

Court of Justice EU, 5 juli 2018, Jägermeister v EUIPO



DESIGN LAW

Representation of a design for which registration is sought requires article 36(1)(c) of the Community Designs Regulation to clearly identify that design

• Accordingly, it is apparent from paragraphs 49 to 59 of the present judgment that the literal, teleological and contextual analysis of Article 36(1)(c) of Regulation No 6/2002 leads to the conclusion that that provision must be interpreted as requiring the representation of a design for which registration is sought to clearly identify that design, which is the subject of the protection sought by that application.

Source: curia.europa.eu

Court of Justice EU, 5 juli 2018

(C. Vajda, E. Juhász and C. Lycourgos (Rapporteur))

Provisional text

JUDGMENT OF THE COURT (Ninth Chamber)

5 July 2018 (*)

(Appeal — Community design — Application for registration of designs representing beakers — Regulation (EC) No 6/2002 — Article 36(1)(c) — Graphic representation — Articles 45 and 46 — Attribution of a date of filing — Conditions — Regulation (EC) No 2245/2002 — Article 4(1)(e) and Article 10(1) and (2))

In Case C-217/17 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought by fax on 21 April 2017, the original of which was lodged on 25 April 2017,

Mast-Jägermeister SE, established in Wolfenbüttel (Germany), represented by C. Drzymalla, Rechtsanwalt,

appellant,

the other party to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by S. Hanne, acting as Agent, defendant at first instance,

THE COURT (Ninth Chamber),

composed of C. Vajda, President of the Chamber, E.

Juhász and C. Lycourgos (Rapporteur), Judges,

Advocate General: J. Kokott,

Registrar: R. Schiano, Administrator,

having regard to the written procedure and further to the hearing on 7 February 2018, after hearing the Opinion of the Advocate General at the sitting on 22 February 2018, gives the following

Judgment

1 By its appeal, Mast-Jägermeister SE requests the Court to set aside the judgment of the General Court of the European Union of 9 February 2017, Mast-Jägermeister v EUIPO (Beakers) (T-16/16, ‘the judgment under appeal’, EU:T:2017:68), by which the General Court dismissed its action for annulment of the decision of the Third Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 17 November 2015 (Case R 1842/2015-3) regarding applications to register beakers as Community designs (‘the decision at issue’).

Legal context

International law

2 The Paris Convention for the Protection of Industrial Property was signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaties Series, vol. 828, No 11851, p. 305, ‘the Paris Convention’). Article 4(A) of that convention, which governs the right of priority that arises from an application for registration of an intellectual property right, provides:

‘(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.’

EU law

Regulation (EC) No 6/2002

3 Article 36 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), entitled ‘Conditions with which applications must comply’, provides:

‘1. An application for a registered Community design shall contain:

(a) a request for registration;

(b) information identifying the applicant;

(c) a representation of the design suitable for reproduction. However, if the object of the application is a two-dimensional design and the application contains a request for deferment of publication in accordance with Article 50, the representation of the design may be replaced by a specimen.

2. The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

...

5. The application shall comply with the conditions laid down in the implementing regulation.

...'

4 Article 38(1) of that regulation defines the date of filing of an application for registration of a Community design as follows:

'The date of filing of an application for a registered Community design shall be the date on which documents containing the information specified in Article 36(1) are filed with [EUIPO] ...'

5 Article 41 of the regulation, headed 'Right of priority', provides:

'1. A person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation [(WTO), signed in Marrakesh on 15 April 1994], or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application.

2. Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.

3. "Regular national filing" means any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

...'

6 Title V of Regulation No 6/2002, entitled 'Registration procedure', comprises Articles 45 to 50.

7 Article 45 of Regulation No 6/2002, entitled 'Examination as to formal requirements for filing', provides:

'1. [EUIPO] shall examine whether the application complies with the requirements laid down in Article 36(1) for the accordancy of a date of filing.

2. [EUIPO] shall examine whether:

(a) the application complies with the other requirements laid down in Article 36(2), (3), (4) and (5) and, in the case of a multiple application, Article 37(1) and (2);

(b) the application meets the formal requirements laid down in the implementing regulation for the implementation of Articles 36 and 37;

(c) the requirements of Article 77(2) are satisfied;

(d) the requirements concerning the claim to priority are satisfied, if a priority is claimed.

3. The conditions for the examination as to the formal requirements for filing shall be laid down in the implementing regulation.'

8 Article 46 of that regulation, entitled 'Remediable deficiencies', provides:

'1. Where, in carrying out the examination under Article 45, [EUIPO] notes that there are deficiencies

which may be corrected, [EUIPO] shall request the applicant to remedy them within the prescribed period.

2. If the deficiencies concern the requirements referred to in Article 36(1) and the applicant complies with [EUIPO's] request within the prescribed period, [EUIPO] shall accord as the date of filing the date on which the deficiencies are remedied. If the deficiencies are not remedied within the prescribed period, the application shall not be dealt with as an application for a registered Community design.

3. If the deficiencies concern the requirements, including the payment of fees, as referred to in Article 45(2)(a), (b) and (c) and the applicant complies with [EUIPO's] request within the prescribed period, [EUIPO] shall accord as the date of filing the date on which the application was originally filed. If the deficiencies or the default in payment are not remedied within the prescribed period, [EUIPO] shall refuse the application.

4. If the deficiencies concern the requirements referred to in Article 45(2)(d), failure to remedy them within the prescribed period shall result in the loss of the right of priority for the application.'

9 Article 47 of that regulation, entitled 'Grounds for non-registrability', states:

'1. If [EUIPO], in carrying out the examination pursuant to Article 45, notices that the design for which protection is sought:

(a) does not correspond to the definition under Article 3(a); or

(b) is contrary to public policy or to accepted principles of morality,

[EUIPO] shall refuse the application.'

2. The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations.'

Regulation (EC) No 2245/2002

10 Article 4 of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Regulation No 6/2002 (OJ 2002 L 341, p. 28), entitled 'Representation of the design', provides in paragraph 1: 'The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour. It shall meet the following requirements:

...

(e) the design shall be reproduced on a neutral background and shall not be retouched with ink or correcting fluid. It shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of Community Designs provided for in Article 72 of Regulation (EC) No 6/2002 ...'

