

## DECISION

of the Court of Appeal of the Unified Patent Court  
of 9 February 2026

concerning an appeal against a decision concerning an Application to annul a decision of the  
Office to reject a request for unitary effect (R. 97 RoP)

### HEADNOTE

Article 3(1) of Regulation 1257/2012 cannot be interpreted to allow registration of unitary effect for a granted European patent which does not include the designation of one of the participating Member States.

### KEYWORDS

- Registration of unitary effect
- Article 3(2) of Regulation 1257/2012

### APPELLANT (AND APPLICANT BEFORE THE COURT OF FIRST INSTANCE)

**PAPST LICENSING GmbH & Co. KG**, St. Georgen, Germany

(hereinafter: Papst Licensing)

represented by Patent attorney Jan Gigerich, IPCGS Gigerich Sedlmaier, Munich, Germany

### RESPONDENT (AND RESPONDENT BEFORE THE COURT OF FIRST INSTANCE)

**European Patent Office (EPO)**, Munich, Germany

(hereinafter: EPO)

Represented by President António Campinos

### LANGUAGE OF THE PROCEEDINGS

German

### JUDGE

Ingeborg Simonsson, standing judge

## IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Date: 30 December 2025, Central Division Paris,

Action number of the file at First Instance:

- UPC\_CFI\_1771/2025.

## PATENT AT ISSUE

EP 3 327 608

## SUMMARY OF FACTS

### *The patent at issue*

1. The patent at issue was granted on 16 April 2025. The application was filed on 11 December 2017 as a divisional application of an earlier European application, which in turn was a divisional application of a Euro-PCT application with a filing date of 31 July 2005 (the parent application). The granted patent covers 30 countries, not including Malta.

### *The application for unitary effect and the decision of the EPO*

2. Papst Licensing filed an early application for unitary effect on 10 April 2025, which was deemed to have been filed on 16 April 2025. The application was rejected by the EPO's Unitary Patent Protection Division in a reasoned decision on 10 November 2025. The Division referred to Article 3(1) of Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (hereinafter Regulation 1257/2012) and to Rule 5(2) of the EPO Rules relating to Unitary Patent Protection, dismissing the counter arguments raised by Papst Licensing.
3. Papst Licensing applied to the Paris Central Division for the annulment of the decision of the EPO.

### *The impugned decision*

4. By the impugned decision, the Paris Central Division rejected the request for annulment. The Central Division noted that there were no indications and no allegations by the parties that Papst Licensing had attempted to extend the territorial scope of protection of the divisional application by adding Malta. The Central Division stated, *inter alia*, that unitary effect is not linked to the designation of the states in the patent application, but to the grant of the European patent as the final result and to the date of the request for unitary effect. This is a deliberate legislative decision to ensure the unitary character of the European patent with unitary effect and cannot be regarded as an unintended loophole. The unitary territorial protection concerns the validity of the patent in all participating Member States. It does not depend on the manageability and use of the patent. Rule 7(2) of the EPO Rules relating to Unitary Patent Protection is mandatory in nature and restricts the operational autonomy of the EPO. If the conditions for the registration of unitary effect are not met, the EPO may not issue an administrative act other than a refusal.
5. Papst Licensing appealed the decision.

## INDICATION OF THE PARTIES' REQUESTS

6. Papst Licensing requests (in summary) that the impugned decision be set aside, that the request of 10 April 2025 for unitary effect for the patent at issue be granted and that court fees for the proceedings (first and second instance) be borne by the EPO. Papst Licensing is in addition requesting that the Court of Appeal refer several questions to the Court of Justice of the European Union (CJEU) for a preliminary ruling.
7. The EPO has explained that it stands by its decision of 10 November 2025.

