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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**

**PROPOSITION EN VUE DE LA MODIFICATION
DES PARAGRAPHES 80 ET 81 DU GUIDE D'UTILISATION DE LA CIB**

Document établi par le Bureau international

1. L'annexe du présent document contient une proposition, soumise par 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, visant à clarifier l'utilisation non arbitraire des codes d'indexation.
2. Les observations sur cette proposition qui seront reçues avant le 20 septembre 1998 feront l'objet d'un supplément au présent document.

[L'annexe suit]

ANNEX/ANNEXE



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

14 July, 1998

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

Re: US Proposal for Committee of Experts Specified in PCIPI/SI/21/6 Final Report,
Paragraph 25, Revision of the Guide to the International Patent Classification

Dear Mr. Makarov,

Attached is a US proposal for additional modifications to the Guide. It is intended to replace all of existing paragraph 80 and the existing portion of paragraph 81 preceding its 'Examples'.

As stated in paragraph 25 of the PCIPI/SI/21 Report, this proposal is meant to clarify, without significant alteration, what our Office believes to be the actual meaning of existing paragraphs 80 and 81 of the Guide to the Sixth Edition of the IPC. We believe the suggested alterations will clarify for all Offices and public users the purpose of the current indexing practice. In our opinion, this must be done to enhance searching by IPC online.

We believe these clarifications are necessary since misunderstanding of the intent of these paragraphs has occurred in some Offices. Also, in our opinion, the current language of these paragraphs does not fully correspond to the oral negotiation history remembered by our US representative during the addition of existing paragraphs 80 & 81 to the 6th edition Guide.

In addition, the Handbook on Industrial Property Information And Documentation, page 5.1.3.24, paragraph 90 may need modified to specify the current practice. In our opinion, it would also be useful to include a new paragraph in Part 5, Chapter 3 of the Handbook for covering 'Indexing Assignment Rules'.

Our proposal assumes that the current status quo with regard to indexing practice will be maintained in the seventh edition. It is not intended, under any circumstances, to be the official US response to paragraph 19 of the Committee of Experts Report IPC/CE/26/8. US reserves the right to revisit the appropriateness of some of the current indexing practices during the discussion of making indexing code assignment mandatory.

Nevertheless, we believe that our proposal will be very useful to the Committee of Experts during their discussion of indexing. Our proposal spotlights all aspects of the current indexing practice. It makes clear that indexing code assignment is currently not obligatory. It specifies that the determination of what is indexed is based on each patent document's disclosure and each particular indexing scheme. It also clarifies the intent of the term 'non-discretionary' and specifies that it is not intended to obligate an Office to require that every classifier use indexing or that all indexing schemes be used. In addition, it graphically illustrates the actual minuteness of disclosure required for assignment to indexing codes. Furthermore, the proposal now clearly specifies that classifiers must avoid any judicious reasoning or selectivity based on the level of disclosed utility when assigning indexing codes within a scheme.

The current 'non-discretionary' practice was not included within the Guide for the 5th edition of the IPC. This would normally indicate to a trained user that this practice did not become official until the start of the 6th edition of the IPC. If this is the case, then the Guide and Handbook should also clearly indicate when the practice became official. This information is important to correctly search older indexing codes since the back file must be searched by the older practice.

Finally, we also included new terminology in our proposal which we hope will avoid the required assignment of redundant indexing codes for subject matter that is already clearly covered within the scope of other assigned codes or classifications. This problem was not discussed during the original inclusion of these new paragraphs into the 6th edition Guide. Nevertheless, US believes that at least some Offices considered this practice to be essentially implied. This belief is consistent with the philosophy already expressed in the terminology in the Handbook's paragraph 90. It states that indexing codes should identify "elements of information in addition to the information covered by one or more of the classification symbols".

The following examples are included to help illustrate this particular problem:

1. The B 29 L indexing scheme clearly includes index codes that overlap. To overcome this problem in obvious situations and avoid useless redundancy, many of the titles involved include either precedence indications or references. However, these safeguards are no longer enforceable (based on its Note (2)) now that non-discretionary application is the new assignment rule in the Guide and they are overridden. The concepts of precedence and references within an Indexing scheme are now entirely inappropriate. I believe my suggested wording would allow their use to continue when helpful to searchers. Furthermore, without my additional wording excessive additional assignment in other codes with overlapping terminology would be required according to some Offices at our meeting. For example, a classifier would be required to assign a 'rod shaped' roller bearing to both index code 31:04 that fully provides for it and to indexing code 31:06 for 'rods' based on its shape. A propeller would need to be assigned both to in indexing code 31:08 that fully provides for it and to indexing code 15:00 based on its shape since the 'blades' are also projections on a rotating hub.

