

**Decision**  
**of the Court of First Instance of the Unified Patent Court**  
**UPC\_CFI\_1771/2025**  
**concerning EP 3 327 608**  
**issued on 30 December 2025**

LEADING HEADNOTES:

1. Pursuant to Article 1(2) and Article 20 of the Agreement on a Unified Patent Court (UPCA), the Unified Patent Court shall, in any event, apply Union law in its entirety and respect its primacy, including when reviewing a decision of the European Patent Office (EPO). Therefore, compliance with the guarantees afforded by the EU legal system is all the more important in administrative proceedings before the EPO.
2. Unitary effect is not linked to the designation of countries 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.
3. Unitary territorial protection concerns the validity of the patent in all participating Member States. It is not dependent on the enforceability and use of the patent.
4. Rule 7(2) of the Implementing Regulations for Unitary Patent Protection (IRUP) is mandatory in nature and restricts the operational autonomy of the EPO. If the conditions for registering unitary effect are not met, the EPO may not issue any administrative act other than rejection.
5. When a new Member State ratifies the UPCA, registered unitary patents retain their unitary effect.

KEYWORDS: Application for annulment of a decision of the EPO, Rule 97 of the Rules of Procedure of the Unified Patent Court (RPC); registration of the unitary effect of the European patent.

PARTIES:

APPLICANT:

**PAPST LICENSING GmbH & Co. KG**, Bahnhofstraße 33, 78112 St. Georgen, Germany, represented by Papst Licensing Verwaltungsgesellschaft mbH, same address, represented by Daniel Papst,

represented by: **Jan Gigerich and Dr Roman Sedlmaier**, IPCGS Gigerich Sedlmaier Patentanwalt Attorney PartG mbB, Munich, Germany

OPPOSING PARTY:

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

represented by President **António Campinos** PATENT IN

CONTENTION:

European Patent 3 327 608 (application number: 17 206 422.2)

Patent proprietor: PAPST LICENSING GmbH & Co. KG

DECISION UNDER APPEAL: Decision of the EPO of 10 November 2025 (file number: P002003EP608E) rejecting the request for unitary effect for EP 3 327 608

COOPERATION JUDGES:

This decision was issued by permanent judge Dr Tatyana Zhilova. BRIEF DESCRIPTION

OF THE FACTS

1. European Patent 3 327 608 (hereinafter EP 608) was granted to the applicant on the basis of patent application No. 17 206 422.2 on 16 April 2025.
2. Patent application No. 17 206 422.2 was filed on 11 December 2017 as the second divisional application of the earlier European application No. 15 187 499.7 (earlier application), which in turn is a divisional application of Euro-PCT application No. 05 782 466.6 (parent application) dated 31 July 2005.
3. All Contracting States which were party to the EPC at the time of filing the divisional application for the earlier application and the parent application were deemed to be designated pursuant to Articles 76(2) and 79 EPC (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IS, IT, LI, LT, LU, LV, MC, NL, PL, PT, RO, SE, SI, SK, TR). At the time of filing the parent application, Malta had not acceded to the EPC and therefore could not be designated for protection.
4. Malta acceded to the EPC on 1 March 2007. In the present case, there are no

indications, nor have the parties made any allegations, that the applicant attempted to extend the territorial scope of protection of the divisional application by adding Malta.

5. The applicant filed an application for unitary effect on 10 April 2025. This is deemed to have been filed on 16 April 2025 (the date of grant of the patent). At that time, Malta is also a member state of the Agreement on a Unified Patent Court (UPCA).
6. In communications dated 6 May 2025 and 26 June 2025, the applicant was informed of the intended rejection of the application for unitary effect pursuant to Rule 7 DOEPS. The reason given was that EP 608 had not been granted with the same claims for all 25 participating Member States, as required by Rule 5(2)(a) DOEPS.
7. In letters dated 16 May 2025 and 21 July 2025, the applicant maintained its request for unitary effect and put forward additional arguments.
8. In its decision of 10 November 2025, the EPO rejected the request for unitary effect for EP 608. The rejection was based on the fact that the patent had not been granted for all member states participating in the UPCA at the time of the request. The grounds for the decision addressed all the arguments put forward by the applicant.
9. On 28 November 2025, the applicant filed an application for the revocation and amendment of the Office's decision.
10. The EPO, as the respondent, submitted a response to the request for annulment of the Office's decision through its President.

