

C. PCT 1387

July 18, 2013

Madam,
Sir,

Future Implementation of Revised WIPO Standard ST.14

1. This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).
 2. At the second session of the Committee on WIPO Standards (CWS) in April/May 2012, a Task Force was established to prepare a proposal for revision of WIPO Standard ST.14 "Recommendation for the Inclusion of References cited in Patent Documents". Work within the Task Force has progressed substantially but is ongoing, with discussions now focusing on implementation issues and transitional provisions.
 3. In the context of those discussions on implementation issues and transitional provisions, the Task Force has requested the International Bureau to consult with International Searching Authorities on a proposed time frame for the implementation of the revisions to ST.14, noting that it was the International Bureau's intention to implement the revised Standard ST.14 in the Administrative Instructions under the PCT to require all International Searching Authorities to use revised citation category codes in international search reports. That proposed implementation time frame is set out in paragraph 11, below.
 4. In order to enable International Searching Authorities to provide comments on the proposed time frame for the implementation of revised Standard ST.14, the present Circular gives some background information on the discussions by the Task Force and the provisional agreements reached to date. In addition, so as to show how the revisions to ST.14 might impact on the PCT Administrative Instructions, including certain forms, and the PCT International Search and Preliminary Examination Guidelines, it further sets out, in Annexes II and III, preliminary draft modifications to the Administrative Instructions, to certain
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forms and to the International Search and Preliminary Examination Guidelines. Furthermore, it sets out (in paragraph 19, below) preliminary draft transitional arrangements to bring those modifications into force.

5. At this point, all of the preliminary draft modifications to the PCT Administrative Instructions, the forms and the Guidelines, as well as the preliminary transitional arrangements, are presented for the purposes of information only. The International Bureau will formally consult on proposed modifications to the Administrative Instructions, forms, the Guidelines and proposed transitional arrangements after the formal adoption of the revised WIPO Standard ST.14 by the CWS, envisaged to take place in 2014.

6. International Authorities are invited to comment on the proposed timetable for implementation of revised Standard ST.14 set out in paragraph 11, below. Comments should be made to the International Bureau by August 31, 2013, preferably by e-mail to the following address: pctbdd@wipo.int.

7. Comments are also welcome, already at this early stage, on the preliminary draft modifications to the Administrative Instructions and the forms as set out in Annex II to this Circular, on the preliminary draft modifications of the PCT International Search and Preliminary Examination Guidelines set out in Annex III to this Circular, and on the preliminary draft transitional arrangements set out in paragraph 19, below. Those preliminary draft modifications and transitional arrangements have been prepared on the assumption that paragraph 14 of revised Standard ST.14 is adopted as shown in the draft set out in Annex I to this Circular.

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Background

8. The Committee on WIPO Standards (CWS), at its second session in April/May 2012, established a Task Force to prepare a proposal for revision of WIPO Standard ST.14, covering the issues of definition of category codes and the identification of non-patent literature.

9. At the third session of the CWS from April 15 to 19, 2013, the CWS noted a status report on the work of the Task Force (document CWS/3/4) and recommended that categories "N" and "I" should be introduced to replace category "X", but that a transitional period should be allowed where all three codes, "X", "N" and "I", could be used in parallel. The CWS referred the issue of the revised definition of category "X" along with the details of the transition period back to the Task Force. The CWS also noted the preliminary agreement on the revision of category "P" and recommended that the combination of category codes "E" and "O" with other categories should be optional (see the Summary by the Chair, document CWS/3/13, paragraphs 19 to 23 and the Report, document CWS/3/14, paragraphs 29 to 41). An informal meeting of the ST.14 Task Force was held in parallel to the third session of the CWS to take the drafting forward, especially in relation to the matters referred to the Task Force by the CWS.

