

PCT/MIA/21/5
ORIGINAL: ENGLISH ONLY
DATE: JANUARY 14, 2014

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

**Twenty-First Session
Tel Aviv, February 11 to 13, 2014**

REVISION OF WIPO STANDARD ST.14

Document prepared by the International Bureau

SUMMARY

1. Noting the lack of consensus between members of the Task Force preparing a proposal for revision of WIPO Standard ST.14 on whether or not to introduce the proposed citation category codes, this document explores issues relevant to this question. International Authorities are invited to provide their views on the implementation and utility of the proposed revisions to ST.14.

BACKGROUND

2. The Meeting of International Authorities, at its nineteenth session held in Canberra from February 8 to 10, 2012, recommended that the International Bureau should propose the creation of a Task Force under the Committee on WIPO Standards (CWS) to consider the revision of WIPO Standard ST.14 (see paragraph 40 of document PCT/MIA/19/13 and paragraphs 96 to 102 of document PCT/MIA/19/14).

3. In line with this recommendation, the CWS, at its second session from April 30 to May 4, 2012, decided to establish a Task Force (see paragraphs 30 and 31 of document CWS/2/14). The task included two components:

- (i) preparing a proposal for the revision of category codes provided in paragraph 14 of WIPO Standard ST.14, taking into account the comments and draft proposals stated in paragraphs 7 and 10 to 14 of document CWS/2/6; and

(ii) studying 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), and preparing a proposal if the revision were considered convenient.

4. The International Bureau presented a status report on the work of the Task Force to the sixth session of the PCT Working Group (document PCT/WG/6/8). Discussions of this document are detailed in paragraphs 377 to 387 of the report of the session (document PCT/WG/6/24).

5. This document analyzes the advantages and disadvantages from a PCT perspective of implementing the revision of citation category codes prepared by the Task Force. Work on the second component covering identification of non-patent literature citations remains ongoing in the Task Force, with further analysis of ISO 690:2010 and the citation of documents in a language other than the language of the search report. Progress on this part of the task will be reported to the fourth session of the Committee of WIPO Standards, but is not touched upon in this document.

REVISION OF CITATION CATEGORY CODES

ESTABLISHMENT OF THE TASK FORCE

6. Before the Task Force was set up, the Meeting of International Authorities, at its nineteenth session in February 2012, considered the desirability to revise WIPO Standard ST.14 to provide new category codes specific to novelty and inventive step. The benefits of distinguishing between novelty and inventive step for a relevant document when taken alone are detailed in document PCT/MIA/19/11. In brief, these advantages are as follows:

- (a) Offices would have more detailed information on the relevance of documents cited in national search reports on related patent applications in other Offices as well as international search reports. Given that most national search reports are not accompanied by a written opinion on patentability of the claims, this information could therefore contribute to more efficient processing of patent applications and help avoid duplication of work.
- (b) For international applications, the distinction between novelty and inventive step for single documents cited in the international search report would make this information publicly available at an earlier stage in the application process. Since the written opinion of the International Searching Authority is not usually made available until 30 months from the priority date, introducing two new citation category codes to replace category "X" in the international search report would therefore indicate whether a document was relevant to novelty or inventive step one year earlier, around 18 months from the priority date of the international application.
- (c) Extra information on the relevance of a document when considered alone could be particularly useful for projects such as the Common Citation Document (CCD) application involving the IP5 Offices¹. For the participating Offices, the CCD application displays the results of prior art searches of patent applications in the same patent family together on a single page. The extra information could also help to automate the generation of consistent search reports and written opinions by Offices.

¹ See <http://www.fiveipoffices.org/documentation/ccd.html> for further details.

7. The document discussed by the Meeting of International Authorities also noted that the European Patent Office (EPO) had in some cases already begun making available to the public in the European Patent Register information on cited documents classified as relevant to inventive step when taken alone (see EPO Newsletter 23/2011). Previously, the EPO had used a separate citation category for such documents, but the information was kept for internal purposes only. The International Bureau therefore believed that it would be useful if the practice of indicating relevance to inventive step when taken alone could be followed by other International Authorities, and that this information could be included for all searches and made available in a more accessible form as part of the international search report.

8. Paragraphs 96 to 102 of the report of the nineteenth session of the Meeting (document PCT/MIA/19/14) summarize the discussions on the revision of WIPO Standard ST.14. In particular, paragraph 98 gives details of the considerations on distinguishing between documents cited as category "X" for novelty and those for inventive step, and paragraph 102 records the decision by the Meeting:

"98. Most International Authorities supported the principle of distinguishing between documents currently cited as category "X" for novelty and those cited for inventive step, considering it a useful distinction, particularly in the light of development of systems such as the Common Citation Document, though the particular letter "I" might not be appropriate since in some fonts it could be mistaken for "L". However, some International Authorities were concerned that the use of category "X" was well established and either usage implied that the document might constitute a reason for refusal of the relevant claim, or else that distinguishing might be an unnecessary burden on the examiner. One International Authority suggested that it would also be useful to consider the grouping of "Y" category documents to ensure that it was clear how they were supposed to be used together."

...

