



# ANALYSIS OF THE JUDGE'S LEGAL CONSIDERATIONS ON THE TRADEMARK DISPUTE BETWEEN HONGYUNHONGHE TOBACCO (GROUP) Co. Ltd AND PT SUMATRA TOBACCO TRADING COMPANY (STUDY OF SUPREME COURT DECISION NUMBER 76 K/Pdt.Sus-HKI/2024)

**Firman Simarmata<sup>1</sup>, OK. Saidin<sup>2</sup>, Rosnidar Sembiring<sup>3</sup>**

<sup>1,2,3</sup> Universitas Sumatera Utara

Correspondence: Email [firmanSimarmata23@gmail.com](mailto:firmanSimarmata23@gmail.com)

## Abstract

*This study examines the legal considerations of the judges in resolving trademark disputes between Hongyunchonghe Tobacco (Group) Co. Ltd and PT Sumatra Tobacco Trading Company. The focus lies on the Supreme Court decision Number 76 K/Pdt.Sus-HKI/2024, which serves as a significant precedent in intellectual property rights law in Indonesia. The research aims to evaluate the legal protection provided for registered trademarks and analyze the dispute resolution mechanisms implemented in Indonesia, including the rationale behind the Supreme Court's decision. Using a normative legal research method, this study investigates primary and secondary legal sources to draw conclusions. The findings highlight that the proper registration and active use of trademarks are crucial in asserting ownership and protecting market rights. Furthermore, the court's decision reflects a strict application of the Trademark Law (Law Number 20 of 2016), emphasizing fairness for genuine trademark holders. This research contributes to understanding how trademark disputes are handled and offers insights into strengthening legal frameworks for trademark protection in Indonesia.*

**Keywords:** *Trademark disputes, legal considerations, Supreme Court decision, intellectual property rights, Hongyunchonghe Tobacco, PT Sumatra Tobacco Trading Company.*

## A. INTRODUCTION

IPR is human property that is intangible but plays a major role in advancing human civilization, so that IPR protection is provided by the state to stimulate the interest of Creators, Inventors, Designers, and Breeders, so that they can be more enthusiastic in producing new intellectual works for the advancement of society. Basically, IPR is a right that arises as a result of human intellectual ability in various fields that produce a process or product that is beneficial to humanity. Works in the fields of science, art, literature, or inventions in the field of technology are examples of works of creation as a result of human intellectual creativity, through their creations, feelings, and desires. These works of creation give rise to property rights for the creator or inventor.

The development of science and technology has a great influence on the issue of intellectual property rights and their legal protection. The problem is no longer purely in the field of intellectual property rights alone because there are many interests related to intellectual property rights, namely the economic and political fields that have become inseparable elements in discussing the issue of intellectual property rights.

The need, ability and technological progress of a product today is a market for the production of entrepreneurs who own trademarks and services. Everyone wants their products to have the freest possible access to the market, therefore the development in the field of trade and industry which is so rapid requires increased protection of the technology used in the manufacturing process, if the product is then circulated in the market using a certain brand, then the need to protect the marketed product from various unlawful actions is ultimately the need to protect the brand.

*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

One way to strengthen a healthy trading system in developing a brand of a product or service is by providing legal protection for brand registration. A brand (English: Brand) or trademark is a sign worn by entrepreneurs (factories, manufacturers, and so on) on goods produced as an identification mark. Article 1 Number 1 of Law of the Republic of Indonesia Number 20 of 2016 concerning Brands and Geographical Indications states "A brand is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in 2-dimensional and/or 3-dimensional forms, sound, hologram, or a combination of 2 or more of these elements to distinguish goods and/or services produced by a person or legal entity in the trading of goods and/or services." Brands are the heart of a business's sustainability, because it is through brands that a product can be recognized by the wider community. Even when the wider community is fanatical about a brand, people don't want to look at other brands. This means that brands are a tool that makes a product generate multiple profits. Reflecting on the benefits gained from the importance of the "name" contained in a brand, it certainly does not rule out the possibility of trademark disputes and/or having similar/identical brand names.

Trademark registration in this case is to provide a status that the registrant is considered the first user until someone else proves otherwise. Trademark rights do not exist without registration. This is what brings more certainty. Because if someone can prove that he has registered a trademark and he is given a Trademark Certificate which is proof of his ownership rights to a trademark, then other people cannot use it and other people do not have the right to use the same trademark for similar goods.

The definition of a brand in Article 1 point 1 of Law Number 20 of 2016 concerning Brands, defines a brand as a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services obtained by a person/legal entity in the trading of goods/services.