Proposed Time Table for Implementation of Revised Standard ST.14

10. Following the decisions taken by the CWS and the discussions at the informal meeting of the ST.14 Task Force, the International Bureau has prepared a draft revised version of paragraph 14 of WIPO Standard ST.14 (see Annex I to this Circular, indicating changes compared to the present Standard) and of a draft "Editorial Note" to the revised Standard ST.14, setting out the proposed transitional arrangements. The texts of the draft revised version of paragraph 14 of WIPO Standard ST.14 and of the draft Editorial Note were posted on the ST.14 Task Force wiki forum on July 2, 2013, for comments by members of the Task Force by July 31, 2013.

11. The text of the draft Editorial Note, which is based on paragraphs 15 and 16 of document CWS/3/4, reads as follows:

“Editorial Note by the International Bureau

“The Committee on WIPO Standards (CWS) adopted the revision of paragraph 14 of Standard ST.14 at its fourth session on <Month Day>, 2014.

“The CWS agreed that the provisions of paragraph 14 of the revised Standard should be implemented by industrial property offices for all search reports established from <Month Day>, 2015, onwards. For search reports established prior to that date, the previous version of the said paragraph 14 (see Annex) should continue to be used.

“In adopting this revision with regard to the inclusion of new categories “N” and “I” and discontinuation of the category “X”, the CWS agreed that Offices may continue to use category “X” in addition to categories “I” and “N” for a transition period, while being considered still to be compliant with the Standard. This period should be kept as short as possible and not extend beyond <Month Day>, 2016.”

12. The draft revised version of paragraph 14 and of the draft Editorial Note have been prepared on the assumption that the revision of WIPO Standard ST.14 will be adopted by the CWS at its fourth session in 2014. The texts propose a transitional period of one year where categories “N” and “I” can be used in parallel with category “X” before use of the latter would be discontinued.

Preliminary Draft Modifications to the PCT Administrative Instructions and the PCT International Search and Preliminary Examination Guidelines

13. Annexes II and III to this Circular set out preliminary draft modifications to the Administrative Instructions under the PCT and the PCT International Search and Preliminary Examination Guidelines (Annex III) to show the impact the changes to paragraph 14 of WIPO Standard ST.14 currently under consideration by the Task Force might have on the Administrative Instructions and the Guidelines. Annex II also includes a draft of a page of Form PCT/ISA/210 listing the new category codes for cited documents. As explained above, at this point, those preliminary draft modifications are presented for the purposes of information only; the International Bureau will formally consult on proposed modifications to the Administrative Instructions (including forms) and the Guidelines after the formal adoption of the revised WIPO Standard ST.14 by the CWS, envisaged to take place in 2014.

14. With respect to the proposed preliminary draft modifications to the PCT Administrative Instructions, the proposal is to replace category “X” with categories “N” and “I” and to extend the scope of category “P” to cover documents published prior to the international filing date but on or after the priority date claimed in the international application. In addition, the requirement for category “P” to be accompanied by a category indicating relevance of a document to novelty and inventive step has been added to the Administrative Instructions, as is currently reflected in WIPO Standard ST.14.

15. It would also seem desirable to require International Authorities, when citing documents using categories “E” or “O”, to provide an indication of the potential relevance to novelty and inventive step in international search reports. This would result in improved guidance to applicants, third parties and examiners in the national phase. In particular, the indication of relevance to novelty or inventive step for documents cited “E” would facilitate the effective sharing of search reports, noting that documents published after the international filing date can be relevant to inventive step as well as novelty under the national laws of some States. Furthermore, for the majority of States that only consider later published documents as being relevant to novelty, this indication would allow an examiner in the national phase to dismiss “E” citations other than documents cited “E,N”. The preliminary draft modifications to

Section 507 of the Administrative Instructions set out in Annex II therefore require categories “E” and “O” to be accompanied by one of categories “N”, “I”, “Y” or “A” as an indication of relevance of the document to novelty and inventive step.

16. The preliminary draft modifications set out in Annex II also insert a subparagraph in Section 507 to provide for the use of citation category “D” for documents cited by the applicant in the application. This category currently exists in WIPO Standard ST.14 and its absence from the PCT Administrative Instructions appears to have been an accidental omission.

