

ANNEX VI

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 novel and unobvious subject matter in its total disclosure (e.g., description, drawings, claims) that represents an addition to the state of the art in the context of the state of the art (e.g. solution to a stated problem); “invention information” should usually be determined using the claims of the patent document as guidance.

“*Addition to the state of the art*” is the difference between the subject matter in question and the state of the art.

“*The state of the art*” is the collection of all technical “things” that have already been placed within public knowledge.

“*Thing*” means any technical subject matter, tangible or not, such as:

- methods of using a product or performing a non-manufacturing operation;
- products (articles of manufacture);
- processes of making a product;
- apparatus; and
- materials from which a product is made.

“*Inventive thing*” means any part of the invention information which is novel and unobvious in itself.

PROCEDURES FOR DETERMINING OBLIGATORY CLASSIFICATION

It is *obligatory* to classify all subject matter that constitutes invention information in a patent document. In practice it can be difficult to objectively determine invention information. Therefore, the best possible approximation to this ideal case has to be found.

The following procedures should be used by classifiers to determine for each of the various types of published patent documents which technical information must be classified.

Procedure for Patents Granted after Search and Examination

- All subject matter covered by the claims must be classified. This means that classification should be based on the subject matter of each claim as a whole and on each inventive thing within a claim.
- In addition, any part of a claimed combination should be classified if it is novel and unobvious per se.
- Any unclaimed invention information should also be classified when not fully covered by a related published application (e.g., a published divisional application).

Procedure for Applications that Have Been Searched

- All claimed subject matter that appears to be novel and unobvious in view of the search results should be classified.
- Any unclaimed subject matter that appears to be novel and unobvious in view of the search results should be classified when not fully covered by a related published application (i.e., a published divisional application).

Procedure for Unsearched Applications Classified by an Expert in the Art

- All claimed subject matter that appears to be potentially novel and unobvious in the opinion of the expert should be classified. This opinion is based on what the examiner or classifier remembers as being already known or obvious based on previous similar searches or general experience; it is not an actual review of the prior art.
- Any unclaimed subject matter, believed by an experienced examiner or classifier reviewing the disclosure to be novel and unobvious, should also be classified when not fully covered by a related published application (i.e., a published divisional application).

Procedure for Unsearched Applications Classified by a Non-Expert in the Art

The claims should be used as guidance for the subject matter to be classified.

To minimize potentially unnecessary classifications of patent documents in the search files, the classifications of any previously published stages of the applications may be reviewed at the time that the applications are either granted, searched, evaluated, or abandoned to *confirm* or *alter* their obligatory classifications. However attention should be paid to any information that is only disclosed in a previous publication to avoid the loss of information.

In situations where a classifier determines that *no* invention information is present within a published patent document, at least one classification must still be assigned to the patent document. In this exception to standard practice, the classification should be based on the portion(s) of the total disclosure that the classifier determines is most useful. Normally, when the subject matter of the disclosure is well represented in the prior art, a single classification is adequate.

GUIDELINES APPLY EQUALLY TO THE CORE AND THE ADVANCED LEVEL

All procedures for determining “invention information” and “obligatory classification” apply equally to both the core and the advanced level.

IDENTIFYING “INVENTION INFORMATION” TO BE CLASSIFIED

In the following, the term “invention information” is meant to also cover its best possible approximation based upon the stage of the patent granting procedure during which the patent document is classified.

The “invention information” in a patent document may contain several separately classifiable “inventive things” that could each be classified in a different classification place. The general rule is that an “inventive thing” must be classified as a whole, and not by separate classification of its parts. The following subsections provide additional guidance for applying this general rule in particular situations:

- (a) Each claim in a patent document potentially defines at least one “inventive thing.”
- (b) If a document discloses “inventive things” of more than one category of invention (e.g. method of manufacturing, article/product, process of using apparatus), the “inventive things” of all categories must be classified. An example is a novel and unobvious method for making a product (e.g., tyre) and a novel and unobvious apparatus for making this product. This may or may not result in classifying a patent document in more than one place, since a particular process and apparatus for making a product potentially could be classified in the same place or in different places.
- (c) Every different “inventive thing” within a single category of invention must be classified as a whole into a classification place covering it.
- (d) When a document discloses, within a single category of invention, multiple fully disclosed alternative variants of “inventive things” (e.g. alternative types of vehicle springs), each variant must be classified as a whole.

For variants covered by general chemical formulae (e.g., Markush-type organic compound formulae), all variants that are “fully disclosed” within the meaning of paragraph - of the Guide to the IPC must be classified. This principle is also used when documents contain inventive things that are appropriate for both “function-oriented” (e.g., more general use) places and “application” places.

(e) Whenever a part of an “inventive thing” is determined to also be novel and unobvious, that part should also be classified. This situation could be indicated by the part being separately claimed in an independent claim, or by being described in detail in the description.

DISCRETIONARY (I.E., NONOBLIGATORY) CLASSIFICATION

(a) Any portion of the total disclosure of a patent document or of non-patent literature (e.g., 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) Nonobligatory classifications are made at the discretion of examiners and classifiers, subject to internal instructions of the office concerned.

(c) In specific classification places, rules or recommendations can be stated (e.g. in the definitions of those places) in order to assist classifiers and searchers in the use of discretionary classification. However, such rules should normally not affect the discretionary nature of this type of classification.

[Annex VII follows]