Many brands in Indonesia are experiencing disputes, such as the company HONGYUNHONGHE TOBACCO (GROUP) Co. Ltd., which is a cigarette company as stated in Decision Number 45/ Pdt.Sus/HKI/ Merek/ 2023/ Jkt. Pst where the Plaintiff is the owner and rights holder of the WIN Trademark which has been used in China since July 2005 and the Plaintiff's WIN Trademark has also been registered since July 28, 2005 with No. 3792948 to protect class 34 goods, which has been extended to be valid until July 27, 2026 and registered with No. 4029175 to protect class 34 goods and registered with No. 4181543 to protect class 34 goods:

The Plaintiff's WIN trademark has also been registered in the European Union (EUIPO) on March 3, 2020 with No. 018135805, and in addition to registration in the European Union (EUIPO), the Plaintiff's WIN trademark has been registered in various countries in the world, including:

1. South Korea registered under No. 40-1567875 to protect goods included in class 34;
2. New Zealand registered No. 1122293 on 6 December 2019 to protect goods included in class 11 and class 34.
3. South Africa registered under No. 2019/27099 to protect goods included in class 34;
4. Moldova registered under No. 34297 to protect goods included in class 11 and class 34;
5. Ecuador registered under No. 2511-12 to protect goods included in class 34.
6. Serbia registered under No. 77672 to protect goods included in class 34;

The case example discussed in this thesis is the Supreme Court decision Number 76 K/ Pdt.Sus HKI/2024, which states that HONGYUNHONGHE TOBACCO (GROUP) Co.

*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

**Ltd.**, represented by the Director, Wu Yi, domiciled at 181 Hongjin Road, Wuhua District, Kunming City, Yunann Province, China, in this case granting power of attorney to Marodin Sijabat, SH, and AFFA Intellectual Property Rights Advocates, having their offices at Graha Pratama Building, 15th Floor, Jalan MT Haryono Kaveling 15, Jakarta, based on a Special Power of Attorney dated June 22, 2022;

Applicant/formerly Plaintiff; Opponent PT SUMATRA TOBACCO TRADING COMPANY, represented by Director, Dani Ki, domiciled at Jalan Pattimura Number 3, Pemantang Siantar City, North Sumatra Province, in this case granting power of attorney to Jose Andreawan, SH, MH, and friends, Advocates at the Syamsu Djalal & Partners Law Firm, having an office at Vinion Building 3rd Floor #3, Jalan Raden Saleh Kaveling 13-17, Central Jakarta City, DKI Jakarta Province, based on a Special Power of Attorney dated October 20, 2023;

Respondent in cassation/formerly Defendant.

That the main dispute in this case is regarding the Plaintiff's interest in demanding the removal of the Defendant's WIN trademark based on the provisions of Article 74 paragraph (1) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications; That Judex Facti is in principle of the opinion that the Plaintiff has no interest because the Plaintiff is not hindered in submitting an application for his WIN trademark in Indonesia; That the Supreme Court is of the opinion that Judex Facti's consideration is inappropriate because the Plaintiff is the owner of the WIN trademark which has been registered in China and several countries that wish to invest in Indonesia by using his WIN trademark in Indonesia legally and safely from lawsuits so that the Plaintiff has an interest as referred to in the provisions of Article 74 paragraph (1) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications; That according to the Plaintiff's investigation through a third party, it was proven that the Defendant's WIN trademark had not been used since it was registered, namely for more than 3 (three) consecutive years, for which findings the Defendant did not submit strong evidence to refute the Plaintiff's findings; That thus it is reasonable for the WIN trademark registered in the name of the Defendant to be removed from the General Register of Trademarks; that based on the above considerations, the Supreme Court is of the opinion that there are sufficient reasons to grant the cassation request from the Cassation Applicant HONGYUNHONGHE TOBACCO (GROUP) Co. Ltd., and to cancel the Decision of the Commercial Court at the Central Jakarta District Court Number 45/Pdt.Sus-HKI/Merek/2023/PN Niaga Jkt. Pst.

Which previously decision Number 45/Pdt.Sus-HKI/Merek/2023/PN Niaga Jkt. Pst, That the Plaintiff is the owner and rights holder of the WIN Trademark which has been used in China since July 2005 and the Plaintiff's WIN Trademark has also been registered since July 28, 2005 with No. 3792948 to protect class 34 goods, which has been extended to be valid until July 27, 2026 and registered with No. 4029175 to protect class 34 goods and registered with No. 4181543 to protect class 34 goods; That the Plaintiff's WIN Trademark has also been registered in the European Union (EUIPO) on March 3, 2020 with No. 018135805, and in addition to registration in the European Union (EUIPO).

