

Law Review on Trademark Dispute Between Biore And Biorf Based Marks Law in Indonesia

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Abstract: Kao Corporation almost lost brand its been used since February 1980 and Biore trademark has been registered since 1982. PT Singtong Abadi, using trademarks of Biorf, for cosmetics, powder for women, perfume, skin lotion, shampoo and soap. Kao Corporation sued PT Sintong Abadi. This trademark dispute is heard at the Central Jakarta Commercial Court (Central Jakarta District Court). However Kao Corporation lost and eventually this problem continued until the Supreme Court. At the highest court, the Supreme Court won the appeal of Kao Corporation with the number 590K/Pdt.Sus/2012 in this case the judge annulled Biorf's trademark registration. The results showed that criterion of the equation principally in Act no. 15 of 2001 regarding Marks which has now been changed into law no. 20 of 2016 regarding Marks and Geographical Indications. Refers to the similarity aspect caused by the presence of prominent elements between one brand and another brand which may give the impression of equality of form, way of placement, way of writing or combination of elements or equations the sounds of speech contained in these brands. The concept of equality is substantially attributed in Decision No. 590 K / PDT.SUS / 2012 is the existence of equality of elements that is the equality of Biore's proprietary word of Plaintiff, the same sound or utterance as the Plaintiff's brand, the way of writing and the pronunciation of the pronunciation sound of Biorf brand is used to pitch the Biore brand and this is a bad faith of the Defendant. This is because the equation of the element of the letters BIORF is only different in the last letter F and E only, at the other side also because the second brand visually have shape equation, placement way.

Keywords: Trademark Dispute, Biore, Biorf.

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I. BACKGROUND

Human abilities are born as God's perfect creature is believed to be able to create results of creative and innovative work. Humans as social beings often interact with each other in their daily lives. Trading activity is one form of interaction result human beings who aim to be mutually beneficial and provide benefits between producers and consumers. In the business world or trade in the use of brands of goods and services, the purpose of distinguishing goods or services with goods or services, which circulate in the market. The need to show the identification of origin sources of goods is more perceived the benefits of brand giving. [1] The success of the business, is inseparable from the role of brand as an intangible asset, which can provide the identity of the goods or services produced. The industrial world continues to grow dynamically and competition, which is so strictly growing develop the awareness of businesspeople about the importance of a brand. The existence of a brand can make it easier for consumers to distinguish the product, which consumers will buy with other products, due to the quality, satisfaction, pride, and other attributes attached to the brand. [2] Brand is also one of intellectual works, which has an important role in economic life especially in the field of trade in goods and services. Importantly, the brand has elements that have color-differentiating power, or a combination and function to differentiate products, one with another, the like in a class. Brand shall be a sign, which may be imprinted on the item or package of a good. [3] In the perception of the brand of value-added specially if the brand in question is already known by many consumers that the "spirit" of the economy of the company. [4] Thus, companies may transfer or license to other parties so that expand marketing, increase revenue by creating jobs.

At the time consumers make decisions, the strength of a brand identity will increase the chances that consumers will keep the brand remembering h al this will also contribute to the perception of the quality of the product, encouraging customer loyalty so buy it again. Although the price is slightly more expensive than other brands, but because consumers are loyal consumers still buy it. [5]

Unwittingly, the brand has enormous economic advantages, therefore, there must be protection for the brand. When a brand becomes famous, then what happens next is, the emergence of counterfeit products that use the same trademark. It is of course detrimental to the product manufacturer and also directly harm

consumers brand users, and therefore for giving protection of the brand, then the registration of the mark on the relevant authorities. In case this is General Directorate of Intellectual Property Rights. [6] But be aware that the registration of a trademark, of course, also have to meet the existing requirements under the applicable provisions. In essence, the brand must have differentiating power, therefore, the naming of a brand must be different from one another. [7] With the registration and the issuance of certificates on the brand. M aka owned brands have obtained legal protection.

