

Federal Patent Court highlights the importance of protective briefs

In a recent landmark decision, the Federal Patent Court underscored the critical role of protective briefs in preventing preliminary injunctions (PIs). The court reaffirmed its practice of rejecting PI requests without notifying the alleged infringer when a compelling protective brief is on file.

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For parties concerned about the potential for an ex parte preliminary injunction (i.e., an urgent injunction granted without first hearing the respondent) in a Swiss court, filing a protective brief serves as a key defensive measure. Protective briefs are designed to block ex parte PI requests. If successful, the ex parte request is rejected, and the alleged infringer is invited to submit a statement of defense. The court then reviews the PI request and ultimately renders a decision after considering arguments from both parties.

Protective briefs remain confidential and are not disclosed to the IP right holder unless an ex parte PI request is filed (as per Article 270(2) of the Swiss Code of Civil Procedure). In patent disputes, protective briefs are a cost-effective tool for preventing ex parte injunctions. However, as highlighted in a recent ruling, protective briefs can sometimes achieve more than their intended purpose under the Code of Civil Procedure.

In the case at hand, Helvepharm, a generics manufacturer, filed a protective brief to prevent an ex parte injunction against its generic product containing rivaroxaban. The relevant patent (EP 1 845 961) concerns a specific dosage regimen of rivaroxaban for treating thromboembolic diseases. Helvepharm's protective brief apparently challenged the patent's validity based on prior art.

Bayer, the patent owner, subsequently filed for an ex parte PI. The court not only denied the ex parte PI but also dismissed the entire PI request without requesting a statement of defense from Helvepharm. Based on the arguments presented in the protective brief, the court found the patent to be prima facie invalid for lack of inventive step.

According to publicly available information, Bayer has appealed the decision to the Federal Supreme Court.



Commentary

This decision highlights the power of protective briefs in effectively preventing ex parte PI orders and, in some cases, halting PI proceedings altogether. It also underscores the Federal Patent Court's rigorous approach to examining patent validity even at the preliminary injunction stage. The decision illustrates the speed and efficiency of Swiss patent litigation, with the court issuing a detailed 24-page opinion on patent validity just 14 days after receiving the PI request.

The upcoming appeal decision from the Federal Supreme Court will be closely watched, especially regarding concerns that the patent holder did not have an opportunity to respond to the arguments in the protective brief, potentially raising issues related to the right to be heard.

Overall, this case emphasizes the importance of protective briefs. Although protective briefs are common while ex parte requests are relatively rare – according to the Federal Patent Court's 2023 statistics, 77 protective briefs were filed compared to just eleven PI requests – their use as a proactive defense strategy continues to be invaluable in Swiss patent law.

Please do not hesitate to contact us if you have any further questions on this subject.

Legal Note: The information contained in this Smart Insight newsletter is of general nature and does not constitute legal advice.

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