#### PLAIDS OF THE PARTIES AND CONTROVERSIAL ISSUES:

11. The applicant requests that the EPO's decision be set aside as unlawful and that the request of 10 April 2025 for unitary effect of EP 608 be granted.
12. The applicant essentially argues as follows:
  - i. The wording "for all participating Member States" in Rule 5(2)(a) of the Implementing Regulations for the Unified Patent Court (IRUPC) refers to those Member States whose designation was legally possible at the time of the patent application. Any other interpretation would create a condition that is impossible in practice.
  - ii. The EPO is applying an erroneous restricted interpretation of the wording of Rule 5(2)(a) DOEPS and Article 3(1) of Regulation No.

1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (hereinafter Regulation 1257/2012).

- iii. Since there is no explicit provision regarding Member States that subsequently acceded to the EPC, the DOEPS contains an unintended regulatory gap, which the EPO has discretion to overcome. The fact that, for practical reasons, no grant could be made in Malta does not affect the uniformity of the patent, as there is neither a divergent claim nor a partial patent there. The decisive factor is the substantive consistency of the claims and thus the manageability of the unitary patent, not its geographical scope.
  - iv. Rule 7 DOEPS does not provide for mandatory rejection in the event of non-fulfilment of the requirements of Rule 5 DOEPS. The registration of the unitary effect is at the discretion of the EPO. The EPO does not carry out a proper proportionality test and misinterprets the requirements for an interpretation that complies with fundamental rights.
  - v. The contested decision violates the fundamental right to intellectual property within the meaning of Article 17(2) of the Charter of Fundamental Rights of the European Union (CFREU). The unitary patent is not merely an administrative option, but an essential component of modern patent protection in the internal market. Refusal would lead to considerable economic disadvantages: higher costs for national validations, fragmented protection, more complex enforcement and increased legal uncertainty. A patent holder who does not have access to the unitary patent also suffers a significant disadvantage compared to other patent holders.
  - vi. The contested decision violated the ban on discrimination within the meaning of Article 21(1) of the Charter of Fundamental Rights of the European Union. At the very least, there was indirect discrimination that was not justified. Old applications and thus their inventors and patent holders were systematically disadvantaged. The disadvantage is based exclusively on a formal, historical criterion (date of application) over which the parties concerned had no influence.
  - vii. There is also arbitrary unequal treatment in comparison with subsequent UPCA accessions (such as most recently Romania), where uniform effect is possible and is automatically extended to the new contracting Member State.
13. These arguments had essentially already been put forward in the proceedings before the EPO in response to the EPO's preliminary communication regarding its intention to reject the request for unitary effect, and were taken into account by the EPO in the contested decision.
14. In response to the request for annulment of the contested

decision, the President of the EPO states the following submission:

- i. The wording of Rule 5(2)(a) DOEPS and Article 3(1) of Regulation No 1257/2012 expressly requires that the patent has been granted with the same claims for all participating Member States. The term "has been granted" refers to the actual effect of the grant of the patent and not to the legal possibility of designating the Member States in the patent application.
- ii. The interpretation of the wording of Rule 5(2)(a) DOEPS and Article 3(1) of Regulation No 1257/2012, as undertaken by the applicant, must be rejected from a systematic and normative point of view. These should be interpreted in conjunction with Article 2 of Regulation No 1257/2012, which determines the group of participating Member States at the time of the request for unitary effect.
- iii. If the requirement of Rule 5(2)(a) DOEPS is not met, the application for unitary effect must be rejected by the EPO in accordance with Rule 7(2) DOEPS. The EPO has no discretion in this matter, so rejection is mandatory in the event of non-compliance.
- iv. There is no regulatory gap in the DOEPS. The absence of an exception with regard to the contracting states that subsequently acceded to the EPC is a legislative decision. The principle of proportionality is not an independent legal remedy, but can only be used as an aid to interpretation within the scope of the authority's discretion.
- v. There is no infringement of Article 17(2) of the Charter of Fundamental Rights. The registration of unitary effect is an additional, optional legal status and an administrative act. The rejection of the application therefore does not constitute an infringement of property rights, but concerns a regulatory admission requirement.
- vi. There is no unequal treatment within the meaning of Article 21(1) of the Charter of Fundamental Rights. The fact that it was not possible to designate Malta is an objective circumstance and the necessary legal consequence. This is in line with the established practice of the EPO in comparable cases.
- vii. There was no unequal treatment compared to subsequent UPCA accessions (such as Romania most recently). The unitary patents retain their uniform effect in relation to the Member State that subsequently acceded to the UPCA because they were originally granted for that state as well.

