# Patent prosecution, what can go wrong and some future developments

Tony Rollins

# How prosecution can affect litigation under the patent – some examples

And the message is : - provide adequate fall back positions, control publications

# Some recent case law to bear in mind

- Neurim decision of CJEU – second medical uses can give rise to SPC's, make sure include suitable claim(s)
- Myriad decision in US – substances occurring in nature
- Lilly decisions in UK on place of business and file wrapper estoppel

# Future developments that could affect prosecution practice

- Unitary Patent/Unified Patent Court
- Patent Law Harmonisation
- Global dossier
- Common Citation Document

# Unitary Patent/Unified Patent Court

- Choice once new system comes into existance: national, EP (and?)/or Unitary Patent
- UPC should simplify procedures but still many unknowns, particularly cost and what happens on opt-out, but also still unresolved procedural issues, for example will court decide on all issues before it but only on one or some if this decides issue

# Patent Law Harmonisation

- Tegernsee process: next steps WIPO B+ group/IP5?
- Grace period
- 18 month publication (US)
- Prior use
- Conflicting applications

# Global Dossier

- IP5 initiative to agree common procedures
- Industry involved in meetings

# Global Dossier

- A set of business services including an integrated online web portal/interface allowing users to access all available information about patents/applications in the offices; confidential info limited to authorised persons.
- GD will enable communication and collaboration between applicants and examiners and between examiners in different offices facilitating increased quality, harmonization of office procedures, work sharing and acceleration of examination.

# Common Citation Document

- Originally Trilateral Initiative – proposed by industry
- Citations originally being entered from EPO/USPTO and JPO but now extended to SIPO and KIPO
- Plan is to have type of citation included (novelty, inventive step, etc.)

# Patent Harmonization Experts Panel

- IP5 harmonization initiative
- Topics proposed for consideration:
- Unity of invention
- Citation of prior art
- Written description/clarity/enablement/sufficiency requirements

# Going Forward

- Need to lobby for law and practice changes
- Both at industry and CIPA level