Date	June 27, 2012	Court	Intellectual Property High Court, Second Division
Case number	2011 (Gyo-Ke) 10400		
– A case in which, with regard to a trademark consisting of the standard alphabetical characters, "Tarzan," the court ruled that the trademark falls under a trademark which is likely to cause damage to public policy (Article 4, paragraph (1), item (vii) of the Trademark Act) as one that goes against international good faith and disturbs fair transaction order, though it cannot be said that the registration of the trademark is an act of plagiarism based on a wrongful intention to take advantage of the image and power of "Tarzan" to attract customers			

References:
Article 4, paragraph (1), item (vii) of the Trademark Act

1. Background

This case is a lawsuit to seek rescission of a decision of the Japan Patent Office (JPO) that dismissed a request for a trial for invalidation of a trademark registration. The point at issue is whether the trademark is likely to cause damage to public policy (Article 4, paragraph (1), item (vii) of the Trademark Act). The trademark (Registration No. 5338569) consists of the standard alphabetical characters, "Tarzan," and the designated goods are "plastic processing machines and apparatus, automatic removal robots for plastic molding machines, and chucks (machine parts)" in class 7. The filing date is January 20, 2010, and the date of the decision of registration is July 6, 2010. The date of registration is July 16, 2010. The defendant was the holder of the trademark right until it cancelled the registration on February 13, 2012, after the institution of this lawsuit.

2. Summary of the court decision

(1) Error in finding the well-knownness of "Tarzan (ターザン)"

"ターザン (Tarzan)" is the name of the leading character in a series of novels published by a U.S. author, Edgar Rice Burroughs (1875-1950), in 1912 and thereafter, entitled the "Tarzan Series" (26 volumes in total), and there are many derivative works, including films, in which "ターザン" appears as the leading character. It is recognized that "ターザン(Tarzan)" came to have a worldwide profile owing to its film adaptation by Hollywood in the 1930s, particularly, due to the popularity of films in which a swimmer, Johnny Weissmuller, played the lead, and that, though the heyday of "ターザン" films was the 1930s, in 1962, when the original novels, for which the copyrights expired, were published in paperback, they became huge hits, causing a second boom in popularity of "ターザン."

However, in light of the facts that the original novels had been written or published before 1950, when Burroughs died, and that the films starring Weissmuller, which served as a driving force for "ターザン" acquiring a worldwide profile, were shown until 1950 in Japan and subsequent live-action films were released before 1970 in a concentrated manner, it is recognized that "ターザン" had gradually become less popular in Japan since the 1970s and that there had been less opportunities for the original novels of "ターザン" or their derivative works and tie-up goods, etc. to widely catch people's eyes at the time of the decision of registration of the trademark (July 6, 2010), even taking into account that an animation film, "ターザン," made by Walt Disney Company became a hit in Japan in 1999.

What the word, "ターザン," evoked in Japan at the time of the decision of registration of the trademark is a vague image, that is, the image of a man (young man) who flits in a jungle with the use of an ivy vine while giving shouts, though it is considered that there is a certain generation difference. It cannot be said that the word "ターザン" was common to ordinary people, apart from enthusiastic devotees and researchers, to the extent that it evokes the fact that it is the title or the name of the leading character of novels written by a U.S. author, Burroughs, entitled the "Tarzan Series," as well as a specific character (feature and personality), that is, a person who was brought up by anthropoids in a jungle in Africa despite his origin, descended from a British noble, and came to reign as the king of the jungle after he grew up. Therefore, it cannot be said that the finding and determination in the JPO decision are erroneous in terms of the well-knownness of "Tarzan (ターザン)."

(2) Error in the determination that the trademark does not go against public policy

It can be recognized that the word "ターザン" had certain power to attract customers. However, it is hard to recognize that the word "ターザン" has the power to attract customers that can be economically evaluated to a certain extent in the field of goods that are not for general consumers like the designated goods of the trademark, setting aside cases in connection with goods and services that have direct contact with general consumers, such as films and TV broadcasts. In addition, at the time of the decision of registration of the trademark (July 6, 2010), the image evoked by the word "ターザン" had already become considerably vague, as mentioned above. In that case, even if the defendant obtained the trademark registration, anticipating using the word "ターザン" as the name of a resin molding removal robot manufactured by the defendant by identifying the image of Tarzan (ターザン), that is, a man (young man) who flits in a jungle with the use of an ivy vine while giving shouts, with the movement of said robot, that cannot be said to be an act of plagiarism based on a

wrongful intention to take advantage of the image and power of "ターザン" to attract customers.

