



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

May 25, 2000

Mr. W.M. Guy  
Head  
Special Projects Section  
Inter-Office Information Services  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20  
SWITZERLAND

Re: C.SCIT 2493 – JOPAL Survey Questionnaire

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Dear Mr. Guy:

Enclosed, please find our response to the JOPAL Survey Questionnaire. Also, please note that we have attached as an Annex a further elaboration of our response as well as some possible solutions for the problems associated with classifying non-patent literature in the IPC.

Sincerely,

***Original signed by:***

Robert W. Saifer, Director  
International Liaison Staff

Enclosure

## JOPAL SURVEY

### I. Contact Details

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### II. Use of JOPAL information by your Office/Organization

*(Tick appropriate box)*

- Currently using** *(Go to Section III)*
- Previously used but discontinued** *(Please specify why)*
- Never Used** *(Please specify why)*

In interviews with personnel from our Main Library, the Scientific and Technical Information Center (STIC), US examiners prefer accessing non-patent literature (NPL) in the actual journals (many of which are on the PCT "minimum documentation" list) and electronic databases specific to their art (in the Main Library, or in the Biotechnology, Chemical and Electronic Information extensions of STIC). One of the reasons stated was that the examiners prefer basing prior art searches on entire contents of journal articles or at least abstracts thereof rather than merely an title as provided in JOPAL. Furthermore, JOPAL is not in a format which is easy to use (for further explanation see Annex attached).

*(Go to Section V)*

### V. Does your Office/Organization use other sources of Non-Patent Literature?

Yes                       No

If yes, please provide details of the services used:

(see Appendix 1 and Annex ).

### VI. If the JOPAL Service was discontinued, what effect would this have for your Office/Organization?

It would have little effect as currently provided (see explanation in Annex )

## **VII. Other comments**

Please provide any additional comments that you consider relevant to the Survey:

The USPTO considers the provision of the latest non-patent literature in an easily accessible format and sufficient content to be essential in patent examination. However, we feel that the process used in developing JOPAL, as well as its present format to not be the most expedient means of providing this valuable asset to searchers. The current means of producing the JOPAL database is a very tedious task consisting of perusing quite complex journal articles and providing only the articles' bibliographic data and IPC classification(s). It is questionable that the titles and proposed IPC classifications are sufficient to encourage one to use the citations without the enefit of reading the full articles.

We feel that a thorough reanalysis of JOPAL is needed and that the proper group to handle this analysis would be the IPC Committee of Experts (IPC/CE). Appendix 2 (attached) which provides additional comments from the USPTO viewpoint might also serve as an initial working paper for the IPC/CE, assuming they are given this project .

Please address any queries to Mr. W.M. Guy by e-mail to [iois.mail@wipo.int](mailto:iois.mail@wipo.int) or fax to +41 22 734 6392

[Appendix follows]

<b>Service Name</b>	<b>Service Provider</b>	<b>Service Type: I=Internet C=CD-ROM O=Other (Specify)</b>	<b>Free Service Yes or No</b>	<b>Estimated Service Cost per month</b>	<b>Additional Remarks</b>
CAplus	STN International-CAS	I	NO	\$100,000	
BIOSIS Previews (BIOSIS®)	STN International-CAS	I	NO	\$25,000	
EMBASE (Excerpta Medica database)	STN International-CAS	I	NO	\$15,000	
BEILSTEIN	STN International-CAS	I	NO	\$12,000	
MEDLINE (for biomedical literature)	STN International-CAS	I	NO	\$12,000	

## ANNEX

### ADDITIONAL USPTO COMMENTS ON JOPAL SURVEY QUESTIONNAIRE

In view of our answers to the survey questions, it is obvious that discontinuance of current JOPAL services would have an inconsequential impact on the USPTO. To justify any expenditure of manpower or funds by the USPTO on JOPAL, it must evolve into a tool that is more useful to our Examiners and the public. What remains to be answered is “can JOPAL provide any services to the USPTO for Non-Patent Literature (NPL) searches that are not now readily provided by commercial databases or eventually from the IPC Master Classification File (MCF)?” What JOPAL must do is to develop a ‘new mission’ that is useful for searching to all IPOs.

Moreover, since the Reform IPC will also include in its MCF the classifications of NPL, do we need a duplication of this effort by JOPAL? Probably not, since in a relatively short time period, the two databases will have significant overlap between their data. A single WIPO source for patentability-relevant NPL document data is sufficient for the IPOs and public. The merging of NPL data will be much more cost effective. For this reason, we believe that the question of JOPAL’s future interaction with the IPC must be assigned to the Reform Working Group through the IPC Committee of Experts.

In addition, the Intellectual Property Digital Libraries (IPDLs) will soon be completed. As is current practice at the EPO, the IPDLs should store at least the image of all NPL documents in the IPC-MCF. These will be accessible using either their IPC group classifications or possibly by term searching.

In our opinion, easy access to the full image and/or text of classified NPL documents in rapidly developing or emerging technologies is essential to their use by our Examiners. These Examiners are under significant search time constraints and frequently must search massive amounts of NPL. The use of NPL is critical in these technologies since they have not matured to the level where a substantial amount of the inventive information in NPL is well represented in classified patent documents. Examiners in emerging technologies don’t have the time to locate massive numbers of documents whose titles merely indicate that they might be of interest to the search. JOPAL does not currently provide the full image or text for any of its NPL documents. Ways to circumvent copyright problems in these areas needs to be explored by JOPAL and the Reform Working Group.