11 Article 10 of that regulation, entitled 'Examination of requirements for a filing date and of formal requirements', states in paragraphs 1 and 2:

‘1. [EUIPO] shall notify the applicant that a date of filing cannot be granted if the application does not contain:

(a) a request for registration of the design as a registered Community design;

(b) information identifying the applicant;

(c) a representation of the design pursuant to Article 4(1)(d) and (e) or, where applicable, a specimen.

2. If the deficiencies indicated in paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing.

If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community design application. Any fees paid shall be refunded.’

12 Article 12 of that regulation, entitled ‘Withdrawal or correction of the application’, provides in paragraph 2:

‘Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design.’

Background to the dispute

13 On 17 April 2015, the appellant, Mast-Jägermeister, filed applications for registration of two Community designs with EUIPO, under Regulation No 6/2002.

14 The products in respect of which the applications for registration were made are ‘beakers’ in Class 07.01 of the Locarno Agreement of 8 October 1968 establishing an international classification for industrial designs, as amended.

15 By an initial examination report drawn up on 17 April 2015, the examiner informed the appellant that, with regard to both designs, the indication of the product, namely the ‘beakers’ in respect of which protection was sought, did not correspond to the representations filed, on the ground that those representations also showed bottles. He therefore suggested that the appellant add the indication ‘Bottles’ in Class 09.01 of the Locarno Agreement to the two designs. The examiner added that, since ‘Beakers’ and ‘Bottles’ belonged to different classes, the multiple application had to be divided. He stated that, unless the deficiencies were remedied within the prescribed period, the application would be refused.

16 By letter of 21 April 2015, the appellant replied that no protection was sought for the bottles reproduced in the representation, and it accordingly proposed to specify the indication of the products as follows: ‘Drinking beakers as receptacles for a bottle which is part of those beakers’. It added that Class 07.01 of the Locarno Agreement also appeared to be the appropriate class for that indication.

17 By a second examination report of 25 June 2015, the examiner replied that, following the letter of 21 April 2015 and the telephone conversation which he had had with the appellant, it was clear that the latter was not seeking any protection for the bottles. However, according to the examiner, those bottles appeared clearly on the representations and a further examination

revealed that the applications for registration did not contain representations consistent with Article 4(1)(e) of Regulation No 2245/2002. He therefore considered that, because of the presence of the bottles, the characteristics for which protection was sought were not clearly visible. He added that this could be remedied by the filing of new views in which the required characteristics would be outlined by dotted lines or coloured borders. He stated that no date of filing could be attributed to the applications while the deficiencies remained unremedied. He concluded by indicating that, if the deficiencies were remedied within the prescribed period, the date on which the new views were submitted would be recognised as the date of filing, but that, failing this, the applications for registration would be regarded as not having been filed.

18 By letter of 14 July 2015, the appellant replied that the conditions for the attribution of a date of filing were satisfied, since the representations filed showed the designs against a neutral background. It stated that Article 4(1)(e) of Regulation No 2245/2002 related to the quality of representations and not to their content. Accordingly, it did not file new views.

19 By a third examination report of 16 July 2015, the examiner stated that he was maintaining his examination report of 25 June 2015, since the representations showed a beaker and a bottle.

20 By letter of 21 August 2015, the appellant, with reference to a telephone conversation which it had had with the examiner, replied that it did not understand why the date of filing could be maintained in the event of the addition of a product indication or in the event of the division of the multiple application, but not for the views originally filed. The appellant requested the adoption of a decision against which an appeal might be brought in the event that the examination decision was not annulled.

21 By a fourth examination report of 24 August 2015, the examiner informed the appellant that the deficiencies in the applications could be remedied either by the filing of new views or by the addition of the indication ‘Bottles’ and the division of the multiple application.

22 By letter of 28 August 2015, the appellant requested the adoption of a decision against which an appeal might be brought.

23 By decision of 31 August 2015, the examiner noted that the appellant had not remedied the deficiencies in the applications, as it did not agree with the examination report. The examiner took the view, pursuant to Article 46(2) of Regulation No 6/2002 and Article 10(2) of Regulation No 2245/2002, that both Community design applications could not be regarded as applications for Community designs, with the result that no date of filing could be attributed. In addition, it ordered a refund of the amount of the fee paid.

24 On 15 September 2015, the appellant filed a notice of appeal with EUIPO, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the examiner’s decision.

25 The Third Board of Appeal of EUIPO confirmed, in paragraph 15 of the decision at issue, that it was not

possible to determine from the representation of the two designs concerned whether protection was being sought for the beaker, for the bottle, or for a combination of the two. It stated in paragraph 16 of the decision at issue that the representation to be filed with the application, pursuant to Article 36(1)(c) of Regulation No 6/2002, serves to identify the design for which protection is sought and is a condition for the attribution of a date of filing, in accordance with Article 38(1) of that regulation. The date of filing determines the priority in time of the registered design, and both novelty and individual character are determined on the basis of earlier designs disclosed before the date of filing. The Board of Appeal added that, pursuant to Article 4(1)(e) of Regulation No 2245/2002, the representation has to permit all the details of the matter for which protection is sought to be distinguished clearly.

26 The Board of Appeal added, in paragraphs 17 and 18 of the decision at issue, that the assertion that the subject of the protection of the applications filed was clearly evident from the representations was at variance with the appellant's own account and that the latter's proposal for indicating the products concerned was not capable of remedying the deficiencies in the representation of the designs, because it could not be used to determine the scope of protection.

The proceedings before the General Court and the judgment under appeal

27 By application lodged at the Registry of the General Court on 19 January 2016, Mast-Jägermeister brought an action for annulment of the decision at issue.

28 It put forward two pleas in law in support of its action. The first plea alleged infringement of Articles 45 and 46 of Regulation No 6/2002, read in conjunction with Article 36 of that regulation, and the second plea alleged infringement of the rights of defence.

29 By the judgment under appeal, the General Court dismissed both pleas and, therefore, the action in its entirety. In particular, the General Court interpreted Article 36(1)(c) of Regulation No 6/2002 as meaning, as EUIPO had submitted, that the scope of that provision also covers a lack of precision, certainty or clarity regarding the matter to be protected by the design for which registration is sought.

Forms of order sought by the parties

30 By its appeal, Mast-Jägermeister claims that the Court should:

- set aside the judgment under appeal; and
- should the appeal be declared well founded, uphold the first and third heads of claim set out in the action at first instance.

