

# WIPO



PCT/MIA/IV/4

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Fourth Session  
Geneva, June 27 to July 1, 1994**

MATTERS CONCERNING THE INTERNATIONAL SEARCHING AUTHORITIES

*Document prepared by the International Bureau*

1. Part 1 of this document contains comments on and proposals for modification of the PCT Search Guidelines (document PCT/GL/2) provided by the European Patent Office.
2. Part 2 of this document contains comments on and proposals for modification of the Administrative Instructions under the Patent Cooperation Treaty (PCT) provided by the European Patent Office, the Swedish Patent Office and the United States Patent and Trademark Office as well as an excerpt of the report of the Executive Coordination Committee of the Permanent Committee on Industrial Property Information (PCIPI/EXEC), adopted on May 20, 1994, which relates to the revision of WIPO Standard ST. 14. It also contains two alternative proposals prepared by the International Bureau for the modification of Section 503 of the Administrative Instructions.
3. Part 3 of this document contains comments on and proposals for modification of some forms for use by the International Searching Authorities provided by the Australian Industrial Property Organisation, the European Patent Office and the United States Patent and Trademark Office.
4. These comments and proposals, which will serve as a topic for discussion at the fourth session of the Meeting of International Authorities under the PCT, are hereby submitted to all International Authorities for information and comment.

PART 1

COMMENTS ON AND PROPOSALS FOR MODIFICATIONS  
OF THE PCT SEARCH GUIDELINES

Proposal by the European Patent Office

→ The aim of this proposal is, on a non mandatory basis, to make available copies of those documents cited in the application which are not comprised by the PCT minimum documentation such as non-patent literature; the documents might be used during search procedure, later during the Chapter II phase if any and finally in the national examination procedure.


In order to draw the applicants attention to this possibility a respective supplementing of the 2, part of the Administrative Instructions could be envisaged.

→ Furthermore the introduction of a second paragraph to No. 5.1 of the PCT SEARCH GUIDELINES, CHAPTER VI, could be suggested enabling the search examiner after verification of the content of the documents cited in the description of the application to invite the applicant to send copies of cited documents not belonging to the PCT minimum documentation and which are not available at the ISA to the ISA directly.

PART 2

COMMENTS ON AND PROPOSALS FOR MODIFICATIONS  
TO THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

2.1 Proposal by the European Patent Office



The aim of this proposal is, on a non mandatory basis, to make available copies of those documents cited in the application which are not comprised by the PCT minimum documentation such as non-patent literature; the documents might be used during search procedure, later during the Chapter II phase if any and finally in the national examination procedure.

In order to draw the applicants attention to this possibility a respective supplementing of the 2, part of the Administrative Instructions could be envisaged.

Furthermore the introduction of a second paragraph to No. 5.1 of the PCT SEARCH GUIDELINES, CHAPTER VI, could be suggested enabling the search examiner after verification of the content of the documents cited in the description of the application to invite the applicant to send copies of cited documents not belonging to the PCT minimum documentation and which are not available at the ISA to the ISA directly.

2.2 Proposal by the United States Patent and Trademark Office

A.I. §110

This section should be liberalized to allow numerical dates which include slashes (23/12/94) in addition to periods (23.12.94). Users of the forms are separating the day, month and year by slashes since the forms indicate that the day, month and year are separated by slashes rather than periods.

[See the attached form PCT/ISA/220]

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT  
OR THE DECLARATION

(PCT Rule 44.1)

To:	
Applicant's or agent's file reference	<b>FOR FURTHER ACTION</b> See paragraphs 1 and 4 below
International application No.	International filing date (day/month/year)
Applicant	

