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## Doctrine of Equivalents: Recent Developments in Switzerland

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Peter Ling

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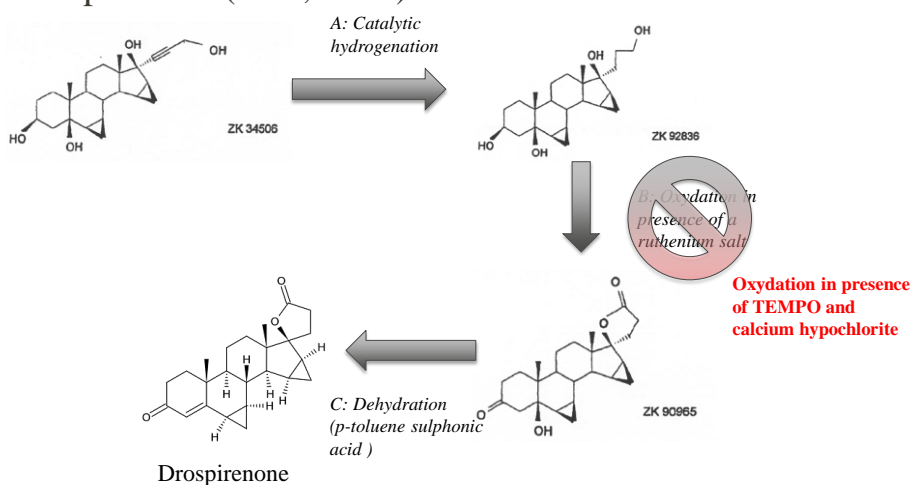
## Introduction

- › Federal Patent Court (2012-)
- › Statutory basis of equivalence
  - "imitation is also deemed to constitute use" (Art. 66(a) Patent Act)
- › Case law was scarce...
  - Federal Supreme Court 1998 – *Sigg v. Mägert* (BGE 125 III 29)
    - TWO questions:
      1. *Do the replaced features have the same objective function? (same effect)*
      2. *Are the replaced features and their same objective function obvious to a person having ordinary skills in the art on the basis of the teaching of the patent? (accessibility)*
- › ... until now

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## Drospirenone (FPC, 2013)



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## Drospirenone (FPC, 2013)

- › Swiss Federal Supreme Court: TWO questions
- › Germany
  - Schneidmesser I and II (GRUR 2002, 515 and 519)
    - 3<sup>rd</sup> question "are the considerations that the person skilled in the art applies drawn from the technical teaching of the patent claim (so that the person skilled in the art took the modified embodiment into account as being an equivalent solution)?"
- › UK
  - Improver v. Remington (R.P.C. 1990, 181; GRUR Int. 1993, 245)
    - 3<sup>rd</sup> question "Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention?"

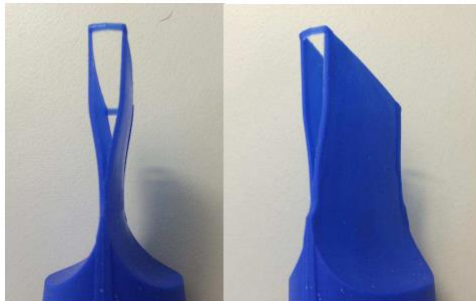
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## Drospirenone (FPC, 2013)

- › Third question → legal certainty of third parties
- › Should understand what is allowed and what is not by reading the patent specification
- › Foreign decisions to be taken into account → unified case law for EP
- › 3<sup>rd</sup> question under Swiss patent law:
  - *After reading the wording of the claim in light of the description, would a person having ordinary skills in the art consider the replaced features as a solution of equal value? (equal value)*

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## Urinal valve (FPC, 2016 / FSC, 2016)



and further comprising a component that is separate from the strip (6) providing a complementary surface against which the lower end of the flexible strip (6) may seal

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## Urinal valve (FPC, 2016 / FSC, 2016)

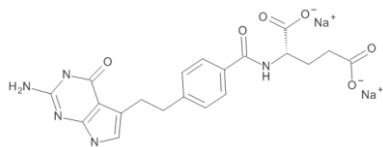
- › Precision of the case law regarding Question 2 (accessibility):
  - Starting point for the assessment of accessibility is not the general state of the art, but the patent in suit. Therefore it is not to be assessed whether the replaced feature is inventive in view of the state of the art. It is rather to be assessed whether, starting from the teaching of the patent in suit, it is evident for the skilled person that the replaced feature has the same effect.
- › Federal Supreme Court (on appeal)
  - Confirms 3-questions-test of equivalence
  - BUT: FPC misapplied the test
    - Additional features of infringing valve:
      - no influence on the solution as claimed
      - → obvious for the skilled person
    - 3<sup>rd</sup> question: based on claim, not description
      - Claim ≠ "separate on their full length"
      - Infringing valve = mostly separate → infringement

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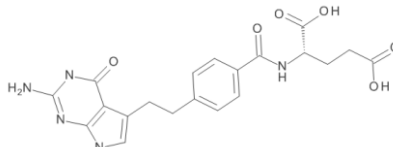
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## Pemetrexed (FPC, 2017)



Pemetrexed disodium



Pemetrexed diacid

## Pemetrexed (FPC, 2017)

- › PI denied (2016) / non-infringement confirmed in main proceedings (2017)
  - Prosecution: "antifolate" → "pemetrexed" → "pemetrexed disodium"
  - **Asserting a limitation accepted in prosecution as infringement under DoE?**
    - NOT part of the three-question-test
      - In particular NOT part of Question 3
      - Question 3 focuses on patent specification, not prosecution history
    - NOT prosecution history estoppel
      - But: "prosecution history cannot be entirely disregarded when interpreting the claims"
    - Abuse of law / venire contra factum proprium (Art. 2 SCC)

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## Pemetrexed (FPC, 2017)

- › PI denied (2016) / non-infringement confirmed in main proceedings (2017)
  - Alternatively:
    - Q1: yes, same effect when using P. diacid
    - Q2: yes, same effect is obvious for skilled person
    - Q3: no
      - Other components defined broadly in patent ("X or a pharmaceutical derivative thereof")
      - P. disodium defined narrowly
      - Skilled person understands this as an intentional limitation (in the patent specification)

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# Thank you!

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