

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Twelfth Session
Geneva, December 12 to 16, 2005

IMPLICATIONS OF IPC REFORM FOR THE INTERNATIONAL AUTHORITIES

Document prepared by the International Bureau

1. At its eleventh session, held in February 2005, the Meeting discussed implications of International Patent Classification (IPC) reform for the International Searching Authorities (ISAs), noted the effects of changes resulting from the reform to the classification of PCT applications in international search reports (ISRs) and agreed that further investigation of the effects of IPC reform was necessary (see document PCT/MIA/11/14, paragraphs 23 to 28).
2. As a follow-up, the International Bureau (IB) issued, on April 25, 2005, Circular PCT 1031 with a questionnaire requesting information from the ISAs on their plans in respect of recording IPC symbols in ISRs when IPC reform comes into effect. A summary of replies to Circular PCT 1031 is attached as Annex I.
3. Certain conclusions drawn from the replies are presented at the end of the summary. One of the conclusions was that most of the ISAs would continue to transmit ISRs on paper after January 1, 2006, and there would be problems in using a tabular presentation of IPC symbols or different fonts for indicating invention or non-invention information on form PCT/ISA/210. It was requested that the IB elaborate recommendations for minimum classification information to be presented on form PCT/ISA/210 and other relevant forms.

4. On September 29, 2005, the IB issued Circular PCT 1047 outlining the procedure for reporting erroneous IPC symbols to the ISAs and containing recommendations on the presentation of IPC symbols in ISRs and on other relevant PCT forms. This Circular is attached as Annex II.

5. It should be noted that the recommendations made in Circular PCT 1047 aimed to facilitate presentation of IPC symbols on PCT forms in accordance with requirements of IPC reform and to ensure correct transfer of the symbols to published international applications. If an ISA is not in a position to follow these recommendations because, for example, of the design of its computer system, it is requested that the ISA present a clear sample showing how IPC symbols will be recorded, in particular in Box A of form PCT/ISA/210.

6. The Meeting is invited to take note of the information given in Annexes I and II and to comment on any issues arising.

[Annexes follow]

ANNEX I

SUMMARY OF REPLIES TO CIRCULAR PCT 1031 CONCERNING IMPLICATIONS OF
IPC REFORM FOR THE PCT INTERNATIONAL AUTHORITIES

Introduction

At its eleventh session, held in February 2005, the Meeting of International Authorities under the PCT (PCT/MIA) discussed implications of International Patent Classification (IPC) reform for International Authorities and agreed that further investigation of the effects of IPC reform was necessary (see document PCT/MIA/11/14, paragraphs 23 to 28). As a follow-up, the International Bureau (IB) issued, on April 25, 2005, Circular PCT 1031 with a questionnaire requesting information from the Authorities on their plans in respect of recording IPC symbols in International Search Reports (ISRs) when IPC reform comes into effect. A questionnaire attached to the circular is contained in the Annex to this summary.

The following 11 International Searching Authorities (ISAs) returned the completed questionnaire: the Austrian Patent Office (AT), the Canadian Intellectual Property Office (CA), the European Patent Office (EP), the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (RU), IP Australia (AU), the Japan Patent Office (JP), the National Board of Patents and Registration of Finland (FI), the Spanish Patent and Trademark Office (ES), the State Intellectual Property Office of the People's Republic of China (CN), the Swedish Patent and Registration Office (SE), and the United States Patent and Trademark Office (US).

The replies received are summarized under each question of the questionnaire. A cumulative table of replies, as well as some conclusions and remarks, are presented at the end of the summary.

Questions and Replies

Monitoring the validity of IPC symbols of the eighth edition indicated in ISRs

The IPC valid symbols file produced by the IB is used by offices for checking the validity of IPC symbols assigned to patent documents before their publication. The IB will produce the IPC valid symbols file for the eighth edition well in advance before its entering into force and ISAs should establish a system of monitoring the validity of IPC symbols assigned on the basis of the said IPC valid symbols file.

A system of monitoring the validity of IPC symbols will also be established at the IB. Where invalid symbols are found to have been entered on an ISR, the ISA concerned will be notified and requested to update or correct the classification.

1. Will your Office be able to implement a system of monitoring the validity of IPC symbols of the eighth edition of the IPC by the time when the eighth edition comes into effect?

Yes

No

Replies:

Yes: AT, AU, CA, CN, EP, ES, FI, JP, RU, SE

No: US

2. If the response to question 1 is “No”, when does your Office plan to implement a system of monitoring the validity of IPC symbols?

