

C. PCT 1488

November 30, 2016

Madam,
Sir,

Use of National Classification Symbols in International Applications

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority and International Preliminary Examining Authority and/or designated or elected Office under the Patent Cooperation Treaty (PCT). It is also being sent to certain non-governmental organizations representing users of the PCT System.

Background

2. The PCT Working Group, at its ninth session, held in Geneva from May 17 to 20, 2016, discussed a working document submitted by the Republic of Korea titled “Specifying National Classifications on the Front Page of Published International Applications” (document PCT/WG/9/26). This working document proposed that, in addition to International Patent Classification (IPC) symbols, national classification symbols assigned by the International Searching Authority and indicated in the international search report could be included in the information set out on the front page of published international applications.

3. Paragraphs 83 to 85 of the Summary by the Chair of the session (document PCT/WG/9/27) outline the discussions of this proposal and the follow-up agreed by the PCT Working Group, as follows:

“83. Several delegations which took the floor supported the principle of the proposal to include classifications other than the International Patent Classification (IPC) on the front page of published international applications, noting that, while referring to “national classification”, it in fact related primarily to the Common Patent Classification (CPC), which was used by many of the Offices which acted as International Searching

Authorities as well as many designated Offices. One delegation mentioned that according to the PCT Administrative Instructions, such information could already be provided in the international search report and made available to examiners and the public. Another delegation suggested that the inclusion on the front page of the published international application of information related to truly national classification systems, which were not used by multiple Offices, would be of limited value and that such information should thus probably appear only in the international search report.

“84. It was recognized that, for the proposal to be implemented in practice, various details needed to be resolved. Quality of classification was essential. Several delegations suggested that applying classifications other than the IPC should not be made compulsory or that International Searching Authorities should only apply classifications such as the CPC if they used it as their national classification system and were therefore experienced in its use. The classification terms should also be properly validated. Classifications were only useful if they could be understood by users, so it was important that any classification schemes involved were easily available, preferably in a range of languages but at least in English. Inclusion of national classification symbols on the front page of the international publication would presumably involve a change to the XML associated with international publication so that the classification information could be imported efficiently into the search databases where it could be useful. This would likely require a significant lead time so that users of the XML could ensure that their systems were able to process it properly. For an effective implementation, the XML of international search reports should also be updated.

“85. The Working Group invited the Korean Intellectual Property Office to work with the International Bureau to develop and discuss the legal and technical issues related to implementation of the principles set out in document PCT/WG/9/26 and also invited the International Bureau to issue a Circular to collect comments and information on national classification from Offices. All the above information would be considered by the Working Group at its next session.”

Legal Framework

4. PCT Rule 43.3(a) states that “the international search report shall contain the classification of subject matter at least according to the International Patent Classification”. Further details on classification are provided in Section 504 of the Administrative Instructions under the PCT. In terms of national classification symbols, Section 504(b) permits their inclusion in the international search report where the corresponding national classification system is used by the International Searching Authority. Where an International Searching Authority uses both the IPC and a national classification system, Section 504(c) states that “the international search report shall, wherever possible, indicate the corresponding symbols of both classifications opposite each other”.

5. In respect of international preliminary examination, PCT Rule 70.5(a) requires the international preliminary examination report to repeat the classification provided by the International Searching Authority, unless the International Preliminary Examining Authority does not agree with that classification. In this case, Rule 70.5(b) requires the International Preliminary Examining Authority to report the classification it considers to be correct at least according to the IPC.

6. Thus, already at present, under the PCT Regulations and Administrative Instructions, the international search report and the international preliminary examining report may contain symbols from both the IPC and any national classification system used by the International

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Searching Authority or by the International Preliminary Examining Authority. For individual International Authorities, this matter is also regulated by Article 6 of the respective Agreement under PCT Articles 16(3)(b) and 32(3)(b) between the Office and the International Bureau in relation to its operation as an International Searching and Preliminary Examining Authority; at present, only the agreement with the United States Patent and Trademark Office (USPTO) specifically provides for the inclusion of national classification symbols by the USPTO in its capacity as an International Authority. All these agreements will expire on December 31, 2017; Circular C. PCT 1479, dated June 24, 2016, has been sent to International Searching and Preliminary Examining Authorities concerning their renewal for a further 10 years from January 1, 2018.

7. National classification symbols are only included in the international search report, not on the front page of the published international application. Thus under paragraph 2.2 of Annex D of the Administrative Instructions, which lists the information extracted from the front page of the international publication for publication in the Gazette, only the IPC symbols are extracted. Any national classification symbols are not extracted for use elsewhere, such as inclusion in any electronic databases.

Discussion of Proposal by the Republic of Korea

8. The proposal by the Republic of Korea in document PCT/WG/9/26 to include national classification symbols on the front page of the international application would allow for their extraction and inclusion in electronic databases. This would benefit designated and elected Offices who use the same national classification system by avoiding duplication of classification work. It would also facilitate any top-up searching in the national phase. One national classification system used by many Offices, including several International Authorities, is the Cooperative Patent Classification (CPC). The International Bureau therefore understands that the proposal primarily relates to the inclusion of the CPC on the front page of the international publication.

