects consumers from fraud by people or companies with poor or low quality products.

Trademark rights are intellectual property rights protected by law. Regulations on trademarks in Indonesia were first stipulated through Act Number 19 of 1992 and amended by Act Number 14 of 1997 concerning Amendment to Law Number 19 of 1992 concerning Trademarks. After Indonesia ratified the membership of the WTO through Law Number 7 of 1994, further provisions regarding trademarks were adjusted to TRIPs through Law Number 15 of 2001 on Trademarks, which was finally revoked and replaced with Law Number 20 of 2016 concerning Trademarks and Geographical Indications (Zen, 2005).

Article 1 paragraph (5) of the UUM states that Right on Mark means the exclusive right granted by the State to a registered Mark owner for a definite period to use his/her Mark or authorize others. Registering a trademark will give the entrepreneur exclusive rights to a name or symbol. Therefore, the registration of a mark shall fulfil the provisions as regulated in Article 20 and Article 21 of the UUM.

According to Article 20 of the UUM, trademarks cannot be registered if the mark (Indonesia, Law of the Republic of Indonesia Number 20 of 2016) is similar to, related to, or merely mention the goods and/or services being applied for registration. In addition, according to Article 21 of the UUM an Application is refused by the Directorate General of IPR if the Mark is substantively similar to or identical with another (Indonesia, Law of the Republic of Indonesia Number 20 of 2016).



Based on these provisions, the category of a mark that can be registered is that the mark must have a distinguishing power. Therefore, if there is a mark that meets the provisions of Article 20 and Article 20, a claim for mark cancellation can be filed by the parties concerned based on the provisions of Article 76 paragraph (1) of the Law. In regards to other parties who unrightfully use a mark that is similar in principle or in whole for goods and / or services, mark infringement claims can be filed according to the provisions of Article 83 paragraph (1) of the Law on civil law. In this obvious case, the owner can file a claim for compensation to the Commercial Court for the loss he has suffered and can request that the Commercial Court order the termination of all acts relating to the use of the mark.

With regard to the cancellation of a registered mark allegedly violating the provisions of Article 20 or 21, and at the same time a claim for the material and immaterial losses suffered, according to the perspective of the Civil Procedure Code, documents can be filed through the cumulation of the claim, which is the cumulation of an objective claim. In the civil procedure, if there is a connection between the claims that are merged into one, the merger of the lawsuit will facilitate the process and avoid the possibility of conflicting decisions so that the cumulation of the claim (*samenvoering*) is justified according to the *doelmatig process* (Soepomo, 1993).

In practice, objective claims have been conducted in cases between PT. Krakatau Steel as the Plaintiff and Ir. Goh Ka Thioe as the defendant, who was questioned at the Central Jakarta Commercial Court on February 26, 2019. Considering that from the perspective of formal civil law, it is possible to submit a cumulative claim, whether it can be applied in trademark disputes still requires an in-depth study.

2. Research Problems

The main issues in this study: How can the filing of a lawsuit in a mark dispute that includes a claim for cancellation of a trademark and a claim for trademark infringement be understood from the perspective of Civil Law?

B. Research Method

Empirical legal research is a research method that uses empirical facts taken from the field in court, both obtained from interviews and direct observations of brand matters. The three data collection techniques in empirical legal research were used individually, separately, and together at the same time. The technique comprised interviews and questionnaires.

C. Discussion and Analysis

Filing a Lawsuit in Mark Disputes which Include Mark Cancellation and Trademark Infringement Laws according to the Formal Civil Law Perspective

1. Claims for Rights Disputes on Marks

Mark rights are material rights, which can be defended against anyone. As a sign that the mark rights are absolute rights, the law is granted by the law to the holders of the rights to the mark, in addition to criminal charges against those who violate these rights.

The main purpose of mark management is to protect the business and prevent others from using the reputation of a person or company. The protection provided by UUM is to protect the interests of business actors against mark violations.

According to Article 76 paragraph (1) of the UUM, claims for the cancellation of trademarks may be filed by interested parties based on the reasons stated in Article 20 and / or Article 21. In Article 77 paragraph (1), the UUM states that claims for the cancellation of trademarks may only be registered within a period of 5 (five) years from the registration of the mark. Whereas a claim for the cancellation of a mark may be filed indefinitely if the mark concerned is contrary to morality, religion, decency or public order as referred to in Article 77 paragraph (2) of the Law.¹

With the issuance of the Commercial Court decision, which decides the trademark cancellation lawsuit and after the decision has permanent legal force, the Directorate General of Intellectual Property Rights will carry out the cancellation of the mark registration concerned from the General Register of Marks and announce it in the Official Gazette of Marks. Furthermore, the cancellation of the registered the mark shall be made in writing to the holder of the trademark right by stating the reason and that the certificate of the said mark is no longer valid. Crossing the registration of a mark from the General Register of Marks shall be announced in the Official Gazette of Marks. Cancellation and deletion of trademark registration results in the termination of legal protection for the mark concerned (Saidin, 2015).

