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## **Consultation on whether there is a continuing need for a UK Patent Classification Key**

### **Introduction**

1. It is desirable to be able to group together patent specifications relating to particular technical fields. To facilitate this, published patent specifications are allotted a classification, usually comprising an alpha-numeric code. Such codes are listed in a key which defines the technical sphere they encompass.
2. The UK Patent Office has its own Patent Classification Key (the UKC key). All published UK patents are classified using the UKC key. The documents classified using the UKC key now represent only a small proportion of the total number of patents published globally. All published UK patent specifications are also classified using the International Patent Classification (IPC) system and, some time following publication, the European Patent Office's own classification system ECLA. Consequently, the value and future of the UKC key has been brought into question.
3. There is an internationally agreed system for making a worldwide patent application under the Patent Cooperation Treaty (PCT). Such applications are made through the World Intellectual Property Organisation (WIPO). The applicant declares which countries each application is to relate to. WIPO makes arrangements for an international search and publication for such applications. As part of the search process the applications are classified using the IPC system. Each application is then used to make up a series of national (e.g. GB) and/or regional (e.g. EP) patent applications based on the applicant's earlier declaration. The national or regional patent granting authorities make a decision on whether to grant or not based in part on the international search. In the UK we republish these PCT cases (front page only if the original language is English) when they enter our national phase of processing. The value of re-publication is questionable for cases which were originally filed in English.
4. Prior to re-publication we add a UK classification to PCT cases. This is generally the only value-add that we make to these cases prior to re-publication. The future of the UKC key therefore has a consequential impact on the value of re-publication of such cases and it is therefore considered appropriate to consult on both issues together.

### **Purpose of the consultation**

5. In the mid 1990s the UK Patent Office held a consultation exercise on the Future of the UKC key. The decision at the time was to retain the UKC key and, in view of a changing environment, to review the position later.

6. This consultation is intended to inform all interested parties of the background to the use of the UKC key and of the changing environment in which it is used, so as to obtain views on the continuing need for the UKC key. The consultation will provide valuable feedback contributing to the decision-making process in relation to the future of the UKC key.
7. We are also seeking views in relation to the present practice of re-publishing PCT (original language English) cases so that we are better placed to make a decision regarding whether to continue with this practice.

### **Who is being consulted?**

8. Responses are welcome from anyone interested in the patent system in the UK, but especially those who have been or expect to be users of the system. Copies of this consultation document have been sent to the individuals and organisations listed in [Annex A](#). Further copies may be obtained from the Patent Office by contacting Sue England, tel. 01633 814883, <mailto:Sue.England@patent.gov.uk>.
9. This consultation document has been prepared in accordance with the Government Code of Practice on Written Consultations. The code criteria are set out in [Annex B](#).

### **Your views/feedback**

10. We are interested in receiving feedback about whether and how you make use of the UKC key.
11. We are also interested in your views and supporting argument(s) about whether there is a continued need for the UKC key. As a stimulus, the following are offered as potential future scenarios which are [explored in more detail later](#):
  - a) Continue to use the UKC key as at present. This is the no-change scenario.
  - b) Freeze the key and continue to apply the frozen UKC terms to all published UK patent specifications. The UKC key would not be amended to reflect changes in technology and would consequently become of diminished value and use with time.
  - c) Abandon the UKC key and no longer apply UKC terms to published patent specifications.
12. We are also interested in your views on the value of the practice of re-publishing PCT (original language English) cases when they enter the National Phase in the UK, particularly in relation to scenario (c) above.

## How and when to respond

13. Please send your responses by **22<sup>nd</sup> November 2005** to:

Tim James  
Patents Directorate  
Room 2R60  
Concept House  
The Patent Office  
Cardiff Road  
Newport  
NP10 8QQ

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E-mail: [tim.james@patent.gov.uk](mailto:tim.james@patent.gov.uk)

14. If you are responding on behalf of a representative group, please give a summary of the people and organisations you represent.

15. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Coordinator, whose details are included in [Annex B](#).

## Openness/Confidentiality

16. This is part of a public consultation exercise. As such, your response may be made public by The Patent Office. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

17. Information provided in response to this consultation, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.

18. In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all

circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding on The Patent Office.

