F

OMPI

IPC/CE/27/8 Suppl.1
ORIGINAL : anglais
DATE : 12 octobre 1998

ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
GENÈVE

UNION PARTICULIÈRE POUR LA CLASSIFICATION INTERNATIONALE DES BREVETS (UNION DE L'IPC)

COMITÉ D'EXPERTS

Vingt-septième session
Genève, 21 - 30 octobre 1998

OBSERVATIONS SUR LE DOCUMENT IPC/CE/27/8

Document établi par le Bureau international

Les annexes I à IV du présent document contiennent les observations, soumises par le Japon, la Suède, le Royaume-Uni et l'Organisation régionale africaine de la propriété industrielle (ARIPO), relatives à la proposition de l'Office des brevets et des marques des États-Unis d'Amérique en vue de la modification des paragraphes 80 et 81 du Guide d'utilisation de la CIB (voir le document IPC/CE/27/8).

[Les annexes suivent]

ANNEX I/ANNEXE I

JP COMMENNTS **Date 30.09.98**

JP opinion (+)improvement
(x)improvement if modified
(-)no improvement

CE/27/8 (x)

The JPO generally agree with the US proposal.
Indexing is non-obligatory, and it should be done in a non-discretionary manner whenever the indexing codes are applied.

The only one point we are not sure is specified below.

We wonder whether the US appreciation "non-discretionary application of Indexing Codes" is proper. We do not think that non-discretionary indexing means that a classifier can decide to index or not on a case-by-case basis at his (her) discretion as in the US proposal. In Japan, it is our Office and not each classifier to determine whether a certain patent document should be indexed or not. We always allot indexing codes in the IPC fields where the hybrid system is introduced. It is our pinion that it should be a competent authority to determine whether it shall adopt indexing practice according to each country's condition of classification tools.

[Annex II follows/
L'annexe II suit]

ANNEX II/ANNEXE II

Swedish Patent and Registration Office

Paragraphs 80 and 81
of the Guide to the IPC
Date: 18 September 1998

COMMENTS
on the Annex to IPC/CE/27/8

We are not in favour of substantially changing the way that the non-obligatory status of indexing is described in the Guide. The situation is made clear the existing paragraph 87. If something needs to be changed, we do not think it should be done in paragraphs 80 and 81. We think these paragraphs are satisfactory as they are, and the changes proposed by US could cause confusion between the expressions ”non-obligatory” and ”non-discretionary”. If any change is considered necessary, we think the proper place would be paragraph 74, the heading paragraph of the entire chapter. Any new wording should also point out the benefits of indexing and not only emphasise that it is non-obligatory. Suitable wording could perhaps be found in paragraph 87.

Some of the arguments put forward in the document appear to be based on a lack of understanding of the way that indexing systems are supposed to work. The thinking behind indexing is that information based on two or more different philosophies for subdivision, is given and used in searching for cutting down the number of documents that have to be searched. This ”overlapping” information is not redundant, it is essential for the function of the system.

In example 1, it is stated that the safeguards of references and precedences are not enforceable in view of paragraph 81. This is not correct. As stated in paragraphs 45 and 46, the scope of a group is determined by its title as modified by references or notes. If something is referred out of an indexing entry it cannot be indexed there, even though the title of the entry might cover it. The concepts of precedences and references in indexing schemes, although perhaps not desirable, are not inappropriate. We do not think the examples are convincing. Overlap between B29L 31:04 and B29L 31:06 appears unlikely, but if a bearing is a rod, then the additional information can be used to limit a search. B29L 31:08 is in a residual main group, so no overlap with B29L 15:00 should be possible, even for someone who would consider a propeller blade to be similar to a gear wheel.

In example 2, the combination of the two codes gives the complete information about the fibre, that it is both non-metallic and coated. This is worthwhile additional information that can be used to limit a search. We consider paragraph 31 to be very helpful in the situation of example 3. It recommends considering related subclasses or groups when interpreting titles or wordings. It would be natural for the classifier to interpret these titles in the same way as in section C.