Brand registering advantage is to protect the brand, avoiding fraud and cheating brand conducted by other parties, irresponsible and want to have an economic gain on a brand. [8] Often with the intense competition in the world of goods and services trade, the brand becomes a thing, which is often the object of piracy. Piracy in the brand, usually includes the equation on the whole and the equation in essence. This violation often occurs even though the trademark has been registered with the Directorate General of Intellectual Property Rights, that the mark is also registered to the Directorate General of Intellectual Property Rights and obtains a registration certificate. This is one of the problems in the field of Intellectual Property Rights especially the brand field. [9] A registered trademark dispute case should be a reflection of the entrepreneur, and as a warning to the business actor, to be careful with brand registration. On the other hand, the occurrence of brand piracy by other parties usually occur because the nature of human beings do imitate including in creating the brand. Another reason is that creating your own brand requires huge fees and a complicated registration procedure. One of the functions of the brand is to facilitate the advertising of products to the public so that people are interested to use / buy the product. Because the function of the parties who want the product easy to recognize and then imitate the famous brand.

With regard to the above mentioned reviews, the authors are interested to examine in depth the case of a brand dispute between the "Biore" brand (Kao Corporation) and the "Biorf" brand (PT Sintong Abadi). Kao Corporation sued PT. Sintong Abadi for using Biorf brand, for cosmetic products, talc for women, perfume, skin lotion, shampoo and bath soap. The Biorf brand has the concept of equality in essence or overall with the Biore brand. Kao Corporation has been using the Biore trademark since February 1980 and registered trademark since 1982, this is certainly a trademark of Biore is a well-known trademark. This brand dispute is heard at the Central Jakarta Commercial Court (Central Jakarta District Court). Kao Corporation lost and eventually this problem continued until the Supreme Court. At the highest court, the Supreme Court (MA) won the appeal Kao Corporation with number 590 K/Pdt.Sus/2012. The trial, chaired by I Made Tara, SH, canceled Biorf's trademark registration. The reason has similarities with famous brands. MA considers that the Biore brand has been registered on the General Register of brand first of the Biorf brand. The first most registered trademark is the Biore brand, which was first filed on June 17, 1982 and listed under List no. 164670 on June 17, 1982. Then the brand was extended again on October 27, 1993 and extended both times under List no. 496355 dated December 31, 2001. The Biorf brand has a similarity in essence to the Defendant's brand-in this case between the two brands visually having the form equation, the way of placement

The reason for the author's interest in this case is on the consideration of the Commercial Court of the Central Jakarta District Court which states there is no similarity in essence based on the consideration that BIORF brand has the meaning of the word and the BIORE brand has no meaning of the word. The Defendant Cassation (formerly the Defendant) has argued that the BIORF trademark registration that has passed the procedural stages set forth in the Trademark Law as a basis to prove that the BIORF brand is submitted in good faith, does not conflict with public order or has no similarity with the brand registered, or well-known brand, clearly indicates a mistake in understanding and understanding fundamentally what is stipulated in the Trademark Law.

The Supreme Court Judge is of the opinion that the Central Jakarta Commercial Court has made a fatal mistake in implementing the law in giving legal consideration and deciding the case of cancellation of the mark, which should be considered in accordance with the legal basis of Article 68 Paragraph (1) jo. Article 6 paragraph (1) points (a) and (b), Article 6 paragraph (2), Article 4 and Article 5 point (a) of the Trademark Law are considered in accordance with the legal basis of Article 76 of the Trademark Law. In the context of the above description, the Director General of Intellectual Property (HI) must be referring in Article 6 of Law no. 15 of 2001 on Marks:

"(1) The application shall be rejected by the Directorate General if the Mark:

- a. Have an equivalent in essence or in its entirety with a Mark owned by another party already registered in advance for similar goods and / or services;
 - b. Have in common or in whole with a mark that is already well-known to another party for similar goods and / or services;
 - c. Have an equation in essence or in its entirety with known geographical indications.
- (2) The provisions referred to in paragraph (1) letter b may also apply to unequal goods and / or services as long as they meet certain requirements which shall be further stipulated by Government Regulation.
- (3) The application must also be rejected by the Directorate General if the Mark:

