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We provide you with updates on new decisions, the relevant legislative process and other trends in the fields of intellectual property and unfair competition law from a Swiss perspective.

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Only One Version of the Patent Claim Allowed in Preliminary Injunction Proceedings

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The Federal Patent Court now requires patentees to assert the patent in a single version only in preliminary injunction proceedings. This change in practice puts an end to auxiliary requests in preliminary injunction proceedings.

Background

In Switzerland, enforcing a patent in preliminary injunction proceedings does not require that the patent at issue has already been the subject of adversarial proceedings on its validity. However, the defendant may object that the patent is invalid. To address such objections, patentees can amend the patent – effective only between the parties and for the preliminary injunction proceedings – and (also) assert one or more amended versions of the patent. Consequently, a patentee may base its preliminary injunction request on several versions of the patent at issue, i.e., with a cascade of auxiliary limitations. This can delay and complicate proceedings, as the Federal Patent Court (FPC) is often required to assess multiple versions of the patent claims.

In this case, the claimant based its preliminary injunction request on a supplementary protection certificate and six different versions of the basic patent. All versions targeted the same product of the defendant.

Decision

In a significant change of its practice, the FPC held that a patent could only be asserted (or defended) in a single version in preliminary injunction proceedings (procedural order S2024_008 of 29 October 2024). The FPC reasoned that this was neither unfair nor a violation of the patentee's right to be heard or to a fair trial. The purpose of a preliminary injunction was to prevent a specific product from entering the market until a decision in infringement proceedings is reached on the merits. A rational patentee would assert the narrowest version of the patent that is still infringed. If this narrowest version is found invalid, broader versions would also fail, rendering auxiliary requests unnecessary. While a narrower version may be more easily circumvented by a modified product, the FPC noted that the patentee could file a new request for a preliminary injunction and assert (or defend) the patent in a different version in such cases.

The claimant also argued that it would be unfair to prohibit auxiliary requests in preliminary injunction proceedings while allowing a defendant to submit unlimited invalidity attacks and prior art. Since the basic patent had already been the subject of opposition proceedings before the European Patent Office (EPO), the claimant requested that the defendant be limited in the preliminary injunction proceedings to new invalidity arguments and evidence that was not already evaluated in the opposition proceedings. The FPC dismissed this request, stating such restriction would mean that the FPC would be bound by the assessment in the opposition proceedings if the defendant did not submit new invalidity challenges or prior art and that Swiss law does not give such binding effect to EPO opposition decisions. Moreover, such restriction would affect the defendant's means of defence disproportionately compared to

requiring the claimant to assert (or defend) only a single version of the patent. The equal treatment of the parties does therefore not require that the defendant's means of defence be limited to new invalidity challenges and new prior art.

Comment

This decision marks an important shift in the practice of the FPC. The decision is expected to streamline preliminary injunction proceedings, which so far have typically taken five to nine months.

Preliminary injunctions are intended to prevent irreparable harm to the patentee, implying urgency. Lengthy discussions over the validity of multiple versions of a patent claim may undermine the required urgency. In cases where time is of the essence, a patentee may choose to assert the patent in a narrow version that is more likely to withstand invalidity challenges and still covers the attacked embodiment; a broader version of the patent, along with auxiliary requests, can still be pursued in subsequent main proceedings once the preliminary injunction is in place. However, narrowing a claim by adding features may open the door for new arguments of non-infringement based on those added features. It is critical to assess carefully how a claim should be narrowed for preliminary injunction proceedings.

While the change in practice prohibits auxiliary requests in preliminary injunction proceedings, it should, in our view, not prevent a patentee from amending the asserted version of the patent claim in response to invalidity challenges submitted by the defendant that the patentee could not reasonably have anticipated.

The FPC's reasoning for not restricting the defendant to new invalidity arguments not yet heard in the opposition proceedings is convincing. Another question is whether a defendant should be allowed to present unlimited invalidity arguments in preliminary injunction proceedings. While restricting defendants to a specific number of invalidity arguments would, even in summary proceedings, be difficult to reconcile with their right to be heard, the court can address excessive or unreasonable challenges by imposing additional costs on defendants.