

## **Res judicata – The scope of re-examination of the appeal following annulment by the EU courts**

Consistency Circle Procedure & Registry

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## 1 Introduction

- 1 This report is a compilation of case-law from the Court of Justice (CJ) and the General Court (GC), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic. It aims to analyse the question of determining the scope of *res judicata* (binding effect) of EU court judgments, in particular, the **scope of re-examination of the appeal** following an annulment of a previous decision of the Boards of Appeal (BoA).
- 2 The purpose is to further support the work of the BoA with a view to maintaining and enhancing the **consistency** of its decision-making practice with the case-law of the EU Courts and among the BoA. As such, it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness, and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the Boards of Appeal (BoA) at the given date of the report. **It does not have any binding effect on the BoA.** It has been made available to the staff of the BoA and the public in general for information purposes only.
- 4 The effect of *res judicata* on the parties, excluding them from subsequent proceedings (admissibility bar) <sup>(1)</sup>, is beyond the scope of this case-law analysis.

## 2 Legal Framework

- 5 **Article 72(2) EUTMR** limits the GC's competence to the **review of legality** of BoA decisions. It provides that an action may be brought before the GC against a decision of the BoA '*on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the TFEU, infringement of this Regulation or of any rule of law relating to their application or misuse of power*'.
- 6 **Article 72(3) EUTMR** provides that '*the General Court shall have jurisdiction to annul or to alter the contested decision*'.
- 7 **Article 72(6) EUTMR** provides that '*the Office shall take the necessary measures to comply with the judgment of the General Court or, in the event of an appeal against that judgment, the Court of Justice*'.

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<sup>(1)</sup> *Res judicata* prevents the parties from pursuing in subsequent proceedings an issue already decided by a prior final judgment. In the context of administrative proceedings before the Office, Article 63(3) EUTMR explicitly stipulates an absolute (non-remediable) admissibility obstacle to subsequent applications for cancellation involving the same parties and relating to the same subject matter and cause of action.

### 3 Case-law Analysis

#### 3.1 The principle of *res judicata*

8 *Res judicata* (literally, 'judged thing' from Latin) is a doctrine of law, the principle of the final and binding effect of judgments.

9 *Res judicata* affects the Boards in their implementation of EU court judgments pursuant to Article 72(6) EUTMR. In particular, *res judicata* defines the scope of re-examination of an appeal **after an annulment**.

10 Pursuant to Article 72(3) EUTMR, in the event of a successful action, the GC can either annul or alter the contested BoA decision, depending on the form of order sought by the applicant. In the case of an **alteration**, if that has been requested and the conditions are met, the **Court's judgment takes the place** of the contested decision. There is no room for a new decision by the BoA. An **annulment** also removes the contested decision from the legal system<sup>(2)</sup>, but it is the **BoA that must replace** the previous decision with a new decision, in order to decide on the appeal brought before it.



11 That impact of *res judicata* on the Boards implementing an annulling judgment constitutes the subject of this case-law analysis. The *res judicata* effect of the annulling judgment determines the **scope of the matters** that can no longer be examined or, on the contrary, that are still left to be examined by the BoA for the purposes of taking its new decision on the appeal. Indeed, the BoA, in the new decision adopted after an annulment, would normally recapitulate the findings of the annulling judgment and determine what has been decided by the court with a final effect and what is still to be decided, having regard to the particular circumstances of the case and the chosen strategy to resolve the appeal. However, the interpretation of the annulling judgment and the correct delimitation of the scope of the matters that the Board must still decide may pose challenges.

#### 3.2 Relevance of the grounds supporting the operative part of the annulling judgment

12 The case-law highlights the importance of taking into account the court's essential reasons supporting the operative part of the judgment, i.e. the grounds for the annulment: '*In order to comply with a judgment annulling a measure and to implement it fully, EUIPO is required to adopt a new decision, having regard **not only to the operative part of the judgment but also to the grounds which led to that ruling and constitute its essential basis**, in so far as they are necessary for the purposes of determining the exact meaning of what is stated in the operative part. It is those grounds which, on the one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons which underlie the finding of illegality contained in the operative part and which EUIPO must take into account when replacing the annulled measure*'<sup>(3)</sup>.

