



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

14 April 2021 *

(Community design – Multiple application for registration of Community designs representing gymnastic and sports apparatus and equipment – Right of priority – Article 41 of Regulation (EC) No 6/2002 – Application under Patent Cooperation Treaty – Article 4 of the Paris Convention for the Protection of Industrial Property – Priority period)

In Case T-579/19,

The KaiKai Company Jaeger Wichmann GbR, established in Munich (Germany), represented by J. Hellmann-Cordner, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Walicka, acting as Agent,

defendant,

ACTION brought against the decision of the Third Board of Appeal of EUIPO of 13 June 2019 (Case R 573/2019-3), relating to an application for registration of gymnastic and sports apparatus and equipment as Community designs claiming the right of priority of an international patent application filed under the Patent Cooperation Treaty,

THE GENERAL COURT (Third Chamber),

composed of A.M. Collins, President, G. De Baere and G. Steinfatt (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 20 August 2019,

having regard to the response lodged at the Court Registry on 15 November 2019,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

* Language of the case: German.

gives the following

Judgment

Legal context

International law

- 1 The Paris Convention for the Protection of Industrial Property was signed in Paris (France) 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 EU Member States are party to that convention.
- 2 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.’
- 3 Article 4(C)(1) of the Paris Convention is worded as follows:

‘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 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.’
- 5 The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), as set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organisation (WTO), was signed in Marrakesh (Morocco) 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 TRIPS Agreement’). The members of the WTO, including all EU Member States and the European Union itself, are party to the TRIPS Agreement.
- 6 Article 2 of the TRIPS Agreement, entitled ‘Intellectual Property Conventions’, provides:

‘1. 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 [for the Protection of Industrial Property, as revised in Stockholm on 14 July 1967].

2. Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention ...’

7 The Patent Cooperation Treaty was concluded in Washington 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.

8 Article 1(2) of the PCT provides:

‘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.’

9 Article 2 (i) and (ii) of the PCT 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 ...’

10 Article 3(1) of the PCT is worded as follows:

‘Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.’

EU law

11 Article 41(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), is worded as follows:

‘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.’

Background to the dispute

12 On 24 October 2018, the applicant, The KaiKai Company Jaeger Wichmann GbR, filed a multiple application for the registration of 12 Community designs with the European Union Intellectual Property Office (EUIPO), pursuant to Regulation No 6/2002. The goods to which the designs are intended to be applied are in Class 21-02 of the Locarno Agreement establishing an International Classification for Industrial Designs of 8 October 1968, as amended, and correspond to the

following description: ‘gymnastic and sports apparatus and equipment’. For each of the designs, the applicant claimed priority based on international patent application No PCT/EP2017/077469, filed with the European Patent Office (EPO) on 26 October 2017.

- 13 By letter of 31 October 2018, the EUIPO examiner informed the applicant that the multiple application had been accepted in its entirety, but that the priority claimed was refused for all of the designs because the date of the earlier filing was more than six months prior to the date of the multiple application.
- 14 The applicant maintained its priority claim and asked for an appealable decision to be made, following which, by decision of 16 January 2019, the examiner refused the right of priority in respect of all the designs.
- 15 In support of his decision, the examiner stated, on the basis of paragraph 6.2.1.1 of the Trade Mark and Design Guidelines of 1 October 2018 (‘the EUIPO Guidelines’), that, even though an application under the PCT could, in principle, form the basis for a right of priority under Article 41 of Regulation No 6/2002, given that the broad definition of the concept of ‘patent’ in Article 2 of the PCT also included utility models, that application was also subject to a priority period of six months, which had not been complied with in the present case.
- 16 On 14 March 2019, the applicant lodged an appeal with EUIPO against the examiner’s decision, pursuant to Articles 55 to 60 of Regulation No 6/2002.
- 17 By decision of 13 June 2019 (‘the contested decision’), the Third Board of Appeal of EUIPO dismissed the appeal brought by the applicant against the examiner’s decision. 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.
- 18 In that regard, the Board of Appeal found that, in accordance with Article 4(A)(1) and Article 4(C)(1) of the Paris Convention, any person who duly files an application at national level for an industrial design or utility model enjoys a right of priority for a period of 12 months for patents and utility models and 6 months for industrial designs and trade marks. In addition, the Board found that Article 4(E)(1) of the convention makes it clear that, in the case of a later application for an industrial design, the priority of a utility model application can only be claimed within the six-month priority period applicable to industrial designs. By contrast, under Article 4(E)(2) of the convention, the priority of a patent application can be claimed in the case of a utility model application during the 12-month priority period applicable to utility models and patents, and vice versa. The Board of Appeal found that there was therefore nothing in the Paris Convention to provide that a patent application would give rise to a right of priority for an industrial design application.
- 19 The Board of Appeal also found that, pursuant to Article 2(1) of the TRIPS Agreement, Article 4 of the Paris Convention applied *mutatis mutandis* to the European Union, which is a member of the WTO. However, the Board found that the Paris Convention did not take precedence over the provisions of Regulation No 6/2002, as the regulation did not constitute a special agreement within the meaning of Article 19 of the convention. Therefore, the ability to rely on a right of priority must be assessed solely in the light of that regulation.