The IPC:CLASS CD-ROM will be the main instrument for accessing the IPC during the next revision period. If previous editions of the Guide are not included in the next edition of IPC:CLASS, we think it would be wise to indicate that the principle of non-discretionary application of indexing codes was only introduced in IPC5.

The proposals for modifying paragraphs 80 and 81

On the whole, we are not in favour of the proposed paragraph 80.

As stated above, we think the first sentence emphasises the word ”non-obligatory” in an inappropriate way, and in the wrong paragraph.

We strongly disagree with the second sentence of the proposed paragraph 80. If indexing is ever to become a usable search tool, it must be applied in a consistent way. The proposed wording would encourage inconsistent application of codes. We think that simple self-preservation instincts would argue strongly against the reasoning behind the US proposal. For an office where indexing is applied on a case by case basis in the way proposed, it would be impossible to trust it as a search tool even for the documents that they publish themselves.

We do not think that the second sentence reflects the intention of the word ”non-obligatory”. In our view, the intention was never that the decision should be done by individuals on a case by case basis. At the Swedish Patent Office, we have decided that indexing is obligatory for documents published by us, and included instructions to that effect in our internal guidelines (RL II.1.3). This is our interpretation of the intention, that offices should make a policy decision on whether they, as a whole, use indexing or not. If paragraph 74 is modified, we would propose adding something to that effect, for example ***”It is recommended that organisations publishing patent documents make a policy decision on the use of indexing, and announce that decision to interested parties”***. In this way the system, although still far from perfect, would at least be more predictable and consistent.

The fourth and fifth sentences do not correctly reflect the existing paragraph 80 or the current use of indexing. The fourth sentence of the proposed paragraph 80 says that ”all appropriate indexing codes identifying distinct elements of information about ***any technical subject found in the patent document*** should be allotted”. This is an extremely non-discretionary way of indexing documents, and definitely not what the present paragraph 80 says. It says ”all indexing codes identifying elements of information about ***a technical subject already classified as such*** have to be allotted”. There is a widely spread misconception that IPC is an instrument for classification of documents - it is not, it is an instrument for classification of the inventions that are disclosed by the documents. As can be seen from the existing paragraph 80, only those technical subjects that are classified should be indexed. Those parts

of a document that relate to technical subjects that are not classified, for example non-invention information such as a description of the prior art, should not be indexed.

We also disagree with the sentence starting on line 13 of the proposed paragraph 80 and with the last sentence of the paragraph. These places state that indexing should only be done in the most appropriate of overlapping indexing entries or the entry where a particular element of information is most completely provided for. This would be opposite to the way indexing is intended to work, that is by giving additional information by combining partially overlapping elements of information.

We agree that non-discretionary indexing should not be applied where the element of information to be indexed is already completely identified by the classification of the same element. However, we think this situation is rare, and it should normally be avoided already in the drafting of an indexing scheme.

In can be argued that it is unnecessary to index in a case where it is obvious that an information element is just part of a list of alternatives and that no particular selection is made or indication of advantage is given. However, in actual searches it is often important to find such mentionings, and it is always impossible to tell in advance which particular element of information that will be useful in a future search.

The sentence describing how indexing of ”Markush”-type formulae should be done appears to be a worthwhile improvement, since the present wording does not give very much guidance to the classifier.

Some parts of the proposed paragraph 81 might be a clarification, but the proposal basically uses 60 % more words to say the same thing as the existing paragraph. We think the existing paragraph is satisfactory, so we are not convinced that the improvement is worth the effort.

Anders Bruun

[Annex III follows/
L’annexe III suit]

ANNEX III/ANNEXE III

The Patent Office

Concept House,
Cardiff Road,
NEWPORT,
South Wales
NP9 1RH,

Mikhail Makharov

Head, IPC Revision

W.I.P.O.