19. The Patent Office will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

### **Our response**

20. In accordance with our general principle of consultation we will produce a response document which will be made available at <http://www.patent.gov.uk/about/consultations/responses/index.htm> by the end of January 2006.
21. Paper copies of the response document will be available from that date by contacting Sue England, tel. 01633 814883, <mailto:Sue.England@patent.gov.uk>.

### **Background**

#### *UKC*

22. The UK Patent Office has its own Patent Classification Key (the UKC Key). All published UK Patents are classified using the UKC key. The allotted classification is printed on the front page of published GB specifications and is also included in some electronic media such as the Espace Access Europe series of CDs produced by the European Patent Office.
23. Until recently the UKC key has only been available outside the Patent Office in paper form. As from 2 January 2004 the UKC key was made available at <http://www.patent.gov.uk/patent/reference/ukc/index.htm> .
24. National and regional patent offices worldwide (including the UK) classify applications within their domain using the International Patent Classification system (IPC). The IPC key is available at [http://www.wipo.int/classifications/fulltext/new\\_ipc/index.htm](http://www.wipo.int/classifications/fulltext/new_ipc/index.htm) .
25. The European Patent Office also classifies many of the patent specifications published worldwide (including UK publications) using their own classification system ECLA, which is generally an enhanced version of the IPC. This data is not applied and is therefore not available until some time after publication, unlike any applied UKC and IPC terms which are available at the time of publication of the related patent specifications. The ECLA key is available at <http://v3.espacenet.com/eclasrch?CY=ep&LG=en>
26. As part of the patenting process, a prior art search (a statutory search) is conducted to ascertain whether the invention of each application is novel and

inventive. The majority of this searching is conducted through collections of patent specifications. Within the UK, the search process generally involves selection based on classification terms from the UKC and/or the IPC and/or ECLA keys. This search process may, instead or additionally, include selection based on other classification systems and/or key-words. The UK Patent Office also conducts some non-statutory (commercial searches) through the same collections of classified patent specifications.

- 27.** Statutory and commercial searches conducted by the UK Patent Office are now primarily conducted via EPOQUE (the European Patent Office's QUERy system). EPOQUE includes several databases containing abstracted patents. The records within these databases include terms from the IPC applied to patents by the National Offices worldwide. One database (EPODOC) also includes ECLA classification terms. Searches using the UKC involve either searching a paper collection of documents (arranged according to the UKC – this will no longer be available from September 2005) or using the UK Patent Office's OPTICS database in conjunction with EPOQUE. The UK classification is soon to be added to the EPODOC database, which will allow direct searching without having to use the OPTICS database.
- 28.** For any classification system to be of continued use it needs to be continually developed to reflect technological advancement. The UKC key generally undergoes an annual revision which is completely within the control of the UK Patent Office. The IPC key currently undergoes review every 5 years and the UK office has input to this system, as do all other PCT member states. This input allows us to both table and comment on proposals. The ECLA key undergoes continuous revision by the EPO and the UK Patent Office is invited to comment on changes to that key.
- 29.** The IPC key is currently undergoing reform. In 2006 the ECLA and IPC keys will enter a period in which they will converge with a view to providing a single unified key.
- 30.** In the early 1980s the UK Patent Office was publishing around 50,000 patent specifications per year. This represented approximately 20% of all patent families worldwide. However, following the opening of the European Patent Office in the late 1970s the number of GB documents published per year has reduced to around 13,000. During recent years, patenting activity worldwide has been steadily increasing. Consequently, those cases published by the UK Patent Office now represent around 2.5% of all families worldwide.

