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Legal Protection Of First To Use In The Trademark Registration System Based On Law Number 20 Of 2016 (Study of Decision Number 33/Pdt.Sus HKI/Merek/2025/PN Niaga Jkt.Pst)

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ABSTRACT

This study examines the legal protection of the first to use principle in the trademark registration system in Indonesia based on Law Number 20 of 2016. Although Indonesia fundamentally adheres to a constitutive system (first to file), trade practices often give rise to disputes where parties who have used a trademark first are actually harmed by registrants who act in bad faith. The purpose of this study is to analyze the regulation of the trademark registration system and evaluate the judge's considerations in Decision Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst regarding the RUNMOUNT trademark dispute. The research method used is normative juridical with a qualitative approach, which examines secondary data in the form of laws and court decisions. The research findings indicate that although the registration system aims to provide legal certainty, there are gaps in substantive injustice when judges apply well-known trademark standards rigidly. In the RUNMOUNT case, the Panel of Judges rejected the cancellation lawsuit by ignoring evidence of the Plaintiff's use of the trademark for six years, and prioritizing older jurisprudence over the latest regulations such as Permenkumham Number 67 of 2016. This research contribution emphasizes the importance of a balance between administrative certainty and protection for honest trademark users (first to use) to prevent unfair business competition. In conclusion, overly formalistic decisions can reduce the protection rights of small business actors in the digital era.

Keywords: Legal Protection, First to Use, Trademark Registration.

INTRODUCTION

The development of trade and services in the era of globalization has increased the need for legal protection for intellectual property rights. Intellectual Property Rights are rights granted by the state to individuals and legal entities over the intellectual works they

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produce.[1]Protection of these rights plays a strategic role in supporting economic growth and creating healthy business competition. One form of intellectual property rights that plays a crucial role in economic activity is the trademark.[2]As part of intellectual property rights, a trademark serves a fundamental function as a distinguishing mark that identifies the origin of goods and/or services and differentiates them from similar products owned by other parties. In commercial practice, a trademark serves not only as an identity but also as a representation of the reputation, quality, and guarantee of a product offered to consumers.[3]

Conceptually, legal protection for trademarks is aimed at achieving legal certainty and fairness in the trade system. This legal certainty is reflected through a registration system that provides formal legitimacy for trademark ownership and protection against unauthorized use by others.[4]However, fairness cannot only be measured from these formal aspects, but must also take into account the reality of brand use in practice.[5]In this context, protection for parties who previously used a trademark in bad faith is crucial to ensuring substantive justice. Therefore, an ideal trademark protection system must balance registration-based legal certainty with fairness that considers the first-to-use principle in judicial practice.[6]

In the Indonesian legal system, legal protection for brands is regulated in Law Number 20 of 2016 concerning Brands and Geographical Indications.[7]However, in business practice, it is not uncommon to find situations where a party has actually used a trademark for a certain period of time before officially registering it. This use reflects a factual relationship between the business actor and the trademark in question, both in terms

[1] Yulia. Intellectual Property Rights Law (Lhokseumawe: CV. Sefa Bumi Persada, 2021, p. 9.
[2] Insan Budi Maulana et al. Intellectual Property Rights (Theory and Problems) (Jakarta: PT Rajawali Buana Pusaka, 2024), p. 45.
[3] Rahmi Jened, Trademark Law. (Jakarta: Prenadamedia Group, 2013), p. 3.
[4]Rouf Fajrin Widiantoro, Trademark Registration as a Means of Legal Protection, Lex Renaissance 7, no. 2 (2022): p. 417.
[5] Selni Ardian, Muryanto Lanontji, and Rima Anggriyani, "First to File Principle and Trademark Rights Disputes in the Study of Legislation in Indonesia," Staatsrecht Journal of State Law and Islamic Politics 5, no. 1 (2025): p. 23.
[6] Sebastian Edward Mardianto and R Rahaditya, "Analysis of Legal Provisions and the Implementation of the First to File System in Cases of Cancellation of Registered Trademarks," Ranah Research: Journal of Multidisciplinary Research and Development 7, no. 1 (2024): p. 152.
[7] Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications.