<sup>(2)</sup> 08/02/2018, T-879/16, VIETA, EU:T:2018:77, § 37.

<sup>(3)</sup> 17/11/2021, T-616/20, THE ONLY ONE by alphaspirit wild and perfect (fig.) / ONE, EU:T:2021:794, § 37; 01/09/2021, T-96/20, Limbic® Types, EU:T:2021:527, § 44; 11/06/2020, T-563/19, PERFECT BAR (fig.),

- 13 In **VIETA**, in the context of a revocation on the ground of non-use, the GC held in the first annulling judgment<sup>(4)</sup> that the Board erred in finding genuine use for the entire category of ‘apparatus for the reproduction of sound and images’ when that category was not sufficiently precise and narrow, contained a wide array of audio-visual and electronic equipment and was capable of being divided into subcategories. In its new decision, the Board found again genuine use proven for the entire category, considering it ‘a *specific term, and a synonym of “television sets”, sufficiently clear and precise*’. In its second annulling judgment<sup>(5)</sup>, the GC stated that the BoA had clearly disregarded the *ratio decidendi* of the first judgment, inseparable from its operative part and, thereby infringed *res judicata*.
- 14 In **SILUETA EN FORMA DE ELIPSE DISCONTINUA**, in the context of the comparison of the signs  and , the GC found in the first annulling judgment<sup>(6)</sup> that the BoA erred in finding the signs to be dissimilar when they were visually similar to a certain degree. In particular, the GC pointed out two differences between the signs that were noticeable only upon a close inspection<sup>(7)</sup>. In its new decision, the BoA considered that the degree of similarity between the signs was ‘not high’, a consideration which was, as recognised by the GC in the second judgment, not formally contrary to the first judgment since it did not qualify the degree of similarity. However, in reaching that conclusion, the Board erroneously took into consideration two differences already held to be irrelevant in paragraph 59 of the first annulling judgment. As such, the Board disregarded certain grounds of the previous annulling judgment which were inseparable from its operative part, and thereby infringed *res judicata*<sup>(8)</sup>.
- 15 However, to the extent that the BoA has to take into account the GC’s **reasoning** when adopting a new decision, the force of *res judicata* extends **only** to the grounds of a judgment which constitute the **necessary** support of its operative part and are, therefore, inseparable from it. In particular, the grounds on the basis of which the court **dismissed certain arguments relied upon by the parties in their pleadings** do not have the effect of *res judicata*.
- 16 In **SHAPE OF A 4-FINGER CHOCOLATE BAR (3D)**<sup>(9)</sup>, the CJ dismissed as inadmissible an appeal brought by the party who actually succeeded before the GC in its claim for annulment of the BoA’s decision<sup>(10)</sup>. The appeal sought to amend only

EU:T:2020:271, § 26; 19/12/2019, T-690/18, Vita, EU:T:2019:894, § 45; 10/10/2019, T-536/18, FITNESS, EU:T:2019:737, § 35; 08/02/2018, T-879/16, Vieta (fig.), EU:T:2018:77, § 31, 35, 38.

<sup>(4)</sup> 10/12/2015, T-690/14, Vieta, EU:T:2015:950, § 63, 68-69.

<sup>(5)</sup> 08/02/2018, T-879/16, Vieta (fig.), EU:T:2018:77, § 30-41.

<sup>(6)</sup> 08/11/2017, T-754/16, CC (fig.) / O (fig.), EU:T:2017:786, § 58-60, 66.

<sup>(7)</sup> Namely, the greater difference between the maximum and minimum heights and the rectangular shape of the interior of the elliptical shape in the contested mark, that can only be noted by a close inspection of the signs, not normally done by the consumer.

