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“TORO vs. BADTORO”: Head to head in a Spanish bullfight

Carolina Pina (Garrigues) · Wednesday, February 8th, 2017

The Spanish Supreme Court has held that there is no risk of confusion between the word trade mark “Toro” (owned by Osborne Group, S.A., the notorious beverage company) and the word trade mark “Badtoro” (owned by Jordi Nogués, S.L., and filed for goods and services in classes 25 and 35 – relating to clothing-).

Firstly, the judgment “poetically” concludes that the bull, and the Spanish term “toro” to designate the animal, is an iconic figure in Spain and its culture, with bullfighting as a part of Spanish cultural heritage. The judgment cites case law of the Spanish Supreme Court (Judgment 177/2016, of 2 October) according to which, bullfighting has a long tradition and is a historic, cultural, social, artistic, financial and business phenomenon in Spain (this point of view is open to debate, given that an increasing sector of the Spanish population has a declared and vociferous interest in animal welfare, but that is a matter for a different blog post…).

For the Supreme Court, the fact that a specific graphic representation of a fighting bull is well known in the public sector, both in Spain and abroad, and that it is also linked to Spain, this does not mean that the Spanish term “toro” (translated to bull), does not have distinctive capacity to designate goods and/or services.

Based on the premise that the term “toro” can be protected as a trademark, the judgement analyses the risk of confusion between the trademark application “BADTORO” and the opposing trademark “TORO”, according to the following criteria:

- the overall impression created by the signs for an average consumer, considering this to be one who is reasonably well informed, observant and circumspect. It should be borne in mind that this average consumer rarely has the opportunity to directly compare the trademarks, and is required to trust in an imperfect image retained in the memory.
- The degree of graphic, phonetic and conceptual similarity, paying special attention to the predominant elements.
- Overall evaluation of the trademarks. This does not mean that distinctive and dominant elements may not exist, but rather, that it is not possible to artificially break down the sign.
- Application of the principle of interdependence, that is, if there is very little similarity between the goods or services covered it may be compensated by a high

degree of similarity between the trademarks (and vice versa).

Applying these criteria, and taking into account that the goods and services for which both trademarks were registered do not completely match, the Court concluded that there is no risk of confusion between the signs, as the term “toro” does not have a special reputation. Furthermore, a neologism is created by adding the English word “bad” to the Spanish term “toro”, which makes a graphic and phonetic differentiation regarding the sign “toro”, which it is considered sufficient to ensure that there is no risk of confusion between both trademarks for the average consumer.

Conclusion

This judgment concludes that the term “toro”, and despite its special and idiosyncratic place in Spanish culture, can be registered as a trademark. Furthermore, it states that there is no risk of confusion between the Osborne trademark “TORO” and the trademark “BADTORO”, due to the addition of the English word “bad” and the creation of a neologism, thus ensuring that the term is has a sufficient distinctiveness.

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