However, although it is not widely known in Japan, a unique coined word, "ターザン," is consistently described as the name of an imaginary person with a specific character in novels, films, and dramas worldwide, mainly in the United States, and the word "ターザン" is not recognized as evoking any other concept, not only in Japanese but also in other languages. Taking this into consideration, maintaining the registration of the trademark consisting solely of the word "ターザン" should be considered as going against international good faith even if the word "ターザン" does not have the power to attract customers in connection with the designated goods.

The duration of copyrights for the novels, the "Tarzan Series," was left until May 22, 2011, in Japan. The plaintiff, which took over the rights for all books of the "Tarzan Series" from Burroughs, has made efforts to preserve and maintain the value of the original novels of "ターザン" and derivative works thereof and has also made efforts to maintain and manage the commercial value thereof by registering and holding trademarks for "ターザン" not only in the United States but also around the world and by engaging in the conclusion and management of related license agreements. Taking into account that renewal of a trademark registration is easily permitted and that the right therefor can continue semi-permanently, the following situation can hardly be deemed reasonable from the perspective of maintenance of fair transaction order: Under circumstances where the copyright for the original novel which created a mark and character that have certain value subsists and there is an organization which has made efforts to maintain and manage its cultural and economic value, a third party which is not related to the aforementioned copyright management organization, etc. files the earliest trademark application and consequently becomes able to exclusively use the trademark in connection with specific designated goods or designated services and to exclude use by the aforementioned copyright management organization. As the defendant has not engaged in the maintenance of the cultural and commercial value of the word "ターザン" at all, it is not reasonable to permit the defendant to exclusively use the word "ターザン," even in connection with limited goods, i.e. designated goods. Therefore, the trademark registration can be said to be an act of disturbing fair transaction order and causing damage to public policy."

3. Essential points of the reasons for the JPO decision

It can be said that the word "Tarzan (ターザン)" is recognized as a vague image of the king of the jungle to a certain extent among consumers in Japan today. However, it cannot be recognized that the word was widely recognized as the title or the name of a

character of a work written by Burroughs, a U.S. author, or as a mark managed by the plaintiff, at the time of the decision of registration of the trademark.

Moreover, no circumstance is recognized where the United States or a U.S. public organization, etc. has engaged in the management, etc. of the name in a close and inseparable manner beyond the fact that the word (characters) "Tarzan (ターザン)" is the title or the name of a character of a work written by Burroughs and is a mark managed by the demandant. As an issue over the attribution, etc. of a trademark right between the holder of the trademark right (defendant) and one who asserts that he/she should by nature receive the trademark registration (plaintiff) should be absolutely solved as a private issue between the parties concerned, it is not reasonable to understand such a case as an exceptional case in which there are special circumstances in relation to the likelihood of causing damage to public policy. The trademark is not recognized as one that insults the United States or U.S. citizens or goes against international good faith in general, nor can it be said that the developments of filing an application for registration of the trademark lack social validity and the registration can never be permitted as one that goes against the order predetermined by the Trademark Act. Therefore, the trademark does not fall under Article 4, paragraph (1), item (vii) of the Trademark Act.

Judgment rendered on June 27, 2012
2011 (Gyo-Ke) 10400, Case of Seeking Rescission of a JPO Decision
Date of conclusion of oral argument: May 14, 2012

Judgment

Plaintiff: Edgar Rice Burroughs, Inc.
Counsel attorney: HORIGOME Yoshinori
Patent attorney: HOSAKA Michiko
MURAKAMI Koichi
Defendant: Star Seiki Co., Ltd.
Counsel patent attorney: ITO Kenichi

Main Text

The JPO decision rendered regarding Invalidation Trial No. 2011-890014 on July 28, 2011 shall be rescinded.
The defendant shall bear the court costs.

