

Settlement of Legal Disputes Against Rights Holders of the Famous Brand "Bensu" Based on the First to File Principle

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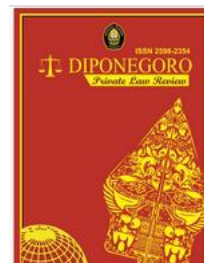
ABSTRACT

In Indonesia there have been many legal cases related to famous trademark rights disputes, one clear example is the existence of a famous trademark dispute with the name bensu. This creates problems with Law Number 20 of 2016 concerning Brands and Geographical Indications which adheres to a constitutive system. The writing of this article aims to find out how the legal provisions and legal dispute resolution against the rights holders of the famous brand Bensu. The writing of this article uses a normative juridical approach with a descriptive method, and analysis using literature studies. The result of writing the article was that the lawsuit filed by Ruben Onsu against Jesy Handalim was not accepted by the panel of judges. And the trademark registration system in Indonesia adheres to the principle of *first to file principal* where the first registrant gets exclusive rights and legal protection.

Keywords: First To File Principal, Famous Brand Rights, Legal Protection

INTRODUCTION

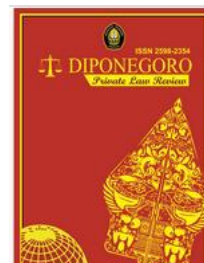
Brands play a very important role in the goods and services industry because brands are not only used as product identification in the form of goods or services, but also as a business strategy tool in order to win the currently competitive business competition. Therefore, there is a need for a

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regulation that can provide guarantees of protection and legal certainty, especially in the field of brands. Currently it has been regulated in Law Number 20 of 2016 concerning Brands and Geographical Indications so that it can protect all economic actors in Indonesia and can create healthy business competition. As a result, if a well-known mark or famous name wants to be made a trademark, it must be registered because if it does not have juridical legal force, it has a detrimental impact on the owner because it does not have exclusive protection and rights.

If the product brand (goods and / or services) is included in the category of well-known brands, usually the brand will become the target or toughest rival for some entrepreneurs or producers, which makes them compete unfairly, namely by making brands that are similar or even exactly the same as well-known brands and trading goods and / or services using the brand as if it were his. Because if a person has been categorized as a well-known brand, usually consumers can find out the shape and quality of a product (goods and / or products) just by seeing, reading or hearing related famous brands. As happened in the dispute between a famous person, namely ruben onsu and Jesy Handalim, the owner of a café and bar called Bengkel Susu, abbreviated as Bensu. Ruben Onsu filed the lawsuit on the basis that Ruben's geprek bensu business was hampered because it failed to register the trademark with the Directorate of Trademarks, Directorate General of Intellectual Property Rights (DJKI) at the Ministry of Law and Human Rights. The reason is someone has registered the Bensu brand before Ruben. The first bensu name holder registered is Jesy Handalim holding a Bensu brand certificate with IDM000622427 number which was declared registered since June 7, 2018, and will expire on September 3, 2025. The trademark registration was carried out on September 3, 2015, From World Intellectual Property Organization data integrated with DJKI Brand Directorate data, Jessy Handalim is located in Bandung, West Java. Ruben Onsu insisted on the name of the bensu because he had obtained the decision of the South Jakarta District Court, which in the end the South Jakarta District Court through Determination Number: 384 / Pdt.P / 2018 / PN. Jkt.Sel. has determined, one of which is: "Declaring

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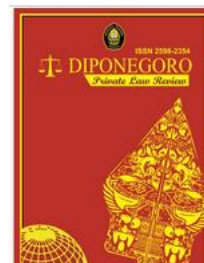
that it is valid and has legal force to determine the name BENSU is an abbreviation of the name of Ruben Samuel Onsu aka Ruben Onsu."

In essence, Indonesia itself adheres to the first registrant system also called the first to *file principle*. That is, the registered brands are those that qualify and as the first. Then the registration system changed to first to file. That is, in the legal system of brands. Indonesia adheres to and implements a *first to file system*, which means, whoever registers first, then he is the one who is eligible. In contrast to the United States and Canada which use the (Kusumah, 2022) *First To Use system*, which is a protection system that gives exclusive rights to the first commercial user of a mark in a certain region, even though the user of the mark has not applied for registration in using the mark commercially. This is provided for in Sections 1(a) and 1(b) of The Lanham Act, 15 U.S.C. §§ 1051, under which applications for a mark in the United States may be filed based on the first commercial use of the mark or the intention of future use of the mark.

Based on the background of the above issues, this article will discuss about: (i) how the legal provisions regarding famous trademark rights in Indonesia; (ii) how to resolve legal disputes against Bensu famous trademark rights holders based on the principle of *first to file principal*.