<sup>(8)</sup> 10/09/2019, T-744/18, Silueta en forma de elipse discontinua (fig.) / Silueta en forma de elipse (fig.), EU:T:2019:568, § 37-42, 45.

<sup>(9)</sup> 25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 46-50, § 51-54.

<sup>(10)</sup> Namely, on the ground that, contrary to the Board’s view, acquired distinctiveness of the contested mark was not proven.

certain grounds by which the GC dismissed some of the arguments of that party<sup>(11)</sup>, but not the operative part that was favourable to it. The party challenged those unfavourable findings before the CJ to prevent them from acquiring the force of *res judicata* and to secure its right of redress. However, the CJ rejected that argument pointing out that *'the force of res judicata extends only to the grounds of a judgment which constitute the necessary support of its operative part and are, therefore, inseparable from it. Consequently, when a decision of EUIPO is annulled by the General Court, the grounds on the basis of which that court dismissed certain arguments relied upon by the parties cannot be considered to have gained the force of res judicata. Therefore, in the present case, [...] the Board of Appeal is not bound by the fact that the General Court dismissed certain arguments, and [that party] will be able to submit, where appropriate, the same arguments in the context of any action against the decision that may be adopted following the General Court's annulment of the decision at issue'*.

### 3.3 Questions not yet decided by the BoA or the Court

- 17 There is no *res judicata* in a relevant matter not yet examined by the BoA or the Court. This means, on the one hand, that there may still be outstanding matters that need to be examined in the new decision subsequent to the annulment in order to resolve the appeal. On the other hand, it also means that the annulling judgment does not necessarily prejudice as to the final outcome. For example, if the GC annuls a BoA decision for an error made in the assessment of a legal criterion, parameter or assessment step of a legal ground (to which extent there is *res judicata*), that does not necessarily prejudice the assessment of the respective legal ground in the new BoA decision.
- 18 In **THE ONLY ONE BY ALPHASPIRIT WILD AND PERFECT**, in the context of Article 8(1)(b) EUTMR, the GC held in the first annulling judgment<sup>(12)</sup> that the very low degree of similarity between the signs at issue did not support the conclusion that there was a likelihood of confusion. The evidence submitted to prove the enhanced distinctiveness of the earlier mark 'ONE' could not compensate for that low degree of similarity, as it showed the reputation of a different sign, 'PURINA ONE'. Nevertheless, the GC underlined the possibility of proving reputation of a mark used in a different form, as long as the relevant public continued to perceive the goods at issue as originating from the same undertaking. These findings also applied to the assessment of reputation pursuant to Article 8(5) EUTMR. However, the GC expressly noted that the BoA *'did not raise the question of whether or not that reputation could be established on the basis of a mark presented in a different form'*.
- 19 In its new decision, the BoA merely referred to the GC's finding that the reputation of the earlier mark was not proven, without assessing whether the reputation established

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(11) Namely, criticising the GC for finding that (i) while, indeed, the contested mark was not used for the categories of 'bakery products, pastries, cakes and waffles', it was used for 'sweets and biscuits'; (ii) the contested mark was used in accordance with the function of a trade mark and in a form that did not alter its distinctive character as registered and (iii) acquired distinctiveness was proven for 10 out of the 15 Member States of the European Union at the material point in time.

(12) 19/12/2019, T-40/19, THE ONLY ONE by alphaspirt wild and perfect (fig.) / ONE, EU:T:2019:890, § 94-95, 103-104, 107-110, 116.

for the sign 'PURINA ONE' could be attributed to the earlier mark 'ONE'. In its second annulling judgment<sup>(13)</sup>, the GC held that the BoA wrongly considered itself to be bound by *res judicata* regarding the issue of the enhanced distinctiveness and reputation of the earlier mark, as the GC explicitly left that question open on the ground that it was not yet examined by the BoA. The GC added that it followed from Article 72(2) EUTMR which limits the GC's competence to a review of the legality of BoA decisions that '*it does not have the power to substitute its own reasoning for that of a Board of Appeal or to carry out an assessment on which that Board of Appeal has not yet adopted a position*'. For that reason, no *res judicata* could attach to a relevant matter not yet examined by the Board.