Facts and reasons

No. 1 Judicial decision sought by the plaintiff
The same as the main text of this judgment.
No. 2 Background

This is an action to seek rescission of a JPO decision that dismissed a request for a trial for invalidation of a trademark registration. The issue is whether the trademark in question (the "Trademark") is likely to cause damage to public policy (Article 4, paragraph (1), item (vii) of the Trademark Act; hereinafter "item (vii)" refers to Article 4, paragraph (1), item (vii) of the Trademark Act).

1. The Trademark and development of the procedure

(1) The defendant had been the holder of the trademark right in question (the "Trademark Right") until it cancelled the registration thereof on February 13, 2012 after this action was instituted.

[The Trademark]
Tarzan (standard characters)
▪ Registration No. 5338569
▪ Designated goods
Class 7: Plastic processing machines and apparatus, automatic removal robots for plastic molding machines, and chucks (machine parts)
▪ Filing date: January 20, 2010

▪ Date of the examiner's decision of trademark registration: July 6, 2010
▪ Registration date: July 16, 2010
(2) The plaintiff filed a request for a trial for invalidation of a trademark registration (Invalidation Trial No. 2011-890014; the "Trial") in relation to the Trademark on February 4, 2011. The JPO rendered a decision dismissing said request on July 28, 2011, and a transcript thereof was served to the plaintiff on August 5, 2011 (an addition of 90 days to the statute of limitations for filing an action).
(3) In the Trial, the plaintiff alleged that the Trademark falls under item (vii). As reasons therefor, the plaintiff alleged as follows: The defendant is presumptively recognized as having obtained the trademark registration in question (the "Trademark Registration") for the purpose of exclusively using the word "Tarzan" permanently based on the Trademark Right though it had recognized that "ターザン (Tarzan)" is a famous name of a character in novels, films, etc., who is a world-famous character that can also be said to be a symbol of the United States, at the time when the examiner's decision of trademark registration was rendered for the Trademark (the "Time of the Examiner's Decision of Trademark Registration"); such act goes against international good faith and is not permissible; in addition, the defendant is presumptively recognized as having obtained the Trademark Registration for the purpose of exclusively using the word "Tarzan" permanently based on the Trademark Right without the plaintiff's permission though it had also recognized that significant economic value as a mark was embodied in the word "ターザン (Tarzan)" at the Time of the Examiner's Decision of Trademark Registration owing to the plaintiff's efforts; such act disturbs fair transaction order and is not permissible; therefore, the Trademark is a trademark that causes a damage to public policy
2. Essential points of the reasons for the JPO decision

Even if it can be said that the word "Tarzan" is recognized as a vague image of the king of a jungle to a certain extent among consumers in Japan today, it cannot be recognized that the word had been well known as the title or the name of a character of works written by Burroughs, a U.S. author, or as a mark managed by the plaintiff, at the Time of the Examiner's Decision of Trademark Registration.

Moreover, there are also no circumstances where the United States or a U.S. public organization, etc. has engaged in the management, etc. of the name in a close and inseparable manner other than the fact that the word (characters) "Tarzan" is the title or the name of a character of works written by Burroughs and is a mark managed by the demandant.

The plaintiff holds 44 trademark rights for "Tarzan," "ターザン," and trademarks

containing these words in part in Japan, but has no trademark right in relation to class 7, which is the class of goods or services of the designated goods of the Trademark. It must be said that the plaintiff failed to file an application for trademark registration in relation to the goods in class 7 despite the fact that the plaintiff had sufficient room for filing such an application. In such a case, an issue over the attribution, etc. of the Trademark Right between the holder of the Trademark Right (defendant) and a person who alleges that he/she should originally receive the Trademark Registration (plaintiff) should be solved absolutely as a private issue between the parties. Therefore, it is not reasonable to understand such a case to be an exceptional case where there are special circumstances in relation to the likelihood of causing damage to public policy.

In that case, the Trademark is not recognized as one that insults the United States or U.S. citizens or goes against international good faith in general, nor can it be said that the developments of filing an application for trademark registration for the Trademark lack social validity and the registration can never be permitted as one that goes against the order predetermined by the Trademark Act.

