

## **THE PRINCIPLE OF ACCURACY IN FAMOUS TRADEMARK REGISTRATION: AN ANALYSIS OF COURT RULING NUMBER 36/PDT.SUS-MERЕК/2024/PN.NIAGA.JKT.PST**

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### *Abstract*

*The trademark registration system in Indonesia, namely First to File, is often misused by unscrupulous individuals to register trademarks similar to well-known brands. This study aims to analyze and address issues related to trademark registration in Indonesia, including the First to the File system in trademark registration, primarily based on the “Jollibee vs Jollybe” trademark dispute, by integrating the use of one of the General Principles of Good Governance (AUPB), namely the principle of accuracy. Implementing AUPB can reduce the potential for conflicts and trademark disputes in the future. This study uses a statute approach by prioritizing primary and secondary data sources collected through literature research and uses qualitative descriptive analysis techniques. The results of this study indicate that the First to File system in trademark registration in Indonesia only provides legal protection after the Trademark is registered. Therefore, applying the Principle of Care in AUPB as a guideline in the trademark registration process is essential. However, suppose there is an error made by the trademark examiner when registering a trademark. In that case, it can be accounted for by creating a report addressed to the Indonesian Ombudsman to obtain mediation, consolidation, or adjudication.*

**Keywords:** Trademark Registration; Trademark Disputes; Principle Of Accuracy.

### **INTRODUCTION**

In general, traders, as commercial business actors in the world of trade, deliberately use brands for their merchandise. A brand as a sign to distinguish one product from another, especially for similar goods, is a form of business imposed by the entrepreneur by placing a stamp in the form of a name, color, image, and shape on the traded object. This aligns with the definition of a brand, which is something (an image or name) that can be used to define a product or company in the market. The use of a brand on a traded object has a significant impact on business people's promotion of the products they produce. Among other things, sellers can achieve popularity and gain buyers' trust. In addition, its use also

indicates that the product comes from the manufacturer concerned. For this reason, entrepreneurs often register their brand to prevent other parties from using it. All of this is done solely to gain a positive reputation from consumers. (Istiqmalia & Joesoef, 2021).

The trademark registration system in Indonesia, namely First to File, is often misused by people to register trademarks similar to well-known foreign brands not registered in Indonesia. So, by registering these famous brands and selling similar products, consumers can be deceived because they will think that the products sold under these brands are the same as those of well-known brands. Free-riding on reputation is the correct term to use to define this situation. In general, the targets of these unscrupulous people are



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famous brands that have long built a reputation and trust in the community. (Rizkia & Fardiansyah, 2022).

Legal protection for well-known brands in Indonesia is essential for creating a safe and comfortable industrial and economic climate for business actors. This has been regulated in Article 21 paragraph (1) of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which states that: “The application will be rejected if the Trademark is essentially or entirely identical to:

- a) Registered Trademark belonging to another party or previously requested by another party for similar goods and/or services;
- b) Well-known Trademark belonging to another party for similar goods and/or services;
- c) Well-known Trademark belonging to another party for dissimilar goods and/or services that meet specific requirements or
- d) Registered Geographical Indication.”

Trademark registration in Indonesia uses the First to File system, where the first registrant is recognized as the trademark owner. In practice, many unscrupulous people still take advantage of the loopholes in the First to File system, which results in well-known foreign brands being unable to register their brands in Indonesia because they have been registered first by residents. This is detrimental to foreign producers whose brands are notable because they cannot be used alone. The case raised for this study is the dispute over the Jollibee brand owned by Jollibee Foods Corporation (JFC), an international fast food company from the Philippines,

which has sued Budi Satria as the defendant and the Trademark Appeal Commission, Directorate General of Intellectual Property of the Ministry of Law and Human Rights of the Republic of Indonesia as the co-defendant. Budi Satria's registered trademark “Jollybe” is similar in whole or substance to JFC's well-known trademark “Jollibee”.