The case studies that the author discusses in this journal certainly cannot be separated from some previous research which we made for study materials and comparisons from some of these journals. The study compared three previous studies, including the following:

1. Research by Bayu Saputra and Widhi Handoko (2023) entitled "Legal Protection of Registered Famous Marks (Case Study of Decision Number: 206/G/2020/PTUN. JKT)". This article focuses more on the issue of legal protection of marks due to the legal consequences of marks that have been registered the same as other marks. The research method used in writing this article is normative juridical research. (The Gospel and the Hand of the Devil, 2023)
2. Research by Dendy Widya Chandra, Budi Santoso, Novira Maharani Sukma (2020) entitled "Protection of Foreign Famous Brands That Have Not Been Registered in Indonesia (Case Study of KEEN Brand Disputes)". The focus of the research study is to find out whether

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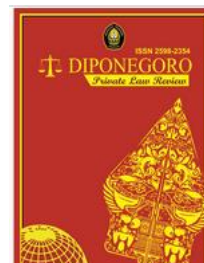
foreign famous brands that are not registered in Indonesia are protected and how long the period for cancellation of registration of marks registered in bad faith. This study used normative juridical methods. (Dendy Widya Chandra, dkk 2020)

3. Research by Fatmawati and Aminah (2023) entitled "Legal Protection of Brands for MSME Actors in Indonesia". The focus of research in the article is to find out efforts to provide brand protection to MSMEs with research results showing that brands are one of the rights protected from IPR. The research method used in writing the article is normative juridical. (Fatmawati & Aminah, 2023)

This article has differences with some of the articles mentioned above. The author's research article is entitled "Legal Dispute Resolution Against Benu Famous Brand Rights Holders Based on *First to File Principal Principles*". The focus of research studies is more focused on issues regarding legal provisions and resolving legal disputes against famous trademark rights holders. This study used normative juridical methods. When compared with the three journals above that have been conducted previous research, in terms of title, and study focus has clear differences, so this research is not the result of plagiarism.

METHOD

This legal research uses normative juridical methods or doctrinal legal research, which is an approach by exploring library materials or secondary data information, then analyzed according to the point of view of laws and norms that are in harmony with existing problems. This research emphasizes descriptive analytical, which looks at theories that are relevant and associated with positive laws that apply, as well as the application of practice that is consistent with the problems in this article. For the material that is the source and data used in this legal article is secondary data obtained from combining existing legal materials, namely primary legal materials, secondary legal materials, and tertiary legal materials. The data collection technique in this article uses library research

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which means that research is carried out by examining existing scientific articles as library material (secondary data). (Fajar & Ahmad, 2017)

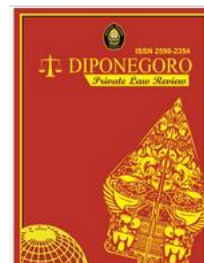
Data analysis techniques use normative qualitative, namely data that has been obtained and then systematically researched, and conduct analysis using normative qualitative methods with the aim of obtaining clarity from the problem under study. The purpose of choosing this analysis is to obtain various perspectives on the application of legal protection to famous trademark rights holders in order to maintain healthy business competition in Indonesia. As stipulated in Law Number 20 of 2016 concerning Brands and Geographical Indications, so as to get an overview of legal regulations related to the issue of applying legal protection to famous brands in Indonesia.

RESULTS AND DISCUSSIONS

Legal Provisions Regarding Famous Brand Rights in Indonesia

Products with well-known brands will be easier to market, so they can be more easily sold and provide greater financial benefits. The definition of a well-known Mark is, if a Mark has circulated outside regional boundaries to international boundaries, where it has circulated outside its country of origin and is evidenced by the registration of the relevant Mark in various countries. Thus, legal protection is needed for Famous Brand Rights to ensure legal certainty for brand inventors, brand owners and trademark rights holders. In addition, it is also to prevent violations and crimes against Trademark Rights and provide benefits to the community so that the public is more encouraged to make and take care of trademark registration. (Marzuki, 2010)

The legal use of famous brands in Indonesia is an important element of fundamental similarity, the opinion of this element expressed by Beverly W. Pattishall in her writing states that the factors that can be a benchmark for knowing the existence of fundamental similarities are as follows: (a) Parallelism of appearance (Similitude of Appearance); (b) Foreign Words (Unfamiliar Terms); (c) Closeness of Meaning; (d) Word and Picture Imprints; (e) Parallelism of Closeness of Sound.

