

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twentieth Session
Munich, February 6 to 8, 2013**

REVISION OF WIPO STANDARD ST.14

Document prepared by the International Bureau

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” (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. This document provides an update on the ongoing work of the Task Force. A further oral report on more recent progress will be given at the Meeting.

REVISION OF CATEGORY CODES

4. In relation to the proposal for the revision of category codes provided in paragraph 14 of WIPO Standard ST.14, the third round of discussion by the Task Force is scheduled to finish on December 14, 2012.

5. At the end of the second round of discussions, the participants in the Task Force have 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. The Task Force is yet to agree, however, on a new definition for category “X”, which currently covers documents which would either be cited “N” or “I” under the 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”.

6. The Task Force has also 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. Currently, this category only covers such documents when they are published after the priority date claimed.

7. Agreement remains to be reached by the Task Force participants on how International Authorities should cite patent documents bearing the same date as the international application being searched as a practice to help Offices apply anti-double-patenting laws. For these documents, paragraph 16.17 of the PCT International Search and Preliminary Examination Guidelines recommends the use of category “E”, even though these documents fall outside of this definition. One Office has proposed the introduction of new category “R” for these documents, but some other Offices participating in the Task Force believe that it would be preferable to use category “L” for this purpose since this category covers a 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 (the reason for the citation shall be given).

8. The Task Force has also not yet agreed on revised definitions of citation categories “O” and “E” with respect to their combination with other citation categories.
9. The question of implementation of a revised Standard after adoption by the CWS is under discussion, in particular, the Task Force has not yet reached a consensus on the time period for its implementation; one Office has suggested that implementation may take several years due to the time needed to change its systems.
10. In view of the number of items that remain to be agreed by the participants of the Task Force, it is likely that the Task Force will present only a progress report to the third session of the Committee on WIPO Standards instead of a final proposal for revision of paragraph 14 of ST.14 for consideration and adoption by the Committee.

RECOMMENDATIONS FOR NON-PATENT LITERATURE

11. In terms of the recommendations for the identification of non patent literature citations in order to bring WIPO Standard ST.14 in line with International Standard ISO 690:2010, the second round of discussions finished on December 10, 2012.
12. After the first round of discussions, the Task Force supported the proposal to revise WIPO Standard ST.14 taking into account the recommendations provided for in revised Standard ISO 690:2010. Participants nevertheless stated that more detailed consideration would be necessary to determine what particular recommendations in ISO 690:2010 should be transferred to ST.14 and what should be the level of granularity of the recommendations transferred. It was mentioned that, during the revision, the following aspects should be taken into account: coverage of all kinds of non-patent literature reference (in depth and structure); applicability and relevance of recommendations; examples to show a realistic range of document types and document sources; and balance between the impact on the practices of IP Offices (e.g. the need to change IT systems) and the benefits expected from the revision.
13. 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 in March 2013.
14. 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 of a name or title is provided, there is the question of how it should be indicated that it is a translation.
15. In the second round of discussions for this component of the Task Force, participants have therefore been invited to comment on whether the issue of citing documents published in a language different from the language of the search report should be addressed in the framework of the current revision.
16. The Task Force will report on the progress following the second round of discussions on this component to the third session of the Committee on WIPO Standards.

17. The Meeting is invited to note the contents of the present document.

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