Therefore, this study aims to analyze and address issues related to trademark registration in Indonesia, including the First to File system in trademark registration, primarily based on the “Jollibee vs Jollybe” trademark dispute, by integrating the use of one of the General Principles of Good Governance (AUPB), namely the principle of accuracy. AUPB is a legal principle in legal science, so it has an abstract dimension and directs the implementation of legal norms. According to G.W. Paton, legal principles are abstract thoughts in law that have a directing dimension, meaning that the implementation of legal norms must refer to legal principles. (Zamroni, 2019). The existence of AUPB in positive law in Indonesia has been facilitated, as in the formulation of Article 5 of Law Number 30 of 2014 concerning Government Administration (AP Law), which emphasizes that the implementation of government administration in Indonesia must be based on AUPB. The emphasis on AUPB in the Government Administration Law not only strengthens the position of AUPB in administrative law but also demonstrates the importance of AUPB in maintaining justice and legal certainty in government administration.

Applying the General Principles of Good Governance (AUPB) is expected to

minimize the occurrence of maladministration in the trademark registration process, which can occur in various forms, such as errors in the examination stage, unreasonable delays, or unclear registration procedures. This can result in losses for trademark applicants, such as delayed processes, additional costs, or even unfair rejection of registration. Furthermore, it can reduce the potential for conflicts and trademark disputes in the future, as the use of AUPB in trademark registration is oriented towards achieving justice and can realize accountability to the community, especially between the parties registering trademarks and the general public (Masnun et al., 2024). Therefore, trademark registration authorities must increase transparency and accountability in the registration process and provide an effective complaint-handling mechanism to address potential maladministration. By applying the General Principles of Good Governance (AUPB) in trademark registration, public trust in the trademark registration system can increase, and the registration process can run more effectively and efficiently. Thus, the research problem formulation arising from this background is: 1) How is the process of registering a well-known trademark in Decision Number 36/Pdt.Sus-Merek/2024/PN.Niaga.Jkt.Pst?; and 2) How should the government be held accountable for registering well-known trademarks by applying the principle of accuracy?

## **RESEARCH METHODS**

The research method used in this article is doctrinal legal research. (Disemadi, 2022) This is a legal research

based on library materials. This type of research will thoroughly examine statutory laws, jurisprudential decisions, and expert opinions to understand the regulatory framework comprehensively. This research employs a dual approach, combining the statutory approach, which involves a thorough analysis of pertinent legislation and regulations, with the case approach, which provides an in-depth examination of a specific legal case to gain a deeper understanding. This research uses primary and secondary legal materials. Primary legal materials consist of the Trademark Law, Geographical Indications Law, Law on Government Administration, Ombudsman Regulation of the Republic of Indonesia Number 26 of 2017 concerning Procedures for Receiving, Examining, and Settling Reports, and Court Decisions. Secondary legal materials, which provide supplementary information and analysis, include journals, research findings related to protecting well-known trademarks, applying the principle of carefulness, and books.

This study employs a library research approach, wherein the researcher collects data from various sources, including journals, books, academic papers, and relevant literature. The data analysis in this research uses a descriptive qualitative study, which involves taking and examining data related to the problems/cases that occur, so that it can be described descriptively, qualitatively, and comprehensively, and is still associated with the applicable legal aspects. (Marzuki, 2017).

## RESULTS AND DISCUSSION

### Registration Process for Famous Brands in Decision Number 36/Pdt.Sus-Merek/2024/PN.Niaga.Jkt.Pst

In Indonesia, the history of trademark law began in 1961, with Law Number 21 of 1961 concerning Company Trademarks and Commercial Trademarks (State Gazette of the Republic of Indonesia Number 290, Supplement to State Gazette Number 2341). In 1992, Trademark Law Number 19 of 1992 (State Gazette Number 81 of 1992) was enacted to repeal Law Number 21 of 1961, which was then revised in 1997 and 2001 to conform to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement), with the issuance of Law Number 15 of 2001 concerning Trademarks. On October 27, 2016, the government and the House of Representatives (DPR) passed Law Number 20 of 2016 concerning Trademarks and Geographical Indications, which replaced Law 15/2001. The change in the legal principle of trademarks first occurred in 1992, when the system changed from the first-to-use principle or declaration system to the first-to-file system or constitutive system.