- 20 The Board of Appeal found, in addition, that the wording of Article 41 of Regulation No 6/2002 was unambiguous, that it stated the priority period to be six months from the filing date of the earlier application and that the right of priority arose only from the due filing of a design right or utility model application and not from a patent application. On the basis of paragraph 6.2.1.1 of the EUIPO Guidelines, the Board of Appeal acknowledged that the concept of a utility model had to be interpreted broadly so as to include international patent applications made under the PCT, since, according to the definition in Article 2(ii) of the PCT, those applications encompassed utility models. Nonetheless, according to the Board of Appeal, that broad interpretation has no effect on the prescribed six-month priority period, meaning that the priority of a patent application filed under the PCT also needs to be claimed within that period.
- 21 Furthermore, the Board of Appeal found that there was no contradiction between the two orders of the Bundespatentgericht (Federal Patent Court, Germany) of 10 November 1967 relied on by the applicant and Article 41 of Regulation No 6/2002, since those orders related to rights of priority claimed for the later filing of utility model applications and not design right applications.
- 22 Accordingly, the Board of Appeal found that the applicant could only claim priority of the international patent application filed under the PCT on 26 October 2017 within six months of that date, that is, until 26 April 2018.

Forms of order sought

- 23 The applicant claims that the Court should:
- annul the contested decision;
 - annul the examiner’s decision of 16 January 2019 in so far as priority was not given to Community design Nos 5807179-0001-0012; uphold the claimed priority of 26 October 2017 and provide for a corrected publication of the Community designs, indicating the priority;
 - order EUIPO to reimburse it for the appeal fee;
 - order EUIPO to pay the costs;
 - alternatively, conduct a hearing.
- 24 EUIPO contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.

Law

Admissibility

- 25 The applicant's second head of claim consists of two parts. By the first part, the applicant seeks the annulment of the examiner's decision of 16 January 2019 in so far as priority was not given to the Community designs in question.
- 26 In that regard, it must be recalled that, under Article 61(1) and (3) of Regulation No 6/2002, it is the contested decision, and not the examiner's decision, which may be the subject of an action brought before the Court, which has jurisdiction to annul or alter the contested decision.
- 27 Furthermore, under Article 61(6) of the same regulation, EUIPO is required to take the necessary measures to comply with the judgment of the Court. Therefore, since the examiner's decision of 16 January 2019 was the subject of the appeal giving rise to the contested decision, in the event that the contested decision is annulled, it will fall to the Board of Appeal to re-examine the examiner's decision in the light of the present judgment.
- 28 The first part of the second head of claim must therefore be dismissed as inadmissible.
- 29 As regards the second part of the second head of claim, by which the applicant claims that the Court should uphold the claimed priority and provide for a corrected publication of the Community designs in question, indicating that priority, it must be recalled that, where an action is brought before the Courts of the European Union against the decision of a Board of Appeal of EUIPO, it follows from Article 61(6) of Regulation No 6/2002 that the Court is not entitled to issue directions to EUIPO, which must draw the appropriate conclusions from the operative part and grounds of the Court's judgment (see, to that effect, judgment of 27 February 2018, *Gramberg v EUIPO – Mahdavi Sabet (Protective case for a mobile telephone)*, T-166/15, EU:T:2018:100, paragraph 96; see also, to that effect and by analogy, judgment of 25 November 2015, *Jaguar Land Rover v OHIM (Shape of a car)*, T-629/14, not published, EU:T:2015:878, paragraph 10).
- 30 Accordingly, the second part of the applicant's second head of claim is inadmissible, as is, therefore, the whole of that head of claim.
- 31 As regards the applicant's fifth head of claim, put forward in the alternative, it must be observed that the request for a hearing submitted in the application was premature in view of the provisions of the Rules of Procedure of the General Court. According to settled case-law, an application for a hearing, and the assessment by the Court of the benefits of a hearing, can only take place once the written part of the procedure is closed and the parties and the Court are in possession of the complete case file and the arguments raised by all the parties, and are thus in a position to decide whether a hearing would be useful (see, to that effect, judgment of 26 October 2017, *Erdinger Weißbräu Werner Brombach v EUIPO (Shape of a large glass)*, T-857/16, not published, EU:T:2017:754, paragraph 13; see also, by analogy, judgment of 3 March 2015, *Schmidt Spiele v OHIM (Representation of boards for parlour games)*, T-492/13 and T-493/13, EU:T:2015:128, paragraph 10).
- 32 By the letter of 18 November 2019 notifying the applicant that the response had been lodged and the written part of the procedure closed, the Court Registry drew the applicant's attention to the provisions of Article 106 of the Rules of Procedure and pointed out that the period within which a