The claim can be submitted to the Commercial Court based on Article 76 paragraph (3) of the UUM. The establishment of the Commercial Court as a court that resolves disputes over trademark rights, has the absolute authority to receive, examine and decide on civil disputes cases.

¹ See Law Number 20 of 2016 concerning Marks and Geographical Indications, Article 76 and Article 77.

As for violations of trademark rights according to the UUM, a civil suit can be filed, which can be categorized into two things, namely Unlawful Acts (onrechtmatige daad) based on Article 1365 of the Civil Code, and breach of default if the violation involves a licensing agreement that occurs when the parties do not meet the stipulations of the agreement, and thus violate the provisions of Article 1234 of the Civil Code.

In the event of a trademark violation, there are 2 (two) types of examination of the trademark infringement case, namely that the plaintiff must be able to prove that the defendant's mark (Lindsey et al., 2013):

1. Has similarities in principle to the brands owned by the plaintiff or
2. Equations that mislead consumers when buying a defendant's product or service.

The principle similarities between brands is determined by comparing the two brands, noting the similarities and differences, and attending to the important characteristics that arise. If the two brands are the same or almost the same, then the trademark violation is considered to have occurred.

According to Article 83 paragraph (1) of the Law, there are 2 (two) forms of claim that can be submitted to the Commercial Court, namely:

- a. Compensation suit;
- b. Termination of all acts related to the use of the mark.

The claim for compensation can be in the form of material and immaterial damages. Material compensation is in the form of a real loss suffered by the plaintiff (the holder of the trademark rights) which can be valued in money. For example, due to the unauthorized use of the brand, the products belonging to the rights holders of the brand become sold a little because, in the market, circulating goods with similar brands are not original (fake). While immaterial compensation is caused by unauthorized use so that the right-holder of the brand suffers a moral loss. For example, these other parties produce goods with low quality so that consumers no longer want to use manufactured goods made by holders of these trademark rights. (Saidin, 2015)

2. Incorporation or Cumulative Claims in Trademark Rights Disputes

A claim for trademark infringement can occur when a registered mark belonging to another party has in common the principle or whole of a trademark that has been previously applied for by another party for similar goods and / or services, as referred to in Article 21 paragraph (1) of the Law. In the elucidation of Article 21 paragraph (1), the UUM referred to equality in essence as the resemblance caused by the existence of a dominant element between one brand and another, which gives rise to the impression of equality, both regarding the form, method of placement, method of writing, or the combination between the elements, as well as the



equation of sound, which is contained in the brand (Indonesia. Undang-Undang Republik Indonesia Nomor 20 Tahun 2016).

Regarding the similarity in essence, this is also confirmed in the MARI Jurisprudence in Decision number 279PK / Pdt / 1992 dated January 6, 1998 which states that the brands used are the same as a whole or have similarities in principle, which can be described as follows : similarity of form; similarity of composition; similarity of combination; similarity of elements; similarity of sound; phonetic similarity; or similarity in appearance.

In the event of a dispute over trademark rights, according to Chapter XV UUM concerning Settlement of Disputes, a claim for infringement of trademarks referred to in Article 83 may be filed. In addition, claims for the cancellation of registered trademarks can also be carried out by interested parties as stipulated in Article 76 of the UUM .

From the perspective of Formal Civil Law, namely Civil Procedure Law, a merger of claims may occur. This is called a cumulation of a claim that is the merging of more than one law suit into one lawsuit. The cumulative lawsuit is not regulated in the *Herzeine Inlandsch Regulations (HIR)*, or the *Recht Voor de Buiten Gewesten (RBg)*, but is regulated in Articles 134 and 135 of the *Op de Rechtvordering (RV)*, as well as in doctrine and jurisprudence. A cumulative lawsuit in Dutch is called *samenvoeging van vordering* (Sutantio dan Iskandar, 2005).

In principle the merging of several lawsuits into one happens if there is a close and fundamental nature or there is connectivity between the lawsuit-merged. This was confirmed in the decision of Raad van Justitie (third room) Jakarta in its decision on June 20, 1039. This close relationship must be proven based on the facts that reflect the close and fundamental relationship between two factual claims (*een feitelijke vraag*) (Mulyadi, 2005).

