



Future of the Patent Profession

CIPA Informals Monday 25 July 2022

Hugh Dunlop, LL.M., EPA, CPA
Past Hon. Sec. CIPA Informals



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Thomas Jefferson, August 1813

- It has been pretended by some, (and in England especially,) that inventors have a natural and exclusive right to their inventions, [but] it is agreed by those who have seriously considered the subject, that no individual has, of natural right, a separate property in an acre of land, for instance. ... [It] is the property for the moment of him who occupies it.
- [An] individual may exclusively possess [an idea] as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. ... He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me.
- Inventions then cannot, in nature, be a subject of property. **Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according to the will and convenience of the society, without claim or complaint from anybody.**
- England was, until we copied her, the only country on earth which ever ... gave a legal right to the exclusive use of an idea. ... [Other] nations have thought that these monopolies produce more embarrassment than advantage to society; and it may be observed that the nations which refuse monopolies of invention, are as fruitful as England in new and useful devices



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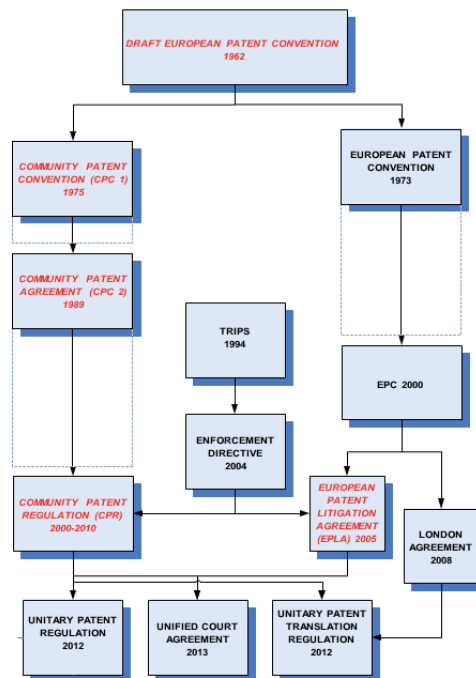
Brief History of Patent Law

- 1852 UK Patent Office established
- 1949 Patents Act
 - 16 year term from grant
 - Repealed in 1978 but continued to apply to existing patents well into the '90s
- EPC signed by 16 countries in October 1973
 - Came into force 7 October 1977
- 1977 Patents Act
 - Came into force 1 June 1978
- Copyright, Designs and Patents Act 1988
- America Invents Act
 - 16 September 2011



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The Road to the Unitary Patent and the UPC

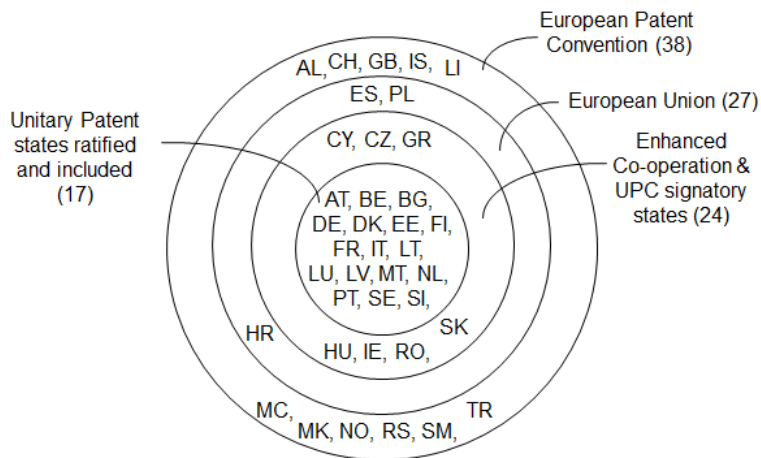


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Concentric circles of participation in EPC, EU and UPC



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Unified Patent Court will have Jurisdiction over “Standard” EPC Patents

- UPC jurisdiction will be non-exclusive for first 7 years
 - [Art.83](#)
- During this period, an action for infringement or for revocation of a European patent can still be brought before a national court.
 - This is not to say that a national court may revoke a European patent as a whole during this period
 - It merely means that the status quo may continue in relation to European patents (not Unitary patents)
- The seven-year period may be extended by a further seven years by the Administrative Committee upon conclusion of a review five years after the start of the system
 - [Art.83\(5\)](#).

