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Legal Protection of Well Known Brands Against Passing Off By Local Entrepreneurs (Case Study of Passing Off of the French Shepora Brand by Shepora Batik)

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Abstract: *The purpose of this research is to determine the criteria that indicate that the Plaintiff's Shepora is a well-known mark that must be protected and how to prove if there has been a passing off of the Plaintiff's mark (Shepora) by Shepora Batik (defendant). This research is a study of documents related to the Passing off of the French Shepora Brand by Shepora Batik. The research results show that the two marks have similarities in essence, because the Defendant's mark also contains the words Sephora, which is the dominant element in the Plaintiff's mark and is also the Plaintiff's mark which has been registered in several countries in the world. The two brand writings are similar in terms of placement, writing method, and letter elements that make up the word Sephora itself, so they produce exactly the same sound when read. The Plaintiff's Sephora was registered in various countries long before the Defendant's brand was registered in Indonesia. If there are similarities in writing, speech and sound with the Plaintiff's brand, it can be ascertained that the Defendant's intentions are other than wanting to piggyback on and benefit from the popularity of the Sephora brand.*

INTRODUCTION

In the trade in goods and services, a brand is a form of intellectual work that is important for the smoothness and improvement of trade in goods or services. Brands have crucial and important value for producers and consumers. The use of a brand is the key to the success of a corporation's trading business, to win business competition in the target market where the product is distributed. Apart from that, the function of the brand itself is that apart from being an aspect of intellectual work that has economic value, it is also a symbol that is a marker of a product produced by a business entity, so that it can be recognized by the public as consumers of that product (Gultom, 2018).

So that companies can maintain and provide quality assurance for the goods and services they produce to consumers or Quality Assurance for a brand. If supported by good promotions, a

brand can gain a good image in society, thereby fostering consumer loyalty to the goods and services produced by the producer (Pangestu, 2020). This will of course make it easier for producers to promote new goods or services, this is also called the promotional function for a brand, and also provides a competitive advantage for market competition. Therefore, a brand has economic value and is an invaluable company asset.

International law also regulates brand protection, these provisions are contained in the Paris Convention, Madrid Agreement, WIPO (World Intellectual Property) Agreement, TRIPs (Trade Related Aspect of Intellectual Property Rights) Agreement. The TRIPs Agreement is a provision that has the most important role, because it is followed by many participating countries and has a strategic role in regulating international trade. The most important thing in the TRIPs Agreement is the emphasis on differentiating elements (Sari, 2014). The TRIPs Agreement explains that distinctiveness is the only substantive condition for brand protection. In Indonesia, brand protection is regulated in a special brand law, namely Law Number 20 of 2016 concerning Trademarks and Geographical Indications. However, this law does not yet regulate the level of brands based on reputation, but in general experts differentiate between brand levels. based on the popularity of the brand. Brand levels are divided into three, namely normal brands, well-known marks and famous brands.

Brands are important to protect because brands include immaterial wealth that can bring high economic profits, because if a brand is used to market a particular product, the high or low quality of a product is indicated by the well-known brand attached to the item. A well-known brand is a sign that a company has a good reputation and is higher than other brands, because of the high qualifications of its product standards, making the brand well-known and much needed by the public. Brands can be very valuable assets commercially, so that sometimes brands actually have a higher value than their real assets, this is because building a brand requires hard work and costs a lot of money (Zainnullah, 2022).

If there is a violation of trademark rights, it will cause losses for the registered trademark owner, because the registered trademark owner has spent quite a lot of money to promote the trademark he owns. Apart from that, the trademark owner must be able to maintain the quality of his business so that he continues to gain the trust of the wider community. So if there is a violation of certain brand rights, it will be very detrimental to entrepreneurs who have tried hard and honestly to use the brand for their business. (Amira, 2021) Protection of famous marks is regulated in Article 6 paragraph (1) of the Paris Convention which states that "States must refuse registration of a trademark where the registered trademark is a famous trademark, so as to prevent replicas, reproduction, or translation and confusion between the original well-known mark and the imitation mark."

