

Swiss Patent Office clarifies applicability of new Medeva approach to the examination of SPCs

Kluwer Patent Blog
November 7, 2018

Alexa von Uexküll, Oswin Ridderbusch (Vossius & Partner)

Please refer to this post as: *Alexa von Uexküll, Oswin Ridderbusch, "Swiss Patent Office clarifies applicability of new Medeva approach to the examination of SPCs", Kluwer Patent Blog, November 7 2018, <http://patentblog.kluwerplaw.com/2018/11/07/swiss-patent-office-clarifies-applicability-of-new-medeva-approach-to-the-examination-of-spcs/>*

The Swiss Patent Office issued a brief notice regarding a change of practice in the granting of supplementary protection certificates (SPCs) as well as corresponding detailed information on 22 October 2018. Following the Swiss Federal Supreme Court's judgment 4A_576/2017 of 11 June 2018 relating to the SPC for Truvada, the requirement under Article 140b(1)(a) Swiss Patent Act that the product of an SPC must be "protected" by the basic patent is no longer assessed using an "infringement test". Instead, as summarized by the Swiss Patent Office, "it is essential that the product is detailed in the patent claims in a form recognizable for a person skilled in the art". Switzerland thereby intends to follow the approach established by the CJEU in *Medeva* (C-322/10) and subsequent decisions.

The Swiss Federal Supreme Court in 4A_576/2017 already made it clear that this change of practice does not have retroactive effect, so that the "infringement test" remains applicable to earlier granted SPCs. What the Court did not explicitly address, however, is how SPC applications that were already pending but not yet granted on 11 June 2018 should be dealt with.

Welcome clarification has now been provided by the practice notice of the Swiss Patent Office, which sets out that also SPC applications that were already pending on 11 June 2018 have to be examined under the new approach in line with *Medeva*.

In a circular letter of the Swiss Patent Office dated 22 October 2018, this is justified as resulting from the general principle of immediate applicability of Federal Supreme Court decisions, considering also that the Federal Supreme Court in 4A_576/2017 discusses the principle of the protection of legitimate expectations only in relation to granted SPCs but not pending SPC applications, and that the Court has not made use of its authority to establish a transitional regime for pending cases.

The Swiss Patent Office has also provided an [update to its Examination Guidelines](#) and corresponding [case studies](#) (in German), which provide detailed guidance and illustrate how the new *Medeva* approach should be applied in Switzerland.

Dr. Alexa von Uexküll and **Oswin Ridderbusch** are the editors of the new handbook "*European SPCs Unravelling: A Practitioner's Guide to Supplementary Protection Certificates in Europe*" published by Wolters Kluwer.