



BALANCING THE PRINCIPLE OF LEGAL CERTAINTY AND THE PRINCIPLE OF JUSTICE IN THE APPLICATION OF THE FIRST TO FILE PRINCIPLE IN TRADEMARK DISPUTES: A STUDY OF THE MS GLOW AND PS GLOW CASES

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Abstract: The trademark dispute between MS Glow and PS Glow is a concrete example of the tension between the principle of legal certainty and the principle of justice in the application of the first-to-file principle. This study aims to analyze the balance between the principle of legal certainty and the principle of justice in the application of the first-to-file principle and the form of legal protection provided in the trademark dispute. The research method used is normative legal research with a legislative and case approach, specifically by analyzing the Commercial Court Decision and the Supreme Court Decision. The results of the study show that the application of the first to file principle cannot be based solely on the formalities of registration, but must also take into account elements of good faith, actual use of the trademark, and a sense of justice in order to achieve equitable legal protection for the parties.

Keywords: *First To File; Legal Certainty; Fairness; Legal Protection; Trademark Disputes*

INTRODUCTION

Intellectual property is the result of human creativity and thought, which is born in order to support the fulfillment of needs and improve the quality of life. This creativity is then recognized and rewarded through legal protection for inventions, creations, and works of art under the Intellectual Property Rights (IPR) regime. This legal protection aims to create incentives for the birth of innovations and creations that are of higher quality and competitiveness, thereby driving the development of science knowledge, technology, and the economy.

Intellectual property rights cover various types of rights, one of which is trademark rights. In this era of globalization with increasing business competition, businesses are required to have a clear and strong identity to facilitate the introduction of goods or services to the market. One way to achieve this identity is through trademarks, which serve as a

distinguishing mark between one product and another. Innovation that is not accompanied by adequate legal protection has the potential to be copied or exploited by other parties without permission, which could ultimately harm the creator or owner. Therefore, the existence of Intellectual Property Rights Law is very important in preventing unfair competition, both in the form of counterfeiting and the unauthorized use of trademarks by parties other than the rightful owner. Trademarks serve as a distinguishing mark that reflects the quality, reputation, and characteristics of a product or service. With the existence of a brand, consumers gain confidence in distinguishing and choosing the desired product. Recognition of ownership of a new brand can be obtained after the brand is registered with the Directorate General of Intellectual Property (DJKI). One of the main requirements for brand registration is the existence of a

distinctive distinguishing feature so that the brand does not have similarities with other brands that have been registered previously. In addition, trademark registration serves as a legal basis for rejecting other trademark applications that are similar in whole or in part to goods or services.

In practice, it is still common to find trademark registration applications made in bad faith, namely by registering a trademark without first considering its similarity to other registered trademarks or even deliberately imitating well-known trademarks. This situation highlights the importance of legal protection for trademarks, including foreign trademarks, so that they are not misused by other parties for their own business interests. In Indonesia, trademark protection is regulated in the Trademark and Geographical Indications Law, which adheres to the constitutive principle of *first to file*, meaning that a trademark only obtains legal protection if it has been registered with the state through the Ministry of Law and Human Rights. If a party uses a trademark without registering it, that party does not obtain legal protection for the trademark. Thus, trademark rights only arise after the trademark has been registered with the Directorate General of Intellectual Property. Article 1(5) of the Trademark and Geographical Indications Law emphasizes that trademark rights are exclusive rights granted by the state to the first registrant for a certain period of time to use the trademark themselves or to grant permission to other parties.

This regulation aims to increase legal certainty and support the industrial, trade, and investment climate in the face of economic developments at the local, national, and international levels. Conceptually, Gustav Radbruch stated that good law must reflect three basic values, namely

justice, utility, and legal certainty. Legal certainty is a fundamental element in a legal system.

which guarantees that the law is predictable, applied consistently, and does not change, so that the public can clearly understand their rights and obligations. Without legal certainty, individuals will experience confusion in their actions because they do not have definite guidelines, which can ultimately lead to legal instability. Therefore, legal certainty is an important requirement in realizing justice and protecting the rights of individuals in a country. The value of justice also plays an important role in ensuring balanced legal protection between registered trademark owners and other parties with legitimate interests.