17. In the absence of agreement in the Task Force to introduce a new category for citing documents sharing the same date as the application being searched, a provision has been added in Section 507(f) for category “L” to be used for this purpose (see paragraph 14 of document CWS/3/4).

18. The changes to the citation category codes set out in the proposed preliminary draft modifications to the Administrative Instructions in Annex II have been reflected in a draft page of Form PCT/ISA/210, also included in Annex II. Identical changes would also have to be made to the citation category lists in Forms PCT/ISA/201 and 206 and Form PCT/SISA/501. In the draft page of Form PCT/ISA/210, the order of listing of the citation category codes has been revised to correspond to paragraph 14 of WIPO Standard ST.14 as proposed to be amended, rather than being alphabetical as in the current version of those forms.

19. With regard to bringing into effect the modifications to the PCT Administrative Instructions, the International Bureau proposes to follow a timetable similar to that proposed in the draft Editorial Note set out in paragraph 11, above, resulting in an implementation period of the revised Standard for International Authorities of slightly more than two years from the date of the adoption of revised Standard ST.14, along the lines of the following preliminary draft transitional arrangements:

(a) The modifications to the PCT Administrative Instructions would be promulgated with effect from a date between one year and 18 months from the date on which the CWS adopted the revised Standard ST.14 (the aim would be to promulgate the modifications with effect from July 1, 2015, the date on which any amendments to PCT Regulations which the PCT Assembly might adopt in 2014 would normally enter into force), and would apply to any international search report established on or after that date, irrespective of the international filing date of the international application concerned.

(b) Notwithstanding the above, any International Authority would be permitted to continue to follow the present version of the relevant Administrative Instructions for international search reports established within a period of up to 12 months from the date of entry into force of the modified Administrative Instructions. International Authorities intending to make use of that period would be invited to notify that fact to the International Bureau prior to the entry into force of the modified Administrative Instructions, giving an estimated date by which they expected to be using the new category codes.

(c) As category “D” exists in the current text of WIPO Standard ST.14, the addition of Section 507(i) of the Administrative Instructions to provide for citation category “D” does not depend on the adoption of the new standard by the CWS. This could therefore be brought into force at an earlier date than the date proposed in paragraph (a), for example, to coincide with other changes to the Administrative Instructions that may be made in the meantime.



HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION

Ref.: Standards - ST.14

page: 3.14.0

14 It is recommended that any document (reference) referred to in paragraph 7, above, and cited in the search report should be indicated by the following letters or a sign to be placed next to the citation of the said document (reference):

(a) *Categories indicating cited documents (references) of particular relevance:*

Category "~~N~~" "~~X~~": The claimed invention cannot be considered novel ~~or cannot be considered to involve an inventive step~~ when the document is taken alone;

Category "I": The claimed invention cannot be considered to involve an inventive step when the document is taken alone.

Category "Y": The claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

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) *Categories indicating cited documents (references) of other relevant prior art:*

Category "A": Document defining the general state of the art which is not considered to be of particular relevance;

Category "D": Document cited by the applicant in the application and which document (reference) was referred to in the course of the search procedure. Code "D" should always be accompanied by one of the categories indicating the relevance of the cited document;

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 preferably be accompanied by one of the categories "N", "I", "X"¹, "Y" or "A";

Category "L": 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 citing the document shall be given);

Category "O": Document referring to an oral disclosure, use, exhibition or other means. Code "O" should preferably be accompanied by one of the categories "N", "I", "X"¹, "Y" or "A";

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"¹, "Y" or "A";

Category "T": Later document published after the filing date (in the case of the PCT, the international filing date) or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention;

Category "&": Document being a member of the same patent family or document whose contents have not been verified by the search examiner but are believed to be substantially identical to those of another document which the search examiner has inspected.