- a. Represents or resembles the names of famous persons, photographs, or the names of legal persons owned by others, except by written consent of the rightful;
- b. It is an imitation or resembles a name or abbreviation of a name, flag, emblem or symbol or emblem of a state or national or international agency, except with the written consent of the competent authority;
- c. It is an imitation or resembles an official mark or seal or stamp used by a State or Government agency, except with the written consent of the competent authority. " [\[10\]](#)

II. DISCUSSION

1. The Criteria of Equations Basically in Act no. 15 of 2001 regarding Marks

The application for brand registration is often rejected in the process of examination that has been going on for quite a while. This often happens because of the applicant of the mark sometimes ignores some of the provisions of Law No. 15 of 2001 concerning other trademarks and / or legislation in connection with the registration of a brand. Here are some of the reasons underlying the rejection of a brand's application, including:

- a. Because it has an equality in essence or in its entirety with another registered party brand for goods and / or similar services (under Article 6 paragraph (1) letter a of the Trademark Law Number 15 Year 2001);
- b. Because it has the similarity in essence or in its entirety with a well-known brand belonging to another party for similar goods and / or services (based on Article 6 paragraph (1) sub-paragraph b of the Trademark Law Number 15 Year 2001);
- c. Because it has in common or in common with another party's well-known marks for unequal goods and / or services as long as it meets certain conditions stipulated by government regulations (under Article 6 paragraph (2) of the Trademark Law Number 15 Year 2001);
- d. Because it has the similarity in essence or the whole with known geographical indications (under Article 6 paragraph (1) Sub-Paragraph c of the Trademark Law Number 15 Year 2001);

The doctrine of equality as a whole is the oldest teaching in determining the similarity of one brand to another. This doctrine emphasizes the existence of a comprehensive equality between one brand with another brand. The overall meaning of equality according to this doctrine must cover all relevant factors.

Based on the same principle as a whole, the comparison of brand element is really the same must be fulfilled maximal or optimal equation. According to M. Yahya Harahap for optimal overall equations can be realized between one brand of someone with another person's brand, is: [\[11\]](#)

- a. One is an imitation or mimicry total (*imitation*) of the brands other people, by copying from the original, or produced from the original.
- b. Equality of goods type, but also includes the equation of the total type of goods. Goods that are protected with one another must be the *same generic*. At least it should be about the type of goods that are in one class. Although all brand factors are equal to being met "*as a very similar*" with the same "*true appearance*", if the classification of unlike goods in the same class is not an equation, it manifests itself as "*inequality*" or *dissimilarity*.
- c. The equation of marketing channels, the third condition to express whether or not equations, demanded the equation of "marketing channel" or trade channel. The marketing path is considered the same, covering the same geographic area or "*the same common market place*" and addressed to the same consumer layer. Even if the totality of the brand element is the same, and the type of goods is the same, but it turns out the marketing channels are different, it is deemed not to materialize the overall equation.

From the above opinion when it is related to the reality of the circulation of goods in order to see whether or not there is a whole equality, it is difficult to apply, because the doctrine expresses the equation in total, but now business actors with bad intentions have a thousand ways to avoid the existence of the whole equation by modifying the brand but still impressed the same. This doctrinal approach can no longer be used as a whole.

On the other hand, to the provisions concerning the description of the brand which have in common in its entirety or essentially this relates to Law no. 15 of 2001 regarding Marks, whereby the same brand in its entirety or in essence is:

1. A *similarity of form*;
2. The same brand of composition (*similarity of composition*);
3. The same brand of combination (*similarity of combination*);
4. The same brand of elements (*similarity of elements*);
5. A brand that has a *sound similarity*;
6. Brands that have a *phonetic similarity*;
7. A brand that has a *similarity appearance*.