Justice is a fundamental principle in a legal system that serves to create order, balance, and protection of the rights and obligations of legal subjects. A just law is not a law that treats everyone equally without considering the existing conditions, but rather a law that is able to grant rights proportionally in accordance with the circumstances and needs of each party. Therefore, in resolving trademark disputes, the principles of fairness and legal certainty must always be part of the judge's considerations so that the resulting decision is not only normatively valid but also reflects fairness for the parties.

Legal problems arise when there are trademarks with similar names but are still registered by the Directorate General of Intellectual Property. This condition raises questions about how legal certainty and justice can be realized for the first trademark registrant, given that the trademark legal system in Indonesia adheres to the *first-to-file* principle. Basically, legal certainty in trademark protection is reflected in a registration system that grants rights to the party who first applies for and obtains trademark

registration. However, if there are identical or similar trademark registrations, this situation has the potential to cause injustice, especially for parties who have registered their trademarks legally and in good faith. Therefore, the application of trademark law should not only focus on the administrative aspects of registration but also consider the use of trademarks in business practices and their impact on the balance of rights and obligations of the parties, so that legal protection can be provided more fairly.

This study focuses on the trademark dispute between the owner of the MS Glow trademark, Shandy Purnamasari, and Putra Siregar, the owner of the PS Glow trademark. The dispute began when Putra Siregar launched the PS Glow beauty product in August 2021, which was considered to be similar to the MS Glow trademark in terms of spelling.

name, packaging, aroma, product color, and marketing concept. The MS Glow brand itself has been registered with the Directorate General of Intellectual Property since September 20, 2016, and is widely known by the Indonesian public. This action is considered an attempt to imitate or exploit the fame of the registered and reputable MS Glow brand, which has the potential to cause unfair business competition and mislead consumers. On this basis, Shandy Purnamasari filed a lawsuit with the Medan Commercial Court on March 15, 2022, with Case Number 2/Pdt.Sus-HKI/Merek/2022/PN Niaga Mdn. In its decision dated June 13, 2022, the Panel of Judges declared MS Glow the winner and ordered the cancellation of the Pstore Glow and Pstore Glow Men trademarks. Subsequently, Putra Siregar filed a counterclaim with the Surabaya Commercial Court under Case Number 2/Pdt.Sus-HKI/Merek/2022/PN Ni-aga Sby, which

in its ruling declared PS Glow as the exclusive owner of the trademark. However, this decision was later overturned by the Supreme Court through Decision Number 161 K/Pdt.Sus-HKI/2023 dated January 30, 2023, which declared the cancellation of the PS Glow, Pstore Glow, and PS Glow Men, and ordered the owner of PS Glow to pay compensation to the owner of MS Glow in the amount of IDR 547,333,192,813.33 and court costs at the cassation level. This study aims to analyze the balance between the principle of legal certainty and the principle of justice in the application of *the First to File* principle to create fair legal protection for trademark holders in the MS Glow and PS Glow case study.

MAIN PROBLEM

1. How is the balance between the principle of legal certainty and the principle of justice in the application of *the first to file* principle in the MS Glow and PS Glow case studies?
2. What is the form of legal protection in the first to file principle and the form of legal protection in the first to file principle in the MS Glow and PS Glow cases?

METHOD OF RESEARCH

The type of research used in this study is normative or normative juridical research. Normative juridical research refers to legal norms contained in legislation and court decisions and legal norms that apply in society. This study uses a normative juridical approach with a qualitative legal research method that aims to examine the balance between the principle of legal certainty and the principle of justice in the application of the *first-to-file* principle in the MS Glow and PS Glow cases. The normative juridical approach was chosen because this study focuses on kajian terhadap norma law, legal principles, doctrines,

and court decisions in the MS Glow and PS Glow cases. Using a legislative approach, a case approach, namely the MS Glow and PS Glow cases, and a conceptual approach. This study uses descriptive analysis, namely data presented in written form. This research was conducted to reveal a problem and situation as it is, so that it is only for the disclosure of facts. The descriptive research method was used to solve or answer the problems being faced. Therefore, this descriptive research aims not only to reveal the truth, but also to understand the truth of legal rules.

