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**SPECIAL UNION FOR THE INTERNATIONAL PATENT CLASSIFICATION
(IPC UNION)**

COMMITTEE OF EXPERTS

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**PROPOSAL FOR THE MODIFICATION OF PARAGRAPHS 74, 80 AND 81
OF THE GUIDE TO THE IPC**

Document prepared by the International Bureau

The Annex to this document contains a modified proposal submitted by the United States Patent and Trademark Office for the modification of paragraphs 74, 80 and 81 of the Guide to the IPC, in the light of the comments submitted by Japan, Sweden, the United Kingdom and the African Regional Industrial Property Organization (ARIPO) (see document IPC/CE/27/8 Suppl. 1).

[Annex follows]

ANNEX/ANNEXE



UNITED STATES
DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

6 October, 1998

Mr. Mikhail Makarov
Head, IPC Section,
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World Intellectual Property Organization
34, Chemin des Colombettes
1211 Geneve 20
Switzerland

Re: US Proposal for 'The Modification Of Paragraphs 80 and 81 Of The Guide To The
IPC' specified in the Annex to PCIPI/CE/27/ 8

Dear Mr. Makarov,

We have carefully reviewed the comments made by GB, ARIPO, SE, and JP on this topic. Their comments plainly show that some of our suggested terminology in paragraph 80 would not be acceptable to them. However, we still believe clarifications are necessary to the Guide. In an attempt to expedite the discussion of this topic at our upcoming meeting, we would like to discuss several points and offer a potential alternative solution that may be acceptable to all parties.

All commenting parties agree with the US position that indexing is 'non-obligatory' as clearly stated in paragraph 87 of the Guide. The problem is that we do not seem to have agreement as to what is intended by this terminology in regard to indexing practice.

JP, GB, and SE are of the opinion that it means that the 'competent authority' shall determine if it will use indexing or not use indexing in the IPC. Our opinion is that 'non-obligatory' has the same interpretation, and should be used in the same manner, as in the other situations covered by paragraph 87. In these situations it is the person classifying a patent document, on a case by case basis, who usually determines what information, other than that covered by the 'obligatory' classifications in paragraph 86, is classified.

Of course we would agree that classifiers are directed by their authority on what subject matter to classify. We also agree that their authority has the right to impose additional restrictions on their methods of classifying into the Classification (e.g., SE and GB making indexing obligatory for their classifiers) so long as they are in compliance with the Guide. Therefore, we can accept as stated by JP that it is the ‘competent authority’ that has the right to determine the extent of its indexing usage. This clearly allows the authority the option of not using any indexing schemes (e.g., US, CA), using them in an obligatory manner (e.g., SE, GB) or only using indexing schemes in the Classification at their discretion (e.g., JP). We do not believe that there is any obligation for an authority to continue to classify in any particular indexing scheme, or to use all indexing schemes, if an authority does not find such use productive.

SE has suggested that paragraph 74 is the proper place, if needed, to emphasize the non-obligatory nature of indexing. GB has suggested a small footnote in paragraph 80 referring the reader to paragraph 87. US suggest as a potential alternative to the first two lines of our proposal, the following addition to paragraph 74 following the existing terminology:

“---Each competent authority determines its general policy in regard to the use and application of indexing codes to its patent documents since their application is not obligatory. The authorities that apply indexing codes may use all or a portion of the indexing schemes within the Classification. Nonetheless, whenever indexing codes are applied to a patent document from a specific indexing scheme associated with one of its classifications, the authorities agree that the codes must be applied in a non-discretionary manner as defined in paragraph 80.”

This language would allow GB and SE to continue their internal policy of making assignment of all indexing codes in all schemes ‘obligatory’ for their examiners without requiring any changes to the internationally accepted meaning of ‘non-obligatory’.

Given the late date of our original proposal, and if the modification suggested above were made to paragraph 74, US would have no objection to withdrawing our original proposal for the additional modification to paragraphs 80 and 81 of the Guide. We believe this may be in the best interest of the meeting given our large number of task, even though the additional modifications suggested by US also have JP’s support.

However, we strongly agree with SE that it is ‘wise’ to indicate directly in the seventh edition of the Guide when the principle of non-discretionary application of indexing codes was ‘Officially’ introduced into the Classification. Nevertheless, we are not sure SE is correct in its statement that the principle of non-discretionary applications of indexing codes was ‘officially’ introduced in the 5th edition of the IPC. The first and only ‘official’ use of the term in the Guide, which I have located, occurred in the new paragraph 80 that was created for the 6th edition guide. We suggest that the IB clarify this point.