[Annex II follows]

¹ Category "X" is no longer recommended to be used by the industrial property offices (see definition above), but the search reports established earlier than <Month Day>, 2015 or during the transitional period (from < Month Day >, 2015 to < Month Day >, 2016) may contain this category either as the main one, or accompanying categories "E", "O" or "P".

Draft modifications of the Administrative Instructions under the PCT

PART 5

INSTRUCTIONS RELATING TO THE INTERNATIONAL SEARCHING AUTHORITY²

Section 505

Indication of Citations of Particular Relevance in the International Search Report

(a) Where any document cited in the international search report is of particular relevance, the special indication required by Rule 43.5(c) shall consist of the letter(s) “N”, “I” ~~“X”~~ and/or “Y” placed next to the citation of the said document.

(b) Category “N” ~~“X”~~ is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel ~~or cannot be considered to involve an inventive step.~~

(b-bis) Category “I” is applicable where a document is such that when taken alone, a claimed invention cannot be considered to involve an inventive step.

(c) Category “Y” is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

Section 507

**Manner of Indicating Certain Special Categories
of Documents Cited in the International Search Report**

(a) Where any document cited in the international search report refers to an oral disclosure, use, exhibition, or other means referred to in Rule 33.1(b), the separate indication required by that Rule shall consist of the letter “O” placed next to the citation of the said document. This letter should be accompanied by an indication of the relevance of the document if the document had been relevant prior art as defined in Rule 33.1(a), using the categories provided in Section 505 and paragraph (c) below.

(b) Where any document cited in the international search report is a published application or patent as defined in Rule 33.1(c), the special mention required by that Rule shall consist of the letter “E” placed next to the citation of the said document. This letter should be accompanied by an indication of the relevance of the document if the document had been relevant prior art as defined in Rule 33.1(a), using the categories provided in Section 505 and paragraph (c) below.

(c) Where any document cited in the international search report is not considered to be of particular relevance requiring the use of categories “N”, “I” ~~“X”~~ and/or “Y” as provided in Section 505 but defines the general state of the art, it shall be indicated by the letter “A” placed next to the citation of the said document.

² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

(d) Where any document cited in the international search report is a document whose publication date occurred earlier than the international filing date of the international application, but on or after ~~later than~~ the priority date claimed in that application, it shall be indicated by the letter "P" next to the citation of the said document. The document category "P" should be accompanied by an indication of the relevance of the document using the categories provided in Section 505 and paragraph (c) above.

(e) Where any document cited in the international search report is a document whose publication date occurred after the filing date or the priority date of the international application and is not in conflict with the said application, but is cited for the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it shall be indicated by the letter "T" next to the citation of the document.

(f) Where in the international search report any document is cited for reasons other than those referred to in paragraphs (a) to (e), for example:

- a document which may throw doubt on a priority claim,
- a document cited to establish the publication date of another citation,
- a patent document having the same priority date as the international application that could be conflicting application,

such document shall be indicated by the letter "L" next to the citation of the document and the reason for citing the document shall be given.

(g) Where a document is a member of a patent family, it shall, whenever feasible, be mentioned in the international search report in addition to the one cited belonging as well to this family and should be preceded by the sign ampersand (&). Members of a patent family may also be mentioned on a separate sheet, provided that the family to which they belong shall be clearly identified and that any text matter on that sheet, if not in the English language, shall also be furnished to the International Bureau in English translation.

(h) A document whose contents have not been verified by the search examiner but are believed to be substantially identical with those of another document which the search examiner has inspected, may be cited in the international search report in the manner indicated for patent family members in the first sentence of paragraph (g).

(i) Where any document referred to in the international search report has been cited by the applicant in the application, it shall be indicated by the letter "D" next to the citation of the said document. The document category "D" should be accompanied by an indication of the relevance of the document using the categories provided in Section 505 and paragraph (c) above.