## SUBMISSIONS OF THE PARTIES

### *Papst Licensing (in summary and insofar as relevant)*

8. Papst Licensing is advancing that there are procedural errors, incorrect interpretation of the law and contradiction with higher-ranking law in the impugned decision.
  - The request is explicitly aimed at granting unitary effect for the participating Member States actually granted - i.e. expressly without Malta, although the Central Division failed to recognise this.
  - The Central Division's demand that Papst Licensing should have extended the territorial scope of protection of the divisional application by adding Malta when filing the divisional application cannot be upheld, as the parties were not informed of this procedural matter by the court (procedural error). It is also incorrect in substance since there is no possibility to make such an addition.
  - Unitary effect does not presuppose that the patent has been granted in every single participating Member State. Article 18(2) of Regulation 1257/2012 shows that different generations of unitary patents with different territorial scope were already envisaged when the Regulation was issued. Since Malta only joined the Convention on the Grant of European Patents (European Patent Convention or EPC) in 2007 and was not included in the application filed in 2005, it is consistent under EU law and systematical to treat Malta as a non-participating Member State for this patent. This does not affect the unitary character of the patent for the other participating Member States.
  - The EPO's approach and that of the Central Division jeopardise the objectives of "promoting scientific and technological progress and the functioning of the internal market" (see recital 4 of Regulation 1257/2012) and the achievement of the Union's objectives.
  - What the Central Division stated about a deliberate legislative decision is not justified. Regulation 1257/2012 was issued in 2012, five years after Malta's accession to the EPC in 2007. If the legislator had intended to expressly regulate or deliberately exclude the constellation concerned here, it would have provided for this in the transitional provisions.
  - Article 18(6) of Regulation 1257/2012 under the heading "Entry into force and application", provides that unitary patent protection may be requested for "any European patent" granted on or after the entry into force of the Regulation. This leaves no room for restrictive interpretation.
  - The impugned decision is based on the flawed assumption that the principle of proportionality does not apply where an authority is bound by a mandatory statutory provision. The Central Division should have carried out a proportionality test.
  - The denial of unitary effect also results in objectively unjustified unequal treatment between patent proprietors based solely on the historical filing date. Such a differentiation, which bears no relation to the protectability of the invention, infringes the substantive equality of property protection under Article 17(2) of the Charter of Fundamental Rights of the European Union (the Charter).

- The Central Division applied the prohibition of discrimination in Article 21(1) of the Charter in an incorrect way.
- The request for reimbursement of court fees is justified because Art. 69 UPCA is not superseded by Art. 66(2) UPCA.

*The EPO (in summary and insofar as relevant)*

9. The EPO has referred to the assessment in its decision of 10 November 2025, emphasizing that
  - According to Article 2(a) of Regulation 1257/2012, "participating Member State" means a Member State participating in enhanced cooperation in the area of the creation of unitary patent protection on the basis of Decision 2011/167/EU or on the basis of a decision adopted pursuant to the second or third subparagraph of Article 331(1) TFEU at the time of the request for unitary effect referred to in Article 9 of the Regulation. Currently, all EU Member States, with the exception of Spain and Croatia, participate in the enhanced cooperation in the area of the creation of unitary patent protection (see recital 3 of Regulation (EU) No 1257/2012 in conjunction with Council Decision 2011/167/EU and Commission Decision (EU) 2015/1753).
  - The filing date of the patent application is before 1 March 2007, the date on which Malta acceded to the EPC. Therefore, the European patent application 17 206 422.2 could not include the designation of Malta (Article 76(2) EPC). Consequently, the granted patent did not include the designation of this participating Member State. The patent thus does not contain claims for the participating Member State Malta and was consequently not granted with the same claims for all twenty-five participating Member States as required by Rule 5(2)(a) of the Rules relating to Unitary Patent Protection.
  - With regard to Papst Licensing's request to order the EPO to pay the costs of the proceedings at first and second instance, reference is made to Art. 66(2) UPCA - which as *lex specialis* takes precedence over Art. 69 UPCA - and R. 98 RoP. Accordingly, the parties must bear their own costs in the case.

REASONS FOR THE DECISION

*In substance*

10. The appeal is admissible (R. 97.5 RoP) but must be rejected as unfounded.
11. Pursuant to Article 3(1) of Regulation 1257/2012, a European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection. A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect.
12. Article 18(2) of Regulation 1257/2012 provides that by way of derogation from Articles 3(1), 3(2) and 4(1), a European patent for which unitary effect is registered in the Register for unitary patent protection shall have unitary effect only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.
13. Malta has ratified the Agreement on a Unified Patent Court and is consequently a Member State in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration as meant in Article 18(2) of Regulation 1257/2012 (also referred to as a 'Contracting Member State').