## **B. FORMULATION OF THE PROBLEM**

1. How is the Legal Protection for Registered Trademarks?
2. How Are Trademark Disputes Resolved in Indonesia?
3. How is the Judge's Legal Consideration of the Dispute Between Hongyunhonhe Tobacco Group and PT. Sumatra Tobacco Trading Company (Study of Supreme Court Decision Number 76K/ Pid.Sus-HKI/2024)?

## C. DISCUSSION

### 1. Legal Protection for Registered Trademarks

In simple terms, a brand can be defined as a tool to distinguish goods and services produced by a party or company. According to Article 1 number 1 of Law Number 20 of 2016 concerning Brands and Geographical Indications, what is meant by a brand is a sign that can be displayed graphically in the form of images, logos, names, words, letters, numbers, color arrangements, in the form of 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by a person or legal entity in the trading of goods and/or services.

A brand is an identity for every product issued by a company, a brand is identical to a certain name accompanied by an image or logo equipped with distinctive colors that are considered capable of describing the character of the company that makes the product. Based on the provisions of Article 1 number 1 of Law Number 20 of 2016 concerning Brands and Geographical Indications, it provides a definition of a brand, namely:

A brand is a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in 2 (two) dimensions and/or 3 (three) dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by a person or legal entity in the trading of goods and/or services.

A brand is an identifier that distinguishes one person's property from another's, such as the use of stamps and other signs that have distinguishing power so that they can distinguish goods or property from one person's property and that of another person that has similarities. Not only that, a brand is also a product attribute that is considered important, especially in fostering positive perceptions, and consumers will believe after assessing the attributes of a brand, positive perceptions and consumer trust in a brand will create a brand image. Ultimately, a brand is one of the factors that influences consumer interest in buying.

In addition to being a sign, a brand is also always identical to the quality of a product produced by a producer which then becomes an asset for the producer. The identity of a product also explains the quality of an item, it also indicates that the item has its own characteristics. In addition to functioning as an identifier, brands also have other functions in the trading of goods and services, namely:

- a. The identification mark or identity of a product, in other words, the brand functions as a distinguishing mark (Distinctive Function).
- b. Source indicator, brand is the link between the producer and the product produced.
- c. Quality indicators, in other words, brands function as a guarantee of quality (Quality Product Function). Trademarks of goods purchased by consumers will gradually form an impression in the memory of the consumer concerned that the brand is a symbol of the quality of goods or services.
- d. As a promotional tool, brands also function as a provider of attraction for goods and services, and at the same time are also advertisements or commercials for goods or services marked with the brand.

A good faith brand owner is an honest brand owner. Honest nature must be shown by the absence of the brand owner's intention to cheat on other people's brands. The definition of other people's brands is limited to brands that are already known in the

community. The application of bad faith in trademark registration is used as a reason for trademark cancellation according to the Trademark Law, with the aim of determining the application of similarities in principle and bad faith in a lawsuit for cancellation of trademark registration. The reason for the cancellation of a trademark registration based on similarities in principle is the same as that proven in good faith in a lawsuit for cancellation of trademark registration. The good principle is a requirement that must be met when registering a brand, the article states in Article 21 of Law Number 20 of 2016 that a brand registration application will not be accepted if it does not have good faith. In this context, it can be correlated that the principle of good faith is an absolute thing for the subsequent use of rights to a particular brand.

Its history, if seen in the use of the term Intellectual Property Rights (IPR), is still relatively new considering that previously Indonesia used the term Intellectual Property Rights (HMI). According to experts, the use of the term Intellectual Property Rights is considered inappropriate or does not yet describe the main elements contained in Intellectual Property Rights (IPR). However, the use of the term Intellectual Property Rights is still often used considering that it is logical in the normative legal framework. This is because the use of the term Intellectual Property Rights is based on the concept of property rights as regulated in the second book of the Civil Code.

The definition of a legal object itself is something that can provide enjoyment for legal subjects who have rights to that thing, whether in the form of movable or immovable objects. Legal objects are everything that is useful for legal subjects and can be the subject of a legal relationship carried out by legal subjects. In legal language, legal objects can also be called rights or objects that can be controlled and/or owned by legal subjects. For example, A borrows a book from B. Here, the legal object in the legal relationship between A and B is the book. The book becomes the legal object of the rights owned.