So the Paris Convention prohibits countries that ratify the Paris Convention and TRIPS from ratifying marks registered by other parties where the mark is a well-known brand whose quality is known to the public at the international level (Putra, 2022). Trademarks can obtain protection if the mark is registered with the Directorate General of Intellectual Property Rights. In the Trademark Law, it is explained that a registered mark has the exclusive right to prohibit third parties without the permission of the mark owner from using the same mark for goods and/or services that have been previously registered. However, legal protection of the registered mark is not a guarantee, if there are sufficient reasons for a trademark registration with the Director General of Intellectual Property Rights, it can be removed or canceled based on statutory regulations, where the trademark has violated the requirements regarding whether or not a trademark can be registered and the trademark is rejected.

The important principles to be used as a basis for trademark registration are the need for good faith on the part of the registrant. Based on this principle, only registrants who have good faith will receive legal protection. This has the consequence that the Director General of Intellectual Property Rights in Indonesia is actively obliged to refuse trademark registration if it is clearly found that there is imitation of a registered trademark based on bad faith. An applicant in good faith is an applicant who registers his or her trademark properly and honestly without any intention to piggyback on, imitate or copy the popularity of another party's brand for the sake of his or her business interests, resulting in losses to other parties or creating conditions for unfair competition, deceiving or misleading consumers (Syafi'i, 2021).

In Indonesia there are often trademark disputes, one of the cases is the trademark dispute between Shepora International and Shepora Batik owned by Yuana Thanaya. This case started when Shepora International registered a lawsuit with the Central Jakarta Commercial Court through decision Number 34/Pdt.Sus-Merek/2015/PN .Niaga.Jkt.Pst dated June 5 2015 for brand cancellation. The dispute occurred between a manufacturer and retailer of premium cosmetic equipment from Paris, France or the owner of the Sephora trademark (as plaintiff) whose brand is a well-known international brand in the cosmetics sector and has been in use since 1970, and has been registered, traded and promoted publicly. large and sustainable in several countries in the world, including Indonesia, which has been registered with the Directorate General of Intellectual Property for the Sephora trademark with types of goods in class 3, namely class 25, class 34 and class 44.

In this dispute the plaintiff is fighting against the defendant Yuana Tanaya, a local businessman who uses the Sephora trademark, whose brand has been registered since July 22 2009. Where there are similarities in essence and overall in the use of the brand between the plaintiff and the defendant in the class 25 trademark for clothing , footwear and headgear as well as in class 35 service marks for advertising, business management, business administration and office functions (Desmayanti, 2020). Therefore, Sephora, which hereby acts as plaintiff, filed a lawsuit for the cancellation of the Sephora (local) registered mark used by the defendant, and in this lawsuit the Commercial Court at the Central Jakarta District Court has handed down decision Number 34/Pdt.Sus-Brand/2015/PN. Niaga.Jkt.Pst on October 13 2015, which in the main case agreed to the plaintiff's lawsuit in its entirety. One of Sephora International's lawsuits is asking for the cancellation of the local defendant Sephora brand. The Defendant was unable to accept the results of the Commercial Court's decision at the Central Jakarta District Court, and submitted an appeal, however, regarding the petition's legal action, the Supreme Court handed down decision Number 166 K/Pdt.Sus-HKI/2016 whose decision stated that it rejected the cassation request from the cassation applicant. sephora (local).

RESEARCH METHOD

The type of research used in this research is normative legal research. Normative legal research is useful in providing legal opinions if there are gaps, ambiguities or conflicting norms. This research uses a court decision approach and a conceptual approach. The legal materials used in this research are primary and secondary legal materials. The primary data used is court decisions that have permanent legal force. Secondary data in the form of books, journals, scientific articles, newspapers and other scientific papers such as theses and dissertations as a result of research regarding court decisions. The technique for collecting legal materials will use library research. The legal material analysis technique uses syllogism with inference or deductive logic, namely the technique of drawing a conclusion based on the major premise on the minor

premise and then drawing a conclusion.

RESULT AND DISCUSSION

Criteria indicating that the plaintiff's Shepora is a well-known brand that must be protected

Article 6 of the Paris Convention is the basis for the regulatory protection of well-known brands. However, this article cannot provide a clear definition or criteria for famous brands. So these criteria are left completely up to each member country. Meanwhile, in Article 1 of the Decree of the Minister of the Republic of Indonesia No.M.03-HC.02.01 of 1991 concerning Rejection of Applications for Registration of Famous Trademarks regarding Trademark Registration, it states the definition of a famous trademark: "What is meant by a famous trademark in this decision is a trademark that is generally better known. or used on goods traded by a person or entity, both in Indonesia and abroad (Arifin, 2020).

