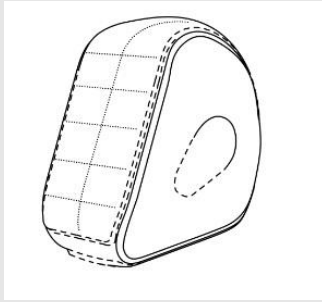


Court of Justice EU, 27 February 2024, EUIPO v KaiKai



DESIGN LAW

Art. 4 of the Paris Convention has no direct effect in the European Union

- [The right of priority to file an application for a community design is governed by Article 41 Community Designs Regulation](#)

67 However, such an intention on the part of the EU legislature cannot be inferred from Article 41 of Regulation No 6/2002 solely on the basis of the fact that the wording of Article 41, on the one hand, matches that of Article 4 of the Paris Convention, on the other. That regulation is in fact the expression of that legislature's intention to adopt, in respect of one of the industrial property rights covered by that convention, an approach specific to the legal order of the European Union, by establishing a specific system of unitary and indivisible protection for Community designs on the territory thereof, of which the right of priority provided for in that Article 41 forms an integral part.

General Court erred in law in directly applying Article 41(1) Community Designs Regulation to right of priority based on a patent

- [Art. 41 Community Designs Regulation does not allow an application for registration of a patent to form the basis of a right of priority for a subsequent application for registration of a community design](#)

76 Thus, it follows unequivocally from the clear wording of Article 41(1) that only two categories of earlier application – namely (i) an application for registration of a design and (ii) an application for registration of a utility model – can form the basis of a right of priority for a subsequent application for registration of a Community design, solely within a period of six months as of the date of filing of the earlier application concerned.

77 It also follows that Article 41(1) is exhaustive and that the fact that that provision does not fix the time period in which a right of priority based on an application for registration of a patent may be claimed is not a gap in that provision, but the consequence of the fact that that provision does not allow such a right to be based on that category of earlier applications.

- [The time period for claiming a right of priority is six months, as expressly fixed in Article 41 Community Designs Regulation](#)

Under Art. 4 Paris Convention, no claim of priority for a design application can be made on the basis of a prior patent application

- [It follows from a combined reading of sections A and C of Art. 4 that the subsequent application must concern the 'same subject' as the earlier application that forms the basis of the right of priority](#)

85 In those circumstances, Article 4 of the Paris Convention does not allow priority to be claimed in respect of an earlier patent application when filing a subsequent design application, and therefore, a fortiori, does not lay down any rules on the time period prescribed to the applicant to that end. Thus, only an international application filed under the PCT relating to a utility model can give rise to a right of priority for a design application by virtue of that Article 4, within the period of six months referred to in section E, paragraph 1, thereof.

Claimed right of priority more than six months before application, rightly denied; judgment under appeal set aside

- [Neither Art. 41 Community Designs Regulation nor Art. 4 Paris Convention provides for a 12-month time period](#)

Neither Article 41(1) of Regulation No 6/2002 nor Article 4 of the Paris Convention – which, moreover, does not have direct effect in the EU legal order – makes it possible to claim priority for an international application filed under the PCT when filing a subsequent design application within a period of 12 months, irrespective of whether that international application concerns a utility model or a patent. Thus, in accordance with those provisions, in the first of those situations, the period for claiming a right of priority on the basis of that international application is set at six months whereas, in the second of those situations, the existence of such a right is precluded from the outset.

Source: [Case C-382/21 P - ECLI:EU:C:2024:172](#)

Court of Justice EU, 27 February 2024

(K. Lenaerts, L. Bay Larsen, K. Jürimäe, C. Lycourgos, E. Regan, N. Piçarra, M. Ilešič, P.G. Xuereb, L.S. Rossi (Rapporteur), I. Jarukaitis, A. Kumin, N. Jääskinen, N. Wahl, I. Ziemele and J. Passer)

JUDGMENT OF THE COURT (Grand Chamber)

27 February 2024 ⁽¹⁾

(Appeal – Intellectual property – Community designs – Patent Cooperation Treaty (PCT) – Agreement on Trade-Related Aspects of Intellectual Property Rights – Paris Convention for the Protection of Industrial Property – Article 4 – Regulation (EC) No 6/2002 – Article 41 – Application for registration of a Community design – Right of priority – Priority claim based on an

¹ Language of the case: German.

international application filed under the PCT – Time period – Interpretation consistent with Article 4 of that convention – Limits)

In Case C-382/21 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 23 June 2021, European Union Intellectual Property Office (EUIPO), represented by D. Gája, D. Hanf, E. Markakis and V. Ruzek, acting as Agents,

appellant,

supported by:

European Commission, represented by P. Němečková, J. Samnadda and G. von Rintelen, acting as Agents,

intervener in the appeal,

the other party to the proceedings being:

The KaiKai Company Jaeger Wichmann GbR, established in Munich (Germany), represented by J. Hellmann-Cordner, Rechtsanwältin, and by T. Lachmann and F. Steinbach, Patentanwälte, applicant at first instance,

THE COURT (Grand Chamber),

composed of K. Lenaerts, President, L. Bay Larsen, Vice-President, K. Jürimäe, C. Lycourgos, E. Regan and N. Piçarra, Presidents of Chamber, M. Ilešič, P.G. Xuereb, L.S. Rossi (Rapporteur), I. Jarukaitis, A. Kumin, N. Jääskinen, N. Wahl, I. Ziemele and J. Passer, Judges,

Advocate General: T. Čápetá,

Registrar: M. Krausenböck, Administrator,

having regard to the written procedure and further to the hearing on 13 March 2023,

after hearing [the Opinion of the Advocate General](#) at the sitting on 13 July 2023,

gives the following

Judgment

1 By its appeal, the European Union Intellectual Property Office (EUIPO) seeks to have set aside the judgment of the General Court of the European Union of 14 April 2021, *The KaiKai Company Jaeger Wichmann v EUIPO* (Gymnastic and sports apparatus and equipment) (T-579/19, EU:T:2021:186; ‘*the judgment under appeal*’), by which the General Court annulled the decision of the Third Board of Appeal of EUIPO of 13 June 2019 (Case R 573/2019-3).

Legal context

International law

The Paris Convention

2 The Paris Convention for the Protection of Industrial Property was signed in Paris on 20 March 1883, last revised in Stockholm (Sweden) on 14 July 1967 and amended on 28 September 1979 (United Nations Treaties Series, Vol. 828, No 11851, p. 305; ‘*the Paris Convention*’). All Member States of the European Union are parties to that convention.

3 Article 1(1) and (2) of that convention provides:

‘(1) *The countries to which this Convention applies constitute a Union for the protection of industrial property.*

(2) *The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or*

appellations of origin, and the repression of unfair competition.’

4 Article 4 of that convention provides:

‘A.

(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 [for the protection of industrial property], 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 [for the protection of industrial property] or under bilateral or multilateral treaties concluded between countries of the Union [for the protection of industrial property] shall be recognised as giving rise to the right of priority.*

...

C.

(1) *The periods of priority referred to above shall be [12] months for patents and utility models, and [6] months for industrial designs and trademarks.*

(2) *These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.*

...

(4) *A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union [for the protection of industrial property] shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.*

...

E.

(1) *Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs[.]*

(2) *Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.*

...

5 Article 19 of the Paris Convention provides:

‘*It is understood that the countries of the Union [for the protection of industrial property] reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.*’

6 Under Article 25(1) of that convention:

‘*Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures*

necessary to ensure the application of this Convention.'

The TRIPS Agreement

7 The Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPS Agreement'), as set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization (WTO), was signed in Marrakesh on 15 April 1994 and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1). The members of the WTO, including all EU Member States and the European Union itself, are party to the TRIPs Agreement.

8 Article 2 of that agreement, under Part I thereof, provides, in paragraph 1 thereof:

'In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris [Convention].'

9 Article 25(1) of that agreement, under Part II thereof, requires WTO members to provide for the protection of independently created industrial designs that are new or original.

10 Article 62 of that agreement, which constitutes Part IV thereof, concerns, inter alia, the acquisition of intellectual property rights.

The PCT

11 The Patent Cooperation Treaty was concluded in Washington (United States) on 19 June 1970 and last modified on 3 October 2001 (United Nations Treaties Series, Vol. 1160, No 18336, p. 231; 'the PCT'). All EU Member States are party to the PCT.

12 Article 1(2) of the PCT states:

'No provision of this Treaty shall be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property of any national or resident of any country party to that Convention.'

13 Article 2 of that treaty provides:

'For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(i) "application" means an application for the protection of an invention; references to an "application" shall be construed as references to applications for patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;

(ii) references to a "patent" shall be construed as references to patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;

...

(vii) "international application" means an application filed under this Treaty;

...'

European Union law

14 Article 25 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1) provides, in paragraph 1 thereof:

'A Community design may be declared invalid only in the following cases:

...

(g) *if the design constitutes an improper use of any of the items listed in Article 6ter of the [Paris Convention], or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State.'*

15 Article 41 of that regulation provides, in paragraphs 1 and 2 thereof:

'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], or to the Agreement establishing the [WTO], 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.'

Background to the dispute

16 The background to the dispute was set out by the General Court in paragraphs 12 to 22 of the judgment under appeal and, for the purposes of the present proceedings, may be summarised as follows.

17 On 24 October 2018, The KaiKai Company Jaeger Wichmann GbR ('KaiKai') filed a multiple application for the registration of 12 Community designs ('the application for registration at issue') with EUIPO, claiming priority, in respect of all of those designs, on the basis of international patent application PCT/EP2017/077469 filed, pursuant to the PCT, with the European Patent Office on 26 October 2017 ('the international patent application filed under the PCT on 26 October 2017').

18 By letter of 31 October 2018, the EUIPO examiner informed KaiKai that the application for registration at issue had been accepted in its entirety, but that the priority claimed was refused for all of the designs at issue because the date of the filing of the international patent application filed under the PCT on 26 October 2017 was more than six months prior to the date of that application for registration.

19 Since KaiKai maintained its priority claim and asked for an appealable decision to be made, by decision of 16 January 2019, the examiner refused the right of priority in respect of all the designs at issue ('the examiner's decision').

20 In support of that decision, the examiner stated that, even though an application under the PCT could, in principle, form the basis for a right of priority under Article 41(1) of Regulation No 6/2002, given that the broad definition of the concept of 'patent' in Article 2 of the PCT also included the utility models referred to in Article 41(1), the claim of such a right of priority was also subject to a period of six months, which had not been complied with in the present case.

21 On 14 March 2019, KaiKai lodged an appeal with EUIPO against the examiner's decision.

22 By decision of 13 June 2019 (*'the decision at issue'*), the Third Board of Appeal of EUIPO dismissed the appeal. It found, in essence, that the examiner had correctly applied Article 41(1) of Regulation No 6/2002, which accurately reflected the provisions of the Paris Convention.

23 Accordingly, the Board of Appeal found that KaiKai could only claim a right of priority of the international patent application filed under the PCT on 26 October 2017 within six months of the date of filing of that application, that is, until 26 April 2018.

The procedure before the General Court and the judgment under appeal

24 By application lodged at the General Court on 20 August 2019, KaiKai brought an action against the decision at issue, by which it sought:

- by its first, third and fourth heads of claim, annulment of that decision and an order that EUIPO pay the costs of the proceedings before both the Board of Appeal and the General Court;
- by its second head of claim, annulment of the examiner's decision and recognition of the priority claim; and
- in the alternative, by its fifth head of claim, a hearing.

25 In support of its action, KaiKai relied on two pleas in law, alleging (i) infringement of essential procedural requirements on the part of the Board of Appeal of EUIPO and (ii) misinterpretation and misapplication of Article 41(1) of Regulation No 6/2002 by that board of appeal.

26 By the judgment under appeal, the General Court, first, in paragraphs 25 to 33 thereof, rejected KaiKai's second and fifth heads of claim as inadmissible and, next, examined the merits of the second plea in law.

27 In the first place, in paragraphs 41 to 50 of that judgment, the General Court rejected the first part of that plea, alleging misinterpretation of the concept of *'utility model'*, within the meaning of Article 41(1) of Regulation No 6/2002.

28 In that connection, the General Court held, in paragraph 44 of the judgment under appeal, that KaiKai's arguments were ambivalent and of no help to it. In paragraphs 45 to 47 of that judgment, the General Court observed that, in any event, *'international patent applications'* filed under the PCT covered utility models, since that treaty did not distinguish between the different rights through which the various contracting States protect inventions. Thus, the General Court held, in paragraphs 49 and 50 of that judgment, that, although the wording of Article 41(1) of Regulation No 6/2002 did not expressly refer to a right of priority claimed on the basis of a patent, the Board of Appeal of EUIPO did not err in law by giving that provision a broad interpretation in the light of the overall scheme of the PCT, in order to treat the claim of the right of priority based on the international patent application filed under the PCT on 26 October 2017 as being governed by that provision in so far as concerns the question whether a right of priority could be based on such an application.

29 In the second place, in paragraphs 51 to 87 of the judgment under appeal, the General Court upheld the

second part of the second plea, alleging that Article 4(C)(1) of the Paris Convention was not taken into account when determining the period in which such a right of priority may be claimed.

30 In order to do so, the General Court held, first, in paragraphs 56 to 66 of that judgment, that since Article 41(1) of Regulation No 6/2002 did not govern the question of the period for claiming the priority of an *'international patent application'* in the context of a later application for a design, and that the purpose of that provision was to ensure the consistency of that regulation with the obligations incumbent on the European Union pursuant to the Paris Convention, it was necessary to resort to Article 4 of that convention in order to fill the gap in that regulation. Next, the General Court observed, in paragraphs 72 and 77 to 85 of that judgment, that even though that convention also did not contain any express rules for the priority period applicable to such a situation, it was nonetheless apparent from the inherent logic of the priority system and from the travaux préparatoires for that convention that, as a general rule, it was the nature of the earlier right that determined the duration of the priority period.

Lastly, the General Court concluded, in paragraph 86 of the judgment under appeal, that the Board of Appeal of EUIPO had erred in law by finding that the period applicable to KaiKai's claim for priority of the international patent application filed under the PCT on 26 October 2017 was six months.

31 Consequently, in paragraph 88 of the judgment under appeal, the General Court upheld the action in so far as it sought annulment of the decision at issue and, accordingly, annulled that decision, without examining the first plea in law.

Procedure before the Court and forms of order sought

32 By statement of appeal lodged at the Registry of the Court of Justice on 23 June 2021, EUIPO brought the present appeal against the judgment under appeal.

