Reports of Cases

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

28 May 2020*

(EU trade mark — Opposition proceedings — Applications for the EU figurative marks We IntelliGence the World, currencymachineassistant, robodealer, currencyassistant, tradingcurrencyassistant, CKPL, moneypersonalassistant, moneyassistant, currencypersonalassistant, CNTX Trading, AIdealer and CNTX — Earlier EU and UK figurative marks representing two intertwining circles or two overlapping circles — Suspension of proceedings — Article 71(1) of Delegated Regulation (EU) 2018/625)

In Cases T-84/19 and T-88/19 to T-98/19,

Cinkciarz.pl sp. z o.o., established in Zielona Góra (Poland), represented by E. Skrzydło-Tefelska and K. Gajek, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by A. Söder and H. O'Neill, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

MasterCard International, Inc., established in New York, New York (United States), represented by J. Olsen, B. Hitchens and P. Andreottola, Solicitors, and G. Tritton and A. Muir Wood, Barristers,

TWELVE ACTIONS brought against the decisions of the Second Board of Appeal of EUIPO of 7 December 2018 (Cases R 1062/2018-2, R 1059/2018-2, R 1058/2018-2, R 1057/2018-2, R 1056/2018-2, R 1060/2018-2, R 1055/2018-2, R 1054/2018-2, R 1053/2018-2, R 986/2018-2, R 1063/2018-2 and R 1064/2018-2), relating to opposition proceedings between MasterCard International and Cinkciarz.pl,

THE GENERAL COURT (Eighth Chamber),

composed of J. Svenningsen (Rapporteur), President, R. Barents and C. Mac Eochaidh, Judges,

Registrar: A. Juhász-Tóth, Administrator,

having regard to the applications lodged at the Court Registry on 12, 13 and 14 February 2019,

* Language of the case: English.

having regard to the responses of EUIPO lodged at the Court Registry on 21 May 2019,

having regard to the responses of the intervener lodged at the Court Registry on 17 May 2019,

having regard to the decision of 10 April 2019 joining Cases T-84/19 and T-88/19 to T-98/19 for the purposes of the written part of the procedure and the oral part, if any,

having regard to the change in the composition of the Chambers of the General Court,

further to the hearing on 17 December 2019,

gives the following

Judgment

Background to the dispute

1 Between 16 March and 25 April 2016, the applicant, Cinkciarz.pl sp. z o.o., filed 12 applications for registration of EU trade marks with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

2 Registration as marks ('the marks applied for') was sought for the following figurative signs:

– in Case T-84/19:



– in Case T-88/19:



– in Case T-89/19:



– in Case T-90/19:



– in Case T-91/19:



– in Case T-92/19:



– in Case T-93/19:



– in Case T-94/19:



– in Case T-95/19:



– in Case T-96/19:



– in Case T-97/19:



– in Case T-98/19:



3 The goods and services in respect of which those registrations were sought are in Classes 9 and 36 and, depending on the case, 41 (marks applied for at issue in Cases T-92/19, T-96/19 and T-98/19) or 45

(marks applied for at issue in Cases T-84/19, T-88/19 to T-91/19, T-93/19 to T-95/19 and T-97/19) of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 July 1957, as revised and amended.

4 The EU trade mark applications were published in the *European Union Trade Marks Bulletin*, depending on the case, on either 19 May or 14 July 2016.

5 At an earlier date, namely on 15 March 2015, the applicant had filed another application for registration of an EU trade mark concerning the following figurative sign ('the purely figurative mark €$'):



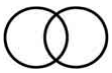
6 The purely figurative mark €$ corresponds exactly to the figurative element of the four marks applied for at issue in Cases T-84/19, T-92/19, T-96/19 and T-98/19, and the application for its registration covered goods and services in the same classes as those covered by those four marks applied for. The application for registration of the purely figurative mark €$ was refused by the examiner, whose decision was upheld by the Board of Appeal. The latter's decision was however annulled by the judgment of 8 March 2018, *Cinkciarz.pl* v *EUIPO (€$)* (T-665/16, not published, EU:T:2018:125) and the case was referred back to the First Board of Appeal (Case R 1345/2018-1).

7 On 12 August 2016, the intervener, Mastercard International, Inc., filed notices of opposition to registration of the 12 marks applied for, pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001), in respect of all the goods and services covered by each of those marks.

8 The oppositions were based, inter alia, on seven EU trade marks and one UK trade mark.

9 The seven EU trade marks included the following three trade marks:

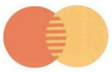
– EU figurative mark No 9835869, reproduced below, covering goods and services in, inter alia, Classes 9 and 36 ('intertwining circles'):



– EU figurative mark No 2988533, reproduced below, depicted in black and white, covering goods and services in, inter alia, Classes 9, 36, 41 and 45 ('black and white circles'):



– EU figurative mark No 9812538, reproduced below, depicted in red-orange and light orange, covering goods and services in, inter alia, Classes 9, 36, 41 and 45 ('red and orange circles'):



10 The grounds relied on in support of the oppositions were, inter alia, those set out in Article 8(1)(b) and (5) of Regulation No 207/2009 (now Article 8(1)(b) and (5) of Regulation 2017/1001).

