

CHAPTER 25

MAKING UP OF FILES

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Annexes

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25 FILE MAKE UP AND ASSOCIATED ACTIONS

PATENT CASES

Introduction

25.01 The A1 will record case details in the electronic ledger, make up movement cards where appropriate, and proceeding files, and will create register entries. Where the case is already on PECS, the A1 should arrange with Index & Scanning for new documents received to be scanned into the dossier.

Types of cases

25.02 The types of cases are as follows:

- Patents Form 2 - *inter partes* cases.
- Patents Form 15 - *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 54 - correction of the translation of a European patent (UK) (Section 80).
- Patents Form 30 - cancellation of licence of right proceedings (section 47).
- Patents Form 16 – Restoration cases
- No form is required for: (a) request to surrender a patent (section 29); (b) amendment before the court (section 75); (c) a counterclaim for revocation before the court; (d) correction (section 117) or amendments after grant (section 27); (e) revocation on the comptroller's initiative sections 73(1) and 73(2)).

Initial Action

25.03 On receipt in Litigation Section of either a Patents Form 2 or Patents Form 15 and associated papers, the A1 should hand these to the B3 to carry out a cursory check. Where appropriate, the papers will then be returned to the A1 so that he can arrange for the documents to be scanned into PECS. The A1 will also make up a paper proceedings file for the case. EP and GB *ex parte* cases will be added to PECS after a cursory check by the A3 (*ex parte* team). Where appropriate, the A1 will obtain the patent file or a copy of the patent specification and will arrange for it to be scanned into PECS (see annexes 2 and 3). A PECS message will in due course be sent to the relevant case officer.

Inter partes cases

25.04 On return of the documents from the B3, the A1 should:

- Make a register entry to record the fact that proceedings have been filed.
- Use a green NOPI folder to make up a file containing the minute sheets.
- Complete the Index & Scanning form (see annex 3).
- Send documents with form to Index & Scanning.
(PECS action: Message to be sent to Inter Partes team; User = Case Officer; message = “see new F2” or “see new F15” as appropriate.)
- If the application/patent file is not a PECS case, obtain the file from NMP using the Litigation Request for file form DDU/P152/green or if the file is currently with another section use Form DDU/P152/yellow. The file should be sent to Index & Scanning along with the other documents.
- When sending documents to Index & Scanning, ensure that the correct public status is set. If there are confidential documents on file or the case has been filed, for example, under section 8 or section 40 of the act, place instructions on the Index & Scanning form to set the public status as NOPI.

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

25.05 An entry should be made in the electronic *inter partes* ledger for section 13 cases and in the *ex parte* ledger for counterclaims and section 75 cases before the court.

Main patents file, Ledger, OPTICS

25.06 The A1 should follow procedures in paragraphs 1.06 and 1.08 - 1.09 .

25.07 Using the OPTICS function REG ENT (Menu no. 11), 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.

25.08 When the above actions have been completed, messages on *inter partes* cases will be sent to the B2/B3 and messages on *ex parte* cases sent to the A3s.

DESIGN RIGHT CASES

25.09 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.

PECS Action: Ensure that the public status of each document is set to NOPI

25.10 The details of each case will be entered in the Design Right ledger by the B3 and an LIT reference number will be allocated. No OPTICS actions are required.

EUROPEAN PATENT FILES

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

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

PECS action: Arrange for the documents to be scanned into PECS by obtaining a corresponding LIT number from the spreadsheet.

25.13 Make a free text register entry to show the LIT number: LIT number is

European Patent Files not made up

25.14 If a patent 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
- Make a free text register entry: File raised – LIT number is [use OPTICS – REG ENT function]
- Arrange for the document to be scanned into PECS under the corresponding LIT number

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 under rule 10(2) for inventor to be mentioned filed on.....”
Section 13(3)	“Application for a person not to be mentioned as inventor under section 13(3) filed on”
Section 28	“Application for restoration 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.....”