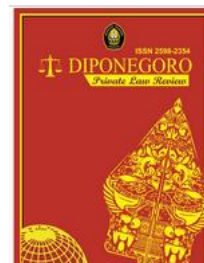
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The application of legal protection for popular brands, institutions that are at the forefront are the DJKI, district courts, the supreme court and the owners of well-known brands that have been registered themselves. Each of these institutions certainly has its own role. DJKI's role is to filter brands that have a fundamental resemblance to famous marks when registering new marks through institutional data banks, district courts, especially commercial courts have a role to decide fairly and thoroughly if there are cases with elements of fundamental similarity, the supreme court acts like a district court but at a higher level and a stronger decision later, Finally, the owner of the famous brand itself has a role to oversee the newly registered brands.

For well-known brands, the protection provided for these marks is carried out in two ways, namely preventive legal protection and repressive legal protection.

The Trademark Law protects Wellknown Marks, where a trademark application will be rejected if it has similarities in principal or in whole with a Famous Mark for similar goods and/or services. Legal protection of Famous Trademark Rights in Indonesia is regulated based on Law Number 20 of 2016 concerning Marks and Geographical Indications, precisely in Article Article 21 paragraph (1) letter b and c, Article 83 paragraph (2), and strengthened by the Explanation of Article 21 paragraph (1) point b, Explanation of Article 76 paragraph (2), and Explanation of Article 83 paragraph (2). Indonesia adheres to a trademark registration system with a constitutive system. This system requires registration of a Trademark so that a Mark can get protection, this system is also known as the *first to file system*. This system confirms that the person who first registers the Mark, then he is the one who is entitled to the rights of the Mark. Although Indonesia adheres to trademark registration based on a constitutive system, the protection of well-known marks that have not been registered in Indonesia will still get protection, because Indonesia has ratified the Paris Convention and the World Trade Organization's TRIPS Agreement (TRIPS). Based on the provisions of Article 21 paragraph (1) letter b and c "The application is rejected if the Mark has similarities in principal or in whole with: b. Famous brands owned by other parties for similar goods and/or

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services; c. Other parties' well-known marks for non-similar goods and/or services that meet certain requirements.

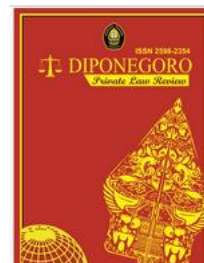
Refusal of trademark registration related to preventive protection of famous marks needs to pay attention to the element of bad faith, in the sense that registrants who are not owners of Famous Marks deliberately in bad faith want to take advantage of the fame of other people's Famous Marks, take advantage of the promotion of Famous Marks for their own benefit free of charge. Repressive protection is given to a person if there has been a violation of trademark rights. Registered trademark owners receive protection for infringement of rights to their trademarks, both in the form of compensation claims (and claims for cancellation of trademark registration) or based on criminal lawsuits through law enforcement officials.

This brand regulation is intended to provide effective protection to prevent all forms of infringement in the form of plagiarism, use of the same name, profiteering of names, or domain names of a brand.

Settlement of Legal Disputes Against Benu Famous Brand Rights Holders Based on First to File Principal Principle

Products with well-known brands will be easier to market, so they can be more easily sold and provide greater financial benefits. The Trademark Law protects Wellknown Marks, where a trademark application will be rejected if it has similarities in principal or in whole with a Famous Mark for similar goods and/or services. The enactment of the Trademark Law in Indonesia matters related to profiteering, stacking, the use of names and domain names on a well-known brand is a big enemy for the development of a company's industry. (Dharmawan & dkk, 2016)

In the case of the dispute between Ruben Onsu's famous name and Jesy Handalim, the owner of a dairy workshop who uses the abbreviated name Benu. Ruben Onsu with his PT named PT. Onsu Pangan Perkasa feels aggrieved because the brand is managing brand rights to their products such as Benu Sosis, Benu Bakso, Benu Nugget, Geprek Benu, Benu otak-otak, Benu Drink, and Lukisan . However, the status of the application was delayed because Benu's name was first used and registered at the director general of IPR in the name of Jesy Handalim who

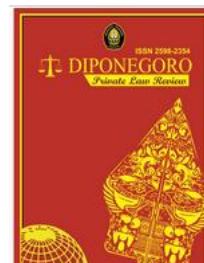
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was registered. This is detrimental to PT. Onsu Pangan Perkasa because the owner is a well-known public figure, and his name has also received confirmation from the South Jakarta District Court so that the owner Ruben Onsu filed a lawsuit at the Central Jakarta Commercial Court. In the petition petitum, Ruben Onsu demanded the Central Jakarta Commercial Court Judges to cancel the Benu mark registered by Jesy Handalim, besides that Ruben Onsu also demanded to declare that Benu is an abbreviation of a famous person's name, aka his own name and declare the plaintiff's Geprek Benu brand (Ruben) is a famous brand. (Abdurahman, 2020)