31 EUIPO contends that the Court should:

- dismiss the appeal; and
- order the appellant to pay the costs.

The appeal

32 Mast-Jägermeister relies on a single ground of appeal, alleging infringement of Articles 45 and 46 of Regulation No 6/2002, read in conjunction with Articles 36 and 38 of that regulation.

Arguments of the parties

33 According to Mast-Jägermeister, it is apparent from the spirit and purpose of Articles 36 and 38 of Regulation No 6/2002 and Article 4(1)(e) and Article 10(1)(c) and (2) of Regulation No 2245/2002 that the attribution of a date of filing is to depend only on an examination of the representation of the design from the perspective of whether it can physically be reproduced.

34 First, Mast-Jägermeister relies on the wording of Article 36(1)(c) of Regulation No 6/2002 and on the Proposal for a European Parliament and Council Regulation on the Community Design (OJ 1994 C 29, p. 20) in order to submit that that provision refers only to whether the representation of a design can physically be reproduced so that it can be published in the Register of Community Designs.

35 Mast-Jägermeister submits that the question of whether the representations of the designs for which registration has been sought do not make it possible to determine whether, in the present case, the protection is sought for the beaker, the bottle or a combination of the two concerns the assessment of the scope of the protection of the registered design in the context of any infringement proceedings and, consequently, does not prevent the attribution of a date of filing. In that respect, it does not follow from Article 4(1)(e) of Regulation No 2245/2002 that the representation of the design concerned must not leave any room whatsoever for doubt as regards the matter for which the protection is sought.

36 Next, Mast-Jägermeister stresses the importance of the date of filing of an application for a Community design, which, amongst other legal effects, determines the start of the priority period within which the applicant has the possibility of filing abroad subsequent applications for his design and of claiming, for that purpose, the priority of the application for a Community design. In that regard, Mast-Jägermeister refers to Article 4 of the Paris Convention, which concerns the right of priority in the context of that convention. Due to the importance of the right of priority, the date of filing of the application for registration should be established within the shortest time frame possible, enabling the creator of the design to make it accessible to the public without his own disclosure of the design invalidating subsequent applications filed abroad.

37 Consequently, the appellant challenges paragraphs 35 and 36 of the judgment under appeal, by which the General Court held that it is apparent from the structure of Regulation No 6/2002 that, during the procedure for examining designs, EUIPO must first determine that the application for registration concerns a design and that it is contrary neither to public policy nor to accepted principles of morality and must then verify that the application for registration satisfies the mandatory conditions established by Article 36(1) of Regulation No 6/2002. According to the appellant, nothing of the kind is apparent from the structure of Regulation No 6/2002 and that interpretation

contradicts the desire to obtain legal certainty for the applicant quickly.

38 According to Mast-Jägermeister, the examination of whether the application can be attributed a date of filing is the most urgent and most simple examination. It is necessary only to verify whether the three conditions established by Article 36(1) of Regulation No 6/2002 are met. In that respect, it is not possible for the EU legislature to have actually wanted it to be verified, in any event, at the outset whether the application concerns a design and, as the case may be, whether the design is contrary to public policy or to accepted principles of morality, when that is a question that is difficult to answer and merits a thorough examination.

39 It submits that a distinction should be drawn between the conditions for the attribution of the date of filing which are laid down in Article 36(1) of Regulation No 6/2002 and the formal requirements applicable to the reproduction in order for registration of a design to be allowed. In that regard, the assessments of the Board of Appeal of EUIPO and the General Court may, in any event, be taken into account in order to determine whether the design is registrable, but not at the stage of attribution of a date of filing.

40 Furthermore, as regards the assessment of the Board of Appeal and the General Court that the representation must enable all the details of the matter for which protection is sought to be clearly and precisely distinguished, Mast-Jägermeister submits that, if Article 4(1)(e) of Regulation No 2245/2002 were to be interpreted as granting EUIPO a power of substantive review in relation to the representation of the design, it would be EUIPO, and not the applicant, that would determine the subject of the application for registration. However, through the nature of the representation, the applicant determines the subject of his application for registration of a Community design. The characteristics which are not identifiable on a representation do not benefit from protection.

41 Mast-Jägermeister contends that, although any office responsible for the examination of an application for registration can refuse the registration of a design and, therefore, reject an application for registration of a design when it considers that registration will generate legal uncertainty, that requirement of legal certainty should, however, be considered completely separately from the legal certainty conferred on the applicant by the fact that his application is, at least, attributed a date of filing.

42 Mast-Jägermeister submits that the deficiency found by the Board of Appeal of EUIPO does not constitute a ground for refusing the attribution of a date of filing. According to Mast-Jägermeister, combined products, made up of two or more products which can be handled or marketed separately, can also be protected, since it is the appearance of a whole or part of a product, represented in a visible manner in the application, that is the matter protected by a registered design, in accordance with Article 3(a) of Regulation No 6/2002.

43 Finally, Mast-Jägermeister refers to the considerations relating to the structure of Regulations No 6/2002 and No 2245/2002. It states that Article 46(2) of Regulation No 6/2002 expressly provides that only deficiencies in the application, within the meaning of Article 36(1) of that regulation, justify an application not being dealt with as an application for a Community design and, consequently, a date of filing not being attributed. On the other hand, the deficiencies referred to in Article 46(3) of Regulation No 6/2002 result in the rejection of the application for registration, which presupposes that a date of filing was determined previously. Mast-Jägermeister states that those deficiencies include the deficiencies referred to in Article 45(2)(a) of Regulation No 6/2002, and that provision refers to the requirements laid down in Article 36(5) of Regulation No 6/2002, which itself requires the application for registration to comply with the conditions laid down in Regulation No 2245/2002. Consequently, any deficiency in the application in the light of Article 4(1)(e) of Regulation No 2245/2002 can only lead to the rejection of the application for registration, after a date of filing has been attributed.

44 In that regard, Mast-Jägermeister accepts that, if Article 10(1)(c) and (2) of Regulation 2245/2002 were interpreted in conjunction with Article 4(1)(e) of that regulation, a conflict with the provisions of Article 46(2) and (3) of Regulation No 6/2002 could arise. However, it is necessary to interpret the provisions of Regulation No 2245/2002, which is an implementing regulation, in the light of those of its basic regulation, namely Regulation No 6/2002.

