

WIPO



IPC/CE/31/4 Suppl.1
ORIGINAL: English
DATE: February 26, 2002

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**SPECIAL UNION FOR THE INTERNATIONAL PATENT CLASSIFICATION
(IPC UNION)**

COMMITTEE OF EXPERTS

**Thirty-First Session
Geneva, February 25 to March 1, 2002**

COMMENTS ON DOCUMENT IPC/CE/31/4

Document prepared by the International Bureau

The Annex to this document contains comments submitted by Sweden, concerning recommendations formulated by the ad hoc IPC Reform Working Group (see document IPC/CE/31/4).

[Annex follows]

Swedish Patent and Registration Office

References in the IPC

February 20th, 2002

Limiting and informative references - some additional thoughts

At REF/6 the following definition of limiting references was adopted:

"A limiting reference is a reference associated with a classification place, that:

- **(a) excludes specified subject matter from the scope of this classification place, when this subject matter would otherwise fulfill all the requirements of the classification title and definition; and**
- **(b) indicates the place(s) where this subject matter is classified."**

It is obvious from discussions in the definition projects that the situation is still not clear. The difficulties are caused by several issues. (b) causes no problems, and is in fact not a definition but a rule for how references should be worded.

However, (a) is more difficult. The first part of (a) is clear - a limiting reference excludes matter from the scope of the place. The second part causes problems, since it does not relate to the first part, but to "requirements of the classification title and definition", which is not the same as the "scope of the place". The expression "requirements" does not reflect any current wording in the Guide. The Guide (see especially paragraph 32) does not talk about "requirements", it talks about what is "covered" or "provided for" by a place. These expressions mean that the matter which is appropriate for classification "has characteristics enabling the subject matter to be classified" in the place. These characteristics are not dependent on only the title (or its definitions), but the words "enabling ... to be classified" encompass the general rules of classification.

Subject matter that fulfils the "requirements of the title and definition" of a place might still not be classifiable in that place, because of general rules, notes or other placement rules. One example is references pointing downwards in a last place rule scheme. With the definition given above they would be considered limiting, whereas they in reality are redundant and do not affect classification.

We would prefer changing the wording of the definition to

"A limiting reference is a reference associated with a classification place, that:

- **(a) excludes specified subject matter from the scope of the classification place, when this subject matter would have been covered by the classification place if the reference had not existed, and**
- **(b) indicates the place(s) where this subject matter is classified."**

We think this is more correct, and also easier to read and understand. **However, we would still recommend, for use of the persons who develop schemes, a list of situations where references are definitely limiting or informative.**

Are references to "specially adapted" places limiting or informative?

Why is this question important? The reason is that a specially adapted "thing" kills the novelty of the same "thing" when the "thing" is claimed in a wider manner. It is therefore of crucial importance to be able to find "specially adapted things" also when searching for "things in general". If an applicant files an application for a "thing", claimed or disclosed only for a particular application, and it is classified only in a place for that application, then that document will be hidden if someone at a later date files an application for an identical "thing" without the limitation to the specific purpose. For this reason it must be ensured that the general places are complete for information that is of a general nature. This will not be the case if "specially adapted" matter is referred out by limiting references.

According to paragraph 59(b) a technical subject should be classified in both a function-oriented place and an application place if essential technical characteristics relate both to the intrinsic nature or function of a thing and to its special adaptation to a larger system. Since this multiple classification is accepted, the subject is still covered by the place where the reference stands. The reference does not exclude matter and can therefore not be limiting. This is true for all references between function-oriented places and application places.

The question might arise whether the expression "specially adapted" is so strict as to rule out any general interest. This is not the case - according to Paragraphs 41 and 53 the expression "specially adapted for" means that the subject matter in question **"has been modified or particularly constructed for the given use or purpose"**. This does not require adaptation that is so uniquely special that it can have no general applicability.

It should be noted that Paragraph 69 gives a much stricter definition of adaptation: **"When constructional or functional details or parts are only applicable to, or only of use for, one specific kind of apparatus, they are classified only in the place for that apparatus"**. This should be done regardless of whether there is a particular classification place for the uniquely adapted detail in the specific application area or not. In this case there is a mutually exclusive situation - the detail or part is so uniquely adapted as not to be of general interest. However, even in this case a reference between a general place and the "uniquely adapted" place would not be limiting, since the uniquely adapted detail is not covered by the general place and thus can not be removed from its scope!

What is the scope of a reference - should it be interpreted in an "inclusive" manner or should it be interpreted as covering only the matter referred out "per se"?

This question arose because of the introduction of group G21B 1/01 was not seen as resulting in a change of scope for G21C. This is the situation in IPC7:

G21B	Fusion reactors
G21C	Nuclear reactors (fusion reactors G21B)

This is what has been adopted by WG6:

G21B Fusion reactors
N G21B 1/01 Hybrid fission/fusion nuclear reactors
G21C Nuclear reactors (fusion reactors, hybrid fission/fusion reactors G21B)

No change in the scope of G21C was indicated as a result of this modification. If references are interpreted as "inclusive", this is correct. In that case, the IPC7 reference means that any reactor that to any extent operates with fusion is referred out of G21C and covered by G21B.

If references are seen as limited to the matter referred out per se, the situation in IPC7 would have been that only fusion reactors per se were referred out. Hybrid fission/fusion nuclear reactors would then be seen as a combination of matter of G21B and G21C, and therefore, according to Paragraph 70, classified in both these subclasses. If this is the correct interpretation it means there is a difference between limiting references and precedence references in the case of combinations - if the reference in G21C had said "G21B takes precedence", combinations would have gone into G21B.

We think a general "inclusive" interpretation of references is dangerous, and we doubt that all references in the IPC has been drafted with that interpretation in mind. In the future we think references should be worded more carefully in order to avoid this ambiguity.

Anders Bruun

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