This doctrine of identical identification or close resemblance is felt more precisely for today, since the doctrine of equality in its entirety must apply all of it to be the same, it can not be applied to identical identical brands. In order to realize fair and *healthy trade competition*, it turns out that the doctrine of similar equations (entireties similar) is less reliable. In business practice, fraud often occurs in the forming of a famous brand and the hoax does not include all the factors or elements cumulatively specified in the doctrine, in a sense;

1. Not copying or reproducing in full the imitated brand
2. Protected items are not exactly the same type or class
3. The marketing path is not exactly the same
4. The geographic area and source of origin of production are not thoroughly the same.

Basically brands must be registered in good faith. If a person tries to register a trademark that he or she is aware of as a mark of another person's or is similar to that of another person, the mark can not be registered. If a trademark is filed in Indonesia by a person who does not intend to use the mark and intends to prevent others from entering a local market or hampering a competitor to expand its business network, the mark can not be registered in Indonesia. [12] In connection with this, in order to anticipate fraudulent behavior and bad faith in the business world, a wider and more flexible doctrine, called "identical or closely related or very similar" resemblance.

The occurrence is not identical or resemblance between one brand with another person's brand, among others using the same or similar *word or character* (*to use any word or character*); using the same or similar form or equipment (*any figure or device which is identical with or similar*); with respect to *the same or similar goods of similar goods* or similarly to the *design or decoration of the goods* ; and potentially lead to "great misleading" to the public (*sufficiently misleading the public*). Theory and practice of these teachings, aimed at flexing doctrine thorough equation (*entireties similar*), according to this doctrine, stiffness ajran overall equation, it should be bent and developed (*enlarge*).

This identical doctrine and very close similarity is more widely used in anticipation of piracy or imitation of a previously registered trademark. The criteria of equality principally between one brand and the other does not lie only in terms of form, placement, or combination of elements or equations of speech sounds contained in the brands concerned.

The difficulty of making the criteria of equality substantially provides an opportunity for each party to provide an unlimited interpretation, the result being the number of brands that actually have in common but can be listed in the General Register of Trademarks and vice versa, since there is no objective criteria of many brands which should be registered, but rejected by the Trademark Office because it is deemed to have an equation in essence. Basically it is not difficult to determine the existence of the whole equation, because it is enough to compare the two brands in total, whereas in identical doctrine it will be difficult to determine whether or not there is an equation in essence.

In the opinion of the authors, the provision of equality criteria in principle in Act no. 15 of 2001 on the brand are:

- a. The existence of the form equation, the way of placement, the way of writing or the combination of elements or equations of speech sounds contained in the brands.
- b. The existence of elements that stand out between one brand and another brand, which can lead to the impression of the existence of equations either about the form, way of placement, way of writing or a combination of elements or equations of speech sounds contained in the brand.

Based on the above provisions, the applicant of the mark needs to pay attention to the presence or absence of the brand equation to be filed with the registered trademark and / or already submitted in advance either in whole or in principle, as provided in the existing provisions. It is indispensable to ensure the presence or absence of rejection of the trademark application filed with the Director General of Intellectual Property Rights.

Based on this, the natural and maybe national and global trading activities, the brand is an important element to differentiate the product from other products manufactured by different businesses. Other trademarks, in addition to resulting in no confusion to consumers, may also damage the reputation of a trademark of a product due to an act of compromise on another's brand. Despite being protected by law, brand brilliance cases are prevalent. As mandated by law, one of the factors causing the rejection of a request for registration of a mark by the Trademark Office (the Director General of IPR of the Department of Law and Human Rights) is that if the mark submitted by its registration has any similarity in essence to the registered trademark. It is not too difficult to determine when a brand is said to have an equality in its entirety with another's brand, but it is different with a brand that has an essentially similar equation which is not easy to

determine, since its own law in its arrangement has not set clear limits, which technically often lead to multiple interpretations. [13]