45 EUIPO submits that the General Court has not erred in law in its interpretation of Regulations No 6/2002 and No 2245/2002. It therefore contends that the sole ground of appeal is unfounded and that the appeal must be dismissed.

Findings of the Court

46 By its sole ground of appeal, Mast-Jägermeister submits, in essence, that Article 36(1)(c) of Regulation No 6/2002, read in the light of the other relevant provisions of that regulation and of Regulation No 2245/2002, must be interpreted as meaning that the attribution of a date of filing depends only on an examination of the representation of the design from the perspective of whether it can be physically reproduced. Accordingly, it contends that the General Court erred in law by holding that Article 36(1)(c) also covers a lack of precision, certainty or clarity regarding the matter to be protected by the design for which registration is sought.

47 For the purposes of the analysis of the merits of this ground of appeal, Article 36(1)(c) of Regulation No 6/2002 should be interpreted, according to which the application for registration of a Community design must contain '*a representation of the design suitable for reproduction*'.

48 According to settled case-law of the Court of Justice, the interpretation of provisions of EU law requires account to be taken not only of their wording but also of the context in which they occur and the

objectives of the rules of which they form part (judgments of 19 September 2000, Germany v Commission, C-156/98, EU:C:2000:467, paragraph 50, and of [19 October 2017, Raimund, C-425/16, EU:C:2017:776](#), paragraph 22).

49 As regards, first, the wording of Article 36(1)(c) of Regulation No 6/2002, it provides that the application for registration of a design must contain a '*representation of the design suitable for reproduction*'. That wording seems to emphasise the technical quality of the representation. However, as the Advocate General noted in point 32 of her Opinion, the concept of representation encompasses, in itself, the idea that the design must be clearly identifiable.

50 In addition, it should be noted that, whilst Article 4(1)(e) of Regulation No 2245/2002 does not add substantive requirements to that of Article 36(1)(c) of Regulation No 6/2002, it states, inter alia, that the representation must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished.

51 Analysis of the wording of Article 36(1)(c) therefore leads to the conclusion that the representation of the design for which registration is sought must enable that design to be clearly identified.

52 The literal interpretation of Article 36(1)(c) of Regulation No 6/2002 is confirmed by the teleological interpretation of that provision, which must contribute to the proper functioning of the system of registration of designs. Accordingly, the function of the graphic representation requirement is, in particular, to define the design itself in order to determine the precise subject of the protection afforded by the registered design to its proprietor (see, by analogy, judgment of [12 December 2002, Sieckmann, C-273/00, EU:C:2002:748](#), paragraph 48).

53 In that regard, it should be noted that the entry of a design in a public register has the aim of making it accessible to the competent authorities and the public, particularly to economic operators. On the one hand, the competent authorities must know with clarity and precision the nature of the constituent elements of a design in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and to the publication and maintenance of an appropriate and precise register of designs (see, by analogy, judgments of [12 December 2002, Sieckmann, C-273/00, EU:C:2002:748](#), paragraphs 49 and 50, and of [19 June 2012, Chartered Institute of Patent Attorneys, C-307/10, EU:C:2012:361](#), paragraph 47).

54 On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to obtain relevant information about the rights of third parties (see, by analogy, judgments of [12 December 2002, Sieckmann, C-273/00, EU:C:2002:748](#), paragraph 51, and of [19 June 2012, Chartered Institute of Patent Attorneys, C-307/10, EU:C:2012:361](#), paragraph 48).

Such a requirement, as the General Court points out, in essence, in paragraph 47 of the judgment under appeal, is intended to ensure legal certainty for third parties.

55 It follows that the Community design system arising from Regulation No 6/2002 confirms the interpretation that results from the wording of Article 36(1)(c) of that regulation by requiring that the representation of a design for which registration is sought makes it possible to identify that design clearly.

56 That conclusion is indeed also confirmed by the fact that the obtaining of a date of filing, which, in accordance with Article 38 of Regulation No 6/2002, is the date on which documents containing the information specified in Article 36(1) are filed with EUIPO, enables the proprietor of the design concerned to benefit from the right of priority, as provided for in Article 41 of Regulation No 6/2002. Contrary to Mast-Jägermeister's contention on the basis of Article 4 of the Paris Convention, the wording of which corresponds, in essence, to that of Article 41 of Regulation No 6/2002, the fact that the date of filing enables that right of priority to be obtained justifies in itself the requirement that the representation must not lack precision as regards the design for which registration is sought. As the Advocate General noted, in essence, in point 55 of her Opinion, an imprecise application for registration would give rise to the risk that a design in respect of which the matter to be protected is not clearly identified would obtain excessive protection under the right of priority.

57 Finally, the interpretation that Article 36(1)(c) of Regulation No 6/2002 requires the representation of the design contained in the application for registration to enable the matter for which protection is sought to be clearly identified is also confirmed by the contextual analysis of that provision.

58 In that respect, since Article 36(5) of Regulation No 6/2002 provides that the application for registration must comply with the conditions laid down in Regulation No 2245/2002, reference should be made to other provisions of the latter regulation relating to the application for registration.

59 Thus, it should be noted, as EUIPO correctly submits, that Article 12(2) of Regulation No 2245/2002 provides that a correction of the application for registration cannot change the representation of the design concerned. That necessarily implies that, before the application for registration can obtain a date of filing, it must contain a representation that enables the matter for which protection is sought to be identified. It is not possible to interpret Regulation No 6/2002 as allowing an application for registration to be considered validly filed when it does not enable the design for which registration is sought to be clearly identified and that deficiency can no longer be remedied.

60 Accordingly, it is apparent from paragraphs 49 to 59 of the present judgment that the literal, teleological and contextual analysis of Article 36(1)(c) of Regulation No 6/2002 leads to the conclusion that that provision must be interpreted as requiring the representation of a

design for which registration is sought to clearly identify that design, which is the subject of the protection sought by that application.

61 It follows from Article 46(2) of Regulation No 6/2002 that an application which contains deficiencies relating to the requirements referred to in Article 36(1) of that regulation that have not been remedied within the prescribed period is not to be dealt with as an application for a registered Community design and that, consequently, no date of filing is attributed to it.

