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Second Round of the Jurassic Battle

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The first instance court of Barcelona held that that the trade mark device of a dinosaur on a biscuit must remain in the public domain, ruling against the claimant in a trade mark and unfair competition lawsuit (judgement available [here](#), and post [here](#)). The Appellate Court (judgement No. 629/2020 of March 23, 2020) has now concluded that 'GALLE SAUROS' infringes the trade mark 'DINOSAURUS' (word and figurative). However, the use of dinosaur-shaped biscuits per se was not considered to infringe of ARTIACH's earlier rights.

Background

'DINOSAURUS' biscuits, shown below, are a popular product manufactured by GALLETAS ARTIACH S.A.U. (ARTIACH).



ARTIACH brought action for trademark infringement and unfair competition against competitor LA FLOR BURGALSA S.L. (FLORBU), which was marketing dinosaur-shaped biscuits under the brand 'GALLESAUROS' (*cookiesaurus*).

The first instance court of Barcelona dismissed ARTIACH's claim, holding that that the two-dimensional representation of a dinosaur on a three-dimensional object (i.e. a biscuit) could not be monopolised.

Reasoning behind the Appellate Court's ruling

First, the Appellate Court of Barcelona reminded ARTIACH that the relevant assessment should be limited to the earlier trademarks, as registered, and the signs used by FLORBU (Supreme Court Judgment No. 101/2016 of February 25, 2016).

The judgment then went on to analyse the evidence submitted by the claimant

regarding the reputation of the earlier marks, concluding that the mark 'DINOSAURUS' is widely known by the relevant sector of the public for which the goods are intended (purchasers of biscuits intended for children). In order to reach that conclusion, it assessed the sales volume, the investment in advertising and the knowledge of the product among the target public of the products. Funnily enough, only reference to 'women with children' aka 'mothers' -instead of gender-neutral 'parents'- was made in connection with the relevant survey results.

The judgment further concluded that there was no likelihood of confusion between DINOSAURUS and GALLESAUROS, due to their overall aural and visual dissimilarities. It also held that there was no conceptual similarity between the marks, in view of the fact that the earlier registration was a figurative mark, and not a three-dimensional mark. In the court's view, the different dinosaur species may not be monopolised.

After recalling the types of injury against which trade marks with a reputation should be protected, the decision held that the degree of similarity between the defendant's sign 'GALLESAUROS' and the claimant's well-known mark 'DINOSAURUS', was sufficient to establish a link between the two signs, despite them not being confusingly similar. The Court found that *"there is a natural and inevitable association between the well-known mark 'DINOSAURUS' and the product on which it is used (dinosaur-shaped biscuits), an association which the defendant also seeks to exploit."* However, the Appellate court does not hold infringement in respect of the device trade marks in the shape of dinosaurs which cannot be monopolised by ARTIACH.

The court concluded that the sign 'DINOSAURUS' (word and figurative) was infringed by FLORBU's use of 'GALLESAUROS'. However, the use of dinosaur-shaped biscuits per se was not considered to infringe of ARTIACH's earlier rights. The question remains as to whether it would have secured a higher degree of protection based on a three-dimensional, rather than on a figurative, trade mark.

The final question is how are our children supposed to call a biscuit evocative of the Jurassic era, assuming that SAURUS/SAUROS cannot be used?

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