

Newsletter No.

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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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## Preliminary Draft for a Partial Revision of the Patents Act Published

On 14 October 2020, the Swiss Federal Council published the preliminary draft for a partial revision of the Patents Act and opened the public consultation procedure on the proposed bill. The revision's purpose is to modernise the Swiss patent system and adapt it to international standards. At the same time, the patent system shall be made more attractive for SMEs and individual inventors. The consultation period runs until 1 February 2021.

The preliminary draft provides for major changes in the Swiss patent system. The key aspects of the proposed revision are as follows:

### Full examination of Swiss patent applications

Under the current law, the Swiss Federal Institute of Intellectual Property (IPI) does not examine the core patentability requirements of novelty and inventive step of patent applications. As a consequence, a Swiss patent, once issued, often involves legal uncertainty with regards to its validity and enforceability. Many patent applicants therefore choose to obtain a fully examined European patent via the European Patent Office. Under the proposed revision, the IPI will, in line with international standards, examine patent applications for all patentability requirements, including novelty and inventive step. The Swiss patent will thus become a fully examined alternative to a Swiss part of a European patent.

### Post-grant oppositions on the merits

Under the current law, it is already possible to file post-grant oppositions against Swiss patents before the IPI within nine months of the grant. However, an opposition cannot be currently based on the grounds that the opposed patent lacks novelty or inventive step. Under the proposed revision, oppositions on the merits may be filed as well. Further, the IPI may also examine opposition grounds that have not been raised by the opponent, and it may even proceed with the opposition ex officio if the opposition is withdrawn.

### Introduction of utility models

The preliminary draft provides for a new form of protection for inventions by introducing utility models (often called "petty patents" or "small patents"). The term of protection will be limited to ten years. The protection requirements for a utility model will be the same as for a patent, except that utility models will not be available for certain types of inventions (such as pharmaceutical and chemical substances, biotechnological inventions or processes). Hence, the standard for novelty and inventive step for patents will apply to utility models as well. However, novelty and inventive step will not be examined by the IPI in the grant procedure.

The proposed dual system with a fully examined patent, on the one hand, and a

cheaper and quicker utility model, on the other hand, will allow innovators to better tailor their IP strategy to their needs and resources.

The proposed revision also allows procurement of both a patent and a utility model for the same invention. This may be of interest in particular to applicants who would like to obtain a patent with a twenty-year term of protection but wish to enforce the exclusive right to use the invention before the patent is granted, which is not possible under current Swiss patent law. Given the different scope of the pre-grant examination (i.e. full examination of patents and limited examination of utility models), the utility model may be issued much earlier than the patent. An applicant may thus obtain and enforce a utility model pending grant of the patent.

The preliminary draft does not provide for oppositions against utility models. However, under the proposed revision, a cancellation procedure before the IPI will allow any third party to challenge utility models on all protection requirements, including novelty and inventive step. Such cancellation procedure against a utility model may be introduced at any time after the grant. In addition, a nullity action against a utility model may be brought before the Federal Patent Court.

Finally, like patents, utility models will qualify for the so-called "patent box" under Swiss tax law.

### English before the IPI

The preliminary draft provides that the English language may be used extensively before the IPI. Translation requirements will be further limited.

### Appeal proceedings

Appeals against decisions by the IPI will continue to be heard by the Federal Administrative Court, not the Federal Patent Court, which is specialised in patent matters and has the necessary resources and expertise to also handle technical questions. Given the proposed extended scope of examination and the opposition proceedings for patents and the cancellation proceedings for utility models, all covering novelty and inventive step, the Federal Administrative Court will require increased technical expertise to deal with such appeals.

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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