15. The EPO requests that the application for annulment of the contested decision be dismissed.

16. For further details, reference is made to the briefs of the parties.

## REASONS FOR THE DECISION:

17. The request to set aside the contested decision of the EPO is to be dismissed.

### *Decision-making power of the permanent judge*

18. The request to set aside a decision of the EPO to refuse a request for unitary effect must be filed with the Court of First Instance in accordance with Rule 97(1) RPC. The decision must be taken by the permanent judge in accordance with Rule 97(4) RPC.

### *Competence of the EPO*

19. The tasks relating to the administration of requests from European patent proprietors for unitary effect and the establishment and administration of the Register for unitary patent protection have been conferred on the EPO by the participating Member States pursuant to Article 9(1)(a) and (b) of Regulation No 1257/2012. Consequently, the EPO is the competent authority for registering the unitary effect.

20. The contested decision was adopted as an administrative act within the competence of the EPO.

### *The EPO's obligation to comply with EU law*

21. As an independent supranational organisation with its own autonomous legal system, the European Patent Office is not directly bound by EU law and the fundamental rights enshrined in the Charter of Fundamental Rights of the European Union.
22. However, the question arises as to whether the link between the EPO and its integration into the unitary patent system gives rise to an obligation to apply EU law.
23. In particular, such an obligation cannot be inferred from Article 9(1) of Regulation No 1257/2012. Although this provision and, consequently, a regulation under Union law transfer powers to the European Patent Office, this is done expressly by the "participating Member States" in the unitary patent system as nation states in their capacity as EPC member states, by making institutional use of the European Patent Office created by them under the EPC, which is governed by international law, and not in their capacity as EU member states.
24. Another argument against the assumption that the European Patent Office is bound by EU law is that, as it is not classified as a "court of a Member State" within the meaning of Article 267 TFEU, the European Patent Office is not entitled to refer questions of interpretation to the ECJ. Only this mechanism would ensure the uniform interpretation and application of EU law.

25. Accordingly, it is not absolutely necessary for the EPO itself to be bound by EU law in order to preserve its autonomy and ensure the uniform interpretation of EU law, as this is guaranteed by the possibility of comprehensive control by the EPG (see ECJ, judgment of 6 March 2018 – C-284/16, NJW 2018, 1663 – Achmea).
26. In any case, the EPG applies Union law in its entirety and respects its primacy, including when reviewing a decision of the EPO, in accordance with Article 1(2) and Article 20 of the UPCA. Pursuant to Article 6(1) of the Treaty on European Union (TEU), the Charter of Fundamental Rights has the same primary status as the Union treaties and is therefore part of the Union law to be given priority by the UPC pursuant to Article 1(2) and Art. 20 UPCA (expressly also EPG, Court of Appeal, order of 20 August 2025 – UPC\_CoA\_380/2025, GRUR-RS 2025, 21002 marginal no. 35 – expert/Viosys). Since the arguments put forward by the applicant are also based on the application of EU law, they must be discussed by the court.
27. Therefore, compliance with the guarantees afforded by EU law in administrative proceedings is all the more important for the EPO as the competent authority, so that the question of whether the EPO is bound by EU law can be left open.

#### *The administrative procedure*

28. The case law of the ECJ has developed the principles of good administration (C-269/90 Technische Universität München; C-17/99 France v Commission; C-349/07 Sopropé). These include, in particular, the obligation of the competent body to examine all relevant aspects of the individual case carefully and impartially, the right of the person concerned to be heard, and the right to a sufficient statement of reasons for the decision. Only in this way can the court review whether the factual and legal circumstances relevant to the exercise of discretion were present.
29. These principles have been summarised as components of the fundamental right to good administration in Article 41 of the Charter of Fundamental Rights of the European Union: "This right includes, in particular: the right of every person to be heard before any individual measure which would affect him or her adversely is taken; the right of every person to have access to his or her file, while respecting the legitimate interests of confidentiality and professional and business secrecy; the obligation of the administration to give reasons for its decisions."
30. In the present case, the contested decision was issued following administrative proceedings in which the right to good administration was observed and none of the applicant's procedural rights were infringed. The court will then discuss the legality of the contested decision.