## **2. Trademark Dispute Resolution in Indonesia**

Competition in trade in the current era is a common thing in society. In this case, people compete to create a brand that can attract purchasing power for consumption or daily use. Not only brands are used in a product, along with the development of technology, new ideas or concepts have emerged regarding online services that have quite a large appeal in society. This online-based service itself is in great demand by home entrepreneurs and companies with legal entities or companies that are not legal entities. Often there are criminal practices in trade, one of which is imitation of a well-known brand which is then produced or used in applications by companies or medium to large/low businesses, which are not the original owners who first issued the brand.

Making a famous brand is not easy, it takes a long time and process, this makes other business producers do fraudulent ways to gain profit for their business by imitating famous brands so that their business is as famous as famous brands that are already known to the public. Brand counterfeiting damages the trade market because it is considered to disrupt marketing and cause conflict between several parties. Maintaining the balance of the rights of registered brand owners The law has provided protection to maintain the balance of trade.

The occurrence of brand imitation is a sign of unfair competition in the trade of goods or services, because brand imitation is an action that is quite detrimental to the owner of the brand. The reason is, the brand that is imitated is a brand that is already well-known in society. Everyone knows that even though not all famous brands in Indonesia are registered, because many people do not know how to register the brand they own in



*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

---

order to get a certificate of brand rights. Famous brand entrepreneurs are not only protected by a company, but are owned by some ordinary people or can be said to be home production that initially opened a small shop changed over time that they did not expect that their business would immediately be successful when the business they were running sold with the brand they had made, which then many business competitors imitated the same brand and the same production too, did not have the distinguishing power in the use of the brand with the aim of being a sign that cannot be achieved if other parties or consumers cannot distinguish one brand from another. The following are some disputes over imitation of famous brands that have occurred in Indonesia:

Cancellation of a well-known mark which has imitated the similarity or approximation of words, sounds, signs, seals and logos can be done at the Commercial Court or Supreme Court as intended in article 68 paragraph (2). Cancellation of a famous mark which has imitated the similarity or approximation of words, sounds, signs, seals and logos can be canceled by the Commercial Court or Supreme Court as intended in article 68 paragraph (2) and paragraph (3) of Law no. 20 of 2016 concerning Brands and Geographical Indications:

Article 68 paragraph (2), "In the event that the sign as referred to in paragraph (1) has been registered as a trademark, the Minister shall cancel and strike out the registration of the trademark for all or part of the same type of goods after a period of 2 (two) years from the time the sign is registered as a Geographical Indication."

Article 68 paragraph (3), "Cancellation and deletion of trademark registration as referred to in paragraph (2) must be notified in writing to the trademark owner or his attorney stating the reasons."

Cancellation of a trademark is done with a strong enough reason to cancel it because it has similarities as a whole or not as a whole that has similarities, in principle which means that the trademark is completely copied as a whole if it is felt that the imitation trademark is disturbing the market, it can request an appeal in the Commercial Court. Imitation of famous trademarks is indeed not uncommon in Indonesia, many people underestimate the protection of trademark rights in order to get their own benefits, harming other parties who have certificates of rights to the trademark.

Cancellation of a brand is done because of bad intentions using someone else's brand without permission and knowledge of the person who owns the brand rights, canceling the registration of a brand that without permission uses the same words or pronunciation and uses the same logo can be submitted to the commercial court to ask for justice, the use of a brand without permission then registered intentionally without the knowledge of the brand owner often happens like that causing conflict between other producers fighting for brand rights who believe each other that there is no element of imitating a well-known brand. Entrepreneurs who start their business by imitating a well-known brand but often change the vocabulary and add word management but still look the same because of the use of a logo that resembles which makes entrepreneurs believe that the brand created is not the same as a well-known brand, on average entrepreneurs who use the same brand words as well-known brands do not understand what sanctions they get when using a well-known brand.

Protection of a registered trademark does not require either "novelty" or "originality", with this a trademark that has been used for years can still be registered, as long as it does not have any similarities either in whole or in principle with a trademark owned by another party that was previously registered and an application for registration was submitted to the Directorate General of Intellectual Property Rights (Dirjen HKI).

