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## **JURIDICAL ANALYSIS OF VERDICT NUMBER 811K/Pdt.Sus-HKI/2021 CONCERNING BRAND DISPUTE THAT HAVE FUNDAMENTAL SIMILARITY**

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### **ABSTRACT**

*Brand similarities are regulated in brand law which often occurs in various places, especially in Indonesia. Based on this research, these similarities are in the form of similar image elements, similar sounds, similar letters or words, names, numbers, colors, etc. in the form of an arrangement or combination of the arrangement of these elements, whether in the form of goods or services, whether dissimilar or similar and based on general public knowledge, the quality of the mark obtained due to holding very large promotions and followed by proof of registration of the mark itself in various country.*

*This research aims to understand the types of brand violations that have fundamental similarities with other brands and to find out the sanctions that will be given to perpetrators who commit similarities with other brands. This research also aims to understand the legal consequences for perpetrators who use brands that have fundamental similarities with other brands. This study uses a normative or doctrinal method and uses a statute and conceptual approach.*

*The study concluded that The Timberlake brand had violated the Brand Law, namely by having essential resembles with the Timberland brand, which includes pronunciations, product classification, and visual aspects. The judge's verdict was that the Timberlake was guilty of Trademark violation and was obliged to compensate the plaintiff*

**Keywords: Registered brand, Fundamental Similarities.**

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### **INTRODUCTION**

Trademarks are part of Intellectual Property Rights (IPRs). These rights arise for creative activities that are expressed in various forms, useful for society, and economically valuable. IPRs are essentially conceived from three main fields: technology, science, and literature.<sup>1</sup>

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<sup>1</sup>P Yunita.(2019), HaKI dan Masyarakat Ekonomi ASEAN, Malang: Cempluk Aksara.p.4

The law on Trademarks of 2001 specifies the types of Trademarks. Particularly set forth in Article 1, 2 and which is generally divided into Trademarks of goods and services. Article 1 Subsection 1 stated that signs that can be protected as Trademarks should meet the criteria of:

- a. Contain distinguish characteristic
- b. Contain distinguish sign
- c. Contain useful/applicable goods and/ or services<sup>2</sup>

To be protected, the Trademarks have to be registered in DEPKUMHAM (the Indonesian Department of Law and Human Rights), Intellectual Property desk. A registered Trademark will receive a registration number and be officially protected by the state. In contrast, an unregistered one is unprotected by the state and thus can take legal action against imitation or freeriding.

One pertinent Trademark violation example in Indonesia is displayed in the Timberlake Vs Timberland case. It is known that Timberland is a registered Trademark in Indonesia, registration number IDM000010344. Therefore, this Trademark is entitled to protection from any kind of imitation.

The Indonesian Trademark Law governs that item that is listed in the General Registry of Trademark in the Trademark department is protectable. Meanwhile, Timberland was registered on 81 July 1945, extended on 9 July 2004 under registration number 336470 and last extension on 26 February 2014, registration number R.2991/2014, which is classified as class 25 (clothes, footwear and head cover). Hence, the “Timberland” brand is exclusively owned by the relevant company and restricted to be used by other parties without legal permission.

On the other hand, the Timberlake company or Indra Halim registered the Timberlake brand, registration number IDM000471725, on 28 August 2015 on their behalf under the class 25 category. They claim that Timberlake is an official Trademark. The proposed evidence is the registration certificate of Timberlake brand number IDM000471725.

Regarding the similarities and differences, it seems these brands are significantly identical (Timberland and Timberlake). Thus, this could potentially harm the plaintiff, as the plaintiff is the owner of Timberland, a well-known brand. Indeed, the Timberlake registration number IDM000472725 dated 28 August 2015, and Indra Halim was terminated. Further, they were also fined Rp.5.000.000 (Five Million Rupiah) for the trial case.

## METHOD

This research can be categorized as normative and doctrinal legal research. It mainly applies literature study, including but not limited to materials such as books, notes, and reports of previous research.<sup>3</sup> These materials are collected and analysed to address the research questions. The applicable research materials can be divided into two categories: primary and secondary legal materials. Primary materials consist of relevant statutes, cases, and tribunal decisions. Secondary materials consist of non-legal products yet relevant to the research, such as experts’ opinions.

