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Swiss jurisdiction over a US patent
(Article by Thomas Widmer, LALIVE, Geneva, Switzerland)

[Decision of the Swiss Supreme Court 4A_442/2014](#)

A Swiss watchmaker company and an individual domiciled in Switzerland were in dispute regarding the ownership of an invention, which the individual filed as a US patent in his own name. The company took the dispute to court, claiming that it was (on a contractual basis) the genuine owner of the invention and requesting that the individual be ordered to perform all acts that are necessary to transfer the US patent in its favor.

This request raised the following issues of Swiss international private law.

Jurisdiction of Swiss courts with respect to intellectual property matters is governed - provided that no international conventions apply - by article 109 of the Swiss Private International Law ("PILA"). Article 109(1) PILA relates to jurisdiction over actions pertaining to the "validity or registration in Switzerland of intellectual property rights", whereas art. 109(2) PILA concerns jurisdiction over actions pertaining to the "violation of intellectual property rights".

The discussion before the Swiss Supreme Court focused on art. 109(1) PILA, and the questions were twofold. First, whether an action regarding the transfer of intellectual property rights fell into the scope of the "validity or registration" of such rights. Second, whether, taking into account the principle of territoriality, Swiss courts had jurisdiction over the validity or registration of intellectual property rights that are protected abroad.

The Swiss Supreme Court, in a decision dated 7 January 2015 (4A_442/2014), left these questions open and reasoned as follows:

The company had not requested the Swiss court to invalidate a US patent nor to amend the US patent registry, but merely to order the opposite party to perform all acts that are necessary to transfer a US patent. Such an order will only be subject, if not complied with, to criminal sanctions to be imposed by Swiss authorities.

In these circumstances, such a request falls out of the scope of art. 109(1) PILA and is not governed by any other specific provision of the PILA either. Jurisdiction is therefore to be decided in accordance with article 2 PILA pursuant to which, unless otherwise stated, Swiss courts at the (Swiss) domicile of the defendant have jurisdiction. The defendant being domiciled in Switzerland *in casu*, the Swiss Supreme Court affirmed Swiss jurisdiction.

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