33 By document lodged on the same date, EUIPO requested, pursuant to Article 170a(1) of the Rules of Procedure of the Court of Justice, that its appeal be allowed to proceed, in accordance with the third paragraph of Article 58a of the Statute of the Court of Justice of the European Union.

34 By order of 10 December 2021, EUIPO v The KaiKai Company Jaeger Wichmann (C-382/21 P, EU:C:2021:1050), the appeal was allowed to proceed.

35 By decision of the President of the Court of 8 April 2022, the European Commission was granted leave to intervene in support of the form of order sought by EUIPO.

36 EUIPO claims that the Court should:

- set aside the judgment under appeal in its entirety;
- dismiss, in its entirety, the action at first instance brought against the decision at issue; and
- order KaiKai to pay the costs incurred by EUIPO in the present proceedings and in the proceedings at first instance.

37 KaiKai contends that the Court should:

- dismiss the appeal as unfounded; and

– order EUIPO to pay the costs that KaiKai has incurred in the appeal proceedings, the proceedings at first instance and the appeal proceedings before the Board of Appeal of EUIPO.

38 The Commission contends that the Court should:

- set aside the judgment under appeal in its entirety;
- dismiss the action at first instance in its entirety; and
- order KaiKai to pay the costs of the present proceedings.

The appeal

Arguments of the parties

39 In support of its appeal, EUIPO raises a single ground of appeal, alleging infringement of Article 41(1) of Regulation No 6/2002. That single ground is divided into three parts.

40 By the first part, EUIPO takes issue with the General Court for wrongly holding, in paragraphs 56, 57 and 64 to 66 of the judgment under appeal, that the fact that Article 41(1) does not provide that an earlier patent application may serve as a basis for the priority of a subsequent application for a Community design, and therefore does not set the period during which such priority may be claimed, constitutes a gap in the legislation.

41 According to the appellant, such an interpretation runs manifestly counter to the wording of that provision, which establishes both the nature of the industrial property rights on which a priority claim may be based, namely an earlier design or utility model – therefore excluding patents – and the duration of the period within which such priority may be claimed, namely six months from the date on which the earlier application was lodged.

42 By the second part of the single ground of appeal, EUIPO submits that, by recognising a 12-month period in which priority may be claimed, the General Court, in paragraphs 75 to 86 of the judgment under appeal, did not simply interpret Article 41(1) of Regulation No 6/2002 in a manner consistent with Article 4 of the Paris Convention, but rejected the application of that Article 41(1) in order to apply Article 4 instead. In so doing, the General Court gave the latter provision direct effect in the legal order of the European Union.

43 However, on the one hand, conferring direct effect on Article 4 of the Paris Convention runs counter, in EUIPO's submission, to the case-law arising from the judgment of [25 October 2007, *Develey v OHIM* \(C-238/06 P, EU:C:2007:635\)](#), paragraphs 37 to 44), according to which the provisions of both the Paris Convention and the TRIPs Agreement – through which the European Union is bound by that convention – do not have direct effect. Furthermore, the absence of direct effect of the Paris Convention also follows from Article 25 thereof, as is clear, by analogy, from the judgment of [15 March 2012, *SCF* \(C-135/10, EU:C:2012:140\)](#), paragraphs 47 and 48). On the other hand, and in any event, the rule established by the General Court in the judgment under appeal cannot be inferred from the wording of Article 4 of that convention, with the result that the requirements of clarity, precision and unconditionality laid down by the case-law on the direct

applicability of international law under EU law stemming, inter alia, from the judgment of 3 June 2008, *Intertanko and Others* (C-308/06, EU:C:2008:312, paragraph 45), are not satisfied.

44 The Commission adds, in the same vein, that the limits set out in the case-law of the Court of Justice concerning the obligation to interpret national law in conformity with EU law, stemming inter alia from the judgment of 24 January 2012, *Dominguez* (C-282/10, EU:C:2012:33, paragraph 25), also apply to the General Court where it interprets Article 41(1) of Regulation No 6/2002 in the light of the Paris Convention. Thus, given that the General Court's interpretation runs counter to the clear wording of that provision, the General Court actually applied that convention directly, whereas the latter cannot have direct effect, even through the TRIPs Agreement.

45 In particular, the Commission takes the view that the case-law of the Court of Justice, stemming inter alia from the judgments of [23 November 1999, *Portugal v Council* \(C-149/96, EU:C:1999:574\)](#), paragraph 49), and of 16 July 2015, *Commission v Rusal Armenal* (C-21/14 P, EU:C:2015:494, paragraphs 40 and 41), which recognises, by way of exception, the direct applicability of certain provisions of the Agreement establishing the WTO and of the agreements in Annexes 1 to 4 to the latter ('the WTO Agreements'), does not apply in the present case. Since Article 41(1) of Regulation No 6/2002 does not contain any deliberate reference to a specific provision of the Paris Convention, that provision does not make it possible to infer any intention on the part of the EU legislature to give direct effect to Article 4 of that convention. This may also be inferred, it is argued, from a comparison between that provision and Article 25(1)(g) of that regulation which, by contrast, in making a concrete and explicit reference to Article 6ter of that convention, demonstrates such an intention.

46 By the third part of its single ground of appeal, EUIPO takes issue with the General Court for having filled the alleged gap in the legislation which vitiated Article 41(1) of Regulation No 6/2002, by misinterpreting Article 2 of the PCT and Article 4 of the Paris Convention.

47 More specifically, EUIPO submits that by mentioning, in paragraphs 15, 18, 20, 22, 39, 40, 44 to 50, 56, 64, 66, 70, 72, 74, 79, 83, 84 and 86 of the judgment under appeal, the phrase '*international patent application*', the General Court disregarded the concept of '*international application*', within the meaning of Article 2(i), (ii) and (vii) of the PCT, as well as the fact that, pursuant to Article 4(E)(1) of the Paris Convention and Article 41(1) of Regulation No 6/2002, only the earlier filing of an '*international utility model application*', within the meaning of that provision, can give rise to a right of priority for a subsequent '*Community design*' application.

48 In that connection, EUIPO submits that, in the present case, both the examiner's decision and the decision at issue correctly categorised the international application filed under the PCT on 26 October 2017 as an

'*international utility model application*' and not as an '*international patent application*', as the General Court wrongly assumed. EUIPO states in that context that, in so far as the text of an '*international application*', for the purposes of Article 2(vii) of the PCT, does not expressly exclude the protection of the '*utility model*' within the meaning of point (i) of that article, the protection claimed by way of such an application extends by default to a utility model, as does that lodged by KaiKai. It is only on account of the fact that the international application filed under the PCT on 26 October 2017 was categorised, pursuant to that rule, as an '*international utility model application*' that the latter could, in principle, form the basis of a right of priority in order to make an application for registration of a Community design.

49 EUIPO submits that it follows, inter alia, from Article 4(C)(2) and (4) of the Paris Convention that, as a general rule, only a subsequent application that concerns the '*same subject*' as an earlier application may enjoy a right of priority. Thus, according to that rule, each type of industrial property right gives rise to a right of priority only for the same type of industrial property right, within the time periods provided for in Article 4(C)(1) of that convention. It is only by way of exception that Article 4(E)(1) of that convention provides that a utility model application can form the basis of a right of priority for a subsequent application relating to a design and not to a utility model, provided however that that '*disparate pair of subjects*' covers the same representation of the product, and only for a period of six months. Accordingly, the exception provided for in Article 4(E)(1) relates to the general rule of the '*same subject*' set out in Article 4(C)(2) and (4) and not, as the General Court wrongly held in paragraphs 77 to 85 of the judgment under appeal, to an alleged general rule that the nature of the earlier right determines the time period for the right of priority attached thereto.

50 It is argued that it follows, therefore, from a combined reading of the general rule of the '*same subject*', set out in Article 4(C)(2) and (4) of the Paris Convention, and the exception to that rule provided for in Article 4(E)(1) of that convention, that only two types of industrial property right – namely, an earlier design or an earlier utility model – can, pursuant to that convention, validly form the basis of a right of priority for a design registered subsequently. Consequently, an earlier patent does not, it is argued, make it possible to establish a right of priority for a Community design registered subsequently. Thus, the General Court's finding that the period applicable to the priority claim of a patent application for a subsequent design application is 12 months has no legal basis in that convention.

51 In support of EUIPO's line of argument, the Commission submits that, as is apparent, inter alia, from the Guidelines for the interpretation of the Paris Convention drawn up by the World Industrial Property Organization (WIPO) – which, whilst not legally binding, may nonetheless be relied upon before the Courts of the European Union for the purposes of interpreting that convention – the contracting parties to

that convention deliberately decided not to include patents in the exception provided for in Article 4(E) thereof, on account of the lack of possibility of any overlap between patents and designs. That institution submits that Article 41(1) of Regulation No 6/2002 is fully in line with that approach, inasmuch as it recognises a certain permeability between, on the one hand, utility models alone and, on the other hand, designs, as a result of the fact that, as the Court acknowledged in its judgment of [8 March 2018, DOCERAM \(C-395/16, EU:C:2018:172](#), paragraphs 24 to 29), those are both capable of protecting the technical function of a product.

52 KaiKai contends, first of all, that Article 41(1) of Regulation No 6/2002 merely reproduces the special rule laid down in Article 4(E)(1) of the Paris Convention, which is applicable only to the priority claim based on a utility model; its purpose or effect is not to set the period applicable to a priority claim based on an international patent application. Since Article 25 of that convention does not authorise the EU legislature to restrict the priority rights conferred on an applicant, the absence of any provision allowing the priority of an earlier patent application to be claimed constitutes a gap in that regulation.

53 Next, KaiKai submits that, by filling that gap by reference to the Paris Convention, the General Court did not directly apply that convention, by consequently disapplying Article 41(1) of that regulation, but interpreted the latter provision in the light of that convention, in accordance with the settled case-law of the Court of Justice, recalled inter alia in the judgment of [15 March 2012, SCF \(C-135/10, EU:C:2012:140](#), paragraph 51). The existence of that gap thus precludes any conflict with the case-law of the Court cited in paragraph 43 of the present judgment, which denies any direct effect to that convention.

54 Finally, KaiKai submits that an international application filed under the PCT constitutes both a patent application and a utility model application; those two applications are therefore identical as to their subject, inasmuch as they both describe a technical invention. It follows that both the priority of a utility model application and that of a patent application can be claimed when lodging an application for a Community design. The fact that the Paris Convention establishes different priority periods in those two cases therefore does not depend on the difference between the protected aims of industrial property law, but depends instead on the difference between the registration procedures that are respectively applicable thereto.

55 Furthermore, in KaiKai's submission, the exclusion of patents as the basis for the priority of Community designs leads to discrimination against applicants on the basis of their nationality. Whereas, in certain Member States, it is possible to transform a national patent into a national utility model and then use it as the basis of the priority of a design, in others – such as the Kingdom of Belgium, the Republic of Cyprus and the Kingdom of the Netherlands, which do not make provision for

national utility models – an applicant is deprived of that possibility.

Findings of the Court

56 By way of the three parts of its single ground of appeal, which it is appropriate to examine together, EUIPO takes issue, in essence, with the General Court for having directly applied Article 4 of the Paris Convention, by disapplying the clear and exhaustive provisions of Article 41(1) of Regulation No 6/2002, in order to replace them with a misinterpretation of that Article 4.

The effects of the Paris Convention in the EU legal order

57 As is clear from Article 216(2) TFEU and the settled case-law of the Court of Justice, international agreements concluded by the European Union are binding on it and form an integral part of its legal order as from their coming into force (see, to that effect, judgments of 30 April 1974, Haegeman, 181/73, EU:C:1974:41, paragraph 5, and of 1 August 2022, Sea Watch, C-14/21 and C-15/21, EU:C:2022:604, paragraph 94).

58 Moreover, the European Union can succeed the Member States in their international commitments when the Member States have transferred to it, by one of its founding Treaties, their competences relating to those commitments. Such is the case where the European Union has exclusive competence in a matter governed by the provisions of an international agreement concluded by all of the EU Member States (see, to that effect, judgment of 12 December 1972, International Fruit Company and Others, 21/72 to 24/72, EU:C:1972:115, paragraphs 10 to 18, and Opinion 2/15 ([EU-Singapore Free Trade Agreement](#)) of 16 May 2017, EU:C:2017:376, paragraph 248).

59 That said, it is not necessary, for the purposes of dealing with the present appeal, to examine whether and, as the case may be, the extent to which the European Union has exclusive competence in matters governed by the Paris Convention, which was concluded by all of the Member States but not by the European Union itself. In fact, as the Court has already held, the rules set out by certain articles in that convention, including Article 4 thereof, have been incorporated into the TRIPs Agreement which was itself concluded by the European Union (see, to that effect, judgment of [16 November 2004, Anheuser-Busch, C-245/02, EU:C:2004:717](#), paragraph 91).

60 More specifically, that agreement provides, in Article 2(1) thereof, that WTO Members, including the European Union, are to comply with Articles 1 through 12 and Article 19 of the Paris Convention in so far as concerns Parts II to IV of that agreement, which contain Articles 9 to 62 thereof.

61 Accordingly, as regards, in particular, the protection of industrial designs, referred to in Article 25 of the TRIPs Agreement, and the acquisition of such protection, referred to in Article 62 of that agreement, the rules set out in those articles of the Paris Convention, including Article 4 thereof, must be regarded as forming an integral part of the TRIPs Agreement.

62 In those circumstances, the rules set out in Article 4 of the Paris Convention must be regarded as producing the same effects as those produced by the TRIPs Agreement (see, to that effect, judgment of [16 November 2004, Anheuser-Busch, C-245/02, EU:C:2004:717](#), paragraph 96).

63 In that connection, it is settled case-law that, having regard to the nature and structure of the TRIPs Agreement, the provisions of that agreement do not have direct effect. Thus, those provisions are not, in principle, among the rules in the light of which the Court is to review the legality of measures of the EU institutions and are not such as to create rights upon which individuals may rely directly before the courts by virtue of EU law (see, to that effect, judgments of [14 December 2000, Dior and Others, C-300/98 and C-392/98, EU:C:2000:688](#), paragraphs 43 to 45; of [16 November 2004, Anheuser-Busch, C-245/02, EU:C:2004:717](#), paragraph 54; and of 28 September 2023, Changmao Biochemical Engineering v Commission, C-123/21 P, EU:C:2023:708, paragraphs 70 and 71).