In the constitutive system, it can be explained that “the right to a trademark is an exclusive right, granted by the State to the owner of the trademark, who is the first to register and is registered in the General Register of Trademarks.” So, without registration, there is no right to a trademark. Based on Article 3 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications, “the right to a trademark is obtained after the trademark is

registered.” Therefore, trademark registration is a must to obtain trademark rights. This means that without registering a trademark, a person will not be given legal protection by the state if others copy the Trademark. (Nadya & Lim, n.d.). Under this system, the owner of trademark rights is a person or entity that first registers the Trademark with the Directorate General of Intellectual Property (DGIP) and is listed in the General Register of Trademarks.

A trademark registration application can be made when the Trademark has sufficient distinctiveness for legal protection. In addition, there are provisions regarding brands that cannot be registered and are rejected based on the provisions of Article 20 of the Job Creation Law Number 11 of 2020 in conjunction with Law Number 20 of 2016 concerning Trademarks and Geographical Indications (MIG Law), “namely Trademarks cannot be registered if:

- a) Conflict with the state's ideological principles, laws and regulations, moral standards, religious values, ethical norms, or public decency.
- b) Same as, related to, or only mentioning the goods and/or services for which registration is requested.
- c) Contains elements that can mislead the public about the origin, quality, type, size, kind, and intended use of the goods and/or services for which registration is requested, or is the name of a protected plant variety for similar goods and/or services.
- d) Contains information not by the quality, benefits, or efficacy of the goods and/or services produced.
- e) Has no distinctiveness.

- f) Is a common name and/or symbol that is in the public domain and/or
- g) Contains a functional form.”

In addition, based on the provisions of Article 21, paragraph 1 of the MIG Law, “the application will be rejected if the Trademark is wholly or essentially identical to the following:

- a) Registered Trademarks belong to other parties or are applied for in advance by other parties for similar goods and/or services.
- b) Well-known trademarks belong to other parties for similar goods and/or services.
- c) Well-known Trademarks belonging to other parties for dissimilar goods and/or services that meet specific requirements, or
- d) Registered Geographical Indications.”



Furthermore, the provisions of Article 21, paragraph 2 state that “the application will be rejected if the Trademark:

- a) Constitutes or closely resembles the name, initials, photograph, or name of a legal entity belonging to another person, unless explicitly authorized in writing by the rightful owner;
- b) It is an imitation or resembles the name or abbreviation of the name, flag, emblem, symbol, or emblem of a country, national, or international institution, except with the written consent of the authorized party;
- c) It is an imitation or resembles the official mark or stamp used by the state or government agency, except with the written consent of the authorized party.”

However, applying the provisions in articles 20 and 21 of the MIG Law is still

questionable. This is because in decision number 36 / Pdt. Sus-Merek / 2024 / PN.Niaga.Jkt.Pst. It is known that the owner of the famous Jollibee brand has applied for trademark registration in class 35 on March 20, 2024, with application number JID2024026035. In the registration process, another registered trademark was found to have similarities with the well-known Jollibee brand, namely the Jollybe brand, which was registered on May 13, 2020, in class 35 with registration number IDM000710913. If viewed further, the famous Jollibee has registered its brand in various classes since 2004, as listed in the table below.

*Table 1. Jollibee's trademark list*

No	Brand	Registration Number/ Registration Date	Class
1		IDM001150579 / January 3, 2024	43
2		IDM000004618 / April 19, 2004	43
3	JOLLIBEE	IDM000441083 / May 11, 2022	29
4	JOLLIBEE	IDM000648400 / July 10, 2019	25
5	JOLLIBEE	IDM000845637 / April 15, 2021	21

Based on the table above, it can be seen that the Jollibee brand has been registered and is still valid today. However, when the owner of the Jollibee brand wanted to register again in class 35, a similar brand was registered. Namely, the Jollybe brand is registered by Budi Satria with registration number IDM000710913 for class 35. The Intellectual Property Database (PDKI) page states that the Jollybe brand was registered on May 13, 2020, and has a protection date of August 28, 2028. Indeed, when the Jollybe trademark was registered, the Jollibee brand had not registered its Trademark in that class. However, if you look at the table above, the Jollybe trademark should have been rejected because it is essentially similar to

the famous Jollibee brand. This is a loophole in implementing the First to File system in Indonesia because this system is contrary to the protection of well-known trademarks, namely in Article 21 of the MIG Law. (Al'Uzma et al., 2023).

