

Analysis of Solaria Brand Dispute Resolution with Solaris (Case Study No. 775 K/PDT.SUS-HKI/2021)

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Abstract. *This research discusses the dispute between the SOLARIA and SOLARIS brands in Indonesia, focusing on Decision No. 775 K/Pdt.Sus-HKI/2021. It aims to analyze the considerations of the Panel of Judges in resolving the trademark dispute and determine the protection of the SOLARIA brand against the SOLARIS brand in the mentioned decision. The findings reveal that the Plaintiff, as the owner of the SOLARIA brand, is the registrant and first user of the brand under the first-to-file system. Consequently, the Plaintiff is the legal owner of the SOLARIA brand, which is recognized as a well-known brand based on registrations in various countries. The Defendant's registration of the SOLARIS mark is considered to be in bad faith due to significant similarities in terms of shape, sound, and pronunciation. This suggests that the Defendant registered the mark solely for their own business interests, misleading consumers and causing harm to other parties. Accordingly, the Directorate General of Intellectual Property should reject the Defendant's SOLARIS trademark application under Article 21 paragraph (1) letter a of the MIG Law. The Plaintiff, as the owner of the SOLARIA brand, obtains legal protection through the resolution of this case via a legal process. The Panel of Judges granted the Plaintiff's lawsuit and declared the SOLARIS brand invalid according to the law. The cassation request submitted by the Defendant was also rejected, providing repressive legal protection for the Plaintiff.*

Keywords: Equality; Protection; Trademark.

1. Introduction

Intellectual Property Rights (IPR), also known as Hak Kekayaan Intelektual (HKI) in Indonesian, are rights that arise from creative intellectual endeavors that produce

products or processes beneficial to humanity.¹ HKI encompasses the rights to obtain economic benefits from human intellectual creativity, and these rights emerge when something has been created and can be seen, heard, read, and practically used.² HKI grants the right to enjoy economic benefits from one's creations. Additionally, HKI provides legal protection to creators or owners and encourages further development in other areas such as cultural arts, scientific discoveries, and trademarks.³

Trademark is one of the components of Intellectual Property Rights (HKI) used to introduce a product or service with the aim of being recognized by the public. Therefore, a trademark becomes an important aspect of business activities as it serves as the identity of the business.⁴ Article 1, Number 1 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as the Trademark and Geographical Indications Law) states:

"A trademark is a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in two-dimensional and/or three-dimensional form, sound, hologram, or a combination of two or more of these elements, to distinguish goods and/or services produced by individuals or legal entities engaged in the trade of goods and/or services."⁵

The above explanation explains that a brand is an identification used by businesses to identify their products on the market.⁶ Trademarks can serve as a preventive measure against unfair business competition because they have the ability to provide information about the origin and history of a company, as well as guarantee the authenticity of the quality of goods and/or services.⁷ Trademarks offer protection against imitation attempts by competitors, as they create exclusive rights for the owner to use the trademark. However, there are other businesses that act unfairly by creating products or services and using a trademark that resembles a

¹ Nanda Dwi Rizkia, *et.al*, *Hak Kekayaan Intelektual Suatu Pengantar*, (Bandung: Penerbit Widina Bhakti Persada Bandung, 2022), p. 14

² Muchtar Anshary Hamid Labetubun, "Aspek Hukum Hak Cipta terhadap Buku Elektronik (E-Book) sebagai Karya Kekayaan Intelektual", *Sasi*, Vol. 24, No. 2 Desember 2018, p. 138

³ Anis Mashdurohatun, *Hak Kekayaan Intelektual (HKI) Dalam Perspektif Sejarah di Indonesia*, (Semarang: Madina Semarang, 2013), p. 8

⁴ Ni Ketut Supasti, *et.al*, *Buku Ajar Hak Kekayaan Intelektual*, (Yogyakarta: Penerbit Deepublish, 2016), p. 52 – 53

⁵ Article 1 number 1 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

⁶ Tim Lindsey, *et.al*, *Hak Kekayaan Intelektual Suatu Pengantar*, (Bandung: Penerbit P.T. Alumni, 2003), p. 131

⁷ Meli Hertati Gultom, "Perlindungan Hukum Bagi Pemegang Hak Merek Terdaftar terhadap Pelanggaran Merek", *Warta Dharmawangsa*, No. 56, 2018, p. 8

famous trademark with the intention of misleading consumers in their market choices.