Annex 2

DOCUMENT CODES

CODE	DESCRIPTION	CODE	DESCRIPTION
ADVERT AGNTL-LIT	Advertisement Agent's Letter	AMEN-LIT APPEAL	Amendments – Lit Appeal Notice
BDOC	B Pub Front page		
CONFLND CONFNPT CORRECT CRT-JDGMT CRT-ORDER CTRCLM-REV	Shorthand confirm London Shorthand confirm Newport Corrections Court Judgement Court Order Counter-claim for revocation	CDOC CERTIFICATE CNCLLND CNCLNPT CONFIDENTIAL	C Document/Spec Certificate Shorthand cancel London Shorthand cancel Newport Confidential/Offensive material
DECISION-LIT DESIGNNOPI	Decision Decision design NOPI	DESIGNOPI	Decision design OPI
EXPARTENOPI EXPARTENPT EXPARTEOPI	Decision ex parte NOPI Hearing ex parte Newport Decision ex parte OPI	EMAIL-LIT EOT-LIT EVID-LIT EXAM-REP-LIT EXPARTELND	Email EOT request Evidence Exam Report – Lit Hearing ex parte London
F2	Initiation of proceedings before the comptroller	F20 F30	Request to alter a name or address Cancellation of entry in register regarding

F15	Notice of opposition to proceedings before the Comptroller Application to restore a patent Request for opinion as to validity or infringement	F49 FILENOTE-LIT	availability of licences Caveat request File Note – Litigation
F16			
F17			
HEAR-TRANS	Transcript of hearing		
INITARRANGE INTERLND INTERNPT	Hearing initial arrangement Hearing inter partes London Hearing inter partes Newport	INTERPARTNOP INTERPARTOPI	Decision inter partes NOPI Decision inter partes OPI
JUDICIAL RVW	Judicial Review		
LETTER-LIT LICENCE	Letter sent by Litigation Licence	LITWARN	Inter partes warning sheet
MINUTE-LIT	Minute produced by Litigation		
N244	N244 Court application notice	NTC-OF-APP	Notice of Appeal
OBSERVATIONS	Observations	OPINION- LIT	Opinion - Litigation
PRELIM EVAL	Preliminary Evaluation	REDACTED	Decision redacted version

S117A	S117 date advert letter in PDJ	S72D	Court order acknowledged & records updated
S117B	S117 exam letter	S72E	Request copy of sealed order
S117C	S117 correction allowed	S73	Request for fresh spec
S117D	S117 request for evidence	S73(1)PL1	PL1
S117E	EPO opposition outstanding	S73(1)PL2	PL2
	S27 date advert in PDJ	S73(2)PL3	PL3
	S27 date advert in PDJ negation	S73(1)PL4	PL4
S27A(I)	S27	S73(2)PL5	PL5
S27A(II)	amendments allowed.	S75A	Date advert in PDJ
S27B	S27 opposition period outstanding	S75B	Request update on proceedings
S27C	S27 exam letter	S75C	Comptrollers comments
	S27 EPO already actioned	S75D	Amend allowed
S27D	S27 copy fresh spec requested	S75E	Court order received & records updated
S27E	S27 retyped pages of spec requested	S75F	Applicants notice received records updated
S27F	S27 extension of time	S75G	Copy fresh spec requested
S27G	S27 filing of F11 & fee for amend	S75H	Extension of time
	Request details of any court action pending	S80(3)A	Exam letter
S27H	Date of advert in PDJ	S80(3)B	Translation accepted
S27I	Patent surrender accepted date	S80(3)C	British Library
S29A	Decision	SECTION13	Decision Sec13
	Date of advert in PDJ	SKEL-ARGS	Skeleton Arguments
S29B	Cancellation of LOR confirmed	STATE	Statement
		STATE-AMEN	Amended statement
		STATE-ATT	Attachment to statement
		STATE-OF-RSN	Statement of reasons
		STATE-SUP	Supplementary statement
		STATECTR	Counterstatement
		STATECTR-AMD	Amended counterstatement
		STATECTR-ATT	Attachment to counterstatement
		STATECTR-SUP	Supplementary counterstatement
		STDEC	Statutory Declaration

S29C	Initial acknowl. Initial acknowl. other side Request for update		
S29D S47A			
S47B			
S72A S72B			
S72C			
TELREP-LIT	Telephone Report	TRANS E	Spec correction allowed & noted trans filed.
TRANS B	Acceptance of translation filed	TRANS F	Correction allowed and trans will be published
TRANS C	Copy of corrected trans to British Library	TSOL	Letters from the Treasury Solicitor
TRANS D	Spec correction allowed & request to file trans		

ANNEX 3

REQUEST FOR INDEX AND SCAN GY19

Please provide all of the following information:

From:	Insert your name
Section:	Litigation
Extension:	Insert your contact number

Dossier (inc check digit):	
Doc Code:	
Doc Date:	
Number of Pages:	
Is this a fax copy?	

Team:	Insert 'Inter Partes'
User (if any):	Insert name of case officer
Message text:	Example: New F2

Does this need to be processed urgently?

YES

NO

Other instructions:

Include any instructions to annotate.