11 On 5 May 2017, the applicant filed applications for a declaration of invalidity in respect of the two earlier marks in black and white, referred to in the first two indents of paragraph 9 above (intertwining circles and black and white circles; taken together, 'the earlier marks in black and white').

12 By 12 decisions delivered on 27 March, 10 and 11 April 2018, the Opposition Division rejected the oppositions in full. In its analysis, it first of all took into consideration, as regards the marks relied on in support of the opposition, the mark representing two black and white circles, and found that the signs at issue were not similar. It then extended its finding to include the other earlier marks, a fortiori, on the ground that those other marks did not display the white and black combination of the circles characterising the figurative element of the marks applied for. Given the lack of similarity between the signs at issue, the Opposition Division found that it was not necessary to wait for the outcome of the invalidity proceedings relating to the earlier mark representing two black and white circles.

13 On 29 May and 7 June 2018, the intervener filed notices of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against all the decisions of the Opposition Division.

14 By decisions of 7 December 2018 ('the contested decisions'), after examining of its own motion the issue of whether to suspend the proceedings on account of the ongoing parallel proceedings relating to the applications for a declaration of invalidity in respect of the two earlier marks in black and white as well as those relating to the registration of the purely figurative mark €$, the Second Board of Appeal of EUIPO upheld those appeals.

15 In particular, the Board of Appeal found that the Opposition Division had erred in failing to define the relevant public, which the former defined on the basis of the various classes of goods or services concerned in the present case.

16 Furthermore, in all the contested decisions except the contested decision in Case T-96/19 (decision R 986/2018-2) ('the first 11 contested decisions'), the Board of Appeal decided, as did the Opposition Division, to compare the signs at issue on the basis of the EU trade mark representing two black and white circles, regarded as one of the two most favourable earlier marks for the intervener (the other being the earlier mark representing two intertwining circles). At the end of that comparison, the Board of Appeal found, unlike the Opposition Division, that those signs were visually similar to a low degree.

17 In the contested decision in Case T-96/19 ('the 12th contested decision'), the Board of Appeal decided to base its analysis on the EU trade mark representing two red and orange circles, on the ground that the earlier marks in black and white were subject to applications for a declaration of invalidity. In that decision, the Board of Appeal also found that the signs compared in that case were visually similar to a low degree.

18 In the light of the similarity between the signs at issue, the Board of Appeal found that it was necessary to compare the goods and services at issue and to examine the intervener's claims regarding the enhanced distinctiveness of the earlier marks. In that regard, in the first eleven contested decisions, the Board of Appeal noted that that issue was liable to play a crucial role, since the opposition was based on several earlier rights 'and that some (if not all) [of those earlier rights and the mark applied for in the present case] may be considered lowly similar … because they consist of two overlapping circles that are of the same size and are arranged in a horizontal way'. For the same reason regarding the existence of similarity between those signs, the Board of Appeal also found that it was necessary to examine the ground of opposition set out in Article 8(5) of Regulation 2017/1001.

19 Consequently, after annulling the decisions of the Opposition Division, the Board of Appeal referred the cases back to it. However, in the first 11 contested decisions, it '[recommended that the Opposition Division suspend] the opposition proceedings until a final legally binding decision concerning the validity of [the earlier rights on which the Opposition Division and the Board of Appeal itself based their decisions]' and, in the 12th contested decision, invited 'the Opposition Division [to] take into account the pending invalidity proceedings against [the registration of the earlier marks in black and white]'. A second recommendation of suspension was, moreover, included in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, having regard to the final decision to be reached in the proceedings relating to the registration of the purely figurative mark €$ (see paragraphs 27 to 33 below).

Forms of order sought

20 The applicant claims that the Court should:

– annul the contested decisions;

– order EUIPO and the intervener to pay the costs, including the costs relating to the proceedings before EUIPO.

21 EUIPO and the intervener contend that the Court should:

– dismiss the actions;

– order the applicant to pay the costs.

Law

22 In accordance with Article 68 of the Rules of Procedure of the General Court, two or more cases concerning the same subject matter may at any time, either of the Court's own motion or on application by a main party, be joined, on account of the connection between them, for the purposes, alternatively or cumulatively, of the written or oral part of the procedure or of the decision which closes the proceedings.

23 In the light of the applicant's requests that the present cases be joined, the other parties were heard, following which the cases were joined, at first, for the purposes of the written part of the procedure and the oral part, if any, by decision of 10 April 2019.

24 The Court considers it appropriate also to join the present cases for the purposes of the decision which closes the proceedings.

