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Court rules on presumption of patent validity and product's "embodiment" of patent

Westerberg & Partners Advokatbyrå AB | Intellectual Property - Sweden



LUDVIG HOLM



SIMON
FREDRIKSSON

> Facts

> Decision

> Comment

In the case discussed in this article,⁽¹⁾ the Patent and Market Court of Appeal delivered a clear decision on the presumption of a patent's validity and its scope of protection in relation to unclear and disputed features. In particular, the Court confirmed through its reasoning that if there is any uncertainty regarding a product's general availability on the market at the day of application, it cannot be enough to disprove the presumption. Additionally, the Court expanded on the possibilities to combine separate patents and products, as well as their relation to each other, in a party's claims.

Facts

The holders of a patent for a security strike plate claimed that their patent had been infringed and asked the Court to issue an information order. The defendant counterclaimed that the patent in question was invalid.

According to the defendant's petition, the patent was invalid on several grounds. Initially, the defendant claimed that two older patents had not been accounted for during patent prosecution. Further, the defendant claimed that the patented product lacked inventive step over publicly available products at the priority date.

While a granted patent is presumed to be valid, that presumption can be disproven through new evidence that was not accounted for in the prosecution procedure, or by deficiencies in the grant of the patent.

Decision

The Court commenced its assessment with the defendant's first claim that two patents, one Swedish and one Norwegian, had not been accounted for during prosecution. On this matter, the Court found that the patents had been accounted for, and it therefore constituted insufficient grounds to disprove the presumption at that preliminary stage of the proceedings.

The second claim was the more complicated in terms of its composition and was therefore broken up into two separate segments:

- First, the defendant claimed that a comparable product was generally available at the priority date, causing lack of inventive step.
- Second, the defendant claimed that a second product constituted an "embodiment" of the Swedish patent brought forth in the first claim.

According to the defendant, this second product on its own, in conjunction with the aforementioned Swedish patent or the first product, meant that the contested patent lacked inventive step.

The Court did not go into the rationale behind its ruling in any depth, but stated that it could not, from its current high-level analysis, be made sufficiently certain that the two products were publicly available on the priority date. It could, therefore, not be accepted that any of the claims made based on the products' public availability could disprove the presumption of validity.

Following the decision to preliminarily not question the patent's validity, the Court moved on to the question of whether patent infringement had occurred. That analysis found that a certain term used in the patent was unclear from the description and lacked a standard definition. As a result of the Court's analysis, the patent was considered likely valid, but unlikely to be infringed.

Comment

This ruling confirms, again, the strong presumption of validity in Swedish preliminary actions. The Court did not provide any abundance of explanation as to how or why the two products brought forward as novelty-destroying were not considered publicly available. It pointed out that the products' technical features did not, on their own, make it so that the presumption could be considered disproven, but it did not expand on this much further.

The Court's use of the term "contains such elements of uncertainty" regarding the product's public availability hints at the required level of evidence to negate the presumption. This choice of wording suggest that the Court aimed to confirm that disproving the presumption of validity requires clear and solid evidence.

For further information on this topic please contact [Ludvig Holm](#) or [Simon Fredriksson](#) at [Westerberg & Partners Advokatbyrå Ab](#) by telephone (+46 8 5784 03 00) or email (ludvig.holm@westerberg.com or simon.fredriksson@westerberg.com). The [Westerberg & Partners Advokatbyrå Ab](#) website can be accessed at www.westerberg.com.

Endnotes

(1) PMCA, PMÖ 11599-21.