14. In 2005, when Papst Licensing filed the parent application, Malta had not yet acceded the EPC. Malta deposited its instrument of accession to the EPC on 1 December 2006, and the EPC entered into force for Malta on 1 March 2007. As explained in the official publication where Malta's accession was announced (Official Journal of the EPO 1/2007), European patent applications filed on or after 1 March 2007 will include the designation of the new EPC Contracting State, but it was not possible to designate Malta retroactively in applications filed before that date. This is also consistent with Article 76(2) EPC, according to which all the EPC Contracting States designated in the earlier application at the time of filing of a European divisional application shall be deemed to be designated in the divisional application.
15. As a result, the grant of the patent at issue does not include Malta, and this is common ground in the proceedings.
16. Papst Licensing takes the view that "granted for all participating Member States with the same claims" in Article 3(1) of Regulation 1257/2012, is to be understood as "for all participating Member States designatable for this European patent ..." and that non-designatable states are not deemed to be participating Member States in this respect. Papst Licensing is effectively asking for unitary effect, although with a carve-out for Malta.
17. According to the case-law, an interpretation of a provision of EU law cannot have the result of depriving the clear and precise wording of that provision of all effectiveness. Thus, where the meaning of such a provision is absolutely plain from its very wording, the EU judicature cannot depart from that interpretation (see judgment of 23 November 2023, Ministarstvo financija, C-682/22, EU:C:2023:920, paragraph 31 and the case-law cited). According to settled case-law, in interpreting a provision of EU law, where its wording does not expressly delimit the provision's scope, account must be taken of the context of the provision and the objectives pursued by the rules of which it forms part (see judgment of 21 January 2021, Whiteland Import Export, C-308/19, EU:C:2021:47, paragraph 34 and the case-law cited).
18. By its submissions, Papst Licensing is effectively asking the Court of Appeal to apply Article 3(1) of Regulation 1257/2012 *contra legem*. Here, it should be borne in mind that, according to settled case-law, recourse to a broad interpretation is possible only in so far as it is compatible with the wording of the provision at issue and that even the principle of interpretation in conformity with a rule of superior binding force cannot serve as the basis for an interpretation that is *contra legem* (see judgment 26 June 2025, Uniper Global Commodities vs ACER, T-96/23, EU:T:2025:633, at para 36 with references).
19. It is apparent already from the wording of Article 3(1) of Regulation 1257/2012 that a European patent can only benefit from unitary effect if it is granted with the same set of claims in respect of all the participating Member States. The purpose is underlined by the preamble at 7 of Regulation 1257/2012. The main feature of a European patent with unitary effect should be its unitary character, i.e. providing uniform protection and having equal effect in all the participating Member States. To ensure the uniform substantive scope of protection conferred by unitary patent protection, only European patents that have been granted for all the participating Member States with the same set of claims should benefit from unitary effect.

20. For these reasons, Article 3(1) of Regulation 1257/2012 cannot be interpreted to allow registration of unitary effect for a granted European patent which does not include the designation of one of the participating Member States.
21. According to recital 4 to the preamble of Regulation 1257/2012, unitary patent protection will foster scientific and technological advances and the functioning of the internal market by making access to the patent system easier, less costly and legally secure. It will also improve the level of patent protection by making it possible to obtain uniform patent protection in the participating Member States and eliminate costs and complexity for undertakings throughout the Union.
22. Insofar as Papst Licensing is relying on recital 4 to support its interpretation of Article 3(1) of the Regulation, it suffices to say that the preamble to an EU law act has no binding legal force and cannot be relied on either as a ground for derogating from the actual provisions of the act in question or for interpreting those provisions in a manner clearly contrary to their wording (see judgment of 19 June 2014, *Karen Millen Fashions*, C-345/13, EU:C:2014:2013, paragraph 31 and the case-law cited).
23. Papst Licensing's arguments about application of the proportionality principle fail for the reasons set out in the preceding paragraphs. Whether or not proportionality is considered a higher-ranking rule in this context, it cannot be applied to arrive at an application of Article 3(1) of Regulation 1257/2012 *contra legem*.
24. What Papst Licensing has brought forward about a procedural error of the Central Division is irrelevant, since such an error, had it occurred, could not lead to the granting of unitary effect in this case.
25. Papst Licensing is in addition referring to Article 17(2) of the Charter, which reads "Intellectual property shall be protected". Here, however, it is clear from the submissions that Papst Licensing is partly recycling its arguments about interpretation of Article 3(1) of Regulation 1257/2012, and partly taking issue with the outcome of the assessments made by the EPO and the Central Division. All these aspects have already been addressed in the preceding paragraphs.
26. Furthermore, Papst Licensing is reading Article 18(2) of Regulation 1257/2012 in an incorrect way to support its argument that unitary effect can be granted, although with a carve-out for Malta.
27. Article 18(2) of Regulation 1257/2012 was introduced by the Council following an agreement with the European Parliament at first reading (see PE-CONS 72/11, EP-PE\_TC1-COD(2011)0093 and European Parliament Report - A7-0001/2012). It was the European Parliament that proposed the provision in (then) Article 22. The purpose of this provision is that unitary effect will apply only in those states for which the UPCA is applicable at the time of registration.
28. Although this results in successive generations of European patents with unitary effect with different territorial scope as new Member States ratify the UPCA, there are no indications in the preparatory works that supports the interpretation of Article 3(2) of the Regulation suggested by Papst Licensing. To the contrary, Article 18(2) of Regulation 1257/2012 is an exemption from the general rules in Articles 3(1), 3(2) and 4(1) and as such cannot be understood to change the character of Article 3(1) of the Regulation.