- 20 In **STAR FOODS**<sup>(14)</sup>, the GC stated that though it annulled the Board's decision on the ground that it had wrongly concluded that there was no similarity between the conflicting signs and, on that account, wrongly excluded the likelihood of confusion, that did not mean that the GC decided that there was a likelihood of confusion. The BoA, therefore, did not err in conducting a global assessment of the likelihood of confusion in its new decision, given that this had neither been examined by the BoA or the GC before (i.e. there was no *res judicata* on the final outcome of the opposition). However, the new BoA decision also had to be annulled, as it concluded that the marks at issue were similar to a low degree, whereas the first annulling judgment considered them to be similar to an average degree (to which extent there was *res judicata*), with an impact on the final outcome.
- 21 In **CMS ITALY**<sup>(15)</sup>, the GC recapitulated that the previous annulling judgment annulled the previous BoA decision on the ground that it had omitted to take into account certain previous decisions of the Opposition Division relied on by the opponent as evidence of reputation of the earlier mark 'Puma'. However, the previous annulling judgment did not rule on the question whether the **other** evidence also submitted by the opponent proved the reputation of the earlier mark. Therefore, the BoA erred in considering that the previous annulling judgment implicitly upheld the finding of the previous BoA decision that the other evidence also submitted by the opponent did not prove the reputation of the earlier mark. Consequently, the BoA erred in stating that there was no need for re-examining that other evidence. As a result, the new BoA decision again had to be annulled.
- 22 Where the BoA did not examine a particular issue for economy of procedure (e.g. not examining a particular absolute or relative ground for refusal as the initially examined ground led to the refusal of the contested application in its entirety, or not examining all the conditions of applicability of a relative ground for refusal as, on initial assessment, one of the cumulative conditions was not fulfilled), it may have to do so in consequence of an annulment.
- 23 In **LOUDSPEAKER**<sup>(16)</sup>, the GC dismissed the applicant's argument that the Board was not entitled, in its second decision, to consider the mark applied for under Article 7(1)(e)(iii) EUTMR, on the ground that the first annulling judgment had already decided on the application of that provision. The GC stated that '*neither the examiner,*

<sup>(13)</sup> 17/11/2021, T-616/20, THE ONLY ONE by alphaspirt wild and perfect (fig.) / ONE, EU:T:2021:794, § 46-49.

<sup>(14)</sup> 10/10/2012, T-333/11, Star foods, EU:T:2012:536, § 19.

<sup>(15)</sup> 05/10/2022, T-711/20, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2022:604, § 13, 118-123, 130-135, 142.

<sup>(16)</sup> 06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 28.

*in his decision of 1 March 2005, nor the Board of Appeal, in its decision of 22 September 2005, decided on the application of Article 7(1)(e)(iii) of Regulation No 40/94 to the mark applied for. Likewise, in [the first annulling judgment], and in particular at paragraphs 40 to 45 thereof, the Court ruled solely on the distinctive character of the sign at issue within the meaning of Article 7(1)(b) of Regulation No 40/94. The Court did not adjudicate on the application of Article 7(1)(e)(iii) of Regulation No 40/94 to that sign'. Therefore, the Board was entitled to apply that provision for the first time in its second decision.*

- 24 In **TAFEL**<sup>(17)</sup>, the GC held that after annulment of the previous BoA decision for its erroneous finding that the sign 'Tafel' was descriptive based on its meaning 'table', the BoA was right to carry out a fresh examination of the other possible meanings of the sign in the new decision.
- 25 Similarly, in **GELENKGOLD**<sup>(18)</sup>, the GC stated that the BoA, in its first decision, did not have to rule on whether the evidence provided was sufficient to establish the enhanced distinctiveness of the earlier mark under examination, since it concluded that there was a likelihood of confusion irrespective of the possible enhanced distinctiveness of that mark. Consequently, there was no *res judicata* concerning this question, since the GC was not allowed to make such an examination for the first time. The BoA, therefore, complied with the first annulling judgment when it assessed the evidence relating to the enhanced distinctiveness of the earlier mark in its new decision.