Based on this, the authors argue that the brand case that has the similarity in essence is a case that is not easy and complicated in the solution, so that carefulness and caution judge is needed in handling. This is in line with Article 6 paragraph (1) of Law no. 15 of 2001 regarding Marks are mentioned as follows:

- (1) The application shall be rejected by the Directorate General if the Mark:
- a. Have an equivalent in essence or in its entirety with a Mark owned by another party already registered in advance for similar goods and / or services;
 - b. Have in common or in whole with a mark that is already well-known to another party for similar goods and / or services;
 - c. Have the equation in essence or the whole with known geographical indications.

From the meaning of the equation principally based on the explanation of Article 6 of Law no. 15 of 2001 regarding Marks, any registration of marks which have in essence the equivalent of a previously registered mark for similar goods and or services shall be rejected by the mark office. This Article is one form of protection to registered trademark owners of the conventional means, whereby the parties wishing to take advantage by cutting corners, are now brand hijacking by taking refuge under the Ordinance. The equation is substantially due to the presence of prominent elements between one brand and the other, which may give the appearance of an equation of either the shape, the mode of placement, the way of writing or the combination of elements or equations of speech sounds contained in the brand. In the explanation of Article 6 Paragraph (1) letter a, is an equation in essence is a resemblance due to the presence of prominent elements between the one Brand and the other Brand, which may lead to the impression of equality of form, way of placement, way of writing or combination of elements or equations of speech sounds contained in the brands.

Seeing this, the possibility of an element of subjectivity from brand examiners to reject the registration of a brand on the grounds that there are similarities in essence is reasonable. It also affects the judge's decision to examine and adjudicate the cases, causing the verdict to have no clear interpretation of what the criteria of a brand have in common in essence. [14]

Whereas in the explanation of Article 6 Paragraph (1) letter b states:

"Rejection of an Application which has the same or substantial equivalence with a well-known Brand for similar goods and / or services shall be made by observing the general knowledge of the public concerning the Mark in the business concerned. In addition, it is also noted that reputed Brands are acquired for their hefty and large-scale promotions, investments in some countries of the world by their owners, and with evidence of such Marks registration in some countries. If the above matters are not considered sufficient, the Commercial Court may order an independent institution to conduct a survey in order to obtain a conclusion as to whether or not the Mark is the basis for the refusal. "

On the other hand that the determination of the introduction of a brand must be made in consideration of the public knowledge of the trademark in the field of business concerned, as well as its reputation as a well-known brand acquired for large-scale promotions, investments in some countries of the world by its owner, and accompanied proof of registration of such marks in some countries of the world. If the above matters are not considered sufficient, the Commercial Court may order an autonomous institution to conduct the survey in order to obtain a conclusion as to whether or not the brand is the basis of the refusal. The legal basis for the filing of a Biore trademarks disputes against Biorf is in accordance with the provisions of Article 6 paragraph (1) letter b, paragraph (3) letter a, namely on equality principally with other registered trademarks and registration of a brand that resembles a person's name famous, photograph, or legal name of another person, except by written consent of the rightful person and P of 4 concerning bad faith. So judging from the criteria should be able to assess the similarity between the two brands in dispute at least in terms of pronunciation, writing and the type of goods and the name of a person or legal entity owned by another party.

The system of protection afforded to the right to a brand adopted by Law no. 15 of 2001 is a constitutive system. This means that the protection of the rights to the mark is provided only on the basis of the registration. This system is also known as "*first to file system*", which means protection is given to who register first. For the Subsequent Applicant who submits the same or similar mark shall not be protected by law. The opposite of the constitutive system is the declarative system in which the protection of the right to the mark is granted on the basis of first use so long as it can not be proven otherwise. Some countries still adhere to this system, although it does not guarantee legal certainty. Often in the case of the Court, it is found difficult to

determine who is actually the first user (good faith) because it is difficult to prove who the first user is. Therefore, it often leads to legal uncertainty on the owners of the rightful brands.