25 In support of the actions, the applicant puts forward four pleas, alleging, in each case, respectively:

– First plea: infringement of Article 71(1)(a) of Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation 2017/1001 and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1), read in conjunction with Article 41(2) of the Charter of Fundamental Rights of the European Union ('the Charter');

– Second plea: infringement of Article 94(1) of Regulation 2017/1001, read in conjunction with Article 41(2) of the Charter;

– Third plea: infringement of the principles of equal treatment and sound administration; and

– Fourth plea: infringement of Article 8(1)(b) and (5) of Regulation 2017/1001.

The first plea in each case and the first part of the second plea in Case T-96/19 as well as the third part of the second plea in all the cases except Case T-96/19

26 By the first plea in each case and the first part of the second plea in Case T-96/19 as well as the third part of the second plea in all the cases except Case T-96/19, which it is appropriate to examine together, the applicant takes issue with the contested decisions, in essence, in that the Board of Appeal failed to suspend the appeal proceedings when it should have found that it was appropriate to do so, and failed to state to the requisite legal standard the grounds for deciding not to suspend the appeal proceedings.

Background

27 Those pleas and parts of pleas concern the passages of the contested decisions in which the Board of Appeal mentioned suspending the proceedings on account of various parallel proceedings pending before EUIPO, even though it examined the appeals brought before it.

28 The parallel proceedings in question included, first, two invalidity proceedings concerning the earlier marks in black and white, namely the intertwining circles and the black and white circles, the second of those marks having been taken into consideration for the comparison of the signs in the first 11 contested decisions, that is, all the contested decisions except that in Case T-96/19.

29 The parallel proceedings in question included, secondly, the proceedings relating to the registration of the purely figurative mark €$, which corresponds exactly to the figurative element of 4 of the 12 marks applied for, namely the marks applied for at issue in Cases T-84/19, T-92/19, T-96/19 and T-98/19.

30 The relevant passages of the contested decisions are, first, paragraph 13 of the first 11 contested decisions, in which the Board of Appeal noted that the two earlier marks in black and white, which it had regarded as the earlier marks most favourable to the intervener, were subject to invalidity proceedings that were already at an advanced stage before the decisions subject to the appeals were adopted by the Opposition Division, with the result that 'in the Board's opinion, it would be appropriate to suspend the present proceedings until a final, legally binding decision is reached in those [invalidity] proceedings'.

31 Furthermore, in those first 11 contested decisions, on the basis of an identical finding, the Board of Appeal '[recommended] suspending the opposition proceedings [concerned] until a final, legally binding decision concerning the validity of [the earlier rights on which the Opposition Division and the Board of Appeal itself based their decisions]' (see, for example, paragraph 53 of the contested decision in Case T-84/19 or paragraph 56 of the contested decision in Case T-98/19). It also implicitly expressed the same view in paragraph 61 of the 12th contested decision, at issue in Case T-96/19.

32 Secondly, in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, which relate to the four marks applied for in which the figurative element corresponds exactly to the purely figurative mark €$ subject to the earlier registration proceedings referred to in paragraph 5 above, the Board of Appeal found that 'the final decision [regarding the application for registration of the purely figurative mark €$ was] of utmost relevance for the current assessment[, so it found that it was] appropriate to wait for the final, legally binding decision in that [other] case, before assessing the distinctiveness of the figurative element [of the relevant marks applied for]' or '[that it was] appropriate to take the

final, legally binding decision [to be reached in that other case] into account when assessing the distinctiveness of the figurative element at issue' (see, respectively, paragraphs 35, 35, 39 and 38 of those contested decisions).

33 Furthermore, still in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, 'the Board [of Appeal sought] to draw the Opposition Division's attention to case … R 1345/2018-1, … pending before the First Board [of Appeal]' and '[recommended] suspending the current proceedings … until a final, legally binding [decision was reached in that other case]' (see, respectively, paragraphs 58, 57, 62 and 61 of those contested decisions).

34 In addition, in paragraphs 58, 62 and 61 of the contested decisions in Cases T-84/19, T-96/19 and T-98/19, the Board of Appeal added that, 'in the light of said [decision] and the fact that the [word] element [of the relevant mark applied for was weakly] distinctive in relation to a part of [the relevant public or goods and services in question], … the Opposition Division might even consider whether to reopen the examination [of the relevant marks applied for] based on absolute grounds'.

Arguments of the parties

35 By the first plea in each of the cases, the applicant claims, in essence, that, since the Board of Appeal made the findings referred to in paragraphs 30 to 33 above, it should have suspended the appeal proceedings in order to avoid infringing Article 71(1)(a) of Delegated Regulation 2018/625, the requirements of clarity, consistency and efficiency underpinning that provision and the principle of good administration enshrined in Article 41(2) of the Charter. In failing to do so, the Board of Appeal misused its powers. Moreover, the Board of Appeal failed to take the interest of the parties into account, although it is required to do so when deciding whether or not it is appropriate to suspend the proceedings. The applicant adds, in essence, that the Board of Appeal failed to state reasons for its final decision not to suspend the proceedings even though it had considered suspension to be appropriate.

