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WORLD INTELLECTUAL PROPERTY ORGANIZATION
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

GENEVA/GENÈVE

COMMITTEE OF EXPERTS OF THE IPC UNION
COMITÉ D'EXPERTS DE L'UNION DE L'IPC

IPC REFORM PROJECT FILE/DOSSIER DE PROJET DE RÉFORME DE LA CIB

SUBJECT:	ELABORATION OF RULES OF MULTIPLE CLASSIFICATION IN THE IPC AND INVESTIGATION OF POSSIBLE BEARING OF SUCH RULES ON GENERAL PRINCIPLES OF CLASSIFYING DISCLOSED IN THE GUIDE TO THE IPC
SUJET :	DÉFINITION DE RÈGLES APPLICABLES AU CLASSEMENT MULTIPLE DANS LA CIB ET ANALYSE DE L'INCIDENCE QUE POURRAIENT AVOIR CES RÈGLES SUR LES RÈGLES DE CLASSEMENT GÉNÉRALES QUI FIGURENT DANS LE GUIDE D'UTILISATION DE LA CIB

ANNEX/ ANNEXE	CONTENT/CONTENU		SEE/VOIR R 4/99	ORIGIN/ ORIGINE	DATE
1	Comments	Observations		US	15.04.99
2	Comments	Observations		IB	16.04.99
3	Comments	Observations		DE	03.05.99
4	Comments	Observations		GB	04.05.99
5	Discussion paper	Document de discussion		JP	17.05.99
6	Decision by IPC/REF/1 and follow-up	Décision de l'IPC/REF/1 et suite	Rev.1	IB	28.05.99
7	Discussion paper	Document de discussion	Rev.1	US	03.08.99
8	Discussion paper	Document de discussion	Rev.1	SE	26.08.99
9	Comments	Observations	Rev.1	EP	15.09.99
10	Comments	Observations	Rev.1	SE	20.09.99
11	Comments	Observations	Rev.1	SE	01.10.99
12	Comments	Observations	Rev.1	GB	25.10.99
13	Project coordinator report	Rapport du coordonnateur du projet	Rev.2	JP	13.11.99
14	Recommendations by the Trilateral Offices	Recommandations des offices de la coopération trilatérale	Rev.3	EP	14.03.00

ANNEX/ ANNEXE	CONTENT/CONTENU		SEE/VOIR R 4/99	ORIGIN/ ORIGINE	DATE
15	Decision by IPC/REF/3 and follow-up	Décision de l'IPC/REF/3 et suite	Rev.4	IB	05.05.00
16	Background paper	Document d'information	Rev.4	EP	16.08.00
17	Position paper	Document de synthèse	Rev.4	US	02.10.00
18	Excerpt from document IPC/REF/4/4	Extrait du document IPC/REF/4/4	Rev.5	IB	03.11.00
19	Modified Guidelines	Principes directeurs modifiés	Rev.5	US	05.01.01
20	Comments	Observations	Rev.5	US	20.03.01
21	Comments	Observations	Rev.5	CA	26.03.01
22	Comments	Observations	Rev.5	SE	02.04.01
23	Rapporteur report	Rapport du rapporteur	Rev.6	US	30.04.01
24	Comments	Observations	Rev.6	GB	10.05.01
25	Comments	Observations	Rev.6	GB	10.05.01
26	Comments	Observations	Rev.6	SE	11.05.01
27	Excerpt from document IPC/REF/5/3	Extrait du document IPC/REF/5/3	Rev.7	IB	18.05.01
28	Comments	Observations	Rev.7	GB	02.07.01
29	Comments	Observations	Rev.7	EP	02.07.01
30	Comments	Observations	Rev.7	US	30.07.01
31	Comments	Observations	Rev.7	US	30.07.01
32	Comments	Observations	Rev.7	US	30.07.01
33	Comments	Observations	Rev.7	SE	09.08.01
34	Rapporteur report	Rapport du rapporteur	Rev.8	US	28.09.01
35	Comments (re Annex 34)	Observations relatives à l'annexe 34	Rev.8	SE	22.10.01

ANNEX 34/ANNEXE 34

United States Patent and Trademark Office	
WIPO Reform Working Group	
Topic: Updating Guidelines for determining 'What' to Classify in Reform IPC	**Date: September 28, 2001**

