

## Legal Protection Over the 'GOTO' Trademark Ownership Dispute between PT Terbit Financial Technology and PT GoTo Gojek Tokopedia

**Arrifah Amarya Putri\***

*Fakultas Hukum Universitas Islam Indonesia, Yogyakarta, Indonesia,  
19410278@alumni.uui.ac.id*

**Ery Arifudin**

*Fakultas Hukum Universitas Islam Indonesia, Yogyakarta, Indonesia,  
ery.arifudin@uui.ac.id*

**Abstract.** A trademark serves as the identity of a product, aimed at distinguishing one product from the other producers' product. In Indonesia, there is a protection for trademark owners, governed by Law No. 20 of 2016 on Trademarks and Geographical Indications. The main principles used in the protection of rights to a trademark are the constitutional principle and the first-to-file principle. The study is about the legal protection of rights to a trademark over the "GOTO" brand ownership dispute between PT Terbit Financial Technology and PT GoTo Gojek Tokopedia. This study uses a normative legal research method with approaches based on legislation and conceptual frameworks. According to the conducted research, the "GOTO" trademark owned by PT GoTo Gojek Tokopedia should not exist and its registration should not have been accepted because Indonesian trademark law adheres to the constitutional principle and the first-to-file principle. Legal protection, therefore, allows PT Terbit Financial Technology to file a trademark infringement lawsuit and/or a trademark cancellation. Consequently, the authorities responsible for enforcing rights to a trademark protection are expected to perform their duties effectively to prevent future brand ownership disputes.

**Keywords:** Trademark, Legal Protection, GOTO

**Abstrak.** Merek merupakan identitas dari sebuah produk yang bertujuan untuk membedakan antara produk yang satu dengan produk milik produsen lainnya. Di Indonesia telah terdapat perlindungan bagi pemilik hak atas merek. Perlindungan tersebut diatur dalam Undang-Undang Nomor 20 Tahun 2016 Tentang Merek dan Indikasi Geografis. Prinsip utama yang digunakan dalam perlindungan pemilik hak atas merek adalah prinsip konstitusi dan prinsip first to file. Permasalahan yang dikaji dalam penelitian ini adalah mengenai perlindungan hukum terhadap pemilik hak atas merek atas sengketa kepemilikan merek "GOTO" antara PT Terbit Financial Technology dan PT GoTo Gojek Tokopedia. Penelitian ini menggunakan metode penelitian hukum normatif dengan metode pendekatan peraturan perundang-undangan dan pendekatan konseptual. Menurut penelitian yang dilakukan penulis, merek "GOTO" milik PT GoTo Gojek Tokopedia seharusnya tidak ada dan tidak diterima pendaftarannya karena hukum merek Indonesia menganut prinsip konstitusi dan prinsip first to file. Perlindungan hukumnya yaitu PT Terbit Financial Technology ini dapat mengajukan gugatan pelanggaran merek dan/atau pembatalan merek. Oleh karena itu, pihak yang berwenang dalam proses penegakan perlindungan hukum pemilik hak atas merek merek diharapkan melakukan tugasnya dengan maksimal agar tidak terjadi sengketa kepemilikan merek di masa yang akan datang.

**Kata kunci:** Merek, Perlindungan Hukum, GOTO

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## INTRODUCTION

The trademark dispute started when PT GoTo Gojek Tokopedia registered the "GOTO" trademark in Class 42 under the registration number IDM000936923 dated on December 27, 2021. The protection of the "GOTO" trademark owned by PT GoTo Gojek Tokopedia started on March 6, 2021 until March 6, 2031.<sup>1</sup> On March 11, 2021, PT GoTo Gojek Tokopedia applied for another "GOTO" trademark registration in other classes. The GoTo trademark owned by PT GoTo Gojek Tokopedia was officially registered on December 27, 2021. On the other hand, PT Terbit Financial Technology has used the "GOTO" trademark and has registered it beforehand. PT Terbit *Financial Technology* has registered the "GOTO" trademark in class 42 under the registration number IDM000858218 dated on May 25, 2021. The protection of the "GOTO" trademark owned by PT Terbit Financial Technology started on March 10, 2020 and ends on March 10, 2030.<sup>2</sup> Both GOTO trademarks are registered in the same class which class 42. The type of goods and services under the class code 42 are research and technology services and research and design related to it; research and industrial analysis services; design and the development of software and hardware computer.<sup>3</sup>

