

EU General Court confirms OHIM's decision in *Infinite Cycle Works* European Union - Casalonga & Associés

Confusion Infringement

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In *Infinite Cycle Works Ltd v Office for Harmonisation in the Internal Market (OHIM)* (Case T-30/15, February 19 2016), the EU General Court confirmed OHIM's decision of October 30 2014 (R 2308/2013-2) insofar as it held that the degree of similarity between the signs at issue was sufficiently high to conclude that there was a likelihood of confusion pursuant to Article 8(1)(b) of the Community Trademark Regulation.

On April 25 2012 Infinite Cycle Works filed a Community trademark application for the word mark INFINITY for goods in Classes 12, 25 and 28.

On July 13 2012 Chance Good Enterprise Co Ltd filed an opposition based on its prior figurative Community Trademark No 4538476 registered for goods in Classes 9, 11 and 12, and Community Trademark No 8211153 registered for goods in Classes 11, 18 and 25, pursuant to Article 8(1)(b) of the Community Trademark Regulation.

The OHIM Opposition Division partially accepted the opposition, rejecting the Community trademark application for "bicycles; bicycle parts; bicycle accessories" in Class 12 as well as for "exercise bicycles" in Class 28.

On November 22 2013, Infinite Cycle Works filed a notice of appeal against OHIM's decision.

The board of appeal dismissed the notice. It found that the signs were visually, phonetically and conceptually similar, and that the degree of similarity between the signs at issue was high enough that French or Belgian consumers would believe that the goods at issue came from the same supplier. It concluded that there was a likelihood of confusion between the prior marks and the Community trademark application.

Infinite Cycle Works brought an action for annulment of OHIM's decision before the EU General Court, alleging infringement of Article 8(1)(b).

The court dismissed the action in its entirety and confirmed the board of appeal's decision, also holding that the signs at issue were visually, phonetically and conceptually similar and the goods rejected from the Community trademark application were similar to those protected by the opponent's prior marks.

It held that the signs were visually similar as the word element of the earlier mark was included in the contested application and the figurative element of the earlier marks was not striking.

It also held that the signs were similar phonetically since they had three syllables in common, differing only in the ending, and the relevant public (ie, the French-speaking public) was likely to pronounce the syllables in common in the same way, using the French pronunciation for both words.

Finally, the court held that as the French word '*infini*' is the root of the English word 'infinity', the French-speaking public would understand the word in the same way, without needing to understand the corresponding English word. Further, as the earlier marks were Community trademarks, a likelihood of confusion in relation to only part of the relevant public, the French public, was sufficient.

In response to Infinite Cycle Works' argument that the prior marks had a weak distinctive character, the court reiterated that while the distinctive character of the earlier marks must be taken into account in assessing the likelihood of confusion, it is only one factor in that assessment.

Accordingly, even in a case involving earlier marks of weak distinctive character, there may be a likelihood of confusion due to a similarity between the signs and between the goods or services covered.

This decision confirms that it is sufficient that there is a likelihood of confusion in relation to only part of the relevant public where the earlier mark is a Community trademark, even when the prior mark upon which the opposition is based has a weak distinctive character.

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