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Analysis of Hugo Famous Trademark Dispute from the Perspective of Legal Protection in Indonesia

Rusdinah[1*], Rolib Sitorus[2]
Fakultas Hukum, Universitas Pelita Harapan
Corresponding Author: Rusdinah rusdinah@gmail.com

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A B S T R A C T

Hugo, one of the trademarks under Hugo Boss, is often the target of violations in the form of registering trademarks that are essentially similar to the Directorate General of Intellectual Property Rights, which is considered unfair business competition, because it can harm the owner of the original trademark, mislead consumers, and damage the reputation of the brand that has been built. This study examines the analysis of the famous Hugo trademark dispute from the perspective of legal protection in Indonesia, which is the object of the dispute in decision Number 10 PK / Pdt.Sus-HKI / 2023.The focus of the research is an analysis of the legal basis underlying the protection of famous trademarks in Indonesia and a review of legal considerations by the panel of judges in the trial process in 3 (three) stages, namely the first decision, cassation, and judicial review. The research method used in this study is the normative legal research method by examining court decisions and laws and regulations as primary legal materials. Books, documents, journals, and scientific works as secondary legal materials. As well as official and trusted publications as tertiary legal materials. The analysis technique applied in this study is a qualitative method through literature studies. The results of the research and analysis obtained are that the Plaintiff as the owner of the HUGO BOSS brand is the first registrant and user of the HUGO BOSS brand and variations of HUGO and/or BOSS based on the first to file system, so that the Plaintiff is the legal owner of the HUGO BOSS brand and is also a well-known brand according to the evidence of its registration in various countries. The registration of the HUGO brand owned by the Defendant is considered to be in bad faith because its brand is essentially similar to the Plaintiff's brand.

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INTRODUCTION

Background

Intellectual Property (IP) is part of property law that includes individual ownership rights over intangible products of human creativity. Unlike physical assets such as land and vehicles, Intellectual Property Rights (IPR) are abstract in nature. According to David I. Bainbridge, IP refers to property rights derived from intellectual effort, encompassing various works that are useful in daily life. IPR protects creative outputs through copyrights, patents, trademarks, and industrial designs, offering legal safeguards to promote innovation and reward creators.

Jill McKeough and Andrew Stewart have expressed that IPR is generally defined as a set of rights granted by law to protect the economic investment of creative endeavors. Similarly, UNCTAD-ICTSD defines IPR as the result of creative human effort protected by law. In addition, the Director General of IP, in collaboration with ECAP, defines IPR as rights arising from the intellectual processing of the human brain that results in a product or process beneficial to humanity.

Once intellectual property is formalized through relevant regulations, it transforms into a legal asset known as Intellectual Property Rights (IPR). These rights are essentially legal entitlements obtained from the creation of intellectual property. Once established, IPRs are used in commercial contexts, contributing to the economic value of inventors or creators.

There are **two main categories** of IPR:

1. **Copyrights**
   These grant the creator or rights holder exclusive authority to manage and control the use of their copyrighted material by third parties. Copyright protection extends to various forms of creative works such as literature, music, films, images, and more.
2. **Industrial Property Rights**
   These encompass various forms of protection, including:
   a. **Patents**
      Grant exclusive rights to inventors or right holders for their inventions, preventing others from making, using, or selling the invention without permission.
   b. **Trademarks**
      Protect brand names, logos, symbols, or any distinctive signs that differentiate one entity's goods or services from another.
   c. **Industrial Design Rights**
      Protect the aesthetic or ornamental aspects of a product, ensuring that unauthorized use or reproduction is prohibited.
   d. **Layout-Design Rights of Integrated Circuits**
      Protect the layout designs of integrated circuits, prohibiting unauthorized reproduction or use.
   e. **Trade Secret Rights**
      Protect confidential information, formulas, processes, or strategies that provide a competitive advantage, ensuring they are not disclosed or used without permission.

f. **Plant Variety Rights**
Protect new plant varieties developed through breeding or genetic manipulation, granting exclusive rights to produce, sell, or distribute them for a specific period.

In today's global trade and open markets era, trademarks play a vital role as a form of intellectual property. A trademark, whether a name or image, serves as a distinctive identifier for products or companies in the market. Essentially, trademarks are crucial for advancing modern commerce, offering benefits such as fostering goodwill, symbolizing quality, setting standards, facilitating market penetration, and providing guarantees that yield substantial profits.