62 Mast-Jägermeister's arguments, summarised in paragraph 43 of the present judgment, concerning the link between the various provisions of Articles 45 and 46 of Regulation No 6/2002 cannot succeed. The application made by Mast-Jägermeister contains a deficiency in the light of Article 36(1) of Regulation No 6/2002 since that application does not enable the design for which registration is sought to be identified clearly. As is apparent from the preceding paragraph of this judgment, under Article 46(2) of Regulation No 6/2002 such a deficiency means that the application concerned is not to be dealt with as an application for a registered Community design if that deficiency has not been remedied within the prescribed period.

63 Furthermore, the argument concerning paragraphs 35 and 36 of the judgment under appeal, in which the General Court explains the procedure for examining designs, must be rejected as being ineffective, since the assessment contained in those paragraphs does not appear necessary to support its interpretation of Article 36(1)(c) of Regulation No 6/2002, which results from the assessments in paragraphs 40 to 46 of that judgment.

64 It follows from the above considerations that Mast-Jägermeister's sole ground of appeal is unfounded and, consequently, it must be dismissed and the appeal must be dismissed in its entirety.

Costs

65 Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is unfounded, the Court is to make a decision as to the costs.

66 Under Article 138(1) of those rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

67 Since EUIPO has applied for costs and the appellant's sole ground of appeal has been unsuccessful, the appellant must be ordered to pay the costs incurred by EUIPO.

On those grounds, the Court (Ninth Chamber) hereby:

1. Dismisses the appeal;
2. Orders Mast-Jägermeister SE to pay the costs.

[Signatures]

* Language of the case: German.

Opinion of A-G Kokott

delivered on 22 February 2018 (1)

Case C-217/17 P

Mast-Jägermeister SE

v

European Intellectual Property Office (EUIPO)
(Appeal — Regulation (EC) No 6/2002 — Community design — Application for registration — Refusal to accord a date of filing — Representation of the design — Clarity of the representation)

I. Introduction

1. One might have expected the Courts of the European Union to have exhaustively considered most issues relating to applications to register intellectual property rights on account of the large number of cases relating to the European Union trade mark. However, the present appeal relating to a design concerns, with the attribution of a date of filing and the associated priority, a set of questions on which, as yet, there has been scarcely any case-law.

2. This case concerns the requirements to be placed on an application for registration of a design for the European Office Intellectual Property Office (EUIPO) to attribute a filing date to it. Whilst the appellant, Mast-Jägermeister, considers that only certain technical requirements on the design are justified, EUIPO and the Court of Justice require that it be unequivocal also in terms of its content.

II. Legal context

A. International law

3. Article 4(A) of the Paris Convention (2) lays down the right of priority which arises from the registration of intellectual property.

'A. [National filing]

(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.'

B. EU design

4. Article 3(a) of the Designs Regulation (3) defines as a 'design' 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

5. Article 36 of the Designs Regulation lays down the conditions with which applications for a design must comply:

'(1) An application for a registered Community design shall contain:

...

(c) a representation of the design suitable for reproduction. ...

(2) The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

(3) ...

(4) ...

(5) The application shall comply with the conditions laid down in the implementing regulation.

(6) ...'

6. Article 38(1) defines the date of filing of an application for a design:

'The date of filing of an application for a registered Community design shall be the date on which documents containing the information specified in Article 36(1) are filed with [EUIPO] ...'

7. Article 41(1) to (3) of the Designs Regulation essentially corresponds to Article 4(A) of the Paris Convention.

8. The examination as to formal requirements for filing forms the subject matter of Article 45 of the Designs Regulation:

'(1) [EUIPO] shall examine whether the application complies with the requirements laid down in Article 36(1) for the accordance of a date of filing.

(2) [EUIPO] shall examine whether:

(a) the application complies with the other requirements laid down in Article 36(2), (3), (4) and (5) ...;

(b) the application meets the formal requirements laid down in the implementing regulation for the implementation of Articles 36 and 37;

(c) the requirements of Article 77(2) are satisfied;

(d) the requirements concerning the claim to priority are satisfied, if a priority is claimed.

(3) The conditions for the examination as to the formal requirements for filing shall be laid down in the implementing regulation.'

9. Article 46 of the Designs Regulation stipulates which deficiencies are remediable:

'(1) Where, in carrying out the examination under Article 45, [EUIPO] notes that there are deficiencies which may be corrected, the Office shall request the applicant to remedy them within the prescribed period.

(2) If the deficiencies concern the requirements referred to in Article 36(1) and the applicant complies with [EUIPO's] request within the prescribed period, [EUIPO] shall accord as the date of filing the date on which the deficiencies are remedied. If the deficiencies are not remedied within the prescribed period, the application shall not be dealt with as an application for a registered Community design.

(3) If the deficiencies concern the requirements, including the payment of fees, as referred to in Article 45(2)(a), (b) and (c) and the applicant complies with [EUIPO's] request within the prescribed period, [EUIPO] shall accord as the date of filing the date on which the application was originally filed. If the deficiencies or the default in payment are not remedied within the prescribed period, [EUIPO] shall refuse the application.

(4) If the deficiencies concern the requirements referred to in Article 45(2)(d), failure to remedy them

within the prescribed period shall result in the loss of the right of priority for the application.'

10. Article 47 of the Designs Regulation sets out the grounds for non-registrability:

'(1) If [EUIPO], in carrying out the examination pursuant to Article 45, notices that the design for which protection is sought:

(a) does not correspond to the definition under Article 3(a); or

(b) is contrary to public policy or to accepted principles of morality,
it shall refuse the application.

(2) The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations.'

11. Article 4 of the Implementing Regulation (4) specifies the requirements for the representation of the design:

'(1) The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour. It shall meet the following requirements:

...

(e) the design shall be reproduced on a neutral background and shall not be retouched with ink or correcting fluid. It shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of Community Designs ...'

12. Article 10 of the Implementing Regulation contains further rules on examination of requirements for a filing date and of formal requirements:

'(1) [EUIPO] shall notify the applicant that a date of filing cannot be granted if the application does not contain:

(a) ...

(b) ...

(c) a representation of the design pursuant to Article 4(1)(d) and (e) or, where applicable, a specimen.

(2) If the deficiencies indicated in paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing.

If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community design application. Any fees paid shall be refunded.'