## *Legal framework*

31. The definition of 'participating Member State' is set out in Article 2(a) of Regulation No 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 taken in accordance with the second or third subparagraph of Article 331(1) TFEU at the time of the request for unitary effect referred to in Article 9."*
32. Article 3(1) in conjunction with recital 7 of Regulation No 1257/2012 provides: *"A European patent which has been granted with the same claims for all participating Member States shall have unitary effect in the participating States, provided that its unitary effect has been entered in the Register for unitary patent protection."*
33. Furthermore, Article 3(1), second subparagraph, of Regulation No 1257/2012 expressly states that a European patent granted with different claims for different participating Member States does not have unitary effect.
34. Rule 5(2)(a) DOEPS stipulates: *"Unitary effect shall only be registered if the European patent has been granted with the same claims for all participating Member States."*
35. Rule 7(2) DOEPS stipulates: *"If the requirements of Rule 5(2) are not met or if the request for unitary effect does not comply with Rule 6(1), the European Patent Office shall reject the request."*
36. The DOEPS does not contain any specific provision for cases where a participating Member State was not yet a member of the EPC at the time of filing the application.

## *Interpretation of Article 3(1) in conjunction with Recital 7 of Regulation No 1257/2012*

37. According to recital 7 of Regulation No 1257/2012, the most important feature of a European patent with unitary effect should be its unitary character, i.e. it offers uniform protection and has the same effect in all Member States. Consequently, a European patent with unitary effect can only be limited, transferred or revoked in respect of all participating Member States and can only expire in respect of all participating Member States. This recital is reflected in Article 3 of Regulation No 1257/2012.
38. Unitary effect is not linked to the designation of states in the patent application, but to the granting of the European patent as the final result and to the date of the request for unitary effect



effect. This is a deliberate legislative decision to ensure the uniform character of the European patent with unitary effect and cannot be regarded as an unintended loophole. Furthermore, it should be noted that Regulation No 1257/2012 does not provide that the designation of one or more Member States is deemed to be the designation of all Member States, which is a legal possibility under Article 149(1) EPC.

39. The unitary character of the European patent with unitary effect requires that the grant of the patent gives rise to the same substantive rights in all Member States. If the patent has not been granted for a Member State, these substantive rights cannot arise in that State and the patent does not have a unitary character.
40. Furthermore, this understanding is also supported by the wording of Article 3(1) of Regulation No 1257/2012, which requires "a European patent" for the registration of unitary effect. This wording refers to the European patent granted *uno acto* by the EPO. Due to the time difference between the filing of a European patent application and the subsequent accession of a new EPC state, it is no longer possible to speak of "one" patent within the meaning of this provision at the time of grant of this patent. The fact that the date of the original grant is decisive for consideration is made clear by the unambiguous wording of Article 3(1) of Regulation No 1257/2012: "has been granted".

*Interpretation of Rule 5(2)(a) DOEPS in conjunction with Recital 7 of Regulation No 1257/2012*

41. Furthermore, recital 7 of Regulation No 1257/2012 stipulates that, in order to ensure the uniform substantive scope of protection conferred by the unitary patent, **only** those European patents which have been granted with the same claims for all Member States should have unitary effect.
42. Consequently, **only** those patents that have been granted for all Member States with the same claims should be entered in the register. This legal understanding is reflected in Rule 5(2)(a) DOEPS.
43. According to the definitions in Article 2(a) of Regulation No 1257/2012, the unitary territorial protection extends to the participating Member States at the time of the request for unitary effect. The DOEPS does not contain any specific provision for cases where a participating Member State was not yet a member of the EPC at the time of application. This is a consequence of the link between the European patent and the date of its grant, as well as the link between the unitary effect and the date of the request for unitary effect. Therefore, the absence of a specific provision cannot be considered an unintended regulatory gap.

44. The applicant's view that the failure to grant the patent in Malta does not affect its unity, provided that the patent is not used in Malta, cannot be accepted. Unitary territorial protection concerns the validity of the patent in all participating Member States. It is not dependent on the enforceability and use of the patent. In this sense, Article 3(2), second sentence, provides that the patent may be licensed with unitary effect in all or part of the territories of the participating Member States.

*The powers of the EPO under Rule 7(2) DOEPS*

45. Rule 7(2) DOEPS contains two alternatives. The first concerns the case where the requirements of Rule 5(2) DOEPS are not met, the second the case where the request for unitary effect does not comply with the conditions of Rule 6(1) DOEPS. The first alternative is relevant to the present case because, in accordance with the arguments set out above, the Court concludes that the requirements of Rule 5(2) are not met. This raises the question of the powers of the EPO.
46. Rule 7(2) DOEPS stipulates that "the European Patent Office shall reject the request" as a legal consequence. The mandatory nature of the rule restricts the operational autonomy of the authority. It is not at the discretion of the EPO to issue a different administrative act.