Reply:

US: The validation of IPC symbols is currently planned for mid-2006.

Periodical update of the IPC valid symbols file

After the entering into force of the eighth edition of the IPC, the IB plans to update the IPC valid symbols file every three months, according to the revision amendments of the advanced level of the IPC. ISAs will need to foresee the periodical replacement of the valid symbols file in their internal IT systems.

3. Please describe any problems with the periodical update of the IPC valid symbols file that your Office can foresee.

Replies:

AT, AU, EP, FI and US foresee no problems.

- CA: – Timely delivery of symbols update and MCD files will be critical.
- Manual update of invalid symbols – depending on the number of symbols which become invalid for such an update, we may have an issue with our normal workload (i.e. handling normal classification, reviewing granted patent symbols, etc.) and the reclassification of invalid symbols.
 - No process exists yet for the update of symbols on an ISR if the ISR was already sent to WIPO and that some of the symbols are no longer valid. Responsibility has not been decided either on this issue.

CN: It takes 3 months to prepare the publication of the granted documents. If the update of the IPC happens in that period, there may be differences between the documents in preparation and documents updated.

- ES: – Updated information about IPC changes.
– Changes before publication and different publications (A1, A3, B1, B2).
– Translation of the IPC into Spanish and update of the version.
– Reclassification of Spanish documents.
– Classification with ECLA and update of the concordance table ECLA/IPC.
– Load the IPC in the local databases.
- JP: Even though ISAs follow the periodical update of the IPC valid symbols file, it will face a basic problem. When an ISA has to establish an ISR long time before the international publication date (e.g., international application without claiming priority), the ISA is not able to know IPC symbols which are valid on the international publication date. This problem is applicable not only to JPO but also to all International Authorities.
- RU: It is desirable to have in place a procedure of notification about updates and changes in the IPC valid symbols files, whereas the updates and updated file itself could be posted on WIPO Website for free access of interested offices.
- SE: – Updating of classifications when ISRs are established a long time before publication.
– In some cases it will be necessary to know the exact date of publication in order to give a correct classification.

Transmission of ISRs to the IB

ISRs are currently transmitted to the IB on paper or electronically. If an ISR containing classification data according to the eighth edition of the IPC is submitted on paper, IPC symbols should be presented according to the revised version of WIPO Standard ST.10/C (“Presentation of Bibliographic Data Components”) which will be valid from January 1, 2006, onwards. If an ISR containing classification data according to the eighth edition of the IPC is submitted electronically, IPC symbols should be recorded according to the revised version of WIPO Standard ST.8 (“Standard Recording of International Patent Classification (IPC) Symbols on Machine-Readable Records”) which will also be valid from January 1, 2006, onwards.

4. Does your Office plan to transmit ISRs to the IB on paper or electronically by the time when the eighth edition of the IPC comes into effect?

on paper electronically

Replies:

On paper: AT, AU, CN, EP, JP, RU, SE, US

Electronically: CA, ES, FI

5. If the response to question 4 is “On paper”, please describe any problems that your Office may have with regard to the use of the revised WIPO Standard ST.10/C and how your Office plans to implement this Standard.

Replies:

AT, AU, CA, ES and FI did not indicate any problems.

CN: We are now undergoing the preparation of PCT-SAFE software for the future filing. Once that's accomplished, the electronic file would be presented.

EP: – Only the IPC symbols themselves can be printed on the ISRs. All IPC given by EPO is advanced level, so there is no need to indicate this separately.
– Invention and additional information will be indicated, but not using different fonts, because our printing routines for the ISRs currently do not support bold fonts.
– Version information cannot be printed, because it is generated in a later step of the procedure.

JP: It is virtually impossible to present IPC symbols in tabular form, because of the column size for IPC. Japan Patent Office will indicate IPC symbols separating by commas.

RU: There are no plans to use various fonts to differentiate various meanings of IPC symbols in the record of ISR (i.e. to differentiate first and later symbols, invention information and non-invention information). The said purpose could be achieved by arranging IPC symbols in fixed positions (e.g. columns) according to the indicated categories.

SE: Unless the layout of the forms is changed, it will in some cases be difficult to present all classification symbols in column form. It is suggested to present them as a string instead, separated by commas.

US: USPTO will not provide the version indicators for IPC symbols in the field of search. The version indicators can be erroneous or of little value when a range of classification is specified.

6. **If the response to question 4 is “On paper”, when does your Office plan to move to the electronic transmission of ISRs to the IB?**

Replies:

CA, ES and FI will use the electronic transmission of ISRs as of January 1, 2006.