There are 3 (three) forms of well-known trademark infringement regulated in WIPO, namely:

1. Trademark Piracy: Trademark piracy means the use of a generally well-known foreign trademark that is not registered in that country or is invalid as a result of non-use
2. Counterfeiling: Counterfeit products that are not only similar in pronunciation. However, it also gives the impression of being a genuine product (for example a Louis Vuitton bag), which comes from a genuine manufacturer or trader. counterfeiting (falsification) is the impression that a fake product is a genuine product, it is not enough just to have similar words
3. Imitation Label and Packaging: In the case of counterfeiting, the label or packaging of a competitor's product is imitated, but in the case of imitation it does not give the impression of being an original product. (Prasetia, 2020)

Protection of well-known marks is regulated in Article 6 of the Paris Convention which requires all members to protect the well-known marks of other citizens for similar or identical goods. With Trips Art.6 bis Paris Convention regarding well-known marks, this applies to goods or services that are not the same as the goods for which the mark is registered, provided that the trademark user is in connection with the goods or services with the goods for which the trade mark is registered and on the condition that the interests of the owner of the registered mark are disturbed by that user (Nasir, 2021).

The permanent jurisprudence of the Supreme Court of the Republic of Indonesia states that a well-known brand is a brand that has circulated beyond regional boundaries to international boundaries, where it has circulated outside its country of origin and is proven by the public's general knowledge of the mark in question (Nugroho, 2016). The criteria for this well-known brand are regulated in Article 18 of the Minister of Law and Human Rights Regulation Number 67 of 2016 concerning Trademark Registration which states that:

1. The criteria for determining a well-known brand as intended in Article 16 paragraph (2) letters b and c are carried out by taking into account the public's general knowledge regarding the mark in the relevant business field.
2. The community as intended in paragraph (1) is the consumer community or the community in general who have good relationships at the production, promotion, distribution and sales levels of goods and/or services protected by the famous brand in question.
3. In determining the criteria for a brand as a well-known brand as intended in paragraph (1), this is done by considering:

a. The level of public knowledge or recognition of the brand in the relevant business field as a well-known brand
b. The volume of sales of goods and/or services and profits obtained from the use of the brand by the owner
c. The market share controlled by the brand in relation to the circulation of goods and/or services in society;
d. The range of areas where the brand is used
e. The period of use of the brand;
f. Brand intensity and promotion, including the investment value used for such promotion;
g. Trademark registration or application for trademark registration in other countries;
h. The level of success of law enforcement in the field of brands, especially regarding the recognition of the brand as a well-known brand by authorized institutions or
i. The value attached to a brand is obtained because of the reputation and quality assurance of the goods and/or services protected by the brand. (Khotimah, 2022)

If we look at the criteria for famous brands according to Law Number 20 of 2016 concerning Brands and Geographical Indications and according to the World Intellectual Property Organization (WIPO), the Shepora brand is included in the well-known brand because many people already know about Shepora products through advertisements. broadcast on television, or broadcast via radio, distributed via brochures and pasted on billboards on the side of the highway. The Shepora brand is not only available in Indonesia but also in various countries. The plaintiff's Sephora brand has been used commercially which is a valuable asset for the plaintiff and has registered its trademark in several countries in the world, namely on May 3 1973 under Number 398767 to protect goods and services in classes 3, 5, 35 and 42 through WIPO for Germany, Algeria, Australia, Beneluk, Egypt, Spain, Hungary, Italy, Liechtenstein, Morocco, Portugal, German Democratic Republic, Romania, Switzerland, Czechoslovakia, Tunasia, Yugoslavia, Vietnam. April 12, 2000 under Number 003023240 to protect goods and services in classes 3, 5, 6, 8, 16, 18, 21, 24, 25, 26, 35, and 44 in France.

