

The historical personal name “DARI” Case

(Article 4(1)7 of the Trademark Law)

Tokyo High Court

Case *Hei* 13 (*Gyo-Ke*) No. 443 (July 31, 2002)

FACTS

The defendant filed a trademark application for “ダリ/DARI” (“ダリ” is a Japanese syllabary (*katakana*) rendering of DARI) in respect of designated goods “soap, perfumery, cosmetics, etc.” in Class 3 on December 1, 1994. The trademark application was registered as TM Reg. No. 3370476 on October 16, 1998 on the basis of the final decision for registration issued on July 23, 1998.

The plaintiff claimed that the subject trademark violated Articles 4(1)7, 4(1)11 and 4(1)15 of the Trademark Law as likely to offend public policy or morality, and filed an invalidation trial against the registration of the subject trademark on December 11, 1998.

DISPOSITION IN THE JAPAN PATENT OFFICE

The Japan Patent Office did not sustain demands of this invalidation trial for the following reasons:

(1) The alphabetic part of the subject trademark is "DARI". Its spelling differs from the "Dali" of "Salvador Dali", the artist, and in addition, it is understood that the *katakana* part merely identifies the way the alphabetic part of "DARI" is pronounced. Thus, it is assumed that the subject trademark is identified as a coined word and does not cause dealers and consumers to recall Salvador Dali. As a result, the subject trademark cannot be identified as a

trademark that is likely to offend public policy or morality, and therefore does not violate Article 4(1)7 of the Trademark Law.

(2) The subject trademark is pronounced “da-ri“ whereas the plaintiff’s trademark is only pronounced “sa-ru-ba-do:-ru-da-ri” from "Salvador Dali", and thus the two marks are not similar in pronunciation. Furthermore, the subject trademark is a coined word whereas the plaintiff’s trademark “Salvador Dali” represents a famous Spanish artist, Salvador Dali, and thus the two marks are not similar in conception, either. In addition, the two marks are distinguishable in appearance. Accordingly, the subject trademark does not violate Article 4(1)11 of the Trademark Law.

(3) Since the subject trademark is dissimilar to the plaintiff’s trademark, it cannot be said that the public is likely to be deceived or confused by the trademarks when the subject trademark is used for the designated goods. Accordingly, the subject trademark does not violate Article 4(1)15 of the Trademark Law.

The plaintiff appealed to the Tokyo High Court.

ISSUE

If a trademark consisting of an abbreviation of the name of a historical person is registered in connection with designated goods without the consent of the person’s heirs, estate, etc., does registration of the trademark offend public policy or morality?

HOLDING AND REASONING

The alphabetic part of the subject trademark "DARI" differs from "Dali"

of the artist "Salvador Dali" in spelling. However, the same *katakana* character corresponds to "RI" and "li" because *katakana* is phonetic and both "RI" and "li" have the same sound in Japanese. Accordingly, it is often difficult for native speakers of Japanese to distinguish "r" from "l" by sound and also by spelling. In addition, "Salvador Dali" is more commonly written in Japan as "サルバドール・ダリ" or "ダリ", that is, in *katakana*, than alphabetically as "Salvador Dali" or "Dali".

Consequently, it may be unreasonable to assume that dealers and consumers seeing the subject trademark can easily recognize the difference between the "DARI" of the subject trademark and the "Dali" of "Salvador Dali". It is admitted that the subject trademark reminds dealers or consumers of the designated goods of the late Salvador Dali, who was born in Spain and is an artist known worldwide as the leader of surrealism.

When the final decision for registration of the subject trademark was issued on July 23, 1998, "DALI" was still a well-known abbreviation of the artist's name even after his death. If a trademark consisting of abbreviations of the name of a historical person is registered in connection with designated goods without the consent of the heirs, the registration of the trademark allows the defendant to take unfair advantage of the fame and honor of the deceased and to monopolize the use thereof for the designated goods. The registration of the trademark may not only damage the fame and honor of the deceased but also violate fair trade practices and international faith. Thus, it must be said that the subject trademark offends public policy or morality.

The Tokyo High Court judged that the trial decision was incorrect because the subject trademark was registered despite violating Article 4(1)7 of

the Trademark Law. Accordingly, the Tokyo High Court vacated the trial decision without deciding the other points.