**3. Legal Considerations of the Judge on the Dispute Between Hongyunhonhe Tobacco Group and PT. Sumatra Tobacco Trading Company (Study of Supreme Court Decision Number 76K/ Pid.Sus-HKI/2024)**

HONGYUNHONHE TOBACCO GROUP as the plaintiff and the defendant is PT. SUMATRA TOBACCO COMPANY as in the decision Number 45/ Pdt.Sus/ 2023/ PN.Niaga Jkt Pus That the Plaintiff is the owner and rights holder of the WIN Trademark which has been used in China since July 2005 and the Plaintiff's WIN Trademark has also been registered since July 28, 2005 with No. 3792948 to protect class 34 goods, which has been extended to be valid until July 27, 2026 and registered with No. 4029175 to protect class 34 goods and registered with No. 4181543 to protect class 34 goods;

- a. That the Plaintiff's WIN Trademark has also been registered in the European Union (EUIPO) on March 3, 2020 with No. 018135805, and in addition to registration in the European Union (EUIPO), the Plaintiff's WIN Trademark has been registered in various countries in the world, including:
  - 1) South Korea registered under No. 40-1567875 to protect goods included in class 34;
  - 2) New Zealand registered No. 1122293 on 6 December 2019 to protect goods included in class 11 and class 34;
  - 3) South Africa registered under No. 2019/27099 to protect goods included in class 34;
  - 4) Moldova registered under No. 34297 to protect goods included in class 11 and class 34;
  - 5) Ecuador registered under No. 2511-12 to protect goods included in class 34;
  - 6) Serbia registered under No. 77672 to protect goods included in class 34;
  - 7) Kyrgyzstan registered under No. 16809 to protect goods included in class 11 and class 34;
- b. That in order to obtain legal protection in Indonesia, the Plaintiff as the owner of the WIN Trademark has filed a Request for Registration of the WIN Trademark with the Directorate of Trademarks and Geographical Indications, Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia with Application Number DID2023020309 to protect the types of goods: "Liquid solution for use in electronic cigarettes; Flavorings, other than essential oils, for tobacco; cigarette filters; filters for cigarettes; matches; lighters for smokers; cigarettes; electronic cigarettes; tobacco; hand-rolled tobacco", which are included in class 34;
- c. That based on the provisions of Article 1 letter (a) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, it 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 2 (two) dimensions and/or 3 dimensions, sound, hologram, or a combination of 2 (two) or more of these elements to distinguish goods and/or services produced by a person or legal entity in the trading of goods and/or services";
- d. That the Plaintiff's WIN trademark is the result of the Plaintiff's creativity to be used as a trademark for its products in order to differentiate the Plaintiff's products and services from the products and services of other people or other legal entities;

*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

- e. That the Plaintiff is aware that the Defendant has registered the WIN trademark registered No. IDM000030697 with the Directorate of Trademarks, Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia to protect the types of goods: "WIN Cigarettes, kretek cigarettes, chopped cloves, tobacco and cigars", which are included in class 34;
- f. That in accordance with the provisions of Article 1 letter (e) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, it states: "Rights to a Trademark are exclusive rights granted by the state to the owner of a registered Trademark for a certain period of time by using the Trademark himself or granting permission to another party to use it";
- g. That based on the provisions of Article 1 letter (a) in conjunction with Article 1 letter (e) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, the Defendant should have used the registered WIN trademark No. IDM000030697, but based on the results of the search and investigation obtained by the Plaintiff in the markets in various regions in Indonesia, it turns out that the registered WIN trademark No. IDM000030697 to protect the type of goods "WIN Cigarettes, kretek cigarettes, chopped cloves, tobacco and cigars", which are included in class 34 since they were registered have never been used by the Defendant for 3 (three) consecutive years, because the Defendant has never produced and marketed the products and/or types of goods above using the registered WIN trademark No. IDM000030697;
- h. That the Defendant's actions in not using the registered WIN trademark No. IDM000030697 for 3 (three) consecutive years in the trade of goods and/or services since the date of registration of the registered WIN trademark No. IDM000030697 or the last use of the goods in accordance with that stated in the registered WIN trademark certificate No. IDM000030697, then the registration of the registered WIN trademark No. IDM000030697 in the name of the Defendant can clearly be deleted as referred to in Article 74 paragraph (1) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications;
- i. That in accordance with the provisions of Article 74 paragraph (1) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, it states: "The deletion of a registered Trademark may also be submitted by a third party in the form of a lawsuit to the Commercial Court on the grounds that the Trademark has not been used for 3 (three) consecutive years in the trade of goods and/or services since the date of registration or last use";
- j. That based on the explanation of Article 76 paragraph (1) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, it states: "What is meant by interested parties include, among others, registered trademark owners, prosecutors, consumer foundations/institutions, and religious councils/institutions";
- k. That as the owner and rights holder of the WIN Trademark which has been registered, namely registered in the European Union and in various countries, then because the Plaintiff has also submitted a Request for Registration of the WIN Trademark to the Directorate of Trademarks and Geographical Indications, Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia with Application Number DID2023020309 to protect class 34 goods, then in this case the Plaintiff is very interested and is a third party as referred to in Article 74 paragraph (1) of Law No. 20 of 2016 concerning Trademarks and Geographical Indications;
- l. That based on the provisions of Article 74 paragraph (1) and Article 1 letter (a) and Article 1 letter (e) of Law No. 20 of 2016 concerning Trademarks and Geographical