BALANCE THE PRINCIPLE OF LEGAL CERTAINTY AND THE PRINCIPLE OF JUSTICE IN THE APPLICATION OF THE *FIRST TO FILE* PRINCIPLE IN THE MS GLOW AND PS GLOW CASE

The law basically has a general character and is binding on everyone without discrimination. This general nature aims to create social order and ensure equality for every subject of law before the law. Through the application of norms that are general and impersonal in nature, the state seeks to build public trust in the law as a mechanism for conflict resolution and protection of interests. In this framework, the law not only functions as a regulatory tool, but also as a means of protection and creator of legal certainty, benefit, and justice, which are the three fundamental values that form the foundation of every law. These three values, as formulated by Gustav Radbruch, are known as the triadic values of law that cannot be separated in the formation and application of legal norms.

Legal certainty emphasizes the clarity of norms, consistency of application, and stability of regulations. Beneficence is oriented towards the extent to which the law provides

tangible benefits to society. Meanwhile, justice demands proportional treatment in accordance with the concrete conditions of the parties involved. It is the differences in the character of each of these values that often cause tension in the practice of law enforcement.

Legal clarity is a guarantee of legal equality. Norms aimed at achieving equality must be effectively functioned as rules that are truly obeyed and implemented in practice. This means that legal provisions are not sufficient to be formulated formally, but must have real validity and binding force in legal life. Without consistent implementation, norms designed to ensure equality of status will lose its substantive meaning. In the context of trademark law in Indonesia, the system adopted is a constitutive system based on the *first-to-file* principle, with the consequence that trademark rights are granted to the party who first registers the trademark and who has authority over the ownership of that trademark. Trademarks can be protected by law, so they must be registered with the Ministry of Law and Human Rights. The trademark registration system in Indonesia does not base the recognition of rights on who first used or introduced the trademark in commercial activities, but rather on who first submitted and obtained official registration. This principle is known as *first to file*, which is the principle that gives priority to the applicant who first submits a registration application in accordance with the applicable procedures. This results in obtaining legal protection for the trademark. Consequently, if a person or legal entity has already registered a trademark and their application has been approved, other parties are not permitted to register an identical trademark or one that is essentially similar for similar goods and/or services.

In the context of trademark legal protection, these two principles often conflict with each other, especially in the application of the *first-to-file* principle. The *first-to-file* principle in Indonesian trademark law is essentially an implementation of the principle of legal certainty. With the enactment of the constitutive system, the party who first registers a trademark and fulfills the legal requirements obtains exclusive protection from the state. According to Utrecht, legal certainty has two main meanings. First, the existence of general legal norms allows every individual to clearly know what actions are permitted and what actions are normatively prohibited in the legal system. Second, legal certainty plays an important role as a form of protection for individuals from the possibility of arbitrary actions by the government. The existence of norms that are formulated in a general and clear manner enables every legal subject to know with certainty the scope of the state's authority. Thus, individuals can understand the limits of actions that can be taken by the government against them, including the rights and obligations that can be imposed based on applicable legal provisions. In relation to the *first-to-file* principle, it provides certainty as to who is the rightful holder of the rights because these rights can be objectively proven through a registration certificate. If legal protection is based solely on the administrative aspect of registration, then the party who are factually and substantively more entitled to suffer harm. In this case, the registration of the PS Glow trademark after MS Glow was registered has the potential to cause injustice, as it allows other parties to piggyback on the reputation and fame of a brand that is already well-known to the public. This is where the principle of justice becomes relevant in assessing whether the trademark

registration was carried out in good faith or whether it actually contradicts the principle of justice. If the *first-to-file* principle is applied rigidly and formalistically, the law has the potential to lose its dimension of fairness. This is in line with Gustav Radbruch's idea of placing fairness, legal certainty, and benefit as the three basic values of law. Gustav Radbruch emphasized that positive law should not be applied mechanistically if its content clearly contradicts fairness.