To gain recognition and success, a trademark must have a unique appeal that distinguishes it from competitors. This distinctiveness is essential for consumers, as it helps them differentiate products based on factors such as quality, satisfaction, and reputation associated with the brand. Ultimately, a strong brand not only attracts consumers but also builds loyalty and trust, forming the foundation of sustainable business growth in today's competitive landscape.

Trademark rights are unique and exclusive rights granted by the state to the owner, allowing them to use the trademark or permit others to use it. These exclusive rights depend on state approval and thus require a registration process. Therefore, obtaining trademark rights is mandatory and must go through a registration mechanism. For a trademark to be protected and recognized by the state, it must be officially registered with the relevant authority.

Unregistered trademarks are automatically denied recognition and special treatment by the state, meaning they do not enjoy the legal protection granted to registered trademarks. As a result, unregistered trademarks can still be used or exploited by others without legal consequences. The legal protection provided by the state is primarily aimed at safeguarding well-known trademarks.

This protection is both preventive and repressive and is stipulated in **Law Number 20 of 2016 on Trademarks and Geographical Indications** (known as the Trademark and GI Law). The purpose of trademark protection is to prevent imitation or brand piggybacking (passing off), ensuring that the original trademark owner retains their unique identity and market presence.

As a distinguishing mark, a trademark enables consumers to identify products and services associated with a particular company. This exclusivity provides the registered trademark owner with legal rights to prevent unauthorized use of the trademark by others. However, in today's commercial environment, trademark infringement is a common occurrence.

Indonesian society has a strong tendency to use foreign products, especially those with well-known brands. However, the limited purchasing power of Indonesian consumers often leads them to choose cheaper alternatives, even if those alternatives are counterfeit and of lower quality.

This situation creates opportunities for unscrupulous entrepreneurs to register and sell goods using counterfeit versions of famous foreign brands, thereby infringing the intellectual property rights of the original trademark owners. Consequently, the original brand owners suffer financial losses due to the unauthorized use of their trademarks, which indirectly reduces sales of their authentic products. Additionally, Indonesian consumers are also harmed, as they unknowingly purchase and use counterfeit products that do not meet the quality standards of the original brands.

This scenario has significant implications for foreign investors, as it deters them from entering the Indonesian market. The lack of trademark protection assurance may make foreign companies reluctant to invest in Indonesia, potentially hindering the country's economic growth and development. Therefore, addressing counterfeit products and ensuring strong intellectual property protection is crucial for creating a favorable business environment and attracting foreign investment.

A common violation occurs when a trademark similar to a famous brand is registered with the Directorate General of Intellectual Property (DGIP), which constitutes unfair business competition. The registration of trademarks resembling well-known marks at DGIP requires special attention to legal and ethical business aspects. **Article 21 paragraph (1)** of the Trademark and GI Law prohibits the registration of trademarks that are essentially or wholly similar to registered or well-known trademarks for similar or dissimilar goods.

In practice, many trademark registrations are carried out in bad faith, often intending to mislead consumers or exploit the reputation of famous brands. Such fraudulent practices undermine market integrity, cause financial harm to renowned brand owners, and pose significant challenges for trademark holders. As a result, well-known trademark owners are often compelled to file lawsuits against parties infringing on their trademark rights.

One trademark dispute case is the conflict between the famous brand **Hugo Boss Trademark Management GmbH & Co. KG**, the owner of the well-known Hugo Boss brand, and **Anthony Tan**, who owned a brand using the word “Hugo” on his product label. In this legal dispute, Hugo Boss Trademark Management GmbH & Co. KG, acting as the Plaintiff, filed a lawsuit against Anthony Tan, the Defendant, alleging trademark infringement related to the unauthorized use of the word "HUGO."

The Plaintiff argued that the Defendant deliberately registered his product with a brand containing the word "HUGO" intending to capitalize on the widespread popularity of the Hugo Boss brand and deceive consumers. Hugo Boss alleged that registering a trademark with the word “HUGO” in the same class as their certified brand was done dishonestly and violated **Article 21 paragraph (1) letters a and b** of the Trademark and GI Law, which states: “has essential or whole similarities to a registered/well-known trademark belonging to another party for similar and/or dissimilar goods and/or services.”

Hugo Boss filed a trademark cancellation lawsuit with the Central Jakarta Commercial Court on **May 18, 2020**. The Plaintiff was the first to register the “HUGO BOSS” trademark outside Indonesia, specifically in **Germany** (Europe) on **September 8, 1980**, under registration number **DE1007460** to protect goods under Class 25, and in **Hong Kong** (Asia) on **May 23, 1985**, under registration number **1991B0042** for goods in Class 25.