36 By the third part of the second plea in Cases T-84/19, T-92/19 and T-98/19 and the first part of the second plea in Case T-96/19, cases in which the mark applied for at issue includes a figurative element identical to the purely figurative mark €$, the applicant submits that the contested decision is vitiated by contradictory reasoning. The contradiction lies in the fact that, successively, the Board of Appeal, on the one hand, found that it was appropriate to wait for a final decision to be reached in the parallel proceedings concerned, relating to the refusal to register the purely figurative mark €$ owing to a lack of distinctiveness, before assessing the distinctiveness of the identical figurative element of the marks applied for at issue in those four cases and, on the other hand, examined the appeal and, in that context, assessed the distinctiveness of that figurative element.

37 The third part of the second plea in the eight other cases also alleges contradictory reasoning. The contradiction lies in the fact that, successively, the Board of Appeal, on the one hand, found that it was appropriate to suspend the proceedings owing to the existence of two invalidity proceedings in which the distinctiveness of the two earlier marks in black and white was called into question, and, on the other hand, took into account one of those two earlier marks for the purposes of comparing the signs and, in that context, found that a minimum degree of distinctiveness had to be recognised in that mark on account of its registration.

38 EUIPO confines itself to submitting that the first plea is inadmissible on two grounds.

39 In the first place, that plea concerns paragraphs of the contested decisions that are not binding on the Opposition Division, to which the cases were remitted in accordance with Article 71(2) of Regulation 2017/1001. EUIPO contends that the Board of Appeal confined itself to giving recommendations to the Opposition Division regarding the suspension of the opposition proceedings.

40 In the second place, EUIPO submits that non-suspension of the proceedings before the Board of Appeal did not affect the applicant's interests because the parallel proceedings concerned would not have influenced the outcome of the opposition proceedings in question, with the result that the cases had in any event to be remitted to the Opposition Division. First, the oppositions at issue are also based on earlier marks other than the earlier marks in black and white that were subject to the two sets of invalidity proceedings. Secondly, as regards the third set of parallel proceedings, relating to the registration of the purely figurative mark €$, EUIPO contends that, even assuming that the identical figurative element of the four marks applied for in question is devoid of distinctive character, the signs at issue are still similar.

41 The intervener submits, moreover, that the first plea is unfounded because it is apparent inter alia from the case-law relating to Article 71(1) of Delegated Regulation 2018/625 that, in the light of the Board of Appeal's freedom to assess, it is not required to suspend the proceedings even where suspension is appropriate. Furthermore, the fact that the applicant did not repeat its request to suspend the proceedings before the Board of Appeal is the reason why the Board of Appeal did not state reasons for its decision not to suspend the proceedings, in the light of the interest of the parties. Lastly, the EUIPO guidelines, to which the applicant refers, do not prescribe suspension of the opposition proceedings where the validity of the earlier mark is contested and, in any event, are not binding on the Board of Appeal.

42 As regards the first or third part of the second plea, EUIPO contends that the applicant's criticisms stem from an incorrect reading of the contested decisions and the applicant's conflation of criticism concerning the obligation to state reasons and criticism as to whether the reasoning is well founded, although EUIPO concedes that, in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, the reasons for which the Board of Appeal suggested suspending the proceedings on account of the parallel proceedings relating to the registration of the purely figurative mark €$ are unclear.

43 For its part, the intervener submits that there is neither a failure to state reasons nor contradictory reasoning in the various elements put forward by the applicant, inter alia because it is consistent with the case-law that a minimum degree of distinctiveness is recognised in a registered trade mark even if its registration is subject to an application for a declaration of invalidity calling its distinctiveness into question, as is the case in respect of the earlier mark taken into consideration for the comparison of the signs in the first 11 contested decisions.

Findings of the Court

– Reminder of the legal framework and case-law

44 Under Article 71(1) of Delegated Regulation 2018/625, as regards opposition, revocation and declaration of invalidity and appeal proceedings, the competent department or Board of Appeal may suspend proceedings either of its own motion, where a suspension is appropriate under the circumstances of the case, or at the reasoned request of one of the parties in *inter partes* proceedings, where a suspension is appropriate under the circumstances of the case, taking into account the interests of the parties and the stage of the proceedings.

45 It follows from recital 17 of Delegated Regulation 2018/625 that Article 71(1) of that regulation is intended to increase the clarity, consistency and efficiency of opposition, revocation, invalidity and appeal proceedings. In that regard, it must be noted that, if the earlier mark relied on in support of an opposition loses its validity in the course of the proceedings, that opposition becomes devoid of purpose (see, to that effect, judgments of 25 November 2014, *Royalton Overseas* v *OHIM — S.C. Romarose Invest (KAISERHOFF)*, T-556/12, not published, EU:T:2014:985, paragraph 40 and the case-law cited, and of 14 February 2019, *Beko* v *EUIPO — Acer (ALTUS)*, T-162/18, not published, EU:T:2019:87, paragraph 42 and the case-law cited).