Section 508 **Manner of Indicating the Claims to Which** **the Documents Cited in the International Search Report Are Relevant**

(a) The claims to which cited documents are relevant shall be indicated by placing in the appropriate column of the international search report:

(i) where the cited document is relevant to one claim, the number of that claim; for example, "2" or "17";

(ii) where the cited document is relevant to two or more claims numbered in consecutive order, the number of the first and last claims of the series connected by a hyphen; for example, "1-15" or "2-3";

(iii) where the cited document is relevant to two or more claims that are not numbered in consecutive order, the number of each claim placed in ascending order and separated by a comma or commas; for example, "1, 6" or "1, 7, 10";

(iv) where the cited document is relevant to more than one series of claims under (ii), above, or to claims of both categories (ii) and (iii), above, the series or individual claim numbers and series placed in ascending order using commas to separate the several series, or to separate the numbers of individual claims and each series of claims; for example, "1-6, 9-10, 12-15" or "1, 3-4, 6, 9-11."

(b) Where different categories apply to the same document cited in an international search report in respect of different claims or groups of claims, each relevant claim or group of claims shall be listed separately opposite each indicated category of relevance. Each category and each relevant claim or group of claims may be separated by a line.

The following example illustrates the situation where a document is of particular relevance under Section 505(b) as to claims 1 and 2, under Section 505(b-bis) as to claim 3 and under Section 505(c) as to claim 4, and indicates the general state of the art under Section 507(c) as to claims 11 and 12:

<i>Category</i>	<i>Citation</i>	<i>Relevant to claim No.</i>
	GB, A 392,415 (JONES) 18 May 1933 (18.05.33)	
N X	Fig.1	1- 2 3
I	<u>Fig.1</u>	<u>3</u>
Y	page 3, lines 5-7	4
A	Fig. 5, support 36	11-12

INTERNATIONAL SEARCH REPORT

International application No.

A. CLASSIFICATION OF SUBJECT MATTER		
According to International Patent Classification (IPC) or to both national classification and IPC		
B. FIELDS SEARCHED		
Minimum documentation searched (classification system followed by classification symbols)		
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched		
Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)		
C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.		
Categories of cited documents: "N" document of particular relevance; the claimed invention cannot be considered novel when the document is taken alone "T" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art "A" document defining the general state of the art which is not considered to be of particular relevance "D" document cited by the applicant in the application and which document (reference) was referred to in the course of the search procedure "E" earlier application or patent published on or after the international filing date "L" 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 (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but on or after the priority date claimed "I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "&" document member of the same patent family		
Date of the actual completion of the international search	Date of mailing of the international search report	
Name and mailing address of the ISA/ Facsimile No.	Authorized officer Telephone No.	

Form PCT/ISA/210 (second sheet) (Draft for Consultation)

[Annex III follows]

Draft modified paragraphs of the International Search and
Preliminary Examination Guidelines

CHAPTER 16
INTERNATIONAL SEARCH REPORT³

Citation Category

Sections 505, 507

16.65 Documents which are cited are given a category indication by way of an alphabetic character, details of which are given in Administrative Instructions 505 and 507 and below. The categories for citations are also explained under the “Documents considered to be relevant” section of the report. A category should always be indicated for each document cited. Where needed, combinations of different categories are possible.

- *Particularly relevant documents*

Section 505

16.66 Where a document cited in the international search report is particularly relevant, it is indicated by the letters “N”, “I”~~“X”~~ or “Y”.

16.67 Category “N”~~“X”~~ is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel ~~or where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step.~~

16.67.1 Category “I” is applicable where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step.

16.68 Category “Y” is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art.

- *Documents defining the state of the art not prejudicing novelty or inventive step*

Section 507(c)

16.69 Where a document cited in the international search report represents state of the art not prejudicial to the novelty or inventive step of the claimed invention, it is indicated by the letter “A”.

