

OPPOSITION No B 2 937 293

Hyperion Entertainment, Tervurenlaan 34, 1040 Brussel, Belgium (opponent), represented by **Gevers**, Brussels Airport Business Park, Holidaystraat 5, 1831 Diegem, Belgium (professional representative)

a g a i n s t

Cloanto Corporation, 5940 S Rainbow Blvd Suite 400 #67834, Las Vegas, Nevada 89118-2507, United States of America (holder), represented by **Grünecker Patent- und Rechtsanwälte PartG mbB**, Leopoldstr. 4, 80802 München, Germany (professional representative).

On 20/09/2018, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 937 293 is upheld for all the contested goods.
2. International registration No 1 338 754 is entirely refused protection in respect of the European Union.
3. The holder bears the costs, fixed at EUR 620.

PRELIMINARY REMARK

As from 01/10/2017, Regulation (EC) No 207/2009 and Regulation (EC) No 2868/95 have been repealed and replaced by Regulation (EU) 2017/1001 (codification), Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431, subject to certain transitional provisions. Further, as from 14/05/2018, Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431 have been codified and repealed by Delegated Regulation (EU) 2018/625 and Implementing Regulation (EU) 2018/626. All the references in this decision to the EUTMR, EUTMDR and EUTMIR should be understood as references to the Regulations currently in force, except where expressly indicated otherwise.

REASONS

The opponent filed an opposition against all the goods of international registration designating the European Union No 1 338 754, for the word mark 'WORKBENCH'. The opposition is based on Benelux trade mark registration No 1 008 486, for the word mark 'Workbench'. The opponent invoked Article 8(1)(a) and (b) EUTMR.

DOUBLE IDENTITY — ARTICLE 8(1)(a) EUTMR

Pursuant to Article 8(1)(a) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for will not be registered if it is identical to the

earlier trade mark and the goods or services for which registration is applied for are identical to the goods or services for which the earlier trade mark is protected.

a) The goods

The goods and services on which the opposition is based are the following:

Class 9: *Computer operating programs; Computer operating programs, recorded; Computer operating programmes; Computer operating software; Computer operating system software; Computer software adapted for use in the operation of computers; Operating software; Operating system programs; Operating system software; Embedded operating software; Programs (Computer operating -) recorded; Recorded computer operating programs.*

Class 25: *Baseball caps and hats; Beachwear; Athletics footwear.*

Class 41: *Book publishing; Electronic publication of texts and printed matter, other than publicity texts, on the Internet.*

The contested goods are the following:

Class 9: *Computer operating programs; computer operating systems; computer software for emulating computer operating systems on personal computers; operating system programs.*

Computer operating programs and computer operating systems are identically contained in both lists of goods (including synonyms).

The contested *computer software for emulating computer operating systems on personal computers* is included in the broad category of the opponent's *computer software adapted for use in the operation of computers*. Therefore, they are identical.

The contested *operating system programs* overlap with the opponent's *computer operating system software*. Therefore, they are identical.

b) The signs

Workbench	WORKBENCH
Earlier trade mark	Contested sign

Since the protection conferred by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic features which that mark might possess (22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43), it is irrelevant whether a word mark is depicted in lower or upper case letters, or in a combination thereof.

Therefore, the signs are identical.

c) Global assessment and conclusion

The signs are identical and the contested goods are identical.

Therefore, the opposition is well founded on the basis of the opponent's Benelux trade mark registration No 1 008 486. It follows that the contested trade mark must be rejected for all the contested goods.

Since the opposition is fully successful on the basis of the ground of Article 8(1)(a) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(1)(b) EUTMR.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR (former Rule 94(3) and (6) and Rule 94(7)(d)(i) EUTMIR, in force before 01/10/2017), the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.

**The Opposition Division**

Vít MAHELKA

Raphaël MICHE

Klaudia MISZTAL

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.