46 Furthermore, it follows from the wording of Article 71(1) of Delegated Regulation 2018/625 that the Board of Appeal has broad discretion in deciding whether or not to suspend the current proceedings, suspension remaining an option for the Board of Appeal (see, to that effect, judgment of 20 September 2017, *Jordi Nogues* v *EUIPO — Grupo Osborne (BADTORO)*, T-386/15, EU:T:2017:632, paragraph 21 and the case-law cited).

47 However, the fact that the Board of Appeal has broad discretion to suspend proceedings before it does not mean that its assessment falls outside the scope of judicial review by the Courts of the European Union. That fact does, however, restrict judicial review on the merits to ensuring that there is no manifest error of assessment or misuse of powers (see judgment of 20 September 2017, *BADTORO*, T-386/15, EU:T:2017:632, paragraph 22 and the case-law cited).

48 Thus, the existence of parallel proceedings the outcome of which is liable to have an impact on that of the appeal proceedings does not result in the appeal proceedings being automatically suspended and, accordingly, is not a sufficient basis, in itself, for categorising the fact that the Board of Appeal refrained from suspending the proceedings as a manifest error (see, to that effect, judgment of 25 November 2014, *KAISERHOFF*, T-556/12, not published, EU:T:2014:985, paragraph 33).

49 In the first place, there is no interest in suspending the proceedings if analysis shows that the outcome of the parallel proceedings would have no impact on the outcome of the opposition, which would be the case if the opposition had to be upheld on the basis of another earlier right that was not contested (see, to that effect, judgment of 20 September 2017, *BADTORO*, T-386/15, EU:T:2017:632, paragraph 17) or, on the contrary, if the opposition in any event had to be dismissed, for example where there is no similarity between the signs at issue, like the Opposition Division stated in the decisions which, in the present case, were appealed before the Board of Appeal, after finding that the marks at issue were not similar.

50 In the second place, in *inter partes* proceedings, the Board of Appeal must take into account the interest of each of the parties when exercising its discretion with respect to the suspension of the proceedings, and the decision whether or not to suspend the proceedings must follow upon a weighing up of the competing interests. Thus, even where there are parallel proceedings, the Board of Appeal may find that weighing up the interests involved requires, in any event, that the appeal proceedings not be suspended (see, to that effect, judgment of 25 November 2014, *KAISERHOFF*, T-556/12, not published, EU:T:2014:985, paragraphs 33 and 34).

51 In that regard, it has been held that, in weighing up the interests involved, the Board of Appeal must inter alia carry out the assessment, prima facie, of the likelihood that the potentially relevant parallel proceedings result in a decision that would have an impact on the appeal proceedings (see, to that effect, judgments of 17 February 2017, *Unilever* v *EUIPO — Technopharma (Fair & Lovely)*, T-811/14, not published, EU:T:2017:98, paragraph 67 and the case-law cited, and of 14 February 2019, *ALTUS*, T-162/18, not published, EU:T:2019:87, paragraph 44 and the case-law cited) and that, if that assessment results in the finding that that likelihood is low, the weighing up of the interests tends in favour of the opponent's legitimate interest in obtaining a decision on the opposition (see, to that effect, judgment of 21 October 2015, *Petco Animal Supplies Stores* v *OHIM — Gutiérrez Ariza (PETCO)*, T-664/13, EU:T:2015:791, paragraph 35).

52 However, where there is uncertainty as to the outcome of parallel proceedings calling into question the earlier mark relied on in support of an opposition, bringing opposition proceedings without awaiting the outcome of the parallel proceedings is, in principle, of no advantage to the proprietor of the earlier mark because, even if the opposition proceedings resulted in rejection of the application for registration of the later mark, there would be nothing to prevent the same application from being filed again once the earlier mark had been declared invalid (see, to that effect, judgment of 25 November 2014, *KAISERHOFF*, T-556/12, not published, EU:T:2014:985, paragraphs 41 and 50 and the case-law cited).

53 Furthermore, in the context of the review by the Courts of the European Union of Board of Appeal decisions concerning the possible suspension of proceedings, it is necessary to examine, inter alia, whether the evidence that the Board of Appeal took into consideration allowed it to conclude, without making a manifest error of assessment, that it was not necessary or, as the case may be, that it was necessary to suspend the proceedings before it (see, to that effect, judgment of 12 November 2015, *Société des produits Nestlé* v *OHIM — Terapia (ALETE)*, T-544/14, not published, EU:T:2015:842, paragraph 28).

54 In that regard, the Board of Appeal makes a manifest error of assessment inter alia where it bases its conclusion concerning the weighing up of the interests involved on an incorrect legal assessment of the facts or on imprecise facts, or fails to take into consideration all the relevant aspects of the parties' situation (see, to that effect, judgment of 14 February 2019, *ALTUS*, T-162/18, not published, EU:T:2019:87, paragraphs 41, 44, 47, 49 and 57 and the case-law cited; see also, by analogy, judgment of 26 September 2013, *Centrotherm Systemtechnik* v *OHIM and centrotherm Clean Solutions*, C-610/11 P, EU:C:2013:593, paragraphs 108, 110 and 116).

