Change of practice for granting supplementary protection certificates (SPCs)

The IPI is changing its practice for granting SPCs retroactively from 11 June 2018. This is based on the Federal Supreme Court decision 4 A_576/2017 “Tenofovir” of the same date.

In this judgment, the Federal Supreme Court (FSC) decided that the product to be protected must in future be detailed in the patent claims in a form recognisable for a person skilled in the art. This new practice is based on the European Court of Justice of the European Union’s (CJEU) more recent practice. The CJEU takes into account whether the product in the SPC application is specified in the claims of the basic patent (“Medeva”, C-322/10) or whether the patent claims implicitly yet necessarily and specifically relate to the active ingredient or active ingredient combination (“Eli Lilly”, C-493/12). With “Tenofovir”, the FSC departed from the old “Fosinopril” practice (BGE 124 III 375), which examined whether the product fell under the scope of protection of the basic patent (known as the infringement test).

Since 2014, the IPI has been working with the patent attorney associations (VESPA, ASPTA and VIPS), AIPPI Switzerland, affected industry associations (Interpharma, scienceindustries, vips and Intergenerika) and an external expert on adapting the practice on the basis of the new European case law. At the beginning of 2017, the research and generic pharmaceutical industry urged for a quick implementation of the adaptation. However, as an SPC had in the meantime been contested in court, which then led to the FSC decision “Tenofovir”, the old practice was retained for the time being.

The new practice applies retroactively from the date of the FSC’s decision, i.e. from 11 June 2018, and applies to all applications pending from this date, which was separately notified to the stakeholders in question. The change of practice will be implemented in Chapter 13.2.1 of the Guidelines for the substantive examination of national patent applications. It corresponds – without change – to the new jointly developed examination principles, which were communicated to all involved on 22
March 2017. To gain a better understanding of the new practice, the IPI and the involved stakeholders have developed hypothetical case studies.

For questions or further information, please contact Felix Addor (felix.addor@ipi.ch, 031 377 72 01) or Beatrice Stirner (beatrice.stirner@ipi.ch, 031 377 72 63).

DOCUMENTS & LINKS

- Guidelines – Chapter 13.2.1 (in German)
- Case studies of Guideline 13.2.1 (in German)