hearing could be requested ran only once and commenced upon that notification. However, the applicant did not make a new request for a hearing within the three-week period prescribed in that article.

- 33 In those circumstances, the Court decided, pursuant to Article 106(3) of the Rules of Procedure, to rule on the action without an oral part of the procedure.

Substance

- 34 In support of its action, the applicant relies on two pleas in law, the first alleging infringement of essential procedural requirements and the second alleging infringement of Regulation No 6/2002, in conjunction with a rule of law relating to its application, pursuant to Article 61(2) of that regulation.
- 35 The Court considers it appropriate to begin by examining the second plea in law put forward by the applicant. This plea must be understood as alleging a misinterpretation and misapplication of Article 41(1) of Regulation No 6/2002. Even though Title II of the application is entitled ‘Inapplicability of Article 41 of [Regulation No 6/2002]’, the applicant states in paragraphs 12 and 21 of the application that it is in fact relying on ‘in particular ... an infringement of Regulation [No 6/2002], in conjunction with a rule of law relating to its application, pursuant to Article 61(2) [of Regulation No 6/2002]’, and that it ‘considers it particularly important in the present case to take account, when interpreting the provisions of [that regulation], of all the relevant provisions of the Paris Convention’.
- 36 In essence, the applicant submits that the Board of Appeal was wrong to find that the priority claim for the 12 Community designs covered by the multiple registration application of 24 October 2018, which was based on the international patent application of 26 October 2017, was out of time. In that regard, the applicant invokes the 12-month priority period laid down in the Paris Convention in relation to patents and asserts that the 6-month period laid down in Regulation No 6/2002 in relation to utility models is not applicable in the present case.
- 37 The second plea consists of two parts. In the first place, the applicant alleges that the Board of Appeal erred in finding that all applications filed pursuant to the PCT fell within the concept of ‘utility model’ within the meaning of Article 41(1) of Regulation No 6/2002.
- 38 In the second place, the applicant argues that, given that there is no clear rule in Regulation No 6/2002 about the priority resulting from an international patent application, the Board of Appeal should have taken into account the relevant provisions of the Paris Convention, which form the basis of that regulation. Since Article 4(C)(1) of the convention lays down a 12-month priority period for patents, and since it is based on the principle that, where priority is based on a different kind of right, the earlier filing determines the priority period regardless of the kind of right involved in the later filing, the Board of Appeal should not have imposed a 6-month period.
- 39 It must be observed from the outset that, in the contested decision, the Board of Appeal acknowledged that the right of priority resulted from an international patent application filed under the PCT. Its reasons for that were based on paragraph 6.2.1.1 of the EUIPO Guidelines, which states that, for the examination of registered Community designs, ‘the priority of an international application filed under the [PCT] can be claimed, since Article 2 of the PCT defines the term “patent” in a broad sense that covers utility models’.