2. Concept the equation is substantially attributed in Decision No. 590 K/ PDT.SUS / 2012

Basically, the concept of equality is essentially related to Decision No. 590K/Pdt.Sus/2012 are as follows:

1. Both brands are equally composed of 5 (five) letters.
2. The first four letters consist of the same letters, namely: B, I, O, R and placed in the same order.
3. Overall, it appears that only one element leaves a difference between the two brands compared, the last letter of each brand-letter E in the BIORE Brand and the letter F in the BIORF Brand.
4. Types of goods are equally classified as 3 categories: soaps, foams for cleaning, perfume, cosmetics, shampoos, preparations to clean the hair, preparations for hair care. All kinds of cosmetics, all kinds of powder for women and children, perfumery / perfume, perfume / lotion, shampoo, bath soap, laundry soap, soap.

In this case, the equation is substantially due to the presence of prominent elements between one brand and another brand which may lead to the impression of equality of form, way of placement, way of writing or combination of elements or equations of speech sounds contained in the brand. Kao Corporation the exclusive rights owner of the Biore / Plaintiff brand filed a lawsuit against Biorf's trademark renewal of PT. Sintiong Abadi / Defendant because the Defendant's trademark has an equation in essence and overall with the Plaintiff's brand. It can be seen from the equation of the elements of the equation of Biore's proprietary word of Plaintiff, the same sound or utterance as the Plaintiff's brand, the way of writing and the pronunciation of the pronunciation sound of the Biorf brand is used to pitch the Biore brand, and this is a bad faith of the Defendant. This is because the equation of the element of BIORF letters is only different in the last letter F and E only.

Biorf brand registration submitted by PT. Sintiong Abadi at the Directorate General of HKI of the Department of Law and Human Rights is difficult to envisage the intent and purpose of use of the iorf brand unless inspired and there is an intention to piggyback, imitate or plagiarize a Biore brand belonging to a Plaintiff who has been known or first registered in Indonesia. Thus, the Defendant's biopharmaceutical marker registration is based on good faith to raise the introduction of the Plaintiff's trademark with the aim of obtaining a large profit without having to promote its own brand. The Trademark Law expressly stipulates the matters which make a trademark unregistrable and must be rejected for application by the Directorate of IPR Joint Venture. Generally, a trademark may not be registered on a request filed by a non-baked request, and this is clearly reflected in Article 4 of Law no. 15 of 2001 concerning Marks explaining that:

"Trademarks can not be registered on the basis of a petition filed by an unfairly challenged applicant".

Brand The Plaintiff's biore has been listed on the Register General Brands in advance of the Defendant's brand-most brands first registered is the Biore brand which was first filed his petition on dated June 17, 1982 and listed under List no. 164670 on the 17th of June 1982, extended by List no. 301846 dated October 27, 1993, extended both times under List no. 496355 of 31 December 2001 which until now applies (hereinafter referred to as "Brand Biore"), has the similarity in essence with the Defendant's Brand-in this case between both brands visually have shape equations, placement ways, ways writing.

The Plaintiff has obtained protection in Indonesia against brands containing the word 'BIORE' as will indicated on the trial of this case verification. Can be proved that all such brands have in essence the same with the Marks Defendant.

Also note that m the Plaintiff's own famous plaster of the BIORE has a long history of usage both in the country of origin ie Japan and in Indonesia. In particular, known brands of BIORE have been used in Indonesia since February 1980. On the date of the application for registration of the Defendant's Mark, Trademark The Plaintiff's BIORE has been registered internationally. In addition to Country originally in Japan and in Indonesia, the Plaintiff's BIORE Mark has been registered with many countries in the world.