The merger of more than one lawsuit occurred because of the connection between one another. The cumulation of a claim can be justified if there is a close relationship between the claims that can facilitate the examination process. The accumulation of a lawsuit can also avoid the possibility of conflicting sentences, and the cumulation of a claim like this is considered useful in terms of Civil Procedure Law (Asikin, 2016).

According to Prof. Z. Asikin Kusumah Atmaja in his commentary on MARI Decision Number 885K / Pdt / 1985 dated July 30, 1987, the merger of a lawsuit always took place with the initiative of one the parties. However, in Article 9 of the Draft Bill on the Civil Code, the cumulative claim can be made by the Chair of the District Court because of his position (*secara ex officio*) (Mamudji, 2005). Generally, to combine lawsuits handed down in interim decisions are called incidental decisions.

Some jurisprudence regarding the merging of claims (cumulative claims):

- 1) MARI Decree No. 1043.K/Sip/1971 dated December 3, 1974;²
- 2) MARI Decree No. 677.K/SIP/1972 dated December 13, 1972.³
- 3) MARI Decree Nomor 880 K/Sip/1973 dated May 6, 1975.

In general, each lawsuit must stand alone. The combination of lawsuits is only allowed as long as it is still within certain limits. There are 2 (two) basic requirements for the merging of a claim, as follows (Asikin, 2016):

- 1) There is a close relationship.

According to Soepomo in his book Civil Procedure Law, the District Court stated that between the combined claims there must be an inner connection (*innerlijke samenhang* or *connexiteit*) (Soepomo, 1993).

- 2) There is a legal relationship between the plaintiffs or between the defendants. If the subjective cumulative claim is submitted by several people, or if there is no legal relationship at all, the claims must be filed separately and individually.

In a merger or cumulation of a lawsuit there are 2 (two) types) (Asikin, 2016):

- a. Subjective cumulation, which involves parties comprising more than one person. The law does not prohibit plaintiffs from filing lawsuits against several defendants (Article 127 HIR, 151 RBg, Articles 1283-1284 Civil Code and Article 18 WvK). This means that the plaintiff or several plaintiffs sued several defendants. The requirement for subjective cumulation is that the claim must have a close legal relationship between one defendant and the other defendant (connection relationship), if there is no connection, it must be conducted separately.
- b. Objective cumulation is the merging of several demands in one case at a time (merging object demands).

In order to merge lawsuits, several restrictions must be considered in Article 102-105 Rv. The things that must be considered in the objective combination are as follows (Maru, 2019):

1. Judges do not have the relative authority to examine a single claim brought together in a lawsuit.
2. One specific claim requires a special lawsuit, while other claims are examined according to ordinary procedural law. The example of a divorce suit in the District Court is settled according to the Marriage Law with a special event, while the claim in the event of a breach

² See Decision of the Supreme Court of the Republic of Indonesia Number 1043.K / Sip / 1971 dated December 3, 1974.

³ See Decision of the Supreme Court of the Republic of Indonesia Number 677.K / SIP / 1972 dated December 13, 1972.



of contract in the agreement is examined according to the usual procedural law namely the Civil Code.

3. Claims concerning bezites must not be filed together with demands regarding eigendom in a lawsuit Article 103 Rv.

Based on the description above, in the trademark dispute, an objective claim cumulation can be submitted when the merging the object of the claim with the claim for trademark cancellation as regulated in Article 76 paragraph (1) and the trademark infringement suit regulated in Article 83 paragraph (1) of the UUM, which asks for compensation for both material and immaterial. In this case the merger of the object of a lawsuit is permitted as long as it is within the scope of the authority of the Commercial Court, and the procedural law used is a special procedural law as regulated in Act Number 20 of 2016 concerning Marks and Geographical Indications. Besides that, based on systematic interpretation, between Article 76 and Article 83, there are no conflicting provisions, and also there is no prohibition on combining the use of the provisions in the two articles, so that the lawsuit cancellation and trademark infringement claims should be set forth in one claim letter bearing in mind that the case and the parties are the same.

D. Conclusion

Based on results obtained in this line of research, it is therefore concluded that the filing a claim in a marks dispute that includes a claim for cancellation and a claim for trademark infringement is, according to the perspective of a Formal Civil Law, possible through objective cumulative lawsuits. Cumulation of an objective lawsuit is the merging of several claims in one case at a time (merging the object of demand). The main requirement in the cumulation of a claim is that there is a close relationship and a legal relationship. The benefits and objectives of merging lawsuits are to bring about simple, quick and low-cost justice, and to avoid conflicting decisions.



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