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What's next?



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Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)

- Free trade agreement between Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, Peru, New Zealand, Singapore and Vietnam.
- UK Govt applied to join on 1 February 2021.
- Problem is that Art 18.38 requires a 12-month grace period under which self-disclosure does not destroy novelty in a patent.
- Incompatible with the EPC.
- Can we join the CPTPP without dropping out of the EPC?



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Statement from the UKIPO

- *“[The UK] will only accede to CPTPP on terms compatible with the UK’s broader interests and domestic priorities. The UK will ensure that accession negotiations with CPTPP are consistent with the UK’s interests and the Government’s policies and priorities, and with the UK’s existing international obligations, including the European Patent Convention.”*
- 22 June 2021



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Major Developments in Case law in the last 40 years

Selected by HCD



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Interpretation

- *Catnic Components Ltd. v. Hill & Smith* [1982] R.P.C. 18
 - “purposive” construction
- *Improver v Remington* [1990] F.S.R. 181.
 - Reduced *Catnic* to three questions
 - Applied in *Kirin-Amgen, Inc. v Hoechst Marion Roussel* [2004] UKHL 46)
- *Eli Lilly v Actavis* [2017] UKSC 48
 - Protocol of interpretation of Art 69 EPC, Art 2
 - For the purpose of determining the extent of protection conferred by a European patent, **due account shall be taken of any element which is equivalent** to an element specified in the claims.
 - Doctrine of Equivalents – Lord Neuberger



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Eli Lilly v Actavis

1. Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, **does the variant achieve substantially the same result in substantially the same way as the invention**, ie the inventive concept revealed by the patent?
2. Would it be obvious to the person skilled in the art, reading the patent at the priority date, but **knowing that the variant achieves substantially the same result as the invention**, that it does so in substantially the same way as the invention?
3. Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?



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Breadth of claim

- T 32/82 and T 115/83
 - Art. 84 EPC has to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define the object of the invention clearly, that is to say **indicate all the essential features thereof**.



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Breadth of claim UK

- *Biogen Inc v Medeva plc* HL [1997] R.P.C. 1
 - Prof. Murray of Edinburgh embarked on a method to produce DNA coding for HepB antigens
 - Claimed *A recombinant DNA molecule characterised by a DNA sequence coding for a polypeptide . . . displaying HBV antigen specificity . . . when a suitable host cell transformed with said recombinant DNA molecule is cultured*
 - “the specification must enable the invention to be performed to the full extent of the monopoly claimed.” - Lord Hoffman



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What may be next?

- Second medical use has almost run its course as far as the Courts are concerned
 - *Warner-Lambert v Generics* [2018] UKSC 56
 - Legislation is needed
- Plausibility pending before Enlarged Board G2/21
- Priority – G21 & G22
- Adjudication over “essentiality” of patents in standards has matured but is still a hot area and UK Courts may remain popular for global licensing deals
 - *Optis & Unwired Planet v Apple* [2022] EWHC 561 (Pat)



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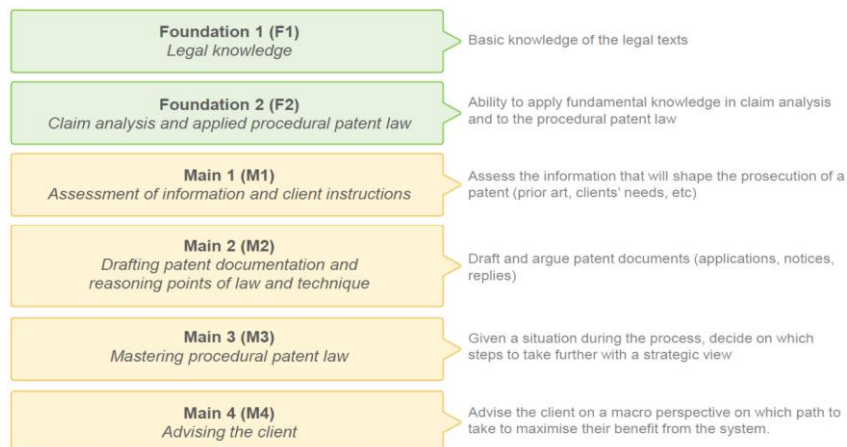
Future of the EQE