40 Accordingly, the Board of Appeal recognised that international patent application No PCT/EP2017/077469, filed by the applicant on 26 October 2017, gave rise to a right of priority in the context of the later application for registered Community designs. That finding is not called into question in the present case.

The first part of the second plea in law, alleging a misinterpretation of the concept of ‘utility model’ appearing in Article 41(1) of Regulation No 6/2002

41 By the first part of the second plea in law, the applicant claims that the Board of Appeal incorrectly adopted a broad interpretation of the concept of ‘utility model’ appearing in Article 41(1) of Regulation No 6/2002, on the basis of an incorrect reading of Article 2 of the PCT.

42 The applicant disputes EUIPO’s interpretation according to which an application filed under the PCT is only a utility model application or, at the very least, equivalent to a utility model application. Article 2(ii) of the PCT, relied on by EUIPO, does not define the concept of an application filed under the PCT as such. An international patent application is both a patent application and a utility model application.

43 EUIPO disputes the applicant’s arguments.

44 It must be observed from the outset that the applicant’s arguments are ambivalent. The applicant challenges the Board of Appeal’s broad interpretation of the concept of ‘utility model’, although, as can be seen from paragraph 39 above, that interpretation allowed the Board of Appeal to find that an international patent application could give rise to a right of priority within the meaning of Article 41(1) of Regulation No 6/2002. As the Board of Appeal stated in paragraph 16 of the contested decision, the wording of that provision does not expressly provide that a right of priority results from the filing of an international patent application. It is therefore only through the broad interpretation of that concept adopted by EUIPO that the right of priority claimed by the applicant in the context of its later application for design rights was examined. Therefore, as EUIPO points out in its response, the applicant’s arguments are of no help to it and must be disregarded.

45 In any event, it must be observed that, according to the definition in Article 2(ii) of the PCT, ‘references to a “patent” shall be construed as references to patents for inventions, inventors’ certificates, utility certificates, utility models ...’. It follows that patent applications filed under the PCT cover utility models, as the Board of Appeal pointed out in paragraph 16 of the contested decision.

46 Of course, as the applicant rightly asserts, that finding does not mean that the concepts of ‘patent’ and ‘utility model’ are the same, nor that the concept of ‘utility model’ includes that of ‘patent’.

47 In that regard, it must be observed that, under Article 3(1) of the PCT, applications for the protection of inventions in any of the contracting States may be filed as international applications under that treaty. Furthermore, in accordance with Article 2(i) of the PCT, ‘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’. Thus it is clear that the PCT does not distinguish between the different rights through which the various States in question protect inventions.

- 48 Accordingly, to avoid the unjustified exclusion of some utility model applications, EUIPO's broad interpretation allows all international patent applications filed under the PCT to be accepted as the basis for a right of priority, thus avoiding any impediment to the legal protection afforded to industrial property rights by the PCT. However, even though international patent applications may give rise to a right of priority for design rights under Article 41 of Regulation No 6/2002, that does not mean that patent applications are converted into utility model applications or that they are automatically subject to the rules for utility model applications.
- 49 In view of the foregoing considerations, it must be held that, although the wording of Article 41(1) of Regulation No 6/2002 does not expressly refer to a right of priority claimed on the basis of a patent, the Board of Appeal was entitled to take international patent applications into consideration in the context of that article. That broad interpretation of the provision is in keeping with the overall scheme of the PCT, which seeks to ensure that, in the case of an international application, equivalent protection is afforded to utility models and patents.
- 50 It follows that the Board of Appeal did not err in regarding the claim for a right of priority based on the international patent application filed by the applicant under the PCT as being governed by Article 41(1) of Regulation No 6/2002 when considering whether a right of priority can be based on an international patent application of that sort.

The second part of the second plea in law, alleging that Article 4(C)(1) of the Paris Convention was not taken into account when determining the priority period

- 51 By the second part of the second plea in law, the applicant considers that the period of 6 months prescribed in Article 41(1) of Regulation No 6/2002 is not applicable in the present case and the Board of Appeal should have applied the rules of the Paris Convention, Article 4(C)(1) of which prescribes a period of 12 months for a right of priority based on a patent application.