29. Nothing else follows from Article 18(6) of Regulation 1257/2012 which provides that unitary patent protection may be requested for any European patent granted on or after the date of application of the Regulation.
30. Art 21 of the Charter prohibits any discrimination based on any ground such as sex, race, colour, ethnic or social origin, genetic features, language, religion or belief, political or any other opinion, membership of a national minority, property, birth, disability, age or sexual orientation. Papst Licensing has not explained in a comprehensive manner how this provision applies.
31. For the reasons stated, the appeal must be rejected.

*The requests for referrals for preliminary rulings pursuant to Article 267 TFEU*

32. Papst Licensing is making a conditional request that the Court of Appeal refer the following questions to the CJEU for a preliminary ruling (the list is said to be non-exhaustive):

*Proposed question referred 1:*

*Is an understanding of Article 9.1 of 'Regulation (EU) No 1257/2012' compatible with Union law, in particular with Article 4.3 TEU, that the "participating Member States" under 'Regulation (EU) No 1257/2012' have transferred competences established by 'Regulation (EU) No 1257/2012' to the European Patent Office as nation states (in their capacity as EPC member states) and not in their capacity as EU member states, without the European Patent Office being bound by Union law and the fundamental rights under the Charter?*

*Proposed question referred for a preliminary ruling 2:*

*If the answer to Question 1 is in the affirmative, is it compatible with EU law, in particular with CJEU decision C-284/16 - "Achmeda", for the UPC to review the Decision of the authority not bound by EU law from its perspective, i.e. the perspective of the authority?*

*Proposed question referred for a preliminary ruling 2a:*

*If the second question referred is answered in the affirmative, is it compatible with EU law, in particular with the principle of proportionality under Article 5 TEU and the second subparagraph of Article 19(1) TEU, for the national court to recognise the fundamental relevance of the principle of proportionality under EU law to the case to be decided, but does not apply the principle of proportionality because it considers the authority not bound by EU law to be bound by the mandatory nature of the statutory provision and takes the view that that authority does not have a choice between various appropriate measures?*

*Proposed question referred for a preliminary ruling 2b:*

*If Question 2a is to be answered in the affirmative, is it compatible with EU law, in particular Article 5.4 TEU, for the court to follow the interpretation of the law of the authority not bound by EU law, even though an alternative interpretation of the law which respects the principle of proportionality is possible and thus another suitable measure is available for selection?*

*Proposed question referred for a preliminary ruling 3:*

*Is the expression 'a European patent granted with the same claims for all participating Member States' in Article 3(1) of Regulation (EU) No 1257/2012 to be interpreted as meaning that the European patent must have been granted for all participating Member States at the time the patent was granted, even if the designation of a particular State was not possible at the time of filing and that non-designated State cannot therefore be included in the territorial scope of protection of the patent at the time of grant?*

*Question referred for a preliminary ruling 4:*

*Is it compatible with EU law, in particular with Article 6(3) TEU and Article 2 TEU (principle of the rule of law), for the court to make the application of the principle of proportionality under EU law conditional on the person concerned having made at least one prior attempt to remedy the situation, even if the statutory requirements, practice and case-law of an authority not bound by EU law preclude that and any attempt is therefore unsuccessful from the outset?*

*Question referred for a preliminary ruling 5:*

*Does the principle of fair trial and the right to be heard under Article 47 of the Charter and Article 6.1 TEU require that a court, in the context of amendment proceedings which qualify as administrative court proceedings, inform the parties in advance of the decision-making process of legal or factual circumstances which it intends to take into account of its own motion?*

*On the obligation to make references pursuant to Art. 267 TFEU*

33. It is established case-law that where there is no judicial remedy under national law against the decisions of a national court or tribunal, that court or tribunal is in principle obliged to make a reference to the Court of Justice within the meaning of the third indent of Article 267 TFEU where a question concerning the interpretation of EU law is raised before it. What such a court must observe in this regard has been set out in case-law too (see, for example, judgment of 6 October 2021, *Consortio Italian Management e Catania Multiservizi and Catania Multiservizi*, C-561/19, EU:C:2021:799, paras 32-59).