Furthermore, since 1980 to date, the Plaintiff has also held various trademark registrations using and/or containing variations of the word "HUGO" and/or the word "HUGO" combined with "BOSS" in numerous countries worldwide, all legally registered with each country's trademark office. Examples include **HUGO HUGO BOSS**, **BOSS HUGO BOSS**, and **BOSS HUGO BOSS SELECT LINE**, which protect a wide range of goods/services across multiple classes, including Class 25, thereby fulfilling one of the criteria for being recognized as a well-known trademark.

LITERATURE REVIEW

METHODOLOGY

The title of this research indicates that it falls under the category of normative legal research, which is a study based on literature or document analysis. This research utilizes sources of legal materials such as court decisions, statutory regulations, treaties, legal theories, and expert opinions. In general, normative legal research aims to explore legal principles, legal systematics, legal synchronization, legal comparisons, and legal history.

The choice of normative legal research methodology stems from the intention to deeply and systematically analyze specific civil law cases of a juridical nature regarding trademark disputes, particularly based on Decision Number 10 PK/Pdt.Sus-HKI/2023. This methodology facilitates a comprehensive examination of the legal theories and principles underlying trademark disputes, enabling a thorough understanding and analysis of specific cases within their legal framework.

This research is conducted through a library-based approach, which includes reviewing written regulations related to the research subject and utilizing secondary data sourced from primary, secondary, and tertiary legal materials. Normative legal research does not merely focus on the system of norms within legislation, but also considers the reactions and interactions that occur during the implementation of the law. As such, this method provides a more comprehensive picture of how the law is applied in real contexts and how society interacts with the legal system. Therefore, normative legal research can offer deeper insights into the effectiveness and sustainability of the legal system within society.

The sources chosen are based on their relevance to the research topic, particularly concerning legal decisions that serve as references in this study, especially Decision Number 10 PK/Pdt.Sus-HKI/2023 in conjunction with Decision Number 520 K/Pdt.Sus-HKI/2021 and Decision Number 27/Pdt.Sus.Merek/2020/PN.Niaga.Jkt.Pst.

There are **two types of approaches** used by the researcher to frame and investigate the research problem:

1. **Statutory Approach**
   This involves examining laws and regulations related to the legal issues under investigation. In this study, emphasis is placed on reviewing statutory provisions relevant to the Trademark and Geographical

Indications Law (UU MIG), particularly regarding the use of similar trademarks between Hugo Boss and Hugo Selection.

2. **Case Approach**
   This involves analyzing legal cases, especially those that have resulted in final and binding court decisions. The focus of this research lies in dissecting the judges' considerations (ratio decidendi) in Decision Number 10 PK/Pdt.Sus-HKI/2023 in conjunction with Decision Number 520 K/Pdt.Sus-HKI/2021 and Decision Number 27/Pdt.Sus.Merek/2020/PN.Niaga.Jkt.Pst, as well as the legal reasoning for the judicial review submitted by the applicant in Decision Number 10 PK/Pdt.Sus-HKI/2023. Through this approach, the researcher aims to gather and interpret the considerations taken by the panel of judges in adjudicating the trademark dispute arising from brand passing off.

Data analysis in this research involves examining legal materials, which may include critiques, support, or comments on the research findings. These are then used to draw conclusions based on the researcher's interpretation with the aid of the theoretical framework employed. The data analysis method used by the researcher is **qualitative**, focusing on analyzing data derived from legal sources, emphasizing theories, legislation, doctrines, legal norms, and expert opinions.

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RESEARCH RESULT

A **trademark** serves as a distinctive sign that differentiates the ownership of one party's goods or services from those of others, often achieved through the use of unique images, logos, or symbols. Beyond mere identification, a trademark holds significant weight as a product attribute, particularly in shaping favorable consumer perceptions. When consumers evaluate a brand's attributes, it fosters positive perception and builds trust, ultimately contributing to the development of brand image. As a result, trademarks become a key factor influencing consumer purchasing decisions.

The functions of a trademark include:

1. **Product Identity**: A trademark functions as an identifier that distinguishes goods produced by an individual, group, or legal entity from those produced by others.
2. **Trade Promotion Tool**: A trademark serves as a marketing instrument, facilitating product promotion simply by mentioning the brand name.
3. **Quality Assurance**: A trademark guarantees the quality of goods and/or services produced and traded under its name.
4. **Source Indicator**: A trademark serves as a means to identify the origin of goods and/or services, helping consumers make informed purchasing decisions.

According to the Indonesian Trademark and Geographical Indications Law (UU MIG), trademarks are generally categorized into three main groups:

1. **Trademark**: Used for goods traded by an individual, a group of individuals, or a legal entity to distinguish them from similar goods.

