

Latest Court Decisions

2012:
[June]

- **Tarzan Case (Cancellation Suit of Trial Decision)**

IP High Court 2012.6.27 H23(Gyo-Ke)10399,10400

The trademarks "Tarzan" in English and Katakana letters were registered by a Japanese company on July 16, 2010 under Nos. 5338568 and 5338569 with respect to "**plastic processing machines and apparatus, automatic extruding robots for plastic molding machines**" in Int'l Class 7.

A US company, Edgar Rise Burroughs Inc. (ERB), filed Invalidation Trials against the Japanese "Tarzan" trademark registrations according to Article 4-1-7 (Public order and morality) of the Trademark Law because the Japanese trademarks were registered against the international fidelity. Edgar Rise Burroughs Inc. is the copyright management company of the Tarzan novels.

The JPO dismissed the ERB's petitions with the following reasons.

- (1) Although the present Japanese consumers had a vague image that "Tarzan" was the King of Jungle, "Tarzan" was not well known at the time of filing the applications on January 20, 2010 as the title of the novels written by a US author, Edgar Rise Burroughs, or its hero's name, or a trademark managed by ERB.
- (2) ERB had 44 Japanese trademark registrations in various classes. However, it failed to file an application in Class 7 despite such an application was possible.
- (3) An issue as to who should be the real proprietor of the trademark was a personal issue and it should not be settled by Article 4-1-7.

The IP High Court cancelled the Trial Decision although the Court admitted the facts that "Tarzan" was not well known in Japan at the time of filing the applications and that the defendant had no unfair intention to get a free ride on the name of the "Tarzan".

However, the copyrights of the Tarzan novels are still valid and the plaintiff made efforts to maintain the commercial value of "Tarzan". Under the situation, if the defendant's trademark registrations were renewed, it could exclusively use "Tarzan" as its trademark almost permanently while the plaintiff would be prevented from using "Tarzan" as a trademark in the future. Such situation would be against the fair competitive order and the international fidelity. Therefore, the subject registrations should be invalidated according to Article 4-1-7 (Public order and morality) of the Trademark Law.

Usually, an Invalidation Trial can not be filed five years after the trademark registration date (Period of exclusion). However, an Invalidation Trial according to Article 4-1-7 (Public order and morality) can be filed even after five years from the registration date.

The "POPEYE" trademark registered in 1959 by a Japanese company was also invalidated in 1995 according to Article 4-1-7.