



The «Malta issue» of unitary patents

How a missing designation of a UPC Member State can affect the request for unitary effect

European patents with unitary effect have become increasingly popular, with more than 84.000 patents with unitary effect having been registered to date and a current global uptake rate (percentage of requests received with respect to European patents granted) of 30,9%¹. However, not all European patents meet the requirements for requesting unitary effect.

In its decision UPC_CoA_8/2026, the UPC Court of Appeal decided on the question of whether a patent with unitary effect can be obtained when not all UPC Member States were designated in the underlying application.

¹ Numbers were taken from the UP dashboard at the EPO: Statistics & Trends Centre | epo.org

I. Summary of facts

The patent at issue, EP 3 327 608 B1, is based on a divisional application of an earlier European application, which in turn was filed as a divisional application of a Euro-PCT application filed on 31 July 2005. The patent designates 30 EPC contracting states that were EPC contracting states at the filing date of the Euro-PCT application. Since Malta acceded to the EPC only on 1 January 2007, it could not be designated in the original Euro-PCT application. However, Malta is a UPC Member State.

After the patent at issue had been granted on 16 April 2025, the Patentee filed a request for unitary effect, which was rejected by the EPO on the basis of Article 3(1) of Regulation No. 1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection and Rule 5(2)a) of the Rules relating to Unitary Patent Protection. Article 3(1) of Regulation No. 1257/2012 stipulates that:

*»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.« [emphasis added]*

Rule 5(2) of the Rules relating to Unitary Patent Protection i.a. requires that:

»Unitary effect shall be registered only if

- a) *the European patent has been granted **with the same set of claims in respect of all the participating Member States, ...** «*

The EPO argued that the requested unitary effect also comprises Malta, but that the patent was not valid in Malta, since Malta was not a member of the EPC at the filing date of the patent. The Patentee brought an action before the UPC's Central Division in Paris, which upheld the rejection. Subsequently, the Patentee appealed to the UPC's Court of Appeal, requesting that the request for unitary effect of the patent should be granted.

II. Arguments of the Patentee

The Patentee submitted that the requirement *»granted with the same set of claims in respect of all the participating Member States«* in Article 3(1) of Regulation No. 1257/2012 should be interpreted as referring only to those participating UPC Member States which could actually be designated for the patent, i.e., not including Malta. The Patentee could not extend the territorial scope of protection of the divisional application by adding Malta, since there is no possibility to designate Malta retroactively.

The Patentee also referred to Article 18(2) of Regulation No. 1257/2012 which reads:

»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.«

It was argued that this Article implies that, over time, different unitary patents may have different territorial scopes as new Member States ratify the UPCA. The Patentee also submitted that the denial of unitary effect results in an objectively unjustified unequal treatment between patentees based solely on the historical filing date.

III. Decision of the Court of Appeal

In its decision UPC_CoA_8/2026, the Court of Appeal held that Article 3(1) of Regulation No. 1257/2012 is clear and precise from its wording and that the Patentee actually asked the Court to apply this Article *contra legem* (paragraphs 17 and 18). It emphasized that 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 (paragraph 19). 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 (paragraph 19). For these reasons, it concluded that Article 3(1) of Regulation No. 1257/2012 **cannot be interpreted to allow registration of the unitary effect for a granted European patent which does not include the designation of one of the participating Member States** (paragraph 20).



The Court of Appeal acknowledged that Article 18(2) of Regulation No. 1257/2012 results in successive generations of European patents with unitary effect with different territorial scope as new Member States ratify the UPCA, but found that Article 18(2) of Regulation 1257/2012 is an exemption from the general rules in Articles 3(1), 3(2) and 4(1) of Regulation No. 1257/2012 and as such cannot be understood to change the character of Article 3(1) of the Regulation (paragraph 28).

European patents with a filing date before 1 March 2007 cannot obtain unitary effect.

IV. Practical consequences

The Decision confirms a structural limitation of the unitary patent system: **European patents with a filing date before 1 March 2007 cannot obtain unitary effect.** This follows from the fact that Malta, which acceded to the EPC on that date, could not have been designated in earlier applications.

At first glance, the relevance of this issue seems to be limited, since it only applies to patents at the end of the 20 years term.

However, it cannot be excluded that this issue arises again when other EPC Member States become UPC Member States. For example, Croatia, which is an EU Member State, became an EPC Member State on 1 January 2008 so that the issue would also apply if Croatia decided to become a UPC Member State before 1 January 2028. Further, North Macedonia, Albania, Serbia, and Montenegro are countries which are not yet EU Member States but acceded to the EPC between 2009 and 2022, so that this issue may eventually become relevant again and **may continue until 2042.**

Even though it was not explicitly addressed in the Decision, it is reasonable to assume that the same issue exists where not all EPC Member States for which the unitary effect would apply were designated at the filing date of an application. Until 1 April 2009 it was possible to designate in the request for grant of a European patent only individual EPC Member States instead of all EPC Member States, so that care should be taken for applications filed before 1 April 2009. Another situation in which Article 3(1) of Regulation No. 1257/2012 and the present Decision may become relevant is when the designation of a EPC Member State which is also a UPC Member State is withdrawn.

In view of this complex situation, it is advisable to align the designated EPC Member States of a European patent with the UPC Member States and, if there is a discrepancy, to rely on the classical bundle patent instead of the patent with unitary effect.

V. Safety net

If the request for unitary effect has been rejected either by the EPO or the UPC, or where the unitary effect has been revoked by the UPC at the time when deadlines for validating the European patent have already expired, it is possible to rely on the «safety net» mechanism provided by most of the UPC Member States, which mechanism provides the possibility to validate a European patent according to the classical route².



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² For the relevant provision in Germany see §15(3) LIPT.