Therefore, the Trademark does not fall under item (vii).

(omitted)

No. 5 Court decision

1. Regarding basic facts in relation to "Tarzan"

According to pieces of evidence (written in each item) and entire import of argument, the following facts can be found.

(1) Novels titled the "Tarzan Series"

"Tarzan" is the name of the leading character in a series of novels titled the "Tarzan Series" (26 volumes in total), which was created by a U.S. author, Edgar Rice Burroughs (1875 to 1950) and was published in 1912 and thereafter (*Kōjien, sixth edition [Exhibit Ko No. 7], Digital Daijisen [Exhibit Ko No. 8], and Encyclopedia Nipponica (Japonica) [Exhibit Ko No. 9]*). All of the works constituting the "Tarzan Series" are stories about the leading character "Tarzan," who was brought up by anthropoids in a jungle in Africa despite his origin as a descendant of a British noble, and became the king of the jungle after he grew up (Exhibits Ko No. 5 and No. 9). The leading character "Tarzan" is not an actual person but an imaginary person created by Burroughs. "Tarzan" is a coined word made based on words in an imaginary monkey language used in the novels, "Zan" (which means skin) and "Tar" (which means white) (Exhibit Ko No. 85).

The works of the "Tarzan Series" were translated into about 30 languages by the 1950s, and were read by people in over about 50 countries. Over 100,000,000 copies were sold between 1912 and 1947. In the United States, about 10,000,000 copies were sold in a year around 1962 (Exhibits Ko No. 14 to No. 16). In Japan, translations of the works of the "Tarzan Series" were published by multiple publishers between 1921 and 2000, and about 56 books were published as the translated versions of the works of the "Tarzan Series" (Exhibits Ko No. 17 to No. 19; including the branch numbers thereof).

(2) Duration of copyrights

The copyrights for the novels of the "Tarzan Series" in Japan had continued to subsist up to May 22, 2011, which is the day on which 50 years and 3,794 days (wartime addition) passed from January 1, 1951: a year following the year to which the date of death of Burroughs belongs.

(3) The plaintiff and its activities

Burroughs established the plaintiff on March 24, 1923, and transferred his rights for all books of the "Tarzan Series" to the plaintiff based on a contract dated April 2, 1923. Since then, the plaintiff has managed these rights (Exhibit Ko No. 78; entire import of argument).

The plaintiff provides and explains all sorts of works relating to Tarzan and the accomplishment of Burroughs via its official website, and also conducts the management, etc. of a fan club. The plaintiff also prepares and provides an online archive which stores all works relating to Burroughs, such as the novels of the "Tarzan Series" and other novels, pulp magazines, films, radiocasted works, televised works, and comics, on the aforementioned official website. This archive stores works produced and released over 100 years in Japan and abroad as encyclopedically as possible (Exhibits Ko No. 73 to No. 75; entire import of argument).

As of January 31, 2011, the plaintiff holds 44 registered trademark rights in relation to "Tarzan," "ターザン," or trademarks containing these words in part in Japan. In addition, as of January 2012, the plaintiff holds hundreds of trademark rights in about 80 countries and areas, including the United States as well as Japan (Exhibits Ko No. 4, No. 79, and No. 80-1 to No. 80-5).

(4) Derivative works of "Tarzan"

A. Comics

Short comics about "Tarzan" to be serialized in a newspaper, which are based on the novels of the "Tarzan Series," were placed or replaced in a newspaper in the United States during the period from 1929 to around 2000. In addition, placement of comics about "Tarzan" in comic magazines started with publication of a comic magazine titled

"Tarzan" by Western Publishing (1947). Multiple publishers have published comic magazines relating to "Tarzan" up to the present date. At present, Dark Horse Comics in the United States continues to sell such a comic magazine. In Japan, the Japanese version thereof was published in the 1970s (Exhibits Ko No. 20 to No. 23).

B. Stage drama and radiocast

"Tarzan" was performed as a stage drama in 1921, and its radio drama was radiocasted in 1931 (Exhibit Ko No. 24).

C. Theatrical live-action films

Forty three theatrical live-action films were produced during the period from 1918 to 1999, and 39 thereof were released at theaters in Japan during the period from 1919 to 1984 (Exhibits Ko No. 25 and No. 27).