Dated July 31, 1981 under Number 4K00001158654 protects goods and services in classes 3, 5, 8, 16, 18, 20, 21, 24, 25, 10, 26, 35 and 42 through WIPO for the countries Germany, Benelux, China, Poland, Romania, Switzerland, Turkey.Dated February 27, 2001 under Number 2431967 to protect goods and services in classes 3, 35, 38, and 42 in the United States. The plaintiff's Sephora has invested and promoted its brand in several countries including Indonesia and has been able to develop a good reputation and is a seller and distributor of cosmetic products, perfumes and goods related to beauty and body care, and is closely associated with beauty services throughout the world. The plaintiff has been able to operate approximately 1,900 retail stores in 29 countries around the world using its Sephora brand.

By looking at this evidence, it can be concluded that the plaintiff's Sephora brand is included in the well-known brand category. Judges at the Commercial Court and Supreme Court judges stated that well-known brands must meet the elements of being well-known in Indonesian society, but this is a narrow requirement. Sometimes a product is not yet known in Indonesia but is already known abroad, so the manufacturer imports the goods to Indonesia and seeks registration with the Director General of Intellectual Property Rights. The steps taken by the entrepreneur were right and his brand was included in the well-known classification even though it had just entered Indonesia. Article 6 of the Paris Convention stipulates that member countries of the Paris Convention must take ex-officio action if permitted by statutory regulations or at the

request of an interested party to refuse or cancel registration and to prohibit the use of a mark which results in a reproduction, a imitation or a translation which causes confusion, a mark which is determined by the competent authority of the country where the mark is registered or is used as a well-known mark in that country and has become the mark of a person who has the right to do so based on the convention and is used for identical products or similar products. This rule also applies when an essential part of the mark gives rise to an imitation that causes confusion.

There is no set time limit for a trademark cancellation request: “removal or prohibition of use of a registered mark or used in bad faith. A well-known brand means "famous" according to the public's general knowledge. A well-known brand is a brand that is widely known by relevant sectors in society (Puti, 2020). Promotion is the most effective means of building reputation (image). Reputation does not have to be obtained through registration, but can be obtained through actual use in placing goods or services into the market.

Law Number 20 of 2016 does not clearly define famous brands. Famous marks are only mentioned in the explanation of article 21 number 1 letter b. The contents are: Rejection of applications that are substantially or completely similar to well-known marks for similar goods and/or services is carried out by taking into account the public's general knowledge regarding the mark in the relevant business field. Apart from that, attention is also paid to the reputation of a well-known brand which has been obtained due to intensive and large-scale promotion, investment in several countries in the world carried out by its owner and accompanied by proof of registration of the brand in several countries. If the above matters are not deemed sufficient, the Commercial Court can order an independent institution to conduct a survey to obtain conclusions regarding whether or not the mark is famous as the basis for rejection. (Laksmono, 2020)

Proving that there has been a passing off of the Plaintiff's brand (Shepora) carried out by Shepora Batik (defendant)

In Indonesia, counterfeiting of well-known brands often occurs. This can be categorized as an economic crime, because brand counterfeiters not only deceive and harm consumers with fake products, but also damage the reputation of the original entrepreneur. Brands can be a guarantee for the quality of goods or services, if a brand is well known in society, the brand is considered to have sufficient quality of differentiating power and has an influence on society's acceptance. Brands play a very important role in the era of global trade and can only be maintained if there is a climate of healthy business competition and legal certainty in consumer protection by producers of goods. Seeing the large potential and benefits attached to brands, this has resulted in an increase in brand violations occurring (Fajar, 2018).

This is related to the reputation of well-known brands, reputation is one of the factors that can influence consumers' decisions in purchasing a product, usually consumers will prefer to buy products from brands that have a good reputation. Then, when consumers consistently have a good experience with a brand, consumers tend to be loyal to using products from that brand, this is a big advantage for business actors (Wicaksono, 2016). The success of a brand in maintaining its quality and service also gives rise to irresponsible parties using the well-known brand which has negative impacts on the other hand, in order to get the same large profits but with minimal promotional costs so that business actors who are determined to do so acts of brand infringement, these actions are carried out to obtain profits through shortcuts, namely by violating business ethics, norms, morality and the law. One of the brand rights violations that is often encountered is brand infringement by riding on the reputation of a well-known brand.