*The principle of proportionality*

47. Proportionality has been recognised in the case law of the ECJ as one of the general principles of EU law (C-104/97 Pistore, C-265/87 Schröder, C-331/88 FEDESA, C-210/00 Hofmeister et al.). As such, it is also binding on the UPC (see Article 1(2) UPCA, Article 20 UPCA, and UPC (Court of Appeal), order of 20 August 2025 – UPC\_CoA\_380/2025, GRUR-RS 2025, 21002 marginal no. 35 – expert/Viosys)
48. According to headnote 2 of the ECJ decision C-331/88 FEDESA, the legality of an administrative act is dependent on whether the administrative measures are appropriate and necessary to achieve the objectives pursued by the regulation in question. Furthermore, the disadvantages caused to the party concerned must be proportionate to the objectives pursued.
49. However, when reviewing compliance with these requirements in court, it must be taken into account whether the competent authority has discretionary power. If there are several suitable measures to choose from, the least burdensome one must be selected.
50. In a case such as the present one, where the authority is bound by the mandatory nature of the legal provision and has no choice between different suitable measures, the principle of proportionality cannot be applied. This would lead to a

Administrative act contra legem.

51. All the arguments put forward by the applicant regarding the disproportionate nature of the exclusion of unitary effect due to the impossibility of designating Malta would be relevant to the filing of the divisional application on the basis of which the patent was granted. However, the applicant did not even attempt to request an extension of the territorial scope of protection of the application on the basis of the principle of proportionality. Once the patent has been granted, it is impossible to extend the territorial scope of protection through the unitary effect of the patent.

*The fundamental right to intellectual property within the meaning of Article 17 of the Charter of Fundamental Rights of the European Union*

52. Article 17 of the Charter of Fundamental Rights of the European Union reads as follows:

*(1) Everyone has the right to own, use, dispose of and bequeath their lawfully acquired property. No one shall be deprived of their property except for reasons of public interest in the cases and under the conditions provided for by law, and in return for timely and adequate compensation for the loss of property. The use of property may be regulated by law insofar as this is necessary for the common good.*

*(2) Intellectual property shall be protected.*

53. The applicant claims that the contested decision infringes the right to patent protection under Article 17(2) of the Charter.

54. Even though Article 17(2) of the Charter does not specify the scope of protection of intellectual property rights, there is no question that intellectual property is protected under the law. This follows from the different nature of intellectual property objects, which require different legal remedies at different levels of protection. Ultimately, intellectual property rights, including their protection, are subject to systematic interpretation in the context of paragraph 1 of a statutory provision.

55. Therefore, the refusal of the uniform effect of the patent on the grounds of non-fulfilment of the legal requirements for its grant cannot be regarded as a violation of the fundamental right to intellectual property protection.

*The ban on discrimination within the meaning of Article 21(1) of the Charter of Fundamental Rights of the European Union*

56. The ban on discrimination comprises three conditions that must be met simultaneously:

1) a person is treated unequally and less favourably than other persons

- who
- 2) who are in a comparable situation, and
  - 3) on the basis of one or more protected features.

A non-exhaustive list of protected features can be found in Article 21(1) of the Charter of Fundamental Rights of the European Union.

57. The applicant does not name any persons who are in a comparable situation and towards whom she has been disadvantaged. The case in which a new state ratifies the UPCA does not constitute a comparable situation. In such cases, most recently the ratification by Romania, the patent was originally granted to all participating states at that time and the new member state only subsequently acceded to the UPCA. In the present case, however, Malta was already a participating contracting state at the time the patent was granted.

#### DECISION:

The request by PAPST LICENSING GmbH & Co. KG to set aside the decision of the European Patent Office of 10 November 2025 (file number P002003EP608E) rejecting the request for unitary effect for EP 3 327 608 is rejected.

Permanent Judge:  
Dr Tatyana Zhilova

**Tatyana  
Zhilova**  
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Tatyana Zhilova  
Date: 30 December  
2025  
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For the Deputy  
Chancellor:

**CHARLOTT  
E CAMILLE  
CLAIRE  
FERHAT**

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Date: 30 December 2025, 13:04:57 +01'00'

#### INFORMATION ABOUT THE APPEAL

Both parties may appeal against this decision within three weeks of its notification (Rule 97(5) of the Rules of Procedure).