

CHAPTER 25

MAKING UP OF FILES

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25 FILE MAKE UP AND ASSOCIATED ACTIONS

PATENT CASES

Introduction

25.01 Messages will be sent to the A1's personal mailbox by Index & Scanning on a daily basis. The A1 should update the document codes before allocating the work to the relevant team within Litigation Section. If it relates to a new case the team should message the A1 so he can record the case details in the electronic ledger, annotate the front cover of the dossier, and proceeding files, and will create register entries. The A1 should message the team to inform them once this has been completed.

Where paper copies of documents are received in the office then the A1 should arrange for them to be scanned into PECS (see annexes 2 and 3).

Types of cases

25.02 The types of cases are as follows:

- Patents Form 2 and Form 4 - *inter partes* cases.
- Patents Form 15 - *inter partes* cases in respect of opposition to amendment (section 27(5)), correction (section 117(2)), surrender (section 29(2)) and cancellation of licence of right (section 47(6)).
- Patents Form 20 – Correction (section 117) – A Form 20 may not be filed when a correction has already been allowed at the EPO.
- 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
- Patents Form 17 – Request for an opinion

- 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 of a message relating to a Patents Form 2 or Patents Form 15 and associated papers, the A1 should update the ledger and message the B3's Inter Partes personal mailbox saying 'New Case'. Where appropriate, the A1 will obtain the patent file or a copy of the patent specification and will arrange for it to be scanned or imported into PECS (see 25.04 for further details). A PECS message will be sent by the B3 to the relevant B2 case officer.

Inter partes cases

25.04 On receipt of the message from the B3 the B2 will message the A1 to:

- 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.
- 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. If the file is an EP patent which is not at NMP see 25.14 for details.

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.

If the document filed is a Form 4 then a different procedure is used when making the REG ENT on Optics. After the A1 has made the free text entry instead of typing his authority in the following screen he should enter F4 and the date the form was filed instead.

- 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 by Index and Scanning. Make a free text register entry to show the LIT number:-

'LIT number relates to

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 PDD Filestore.

PECS action: Arrange for the documents to be scanned into PECS using the Litigation Request for file form DDU/P152/green.

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

European Patent Files not made up

25.14 If an EP patent has not been raised a copy of the granted specification should be electronically imported into PECS from the espacenet website. Carry out a number search on espacenet and click on the PDF copy of the published 'B' specification. Choose to save the full document to your desktop and then use the manual import function to import it into PECS (Doc Code – BDOC).

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 73(1) No entry necessary

Section 73(2) No entry necessary

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

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

Form 4 "Confirmation of continuation of proceedings under section(s) filed on (insert date Form 4 filed)"

OPPOSITIONS

Section 27(5) "Opposition to amendment under Section 27(5) filed on"

Section 29(2) "Opposition to surrender under Section 29(2) filed on"

Section 47(6) "Opposition to the cancellation in the register of a license available as of right under section 47(6) filed on"

Section 75(2) "Opposition to amendment under Section 75(2) filed on"

Section 117(2) "Opposition to a correction filed under Section 117(2) 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 DRF1 DRF 2 DRF 3 DRF 4	Decision design OPI Design right form 1 Design right form 2 Design right form 3 Design right form 4
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	F20	Request to alter a

F4	proceedings before the comptroller	F30	name or address
F15	Continuation of proceedings before the comptroller.	F49	Cancellation of entry in register regarding availability of licences
F16	Notice of opposition to proceedings before the Comptroller	FILENOTE-LIT	Caveat request
F17	Application to restore a patent		File Note – Litigation
	Request for opinion as to validity or infringement		
HEAR-TRANS	Transcript of hearing		
INITARRANGE	Hearing initial arrangement	INTERPARTNOP	Decision inter partes NOPI
INTERLND	Hearing inter partes London	INTERPARTOPI	Decision inter partes OPI
INTERNPT	Hearing inter partes Newport		
JUDICIAL RVW	Judicial Review		
LETTER-LIT	Letter sent by Litigation	LITWARN	Inter partes warning sheet
LICENCE	Licence		
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
	EPO opposition outstanding	S73(1)PL2	PL2
S117E	S27 date advert in PDJ	S73(2)PL3	PL3
		S73(1)PL4	PL4
		S73(2)PL5	PL5
S27A(I)	S27 date advert in PDJ negation	S75A	Date advert in PDJ
		S75B	Request update on proceedings
S27A(II)	S27 amendments allowed.	S75C	Comptrollers comments
		S75D	Amend allowed
S27B	S27 opposition period outstanding	S75E	Court order received & records updated
		S75F	Applicants notice received records updated
S27C	S27 exam letter		updated
	S27 EPO already actioned	S75G	Copy fresh spec requested
S27D	S27 amendmt	S75H	Extension of time
	S27 copy fresh spec requested	S80(3)A	Exam letter
S27E	S27 retyped pages of spec requested	S80(3)B	Translation accepted
		S80(3)C	British Library
		SECTION13	Decision Sec13
S27F	S27 extension of time	SKEL-ARGS	Skeleton Arguments
		STATE	Statement
	S27 filing of F11 & fee for amend	STATE-AMEN	Amended statement
S27G	Request details of any court action pending	STATE-ATT	Attachment to statement
		STATE-OF-RSN	Statement of reasons
		STATE-SUP	Supplementary statement
S27H	Date of advert in	STATECTR	Counterstatement

S27I	PDJ	STATECTR-AMD	Amended counterstatement
S29A	Patent surrender accepted date Decision	STATECTR-ATT	Attachment to counterstatement
S29B	Date of advert in PDJ	STATECTR-SUP	Supplementary counterstatement
S29C	Cancellation of LOR confirmed	STDEC	Statutory Declaration
S29D	Initial acknowl.		
S47A	Initial acknowl. other side		
S47B	Request for update		
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.