– The relevance of the Paris Convention for the interpretation of Article 41 of Regulation No 6/2002

- 52 The applicant opposes the Board of Appeal's interpretation of Regulation No 6/2002, according to which the circumstances in which a right of priority can be claimed are set out exhaustively in the regulation and reflect the provisions of the Paris Convention, meaning that there is no need to refer to the convention itself.
- 53 The applicant takes the view that, as there is no clear provision in Regulation No 6/2002 as to the circumstances in which a right of priority based on the filing of an international patent application can be claimed, the provisions of the Paris Convention must be taken into account during the registration process before EUIPO.
- 54 EUIPO disputes the applicant's arguments. It is of the view that Regulation No 6/2002 accurately implements the relevant rules of the Paris Convention on designs. The unambiguous wording of Article 41(1) of Regulation No 6/2002 clearly expresses the wish of the EU legislature to provide an exhaustive set of rules on the period in which priority can be claimed in the case of applications for registered Community designs. Therefore, it is neither necessary nor appropriate to apply the Paris Convention directly or by analogy.

- 55 In that regard, it must be recalled that, according to settled case-law, the interpretation of a provision of EU law requires account to be taken not only of its wording, but also of its context, and the objectives and purpose pursued by the act of which it forms part. The legislative history of a provision of EU law may also reveal elements that are relevant to its interpretation (see judgment of 11 November 2020, *EUIPO v John Mills*, C-809/18 P, EU:C:2020:902, paragraph 55 and the case-law cited).
- 56 It must be observed that the wording of Article 41(1) of Regulation No 6/2002 does not provide for the situation in which an application for a design right is filed and a right of priority claimed on the basis of a patent application, so does not govern the period for claiming priority in that situation.
- 57 Therefore, contrary to what EUIPO appears to assert, Article 41(1) of Regulation No 6/2002 does not exhaustively govern the question of the period in which priority can be claimed in the event of a later application for a design right.
- 58 As for the legislative history of Article 41(1) of Regulation No 6/2002, it must be noted that passages of the *travaux préparatoires* indicate that the provisions of the regulation concerning the right of priority are intended to ensure consistency with the Paris Convention in terms of the right of priority and the priority period (see proposal for a European Parliament and Council Regulation on the Community Design of 3 December 1993, COM(93) 342 final-COD 463, statement of reasons, part II, title IV, section 2).
- 59 The connection between the right of priority laid down in Article 41(1) of Regulation No 6/2002 and the Paris Convention is also reflected in the actual wording of that provision, which grants a right of priority to ‘a person who has duly filed an application ... in or for any State party to the [Paris Convention], or to the Agreement establishing the World Trade Organisation ...’. It may be concluded from that reference that the aim of Article 41 of Regulation No 6/2002 is to take account of the obligation created by the Paris Convention for members of the WTO to observe the priorities resulting from the due filing of an application for protection in any State party to either of those conventions.
- 60 Since the European Union, as a member of the WTO, is party to the TRIPS Agreement, it is under an obligation to interpret its intellectual property legislation, as far as possible, in the light of the wording and purpose of that agreement. Article 2(1) of the TRIPS Agreement provides that, in respect of Parts II, III and IV of that agreement, the States which are parties thereto must comply with Articles 1 to 12 and 19 of the Paris Convention (see, in relation to trade mark law, judgments of 16 November 2004, *Anheuser-Busch*, C-245/02, EU:C:2004:717, paragraph 42 and the case-law cited, and of 11 November 2020, *EUIPO v John Mills*, C-809/18 P, EU:C:2020:902, paragraph 64). That finding, though it derives from the case-law on trade marks, may be transposed to the law on designs since, as is clear from the statement of reasons in the proposal for a European Parliament and Council Regulation on the Community Design of 3 December 1993, COM(93) 342 final-COD 463, the rules in Regulation No 6/2002 on the right of priority were drafted by analogy with the almost identical provisions of the proposed regulation on the Community trade mark.
- 61 Furthermore, it is important to bear in mind the case-law of the Court of Justice, according to which, even where the European Union is not a contracting party to an international convention concluded by its Member States, but it is required, under an international treaty to which it is party, not to stand in the way of the obligations of the Member States under that convention, the concepts contained in the act of secondary EU legislation must be interpreted in such a way that they are compatible with the aforesaid convention and with the aforesaid treaty, also taking

account of the context in which those concepts are found and the purpose of the relevant provisions of the agreements as regards intellectual property, since that case-law applies not only to trade mark law but also to other areas of intellectual property law (see, to that effect and by analogy, judgments of 15 March 2012, *SCF*, C-135/10, EU:C:2012:140, paragraphs 50 and 56, and of 15 November 2012, *Bericap Záródástechnikai*, C-180/11, EU:C:2012:717, paragraphs 69 and 70).