Application of the principles of legal certainty and fairness in the *first-to-file* principle in the trademark dispute between MS Glow and PS Glow based on an analysis of the Commercial Court's decision Medan and the Supreme Court Supreme Court number 57/K/Pdt.Sus-HKI/2022, there was a previous ruling by the Commercial Court of Surabaya No.2/Pdt.Sus-HKI/Merek/2022/PN Sby, a fundamental difference was found in the way the two judicial institutions interpreted the similarity in essence, it is a matter of good faith. This study does not seek to interpret the two decisions between the Medan Commercial Court and the Supreme Court, but rather to highlight the application of the principles of legal certainty and justice in the MS Glow and PS Glow cases from the perspective of the *first-to-file* principle in trademark registration adopted by Indonesia. This creates a difference between legal norms and their practical application. Normatively, Article 21 paragraph 1 of Law No. 20 of 2016 concerning trademarks stipulates that a trademark registration application must be rejected if it is essentially or entirely similar to a trademark that has been registered earlier by another party. This provision reinforces the application of the *first-to-file* principle, which is the basis of legal certainty for trademark owners in Indonesia, but in practice,

this provision is not consistently applied. Before filing a civil lawsuit, the PS Glow trademark registration application had been rejected by the Director General of Intellectual Property, but the owner of PS Glow filed an appeal to the Trademark Appeal Commission, resulting in the PS Glow trademark owner's application to the Trademark Appeal Commission being granted by the Directorate of Trademarks and Geographical Indications, Director General of Intellectual Property. Thus, PS Glow obtained a trademark certificate that had previously been rejected. This prompted the owner of MS Glow to file a civil lawsuit with the Commercial Court.

At the Medan District Court, conversely, the owner of PS Glow filed a petition with the Commercial Court in Surabaya. The results of these two decisions led to differences in the judges' assessments of the subject matter, thereby creating a legal precedent that was confusing to the public. This reinforces the fact that interpretations of the principle of *first to file* and good faith are not yet fully uniform. This situation has led to legal uncertainty for the parties, especially for the party who first applied for and obtained the trademark registration. This is because the Medan District Court's decision stated that MS Glow was the first owner and first registrant, while the Surabaya District Court's decision stated that PS Glow was the first owner of the word "Glow." MS Glow appealed the Surabaya Commercial Court's decision on the grounds that it felt the decision did not provide justice for the first trademark holder. The Supreme Court, at the cassation level, confirmed that MS Glow was the legitimate trademark holder based on the *first-to-file* principle and overturned the Surabaya Commercial Court's ruling. The Supreme Court found that

the PS Glow trademark was essentially similar to the MS Glow trademark and that the registration of was made after the MS Glow trademark had obtained legal protection. The Supreme Court also considered the presence of bad faith in the registration of the PS Glow trademark, as it had the potential to ride on the fame of the MS Glow trademark, which was already widely known by the public. Based on these considerations the Supreme Court granted the MS Glow lawsuit and ordered the cessation of the use of the PS Glow trademark and awarded compensation to MS Glow.

FORM OF LEGAL PROTECTION UNDER THE *FIRST TO FILE* PRINCIPLE IN THE MS GLOW AND PS GLOW CASE

Legal protection generally refers to a series of efforts made by the state through law enforcement mechanisms to ensure that every individual obtains their rights fairly. Conceptually, legal protection can be understood as a guarantee given by the state to every individual that their rights are protected by law. Legal protection reflects the function of law as a protector of human interests in civil, economic, political, and social life, and is a concrete form of the state's support for human dignity as a whole and sovereign legal subject. According to Satjipto Raharjo, legal protection is essentially an effort to provide protection for human rights that have been violated or harmed as a result of the actions of others. This protection is intended to ensure that every individual is guaranteed their rights and is protected from harmful or unfair treatment. The purpose of legal protection is not only to protect individuals from rights violations or abuse of power, but also to serve as an instrument to guarantee substantial justice, create legal certainty, and strengthen the rule of law in all aspects

of life. Legal protection is a tool used by the state to ensure that these rights are not only formally guaranteed through the constitution and laws but also upheld in their implementation through legal mechanisms that serve as the basis for citizens to demand their rights.

Legal protection of a trademark is basically only given to trademarks that have been officially registered in accordance with applicable procedures. Through such registration, trademark owners obtain stronger protection, especially in the event of a dispute with another party using the same or a similar trademark. Although most business actors are aware of the importance of using trademarks to differentiate products in the market, not all understand in the urgency of trademark registration as a form of effective legal protection.