64 Furthermore, Article 4 of the Paris Convention also does not come under the two exceptional situations in which the Court has accepted that private individuals may rely directly on the provisions of the WTO Agreements before the Courts of the European Union, namely, first, the situation in which the act of the European Union at issue expressly refers to specific provisions of those agreements and, second, that in which the European Union intended to give effect to a specific obligation assumed under those agreements (see, to that effect, judgments of 22 June 1989, Fediol v Commission, 70/87, EU:C:1989:254, paragraphs 19 to 22; of 7 May 1991, Nakajima v Council, C-69/89, EU:C:1991:186, paragraphs 29 to 31; and of 28 September 2023, Changmao Biochemical Engineering v Commission, C-123/21 P, EU:C:2023:708, paragraphs 74 and 75).

65 First, Article 41(1) of Regulation No 6/2002 in fact makes no express reference to Article 4 of the Paris Convention.

66 Second, it should be noted that the Court has held, in essence, that, in order for the intention of the EU legislature to implement in EU law a specific obligation entered into in the context of the WTO Agreements to be established, it is not sufficient for the preamble to an EU act to support only a general inference that the legal act in question was to be adopted with due regard for international obligations entered into by the European Union. It is, on the other hand, necessary for it to be possible to infer from the specific provision of EU law contested that it seeks to implement into EU law a particular obligation stemming from the WTO Agreements (see, to that effect, judgments of 16 July 2015, Commission v Rusal Armenal, C-21/14 P, EU:C:2015:494, paragraphs 45, 46 and 48, and of 28 September 2023, Changmao Biochemical Engineering v Commission, C-123/21 P, EU:C:2023:708, paragraphs 76, 78 and 79).

67 However, such an intention on the part of the EU legislature cannot be inferred from Article 41 of Regulation No 6/2002 solely on the basis of the fact that the wording of Article 41, on the one hand, matches that of Article 4 of the Paris Convention, on the other. That regulation is in fact the expression of that legislature's intention to adopt, in respect of one of the industrial property rights covered by that convention, an approach specific to the legal order of the European Union, by establishing a specific system of unitary and indivisible protection for Community designs on the territory thereof, of which the right of priority provided for in that Article 41 forms an integral part.

68 It follows that the rules set out in Article 4 of the Paris Convention do not have direct effect and, accordingly, are not such as to create, for individuals, rights on which they may directly rely by virtue of EU law (see, to that effect, judgment of **25 October 2007, *Develev v OHIM*, C-238/06 P, EU:C:2007:635**, paragraphs 39 and 43).

69 Consequently, the right of priority to file an application for a Community design is governed by Article 41 of Regulation No 6/2002, without economic operators being able to rely directly on Article 4 of the Paris Convention.

70 That said, since the TRIPs Agreement is binding on the European Union and, accordingly, takes precedence over EU secondary legislation, the latter must be interpreted, as far as is possible, in accordance with the provisions of that agreement (see, by analogy, judgments of 10 September 1996, *Commission v Germany*, C-61/94, EU:C:1996:313, paragraph 52, and of 1 August 2022, *Sea Watch*, C-14/21 and C-15/21, EU:C:2022:604, paragraphs 92 and 94 and the case-law cited). It follows that Regulation No 6/2002 must be interpreted, as far as is possible, in accordance with the TRIPs Agreement and, as a consequence, with the rules set out by the articles of the Paris Convention, including Article 4 thereof, which are incorporated into that agreement (see, by analogy, judgments of 15 November 2012, *Bericap Záródástechnikai*, C-180/11, EU:C:2012:717, paragraphs 70 and 82, and of 11 November 2020, *EUIPO v John Mills*, C-809/18 P, EU:C:2020:902, paragraphs 64 and 65).

71 When interpreting Article 41 of Regulation No 6/2002 in accordance with Article 4 of the Paris Convention, regard should also be had to the provisions of the PCT, pursuant to which the earlier application, on which KaiKai relies in order to claim a right of priority, was filed. Since all of the EU Member States are party to the PCT, regard may be had to the provisions of that treaty in the interpretation of provisions of EU secondary legislation which fall within its scope (see, to that effect, judgment of 1 August 2022, *Sea Watch*, C-14/21 and C-15/21, EU:C:2022:604, paragraph 90 and the case-law cited). In that context, it must also be noted that the PCT, in accordance with Article 1(2) thereof, is without prejudice to the rights provided for by the Paris Convention.

72 It is in the light of those considerations that the question whether the General Court, as EUIPO essentially submits, disapplied Article 41(1) of

Regulation No 6/2002 in favour of the direct application of Article 4 of the Paris Convention must be examined.

The clear and exhaustive nature of Article 41(1) of Regulation No 6/2002

73 On the one hand, in paragraphs 56 to 66 of the judgment under appeal, the General Court found, on the basis of an interpretation of Article 41(1) of Regulation No 6/2002 in accordance with its own interpretation of Article 4 of the Paris Convention, that Article 41(1) contained a gap, in that it did not provide for the period for claiming the right of priority based on the international application filed under the PCT on 26 October 2017, which it categorised as an '*international patent application*', and that it was necessary to fill that gap by applying Article 4 of the Paris Convention. On the other hand, in paragraphs 70 to 86 of the judgment under appeal, the General Court essentially held, on the basis of its own interpretation of Article 4, that that period was 12 months, with the result that the Board of Appeal of EUIPO had wrongly found that that period was that of six months set by Article 41(1).

74 However, irrespective of the merits of the General Court's interpretation of Article 4 of the Paris Convention, it must be found that it erred in law, in that it manifestly exceeded the limits of a consistent interpretation of Article 41(1) of Regulation No 6/2002 and proceeded, in fact, to apply directly Article 4 of the Paris Convention, as interpreted by that court, to the detriment of the clear wording of Article 41(1) and in disregard of the exhaustive nature of the latter provision.

75 Article 41(1) of Regulation No 6/2002 in fact provides that '*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], or to the Agreement establishing the [WTO], ... shall enjoy, for the purpose of filing an application for a registered Community design ... a right of priority of six months from the date of filing of the first application*'.

76 Thus, it follows unequivocally from the clear wording of Article 41(1) that only two categories of earlier application – namely (i) an application for registration of a design and (ii) an application for registration of a utility model – can form the basis of a right of priority for a subsequent application for registration of a Community design, solely within a period of six months as of the date of filing of the earlier application concerned.

77 It also follows that Article 41(1) is exhaustive and that the fact that that provision does not fix the time period in which a right of priority based on an application for registration of a patent may be claimed is not a gap in that provision, but the consequence of the fact that that provision does not allow such a right to be based on that category of earlier applications.

78 Accordingly, first, an international application filed under the PCT can form the basis of a right of priority, pursuant to Article 41(1) of Regulation No 6/2002, solely provided that the subject of the international application in question is a utility model and, second, the time period in which to claim that right on the basis of

such an application is that of six months, expressly fixed in Article 41(1).

The General Court's interpretation of the Paris Convention

79 As regards the General Court's interpretation, in paragraphs 70 to 86 of the judgment under appeal, of Article 4 of the Paris Convention, under which that provision allows the priority of an earlier '*international patent application*' to be claimed when filing a later design application within a period of 12 months, it must be held that that interpretation is also vitiated by errors of law.

80 At the outset, it should be recalled that, in so far as the rules set out by certain articles of the Paris Convention, including Article 4 thereof, are incorporated into the TRIPs Agreement, which was concluded by the European Union and forms an integral part of its legal order, the Court of Justice has jurisdiction to interpret those rules (see, by analogy, judgments of [14 December 2000, Dior and Others, C-300/98 and C-392/98, EU:C:2000:688](#), paragraphs 33 to 35 and the case-law cited, and of 2 September 2021, Republic of Moldova, C-741/19, EU:C:2021:655, paragraph 29 and the case-law cited).

81 In that connection, it should be observed that Article 4(A)(1) of the Paris Convention provides that the beneficiary of the right of priority is 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 party to that convention, and that that right of priority is to be recognised for the purposes of allowing that beneficiary to do so in the other countries to which that convention applies.

82 Furthermore, it is clear from Article 4(C)(1), (2) and (4) of that convention that, in principle, only a subsequent application with the '*same subject*' as an earlier applicant can enjoy a right of priority and that the time periods in which that right may be exercised are determined by reference to the type of industrial property right concerned; those time periods are fixed at 12 months for patents and utility models, and six months for industrial designs.

83 As the Guide to the application of the Paris Convention – an interpretative document prepared by WIPO which, despite having no normative scope, nevertheless contributes to the interpretation of that convention (see, by analogy, judgment of [7 December 2006, SGAE, C-306/05, EU:C:2006:764](#), paragraph 41) – also states, it therefore follows from a combined reading of sections A and C of Article 4 of that convention that the subsequent application must concern the '*same subject*' as the earlier application that forms the basis of the right of priority.

84 Finally, while Article 4(E) of the Paris Convention accepts that a given subject can sometimes enjoy more than one form of protection, with the result that a right of priority can be relied upon for a form of protection other than that sought earlier, that provision exhaustively sets out, however, the situations in which that may occur. More specifically, that provision provides, in paragraph

1 thereof, that a utility model application can give rise to a right of priority for a design application, in the period fixed for designs, namely six months, and, in paragraph 2 thereof, that a patent application can give rise to a right of priority for a utility model application and vice versa.

85 In those circumstances, Article 4 of the Paris Convention does not allow priority to be claimed in respect of an earlier patent application when filing a subsequent design application, and therefore, a fortiori, does not lay down any rules on the time period prescribed to the applicant to that end. Thus, only an international application filed under the PCT relating to a utility model can give rise to a right of priority for a design application by virtue of that Article 4, within the period of six months referred to in section E, paragraph 1, thereof.

86 Having regard to all of the foregoing considerations, the single ground of appeal must be upheld and, accordingly, the judgment under appeal set aside in so far as it upholds the second part of the second plea in law in the action at first instance and annuls the decision at issue.

The action before the General Court

87 In accordance with the second sentence of the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, if the decision of the General Court is set aside, the Court of Justice may itself give final judgment in the matter, where the state of the proceedings so permits.

88 In the present case, in the light of the fact that the action for annulment brought by KaiKai in Case T-579/19 is based on pleas that were the subject of an exchange of arguments before the General Court and the examination of which does not require any further measure of organisation of procedure or inquiry to be taken in the case, the Court of Justice considers that the state of the proceedings is such that it may give final judgment in the matter and it is therefore appropriate that it does so, within the limits of the matter before it (see, by analogy, judgments of 8 September 2020, Commission and Council v Carreras Sequeros and Others, C-119/19 P and C-126/19 P, EU:C:2020:676, paragraph 130, and of 4 March 2021, Commission v Fútbol Club Barcelona, C-362/19 P, EU:C:2021:169, paragraph 108).

89 That action is based on two pleas in law, set out in paragraph 25 of the present judgment. As is clear from paragraph 27 of the present judgment, the first part of the second of those pleas was rejected by the General Court, without KaiKai challenging, in the context of a cross-appeal, the merits of that part of the judgment under appeal. Accordingly, the setting aside, in part, of that judgment by the Court of Justice does not call that same judgment into question in so far as the General Court rejected that part of the second plea. In those circumstances, the judgment under appeal has the force of res judicata in so far as the General Court rejected the first part of the second plea in law in the action at first instance.

90 The same applies, for those reasons, to the grounds of the judgment under appeal, referred to in paragraph 26

of the present judgment, on which the General Court rejected as inadmissible the second and fifth heads of claim in the action.

91 In the light of the foregoing considerations, it is appropriate to examine only the first plea and the second part of the second plea relied on by KaiKai in support of its action for annulment, and only in so far as that plea and that part seek annulment of the decision at issue and an order that EUIPO pay the costs of the proceedings before the Board of Appeal and before the General Court.

Arguments of the parties

92 By the first plea in its action for annulment, KaiKai claims that the Board of Appeal of EUIPO infringed essential procedural requirements.

93 By the second part of the second plea in that action, KaiKai claims that, in the absence of a clear rule in Regulation No 6/2002 in so far as concerns the time period for claiming the priority arising from an international patent application filed under the PCT, the Board of Appeal of EUIPO ought to have applied Article 4(C)(1) of the Paris Convention in order to determine that time period.

94 In that connection, KaiKai takes the view, first, that it follows from Article 4(E)(1) of that convention that where, on the one hand, the respective material contents of a patent application and a utility model application are, in essence, identical, with the result that the earlier of those two applications can be relied upon in support of a right of priority when the other application is filed, and, on the other hand, the content of a utility model application is sufficient in order for it to be relied upon as the basis of priority for a subsequent design application, the content of a patent application is necessarily sufficient to give rise to a right of priority for a subsequent design application. Second, KaiKai argues that that convention is founded on the principle that the effective period for claiming a right of priority depends on the nature of the industrial property right that was the subject of the earlier application, irrespective of the nature of the right that is the subject of the subsequent application. KaiKai observes, moreover, that Article 4(C)(1) of that convention provides for a period of 12 months in which to claim a right of priority based on an earlier patent application. Finally, KaiKai infers from this that, in so far as an international application filed under the PCT must be regarded as a '*patent application*' within the meaning of the latter provision, the priority period applicable to that application is 12 months.

95 EUIPO disputes those arguments.

Findings of the Court

96 As regards the first plea in the action for annulment, it must be recalled that it follows from the first paragraph of Article 21 of the Statute of the Court of Justice of the European Union, which applies to the General Court by virtue of the first paragraph of Article 53 of that statute, and from Article 76(d) of the Rules of Procedure of the General Court, that an application initiating proceedings must, in particular, contain the subject matter of the proceedings, the pleas in law and arguments relied on

and a summary of those pleas in law. That information given must be sufficiently clear and precise to enable the defendant to prepare its defence and the General Court to rule on the action. In order to guarantee legal certainty and the sound administration of justice it is necessary, in order for an action before the General Court to be admissible, that the basic legal and factual particulars relied on be indicated, at least in summary form, coherently and intelligibly in the application itself (see, to that effect, judgments of 29 March 2012, *Commission v Estonia*, C-505/09 P, EU:C:2012:179, paragraph 34, and of 3 March 2022, *WV v EEAS*, C-162/20 P, EU:C:2022:153, paragraphs 67 and 68).

97 In the present case, it is clear that the matters of law on which the alleged infringement of essential procedural requirements relied upon in the first plea is based are in no way apparent in the text of the application at first instance, since KaiKai confined itself to raising such an infringement without putting forward any argument whatsoever in support of that plea. It follows that the first plea in law must be rejected as inadmissible.