- 62 As regards the right of priority, it must be observed that the origin of that right is in Article 4 of the Paris Convention (see, in relation to the right of priority under Article 29 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), judgment of 15 November 2001, *Signal Communications v OHIM (TELEYE)*, T-128/99, EU:T:2001:266, paragraph 37).
- 63 It follows that the provisions of the Paris Convention must be taken into account for the interpretation of Article 41(1) of Regulation No 6/2002.
- 64 The applicant is therefore correct in asserting that, since Regulation No 6/2002 makes no provision for the priority period resulting from an earlier international patent application, it is necessary to look to the underlying legislation, namely, the Paris Convention. The provisions of that convention relating to the determination of the period in which priority based on a patent filing can be claimed in the context of a later design application must be taken into account as a reference for interpreting and complementing that regulation.
- 65 Lastly, it must be observed that while the Board of Appeal did acknowledge, for the same reasons as those put forward by the applicant, that the Paris Convention applied *mutatis mutandis* to the European Union, it found, in that context, that the convention did not take precedence over the provisions of Regulation No 6/2002, as the regulation did not constitute a special agreement within the meaning of Article 19 of the convention, and that the enforceability of a right of priority had to be assessed solely in the light of that regulation.
- 66 However, the question of the priority period in circumstances such as those in the present case does not depend on whether the Paris Convention takes precedence over Regulation No 6/2002. As can be seen from paragraphs 56 and 57 above, the reason for resorting to the convention is to fill a lacuna in the regulation, which is silent on the matter of the priority period resulting from an international patent application.

– *The priority period resulting from an international patent application and conforming with Article 4 of the Paris Convention*

- 67 The applicant invokes the provisions of Article 4 of the Paris Convention, in particular Article 4(C)(1). Since, in the present case, the priority claim concerns an application filed under the PCT, and therefore, an application for a patent within the meaning of Article 4(A)(1) of the Paris Convention, it follows, according to the applicant, that the priority period applicable to its multiple application for the registration of designs is 12 months, in accordance with Article 4(C)(1) of the Paris Convention.

- 68 EUIPO contends, in essence, that the applicant has failed to show that the Paris Convention contains rules pertaining to the period at issue. First, it argues that the applicant does not invoke any provision of the Paris Convention specifically governing a priority claim based on an earlier patent application in the context of a design application and, secondly, the convention does not contain any general rule applicable to all possible situations involving a later application.
- 69 According to EUIPO, the Paris Convention governs only two situations in which the priority of a right of protection may be claimed in the context of a later application for a right of protection of a different kind. Those two situations are governed by Article 4(E) of the convention and, in both cases, the period depends on the nature of the later application.
- 70 In that regard, it is common ground that, in the context of a design application, the applicant is claiming a right of priority based on an earlier international patent application.
- 71 Under Article 4(C)(1) of the Paris Convention, the applicable priority periods depend on the kind of right concerned. Assuming that the subject matter of the later application is the same as the subject matter of the application on which the priority claim is based, the priority period under that provision is 12 months for patents and utility models, and 6 months for designs.
- 72 As EUIPO rightly states, the Paris Convention does not contain any express rule for the priority period applicable to the situation where the later application is for a design but the priority claim is based on an earlier international patent application.
- 73 EUIPO is also correct in pointing out that Article 4(E)(1) of the Paris Convention contains a rule that the priority period prescribed for the later right prevails where the later right is a design right and the earlier right is a utility model.
- 74 By contrast, it must be observed that Article 4(E)(2) of the Paris Convention, which provides that the filing of a patent application may form the basis of and create a right of priority in the event of the later filing of a utility model, and vice versa, does not contain any indication of the priority period, contrary to what EUIPO appears to suggest.
- 75 The question therefore arises as to whether Article 4(E)(1) of the Paris Convention, being the only express rule to deal with the situation where there are two successive applications relating to rights to which different priority periods apply, reflects a general rule that the priority period resulting from the later right prevails, or whether, on the contrary, it is an exception to a general rule that stipulates that the length of the priority period is determined by the nature of the earlier right.
- 76 The applicant, in reliance on two orders of the Bundespatentgericht (Federal Patent Court) of 10 November 1967 and on German scholarly writings, submits that the earlier right should be taken as the basis for the priority period in the event that priorities are claimed for rights of protection of different kinds. In those orders, the Bundespatentgericht (Federal Patent Court) cites, in particular, the Memorandum on the Additional Brussels Act (Denkschrift zur Brüsseler Zusatzakte), an explanatory document written in 1903 about the revision of the Paris Convention for the Protection of Industrial Property of 1883 that took place at the Brussels Conference of 1900, from which it appears that the international priority system was such as to allow someone wishing to obtain international protection for industrial rights to proceed in stages, with the application in other States being dependent on the success of the first application, which was normally a national one. According to that document, it was for that reason that the period for a