34 chemin des Colombettes

1211 Geneve 20

Switzerland

Your reference

Our reference IPP/41037/4/26

Date 14 September 1998

Dear Mikhail

We are very concerned about the changes to paragraph 80 of the Guide to the IPC proposed by US and we have the following comments about those proposals and the comments which accompanied them.

i) Indexing is non-obligatory

It is quite clear to us that indexing is non-obligatory, but in a world-wide political sense in that certain Patent Offices do not choose to apply indexing and there is currently no obligation upon them to apply indexing. Paragraph 80 of the Guide merely states that "indexing codes are applied in a non-discretionary manner", so **if** an Office **chooses** to apply them, they are applied in a non-discretionary manner. Paragraph 80 therefore deals with **how** indexing is applied, not whether it is applied, and therefore any reference in paragraph 80 to whether indexing is obligatory or non-obligatory would be totally inappropriate.

Furthermore, we consider that the question of indexing being obligatory or non-obligatory is already clearly set out in paragraph 87 of the Guide. We do not believe that there is any need for this to be repeated in paragraph 80 and indeed we feel it is **extremely** undesirable to do so since there will inevitably be confusion between what is non-obligatory and what is non-discretionary, particularly where English is not the mother tongue. We suggest merely a small footnote to paragraph 80 referring the reader to paragraph 87.

We would like to reiterate that the present internal policy of our Office is that indexing is obligatory and non-discretionary, and the current wording of paragraph 80 clearly reflects that. We also note the result of the survey on the use of the IPC carried out by WIPO and given in paragraph 19 of IPC/CE/26/8 that "the majority of the offices having submitted replies allotted the non-obligatory classification symbols and indexing codes to their published documents". There appears to be no desire on the part of those offices to alter paras. 80 and 81 of the Guide.

ii) Indexing codes overlap?

A certain overlap of indexing codes is usually desirable, being built in to the design of most indexing schemes. There is nothing wrong with overlap in a well-designed indexing scheme as long as there is not an overwhelming excess of redundant information.

For instance, F16H 59:48 relates to an input signal relating to acceleration but in many cases this signal would be achieved by differentiating a speed signal and would therefore also attract one of 59:36 to 59:42. It is desirable for this to happen to give extra information about the nature of the acceleration signal and it was designed into the scheme. The proposed US wording could preclude the intended use of such a scheme and would therefore be impractical as most schemes included in the IPC would have to be revised.

As regards US examples we have the following comments:-

1. B29L:- Although a proliferation of precedence references in indexing is undesirable, the references in this scheme are logical and desirable and we see no problem with them vis-a-vis paragraph 80, especially when taken in conjunction with paragraph 81, of the Guide. As regards US specific examples 31:06 does not say "rod-shaped" but "rods". We doubt if many technically qualified classifiers would call a needle bearing a "rod". 31:06 relates to the blades of a propeller, not the hubs and 15:00 would only apply if that hub were grooved, and if it were indeed grooved then it would seem to be perfectly desirable to index it in 15:00. This B29L scheme abounds with possibly overlapping indexing codes and we think this is both necessary and desirable. Where redundancy may be a problem, preference notes are used but application of several overlapping codes is apparently envisaged and desirable, e.g. vehicle wheels 31:30 + 31:32, vehicle radiators 31:18 + 31:30. This also gives the possibility of using the boolean "NOT" for defining a further category, e.g. heat exchangers but not vehicle radiators 31:18 NOT 31:30.

2. C22C:- It seems highly desirable to have coated non-metallic fibres (101:62 + 101:00) differentiated from coated metallic fibres (101:62 + 101:50) and this illustrates how use of two overlapping index codes can provide desirably precise information.

3. A61L:- Again it seems desirable for information about the organic compound, in 101:32 to be able to be indexed as well as the fact that it may be an enzyme or a micro-organism. This avoids repetition of the organic compounds part of the scheme, e.g. by indenting under both enzymes and micro-organisms.