55 Moreover, it must be noted that, according to settled case-law, the examination of the question of whether to suspend the proceedings before the Board of Appeal must be carried out before the examination of whether there is a likelihood of confusion (see judgment of 8 September 2017, *Aldi* v *EUIPO — Rouard (GOURMET)*, T-572/15, not published, EU:T:2017:591, paragraph 24 and the case-law cited).

56 The decision to suspend appeal proceedings against a decision of the Opposition Division aims to avoid ruling on an opposition inter alia where the validity of an earlier mark on which the merits of the opposition depend is regarded as seriously undermined, in such a way as to make it possible to draw the appropriate consequences from the decision ruling definitively on the validity of that mark in the analysis of the merits of all the arguments put forward against the Opposition Division's decision (see, to that effect, judgment of 21 October 2015, *PETCO*, T-664/13, EU:T:2015:791, paragraph 29). Those considerations may be reconciled with the objective of clarity, consistency and efficiency set out in recital 17 of Delegated Regulation 2018/625.

57 Lastly, it should be recalled that, in cases in which an EU body has broad discretion, respect for the rights guaranteed by the EU legal order in administrative procedures is of even more fundamental importance. Those guarantees include, in particular, the obligation of the competent body to examine carefully and impartially all the relevant aspects of the individual case and the right of the persons concerned to have adequate reasons provided for the decision. Only in this way can the Courts of the European Union verify whether the factual and legal elements upon which the exercise of the discretion depends were present (judgment of 21 November 1991, *Technische Universität München*, C-269/90, EU:C:1991:438, paragraph 14).

– *Assessment in the present case*

58 It is common ground that, in the contested decisions, the Board of Appeal took into account the existence of three sets of parallel proceedings in connection with the question whether it was appropriate to suspend the appeal proceedings. Those proceedings were, first, two invalidity proceedings relating to the earlier marks in black and white and, secondly, proceedings relating to the refusal to register the purely figurative mark €$. In those three sets of proceedings, the distinctiveness of the marks concerned was called into question.

59 As regards the two sets of parallel invalidity proceedings relating to the earlier marks in black and white, the Board of Appeal stated as a preliminary point in the first 11 contested decisions that those proceedings 'were already at an advanced stage before the decision [of the Opposition Division] was

adopted' and that, 'consequently, … it would be appropriate to suspend the present proceedings until a final, legally binding decision is reached in those proceedings' (see, for example, paragraph 13 of the contested decisions in Cases T-84/19 and T-98/19).

60 Nevertheless, the Board of Appeal examined the appeals and found that, 'in any event, any sign registered as a European Union trade mark enjoys a degree of distinctiveness' and went on to state that 'therefore, the Board, for now, [took] the view that [the earlier mark representing two black and white circles had] some distinctiveness' (see, for example, paragraph 37 of the contested decision in Case T-84/19 or paragraph 40 of the contested decision in Case T-98/19).

61 By contrast, in paragraph 25 of the 12th contested decision, at issue in Case T-96/19, the Board of Appeal found that the earlier mark representing two black and white circles '[appeared] to have the most in common with the [relevant mark applied for]', but, 'given that that earlier right [was] … subject to invalidity proceedings', it decided to examine the appeal on the basis of another earlier mark.

62 Moreover, as follows from paragraph 31 above, in all of the contested decisions, including the decision at issue in Case T-96/19, the Board of Appeal recommended that the Opposition Division suspend the opposition proceedings until a final decision had been reached concerning the validity of the earlier marks in black and white.

63 As regards the parallel proceedings relating to the registration of the purely figurative mark €$, in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, the Board of Appeal found that 'the final decision in [those parallel proceedings was] of utmost relevance for the current assessment', namely the assessment of the distinctiveness of the figurative element of the relevant marks applied for in the comparison of the signs, and that, 'consequently, [it found that it was] appropriate to wait for the final, legally binding decision in [those parallel proceedings], before assessing the distinctiveness of the figurative element at issue' (see, for example, paragraph 35 of the contested decision in Case T-84/19 or paragraph 38 of the contested decision in Case T-98/19).

64 Nevertheless, the Board of Appeal examined the appeals before it and found that, in the figurative element of the marks applied for at issue in Cases T-84/19, T-92/19, T-96/19 and T-98/19, the elements '€' and '$' were not distinctive and the black and white circles were only weakly distinctive (see, for example, paragraphs 33 and 34 of the contested decision in Case T-84/19 or paragraphs 36 and 37 of the contested decision in Case T-98/19).

65 Moreover, also in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, the Board of Appeal recommended that the Opposition Division suspend the opposition proceedings until a final decision had been reached in the parallel proceedings concerned.