As a result of the trademarks similarity, PT Terbit Financial Technology has filed a lawsuit which was registered on November 2, 2021, at the Central Jakarta District Court with registration number 71/Pdt.Sus-HKI/Merek/2021/PN Niaga Jkt.Pst. PT Terbit Financial Technology stated in its lawsuit that there are similarities in the trademark with PT GoTo Gojek Tokopedia, which are essentially present in the following aspects:

1. The dominant element of the "GOTO" trademark owned by PT Terbit Financial Technology is a combination of letters forming the word "GOTO";

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<sup>1</sup> <https://pdki-indonesia.dgip.go.id/detail/IPT2021032527?type=trademark&keyword=goto>, accessed on March 16, 2023.

<sup>2</sup> <https://pdki-indonesia.dgip.go.id/detail/IPT2020018216?type=trademark&keyword=goto>, accessed on March 16, 2023.

<sup>3</sup> <https://skm.dgip.go.id/index.php/skm/detailkelas/42>, accessed on 16 March 2023.

2. The "GOTO" trademark used by PT GoTo Gojek Tokopedia uses the same letters and forms the same word as the trademark "GOTO" owned by PT Terbit Financial Technology;
3. The "GOTO" trademark used by PT GoTo Gojek Tokopedia has a similar pronunciation to the "GOTO" trademark owned by PT Terbit Financial Technology.
4. There is no distinguishing element between the "GOTO" trademark or "goto" used by PT GoTo Gojek Tokopedia and the "GOTO" trademark owned by PT Terbit Financial Technology;
5. The aforementioned similarities give consumers the impression that the "GOTO" trademark or "goto" used by PT GoTo Gojek Tokopedia is the same as the "GOTO trademark" owned by PT Terbit Financial Technology;
6. It is known that PT GoTo Gojek Tokopedia filed a trademark registration for "GOTO" using all capital letters in Class 42 on March 6, 2021, and subsequently filed a trademark registration for "goto" in other classes on March 11, 2021. Therefore, it is reasonable for PT Terbit Financial Technology to argue that PT GoTo Gojek Tokopedia has indeed used variations of the trademark "GOTO" other than "goto".

The protection of trademarks in Indonesia adheres to the first-to-file principle. This principle states that the party recognized as the owner of a trademark is the first registrant of that trademark.<sup>4</sup> Therefore, with the application of the first-to-file principle, the existence of two trademarks in the same class, such as the GOTO trademark owned by PT GoTo Gojek Tokopedia, does not comply with the provisions of Law Number 20 of 2016 on Trademarks and Geographical Indications. Based on this background, the issues that will be studied are: How is the legal protection for trademark owners affected by the emergence of a new trademark that is identical and falls within the same class? and What are the legal consequences of violating the first-to-file principle in the case of the GOTO trademark dispute?

## METHODOLOGY

The research conducted to address the legal issue used a normative research method. The research approach used are a case-based approach, laws and regulation approach,

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<sup>4</sup> Khoirul Hidayah, *Hukum Hak Kekayaan Intelektual*, Setara Press, Malang, 2017, p. 61

and conceptual approach. The object of this research is the legal protection for the trademark owner in the dispute over the ownership of the "GOTO" trademark. The techniques used in this research are document study and literature review, involving the analysis of legal sources such as the 1945 Constitution, the Indonesian Civil Code, and Law Number 20 of 2016 on Trademarks and Geographical Indications.

## RESULT AND DISCUSSION

### **Legal Protection for the Trademark Owner (PT Terbit *Financial Technology*) Over the Emergence of a Newly Registered Trademark with the Same Name and Same Class Category**

Legal protection is an act based on law, both in the form of repression and prevention, used to protect the rights of legal subjects in order to achieve justice.<sup>5</sup> Indonesia protects the trademarks rights of the trademark owners through several applicable laws and regulations. The 1945 Constitution regulates the rights related to trademarks in Article 28D paragraph (1), Article 28H paragraph (2), Article 28I paragraph (5), and Article 28J paragraph (1).