<https://www.epo.org/learning/eqe/new-eqe.html>



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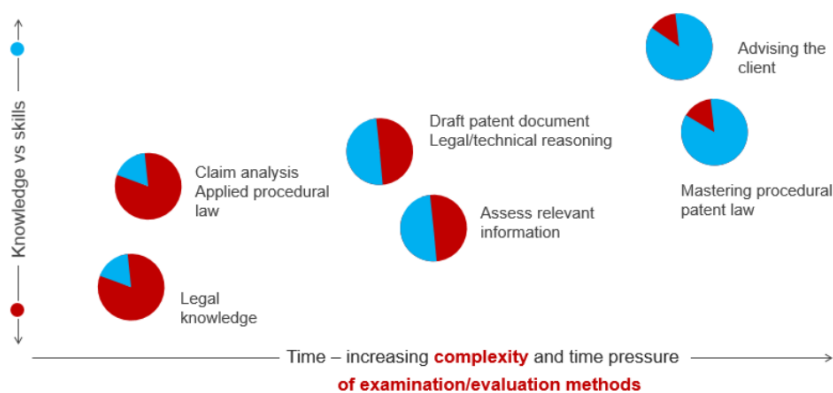
New EQE modules



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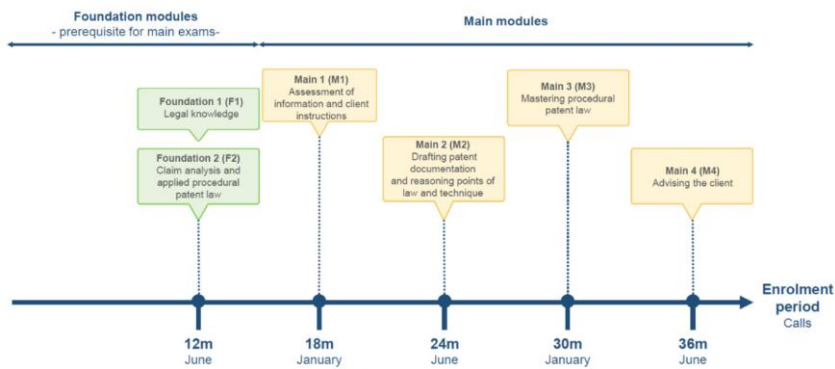
EQE Module Idea

Modules



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Proposed EQE Timeline



European Patent Litigators' Certificate



EPLC

- Not necessary if you are grandfathered onto the List of Representatives before the UPC
 - Need to be an EPA and have other “appropriate qualifications” such as QM Certificate.
 - Can be grandfathered up to 12 months from entry into force of the UPCA
- Otherwise, attend a 120-hour course at an accredited EU University
 - Paris, Strasbourg, Milan can all be held in English
 - 120 hours of study
 - Can be done in 4 long weekends + remote study



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Other available qualifications

- Higher Courts Litigators' Certificate
- Law Conversion Course
- Irish Trade Mark Agents' Examination
 - If you are an EU national
 - Gives a route to registration as a EUIPO Representative



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Keep up with the Law in Europe

- Even if you are not a UPC Representative and have no intention to become one, you will still need to advise clients
- Look out for further CIPA webinars on the Unitary Patent and the UPC
 - CIPA Webinar Tuesday 6 September 2022, 12:30 PM
 - looks at the injunction/damages/preliminary measures landscape in multiple national jurisdictions under the current regimes.
 - <https://www.cipa.org.uk/events/saisie-the-day-patent-infringement-remedies-in-europe/>



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About Maucher Jenkins



UK locations: London, Edinburgh, Farnham and Cambridge
International locations: Munich, Freiburg, Basel, Beijing and Shenzhen