2. **Service Mark**: Used for services traded by an individual, a group of individuals, or a legal entity to distinguish them from similar services.
3. **Collective Mark**: Used for goods and/or services with similar characteristics in terms of nature, general features, and quality, which are marketed by a group of people or legal entities collectively to distinguish them from similar goods and/or services.

According to **Yahya Harahap**, trademarks can be categorized into three levels based on their strength:

1. **Ordinary Marks**: These marks lack significant reputation and are considered average. They are seen as having little influence on lifestyle and are less sophisticated in usage or technology. Such marks typically fail to establish a strong emotional connection or appeal to consumers and struggle to build a distinct market segment.
2. **Well-Known Marks**: These marks enjoy high reputation and broad recognition, often due to the strength of their appealing logos. They have strong emotional resonance and familiarity due to global recognition and high value, fostering psychological connections with consumers.
3. **Famous Marks**: These marks are extremely well-known and enjoy the highest reputation, receiving recognition across multiple countries. They surpass ordinary and well-known marks in terms of status, with all products bearing the mark attaining legendary recognition.

Trademark Registration Systems

There are two primary systems for trademark registration:

1. **Constitutive System (First to File)**: Grants registration to the first party to file an application, prioritizing registration over actual use. This system provides legal certainty but may lead to trademark squatting, especially for well-known marks. Legal protection is granted based on the first registration filed in good faith.
2. **Declarative System (First to Use)**: Prioritizes the party who first used the trademark. Registration is not mandatory, and the focus is on demonstrating prior use. It is presumed that the first user owns the trademark unless proven otherwise. Registration serves as supporting evidence. This system provides legal protection based on actual use rather than formal registration.

Originally, **Indonesia applied the first-to-use system** under Law No. 21 of 1961, granting rights to the first domestic user. However, with the enactment of Law No. 15 of 2001 on Trademarks, the system shifted to first to file, where trademark rights are granted based on registration. This law replaced Law No. 19 of 1992 and Law No. 14 of 1997. Subsequently, Law No. 15 of 2001 was repealed and replaced by **Law No. 20 of 2016** on Trademarks and Geographical Indications, effective as of 25 November 2016. The first-to-file system remains in place.

Legal subjects of trademarks include individuals, groups, and legal entities that can register trademarks, hold exclusive rights, and file claims for trademark infringement. In Indonesia, trademark registration is crucial for legal protection under the first-to-file system, which grants rights to the party that registers with the Directorate General of Intellectual Property (DJKI).

Trademark Registration Rejection Grounds

Trademark applications may be rejected under:

Article 20:

1. Contrary to state ideology, law, morality, religion, or public order.
2. Identical to the goods/services being registered.
3. Misleading regarding origin, quality, or type of goods/services.
4. Not in line with the goods'/services' quality, function, or benefit.
5. Lacking distinctiveness.
6. A generic name or emblem.

Article 21:

1. Similar or identical to a registered or well-known mark for similar or dissimilar goods/services (under certain conditions).
2. Resembling the name, photo, or legal entity of a famous person or organization without permission.
3. Imitating national/state symbols, institutions, or official seals without consent.
4. Filed in bad faith.

A registered trademark receives legal protection for 10 years from the filing date and may be renewed following a prescribed procedure. Chronology of Trademark Dispute: Hugo Boss vs. Anthony Tan .The trademark dispute between Hugo Boss Trademark Management GmbH & Co. KG (Plaintiff) and Anthony Tan (Defendant) centers on the cancellation of the Defendant's registered trademarks: HUGO SELECT LINE, HUGO SELECTION, and HUGO SELECTLINE + Design, all registered under Class 25. The lawsuit was filed by the Plaintiff under Case No. 27/Pdt.Sus.Merek/2020/PN.Niaga.Jkt.Pst, alleging trademark infringement.

Parties:

1. Plaintiff: Hugo Boss Trademark Management GmbH & Co. KG, a German company, represented by a law firm in Jakarta.
2. Defendant: Anthony Tan, residing in North Jakarta, represented by a law firm in South Tangerang.
3. Co-Defendant: Government of the Republic of Indonesia through the Ministry of Law and Human Rights, Directorate General of Intellectual Property.