- *Documents which refer to a non-written disclosure*

Section 507(a)

16.70 Where a document cited in the international search report refers to a non-written disclosure, the letter “O” is entered. Examples of such disclosures include conference proceedings. The document category “O” should be ~~is always~~ accompanied by a symbol indicating the relevance of the document according to paragraphs 16.67 to 16.69, for example O,N~~X~~, O,I, O,Y or O,A.

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned, with respect to the proposed PCT International Search and Preliminary Examination Guidelines PCT/GL/ISPE/3 Prov. sent to International Authorities with Circular C. PCT 1371 dated January 31, 2013 for the purposes of consultation.

- *Intermediate documents*

Section 507(d)

16.71 Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see Article 2(xi)(b)), are denoted by the letter "P". The letter "P" is also given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category "P" is always accompanied by a symbol indicating the relevance of the document, for example P, ~~N,X~~, P,I, P,Y or P,A.

- *Documents relating to the theory or principle underlying the invention*

Section 507(e)

16.72 Where any document cited in the search report is a document whose publication date occurred after the filing date or the priority date of the international application and is not in conflict with the said application, but which may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter "T".

- *Potentially conflicting patent documents*

Section 507(b)

16.73 Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date) but published later than that date and the content of which would constitute prior art relevant to novelty (Article 33(2)) or inventive step (Article 33(3)) is indicated by the letter "E" (see Section 507(b) and Rule 33.1(c)). ~~Where the patent document and the application searched have the same date, the patent document is also identified by the letter "E". An exception is made for patent documents based on the priority under consideration. The document category "E" should be accompanied by a symbol indicating the relevance of the document according to paragraphs 16.67 to 16.69, for example E,N, E,I, E,Y or E,A.~~

- *Documents cited in the application*

Section 507(i)

16.74 When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, such documents are identified using the letter "D". The document category "D" should be accompanied by one of the categories showing the relevance of the cited document, for example D,N, D,I, D,Y or D,A ~~may be identified on the search report by the wording "cited in the application", which appears under the cited document.~~

- *Documents cited for other reasons*

Section 507(f)

16.75 Where in the search report any document is cited for reasons other than those referred to in the foregoing paragraphs (in particular as evidence), for example:

(a) a document which may throw doubt on a priority claim (Article 4(C)(4) of the Paris Convention) (see paragraph 11.06), ~~or~~

(b) a document cited to establish the publication date of another citation (see paragraph 11.18), or

(c) a document whose publication date cannot clearly be established, but would be relevant to novelty and/or inventive step if the publication date were prior to the filing date of the international application (see paragraph 11.18), or

(d) a patent document having the same priority date as the international application that could be a conflicting application and give rise to issues such as double patenting or entitlement (see paragraph 11.10).

the document is indicated by the letter “L”. Brief reasons for citing the document should be given. Documents of this type need not be indicated as relevant to any particular claims. However, where the evidence which they provide relates only to certain claims (for example the “L” document cited in the search report may invalidate the priority in respect of certain claims and not others), then the citation of the document should refer to those claims.

- *Non-prejudicial disclosures*

16.76 In certain cases the invention may have been disclosed, before the relevant date for the purposes of the PCT, in such a way that it is not considered to form part of the state of the art in accordance with the national law of one or more designated Offices. The applicant may make a declaration of the existence of such excluded state of the art in the request form according to Rule 4.17(v). However these exemptions do not necessarily apply in all designated Contracting States and additionally, according to Rule 51 *bis*.1(a)(v), the applicant may still have to file the correct documents in the national/regional phase at the designated Office in question in order to qualify for the exemption. Consequently such documents must be cited on the international search report with the appropriate category indicated above and may also be considered in the written opinion of the International Searching Authority and during international preliminary examination.