In addition, the gap in the implementation of the First to File system is also proven by the results of the Jollibee vs. Jollybe trademark dispute case, namely:

1. Grant the Plaintiff's lawsuit in part;
2. Declare that the "JOLLIBEE" trademark and its variations, belonging to the Plaintiff, are well-known trademarks;
3. Declare that the "JOLLYBE" trademark with Registration No. IDM000710913, belonging to Defendant in class 3, is similar to the "JOLLIBEE" trademark and its variations, belonging to Plaintiff, a well-known trademark.
4. Declaring that the "JOLLYBE" trademark with Registration No. IDM000710913, belonging to the Defendant in class 3, was applied for in bad faith;
5. Canceling or declaring the "JOLLYBE" trademark invalid with Registration No. IDM000710913 belongs to the Defendant in class 3 from the General Trademark Register.
6. Ordering the Co-Defendant (Trademark Appeal Commission, DGIP, Ministry of Law and Human Rights) to cancel the trademark "JOLLYBE" with Registration No. IDM000710913 belongs to the Defendant in class 35 of the General Trademark Register;

7. Ordering the Defendant to bear the costs of the proceedings in the amount of Rp2.580.000,-;

8. Dismiss the Plaintiff's claim in addition to and over the foregoing.

Under the court's ruling, it can be proven that the Jollibee brand is a well-known brand. In contrast, the Jollybe brand registered in class 35 results from a trademark registration in bad faith because it is similar in principle to the well-known Jollibee brand. Therefore, the judge ordered the co-defendant to cancel the Jollybe trademark with registration number IDM000710913 belonging to the defendant in class 35 from the General Trademark Register so that the well-known Jollibee trademark could register its Trademark in class 35.

Despite canceling the registered trademark Jollybe, the implementation of Articles 20 and 21 of the Trademark Law is still incomplete. This is because these articles' provisions regarding trademarks that have similarities with well-known trademarks must be rejected. As the trademark examiner, DGIP has been negligent in conducting trademark examinations and granting trademark registration applications. This has led to disputes between registered trademarks and well-known trademarks, such as the dispute between the well-known trademark Jollibee and the registered trademark Jollybe. Due to this negligence, various losses have been incurred by both parties, not only material losses such as loss of sales and significant revenue, loss of large investments in trademarks and products that have been developed with great effort, and unexpected expenses to replace trademarks, pay fines or penalties imposed, but also immaterial losses such

as damage to the company's reputation, which can affect business relationships between the company and its partners, suppliers, and customers, as well as loss of consumer trust in the company and its products, thereby hurting the company's image that can last long-term and be challenging to restore. Therefore, accountability is needed to register well-known trademarks by applying the principle of accuracy.

### **Government Accountability in Registering Well-Known Trademarks by Applying the Principle of Accuracy**

Implementing the First to File system in Indonesia underscores the crucial role of DGIP (Directorate General of Intellectual Property) in providing trademark owners with legal certainty and protection. Consequently, individuals seeking to acquire trademark rights must register their trademarks. The trademark registration process necessitates the application of several principles of good governance. Examining trademark registration applications, culminating in issuing a trademark registration certificate, constitutes an integral aspect of governmental administration. The General Principles of Good Governance (AUPB), as stipulated in Article 1, paragraph 17 of Law No. 30 of 2014 on Administrative Governance, serve as a guiding framework for government officials in decision-making and action-taking. The principle of diligence is one of the core principles. Furthermore, AUPB plays a vital role in safeguarding the rights of well-known trademark owners by preventing the registration of trademarks in bad faith.

Legal protection protects society from the detrimental consequences of unfair competition and illicit activities. Essentially, legal protection constitutes a legal measure instituted by the State to promote justice, maintain social order, safeguard intellectual property rights, and prevent violations by parties seeking to exploit trademarks for duplicitous purposes. The primary goal of legal protection is to guarantee that products purchased by consumers are secure, trustworthy, and fulfill their intended function upon acquisition.

