

EDGAR RICE BURROUGHS, INC.,
Opposer

IPC No. 14-1999-00029
Opposition to:

Serial No : 102037
Date Filed : 15 Aug. 1995
Trademark: "TARZAN"
Goods: Bubble Gum

-versus-
PHILIP SWEET MANUFACTURING CO.,
Respondent-Applicant.

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Decision No. 06-141

DECISION

Before this Bureau is an Opposition filed by Edgar Rice Burroughs, Inc., a corporation duly organized and existing under and by virtue of the laws of the State of California, with its principal offices located at 18354 Ventura Boulevard, Los Angeles, California, U.S.A., against the application Serial No. 102037 and filed on 15 August 1995 in the name of Philip Sweets Manufacturing Co.

The grounds for the opposition to the application for registration of the trademark TARZAN are as follows:

"1. Opposer is the successor to the late author, Edgar Rice Burroughs, the creator of the TARZAN character and is thus the owner of rights, in and to, the TARZAN literary character and properties related thereto, including the trademark TARZAN.

"2. The trademark TARZAN has been copied from and is identical to Opposer's trademark TARZAN, which was derived from its copyrights-protected pictorial character TARZAN, and which has been previously used and registered as a trademark and published as a pictorial character in the Philippines and other parts of the world, and not abandoned, as to be likely, when applied to or used in connection with the goods of applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"3. The registration of the trademark TARZAN in the name of applicant will violate Article 4 (1) and (2) of the Berne Convention, Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement to which the Philippines and the United States of America are parties.

"4. Opposer was the registered owner of the trademark TARZAN under Registration Certificates No. 28333, issued on May 22, 1980 and No SR-4404, issued on December 12, 1979 covering goods in classes 16 and 25 and remains its owner under Application Serial No. 4-1998-06523 filed on August 28, 1998 covering goods in classes 6, 9, 16, 21, 24, 28 and 41. The registration and use by applicant of the trademark TARZAN will dilute the goodwill of opposer's trademark TARZAN derived from its copyright-protected pictorial character TARZAN. It will also diminish the value and distinctiveness of said pictorial character, which has also been used as a trademark by opposer and its various licensees in the Philippines and elsewhere.

"5. The registration of the trademark TARZAN in the name of the applicant is contrary to other provisions of the Intellectual Property Code on the protection of well-known trademark under Section 123.1 (e) and (f), and of pictorial characters. The registration of the trademark TARZAN in the name of applicant will also violate the decision of the Supreme Court in G.R. No. 76193, November 9, 1989, entitled "United Features Syndicate, Inc. vs. Munsingwear Creation

Manufacturing Company,” where the Supreme Court ruled that the creator of the pictorial character has prior right to it against an unauthorized trademark applicant.

Opposer relied on the following facts to support its contentions in this Opposition:

“1. Opposer is the owner of all right, title and interest in and to the TARZAN literary character, and properties related thereto, including the trademark TARZAN. As such owner, opposer has the exclusive right to grant licenses for the use of the name and trademark TARZAN and likeness of said character on merchandise of all kinds.

“2. Opposer and its various licensees have also used TARZAN as a trademark on a wide variety of merchandise, including goods in classes 6, 9, 16, 21, 24, 28 and 41.

“3. Opposer is the successor of the creator and first user of the pictorial character TARZAN, which it has also used as a trademark on the goods included under the former registrations and pending application, which goods have been sold and marketed by opposer and its licensees in various countries worldwide, including the Philippines.

“4. By virtue of opposer’s prior and continuing use and publication of TARZAN and its use of the name and character as a trademark in the Philippines and other parts of the world, said character and trademark have become popular and internationally well-known and have established valuable goodwill for opposer among consumers who have identified opposer as the source of the goods bearing said pictorial character or trademark. The facts proving opposer’s prior and continuing use and publication of TARZAN and its worldwide fame include the following –