Preventive legal protection subjects are given the right to submit objections, responses, or arguments before the government makes a final decision. This protection aims to avoid legal disputes between parties. Repressive Legal Protection, Repressive legal protection is directed at resolving legal conflicts that have occurred through judicial processes on mechanisms for resolving disputes that have occurred. This repressive legal protection is implemented through judicial institutions such as general courts and administrative courts. The main basis of this protection is the principle of respect for and protection of human rights so as to guarantee human rights. Regulations regarding the protection of well-known trademarks are established by the state through laws that cover preventive and repressive protection. Regulations regarding the form of preventive legal protection can be found in Articles 20, 21, and 22 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Meanwhile, repressive protection is explained in

articles 90-103 and in articles 100-103. In the form of legal protection provided through repressive legal protection, the most umum pursued by The registered trademark owner in the event of trademark infringement. This lawsuit is filed in commercial court by the trademark owner or party with a legal interest on the basis of the use of a trademark that is similar in essence or in its entirety to the registered trademark without the permission of the rightful owner. In the realm of civil law protection, the legally registered trademark owner obtains protection in accordance with the provisions of the legislation. In the Indonesian trademark law system, the holder of trademark rights has the authority to file a lawsuit if there is an infringement committed by another party against those rights. Such a lawsuit may be filed to claim damages and to request that all acts related to the unlawful use of the trademark be stopped. The lawsuit is filed with the Commercial Court, including the complete identities of the parties, including the identities and addresses of legal representatives, if represented. In addition, if the trademark application uses color elements, these elements must be clearly stated in the lawsuit. The lawsuit must also include information about the country of origin and the date of the trademark application, as well as a description of the types of goods and/or services protected. To complete the administrative requirements, the lawsuit must be accompanied by a trademark label and proof of payment of the prescribed fees.

Claims for damages in trademark infringement cases can be divided into material damages and immaterial damages. Material damages are tangible, actual losses that can be calculated and assessed in monetary terms. Immaterial damages are claims for non-economic losses arising from

the unauthorized use of a trademark, resulting in normal and reputational losses to the rightful owner. In order for such claims for damages to be valid and acceptable as the basis for a lawsuit, three main elements must be fulfilled, namely: The trademark used by the defendant is essentially or entirely similar to another person's trademark, the trademark belonging to the other party has been legally registered, and there has been unauthorized use of the trademark or without permission from the legal rights holder. The mechanism for civil lawsuits related to trademarks is outlined in Article 83 of Law Number 20 of 2016 concerning Trademarks and Geographical Indications. Any losses incurred by the trademark holder can be submitted to the commercial court for all losses incurred and the cessation of all legal actions involving the use of trademarks in trade. Based on the MS Glow and PS Glow case, MS Glow felt that its rights had been infringed upon by PS Glow. Therefore, MS Glow filed a lawsuit dated March 15, 2022 which was received and registered in the administration of the Commercial Court at the Medan District Court under registration number 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Mdn to claim damages suffered by MS Glow. According to PS Glow, the MS Glow trademark does not meet the legal requirements for registration and protection because the type of trademark registered does not match the products being sold. Therefore, PS Glow filed a counterclaim on April 5, 2022, which was accepted by the Commercial Court Registry at the Surabaya District Court on April 12, 2022, with registration number 2/Pdt.Sus.HKI/Merek/2022/PN.Niaga Sby. As a result of the Surabaya Commercial Court's decision, MS Glow concluded in filing a cassation appeal. The decision of the Medan Commercial

Court was upheld by the Supreme Court in the cassation ruling, which acknowledged the losses suffered by MS Glow as a result of the actions against in the form of trademark infringement committed by PS Glow.

CONCLUSION

The *first-to-file* principle is the main basis of the trademark protection system in Indonesia, which emphasizes that registration is a constitutive requirement for the emergence of trademark rights. This is as stated in Law No. 20 of 2016 concerning trademarks and geographical indications, which states that trademark rights arise upon registration. Consequently, this system ensures legal certainty by granting exclusive rights only to those who register their trademarks first in accordance with the applicable procedures. This certainty is reflected in the clear, measurable, and predictable protection afforded to registered trademark holders. The guarantee of legal protection for the party who first registered the trademark does not only stop at formal administrative recognition, but is also substantively realized through a mechanism for canceling trademarks that have been registered in bad faith and the possibility of compensation. Thus, the *first-to-file* principle not only guarantees procedural legal certainty but also functions as an instrument to achieve substantive justice in the practice of resolving trademark disputes.

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