### 3.4 The court's decision on the substance

- 26 *Res judicata* only applies where the GC decided **on the substance**. There is no *res judicata* when the GC solely identifies a lack of reasoning in the contested decision. As stated in **VITA**<sup>(19)</sup>, '*the obligation to state reasons constitutes an essential procedural requirement which must be distinguished from the question of the merits of those reasons, which concern the substantive legality of the contested measure*'.
- 27 In **PERFECT BAR**<sup>(20)</sup>, the GC noted that where the previous annulling judgment held that the contested decision had 'failed to establish' that the mark applied for was descriptive and devoid of distinctive character for the goods at issue, the Board of Appeal, when adopting its new decision, was right to carry out a **new examination**, since the General Court **did not adjudicate** on whether the mark applied for was descriptive or not. The GC in its first annulling judgment '*did not consider that the mark applied for was not descriptive in respect of the goods at issue, but found that the assessment of the descriptiveness and lack of distinctiveness of the mark applied for in respect of the goods at issue was deficient and that the earlier decision was vitiated by an error of law concerning the conditions for applying Article 7(1)(b) and (c) EUTMR*'.

<sup>(17)</sup> 08/06/2017, T-326/16, Tafel, EU:T:2017:380, § 25-26.

<sup>(18)</sup> 04/05/2017, T-25/16, GelenkGold (fig.) / FORM EINES TIGERS (fig.) et al., EU:T:2017:303, § 36, 39-41, 51-52.

<sup>(19)</sup> 19/12/2019, T-690/18, Vita, EU:T:2019:894, § 48, 51.

<sup>(20)</sup> 11/06/2020, T-563/19, PERFECT BAR (fig.), EU:T:2020:271, § 28-29.



- 28 In **RADIATORI PER RISCALDAMENTO** <sup>(21)</sup>, the GC held that the BoA was right to carry out an examination of the individual character of the contested design, and particularly, the question of the saturation of the state of the art. In the previous annulling judgment <sup>(22)</sup>, the GC only held that the BoA failed to state the reasons for its decision by omitting to examine the saturation of the state of the art, but the GC did not itself decide that question.
- 29 It follows from the above that the following two situations must be distinguished.
- (i) Where the GC rules that a finding made by the BoA was **wrong and takes a position on the substance** (i.e. replaces the BoA's finding with its own), *res judicata* applies.
- (ii) Where the GC rules that the BoA's finding is vitiated by a failure to state reasons (e.g. 'failed to establish', 'provided inadequate reasons', 'omitted to address'), **without, however, deciding on the substance**, there is no *res judicata* regarding the matter. A new assessment must be carried out by the BoA.
- 30 In that new assessment, the BoA must carefully consider the findings of the annulling judgment. This requires an in-depth interpretation of the court's reasoning.
- 31 **LIMBIC® TYPES** concerned a case where the BoA initially found that the sign 'Limbic® Types' was descriptive of the goods and services in Classes 16, 35 and 41 at issue and confirmed the examiner's decision rejecting the application under Article 7(1)(c) EUTMR. In essence, the BoA found that the relevant public understood the mark as referring to different types of personality which respond differently to stimuli from the 'limbic system', i.e. the region of the brain that influences hormonal control and the autonomic nervous system. In the **first annulling judgment** <sup>(23)</sup>, the GC disagreed and held that the BoA incorrectly assessed the descriptive character of the mark applied for. In particular, it held the following: '[...] *it should be noted that the Board of Appeal merely found that the relevant public understood the mark as referring to different types of personality which respond to stimuli from the limbic system in different ways. [...] Apart from the fact that the mark applied for contains a term which is used in an unusual combination and is devoid of its clear and direct meaning, it has not been proven that the average specialist, particularly in the fields of advertising, business management and human resources management and business administration, upon encountering a specialist medical term, would not at least have to engage in some process of interpretation involving a period of consideration, in order to understand the meaning of the proposed trade mark in respect of the services at issue. Such a process of interpretation is incompatible with the recognition of descriptive character, the meaning of which must be immediately perceived without further thought*' (§ 44-48).
- 32 However, **the GC also added**: 'As regards the case-law [...] according to which a word sign must be refused registration under Article 7(1)(c) [EUTMR] if at least one of its possible meanings designates a characteristic of the goods or services concerned [...], it is sufficient to note, in the light of the foregoing, that **the mark applied for does not convey a meaning that is sufficiently clear and direct for it to be regarded by the**