right of priority based on a patent had to be extended from 6 to 12 months since, in the particular case of Germany, the first stage of the examination for potential protection of a patent took 7 months in itself.

- 77 It is apparent from the inherent logic of the priority system that, as a general rule, it is the nature of the earlier right that determines the length of the priority period. In that regard, it must be noted that the reason why, under Article 4(C)(1) of the Paris Convention, the priority period for patents and utility models is longer than that for industrial designs and trade marks is due to the more complex nature of patents and utility models. Given that, under Article 4(C)(2) of the Paris Convention, the priority period starts to run from the date of filing of the first application and that the registration procedure for patents and utility models is longer than that for industrial designs and trade marks, there is a risk that the right of priority resulting from the filing of an application for a patent or utility model would expire if the same, relatively short, six-month period were applied to all rights giving rise to a right of priority. The advantage that the right of priority is intended to procure is to enable an applicant to assess his chances of obtaining protection for the invention concerned on the basis of the earlier patent application filed in one State before potentially making a later application for protection in another State by going through the necessary steps and preparations and undertaking the necessary costs and formalities. In that regard, in relation to trade marks, the Court has already held that the authors of the Paris Convention wished to enable holders of a right in one of the States party to that convention, who are faced with the impossibility of simultaneously filing applications for a given trade mark in all those States, to apply for it successively in each State, thereby giving an international dimension to the protection obtained in any one of the States without a multiplicity of formalities needing to be accomplished (judgment of 15 November 2001, *TELEYE*, T-128/99, EU:T:2001:266, paragraph 38).
- 78 In addition, it appears consistent that the length of the priority period should be determined by the nature of the earlier right, since, as the Court held in the context of trade mark law (judgment of 15 November 2001, *TELEYE*, T-128/99, EU:T:2001:266, paragraph 42), it is the application for registration of the earlier right which causes the right of priority to come into existence. Moreover, it is on the date when that application is filed that the priority period starts to run. If the very existence of the right of priority and the start of the period for which that right runs both depend on the earlier right and the application for its registration, it is logical that the duration of the right of priority should also depend on the earlier right. By contrast, there is nothing to lead to the presumption that the duration of the right of priority should depend, as a general rule, on the later right.
- 79 That is confirmed by the *travaux préparatoires* of the first revision of the Paris Convention for the Protection of Industrial Property of 1883, which took place in 1900. It is clear from the papers and the minutes of the conference held in Brussels from 1 to 14 December 1897 and from 11 to 14 December 1900, in particular from an overview of paragraph 1 of the statement presented by the German delegation at the preparatory meeting of 1 December 1897, from the minutes of the fourth session of 7 December 1897 and the minutes of the second session of 12 December 1900 (see *Actes de la Conférence réunie à Bruxelles du 1^{er} au 14 December 1897 et du 11 au 14 December 1900*, Union internationale pour la protection de la propriété industrielle, Berne, 1901; ‘the proceedings of the Brussels Conference’, respectively p. 169, pp. 209 to 212 and pp. 379 to 382), that the reason that the priority period was extended from 6 to 12 months for a right of priority based on a patent was that the preliminary examination to which patent applications were subject took longer under German, Austrian and Hungarian law. As a consequence, the States in question felt that they were prevented from complying with the

convention by the priority period being, in their view, too short, given that the length of time taken for the preliminary examination almost always exceeded the priority period (see p. 37 of the proceedings of the Brussels Conference). An extension of the priority period for patents had been proposed by the International Bureau of the International Union for the Protection of Industrial Property ‘to take account of the special needs of countries with practical preliminary examinations’ (see p. 144 of the proceedings of the Brussels Conference) and consequently accepted and implemented by Article 1(II) of the Additional Act of 14 December 1900 amending the Convention of 20 March 1883 (see p. 410 of the proceedings of the Brussels Conference).