To be able to identify a brand violation as a hitchhiking off of a reputation, its characteristics and characteristics must first be known. The characteristics of reputational piggybacking (passing off) are first, there is a mistake that occurs in society regarding the origin of goods and/or services. Second, the violation was committed by a business actor within the scope of trade. Third, the target is consumers or loyal customers of business actors who are made victims. Fourth, this action is considered to have detrimental consequences for the reputation of other business actors. And fifth, causing damage to the business or goodwill of the business actor with whom the action is carried out. This action is usually carried out implicitly, meaning that it does not openly imitate another brand in its entirety (Suryadi, 2022).

Piggybacking on the reputation (passing off) of a well-known brand carried out by perpetrators of brand infringement will usually cause ambiguity among consumers, because the basic similarities between the original famous brand and the perpetrator's brand will make consumers think that the two brands come from the same company. . This is what the perpetrator hopes for, because if consumers already believe that the two brands come from the same company, consumers will tend to prefer one of the two brands which has a lower price, which means that the chance of consumers choosing the perpetrator's brand will increase. bigger, because well-known brands generally have higher prices (Donandi, 2019).

When observing consumer behavior, consumers in this situation usually have a tendency to think that if a brand comes from the same company, even though the price is different, the quality will not be too different. Piggybacking on a reputation (passing off) is an unlawful act, because this act violates the applicable law, in this case the law that is violated is Article 21 (1) of Law Number 20 of 2016 concerning Marks and Geographical Indications, in this article it is regulated that the mark is registered must not have similarities with any brand whether similar in substance or in general with other registered trademarks and/or well-known trademarks. If it turns out that the trademark being applied for does not meet the specified criteria, then the application for registration of the trademark must be rejected. "In the common law legal system, brand piggybacking (passing off) is an act of unfair competition, because this action causes other parties as brand owners who have registered their marks in good faith to experience losses due to parties who fraudulently piggyback or piggybacking on his brand to gain financial gain" (Pentecost, 2020).

In Indonesia, the act of passing off was experienced by the cosmetics company Shepora. In the Supreme Court Decision Number 166K/Pdt.Sus-HKI/2016, namely regarding a trademark dispute between a manufacturer and retailer of premium cosmetic equipment from France, namely Sephora as the plaintiff and Yuana Tanaya as the defendant. The lawsuit was first filed with the Commercial Court at the Central Jakarta District Court with Number: 34/ Pdt.Sus-Merek/ 2015/ PN. Niaga.Jkt.Pst. on June 5 2015.Yuana Tanaya resides at Kejawan Putih Villa West Wood A.7/11-A, Kejawan Putih Tambak, Mulyorejo, Surabaya, as the defendant is a fashion designer who uses the Sephora batik brand to market her batik clothing designs. Based on his Instagram account, the defendant was seen holding fashion shows several times under the name Sephora Batik as the backdrop for the performance stage. The defendant also created an official website with the same name. In terms of font choice, the word "Sephora" appears larger, with capital letters. Meanwhile, the word "batik" in Sephora Batik is only written in fine italic font. From its official website, Sephora Batik is recorded as having its address at Pasar Atum Mall, Surabaya. Yuana registered the brand with the Directorate General of Intellectual Property on July 22 2009 with registration number IDM00211660 for class 25 which consists of all kinds of clothing, namely; ready-made clothing, men's clothing, women's clothing, children's and baby

clothing, head coverings, footwear and others, and IDM00021800 for class 35 which consists of chain sales and marketing services for goods (Multi level marketing/ MLM), advertising , business management, shops, boutiques, sales stands/counters.

Examples of the use of the Sephora brand used by the Defendant in its business activities include brands with the following appearance:





Figure 1. Defendant SEPHORA Logo Image **Figure 2. Plaintiff's SEPHORA Logo Image**

Meanwhile, the Plaintiff is an international cosmetics company under the banner of Louis Vuitton Moet Hennessey (LVMH) located at avenue Edouard Vaillant, 92100 Boulogne Billancourt, France, which has used the "Sephora" brand since 1970 for business activities related to the first sale of cosmetics in Paris, France. From the continuous use of the Sephora brand in many countries around the world, which began in 1970, the Plaintiff has succeeded in developing a good reputation related to the use of the Sephora brand. Currently, the Plaintiff is a seller and distributor of cosmetic products, perfume and goods related to beauty and body care and is closely associated with beauty services throughout the world. The plaintiff has operated approximately 1,900 retail stores in 29 countries in the world using the Sephora brand. The plaintiff has registered the Sephora trademark in Indonesia to protect types of goods in class 3 and types of services in classes 35 and 44. Among them are class 3 goods which have been registered on 4 December 2013 with registration number IDM000402953 which consists of all soaps, fragrances, essence oils, cosmetics, hair oils and others, service class 44 which was registered on 11 May 2009 with registration number IDM000202967 which consists of medical services, health care and beauty, service class 35 which was registered on 11 May 2009 which consists of advertising, business management, office functions, outlets.