We also agree with SE that our sentence describing how to index ‘Markush-type’ formulae is a worthwhile improvement giving useful guidance to the classifier. We suggest that “**In these situations, only the indexing codes in the scheme covering subject matter having a significant disclosure should be assigned to the patent document.**” be added at the end of the existing paragraph 80.

If the current proposal is withdrawn, this action does not indicate that US believes that paragraphs 80 and 81 are correct in their wording. The problems with indexing practice that we attempted to remedy in our proposal still exist. What it does indicate, given the responses to our proposal, is that the solutions to these problems need careful consideration and additional discussion prior to the inclusion of additional modified terminology in the seventh edition of the Guide and the WIPO “Handbook on Industrial Property Information and Documentation”.

For example, SE believes that the safeguards of references and precedence are enforceable in the first example (B 29 L) of our original proposal in view of paragraphs 45 & 46 of the Guide. Unfortunately, these paragraphs cover ‘classification groups’ and not ‘indexing codes’. This point is why paragraph 81 is needed and paragraph 47 (b) is not used. Since indexing code assignment practice is covered in paragraph 80 and is very different from that of groups, the use of references and precedence in their schemes and how they modify standard practice must be covered separately.

We would support the use of references and precedence in select Indexing schemes to help limit assignment of indexing codes. In fact, we believe the WIPO Handbook in part 5, page 5.2.1.2, paragraph 13 hints that such tools could still be used in some indexing schemes. Unfortunately, (2) Note of subclass B 29 L refers only to Chapter IV of the Guide for the application rules for indexing codes. This portion of the Guide is currently inconsistent with the cited portion of the Handbook. It completely fails to cover the indexing schemes that embody the discretionary principle. These types of schemes should, and indeed must, also be covered in Chapter IV in the future. This is true since there are still discretionary indexing schemes, such as B 29 L introduced in the 4th edition, that started out with assignment rules based on this theory and that their construction requires the continuation of at least partial discretionary assignment. Furthermore, the Handbook still allows their introduction in future situations when necessary and the US fully supports continuation of this policy.

SE also points out in this example that “B 29 L 31:08 is a residual main group, so no overlap with B 29 L 15:00 should be possible”. Again, there is no concept of a ‘residual main indexing code’ currently in the Guide and the existing terminology in paragraph 80 requires all coordinate indexing codes identifying elements have to be allotted. SE and GB both point out that propeller blades are not very similar to ‘gears’. However, many propellers are articles with projections (no grooves are needed if the title is read correctly by GB) which rotate and seem to be as similar to gears as the example of ‘control knob’ in the title. This example is intended to show the type of overlapping indexing code assignment that should never, in US opinion, be acceptable in a well designed indexing system. It is clear that no additional information to the searcher can be gained by combining the two assigned codes. It is still our opinion that the current indexing rules in paragraph 80 should be modified in the future so as not to require the assignment of both codes.

Finally, the contradictory responses of GB and SE to our example 3 should be noted. We believe that SE is correct and that logic similar to that found in paragraph 31 should be followed by classifiers when they assign indexing codes. Unfortunately, GB seems to be of the opinion, and they may be correct under the current wording of paragraph 80, that all of the overlapping indexing codes should be assigned regardless of the obvious intent of related indexing code titles in their scheme. US views the additional information gained by such indexing as 'trivial', since it is already fully covered by other indexing codes more specific to the same 'element of information'.

In conclusion, in view of the upcoming Advance IPC Seminar and potential changes to IPC practice that may be introduced there, US suggests that the more limited modification to the Guide indicated in this paper for the seventh edition may be the most significant and beneficial improvement now possible. In our opinion, the additional extensive 'clarifications' needed to index code assignment practices may be better handled by the Working Group at a later date given the diversity of opinions on this topic. In addition, we believe that portions of the Handbook would benefit by enhancement of their existing coverage on this topic. However, should the meeting want to address additional amendments to the Guide that go beyond those necessary for clarification of 'non-obligatory', then our original proposal is still a valid point to start discussions. Furthermore, ARIPO's suggestion, to provide an INID code for indexing codes which is distinct from the existing INID codes for classification symbols, seems more appropriate for discussions at the upcoming Advance IPC Seminar and not at this meeting. This concept goes beyond clarification of assignment of indexing codes and would need to be coordinated with the SCIT Standards and Documentation Working Group for implementation.

Sincerely yours,

Gary Auton
International Patent Classifier,
IPC Group
US Patent & Trademark Office

cc SIG Members

[End of Annex and of document/
Fin de l'annexe et du document]