In Indonesia, legal protection can be categorized into two main types: Preventive Legal Protection and Repressive Legal Protection. Preventive Legal Protection refers to proactive measures taken by the government to prevent potential violations and avoid situations that can significantly harm the interests of registered trademark holders and their business interests. Preventive measures based on the Trademark Law depend on the trademark owner. Article 1(5) of the Trademark Law states that trademark rights are exclusive rights granted by the state to registered owners for a specific period, allowing them to use the trademark or authorize others to use it. Article 35 further explains that registered trademarks are granted protection for 10 years from the registration date. Extension of this protection is subsequently possible in consecutive 10-year periods. To renew a trademark, the owner must initiate the extension process at least 12 months before the expiration of the protection period. It should be noted that the protection period will only be extended if the trademark is continuously used in commercial activities. In the case of the

Jollibee vs Jollybe trademark dispute, it can be seen that although Jollibee did not conduct business directly in Indonesia, the company still collaborated with third parties, which are also well-known to the Indonesian and international communities, to promote the Jollibee brand. This is also stated in the list of evidence submitted by Jollibee during the trial. Therefore, unregistered products will not be recognized or protected under the Law. The Ministry of Law and Human Rights and the Directorate General of Intellectual Property Rights (DGIP) are crucial in ensuring trademark protection through preventive legal assistance, including seminars and trademark registration facilitation, especially for Micro and Small Businesses. Meanwhile, Repressive Legal Protection includes punitive measures (fines, imprisonment, and sanctions) that are the last resort and settlement in case of violating the applicable laws and regulations. Despite registration, trademarks frequently encounter obstacles, including unauthorized use by prior users or third-party imitation. Resolution can be pursued in a dispute through either criminal or civil channels. As exemplified by the Jollibee vs Jollybe trademark dispute case, Jollibee Foods Corporation, the proprietor of the renowned Jollibee brand, opted to pursue the civil route by instituting a lawsuit with the Jakarta Central District Court. This decision was motivated by the lawsuit's content, which sought a declaration of nullity of the registered Jollybe trademark in class 3 and a declaration of Jollibee as the first and sole legitimate user and owner of the Jollibee trademark.

The legal protection provided to registered trademarks is designed to prevent unfair business competition. This preventative measure manifests as prohibitions or injunctions against third parties that exploit or misappropriate others' trademarks. Furthermore, it safeguards trademark owners, enabling their economically valuable creations to fulfill their needs effectively. Consequently, trademark protection is paramount, as it can constitute a highly valuable commercial asset.

The First to File trademark registration system creates a significant loophole for irresponsible parties to register similar trademarks, either in whole or in substance, to existing well-known trademarks. This vulnerability arises from the negligence of the trademark examiner or the Directorate General of Intellectual Property (DGIP), leading to the registration of trademarks that bear essential similarities to well-known trademarks. The issues surrounding trademark registration under the "first to file" system at the DGIP have highlighted the need for the DGIP to prioritize and adopt the Principles of Good Governance (AUPB) as the foundation for conducting trademark registration processes that guarantee fairness and equity for the community. (Al'Uzma et al., 2023).

In the trademark registration process, a stage of trademark examination is undertaken to assess the mark's registrability. This stage is referred to as the substantive examination stage. If the trademark registration application submitted is deemed to comply with Articles 20 and 21 of the Trademark Law, the Directorate General of Intellectual



Property (DGIP) will assign a registration number and proceed with the next stage of the registration process. Conversely, suppose the trademark registration application is deemed to conflict with Articles 20 and 21 of the Trademark Law. In that case, the DGIP will issue a notification of rejection, allowing the applicant to respond to the decision. The rejection proposal is based on two primary grounds, namely:

a) Absolute Grounds for Refusal

A trademark may be subject to absolute rejection if it fails to satisfy specific requirements. A trademark may be rejected if it resembles the name or initials of a renowned individual, photograph, or name of a legal entity, as well as emblems, symbols, or logos utilized by institutions or governments. A trademark may also be rejected if it contravenes the state ideology, laws and regulations, moral principles, religious tenets, or public order. Trademarks that incorporate elements that mislead the public regarding a product's origin, type, or quality may also be rejected. Likewise, trademarks that lack distinctiveness from other marks or constitute generic names or public logos are ineligible for registration.

b) Relative Grounds for Refusal

This denotes rejections that arise from subjective grounds or are contingent upon the examiner's expertise, as informed by the prevailing technical guidelines for trademark examination. A multitude of factors contribute to the absolute rejection of a trademark. Subjective rejections typically stem from the

examiner's perspective on a trademark application, which is anchored in Article 21 of Law Number 20 of 2016 regarding Trademarks and Geographical Indications. (Heriani, 2023).