- a. Following the publication of the original TARZAN story in 1912, commencing in 1918, motion features featuring the TARZAN name and character have been produced, publicized and exhibited under the authorization of its creator.
- b. The series of 26 TARZAN stories which were written by Edgar Rice Burroughs achieved great success, and attained great recognition and tremendous popularity, not only in the United States, but in many other countries around the world. Sales of TARZAN books have taken place in more than 50 countries and over 800 million books, comic books and other publications have been sold to date.
- c. The TARZAN character has been depicted in comic strips which have appeared on a worldwide basis starting on January 7, 1929. United Features Syndicate has been duly licensed by opposer to publish these comic strips since their inception. There have also been regular TARZAN radio programs broadcast under opposer’s authority.
- d. The series of TARZAN motion pictures featuring the TARZAN name and character have been shown in over 113 countries of the world. In addition to the more than 40 full length TARZAN motion pictures, a number of TARZAN motion pictures serials, Tarzan, Lord of the Jungle, have been produced and exhibited in numerous countries of the world. Income from these features has amounted to well over a hundred million dollars. Today, in the Philippines and in numerous other countries of the world, the new TARZAN animated motion picture, produced by the Disney

organization under opposer's license and authority has been launched with wide audience acclaim and such release has been accompanied by extensive licensing of opposer's TARZAN trademark in connection with a wide variety of consumer merchandise, including various items for consumption.

- e. The TARZAN has been registered as a trademark in the United States of America, Philippines and in many other countries of the world.

"5. The registration and use of an identical trademark by the applicant for use on identical or related goods will tend to deceive and/or confuse purchasers into believing that applicant's products emanate from or are under the sponsorship of opposer. Applicant obviously intends to trade, and is trading on, opposer's goodwill.

"6. The registration and use of a confusingly similar trademark by applicant will diminish the distinctiveness and dilute the goodwill of opposer's trademark and pictorial character TARZAN.

The Notice to Answer dated 06 September 1999 was sent to Respondent-Applicant, through its Counsel, Atty. Vicente V. Ocampo, directing it to file its Verified Answer within a prescribed period from receipt. After several extensions which were granted by this Bureau, Respondent finally filed its Verified Answer on 04 November 1999.

Respondent in its Answer and interposed the following ADMISSIONS and DENIALS:

1. "Respondent-Applicant has no knowledge or information sufficient to form a belief as to the truth of the material averments in Paragraph 1 of the Opposition.
2. "Respondent-Applicant denies specifically the material allegations of paragraph 2 of the Opposition for being false and without basis and for the reasons set forth in the Special and Affirmative Defenses.
3. "Respondent-Applicant denies the material averments in paragraph 3 of the Opposition for being mere conclusions devoid of any legal basis.
4. "Respondent-Applicant has no knowledge or information sufficient to form a belief as to the truth of paragraph 4 of the Opposition insofar as it avers that Opposer is the registered owner of the trademark TARZAN under Registration Certificates no. 28333 and No. SR-4404, and specifically denies the other allegations in paragraph 4 for being false and without basis and for the reasons set forth in the special and affirmative defenses.
5. "Respondent-Applicant denies the material averments in paragraph 5 for being mere conclusions and for the reasons stated in the Affirmative defenses.
6. "Respondent-Applicant specifically denies the material allegations in paragraph 1-5 of the statement of facts Opposer intends to rely upon.

and raised in its Answer the following special and Affirmative Defenses. To wit: (1) That Respondent-Applicant has never made reference to the TARZAN character pictorial since its use in 1965 [see par. 1 page 2, Answer]; (2) The registration of the trademark TARZAN for bubble gum will not violate Article 4 (1) & (2) of the Berne Convention, Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement [see par. 2 page 3, Answer]; (3) Respondent-Applicant was issued registration for the trademark TARZAN on 17 September 1976 for use on bubblegum [see par.3, page 4, Answer]; (4) Opposer's registration of the trademark TARZAN covers only goods in classes 6, 9, 16, 21, 24, 28 and 41 while Respondent-Applicant's trademark

TARZAN covers goods under class 30, specifically, bubble gum [see par. 4, page 5, Answer]; (5) Supreme Court allowed registration of similar or identical trademarks on several occasions [see par. 7, page 7, Answer]; (6) Likewise, on same or related goods, the Supreme Court allowed registration of the same [see par. 6, page 7, Answer]; (7) The registration of the trademark TARZAN for bubble gum will not be contrary to Section 123.1 (e) and (f) of the Intellectual Property Code [see par. 7, page 8, Answer]; (8) The ruling in the case of United Features Syndicate, Inc. vs. Munsingwear cannot be applied in the instant case because Respondent-Applicant is not using nor does he have any intention of using TARZAN'S pictorial documentary evidences to prove its claim, thus, the Opposition should be dismissed [see par. 9, page 9, Answer].

