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Swiss Federal Supreme Court clarifies consequences of amendment of patent claim under the former Patent Act

Simon Holzer (MLL Meyerlustenberger Lachenal Froriep Ltd.) · Sunday, November 27th, 2011

In a recently published [decision](#) the Swiss Federal Supreme Court clarified some particularities of the former Swiss Patent Act regarding the amendment of patent claims during prosecution proceedings.

Under the Swiss Patent Act in force until 1 July 2008, applicants who applied for the grant of a Swiss patent were allowed to extend the scope of their applications, for example by removing a feature that was originally contained in the patent claim as initially filed. If, however, the amended claim extended beyond the subject-matter of the patent application, the filing date had to be changed to the day on which the amendment was requested.

The former article 58 (2) of the Swiss Patent Act (in force until 1 July 2008) read as follows:

“Where the subject matter of the modified application goes beyond the content of the documents originally filed, the date on which the documents describing the invention claimed are filed shall be considered the filing date; in such case, the original filing date shall lose all legal effect.”

This system protected the applicant from having to file (and pay for) a new application if he wanted to extend the scope of its patent claims even beyond the original subject-matter.

In a decision rendered on 21 July 2011 the Swiss Federal Supreme Court clarified what the consequences are if the applicant amended a patent claim and the Swiss patent office was of the opinion that the amended claim did not extend beyond the subject-matter of the patent application as initially filed but in a lawsuit pending years later before a Swiss civil court the competent judges do not share this view and come to the conclusion that the amended claim extends beyond the initial subject-matter.

In such a case the filing date of the concerned invention does not change retroactively but the patent claim in dispute is null and void. This means that there is no need to check whether the postponement of the filing date to the date when the amendment was requested generates new prior art that could be crucial for the validity of the concerned patent claim.

While it was possible under the former law to extend the scope of a patent claim during

prosecution proceedings even beyond the scope of the subject-matter of the initial patent application the concerned patent is held invalid if this question arises only after the grant of the patent.

Per 1 July 2008 the Swiss Patent Act was amended and today it corresponds to Article 123 (2) EPC. According to the [new wording of article 58 \(2\)](#) of the Swiss Patent Act the patent application must not be amended in such a way that its subject-matter extends beyond the content of the application as filed.

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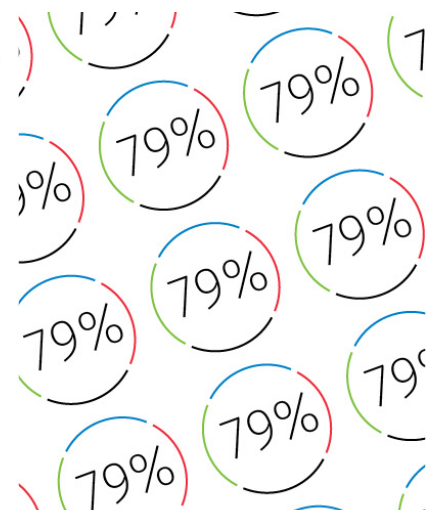
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This entry was posted on Sunday, November 27th, 2011 at 11:37 am and is filed under [G 1/93](#), [OJ 1994, 541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and*

unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).“>Amendments, Switzerland, Validity

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