RAPPORTEUR REPORT ON GUIDELINES FOR DETERMINING SUBJECT MATTER APPROPRIATE FOR OBLIGATORY AND NONOBLIGATORY CLASSIFICATION

Background

1. This paper is submitted in response to the request from the Reform Working Group found in their Report IPC/REF/5/3, Paragraphs 27 - 31 under the heading – General Principles of Classification; Elaboration of Rules for Multiple Classification in the IPC. In this paper Rapporteur has attempted to update and 'finalize' the draft version of the "Guidelines for Determining Inventive Subject Matter Appropriate for Obligatory and Nonobligatory Classification" submitted in the Annex of our previous Rapporteur Report on this topic (see Annex 23 of the project file IPC/R 4/99 Rev. 6). Comments, or in one case an extensive alternative proposal, on this previous draft version or the general topic have been made by GB (Annex 24), GB (Annex 25), SE (Annex 26), GB (July 12,2001), EP (dated 2 July 2001), three different US papers (all dated July 30, 2001), and SE (dated August 9, 2001).

2. Rapporteur has attached a modified proposal in the Annex of this paper. This proposal includes the definition of 'invention information' already adopted by the Committee of Experts as requested in paragraph 27 of IPC/REF/5/3. It has also been modified to specify how different types of patent documents should be classified.

3. Rapporteur has intentionally delayed submitting this report and the attached proposal so that the Trilateral Offices could also review the proposal at their last meeting (September 11 – 14, 2001). After reviewing the proposal, some additions and modifications (already incorporated by Rapporteur) were requested and they approved the modified proposal. Rapporteur believes that it is essential to have unanimous support among the Trilateral Offices for the proposal.

4. However, Rapporteur has not addressed in this Report the issue of creating "multi-aspect classification schemes" (see paragraph 28 & 30 of IPC/REF/5/3) or particular comments made in the above listed papers dealing with this or other 'where' topics. This issue was separately discussed at the last Trilateral Offices meeting and a separate report will deal with these related 'where' to classify issues. This report covers 'what' subject matter in patent documents is to be classified (the inventions) and not whether there is a specific place for each invention in the system ('where' to classify issue).

Comments

5. In situations where a particular Office has sent in several papers on this topic, Rapporteur has grouped each Office's comments together in this section as if they occurred in a single paper. I have done this to avoid confusing the Working Group by separately stating or addressing comments made by an Office in different papers that are merely repeated or in apparent conflict with each other. In any situation where an Office has made conflicting proposals that are not complementary to each other (could not be used together), I have chosen to state only their last suggested 'preferred' solution to a problem in this section.

6. GB's paper in Annex 25 covers only 'where' to classify issues and will be discussed in the other Report. In its Annex 24 paper, GB is concerned that the terminology 'state of the art' should be defined. The solutions proposed by GB deal with potential ways to determine the 'state of the art' from the subject matter in an application that is unsearched or not examined. GB's suggestions would be inappropriate for subsequently published related patent documents of any national family that actually determine the 'state of the art' by search. The solution GB envisions is accepting or interpreting applicants' statements on what is the 'state of the art' for their inventions found within their applications. In its paper mailed July 12th, GB further clarifies its previous attempts and expands its prior statements for determining the actual 'state of the art' based solely on the applications' disclosure.

7. SE's paper in Annex 26 covers mainly 'where' issues that will be discussed in the other Report. The main 'what' issue covered is again attempting to determine 'what' to classify based solely on the content of the disclosure of unsearched patent applications. SE states that the complete information about each invention contains the following elements: (a) state of the art, (b) the problem the invention solves, and (c) the novel contribution. SE additionally states that a search often will give a better indication of the 'state of the art' or a better understanding of the problems to be solved.

8. SE's paper dated August 9, 2001 is more of a philosophical discourse with an alternative proposal than the requested comments. It includes a 1st draft of an alternative solution to 'what to classify' incorporating all of their newly stated views without retention of any of the previously agreed to language of CE's definition or the proposal actually being commented on. SE asserts that claims are **not** relevant to determining the invention and should not be the focus of these Guidelines. SE thinks the Committee of Experts was wrong to use "addition to the state of the art" when defining the terminology 'invention information'. SE would like to define 'invention information' in an entirely different way. Their proposed definition is the same as the complete information of a patent document they stated in their other paper. This is what SE wants to classify and not the actual invention. One reason they feel this way is that, in their opinion, this is what the IPC classification schemes now provide for. SE also states that it is useless to give detailed instructions for non-obligatory classifications and that it should be entirely up to the examiners to determine when

they are useful. It is also SE's view that "claims are written primarily in order to make life difficult for the competitors of the applicant". SE also states that in some cases patent documents do not contain any novel information and in these situations classification should be based on the disclosure as a whole. Additionally, SE noted portions of the existing proposal that should be changed based upon the above statements. SE notes that their proposal is being made at a relatively late stage (3 years late), but thinks their proposed wide-ranging changes are now necessary.