Admitted as documentary evidence for the Opposer based on the records are Exhibits "A" to "R" inclusive of submarkings which consisted, among others, of the Legalized Affidavit of Ms. Sandra Galfas, President of Edgar Rice Burroughs, Inc., herein Opposer; Certificates of Trademark Registration for the mark TARZAN in different countries including the Philippines.

Opposer also presented its Counsel, Atty. Riza Faith C. Ybañez, as witness.

Admitted as documentary evidence for the Respondent are Exhibits "1" to "13" including their sub-markings, consisting of, among other: Certificate of Registration No. 24070 issued by the Philippines Patent Office dated September 17, 1976; Affidavit of Mr. Leoncio Dy, Treasurer of Respondent-Applicant; Plastic wrapper of Tarzan bubble gum in different colors; Affidavit of Atty. Vicente Ocampo, former counsel of Respondent-Applicant; Affidavits of Use/Non-Use dated September 18, 1981, November 25, 1986 and September 24, 1990; Letter addresses to Atty. Vicente Ocampo dated May 22, 1978 from Atty. Romeo U. Limpingco of Barcelona Limpingco & Santos.

Respondent also presented Mr. Leoncio Dy, Treasurer of Respondent-Applicant as its witness;

As per Order No. 2006-1282 dated 2 September 2006, the parties were given thirty (30) days from receipt of the Order to file their respective Memorandum. Opposer filed its Memorandum on 23 October 2006 while Respondent filed its Memorandum on 09 November 2006.

For consideration in particular is the propriety of Application Serial No. 102037. Resolution by this Office is called for on the following issues:

1. Whether or not there is confusing similarity between Opposer's trademark, TARZAN and Respondent-Applicant's mark, TARZAN for use specifically on bubble gum; and
2. Whether or not Respondent-Applicant's mark application for TARZAN should be granted registration.

Considering that the Application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), and that Respondent, through Counsel, manifested in writing their desire to prosecute this application under the provisions of Republic Act No. 166, as amended, and Respondent's Counsel, likewise, disagreed with the proposition that the case be governed by the summary ruled under IPO issued Office Order No. 79, Series of 2005 (Amendments to the Regulations of Inter Partes Proceedings), hence, the case shall be resolved under the old trademark law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

Under R.A. 166, as amended, more particularly Section 4 (d), it is provided that:

Section 4. Registration of trademarks, trade-names and service-marks on the principal register --- xxx The owner of a trademarks, trade-name or service mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers."

The issue stems or springs from Respondent-Applicant's appropriation of the word or mark TARZAN which is the same in sound and spelling vis-à-vis Opposer's trademark, TARZAN. There is no issue that the marks involved are identical, not with the style these marks were printed or presented or with the device used thereon. The word or mark TARZAN appears in both labels of the contending parties. Having shown and proven resemblance of the two marks, we now delve on the matter of confusion of goods which certainly has decisive effects in the adjudication of the case.

From a plain reading of the old trademark law (R.A. 166, as amended) in point, what us there to suffice the requirement of the law and thus bar registration by subsequent user of identical or similar mark is the *confusing similarity* between the subject trademarks, the likelihood that purchasers may confuse the goods of the Applicant and Opposer to come from the same manufacturer or source or that these goods when place alongside each other will suggest a connection or association of one with the other. The goods of the contending parties do not move in the same channels of trade and the possibility appears remote that purchasers will confuse one product with the other because the goods are dissimilar. It can not be said that the other classes of goods which Opposer applied using the same trademark TARZAN are related to the goods of Respondent-Applicant. Opposer's goods constitute books, games, textile, optical merchandise and the business to which they render service consists mainly the operation of restaurants and providing entertainment of all forms whereas Respondent-Applicant's goods consist of confectionery, more particularly bubble gum. The fact that Opposer's TARZAN trademark is applied on products and services which Respondent-Applicant does not deal negates the probability of confusion among prospective purchasers.

