

Background Paper

June 17, 1998 Version

1. WIPO Comment - 1998-05-22:

... subpara. 11bis will completely replace subparas. 11(e) and (f) of the draft given in Annex 3 to project P 37/97. Therefore, it seems to me logical to combine the two introductory sentences of 11bis (May 22, '98 version). One could start the new subpara. as follows:

11bis Identification of an electronic document retrieved, e. g., from a CD-ROM, the Internet or an online database, shall be made in the manner indicated in paras. 11(a), ...

... or parts thereof.

Attention is drawn.....:

(i)...

(ii)...

etc.

EPO Comment - 1998-05-27:

Par. 11.bis title

Both Internet and Online databases are "online". Suggestion :

Identification of an electronic document, e.g., retrieved from a CD-ROM, the Internet, or other dedicated online access mechanism (eg X25, Z39.50,...)

JPO Response - 1998-05-28:

Sorry, we cannot understand the phrase "dedicated online access mechanism (e.g. X25, Z39.50, ...)".

EPO Response - 1998-06-03:

EPO accepts the comment from JPO and proposes the following new wording:

“11bis. Identification of an electronic document, e.g. retrieved from a CD-ROM, the Internet, or from an online database accessible outside Internet”

This wording should make clear that Internet is not the only way to access electronic documents online. Indeed some classic online databases like STN are available via Internet as well as a direct access connection (like dial-up, X.25, leased line, etc). Does this explanation clarify the matter?

USPTO Response – 1998-06-11:

Since paragraph 11bis is a new paragraph and not a subparagraph, it does not need a title. Its introductory text should be similar in format to paragraph 11. The further clarification of “online” should be helpful and has been included in the latest revision.

2. WIPO Comment - 1998-05-22:

... propose to amend the heading of the first group of examples under 11bis as follows:

Examples 1-3: Documents retrieved from online databases.

EPO Comment - 1998-05-27

Title of examples 1-3: "Documents retrieved from commercial databases"

JPO Response - 1998-05-28:

Regarding the title of Example 1-3 in paragraph 11bis, we support the WIPO proposal.

EPO Response - 1998-06-03:

In view of point 2 above, our proposal for the title introducing Examples 1-3 would be:

“Examples 1-3: Online databases outside Internet”

USPTO Response - 1998-06-11:

The suggestions have been combined to state what we are giving examples of and to follow the format of the title for the Internet examples:

Examples 1-3: Documents retrieved from online databases outside the Internet

3. EPO Comment - 1998-05-27:

Ok for ISSN in online citations, but note that the numbers for electronic and paper publications may be different. On this part I am attaching a report on the "DOI", for further reflection. It is however too early to include this in the current revision of st.14.

USPTO Response - 1998-06-11:

No text change appears necessary at this time. Also note that paragraphs 11(b)(viii) and 11(c)(vi) both refer only broadly to a "standard identifier and number". Any future "DOI" identification would seem to be covered by this text. ISBN and ISSN are only examples of two possible identifiers which could be used (see, e.g., paragraph 1 of the DOI paper).

4. EPO Comment - 1998-05-27:

The GB remark to replace available by retrieved is ok, but then the wording becomes very cumbersome. Let us say simply "[retrieved on 1998-02-04 from Questel]" for instance in all examples. Another solution would be to say "accessed at Questel", but we prefer the combination in one phrase.

USPTO Response - 1998-06-11:

ISO 690-2 indicates the date should be in square brackets but not the source of the document. Also note examples 1-3, 6, 7 and 11 have text between the date and the source. Note we would also probably have to include the Internet URL address inside the square brackets too for the Internet examples. Another option might be to use "obtained from" or "acquired from" instead of "retrieved from". Regardless, we should try to parallel the ISO standard in this matter whenever possible even though "retrieved" would be used twice in the citation.

EPO Comment - 1998-06-12:

We leave it to the rest of the working group to choose the best solution.

USPTO Response - 1998-06-17:

We agree.

5. EPO Comment - 1998-05-27:

Examples 4 and 5 are inconsistent: one says "retrieved from the Internet" the other says " ... via URL". As URL is always Internet, maybe URL is a better way. It opens also the option URN, DOI, etc (see attachment) for later.

JPO Response - 1998-05-28:

As for the usage of URL and the Internet, we support the EPO proposal.