*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

Indications, the filing of a lawsuit for the a quo deletion by the Plaintiff as a third party is very legally justified and therefore it is appropriate that the lawsuit be filed. The Plaintiff's claim was granted in its entirety. Then, with the Defendant not using the registered WIN trademark No. IDM000030697 for 3 (three) consecutive years in the trade of goods and/or services since the date of registration or last use as the results of the search and investigation obtained by the Plaintiff in the market in various regions in Indonesia, it is appropriate that the registered WIN trademark No. IDM000030697 in the name of the Defendant be deleted by the Central Jakarta Commercial Court;

- m. That in the a quo case, even though the Government of the Republic of Indonesia cq. Ministry of Law and Human Rights of the Republic of Indonesia cq. Directorate General of Intellectual Property cq. Directorate of Trademarks and Geographical Indications is not made a party, it does not make the Plaintiff's lawsuit less party. This is in line with the Permanent Decision of the Supreme Court of the Republic of Indonesia Number 471 K/Pdt.Sus-HKI/2019 dated June 11, 2019, which provides the following consideration: "That based on the provisions of Article 91 and Article 92 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications, there is no obligation to sue the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia because even though it is not made a party, the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia must submit to and obey all court decisions that have permanent legal force." Likewise, the Permanent Decision of the Supreme Court of the Republic of Indonesia Number 991 K/Pdt.Sus-HKI/2019 dated October 29, 2019 provides the consideration: "That for the deletion of a trademark or cancellation of a trademark there is no requirement to sue the Directorate General of Intellectual Property because in essence the Directorate General of Intellectual Property will implement the Decision of the Commercial Court a quo".
- n. That in Law No. 20 of 2016 concerning Trademarks and Geographical Indications, namely CHAPTER XV DISPUTE RESOLUTION, Part Four, Procedures for Executing Decisions, especially Articles 91 and 92, states:  
Article 91 paragraph (1): The cancellation based on a court decision is carried out after the Minister receives an official copy of the decision which has permanent legal force and is announced in the Official Trademark Gazette.  
That as in the judge's decision which rejected the plaintiff's lawsuit, the plaintiff made a cassation appeal to obtain his rights.

### **Judge's Legal Considerations**

HONGYUNHONGHE TOBACCO (GROUP) CO.LTD., a company established under the laws of the Republic of China, domiciled at 181 Hongjin Road, Wuhua District, Kunming City, Yunann Province, China, in this case represented by Wu Yi as Director who grants Power of Attorney to Marodin Sijabat, SH; Zenery Perangin- angin, SH; M. Chalis Damrah, SH and Ardila Rahmanita, SH, Advocates and Legal Consultants (HKI) from Affa Intellectual Property Rights Advocate & Legal Consultant with offices at Graha Pratama Building 15th Floor, Jl. MT Haryono Kav. 15, Jakarta 12810, Indonesia based on Power of Attorney dated June 22, 2022. Hereinafter referred to as the Plaintiff; That the Plaintiff is the owner and rights holder of the WIN Trademark which has been used in China since July 2005 and the Plaintiff's WIN Trademark has also been registered since July 28, 2005 with No. 3792948 to protect class 34 goods, which has been extended to be

*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

valid until July 27, 2026 and registered with No. 4029175 to protect class 34 goods and registered with No. 4181543 to protect class 34 goods;

That the Plaintiff's WIN Trademark has also been registered in the European Union (EUIPO) on March 3, 2020 with No. 018135805, and in addition to registration in the European Union (EUIPO), the Plaintiff's WIN Trademark has been registered in various countries in the world, including:

South Korea, New Zealand, Africa, etc. The Plaintiff's WIN trademark is the result of the Plaintiff's creativity to be used as a trademark for its products in order to distinguish the Plaintiff's products and services from the products and services of other people or other legal entities. In order to obtain legal protection in Indonesia, the Plaintiff as the owner of the WIN trademark has filed a WIN Trademark Registration Request with the Directorate of Trademarks and Geographical Indications, Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia with Application Number DID2023020309 to protect the types of goods: "Liquid solution for use in electronic cigarettes; Flavorings, other than essential oils, for tobacco; cigarette filters; filters for cigarettes; matches; lighters for smokers; cigarettes; electronic cigarettes; tobacco; hand-rolled tobacco", which is included in class 34. Granted the cassation request from the Cassation Applicant.