Further legal protection for trademark owners is governed by Law Number 20 of 2016 on Trademarks and Geographical Indications (Trademark Law). Indonesian law recognizes rights to a trademark as exclusive rights granted to trademark owners who have registered their trademarks for a certain period of time.<sup>6</sup> The legal protection of rights to a trademark consists of several elements, i.e.,:

1. The subject of protection is an individual or legal entity who becomes the owner of a registered trademark.
2. The object of protection is all the rights of a trademark that have been registered in accordance with the Trademark and Geographical Indications Law.
3. Registration of protection refers to trademarks that have been registered and proven through a certificate of trademark ownership.
4. The duration of protection is 10 (ten) years and can be extended for the same period of time.

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<sup>5</sup> Abintoro Prakoso, *Hukum Perlindungan Anak*, LaksBang Pressindo, Yogyakarta, 2016, p. 6

<sup>6</sup> Article 1 number 5 Law Number 20 of 2016 on Trademarks and Geographical Indications

5. Legal actions for protection occur when a trademark violation is proven, and the trademark owner can seek the restoration of their rights through litigation or non-litigation procedures as regulated in Article 93 of the Trademark Law.

Protection of the rights to a trademark is granted to the owner whose trademark has been officially registered with the Directorate General of Intellectual Property. In accordance with Article 3 of the Trademark Law, the rights to a trademark are exclusive rights granted by the state to the registered trademark owner for a certain period of time. The exclusive rights, as defined in the rights to a trademark, refer to the owner's right to use the trademark themselves or grant permission to others.<sup>7</sup> The context of the word "registered" in Article 3 implies that after the application goes through the process of formal examination, publication, substantive examination, and obtains the Minister's approval, a certificate is issued.<sup>8</sup> The duration of protection for a registered trademark according to the law is 10 years from the filing date of the application. After this initial period, the protection can be renewed for additional periods of the same duration.<sup>9</sup>

Protection for trademark owners in Indonesia is based on the constitution principle and first-to-file principle. The constitutional principle states that rights to a trademark can only be granted to the trademark holder if the trademark is officially registered.<sup>10</sup> The principle of first-to-file means that the first applicant to file a trademark registration is considered the rightful owner of that trademark.<sup>11</sup> These two principles are implicitly regulated in Article 3 of the Trademark Law. Furthermore, Indonesia has ratified the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) under the Agreement Establishing the World Trade Organization (WTO). The TRIPS Agreement covers trade-related aspects of intellectual property rights. In the TRIPS Agreement, there are provisions regarding the principle of trademark ownership, which include:

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<sup>7</sup> Meli Hertati Gultom, "Perindungan Hukum Bagi Pemegang Hak Merek Terdaftar Terhadap Pelanggaran Merek", *Jurnal Warta* Edisi 56, Universitas Darmawangsa, 2018, p. 7

<sup>8</sup> Elucidation of Article 3 Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>9</sup> *Ibid*, Article 28.

<sup>10</sup> Khoirul Hidayah, *Hukum HKI...*, *Op.Cit*, p. 60

<sup>11</sup> *Ibid*, p. 59

1. Article 15 which regulates that:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements, and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

2. Article 16 which regulates that:

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

In summary, the TRIPS Agreement has been ratified and serves as a legal source that regulates and protects trademark owners. For instance, Article 16 states that trademark owners have exclusive rights, which allow them to prevent third parties from using their trademarks without permission. Additionally, the existence of similar trademarks being used can lead to consumer confusion.

Indonesia has ratified the TRIPS Agreement through Law Number 7 of 1994 on the Ratification of the Agreement Establishing the World Trade Organization. Consequently, the current Trademark Law has been aligned with the TRIPS Agreement. The Trademark Law is a legislation that regulates and protects legitimate trademark owners. Therefore, legal entities intending to register a trademark must

fulfil the administrative requirements and take into account the criteria for trademarks that are ineligible for registration or may be rejected, which include:

#### Article 20

A trademark cannot be registered if it:

- (1) contradicts the state's ideology, laws and regulations, morality, religion, decency, or public order;
- (2) is identical to, related to, or merely describes the goods and/or services for which registration is sought;
- (3) contains elements that may mislead the public regarding the origin, quality, type, size, nature, or purpose of use of the goods and/or services for which registration is sought, or is the name of a protected plant variety for similar goods and/or services;
- (4) contains information that is inconsistent with the quality, characteristics, or efficacy of the produced goods and/or services;
- (5) Lacks distinctiveness; and/or
- (6) Is a common name and/or a public symbol.