Trademark infringement can be prevented by registering the trademark to obtain recognition and legal protection as regulated in Article 3 of the Trademark and Geographical Indication Law. However, not all trademark registration applications are granted according to Article 21 of the Trademark and Geographical Indication Law:

(1) The application will be rejected if the trademark has substantial or overall similarity with:

- a. Registered trademarks owned by others or applied for earlier by others for similar goods and/or services;
- b. Well-known trademarks owned by others for similar goods and/or services;
- c. Well-known trademarks owned by others for dissimilar goods and/or services that meet certain requirements; or
- d. Registered geographical indications.

(2) The application will be rejected if the trademark:

- a. Resembles or imitates the name or abbreviation of a famous person, their photograph, or the name of a legal entity owned by others, unless written consent is obtained from the rightful owner;
- b. Resembles or imitates the name or abbreviation, flag, emblem, or symbol of a country, national or international institution, unless written consent is obtained from the authorized party; or
- c. Resembles or imitates an official sign, seal, or stamp used by a country or government institution, unless written consent is obtained from the authorized party.

(3) The application will be rejected if it is filed by an applicant with bad faith."

Article 21 paragraph (1) of the Trademark and Geographical Indication Law states the phrase "substantial or overall similarity." This phrase indicates the presence of a dominant element in a trademark that makes it similar to another trademark.

Substantial similarity in the main parts or overall between the two trademarks can be said to exist if they have similarities. These similarities can be found in the form, placement, writing, combination of elements, sound, and visual appearance of the trademarks.⁸

A famous brand in a business is known as a brand that has a high reputation and is widely recognized by the public. Famous brands are often associated with superior-quality products, excellent services, and reliability. The success of a brand in achieving fame usually involves continuous marketing efforts to build a positive image and improve product quality in order to provide satisfaction to consumers. Well-known trademarks provide various benefits to a business entity, one of which is the tendency of the public to be attracted to the reputation of a widely recognized brand.⁹ A positive brand image can help build long-term consumer loyalty. People tend to have a greater preference for well-known brands compared to ordinary brands because of the association between the brand and proven qualities, innovation, and added value.

Famous brands have usually built a good reputation and gained widespread recognition from the public. This is exploited by other businesses that are too lazy to come up with their own ideas by imitating famous brands in order to gain instant benefits.¹⁰ This action can harm the original owner of the famous brand and disrupt the market and healthy competition. Indonesia has enacted the Trademark Law (UU MIG) with the aim of protecting brands that deserve legal protection and certainty. However, there are still many businesses that engage in imitation of famous brands. One such case in Indonesia involves the brands SOLARIA and SOLARIS. SOLARIA is a well-known brand in the fast-food industry, while there are other businesses that use the brand SOLARIS in the same industry.

SOLARIA is a fast-food company from Indonesia that was founded by Aliuyanto in 1995 and has become one of the most popular brands in the fast-food industry, widely loved by the public. SOLARIA has been proven to be a famous brand with an international reputation, in accordance with Article 21 paragraph (1) letter b of the

⁸ Hukum Online, "Arti 'Persamaan pada Pokoknya' dalam UU Merek dan Indikasi Geografis". <https://www.hukumonline.com/klinik/a/arti-persamaan-pada-pokoknya-dalam-uu-merek-dan-indikasi-geografis-lt560aad4d30945/>, accessed on August 10, 2023

⁹ Magyar Slamet Permana and Jony Oktavian Haryanto, "Pengaruh *Country of Origin*, *Brand Image* dan Persepsi Kualitas terhadap Intensi Pembelian", *Jurnal Manajemen Untar*, Vol. 18, No. 3 October 2014, p. 366