98 As regards the second part of the second plea in law, it is sufficient to observe that, on the grounds set out in paragraphs 57 to 85 of the present judgment, that part must be rejected as unfounded. Neither Article 41(1) of Regulation No 6/2002 nor Article 4 of the Paris Convention – which, moreover, does not have direct effect in the EU legal order – makes it possible to claim priority for an international application filed under the PCT when filing a subsequent design application within a period of 12 months, irrespective of whether that international application concerns a utility model or a patent. Thus, in accordance with those provisions, in the first of those situations, the period for claiming a right of priority on the basis of that international application is set at six months whereas, in the second of those situations, the existence of such a right is precluded from the outset.

99 Since the first plea and the second part of the second plea in the action for annulment have been rejected, that action must be dismissed.

Costs

100 Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is unfounded or where the appeal is well founded and the Court itself gives final judgment in the case, the Court is to make a decision as to the costs.

101 Under Article 138(1) of the Rules of Procedure of the Court of Justice, which applies 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.

102 In the present case, since KaiKai has been unsuccessful in both the present appeal and the proceedings at first instance, it must be ordered to bear its own costs and pay those incurred by EUIPO in both sets of proceedings, in accordance with the pleadings of EUIPO and the Commission.

103 In accordance with Article 140(1) of those rules of procedure, applicable to appeal proceedings by virtue of

Article 184(1) thereof, the Member States and institutions which have intervened in the proceedings are to bear their own costs.

104 Consequently, the Commission, which has intervened in the present appeal, is ordered to bear its own costs.

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

1. Sets aside the judgment of the General Court of the European Union of 14 April 2021, *The KaiKai Company Jaeger Wichmann v EUIPO* (Gymnastic and sports apparatus and equipment) (T-579/19, EU:T:2021:186), in so far as it upholds the second part of the second plea in law in the action at first instance and annuls the decision of the Third Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 13 June 2019 (Case R 573/2019-3);

2. Dismisses the action brought by *The KaiKai Company Jaeger Wichmann GbR* in Case T-579/19;

3. Orders *The KaiKai Company Jaeger Wichmann GbR* to bear its own costs and pay those incurred by the European Union Intellectual Property Office (EUIPO) in both the present appeal and the proceedings at first instance;

4. Orders the European Commission to bear its own costs.

Opinion of Advocate General T. Čápetá delivered on 13 July 2023.

Case C-382/21 P

European Union Intellectual Property Office (EUIPO)
v

The KaiKai Company Jaeger Wichmann GbR

(Appeal – Intellectual property – Community designs – Regulation (EC) No 6/2002 – Article 41(1) – Right of priority – Priority claim based on international application filed under the Patent Cooperation Treaty – Priority period – Paris Convention for the Protection of Industrial Property – Article 4 – Interpretation of EU law in conformity with international law – Direct effect of international agreements – Preliminary admission mechanism for appeals – Case raising significant issue with respect to the unity, consistency or development of EU law)

I. Introduction

1. This case arises from the appeal brought by the European Union Intellectual Property Office ('EUIPO') against the judgment of 14 April 2021, *The KaiKai Company Jaeger Wichmann v EUIPO* (Gymnastic and sports apparatus and equipment) (T-579/19, EU:T:2021:186) ('the judgment under appeal').

2. By that judgment, the General Court annulled the decision of the Third Board of Appeal of EUIPO of 13 June 2019 (Case R 573/2019-3), which refused to recognise the right of priority in the application submitted by *The KaiKai Company Jaeger Wichmann GbR* ('KaiKai') for the registration of gymnastic and sports equipment as Community designs under Regulation No 6/2002. (2) KaiKai's priority claim was

based on an earlier international application filed under the Patent Cooperation Treaty ('the PCT'). (3)

3. Formally, this appeal is based on only one ground, relating to the alleged infringement of Article 41(1) of Regulation 6/2002 by the General Court. However, the arguments advanced by EUIPO raise important issues regarding the relationship between international agreements binding on the EU and secondary EU law, together with the pertinent powers and duties of the EU Courts in that respect. This appeal also raises the question of the interpretation of an international convention, in this case the Paris Convention for the Protection of Industrial Property ('the Paris Convention'). (4)

4. Those were the reasons why this appeal was allowed to proceed under the preliminary admission mechanism for appeals ('the appeal filtering mechanism') introduced by Article 58a of the Statute of the Court of Justice of the European Union. (5) This case is the first appeal which the Court has admitted since that mechanism was introduced on 1 May 2019. Appeals concerned by that mechanism are allowed to proceed only if they raise an issue that is significant with respect to the unity, consistency or development of Union law. (6)

5. After briefly explaining the background to this case (II), I will say a few words about the appeal filtering mechanism and why the present appeal merited admission (III). I will then proceed to analyse the substance of the arguments raised by the parties (IV).

II. Background

A. Relevant law

1. Regulation 6/2002

6. Article 41(1) of Regulation 6/2002 states:

'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], or to the Agreement establishing the World Trade Organisation, 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. The Paris Convention

7. Article 4(A)(1) of the Paris Convention provides: '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 [States party to the Paris Convention], 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.'

8. Article 4(C)(1) of the Paris Convention states: 'The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.'

9. Article 4(E) of the Paris Convention provides: '(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.'

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.’

B. Events leading to the proceedings before the General Court

10. On 24 October 2018, KaiKai filed a multiple application for the registration of 12 Community designs with EUIPO pursuant to Regulation 6/2002. KaiKai claimed priority based on the previous international application No PCT/EP2017/077469, which it filed under the PCT on 26 October 2017.

11. Applying Article 41(1) of Regulation 6/2002, the EUIPO examiner accepted the multiple application, but refused the priority claim because the date of the filing of KaiKai’s international application exceeded the six-month period set out in that provision.

12. KaiKai lodged an appeal against that decision, considering, in essence, that the applicable priority period was twelve months, not six months.

13. By decision of 13 June 2019 (R 573/2019-3), the Third Board of Appeal of EUIPO dismissed that appeal. The Board of Appeal found, in substance, that the examiner had correctly applied Article 41(1) of Regulation 6/2002, according to which an international application under the PCT could be assimilated to an application for a utility model and can, therefore, serve as a basis for a priority claim for a Community design. However, such priority had to be claimed within the required six-month period, which was exceeded in the proceedings initiated by KaiKai.

C. The proceedings before the General Court and the judgment under appeal

14. On 20 August 2019, KaiKai brought an appeal against the Board of Appeal’s decision before the General Court. In support of its action, KaiKai relied on two pleas in law, the first alleging infringement of essential procedural requirements and the second alleging infringement of Regulation 6/2002.

15. By the judgment under appeal, the General Court upheld KaiKai’s second plea in law and annulled the Board of Appeal’s decision, without ruling on the first plea in law.

16. The General Court found that EUIPO rightly held that an international application under the PCT can be relied on in order to claim priority for a Community design under Article 41(1) of Regulation 6/2002. However, EUIPO erred in applying a six-month priority period, rather than a twelve-month priority period, in the present case.

17. That was so because the General Court considered that KaiKai’s international application under the PCT could also be characterised as an international application for a patent, and not only for a utility model. The General Court then observed that Article 41(1) of Regulation 6/2002 is silent as to the priority period arising from an application for a patent; it only states the length of the period if the priority is based on a previous application for a design or a utility model. In the latter case, that period is six months. In order to fill that legislative gap, the General Court held that account must be taken of Article 4 of the Paris Convention.

18. The General Court seems to have considered that the Paris Convention allows for priority claims between different pairs of intellectual property rights. Basing a priority claim for an industrial design on a previous application for a patent is, therefore, possible under the Paris Convention. The General Court further considered that the priority period in such a case is twelve months, as Article 4(C)(1) of that Convention envisages that the priority period for patents is twelve months.

19. The relevant priority period for the pair consisting of a previous patent and a subsequent design depended, for the General Court, on the period assigned by the Paris Convention for patents. That was so because the Paris Convention establishes a general rule that the nature of the earlier right determines the length of the priority period. In the General Court’s understanding, Article 4(E)(1) of the Paris Convention – which provides that the priority period fixed for the subsequent right is decisive if that subsequent right is a design and the earlier right is a utility model – is a special rule which constitutes an exception to that general rule.

20. Consequently, the General Court concluded that EUIPO had erred in finding that the priority period applicable to claiming priority for an earlier international patent application in respect of a Community design application was six months.

D. The procedure before the Court of Justice

21. On 23 June 2021, EUIPO lodged the present appeal against the judgment of the General Court. EUIPO requests that the Court of Justice set aside the judgment under appeal and dismiss the action brought by KaiKai at first instance. EUIPO also requests that the Court order KaiKai to pay all the costs.

22. Also on 23 June 2021, EUIPO submitted a request, in accordance with Article 58a of the Statute and Article 170a of the Rules of Procedure of the Court of Justice, that the appeal be allowed to proceed.

23. By order of 10 December 2021, EUIPO v The KaiKai Company Jaeger Wichmann (C-382/21 P, EU:C:2021:1050), the Court admitted the appeal.

24. In its response lodged on 25 February 2022, KaiKai requested that the Court dismiss the appeal and order EUIPO to pay all the costs.

25. By decision of the President of the Court of 8 April 2022, the Commission was granted leave to intervene in support of the form of order sought by EUIPO.

26. EUIPO and KaiKai also lodged a reply and a rejoinder on 30 May 2022 and 11 July 2022, respectively.

27. A hearing was held on 13 March 2023 at which EUIPO, KaiKai and the Commission presented oral argument.

III. The appeal filtering mechanism and its application in the present case

28. As mentioned in the Introduction, this is the first case in which the Court has admitted an appeal under the appeal filtering mechanism. (7) The novelty of this procedure leads me to make some observations on this mechanism and its use in the present case.

A. Some observations on the appeal filtering mechanism

29. The appeal filtering mechanism lies within the context of the (still ongoing) reforms of the EU judiciary. The idea stemmed from the fact that many appeals are brought in cases which have already been considered twice, first by an independent board of appeal and second by the General Court, and that many of those appeals are dismissed as manifestly inadmissible or manifestly unfounded. Thus, in order to enable the Court of Justice to concentrate on the cases that require its full attention, this mechanism was adopted. (8)

30. The appeal filtering mechanism currently applies to decisions of an independent board of appeal of four EU offices and agencies (EUIPO, the Community Plant Variety Office, the European Chemicals Agency and the European Union Aviation Safety Agency), along with decisions of all independent boards of appeal set up after 1 May 2019 within any other EU office or agency. (9) The recent proposal of the Court of Justice will, if accepted by the EU legislature, apply this mechanism to a number of other existing EU offices, bodies and agencies which have an independent board of appeal. (10)

31. Under the appeal filtering mechanism, the Court will allow an appeal to proceed, in whole or in part, only 'where it raises an issue that is significant with respect to the unity, consistency or development of Union law'. (11) The request to admit an appeal must be made by the appellant through a separate document annexed to the appeal, which must explain why the appeal is important for the unity, consistency or development of EU law. (12)

32. The relevant procedural rules do not elaborate as to what is meant by an issue that is significant with respect to the unity, consistency or development of EU law. That has instead been left to the Court to work out in the case-law. (13) In addition, the wording of those rules uses 'or', and not 'and' ('the unity, consistency or development of Union law'), which makes it possible that an appeal can proceed even if one or two, but not all, of those categories is at stake.

33. That open wording suggests that the Court enjoys a wide discretion in deciding whether it finds that a certain appeal raises an issue which it considers to be of importance for the overall development of the EU legal order.

34. In that respect, by way of comparative reflection, I am reminded, for example, of the rules concerning the certiorari mechanism of the United States Supreme Court, by which it is petitioned to review decisions of lower courts in respect of matters of federal law. Typically, the US Supreme Court only decides to hear such cases where they could be of national importance, harmonise conflicting decisions or have precedential value. (14)

35. Rule 10 of the US Supreme Court, entitled 'Considerations Governing Review on Certiorari', (15) explains that review on a writ of certiorari is not a matter of right, but of judicial discretion, and will be granted

only for compelling reasons. That rule enumerates some factors which can be taken into consideration, but which are 'neither controlling nor fully measuring the Court's discretion'. (16)

36. The appeal filtering mechanism can, to my mind, be understood as a kind of 'European Union certiorari'. It does not exist to correct every mistake of the General Court, but only those that are of considerable importance. It is, therefore, to be employed only if the decision of the Court of Justice can have a fundamental impact on the EU legal order. (17)

37. The appeal filtering mechanism highlights the function of the Court of Justice as the Supreme and Constitutional Court of the European Union. (18) Indeed, it involves the Court of Justice in 'constitutional-type' cases of importance for the EU, involving interpretation of basic constitutional principles of EU law and the horizontal and vertical division of competences.

38. The appeal filtering mechanism also strengthens, in my view, the role of the General Court. In all cases in which the Court of Justice does not allow an appeal to proceed, the General Court becomes the court of last resort for cases between private parties and EU authorities in a number of fields (including intellectual property) and thus the General Court's interpretation of the applicable law is binding throughout the EU.

B. Issues justifying the admission of the present appeal

39. It follows from the order allowing the appeal to proceed (19) that the judgment under appeal not only has possible precedential value for future cases concerning priority rights, but also raises important questions for EU external relations law and the horizontal division of competences between the EU Courts and other EU institutions. Consequently, the Court found that this appeal raises significant issues with respect to the unity, consistency 'and' development of EU law.

40. To my mind, this case raises two set of issues that justify its admission through the appeal filtering mechanism.

41. The first set of issues relates to the applicability before the EU Courts of international agreements binding on the EU. More specifically, one issue concerns the relationship between the direct effect and the interpretative effect of such agreements. In the present case, EUIPO claims that the General Court filled the (non-existent) gap in the pertinent EU legislation (Regulation 6/2002) by giving direct effect to the Paris Convention (which it interpreted wrongly). The Paris Convention, in EUIPO's understanding, does not have direct effect in the EU legal order. At the same time, EUIPO does not deny its possible interpretative effect. The Court is thus invited to clarify when an international agreement has direct effect and whether it can have interpretative effect if it lacks direct effect.

42. Another issue that arises in relation to the applicability of international agreements concerns the boundaries of conforming interpretation and whether they are the same when it comes to an interpretation of EU law in conformity with international agreements and

when it comes to an interpretation of national law in conformity with EU law. That issue was introduced by EUIPO's claims that the General Court overstepped the *contra legem* limit. The present case therefore invites the Court to decide whether finding a gap in an EU legal provision is a method of conforming interpretation.