We believe that JOPAL as it currently exists has only two remaining potentially useful functions. These functions are:

- Organizing the assignment and allocation of particular publications, from its list of useful publications, to IPOs that volunteer to review these publications.
- Collecting from these IPOs their NPL document selections and assignment information for inclusion into the IPC-MCF.

We must ask ourselves “does this existing JOPAL process accomplish in a cost effective manner the collection of those NPL documents into the IPC-MCF most needed during patentability searching?” If the answer is no, we must determine what NPL documents are

essential to patentability searching and develop new methods for collecting and classifying them. We must also consider handling mature and emerging technologies differently. It is our opinion that the existing JOPAL practice of forming a list of useful publications for their systematic review by IPOs for all arts is no longer the most beneficial method of acquiring and classifying NPL documents.

We believe that the following methods for selecting NPL documents appropriate for classification and inclusion in the IPC-MCF and IPDLs should be considered:

1. Automatic initial inclusion of any NPL document if it is cited by an Examiner, as a reference or as of interest, in a newly published patent document whenever it is not already included in the IPC-MCF. The EPO already follows this practice. These documents should automatically be assigned to ‘presumed’ appropriate groups that are the same as those to which their patent document is assigned, unless the examiner specifies otherwise.
2. Automatic initial inclusion of any NPL document during its patent application assignment, which is cited as of interest by applicant when it is not already in the IPC-MCF. These documents should automatically be assigned to ‘presumed’ appropriate classifications that are the same as the classifications used to assign their patent document to its Examiner (e.g., the routing classification used for docketing). This method would most benefit new technology where rapid inclusion of NPL is critical.
3. Direct requested inclusion of any NPL document that an Examiner or Classifier has located during online searching or technology review for which they specify a particular classification.
4. Development of interlinked ‘family-type’ collections of the same NPL document whenever it is available in multiple languages from publishers or translated versions exist that an IPO required during examination.
5. Creating for each Subclass a prioritized list of publications potentially of interest that each IPO may review. Each of these lists could be based on the number of NPL documents assigned from particular publications to the Subclass in sections 1-3 above over a short time period (e.g., 2 or 3 years).
6. Providing mining services for emerging technologies to locate relevant NPL documents from Internet locations, commercial databases, and Journals for Examiners.

Our primary motivation for suggesting the above methods is to show how to convert the existing NPL document selection procedure from an attempted ‘exhaustive’ type approach to locating potential NPL documents toward a much more productive and cost effective ‘concentrated’ approach. The ‘concentrated’ approach that we envision requires a preliminary review mechanism designed for targeting publications, or their articles, that have an extremely high potential for applicability to patentability searches in a Subclass. In addition, we want to gather any NPL documents that may have alternative potential usefulness to IPOs (e.g. completing disclosure).

The Reform Working Group has already indicated that it does not believe that inclusion of all technical NPL into the IPC-MCF is advantageous or desirable (see IPC/REF/1/2, paragraphs 13, 14, & 17a). The only NPL documents that it is interested in classifying are those containing “invention-like information”. Existing guidance from JOPAL on ‘what’ to classify is consequently clearly inadequate. Previous JOPAL assignment guidelines do not specify how to determine what is ‘invention-like’. The USPTO’s view on this subject is that any attempt to exhaustively search even all the printed publications for articles including ‘invention-like’

information is impossible. When Internet publications are also considered, it becomes a ridiculous endeavor. Even if the IPOs did succeed, the increased volume of NPL documents added to the search files would make patentability searching impossible at a reasonable cost. It would also clog the file with a significant amount of redundant reference material. The goal of our above suggestions is to show potential methods that overcome these difficulties and add only important novel search material to the search files.

The IPC-MCF will clearly be able to easily gather the NPL type documentation specified in sections 1 and 2 above. This is true since it will be developed from EPODOC and the EPO already includes any NPL documents cited within the patent documents they publish in this database. Presuming that their appropriate IPC classifications are the same as the patent document they are cited in, will also save vast amounts of NPL document classification time and funds. In the situations where only some of these classifications are representative of the novel content of their disclosure, the Examiner can remove any inappropriate citations. Examiners can also remove, after examination from the search files, any useless NPL documents that were cited by applicants when the 'invention-like' portion of their disclosure is already available in patent documents.

Allowing direct Examiner input and classification of NPL documents that they otherwise locate (section 3 above) and rapid inclusion of those that are cited in incoming applications (section 2 above) prior to publication of their patent document will facilitate prompt collection of essential novel NPL documents for emerging new technologies. The creating of Subclass specific publication lists (and potentially of useful Internet sites), particularly for examiner identified emerging technologies, will also facilitate location of other novel NPL documents by Examiners (section 5 above).

The development of 'family-type' collections of NPL documents (section 4 above) will reduce potential duplication of classification efforts by IPOs. It will also help to make their invention-like information more usable by the world community by linking currently wasted translations to them that might be in a preferred language.

Finally, the Reform Working Group must develop a standard policy for removal of NPL documents from classified files. We suggest routine removal after a set period of time for infrequently or never cited documents. This measure should be sufficient to avoid the risk of clogging the search files.