## *PCT*

- 31.** PCT applications entering the national phase are re-published with GB publication numbers. The re-publication is limited to the front page only for applications filed in English through the PCT and entering the national phase on the expiry of the prescribed period. The front page contains the standard details for a national patent application, including a UK classification, with the cited documents corresponding to those listed on the search report from the International Searching Authority. Where the application is not filed in English, the republished document also includes an English translation of the entire specification. In 2002, 1604 cases entered the national phase, of which 170 (i.e. about 10%) were filed in a language other than English.
- 32.** For PCT applications that have already been published by WIPO, re-publication is an entirely administrative act and accords no legal rights. Only in rare cases where international publication has not taken place (e.g. where there has been early entry to the national phase) will an international application be published under section 16 of The Patents Act.
- 33.** Practice at the European Patent Office for applications in an EPO official language is not to publish a front page: applications are simply accorded an EP publication number, and the bibliographic data are published in the European Patent Bulletin. If the application is in a non-EPO language, however, the EPO publishes the translation that has to be filed. The translation is published with a conventional front page with bibliographic data and abstract.
- 34.** Growth of online search databases affects the re-publication issue in several ways. Firstly, the increase in online searching has resulted in less use of paper records, and to some extent CD-ROMs, although the latter are still used in some PATLIB libraries. The impact on customers of ceasing front page re-publication of English-language PCT applications would now be less significant. Furthermore, within the Office, the absence of a UK classification mark for a document has reduced effect on search quality with the advance in online search tools.

## The potential scenarios explored

### *UKC*

35. We are not certain to what extent the UKC key is used by people outside the UK Patent Office and so it is not possible to assess the impact of the various scenarios on those people, but hopefully this consultation exercise will enlighten us in this regard.
36. Following are three scenarios and their perceived advantages and disadvantages. The paragraphs following these scenarios provide more detail about the perceived advantages and disadvantages:

#### **Scenario (a) Continue to use the UKC key as at present**

The main advantages of this scenario are:

- i. The UKC key can continue to be extensively used as a search tool within the UK Patent Office.
- ii. Searchers (including UK examiners) will continue to have a useful alternative to the ECLA and IPC search tool.
- iii. The UK Patent Office is the only organisation to use the UKC key for statutory searches and continued use will give our searches a continued uniqueness.

The main disadvantages are:

- iv. The cost of maintaining the UKC key and continuing to apply its terms to published specifications equates to approximately £119,320 pa.
- v. There is a danger that UK patent examiners will develop an over-reliance on the UKC key at the expense of further developing an understanding of the ECLA and IPC keys.

#### **Scenario (b) - Freeze the key and continue to apply the frozen UKC terms to all published UK patent specifications**

- i. The main advantage this scenario has is a cost saving which equates to around £33,865 pa, resulting mainly from not spending examiner resources on developing the UKC key.
- ii. This scenario does allow searchers to continue to search old and newly published GB documents using the UKC key.
- iii. The risk with this scenario is that with time the key would not make provision for technological advancement and become less and less

useful, because of increasing numbers of cases which could not be classified using the UKC key. The timescale for developments is difficult to assess but will be shorter in some technological areas than others.

**Scenario (c) - Abandon the UKC key and no longer apply UKC terms to published patent specifications**

- i. The main advantage here is the potential saving of the costs associated with scenario (a), i.e. a benefit of around £119,320 pa.
- ii. Searchers would still be able to search using UKC key terms for cases published prior to abandoning, and so, after abandoning, would have available to them some of those advantages discussed above under scenario (a). There is a risk that with time, knowledge of the UKC key would diminish and ultimately be lost, losing those advantages.

**37.** An important influence which transcends all analysis of the usefulness of the UKC key as a search tool is the relatively low proportion of documents published worldwide which are classified using the UKC key. This amounts to less than 2.5% of all patent families currently being published worldwide. Clearly it is not prudent to conduct a search solely using the UKC key.

**38.** The UKC key has a function-based structure which is fundamentally different to the IPC and ECLA keys which generally have application-based structures. In having this fundamentally different structure to the IPC and ECLA, the UKC key can often provide a useful alternative where the IPC and ELCA do not make for particularly efficient searching. Similarly, the IPC and ECLA can often provide a useful alternative to the UKC in situations where it is not suited to efficient searching. A knowledge of and ability to search using the UKC, the IPC and ECLA therefore provide added flexibility.

**39.** The UK Office is the only office which searches using the UKC key and so our searches have uniqueness. The extent and value of this uniqueness is difficult to quantify. If we abandon the UKC key and ultimately stop searching using it, the search tools we use will be no different to those available to other national/regional offices.

**40.** The main forces influencing the decision making process are, on the one hand, the usefulness of the UKC key as a search tool, and on the other hand the costs associated with maintaining the UKC key as a search tool. The latter comprise the costs of making the UKC key available as a search tool (i.e. the costs of developing the key and classifying by it). The costs of using the UKC key as a search tool are almost impossible to quantify and have not been taken into account when calculating the costs outlined in the above scenarios.

