



## Reports of Cases

### JUDGMENT OF THE COURT (Grand Chamber)

27 February 2024\*

(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 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. Ćapeta,

\* Language of the case: German.

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, *Develey 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.**

[Signatures]