66 First of all, it must be stated that, contrary to what EUIPO contends in the first plea of inadmissibility relating to the first plea, the latter does not cover the fact that the Board of Appeal recommended that the Opposition Division to which the cases had been referred back suspend the opposition proceedings, but the fact that the Board of Appeal did not suspend the appeal proceedings.

67 It that regard, it is undisputed that the Board of Appeal, after setting out the grounds militating in favour of suspending the appeal proceedings, implicitly decided not to suspend them, in that it examined whether the appeals before it were well founded and upheld those appeals in order then to refer the cases back to the Opposition Division.

68 Accordingly, that plea of inadmissibility must be rejected as stemming from an incorrect reading of the first plea.

69 As to the substance, Article 71(1) of Delegated Regulation 2018/625 confers on the Board of Appeal the power to examine and assess, even of its own motion, whether a suspension of the appeal proceedings is appropriate under the circumstances of the case. It is clear from the contested decisions that the Board of Appeal exercised that power in each of the contested decisions.

70 First, the Board of Appeal found that it was appropriate to suspend the appeal proceedings in the contested decisions in all of the cases except the decision at issue in Case T-96/19, on account of invalidity proceedings relating to the earlier marks in black and white. Secondly, in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, it found that it was appropriate to wait until a decision was reached in the proceedings relating to the registration of the purely figurative mark €$ before carrying out an assessment which it was required to carry out (see, for example, paragraphs 13 and 35 of the contested decision in Case T-84/19).

71 Such findings corresponded to the assessment which, under Article 71(1) of Delegated Regulation 2018/625, was a condition of suspending the proceedings. Moreover, those findings necessarily meant that there were significant likelihoods that the parallel proceedings taken into account would lead to decisions that would have an impact on the appeal proceedings and that the weighing up of the interests involved tended in favour of the applicant.

72 Nevertheless, the Board of Appeal examined the appeals, without however stating reasons for its final decision not to suspend the proceedings, a decision which meant, on the contrary, that the weighing up of the interests involved must have tended in favour of the intervener. Moreover, the fact that the Board of Appeal ultimately recommended that the Opposition Division suspend the opposition proceedings suggests that, in the Board of Appeal's opinion, the weighing up of the interests involved would yet again tend in favour of the applicant once the appeal proceedings were closed.

73 It should be recalled that, in accordance with the case-law referred to in paragraph 57 above, respect for the right of the persons concerned to have adequate reasons provided for a decision that affects them is particularly important where that decision stems from a broad discretion, as is the case of a decision of the Board of Appeal as to the possible suspension of the proceedings before it.

74 In that regard, it has previously been held that general, categorical assertions do not in any way establish that the Board of Appeal effectively exercised a broad discretion that has been conferred on it (see, to that effect, judgment of 26 September 2013, *Centrotherm Systemtechnik* v *OHIM and centrotherm Clean Solutions*, C-610/11 P, EU:C:2013:593, paragraph 110). That must apply a fortiori where no reasoning is given in respect of the crucial assessment in the matter stemming from the weighing up of the interests involved, especially if, as in the present cases, a decision of the Board of Appeal contains ambivalent findings as to that assessment itself.

75 It must also be clarified that, even assuming that the fact that the Board of Appeal explicitly stated that it would be appropriate to suspend 'the present proceedings' (paragraph 13 of the first 11 contested decisions) or that the final decision on the application for registration of the purely figurative mark €$ was of utmost relevance 'for the current assessment' (paragraphs 35, 35, 39 and 38 of the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, respectively) is disregarded and that it might be considered that the Board of Appeal confined itself to recommending that the Opposition Division suspend the opposition proceedings, after finding, in absolute terms, that it was appropriate to suspend the proceedings, the Court would still have to hold that such an approach, aiming for a delayed application of Article 71(1) of Delegated Regulation 2018/625, is improper.

76 It follows from the case-law recalled in paragraphs 55 and 56 above, to the effect that the examination of the question of whether to suspend the appeal proceedings must be carried out first, that that suspension, if it is appropriate, must make it possible to take into account the impact of an expected decision in parallel proceedings on the merits of all the arguments put forward against the Opposition Division's decision. Consequently, if the Board of Appeal finds that it is appropriate to suspend the

proceedings, it has no other option than suspending them and may not therefore examine the appeal, even partially. Accordingly, in the present cases, since the Board of Appeal had found that it was appropriate to suspend the proceedings, it could not rule on the appeals and was, as a consequence, unable to make any recommendation whatsoever to the Opposition Division, since any referral of the cases to the latter would mean examining the appeals and would therefore stem from an error of law.

77 The pleas of inadmissibility raised by EUIPO as to the applicant's lack of interest are not such as to call those findings into question.