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of reputation, marketing, and consumer recognition. Therefore, conceptually, first use is relevant in determining the legal interests that deserve protection.

Positive law provides protection for parties who use a brand first through a brand cancellation mechanism, especially if the registration is carried out in bad faith as regulated in Law Number 20 of 2016 in Article 21 paragraph (3) which states that an application will be rejected if submitted by an applicant who acts in bad faith. Article 76 paragraph (2) states that the owner of an unregistered brand can file a lawsuit as referred to in paragraph (1) after submitting an application to the minister. This provision shows that the brand registration system is not absolute, because it still opens up the possibility of correcting registrations that are carried out illegally. Thus, legal protection is not solely based on administrative formalities, but also considers aspects of substantive justice. However, in practice, protection for first users still faces various obstacles, especially in the provision of evidence and assessment by judges. This condition shows an imbalance between the brand registration system and protection for first users.[8]

This problem is reflected in Case Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst, a trademark cancellation lawsuit filed by Agung Mardian as Plaintiff against Abu Solih Muhamad as Defendant, with the participation of the Government of the Republic of Indonesia cq. Ministry of Law of the Republic of Indonesia cq. Directorate General of Intellectual Property cq. Directorate of Trademarks and Geographical Indications as Co-Defendant. This lawsuit centers on a dispute over ownership of the RUNMOUNT trademark for class 25 of goods, namely sportswear products traded through e-commerce platforms.

The Plaintiff argued that he had been using the RUNMOUNT trademark since 2018 through various e-commerce platforms, including Shopee, Instagram, and Tokopedia, long before the registration made by the Defendant on September 20, 2024. Due to his negligence in officially registering the trademark, the Plaintiff only submitted an application to register the RUNMOUNT trademark on November 11, 2024. The Defendant himself, who has no relationship with the Plaintiff, had previously registered an identical

[8] Ibid., Article 21 Paragraph (3) and Article 76 paragraph (2).

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trademark and successfully obtained registration with Number IDM001320199 dated March 26, 2025.

Thus, the Plaintiff filed a lawsuit to cancel the Defendant's trademark based on the argument of bad faith as referred to in Article 21 paragraph (3) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications (hereinafter referred to as the Trademark Law). However, in the end, the Panel of Judges at the Commercial Court at the Central Jakarta District Court rejected the Plaintiff's lawsuit in its entirety through a decision dated July 24, 2025.[9]

Previous research by Farah Zhafirah Putri Lubis and R. Rahaditya (2023) showed that although the Indonesian trademark legal system adheres to the registration principle, protection for first users is still possible through a mechanism for proving trademark use in cancellation disputes. The first-to-use principle is not explicitly regulated, but it is implicitly used as a basis for assessing bad faith in trademark registration.[10]Further research conducted by Susi Marlina Manurung (2026) shows that first-to-use remains relevant in trademark protection, even though it is not explicitly regulated. The existence of this principle is implicitly reflected in the trademark cancellation mechanism and the assessment of bad faith in registrations.[11]This research fills this gap with a normative juridical approach based on a case study that specifically analyzes Decision Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst, to examine how judges assess the element of bad faith and how the first to use principle is applied in judicial practice.

Based on this description, the problem formulation in this research is:

1. How is the RUNMOUNT Trademark Registration System Arranged Based on the First to Use Principle in Law Number 20 of 2016 Concerning Trademarks and Geographical Indications?

[9] Decision of the Supreme Court of the Republic of Indonesia Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst.
[10]Farah Zhafirah Putri Lubis and R. Rahaditya, "Implementation of the First to Use Principle in Trademark Cancellation Based on Law Number 20 of 2016," Syntax Literate: Indonesian Scientific Journal 8, no. 5 (2023): p. 3219.
[11]Susi Marlinda Manurung, "Legal Certainty Regarding the First to Use Principle in Protecting Registered Trademarks in Indonesia," Encyclopedia Research and Community Service Review 5, no. 2 (2026): p. 324.