AT: 2006 - 2007

AU: During 2006

CN: The same as the operation mode of PCT-SAFE. Now we are discussing the filing manner of electronic ISRs with the WIPO PCT working team. After its completion, ISRs will be transmitted electronically.

EP: There are currently no exact plans to move to electronic transmission. We are however in the process of developing electronic search reports for EP searches.

JP: It is planned at the end of March 2006.

RU: Assumably by January 1, 2007.

US: The ability to transmit the ISR electronically is tied to the incorporation of international application processing into the USPTO's new system for electronic processing of applications (IFW). This integration is currently scheduled for late spring/early summer 2006.

7. **If the response to question 4 is “Electronically”, please describe any problems that your Office may have with regard to the use of the revised WIPO Standard ST.8 and how your Office plans to implement this Standard.**

Replies:

AT, AU, CN, EP, FI, JP, RU, SE and US did not indicate any problems.

CA: ST.8 should be fairly easy to use but if the ISR is sent in a PDF format, we will use ST.10/C more than ST.8.

ES: As far as OEPM knows, the exchange to EDI is going step by step. Although in the future they should be in ST.36 format, and the IPC should be in compliance with ST.8, this will take some time. Some help from WIPO would be welcome specially by creating clear instructions about how to proceed.

8. Does your Office plan to use the new WIPO Standard ST.36 (“Recommendation for the Processing of Patent Information using XML (Extensible Markup Language)”) for the electronic transmission of ISRs when the eighth edition of the IPC comes into effect?

Yes

No

Replies:

Yes: AU, CN (all the new systems under development will be in accordance with ST.36), ES, FI, RU, US (when USPTO is ready to transmit ISRs electronically)

No: AT, CA, EP, JP, SE

9. If the response to question 8 is “No”, what other Standard does your Office plan to use for the electronic transmission of ISRs?

Replies:

AU, CN, ES, FI, RU and US plan to use ST.36

AT: Has to be defined in 2006.

CA: CIPO is currently investigating new ways to handle forms, in particular, the XFORM quasi-standard. Since DTDs do not exist yet, we had to create our own fields and we hope it will not be too much work to redo the forms in the case you would accept the data in XML format. We may start using PDF very soon to send the forms electronically to WIPO, but in the long run, this would not make sense, and we would send you our XML version of the form if the XFORM pilot is successful. And if in XML format, then CIPO will issue the ISRs in the ST.36 standard.

EP: See under Question 6.

JP: JPO does not plan to transmit ISRs to the IB electronically when the eighth edition of the IPC comes into effect.

SE: When we start sending ISRs in electronic form we will apply ST.36.

10. **Remarks**

Replies:

AT, AU, CN, EP, ES and FI did not make any remarks.

- CA: – CIPO still considers that publishing of file specifications 6 months prior to production places a high degree of risk on our ability to meet the deadline. This is true primarily because we need to build brand new processes to handle these files.
- We answered very similar questions via a questionnaire entitled "implementation of IPC reform" around August 21, 2003. That questionnaire had been sent to us by fax.
 - If we answer Yes to some questions like question 1, we have no place for comments. Sometimes, we can deliver electronically but still have issues with the process.
- JP: – In relation to the question 3, when an ISA has to establish an ISR long time before the international publication date (e.g., international application without claiming priority), the ISA is not able to know IPC symbols which are valid on the international publication date. In such case, some countermeasure is needed. For instance, the IB needs to revise or correct the IPC symbols on the ISR when the IB assigns to PCT applications the IPC symbols for international publication
- In relation to the question 8, the electronic transmission of ISRs is not realistic without XML style sheet for ISR. It is appreciated if IB provides the schedule for completion of the style sheet.
- RU: It would be desirable that International Bureau could establish prototype software for filling in various PCT forms including ISR forms which could be adapted by national offices for their specific circumstances.
- SE: According to Rule 70.5, the IPER shall contain classification data. Since the classification given at publication will in many cases be obsolete, and since it will be difficult to keep updated classifications synchronized with the IPC Master Classification Database we propose that this requirement is dropped.
- US: USPTO plans to modify its ISR processing software. However, USPTO is waiting for the IB to provide guidance on the presentation of IPC Reform information on the ISRs. Also as mentioned above, providing version indicators for IPCR may not be accurate or useful when ranges are specified in the Field of Search.