43. The second set of issues justifying admission of the appeal relates to the interpretation of the Paris Convention. In the present case, EUIPO claims that the General Court wrongly interpreted that Convention. The Paris Convention does not provide for a right of priority for a subsequent design application based on a previous patent application. Nor does it contain a general rule according to which the priority period depends on the nature of the earlier right. This begs the question of what should guide the Court in the interpretation of the Paris Convention and other international agreements.

IV. Analysis

44. EUIPO, supported by the Commission, raises a single ground of appeal, alleging infringement of Article 41(1) of Regulation 6/2002. That single ground is divided into three claims. The first is that the General Court interpreted Regulation 6/2002 *contra legem*. The second is that the General Court attributed direct effect to the Paris Convention contrary to EU law. The third is that the General Court incorrectly interpreted the Paris Convention and the PCT.

45. The first two claims by EUIPO concern the applicability of the Paris Convention before the EU Courts, which I will address under (A). For the sake of my arguments, I will deal with them in reverse order. I will then, under (B), address the interpretation of that Convention.

A. Applicability of the Paris Convention before the EU Courts

46. At the outset, it is necessary to state that a legal rule can be applied in a case in different ways. (20) It can be used to resolve certain factual situations directly, either without the need to apply other rules, or even by setting aside other rules that are in the way of the rule to be applied. In EU law, this is called direct effect. A rule can also be applied indirectly, if, for example, it serves as a guide for the interpretation of another rule to be applied. In EU law, this is called indirect or interpretative effect. For the discussion that follows, it is important to recognise that the two lead to the same result. For instance, if a dispute is resolved directly on the basis of a directive, the result is the same as if the same dispute is resolved on the basis of national rule that is interpreted in conformity with that directive.

47. EUIPO and the Commission submit that the Paris Convention does not have direct effect. Neither of them excludes the possibility of its interpretative effect, but they consider that in this case that is not possible, as it would require a *contra legem* interpretation of Regulation 6/2002. In the first part of this analysis, I will propose that an international agreement is either applicable (both directly and indirectly) or it is not applicable (either directly or indirectly) before the EU Courts. I am of the opinion that the Paris Convention is applicable, which is why, in the second part of the

analysis, I will analyse the issue raised by EUIPO concerning the limits of conforming interpretation.

1. Direct effect and interpretative effect of the Paris Convention

48. EUIPO, supported by the Commission, complains that the General Court erred in law by substituting Article 41(1) of Regulation 6/2002 with the (wrongly interpreted) provisions of the Paris Convention. That amounts to recognition of the direct effect of Article 4 of the Paris Convention, which runs contrary to the case-law of the Court of Justice. The lack of direct effect of the Paris Convention also follows from Article 25 thereof, and, in any event, the conditions for direct effect (unconditional and sufficiently precise) are not fulfilled.

49. KaiKai does not discuss the possible direct effect of the Paris Convention, but contends that the General Court only recognised the interpretative effect of the Paris Convention when it filled the gap in Article 41(1) of Regulation 6/2002 by reference to Article 4 of that Convention.

50. What effect can an international agreement, such as the Paris Convention, have before the EU Courts?

51. To begin with, the question of how an international agreement can be applied in the EU exists only if that agreement is part of the EU legal order. An international agreement is, in principle, part of the EU legal order if the EU is a party to it. (21) Once part of the EU legal order, an international agreement is binding on the EU institutions and the Member States, (22) and has primacy over secondary EU law. (23)

52. The EU is not a party to the Paris Convention. All EU Member States are parties thereto, but that in itself does not mean that the Paris Convention is also part of the EU legal order and binds its institutions.

53. However, the EU is a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPS Agreement'), (24) which is one of the WTO agreements. The TRIPS Agreement itself does not regulate priority rights. Rather, Article 2(1) thereof provides:

'In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention'.

54. It could thus be concluded that the EU has to recognise priority rights in the same way in which the Paris Convention recognises such rights. (25) Therefore, the EU has become bound by Article 4 of the Paris Convention, which is relevant to the present case, through its obligations under the TRIPS Agreement. (26)

55. That still does not answer the question whether a party, such as KaiKai, can rely before the EU Courts on Article 4 of the Paris Convention directly or for the purposes of interpreting the applicable EU law.

56. Whether a provision of law has direct effect depends not only on its clarity, but also on the context in which that provision is situated. Thus, in the established line of cases, the Court has considered that a provision of a directive, even if sufficiently precise and unconditional, cannot have direct effect to resolve a dispute between individuals. (27)

57. Similarly, the direct effect of an international agreement depends not only on the clarity of the provisions intended to bestow rights on individuals, but also on the nature of the agreement at issue. (28)

58. In principle, the Treaties do not preclude that international agreements are recognised as having direct effect. The Court has, for instance, recognised the direct effect of a number of association agreements, whether their function was to prepare a State for future EU membership, (29) or not. (30) The Court has also recognised the direct effect of other bilateral agreements, such as the Open Skies Agreement with the United States, (31) and of some provisions of multilateral agreements, such as the Yaoundé and Lomé Conventions (32) and the Protocol for the Protection of the Mediterranean Sea against Pollution from Land-based Sources. (33)

59. In contrast, the nature of the WTO agreements, and not their unclear wording, was the main motive for the case-law which, in principle, excluded their direct effect. (34)

60. The Court has, in the light of the case-law relating to the WTO system, also, in principle, excluded the direct effect of the TRIPS Agreement. (35)

61. As certain provisions of the Paris Convention have become part of EU law and bind the EU through the intermediary of the TRIPS Agreement, it is possible to conclude that such provisions, in principle, should not be recognised as having direct effect either.

62. The nature of the WTO agreements, which the Court had in mind when it principally rejected their direct effect, had to do with the flexibility and reciprocity of obligations which the EU has undertaken towards other contracting parties. The WTO system is flexible in the sense that its provisions could be circumvented, and allows for different negotiated solutions to resolve the ensuing dispute. (36) That flexibility allows the EU political institutions, as it does for the other contracting parties to the WTO agreements, to opt for solutions which the Court might not find to be in conformity with WTO requirements. In order to allow such a political margin of manoeuvre, the Court considered that it should not review the validity of EU legislation in relation to WTO law. Rather than expressing that choice as a sort of deliberate self-restraint aimed at respecting the division of powers within the WTO, the Court has used the legal concept of direct effect. However, in my view, the reason for refusing, in principle, to recognise the direct effect of WTO law was not to deprive individuals of the possibility of relying on international agreements in court, but rather was aimed at allowing the EU institutions a political margin of manoeuvre. (37)

63. The Court has, nevertheless, exercised its power of judicial review of EU legislation in relation to WTO law when it considered that the EU legislature did not have the intention of using the political flexibility left by the WTO system. In such a situation, judicial review would not undermine the political discretion necessary at WTO level. (38)

64. As a consequence, two different situations on which the direct applicability of WTO law depends may be distinguished. The first situation, represented by cases such as *Nakajima*, (39) is where the Court considers that the relevant EU legislation was adopted with a view to implementing a WTO-based commitment. ‘With a view to implementing’ not only means a situation in which a WTO obligation necessitates further implementation, but also embraces situations in which the EU legislature decided to align its legislation (existing or new) with its WTO commitments. The second situation, represented by cases such as *Rusal Armenal*, (40) is where the Court considers that it is possible that the EU legislature might have wanted to adopt a specific EU solution, notwithstanding its WTO obligations. That does not mean that the EU solution is not in conformity with WTO law, but only that it is adopted without trying to adjust to WTO obligations.

65. The two situations are mutually exclusive. In other words, as I have already stated elsewhere, (41) either *Nakajima* or *Rusal Armenal* applies.

66. In the present case, the Commission claims that it cannot be concluded from Article 41(1) of Regulation 6/2002 that the EU legislature intended to make Article 4 of the Paris Convention an EU standard for the priority periods which can be relied on in respect of the application of Community designs. (42) Rather, the EU adopted its own solution: when applying for a Community design, a person may rely on a priority right based on a previous application for a design or utility model during the six-month period. Thus, as claimed by EUIPO, the EU legislature intentionally excluded any other type of previous application, including an application for a patent. In its view, that solution is in line with the Paris Convention, but even if it were not, that would not matter, as it expresses the clear will of the EU legislature, and the Court would go against it if it applied a different solution. In other words, we are in a *Rusal Armenal* type of situation, and not in a *Nakajima* type of situation. There is, therefore, no reason to recognise the direct effect of the Paris Convention.

67. I disagree. Article 41(1) of Regulation 6/2002 should be interpreted as an expression reflecting the EU legislature’s intention to align it with Article 4 of the Paris Convention. First, the wording of Article 41 of Regulation 6/2002 is virtually identical to Article 4 of the Paris Convention, which was recognised by the Court. (43) That suggests a legislative intention to align Regulation 6/2002 with that international agreement. (44) Second, the inclusion of a utility model, alongside a design, seems to express the intention of the EU legislature to give effect to Article 4(E)(1) of the Paris Convention. This also seems to follow from the travaux préparatoires leading to Regulation 6/2002, in which the Commission amended its original proposal with a view to adjusting it to Article 4(E)(1) of the Paris Convention. (45)

68. With the aforementioned in mind, I am of the opinion that, in the circumstances of this case, the nature of the Paris Convention introduced into EU law through

the TRIPS Agreement does not prevent its direct effect. By Article 41(1) of Regulation 6/2002, the EU legislature intended to align EU design law with the Paris Convention in respect of the existence and the length of priority rights. This case is, therefore, comparable to the Nakajima situation, rather than the one in Rusal Armenal.

69. I also do not agree with the arguments put forward by EUIPO and the Commission that Article 25(1) of the Paris Convention prevents its direct effect. That provision, entitled 'Implementation of the Convention on the Domestic Level', states: 'Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.' It is my understanding that that provision simply requires the contracting parties to do what is necessary under their constitutions. For those countries whose constitutional choice of the relationship of their legal orders with international law is predominantly dualistic, this may mean transforming the Paris Convention into a domestic source of law in order to give it effect. However, as I have already explained, the Treaties do not exclude, in principle, the direct effect of international agreements which bind the EU. While some provisions of the Paris Convention might indeed require additional choices by the EU legislature, those provisions that can be implemented without additional choices may have direct effect. Thus, given that the EU legislature did not intend to avail itself of the flexible nature of the TRIPS Agreement, but chose to align its legislation on priority rights with the solutions offered by the Paris Convention, the direct effect of those rules of the Paris Convention depends on whether they satisfy the usual criteria of being sufficiently precise and unconditional. I will deal with the interpretation of the relevant rules of the Paris Convention in points 94 to 140 of this Opinion.

70. At this point, it is necessary to address another issue. KaiKai claims that, by filling the legislative gap, the General Court did not grant direct effect, but rather interpretative effect, to the Paris Convention. In that respect, I agree with KaiKai. Therefore, EUIPO's argument that the General Court erred in law because it gave direct effect to the (wrongly interpreted) Paris Convention should be rejected not because that Convention does not have direct effect in the present case, but because the General Court did not apply it directly, and instead used it for interpretative purposes.

71. Even though EUIPO rejects the possibility of the direct effect of the Paris Convention, it does not oppose its possible interpretative effect. That begs the following question.

72. If, indeed, as claimed by EUIPO and the Commission, we are in a Rusal Armenal type of situation and the Paris Convention should not be recognised as having direct effect in order to safeguard the political margin of manoeuvre left to the EU institutions under the TRIPS Agreement, including the possibility to deviate from the requirements of the Paris Convention when regulating Community designs, why should the

Court endeavour to interpret the relevant EU legislation in conformity with the Paris Convention at all?

73. As I recalled at the outset (see point 46 of this Opinion), if the Court successfully interprets EU legislation in conformity with an international agreement, the result is the same as if direct effect were given to that agreement. Once the Court refused to recognise direct effect with a view to safeguarding the political margin of manoeuvre of the EU institutions to depart from an international obligation, the same reasons militate in favour of refraining from a conforming interpretation as well.

74. When imposed on national courts, the obligation of conforming interpretation is a far-reaching obligation to do everything possible to achieve a result required by EU law through interpretation of domestic law. (46) It requires a conforming interpretation not only of the national law adopted for the purpose of implementation of EU law (usually a directive), but also of any other domestic law, including pre-existing rules. (47)

75. That means that, if transferred to the relationship between EU legislation and international agreements, the obligation of conforming interpretation would apply to all EU legislation, whether or not it is adopted specifically for the implementation of an international commitment. In other words, the EU Courts would be under the obligation to interpret EU legislation in conformity with an international agreement not only in a Nakajima type of situation, but also in a Rusal Armenal type of situation. If such an obligation to do whatever possible to attribute to EU legislation the same meaning as that required under an international agreement were imposed on the EU Courts despite the principled exclusion of direct effect, that would run counter to the purpose of that exclusion.

76. Applied to this case, if the reason for precluding the direct effect of the Paris Convention is to enable the EU legislature to exclude a previous patent application as a basis for claiming priority rights for a subsequent Community design, then insisting that the Court nevertheless interpret Regulation 6/2002 in order to achieve such a result does not make much sense.

77. Therefore, if the Court of Justice does not agree with my assessment that the Paris Convention can have direct effect in the present case because the EU legislature did not intend to align Regulation 6/2002 with that Convention, but rather it adopted a specific EU solution (which may or may not be in conformity with the Paris Convention), the Court of Justice should find that the General Court erred in law by even attempting a conforming interpretation. In my view, both direct effect and the obligation of conforming interpretation are excluded in the Rusal Armenal type of situation. Looking for a gap in EU legislation in order to fill it with a solution that is in conformity with the Paris Convention should, in such a case, be excluded. As I will demonstrate in the next section, conforming interpretation is a specific interpretative method that imposes creativity in order to achieve a result required by the target rule (here, Article 4 of the Paris

Convention). It should, therefore, be employed only in the Nakajima type of situation.

78. That leads me to the next claim raised by EUIPO, according to which the General Court exceeded the boundaries of conforming interpretation.

2. Limits to the duty of conforming interpretation

79. EUIPO claims that the General Court interpreted Article 41(1) of Regulation 6/2002 *contra legem*. It inserted the terms ‘patent’ and ‘twelve months’ into the wording of that provision, whereas its unequivocal wording admits only designs and utility models and a priority period of six months.

80. KaiKai disputes that Article 41(1) of Regulation 6/2002 is exhaustive. In its view, the General Court correctly found that there was a gap which must be filled and that that provision does not contain any specific rules relating to the duration of the priority period based on a patent application. Thus, KaiKai emphasised at the hearing that there is no *contra legem* interpretation in this case; Article 41(1) of Regulation 6/2002 does not, by its wording, exclude other types of intellectual property rights from being used as a basis for the right of priority.