That as in Number 76 K/Pdt.Sus-HKI/2024 Granting the Plaintiff's lawsuit in its entirety; Declaring that the Defendant has not used the registered WIN trademark Number IDM000030697 for 3 (three) consecutive years in the trade of goods since the date of registration or last use; Declaring the deletion and/or removal of the registered WIN trademark Number IDM000030697 in the name of the Defendant from the General Register of Trademarks.

## **D. CLOSING**

### **1. Conclusion**

- 1) If there is a party that violates the trademark, the trademark holder can sue for compensation for the losses that have been experienced due to the trademark violation. Then it can also be done with a Lawsuit, where the trademark holder can take legal action against the party that violates the trademark. Legal actions that can be taken include through civil or criminal channels. Based on Article 35 of Law Number 20 of 2016 states that registered trademarks receive legal protection for a period of 10 (ten) years from the date of receipt and the protection period can be extended and can be extended for the same period.
- 2) Trademark disputes that occur in Indonesia can be resolved through lawsuits in court or alternative dispute resolution such as arbitration.. In a trademark dispute there must be a defendant (PT Sumatra Tobacco Trading) and a plaintiff Hongyunhohne (Corporation). The defendant is the owner of a registered trademark where the lawsuit filed is a cancellation or deletion of the trademark in order to create justice for the original trademark holder.
- 3) The judge's legal considerations in the decision to grant the cassation request from the cassation applicant That as in Number 76 K/Pdt.Sus-HKI/2024 Granting the Plaintiff's lawsuit in its entirety; Declaring that the Defendant has not used the registered WIN trademark Number IDM000030697 for 3 (three) consecutive years in the trade of goods since the date of registration or last use; Declaring the deletion and/or removal of the registered WIN trademark Number IDM000030697 in the name of the Defendant from the General Register of Trademarks.

## REFERENCES

### Buku:

- Agus Sudaryanto, 2015, *Pengantar Ilmu Hukum Pengertian dan Perkembangannya di Indonesia*, (Malang: Setara Press).
- Amirulloh, Muhammad, 2017. *Cyberlaw Perlindungan Merek Dalam Cyberspace* (Cybersquatting Terhadap Merek), Bandung, PT. Refika Aditama.
- Dudu Duswara Machmudin, 2010, *Pengantar Ilmu Hukum sebuah sketsa*, (Bandung: Refika Aditama).
- Muhammad dan R. Djubaedillah, Hak Milik Intelektual, 1997, Sejarah, Teori dan Prakteknya di Indonesia, Bandung, Citra Aditya Bakti.
- Burkhart Goebel, Bukrkhart, 2009, *Trademarks As A Fundamental Rights-Europe*, The Trademark Reporter.
- Firmansyah, Heri, 2013, *Perlindungan Hukum Terhadap Merek*, (Yogyakarta: Medpress Digital.
- Iswi Hariyani, 2010, *Prosedur Mengurus HAKI yang Benar*, (Yogyakarta: Pustaka Yustisia.
- Jened, Rahmi, 2015, *Hukum Merek Trademark Law*, (Jakarta, Kencana Pranadamedia Group).
- Lexy J. Moleong, 2009, *Metodologi Penelitian Kualitatif*, Bandung: Remaja Rosdakarya.
- Kansil, CST, 1989, *Pengantar Ilmu Hukum dan Tata Hukum Indonesia*, (Jakarta: Balai Pustaka).
- Kansil, CST, 2009, *Pengantar Ilmu Hukum dan Tata Hukum Indonesia*, (Jakarta: Balai Pustaka).
- Maulana, Insan Budi, 1997, *Sukses Bisnis Melalui Merek, Paten dan Hak*, (Bandung, Citra Aditya Bakti).
- Mulyadi Lilik, 2007, *Kompilasi Hukum Pidana dalam Perspektif Teoritis dan Praktek pradilan*. Mandar Maju.
- Nasution, Bahder Johan 2008, *Metode Penelitian Ilmu Hukum*, Bandung: Mandar Maju.
- Ni Ketut Supasti Dharmawan, et al.,2016, *Buku Ajar Hak Kekayaan Intelektual*, (Yogyakarta: Deepublish).
- Phillipus M. Hadjon, 1987, *Perlindungan Hukum Bagi Rakyat Indonesia*, PT. Bina Ilmu, Surabaya.
- Raharjo, Satjipto, 2000, *Ilmu Hukum*, Bandung, PT. Citra Aditya Bakti.
- Rahardjo, Satjipto, 2012, *Ilmu Hukum*, Bandung, Citra Aditya Bakti.
- Ruslan, Suriyanto, 2009, *Mendesain Logo*, (Jakarta, Gramedia Pustaka).
- Saidin,2008, *Aspek Hukum Hak Kekayaan Intelektual (Intellectual Property Rights)*, (Jakarta, Rajawali Press).
- Soeroso, 2011. *Pengantar Ilmu Hukum*, Jakarta, Pt. Sinar Grafika.
- Soekanto, Soerjono, 2014, *Pengantar Penelitian Hukum*, Jakarta: Universitas Indonesia (UI-Press) Cet Ketiga.
- Setiono, 2004, *Supremasi Hukum*, (Surakarta: UNS)
- Sjahputra, Iman, 2010, *Perlindungan Konsumen dalam Transaksi Elektronik*, Alumni, Bandung).
- Sukiati, 2017, *Metode Penelitian Suatu Pengantar*, Medan: Perdana Publishing, hlm.
- Sunarso, Siswanto, 2009, *Hukum Informasi dan Transaksi Elektronik*, (Jakarta: Rineka Cipta).
- Soekardono, R. 2004. *Hukum Dagang Indonesia*, Jakarta: PT RajaGrafindo Persada.
- Soeroso, R. 2006. *Pengantar Ilmu Hukum*, Jakarta: Sinar Grafika.

