

Committee on WIPO Standards (CWS)

Third Session
Geneva, April 15 to 19, 2013

REVISION OF WIPO STANDARD ST.14

Document prepared by the Secretariat

BACKGROUND

1. The Committee on WIPO Standards (CWS), at its second session held from April 30 to May 4, 2012, discussed a proposal for the revision of WIPO Standard ST.14, "Recommendation for the Inclusion of References Cited in Patent Documents" (see document CWS/2/6). Details of the discussions are set out in paragraphs 28 to 31 of the report of the session (document CWS/2/14). The decision by the CWS to establish a Task Force is reproduced below (see paragraphs 30 and 31 of the report):

"30. The CWS agreed to:

"(a) create the following Task:

Revision of WIPO Standard ST.14:

- (i) Prepare a proposal for the revision of category codes provided in paragraph 14 of WIPO Standard ST.14 taking into account comments and draft proposals stated in paragraphs 7 and 10 to 14 of document CWS/2/6.
- (ii) Study the convenience of revising the recommendations for the identification of non patent literature citations in order to bring WIPO Standard ST.14 in line with the International Standard ISO 690:2010 (Information and documentation – Guidelines for bibliographic references and citations to information resources). If the revision is considered convenient, prepare the corresponding proposal.

“(b) establish a Task Force to handle the Task;

“(c) request the Task Force to present the proposal on the revision of WIPO Standard ST.14 in regard to the recommendations concerning category codes for consideration and approval by the CWS at its session to be held in 2013;

“(d) request the Task Force to present, as far as possible, the results of the study, along with any eventual proposal, regarding the identification of cited non-patent-literature and ISO 690:2010, at the session of the CWS to be held in 2013; if the Task Force is not able to finalize the proposal by that time, the Task Force Leader should present a progress report on the work done by the Task Force with regard to that component of the Task.

“31. The CWS welcomed the offer of the International Bureau, which was designated as the Task Force Leader.”

2. Following the above decision by the CWS, representatives of 12 industrial property offices, a non-governmental organization and the International Bureau were nominated to participate in the Task Force in response to the invitation sent by the International Bureau in Circular C. CWS 27 of April 16, 2012. A Wiki forum was established on the WIPO Wiki for the discussions by the Task Force.

3. Status report and details of the Task Force discussion are provided below.

REVISION OF CATEGORY CODES

4. With regard to the first component of the task, i.e., the revision of category codes (paragraph 14 of WIPO Standard ST.14), the Task Force reached a provisional agreement with respect to certain issues. In addition, the participants exchanged their opinions and made significant progress with respect to others. However, the Task Force has not yet reached consensus on a final proposal for consideration and approval by the CWS.

CATEGORIES “I”, “N” AND “X”

5. The Task Force has provisionally agreed on the inclusion of new categories “N” and “I” for cited documents showing the claimed invention cannot be considered novel when the document is taken alone, and for cited documents showing the claimed invention cannot be considered to involve an inventive step when the document is taken alone, respectively.

6. The Task Force is yet to agree on a new definition for category “X”, which currently covers documents which would either be cited “N” or “I” under the new proposals for ST.14. In this regard, some participants support a clean transition whereby an office beginning to use the new categories for citing documents would cease to use category “X”, whereas some other participants would prefer a definition that would allow for category “X” to be used alongside categories “N” and “I”.

7. The following two definitions of category “X” are currently under consideration of the Task Force:

(a) the initial proposal (Category “X” is excluded from future use)

Category “X”: This category was previously recommended to indicate that the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone. New search reports should no longer use this category. The more specific categories “N” or “I” should be used instead.

(b) the current definition with the explanatory note (Category “X” is left as an alternative to “N” and “I”)

Category “X”: The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone.

Note: Though the definition of category “X” is general enough to be applicable to the same documents to which one of categories “N” or “I” is applicable, more specific categories “N” and “I” should preferably be used, instead using category “X”, unless the specific characteristics of the claimed invention and the cited document recommend the contrary.

Previously, before categories “I” and “N” were introduced, the scope of category “X” included documents which currently fall under categories “I” and “N”.