Relationship Between Documents and Claims

Section 508

16.77 Each citation should include a reference to the claims to which it relates. If necessary, various relevant parts of the document cited should each be related to the claims in like manner (with the exception of “L” documents, see paragraph 16.75, and “A” documents, see paragraph 16.80). It is also possible for the same document to represent a different category with respect to different claims. For example:

<u>N</u> X	WO9001867 A (WIDEGREN LARS (SE))	1
	8 March 1990 (1990-03-08)	
<u>I</u>		<u>2</u>
Y	* figure 1 *	<u>32-5</u>
A	* figure 2 *	6-10

The above example means that Figures 1 and 2 of the cited document disclose subject matter which prejudices the novelty ~~or inventive step~~ of claim 1, which prejudices the inventive step of claim 2 in light of common general knowledge, which prejudices the inventive step of claims 32-5 when combined with another document cited in the search report, and which represents non-prejudicial state of the art for the subject matter of claims 6-10.

**CHAPTER 11
PRIOR ART**

Co-pending Applications, Including Those Filed on the Same Date

11.10 The PCT does not deal explicitly with the case of co-pending ~~international~~ applications of the same date. However, it is an accepted principle in most patent granting systems that two patents shall not be granted to the same applicant for one invention.

Moreover, it could be useful for national jurisdictions to be made aware of any rare incidence where two patent applications for the same invention sharing a priority date are filed by different applicants. Therefore, where a published patent document is found whose claims have the same priority date and relate to the same invention as the international application being searched (even though the patent or application may not necessarily claim that invention in identical terms), the conflicting document should be cited in the international search report and identified with an "L" category symbol, as raising possible issues such as double patenting or entitlement. It is permissible to allow an applicant to proceed with two international applications having the same description where the claims are quite distinct in scope and directed to different subject matter. However, in the rare case in which there are two or more international applications from the same applicant designating the same State or States and the claims of those applications have the same priority date and relate to the same invention (even though they may not necessarily claim that invention in identical terms), each conflicting application should (as long as it has already been published) be cited in the international search report and identified with a "L" category symbol as raising possible double patenting issues.

11.10.1 A notification, independent of the international search report and written opinion, to the applicant alone, may be is given in the case where his international application relates to the same invention and shares the same priority date as a separate unpublished patent application filed by the same applicant designates a State in which he proceeds with a national application having the same priority date and relating to the same invention as the said international application, if the examiner is aware of this such a situation. However, no such notification should be given where two unpublished applications (international or otherwise) of the same priority date and relating to the same invention are received from two different applicants.

- *Disclosure Made on Web Sites of Unknown Reliability*
[...]

11.18 Where the examiner obtains an electronic document which establishes the publication date for the Internet disclosure, he should make a print-out of this document, which must mention both the URL of the relevant Internet disclosure and the date of publication of that relevant Internet disclosure. The examiner must then cite this print-out in the international search report as an "L" document and cite the relevant Internet disclosure according to the relevance of its content ("N", "I" "X", "Y", "A") and according to the date as established ("N", "I" "X", "Y", "A", "P,N" "X", "P,I", "P,Y", "P,A", "E,N", etc) (see paragraph 16.75(b)). Where the examiner is unable to establish the publication date of the relevant Internet disclosure and it is relevant to the inventive step and/or novelty of the claimed invention, he should cite it in the international search report with the category "L" for those claims which it would have affected if it were published in time and giving it the date it was printed out as the publication date (see paragraph 16.75(bc)).

APPENDIX TO CHAPTER 13

Examples in which a single document calls into question the inventive step

A13.13 Under the practice of some Authorities, a document whose content alone calls into question the inventive step of at least one independent claim, and possibly that of one or more claims depending on it would be categorized as "I" "X". The following are examples of situations in which this may occur:

- (a) where a technical feature known in a technical field is applied from its original field to another field and its application therein would have been obvious to a person skilled in the art;
- (b) where a difference between the document's content and the claimed matter is so well known that documentary evidence is unnecessary;
- (c) where the claimed subject matter relates to the use of a known product, and the use would have been obvious from the known properties of the product;
- (d) where the claimed invention differs from the known art merely in the use of equivalents that are so well known that the citation of documentary evidence is unnecessary.

[End of Annex III]