

Patent Cooperation Treaty (PCT) Working Group

Tenth Session
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USE OF NATIONAL CLASSIFICATION SYMBOLS IN INTERNATIONAL APPLICATIONS

Document prepared by the International Bureau

SUMMARY

1. The International Bureau recommends that International Searching Authorities which use the Cooperative Patent Classification (CPC) as a national classification system be encouraged to classify international applications according to that system and that the International Bureau record the classifications and make them available for search in PATENTSCOPE and for download for use in other patent databases. This can be achieved with no changes to the PCT Regulations. Enabling provisions can be incorporated into the new agreements between the International Searching Authorities and the International Bureau which the PCT Assembly will need to approve this year.

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 international applications. It was understood that this would apply primarily to classification using the CPC. Paragraphs 198 to 214 of the Report of the session give details of the discussion; paragraph 214 outlines the follow up agreed by the Working Group:

“214. 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

3. 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”.
4. 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.
5. 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 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.
6. At the twenty-fourth session of the Meeting of International Authorities, held in Reykjavík from February 8 to 10, 2017, the Meeting approved a draft model agreement to form the basis of individual agreements between the International Authorities and the International Bureau under Articles 16(3)(b) and 32(3)(b) from January 1, 2018 (see the Annex to document PCT/MIA/24/2 and paragraphs 30 and 31 of the Summary by the Chair of the session, document PCT/MIA/24/15). Article 6 of this draft model agreement allows for an Authority to indicate the classification of the subject matter in accordance with Rules 43.3(a) and 70.5 according to any other patent classification, as specified in an Annex to the agreement. An Authority could therefore indicate that it would add CPC symbols to its international search reports and international preliminary examination reports by notifying an amendment to this Annex.
7. National classification symbols are presently 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. Furthermore, any national classification symbols are not presently extracted for use elsewhere, such as inclusion in any electronic databases.

CIRCULAR C. PCT 1488

8. To follow up the invitation from the Working Group (see paragraph 2, above), the International Bureau issued Circular C. PCT 1488, dated November 30, 2016, addressed to Offices in their capacities as a receiving Office, International Searching and Preliminary Examining Authority and/or designated or elected Office, and to certain non-governmental organizations representing users of the PCT System.

9. Paragraphs 13 to 16 of the Circular C. PCT 1488 suggested the following way forward with regard to the proposal by the Republic of Korea:

“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 *[of Circular C. PCT 1488]*, 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.

(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 *[of Circular C. PCT 1488]*, above *[this paragraph is identical to paragraph 5, 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.”

DISCUSSION OF RESPONSES

10. To date, 18 Offices have responded to the Circular; the responses by those Offices are summarized and discussed in the following paragraphs.

11. Almost all Offices supported the suggested way forward discussed in paragraphs 13 to 16 of the Circular.

12. Offices also gave broad support to the aims and requirements of International Authorities to share national classification data, as discussed in paragraphs 10 to 12 of the Circular. One Office did, however, consider that the requirement for an International Searching Authority to have experience in the use of the CPC to transmit CPC symbols to the International Bureau was unclear; this Office suggested that parameters could be established to determine whether an International Searching Authority had the necessary experience.

13. Two Offices raised the issue of availability of the Cooperative Patent Classification (CPC) scheme in different languages. One of these Offices, while supporting the way forward suggested in the Circular (reproduced in paragraph 9, above), underlined that the CPC should be easily available to the public in various languages and could include a condition akin to Article 3(1) of the Strasbourg Agreement Concerning the International Patent Classification: “The Classification shall be established in the English and French languages, both texts being equally authentic.” The other Office did not support the proposal to include CPC symbols and national classifications on the front page of international applications because this information would be of limited value to users in countries using languages other than English, adding that there was no intention for the CPC to be translated into the national language of that Office.

14. The need for clarity on the CPC version used in classification by the International Searching Authority and access to this version in XML format to the International Bureau was raised by some Offices. One Office expressed concern about any additional workload by the International Bureau if there were discrepancies in the CPC data and suggested that there could be an option to suspend inclusion of CPC symbols in data shared between Offices and included in PATENTSCOPE if the latest CPC version was not available to the International Bureau in an acceptable format. Another Office stated that there was a CPC Standard, largely based on WIPO Standard ST.8, which enabled the Office to indicate the CPC version used for classification. This Office also referred to the website of the CPC (www.cpcinfo.org) where information on valid XML symbols was available for download for each CPC version.