9. The International Bureau supports the principle of sharing information between Offices relating to the national classifications of a patent application. However, this does not necessarily require that the information is included on the front page of the international application, where it would take up limited space and largely duplicate information available as IPC codes. Instead, the classification information could be made visible in ways which would allow its more effective use. Specifically, it could be included in the PATENTSCOPE database and in the XML data associated with the international publication so that the classification terms could be loaded automatically into search databases.

Requirements for Sharing Patent Classification Information

10. In the view of the International Bureau, the most important requirement for the sharing of national classification information by the International Searching Authority is that the information should be in a machine readable format both for transmission from the International Searching Authority to the International Bureau and when the International Bureau makes the information available to the public. This would permit automatic importation into IT systems at the International Bureau for inclusion in PATENTSCOPE, avoiding the need for manual transcription, which may introduce errors. Machine readable data published on PATENTSCOPE could then be downloaded for inclusion in the databases of Offices (including designated and elected Offices) and providers of patent search systems. For CPC classification information, a machine readable format would also allow the International Bureau to perform a basic automated check of the symbols applied by the International Searching Authority. This would not, however, be feasible for other national

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classification systems, most of which are used by very few Offices. For the purposes of checking CPC symbols, it would be necessary for the International Bureau to be provided with access to the latest version of the CPC in XML format in a timely manner after revisions to the CPC have been made.

11. As indicated during the discussions at the PCT Working Group, the quality of classification information is also essential (see paragraph 3, above). To minimize erroneous classifications, the International Bureau agrees that applying classifications other than the IPC should not be compulsory. Moreover, an International Searching Authority should only transmit data for national classification systems such as the CPC if the Authority has experience in the use of the classification system. The Working Group also noted that classifications were only useful if they could be understood by users, so it was important that any classification schemes involved were easily available, preferably in a range of languages but at least in English.

12. A further requirement is that the national classification data from the International Searching Authority is transmitted to the International Bureau in a timely manner. Where international search reports are drawn up and transmitted to the International Bureau in XML format, the International Searching Authority could include the national classification symbols in the international search report. Where this is not the case, national classification data would need to be transmitted to the International Bureau as a separate machine readable data element at the time of the international search.

Suggested Way Forward

13. Taking into account the aims of proposal by the Republic of Korea and main requirements for effective sharing of patent classification information, the International Bureau suggests the following approach:

(a) Where the International Searching Authority has experience with classifying subject matter of patent applications using the CPC as a national classification, the Authority may transmit any CPC symbols to the International Bureau. Transmission of CPC data on international applications should only be performed by those Authorities with this experience. International Searching Authorities which use a national classification scheme other than the CPC would also, in principle, be able to transmit such classification data to the International Bureau.

(b) All CPC and other national classification data must be transmitted in a machine-readable format including appropriate identifications of classification type and version, either as part of the classification contained in an XML international search report or, where this is not possible, as part of a separate machine-readable data element. The International Bureau will not re-type any classification codes that it receives in international search reports which are not in XML format.

(c) The International Bureau will import and store national classification information which is in machine readable format and for which the classification scheme is readily available to the public as described in paragraph 11, above. The International Bureau will perform an automated validation of the CPC symbols applied to an international application and contact the International Searching Authority if any discrepancies are found, such as a code being used that is no longer applicable. The International Bureau would not expect to be able to carry out any such validation in respect of any other national classification symbols.

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(d) Any CPC and other national classification data imported will be published on PATENTSCOPE in a machine-readable format, including in the XML data associated with the international publication, but will not appear on the front page of the published international application.

14. International Authorities wishing to include classification information other than the International Patent Classification in international search reports and international preliminary examination reports would need to specify the classification system in the Agreement under PCT Articles 16(3)(b) and 32(3)(b) (see paragraph 6, above).

15. It would seem that this approach could be implemented without any amendment of the PCT Regulations and with only minor changes to the Administrative Instructions (Appendix I of Annex F), ensuring that the XML formats for the international search report and published international application are suitable to hold the classification data in structures which allow it to be validated and imported effectively.

16. Consideration will also need to be given to the processes for maintaining CPC version information in order to ensure that validation can always be performed correctly.

Responses to this Circular

17. At this stage, the International Bureau is inviting your Office to provide comments on the aims and requirements of International Authorities to share national classification data, as discussed in paragraphs 10 to 12, above, and the suggested way forward proposed in paragraphs 13 to 16, above. Taking into account the comments received, the International Bureau will then consider the changes that would be required to IT systems and XML standards and make further proposals needed to implement the proposal.

18. Responses should be sent, preferably by e-mail to Mr. Claus Matthes, Senior Director, PCT Legal and International Affairs Department (claus.matthes@wipo.int; fax: (+41-22) 338 7150) by December 31, 2016. Any comments received by this date will be taken into account in the discussion of a working document at the twenty-fourth session of the Meeting of International Authorities, to take place in Reykjavik, Iceland from February 8 to 10, 2017.

Yours sincerely,



John Sandage
Deputy Director General