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Public prior use: Swiss Federal Patent Court partially revokes/upholds EP 0 944 937 B1 – Any doubts beyond reasonable doubt?

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Swiss Federal Patent Court, [Case No O2013_006](#) (7 October 2015)

The Swiss Federal Patent Court partially revoked/upheld the Swiss Part of [EP 0 944 937 B1](#) concerning a hydraulic pressing device in nullity proceedings initiated by the Swiss Von Arx AG against the patent owner, the German Gustav Klauke GmbH.

The patent in suit pertains to a hydraulic pressing device with an automatically actuating return valve for the hydraulic oil.

The only independent patent claim of EP 0 944 937 B1 originally read as follows:

Hydraulic pressing device (2) having a stationary part (26) and a moving part (24), the moving part (24) being moved relative to the stationary part (26) by means of a hydraulic piston (9) and being moveable by means of a return spring return into an initial position, wherein the return stroke is releasable in dependence on a predetermined pressing pressure by actuation of a return valve, characterized in that the automatically actuating return valve is built such that it is maintained in the open position during the entire return stroke of the hydraulic piston.

EP 0 944 937 B1 was challenged in EPO proceedings by other parties than those involved in the Swiss nullity proceedings. The patent was finally upheld by the competent Board of Appeal as granted (see [T 0861/05](#) dated of 19 June 2007:

One of the opponents in the EPO proceedings asserted that it had sold pressing devices disclosing all features of the patented invention to a third party prior to the priority date but the Board of Appeal concluded that those sales were part of R&D cooperation between the opponent and said third party. According to the Board of Appeal only prototypes were delivered by the opponent to the third party and those prototypes served for the development of bolts that were compatible with the pressing device. According to the Board of Appeal such cooperations are usually the subject of an (implicit) confidentiality obligation and it therefore dismissed the prior use argument.

In the Swiss nullity proceedings the plaintiff Von Arx AG asserted that it sold not only prototypes but more than 1,000 novelty destroying pressing devices prior to the priority date of the patent in suit. With regard to the factors that have to be proven to establish prior use the Swiss Federal

Patent Court ruled as follows:

When assessing public prior use one has to distinguish between the process or activity which allegedly disclosed the relevant (i.e. novelty destroying) item to the public and the question whether this item actually discloses the technical teaching of the concerned invention.

According to the Federal Patent Court the party who asserts prior use has to prove (i) who disclosed (ii) which technical teaching (iii) to whom (iv) when, and (v) under what circumstances. Similar factors are applied by the EPO when it comes to the assessment of public prior use (see [Guidelines for Examination in the EPO, Part G – Chapter IV-7.2](#)).

According to the case law of the EPO Board of Appeal one has to consider that although the standard of proof is the same for all objections covered by Art. 100 EPC (Grounds for opposition), the case law identifies two levels or standards of proof to be applied with regard to disputes around public prior use – either the “balance of probabilities” or “up to the hilt”. The standard of balance of probabilities is applicable when both the patent proprietor and the opponent had access to the material of which public prior use is alleged (see e.g. [T 363/96](#), [T 12/00](#), [T 1105/00](#), [T 2043/07](#)). By contrast, in cases where all evidence in support of an alleged public prior use lies within the power and knowledge of the opponent, while the patentee has barely any or no access to it at all, it is incumbent upon the opponent to prove the alleged prior use up to the hilt ([T 472/92](#), [T 782/92](#) referring to proof “beyond any reasonable doubt”). Subsequent case law also confirmed that, where public prior use is cited, the assessment of probability which normally underlies the boards’ opinion must yield to a stricter criterion close to absolute conviction ([T 97/94](#); see also [T 848/94](#) and [T 12/00](#)).

The Federal Patent Court defined the required standard of proof as follows: Absolute certainty or absolute conviction is not required. However, no reasonable doubts about the asserted facts must remain. Since in Swiss nullity proceedings the patentee had no access to the asserted sales documents that were filed in support of plaintiff’s prior use arguments it remained open whether the Swiss Federal Patent Court would apply a lower standard of proof if patentee had sold the allegedly novelty destroying items.

As a result, the Swiss Federal Patent Court accepted the prior use and partially invalidated the Swiss part of EP 0 944 937 B1. The patent was upheld in amended form.

The amended independent patent claim reads as follows:

Hydraulic pressing device (2) having a stationary part (26) and a moving part (24), the moving part (24) being moved relative to the stationary part (26) by means of a hydraulic piston (9) and being moveable by means of a return spring return into an initial position, wherein the return stroke is releasable in dependence on a predetermined pressing pressure by actuation of a return valve, characterized in that the automatically actuating return valve (1) is built such that it is maintained in the open position during the entire return stroke of the hydraulic piston (9) and that the return valve (1) exists of a valve piston (3), wherein the valve piston is formed with a valve piston surface (4, 5), wherein a partial piston surface which is effective in the locking status is designed with respect to the desired maximum pressure, wherein the smaller partial valve piston surface being effective by being linked by a bore hole with the bore diameter with the pressure chamber (6) during the pressing action of the hydraulic pressing device (2) is pressurized by the oil and which upon exceeding a through the bore diameter predetermined height of the oil pressure of the valve

piston (3) of the return valve (1) is raised above the part of the piston surface from the sealing seat, after which a much larger piston surface comes into effect, further wherein the return valve (1) works in this position with a considerably lower pressure limit than in the closed position, since the pressure limit in this position is no longer defined by the partial piston surface, but rather by the total surface (5) of valve piston (3) which is embodied as a spool piston and the valve piston (3) over the entire return of the hydraulic piston (9) as a result of the oil pressure acting on the valve piston (3) remains in the open position.

Interestingly, the Swiss Federal Patent Court followed neither the preliminary technical opinion of the Judge Rapporteur (which does not happen often) nor the decision of the German Federal Patent Court.

In parallel German nullity proceedings before the German Federal Patent Court the German part of EP 0 944 937 B1 was also upheld in amended form but with different claims (see [decision 6 Ni 47/14 \(EP\)](#) dated of 3 December 2014). The Swiss Patent Court discussed the German decision and decided not to follow it. The Swiss Federal Patent Court granted patentee's second auxiliary request while the Swiss Judge Rapporteur in his preliminary technical opinion and the German Federal Patent Court requested additional limitations.

This decision once again confirms that the Swiss Federal Patent Court is keen on dealing with foreign court decisions and usually explains why it follows or disagrees with those judgements. Not surprisingly, the Swiss Federal Patent Court would like to learn about foreign decisions that concern the same subject as soon as possible. Therefore, the Swiss Federal Patent Court made clear in the case at hand that the parties are requested to inform the Court continuously about foreign judgments. Such submissions will be considered even if they were filed unsolicitedly. This does not apply to submissions containing other facts or legal allegations. For example, one of the plaintiff's unsolicited submissions was declared inadmissible because the plaintiff did not sufficiently demonstrate why it would not have been possible to submit the new evidence together with its second brief if plaintiff would have applied the required care and diligence.

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