The Plaintiff strongly objects to the registration of the Defendant's Sephora mark considering that the Defendant's Sephora mark is substantially similar to the Plaintiff's Sephora mark, so therefore it is reasonable to suspect that the Defendant's Sephora mark has been registered based on bad faith. the plaintiff's Sephora brand and the defendant's Sephora brand, Law No. 20 of 2016 concerning Trademarks and Geographical Indications has provided an explanation regarding the basic similarities between a brand and another brand, which is explained as follows: "Similarity caused by the presence of elements that stand out between one brand and another, which can give the impression that there are similarities in terms of shape, method of placement, method of writing or a combination of elements or similarities in the sound of speech contained in these brands." In essence, equality does not mean absolute equality of elements of all brands, nor does it mean that words, colors and sounds are exactly the same. It is not strictly demanded that there be similarities in marketing segments and ways of using and maintaining goods. The most fundamental thing is that there is an intention to "piggyback" on someone else's brand reputation, which is usually known in good faith, in order to obtain dishonest profits (Michael, 2021).

As stated in Article 21 paragraph (1) letter a of Law No. 20 of 2016 concerning Marks and Geographical Indications. Based on the explanation of the Law, it can be understood that the "salient elements" of a brand are the main factors in determining similarities between a brand and

other brands. Therefore, Sephora, which hereby acts as plaintiff, filed a lawsuit for the cancellation of the Sephora (local) registered mark used by the defendant, with the following arguments:

1. The plaintiff has been the legal owner of the Sephora brand for decades and has a good reputation regarding the use of the "Sephora" brand.
2. The Plaintiff's mark is a well-known brand that is well known in various countries and has been introduced to the international community. The Plaintiff's "Sephora" brand has been used commercially, and therefore the Plaintiff's "Sephora" brand has become a very valuable asset for the Plaintiff.
3. The plaintiff stated that the defendant had submitted an application for his trademark in bad faith due to imitation of his trademark and service mark.
4. Because the Plaintiff's "Sephora" brand is a well-known brand, it is appropriate to protect it as regulated in the provisions of Article 6 paragraph (1) (b) and Article 6 paragraph (2) of the Trademark Law in conjunction with Article 16 (3) of the TRIPs Agreement (Trade-Related Aspects of Intellectual Property Rights) so that it is entitled to enjoy special protection as a well-known brand as regulated in these provisions.

The plaintiff requested the Commercial Court at the Central Jakarta District Court to give the following decision:

1. The plaintiff has been the legal owner of the Sephora brand for decades and has a good reputation regarding the use of the "Sephora" brand.
2. The Plaintiff's mark is a well-known brand that is well known in various countries and has been introduced to the international community. The Plaintiff's "Sephora" brand has been used commercially, and therefore the Plaintiff's "Sephora" brand has become a very valuable asset for the Plaintiff.
3. The plaintiff stated that the defendant had submitted an application for his trademark in bad faith due to imitation of his trademark and service mark.
4. Because the Plaintiff's "Sephora" brand is a well-known brand, it is appropriate to protect it as regulated in the provisions of Article 6 paragraph (1) (b) and Article 6 paragraph (2) of the Trademark Law in conjunction with Article 16 (3) of the TRIPs Agreement (Trade-Related Aspects of Intellectual Property Rights) so that it is entitled to enjoy special protection as a well-known brand as regulated in these provisions.