81. In internal matters, starting with the judgment in *Pupino*, (48) the Court has accepted a *contra legem* limit to the obligation of national courts to find solutions in conformity with EU law. The Court has not yet explained the meaning of that limit. However, EUIPO seems to understand it in the sense that courts cannot go against clear and unambiguous wording. (49)

82. In that light, EUIPO claims that the EU legislature exhaustively and clearly regulated the situations in which a priority right can be claimed for the subsequent application for a Community design; patent applications are not among them. (50) There is no legislative gap in that provision. By finding such a legislative gap, the General Court interpreted Article 41(1) of Regulation 6/2002 *contra legem*.

83. Whether finding such a gap is or is not *contra legem* depends, in my view, on the interpretative context in which a court operates. If the Paris Convention, binding on the EU through the TRIPS Agreement, did not exist or were irrelevant, (51) there would not be any reason for the General Court to consider there to be a legislative gap. However, finding a legislative gap could be a solution in the context of an interpretation in conformity with the Paris Convention. Conforming interpretation is an interpretation that aims not only at choosing a meaning of a provision, but also at finding a specific solution corresponding to the requirements of the target rule.

84. Based on the wording of Article 41(1) of Regulation 6/2002, EUIPO claims that patent applications are clearly and unambiguously excluded as a valid basis for a priority right under that provision. Is that really so? There is, in fact, as claimed by KaiKai, no provision of Regulation 6/2002 which expressly excludes a patent application. As beauty is in the eye of the beholder, the level of unambiguity is in the eye of the interpreter.

85. Indeed, Article 41(1) of Regulation 6/2002 expressly includes only two types of previous application: (i) an application for a design; and (ii) an application for a utility model. If read in isolation, there is no reason to think that the EU legislature ‘forgot’ to regulate previous patent applications.

86. However, if Regulation 6/2002 is placed in the context of the EU’s commitments under the Paris Convention as accepted through the TRIPS Agreement, and that Convention is understood as requiring the possibility to use a priority right for a design application on the basis of a prior patent application, the interpretation changes. The absence of any mention of patents seems in such a context to be an omission by the EU legislature. In the context of conforming interpretation, a court is required to correct possible oversights by the legislature. Thus, the General Court should not be prevented from finding a legislative gap based on the alleged requirement of the Paris Convention to allow for the pair consisting of a previous patent and a subsequent design. Gap-finding is, in my view, an acceptable technique in the context of conforming interpretation.

87. That, at least, seems to be the case with internal matters of interpretation of national law in conformity with EU law. As I have already explained (see point 74 of this Opinion), the obligation of conforming interpretation in such internal matters as imposed on national courts is far-reaching. In that context, the Court did not easily accept national courts’ positions that a different interpretation of national law would be *contra legem*. The Court has required national judges to be creative more than in their domestic practice in order to achieve the target result, (52) and even to depart from established case-law when interpreting the domestic rule at issue. (53) The required creativity includes gap-finding. (54)

88. Should the EU Courts, however, resort to the same level of creativity when they are required to interpret EU legislation in conformity with international commitments of the EU?

89. The Court has justified the obligation of conforming interpretation in internal matters in the following way. National courts, as part of the Member States, are bound by the loyalty obligation expressed today in Article 4(3) TEU and referred to as the principle of sincere cooperation. (55) National courts are thus bound to achieve results required by EU law within the scope of their powers, which is to interpret the law. Additionally, due to the same loyalty obligation, a Member State in its legislative capacity should be presumed not to have the intention of breaching EU law. One can imply from this that, unless expressly stated otherwise, all national legislation, prior and subsequent to EU law, is in conformity with EU law. (56) For national courts, that means that they are not contravening the will of the legislature if they interpret national law in conformity with EU law.

90. Even though, according to Article 216(2) TFEU or the international principle *pacta sunt servanda*, the EU is bound by its international obligations, that does not

rest upon the same loyalty obligation of a constitutional nature, (57) which exists for Member States under Article 4(3) TEU. A presumption that the EU legislature did not intend to breach EU international commitments cannot be as firm as the same presumption in internal matters.

91. That may justify a point of view that the obligation of interpretation of EU law in conformity with international agreements is less far-reaching. In that respect, gap-finding might more easily be characterised as a *contra legem* interpretation in the absence of clear proof of the EU legislature's intention to abide by EU international commitments. In any case, the *contra legem* limit to conforming interpretation is itself an object of interpretation in each particular case.

92. Given that the EU legislature chose almost identical wording to that of the Paris Convention when it regulated priority rights in relation to applications for Community designs, and even though it did not expressly state its intention to abide by the priority rules of that Convention anywhere in Regulation 6/2002, I am, as I have already explained (see point 68 of this Opinion), of the view that this case can be characterised as a Nakajima type of situation. For that reason, finding a gap in Regulation 6/2002 would be justified and not a *contra legem* interpretation, if the Paris Convention indeed clearly required the twelve-month priority period. The General Court therefore did not err when it sought to interpret Regulation 6/2002 in conformity with the Paris Convention.

93. I am, however, of the view that the Paris Convention does not contain such a rule requiring a twelve-month priority period, let alone such a clear rule, and that the General Court, therefore, wrongly interpreted that Convention. That brings me to the final part of my Opinion.

B. Interpretation of the Paris Convention

94. There are two principal issues of interpretation of the Paris Convention in relation to which the parties disagree.

95. First, EUIPO, supported by the Commission, argues that the General Court was wrong to consider that the Paris Convention allows a previous patent application as a basis for a subsequent design application. KaiKai contends that the General Court correctly interpreted that Convention.

96. Second, EUIPO argues that the General Court wrongly found that the Paris Convention establishes a general rule according to which the earlier right determines the length of the priority period and from which Article 4(E)(1) of the Paris Convention is an exception. Therefore, EUIPO considers that the General Court erred in finding that KaiKai could benefit from a priority period of twelve months. KaiKai defends the General Court's interpretation.

97. In my view, the General Court correctly held that the Paris Convention allows for a priority claim based on the pair consisting of a previous patent application and a subsequent design application. However, the General Court erred in law by recognising a twelve-month priority period when the priority claim for a

Community design is based on a previous patent application.

98. Before explaining my reasons for such an interpretation of the Paris Convention, I will briefly discuss the methods that the Court should use when interpreting an international agreement such as the Paris Convention.

1. Methods of interpretation of an international agreement

99. International law, including WTO law despite the existence of its dispute settlement mechanism, is not endowed with a judicial institution empowered to interpret provisions of international agreements with the power of final authority binding on all other actors. Thus, in contrast with the EU legal system, it lacks a mechanism guaranteeing uniform interpretation.

100. One tool for alleviating the problem of disparate interpretation is the Vienna Convention on the Law of Treaties ('the Vienna Convention'), which contains rules of interpretation of international agreements. (58) Even though the EU is not a party to that Convention, its rules are a codification of customary international law, (59) and the EU should apply them when interpreting international agreements. (60)

101. Article 31(1) of the Vienna Convention sets out the following general rule of interpretation: 'A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.' Article 31(2) to (4) of that Convention provides further clarifications, and Article 32 thereof states some supplementary interpretative rules.

102. To my mind, the interpretative rules set out in the Vienna Convention are not so different from the usual methods of interpretation used by the Court. Therefore, when interpreting the Paris Convention, the Court should take into consideration its wording, its context and the purpose for which that Convention was adopted in the first place. However, the starting point should be the wording, context and purpose of that international agreement itself, and not how the EU has implemented it. Thus, even if the EU legislature bona fide understood the Paris Convention as not allowing for the pair consisting of a previous patent and a subsequent design and that was the reason why it decided to allow only previous designs and utility models as a source of priority rights for Community designs, that does not mean that that understanding of the Paris Convention is correct. (61)

103. With that in mind, I will now examine the two disputed issues.

2. A previous patent application as the source of priority rights for a subsequent design application

(a) Preliminary remarks

104. The protection of intellectual property is territorial, which means that it is valid only in the territory of the country (or region) which grants it. For those types of intellectual property rights which require registration in order to benefit from protection, such as patents, utility models and designs, that means that the protection will

be valid only in the territory covered by the jurisdiction of the respective registration body that approved it.

105. A person who wishes to protect their invention, design or trade mark under which the product is sold has to ask for such protection in each individual country or region. To alleviate problems arising from the territoriality of intellectual property protection, the Paris Convention introduced the system of priority rights. It does not remove the need to seek protection in each desired territory separately, but it ‘buys time’ to apply for such protection before potential competitors can do the same. That time, called a priority period, can be six or twelve months and starts to run from the time at which the first application is properly filed.

106. Apart from territoriality, another complication of intellectual property protection arises from differences in the types of intellectual property rights. Countries define differently what is understood as a certain type of intellectual property right, and they do not all provide for the same types of intellectual property rights. Thus, apparently 11 EU Member States recognise utility models as a separate form of intellectual property right. (62) Furthermore, similar types of intellectual property rights are often named differently. For example, the closest type of protection of what is in Europe usually referred to as a design is in the United States called a design patent. (63) Even the term Community design is not uniform at EU level. Thus, the English-language version of Regulation No 6/2002 refers to Community designs, whereas the French-language version refers to ‘dessins ou modèles communautaires’. (64)

(b) An application under the PCT

107. The PCT, under which KaiKai filed an application on the basis of which it asked EUIPO to recognise a priority right in the present case, represents an international effort to make life easier for inventors.

108. The PCT is an international agreement concluded in 1970 and which entered into force in 1978. It currently has 157 signatory States, including all 27 EU Member States, but not the European Union. It is a special agreement within the scope of the Paris Convention, and is administered by the World Intellectual Property Office. The PCT provides for the filing of an ‘international application’ for the protection of inventions. (65) Once such an international application is filed, it may be construed as an application for a patent, a utility model and other types of protection of inventions, such as inventors’ certificates and utility certificates. (66) After the international phase, which cannot lead to the granting of protection, the person who filed an international application has to initiate the national phase, in which that person will ask for the appropriate form of protection in each country or region separately. The purpose of an international application, inter alia, is to establish a filing date with a view to benefiting from priority rights.

109. EUIPO claims that the erroneous reasoning of the General Court starts with its use of the term ‘international patent application’, which is, legally, a non-existent term. Indeed, KaiKai filed an international application within the meaning of the PCT, and not an

international patent application. As I have just explained, such an international application can be construed as either a patent application or a utility model application, but until such a decision is made by filing a national application, an international application is in a quantum state of superposition, so to speak – it is, at the same time, a patent application and a utility model application.

110. In my view, by using the term ‘international patent application’, the General Court wanted to stress that KaiKai’s application may be understood as an application for a patent, even though it can also be an application for a utility model. Precisely for that reason, the General Court concluded that KaiKai would enjoy a priority period of twelve months. Reverting to quantum physics terminology, while the General Court ‘collapsed’ KaiKai’s international application into a patent, EUIPO ‘collapsed’ it into a utility model. That is the same as if EUIPO called it an ‘international utility model application’. Therefore, EUIPO’s claim that the General Court used a non-existent term is irrelevant.

(c) Reasons for interpreting the Paris Convention as allowing the pair consisting of a previous patent and a subsequent design

111. The Paris Convention does not expressly provide for the possibility to base a priority right for a subsequent design application on a previous patent application. Yet, it does not preclude such a possibility.

112. The wording of Article 4(A)(1) of the Paris Convention enumerates different first filing possibilities (‘application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark’) and then states that, for the purpose of subsequent filing in other countries, a person enjoys a priority right, but without specifying the kind of application. That can easily suggest that any of the enumerated first filing possibilities can be the source of priority rights for any subsequent filing.

113. The wording of Article 4(A)(1) of the Paris Convention is, therefore, not conclusive. In fact, the context in which the Paris Convention lies, which includes the diversity of forms of intellectual property rights around the world, militates in favour of an interpretation that does not attribute a decisive role to the form or name of an intellectual property right.

114. EUIPO argues that the General Court misinterpreted the general rule of the Paris Convention on the identity of subject matter. According to EUIPO, each type of industrial property right only gives rise to a right of priority for the same type of right, such as a patent for a patent, a design for a design or a utility model for a utility model. (67) Thus, unless expressly provided otherwise, only an earlier design can give rise to a right of priority for a later Community design; a patent does not satisfy this rule.

115. To my mind, the rule on the identity of subject matter can be understood in formal or substantive terms. In the present appeal, EUIPO seems to use it in the formal sense, as it insists on the identity of the form of the previous and the subsequent application. (68)

116. The Paris Convention Guide, however, seems to suggest a substantive understanding of the rule on the identity of subject matter. Thus, as regards Article 4(E)(1) of the Paris Convention, that Guide states that ‘it will rarely happen that an industrial design and a utility model concern the same subject because, in principle, the first concerns ornamental aspects of an industrial article whereas the latter relates to its technical novelty’. (69) That reference to the same subject seems to entail the substance of the novel idea for which protection is sought, and not the form in which it is protected.

117. It seems to me that the purpose of the Paris Convention to alleviate the territoriality principle by introducing priority rights also dictates such a substantive, rather than a formal, understanding of the rule on the identity of subject matter.

118. Arguably, it was precisely the realisation that there may be substantive overlapping between the object of protection under different forms of industrial property rights that prompted the amendments of the Paris Convention in 1925, which introduced Article 4(E)(1), expressly allowing for the pair consisting of a previous utility model and a subsequent design.

119. If such a substantial overlap may exist between a utility model and a design, it may also exist between a patent and a design. According to EU institutional documents, a utility model is a registered right which confers exclusive protection for a technical invention, as does a patent; it resembles a patent in that the invention must be new, though frequently the level of inventiveness required is not as great as it is in the case of patents. Unlike patents, utility models are granted without a prior search to establish novelty and an inventive step. This means that protection can be obtained more rapidly and cheaply, but that the protection conferred is less secure. (70) For that reason, utility models have been called, for example, ‘second-class patents’, (71) ‘petty inventions’ (72) or ‘short term’ national patents. (73)

120. One may ask why the possibility to rely on a previous patent application for a subsequent design application was not expressly inserted into the text of the Paris Convention at the time when Article 4(E)(1) was introduced in order to provide for the possibility to rely on a utility model. To my mind, that was not necessary precisely because the pair consisting of a previous patent and a subsequent design was already possible due to the rule on the identity of subject matter understood in substantive terms. The reason for express mention of the pair involving a utility model and a design can be explained by the relative novelty of utility models in the Paris Convention.