9. EP believes that 'invention information' when it is defined should be used in the proposal instead of 'claims' in most situations since it is more general. EP states that what is considered 'invention information' changes for different publication stages of a single application. For granted patents the claims **are** invention information, for published applications normally the claims are the most important part of invention information – but some claims specify subject matter that is not novel and some novel subject matter may not be claimed. EP proposes a 5-step checklist for determining invention information at different stages of examination or publication. In these steps invention information is specified for granted patents (claims), searched patents (actual determined difference in state of the art in correct context), an experienced classifier review (what the expert estimates is the difference with prior art), mere review of the disclosure (what applicant states is the invention), and no review of the disclosure (claims). EP would classify only the information that would be needed for future searches. If the information were already present in other documents, it does not need to be classified (i.e., it is not invention information or useful).

10. EP also thinks that it is not useful to classify only the inventive step since this information must be found within useful context during future searches. For patent applications that seem to contain no real invention information, EP suggests classifying what applicant states as the invention. EP also believes that the terminology "obviously not novel" should replace "obviously not patentable" in the proposal, since patentable subject matter varies in different IPOs.

11. US' paper titled "Acceptable Multiple and Multi-aspect Classification in the Reformed IPC" covers only 'where' to classify issues and will be discussed in the other Report. In its comments on defining 'the addition to the state of the art', US agrees to support GB's request for the definition. In this report, Rapporteur will not cover the many statements made in this paper on only 'where' issues since these will be covered in another report. US does not believe that the defining of the terminology 'addition to the state of the art' will significantly impact the proposal of Annex 23. US states that claims when interpreted by the disclosure always specify the actual (when examined) or applicant's stated 'addition to the state of the art'. The US also states that normally a search into the 'state of the art' and an examination are required to accurately determine the novelty of any alleged inventions prior to usefully classifying them at the group level. In US' opinion, any classifications assigned to patent documents that are unexamined or not searched must be confirmed whenever the applications are later searched or examined. They believe that to ignore correcting any inaccurate previously assigned classifications in this situation would adversely impact future searches. US proposes that 'addition to the state of the art, be defined as "***Any 'novel***

and unobvious' subject matter (i.e., invention) specifically disclosed, and normally claimed, within a patent document that was not found by an IPO during a search of the collection of all technical 'things' that individuals in history have already placed within public knowledge (i.e., the prior art)." In their view, only patent documents that have not yet been searched could use alternative bases for their classifications until searches were completed.

12. US' paper titled "Acceptable Short-term Alternatives to the Addition to the State of the Art Standard for Obligatory Classifications" includes concepts very similar to EP's concept of using different standards for different levels of publication or searching. In fact it is merely a more detailed version of it. The primary difference between the two is that US views these variations as acceptable only as short-term transitional alternatives **whenever** additional refining of the knowledge of what is **actually** the 'addition to the state of the art' occurs in the future due to additional searching, examination, or classifier review. Failure to correct classification errors on previously published versions of the same application or to move these patent documents to classifications better covering the actual 'addition to the state of the art' is not acceptable to US. In US' opinion, for both unexamined and granted phases of the patenting process, the published claims represent essential information that must be correctly obligatorily classified. For any in-between intervening situations, the classifiers preexisting knowledge must be utilized to a much greater degree. The US recommended checklist also include a step for reviewing the prior classifications assigned to any legally abandoned applications. This was done to maintain search efficiency and reduce the overall cost of searching.

