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Analysis of the First to File System in Trademark Registration: Implications for Bad Faith Cases (Study of Court Decision No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Smg)

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ABSTRACT

This study aims to analyze the application of the first to file principle in trademark disputes involving elements of bad faith and to examine the judicial reasoning in Decision Number 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang. The Indonesian trademark law adopts a constitutive registration system that grants exclusive rights to the party who first registers the mark. Although this system ensures legal certainty, it also creates the potential for abuse through registrations made in bad faith. This research employs a normative legal method using statutory, case, and conceptual approaches. The legal materials consist of statutory regulations, court decisions, legal doctrines, and scholarly literature, which are analyzed qualitatively through systematic and argumentative interpretation. The findings demonstrate that the first to file principle remains relevant as the foundation of trademark protection; however, its application is not absolute. The court did not rely solely on formal registration status but also assessed substantive elements such as bad faith, similarity in essential elements, and prior factual use of the mark in commerce. This study proposes an integrative model that maintains the first to file system as the primary framework while incorporating elements of first to use as a corrective mechanism in assessing bad faith, thereby promoting a balance between legal certainty and substantive justice.

1. INTRODUCTION

The trademark registration system in Indonesia adheres to the first to file principle, which grants exclusive rights to the party that first registers its trademark with the state (Indrawati, 2023). This principle establishes registration

as a constitutive requirement for the creation of trademark rights, such that legal protection is granted based on valid administrative formalities. This system aims to create legal certainty in commercial transactions and provide protection for owners of registered trademarks.

However, the application of the "first to file" principle is not without the potential for abuse (Oscar & Soesatyo, 2025). In practice, there are parties who register trademarks not for the purpose of fair use, but rather to capitalize on another party's reputation or to hinder those who have been using the trademark first. Such practices are known as bad-faith trademark registration, which, over time, has created a tension between legal certainty and substantive justice (Yulia et al., 2024).

This issue is relevant to examine in Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang, which addressed a trademark dispute involving allegations of bad faith in the registration. This decision is noteworthy because the panel of judges did not rely solely on the formal aspects of registration but also assessed the context of trademark use, the essential similarity of the marks, and indications of bad faith on the part of the registrant.

Based on this background, this study examines two main issues: (1) how the "first to file" principle is applied in Indonesia's trademark legal system and the potential for its abuse; and (2) how the judges' legal reasoning in Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang assessed the element of bad faith in trademark disputes. This study aims to analyze the balance between legal certainty and justice in the application of the "first to file" principle, as well as to provide a conceptual contribution to the development of trademark law doctrine in Indonesia.

2. RESEARCH METHOD

This study is a normative legal study focusing on the analysis of positive legal norms, legal doctrine, and court decisions related to the application of the "first to file" principle in trademark disputes. The approaches used include the statutory approach, the case approach, and the conceptual approach (Gunardi, 2022).

The statutory approach is used to examine the provisions of Law No. 20 of 2016 on Trademarks and Geographical Indications along with other relevant

regulations. The case approach involves a thorough analysis of Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang as the primary subject of the study. Meanwhile, the conceptual approach is used to understand the concepts of legal certainty, justice, and the doctrine of bad faith in trademark law.

The legal materials used consist of primary legal materials in the form of legislation and court decisions (Armia, 2022), as well as secondary legal materials in the form of books, scientific journals, and expert opinions

(Nugroho et al., 2020). All legal materials were analyzed qualitatively through systematic and argumentative interpretation to arrive at conclusions relevant to the research questions.

3. RESULT AND DISCUSSION

3.1 The First to File System and Its Potential for Abuse

The first to file principle is a foundational system in Indonesian trademark law that grants exclusive rights to the party that first registers its trademark (Nathania, 2025). This system establishes registration as the basis for the creation of rights, so the state provides legal protection to the holder of a registered trademark without considering who first used the trademark in commercial practice.

Theoretically, this system provides legal certainty because trademark rights can be verified through administrative data recorded at the Directorate General of Intellectual Property. Such certainty is crucial for fostering stability in commercial transactions and preventing protracted disputes arising from claims of use without registration.

However, the first to file system also opens the door to trademark registrations made in bad faith. This loophole arises when a party registers a trademark that is already known or used by another party with the intent to gain an advantage or hinder that party's business activities (Nathania, 2025). In such situations, an approach that is purely formal and administrative risks overlooking substantive fairness.

From the perspective of legal certainty and justice theory, the tension between certainty and justice is inevitable. Legal certainty demands consistency and formality, while justice requires protection for the party that has, in fact, used the trademark first and built its reputation.

3.2 Integration of the First to File Approach and First to Use Elements as a Corrective Mechanism

Although the first to file system remains relevant in ensuring legal certainty, this study proposes an integrative approach as a corrective mechanism against potential abuse. This approach is not intended to replace the existing constitutive system, but rather to strengthen it by testing the element of factual use (first to use) in proving bad faith.

This integration can be applied during the evidentiary phase in court or within the administrative objection process. Where there are indications that a registration was made in bad faith, the history of trademark use, reputation, and evidence of prior commercial activity can serve as tools to assess the validity of the first applicant's claim.

Thus, the "first to file" system remains the foundation of legal certainty, while the factual use-based approach serves as a corrective instrument to ensure substantive justice. This integrative model creates a balance between administrative protection and the realities of commercial practice.