15. Some Offices stated their support for *not* including national classification information, such as the CPC, on the front page of the international application, as proposed in paragraph 9 of the Circular, but instead making the information visible through databases. In view of the limited space on the front page of the international application, these Offices cited the potentially high number of additional classification symbols and duplication of the IPC data as reasons for not supporting national classification symbols on the front page. These Offices also referred to the more frequent modifications of the CPC compared to the IPC and the fact that the classifications on the front page of documents were in practice never used during a search since searches were nowadays performed using electronic tools.

16. Some other Offices, while supporting the way forward proposed in paragraphs 13 to 16 of the Circular, believed that there was additional benefit to Offices, applicants and third parties by including the CPC or national classification symbols on the front page of the international application. One of these Offices wished discussions to continue on this matter.

17. One Office, while agreeing that the proposal would provide a positive effect on improving search efficiency, requested Offices to discuss and study further the use of Cooperative Patent Classification (CPC) symbols on international applications. This Office cited non-reciprocal exchanges of classification symbol data, the uneven quality of CPC classification and the reclassification workload and resource commitment brought by the revision of the CPC as issues that could need further investigation.

DISCUSSION AT THE TWENTY-FOURTH SESSION OF THE MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

18. The use of national classification symbols in international applications was discussed by the Meeting of International Authorities, at its twenty-fourth session, held in Reykjavík from February 8 to 10, 2017 (see document PCT/MIA/24/12). The Summary by the Chair of the session summarizes the discussions in paragraphs 52 to 57 of document PCT/MIA/24/15, as follows:

“52. Discussions were based on document PCT/MIA/24/12.

“53. Authorities supported the proposal for International Searching Authorities with sufficient experience in using the Cooperative Patent Classification (CPC) symbols to transmit them to the International Bureau in XML format for inclusion in the PATENTSCOPE database. One Authority indicated that it understood the term “sufficient experience” to mean that it would be sufficient for the International Searching Authority to utilize the CPC as part of their regular national classification process.

“54. The European Patent Office stated that validation of the CPC symbols should be done at source before transmission to the International Bureau to improve the quality of data. In this regard, the European Patent Office provided a web service for other International Searching Authorities to validate the CPC symbols. Another Authority questioned whether the International Bureau had the resources to validate and correct the CPC symbols provided by the International Searching Authority.

“55. One Authority stated that there could be value to adding national classification symbols on the front page of published international applications. This Authority, in its capacity as a designated Office, did not currently retrieve XML data from PATENTSCOPE. Moreover, in its capacity as an International Searching Authority, the Authority did not transmit international search reports to the International Bureau in XML, but it hoped to do so in the future. Another Authority stated that only International Patent Classification (IPC) symbols should be included on the front page of international patent applications.

“56. The Korean Intellectual Property Office thanked Authorities for their comments on the document and stated that it would continue working with the International Bureau in preparation of the discussions at the PCT Working Group.

“57. The Meeting noted the contents of document PCT/MIA/24/12.”

NEXT STEPS

19. The International Bureau intends to make proposals to allow for the possibility of International Searching Authorities to transmit CPC symbols and national classification information to the International Bureau, provided the data has been validated by the International Searching Authority and is transmitted in machine-readable format, as explained in paragraphs 13 to 16 of Circular C. PCT 1488, reproduced in paragraph 9, above, taking into account the responses to this Circular and comments at the twenty-fourth session of the Meeting of International Authorities and this session of the Working Group.

20. The International Bureau continues to recommend that CPC and other national classification data be made available electronically for use in databases, but not be included on the front page of the published international application. While a number of Offices, in their responses to Circular C. PCT 1488, stated that they would find the inclusion of the CPC on the front page useful, on balance, the International Bureau considers that the benefits would be outweighed by the disadvantages and costs of change, noting especially the following points:

- (a) Given the close relationship between the IPC and CPC, putting both on the front page would be largely duplicative, noting the limited space on the front page of the international application and the risk of the extra symbols providing distraction, rather than significant additional information which would be useful in that context.
- (b) The CPC is not maintained in multilingual versions, which makes it less accessible than the IPC.
- (c) The CPC undergoes more frequent modifications, so the fixed format information on the front page is likely to go out of date quicker than the IPC, whereas the electronic formats can be updated as the documents are later reclassified.

21. *The Working Group is invited:*

(i) to note the responses received to Circular C. PCT 1488, as discussed in paragraphs 10 to 17, above, and the discussion at the Meeting of International Authorities, as discussed in paragraph 18, above; and

(ii) to comment on the next steps proposed in paragraphs 19 and 20, above.

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