8. Participants in the Task Force supporting the definition in paragraph 7(b) consider that those Offices beginning to use citation categories “N” and “I” should be able to continue to use category “X” in search reports. There might be situations where it is not practical for the examiner performing the search to fully assess the detail of a citation for novelty against every claim. For example, for some applications with technically complex claims and many citations, it could be reasonable for the examiner to take the view when assessing each claim that if the exact scope of that claim is not disclosed specifically in that citation, then whatever feature is missing would be obvious to include. In this scenario, the proposed removal of category “X” would prevent the search examiner from taking the pragmatic approach of stating that the document is relevant to either novelty or inventive step when taken alone. Instead, the examiner would probably cite the document “N”, potentially giving a misleading impression that a citation casts doubt on the novelty of a claim.

9. On the other hand, those participants in the Task Force supporting a clean transition whereby an Office beginning to use categories “N” and “I” ceases to use category “X” as initially proposed in paragraph 7(a) above, have expressed concerns that the definition in paragraph 7(b) would enable categories “X”, “N” and “I” to be used in the same search report. In such a situation, this could lead to a loss in confidence in the quality of analysis, because it would give the impression that the examiner is simply not able to decide on how to cite a document. Moreover, it has been pointed out that the wording in the explanatory note providing the options to use categories “N” and “I” in preference unless the specific characteristics of the claimed invention and the cited document recommend the contrary, does not, in effect, create a Standard recommending a single approach for the citation of a relevant document.

CATEGORY “P”

10. The Task Force has provisionally agreed on a revision of the definition for category “P”, extending the scope to cover documents published prior to the (international) filing date but on or after the priority date claimed in the application, which reads as follows (changes are highlighted):

Category “P”: Document published prior to the filing date (in the case of the PCT, the international filing date) but **on or after** ~~later than~~ the priority date claimed in the application. Code “P” should always be accompanied by one of the categories “N”, “I”, “X”, “Y” or “A”;

CATEGORIES "E" AND "O"

11. The Task Force has not yet agreed on revised definitions of citation categories "O" and "E" with respect to their combination with other citation categories. The following revised definitions are currently under consideration of the Task Force (changes are highlighted):

- (a) the mandatory scheme of accompanying the categories in question by one of the categories "N", "I", "X", "Y" or "A"

Category "E": Earlier patent document as defined in Rule 33.1(c) of the Regulations under the PCT, ~~but~~ published on or after the international filing date. Code "E" should always be accompanied by one of the categories "N", "I", "X", "Y" or "A";

Category "O": Document referring to an oral disclosure, use, exhibition or other means. Code "O" should always be accompanied by one of the categories "N", "I", "X", "Y" or "A";

- (b) the option of adding one of these categories when citing a document with category "E" or "O"

Category "E": Earlier patent document as defined in Rule 33.1(c) of the Regulations under the PCT, ~~but~~ published on or after the international filing date. Code "E" may be accompanied by one of the categories "N", "I", "X", "Y" or "A";

Category "O": Document referring to an oral disclosure, use, exhibition or other means. Code "O" may be accompanied by one of the categories "N", "I", "X", "Y" or "A";

12. The wording provided in paragraph 11 (a) above was supported by a group of Task Force members during earlier rounds of discussion. As it is suggested in paragraphs 11 to 13 of document CWS/2/6, the inclusion of citation categories "N", "I", "X", "Y" or "A" with categories "O" and "E" in search reports would provide further information to the benefit of patent information users. On the other hand, the definition provided in paragraph 11 (b), which was proposed by one member of the Task Force, is drafted not as a "shall" but a "may" provision and thus would not provide for a mandatory requirement but only for the option of adding one of these categories when citing a document with category "E" or "O". An alternative within the latter approach which is also being considered by the Task Force is using the expression "should preferably" in the second sentence of the definition.

13. The word "but" was also removed from the current definition of category "E".

14. Following the proposal presented in paragraph 14 of document CWS/2/6, the Task Force has also considered the extension of the definition of category "E" to patent documents sharing the same date as the application being searched to provide a basis in ST.14 for the agreed practice in paragraph 16.67 of the PCT International Search and Preliminary Examination Guidelines to help Offices apply their anti-double-patenting laws. This approach was not supported by the Task Force members as being potentially confusing. The Task Force has consequently discussed two alternatives to this approach: the creation of a new category (proposed category "R") specifically for coding documents sharing the same date as the application being searched, or using the existing category "L" for this purpose. Finally neither a definition for a new category "R", nor any further revision of existing categories was proposed. A group of Task Force members is of the opinion that the current definition of the category "L" is broad enough to cover documents potentially relevant to double patenting and considers that there are no obvious benefits to introducing a new category. However, some other Task Force

members believe that a separate definition for such documents would enable them to be more easily distinguished from other documents which would normally be cited in category "L".