D. Works for television broadcasting (live-action versions)

Five works for television broadcasting (live-action versions) were produced between 1966 and 2003, three of which were televised in Japan by around 2000 (Exhibits Ko No. 25, No. 28-1, and No. 28-3).

E. Animation works

Five animation works relating to Tarzan were produced during the period from 1976 to 2005. One of them was a TV animation series, and the remaining four were animation works produced by the Walt Disney Company ("Disney"), one of which was for theatrical screening, another one was a TV animation series, and the remaining two were original animation works for DVD (Exhibits Ko No. 25, No. 27, No. 28-2, and No. 31).

Out of the aforementioned works produced by Disney, a theoretical animation film "Tarzan" (Japanese title: "ターザン"), which was produced in 1999 with the license from the plaintiff, was released in about 40 countries, including Japan. It became a hit in the United States, and also became a hit in Japan, making about 2,900,000,000 yen at the box office in Japan (Exhibits Ko No. 41 to No. 44).

F. Upcoming Tarzan films

It was reported in August 2010 on the website that Constantin Film in Germany acquired the right to cinematize a Tarzan story from the plaintiff and is carrying forward production of a three-dimensional Tarzan animation film toward releasing it in 2012, a year marking the 100th anniversary of the birth of Tarzan. In addition, it was also reported in June 2011 on the website that Warner Bros. Entertainment Inc. in the United States would produce a new trilogy of Tarzan films (Exhibits Ko No. 63 and No. 92).

(5) License contracts concerning "Tarzan"

Disney continuously provides various goods and services tied up with Tarzan based

on the license it obtained from the plaintiff. The plaintiff has continuously received payment of royalties from Disney since April 2000 up to the present, and the total amount of the royalties is over 4,000,000 U.S. dollars (Exhibits Ko No. 86-1 and No. 86-2).

Since 1984, for "Tarzan," the plaintiff has granted 21 licenses in total to 12 companies in total in Japan. For example, the plaintiff concluded a license contract concerning a magazine "Tarzan" with Magazine House, Ltd., and also concluded a license contract concerning underwear and casual shoes, etc. with Sumikin Bussan Corporation (Exhibit Ko No. 87).

(6) Other

A. Tarzana is a district in the San Fernando Valley area in Los Angeles, the United States. This area is located in the land that used to be a farm possessed by Burroughs (Burroughs named this farm Tarzana Ranch). Burroughs sold this land in lots for housing, and neighboring small farm households started to move to this area and the area developed as a residential street. In 1927, local residents changed the name of the town to "Tarzana," which means "Tarzan's town," in honor of Burroughs and Tarzan: a character in his works (Exhibits Ko No. 81 and No. 82).

B. It was reported in Asahi Shimbun dated April 2, 1988 that a bronze medal of Marilyn Monroe would go on sale on the 5th of the same month at department stores, etc. nationwide and that said medal was manufactured by Monnaie de Paris and the U.S. government as one of the medals in a series titled "Myth Today" together with those of James Dean and Tarzan (Exhibit Ko No. 69).

2. Regarding Ground for Rescission 1 (an error in the finding of well-knownness)

As found above, "ターザン (Tarzan)" is the name of the leading character in a series of novels titled the "Tarzan Series" (26 volumes in total), which were published by a U.S. author, Edgar Rice Burroughs (1875-1950), in 1912 and thereafter, and there are many derivative works, including films, in which "Tarzan" appears as the leading character. According to pieces of evidence (Exhibits Ko No. 6 [*Encyclopedia Nipponica*], No. 7 [*Kōjien, sixth edition*], No. 8 [*Digital Daijisen*], No. 9 [*Encyclopedia Nipponica*], and No. 93), it is found that "Tarzan" has come to have a worldwide profile owing to its film adaptation by Hollywood in the 1930s, particularly, due to the popularity of films in which a swimmer, Johnny Weissmuller, played the lead. The heyday of "Tarzan" films was the 1930s. However, when the original novels, for which the copyrights expired, were published in paperback in 1962, they became huge hits, causing a second boom in the popularity of "Tarzan" (Exhibit Ko No. 15; Shunsuke Kamei, *Amerikan hīrō no keifu* (Genealogy of American heroes) (November 10, 1993)

[Exhibit Ko No. 66]).