- 80 All of these matters go to confirm that, in accordance with the concept behind the priority period system, it is indeed the earlier right which determines the length of the priority period.
- 81 In addition, the fact that Article 4(E)(1) of the Paris Convention is to be regarded as a special rule constituting an exception to the principle that the length of the priority period is determined by the nature of the earlier right can be seen in the very wording of that provision. The word ‘where’, which, in the context of that provision, means ‘in the event that’, indicates that the rule is only to be applied in the situation specifically mentioned. Similarly, the wording ‘shall be the same as’ which, in the original French version of the Paris Convention is expressed by a negative construction (‘ne sera que’), indicates the exceptional nature of determining the length of the priority period by reference to the later right, namely industrial designs, by way of derogation to the general rule.
- 82 The exceptional nature of Article 4(E)(1) of the Paris Convention is also evident from a historical analysis, which reveals that Article 4(E) of the convention was intended to be applied exclusively to utility models. Article 4(E) of the Paris Convention was adopted in 1925. The insertion of the rule relating to utility models was needed after the scope of the Paris Convention for the Protection of Industrial Property of 1883 was extended in 1911 to include utility models by listing them among the industrial property rights for which protection was guaranteed under Article 2 of that convention (now Article 1(2) of the Paris Convention). The addition of section E to Article 4 in 1925 prevented a long-published utility model, to which a 12-month period applied under Article 4(C)(1) of the Paris Convention, from being the subject of a new filing as an industrial design.
- 83 The applicant is therefore entitled to submit that the difference in the way in which patents and utility models are treated in the particular situation in Article 4(E)(1) of the Paris Convention can be explained, inter alia, by the difference in the length of their respective application procedures, since utility models are registered and published following a brief formal examination, while patent applications are generally not published until expiry of the 12-month priority period. That section was therefore not supposed to produce effects beyond cases involving utility models, contrary to what EUIPO appears to suggest when it proposes applying the six-month period laid down in Article 41 of Regulation No 6/2002 in relation to utility model applications, which is an accurate reflection of Article 4(E) of the Paris Convention, to the filing of an international patent application.
- 84 As regards the situation, as in the present case, where an earlier patent application is followed by a later design application, the applicant is right to submit that the objective underlying Article 4(E)(1) of the Paris Convention does not concern patent applications. The risk of a long-published patent being the subject of a new filing for an industrial design is almost non-existent, as is confirmed by the present case, where the applicant had filed patent application

No PCT/EP2017/077469 with the EPO on 26 October 2017, whereas Article 93(1) of the European Patent Convention of 5 October 1973 only provides for publication 18 months from the date of filing.

- 85 It is clear that the arguments put forward by EUIPO in support of the opposite view cannot call into question the conclusion that the general rule underlying the Paris Convention is that the nature of the earlier right is decisive in determining the length of the priority period. In particular, EUIPO does not put forward any argument to establish that the special rule created for utility models should also apply to patents.
- 86 Accordingly, it must be concluded that the Board of Appeal erred in finding that the period applicable to the applicant's claim for priority of international patent application No PCT/EP2017/077469 in relation to all of the 12 designs for which it sought registration was 6 months.
- 87 Accordingly, the second plea must be upheld.
- 88 It follows from all the foregoing considerations, without there being any need to examine the applicant's first plea in law, that the action must be upheld in so far as it seeks annulment of the contested decision and that it must be dismissed as to the remainder.

Costs

- 89 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Costs necessarily incurred by the parties for the purposes of the proceedings before the Board of Appeal are regarded as recoverable costs under Article 190(2) of the Rules of Procedure. In the present case, since EUIPO has essentially been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

- 1. 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 as to the remainder;**
- 3. Orders EUIPO to pay the costs.**

Collins

De Baere

Steinfatt

Delivered in open court in Luxembourg on 14 April 2021.

[Signatures]