IMPLEMENTATION OF THE REVISED WIPO STANDARD ST.14

15. The Task Force also addressed the issue of the future implementation of the revised Standard after its adoption by the CWS. Certain participants commented that implementation may take several years due to the time needed to change internal systems.

16. In order to streamline the implementation of the revised Standard by different industrial property offices, the Task Force is discussing the inclusion of the following Editorial Note.

"Editorial Note by the International Bureau

"The Committee on WIPO Standards (CWS) adopted the revision of paragraph 14 of Standard ST.14 at its <number> session on <date>.

"Industrial property offices are asked to implement the recommendations provided in paragraph 14 of Standard ST.14, as revised, for all search reports established from <date>, onwards.

"For search reports established prior to that date, the previous version of the said paragraph 14 (see Annex) should continue to be used."

RECOMMENDATIONS FOR NON-PATENT LITERATURE

17. With respect to the second component, i.e., the recommendations for the identification of non-patent literature citations, the ST.14 Task Force has conducted two rounds of discussions, which could be summarized as follows: the Task Force supported the proposal of the revision of the WIPO Standard ST.14 taking into account the recommendations provided for in the International Standard ISO 690:2010. Participants, nevertheless, stated that more detailed consideration was necessary to determine what particular recommendations of the ISO Standard should be transferred to the WIPO Standard ST.14 and what should be the level of granularity of the recommendations transferred.

18. It was mentioned that, during the revision, the following aspects should be taken into account: coverage of all kinds of NPL references (in depth and structure), applicability and relevance of recommendations, examples to show a realistic range of document types and document sources, balance between the impact on IPOs' practices, e.g., the need to change the IT systems, and the benefits expected from the revision.

19. Concerning the extent of the incorporation of International Standard ISO 690:2010 in WIPO Standard ST.14, the European Patent Office plans to carry out an analysis of ISO 690:2010 and share the results with the Task Force. At the moment of preparing this working document, it was expected that the results of the analysis should be ready in March 2013.

20. It was also confirmed that the alignment of WIPO Standard ST.14 with the ISO 690:2010 should be limited to non-patent literature, since the recommendations for patent documents provided in the ISO standard appear to be less effective than those provided in the current version of ST.14.

21. As a matter independent of the alignment with ISO 690:2010, the International Bureau has suggested that the recommendations for citing patent documents (including abstracts) should be reviewed in addition to the non-patent literature question. At present, ST.14 contains no recommendations on how to cite documents in languages other than the language of the

document (search report) in which they are cited. It would therefore be useful to have guidance on when to use translations or transliterations of details, such as authors' names or titles of documents whether this should be done in all cases, only when there is an official translation into the other language, or whether both the original and the translation should be provided. Moreover, if a translation or transliteration of a name or title is provided, there is the question of how it should be indicated that it is a translation/transliteration.

22. If this suggestion is followed, then the examples provided in the Standard should also reflect the question of cited document vs. citing document languages.

23. *The CWS is invited to:*

(a) note the status report on the work of ST.14 Task Force provided in the present document;

(b) note the provisional agreement reached by the Task Force on the inclusion of categories "N" and "I" to paragraph 14 of WIPO Standard ST.14, as referred to in paragraph 5, above;

(c) provide comments and guidance to the Task Force on the issue of category "X", as described in paragraphs 5 to 9, above;

(d) note the preliminary agreement reached by the Task Force on the revision of category "P," as indicated in paragraph 10, above;

(e) note the results of the discussion regarding definition of categories "E" and "O", as reported in paragraphs 11 and 12 above, and provide comments and guidance to the Task Force;

(f) note the results of the discussion regarding citing documents sharing the same date as the application being searched, as reported in paragraph 14, above, and provide comments and guidance to the Task Force;

(g) comment on the approach for implementation of the revised recommendations of WIPO Standard ST.14, the text of the Editorial Note and the required period for implementation of ST.14 once it is revised, as proposed in paragraphs 15 and 16, above;

(h) note the results of the discussion regarding the recommendations for non-patent literature as indicated in paragraphs 17 to 20, above;

(i) note the suggestion to include recommendations on citing documents in languages other than the language of the document in which they are cited, as referred to in paragraphs 21 and 22, above, and comment on it.

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