13. The Trilateral Offices discussed this issue at their last meeting. During this meeting they agreed to a compromise solution for both the 'what' and the 'where' issues. This compromise is:

    To alleviate stated concerns to the previously proposed US solution on 'where' and 'what' to classify, the Trilateral Offices have agreed on an alternative modified version of these policies. These modified policies provide potentially for plural obligatory classifications of an invention, or of an embodiment of an invention, as follows:

    (1) A classification based on inclusiveness and top-down precedence for the combination invention as a whole of each patent document will be assigned, and

    (2) additional classification(s) will be assigned based on a part or piece of a combination (i.e., a subcombination, anything less than the complete combination), if the part or piece

    1. is itself an addition to the state of the art*, or
    2. endows the combination with 'addition to the state of the art'* status, (e.g., incorporation of a known compound into a known medicinal composition unexpectedly increases the effectiveness of the composition, i.e., yields a new and unobvious result).

*In an application, what is classified is an *apparent* addition to the state of the art, as determined by the person classifying the application from a consideration of the application's total disclosure using its claims as a guide (see US proposed guidelines for " What to Classify").

The Trilateral Offices believe that adoption and proper implementation of this agreed to proposal will obviate the concern engendered by the former US proposal on 'where to classify' that specified one obligatory classification per invention as a whole. Furthermore, they hope that adoption of this proposal will eliminate the specter of indexing all parts of a combination invention. The Trilateral Offices share the view that such an indexing policy would be highly detrimental to a cost/effective and properly functioning Reformed IPC.

Rapporteur has included the 'what' portions of this compromise in the attached proposal. The 'where' to classify portions will be discussed in the other Rapporteur Report.

Rapporteur's Comments and Suggestions

14. Rapporteur has made the suggested modifications stated in the Reform Working Group's last report. Rapporteur has also incorporated the EP's suggested checklist for classifying different types of patent documents, as modified by the US (agreed to by the Trilateral Offices), into the attached proposal. Rapporteur has additionally included a legally acceptable definition for 'state of the art' (agreed to by the Trilateral Offices at their meeting) into the proposal to address the concerns of GB and SE. The GB and SE concept of using for the 'state of the art' the disclosure of unsearched patent documents was not included in this definition since many national patent laws specify a more conventional definition. However, EP largely incorporated this type of use of the disclosure into the checklist concept in select situations. Rapporteur has also put less emphasis on claims and more on invention information in the proposal as suggested by SE in their comments. SE's compatible concepts in their alternative proposal are also included in some manner within the checklist. However, since much of their alternative proposal is incompatible with the one being modified, other suggestions were not included. These concepts were not accepted at the Trilateral Office's meeting and would result in a conflict between the advanced level assignment practice and the core level assignment practice. The Guidelines in the Annex have been reviewed and approved by the Trilateral Offices.

15. In Rapporteur's opinion, there is no problem with PCT minimum documentation containing only the first publications of national limited families as SE suggested, but Rapporteur strongly disagrees with 'freezing' the classification of these documents. The finalized classification of first publications should always be based on the most accurate understanding of the actual 'addition to the state of the art'. Limiting classifications to the 'best guesses' of initial classifiers - based on the incomplete facts known at the time of initial classification - would harm the quality of all future searches. This would prohibit usefully modifying initial classifications based on more accurate knowledge gained at a later date - after search, review, or examination - of what is the actual invention information within the first publications. A database's ability to easily modify initial classification errors or increase the precision of classification without any significant increase in cost (i.e., changes are only made by those already doing additional work on the application and only when useful) to the IPOs doing these changes should be taken advantage of.

16. All the changes suggested by the Working Group, Trilateral Offices, and Rapporteur are included in the proposal in the Annex.

ANNEX

Guidelines for Determining Subject Matter Appropriate for Obligatory and Nonobligatory Classification (i.e., 'What' to classify within patent document disclosures)

DEFINITION OF TERMS

'Invention information' in a patent document is all technical information in its total disclosure (e.g., description, drawings, claims) that represents an addition to the state of the art; 'invention information' is determined using the claims of the patent document for guidance.

'Addition to the state of the art' means all 'novel and unobvious' subject matter specifically disclosed, and normally claimed, in a patent document, which subject matter was not found by an IPO during its search of the prior art (i.e., the collection of all technical 'things' that have already placed within public knowledge).

'Obligatory classification' is any classification that provides for 'invention information' subject matter in a patent document. **All** subject matter that constitutes 'addition to the state of the art' **must** be classified.

PROCEDURES FOR DETERMINING 'ADDITION TO THE STATE OF THE ART' FOR 'OBLIGATORY CLASSIFICATION(S)'

The methodology for establishing 'addition to the state of the art', and thus 'obligatory classification(s)' for a particular patent document varies based upon the degree that examination of the document has been completed at its publication date. The following procedures are used by classifiers to determine the technical information to obligatorily classify for each of the various types of published patent documents.