The Plaintiff's claims (dated May 18, 2020) sought cancellation of the following trademarks owned by the Defendant:

1. HUGO SELECT LINE (Reg. No. IDM000263074, registered August 4, 2010)
2. HUGO SELECTION (Renewal Reg. No. IDM000156405, dated March 3, 2008)
3. HUGO SELECTLINE + Design (Reg. No. IDM000248527, registered May 24, 2010)

Key arguments in the Plaintiff's claim included:

1. Plaintiff owns the registered trademark "HUGO BOSS" and other "HUGO" variants in Indonesia and globally, establishing legal standing under

Article 76(1) of the Trademark and Geographical Indications Law. The mark has been used since 1924 and was first registered internationally in Germany and Hong Kong.
2. The lawsuit was filed within the legally permitted timeframe, in accordance with Article 77(2) of the Law.
3. "HUGO BOSS" has been registered in Indonesia since January 24, 1989, granting the Plaintiff exclusive rights.
4. The Plaintiff has registered various "HUGO"-based trademarks to extend protection for the "HUGO BOSS" brand.
5. "HUGO BOSS" and its variations qualify as well-known marks.
6. The Defendant's marks (e.g., "Hugo Selectline") bear similarities to "HUGO BOSS" and should be canceled under Article 21(1) of the Law, which prohibits registration of trademarks substantially similar to existing ones.

The Plaintiff argued that the Defendant's use of "Hugo" without permission created a misleading resemblance, justifying the cancellation request.

On January 4, 2021, the Jakarta Commercial Court rejected the Plaintiff's lawsuit. The judges found sufficient differences between the marks, ruling that they were not substantially similar. Dissatisfied with this ruling, Hugo Boss filed a cassation appeal under Case No. 520 K/Pdt.Sus-HKI/2021 to the Supreme Court.

The Supreme Court granted the cassation on September 10, 2021, recognizing Hugo Boss as the legitimate owner of the registered and well-known trademarks, including its variants. The Court annulled the registrations of Anthony Tan's trademarks and instructed the Ministry of Law and Human Rights to announce the cancellations.

Following this, Anthony Tan filed a judicial review under Case No. 10 PK/Pdt.Sus-HKI/2023. However, on July 4, 2023, the Supreme Court rejected the review, thereby upholding the previous decision in favor of Hugo Boss and affirming their exclusive rights over the "HUGO BOSS" trademark, protecting its integrity from unauthorized use.

1. Legal Protection Analysis of HUGO BOSS Trademark Rights under Indonesian Law

Before discussing its legal protection, it must be demonstrated that HUGO BOSS qualifies as a *well-known trademark* as stipulated in Article 18 of the Regulation of the Minister of Law and Human Rights No. 67 of 2016 concerning Trademark Registration. The criteria and how HUGO BOSS fulfills them are as follows:

a. **Public Awareness**: Globally recognized as a premium fashion brand since the 1980s.
b. **History and Achievements**: Established in 1924, transitioned from military uniform production to elegant menswear, and has received numerous international accolades.
c. **Active Promotion**: Consistently engages in marketing through sponsorships in sports such as Formula 1, golf, football, and sailing.
d. **Global Reach**: Operates over 1,100 outlets in major cities worldwide.

e. **Trademark Registration**: Registered in various countries, including Indonesia since January 24, 1989.
f. **Legal Status**: Recognized as a well-known mark by the Supreme Court of Indonesia in several rulings, including disputes involving Anthony Tan.

Based on this evidence, HUGO BOSS meets all the criteria set out to be considered a well-known trademark.

The basis for trademark protection has been embodied in the Paris Convention and the World Trade Organization, which regulate the multilateral agreement, namely the Trade Aspects of Intellectual Property Rights (TRIPS) Agreement. The Paris Convention and the TRIPS Agreement require member countries to provide protection to well-known trademarks, even if the trademark is not registered or used in the country. Protection for unregistered well-known trademarks under the Paris Convention is generally limited to goods and services that are identical or similar to the goods or services to which the trademark relates, and in situations where the use of the trademark is likely to cause confusion among consumers.

The TRIPs Agreement in Articles 15 and 16 stipulates that the owner of a registered trademark has the exclusive right to prevent third parties who do not have the permission of the owner of the trademark from using the same or similar trademark for goods or services that are identical or closely related to the registered trademark. The use of the trademark must not cause confusion among the public as to the origin of a product. Member countries of the Paris Convention are required to refuse or cancel registration and prohibit the use of trademarks that are reproductions, imitations, or translations that may cause confusion with trademarks that are considered well-known, where the trademark is registered or recognized.