1.  The applicant is hereby notified that the international search report has been established and is transmitted herewith.  
**Filing of amendments and statement under Article 19:**  
 The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):  
**When?** The time limit for filing such amendments is normally 2 months from the date of transmittal of the international search report; however, for more details, see the notes on the accompanying sheet.  
**Where?** To the International Bureau of WIPO  
 34, chemin des Colombettes  
 1211 Geneva 20, Switzerland  
 Facsimile No.: (41-22) 740.14.35  
**For more detailed instructions, see the notes on the accompanying sheet.**
2.  The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.
3.  With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
  - the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
  - no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.
4. **Further action(s):** The applicant is reminded of the following:  
 Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.  
 Within 19 months from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).  
 Within 20 months from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Address only: Commissioner of Patents and Trademarks Box PCT Washington, D. C. 20231 Attn: ISA/US	Authorized officer   Telephone No.
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### 2.3 Proposal by the Swedish Patent Office

We are of the opinion that it is very important that the wording of WIPO Standard ST.14 and Section 503 of the Administrative Instructions under the PCT should in substance be exactly the same when indicating how documents should be cited. It happens that these two standards are not the same, especially when MIA or another PCT-body amends the rules for citing patent documents. This creates

confusion to the examiners and the public. Further it creates problems in our computer system for search reports. In addition, there should only be one single standard under the auspices of WIPO.

We suggest that Section 503 in Administrative Instructions will indicate that the citations in search report shall be indicated as said in WIPO Standard ST.14.

We prefer the form "**FR 222222 A**" when citing a patent document. One of our reasons is to diminish the possibility of reading a numeral in the ST.16 code as a part of the document number. We must stress, however, that we can accept also other forms, as long as ST.14 and Section 503 are in line with each other.

In view of the position taken by MIA on abbreviated titles we are in favour of a review of the entire paragraph 11 of ST.14. One must have in mind, however, that abbreviations must be understandable without a key, like "IBM Tech. Discl. Bull". Abbreviations like "AW&ST", used by "Aviation Week and Space Technology", can not be understood by the general public and should not be allowed. If abbreviations like "AW&ST" are used we will be forced to include a key list with every search report in order to make it understandable to the applicant and third parties.

2.4 Excerpt of document PCIPI/EXEC/XIV/5

Reproduced below is an excerpt of the report, and on the next page of Annex III, of the PCIPI Executive Coordination Committee (adopted on May 20, 1994), concerning the revision of WIPO Standard ST. 14 containing a reference to the need for modification of Section 503 of the Administrative Instructions in order to adapt it to the revised standard. The former text of the Standard is reproduced below under item 2.5 on pages 9 to 12.

"Revision of WIPO Standard ST. 14  
(Project P 967)

25. The Committee adopted the revised wording of subparagraph 11 (a) and a new subparagraph 11 (e) of WIPO Standard ST. 14 as recommended by the PCIPI/GI and which appears as Annex III to this report.

26. The International Bureau drew the attention of the Committee to the difference between the manner of citing a patent document according to the revised WIPO Standard ST.14 and that under Section 503 of the PCT Administrative Instructions, and stressed the need for a uniform system of citing patent documents. Since the offices which acted as International Searching Authorities under the PCT supported the revised WIPO Standard ST.14, the International Bureau stated that a proposal for a modification of Section 503 of the PCT Administrative Instructions as to the order of elements identifying a patent document in a citation would be presented to the next meeting of the PCT/MIA, to be held in Geneva from June 27 to July 1, 1994.

27. Noting the fact that subparagraphs 11(b), (c) and (d) of WIPO Standard ST.14 deviated from International Standard ISO 690:1987, the Committee instructed the PCIPI/GI to elaborate, within the scope of Task No. G-10 (Revise WIPO Standard ST.14 -- Recommendation for the Inclusion of References Cited in Patent Documents), a proposal to bring the said WIPO Standard into compliance with the above-mentioned ISO Standard and to present that proposal for adoption by the Committee, at its fifteenth session in November 1994."

[2.4, continued]

**ANNEX III**  
**WIPO STANDARD ST.14**  
RECOMMENDATION  
FOR THE INCLUSION OF REFERENCES CITED IN PATENT DOCUMENTS  
Revision adopted by the PCIPI Executive Coordination Committee  
at its fourteenth session

Paragraphs 1 to 10: no change.