Regarding this lawsuit, the Commercial Court at the Central Jakarta District Court handed down decision Number 34/Pdt.Sus-Merek/2015/PN.Niaga.Jkt.Pst on 13 October 2015, which in the main case approved the plaintiff's lawsuit in its entirety. One of them is that Sephora requested the cancellation of the Defendant's mark or at least declared the registration of the Defendant Sephora's trademarks and services (local) canceled, especially in class 25 goods and 35 services. The Defendant could not accept the results of the Commercial Court decision at the Central Jakarta District Court, Therefore, the Defendant submitted a legal action for cassation to the Supreme Court on December 8 2015. The cassation memo from the cassation applicant, namely Defendant Yuana Tanaya, was submitted to the cassation respondent/formerly the plaintiff, namely Sephora International, on December 15 2015, then the plaintiff/cassation respondent submitted counter cassation memorandum received at the clerk's office of the Jakarta District or Commercial Court. Regarding the legal action for the cassation petition, the Supreme Court has handed down decision Number 166 K/Pdt.Sus-HKI/2016 whose decision states that it rejects the cassation petition from the cassation applicant Sephora (local). Whereas the Supreme Court in its jurisprudence which has permanent legal force has also given an advice that national

entrepreneurs who produce goods made in Indonesia are obliged to use brand names that clearly display Indonesian national identity and as far as possible avoid using similar brand names, let alone plagiarizing them. foreign brand name.

The judge's considerations are one of the most important aspects in determining the realization of the value of a judge's decision which contains justice (ex aequo et bono) and contains legal certainty, besides that it also contains benefits for the parties concerned so that the judge's considerations must be addressed carefully, well, and careful. In this case the Panel of Judges of the Supreme Court has given the following considerations:

1. Whereas the Respondent of Cassation/Original Opponent Plaintiff, namely Sephora International, has argued that the Cassation Petitioner/Original Opponent Defendant, namely Sephora (local) owned by Yuana Tanaya, has used the same mark as the well-known Respondent Cassation/Resistant Plaintiff, namely the Sephora trademark. and registered in bad faith because there are similarities in essence. Meanwhile, on the contrary, according to the Petitioner for Cassation/Opponent, the Defendant originally registered his trademark not based on bad faith. Apart from that, one of the cassation objections submitted included the judex facti decision which violated the Trademark Law regarding the expiration of the time period for filing a trademark cancellation lawsuit.
2. That the reasons for the cassation cannot be justified because it is proven that the cassation applicant/original defendant plaintiff has succeeded in proving the truth of his argument that the Sephora mark owned by the cassation applicant/original opponent is substantially similar to the Sephora brand owned by the cassation respondent/original opponent plaintiff, on the contrary The cassation applicant/defendant's original opponent was unable to prove his argument.
3. Whereas based on the considerations above, it turns out that the decision of the Commercial Court at the Central Jakarta District Court in this case does not conflict with the law and/or statute, so the cassation petition submitted by the cassation applicant/original opponent, defendant Yuana Tanaya, must be rejected.

Proof of the Existence of Essentially Similar Elements

The panel of judges at the Central Jakarta Commercial Court assessed the Defendant's mistake based on article 21 paragraph (1) letter c in Law No. 20 of 2016 concerning Trademarks and Geographical Indications, which means that the Defendant's brand, namely Sephora, is substantially or completely similar to the brand owned by him. Well-known plaintiff. The terminology "similarity in essence" is a similarity caused by the presence of prominent elements between one brand and another, which can give the impression of similarities in terms of shape, method of placement, method of writing or a combination of elements or similarities in sound. sayings or similar meanings contained in the brand. (Kurniawan, 2021)

In this case, the two marks are essentially the same, because the Defendant's mark also contains the words Sephora, which is the dominant element in the Plaintiff's mark and is also the Plaintiff's mark which has been registered in several countries in the world. The two brand writings are similar in placement, writing method, and letter elements that make up the word Sephora itself, so they produce exactly the same sound when read. The Plaintiff's Sephora was registered in various countries long before the Defendant's brand was registered in Indonesia.

Even though the products owned by the Plaintiff and the Defendant are not the same, the Plaintiff produces goods and services such as perfumes, fragrances and cosmetics, while the Defendant's products are goods and services of all kinds of clothing, so the Defendant has

registered a mark which is the same as the Plaintiff's mark both in writing, speech or voice, it can be ascertained that the Defendant's intention is other than wanting to piggyback on and take advantage of the popularity of the Plaintiff's Sephora brand which he has used as the first perpetrator in the world. The Plaintiff's Sephora is a well-known brand, so the Defendant's brand should not be protected by the Directorate General of Intellectual Property. This is in line with the provisions of the TRIPs agreement, according to which according to the TRIPs agreement the distinguishing power of a brand is the only substantive condition for brand protection. If there are similarities in writing, speech and sound with the Plaintiff's brand, it can be ascertained that the Defendant's intention is other than wanting to piggyback on and benefit from the popularity of the Sephora brand (Afif, 2021).