With the proof that HUGO BOSS is a well-known trademark and Indonesia as a member of the Paris Convention in the TRIPs Agreement, the Author is of the opinion that the owner of this trademark has the right to obtain legal protection in Indonesia. This protection includes the exclusive right to use the trademark and protection from unauthorized use. Forms of Legal Protection:

a. Preventive: Based on Article 1 number 5 of the Trademark and Geographical Indications Law (MIG Law), protection begins after trademark registration, which lasts for 10 years. HUGO BOSS has been registered since January 24, 1989, with an extension valid until 2029.
b. Repressive: Legal action can be taken if a violation occurs, such as a lawsuit for the registration of a similar trademark, including in relation to the case of the HUGO trademark owned by Anthony Tan which violates the provisions of Articles 20 and 21 of the MIG Law.

Legal protection is important to maintain the economic value of well-known trademarks and prevent violations that can harm the brand's reputation. The state, through the Directorate General of Intellectual Property (DJKI), is responsible for providing this protection by refusing to register trademarks that have substantial similarity to well-known trademarks.

The trademark dispute case between HUGO BOSS Trademark Management GmbH & Co. KG and Anthony Tan focuses on marks containing the word "Hugo". HUGO BOSS claims that the marks HUGO Select Line, HUGO Selectline + Painting, and HUGO Selection registered by Anthony Tan imitate its mark, potentially piggybacking on the popularity that HUGO BOSS has built without adequate promotional efforts. The Plaintiff argues that the Defendant's mark has clear similarities to its mark, especially due to the presence of the word "Hugo", and should be rejected in accordance with Article 21 paragraph (1) letter a of the Trademark and Geographical Indications (MIG) Law. In the legal process, the Central Jakarta Commercial Court initially rejected HUGO BOSS's lawsuit on January 4, 2021, on the grounds that there were striking differences between the marks in terms of appearance and pronunciation. However, HUGO BOSS did not accept the decision and filed an appeal with the Supreme Court (MA), which then granted their cassation request. The Supreme Court declared HUGO BOSS as the legitimate owner of the registered trademark in Indonesia since 1989 and canceled Anthony Tan's trademark registration.

After the cassation decision, Anthony Tan filed a judicial review (PK), but the Supreme Court rejected the application on July 4, 2023, upholding the previous decision in favor of HUGO BOSS. The plaintiff was recognized as the first owner based on the "first to file" system, which provides legal protection to the party who first registers intellectual property rights.

The author's analysis shows that the legal protection provided by the Panel of Judges in the Supreme Court Decision Number 10 PK/Pdt.Sus-HKI/2023 and the Supreme Court Decision Number 520 K/Pdt.Sus-HKI/2021 against HUGO BOSS as the Plaintiff is appropriate. This is because Anthony Tan's HUGO variant brand has significant similarities to the HUGO BOSS brand, both in form, pronunciation, and sound.

The Defendant's trademark registration is considered to have been carried out in bad faith, which violates Article 21 paragraph (1) of the Trademark and Geographical Indications (MIG) Law. The Plaintiff has the right to file a lawsuit to cancel the trademark based on Article 20 and/or Article 21 of the MIG Law, because there are similarities in principle between the two trademarks. The Defendant's claim that the Plaintiff's lawsuit has expired is unfounded, because Article 77 paragraph (2) of the MIG Law allows for cancellation without a time limit if the registration is carried out in bad faith.

The legal protection provided in this case is repressive legal protection, namely resolving the case through the legal process. This is in line with the theory of legal protection by Soerjono Soekanto, which states that "Legal protection is protection given to legal subjects in the form of legal instruments."

The Supreme Court's decision affirms HUGO BOSS's exclusive rights to its famous trademark, protecting it from unauthorized use by other parties. Thus, the Plaintiff's lawsuit for the cancellation of the Defendant's trademark is valid and in accordance with legal provisions. The author argues that the decision provides repressive legal protection for HUGO BOSS and preserves the integrity of its brand.

2. Analysis of Judges' Considerations in the First Decision, Cassation Decision and Review Decision in the Granting of Trademark Rights Decision Number 10 PK/Pdt.Sus-HKI/2023

In the civil law system, judges function as enforcers of the law, not as law makers. The role of judges is to try each case fairly and in accordance with the provisions of the law (ex aequo et bono). In general, the task of judges is to uphold justice and apply the law. In making decisions, judges must be able to choose from various alternative actions that are most appropriate to realize a sense of justice in society.

Judges' considerations are an important aspect in the implementation of the judicial process to ensure that the decisions taken reflect justice, benefits, and legal certainty. Several factors that influence judges' considerations include existing facts, evidence, and relevant statutory provisions that support the parties involved during the trial.