#### Article 21

(1) A trademark application will be rejected if the trademark contains elements that are substantially or wholly identical to:

- a. A registered trademark owned by another party or previously applied for by another party for similar goods and/or services;
- b. A well-known trademark owned by another party for similar goods and/or services;
- c. A well-known trademark owned by another party for dissimilar goods and/or services that meet certain requirements.

After considering those aspects, the applicant can proceed with filing a trademark registration application. The Trademark Law outlines four stages that must be followed to process a trademark registration application:

#### 1. Filing of the Trademark Application

This stage is governed by Article 4 of the Trademark Law. It involves submitting the trademark registration application by the applicant or their representative to the Minister.

#### 2. Publication Period

This stage is regulated by Article 14 of the Trademark Law. It entails the Minister publishing the trademark application in the Official Trademark Gazette within 15 (fifteen) days from the date of acceptance of the application. During this stage, interested parties have the opportunity to raise objections.

### 3. Substantive Examination

This stage is regulated by Article 23 of the Trademark Law. It involves an examination conducted by an examiner. During this stage, the examiner has the authority to make a decision to accept or reject a trademark application.<sup>12</sup> The substantive examination must be conducted regardless of whether there are objections or not.

### 4. Issuance of the Trademark Certificate

This stage is regulated by Article 25 of the Trademark Law. The trademark certificate is issued by the Minister upon the registration of the trademark.

The trademark ownership dispute between PT Terbit Financial Technology and PT GoTo Gojek Tokopedia regarding the "GOTO" trademark is quite well-known. The "GOTO" trademark owned by PT GoTo Gojek Tokopedia was able to be registered even though the arrangement of the letters in the trademark lacks distinctiveness and is similar to the "GOTO" trademark owned by PT Terbit Financial Technology. Whereas, according to the Trademark Law, one of the indicators that a trademark cannot be accepted is "lack of distinctiveness"<sup>13</sup> and trademark application shall be rejected if it has substantial or complete similarity to "a registered trademark owned by another party or previously applied for by another party for similar goods or services."<sup>14</sup>

The explanation in the Trademark Law regarding "substantial similarity" refers to the resemblance caused by the presence of dominant elements between one trademark and another, giving the impression of similarity. This can include similarities in terms of shape, placement, writing style, combination of elements, or even phonetic

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<sup>12</sup> Article 24 of Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>13</sup> Article 20 of Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>14</sup> Article 21 of Law Number 20 of 2016 on Trademarks and Geographical Indications



similarity found in the trademark. Furthermore, the explanation for clause a, referring to "a trademark previously applied for," means a trademark registration application that has already been approved for registration.<sup>15</sup>

Minister of Law and Human Rights of the Republic of Indonesia Regulation Number 12 of 2021 on Amendments to Minister of Law and Human Rights Regulation Number 67 of 2016 on Trademark Registration (Ministerial Regulation on Trademark Registration) explained that similarity is primarily assessed by considering the resemblance caused by dominant elements between one trademark and another, resulting in an impression of similarity in terms of shape, placement, writing style, combination of elements, or similarity in sound pronunciation present in the trademarks.

Article 17, paragraph (1) of the Ministerial Regulation on Trademark Registration provides parameters for assessing the existence of similarity, which can be done by considering the presence of dominant elements between one trademark and another. By paying attention to these details, the impression of similarity in terms of placement, writing style, combination of elements, or similarity in sound pronunciation will become apparent.

The dispute over the ownership of the "GOTO" trademark, where in fact the "GOTO" trademark owned by PT GoTo Gojek Tokopedia clearly has dominant elements of similarity with the "GOTO" trademark owned by PT Terbit Financial Technology. It is a fact that the "GOTO" trademark owned by PT Terbit Financial Technology was registered earlier and officially recorded in the Intellectual Property Database of the Directorate General of Intellectual Property of the Ministry of Law and Human Rights (PDKI DJKI Kemenkumham). The following is an illustration of the legal facts:

Source: Ministry of Law and Human Rights *cq* Directorate General of Intellectual Property

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<sup>15</sup> Elucidation of Article 21 section (1) of Law Number 20 of 2016 on Trademarks and Geographical Indications