11. Identification of any document cited shall be made by indicating the following elements in the order in which they are listed:

- (a) In the case of a patent document:
- (i) the Office that issued the document, by the two-letter code (WIPO Standard ST.3);
  - (ii) the number of the document as given to it by the Office that issued it (for Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document);
  - (iii) the kind of document, by the appropriate symbols as indicated on the document under WIPO Standard ST.16 (Standard Code for Identification of Different Kinds of Patent Documents) or, if not indicated on that document, as provided in that Standard, if possible;
  - (iv)\* the name of the patentee or applicant (in capital letters and, where appropriate, abbreviated);
  - (v)\* the date of publication of the cited patent document as indicated thereon;
  - (vi)\* where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following examples illustrate the citation of a patent document according to paragraph (a), above:

Example 1: JP 50-14535 B (NCR CORP.) 28 Hay 1975 (28.05.75), column 4, lines 3 to 27.

Example 2: DE 3744403 A1 (A. JOSEK) 29.08.91, page 1, abstract.)

Subparagraphs (b), (c) and (d): no change.

- (e) In the case of references obtained as print-outs from online databases:
- (i) the identification of the print-out and identification of the original document in the manner indicated in paragraphs (a), (b), (c) and (d), above, depending on the nature of the document;
  - (ii) where the document (e.g., an abstract) was obtained through an online search and neither a printed version of the document from the database nor the original document itself was available, the print-out should be cited.

(The following examples illustrate the citation of a print-out according to paragraph (e), above :

Example 1: Database WPIL, week 9016, London: Derwent Publications Ltd., AN 90-121923, Class Q51, SU 1511467 A (BRYAN MECH), abstract.

Example 2: Database Medline, US National Library of Medicine, (Bethesda, MD, USA), No. 94155687, X. R. DONG, 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements,' abstract, Chung Hua Wai Ko Tsa Chih, May 1993.

Example 3: Database Inspec, Institute of Electrical Engineers, (Stevenage, GB), Inspec No. 956632, B. P. JENSEN, 'Multilayer printed circuits. Production and application. II,' abstract, Electronik (DK), June - July 1976.)

\*

These elements are to be indicated only in a search report.



2.5 Text of WIPO Standard ST. 14 prior to its revision on May 20, 1994**HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION**

Ref: Standards - - ST.14

page: 3.14.0

**RECOMMENDATION FOR THE INCLUSION OF REFERENCES  
CITED IN PATENT DOCUMENTS**

(Statement by the International Bureau)

Articles published in scientific and technical journals often contain a certain number of references to earlier publications. Patent applications also very often contain (e.g. in the descriptions of the inventions) references to earlier patents or patent applications. In the course of the procedure for obtaining a patent, patent examiners cite one or several patent documents or other documents which describe similar or closely related technical solutions to the one described in a patent application being examined, in order to illustrate the prior art.

Some industrial property offices, but not all of them, bring these cited references to the attention of the general public, by including them in a published patent document. The present recommendation is intended to generalize the use of printing on the patent document the "reference cited" during the patent examination procedure, to standardize the way in which the said references should be presented in the patent document and to recommend a preferred place, where the "references cited" should appear in a patent document.

[2.5, continued]



## HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION

Ref: Standards - - ST.14

page: 3.14.1

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### Standard ST. 14

#### RECOMMENDATION FOR THE INCLUSION OF REFERENCES CITED IN PATENT DOCUMENTS

##### DEFINITIONS

1. For the purpose of this recommendation, the term “patents” means patents for invention, Inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition.
2. For the purpose of this recommendation, the expression “patent applications” means applications for -patents for invention, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition.
3. For the purpose of this recommendation, the expression “patent documents” includes patents for invention, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, utility certificates of addition, and published applications therefor.

##### BACKGROUND

4. Applications for patents are examined by a governmental authority or inter-governmental authority which, as a rule, is an Office. A patent for the invention is granted if the application complies with the formal requirements and, depending on whether and to what extent an “examination as to substance” is carried out, if the invention fulfills the substantive requirements of the national patent law.
5. When patent applications are examined or search reports are established therefor, a certain number of patent documents and other documents might be cited as references to illustrate the prior art by the Office (including a regional Office, and an International Searching Authority under the PCT).