78 As regards, first, the assertion that the outcome of the proceedings relating to the purely figurative mark €$ has no impact on the Board of Appeal's conclusion regarding the comparison of the signs in the contested decisions in Cases T-84/19, T-92/19, T-96/19 and T-98/19, on the ground that the Board of Appeal would have been able to arrive at the same conclusion even if the figurative element of the relevant marks applied for was devoid of distinctive character, it must be stated that such an assessment cannot be found in those contested decisions. On the contrary, the Board of Appeal found in those decisions that the assessment of the distinctiveness of that figurative element that would result indirectly from the final decision to be reached in those parallel proceedings was of utmost relevance for the current assessment, namely the assessment relating to the comparison of the signs at issue.

79 In that regard, it should be recalled that EUIPO cannot underpin a decision contested before the Court with evidence that was not taken into account for the purposes of that decision (see judgment of 8 September 2017, *GOURMET*, T-572/15, not published, EU:T:2017:591, paragraph 36 and the case-law cited). That is especially the case regarding assessments in respect of which the Board of Appeal has broad discretion.

80 As regards, secondly, the fact that the oppositions at issue are based on earlier marks other than the two marks that were subject to parallel invalidity proceedings, it must be stated that, for reasons of procedural economy, the Board of Appeal carried out the comparison of the signs at issue by taking into account only one of those two marks in all of the contested decisions except the decision at issue in Case T-96/19, in which it carried out that comparison solely on the basis of another earlier mark.

81 Accordingly, in all of the cases except Case T-96/19, the fact that the opposition was also based on earlier marks other than the earlier mark exclusively taken into consideration by the Board of Appeal cannot establish that the error made by the Board of Appeal in not suspending the proceedings concerned had no specific impact (see, to that effect, judgment of 20 September 2017, *BADTORO*, T-386/15, EU:T:2017:632, paragraph 32).

82 As regards the 12th contested decision, at issue in Case T-96/19, the fact that, in that decision, the comparison of the signs was carried out on the basis of an earlier mark other than the two earlier marks that were subject to invalidity proceedings does not mean, however, that the Board of Appeal's error regarding the decision not to suspend the proceedings concerned in that case has no specific impact. It was stated in paragraph 78 above that it followed from the Board of Appeal's own findings in that decision that the other set of parallel proceedings, relating to the registration of the purely figurative mark €$, was liable to have an impact on its assessment. Furthermore, as follows from paragraph 31 above, the Board of Appeal also found in that contested decision that, even though, for the comparison of the signs, it had taken into account an earlier mark other than those covered by the parallel invalidity proceedings, it was nevertheless suggested to suspend the opposition proceedings until a final, legally binding decision was reached concerning the validity of the earlier marks called into question in the invalidity proceedings.

83 It follows from all of the foregoing that the first plea and, depending on the case, the first or the third part of the second plea in each case are well founded.

The other parts of the second plea and the third and fourth pleas in each case

84 Since the examination of the question of whether to suspend the proceedings must be carried out before the examination of whether there is a likelihood of confusion, the contested decisions must be annulled, without it being necessary to examine the other pleas or parts of pleas.

Costs

85 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

86 Under Article 138(3) of the Rules of Procedure, the Court may order an intervener other than those referred to in Article 138(1) and (2) to bear its own costs.

87 The applicant requested that the Court order EUIPO and the intervener to bear their own costs and to pay the applicant's costs, including those relating to the proceedings before EUIPO.

88 In that regard, it should be recalled that, under Article 190(2) of the Rules of Procedure, costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs. However, that does not apply to costs incurred for the purposes of the proceedings before the Opposition Division. Accordingly, the form of order sought by the applicant cannot be granted in so far as it covers the costs relating to the proceedings before the Opposition Division.

89 Consequently, since EUIPO has been unsuccessful, it must be ordered to bear its own costs and to pay the costs incurred by the applicant for the purposes of the proceedings before the Court, as requested by the applicant.

90 In the circumstances of the present dispute, the intervener must be ordered to bear its own costs in connection with the proceedings before the Court.

91 As regards the claim that EUIPO and the intervener should be ordered to pay the costs of the proceedings before the Board of Appeal, it is for the Board of Appeal to rule, in the light of the present judgment, on the costs relating to those proceedings.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

1. **Joins Cases T-84/19 and T-88/19 to T-98/19 for the purposes of the judgment;**

2. **Annuls the decisions of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 7 December 2018 (Cases R 1062/2018-2, R 1059/2018-2, R 1058/2018-2, R 1057/2018-2, R 1056/2018-2, R 1060/2018-2, R 1055/2018-2, R 1054/2018-2, R 1053/2018-2, R 986/2018-2, R 1063/2018-2 and R 1064/2018-2);**

3. **Orders EUIPO to bear its own costs and to pay those incurred by Cinkciarz.pl sp. z o.o. for the purposes of the proceedings before the Court;**

4. **Orders MasterCard International, Inc. to bear its own costs relating to the proceedings before the Court.**

Svenningsen Barents Mac Eochaidh

Delivered in open court in Luxembourg on 28 May 2020.

E. Coulon
Registrar

M. van der Woude
President