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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.

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Update on the Revision of the Swiss Patents Act

In late 2022, the Federal Council published the draft bill for a revision of the Swiss Patents Act. The draft bill proposes significant changes to Swiss patent law.

Background

Switzerland is currently modernising its patent law. The main goals of the revision are to bring the Patents Act in line with international standards and to make the Swiss patent system more attractive for SMEs and innovators.

As we reported in our [Swiss IP News](#), the Federal Council published the preliminary draft for the revision of the Patents Act for consultation in October 2020. While the direction of the reform was generally approved, several aspects of the preliminary draft were criticized. Taking into consideration the results of the consultation, a revised bill was drafted, and the Federal Council published the draft bill together with its dispatch on 16 November 2022. Parliament will now deliberate on the draft bill. The preliminary committee of the Council of States discussed this bill in its meeting on 31 January 2023 and heard experts from various organisations. It will continue its work at a later session, presumably after the summer break.

The draft bill provides for major changes to Swiss patent law and differs significantly from the preliminary draft. It includes the following key changes compared to the status quo:

Full examination upon request

Under current law, the Swiss Federal Institute of Intellectual Property (IPI) does not examine the core patentability requirements of novelty and inventive

step. As a consequence, a Swiss patent, once granted, often involves legal uncertainty as to its validity and enforceability.

The draft bill introduces the possibility to request a full examination of the patent application, thereby providing applicants with an alternative to a fully examined European patent. A full examination, however, may be requested not only by the applicant but by any person. Whether third parties may also file observations on the patentability of an invention is not addressed in the draft revision. If no request for full examination is made, the IPI will, as under current law, only perform a limited substantive examination and not assess whether the claimed invention is novel and inventive.

The proposal of the preliminary draft to introduce a utility model as an alternative to a fully examined patent has been abandoned in the draft bill.

Mandatory search report

The draft bill provides for a mandatory search report on the state of the prior art for each patent application. The search report is intended to increase legal certainty and to allow a better assessment of whether the application meets the patentability requirements of novelty and inventive step. The search report will be published together with the application or as soon as possible thereafter. A request for full examination must be filed within six months of the publication of the search report.

Appeal proceedings before the Federal Patent Court

Under current law, appeals against IPI decisions in patent matters are brought before the Federal Administrative Court. Under the draft bill, such appeals will now be heard by the Federal Patent Court, which has the necessary resources and expertise to deal with technical questions.

Further, it is possible under current law to file post-grant oppositions against Swiss patents before the IPI. As such oppositions cannot be based on the grounds that the opposed patent lacks novelty or inventive step, there have been no opposition proceedings since their introduction in 2008.

The draft bill proposes to abolish opposition proceedings. Instead, third parties may, under certain conditions, appeal the IPI decision to grant a patent. In this regard, the following aspects are particularly worth mentioning:

- The scope of the appeal proceedings will be limited to the scope of the examination by the IPI. Hence, appealing a patent grant decision on the grounds of lack of novelty or inventive step requires that a request for full examination has been filed with the IPI in due time. However, such request does not need to have been filed by the appellant.
- Appeals have suspensive effect by default. Therefore, unless the Federal Patent Court revokes the suspensive effect, the patent in dispute cannot be enforced during appeal proceedings. This results in a significant disadvantage for patentees. Currently, an opposed Swiss patent, much like an opposed European patent, can be enforced in Switzerland.
- The deadline for third parties to file an appeal is four months. This is rather short compared to the nine

months to file an opposition against a patent under current Swiss law or before the European Patent Office.

- Under current Swiss law as well as before the European Patent Office, any person may file an opposition against a granted patent. By contrast, the appeal against an IPI decision to grant a patent is not an *actio popularis* (*Popularbeschwerde*). Rather, the right to appeal requires that the third-party appellant be specifically affected by the grant decision and have an interest worthy of protection. The same standard applies, for example, if a third party appeals an IPI decision to register a trademark and claims that the trademark should not have been registered due to absolute grounds for refusal. In this context, the Federal Administrative Court has held in the past that a mere competitive relationship between the appellant and the trademark owner is not sufficient for the appellant to be entitled to appeal (FAC B-2608/2019 – Hispano Suiza). Should the Federal Patent Court apply the same strict standard, the possibility of third parties to appeal IPI decisions to grant patents will be considerably limited. The circle of persons entitled to file an appeal would be even smaller than the circle of persons entitled to bring an invalidity action, which appears inconsistent.
- The draft bill introduces a new right of appeal for organisations. To be entitled to appeal a patent grant decision, the organisation must be active throughout Switzerland, pursue purely idealistic purposes, and the appealed patent needs to relate to a field of technology which has been covered by the organisation's statutory purpose for at least five years.

Use of the English language

The draft bill provides that English may be used extensively before the IPI. Application documents may be filed and published in English. If a patent is granted in English, only the title of the invention and the abstract need to be translated into an official Swiss language.

The Walder Wyss Newsletter provides comments on new developments and significant issues of Swiss law. These comments are not intended to provide legal advice. Before taking action or relying on the comments and the information given, addressees of this Newsletter should seek specific advice on the matters which concern them.

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