##### RECOMMENDATION

6. It is recommended that Offices should include in their granted patents and in their published patent applications all relevant references cited in the course of a search or examination procedure.
7. It is recommended that the “List of references cited” be identified by INID Code No. 56.
8. It is recommended that the “List of references cited” appear either
  - (a) on the front page of the patent document or
  - (b) in a search report attached to the patent document.
9. It is recommended that if the “List of references cited” appears in a search report attached to the patent document, (e.g. under the PCT procedure) this should be Indicated on the front page of the patent document.
10. It is recommended that the documents in the “List of references cited” be organized in a sequence suitable to the users’ needs, this sequence being clearly illustrated in the presentation of the said list. The following is an example of a sequence of documents cited:
  - (i) domestic patent documents
  - (ii) foreign patent documents
  - (iii) non-patent literature

In search reports, however, the documents may be cited in the order of their pertinence.



**HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION**

Ref: Standards - - ST.14

page: 3.14.2

11. Identification of any document cited shall be made by indicating the following elements in the order in which they are listed:

- (a) In the case of a patent document set forth in category (1) to (iii) of paragraph 10 above:
- (i) the Office that issued the document, by the two-letter code (WIPO Standard ST.3);
  - (ii) the kind of document, by the appropriate symbols (WIPO Standard ST.16), as indicated on the original document;
  - (iii) the number of the document as given to it by the Office that issued it (for Japanese patent documents the indication of the year of the reign of the Emperor must precede the serial number of the patent document);
  - (iv)<sup>†</sup> the date of publication of the cited patent document as indicated thereon;
  - (v)<sup>\*</sup> where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings;
  - (vi)<sup>\*</sup> the name of the patentee or applicant.

(The following example illustrates the citation of a patent document according to paragraph (a) above: JP. B, 50-14535, published 1975, May 28, see column 4, lines 3 to 27, NCR Corporation.)

- (b) In the case of a book or other separately issued publication:
- (i) the name of the author;
  - (ii) the title (Including, where applicable, the number Of the edition and/or volume);
  - (iii) the year of publication, the pages;
  - (iv)<sup>\*</sup> the name of the publisher (in the case of company publications, the name and postal address of the company);
  - (v)<sup>\*</sup> as far as available, the place of publication (where only the location of the publisher appears on the book or other separately issued publications, then that location shall be indicated as the place of publication);
  - (vi)<sup>\*</sup> where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following example illustrates the citation of a book or other separately issued publication according to paragraph (b) above: H. Walton, 'Microwave Quantum Theory,' Volume 2, published 1973, by Sweet and Maxwell (London), see pages 138 to 192, especially pages 146 to 148.)

- (c) In the case of an article published in a periodical or other serial publication:
- (i) the title of the periodical or other serial publication;
  - (ii) the number of the volume and the date of the Issue in which the article appears;
  - (iii) as far as available, the place of publication (where only the location of the publisher appears in the periodical or other serial publication, then that location shall be Indicated as the place of publication);
  - (iv) the author and the title of the article and the number of the pages on which the article starts and ends;
  - (v) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

[2.5, continued]

<sup>†</sup> These elements are to be indicated only in a search report.

**HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION**

Ref: Standards - - ST.14

page: 3.14.3

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(The following example illustrates the citation of an article published in a periodical or other serial publication according to paragraph (c) above: IBM Technical Disclosure Bulletin, Volume 17, No. 5, issued 1974, October (Armonk, New York), J. G. Drop 'Integrated Circuit Personalization at the Module Level,' see pages 1344 to 1345.)

(d) In the case of an abstract:

- (i) the identification of the document containing the abstract in the manner set forth in paragraphs (a), (b) and (c), respectively, depending upon whether the abstract is contained in a patent document, in a book or other separately issued publication, or in an article published in a periodical or other serial publication;
- (ii) in the case where the abstract is not published together with the full text document which served as its basis, the identification of both abstract and full text document on the basis of whatever bibliographic data may be available in respect thereof.