¹⁰ Siti Marwiyah, "Perlindungan Hukum atas Merek Terkenal", *De Jure: Jurnal Hukum dan Syar'iah*, Vol. 2 No. 1 Juni 2010, p. 40

Trademark Law, Supreme Court Jurisprudence No. 1486/K/1991, and Supreme Court Jurisprudence No. 022K/N/HaKI/2002. The similarity between the brands SOLARIS and SOLARIA has raised objections from Aliuyanto regarding the registration of the SOLARIS brand. He has filed a lawsuit against Erwin Munandar, who has a substantial similarity to the SOLARIA brand and has registered his brand in the same class as SOLARIA to protect the types of goods included in class 30.

Erwin Munandar's actions are considered to be a violation of intellectual property rights as regulated by the law. Intellectual property rights include the protection of trademarks to prevent other businesses from unlawfully using similar trademarks. Therefore, the owner of the SOLARIA brand can use this as a legal basis to claim compensation, cancel the registered trademark, and take legal action in accordance with the provisions of the Trademark Law to protect the ownership rights of the SOLARIA brand. What were the considerations of the judge in resolving the case between the brands SOLARIA and SOLARIS in Decision No. 775K/Pdt.Sus-HKI/2021? How is the protection of the SOLARIA brand against the SOLARIS brand in Decision No. 775K/Pdt.Sus-HKI/2021? Therefore, this research is expected to provide information for understanding the resolution and protection of trademark rights in accordance with the MIG Law.

2. Research Methods

This research uses a type of normative legal research using secondary data consisting of court decisions as primary legal material, statutory regulations, legal principles, books and journals as secondary legal material, and the internet as tertiary legal material. The data acquisition method used in this research is a literature study by analyzing cases that have permanent legal force based on statutory regulations. In analyzing the data obtained, qualitative methods were used.

3. Results And Discussion

3.1 Considerations of the judge in resolving the case between the brands SOLARIA and SOLARIS in Decision No. 775 K/Pdt.Sus-HKI/2021

The considerations of the Panel of Judges in Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks were based on the Plaintiff's lawsuit and the Defendant's response, arguing that four elements needed to be proven in this case, as indicated in the following table.

Four elements need to be proven

The considerations of the Panel of Judges in Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks

1. Is the Plaintiff the first registrant of the SOLARIA brand, making the Plaintiff the legal owner of the SOLARIA brand?

The Panel of Judges considered that based on the evidence of the Certificate of registration for the SOLARIA brand with No. 474903 dated April 14, 2000 owned by the Plaintiff, which is connected to the Certificate of Extension of registration for the SOLARIA brand with No. IDM000219940 owned by the Plaintiff, valid until April 14, 2030, to protect the types of goods included in class 30, which is an extension of the registration for the SOLARIA brand, List No. 474903 owned by the Plaintiff, as well as all certificates of registration for the SOLARIA brand and extension certificates in the name of the Plaintiff until April 14, 2023.

The Panel of Judges considered that based on the evidence submitted by the Defendant, namely registration No. IDM000676148 on February 27, 2020, it can be established that the Plaintiff registered the SOLARIA brand with the Directorate General of Intellectual Property earlier on April 14, 2000.

2. Is the SOLARIA brand owned by the Plaintiff a well-known brand?

The Panel of Judges considered the definition of a well-known brand, which is not explicitly mentioned in the Trademark Law, but can be implicitly seen in the Explanation of Article 21 paragraph (1), which states that a well-known brand is known by the public in the relevant field, has a reputation acquired through extensive and massive promotion, investment in several countries by its owner, and is registered in several countries.

The Panel of Judges considered that the definition of a well-known brand in Article 21 paragraph (1), when connected with the evidence submitted by the Plaintiff in the form of a photocopy of the registration certificate for the SOLARIA brand owned by the Plaintiff abroad, should be considered based on Article 18 paragraph (3) of the Regulation of the Minister of Law and Human Rights. This regulation determines the criteria for a brand to be recognized as a well-known brand as referred to in paragraph (1), considering factors such as the duration of brand use, intensity and promotion of the brand including the investment value used for such promotion, and the

registration of the brand or registration of the brand in other countries. These factors prove that the Plaintiff's SOLARIA brand is a well-known brand with an international reputation.