III. Background to the dispute

13. On 17 April 2015 Mast-Jägermeister filed an application for registration of the Community design at issue with EUIPO, pursuant to the Designs Regulation. To that end, it submitted representations showing beakers and the well-known bottles of the alcoholic beverage which it produces. These representations are not reproduced in the judgment as they were classified as 'confidential'.

14. The goods in respect of which the applications for registration were made are 'beakers' in Class 07.01 of

the Locarno Agreement of 8 October 1968 establishing an international classification for industrial designs, as amended.

15. Between 17 April and 31 August 2015 the EUIPO examiner had intensive communications with Mast-Jägermeister and drew up a total four examination reports, all of which concluded that the representation of the design was not sufficiently clear on account of the bottles depicted.

16. Since Mast-Jägermeister did not rectify that objection, the examiner noted, by decision of 31 August 2015, that it had not remedied the defects in the applications for registration, as it did not approve of the examination report. The examiner took the view, pursuant to Article 46(2) of the Designs Regulation and Article 10(2) of the Implementing Regulation, that the design applications at issue were not to be regarded as applications for Community designs, with the result that no date of filing could be attributed.

17. On an appeal by Mast-Jägermeister, the Third Board of Appeal of EUIPO confirmed, by decision of 17 November 2015, that it was not possible to determine from the two designs at issue whether protection was being sought for the beaker, for the bottle, or for a combination of the two.

18. The General Court dismissed the action brought by Mast-Jägermeister by the judgment under appeal of 9 February 2017. (5)

IV. Forms of order sought

19. By an application dated 21 April 2017, received on 26 April 2016, Mast-Jägermeister lodged an appeal against the judgment of the General Court and claimed that the Court should,

(1) set aside in its entirety the judgment of the General Court of 9 February 2017 in Case T-16/16, and

(2) grant the first and third pleas in law made at first instance, should the appeal be declared well founded.

20. EUIPO contends that the Court should:

(1) dismiss the appeal, and;

(2) order the appellant to bear the costs.

21. Mast-Jägermeister and EUIPO submitted written observations and presented oral argument at the hearing on 7 February 2018.

V. Legal assessment

22. The present dispute derives from the fact that the application for registration at issue allegedly represents the design claimed, a beaker together with other objects, namely bottles, which are not intended to form the subject matter of the design.

23. Both the instances of EUIPO and the General Court consider that this form of representation is incompatible with the Designs Regulation. However, no decision thereon need be given in this case. Instead what needs to be clarified is whether or not this kind of representation satisfies the requirements to be placed on an application and EUIPO should therefore have accorded as the date of filing the date on which the application was filed.

24. In order to answer this question, I will, on the basis of the relevant provisions of the Designs Regulation, first examine Mast-Jägermeister's argument concerning

the wording and history thereof, before moving on to the provisions on remedy and the reference in Article 36(5) of the Designs Regulation to the Implementing Regulation, the function of the date of filing in relation to the acquisition of priority and the purpose of representing the design in connection with an application. Finally, I will address the objections raised by Mast-Jägermeister to the General Court's comments on the examinations to be carried out by EUIPO and the clarity of the representation of the design submitted with the application.

A. The relevant provisions

25. Under Article 38(1) of the Designs Regulation, the date of filing of an application for a registered Community design is to be the date on which documents containing the information specified in Article 36(1) are filed with EUIPO by the applicant. That information includes in particular a representation of the design suitable for reproduction (subparagraph (c)).

26. Article 10(1) of the Implementing Regulation specifies that no date of filing can be accorded if the application contains no representation of the design pursuant to Article 4(1)(d) and (e). In particular, under subparagraph (e) the design is to be reproduced on a neutral background and is not to be retouched with ink or correcting fluid. The representation is also to be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and at the same time enabling the size of the reproduction to be reduced or enlarged to the format of the register.

27. EUIPO and also the General Court take the view that the representation of the design in the application by Mast-Jägermeister does not meet the requirements laid down in Article 36(1) of the Designs Regulation. The General Court finds in particular at paragraphs 44 to 46 of the judgment under appeal that the representation of the beaker to be protected together with a bottle do not distinguish the subject of the protection with sufficient clarity for the purposes of Article 4(1)(e) of the Implementing Regulation. Since Mast-Jägermeister did not correct the representation within the prescribed period, no date of filing is to be accorded.

28. Mast-Jägermeister regards this finding as an infringement of Articles 45 and 46 of the Designs Regulation, in conjunction with Articles 36 and 38 thereof. In this regard it does not complain (primarily) about the factual assessment by the General Court, but rather disputes that the unequivocal representation of the design is of any relevance at all in according a date of filing. In this regard the question arises whether Article 36(1)(c) of the Designs Regulation and Article 4(1)(e) of the Implementing Regulation contain merely technical requirements or also requirements as regards content.

B. Wording and history

29. Mast-Jägermeister takes the view in particular that with regard to the accordance of a date of filing it is sufficient for the representation of the design to satisfy the technical requirements. This is said to be clear from

the Commission proposal which led to the Designs Regulation, (6) and from Article 4(1)(e) of the Implementing Regulation.

30. It must be conceded in this regard that in the case of both its proposal and Article 4(1)(e) of the Implementing Regulation the Commission focused primarily on the technical quality of the representation. In particular retouching is prohibited and the representation must be such that it can be reduced or enlarged to a particular size.

31. Furthermore, at first sight Article 36(1)(c) of the Designs Regulation also highlights the technical aspects of the representation of the design. It requires a '*representation of the design suitable for reproduction*'.

32. However, on closer inspection Mast-Jägermeister's argument is unconvincing. In addition to the technical requirements which a '*representation suitable for reproduction*' must fulfil, the concept of representation also encompasses the idea of being able to distinguish the content of the design.

33. By contrast, the second sentence of Article 4(1)(e) of the Implementing Regulation does not lay down additional requirements but rather merely clarifies this aspect by requiring a quality of representation '*permitting all the details of the matter for which protection is sought to be clearly distinguished*'.

34. Consequently, it is possible to interpret Article 36(1)(c) of the Designs Regulation, by its wording and in the light of the second sentence of Article 4(1)(e) of the Implementing Regulation, as meaning that the representation of the design in the application must not only satisfy certain technical requirements, but also be unequivocal in terms of its content.

