

CHAPTER 25

MAKING UP OF FILES

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25 FILE MAKE UP AND ASSOCIATED ACTIONS

PATENT CASES

Introduction

25.01 The A1 will record case details in the ledger, make up movement cards and where appropriate proceeding files, and create register entries.

Types of cases

25.02 The types of cases are as follows:

- Patents Form 2/77 - *inter partes* cases.
- Patents Form 15/77 - *inter partes* cases in respect of opposition to amendment (section 27), correction (section 117), surrender (section 29) and cancellation of licence of right (section 47).
- Patents Form 11/77 - correction (section 117) or amendment after grant (section 27).
- Patents Form 54/77 - correction of the translation of a European patent (UK) (Section 80).
- Patents Form 30/77 - cancellation of license of right proceedings (section 47).
- No form is required for a request to surrender a patent (section 29), amendment before the court (section 75) or a counterclaim for revocation before the court.
- Section 73(1) and 73(2) – Revocation on the initiative of the comptroller (no form involved).
- Patents Form 16/77 – Restoration cases

Initial Action

25.03 On receipt in Litigation Section of either a Patents Form 2/77 or Patents Form 15/77 and associated papers, the A1 should hand these to the B3 to carry out a cursory check. The papers will then be returned to the A1 to make up the file. For *ex parte* cases, a file is made up by the A1 after a cursory check by the A3 (*ex parte* team).

File make up

25.04 Files are made up slightly differently depending on the proceedings.

Inter partes cases

These proceedings files consist of:

- A NOPI green folder
- An OPI green folder marked surplus copies
- An OPI white binder with yellow inserts

An entry should be made in the *inter partes* ledger. The details of the case including the ledger reference number should be written on the covers of all three parts of the file. The parties are also named on the spine of the yellow binder. Index tabs are inserted in the NOPI green folder for OPTICS progress sheets, minutes, and confidential documents, together with the relevant documents. Index tabs are inserted into the yellow binder for statement, attachments to statement, counter-statement, attachments to counter-statement, decisions, and correspondence, together with the relevant documents. If the case is filed under section 40 or relates to a pre-publication patent application and has been filed under section 8, the inserts for the binder should be red not yellow, as such cases are NOPI. The surplus copies folder should be marked NOPI.

Section 13, section 75 before the court, counterclaim for revocation before the court

These proceedings files consist of:

- An OPI green folder
- An OPI green folder
- An OPI manila folder for correspondence

An entry should be made in the *inter partes* ledger for section 13 and 75, and in the *ex parte* ledger for counterclaims. The details of the case including the ledger number are written on the covers of the first two folders. Index tabs are inserted for section 13 cases. For section 75 and counterclaim for revocation, OPTICS and minutes sheets are placed in the first (NOPI) folder, the amendments or counterclaims and the court order in the second, and correspondence in the third folder.

Section 27 and section 117

These proceedings files consist of:

- An OPI manila folder headed Amendment of Specification and Correction of Clerical Error

Minute sheets should be placed on the patent file.

Section 29, section 47, section 73(1) & 73(2)

No proceedings files are made up. For these cases, the OPTICS printout, form and correspondence are placed on the main patent file.

Section 28 – Restoration cases

These proceedings files consist of:

- An OPI manila file for the Form 16/77 and correspondence
- A NOPI file for the minute sheets

Main patents file, Ledger, OPTICS, file movement card

- 25.05 Follow procedures in paragraphs 1.05 - 1.07.
- 25.06 Using the OPTICS function REG ENT (Menu no. 10), a free text entry is made, eg:

“Application for revocation under Section 72 filed on.....”

A list of free text entries is included in annex 1.

- 25.07 There is one exception to this; section 27 (application to amend specification): the OPTICS command REG FIL (Menu no. 11), is used. The form type and action are [11] [2]. The Journal entry should not be suppressed: “Y” should be inserted. This generates an automatic entry in the Journal.
- 25.08 When making up a file movement card, care needs to be taken as there are two types of card, one for *inter partes* cases (orange) and another for *ex parte* cases (white).
- 25.09 When the above actions have been completed, *inter partes* cases should be sent to the B3 and *ex parte* cases sent to the A3s.

DESIGN RIGHT CASES

- 25.10 The files are similar to the *inter partes* files for pre-publication patent applications under section 8 and section 40 because the whole file is NOPI (red cover to binder etc). However, special labels are attached to the front of the first green folder to indicate that the case relates to a design right matter and has been filed under the Copyright, Designs & Patents Act 1988.

25.11 The details of each case should be entered in the ledger and a reference number allocated. As with patent cases, a file movement card is made up, though no OPTICS actions are required.

EUROPEAN PATENT FILES

25.12 In order to check whether a European patent file already exists, you should check the patents register (OPTICS). Use the DIS FUL function.

Patent published in a foreign language

25.13 Where the patent is published in a foreign language, an English translation must be filed. The European Translations Section will have made up a file for the Patents Form 54/77 and translation. You should send for the file from Nine Mile Point by completing a file voucher.

Patent published in English – “file raised”

25.14 If the patents register shows the entry “file raised”, this mean that a file has been made up. You should send for the file from Nine Mile Point by completing a file voucher.

European Patent Files make up

25.15 If a European file has not been raised, you will need to create one as follows:

- Order a patent specification (B document) using the AD HOC document ordering system
- Complete a free text register entry “file raised” using OPTICS – REG ENT function
- Complete the details on the buff European patent file cover
- Insert the patent specification and a proceedings sheet

ANNEX 1

Free text entries for OPTICS

Section 8	“Reference as to entitlement under Section 8 filed on.....”
Section 10	“Request by joint applicants for directions under Section 10 filed on.....”
Section 12	“Reference as to entitlement under Section 12 filed on.....”
Section 13(1)	“Application for inventor to be mentioned under Section 13(1) filed on.....”
Section 13(3)	“Application for a person not to be mentioned as inventor under section 13(3) filed on.....”
Section 29	“Offer to surrender under Section 29 filed on.....”
Section 37	“Reference as to entitlement under Section 37 filed on.....”
Section 40	“Application by employee for compensation under Section 40 filed on...”
Section 46(3)	“Application to settle terms of licence of right under Section 46(3) filed on.....”
Section 47(1)	“Application by a proprietor to cancel a licence of right under Section 47(1) filed on.....”
Section 48	“Application concerning compulsory licences under Section 48 filed on....”
Section 71	“Application for a declaration of non-infringement under Section 71 filed on.....”

Section 72 "Application for revocation under Section 72 filed on....."

Section 80(3) "Application to correct a translation under Section 80(3) filed on....."

Section 117 "Application for correction under Section 117 filed on....."