<sup>(21)</sup> 16/02/2017, T-98/15, Radiatori per riscaldamento, EU:T:2017:91, § 28-30.

<sup>(22)</sup> 12/03/2014, T-315/12, Radiatori per riscaldamento, EU:T:2014:115, § 100-101.

<sup>(23)</sup> 16/02/2017, T-516/15, Limbic® Types, EU:T:2017:83, § 44-52.

**relevant public as being descriptive of the goods and services at issue.** It must be concluded that **the Board of Appeal's assessment**, according to which the sign *Limbic® Types* will be understood by the relevant public as referring to different types of personality which respond to stimuli from the limbic system in different ways, **is incorrect**. Similarly, the Board of Appeal made an **error of assessment** in finding that that sign had a sufficiently specific and direct link with the goods and services concerned in Classes 16, 35 and 41 (§ 50-52).'

- 33 Subsequent to the first annulling judgment, the case was assigned to the Grand Board of Appeal. The Grand Board, referring to § 45-48 of the first annulling judgment, considered itself to be bound by that judgment only to the extent that the evidence produced until that date was insufficient to establish descriptiveness. Relying on facts and new evidence which the previous BoA decision had not taken into account (and on which it preliminarily heard the applicant), the Grand Board rejected again the application for being descriptive pursuant to Article 7(1)(c) EUTMR <sup>(24)</sup>.
- 34 Yet, the **GC annulled that decision too** <sup>(25)</sup>, finding a breach of *res judicata*. It considered that the question of the descriptive character of the mark applied for has actually been settled by the first annulling judgment. In particular, it pointed out, referring also to § 50-52 of the first annulling judgment, that '*while the judgment annulling the decision contains grounds according to which some of the assessments made by the First Board of Appeal were not sufficiently substantiated or did not permit the inference that the mark applied for was descriptive, it also contains grounds condemning the **substantively incorrect assessments** made by that Board on the basis of established facts. Thus, by the judgment annulling the decision, the Court concluded that the decision of the First Board of Appeal was vitiated **by an error of assessment**, in so far as concerns the conditions for the application of Article 7(1)(c) [EUTMR], as regards the descriptive character of the mark applied for. [...] the fact that the Grand Board of Appeal based its examination of the descriptive character of the mark applied for on facts which the First Board of Appeal had not taken into account in its [previous decision] does not mean that the Court's findings as to the descriptive character of that mark, made in paragraphs 50 to 52 of the judgment annulling the decision, no longer have the force of *res judicata**' (§ 55-56).
- 35 It follows that great care must be taken with the grounds for annulment. Even though the annulment may be primarily based on **insufficient proof, substantiation and a lack of reasoning**, some of the grounds may contain findings made on the **substance** by the court itself. If those substantive findings of the court are inseparable from the operative part, they should be considered as *ratio decidendi* and, thus, having *res judicata* effect. If the second decision contradicts those findings, it may be annulled again due to a violation of *res judicata*.

