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Swiss IP News 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.

walderwyss attorneys at law



By Manuel Bigler
MLaw, Attorney at Law
Managing Associate
Telephone +41 58 658 56 88
manuel.bigler@walderwyss.com

Quick-Starting Preliminary Injunction Proceedings

In a recent decision, the Federal Patent Court addressed the question of whether a motion for a preliminary injunction may be filed even before the allegedly infringed patent has been granted. It confirmed that, under certain circumstances, this was possible.

Background

Patent prosecution takes time. So does obtaining injunctive relief after grant of a patent, even in summary proceedings. Preliminary injunction proceedings before the Federal Patent Court (FPC) often take eight to ten months ([S2018_006](#)).

In a case currently pending before the FPC, a claimant has therefore chosen to file a motion for a preliminary injunction even before the grant of the allegedly infringed patent. The respective European patent application was filed in 2007. In 2020, the Examining Division of the European Patent Office (EPO) decided to refuse the application. The applicant appealed. In its oral hearing of 8 February 2022, the EPO's Boards of Appeal decided to set the appealed decision aside and ordered the Examining Division to grant the patent on the basis of a single claim, with a description adapted thereto. On 5 May 2022, the Boards of Appeal indicated that the written decision would be dispatched by the end of June 2022. The decision of the Boards of Appeal cannot be further appealed, and the Examining Division cannot amend the claim admitted by the Boards of Appeal.

Already on 25 March 2022, i.e. after the hearing before the Boards of Appeal, but before dispatch of the Boards of Appeal's written decision or grant of the patent, the not-yet-patentee filed a motion for a preliminary injunction against the defendant. The claimant argued that it was only a matter of time until its patent would be granted and that, once granted,

the defendant's pharmaceutical product would infringe the patent.

The defendant objected that, because there was not yet a patent that could be infringed, the motion for a preliminary injunction should be dismissed. Subsidiarily, the proceedings should be suspended immediately. Otherwise, the defendant would be put at a disadvantage, as it would not have the opportunity to comment on the reasons for the EPO's Boards of Appeal's decision that the patent should be granted.

Decision

In its procedural order of 2 June 2022 ([S2022_002](#)), the FPC held that issuing a preliminary injunction for patent infringement required a granted patent. However, it would be sufficient if the patent was granted at the time the FPC took its decision. Thus, a patentee could file a motion for a preliminary injunction as soon as the grant of the allegedly infringed patent was just a matter of time and the claims of the patent were fixed. This was the case here. The fact that the reasons for the decision by the EPO's Boards of Appeal were not known to the defendant did not cause it any significant disadvantage. On the one hand, these reasons were not known to the claimant either. On the other hand, and crucially, the reasons of the Boards of Appeal were not binding on the FPC and it was up to the defendant to show in the proceedings before the FPC that the claimant's patent was invalid, as claimed by the defendant. The FPC therefore

decided not to dismiss the motion for a preliminary injunction at this stage.

The FPC further held that the grant of the patent was imminent and, according to experience, would occur before the proceedings before the FPC were ready for decision. Should this not be the case, the FPC could defer its judgement. The FPC therefore also dismissed the defendant's request for an immediate suspension of the proceedings, and ordered the proceedings to continue.

Comment

If intellectual property rights are infringed, it is often crucial to obtain injunctive relief as soon as possible to prevent further infringements. Although it does not deal with an everyday scenario, the FPC's decision clarifying that, under certain circumstances, a motion for a preliminary injunction may also be filed even before the grant of a patent, is to be welcomed. Considering that an ex-parte injunction is difficult to obtain and preliminary injunction proceedings usually take rather long, it provides patent owners with an option to obtain injunctive relief more expeditiously.

For potential infringers, the FPC's decision means that they may be faced with preliminary injunction proceedings sooner than they would like. However, the decision also states that an injunction cannot be issued before a patent is granted (see also [S2021_007](#)). For potential infringers, this means, among other things, that it is typically sufficient to file a protective brief shortly before the publication of the grant of a patent.

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