



National Group: Switzerland

Title: Questionnaire Apotex Inc. v Sanofi-Aventis
Proposed AIPPI intervention – Supreme Court of Canada appeal

Contributors: Andri Hess, Marco Zardi

Date: June 5, 2014

Questions

A. Utility or industrial applicability requirement

1. Does your national law have a utility or industrial applicability requirement for patentability?

[Please just answer 'yes' or 'no'. If 'no', you do not need to answer the remaining questions.]

Yes

2. Please briefly describe the utility or industrial applicability requirement, including whether it is based on:
 - (a) statute;
 - (b) jurisprudence; or
 - (c) both.

(a) applies in Switzerland.

Art. 1 para. 1 of the Swiss Patent Act provides that “*Patents for inventions are granted for new inventions applicable in industry*”. There is no precise definition in the Swiss Patent Act of the expression “inventions applicable in industry”. However, in examining whether an invention is applicable in industry or not, three criteria are generally applied by the Swiss patent office (Guidelines for examination of Swiss patent applications, chapter 2.2):

- The invention must be suitable for the manufacture or use in a business of any kind, including industry and agriculture;
- the invention must be workable;
- the invention must be reproducible.

3. What must be disclosed in the patent specification to satisfy the utility or industrial applicability requirement? In particular, must the patent specification disclose:

(a) the utility or industrial applicability;

- (b) a basis (eg test data) to prove or demonstrate that the utility or industrial applicability is achieved; and/or
- (c) a basis (eg test data) and/or a line of reasoning from which the utility or industrial applicability may be predicted?

Industrial applicability must be *prima facie* evident in light of the type of the invention or result from the description (Art. 26 para. 6 of the Swiss Patent Regulation). This depends on the type of the patent claim (see Guidelines for examination of Swiss patent applications, chapter 2.2.1):

- If the claim is a product claim, suitability for the manufacture or use in a business is generally assumed.
- If a chemical product is protected by a product claim without indication of a purpose, industrial applicability must result from the description. If the chemical product claim names a specific property, the description must give an example of a use for which this specific property is relevant.
- If the claim is a process or use claim, suitability for the manufacture or use in a business is denied if only private use of the invention is possible.

4. Is the basis for any disclosure required in the patent specification:

- (a) statute;
- (b) jurisprudence; or
- (c) both?

[Please just answer (a), (b) or (c)]

(a)

B. Prosecution

5. Is it necessary to demonstrate utility or industrial applicability during prosecution?

[Please just answer 'yes' or 'no'. If 'no', you do not need to answer questions 6-8 but please answer question 9.]

Yes

6. Is the requirement to demonstrate utility or industrial application during prosecution based on:

- (a) statute
- (b) jurisprudence; or
- (c) both?

[Please just answer (a), (b) or (c)]

(a)

7. Is there a material date by which the utility or industrial applicability be demonstrated?

It must be demonstrated that industrial applicability was given as of the filing | priority date.

8. What evidence is required to demonstrate utility or industrial applicability? For example:

- (a) can post filing evidence be used; and/or
- (b) can the applicant rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

(a) and (b) apply in Switzerland.

C. Litigation

9. Is lack of utility or industrial applicability a basis for a validity attack in litigation?

[Please just answer 'yes' or 'no'. If 'no', you do not need to answer questions 10-12]

Yes

10. Is such attack permitted by reason of:

- (a) statute;
- (b) jurisprudence; or
- (c) both?

[Please just answer (a), (b) or (c)]

(a)

11. Is there a material date by which the utility or industrial applicability must be demonstrated?

It must be demonstrated that industrial applicability was given as of the filing | priority date.

12. What evidence may the patentee adduce in response? For example:

- (a) can post filing evidence be used; and/or
- (b) can the patentee rely upon the utility or industrial applicability being soundly predicted as opposed to demonstrated?

(a) and (b) apply in Switzerland.