2. In the newly adopted indexing scheme for C 22 C (project C286), a patent document disclosing a ceramic fiber with protective coating (the code's very example of art proper for it) clearly best fits code 121:02 titled "Coated fibers or filaments". However, the current wording of paragraph 80 would also require the classifier to assign this document to indexing code 101:00 titled "Non-metallic fibers or (not of) filaments", since it is clearly a non-metallic fiber or filament too. In our opinion, these titles were intended to be inherently mutually exclusive when only a disclosure to the greater combination was found in the patent document which is supported by the fact that these groups are in a coordinate level of indentation.
3. In the newly adopted indexing scheme for A 61 L (project C319), a patent document disclosing either only a micro-organism (clearly most proper for 101:52 that includes this term in its title), only an enzyme (clearly most proper for 101:54 that includes this term in its title), or only a plant extract (clearly most proper for 101:56 that includes this term in its title) could also broadly fit under coordinate index code 101:32 titled "Organic compounds". In our opinion, these titles were intended to be inherently mutually exclusive when only a disclosure to one of the narrower 'species' is found in the patent document. We believe this opinion is supported by the fact that these groups are in a coordinate level of indentation.

Sincerely yours,

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

cc SIG Members

Proposal For Altering paragraphs 80 and 81 of the IPC Guide

APPLICATION OF THE INDEXING CODES

80. The applying of Indexing codes to a patent document is not obligatory. Accordingly, the need for indexing is determined by each classifier for each patent document and indexing scheme on a case by case basis. Nonetheless, whenever indexing codes are applied to a patent document from a specific indexing scheme associated with one of its classifications, the codes must be applied in a non-discretionary manner. This means that all appropriate indexing codes identifying distinct elements of information about any technical subject found in the patent document should be allotted. This should be done without regard to the extent, novelty, or quality of the specified subject's disclosure in the patent document so long as it falls within the scope of the title of the indexing code being assigned (i.e., mere naming of subject without any additional disclosure is sufficient). The intent of this policy is to ensure the uniformity of indexing code assignment by avoiding any judgmental selectivity by classifiers on whether or not the allotment to patent documents of particular indexing codes in the scheme is beneficial to searchers. Therefore, all of the indexing codes in the scheme specifying distinct elements of information in the patent document are assigned to it, unless that particular information has already been clearly specified as such by either a classification code or a more appropriate indexing code in the scheme (e.g., two indexing titles in the scheme partially overlap in scope, but one is clearly more descriptive of this information). This policy may be departed from in very exceptional circumstances when non-discretionary indexing would result in an unjustifiable number of indexing codes being applied to a patent document, e.g., indexing of "Markush"-type formulae. In these situations, only the indexing codes in the scheme covering subject matter having a significant disclosure should be assigned to the patent document. Furthermore, because of the broad scope of many indexing code titles, in situations where a single element of information disclosed in a patent document could be covered by the titles of several indexing codes within a scheme, only the indexing code which most completely provides for all the aspects of the single element of information should be applied.

81. Assignment practice to subordinate indexing codes in a hierarchical indexing scheme is different in one aspect to that in a similarly arranged classification scheme. Whereas in a classification scheme a hierarchically higher group may cover combinations of subject matter composed of distinct components separately classifiable in two or more of its subdivisions (see paragraph 70, above), in an indexing scheme the hierarchically higher group is only used to cover unprovided for residual subject manner within the scope of its title (i.e., to cover specific features not provided for, or utilized exclusively in combination with, the subject matter covered in any of its subdivisions, for example such as distinct disclosed species). For example, when indexing a patent document disclosing a combination of plural distinct elements of information covered by two or more subordinate indexing codes in a hierarchical indexing scheme, only the subordinate indexing codes providing for each of the distinct elements are allotted and not the hierarchically higher code.