

## NUTRIBEN marks granted enhanced protection in BIONUBEN dispute

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- The court found that the signs were sufficiently similar to find that BIONUBEN generated a link with NUTRIBEN
- The existence of the PRONUBEN marks owned by one of the defendants did not constitute an obstacle to the conclusion of the existence of such a link
- The fact that the marketing of the Bionuben products had allegedly been unsuccessful did not constitute an obstacle to a finding of free-riding

In a recent judgment dated 24 January 2024 (No 14/2024), the EU Trademark Court of First Instance of Alicante has applied the principle of the enhanced protection of reputed trademarks. Pursuant to a lawsuit filed by Alter Farmacia SA (Alter), the court declared:

1. the infringement of several word and figurative trademark registrations owned by Alter for the well-known infant food brand NUTRIBEN as a consequence of the commercialisation in Spain by Productos y Nutrientes Para Bebés SL (PNB) and Laboratorios Bionuben SL (LB) of identical products marked with the sign BIONUBEN; and
2. the invalidity of the Spanish trademarks BIONUBEN (word and figurative), registered by PNB for products in Classes 5, 29 and 30.

### PNB and LB's arguments

In their response to the lawsuit, PNB and LB, without denying the consolidated reputation of the NUTRIBEN marks and the obvious identity of the products, raised the following arguments as a defence:

1. the alleged dissimilarity of the signs NUTRIBEN and BIONUBEN;
2. the alleged peaceful and longstanding co-existence on the market of the NUTRIBEN marks with several PRONUBEN marks owned by PNB, which appeared to show the existence of a family of NUBEN-formative marks, as well as, in the defendants'

- view, the possible peaceful co-existence of the NUTRIBEN and BIONUBEN marks;
3. the existence of multiple third-party trademark registrations containing the ending '-BEN' for the classes of products concerned, again showing, according to the defendants, the alleged possibility of peaceful co-existence on the market; and
  4. the alleged negative economic results related to the sale of the Bionuben products, which, in the defendants' opinion, proved the absence of any free-riding on the reputation of the NUTRIBEN marks.

## Decision

The court, applying the principle of the enhanced protection of reputed trademarks (which, among other things, does not require that the degree of similarity between the signs at issue be such as to cause a likelihood of confusion), considered that the signs under comparison were sufficiently similar to find, in view of the circumstances of the case, that the sign BIONUBEN generated a link with the NUTRIBEN mark - that is, it evoked the mark or reminded the public of it.

The court clarified that the sign BIONUBEN did not constitute an extension of PNB's PRONUBEN marks for a new line of organic infant food products. If it were so, the new trademark would have been BIOPRONUBEN, rather than BIONUBEN. Therefore, the court considered that, since the prefix 'BIO-' lacks distinctiveness, the comparison of the signs should focus on the word element 'nutriben' of the earlier trademarks and the word element 'nuben' of the BIONUBEN mark. From this perspective, it considered that the signs were sufficiently similar, since the BIONUBEN mark reproduced the sign protected by the earlier trademarks, omitting only the intermediate syllable '-TRI-'. Thus, the court concluded that the public would clearly perceive the first common syllable 'NU-', as well as the last common syllable '-BEN', due to its character as a tonic syllable.

The similarity of the signs, together with the identity of the goods and the reputation - recognised in the judgment - of the trademark NUTRIBEN, allowed the conclusion that there was a link between the signs in dispute.

The court also argued that the existence of the PRONUBEN marks owned by PNB did not constitute an obstacle to the conclusion of the existence of a link between BIONUBEN and NUTRIBEN. As Alter alleged in its lawsuit, the use of the mark PRONUBEN for infant food products would have been made in emerging markets and was unknown to the Spanish public. Likewise, and also in line with Alter's arguments, the court considered that the fact that there were third-party trademark registrations for the relevant classes ending with the syllable '-BEN' did not constitute an obstacle to the existence of such a link. Such registrations did not cover the word element 'nuben' as a whole and, in any case, the defendants did not prove that such third-party trademark registrations were in use, so that it could be considered that the relevant public was regularly confronted with trademarks containing similar syllables.

Having concluded that there was a link between the signs in dispute, and turning to the necessary requirements to apply the enhanced protection of reputed trademarks, the court appreciated the existence of a risk of free-riding. This was in view of various items of evidence furnished by Alter proving that pharmaceutical personnel had marketed the Bionuben products as having the same commercial origin as the Nutriben products, and even believed that Bionuben was a new line of organic infant food products by Alter.

Finally, the court considered that the fact that the marketing of the Bionuben products had allegedly been unsuccessful did not constitute an obstacle to the finding of free-riding. Upholding Alter's arguments in light of the evidence furnished in the proceedings, the court considered that the alleged lack of commercial success of the Bionuben products could be due to many other reasons unrelated to the chosen trademark, such as internal factors of the defendants' companies.

Therefore, the court declared the infringement of the NUTRIBEN marks by PNB and LB, as well as the invalidity of the Spanish BIONUBEN marks owned by PNB. Following the lack of appeal by PNB and LB, this judgment has become final.



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