With R.A. 166, as amended, as basis of Registrability, this Bureau adheres to the rule on prior adoption and use in the Philippines applying specific provisions of R.A. 166 (Sec. 2 and Sec. 2-A). Records will show that as between the parties, Respondent's application has an earlier filing date and use in the Philippines of the trademark TARZAN. Respondent's mark TARZAN for use on bubble gum (Class 29 of the International Classification) was first filed in the Philippines on 08 October 1973 with its first use on the goods declared on December 29, 1965 (*Exhibit "2-A", Respondent*) while Opposer's first application in the Philippines for the same mark came later on 26 August 1977 Opposer's later application for the same mark TARZAN was for another class of goods (Class 16 of the Nice Classification) more particularly for paperback books, hardbound books, comic books and newspaper cartoons.

Opposer further argues that the mark TARZAN is well-known citing authorities and provisions for the protection of well-known marks contained in Article 6*bis* of the Paris convention, thus:

- (1) *"The countries of the Union undertake, ex officio if their legislation so permits or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of*

registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.”

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The protection in Article 6bis extends only to registration or use in respect of identical or similar goods, contrary to what is obtaining in the instant case which involves dissimilar goods. Opposer further bolstered its argument invoking R.A. 8293 (the Intellectual Property Code of the Philippines) which took effect on January 1, 1998.

In the language of R.A. 8293, more particularly Section 123 (f), it is said that:

“Section 123. Registrability. – 123.1. A mark cannot be registered if it:

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- (i) *Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;”*

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It is clear that the foregoing section can not apply to the case at bar because the trademark application was filed when the old trademark law was still effective, it follows that it is R.A. 166, as amended, that must be applied with regard to the determination of whether or not a mark is well-known. In determining whether a trademark is well-known, we used under the old law as standards an international treaty: the Paris Convention for the Protection of Industrial Property or Article 6bis and as national guidelines, the November 20, 1980 Memorandum issued by the then Minister of Trade and Industry, the Hon. Luis Villafuerte and the October 25, 1983 Memorandum issued by then Minister Luis Villafuerte. The scope of protection of well-known marks under the aforementioned standards and guidelines covers only trademarks and use for identical or similar goods. Worth mentioning at this point is the ruling of the court in the case of Canon Kabushiki Kaisha vs. Court of Appeals (G.R. No. 120900, July 20, 2000), which is one case relevant to and decisive of this particular point when the court ruled:

“Petitioner, as this office sees it, is trying to seek refuge under its protective mantle, claiming tat the subject mark is well known in this country at the time the then application of NSR Rubber was filed. However, the then Minister of Trade and Industry, the Hon. Roberto V. Ongpin, issued a memorandum dated 25 October 1983 to the Director of Patents, a set of guidelines in the implementation of Article 6bis (sic) of the Treaty of Paris. These conditions are:

- a) *the mark must be internationally known;*
- b) *the subject of the right must be a trademark, not a patent or copyright or anything else;*
- c) *the mark must be for use in the same or similar kinds of goods; and*
- d) *the person claiming must be the owner of the mark*

From the set of facts found in the records, it is ruled that the Petitioner failed to comply with the third requirement of the said memorandum that is the mark must be for use in the same or similar kinds of goods. The Petitioner is using the mark "CANON" for products belonging to class 2 (paints, chemical products) while the Respondent is using the same mark for sandals (class 25). Hence, Petitioner's contention that its mark is well-known at the time the Respondent filed its application for the same mark should fail."

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In the case at bar, the mark TARZAN is used on confectionery specifically, bubble gum since 1965 in the Philippines while Opposer's mark TARZAN is used for metals or non-precious metals, optical, scientific apparatus and instruments, books, games, textile merchandise and restaurant entertainment business in the Philippines, the earliest trademark application of Opposer for the mark TARZAN in the Philippines in 1977 was only for Class 16 specifically paperback books, hardbound books, comic books and newspaper cartoons.

In view of the foregoing discussions, the Bureau finds the grounds relied upon and arguments raised by Oppose to be unmeritorious or without basis to sustain this Opposition. Respondent-Applicant's right to the use of the questioned mark does not infringe upon the exclusive right of Opposer to its TARZAN trademark.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby DENIED. Consequently, application bearing Serial No. 102037 filed by Philippine Sweets Manufacturing Co. filed on 15 August 1995 for the registration of the mark "TARZAN" for use on bubble gum is, as it is hereby GIVEN DUE COURSE.

Let the filewrapper of TARZAN, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 22 December 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office