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2. What were the Judge's Considerations in Deciding on Case Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst?

The purpose of the research is This research aims to analyze legal protection against the first to use principle in the trademark registration system based on Law Number 20 of 2016 and to examine the legal considerations in Decision Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst, particularly regarding the assessment of the element of bad faith.

METHODS

The research method used in this study is a normative legal research method. Normative legal research relies on written positive law as the primary data obtained through library research, examining legislation, court decisions, and relevant literature. This type of research is descriptive-analytical, as it not only describes applicable legal provisions but also analyzes their application in judicial practice.

This research focuses on the study of Law Number 20 of 2016 concerning Trademarks and Geographical Indications and decision Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst. The data sources used consist of primary legal materials and secondary legal materials obtained through books, journals, and scientific works related to trademark law, especially the principle of first to use.

The data collection technique was carried out through decision studies by examining various relevant legal materials. The data obtained were then analyzed qualitatively using legal interpretation and juridical analysis methods, namely by connecting normative provisions and the judge's considerations in the decision to gain an understanding of legal protection for the principle of legal protection.*first to use*in the trademark registration system.

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DISCUSSION

The RUNMOUNT Trademark Registration System Regulations are Based on the First To Use Principle in Law Number 20 of 2016 Concerning Trademarks and Geographical Indications.

The regulations for the trademark registration system in Indonesia are regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications. This law defines a trademark as a sign that can be displayed graphically in the form of an image, logo, name, word, letter, number, color arrangement, in two-dimensional form, hologram sound, or a combination of these elements to distinguish goods and/or services produced by a person or legal entity. The trademark registration system in Indonesia adheres to the constitutive principle (first to file), which emphasizes that trademark rights are obtained after registration. This provision is expressly regulated in Article 3 of Law Number 20 of 2016.[12]This system is designed to provide legal certainty and prevent future brand ownership conflicts.[13]

The trademark registration system in Indonesia, as adopted in Law Number 20 of 2016, stipulates that the owner of trademark rights is the registrant who first submits a registration application. From the authors' perspective, the implementation of this system is intended to provide clear legal certainty regarding the subjects who have the right to use a trademark, so that the legal relationship between the trademark owner and competitors and consumers can be regulated in a more structured manner.[14]The purpose of trademark registration is to provide legal protection to trademark owners, guarantee legal certainty in trade activities, and prevent unfair business competition.[15]

The trademark registration mechanism under Law Number 20 of 2016 is not only administrative but also includes substantive testing aspects. This is reflected in the examination stages, which include formal examination as stipulated in Article 4,

[12] Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications Article 3.
[13] Tommy Hendra Purwaka, Brand Protection (Yayasan Pustaka Obor Indonesia, 2018), p.15.
[14]Hani Subagio, Muhamad Ridwan, and Vinsensius Yonakolas Fiodian, Fair Trademark Protection (Jakarta: BRIN Publisher, 2024), p. 5.
[15]Yusuf Gunawan Trademark Law (Padang: Gemilang Press Indonesia. 2024. P. 105)

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announcement in the official trademark gazette as stipulated in Article 14, and substantive examination as stipulated in Articles 20 and 21. In the substantive examination stage, an application can be rejected if it is submitted in bad faith. Thus, the state not only records the registration but also assesses the suitability of a trademark for legal protection.[16]

In addition, the trademark registration systemIn Indonesia, the principle of priority is fundamentally closely related to the principle of priority, which provides protection to the party who first files an application. However, in practice, the application of this principle does not always reflect justice if it ignores the fact that the mark was previously used by another party. Therefore, trademark law in Indonesia still provides room for corrections to registrations through a cancellation mechanism. This is regulated in Article 76 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which gives interested parties the right to file a lawsuit for cancellation of a registered mark. This provision is reinforced by Article 21 paragraph (3), which states that an application will be rejected if it is filed by an applicant who acts in bad faith.[17]