3. Does the Plaintiff's SOLARIA brand have substantial similarity with the SOLARIS brand with IDM000676148, registered by the Defendant on February 27, 2020?

The Panel of Judges considered that by examining both brands, the following conclusions can be drawn:

1. Similarity of Form: The form of the Plaintiff's brand, SOLARIA, consists of 7 letters with a color configuration of white, yellow, red, and black, with red writing in combination with white and black. The Defendant's brand, SOLARIS, also consists of 7 letters and uses red writing in combination with white. The font style between the Plaintiff's brand, SOLARIA, and the Defendant's brand, SOLARIS, is almost the same, although SOLARIA uses lowercase letters and SOLARIS uses capital letters, but the letter shapes are very similar.

2. Phonetic Similarity: The pronunciation of the words SOLARIA and SOLARIS will result in similar pronunciations. The only difference between SOLARIA and

SOLARIS is the last letter of each brand, namely the letter "A" in SOLARIA owned by the Plaintiff and the letter "S" in SOLARIS owned by the Defendant.

3. Sound Similarity: The sound produced by the words in the Plaintiff's brand, SOLARIA, and the sound produced by the words in the Defendant's brand, SOLARIS, according to the Panel of Judges, will result in a similar sound.

The Panel of Judges considered that the SOLARIS brand, owned by the Defendant (Erwin Munandar), registered under IDM000676148 on February 27, 2020, in Class 30, has substantial similarity with the SOLARIA brand owned by the Plaintiff, registered under number 474903 since April 14, 2000, to protect the types of goods included in Class 30, which have been extended twice with No. IDM000219940, namely for the period from April 14, 2010, to April 14, 2020, and the period from April 14, 2020, to April 14, 2030.

The Panel of Judges opined that both brands have a substantial similarity in terms of pronunciation and visual appearance, namely the pronunciation of the word "SOLARIA" and the brand "SOLARIS" sound very similar. Therefore, to protect goods/services of the same or similar nature in the same classes as the Plaintiff's brands, namely classes 18, 25, 29, 30, 32, 35, 42, and 43.

Based on the criteria of brand similarity according to the Indonesian Trademark Law (UU MIG), the Panel of Judges found that the brand "SOLARIS" owned by the Defendant has substantial similarity with the brand "SOLARIA" owned by the Plaintiff in terms of visual appearance, pronunciation, type of goods, and juridical assessment.

4. Was the registration of the SOLARIS brand by the Defendant with IDM000676148 on February 27, 2020 made in good faith?

The Panel of Judges considered that according to Article 21 Paragraph (3) of the Indonesian Trademark Law (UU MIG), a bad-faith applicant is someone who is reasonably suspected of registering their trademark with the intention to imitate, copy, or follow another party's trademark for their own business interests, causing unhealthy competition,

deceiving, or misleading consumers. The determination of bad faith can be seen in two main ways:

1. The presence of an intention that is motivated by business interests while also causing harm to others.
2. Deceptive practices towards consumers or unfair competition, such as copying or riding on the fame of another brand.

The Panel of Judges considered that the Plaintiff is the owner of the SOLARIA brand, which was registered earlier and has substantial similarity with the registered SOLARIS brand under No. IDM000676148 in class 30. Therefore, in the opinion of the Panel of Judges, the registration of the SOLARIS brand under No. IDM000676148 in class 30 was done in bad faith.

Table 1 The considerations of the Panel of Judges in Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks

The Defendant was dissatisfied with the decision rendered by the Panel of Judges at the first-instance court. The Defendant/Appellant filed a cassation request to the Supreme Court. In the cassation request, the Appellant requested that the cassation request be accepted and the judgment of the Commercial Court Makassar in Case Number 3/PDT.HKI/Merek/2020/PN.Niaga MKS dated February 18, 2021, be annulled.