As time goes by on February 7, 2019 the Central Jakarta Commercial Court declared the Plaintiff's (Ruben Onsu) claim not when accepted, arguing that as stipulated in Law Number 20 of 2016 concerning Marks and Geographical Indications (MIG Law), the Plaintiff should first take the mechanism of Appeal to the Minister, and wait for the appeal decision from the trademark appeal commission, and if in the end it is decided to reject the appeal, then the Plaintiff took the lawsuit to the Commercial Court. In other words, the trademark cancellation lawsuit filed by the Plaintiff (Ruben Onsu) in the Commercial Court is PREMATURE. So the non-acceptance of the lawsuit implies that Jesy Handalim is the holder of Benu trademark rights and there are exclusive rights for registrants for the mark, in addition to providing an explanation to the public that in Indonesia applies the *principle of first to file principal* in trademark registration in Indonesia, so that the constitutive system used is not a declarative system, this is what is referred to in Law Number 20 of 2016.

Although the Plaintiff (Ruben Onsu) postulates that his name is a well-known name and his product is a well-known product, it has not been registered in accordance with the provisions of the applicable legislation so juridically this cannot be considered a well-known brand. In fact, Article 21 paragraph 2a of Law Number 20 of 2016 explains that the Director General of Intellectual Property (DJKI) must refuse trademark registration if it is a name or abbreviation of a famous person.

That thus even though the name Benu has received confirmation from the South Jakarta District Court on the name attached to the name of Ruben Samuel Unsu aka Ruben Onsu, and Benu has been a stage name

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since 2006, this is not used as a basis, because in the Trademark Law in Indonesia adheres to a constitutive system where the principle of *first to file principal* that is held, so that the first registeree holds exclusive and appropriate rights to legal protection. (Abdurahman, 2020)

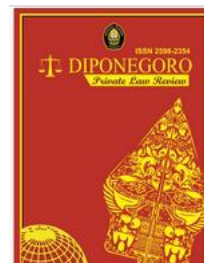
In the analysis of this journal there are differences between constitutive systems and declarative systems. In the constitutive system is a system of protection for a mark where the party who first applies for registration to the trademark office, then becomes the first party who has rights to the mark, so that in this system the party named Jesy Handalim as the first registrant of the Benu trademark rights holder. While in the Declarative System is a protection system that gives exclusive rights to the first commercial user of a brand in a certain region, even though the user of the mark has not applied for registration in using the mark commercially, so in this system Ruben Onsu as the owner of the name Geprek Benu has received confirmation from the South Jakarta District Court with Number: 384/Pdt.P/2018/PN. Jkt.Sel. where in the brand "Benu" is an abbreviation of his own name, namely Ruben Onsu and states the Geprek Benu brand is a well-known brand.

Of the two systems, Indonesia adheres to the Constitutive System because for the first party who has applied for registration to the trademark office, the first party becomes the owner of the trademark rights.

Settlement of disputes related to Trademark Rights is certainly easier if resolved through the Court because in the Court system there is a clear and coherent mechanism so that if a trademark rights dispute occurs, it can be resolved according to existing legal rules and in the decision is permanent. If it is settled out of court, it is difficult to reach an agreement between the two parties, because both parties both defend each other's rights.

CONCLUSION

Legal provisions regarding Famous Trademark Rights in Indonesia are regulated in Law Number 20 of 2016 concerning Marks and Geographical Indications based on a Trademark registration system with a

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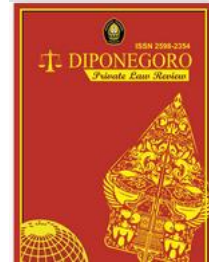
constitutive system. The protection provided for the brand is carried out in two ways, namely preventive legal protection and repressive legal protection. It is intended to provide effective protection to prevent all forms of infringement in the form of plagiarism, use of the same name, profiteering of names, or domain names of a brand. From this research dispute, the settlement of legal disputes against Benu famous trademark rights holders based on the principle of *first to file principal* is appropriate, because it uses a constitutive system instead of a declarative system, this is in accordance with Law Number 20 of 2016 concerning Marks and Geographical Indications. The settlement can be done by registering a famous mark or famous name into a trademark, because if it is not registered, it has no juridical legal force, which has a detrimental impact on the owner because it does not have exclusive protection and rights. With this settlement, it can provide justice and legal protection for the first registrant as an exclusive right to the holder of a famous brand. In this case, Indonesia adheres to the Constitutive System which refers to the party who submits a registration application to the trademark office, then the first party who becomes the owner of the trademark rights. Settlement of disputes related to Trademark Rights is certainly easier if resolved through the Court because in the Court system there is a clear and coherent mechanism so that if there is a trademark rights dispute, it can be resolved according to existing legal rules and in the decision is permanent.

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