However, the original novels were written or published by 1950, a year in which Burroughs died. The films starring Weissmuller, which served as a driving force for "Tarzan" acquiring a worldwide profile, were released in 1948 in the United States and until 1950 in Japan. In addition, 41 out of 43 other theatrical live-action "Tarzan" films were released by 1968 in the United States or by 1970 in Japan in a concentrated manner. There were intervals between productions of subsequent live-action films, which were produced in 1981, 1983, and 1999. In addition, such type of theatrical live-action film was last released in 1984 in Japan. On that basis, it is recognized that "Tarzan" had gradually become less popular in Japan since the 1970s and that there were less opportunities for the original novels of "Tarzan" or their derivative works and tie-up goods, etc. to widely catch people's eyes at the Time of the Examiner's Decision of Trademark Registration (July 6, 2010), when over 10 years had passed since 1999 when the animation film produced by Disney became a hit, even taking the following facts into account: said animation film titled "Tarzan" became a hit in Japan in 1999; a drama series titled "Tarzan: The Epic Adventures" was broadcast on television by broadcasting satellite from 1999 to 2000, and a drama series titled "Tarzan" was broadcast on television by communications satellite broadcasting in 2010 (Exhibits Ko No. 30 and No. 50), and a few videos and DVDs were put on sale by 2005; and Disney has continuously provided various goods and services tied up with Tarzan.

What the word "Tarzan" evoked in Japan at the Time of the Examiner's Decision of Trademark Registration is a vague image, that is, the image of a man (young man) who swings in a jungle with the use of an ivy vine while shouting, though there seems to be a certain generation difference. It cannot be said that the word "ターザン (Tarzan)" was common to ordinary people, apart from enthusiastic devotees and researchers, to the extent that it evokes the fact that it is the title or the name of the leading character of the novels of the "Tarzan Series" written by a U.S. author, Burroughs, as well as a specific character (feature and personality), that is, a person who was brought up by anthropoids in a jungle in Africa despite his origin as a descendant of a British noble, and came to reign as the king of the jungle after he grew up. Therefore, it cannot be said that the JPO decision contains an error in its finding and determination as follows: "Although it can be said that the word "ターザン (Tarzan)" is recognized as a vague image of the king of a jungle to a certain extent among consumers in Japan today, it cannot be found that the word was well known as the title or the name of a character of works written by Burroughs, a U.S. author, or as a mark managed by the demandant (note in the judgment: the plaintiff), at the Time of the Examiner's Decision of Trademark

Registration."

3. Regarding Ground for Rescission 2 (an error in the determination to the effect that the Trademark does not go against public policy)

(1) As mentioned above, it can be found that the word "ターザン (Tarzan)" was recognized as a word that evokes the image of a man (young man) who swings in a jungle with the use of an ivy vine while shouting to a certain extent at the Time of the Examiner's Decision of Trademark Registration (July 6, 2010). Moreover, as found above, it can also be found that the word "Tarzan" had a certain degree of power to attract customers, taking into account the fact that the plaintiff has granted 21 licenses for "Tarzan" in total to 12 companies in total in Japan since 1984.

However, the word "ターザン (Tarzan)" has acquired a worldwide profile through film adaptation of the original novels, and the products covered by license contracts concerning "Tarzan" in Japan include magazines, casual shoes, underwear, and other apparel products, television broadcasting, books for children, and paperbacks (Exhibit Ko No. 87). Disney, which is a dominant licensee in the United States, is a company engaging in the business of managing amusement parks and producing and distributing films (entire import of argument). Taking these facts into account, the word "Tarzan" is hardly recognized as having the power to attract customers that can be economically evaluated to a certain extent in the field of goods that are not for general consumers, that is, "plastic processing machines and apparatus, automatic removal robots for plastic molding machines, and chucks (machine parts)," which are the designated goods of the Trademark, leaving aside goods and services that are directly for general consumers, such as books, apparel products, amusement parks, films, and television broadcasting. In addition, over 60 years had already passed since the death of Burroughs, the author of the original novels of "Tarzan," at the Time of the Examiner's Decision of Trademark Registration (July 6, 2010). Furthermore, "Tarzan" had gradually become less popular in Japan since the 1970s, and there were less opportunities for "Tarzan" to widely catch people's eyes at the Time of the Examiner's Decision of Trademark Registration (July 6, 2010), when over 10 years had passed since 1999 when the animation film produced by Disney became a hit. The image evoked by the word "Tarzan" had already become considerably vague as mentioned above. In that case, even if the defendant obtained the Trademark Registration on the assumption of using the word as the product name of a resin molding removal robot manufactured by the defendant by identifying the image of Tarzan, a man (young man) who swings in a jungle with the use of an ivy vine while shouting, with the movement of said robot, it cannot be regarded as an act of plagiarism based on a wrongful intention to take advantage of the image of "Tarzan" and its power