121. In that respect, it is necessary to state that the Paris Convention was concluded as long ago as 1883. At that time, the utility model as a form of protection of an invention was not dealt with. It was recognised by the Paris Convention only in 1911, on the basis of the Washington Conference revision. Following that, Article 4(E) was introduced in that Convention in 1925, with the Hague Conference revision. (74) It was, therefore, necessary to clarify how utility models fit into

the scheme of priority rights under the Paris Convention. In contrast, that was not necessary for patents because the Paris Convention recognised them as a form of industrial property right from the outset. Therefore, the pair consisting of a previous patent and a subsequent design did not merit special mention where there was a substantive overlap in the object of protection because it already followed from the rule on the identity of subject matter understood in substantive terms.

122. In sum, given the similarities between patents and utility models, it cannot be excluded that substantive overlapping might also occur between a previous patent application and a subsequent design application. If one accepts that the rule on the identity of subject matter is of a substantive nature, there is no reason why a patent could not be used as a source of priority rights for a subsequent design in the same way as this is accepted for a utility model. In my view, that is not excluded as a possibility by any of the provisions of the Paris Convention.

123. I am therefore of the view that the General Court did not err in law when it interpreted the Paris Convention as allowing the use of a previous patent application as the source of priority rights for a subsequent design application, provided that the subject matter of the two applications is substantively the same.

3. The priority period for a subsequent design application based on a previous patent application

124. EUIPO contends that there is no general rule inherent in the logic of the Paris Convention, (75) according to which the length of the priority period is determined by the nature of the earlier right. It therefore claims that the General Court erred in law when it found such a rule.

125. On that point, I agree with EUIPO.

126. Article 4(C)(1) of the Paris Convention attributes a priority period of twelve months to patents and utility models, and a priority period of six months to industrial designs and trademarks. That provision does not explain whether that period depends on the previous or on the subsequent right. If the elements of a pair are the same, that question is moot, as rightly claimed by EUIPO. It becomes relevant, however, if the pairs are heterogeneous, as in the combination of a previous utility model and a subsequent design or that of a previous patent and a subsequent design.

127. For the first of those two situations, the Paris Convention offers an express solution in Article 4(E)(1), which relies on the length of the period attributed to the later right, that is, the six-month period which Article 4(C)(1) attributes to industrial designs. The Paris Convention is silent in respect of the second combination consisting of a previous patent and a subsequent design.

128. Even though the text is silent on that point, the General Court inferred from the alleged general rule, according to which the nature of the earlier right is decisive in determining the length of the priority period, that the appropriate period for that second combination was twelve months. That followed from Article 4(C)(1)

of the Paris Convention, which attributes twelve months to patents.

129. The General Court construed Article 4(E)(1) of the Paris Convention as an exception to that general rule. EUIPO, on the contrary, claims that Article 4(E)(1) of the Paris Convention is an exception, but that the general rule to which that provision is an exception was wrongly identified by the General Court. (76)

130. To begin with, the text of the Paris Convention does not explain whether the priority period depends on the nature of the earlier right or the later right. In such a case, it is necessary to consider supplementary methods of interpretation, which include taking into account the travaux préparatoires.

131. In that regard, the judgment under appeal is revealing. The General Court indicated that the travaux préparatoires to the Paris Convention disclosed that the reason for extending the priority period for patents from six to twelve months was that, in some countries, particularly Germany, it was difficult to accomplish the preliminary examination of the patent application within the six-month period. (77)

132. I understand that description in the following way. In order to be able to assess the length of the priority period, two dates are relevant: the filing date of the first right from which that period starts to run and the filing date of the subsequent right by which that period ends. If, in Germany, the filing for a subsequent patent takes longer than six months, it is impossible to benefit from a previous filing in time where the period is six months from the first filing. That means, for example, that if a person filed for a patent in France, that person would not be able to file for the subsequent patent in Germany within the six-month period. That was the reason for prolonging that period to twelve months. In that way, the balance was struck between the interests of the applicant for an industrial property right, who should be allowed to organise the international extension of such a right within an adequate period, and the interests of third parties, who should not be confronted with too-extensive periods of priority during which rights they might wish to acquire for the same subjects cannot be validly obtained. (78) In short, the reason for prolonging the priority period for patents lay in the length of the filing procedures in certain countries for a patent as a subsequent right.

133. Therefore, I consider that the General Court was wrong to find that there is a general rule in the Paris Convention according to which the length of the priority period depends on the first filing. It makes more sense to me that that period is dependent on the subsequent filing.

134. I am thus of the view that the length of the priority periods as they are provided in Article 4(C)(1) of the Paris Convention depends on the nature of the subsequent, rather than the first, application.

135. Applying that logic to the present case, if the priority right for a subsequent design application is claimed on the basis of an earlier patent application, the length of the priority period would, by application of Article 4(C)(1) of the Paris Convention, be six months.

136. The judgment of the General Court in TELEYE, (79) which that Court relied on in the judgment under appeal, (80) does not prevent the foregoing conclusion. In the TELEYE judgment, the General Court held, in the context of trademark law, that it is the application for registration for an earlier right which causes the right of priority to come into existence. That conclusion seems entirely consistent with the Paris Convention, according to which the existence and the date of the previous application are relevant for the start of the priority period. However, contrary to the reason for which the General Court invoked that judgment, this says nothing about the length of the period at issue.

137. While I agree with EUIPO that in the present case the length of the priority period is six months, I cannot accept its argument based on the lack of reciprocity with third countries, and in particular the United States. EUIPO essentially claims that, in the United States, designs are protected by patent law ('design patents') and that, as a consequence of the judgment under appeal, applicants can automatically benefit from a twelve-month priority period, whereas applicants in the EU only have a six-month priority period. However, the EUIPO Guidelines already treat US design patents as applications for designs, which can be a source of priority rights for Community designs during the six-month period from the application for the design patent. I cannot find any disturbance in reciprocity to the detriment of persons who filed their previous application for a design in the EU that would follow if a previous patent application were to afford twelve months of protection for a subsequent Community design application. The US design patents would still be classified as design applications, and not patent applications.

138. Finally, I should address the arguments based on Article 4(E)(1) of the Paris Convention. The General Court relied on that provision to substantiate its finding that there is a general rule that the priority period is linked to the nature of the earlier right. It construed that provision as an exception to the alleged general rule, such that only in that particular situation is a priority period attached to the subsequent right. To my mind, however, that provision is not an exception, but rather the application of the general rule that the length of the priority period depends on the nature of the subsequent right.

139. For the foregoing reasons, the Court should find that the General Court erred in law, in so far as it concluded that, under the Paris Convention, an application for a design if based on a previous patent application benefits from a priority period of twelve months, rather than six months.

140. In conclusion, I propose that the Court interpret the Paris Convention as allowing for the application for a subsequent design (including a Community design) to be based on a previous patent application, provided that there is a substantial identity of subject matter. The length of the priority period in such a case is six months, as attributed to industrial designs by the Paris Convention.

V. Consequences

141. The single ground of appeal is, in my view, well founded in part. As a consequence, the judgment under appeal should be set aside.

142. Applying the first paragraph of Article 61 of the Statute, the Court of Justice should reject the second plea in law raised by KaiKai before the General Court.

143. However, I do not consider that the state of the proceedings permits the Court to rule on the first plea in law, which was not analysed by the General Court in the judgment under appeal and in relation to which factual claims relating to the substance of the dispute have not been the subject of debate before the Court of Justice. The case should therefore be referred back to the General Court so that it may rule on that plea, the costs being reserved.

VI. Conclusion

144. In the light of the foregoing, I propose that the Court of Justice:

- set aside the judgment of the General Court of 14 April 2021, *The KaiKai Company Jaeger Wichmann v EUIPO* (Gymnastic and sports apparatus and equipment) (T-579/19, EU:T:2021:186);
- dismiss the second plea in law raised by *The KaiKai Company Jaeger Wichmann GbR* before the General Court;
- refer the case back to the General Court for it to determine the remaining plea in law;
- reserve the decision on costs.

SOURCES

1 Original language: English.

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

3 Signed in Washington DC on 19 June 1970 and last modified on 3 October 2001 (United Nations Treaty Series, Vol. 1160, No 18336, p. 231).

4 Signed in Paris on 20 March 1883, last revised in Stockholm on 14 July 1967 and amended on 28 September 1979 (United Nations Treaty Series, Vol. 828, No 11851, p. 305).

5 See further points 28 to 43 of this Opinion.

6 See the third paragraph of Article 58a of the Statute of the Court of Justice of the European Union ('the Statute'); Article 170a(1) of the Rules of Procedure of the Court of Justice.

7 In addition to the present case, five other cases have been admitted so far, all of which concern the EU trademark. Three cases raise issues related to Brexit (see orders of 7 April 2022, *EUIPO v Indo European Foods* (C-801/21 P, EU:C:2022:295); of 16 November 2022, *EUIPO v Nowhere* (C-337/22 P, EU:C:2022:908); and of 18 April 2023, *Shopify v EUIPO* (C-751/22 P, EU:C:2023:328)). The other two cases raise issues relating to the independence of lawyers before the EU Courts (see orders of 30 January 2023, *bonnanwalt v EUIPO* (C-580/22 P, not published, EU:C:2023:126), and of 8 May 2023, *Studio Legale Ughi e Nunziante v EUIPO* (C-776/22 P, EU:C:2023:441)).

8 See Regulation (EU, Euratom) 2019/629 of the European Parliament and of the Council of 17 April

2019 amending Protocol No 3 on [the Statute] (OJ 2019 L 111, p. 1), Articles 1 to 3 and recitals 1, 4 and 5; Court of Justice of the European Union Press Release No 53/19, Luxembourg, 30 April 2019. For a general discussion of the appeal filtering mechanism, see, for example, De Lucia, L., 'The shifting state of rights protection vis-a-vis EU agencies: A look at Article 58a of the Statute of the Court of Justice of the European Union', *European Law Review*, Vol. 44, 2019, p. 809; Gaudissart, M.-A., 'L'admission préalable des pourvois : une nouvelle procédure pour la Cour de justice', *Cahiers de droit européen*, 2020, p. 177; Orzan, M.F., 'Some remarks on the first applications of the filtering of certain categories of appeals before the Court of Justice', *European Intellectual Property Review*, Vol. 42, 2020, p. 426.

9 See the first and second paragraphs of Article 58a of the Statute.

10 The request to amend Article 58a of the Statute would add six EU offices, bodies and agencies existing on 1 May 2019 (the European Union Agency for the Cooperation of Energy Regulators, the Single Resolution Board, the European Banking Authority, the European Securities and Markets Authority, the European Insurance and Occupational Pensions Authority, and the European Union Agency for Railways). It would also extend the scope of this mechanism to appeals brought against decisions of the General Court relating to the performance of a contract containing an arbitration clause within the meaning of Article 272 TFEU. See Request submitted by the Court of Justice pursuant to the second paragraph of Article 281 [TFEU], with a view to amending Protocol No 3 on [the Statute], available at: https://curia.europa.eu/jcms/jcms/P_64268/en/.

11 Third paragraph of Article 58a of the Statute; see also Article 170a(1) of the Rules of Procedure of the Court of Justice. This is decided upon by a specific chamber of the Court set up for that purpose: see Article 170b of those Rules.

12 See, in that regard, Article 170a of the Rules of Procedure of the Court of Justice; see also, for example, order of 10 December 2021, *EUIPO v The KaiKai Company Jaeger Wichmann* (C-382/21 P, EU:C:2021:1050, paragraphs 20 to 22, 27 and 28).

13 See, in that regard, Gaudissart, cited in footnote 8 to this Opinion, p. 188 (noting that there was a suggestion by certain Council delegations to define in the procedural rules the concepts of the unity, consistency and development of EU law, but this was not taken up and instead left to Court to elaborate on in its case-law).

14 See, for example, US Courts website, 'Supreme Court Procedures', available at: <https://www.uscourts.gov/about-federal-courts/educational-resources/about-educational-outreach/activity-resources/supreme-1>.

15 Rules of the Supreme Court of the United States, adopted on 5 December 2022 and effective on 1 January 2023, available at:

<https://www.supremecourt.gov/filingandrules/2023RuleoftheCourt.pdf>.

16 Rule 10 of the US Supreme Court mentions that the following indicate the character of the reasons that may prompt the US Supreme Court to accept the request for review: '(a) a United States court of appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter; has decided an important federal question in a way that conflicts with a decision by a state court of last resort; or has so far departed from the accepted and usual course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power; (b) a state court of last resort has decided an important federal question in a way that conflicts with the decision of another state court of last resort or of a United States court of appeals; (c) a state court or a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court'.

17 Compare, in relation to the US certiorari mechanism, Giannini, L.J., 'Access Filters and the Institutional Performance of the Supreme Courts', *International Journal of Procedural Law*, Vol. 12, 2022, p. 190, in particular p. 218.

18 For a similar conclusion about the Court of Justice in the context of the review procedure under Article 256 TFEU, see Brkan, M., 'La procédure de réexamen devant la Cour de justice: vers une efficacité accrue du nouveau règlement de procédure' in Mahieu, S. (ed.), *Contentieux de l'Union européenne: Questions choisies*, Larcier, 2014, p. 489. See also Rousselot, R., 'La procédure de réexamen en droit de l'Union européenne', *Cahiers de droit européen*, 2014, p. 535.

19 See order of 10 December 2021, *EUIPO v The KaiKai Company Jaeger Wichmann* (C-382/21 P, EU:C:2021:1050, paragraphs 31 to 34). See also paragraphs 13 to 19 of that order for EUIPO's arguments.

20 See, in that regard, Opinion of Advocate General Cruz Villalón in *Spedition Welter* (C-306/12, EU:C:2013:359, point 35).

21 That was recognised by the Court as early as 1974. See judgment of 30 April 1974, *Haegeman* (181/73, EU:C:1974:41, paragraphs 4 and 5).

22 Article 216(2) TFEU.

23 See, for example, judgment of 3 June 2008, *Intertanko and Others* (C-308/06, EU:C:2008:312, paragraph 42).

24 Signed on 15 April 1994 in Marrakesh and constituting Annex 1C to the Agreement establishing the World Trade Organization ('WTO'), and approved by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986–1994) (OJ 1994 L 336, p. 1).