In practice,The element of bad faith is often associated with imitation or registration of a trademark previously used by another party. Thus, although the trademark legal system in Indonesia is registration-oriented (first to file), its application cannot be separated from consideration of prior use (first to use) as part of the assessment of the validity of the registration.[18]

In theoretical studies, the principle of first use emphasizes that trademark rights arise from actual use, which creates a relationship between the brand and consumers. Continued use builds goodwill, reputation, and public trust. Therefore, the party that uses the trademark first inherently has stronger legitimacy than the party that only formally registers. This principle also relates to the protection of good faith and the prevention of reputational pass-off practices.

[16] Law of the Republic of Indonesia Number 20 of 2016 concerning Trademarks and Geographical Indications in Article 4, Article 14, Article 20 and Article 21.
[17] Ibid., article 76, article 21 paragraph (3).
[18] Luthfi Nurul, Hidayah Mudofi, and Kholis Roisah, "Legal Protection for Registered Trademark Owners Based on the First to File Principle," JIHHP: Journal of Law, Humanities and Politics 5, no. 2 (2024): p. 1061.

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PProtection for unregistered trademarks can still be granted through the doctrine of passing off, namely if the use of the trademark by another party creates a misleading impression so that the public associates the goods or services with the party that first used the trademark. This condition shows that even though a trademark is not registered, its owner still has a legal interest that is worthy of protection if there is proven use and reputation in the market.[19]

Thus, it is understandable that the trademark registration system regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications not only emphasizes legal certainty through registration, but also accommodates fairness through trademark rejection and cancellation mechanisms. A balance between these two aspects is crucial in providing protection for parties acting in good faith in trademark use.

In the context of the RUNMOUNT trademark dispute between Agung Mardian as Plaintiff and Abu Solih Muhamad as Defendant, the application of this principle shows the tension between legal certainty and substantive justice. The Plaintiff has been using the RUNMOUNT trademark since 2018 in trading activities through various digital platforms. This fact reflects the existence of prior use which is doctrinally relevant in assessing legal interests worthy of protection, even though the Indonesian trademark legal system formally adheres to the first to file principle as regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications.

BBased on the principle of first to use, prior use by the Plaintiff should be an important factor in assessing the validity of the trademark registration by the Defendant, especially in relation to the element of bad faith as regulated in Article 21 paragraph (3) which states that an application will be rejected if it is submitted by an applicant with bad faith. The explanation of this article shows that bad faith is not only proven through the status of a well-known trademark, but can also be drawn from the entire facts that indicate an intention to imitate or take advantage of another party's trademark. In this case, the existence of identical similarities between the Plaintiff and Defendant's RUNMOUNT

[19]Nada Salshabilla Putri Hendrawan and Christian Andersen, "Legal Certainty and Justice in Trademark Protection: A Comparative Analysis of the First-to-File System in Indonesia and the First-to-Use System in Malaysia," Journal of World Science, Vol. 4, no. 12, December 2025, p. 240.

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trademark, as well as the fact that the Plaintiff has used the trademark first, should be enough to give rise to a strong suspicion of bad faith on the part of the Defendant.

In addition, Article 76 provides legal space for interested parties to file a lawsuit to cancel a registered trademark.[20]This provision demonstrates that the first-to-file system is not absolute, but rather provides a mechanism for correcting registrations that are substantially unfair. In this context, the Plaintiff qualifies as an interested party because he has prior use of the mark.

Based on the above description, it can be concluded that the Plaintiff's position as the party who first used the "RUNMOUNT" trademark should receive legal protection through the bad faith assessment mechanism and trademark cancellation. Therefore, the decision that rejected the Plaintiff's lawsuit reflects the suboptimal application of the principle of protection against first to use in judicial practice in Indonesia.