**Picture 1 Description of PT Terbit Financial Technology Trademark Registration**



Source: Ministry of Law and Human Rights *cq* Directorate General of Intellectual Property

**Picture 2 Description of PT GoTo Gojek Tokopedia Trademark Registration**

The dispute over the ownership of the "GOTO" trademark is one of many trademark infringement cases that occur in Indonesia. Legal protection for trademark owners is divided into two forms:

1. Preventive Protection

The term "preventive" etymologically derives from the Latin word "*pravenir*," which means anticipation or to prevent something. Preventive protection for trademarks refers to efforts used to prevent trademark infringement.<sup>16</sup>

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<sup>16</sup> <https://www.hukumonline.com/berita/a/upaya-preventif-dan-represif-dalam-penegakan-hukum-lt63e0813b74769/>, accessed on June 16, 2023 at 21.30 PM

According to the applicable law, protection for the owner of trademark rights can commence when the trademark has been registered in accordance with the mechanisms and provisions established by the trademark and Geographical Indications laws. Therefore, to initiate and submit a trademark registration application, one must fulfill the formal and substantive requirements.

Preventive protection of trademark rights can be carried out in several ways, i.e.:

- a. The Minister shall not accept trademark registration applications that lack distinctiveness compared to previously registered trademarks;<sup>17</sup>
- b. The Minister of Law and Human Rights, *cq* the Directorate General of Intellectual Property, is obligated to reject trademark registration applications that have similarity in their essential parts and/or in their entirety with registered trademarks owned by others.<sup>18</sup>
- c. Applicants who submit trademark registration applications can withdraw their application if there is an indication of a violation of Article 20 and Article 21 of the Trademark Law, as long as the trademark certificate has not been issued.<sup>19</sup>
- d. The authorized trademark examiner may reject a trademark registration if, during the substantive examination stage, there are trademarks that fall within the criteria of Article 20 and Article 21. The rejection shall be notified to the Minister, who will then inform the applicant or their representative in writing, stating the reasons for the rejection.<sup>20</sup>

## 2. Repressive Protection

Repressive protection is the final form of protection or the protection granted when a problem has already occurred. Repressive protection takes the form of sanctions such as fines, imprisonment, and penalties.<sup>21</sup> Repressive protection, in the context of protecting trademark owners, means that protection is provided to the trademark owner when disputes or infringements are committed by other parties. To protect trademark rights when a trademark

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<sup>17</sup> Article 20 letter e of Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>18</sup> Article 21 section (1) of Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>19</sup> Article 19 section (1) of Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>20</sup> Article 21 section (2) Law Number 20 of 2016 on Trademarks and Geographical Indications

<sup>21</sup> Dyah Permata Budi Asri, "Perlindungan Hukum Preventif Terhadap Ekspresi Budaya Tradisional Di Daerah Istimewa Yogyakarta Berdasarkan Undang-Undang Nomor 28 Tahun 2014 Tentang Hak Cipta", *JIPRO: Journal of Intellectual Property*, Vol. 1 No. 1, 2018, p. 18

infringement occurs against a registered trademark, it can be pursued through civil and criminal legal avenues, both through litigation and non-litigation processes.

The Trademark and Geographical Indications Law provides several options for resolving trademark disputes. The following are repressive legal protections for trademark ownership:

- a. The trademark owner can file a trademark cancellation lawsuit based on Article 76 and Article 77 of the Trademark Law, which states:

#### Article 76

- (1) A lawsuit against invalidation of registered trademark may be filed by relevant party based on the reason as referred to in Article 20 and/or Article 21.
- (2) Unregistered trademark owner may file the lawsuit as referred to in section (1) after filing Application to the Minister.
- (3) The lawsuit for invalidation is filed to the Commercial Court against the registered trademark owner.

#### Article 77

- (1) The lawsuit for invalidation of Mark registration may only be filed within a period of 5 (five) years as from the date of the trademark registration.
- (2) The lawsuit for invalidation may be filed in unlimited time if there is bad faith and/or the relevant trademark contravenes the State ideology, laws and regulations, morality, religions.

- b. The owner of the right to a trademark may file a lawsuit for trademark infringement which could contain a compensation and/or The cessation of all actions related to the use of the trademark. The lawsuit can be filed at the Commercial Court.<sup>22</sup> As stipulated in Article 83 section (1) and (3), i.e.:

- (1) The registered trademark owner and/or Mark Licensee may file the lawsuit against other parties who unlawfully use the trademark that is similar to or identical for similar kinds of goods and/or services in the form of:
  - a. claim for damages; and/or
  - b. ceasing all acts related to the use of trademark.