The Panel of Judges considered the reasons for the cassation appeal, and the Supreme Court opined that those reasons are not justifiable. After careful examination of the cassation appeal reasons dated March 10, 2021, and the counter cassation memorandum dated March 23, 2021, in connection with the considerations of the *Judex Facti* in this case, the Commercial Court of the District Court of Makassar did not err in applying the law, based on the following considerations:

1. The Plaintiff argues that they are the owner of the SOLARIA brand for various classes, including Classes 30, 43, 44, 45, 18. The Plaintiff objects to the registration of the SOLARIS brand under registration number IDM000676148 owned by the Defendant, with a registration date of February 27, 2020, in the name of the Defendant, for the protection of goods that fall within Class 30. This objection is based on the substantial similarity between the SOLARIS brand owned by the Defendant and the well-known and previously registered SOLARIA brand owned by the Plaintiff in Indonesia and other countries;

2. The Plaintiff's brand and the Defendant's brand

The Plaintiff's brand	The Defendant's brand
	

Table 2 The Plaintiff's brand and the Defendant's brand

The Plaintiff's brand uses the word "SOLARIA" in a combination of uppercase and lowercase letters, slightly wavy, with the entire word in red color and a slight blue shadow in the background. On the other hand, the Defendant's brand "SOLARIS" consists of all uppercase letters, written in a wavy manner;

3. When viewed from a distance, both of these brands have similarities, especially when it comes to pronunciation. Both brands use the initial word "SOLARI", which, when pronounced, has a similar sound. There is almost no difference in mouth movement.

4. The Defendant's brand "SOLARIS" bears similarities to the Plaintiff's brand SOLARIA due to the dominant elements of the words "SOLARIS" and "SOLARIA". This creates an impression of similarity, whether it's in terms of the use of the color red, placement, wavy writing style, or a combination of elements. Additionally, there is a similarity in pronunciation, as stipulated in Article 21 paragraph (3) of the UU MIG.

5. The Plaintiff's brand "SOLARIA" under registration number 474903 has been registered in Indonesia since April 14, 2000, to protect goods within Class 30. The Plaintiff has renewed this brand twice. The Plaintiff's brand "SOLARIA" has also been registered in several other countries for different classes, but still using the word "SOLARIA". Therefore, the Plaintiff's brand "SOLARIA" was already well-known before the Defendant registered the brand "SOLARIS".

6. The Defendant's brand "SOLARIS" under registration number IDM000676148 was registered on February 27, 2020, to protect goods within Class 30. This means that the Defendant's brand "SOLARIS" was registered before the Plaintiff's brand "SOLARIA" for the same class, Class 30.

7. It can be reasonably suspected that the Defendant registered their brand "SOLARIS" under registration number IDM000676148 on February 27, 2020, with the intention to imitate, copy, or follow the Plaintiff's brand "SOLARIA" for the purpose of gaining an unfair competitive advantage or misleading consumers, as stipulated in Article 21 paragraph (3) of the UU MIG.

The panel of judges considers that the decision of the Commercial Court at the District Court of Makassar in this case is not in violation of any laws and/or regulations. Therefore, the cassation petition submitted by the cassation petitioner, ERWIN MUNANDAR, must be rejected, and they shall be ordered to pay the costs of the case at the cassation level. The researcher analyzes the decision of the panel of judges in Decision No. 775 K/Pdt.Sus-HKI/2021 jo. Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks has provided a legal and/or statutory solution by granting the lawsuit of the Plaintiff/Appellant and rejecting the application of the Defendant/Appellant, as the Plaintiff/Appellant has proven its arguments.

Article 1 number (5) of the Trademark Law states that the right to a trademark is an exclusive right granted by the state to the registered trademark owner for a certain period of time. This right can be used by the owner itself or by other parties who obtain permission for the trademark.¹¹ The issuance of the SOLARIS Trademark

¹¹ Article 1 number 5 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

Certificate grants exclusive rights to the owner to use that trademark. However, the SOLARIS trademark owned by the Defendant bears similarities to the SOLARIA trademark owned by the Plaintiff, without any distinctive elements. The Defendant is suspected of having acted in bad faith during the trademark registration process.