A. Procedure for granted patents –

   a. All subject matter covered by the finalized claims must be obligatorily classified. This means that each claim as a whole, and each inventive embodiment within a claim, must be classified.

   b. In addition, any part of a claimed combination must be classified if it is (1) novel and unobvious per se or (2) confers novel and unobvious status to the claimed combination as a whole.

c. Any additional novel and unobvious subject matter, determined by an expert's review of the unclaimed disclosure, should also be obligatorily classified when not fully covered by a related application (i.e., a published divisional application).

The classifications of any previously published stages of a granted patent's application must be reviewed at this time and their obligatory classifications confirmed or altered in view of the final determination of the actual 'addition to the state of the art'.

B. Procedure for applications that have been searched –

a. All claimed subject matter that appears to be novel and unobvious in view of the search results must be obligatorily classified.

b. Any remaining separately claimed subject matter that is obviously **not** an 'addition to the state of the art' (i.e., it is already part of the state of the art) should **not** be obligatorily classified.

c. Any additional novel and unobvious unclaimed subject matter, as determined by an expert's review of the disclosure, must be obligatorily classified.

The classifications of any previously published stages of this now searched application must be reviewed at this time and their obligatory classifications confirmed or altered in view of this refinement of the scope of the previously presumed 'addition to the state of the art'. This review should occur at the completion of the search even when no publication is occurring.

C. Procedure for unsearched applications classified by an experienced examiner in the art (i.e., remembrance-type searching) –

a. All claimed subject matter that appears to be potentially novel and unobvious in view of an evaluation by an experienced examiner or searcher in the technology must be obligatorily classified. This evaluation is based on what the examiner or searcher remembers as being already known or obvious within the existing 'state of the art' based on previous similar searches or general experience; it is not an actual review of the art.

b. Any additional subject matter, believed by an experienced examiner or classifier reviewing the disclosure to be novel and unobvious, should also be obligatorily classified.

The classifications of any previously published stages of this now evaluated application must be reviewed at this time and their obligatory classifications confirmed or altered in view of this refinement of the scope of the previously presumed 'addition to the state of the art'. This review should occur at completion of the evaluation even when no publication is occurring.

D. Procedure for unsearched applications not classified by an experienced examiner in the art –

a. The subject matter covered by the initial claims must be obligatorily classified.

E. Procedure for legally abandoned applications – Each legally abandoned application must have at least one obligatory classification. The principal criterion for assigning classifications to abandoned applications is greatest potential usefulness to searchers. Examiners or searchers must review the classifications for previously published stages of their abandoned applications. Any obligatory classifications assigned to their published applications should be confirmed or altered in view of the fact that none of their claims can now validly be used as specific limits to the scope of their 'additions to the state of the art'. In situations where abandoned applications are members of patent families having another member that is a granted patent, the classifications assigned to the granted members may be substituted for those of the abandoned members. Otherwise, any novel or potentially useful subject matter in the disclosures (normally their best mode embodiment) can be used as a basis for obligatory classifications. In many of these situations a single classification is sufficient.

GUIDELINES APPLY EQUALLY TO THE CORE AND ADVANCED LEVELS

All procedures for determining 'addition to the state of the art' and 'obligatory classification(s)' apply equally to both the core and the advanced level.

OLIGATORY CLASSIFICATION

In general, classifiers should assign a classification to each patent document for the combination invention as a whole. They should also assign additional classification(s) based on a part or piece of a combination (i.e., a subcombination, anything less than the complete combination), if the part or piece is (a) itself an addition to the state of the art*, or (b) endows the combination with 'addition to the state of the art' status, (e.g., incorporation of a known compound into a known medicinal composition unexpectedly increases the effectiveness of the composition, i.e., yields a new and unobvious result).