The judge's task in making decisions is not only based on legal considerations, but must also pay attention to aspects of justice. This consideration is very important because it can influence how judges decide a case. Therefore, proof is one of the key factors for judges in issuing court decisions. In the case of a trademark cancellation lawsuit, the burden of proof lies with the Plaintiff. This concept is known as the principle of actor incumbit probatio, in accordance with the provisions of Article 1865 of the Civil Code which states:

"Any person who claims that he has a right or in order to confirm his own rights or deny the rights of others, points to an event, is required to prove the existence of said right or event."

A. Results of Analysis of the Panel of Judges' Considerations in the First Decision

1) Based on the first to file trademark registration system in Indonesia, and upon the submission of evidence P-2 to P-31.b, it has been proven that HUGO BOSS is the first and legal owner of the HUGO BOSS trademark along with variations of the words HUGO and/or BOSS.
2) Anthony Tan just started using the word HUGO on his product brand by registering his brand on March 3, 2008, while the HUGO BOSS brand had been introduced by HUGO BOSS on January 24, 1989. This shows that the period of use of the HUGO BOSS brand is longer than the period of use of the HUGO brand by Anthony Tan.
3) In addition, HUGO BOSS has registered its brand in various countries which can be proven from the submission of evidence P-32.a to P-57, so HUGO BOSS is categorized as a well-known brand.
4) Anthony Tan uses the word HUGO on his product brand, where according to HUGO BOSS the word HUGO has a dominant element of similarity in the form of writing letters and words with his brand.
5) Anthony Tan's HUGO brand is a transfer from the previous owner Teddy Tan who has been proven to have bad intentions because he always used the word HUGO on his product brand. This is evident from the 3 (three) court decisions that annulled 9 (nine) HUGO trademarks owned by Teddy

Tan which were submitted in evidence P-61 to P-63 from 2017, 2018 and 2019. However, in the trial, the Panel of Judges did not focus their examination on this evidence.

6) The Panel of Judges only examined the appearance of the trademark between the trademark owned by the Plaintiff HUGO BOSS and the trademark owned by the Defendant Anthony Tan and was of the opinion that there was a distinguishing power between the two trademarks, so that the trademark owned by Anthony Tan was declared to have no elements of similarity in principle and was registered in good faith.
7) The decision of the Panel of Judges to reject the cancellation of the HUGO trademark owned by Anthony Tan shows a difference of opinion in the legal interpretation of the criteria for trademark similarity. In trademark disputes, the criteria for similarity are often subjective. A judge may identify substantial similarities between two trademarks based on certain elements, such as differences in appearance, pronunciation, and placement of the trademark to prevent confusion among consumers. On the other hand, different Panels of Judges may pay attention to other elements, which can lead to different conclusions. This reflects the complexity in the legal interpretation of trademark similarity.
8) The weakness in the implementation of the law here is very detrimental to the owner of the famous brand HUGO BOSS where in accordance with the TRIPs Agreement and the MIG Law, HUGO BOSS should receive legal protection from someone's bad faith actions and also result in unfair business competition.

B. Results of Analysis of the Panel of Judges' Considerations in the Cassation Decision

1) The Panel of Judges at the cassation level has a different opinion in assessing the criteria for brand similarity.

2) The Panel of Judges considers that there are quite significant similarities between the two brands, namely the HUGO BOSS brand and the HUGO brand owned by Anthony Tan.

3) The Panel of Judges stated that although there are differences in several aspects, the use of the word HUGO as a dominant element in both brands can cause confusion among consumers.
4) Regarding this, the Panel of Judges at the cassation level stated that the consideration of Judex Facti in this case the Commercial Court at the Central Jakarta District Court was a mistaken consideration or had applied the law incorrectly and canceled the decision and tried the case itself.
5) With the opinion of the Panel of Judges that Anthony Tan should have been able to find another name for his brand or product, because in real life there are hundreds or even thousands of names that can be created so that they can show the authenticity of Anthony Tan's product creation.

6) Thus, the Panel of Judges considers that there is an element of bad faith on the part of Anthony Tan because he wants to take advantage of the HUGO BOSS brand name which is already well-known in the world and registered in Indonesia since 1989.
7) The implementation of the law applied here is appropriate because it has provided legal protection to HUGO BOSS from unfair business competition and also provides legal certainty to the owner of a registered brand and/or well-known brand so that it can encourage foreign investor confidence in the law in Indonesia.
8) HUGO BOSS as a well-known brand has the right to obtain legal protection by filing a cassation application to protect its brand and reputation.