Judge's Considerations in Deciding on Case Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst

The Plaintiff opened a Shopee account under the name “Runmount Official” on February 13, 2018, and since then has consistently marketed sportswear products under the RUNMOUNT brand through the Shopee platform, Instagram (since November 2020), and Tokopedia (since January 2021). For years, the Plaintiff did not officially register the brand with the Directorate General of Intellectual Property. This negligence was then exploited by the Defendant, who without the Plaintiff's knowledge and permission filed an application for registration of the RUNMOUNT brand on September 20, 2024, with Application Number DID2024094633 for goods class 25.

After learning of the registration, the Plaintiff immediately filed an application for registration of his own trademark on November 11, 2024 with Application Number DID2024116079. However, because the Defendant's application was submitted earlier and had passed the formal examination process, publication in the Official Trademark Gazette Number BRM: 164/PM/X/A/2024, as well as a substantive examination without any

[20]Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Article 21 paragraph (3) and Article 76.

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objections from any party, the Co-Defendant finally issued a RUNMOUNT trademark certificate in the name of the Defendant. The Plaintiff then filed a lawsuit to cancel the trademark on April 28, 2025, still within the five-year grace period as required by Article 77 paragraph (1) of the Trademark Law.[21]

The Defendant never appeared in court despite being legally and properly summoned, and was therefore deemed to have waived his right to reply. The Co-Defendant was present and submitted a response which essentially rejected the Plaintiff's claims on the grounds that the Defendant's trademark had passed all applicable registration procedures, including substantive examinations in which good faith was one of the considerations. The Co-Defendant also argued that during the announcement period of the Defendant's trademark, no party, including the Plaintiff, had filed an objection.

The Panel of Judges who examined and tried this case went through various stages of systematic consideration before handing down a verdict. The first consideration made by the Panel of Judges was to examine the fulfillment of the formal requirements for filing a lawsuit. The Panel of Judges stated that the Plaintiff had a valid legal standing because he had submitted a trademark registration application to the Co-Defendant, as required by Article 76 paragraph (2) of the Trademark Law which stipulates that the owner of an unregistered trademark may file a cancellation lawsuit after submitting an application to the Minister.[22]The absolute and relative competence of the Central Jakarta Commercial Court was also declared fulfilled, considering that the Defendant's domicile is in the West Java region which falls within the jurisdiction of the Central Jakarta Commercial Court based on Presidential Decree Number 97 of 1999.[23]

The next consideration is to assess the main points of the case, namely whether the Plaintiff's RUNMOUNT brand is a well-known brand, and whether the Defendant's registration of the brand was based on bad faith. In outlining the standards for a well-known brand, the Panel of Judges refers to the Explanation of Article 21 paragraph (1) letter b of

[21]Decision of the Supreme Court of the Republic of Indonesia Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst.
[22] Law Number 20 of 2016 concerning Trademarks and Geographical Indications, Article 76 Paragraph (2).
[23]Decree of the President of the Republic of Indonesia Number 97 of 1999 concerning the Establishment of Commercial Courts.

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the Trademark Law which requires general public knowledge of the brand, a reputation obtained through large-scale promotion, investment in several countries, and accompanied by proof of registration in several countries.[24]This is also in line with Supreme Court Jurisprudence Number 1486 K/Pdt/1991 dated 28 November 1995 which states that a brand is included in the definition of well known marks if the brand has circulated beyond regional boundaries to the transnational level.

Furthermore, the Panel of Judges also explicitly cited the provisions of Article 18 paragraph (3) of the Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration (hereinafter referred to as Permenkumham 67/2016), which details nine criteria in determining a well-known trademark, including the level of public knowledge or recognition of the trademark, sales volume and profits obtained, market share controlled, the area of use of the trademark, the period of use of the trademark, the intensity of brand promotion including investment value, trademark registration in other countries, the level of success of law enforcement in the trademark field, and the value attached to the trademark due to reputation and quality assurance.[25]After examining all the written evidence submitted by the Plaintiff, the Panel of Judges concluded that there was not a single piece of evidence that could show that the requirements for a well-known trademark had been fulfilled, so that the Plaintiff's RUNMOUNT trademark was declared not to be a well-known trademark.