(The following example illustrates the citation of an abstract according to paragraph (d) (ii) above: Chemical Abstracts, Volume 75, No. 20, Issued 1971, November 15 (Columbus, Ohio, USA),

D.I. Shetulov, 'Surface Effects During Metal Fatigue,' see page 163, column 1, the abstract No. 120718k, Fiz.-Khim. Mekh. Mater. 1971, 7(2), 7-11 (Russ.).

Note:

Further detailed information on the inclusion of references cited can be found in ISO Standard 3388 "Patent documents - - Bibliographic references - - Essential and complementary elements."

2.4 Proposal by the International Bureau for modification of Section 503 of the Administrative Instructions

2.6.1 In view of the decision of the PCIPI Executive Coordination Committee to amend WIPO Standard ST. 14 (see pages 7 and 8 of this document) and of the proposal by the Swedish Patent Office (see page 6 of this document), and in order to achieve harmonization between WIPO Standard ST.14 and Section 503, the International Bureau makes two alternative proposals to modify Section 503.

2.6.2 The first proposal consists of aligning the wording of Section 503(a) to the revised wording of WIPO Standard ST.14 (as reproduced on page 8 of this document), as set out below (the modifications in paragraph (a) are identified by underlining):

Section 503

Method of Identifying Documents Cited in the International Search Report

Identification of any document cited in the international search report referred to in Rule 43.5(b) shall be made by indicating the following elements in the order in which they are listed:

(a) In the case of a patent document (patent documents being patents within the meaning of Article 2(ii) as well as published applications relating thereto):

(i) [no change]

(ii) the number of the document as given to it by the Office that issued it (for Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document);

(iii) the kind of document, by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 (Standard Code for Identification of Different Kinds of Patent Documents) or, if not indicated on that document, as provided in that Standard, if possible;

(iv) to (vi) [no change]

The following examples illustrate the citation of a patent document according to paragraph (a), above:

JP-50-14535 B (NCR CORP.) 28 May 1975 (28.05.75), column 4, lines 3 to 27.

DE 3744403 A1 (A. JOSEK) 29.08.91, page 1, abstract.

[End of examples]

(b) to (d) [no change]

[2.6, continued]

2.6.3 The second proposal consists of replacing in Section 503 the detailed provisions by a simple reference to WIPO Standard ST.14. This proposal follows the suggestion made by the Swedish Patent Office (see page 6 of this document). It would have the great advantages of (i) achieving full compatibility between the two texts including new paragraph (e) of the standard and (ii) not requiring any modifications to Section 503 if and whenever WIPO Standard ST.14 is further revised, for example in order to harmonize it with the ISO Standard ISO 690:1987 referred to in paragraph 27 of the PCIPI Executive Coordination Committee report reproduced on page 7 of this document. The second proposal is set out below (the modifications are identified by underlining):

### Section 503

#### Method of Identifying Documents Cited in the International Search Report

Identification of any document cited in the international search report referred to in Rule 43.5(b) shall be made as provided in WIPO Standard ST. 14.

(a) to (d) [deleted]

PART 3

COMMENTS ON AND PROPOSALS FOR MODIFICATIONS OF FORMS FOR USE BY  
THE INTERNATIONAL SEARCHING AUTHORITIES

3.1 Proposal by the Australian Industrial Property Organisation

In the ISR it would be preferable if the patent family annex box, the special categories of cited documents list, and the signature and date boxes could be placed at the end of the list of the “documents considered to be relevant”, irrespective of its length. This would mean that we could do away with the cross in the overflow box. Because we computer-generate these forms now it should be easy to place this matter at the end, and thus eliminate a possible source of error. Is there any reason this can not be done?

3.2 Proposal by the United States Patent and Trademark Office

Notes to Form  
PCT/ISA/220

A separate section should be created to explain the procedure used to file Article 34 amendments. The reference to Article 34 amendments in the discussion of Article 19 amendments is causing confusion among our users.

[End of document