to attract customers.

The defendant is a stock company engaging in the business of manufacturing, selling or otherwise handling synthetic resin molding machines and its accessories. The defendant is recognized as having adopted "ターザン" as the name of its product based on a vague image which Japanese consumers have of "ターザン," based on the odd movements of a mechanism for removing resin molding in a resin molding removal robot which removes resin molding from the resin molding machine (entire import of argument).

(2) However, although it is not widely known in Japan, a unique coined word, "ターザン (Tarzan)," is consistently described as the name of an imaginary person with a specific character in novels, films, and dramas worldwide, mainly in the United States, and the word "ターザン (Tarzan)" is not recognized as evoking any other concept, not only in Japanese but also in other languages. Taking this into consideration, maintaining the Trademark Registration consisting solely of the word "ターザン (Tarzan)" in Japan should be considered as going against international good faith even if the word "ターザン (Tarzan)" has no power to attract customers in connection with the designated goods of the Trademark Registration.

The word "ターザン (Tarzan)" is the name of the leading character in a series of novels titled the "Tarzan Series," which were written by a U.S. author, Burroughs. At the Time of the Examiner's Decision of Trademark Registration (July 6, 2010), copyrights for the novels had subsisted in Japan, and copyrights for the derivative works thereof also continued to subsist. The plaintiff, which took over the rights for all books of the "Tarzan Series" from Burroughs, has made efforts to preserve and maintain the value of the original novels of "Tarzan" and derivative works thereof, for example, by preparing and providing an online archive that stores all works relating to Burroughs, such as novels, including those of the "Tarzan Series," pulp magazines, films, radiocasted works, televised works, and comics as well as by providing and explaining all sorts of works relating to Tarzan and the accomplishment of Burroughs via its official website. In addition, the plaintiff has made efforts to maintain and manage the commercial value thereof by registering and holding trademarks for "ターザン (Tarzan)" not only in the United States but also around the world and by engaging in the conclusion and management of related license contracts. Taking into account that a trademark registration can be easily renewed and that a trademark right can be maintained semi-permanently, the following situation is hardly regarded as reasonable from the perspective of maintenance of fair transaction order: under circumstances where copyrights for the original novels, which created marks and characters that have

certain value, subsist and there is an organization which has made efforts to maintain and manage the cultural and economic value thereof, a third party which is not related to the aforementioned copyright management organization files the earliest application for trademark registration and consequently becomes able to exclusively use the trademark in connection with specific designated goods or designated services and becomes able to exclude use by the aforementioned copyright management organization.

As the defendant has not engaged in the maintenance of the cultural and commercial value of the word "Tarzan" at all, it is not reasonable to permit the defendant to exclusively use the word "Tarzan" even in connection with limited goods, i.e. designated goods. Therefore, the Trademark Registration can be regarded as falling under an act of disturbing fair transaction order and causing damage to public policy.

(3) The court determines that the Trademark falls under Article 4, paragraph (1), item (vii) of the Trademark Act, comprehensively taking into account the aforementioned points.

No. 6 Conclusion

On these grounds, there is a reason for the plaintiff's claim. Therefore, the plaintiff's claim shall be upheld, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Second Division

Presiding judge: SHIOTSUKI Shuhei

Judge: MANABE Tomoko

Judge: TANABE Minoru