Regarding the element of bad faith, the Panel of Judges is of the opinion that the Defendant's RUNMOUNT trademark has been registered through a thorough registration procedure, including formality examination, substantive examination, and announcement in the Official Trademark Gazette which has not received any objections from any party. On that basis, the Panel of Judges concluded that it was not proven that the Defendant registered the trademark to imitate, mislead, or take advantage of the reputation of another party's trademark. Because the main points of the lawsuit were not proven, the Panel of

[24]Law Number 20 of 2016 concerning Trademarks and Geographical Indications Explanation of Article 21 Paragraph (1) Letter b
[25]Regulation of the Minister of Law and Human Rights Number 67 of 2016 concerning Trademark Registration, Article 18 Paragraph (3)

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Judges rejected the Plaintiff's entire petitum and sentenced the Plaintiff to pay court costs in the amount of Rp4,460,000.00.

Based on the decision of the Panel of Judges, it can be formulated that the decision in case Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst does not fully reflect optimal legal protection for brand owners who act in good faith and is not fully based on a proportional assessment of all available evidence. This can be seen from the contradictions in the judge's considerations, particularly regarding the application of the criteria for the period of use of the brand as regulated in Article 18 paragraph (3) of Permenkumham 67/2016.

As previously considered, the Panel of Judges explicitly stated that the period of use of a trademark is one of the nine criteria that must be considered in determining the well-knownness of a trademark. The logical consequence of the inclusion of this criterion is that the evidence of the Plaintiff's use of the RUNMOUNT trademark since 2018, which includes Shopee account data since February 13, 2018, Instagram activity since November 2020, Tokopedia since January 2021, as well as various evidence of actual sales transactions both before and after the lawsuit was filed, should be assessed and considered proportionally as fulfilling, at least partially, the criteria for the period of use of the trademark in question. The fact that the Plaintiff had been using the RUNMOUNT trademark actively and continuously for approximately six years before the Defendant registered it is an indisputable fact and has been supported by a series of written evidence submitted at trial.

However, in its conclusion, the Panel of Judges stated that there was no evidence to demonstrate that the requirements for a well-known trademark had been met. This statement directly contradicts the facts of the trial as revealed through the Plaintiff's written evidence. Not a single paragraph in the judges' reasoning specifically outlines why the six-year period of use is considered inadequate or irrelevant in the context of assessing the trademark's well-knownness.

In addition, the Panel of Judges also appears to have confused two different regimes, namely the regime of internationally renowned trademarks as referred to in the

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Explanation of Article 21 paragraph (1) letter b of the Trademark Law and Supreme Court Jurisprudence Number 1486 K/Pdt/1991, with the regime of trademarks that are widely known locally or sectorally as referred to in Article 18 paragraph (3) of Permenkumham 67/2016. The dominant standard used by the judges, namely that the trademark must be known transnationally, registered in various countries, and promoted globally, is a standard commonly applied to multinational corporate brands. The rigid application of the same standard to small business actors who pioneer their businesses through domestic e-commerce clearly does not reflect proportional justice and is not in line with the spirit of protection intended by Article 76 paragraph (2) of the Trademark Law, which specifically provides the right to sue to owners of unregistered trademarks who act in good faith.

In addition to the issue of mixing up the regimes, there is also a fundamental problem in the aspect of the hierarchy of legal sources that has escaped the attention of the Panel of Judges. In legal theory, the Law is a higher source of law compared to jurisprudence, what is meant by law in the material sense (wet in materiele zin) is every government decision that according to its content is called a law, namely every government decision that establishes generally binding regulations, or in other words objective legal regulations. Thus, Permenkumham Number 67 of 2016 as a ministerial regulation is essentially an implementing regulation that should be subject to and must not conflict with the law above it, in this case the Trademark Law Number 20 of 2016.