EPO Response - 1998-06-03:

Agreed.

USPTO Response - 1998-06-11:

Examples 6, 7, 9 and 11 indicate "Retrieved from the Internet: <URL: etc." It may be helpful to some users to mention the "Internet" in addition to "URL". Examples 4 and 5 have been modified to follow the same pattern.

6. EPO Comment - 1998-05-27:

The URL in example 4 is incomplete. It should end on html or another document type.

USPTO Response - 1998-06-11:

The full citation has been provided in the example.

7. EPO Comment - 1998-05-27:

The URL in example 5 is far too broad (www.dialogselect.com)

USPTO Response - 1998-06-11:

The specific reference Internet address could not be found. A new example has been provided.

EPO Response - 1998-06-12:

The very extensive URL will raise some eyebrows I think. However it is correct, although one can obtain a little shorter URL by navigating through the site in a different way. Obviously nobody will re-type the whole URL if he/she has not an electronic reference where copy and paste can be used. But we basically agree!

USPTO Response - 1998-06-17:

We agree this is a very long URL, but examiners may be faced with equally long URLs and shouldn't have to spend time trying to shorten them. They may introduce an error if they do so. Since we agree it is an accurate example, it has been left in the draft.

8. EPO Comment - 1998-05-27:

Example 10 is missing the sender's email address, which seems essential here.

EPO Response – 1998-06-03:

EPO would like to make the citation work easy for examiners. We would prefer entering one type of data only once and not in several places. And we would like to have very clear rules for identifying the type of publication. In the case of example 10, what should the examiner say: “online - electronic mail” or “online - serial”? Our opinion is that “serial” is a type of publication, but “electronic mail” is a method of transmitting information as opposed to fax or paper mail. We would be glad if JPO and USPTO could give additional proposals for discussion on this matter. By the way the origin of the document in the example 10 is not clear, because it does not mention the address of the email sender.

USPTO Response – 1998-06-11:

Please see our revision of the example which tries to clarify this matter. The example was created at the direction of the Working Group since a normal e-mail from one person to another was not considered to be a likely reference which would be cited. This example is really a citation of a serial document provided by e-mail. In order for someone to obtain information on receiving a copy of the document, they would have to send an e-mail message to the address given and include the text given in the citation (“info scout-report”) in the body of the message.

9. EPO Comment - 1998-05-27:

Replace one of the gopher examples by ftp, see example in EP application 97410036, first citation.

USPTO Response - 1998-06-11:

We could not find a copy of the reference you mentioned. We have provided a different example taken from US patent 5,737,425.

10. EPO Comment - 1998-05-27:

Also a PDF document could appear somewhere.

USPTO Response – 1998-06-11:

Any of the Internet examples could be PDF documents. We indicated in the paragraph prior to the examples that an electronic document in a page oriented mode did not need to be identified as an electronic document unless it is considered desirable or useful to do so. Even if a PDF document were cited, it would not be necessary to indicate it was in PDF format. Furthermore, we were reluctant to specifically mention PDF in the standard because it is the format of one company (Adobe) and not a generic format.

EPO Response - 1998-06-12:

We agree with the answer from USPTO.

11. EPO Comment - 1998-05-27:

Example 8: Is this an email address? Does it come from Usenet? We have to say so. The terms "retrieved from Internet" are too vague here.

USPTO Response - 1998-06-11:

The example is taken from ISO 690-2 (paragraph 5.3.1). A new example has been provided.

12. JPO Comment - 1998-05-28:

Please replace the Japanese patent document in Example 1 in paragraph (a) of section 11 to "JP 10-105775 A (NCR International Inc.) 24 April 1998 (24.04.1998), column 4, lines 9 to 42.", as the publication date of current Example 1 is too old.

EPO Response – 1998-06-03:

We agree with a more recent example of JP document.

USPTO Response - 1998-06-11:

We also agree. The new example has been included.

13. JPO Comment - 1998-05-28:

We recommend that the explanatory note, "If desired, the type of publication (e.g. monograph, serial, database, electronic mail) may also be specified in the type of medium designator." should be added in the paragraph 11bis.(i). This explanatory note makes it clear the type of publications of Example 10. (See, ISO690-2 7.3)

USPTO Response - 1998-06-11:

This option could be helpful for circumstances where the type of publication is clear. It has been added to the text but not to Example 10 as now modified, since the example is an e-mail containing a serial. Also, it would seem redundant to mention that it was an electronic mail message twice in the citation. See our response to Comment 8 above.