Therefore, the Principles of Good Governance (AUPB) must be applied during this examination stage, specifically the principle of accuracy, which requires that all decisions and actions be grounded in comprehensive, accurate information and complete documentation. This principle is also pertinent to examining trademarks intended for registration, which must possess distinctive characteristics that differentiate them from other trademarks and reflect the product's originality.

The trademark registration process also constitutes a governmental action classified as *beschikking* within administrative law. Trademark registration represents a form of governmental action that grants authorization to the trademark owner to utilize the trademark. By meticulous trademark registration undertaken by the trademark examiner, potential losses incurred by the trademark owner can be averted. Consequently, the trademark examiner must exercise diligence and caution throughout the trademark registration process. Suppose an error occurs while registering a trademark bearing similarities to another trademark. In that case, such an oversight can be attributed to a lack of attention to the principles of *rechtmatigheid van bestuur* (legality principle).

The failure to apply the principle of accuracy in the trademark registration process will continue to result in

trademark disputes, as exemplified by the case of the trademark dispute between the renowned Jollibee brand, owned by Jollibee Foods Corporation (the proprietor of the well-known trademark), and the Jollybe brand, owned by Budi Satria (the proprietor of the registered trademark). In court ruling Number 36/Pdt.Sus-Merek/2024/PN.Niaga.Jkt.Pst reveals that the Jollybe trademark was registered on May 13, 2020, with a filing date of August 28, 2018, in the name of Budi Satria in class 35. Given Indonesia's First to File trademark registration system, it created difficulties for the proprietor of the well-known Jollibee brand to register their trademark in the same class. Moreover, the co-defendant (DGIP) asserted in the decision that the registration of the Jollybe trademark in class 35 with registration number IDM000710913 in the name of Budi Satria had complied with the applicable legal mechanisms, including formal examination, publication, substantive examination, and certification, and had even undergone examination based on Articles 20 and 21 of the Trademark Law. This assertion, however, contradicts the evidence presented in the decision, which demonstrates that the well-known Jollibee brand had been registered in the general trademark register in Indonesia across various trademark classes.

This case highlights the insufficient application of the principle of accuracy by the trademark examiner and the DGIP in accepting trademark registration applications that bear similarities to well-known trademarks, thereby resulting in losses for the trademark owner. Therefore, accuracy is essential for registering the Jollybe trademark, which

bears similarities to the well-known Jollibee trademark. One form of accountability undertaken is canceling the "JOLLYBE" trademark with Registration Number IDM000710913 owned by the Defendant in class 35 from the General Trademark Register. In this context, the DGIP bears absolute responsibility for issuing the Jollybe trademark certificate, which bears similarities to the well-known Jollibee trademark, thus contravening Articles 21 and 22 of the Trademark Law. This circumstance arose because the DGIP has been empowered by the state, through the Ministry of Law and Human Rights, to manage Intellectual Property (IP) trademarks by prevailing laws and regulations.

On the other hand, the trademark examiner who passed the substantive examination for a trademark that bears similarities to a well-known trademark must also be held responsible. However, as seen in the court decision, the Panel of Judges only had the defendant accountable by imposing court costs. In contrast, the co-defendant, in this case, the DGIP or the trademark examiner, was not held responsible. This is because there is no regulation regarding the imposition of individual accountability for the mistakes or negligence of the trademark examiner. Nevertheless, to obtain accountability or compensation for the errors, the trademark owner can file a report with the Ombudsman, as the mistakes that occurred during the substantive examination constitute a form of maladministration in the provision of public services. According to Article 1, paragraph 1 of the Ombudsman Regulation Number 31 of 2018, "The Ombudsman is a state institution that has