25 That is different from the EU's obligation not to stand in the way of the obligations which the Member States acquired under the Paris Convention as parties thereto. The obligation 'not to stand in the way' follows from Article 2(2) of the TRIPS Agreement, which provides that nothing in that agreement shall derogate from existing obligations that contracting parties may have to each other under the Paris Convention. The Court found such an obligation of the EU not to stand in the way of Member States' obligations in relation to the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations, to which Member States, but not the EU, are parties. The Court considered that such an obligation for the EU arises on the basis of Article 1(1) of the WIPO Performances and Phonograms Treaty, to which the EU is a party. See judgment of 15 March 2012, *SCF Consorzio Fonografici* (C-135/10, EU:C:2012:140, paragraph 50).

26 See, by analogy, judgment of 15 November 2012, *Bericap Záródástechnikai* (C-180/11, EU:C:2012:717, paragraph 70). Such an understanding was also expressed in paragraph 15 of the Board of Appeal's decision in the present case: 'For the EU which is not a member of the Paris Convention as an intergovernmental organisation but it is a member of the WTO, Article 4 of the Paris Convention applies accordingly pursuant to Article 2(1) of the TRIPS Agreement'.

27 The Court established the principled lack of horizontal direct effect in the judgments of 26 February 1986, *Marshall* (152/84, EU:C:1986:84, paragraph 48), and of 14 July 1994, *Faccini Dori* (C-91/92, EU:C:1994:292, paragraph 20), and it has confirmed that position in numerous subsequent cases. See, for example, judgments of 24 January 2012, *Dominguez* (C-282/10, EU:C:2012:33, paragraph 37), and of 18 January 2022, *Thelen Technopark Berlin* (C-261/20, EU:C:2022:33, paragraph 32).

28 See, *inter alia*, judgment of 8 March 2011, *Lesoochranské zoskupenie* (C-240/09, EU:C:2011:125, paragraph 45).

29 Thus, for example, the Court has recognised the direct effect of the provisions of Association Agreements between the EU and non-member countries granting rights of establishment to individuals which they could rely on in court. See, in that regard, judgments of 27 September 2001, *Głoszczuk* (C-63/99, EU:C:2001:488, paragraphs 30 to 38), and of 20 November 2001, *Jany and Others* (C-268/99, EU:C:2001:616, paragraphs 26 and 28).

30 See, for example, judgments of 12 April 2005, *Simutenkov* (C-265/03, EU:C:2005:213, paragraphs 20 to 29) (concerning provisions of the Partnership Agreement with Russia), and of 24 November 2016, *SECIL* (C-464/14, EU:C:2016:896, paragraphs 99 to 109 and 131 to 137) (concerning provisions of Association Agreements with Tunisia and Lebanon).

31 See judgment of 21 December 2011, *Air Transport Association of America and Others* (C-366/10, EU:C:2011:864, paragraphs 79 to 84). In paragraphs 73

to 78 of that same judgment, the Court recognised that the Kyoto Protocol on Climate Change might, in principle, have direct effect, but denied the direct effect of pertinent provisions because they were not unconditional and sufficiently precise.

32 See judgment of 12 December 1995, *Chiquita Italia* (C-469/93, EU:C:1995:435, paragraphs 34 and 35).

33 See judgment of 15 July 2004, *Pêcheurs de l'étang de Berre* (C-213/03, EU:C:2004:464, paragraphs 39 to 47).

34 Already in the judgment of 12 December 1972, *International Fruit Company and Others* (21/72 to 24/72, EU:C:1972:115, paragraphs 18 and 27), the Court considered that, even though the General Agreement on Tariffs and Trade ('GATT') is binding on the EU institutions, its provisions are of such a nature that they are not capable of granting rights to individuals. In the judgment of 23 November 1999, *Portugal v Council* (C-149/96, EU:C:1999:574, paragraph 47), the Court considered that the establishment of the WTO did not change the nature of GATT or other agreements within the scope of the WTO.

35 See, for example, judgments of 14 December 2000, *Dior and Others* (C-300/98 and C-392/98, EU:C:2000:688, paragraph 44); of 25 October 2007, *Develey v OHIM* (C-238/06 P, EU:C:2007:635, paragraph 39); and of 15 March 2012, *SCF Consorzio Fonografici* (C-135/10, EU:C:2012:140, paragraph 46).

36 See, for example, in respect of GATT, judgments of 12 December 1972, *International Fruit Company and Others* (21/72 to 24/72, EU:C:1972:115, paragraph 21), and of 5 October 1994, *Germany v Council* (C-280/93, EU:C:1994:367, paragraphs 106 to 109). In respect of the WTO agreements generally, see judgment of 23 November 1999, *Portugal v Council* (C-149/96, EU:C:1999:574, paragraphs 36 to 42).

37 See my Opinion in *Changmao Biochemical Engineering v Commission* (C-123/21 P, EU:C:2022:890, points 37 to 43, 56 and 57). The judgment in this case is pending.

38 See, in that respect, my Opinion in *Changmao Biochemical Engineering v Commission* (C-123/21 P, EU:C:2022:890, points 46, 59 and 60).

39 See judgment of 7 May 1991, *Nakajima v Council* (C-69/89, EU:C:1991:186; 'Nakajima'). See also judgment of 22 June 1989, *Fediol v Commission* (70/87, EU:C:1989:254).

40 See judgment of 16 July 2015, *Commission v Rusal Armenal* (C-21/14 P, EU:C:2015:494; 'Rusal Armenal').

41 See my Opinion in *Changmao Biochemical Engineering v Commission* (C-123/21 P, EU:C:2022:890, point 64).

42 In that respect, the Commission makes a comparison with Article 25(1)(g) of Regulation 6/2002, which expressly refers to Article 6ter of the Paris Convention, thus showing an intention to implement that provision of the Convention.

43 See judgment of 5 July 2018, *Mast-Jägermeister v EUIPO* (C-217/17 P, EU:C:2018:534, paragraph 56).

44 See, in that regard, judgment of 20 January 2022, *Commission v Hubei Xinyegang Special Tube* (C-891/19 P, EU:C:2022:38, paragraphs 30 and 34), in which the Court considered that the similarity of the wording of EU legislation and an international agreement leads to the conclusion that the EU legislature intended to implement the latter.

45 See Commission Amended Proposal for a Council Regulation on Community Design, COM(2000) 660 final, 20 October 2000, Explanatory Memorandum, Title IV, Section 2: Priority ('New paragraph 1a of Article 43 ensures the compatibility of the Community design Regulation with Article 4.E of the Paris Convention').

46 See, for example, judgments of 5 October 2004, *Pfeiffer and Others* (C-397/01 to C-403/01, EU:C:2004:584, paragraph 119); of 24 January 2012, *Dominguez* (C-282/10, EU:C:2012:33, paragraph 27); and of 6 November 2018, *Max-Planck-Gesellschaft zur Förderung der Wissenschaften* (C-684/16, EU:C:2018:874, paragraph 59).

47 See, for example, judgments of 13 November 1990, *Marleasing* (C-106/89, EU:C:1990:395, paragraph 8), and of 10 March 2011, *Deutsche Lufthansa* (C-109/09, EU:C:2011:129, paragraph 52).

48 See judgment of 16 June 2005 (C-105/03, EU:C:2005:386, paragraph 47). See also, for example, judgments of 1 August 2022, *Sea Watch* (C-14/21 and C-15/21, EU:C:2022:604, paragraph 84), and of 27 April 2023, *M.D. (Ban on entering Hungary)* (C-528/21, EU:C:2023:341, paragraph 99).

49 In that respect, EUIPO invokes the judgments of 8 December 2005, *ECB v Germany* (C-220/03, EU:C:2005:748, paragraph 31), and of 28 February 2008, *Carboni e derivati* (C-263/06, EU:C:2008:128, paragraph 48).

50 That position is also expressed in point 6.2.1.1 of the EUIPO Guidelines for examination of registered Community designs, 31 March 2023 ('EUIPO Guidelines'), as with the version of 1 October 2018 at the relevant time: 'A priority claim based on a previous patent application will in principle be rejected. ...'.

51 In my view, the Paris Convention is indeed irrelevant for interpretative purposes if there is a reason to exclude its direct effect.

52 For a salient example, see judgment of 24 January 2012, *Dominguez* (C-282/10, EU:C:2012:33, paragraphs 25 to 31).

53 See, for example, judgments of 17 April 2018, *Egenberger* (C-414/16, EU:C:2018:257, paragraph 72), and of 5 September 2019, *Pohotovost'* (C-331/18, EU:C:2019:665, paragraph 56).

54 That is the only way in which I can explain the situation in the *Marleasing* case. See, in that respect, the solution proposed in the Opinion of Advocate General van Gerven in *Marleasing* (C-106/89, EU:C:1990:310, point 10).

55 At the time when the Court first referred to that obligation to justify the obligation of conforming interpretation, the relevant provision was Article 5 of the EEC Treaty (see judgment of 10 April 1984, *von Colson and Kamann* (14/83, EU:C:1984:153, paragraph 26); see

also judgment of 14 July 1994, *Faccini Dori* (C-91/92, EU:C:1994:292, paragraph 26)).

56 In a case where a Member State does not transpose a directive, national courts may conclude that the legislature was of the opinion that its existing legislation already satisfies the legal obligation flowing from the directive.

57 See, in that regard, Temple Lang, J., ‘Community Constitutional Law: Article 5 EEC Treaty’, *Common Market Law Review*, Vol. 27, 1990, p. 645; Temple Lang, J., ‘The duties of cooperation of national authorities and Courts under Article 10 EC: two more reflections’, *European Law Review*, Vol. 26, 2001, p. 84.

58 Signed in Vienna on 23 May 1969 (United Nations, Treaty Series, Vol. 1155, p. 331).

59 See, in that regard, United Nations General Assembly, Resolution adopted on 20 December 2018, A/RES/73/202, ‘Subsequent agreements and subsequent practice in relation to the interpretation of treaties’, Conclusion 2, point 1, according to which Articles 31 and 32 of the Vienna Convention also apply as customary international law.

60 See, for example, judgments of 25 February 2010, *Brita* (C-386/08, EU:C:2010:91, paragraphs 42 and 43), and of 14 July 2022, *ÖBB-Infrastruktur Aktiengesellschaft* (C-500/20, EU:C:2022:563, paragraph 56).

61 Other legal systems, for example, those of Germany, Switzerland and the United States, take a different approach. See, in that regard, Hartwig, H., ‘Claiming priority under the Community design scheme’, in Hartwig, H. (ed.), *Research Handbook on Design Law*, Edward Elgar, 2021, p. 250, in particular pp. 253 to 255.

62 These EU Member States are the Czech Republic, Denmark, Germany, Spain, Italy, Hungary, Austria, Poland, Portugal, Slovakia and Finland. See EUIPO Guidelines, cited in footnote 50 to this Opinion, point 6.2.1.1.

63 According to the US Patent and Trademark Office Manual of Patent Examining Procedure, Ninth Edition, February 2023, Section 1502.01 Distinction Between Design and Utility Patents: ‘In general terms, a “utility patent” protects the way an article is used and works (35 U.S.C. 101), while a “design patent” protects the way an article looks (35 U.S.C. 171). ... Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance. While utility and design patents afford legally separate protection, the utility and ornamentality of an article may not be easily separable. Articles of manufacture may possess both functional and ornamental characteristics. ...’ See also, in that regard, Schickl, S., ‘Protection of Industrial Design in the United States and in the EU: Different Concepts or Different Labels?’, *The Journal of World Intellectual Property*, Vol. 16, 2013, p. 15.

64 Additionally, for example, the Croatian-language version uses only the term ‘design’ (‘dizajn Zajednice’), and the Slovenian-language version uses only the term

‘model’ (‘model Skupnosti’). The German-language version also only uses a single word (‘das Gemeinschaftsgeschmacksmuster’), while the Spanish- and Italian-language versions refer to designs and models (‘dibujos y modelos comunitarios’ and ‘disegni e modelli comunitari’, respectively).

65 See Article 2(vii) and Article 3(1) of the PCT.

66 See Article 2(i) of the PCT. Article 2(ii) of the PCT additionally states that references to a ‘patent’ can mean any of the forms of protection of an invention listed under Article 2(i) thereof.

67 In support of its claim that there is a general rule on the identity of subject matter, EUIPO invokes Article 4(C)(4) of the Paris Convention. In that respect, it is necessary to state that, even though that provision uses the words ‘the same subject’, it does not contain a general rule, but rather resolves a specific situation in which there are two previous applications, the first of which was withdrawn, abandoned or refused, for the purposes of establishing the beginning of the priority period. See Bodenhausen, G.H.C., *Guide to the Application of the Paris Convention for the Protection of Industrial Property as revised at Stockholm in 1967*, United International Bureaux for the Protection of Intellectual Property, 1968, available at: https://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf (‘Paris Convention Guide’), Article 4, Section C(4), comment (b).

68 In that respect, I wish to observe that the EUIPO Guidelines seem to recognise the rule on the identity of subject matter in both a formal and a substantive sense. In a formal sense, they require that the previous application has to concern a design or utility model. In a substantive sense, they require that the Community design must relate to the same design or utility model. In relation to the latter requirement, those Guidelines further explain that the two applications can differ only in details that can be qualified as ‘immaterial’, thus referring to the object of protection, and not the form of protection. See EUIPO Guidelines, cited in footnote 50 to this Opinion, point 6.2.1.1, in particular pp. 61 and 63.

69 Paris Convention Guide, cited in footnote 67 to this Opinion, Article 4, Section E, comment (b) (emphasis added).

70 Commission Green Paper, *The Protection of Utility Models in the Single Market*, COM(95) 370 final, 19 July 1995, p. i-b.

71 Paris Convention Guide, cited in footnote 67 to this Opinion, Article 1, paragraph (2), comment (d).

72 Commission Green Paper on the Legal Protection of Industrial Design, June 1991, 111/F/5131/91-EN, point 2.6.3.

73 Opinion of the Economic and Social Committee on the ‘Proposal for a European Parliament and Council Directive approximating the legal arrangements for the protection of inventions by utility model’ (OJ 1998 C 235, p. 26), point 2.7.

74 See Paris Convention Guide, cited in footnote 67 to this Opinion, Article 4, Section E, comment (a).

75 As the General Court found in paragraph 77 of the judgment under appeal.

76 According to EUIPO, that provision is an exception to the general rule on the identity of subject matter understood in a formal way.

77 See paragraph 79 of the judgment under appeal.

78 See Paris Convention Guide, cited in footnote 67 to this Opinion, Article 4, Section C(1), (2) and (3), comment (b).

79 See judgment of 15 November 2001, *Signal Communications v OHIM (TELEYE)* (T-128/99, EU:T:2001:266; ‘TELEYE’).

80 See paragraph 78 of the judgment under appeal.