C. Results of Analysis of the Panel of Judges' Considerations in the Judicial Review Decision

1) Evidence from PK-1 to PK-6 submitted by Anthony Tan in the form of information, news and general data from Wikipedia shows that the Applicant for Judicial Review Anthony Tan does not understand the meaning of novum and the provisions for requesting a Judicial Review as stipulated in Article 67 letter b of Law Number 14 of 1985 concerning the Supreme Court as amended by Law Number 5 of 2004 and the second amendment by Law Number 3 of 2009.
2) The decision of the Panel of Judges in rejecting the Judicial Review application is a real manifestation of the law on protection of registered trademarks and/or well-known trademarks in Indonesia.
3) The decision of the Supreme Court (MA) to cancel a trademark that imitates a well-known trademark shows that the Indonesian legal system is serious about protecting intellectual property rights, especially well-known trademarks. This reflects that the MA understands the importance of maintaining the uniqueness and reputation of well-known trademarks, which are often valuable assets for their owners, both in terms of economic value and image in the eyes of the public.

CONCLUSION AND RECOMMENDATIONS

1. Conclusion

Based on the results of the research and analysis, the author concludes several things, namely:

1. Legal protection of the rights to the famous HUGO BOSS trademark based on Indonesian law has been regulated in Law Number 20 of 2016 concerning Trademarks and Geographical Indications, where the Plaintiff as the owner of the HUGO BOSS trademark is the owner of the famous trademark according to proof of registration in various countries and is the registrant and first user of the HUGO BOSS trademark and variations of the HUGO and/or BOSS trademarks based on the first to file system, so that the Plaintiff as the owner of the HUGO BOSS trademark is legally entitled to legal protection from passing off actions.

2. Judges' considerations in the first decision, cassation decision and judicial review decision in granting trademark rights decision Number 10 PK/Pdt.Sus-HKI/2023 that in the considerations of the Panel of Judges in the first decision and the cassation decision showed differences of opinion in the interpretation of the law regarding the criteria for trademark similarity where the Panel of Judges may identify substantial similarities between two brands based on certain elements, such as differences in appearance, pronunciation, and placement of the brand, while different Panels of Judges may pay attention to other elements, which can produce different conclusions. This reflects the complexity in the interpretation of the law regarding trademark similarity.

2. Suggestions

Based on the conclusions above and to overcome differences of opinion among judges and prevent errors in the application of the law in trademark dispute cases, a number of systematic steps and improvements can be implemented. These steps aim to improve judges' understanding, align legal guidelines, and strengthen court standards at all levels. The following are some solutions suggested by the researcher as follows:

1. Trademark Applicants should ensure that the brand they wish to register has never been owned by anyone before. Applicants can conduct a search for trademarks used in the market via DJKI or a professional trademark registration service provider. This will ensure that the trademark registration is carried out in good faith. To obtain legal certainty, trademark registration must be carried out without violating the provisions of Articles 20 and 21 of Law No. 20 of 2016 concerning Trademarks and Geographical Indications. 2. The Government, especially Judges who handle cases related to trademarks, need to have a deep understanding and special expertise in the field of trademark law. This knowledge includes not only substantive legal aspects, such as the MIG Law, but also an understanding of business principles, branding concepts, and relevant market dynamics. With this expertise, judges can evaluate and decide cases more accurately and fairly.
2. In addition, the Government also provides and builds a legal information system that is easily accessible to judges, including laws, implementing regulations, jurisprudence, and relevant academic documents. Provide access to judges to view previous relevant decisions, so that they can learn from the mistakes made by other judges. A comprehensive and in-depth approach to the case also ensures that the resulting decision is not only legally correct but also in accordance with the principles of justice and the protection of intellectual property rights.

ADVANCED RESEARCH

Based on the conclusions and recommendations presented in this study, future research can expand upon several critical areas related to the legal protection of well-known trademarks under Indonesian law. These areas are essential not only for strengthening academic discourse but also for informing policy-making and judicial practices to ensure consistency, fairness, and legal certainty in trademark disputes.

Comparative Analysis of Trademark Similarity Interpretation

One area that warrants further exploration is the variation in judicial interpretation of "substantial similarity" in trademark cases. As evidenced by the HUGO BOSS vs. Anthony Tan case, different judicial panels may rely on diverse elements—such as phonetic differences, visual appearance, and conceptual distinctiveness—to assess similarity. Future research should conduct a comparative study of court decisions across multiple cases to identify patterns, inconsistencies, and the underlying rationale behind these variations. This may help formulate guidelines or judicial training modules that promote more consistent and predictable outcomes in trademark litigation.

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