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<sup>22</sup> Article 83 section (3) Law Number 20 of 2016 on Trademarks and Geographical Indications

- (2) The lawsuit as referred to in section (1) is filed to the Commercial Court.
  - a. The owner of the rights to a trademark may apply to alternative dispute resolutions through arbitration or with other non-litigasi pathways as stipulated in Article 93 which stated: "In addition to the lawsuit settlement as referred to in Article 83 the parties may settle disputes through arbitration or alternative dispute resolution."
  - b. Based on the Article 99 of Trademark Law, the owner of the rights to a trademark could report the existence of a trademark criminal act to the National Police's investigation officer of the Republic of Indonesia or the Civil Servant within the ministry administering the special authorization to conduct investigation on trademark criminal acts.
  - c. That, as a form of repressive legal protection, criminal provision on trademark affairs related to trademark infringement are also regulated in Article 100, Article 101 and Article 102, i.e.,:

#### Article 100

1. Every person unlawfully uses any trademark which is identical to registered trademark of other parties for similarly produced, and/or traded goods and/or services, shall be sentenced to imprisonment of up to 5 (five) years and/or fines up to Rp2,000,000,000.00 (two billion rupiahs).
2. Every person unlawfully uses any trademark which is substantially similar to registered trademark of another party for similarly produced and/or traded goods and/or services, shall be sentenced to imprisonment for up to 4 (four) years and/or fines up to Rp2,000,000,000.00 (two billion rupiahs).
3. Every person violating the provisions as referred to in section (1) and section (2), whose goods cause health impairment, environment distortion, and/or human deceases, shall be sentenced to an imprisonment up to (10) ten years and/or fines up to Rp5.000.000.000,00 (five billion rupiahs)

#### Article 101

- (1) Every person unlawfully uses any signs which are identical to Geographical Indications of other parties for similar goods and/or products or identical to registered goods and/or products, shall be sentenced to imprisonment up to 4 (four) years and/or up to Rp2.000.000.000,00 (two billion rupiahs).

- (2) Every Person unlawfully uses any sign which is substantially similar to Geographical Indications of another party for similar goods and/or products or identical with registered goods and/or products, shall be sentenced with imprisonment up to 4 (four) years and/or fines up to Rp2.000.000.000,00 (two billion rupiahs).

Based on the regulations and legal protections in place, PT Terbit Financia Technology may file a trademark infringement lawsuit against the "GOTO" trademark owned by PT GoTo Gojek Tokopedia at the Commercial Court. The lawsuit should be filed at the Commercial Court within the jurisdiction where PT GoTo Gojek Tokopedia is located.

### **The Consequences of Violating the First-to-File Principle in the Dispute over Ownership of the "GOTO" Trademark**

Trademark rights is one of the scope of the protection of intellectual property. The owner of a trademark has exclusive rights that allow them to use their own trademark or grant permission to others to use it. Unauthorized use of a trademark by others without the owner's permission is considered trademark infringement. Article 83 of the Trademark and Geographical Indications Law regulates that trademark infringement is the act of another party using a trademark that is identical or similar to a registered trademark on similar products without proper authorization. Based on the Trademark and Geographical Indications Law, the trademark owner can file a trademark infringement lawsuit at the Commercial Court in accordance with Article 83 paragraph (3).

The trademark registration system in Indonesia is based on the principles of the first-to-file principle and the constitutive principle. The first-to-file principle states that an individual or legal entity becomes the owner of a trademark when they are the first to register a particular trademark.<sup>23</sup> The constitutive principle stipulates that the trademark owner will acquire rights to their trademark once the trademark is

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<sup>23</sup> Khoirul Hidayah, *Hukum HKI...*, *Op.Cit*, p. 62

registered.<sup>24</sup> This principle is regulated in Article 3 of the Trademark and Geographical Indications Law, which states that trademark rights are obtained after the trademark is registered.