Several approaches are taken to address the relevant issues. First, the knowledge integration approach is used to bridge legal theory and its implementation in the field in the elaboration of relevant issues. Second, the conceptual approach is used to understand the underlying concept behind trademark protection and justify the writer’s position.

<sup>2</sup>Titik Triwulan Tutik (2006). Pengantar Ilmu Hukum, Jakarta: Prestasi Pustaka. p 50.

<sup>3</sup>Marzuki, P.M.,2005. Penelitian Hukum. Jakarta. Kencana Prenada Media Grup, p. 22

## ANALYSIS AND DISCUSSION

Trademarks refer to signs attached to a product or service to differentiate it from similar products. Trademark holders have the privilege of protecting their products from similar signs and material copying.<sup>4</sup> According to Article 21 of Trademark Law, substantial similarities mean imitating a registered brand's primacy, leading to identical form, layout, writing style, combination of these aspects or similar pronunciation of the brand. In short, theoretically, similarities in the form of wholly or partial appearance may be considered Trademarks of violence.<sup>5</sup>

Further, according to the Decree of the Supreme Justice No 789 K/PDT.SUS-HKI/2016, Decree of the Supreme Justice No 279 PK/Pdt/1992, identical trademarks contain similarities in terms of:

- 1) Forms, images or logos
- 2) composition, composition and placement of the logo
- 3) Combination, conjoint of several aspects such as colour
- 4) Individual aspect or individual composition
- 5) Sound, identical brand's sound
- 6) Name, identical brand's name
- 7) Visual similarities, the logo's visual similarities

The registered Trademark holder can sue other parties due to illegal use of their brand wholly or partially. The lawsuit may:

- a. Demand compensation to the illegal user, and
- b. Obligated the illegal user to terminate all production relevant to the accused Trademarks.

The Trademarks evaluator classified "distinguishable quality" in two ways:

- a. High distinguishability.
- b. Low distinguishability.

Trademarks are powerful product distinguishers with a robust protection framework. In contrast, less distinguishable Trademarks weaken a brand's protection. A trademark protects a brand's uniqueness, which principle also applies to a third party's brand.<sup>6</sup>

To prevent Trademark imitation or duplication, particularly of a well-known brand, sufficient understanding of well-known brand criteria and definition is required. While the measurement of "popularity" is highly debated, its certainty is essential to protect well-known brands worldwide, more specifically, in Indonesia. Many parties purposely or not exploited this gap for unfair use of well-known Trademarks. Such as in the case of TBL Licensing LLC, the holder of the Timberland brand against Timberlake Indonesia, owned by Indra Halim.

The similarities between Indra Halim's brand number IDM000471725 under the Timberlake Trademark with the Timberland brand No. IDM000010344, registered on 9 July 2004 added with agenda number R.2991/2014 dated 26 February 2014, can be seen from:<sup>7</sup>

- a. Dominant aspect of pronunciation. Both brands' initial pronunciation is "Timber". This similarity potentially misleads consumers' conclusion that the defendant's brand is similar to the plaintiff's as they sound and appear identically.
- b. Aspect of product classification. The plaintiff's brand, Timberland, is categorised under class 25, which includes products such as T-shirts, men's, women's, and children's trousers,

<sup>4</sup>Dandi Pahusa, (1 Juni 2015). *Persamaan Tidak Pokok Pada Suatu Merek Terkenal*, (Analisis Putusan MA Nomor 162 K/Pdt.Sus-HKI/2014), Jurnal Cita Hukum. Vol III Nomor 1, p 179.

<sup>5</sup>Emmy Yuhassarie, (2005) *Hak Kekeyaan Intelektual dan Perkembangannya*, Jakarta. Pusat Pengkajian Hukum, p 207.

<sup>6</sup>Dwi Agustine Kurniasih, (2008). *Perlindungan Hukum Pemilik Merek Terdaftar dari Pembuatan Pembongcengan Reputasi*, (Passing Off) Bagian II, Media HKI, Vol V, Nomor 6, Februari 2009, Dirjen HKI, Jakarta, p 10.