## *PCT*

41. A further saving could be made in relation to PCT cases currently re-published by the UK Patent Office when they enter the National Phase in the UK. Regardless which of the scenarios are adopted, the practice of republishing such cases could be ceased. The benefit of this equates to around £6,000 pa for all scenarios (the publishing costs). There are additional scenario-related impacts:

### **Scenarios (a) and (b)**

There would be no additional cost benefit to be derived from continuing to classify such cases to the UKC key. However, if we decided to cease classifying such cases to the UKC key there would be a cost benefit of around £19,000 (the cost of the examiner time taken).

### **Scenario (c)**

Under this scenario no further cases (including PCT) would be classified using the UKC key. The cost benefit of ceasing classification is therefore already included in the £119,320 benefit mentioned above. Ceasing publication of these PCT cases seems more likely under this scenario as the only current valued-add to these cases will no longer be provided (i.e. application of a UKC key classification).

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## Annex A

### **Individuals and organisations which have initially been sent this consultation document**

Amsel & Co	National Library of Wales
Anti-Counterfeiting Group	NESTA
Association of British Chambers of Commerce	Parliamentary Branch
Association of the British Pharmaceutical Industry	Patent and Trade Mark Group, Institute of Information Scientists
AstraZeneca	PATLIB UK Aberdeen
AURIL	PATLIB UK Belfast
Bharat Electronics Ltd	PATLIB UK Birmingham
Bodleian Library	PATLIB UK Bristol
British Brands Group	PATLIB UK Glasgow
British Pharmaceutical Group Ltd	PATLIB UK Leeds
British Retail Consortium	PATLIB UK Liverpool
Business Links	PATLIB UK Manchester
Cambridge University Library	PATLIB UK Newcastle upon Tyne
Carratu International plc	PATLIB UK Plymouth
Chartered Institute of Patent Agents	PATLIB UK Portsmouth
Chemical Industries Association	PATLIB UK Sheffield
Clark & Company	PATLIB UK Swansea
Compu-Mark	PATLIB UK The British Library
Confederation of British Industry	PATMG
Consumer's Association	Pfizer Limited
Crop Protection Association (new)	PIUG
Davda & Co	Regional Development Agencies
Dept of Enterprise, Trade & Investment Northern Ireland	RWS Group
TSUG (formerly Derwent UK User Group)	Scottish Enterprise
Federation of Small Businesses	The Bar Council
Federation of the Electronics Industry	The Institute of Patentees and Inventors
FICPI	The Intellectual Property Sub-Committee of the City of London Law Society

Incorporated Society of British Advertisers	The Law Society
Institute of Practitioners in Advertising	The Law Society of Scotland
Institute of Trade Mark Attorneys	The Patent Judges:-
Intellectual Property Institute	Judge Fysh
Intellectual Property Lawyers Association	Lord Justice Aldous
International Chambers of Commerce	Lord Justice Jacob
International Federation of Industrial Property Attorneys	Justice Pumfrey
Inventorslink Inc	Justice Laddie
IPAC	The Scottish Executive
Kingsley & Talboys	TMPDF
Libraries of Trinity College Dublin	University of London, Queen Mary and Westfield College
Licensing Executives Society	University of Strathclyde
London Chamber of Commerce and Industry	Vereenigde
Lovells	Victor Green & Company
Magister Ltd	WDA
Ministry Of Defence	
National Consumers Council	
National Library of Scotland	

## **General Principles of Consultation**

1. This consultation is being conducted according to the Code of Practice on Written Consultation issued by the Cabinet Office (available from the Cabinet Office web site at <http://www.cabinetoffice.gov.uk/regulation/consultation/code.asp>). This recommends the following criteria:

1. Consult widely throughout the process, allowing a minimum of 12 weeks for written consultation at least once during the development of the policy.
2. Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
3. Ensure that your consultation is clear, concise and widely accessible.
4. Give feedback regarding the responses received and how the consultation process influenced the policy.
5. Monitor your department's effectiveness at consultation, including through the use of a designated consultation co-ordinator.
6. Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

## **Comments about the consultation process**

2. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is:

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Consultation Co-ordinator  
The Patent Office  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ

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