To clarify the operationalization of this integrative model, concrete parameters are needed to assess the element of factual use (first to use) as part of the bad faith test. These parameters serve as analytical tools, both in substantive examinations by the Directorate General of Intellectual Property and in the evidentiary process in court.

Some indicators that can be used include:

- Evidence of trademark use from the outset, such as product photos, packaging, promotional materials, social media, transaction records, or other marketing documents.
- The duration of trademark use prior to registration, which demonstrates consistency and sincerity in use.
- The brand's reputation and level of recognition among the public, both locally and nationally.
- The existence of legal or business relationships between the parties, such as distributors, resellers, business partners, or former employees, which allow access to another party's trademark.

- The motive for registration, particularly if there are indications that the registration is intended to imitate, hinder, or capitalize on the reputation of an existing brand.

With the presence of more structured indicators, the assessment of bad faith is no longer abstract but is based on and actual conditions on the ground. This approach strengthens the "first to file" system without altering its constitutive nature.

3.3 Analysis of Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang

a. Case Background

The dispute in Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang arose from the registration of a trademark that was substantially similar to a trademark previously used by another party in commercial activities. The plaintiff argued that the registration filed by the defendant involved bad faith, as the trademark had already been used and recognized in business practice.

On the other hand, the defendant based its claim on the "first to file" principle, arguing that the registration accepted and recorded by the Directorate General of Intellectual Property grants legally valid exclusive rights. The dispute then centered on the question of whether the mere formality of registration is sufficient to provide legal protection, or whether further examination of the element of good faith in the registration process is necessary.

b. The Court's Legal Rationale

In its deliberations, the panel of judges did not rely solely on the formal aspects of trademark registration but also assessed indications of bad faith in the registration process. The judges considered the substantial similarity between the two trademarks, the context of use within the same business sector, and the fact that the trademark had been used earlier by the plaintiff.

This approach demonstrates that the "first to file" principle is not applied absolutely. The judges conducted a substantive assessment by examining prior usage facts as part of the evidence of bad faith. Thus, administrative formalities

do not automatically override the factual reality of actual use in the field (Alexander, 2022).

This consideration reflects an effort to balance legal certainty with substantive justice. Legal certainty is still respected through recognition of the registration system, yet justice is upheld through an examination of the motives and context of trademark registration.

c. Relevance of the Ruling to the Integrative Model

This decision implicitly indicates that the "first to file" system, in practice, has accommodated the element of actual use ("first to use") in assessing bad faith. Although Indonesia normatively adheres to a constitutive system, the court still considers evidence of prior use as a key factor in evaluating the validity of the registration.

These findings reinforce the argument that integrating the "first to file" approach with elements of "first to use" does not constitute a systemic change, but rather strengthens corrective mechanisms against the abuse of rights. Thus, a balance between legal certainty and justice can be achieved without altering the fundamental structure of the trademark registration system in Indonesia.

The integrative model proposed in this study offers a conceptual contribution in the form of an argumentative reconstruction of the application of the first to file principle, ensuring it is not understood merely in formalistic terms but also takes into account the ethical and factual dimensions in commercial practice.

3.4 Implications for the Trademark Registration System in Indonesia

Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang demonstrates that the application of the "first to file" principle in judicial practice is not interpreted rigidly or formalistically. Although the constitutive system remains the foundation of trademark protection in Indonesia, judges still allow room to assess factual aspects of use and indications of bad faith as part of the evidentiary process.

The implication of this approach is a strengthening of the substantive dimension in the resolution of trademark disputes. The registration system continues to provide legal certainty through administrative mechanisms, yet it

does not preclude the possibility of correction through an examination of the element of good faith. This demonstrates that trademark protection does not rely solely on the formalities of registration but also on integrity and honesty in the process of acquiring such rights (Yulia, 2021).

Normatively, an integrative approach combining the "first to file" and "first to use" elements can serve as a corrective mechanism without altering the underlying constitutive system. This model functions as a filter against opportunistic registration practices while maintaining the legal stability established through the administrative registration system.

Thus, strengthening the mechanism for testing bad faith—both during the substantive examination stage at the Directorate General of Intellectual Property and in judicial proceedings—is crucial to ensuring a balance between legal certainty and justice. The integrative model proposed in this study contributes to the development of trademark law doctrine by establishing the "first to file" principle as its foundation and utilizing factual evidence as a tool for both ethical and substantive scrutiny.

4. CONCLUSION

The application of the "first to file" principle in Indonesia's trademark legal system remains relevant as the primary instrument for ensuring legal certainty. A constitutive system that treats registration as the basis for the creation of rights provides stability and clarity in trademark protection. However, this system is not absolute and is susceptible to abuse through registrations containing elements of bad faith.

An analysis of Judgment No. 3/Pdt.Sus-HKI-Merek/2024/PN Niaga Semarang indicates that the judge did not apply the "first to file" principle in a formalistic manner but instead conducted a substantive review of indications of bad faith and considered the factual use of the trademark in commercial practice. This approach reflects an effort to balance legal certainty with justice.

This study proposes an integrative model combining the "first to file" principle and the "first to use" element as a corrective mechanism in trademark dispute resolution. This model does not replace the existing constitutive system but strengthens it with an evaluative instrument regarding the motives and context of registration. This conceptual contribution provides a direction for the

development of trademark legal doctrine that is more adaptive to the dynamics of commercial practice without sacrificing legal certainty.

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