*The UPC as a common court which applies EU law*

34. Council Decision 2011/167/EU of 10 March 2011 authorised enhanced cooperation in the area of the creation of unitary patent protection. It was thereafter for the requesting Member States to set up the unitary patent and to lay down the rules attaching to it, including, if necessary, specific rules in the judicial sphere (see judgment of 16 April 2013, *Spain and Italy v Council*, C-274/11, EU:C:2013:240, para 92).
35. The UPC is a court common to the Contracting Member States and thus subject to the same obligations under Union law as any national court of the Contracting Member States (Art. 1 UPCA).
36. The Court shall apply Union law in its entirety and shall respect its primacy (Art. 20 UPCA). The primacy of Union law includes the TEU, the TFEU, the Charter, the general principles of Union law as developed by the CJEU, and in particular the right to an effective remedy before a tribunal and a fair and public hearing within a reasonable time by an independent and impartial tribunal, the case law of the CJEU and secondary Union law (see the preamble of the UPCA). Pursuant to Art. 6(3) TEU, fundamental rights, as guaranteed by the ECHR and as they result from the constitutional traditions common to the Member States, shall constitute general principles of the Union's law.
37. The UPC must interpret its own substantive and procedural law in a manner that is consistent with EU law, and in the rare cases when such interpretation is impossible, ultimately disapply, of its own motion, any rule or practice, which is contrary to a provision of EU law with direct effect (see for example judgment of 19 December 2024, *K GmbH [Traitement de données personnelles des employés]*, C-65/23, EU:C:2024:1051, para 53).



#### *Legislative framework for requests for unitary effect*

38. According to Article 9(3) of Regulation 1257/2012, the participating Member States shall ensure effective legal protection before a competent court of one or several participating Member States against the decisions of the EPO in carrying out the tasks referred to in Article 9(1) of the Regulation.
39. Art. 32(1)(i) UPCA provides that the Court shall have exclusive competence in respect of actions concerning decisions of the EPO in carrying out the tasks referred to in Article 9 of Regulation 1257/2012. Any natural or legal person, or any body entitled to bring actions in accordance with its national law and who is affected by a decision of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012 is entitled to bring actions under Art. 32(1)(i) (Art. 47(7) UPCA).
40. In actions brought under Art. 32(1)(i) UPCA, the Court may exercise any power entrusted on the EPO in accordance with Article 9 of Regulation (EU) No 1257/2012, including the rectification of the Register for unitary patent protection (Art. 66(1) UPCA).
41. The procedural rules for the Court are set out in R. 85 to 98 RoP.
42. At any stage of the proceedings where a question is raised before the Court and the Court considers that a decision on the question by the Court of Justice of the European Union (“CJEU”) is necessary before the Court can give judgment, the Court of First Instance may and the Court of Appeal shall request the CJEU to give a ruling thereon (R. 266.1 RoP).

#### *Application to this case*

43. The outcome in the present proceedings is based on a literal reading of Article 3(1) of Regulation 1257/2012. Questions 1, 2, 2a and 2b proposed by Papst Licensing are irrelevant.
44. Proposed question 3 is based on the impossible starting point that Article 3(1) of Regulation 1257/2012 shall be applied *contra legem* (as explained above).
45. The assessment by the Court of Appeal is not conditional on a requirement that Papst Licensing should have made at least one prior attempt to remedy the situation by including Malta among the designated states in the patent application procedure. This makes proposed questions 4 and 5 irrelevant.

#### *Conclusion on the request for referrals*

46. Based on these considerations, the standing judge concludes that there is no reason to refer any questions to the CJEU for a preliminary ruling pursuant to Article 267 TFEU.

#### *Costs*

47. In actions brought under Article 32(1)(i) UPCA the parties shall, by way of derogation from Article 69 UPCA, bear their own costs (Art. 66 (2) UPCA). This is reflected in R. 98 RoP according to which the parties shall bear their own costs in any action pursuant to Rule 85 or 97.
48. Accordingly each party shall bear its own costs.

DECISION

- I. The appeal is rejected
- II. Each party shall bear its own costs.

Issued on 9 February 2026

Ingeborg Simonsson, standing judge