C. Article 36(5), Article 45(2)(a) and Article 46(3) of the Designs Regulation

35. Mast-Jägermeister submits, however, that an infringement of Article 4(1)(e), second sentence, can be cured under Article 46(3) of the Designs Regulation without altering the date of filing. This submission is based on the argument that under Article 36(5) the Implementing Regulation applies to the filing and an infringement of its requirements thus falls under the examination under Article 45(2)(a), which may be remedied in accordance with Article 46(3).

36. As stated above, Article 36(1)(c) of the Designs Regulation itself can be understood, independently of a separate infringement of Article 4(1)(e), second sentence, of the Implementing Regulation, as meaning that the reproduction of the content of the design must be unmistakable. An infringement of Article 36(1)(c) of the Designs Regulation falls, however, under Article 46(2) with the result that a date of filing is to be accorded only when the deficiency is remedied.

37. This submission of Mast-Jägermeister does not therefore call into question the interpretation of the wording of Article 36(1)(c) of the Designs Regulation.

D. The function of the date of filing

38. In the face of the interpretation of Article 36(1)(c) of the Designs Regulation thus far developed, Mast-Jägermeister refers, however, in particular to the

specific function of the date of filing, the performance of which does not require an assessment of the content. Ultimately, however, this submission too is unconvincing.

39. It is true that the application for registration of a design has legal consequences per se. Mast-Jägermeister highlights in particular the priority associated with the filing which, under Article 4 of the Paris Convention, (7) a person filing an application can claim in other legal systems. Conversely, Article 41 of the Designs Regulation recognises such effect within the Union for an application in the States party to the Paris Convention.

40. This priority is established by the filing, without the need for any subsequent registration of the design. This is expressed clearly in Article 4(A)(3) of the Paris Convention by the expression '*whatever may be the subsequent fate of the application*', which may be found in a similar formulation also in Article 41(3) of the Designs Regulation. (8)

41. Mast-Jägermeister infers from this that a date of filing must be accorded after a very superficial examination, whilst a more extensive examination of the content is necessary only as part of the registration.

42. Although this submission is new in relation to the proceedings before the General Court, it is nevertheless admissible since it does not alter the subject matter of the dispute but merely extends the grounds for the sought after interpretation of Articles 38 and 36(1) of the Designs Regulation. (9)

43. Indeed, in order to accord a date of filing pursuant to Article 38 of the Designs Regulation, it is not necessary for the application for registration of a design to satisfy all the requirements for registration. Article 38 refers precisely only to Article 36(1) and not to the entirety of the conditions for a registration. Accordingly, Article 46(3) allows certain deficiencies in the application to be remedied retrospectively, without calling the date of filing into question.

44. However, Mast-Jägermeister fails to appreciate that the system of filing priority pursuant to the Paris Convention, which displays certain similarities with the principle of mutual recognition in EU law, also allows the State where the application is filed to require an unequivocal representation of the design.

45. As EUIPO argues, it is clear from Article 4(A)(2) of the Paris Convention and Article 41(2) of the Designs Regulation that a filing is to be recognised as giving rise to a right of priority where it is equivalent to a regular national filing under the national law of the State where it is made. That is to say any law, in particular EU law, is free to define certain requirements for a regular filing.

46. It is true that Article 4(A)(3) of the Paris Convention and Article 41(3) of the Designs Regulation appear to restrict the regulatory discretion of the State where the application is filed. Under those provisions, by a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned. However, even if the regulatory powers of that State

are thus restricted, the State where the application is filed must nevertheless be permitted to require an unequivocal representation of the design in order to accept a regular filing. If the representation were equivocal it would be unclear as to which design was actually being filed.

47. The rule concerning the irrelevance of the outcome of the filing, on the other hand, is directed primarily at other legal systems in which the priority of the filing is to be claimed subsequently. They are not to lay down further requirements beyond an application accepted in the State where it is made, for example, by requiring successful registration.

48. Consequently, the function of filing an application to establish a claim to priority does not mean that the clarity of the design is excluded from the scope of Article 36(1)(c) of the Designs Regulation.

E. The purpose of the filing

49. However, the need for an unequivocal representation of the design applied for is clear from the purpose of the filing.

50. In this regard the General Court relies on two Court of Justice judgments on trade marks. In those judgments the Court of Justice emphasised that the registration and application for registration of a trade mark must enable the trade mark authorities and third parties to distinguish clearly which trade mark is being claimed. (10)

51. As regards the application for registration of a trade mark, the legislature has since included this in Articles 31(1)(d) and 4(b) of the Trade Mark Regulation. Under those provisions, an application for a European Union trade mark must contain a representation of the trade mark which allows the competent authorities and the public to determine with precision and clarity the subject matter of protection afforded to the proprietor of such a trade mark. This idea was not expressed so clearly in the earlier versions of the Trade Mark Directive (11) and was drafted more clearly when the possible forms of trade mark were expanded. (12)

52. In the abovementioned judgments the Court did not consider the particular function of filing and the date of filing, although a relevant rule on priority does exist in trade mark law in the form of Article 34 of the Trade Mark Regulation. (13)

53. Nonetheless, the Court's arguments are convincing and can be applied without difficulty to the design.

54. It is indeed true that there are considerable differences between the registered design procedure and the trade mark procedure so far as concerns the intensity of EUIPO's examination. Before a trade mark is registered, EUIPO must examine the absolute and, possibly also the relative, grounds for refusing registration. On the other hand, the examination of the content of a design in the registration procedure under Article 47(1) of the Designs Regulation is limited to whether the design corresponds to the definition under Article 3 of the appearance of a product and whether public policy and accepted principles of morality have been respected. That does not, however, exclude a minimum examination by EUIPO of the application

with regard to the clarity of its content in the course of the design procedure too.

55. Firstly, the clarity of the representation is necessary precisely against the background of the right of priority which arises on filing. That is because priority should apply only to the design which was actually applied for. (14) An unclear application would not — contrary to the view of Mast-Jägermeister — necessarily be to the detriment of the applicant but at the same time give rise to a risk of excessive protection afforded by priority.

56. Therefore, secondly, it is also necessary to refute Mast-Jägermeister's argument that the deficiency objected to did not concern the distinguishability of the subject matter of the protection but rather the scope of the protection, which, however, is not the subject of the application proceedings, but could be resolved only in infringement proceedings.