The opinion of the panel of judges regarding the SOLARIA trademark owned by the Plaintiff is a well-known trademark with an international reputation, which aligns with the criteria of well-known trademarks as stipulated in Article 21 paragraph (1) of the Trademark Law, Article 18 paragraph (3) of the Minister of Law and Human Rights Regulation No. 67 of 2016, and the Jurisprudence of the Supreme Court of the Republic of Indonesia No. 022K/N/HaKI/2002 dated December 20, 2002, supported by the registration of the SOLARIA trademark in various countries. The opinion of the panel of judges stating that the SOLARIS trademark owned by the Defendant is a result of imitating a certain trademark that can mislead is correct, as the SOLARIA trademark owned by the Plaintiff was registered with the Directorate General of Intellectual Property on April 14, 2000, while the SOLARIS trademark owned by the Defendant was registered on February 27, 2020. The registration of the SOLARIS trademark by the Defendant demonstrates bad faith, as the shape, sound, and pronunciation of both trademarks are fundamentally similar. Both the SOLARIA and SOLARIS trademarks consist of 7 letters, and when compared, they have the same color combination of red and white. When pronounced, both the SOLARIA and SOLARIS trademarks produce almost the same sound, "SO-LA-RI," with the only difference being the last letter of each respective trademark.

Explanation of Article 21 paragraph (1) of the Trademark Law states that similarity in essence means resemblance due to the presence of dominant elements between one trademark and another, resulting in a similar impression. Additionally, the explanation of Article 21 paragraph (3) of the Trademark Law states that an applicant who acts in bad faith is an applicant who is suspected of registering their trademark with the intention of benefiting their business and causing harm to others by misleading consumers or engaging in unfair competition.¹² Based on the explanations in Article 21 paragraphs (1) and (3), it can be said that the registration of the SOLARIS trademark demonstrates bad faith. This is because the SOLARIS trademark bears similarity in visual appearance, sound, and pronunciation to the long-registered SOLARIA trademark owned by the Plaintiff.

The opinion of the panel of judges is correct in declaring the SOLARIS trademark owned by the Defendant null and void, and ordering the Ministry of Law and Human

¹² Explanation of Article 21 paragraph (3) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications.

Rights through the Directorate General of Intellectual Property, specifically the Directorate of Trademarks and Geographical Indications, to carry out the cancellation of the registration of the SOLARIS trademark, registration No. IDM000676148, dated February 27, 2020, under the name of the Defendant, by removing the registration of the SOLARIS trademark, registration No. IDM000676148, from the General Trademark Registry.

The panel of judges in Decision No. 775 K/Pdt.Sus-HKI/2021 rejected the appeal request from the Appellant/Defendant and affirmed that the Commercial Court at the Makassar District Court did not incorrectly apply the law. This decision was based on the consideration that the Plaintiff, as the owner of the SOLARIA trademark in various classes, including class 30, objected to the registration of the SOLARIS trademark owned by the Defendant, dated February 27, 2020, to protect the types of goods that fall within class 30. This objection was due to the substantial similarity between the SOLARIS trademark and the well-known and previously registered SOLARIA trademark owned by the Plaintiff in Indonesia and other countries, which has been renewed twice since April 14, 2000 by the Plaintiff.

The researcher believes that the resolution considered by the panel of judges in Decision No. 775 K/Pdt.Sus-HKI/2021 jo. Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks is correct. The court granted the Plaintiff's lawsuit in its entirety, declaring that the Plaintiff is the first owner and user of the SOLARIA trademark, that the SOLARIA trademark owned by the Plaintiff is a well-known trademark, and that the SOLARIS trademark, registration No. IDM000676148, dated February 27, 2020, under the name of the Defendant, has substantial similarity with the Plaintiff's SOLARIA trademark. The court declared the registration of the SOLARIS trademark, registration No. IDM000676148, dated February 27, 2020, under the name of the Defendant, null and void according to the law, with all legal consequences. The court ordered the Ministry of Law and Human Rights through the Directorate General of Intellectual Property, specifically the Directorate of Trademarks and Geographical Indications, to carry out the cancellation of the registration of the SOLARIS trademark, registration No. IDM000676148, dated February 27, 2020, under the name of the Defendant, by removing the registration of the SOLARIS trademark from the General Trademark Registry, with all legal consequences. The court also ordered the Defendant to pay all legal costs incurred in this case, amounting to IDR.610,000 (six hundred and ten thousand rupiah). Additionally, at the cassation level, the panel of judges rejected the cassation request from the Appellant: Erwin Munandar, and ordered the Appellant/Defendant to pay the costs of the case at all levels of the judiciary, amounting to IDR5,000,000.00 (five million rupiah).