With such a construction, there is actually a serious disharmony if the judge prefers to be guided by the Supreme Court Jurisprudence Number 1486 K/Pdt/1991 which was born long before the enactment of Trademark Law Number 20 of 2016 and Permenkumham 67/2016, rather than applying newer and higher norms. In universally applicable legal principles, the principle of lex posterior derogat legi priori applies, namely that newer regulations override older regulations.[26]Jurisprudence Number 1486 K/Pdt/1991 was formed in the context of the old trademark regime and cannot be equated with the provisions of the current legislation. The Panel of Judges should set aside this jurisprudence and consistently apply Article 18 paragraph (3) of Permenkumham 67/2016, which is a

[26]Zainal Arifin Mochtar and Eddy OS Hiariej, Fundamentals of Legal Science: Understanding Legal Rules, Theories, Principles and Philosophy, (Yogyakarta, Publisher, 2021) p. 144.

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newer and more operational norm in regulating the criteria for well-known trademarks. Moreover, Permenkumham 67/2016 itself was issued as an implementing regulation of Trademark Law Number 20 of 2016, which is also a much newer legislative product than the jurisprudence in question. Therefore, legal propriety and accuracy require that the standards for assessing well-known trademarks used by the Panel of Judges be based entirely on Permenkumham 67/2016 and not on old jurisprudence that is no longer in line with the development of current Indonesian trademark law.

The impact of this error in assessing the brand's popularity also influenced the judge's conclusion regarding whether or not there was bad faith on the part of the Defendant. Because the judge concluded that the Plaintiff's RUNMOUNT brand was not a well-known brand, the judge also stated that there was no evidence of the Defendant's intention to imitate or take advantage of the reputation of another party's brand. In fact, the Explanation of Article 21 paragraph (3) of the Trademark Law clearly states that an applicant who acts in bad faith is a party who is "reasonably suspected" of having the intention to imitate, plagiarize, or imitate another party's brand, which means that the assessment is not only based on meeting international well-known brand standards, but also on the overall context and available facts. The fact that the Defendant's registered RUNMOUNT brand has exactly the same elements in words, descriptions of the red and white colors, and overall design as the brand that the Plaintiff had used for the previous six years, combined with the Defendant's absence from all hearings and the absence of evidence of independent use of the brand by the Defendant prior to its registration, is a strong indication of bad faith that should be examined more deeply by the Panel of Judges.[27]

CONCLUSION

The conclusions in this study are as follows:

1. The trademark registration system in Indonesia based on Law Number 20 of 2016 formally adheres to the constitutive principle (first to file), but this principle is not

[27]Decision of the Supreme Court of the Republic of Indonesia Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst

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absolute. Through Article 21 paragraph (3) and Article 76, Indonesian law still accommodates substantive justice by protecting parties who use a trademark first (first to use) in good faith. In the RUNMOUNT case, the actual use by the Plaintiff since 2018 has created goodwill and reputation that should be the basis for assessing bad faith for the registrant, so that trademark registration should not be viewed merely as an administrative formality.

2. Decision Number 33/Pdt.Sus-HKI/Merek/2025/PN Niaga Jkt.Pst is considered to contain fundamental legal flaws due to internal contradictions, where the Panel of Judges ignored concrete evidence of trademark use for six years even though the duration criteria were recognized in their legal considerations. The judges erred in rigidly applying the well-known trademark standard by equating the parameters of local e-commerce brands with international brands, and ignored indications of bad faith by the Defendant. This failure demonstrates an overly formalistic application of the law, which ultimately reduces the protection rights of small business actors and fails to reflect proportional justice that should protect market integrity from imitation practices.

SUGGESTION

It is recommended that future legal enforcement in resolving trademark disputes not only focus on the formal aspects of registration, but also comprehensively consider the facts of prior trademark use and any indications of bad faith. This approach is crucial to ensuring that legal protection not only provides certainty but also reflects substantive justice for parties who have used the trademark in a real and good faith manner.

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