### 3.5 Hearing the parties after annulment by the Court

- 36 In general, the BoA **is not obliged** to invite the parties to submit additional observations after an annulment. According to the case-law, Article 94(1), second sentence,

<sup>(24)</sup> 28/12/2019, R 1276/2017-G, *Limbic® Types*.

<sup>(25)</sup> 01/09/2021, T-96/20, *Limbic® Types*, EU:T:2021:527, § 52-56.

EUTMR<sup>(26)</sup> does not require, *per se*, that, following the resumption of the proceedings subsequent to an annulment of a BoA decision, the parties again be invited to submit observations on points of law and fact on which they already had ample opportunity to express their views in the course of the previous procedure<sup>(27)</sup>.

37 However, on the one hand, where the Court annulled the BoA decision on the ground of a breach of a party's right to be heard, then the BoA **is obliged** to hear this party concerning the particular issue before adopting its new decision.

38 On the other hand, in justified complex situations, it may be **useful** for the BoA to invite the parties to submit their views **on the consequence to be drawn from the annulling judgment, including the question of the scope of *res judicata***<sup>(28)</sup>. That consultation, in any event, does not bind the BoA, who must determine the precise scope of the issues already decided by the Court and those that still remain to be decided by the BoA in its new decision, irrespective of any possible interpretation agreed upon among the parties.

#### 4 Conclusions

39 In order to enhance consistency in BoA decision-making practice, the following conclusions can be drawn from the above case-law analysis.

- (i) To comply with an annulling judgment, the Board is required to consider not only the operative part of the judgment but also the grounds, namely, the Court's reasoning, which led to that ruling and constitute its essential basis. However, the force of *res judicata* extends only to the grounds of a judgment which constitute the necessary support of its operative part.
- (ii) There is no *res judicata* in a relevant matter not yet examined by the BoA. The GC has no competence to make such an examination for the first time.
- (iii) *Res judicata* only applies where the GC decided on the substance. *Res judicata* does not apply where the GC finds a failure to state reasons only.

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<sup>(26)</sup> Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

<sup>(27)</sup> 28/05/2021, T-509/19, Flügel / ... Verleiht Flügel et al., EU:T:2021:225, § 50; 14/07/2021, T-749/20, VERONESE (fig.) / Veronese, EU:T:2021:430, § 34.

<sup>(28)</sup> For example, 22/12/2021, R 1954/2020-5, GRASS IN BOTTLE (other) / Bottle with strand of grass (3D) et al., § 19, 32.

**Annex**  
**List of cases reviewed**

**Court of Justice**

25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596

**General Court**

05/10/2022, T-711/20, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2022:604

22/05/2019, T-161/16, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2019:350

17/11/2021, T-616/20, THE ONLY ONE by alphaspirit wild and perfect (fig.) / ONE, EU:T:2021:794

19/12/2019, T-40/19, THE ONLY ONE by alphaspirit wild and perfect (fig.) / ONE, EU:T:2019:890

01/09/2021, T-96/20, Limbic® Types, EU:T:2021:527

16/02/2017, T-516/15, Limbic® Types, EU:T:2017:83

14/07/2021, T-749/20, VERONESE (fig.) / Veronese, EU:T:2021:430

23/09/2020, T-608/19, VERONESE (fig.) / Veronese, EU:T:2020:423

28/05/2021, T-509/19, Flügel / ... Verleiht Flügel et al., EU:T:2021:225

04/10/2018, T-150/17, FLÜGEL / ... VERLEIHT FLÜGEL et al., EU:T:2018:641

11/06/2020, T-563/19, PERFECT BAR (fig.), EU:T:2020:271

11/06/2020, T-553/19, PERFECT BAR, EU:T:2020:268

08/11/2018, T-758/17, PERFECT BAR, EU:T:2018:762

08/11/2018, T-759/17, PERFECT BAR (fig.), EU:T:2018:760

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