It must be remembered that indexing is very different from classification. When classifying an invention it is usually highly desirable to apply a single code if possible and therefore it is undesirable for codes to overlap. In indexing it is often desirable, as illustrated in examples 2 and 3 above, to apply several partially overlapping indexing codes. Searching combinations of those indexing codes then allows precise definition of the context of an invention to considerably enhance search effiiciency in comparison with search of classification codes alone.

Conclusions

1. It is extremely undesirable to change the wording of paras. 80 and 81 of the Guide at all, unless overall benefit can be demonstrated, which we do not think to be the case so far.

2. US appears to want the Guide to double as an exhaustive internal manual for their classifiers but the proposed amendments to paragraphs 80 and 81 would be totally unsuitable for Offices where indexing is now habitually applied and is well understood, which appears to be the majority, as the amendments tend to obscure the clear guidance given by the present paragraphs 80 and 81.It is up to individual Patent Office's to give internal guidance about their particular policies towards indexing but those policies should not influence the wording of the guide as regards the detail of classification and indexing in IPC as regards how codes are applied.

3. Paragraph 87 already clearly sets out that indexing is currently non-obligatory.

4. US proposals appear to be impractical as they would necessitate redsign of most, if not all, indexing schemes.

Yours Sincerely

Jim Calvert

IPC Revision Coordinator

Telephone	(0)1633 814748
Fax	(0)1633 814827
Email	jim.calvert@patent.gov.uk

[Annex IV suit/
L’annexe IV suit]

ANNEX IV/ANNEXE IV

M.F.Curchod
Deputy Director General
World Intellectual Property Organization
34 chemin des Colombettes
1211 Geneva 20
Switzerland

Dear Mr. Curchod

Re. : Proposal for the Modification of Paragraph 80 and 81 of the Guide to the IPC (Application of Indexing Codes)

1) Please, find below some ARIPO comments on IPC/CE/27/8, dated 18 August 1998.

The document contains a proposal of the USPO to alter the wording of paragraph 80 and 81 of the Guide of the IPC. Although some of the altering may clarify the wording of those paragraphs, others makes it more confusing and makes the usefulness of applying indexing codes doubtful and even senseless

Indeed, applying indexing codes to patent documents is not obligatory for a member of the IPC Union. The Strasbourg Agreement does not mention them because in 1971 they were not yet introduced. However, to mention only that they are not obligatory could be understand that each individual classifier can decide on his own whether or not to apply indexing codes. This is strengthened by the second sentence "Accordingly the need for indexing is determined by each classifier for each patent document and indexing scheme on a case by case basis"

This is not in accordance with the notes in the fields of the IPC where indexing codes were introduced. These notes begin with "It is desirable to add the indexing codes relating to..." (for example C07D, C08F, C08L, C10M, C04B, C05, C22C, C11D and others)

Also the UK "Manual of Patent Practice" (17.102) mentions "The search examiner should classify and/or index the disclosure on both the UK key and the IPC"

2) Furthermore, it is not clear for the user whether or not the hybrid system, provided for in the Classification scheme, is used by the examiner since these systems are "not obligatory" according to the Strasbourg Agreement. Consequently, not all the countries of the IPC Union attribute indexing codes when classifying their documents. Therefore, it is proposed to show the indexing codes on the front page clearly apart from the classification symbols e.g. by a separate entry with its own INID coded and its own abbreviation for example :"Int.Ind." (interantional Indexing)

The more, since it is sometimes very confusing for a nonprofessional in the classification to se the difference between the classification symbols and the indexing codes. Even for an expert it is not always easy to see at a glance the difference between the more important classification symbols and the indexing codes. The classification symbols and indexing codes allotted to one document is sometimes more than three lines on the front page.

your truly,

Mzondi Chirambo
Director General

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