the authority to oversee the provision of public services, both those provided by state administrators and governments, including those provided by state-owned enterprises, regional-owned enterprises, and state-owned legal entities, as well as private individuals or entities that are tasked with providing certain public services, which are partially or fully funded by the state budget and/or regional budget.” The trademark owner can file a report with the Ombudsman after submitting a report directly to the DGIP or the trademark examiner. Still, the report does not receive a proper resolution, as stated in Article 4, paragraph 1, letter D of the Ombudsman Regulation of the Republic of Indonesia Number 26 of 2017. The resolution of this report is mediation or consolidation. However, if no agreement is reached, a special adjudication can be conducted regarding the compensation costs imposed on the trademark examiner after an examination process that finds maladministration, as stated in Article 38 of the Ombudsman Regulation of the Republic of Indonesia Number 26 of 2017. The presence of the Ombudsman, can help reduce the losses experienced by parties involved in disputes over well-known trademarks, such as significant financial losses due to litigation costs, losses due to prolonged delays, and reputational losses that can have long-term impacts on a company's image and consumer trust, thereby enabling parties involved to resolve disputes more quickly and refocus on developing their businesses.

## **CONCLUSION**

- a) The trademark registration process for Jollibee in Indonesia encountered numerous challenges, including the prior registration of a similar trademark, namely Jollybe, in the general trademark register. This underscores a vulnerability in the First to File system, attributable to the inadequate application of the principle of accuracy in examining trademarks intended for registration. Although the proprietor of the well-known Jollibee trademark ultimately succeeded in registering their trademark in Indonesia, this does not exonerate the trademark examiner and those responsible for approving the “Jollybe” trademark from accountability. Genuine accountability is essential, as this situation resulted in losses for both the well-known and registered trademark proprietors. Consequently, accountability and the application of the principle of accuracy are indispensable in the trademark registration process to prevent negligence that may harm the owners of registered trademarks and well-known trademarks.
- b) Implementing the “First to File” system in Indonesia's trademark registration regime underscores the vital role of the trademark registration office in providing legal certainty and protection to trademark proprietors. Nevertheless, weaknesses persist in implementing this system, particularly regarding protecting well-known trademarks. The trademark dispute between the famous Jollibee and the Jollybe

trademark illustrates that the trademark examiner and the DGIP have failed to properly apply the principle of accuracy in the trademark registration process. This oversight has resulted in losses for the proprietor of the well-known trademark. Therefore, accountability is essential for registering the Jollybe trademark, which bears similarities to the well-known Jollibee trademark. Trademark proprietors may file a report with the Ombudsman if the errors that occur during the substantive examination constitute a form of maladministration in the provision of public services.

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#### REFERENCES

- Alexander, R. (2022). Penerapan Prinsip “First To File” Pada Konsep Pendaftaran Merek Di Indonesia. *Jurnal Kertha Semaya*, 10(9), 2110–2121.
- Al’Uzma, F., Saidin, O., Azwar, K. D., & Andriati, S. L. (2023). Analisis Putusan dan Pertimbangan Hakim dalam Perkara Sengketa Merek antara Starbucks Corporation Melawan Sumatera Tobacco Trading Company (Studi Putusan Makamah Agung Nomor 836 K/PDT.SUS-HKI/2022). *Locus Journal of Academic Literature Review*, 2(4), 355–365.
- Arlina, S., & Milandry, A. D. (2022). Implementation Of Legal Protection: The Famous Trademarks Ikea And Sephora Brand (Trademark Law Perspective). *Jurnal Cendekia Hukum*, 8(1), 71–84.
- Bafadhal, T. (2018). Perlindungan Hukum terhadap Merek Terkenal di Indonesia: Kasus IKEA. *Undang: Jurnal Hukum*, 1(1), 21–41.
- Debora, Sidauruk, J., Sihotang, L., & Simangunsong, M. (2022). Ketentuan Hukum Merek Wellknown Mark Dalam Pemberlian Melalui Online. *PKM : Pengabdian Kepada Masyarakat*, 3(1), 42–50.
- Dirkareshza, R. (2022). *Buku Ajar Hak atas Kekayaan Intelektual*. Deepublish.
- Disemadi, H. S. (2022). Lenses of Legal Research: A Descriptive Essay on Legal Research Methodologies. *Journal of Judicial Review*, 24(2), 283–304.
- Gunawan, Y. (2022). Penyelesaian Sengketa Merek Terdaftar Dan Merek Terkenal Dalam Mewujudkan Perlindungan Hukum. *IBLAM Law Review*, 2(2), 141–164.
- Heriani, F. N. (2023). *Begini Mekanisme Pemeriksaan Merek dalam Proses Pendaftaran Merek*. Hukumonline.Com. <https://www.hukumonline.com/berita/a/begini-mekanisme-pemeriksaan-merek-dalam-proses-pendaftaran-merek-lt642d4b0f1b4de/?page=1>
- Is’ad, F., & Riswandi, B. A. (2022). Legal Protection For Well-Known Trademarks Between Indonesia And Spain (Case Study Between Lois And Newlois). *Journal of Intellectual Property*, 5(2), 169–189.
- Istiqmalia, M. N., & Joesoef, I. E. (2021). Itikad Baik Dalam pendaftaran Merek: Studi Perlindungan Hukum