PT Terbit Financial Technology has registered the "GOTO" trademark under class 42 with registration number IDM000858218 on May 25, 2021. The protection of the "GOTO" trademark owned by PT Terbit Financial Technology started on March 10, 2020, and will expire on March 10, 2030.<sup>25</sup> Meanwhile, PT GoTo Gojek Tokopedia has registered the trademark "GOTO" under class code 42 with registration number IDM000936923 on December 27, 2021. The protection of the "GOTO" trademark owned by PT GoTo Gojek Tokopedia started on March 6, 2021, until March 6, 2031.<sup>26</sup>

Both "GOTO" trademarks are in the same class code 42. According to the Nice Agreement, class code 42 stipulates:

Class 42 includes mainly services provided by persons in relation to the theoretical and practical aspects of complex fields of activities, for example, scientific laboratory services, engineering, computer programming, architectural services, or interior design.

In Indonesia, the trademark registration system is based on the First-to-File principle and the constitutional system. The dispute over ownership rights to the "GOTO" trademark is within the territorial jurisdiction of the Republic of Indonesia, and therefore, ownership of the trademark is based on the first-to-file principle. The rightful owner of the trademark is PT Terbit Financial Technology. This can be proven based on the information from the official website of the Intellectual Property Database of the Directorate General of Intellectual Property, Ministry of Law and Human Rights of the Republic of Indonesia (*Pangkalan Data Kekayaan Intelektual milik Direktorat Jenderal Kekayaan Intelektual Kementerian Hukum dan Hak Asasi Manusia*

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<sup>24</sup> *Ibid.*

<sup>25</sup> <https://pdki-indonesia.dgip.go.id/detail/IPT2020018216?type=trademark&keyword=goto>, accessed on March 16, 2023

<sup>26</sup> <https://pdki-indonesia.dgip.go.id/detail/IPT2021032527?type=trademark&keyword=goto>, accessed on March 16, 2023

*Republik Indonesia*, PDKI DJKI Kemenkumham). Here is a comparison based on the dates of trademark registration:

(20) RI Permohonan Merek		
(19) ID	(11) No Pengumuman : BRM2015A	(13) A
(21) No. Permohonan : IPT2020018216	(71) Nama dan Alamat yang mengajukan permohonan merek PT. TERBIT FINANCIAL TECHNOLOGY	
(22) Tanggal Penerimaan Permohonan : 2020-03-10	(74) Nama Dan Alamat Konsultan	
(43) Tanggal Pengumuman : 2020-03-23		
(54) Nama merek : GOTO		
(57) Translasi : Tidak Ada Terjemahan		

Source: Ministry of Law and Human Rights *cq* Directorate General of Intellectual Property

### **Picture 3 Trademark Application of PT Terbit Financial Technology**

(20) RI Permohonan Merek		
(19) ID	(11) No Pengumuman : BRM2113A	(13) A
(21) No. Permohonan : IPT2021032527	(71) Nama dan Alamat yang mengajukan permohonan merek PT GoTo Gojek Tokopedia	
(22) Tanggal Penerimaan Permohonan : 2021-03-05	(74) Nama Dan Alamat Konsultan Risti Wulansari S.H., KMO Building, Floor 05 Suite 502 Jalan Kyai Maja No 1 RT03/RW08	
(43) Tanggal Pengumuman : 2021-03-17		
(54) Nama merek : GOTO		
(57) Translasi :		

Source: Ministry of Law and Human Rights *cq* Directorate General of Intellectual Property

### **Picture 4 Trademark Application of PT GoTo Gojek Tokopedia**

That being the case, based on the indicated registration dates and in accordance with the underlying principle of the trademark registration system (first-to-file), PT Terbit Financial Technology is the rightful owner of the trademark.

The first-to-file principle is the underlying principle of the trademark registration system in Indonesia. Therefore, the role of DJKI in accepting trademark registrations should closely adhere to this principle. This ensures that there are no identical



trademarks in the same class. For example, prior to this case, if DJKI had enforced the first-to-file principle, the "GOTO" trademark owned by PT GoTo Gojek Tokopedia would not exist. However, in this case, there are two identical trademarks in the same class, which causes financial harm to the rightful trademark owner, PT Terbit Financial Technology, owing to the definition of trademark rights is the exclusive right held by the trademark owner. Therefore, the existence of two "GOTO" trademarks in the same class disregards the exclusive rights of PT Terbit Financial Technology.

