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First Decision of Swiss Federal Supreme Court concerning pre-trial taking of evidence in patent matters (BGE 4A_532/2011)

Simon Holzer (MLL Meyerlustenberger Lachenal Froriep Ltd.) · Monday, May 7th, 2012

The Swiss Federal Supreme Court rendered its first decision regarding the new pre-trial taking of evidence proceeding in Switzerland's new Code of Civil Procedure Law (ZPO) and in the Swiss Patent Act (PatG). More than a few patent practitioners feared that the Federal Supreme Court would confirm the challenged decision of the Court of Commerce of the Canton of Aargau. This would have been the end of pre-trial taking of evidence in patent matters. The Federal Supreme Court rendered a judgement of Solomon.

Article 158 of the new Code of Civil Procedure (in force since 1 January 2011) and article 77 of the Swiss Patent Act both provide pre-trial discovery measures.

While Article 158 ZPO allows such measures if the applicant can prove that he has a legal interest worthy of protection the version in dispute of Article 77 PatG (as in force until 1 January 2012) required that the applicant makes plausible that his patent rights are infringed.

The Court of Commerce of the Canton of Aargau decided in the case at hand that in patent matters only Article 77 PatG and its more severe requirements shall apply and that Article 158 ZPO should not be available in patent proceedings. On appeal, the Swiss Federal Supreme Court rejected this opinion and hold that Article 158 ZPO also applies in patent matter, without any additional requirements.

The facts of the case can be summarized as follows:

A German patent holder suspected that a Swiss company supplied a Swiss refuse incineration plant with parts and, therefore, was to be held liable for contributory patent infringement because the Swiss plant and the used methods met all the features of the patent in dispute.

To avoid a long and expensive lawsuit, the German patent holder asked the Commercial Court of the Canton Aargau for a pre-trial inspection of the plant.

The Commercial Court of the Canton Aargau refused to arrange the requested pre-trial discovery inspection and decided that under article 158 ZPO as well as under Article 77 PatG the applicant has to make plausible that its patent rights are infringed. This is hardly possible since the applicant normally lacks sufficient evidence and, therefore, asks for the pre-trial taking of evidence.

The German Patent holder therefore appealed the decision to the Swiss Federal Supreme Court.

The Swiss Federal Court rejected the appeal because the Patent holder did not show that there was a contributory infringement even if the facts that came out of the pre-trial discovery corresponded to its allegations.

However, the Federal Supreme Court backed the appellant's opinion according to which the decision of the Cantonal Court of Aargau was wrong as it requested that the appellant had to make plausible that all the features of its patents were fulfilled by the litigious device that should be the object of the pre-trial inspection.

According to the Federal Supreme Court, it is sufficient that if a party who wants to rely on article 158 ZPO shows that if the alleged facts correspond to the party's allegations then its patent rights would be infringed.

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