



Reports of Cases

OPINION OF ADVOCATE GENERAL

ĆAPETA

delivered on 13 July 2023¹

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

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).

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.'

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

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.

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

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, *bonnawalt 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).

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.

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/2023RulesoftheCourt.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.

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 proceed¹⁹ 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.

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.

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.

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

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.

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'.

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 Conventions³² 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

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, *Lesoochránárske 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, *Gloszczuk* (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).

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,

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.

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

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').

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.

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).

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*.

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. ...’.

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?

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).

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.

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.

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

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).

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

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).

(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

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.

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.

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).

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.

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).

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,

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.

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.

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.

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.