Cumulative table of replies

Question	1	2	3	4	5	6	7	8	9	10
Office										
AT	Y	-	-	Paper	-	2006-2007	-	N	X	-
AU	Y	-	-	Paper	-	In 2006	-	Y	-	-
CA	Y	-	x	Electr.	-	-	x	N	X	x
CN	Y	-	x	Paper	x	x	-	Y	-	-
EP	Y	-	-	Paper	x	No plan	-	N	See 6	-
ES	Y	-	x	Electr.	-	-	x	Y	-	-
FI	Y	-	-	Electr.	-	-	-	Y	-	-
JP	Y	-	x	Paper	x	End march 2006	-	N	X	x
RU	Y	-	x	Paper	x	1/1/2007	-	Y	-	x
SE	Y	-	x	Paper	x	-	-	N	X	x
US	N	mid 2006	No	Paper	x	x	-	Y	-	x

Y → Yes

N → No

- → no comment

x → comment submitted

Some conclusions and remarks:

1. re Questions 1 and 2

The majority of ISAs will implement a system of monitoring the validity of IPC symbols by January 1, 2006.

2. re Question 3

A procedure of notification about updates of the IPC and changes of the validity file should be implemented on the WIPO IPC website.

3. re Questions 4 and 5

Most of ISAs will continue to transmit ISRs on paper after January 1, 2006. Form ISA/210 is not accommodated to the use of IPC reform symbols and ISAs will have problems in their recording on the form, e.g. in using a tabular form of presentation of symbols or different fonts for indicating invention or non-invention information. IB should elaborate requirements for minimum classification information to be presented on form ISA/210 using default values for symbol indicators. Also recommendations should be given on presentation of classification information on other relevant forms, e.g. ISA/203, IPEA/408, IPEA/409.

4. re Question 6

Most of ISAs which will continue transmission of ISRs on paper after January 1, 2006, plan to move to the electronic transmission in the course of 2006.

5. re Questions 8 and 9

Most of ISAs plan to use ST.36 in the electronic transmission of ISRs.

[Annex II follows]

ANNEX II

WORLD INTELLECTUAL PROPERTY
ORGANIZATION

世界知识产权组织

ORGANIZACIÓN MUNDIAL
DE LA PROPIEDAD INTELECTUAL



ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. PCT 1047
-21.1

September 29, 2005

Madam,
Sir,

This Circular is addressed to your Office in its capacity as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT). The circular concerns an outline of the procedure for the International Bureau to report erroneous IPC symbols to the International Searching Authorities, and certain changes in the presentation of IPC symbols following the introduction of the 8th edition of the International Patent Classification (IPC) on certain PCT Forms.

Edition 8 IPC symbol error reporting between the IB and the ISA

In order to ensure that the Edition 8 IPC symbols published are correct and up-to-date, as agreed in the PCT Meeting of International Authorities held in Geneva from February 21 to 25, 2005 (see document PCT/MIA/11/14, paragraph 26), the International Bureau will undertake to verify whether the IPC symbols and version dates mentioned on the ISR reconcile with the Edition 8 IPC validity file. This check will be performed by the International Bureau as soon as the ISR is received, taking into account the projected publication date. If the IPC symbols do not reconcile because a symbol or version date is incorrect in light of the projected publication date, the International Bureau will report such errors to the relevant International Searching Authority.

The International Bureau will transmit either by e-mail or via network transfer to each ISA on a weekly basis, an IPC symbol error report in the form of both a CSV file and an XML file, containing the following information for each international application concerned:

- IA number
- Projected publication date
- IPC symbol
- Type of error: (i) erroneous IPC symbol; (ii) erroneous version indicator; (iii) IPC symbol will be invalid at the time of the projected publication date.

/...

Following this invitation, your Authority would be requested to provide the corrected or up-dated IPC symbol either by issuing a revised or corrected international search report or, at the choice of your Office, by separately furnishing the International Bureau with the correct symbols in electronic form as either a CSV file or an XML file. It is important that best efforts are made to provide the required IPC data to the International Bureau before completion of technical preparations for publication of the international application concerned.

In order to make the necessary technical arrangements for the appropriate transmission method, your Authority is requested to inform the International Bureau, as soon as possible, of the name and e-mail address of the person who can be contacted regarding this matter, by e-mail to pctis@wipo.int and preferably before October 31, 2005.

Format and presentation of IPC symbols (WIPO Standard ST 10/C)

In accordance with WIPO Standard ST.10/C, for IPC symbols of the 8th edition of the IPC, a tabular presentation is recommended to be used. However, the space available on the following current Forms is not sufficient for such a presentation:

- International Search Report (PCT/ISA/210)
- Written Opinion of the ISA (PCT/ISA/237)
- Declaration of Non-establishment of International Search Report (PCT/ISA/203)
- International Preliminary Report on Patentability (PCT/IPEA/409).