14. EPO Comment - 1998-06-03:

Paragraph numbering

There is a lot of interest in paragraph numbering, and it is already in use in recent JP documents. Our proposal would be to change paragraph 11(a)(vi) as follows:

“where applicable, the pages, columns, lines or paragraph numbers where the relevant passages appear, or the relevant figures of the drawings.”

and to add an example for this, which could look like (JPO please correct!):

“Example 4: JP 5-224330 A (<applicant name>) 3 September 1993 (03.09.1993), paragraphs [0003] to [0004]”

USPTO Response – 1998-06-11:

We agree. The text and example have been added. We have included the applicant’s name. Please review.

EPO Response - 1998-06-12:

11(a), Example 4: The applicant's name is "KONICA Corp." not SANPEI TAKESHI who is the inventor.

JPO Response - 1998-06-16:

We agree to add paragraph numbers in the text and example and propose the following modification to diversify the examples.

Example 1: JP 10-105775 A (NCR International Inc.) 24 April 1998 (24.04.1998), paragraphs [0026] to [0030].

Example 4: US 5635683 A (Robert M. McDermott et al.) 3 June 1997 (03.06.1997), column 7, lines 21 to 40.

USPTO Response - 1998-06-17:

We agree with both proposed examples and appreciate the JPO providing them. They have both been inserted into the draft text. In accordance with paragraph 11(a)(iv), the names of the applicant and patentees in the examples have been capitalized. The names of the patentees have also been abbreviated as recommended by the paragraph.

Similarly, the author's names in new Example 4 of paragraph 11bis have been capitalized as recommended by paragraph 11(b)(i).

15. EPO Comment - 1998-06-03:

Place of ISBN and ISSN numbers

These identifiers are part of the bibliographic data. Therefore they should be given before the indication of the relevant passages. Our proposal is to exchange paragraphs 11(b)(vii) and 11(b)(viii) and the same in 11(c), and to adapt the examples. EPO will try to find a real life example for 11(b) or 11(c).

USPTO Response – 1998-06-11:

The text seems to be easier to read with the standard number at the end and as suggested by ISO. The changes have not been included in the standard at this time. If we decide to do so we might want to consider putting the standard numbers after the titles given in paragraphs 11(b)(iii) and 11(c)(iii).

EPO Response - 1998-06-12:

We would like to wait for comments from the rest of the working group.

USPTO Response - 1998-06-17:

We agree.

16. EPO Comment - 1998-06-03:

Office copies of documents retrieved from Internet

EPO proposes that st.14 could contain a recommendation following paragraph 11bis(iv) which would say for instance:

“Office copies of an electronic document should be retained, under an internal reference number, if the document may not be available in future. This is especially important for documents retrieved from the Internet or online databases.”

USPTO Response – 1998-06-11:

We question whether a standard should recommend this level of detail for a storage system or policy. It should be up to each individual office to determine how they wish to store the documents, provided they are retrievable when requested. An internal reference number system does not need to be recommended.

17. EPO Comment - 1998-06-03:

Electronic documents also existing in paper form

Equally it might be worthwhile to insert the following sentence before the first examples in 11bis.:

“If an electronic document is also available in paper form or in a page oriented presentation mode (see paragraph 11 above) it does not need to be identified as an electronic document, unless it is considered desirable or useful to do so.”

Could JPO and USPTO agree with this?

USPTO Response – 1998-06-11:

This appears to be the text we have already include at that location, except for the comma after document which has now been added.

18. EPO Comment - 1998-06-03:

ISSN for electronic documents

You will find an interesting example at:

<http://link.springer.de/link/service/journals/10052/tocs/t8002003.htm>

You will find mention of a journal as follows:

The European Physical Journal C

ISSN: 1434-6044 (printed version)

ISSN: 1434-6052 (electronic version)

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USPTO Response – 1998-06-11:

Users should be made aware of these possibilities. Text has been added in paragraphs 11(b)(viii) and 11(c)(vi).

[End of Annex II and of Circular/
Fin de l'annexe II et de la circulaire]