3.2 The protection of the SOLARIA brand against the SOLARIS brand in Decision No. 775 K/Pdt.Sus-HKI/2021.

The protection obtained by the brand SOLARIA against the brand SOLARIS is through a court lawsuit. Judgment No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks by the panel of judges granted the lawsuit of the brand SOLARIA as the Plaintiff against the imitation of the brand by the brand SOLARIS. The panel of judges declares that the Plaintiff is the first owner and user of the brand SOLARIA. The panel of judges considers that based on the evidence of the certificate of registration of the brand SOLARIA, including the certificate of renewal of the registration of the brand SOLARIA, and the evidence submitted by the Defendant, which is registration No. IDM000676148 on February 27, 2020, the Plaintiff with the brand SOLARIA registered first with the Directorate General of Intellectual Property on April 14, 2000. This is in line with Article 1 number 5 of the Trademark Law, which states that a trademark right is a right granted by the state to the owner of a registered trademark for a certain period of time.

The panel of judges declares that the brand SOLARIA owned by the Plaintiff is a well-known brand, considering that when connected with the definition of a well-known brand in Article 21 paragraph (1) and when considering the evidence submitted by the Plaintiff in the form of a photocopy of the certificate of registration of the brand SOLARIA owned by the Plaintiff abroad. This is considered based on Article 18 paragraph (3) of the Regulation of the Minister of Law and Human Rights, which states that the criteria for determining a brand as a well-known brand as referred to in paragraph (1) shall be done by considering, among other things, the duration of brand usage, the intensity and promotion of the brand including the investment value used for such promotion, as well as the registration of the brand or the registration of the brand in other countries. This proves that the brand SOLARIA owned by the Plaintiff is a well-known brand with an international reputation in accordance with the provisions of the Trademark Law and the Supreme Court of the Republic of Indonesia Jurisprudence No. 022K/N/HaKI/2002 dated December 20, 2002.

The panel of judges declares that the brand SOLARIS, registration No. IDM000676148 with a registration date of February 27, 2020, under the name of the Defendant, has substantial similarity with the brand SOLARIA owned by the Plaintiff. The panel of judges considers that both brands have similarities in terms of form, pronunciation, and sound. The form similarity consists of 7 (seven) letters and a font

shape that is almost the same. The pronunciation similarity, if pronounced, will result in a similar pronunciation, the only difference between the words SOLARIA and SOLARIS is the last letter of each brand. The sound similarity generated by the words in the brand SOLARIA and the sound generated by the words in the brand SOLARIS, when pronounced, will produce a similar sound. This becomes the reason that the application for the Defendant's brand should be rejected by the Directorate General of Intellectual Property in accordance with Article 21 paragraph (1) letter a of the Trademark Law, which states that trademark applications will be rejected if there is substantial or overall similarity with other registered trademarks that have been applied for first for similar goods and/or services.

The registration of the brand SOLARIS, registration No. IDM000676148, with a registration date of February 27, 2020, under the name of the Defendant, is declared null and void by law, with all legal consequences. The panel of judges considers that the Plaintiff is the owner of the brand SOLARIA, which was registered first and has substantial similarity with the registered brand SOLARIS, No. IDM000676148, class 30. Therefore, according to the panel of judges, the registration of the brand SOLARIS, No. IDM000676148, class 30, is deemed to have been made in bad faith.

