

In *Fon Wireless Limited v Office for Harmonization in the Internal Market (OHIM)* (Case T-283/11, January 29, 2013) the General Court has held that there was a likelihood of confusion between the prior mark "FON" and the later filed Community trade mark application "nfon" in relation to goods and services in classes 9 and 38 notwithstanding the perception of "FON" as an indication for telephones.

In August 2007, nfon AG applied to register the word mark "nfon" as a Community trade mark *inter alia* for "*apparatus for recording, transmission or reproduction of sound or images; telephones; telephone installations and telephone networks*" in class 9 and "*telecommunications*" in class 38. On publication, Fon Wireless filed an opposition based on an earlier Community trade mark registration for the figurative mark "fon" and a national UK word mark registration "FON" for goods and services in classes 9, 38 and 42. The grounds for the opposition were those laid down in Article 8(1)(b) of the Community Trade Mark Regulation (40/94), now the Community Trade Mark Regulation (207/2009).

In July 2009, the Opposition Division of OHIM upheld the opposition on the grounds that there was a likelihood of confusion in respect of the above goods and services in classes 9 and 38. nfon appealed.

The Fourth Board of Appeal of OHIM upheld the appeal. In the Board's view, notwithstanding the high similarity or identity of the conflicting goods and services, because of the weak distinctiveness of the earlier mark, there was no likelihood of confusion between the conflicting marks. Fon Wireless appealed to the General Court.

Before the Court, Fon Wireless raised two pleas alleging infringement of Article 8(1)(b) and of Article 8(5). It argued that the opposition was well founded because there was a likelihood of confusion between the marks. In Fon Wireless' view, the Fourth Board of Appeal had incorrectly assessed the visual, phonetic and conceptual similarities between the marks by inadequately considering the distinctiveness of the prior registrations. In the proceedings before the Court, Fon Wireless submitted new evidence claiming that its mark enjoyed an increased distinctiveness through use made of the mark.

The General Court first assessed the second plea alleging infringement of Article 8(5) and held that the plea was inadmissible. Since Fon Wireless had not based its opposition on the ground laid down in Article 8(5) and had not raised infringement of said provision in the proceedings before OHIM, it was now barred from successfully introducing this plea before the Court.

The General Court then considered the first plea alleging infringement of Article 8(1)(b) and held that even the allegedly weak distinctive character of the word "FON" as an indication for telephones could not preclude the likelihood of confusion, as the weak distinctive character is only one

factor to be taken into account. Since the goods and services were held to be identical or highly similar and the marks were similar, the Court concluded that there was a likelihood of confusion.

The marks were held to be visually and phonetically similar, despite the additional letter "n" in the earlier registrations. In the Court's view, the additional letter "n" at the beginning of the earlier mark "nfon" occupied a secondary position in the mark only. The second part, "fon", was held to be dominant in pronouncing the mark; visually decisive was the fact that the later filed mark was completely included in the prior mark "nfon".

The marks were furthermore held to be conceptually similar to a certain extent. In this respect, the Court disagreed with the Board's assessment that the earlier mark "nfon" had no meaning in the relevant languages. Although the Court recognised the fact that the average consumer normally perceives the mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a sign, the consumer will break it down into elements which, for him, suggests a concrete meaning or which resemble words known to him. Accordingly, in the present case, the consumer would recognise the "fon" element, resulting in a conceptual link to the mark applied for.

In its general assessment of a likelihood of confusion, the Court referred to its judgment in Case T-134/06 *pagesjaunes.com* and held that, despite the indicative meaning of "FON" for telephones, that the degree of similarity between the marks in question and the high similarity or identity between the conflicting goods were sufficient to conclude that there was a likelihood of confusion. Thus, the General Court upheld Fon Wireless' appeal and dismissed nfon's appeal against the decision of the Opposition Division. In effect, the opposition was therefore successful.

It is interesting to note that nfon had sought to declare Fon Wireless' UK registration invalid on the basis that the word mark "FON" was devoid of distinctive character or had a descriptive meaning. However, by a decision of the Hearing Officer of 2 March 2011, the UK Intellectual Property Office dismissed the application for declaration of invalidity (Case O-088-11). Without any doubt, conflicts involving trade marks with descriptive terms and meanings will continue to be a contentious area, and while the decision of the General Court may provide some guidance, conflicts between marks with descriptive meanings will have to be considered on a case to case basis.

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Florian Traub
Squire Sanders (UK) LLP, London