The use of the first-to-file principle and the constitutive principle is actually intended to provide legal certainty.<sup>27</sup> Therefore, if the first-to-file principle is properly enforced, the "GOTO" trademark applied for by PT GoTo Gojek Tokopedia should not exist and should not be registered. However, due to the violation of both principles, it leads to the decline of legal certainty, albeit it serves as the purpose of implementing these principles. This creates a domino effect in the future, as it could turn into a boomerang if disputes over ownership of similar trademarks arise by the reason of the legal certainty and guarantee of ownership rights to a trademarks becomes blurred and unclear. The objective of the Trademark Law to achieve legal certainty is regulated in the Legal Considerations of the Trademark Law and in the General Explanation of the Trademark Law.

Article 20 and Article 21 of the Trademark Law stipulate that a trademark cannot be registered if it contradicts the prevailing laws and regulations in Indonesia. This means that the trademark to be registered must not have any similarity, both in substance and as a whole, with a registered trademark. In principle, the registration of a trademark should not cause confusion or deception. The registration of a trademark that causes confusion and deception can result in its nullification. The nullification can be carried out based on Article 76 and Article 77 of the Trademark Law.<sup>28</sup>

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<sup>27</sup> Sudargo Gautama, *Hak Merek Indonesia*, Alumni, Bandung, 1977, p. 71

<sup>28</sup> Khoirul Hidayah, *Hukum HKL...*, *Op.Cit.*, p. 63

## CONCLUSION

Legal protection for PT Terbit Financial Technology as the owner of the "GOTO" trademark has not been properly enforced. The rights to trademarks in Indonesia are regulated by Law Number 20 of 2016 on Trademarks and Geographical Indications. However, the owner of the "GOTO" trademark did not receive legal protection, even though clear regulations have been established to ensure legal certainty. In reality, the enforcement of these rules has not been carried out correctly. Violation of the first-to-file principle occurs due to the acceptance of new trademark registrations that are similar and fall within the same class as previously registered trademarks. The first-to-file principle is intended as a preventive protection for trademark owners. This principle should be enforced during the trademark registration application process to prevent disputes over ownership rights due to the existence of trademarks that are similar to previously officially registered trademarks.

The existence of two "GOTO" trademarks in the same class is a clear violation of the first-to-file principle, which is the basis for trademark protection. Therefore, the violation of the first-to-file principle must have consequences. When a claim is filed by a concerned and well-intentioned party regarding trademark infringement or trademark cancellation, the judge must decisively rule that once a trademark has been officially registered and certified, any subsequent identical trademark applications within the same class can be invalidated through legal proceedings under the Trademark Law. Furthermore, the competent institution responsible for processing trademark registration applications should no longer accept applications for identical trademarks within the same class as previously officially registered trademarks. Regarding the ownership of the "GOTO" trademark by PT Terbit Financial Technology, the judge must provide legal certainty by firmly acknowledging the violation of the first-to-file principle and granting the cancellation of the new trademark that is similar to the registered trademark. Therefore, the other "GOTO" trademark registered after the "GOTO" trademark owned by PT Terbit Financial Technology must have its ownership rights revoked.

Based on the above conclusions, the following recommendations can be given regarding the issue:

1. PT Terbit Financial Technology can seek the restoration of its trademark ownership rights. This can be done by filing a trademark infringement lawsuit against PT GoTo Gojek Tokopedia in the Commercial Court, taking into account the following notes:
  - a. The claim for damages should be written in a detailed and specific manner;
  - b. The content of the lawsuit should be revised, separating the trademark infringement claim from the trademark refusal request, as these fall under the jurisdiction of different institutions.
2. To prevent similar incidents, the related authorities responsible for processing trademark registration applications should be diligent and conduct detailed examinations to ensure that no identical trademarks exist within the same class. Additionally, the relevant authorities must pay close attention to Article 20 letter e and Article 21 paragraph (1) letter a of the Trademark Law to prevent future disputes over trademark ownership, such as in the "GOTO" case.
3. Harmonious cooperation is needed between the government, adequate regulations, the Directorate General of Intellectual Property, law enforcement agencies, the general public (with information about trademark violations), and business owners who intend to use specific trademarks for their products. This will ensure that the first-to-file registration system operates effectively, creating harmony, fairness, and benefit for all parties involved.

## **COMPETING INTEREST**

There is no conflict of interest in the publication of this article

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