The 'invention information' in a patent document may contain several separately classifiable novel and unobvious 'things'[1] within its broad inventive theme. At least one inventive 'thing' is potentially defined by each claim in a patent document. The summation of all of the separate inventive 'things' in the patent document constitute the entire 'invention' that must be obligatorily classified. The general rule for obligatory classification is that each of the distinct 'things' or aspects of the invention information must be classified when it represents an 'addition to the state of the art'. The following subsections provide additional guidance in particular situations for interpreting the general rule:

(a) Each **distinct category** (e.g., method of manufacturing, article/product, process of using apparatus) of inventive 'thing' that constitutes an addition to the state of the art must be classified. An example is a method for making an automobile and the apparatus for making an automobile that are each within the scope of the invention information. Each of these separate categories of invention should be obligatorily classified as a whole. This may or may not result in assigning more than one classification to a patent document, since a particular process and apparatus for making a product potentially could be classified within the same group or in separate Subclasses.

(b) Every 'thing' within a **single category** of invention specified within the invention information must be obligatorily classified as a whole (i.e., as the complete 'thing' and not just as some of its parts). This statement is intended to require obligatory classification of each separately claimed inventive 'thing', as a whole, into a single classification whose scope provides for it. In addition, parts of an inventive 'thing' require obligatory classification if the parts are

- Novel per se, or
- Endow the 'thing' as a whole with novel and unobvious character, i.e. render it an 'addition to the state of the art'.

(c) Whenever the invention information specifies a single category of invention that includes **multiple fully disclosed alternative variations, embodiments, or species,** (e.g., alternative types of vehicle springs, Markush-type organic compound formulae, etc.), **each** variation, embodiment, or species as a 'whole' is an obligatory classification .

This statement is intended to require classification of all variants covered by general chemical formulae whenever these particular variants are 'fully disclosed' within the meaning of Rule 71 of the IPC Guide. This statement is also intended to require classification of variants within a single patent document when one of them is appropriate for a 'function-oriented' (e.g., more general use) classification and the other is appropriate for an 'application-oriented' classification for which it is specially adapted.

[1] Within these guidelines the term **'thing'** is defined, as it is in the IPC Guide, to mean any patentable technical matter, tangible or not, such as a process, product or apparatus.

It should be noted that, frequently, different species or embodiments of invention information would be provided for by the same classification symbol. In such cases, naturally, it is not necessary to provide multiple identical obligatory classifications.

(d) Whenever the invention information in a patent document includes an invention for a 'thing', and an aspect or part (component, subcombination) of the 'thing' already classified as a whole is determined to constitute an addition to the state of the art, the aspect, component, or portion should also be assigned an obligatory classification. This 'addition to the state of the art' status could be indicated by the aspect or part being separately claimed in an independent claim.

DISCRETIONARY (I.E., NONOBLIGATORY) CLASSIFICATION

The intent of this section is to give classifiers maximum discretion in assignment of useful nonobligatory classifications.

A. Any portion of the total disclosure of a patent document or of a non-patent document technical publication that includes subject matter determined by a classifier or examiner to be useful for searching may be used as the basis for assignment of discretionary classifications.

B. Discretionary classification of a 'thing' may be made into a place where the 'thing' is only partially specified by the complete title of the place if such placement is judged to enhance the place's search value. For example, a device that is only disclosed for preventing unauthorized use of a cycle (see B62 H) might be deemed useful for, and may be assigned by an expert examiner to, a classification providing for handcarts that utilize a similar device (see B 62 B).

C. Nonobligatory classifications are assigned for disclosed subject matter entirely at the discretion of examiners and classifiers. Nevertheless, strategies may be stated for 'where' to place discretionary classifications for certain types of disclosed subject matter if the strategies are clearly intended to encourage, but not to require or to preclude, the assignment of certain patent or non-patent subject matter classifications in the stated manner. These strategies should be used merely to promote the nonobligatory classification of such subject matter and to suggest useful procedures or methods in particular unique situations. This would not obligate classifiers to follow these strategies when they were assigning the same type of subject matter within the same subclass scheme. An ancillary benefit of such a stated strategy is that it would alert searchers to the fact that the specified subject matter has been frequently assigned by classifiers of specific IPOs in the manner stated.

D. A patent document may not be assigned both an obligatory and a discretionary classification to the same place. Patent documents covered by a single classification frequently contain disparate embodiments within their total disclosure that are each separately appropriate for the classification and are inventive or non-inventive in nature. Therefore, it is assumed that searchers viewing patent documents having obligatory classifications to a place are aware that these documents may also contain separately disclosed subject matter that could potentially also be proper for discretionary classification into the place. As a practical matter, this situation creates a data base problem. Normally, it might inadvertently occur when (a) limited patent families in the advanced level are assigned a set of common classifications from various IPOs or (b) an unrefined rollup of advanced level classifications to their core level equivalents mistakenly indicates both types of classifications to a group. In these situations, the nonobligatory classification to the place should be automatically deleted.