*Firman Simarmata, OK. Saidin, Rosnidar Sembiring*

---

- Sudaryanto, Agus. 2015. *Pengantar Ilmu Hukum Pengertian dan Perkembangannya di Indonesia*, Malang: Setara Press.
- Sugiyono. 2016. *Metode Penelitian Kualitatif dan R&D*, Bandung: Alfabeta.
- Sunggono, Bambang. 2003. *Metode Penelitian Hukum*, Jakarta: PT. Raja Grafindo Perkasa.
- Suryabrata, Sumadi. 1987. *Metode Penelitian*, Jakarta: Rajawali.
- Suryatin. 2004. *Hukum Dagang I dan II*, Jakarta: PT Raja Grafindo Persada

### **Jurnal/ Karya Ilmiah**

- Ali Ismail Shaleh, Shabirah Trisnabilah, “Perlindungan Hukum Terhadap Persamaan Merek Untuk Barang Atau Jasa Yang Sejenis: Studi Merek Bossini”, *Journal of Judicial Review*, Vol. 22 Nomor 2, (2020).
- Fajar Nurcahya Dwi Putra, “Perlindungan Hukum Bagi Pemegang Hak Atas Merek Terhadap Perbuatan Pelanggaran Merek”, *Mimbar Keadilan Jurnal Ilmu Hukum*, Edisi: Januari-Juni (2014).
- I Made Diyama Putra, et al., “Perlindungan Hukum Bagi Pemegang Hak Merek Di Indonesia”, *Ganec Swara*, Vol. 16 Nomor 2, Desember (2022).
- Nur Hidayati, “Perlindungan Hukum Bagi Merek yang Terdaftar”, *Ragam Jurnal Pengembangan Humaniora*, Vol. 11 Nomor 3, Desember (2011).
- Patrichia Weyni Lasut, “Penyelesaian Sengketa Gugatan Atas Pelanggaran Merek Menurut Undang-Undang Nomor 20 Tahun 2016 Tentang Merek Dan Indikasi Geografis”, *Lex Et Societatis*, Vol. 7 Nomor 1 Januari (2019).
- Putu Eka Krisna, “Perlindungan Hukum terhadap Hak Merek Terkenal di Indonesia”, *Jurnal Universitas Udayana*, Vol. 6 Nomor 11, 2018.
- Putri Permata Amalia, “Perbedaan Penerapan Syarat Pembatalan Merek Terkenal Antara Pengadilan Niaga dan Mahkamah Agung Dalam Kasus Piaget dan Piaget Polo”, *Jurnal Mahasiswa Fakultas Hukum Universitas Brawijaya*, (2015).