- Pemilik Merek Terkenal Di Indonesia. *Jurnal Penegakan Hukum Indonesia*, 2(3), 406–426.
- Kamila, P. (2022). Kepastian Hukum Atas Pemberlakuan Sistem Pendaftaran Merek First To File Terhadap Merek Terkenal Di Indonesia. *Jurnal Notarius*, 1(2), 300–309.
- Kusumawardhana, R. F. A. (2023). Efektivitas Prinsip First To File Pada Sistem Pendaftaran Merek Dalam Melindungi Hak Merek. *Private Law*, 11(1), 12–21.
- Lobo, L. P., & Wauran, I. (2021). Kedudukan Istimewa Merek Terkenal (Asing) Dalam Hukum Merek Indonesia. *Masalah-Masalah Hukum*, 770–783.
- Marzuki, P. M. (2017). *Penelitian Hukum*. Kencana Prenada Media Group.
- Masnun, M. A., Prasetio, D. E., Awang, M. B., & Sulistyowati, E. (2024). Reconstructing Indonesia's Trademark Registration System through the Lens of General Principles of Good Governance to Realize Substantive Justice. *Journal of Law and Legal Reform*, 5(3), 891–912.
- Nadya, C., & Lim, M. (n.d.). Legal Protection for Famous Trademarks in Indonesia: Case Study of the Supreme Court Decision No. 264/K/Pdt.Sus-HKI/2015. *Anthology: Inside Intellectual Property Rights*, 2(1), 348–371.
- Ramli, A. M., Palar, M. R. A., & Tim Peneliti. (2019). *Hukum Kekayaan Intelektual: Indikasi Geografis dan Kekayaan Tradisi dalam Teori dan Praktik*. PT Riefka Aditama.
- Rizkia, N. D., & Fardiansyah, H. (2022). *Hak Kekayaan Intelektual Suatu Pengantar*. Widina Bhakti Persada Bandung.
- Samosir, P. O., & Mustafa, A. (2020). *Legal Protection Implications on Trademark in Indonesia by Comparing the First to Use and First to File Principles*. Atlantis Press SARL.
- Setiawan, R., & Fality, F. (2021). The Jurisdiction Of Intellectual Property Rights Of the Nambo Weaving Affairs Of Banggai Regency. *Jurnal Cendekia Hukum*, 6(2), 172–188.
- Tanjung, D. R., Njatrijani, R., & Rahmanda, B. (2023). Penerapan Prinsip First to file Dalam Sengketa Merek Terkenal. *Law, Development & Justice Review*, 6(2), 111–128.
- Wijayanti, H., & Salma, D. (2023). Bad Faith As A Reason For Cancellation Of Trademarks Registered More Than Five Years According To Law Number 20 Of 2016. *Journal of Social Research*, 2(8), 2826–2834.
- Zalukhu, D. P. (2023). Elements of Good Faith in Trademark Registration Under Indonesian Law (Case Study of Supreme Court Decision No. 781 K/Pdt.Sus-HKI/2022). *Locus Journal of Academic Literature Review*, 2(2), 86–96.
- Zamroni, M. (2019). General Principles of Good Governance in Indonesia: What are The Legal Bases? *Varia Justicia*, 15(1).
- Zobel, K. (2016). The Famous Marks Doctrine: Can and Should W amous Marks Doctrine: Can and Should Well-Known Foreign Marks Receive Trademark Protection within the United States? *DePaul Journal of Art, Technology & Intellectual Property Law*, 19(1).