Since the PCT Meeting of International Authorities held in Geneva from February 21 to 25, 2005, had nevertheless considered that it would be preferable not to change the international search report form (see document PCT/MIA/11/14, paragraph 26) and since several Authorities in reply to the questionnaire attached to Circular C.PCT 1031, dated May 25, 2005, requested the advice of the International Bureau on how to comply with the recommendations of Standard ST.10/C in this respect, the International Bureau recommends that the International Authorities insert the standard phrase “See extra sheet” or “See supplemental box”, as the case may be, in the boxes foreseen for IPC symbols on the above-mentioned Forms. In this way, the IPC symbols can be presented in the recommended tabular form in compliance with WIPO Standard ST.10/C on the corresponding extra sheets or supplemental boxes that are intended for use when the space on other sheets is not sufficient.

./. For an illustration, please see the attached sample of a partially filled-in international search report (Form PCT/ISA/210).

With regard to the “Declaration of Non-establishment of International Search Report” (Form PCT/ISA/203), no extra sheet or supplemental box currently exists for this form. However, due to the fact that this form is only used when no international search report is established, it would seem unlikely that an ISA would wish to establish multiple IPC symbols in such cases, and therefore the space provided in the box would seem to be sufficient for a tabular presentation of the IPC symbol.

Indication of the validity date

It is recommended that the International Authorities always indicate the validity date after the IPC symbol, even in cases where there has been no update or reclassification since January 1, 2006, for example, B 28B 5/02 (2006.01).

Distinction between invention and non-invention IPC symbols

Since a number of Offices have expressed, in reply to Circular C.PCT 1031, some difficulty in being able to reproduce bold characters in order to distinguish between invention and non-invention information in the production of the Forms listed above, the International Bureau recommends that, if your Authority is not able to present the IPC symbols in distinct bold and non-bold characters, the indication “i” or “n” be inserted instead at the end of each IPC symbol after the validity date, so that the International Bureau can clearly distinguish between invention (“i”) and non-invention (“n”) information and be able to subsequently publish the IPC symbols in either bold or normal characters in the international publication, as shown in the following:

“B28B 5/02 (2006.01)i” shall be published by the IB as **B28B 5/02 (2006.01)**
“H05B 31/08 (2007.01)n” shall be published by the IB as *H05B 31/08 (2007.01)*.

Comments, if any, are invited to be provided by October 31, 2005, preferably by fax to (+41 22) 910 00 30 or by e-mail to pct.legal@wipo.int.

Sincerely yours,



Francis Gurry
Deputy Director General

Enclosure: Annex I– Sample pages of Form PCT/ISA/210

INTERNATIONAL SEARCH REPORT

International application No.

<p>A. CLASSIFICATION OF SUBJECT MATTER See extra sheet</p> <p>According to International Patent Classification (IPC) or to both national classification and IPC</p>								
<p>B. FIELDS SEARCHED</p> <p>Minimum documentation searched (classification system followed by classification symbols)</p> <p>Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched</p> <p>Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)</p>								
<p>C. DOCUMENTS CONSIDERED TO BE RELEVANT</p> <table border="1"> <thead> <tr> <th>Category*</th> <th>Citation of document, with indication, where appropriate, of the relevant passages</th> <th>Relevant to claim No.</th> </tr> </thead> <tbody> <tr> <td> </td> <td> </td> <td> </td> </tr> </tbody> </table>			Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.			
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.						
<p><input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.</p>								
<p>* Special categories of cited documents:</p> <p>“A” document defining the general state of the art which is not considered to be of particular relevance</p> <p>“E” earlier application or patent but published on or after the international filing date</p> <p>“L” document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)</p> <p>“O” document referring to an oral disclosure, use, exhibition or other means</p> <p>“P” document published prior to the international filing date but later than the priority date claimed</p> <p>“T” later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention</p> <p>“X” document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</p> <p>“Y” document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art</p> <p>“&” document member of the same patent family</p>								
Date of the actual completion of the international search		Date of mailing of the international search report						
Name and mailing address of the ISA/		Authorized officer						
Facsimile No.		Telephone No.						

International application No.

CLASSIFICATION OF SUBJECT MATTER

B28B 5/02 (2006.01)i
B28B 1/29 (2006.03)i
H05B 31/08 (2007.01)n

[End of Annex II and of document]