“Self-adhesive tape” – You better limit your Swiss patents in good time

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The juxtapositon of patent limitations in national nullity proceedings and before national patent offices on the one hand and according to article 105a EPC on the other hand is a hotly debated issue not only in Switzerland.

In a recently published decision of 2 June 2014 (4A_541/2013), the Swiss Federal Supreme Court had to decide – inter alia – whether the limitation of the European Patent 1 508 436 according to article 105a EPC which only took place after the revocation of the Swiss portion of the patent by the Federal Patent Court must still be taken into account.

In brief, claimant requested the nullity of EP 1 508 436 before the Swiss Federal Patent Court.

The patent relates to a self-adhesive tape with stepwise removable cover film for closing, sealing and adhering joints.

During proceedings before the Federal Patent Court the patentee limited the claims of its patent several times. At the oral hearing, patentee submitted a new version as the result of a centralized limitation before the EPO in accordance with article 105a EPC. Nonetheless, the FPC revoked the Swiss part of EP 1 508 436 in its judgement of 17 September 2013 due to lack of novelty/inventive step (German version only).

The patentee appealed this decision before the Swiss Federal Supreme Court. Appellant raised various objections pertaining to substantial violations of procedural law and objected that the Federal Patent Court had wrongfully construed the subject-matter of the patent in suit. The Supreme Court did not agree.

The patentee also argued that it had requested a second centralized limitation of the patent according to article 105a EPC. This limitation was initiated only after the revocation of the patent by the Federal Patent Court and the limitation was published by the EPO during appeal proceedings before the Federal Supreme Court.

The patentee argued that this limitation should also be taken into account by the Federal Supreme Court. However, the Federal Supreme Court refused to consider the new wording of the patent due to procedural reasons.

According to the Federal Supreme Court new facts that occur only after the issuance of the attacked decision by the Federal Patent Court must not be considered by the Federal Supreme Court. This applies all the more in the case at hand because the limitation of EP 1 508 436 could (and should) have been initiated by the patentee during nullity proceedings before the Federal Patent Court.

Hence, the Supreme Court concluded that the second limitation of EP 1 508 436 according to article 105a EPC must not be taken into account (see considerations 1.1 and 2.4 of the Supreme Court’s decision).

As Mikhail Gorbachev mentioned in East Berlin in 1989, “those who are late will be punished by life”.