[Annex 35 follows/
L'annexe 35 suit]

ANNEX 35/ANNEXE 35

Swedish Patent and Registration Office

IPC Reform Task 4 **October 22nd, 2001**

Comments on the Annex to
RAPPORTEUR REPORT ON GUIDELINES FOR DETERMINING SUBJECT MATTER APPROPRIATE FOR OBLIGATORY AND NONOBLIGATORY CLASSIFICATION

We have commented in some detail in our previous comments (IPC/R 4/99, Annex 33), and we do not see any need to repeat at length what was stated there.

The guidelines proposed in the Rapporteur Report are not acceptable in their existing form. The fundamental definitions lack internal logic. The guidelines are also too focussed on how the patent system works in only some of the world's countries. The guidelines are written in order to fit a limited number of offices dealing with a limited variety of documents, so they will be of little guidance to many users, for example to many of the small offices in developing countries. Furthermore the language is overly complicated for use by non-English speakers.

1. Definition of terms.
This part is not logically consistent: **"Invention information"** is defined as **"technical information … that represents an addition to the state of the art"**. **"Addition to the state of the art"** is defined as **"matter which was not found by an IPO during its search of the prior art"**. This means that if there is no search, there is no definition of "addition to the state of the art". If there is no definition of "addition to the state of the art", there is no definition of "invention information".

It might be worth reminding the Rapporteur that many of the world's patent offices do not search their applications, and that the proposed definition would be useless to them. It also useless for classification of applications before they are searched, which is the norm in many countries, including several of the world's biggest producers of patent information.

Furthermore, the term **"addition to the state of the art"** is ambiguous. Say that a claim contains features a, b, c and d. A search reveals that the combination of a, b and c is previously known. An obvious conclusion is that d is the addition to the state of the art, since the combination of a, b and c are the state of the art. This is for example the conclusion in EPO practice, where the prior art is defined as the best document and what goes beyond this is called "the contribution to the state of the art".

2. Procedure for granted patents.
This section should be headed "Procedure for patents granted after search and substantial examination". In many countries of the world patent applications are not searched, and in some the applications are searched, but not substantially examined. The word "finalized" lacks meaning in many countries, where the scope of patents can be decided by courts long after their granting and publication.

The last sentence "The classifications of any previously published stages of a granted patent's application **must** be reviewed at this time and their obligatory classifications confirmed or altered in view of the final determination of the actual 'addition to the state of the art", and similar statements in other paragraphs, is too strongly worded. This review will not be administratively possible in many countries, and in others the benefit will not be considered worth the effort. It can only be a recommendation to reclassify applications at a later stage.

3. Procedure for other documents
We do not think this section gives instructions that would be practical even at the trilateral offices. Furthermore they do not cover all alternatives.

We do not believe that, for example, an EPO examiner every time he classifies a searched German document would consult the search results. In section B there can therefore be no obligation to consult search results. In section C the words "unexamined applications" should be replaced by "patent documents", otherwise the procedure cannot be applied for searched applications or for patents which are published according to laws other than those of the country of the classifier. Section E is redundant as such, since it is covered by sections C or D in all cases except when an office undertakes the work of actively identifying documents relating to abandoned applications and modifying their classifications. We think extremely few offices will do this, and to make it an obligation is completely unrealistic. In several countries search and examination is not done until several years after publication, and during this time many applications are abandoned that would have fulfilled all criteria for patentability or classification, and they might even have served their legal purpose before being abandoned. Section E should be replaced by a section covering what to do when a document that must be classified obvious lacks all novelty. However, this is mainly a "where to classify" question.

We think that with the possible exception of granted patents, the situation is not defined by the type of document (e.g. whether they are searched or not) and the qualifications of the classifier, but by the information available to the classifier and the qualifications of the classifier:

1. If the classifier has access to documents defining the prior art, for example found during the search of the application, the additions can be objectively decided, e.g. which claims that are novel.
2. If the classifier does not have access to documents defining the prior art, but is an expert in the field, he is allowed to estimate the additions based on his knowledge.
3. If the classifier does not have access to such documents defining the prior art, and is not an expert in the field, he is not allowed to estimate the additions, but has to classify the claims.

