Date	June 27, 2012	Court	Intellectual Property High Court, Second Division
Case number	2011 (Gyo-Ke) 10399		
– A case in which, with regard to a trademark consisting of the standard katakana characters, "ターザン," 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. 5338568) consists of the standard katakana characters, "ターザン," 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.