The Plaintiff's BIORE brand has also gained recognition as a mark famous from the authorized institutions in overseas countries. Plaintiff too has invested heavily, including but not limited in promoting the BIORE Marks it owns and sales of products with the BIORE Brand have reached the sales figures tall one Under consideration of the Supreme Court (MA), the Biorf brand has in essence the similarity with the Biore brand in this case between the two brands visually have the form equation, the way of placement. The Biorf brand is said to have similarity in essence for similar goods with a pre-registered brand, namely Biore. Finally, the Supreme Court granted the KAO Corporation lawsuit dated January 21, 2013.

PT Sintong Abadi which is stated not in good faith by applying for registration of BIORF Mark List no. IDM000292510 and MA cancels those Marks listed in the General Register of Marks with all the legal consequences. Bailiffs are also requested to convey the decision to the parties no later than 14 days after the decision on the cancellation lawsuit is pronounced in accordance with the provisions of the applicable Trademark Law. The MA in its ruling grants the suit to the whole and declares Biore as a well-known brand and the Biorf brand has a similarity in essence under the BIORE brand for unlike items.

Based on the facts and evidence, PT. Sintong Abadi has registered the Biorf mark on the Directorate General of HKI of the Department of Law and Human Rights based on the principle of bad faith which is inappropriate and dishonest by piggybacking, imitating or plagiarizing the trademark of the Plaintiff's trademark (*passing off*) resulting in a condition of dishonest competition (*unfair competition*), deceive or mislead consumers. *Passing off* is an action that seeks to gain profit through shortcuts by all means and propositions that violate business ethics, moral norms, or laws, where it is common in the way of passing of and imitate or similar-branded others who have a good reputation. Regarding dishonest competition (*unfair competition*) in Article 10 bis of the Paris Convention contains a provision that the participating States of the Union of Paris are bound to provide effective protection in order not to engage in dishonest competition. In the second verse it is determined that every action that is contrary to "*honest practice industrial and commercial matters*". Is considered an act of dishonest competition. Whereas the third paragraph determines the prohibition of all acts which may create errors in any way with regard to origins pertaining to the industrial and commercial undertakings of an entrepreneur who disrupts the public concerning the nature of the origin of an item including the impersonation of a brand having the same in essence or in its entirety.

In the opinion of the author, that most of the brand disputes that occurred between local and foreign businessmen based on allegations of bad faith. The introduction of a product name / brand is also always the target of many business actors so that happened passing of introduction. Where in the dispute of the BIORE and BIORF Marks, it can be analyzed from the side of the Kao Corporation, as the party who feels the first time to own and / or owns the mark he is entitled to file a claim of cancellation of the BIORF Brand owned by PT. Sintong Abadi which in Article 3 of Law Number 15 Year 2001 on the brand states:

"The Right to Trademark is an exclusive right granted by the state to the owner of the Mark registered in the General Register of Marks for a certain period of time by using the Mark itself or granting permission to others to use it".

The basis of the Branding Cancellation filed by Kao Corporation may use the provisions of Article 68, namely:

1. "A lawsuit for the cancellation of a Trademark registration may be filed by an interested party on the grounds referred to in Article 4, Article 5 or Article 6.
2. An unregistered Brand Owner may file a lawsuit as referred to in paragraph (1) after filing an Application to the Directorate General.
3. The cancellation law as referred to in paragraph (1) shall be filed with the Commercial Court.
4. In the event that a plaintiff or defendant resides outside the territory of the Republic of Indonesia, the lawsuit shall be filed with the Commercial Court in Jakarta. "

Article 69

"(1) A lawsuit for cancellation of a Trademark registration may only be filed within 5 (five) years from the date of registration brand.

(2) The lawsuit can be filed indefinitely if brand is in conflict with religious morality, morality, or public order. "

The circulation of similar products with brands that have similarity in essence is feared will cause public confusion and misleading the public. Equation in essence of course apart from the mention of the word brand but also pay attention to the display of the brand either the color composition, or placement.