The Ministry of Law and Human Rights through the Directorate General of Intellectual Property, specifically the Directorate of Trademarks and Geographical Indications, is ordered to carry out the cancellation of the registration of the brand SOLARIS, No. IDM000676148, dated February 27, 2020, under the name of the Defendant, by striking off the registration of the brand SOLARIS, No. IDM000676148, from the General Register of Trademarks, with all legal consequences. The panel of judges also orders the Defendant to pay the court costs in the amount of IDR 610,000,- (six hundred ten thousand Rupiah). The panel of judges in the Supreme Court's Decision also affirms that the Commercial Court at the District Court of Makassar did not incorrectly apply the law.

The researcher argues that the protection provided by the panel of judges in Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks, which granted the lawsuit of the SOLARIA trademark as the Plaintiff against the imitation of the SOLARIS trademark, is considered appropriate because the SOLARIS trademark owned by the Defendant does indeed have substantial similarity with the SOLARIA trademark owned by the Plaintiff. In Decision No. 775 K/Pdt.Sus-HKI/2021, the Defendant registered their trademark with bad faith due to the similarity in form, pronunciation, and sound

between the two trademarks. Both the SOLARIA and SOLARIS trademarks have 7 (seven) letters, and the font used also has similar letter shapes. The colors used in the logos contain red and white, making the two trademarks appear similar.

The pronunciation between the words SOLARIA and SOLARIS also sounds almost the same, with the only difference being the last letter of each trademark, namely the letter A in the SOLARIA trademark owned by the Plaintiff and the letter S in the SOLARIS trademark owned by the Defendant. The sounds produced by the words in the SOLARIA and SOLARIS trademarks are also almost identical. The Defendant's actions are considered to be in violation of Article 21 paragraph (1) of the Trademark and Geographical Indication Law (MIG Law) because they have imitated or copied the famous trademark owned by the Plaintiff, which is SOLARIA.

The Plaintiff filed the lawsuit based on the interests stipulated in Article 20 and/or Article 21 of the MIG Law, where the Defendant's trademark has substantial similarity with the Plaintiff's trademark, making the Plaintiff's request for trademark cancellation in accordance with the provisions of Article 76 paragraphs (1) and (3) of the MIG Law. The Defendant registered their trademark on February 27, 2020, and the Plaintiff filed the lawsuit on October 7, 2020, thus the Plaintiff's lawsuit is in accordance with the provisions of Article 77 paragraph (1) of the MIG Law regarding the lawsuit for cancellation of trademark registration. The Plaintiff in this case has the right to legal protection as stipulated in Article 83 paragraph (1) of the UU MIG.

The SOLARIA trademark owned by the Plaintiff is a well-known trademark with an international reputation that has been registered in Indonesia and other countries. The products bearing the SOLARIA trademark are circulated in Indonesia and various other countries, supported by promotional efforts made by the Plaintiff through investments in several countries around the world, along with evidence of trademark registrations in several countries. The writer believes that the SOLARIA trademark falls into the category of well-known trademarks, and therefore it is justified to declare the SOLARIS trademark null and void in accordance with the law, as it bears substantial similarity to the well-known SOLARIA trademark. The researcher believes that Decision No. 775 K/Pdt.Sus-HKI/2021 jo. Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks has provided legal protection to the Plaintiff as the owner of the well-known SOLARIA trademark by granting the Plaintiff's claim and rejecting the Defendant's cassation request. The legal protection given in this case is a form of repressive legal protection through the resolution of the case through legal processes.

4. Conclusion

The considerations of the judge in Decision No. 775 K/Pdt.Sus-HKI/2021 jo. Decision No. 3/Pdt.Sus-HKI/2020/PN Niaga Mks have resolved this case and provided legal protection to the Plaintiff as the owner of the well-known SOLARIA trademark by granting the Plaintiff's claim and rejecting the Defendant's cassation request. Therefore, the Directorate General of Intellectual Property (DJKI) is expected to be more careful and meticulous in examining trademark registration applications and creating regulations related to supervision in trademark registration, so that no trademark has substantial or overall similarity to another trademark that has been registered in the General List of Trademarks.

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