57. It is true that it is necessary in infringement proceedings to derive the scope of the protection from the representation of the design, having regard to Articles 10 and 19 of the Designs Regulation. However, that does not mean that the distinguishability of the representation is irrelevant at the filing stage.

58. The application procedure should rather — also irrespective of the priority — at least provide other market operators with a minimal level of protection against an unclear application, so that they are not exposed unnecessarily to the risk of having to argue in court with the relevant applicant over the scope of his unclear application. (15)

59. And thirdly EUIPO rightly points out that the registration authorities also need a clear and unequivocal representation of the design for the examinations which they have to carry out. (16)

60. It may be that other legal systems are more generous in this regard in recognising an application — they have the freedom to be under Article 4 of the Paris Convention. However, EU law is not compelled to be as generous.

F. The order of the examination

61. More convincing in this case are Mast-Jägermeister's objections to the order of the examination which the General Court outlines at paragraphs 35 and 36 of the judgment under appeal. There the General Court first requires an examination whether there is a design at all and whether it is contrary to accepted principles of morality before the more formal requirements under Article 36 of the Designs Regulation are examined.

62. In particular, an examination of the compatibility of the design with public policy or accepted principles of morality would certainly go beyond determination of the date of filing pursuant to Article 38(1) and 36(1) of the Designs Regulation. In practical terms too it could be difficult to examine whether or not there is a design and it is consistent with public policy or accepted principles of morality if the representation thereof did not satisfy the qualitative requirements under Article 36(1) of the Designs Regulation.

63. However, ultimately the resolution of the present case does not turn on this matter. These preliminary

remarks of the General Court do not support its decision and therefore this argument is ineffective. (17)

G. The clarity of the representation

64. Finally, in so far as Mast-Jägermeister insists that in the present case the representation of the design which was submitted is sufficiently clear, it should be recalled that, in accordance with Article 256(1) TFEU and the first subparagraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal is limited to points of law. The General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal. (18)

65. Whether or not the representation submitted is sufficiently clear despite the bottles depicted alongside the design is a question of fact. It is neither claimed nor evident that the General Court distorted the facts in examining this question. This argument is therefore inadmissible.

H. Conclusion

66. All in all the General Court rightly required that the representation of the design be precise as a condition for the accordance of a filing date pursuant to Articles 38(1) and 36(1) of the Designs Regulation. The appeal must consequently be dismissed as predominantly unfounded and otherwise inadmissible.

VI. Costs

67. In accordance with Article 184(2) of the Rules of Procedure, where the appeal is unfounded, the Court is to make a decision as to costs. Under Article 138(1) of those rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings

68. Since Mast-Jägermeister has been unsuccessful and EUIPO has applied for costs, Mast-Jägermeister must be ordered to pay the costs.

VII. Conclusion

69. I therefore propose that the Court should:

- (1) dismiss the appeal;
- (2) order Mast-Jägermeister SE to pay the costs.

1 Original language: German.

2 The Convention for the Protection of Industrial Property, as most recently revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaty Series, Vol. 828, No 11851, p. 305; *'the Paris Convention'*), was signed in Paris on 20 March 1883.

3 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), as amended.

4 Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Regulation No 6/2002 (OJ 2002 L 341, p. 28).

5 Judgment in Mast-Jägermeister v EUIPO(Beakers) (T-16/16, EU:T:2017:68).

6 Mast-Jägermeister is referring to COM(93) 342 final, p. 30.

7 See, as regards the application of the Paris Convention in EU law, the judgment of 15 November 2012, Bericap Záródástechnikai (C-180/11, EU:C:2012:717, paragraphs 67 to 70).

8 See, as regards trade mark law, judgment of 18 November 2014, Think Schuhwerk v OHIM — Müller (VOODOO) (T-50/13, EU:T:2014:967, paragraph 59).

9 Judgments of 10 April 2014, Areva and Others v Commission (C-247/11 P and C-253/11 P, EU:C:2014:257, paragraph 114), and of 16 November 2017, Ludwig-Bölkow-Systemtechnik v Commission (C-250/16 P, EU:C:2017:871, paragraph 29). See, to this effect, also judgments of 30 September 1982, Amylum v Council (108/81, EU:C:1982:322, paragraph 25); of 22 November 2001, Netherlands v Council (C-301/97, EU:C:2001:621, paragraph 169); of 26 April 2007, Alcon v OHIM (C-412/05 P, EU:C:2007:252, paragraph 40); and of 6 March 2001, Connolly v Commission (C-274/99 P, EU:C:2001:127, paragraphs 34 to 36).

10 Judgments of [12 December 2002, Sieckmann \(C-273/00, EU:C:2002:748\)](#), paragraphs 48 to 52), and of [19 June 2012, Chartered Institute of Patent Attorneys](#) (C-307/10, EU:C:2012:361, paragraphs 46 to 48).

11 See, respectively, Article 26(1)(d) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (OJ 2009 L 78, p. 1).

12 See recital 9 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

13 Now 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).

14 See, as regards trade mark law, judgment of the General Court of 15 November 2001, Signal Communications v OHIM(TELEYE) (T-128/99, EU:T:2001:266, paragraph 45).

15 See judgments of 12 December 2002, Sieckmann (C-273/00, EU:C:2002:748, paragraph 51), and of [19 June 2012, Chartered Institute of Patent Attorneys](#) (C-307/10, EU:C:2012:361, paragraph 48).

16 Judgments of [12 December 2002, Sieckmann \(C-273/00, EU:C:2002:748\)](#), paragraph 50), and of [19 June 2012, Chartered Institute of Patent Attorneys](#) (C-307/10, EU:C:2012:361, paragraph 47).

17 See judgment of 2 June 1994, *de Compte v Parliament* (C-326/91 P, EU:C:1994:218, paragraph 94), and order of 31 January 2017, *Universal Protein Supplements v EUIPO* (C-485/16 P, EU:C:2017:72).

18 Judgments of **7 October 2004, *Mag Instrument v OHIM*** (C-136/02 P, EU:C:2004:592, paragraph 39) and of 26 July 2017, *Staatliche Porzellan-Manufaktur Meissen v EUIPO* (C-471/16 P, not published, EU:C:2017:602) 34), and order of 17 July 2014, *Kastenholz v OHIM* (C-435/13 P, EU:C:2014:2124, paragraph 33).