The Kao Corporation may also prove that the Brand's introduction must meet the criteria as stipulated in Article 6 paragraph (1) sub-paragraph b Law no. 15 of 2001 on Trademarks, outlined in the Terms of Explanation Article 6 paragraph 1 letter b of Law Number 15 Year 2001, among others:

- a. has been widely known by the public
- b. has earned the reputation of a well-known brand acquired for its vigorous and massive promotion
- c. has had proof of investment in some countries in the world by its owner
- d. already has proof of registration of such mark in some countries.

Some jurisprudence also mention the criteria of well-known brands such as Supreme Court Jurisprudence No. RI. 1486 / K / 1991 dated 25 November 1995 stated :

"The notion of a well-known Brand is when a Brand has circulated out of regional boundaries to transnational boundaries, which have circulated out of its home country and proved by the registration of the Mark concerned in various countries".

Jurisprudence of the Supreme Court of the Republic of Indonesia No. 022 K/HaKI/ 2002 dated December 20, 2002 states:

"To determine the criteria of a well-known Brand, the Supreme Court shall be guided by the jurisprudence of the Supreme Court, that is, in addition to being based on general knowledge of the public, its determination is also based on the reputation of the Mark concerned which has been obtained by the promotion which the owner has made, the state, if it exists, is one of the powerful tools of proof ".

Famous Brand Criteria In addition to Article 6 paragraph (1) letters b Law no. 15 of 2001 on Trademarks namely: Famous Brand Criteria Based on WIPO (*World Intellectual Property Organization*) that is the use of old brands, according to WIPO for a brand can be considered a famous brand requires a long time of use and promotion and the cost is not small. While the criteria of a well-known Brand based on the principle of reproduction in the Paris Convention in accordance with Article 6 paragraph (2) of the Paris Convention which one of its principles is the principle of reproduction, the principle of reproduction in this case is meant a reciprocal relationship between member states of the Paris Convention. Famous Brand Owners not only require that their Marks be recognized by a Contracting State, but as the owner of the Marks who consider the Marks to be Famous Marks shall also make a real contribution to the country concerned, such as the circulation and marketing of products with such Famous Marks that are sufficiently high generating real income for the country in which the Famous Brand is protected.

While from the side of the owner of the Brand Biorf namely PT. Sintong Abadi may argue that the Mark has no similarity in substance to Brand Biore because there are two syllables and different meanings so it is impossible to mislead the public and of course the Directorate General of Intellectual Property Rights has also granted the list Biorf mentioned in the General Brand list.

The provisions of Article 6 have stated the detail of the equation on the principal / whole of the brand:

"(1) The application shall be rejected by the Directorate General if the Mark:

- a. Have an equivalent in essence or in its entirety with a Mark owned by another party already registered in advance for similar goods and / or services;
- b. Have in common or in whole with a mark that is already well-known to another party for similar goods and / or services;
- c. Have the equation in essence or the whole with known geographical indications. "

However that being the main element of the case is about whether Biorf brand has been submitted in good faith / no, in accordance with the provisions of Article 4 of Law no. 15 of 2001 on Marks expressly stating:

"The mark can not be registered on the basis of the petition filed by the Petitioners who have a bad faith"

III. CONCLUSION

Based on the discussion that has been described in the previous chapters, it can be concluded as follows:

1. Criterion of the equation principally in Act no. 15 of 2001 on Marks more referring to aspects the similarity caused by the presence of prominent elements between one brand and another brand, giving rise to the impression of equality of form, way of placement, way of writing or combination of elements or equations of speech sounds contained in the brands. The essence of the equation of speech sounds in these two brands either misrepresents society or misleads society because of its similarity.
2. The concept of equality is substantially associated with Decision No. 590 K / PDT.SUS / 2012 is the existence of equations of the elements of the word brand equation BIORE owned by the Plaintiff, the equations of the elements of the Biorf letters differ only in the last letter F and E and both brands visually have the form equation, sound or speech, way of writing and way of placement. The equation of pronunciation sounds indirectly with the brand BIORF is used to PITCH the Biore brand as a well-known brand, and this is a bad faith of the Defendant.

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