<sup>7</sup>Putusan Nomor 42/Pdt.Sus-Merek/2020/PN.Niaga.Jkt.Pst p 11.

shoes, clothes and sandals, belts, and hats. This is similar to the Timberlake brand that registered for products such as T-shirts, trousers, shoes, and sandals.

- c. Visual aspects. Besides the above similarities, these brands also have identical colours, particularly their striking black-and-white colours.

Basically, the judge is obliged to investigate and decide every legal issue that is applied by the public. During the investigation period, the plaintiff could demand the judges to establish an order to terminate the production, distribution and/ or selling of products that use the disputed Trademark. This demand aims to prevent greater loss of the plaintiff. The judges could order or determine the products' valuation once their decree is legally binding. Such a decree made by the industrial court could only be appealed to the Supreme Court.<sup>8</sup>

Timberland LLC is an American producer and retailer of outdoor footwear and clothes owned by VF Corporation. The company also sells accessories, including watches, sunglasses, and leather goods. Its headquarters are located in Stratham, New Hampshire. The Timberland brand has registered in at least 36 countries, including Indonesia.

The TIMBERLAND brand also registered in WIPO (World Intellectual Property Organisation), registration number IR509706, dated 11/10/1986, for products of category 01, 03, 08, 09, 11, 14, 16, 18, 20, 21, 22, 25, 26, 28 and 34. Thus, the defendant is suggested to change its name. Indeed, Timberland has registered in various countries. In Indonesia, it was registered in Trademark general registration, number IDM000010344, on 8 June 1995, was extended on 9 July 2004 under the number 336470, and re-extended on 26 February 2014, number R.2991/2014, which was classified under class 25. Consequently, Timberland exclusively holds and utilises the brand. It is entitled to prevent other parties from using the brand without Timberland's consent.

These facts are further emphasised in the court decree number 881 K/Pdt.Sus-HKI/2021. Particularly, it states that Timberland of TBL Licensing LLC sued the Timberlake brand of Indra Halim due to the use of a Trademark that resembles the plaintiff's. Timberlake is an Indonesian brand, registered in Dirjen HKI (Directorate General of Intellectual Property Rights) number IDM000471725 since 28 August 2015, goods classification 25.

The essential similarities of both Trademarks can be described as follows:

- 1) Dominant aspect of pronunciation aspect signs.
- 2) Classification similarities, both are registered under class 25.
- 3) Product and logo visual aspects which dominantly apply black and white (similar to the Timberland products).

In the Decree number 881 K/Pdt.Sus-HKI/2021 the judge concludes:

- Exception
- Refuse the defendant's claim
- Accept the whole plaintiff's lawsuit, which comprise:
  1. Declare that Timberland is a well-known Trademark
  2. Declare that the plaintiff is the sole owner of Timberland brand
  3. Timberlake resembles the essential aspects of the plaintiff's Trademark
  4. Timberlake registration, number IDM000471725 is terminated
  5. The defendant is obliged to pay for the trial fee.

<sup>8</sup>Iswi Haryani, 2010. *Prosedur Mengurus HAKI yang Benar*, Yogyakarta: Pustaka Yutistia, p. 114.

## CONCLUSION

A trademark is a sign attached to a good or service, aiming to distinguish it from similar products. The right holders may apply their privilege to any party. The Timberlake brand essentially resembles the Timberland brand, in terms of the following:

1) Pronunciation

Both brands' names begin with the "Timber" term, which could potentially mislead consumers into concluding that they are actually the same.

2) Products' classification

Both were registered under class 25 for clothes, footwear, and head cover.

3) Visual Aspect

Both were identical in the colour of their image and logo.

With the obvious similarities, the Timberland brand holder submitted a lawsuit against Timberlake. The principal evidence of total resemblance became the judges' main consideration to conclude this case. Basically, Timberland, held by TBL Licensing LLC, suited Timberlake of Indra Halim to the Supreme Court. Timberland was initially registered and essentially resembled Timberlake, registered later by Indra Halim to the Directorate General of Intellectual Property Rights. The Judges conclude that the Timberlake brand Indra Halim shall terminated from the Trademarks general registry and that the Timberlake is guilty of Trademark violation. Therefore, it obliged to compensate the plaintiff worth of Rp 5.000.000,00 (Five Billion Rupiah).

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