Granted patents are often classified by offices other than those that processed and published them. We can not see that an office when classifying a patent should be required to classify a scope that was granted under a different law and might not be relevant at that office where it is classified.

4. Obligatory classification

We have tested the texts on experienced examiners with good knowledge of English, and have got the unanimous statement that they are difficult to read and understand. They are in general twice as long as they need to be. They are written in a circuitous and repetitive way, and basic defined terms are often replaced by other similar terms.

It starts immediately with talking about "the combination invention as a whole", which does not have an antecedent. (The explanation can of course be found in other papers by the trilateral offices, but more on this later…). We do not understand example (b) - in this case the compound would still be known and not worthy of classification, and the composition would be novel.

The second paragraph gives more confusion than guidance, and includes a lot of unnecessary words. It could be replaced by the following simple sentences: **"A patent document may contain several inventions, for example defined by different claims. All of these must be classified."**

Conclusion

It appears that it would be easier to start from a simple text, which might contain too little, than to start from a lengthy and overcomplicated text and try to shorten it. If this is an acceptable route, we would like to offer the following proposal as a starting point. This proposal includes a different definition of the expression "invention", which would avoid the complicated and difficult definition of "invention information" and particularly "addition to the state of the art". We also prefer the expression "additional classification", since this seems to be the name of the field in the Master Classification Database for this information. It also seems more logical to start with the general description of what an invention is and finish with the specifics of classification of different types of documents in different situations.

Proposal for "What to classify"

Each separate invention mentioned in a patent document must be classified. An invention is a novel non-obvious solution to a problem. Claims of patent applications identify what the applicant regards as inventions.

A patent document can contain several inventions:

- There might be alternative solutions to the same problem. Example: The same effect can be achieved with two different chemicals
- There might be solutions that are defined with a varying degree of specificity. Example: A mixture can be specified with a broad range or a narrow range of an ingredient
- There might be different solutions to different related problems ("different categories of invention"). Example: A document can disclose both a product and a method of its production

- An invention might contain a subsystem that is in itself a non-obvious solution to a problem. Example: A vehicle suspension system might contain a spring that is an invention in itself

When there are several inventions in a patent application they are often covered in different claims. However, some inventions might not be claimed, but for example only described in examples.

The classification of inventions is called "obligatory classification". A document should only be classified once in each group, regardless of whether two or more separate inventions can be classified in the same group.

Some patent documents contain no novel information whatsoever, but must still be classified for legal reasons. The classification of such documents should also be considered obligatory, and the classification should be based on information that could be of any search interest.

Matter that is previously known or obvious can be classified, if it of interest for search purposes. This is called "additional classification". Additional classification is not obligatory. Additional classification can for example be made when information about something that in itself is not an invention could be of use for limiting a search by asking Boolean "and-type" search questions. A document should not be given an obligatory classification and an additional classification in the same group.

Except for special places indicated by notes, each invention should be classified as a whole and not by separate classification of its parts. The exception to this is when a part of an invention can be regarded as an invention in itself.

Guidelines for classification of patent documents:

The person classifying a patent document should ideally be an expert in the field, and have access to the search results and procedure history of the application to which the document relates. The classifier can then form a qualified opinion of what is novel and non-obvious. This is far from always the situation:

- In case a patent has been **granted after search and substantive examination**, the claims can be taken to define matter that is novel and non-obvious. The classifier will still have to check whether there is unclaimed matter that is novel and non-obvious.
- In case an application has been **searched**, a classifier can form an accurate opinion about which matter that is novel and non-obvious by consulting the prior art found during the search.
- In case the classifier is an **experienced expert** in the relevant technical field he can base his opinion on novelty and non-obviousness on his knowledge and experience, without consulting any prior art.
- In case the classifier is **not an expert**, and does not have access to relevant prior art, classification should not be based on the claims.

When using patent claims as guidance for classification it should be remembered that claims are written for legal purposes and not primarily in order to give information. They are often written to be as non-specific as possible. They also sometimes contain limitations that are unnecessary for the solution of a stated problem. An expert in a technical field should use his knowledge to ensure that the information that is classified makes sense as a solution to a problem.

It is recommended that classification is reconsidered, using the additional information available, when applications are searched, substantially examined or patent granted.

Anders Bruun

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Fin de l'annexe 35 et du document]