Proof of the Existence of Bad Faith

Indonesia adheres to a first inspection system, where registration of trademarks that can be accepted are only trademarks that meet the requirements that have been determined to be owned by someone else, in the sense that they are not similar to similar goods to the trademarks that have already been registered with the trademarks. a mark that has been previously registered in the trademark registers in Indonesia. In this case, a thorough examination must first be carried out before a registration application can be granted. In the regulation of trademark rights, there is a declarative system and a constitutive system. The declarative system determines that the first user has the right to the mark, whereas in the constitutive system it is determined that the person who registers first has the right to the mark and is the one who can exclusively use the mark. This means that exclusive rights to a brand are granted due to registration (Nabawi, 2019).

Of course, an applicant with good intentions is an applicant who registers his/her mark properly and honestly without any intention to piggyback on, imitate or plagiarize the popularity of another party's brand for the sake of his/her business interests which results in losses to other parties or creates unfair competition conditions, deceives or misleads consumers. Below we will analyze whether the Defendant in registering the Sephora brand with the Directorate General of Intellectual Property had good intentions or just wanted to ride on the fame of the Plaintiff's brand which has been circulating in the world for a long time. 1). Sephora is the name of a legal entity in France. 2). The Sephora brand was first registered in Paris, France in 1970. 3). The Defendant's Sephora was only registered on the general register of trademarks in 2007.

By looking at this evidence, there is bad faith on the part of the Defendant in registering the Sephora brand. As the researcher has explained, the Defendant's Sephora brand is substantially similar to the Plaintiff's Sephora which is well known and has been used and promoted by the Plaintiff consistently since the 1970s until today. Article 16 (3) TRIPs in conjunction with Article 6 bis of the Paris Convention allows owners of well-known marks to demand cancellation of the same mark for different types of goods and services. Article 6 bis of the Paris Convention also reminds us of the importance of the trademark registration system to provide legal protection for trademarks. genuine and original products, especially well-known brands. The meaning of a legal trademark owner is the first trademark registrant who has good intentions, which contains the meaning of the obligation to reject or cancel the registration of a trademark that is a mere reproduction, imitation or translation. In this way, attempts at piracy, counterfeiting, imitation and competition can be avoided. Apart from that, in Indonesian, good faith in the subjective sense is called honesty. This is contained in article 530 of the Civil Code and so on which regulates positions of power (bezit). Good faith in this subjective sense is an inner attitude or a state of the soul (Sukro, 2020).

CONCLUSION

Criteria indicating that the plaintiff's Shepora is a well-known brand that must be protected: The plaintiff is an international cosmetics company under the banner of Louis Vuitton Moet Hennessey (LVMH) whose address is at avenue Edouard Vaillant, 92100 Boulogne Billancourt, France, which has been using the "Sephora" brand since in 1970 for business activities related to the first sale of cosmetics in Paris, France. From the continuous use of the Sephora brand in many countries around the world, which began in 1970, the Plaintiff has succeeded in developing a good reputation related to the use of the Sephora brand. Currently, the Plaintiff is a seller and distributor of cosmetic products, perfume and goods related to beauty and body care and is closely associated with beauty services throughout the world. The plaintiff operates approximately 1,900 retail stores in 29 countries around the world using the Sephora brand. Proof that there has been a passing off of the Plaintiff's brand (Shepora) carried out by Shepora Batik (defendant). In this case, the two marks are essentially the same, because the Defendant's mark also contains the words Sephora, which is the dominant element in the Plaintiff's mark and is also the Plaintiff's mark which has been registered in several countries in the world. The two brand writings are similar in terms of placement, writing method, and letter elements that make up the word Sephora itself, so they produce exactly the same sound when read. The Plaintiff's Sephora was registered in various countries long before the Defendant's brand was registered in Indonesia. If there are similarities in writing, speech and sound with the Plaintiff's brand, it can be ascertained that the Defendant's intentions are other than wanting to piggyback on and benefit from the popularity of the Sephora brand.

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