"102. While some International Authorities expressed certain reservations, the Meeting recommended that the International Bureau should propose the creation of a task force under the Committee on WIPO Standards to consider revision of WIPO Standard ST.14. The draft mandate of such a task force should extend to all matters within the scope of ST.14, including the definition of citation categories and the recommended presentation of non patent literature."

PROGRESS IN THE TASK FORCE

9. According to the mandate given by the CWS, the Task Force has prepared a revised version of paragraph 14 of WIPO Standard ST.14, which is reproduced in the Annex to the present document (amended or new categories are highlighted). The revised paragraph 14 splits the current citation category "X" used for a document showing that the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone into two new categories, "N" and "I". Category "N" would apply for a document showing that the claimed invention cannot be considered novel when the document is taken alone; category "I" would apply for a document showing that the claimed invention cannot be considered to involve an inventive step when the document is taken alone. The revised paragraph also enlarges the scope of category "P" and provides guidance on how particular categories should be combined.

10. The International Bureau consulted International Authorities on the proposed time frame being considered by the Task Force for the implementation of the revised version of paragraph 14 of WIPO Standard ST.14 by way of Circular C. PCT 1387, dated July 18, 2013. That Circular also included preliminary draft modifications to the PCT Administrative Instructions, including certain forms, and draft modifications to the PCT International Search and Preliminary Examination Guidelines, to indicate how the revisions to ST.14 might be

implemented in the PCT. The Circular proposed an implementation timetable for the PCT based on a draft Editorial Note prepared by the Task Force. This would involve International Authorities switching to the new citation categories during a 12 month period beginning on July 1, 2015, if the revised Standard were adopted in spring 2014 (see paragraph 19 of the Circular). The majority of the nine International Authorities that responded to the Circular supported the proposed implementation timetable.

11. Despite the progress in the Task Force in preparing a draft revision to paragraph 14 of WIPO Standard ST.14 and an Editorial Note to deal with the implementation in line with its mandate from the CWS, consensus has not been reached on whether the revised citation category codes should indeed be introduced at all. While there is a group of Task Force members which appear in favor of adopting the proposed revisions to ST.14 as set out in the Annex to the present document, another group of members do not see a clear advantage to replacing citation category "X" with categories "N" and "I". These members have expressed concern with the use in search reports of the new codes by a patent examiner. They have therefore questioned whether the more detailed codes would bring a net benefit to the system as a whole. The two main reservations about the revisions are as follows:

- (a) The lack of a harmonized definition of novelty and inventive step could lead to a non-uniform application between patent Offices of citing individual documents as relevant to novelty "N" or inventive step "I". This could be misleading for Offices and applicants and bring about de-standardization. In contrast, it was believed that the present definition of category "X" was generally applied uniformly across all International Searching Authorities.
- (b) The increase of work for an examiner in deciding whether a document currently cited "X" should be cited "N" or "I". An increase in the average time to process a search request would result in search reports being issued later than under the current practice. It has therefore been questioned whether the benefit to the applicant of having the additional information on citations in a search report would outweigh the delays in issuing the report due to providing this additional information.

CONSIDERATIONS IN THE REVISION OF WIPO STANDARD ST.14

12. In addition to the benefits and drawbacks to revising the citation category codes outlined in paragraphs 6 and 11, above, respectively, the International Bureau would like to point out the following additional factors that could be relevant in any revision.

13. Since the creation of the Task Force, the PCT Assembly has decided that the written opinion of the International Searching Authority will be made available on PATENTSCOPE at 18 months from the priority date in respect of all international applications filed after July 1, 2014 (see paragraphs 25 to 30 of document PCT/A/44/5 for further details). One reason for establishing the Task Force listed in paragraph 6, above, will therefore become less relevant for international applications in the future. However, most national applications do not publish an opinion on patentability with the search report. The extra information on current category "X" citations may therefore remain useful to Offices, applicants and third parties for national applications where only the search report is published. Moreover, when a written opinion is issued, this may be made available separately from the published application and search report, as will be the case in the PCT where the written opinion will be made available on PATENTSCOPE but not published together with the international application and the search report. Alternatively, third parties and Offices may be using information from secondary sources, such as CCD, for their information on potentially relevant documents. In such cases, there will no doubt be some benefit to accessibility of information by distinguishing between "N" and "I" citations in the search reports.

14. In the view of the International Bureau, it would appear that the lack of a harmonized definition of novelty and inventive step will not lead to a non-uniform application between patent Offices of citing individual documents as relevant to novelty "N" or inventive step "I". Along with this concern, it was pointed out that the present category "X" is generally applied uniformly across all International Searching Authorities. This requires an examiner to make a judgment on the difficult issue of obviousness for borderline inventive step citations. If this judgment is made in a sufficiently uniform manner between patent Offices despite the lack of a harmonized definition of inventive step, there would appear to be no reason why categories "N" and "I" would not be applied with a similar high degree of consistency. In most cases, novelty is a more straightforward issue to determine than inventive step. This is therefore unlikely to be any more of a problem than the current decision between whether to cite a document as category "X" or "A", opinions on which may differ both between national laws and between different examiners seeking to apply the same national law

15. The relative difficulty in determining novelty and inventive step is also a factor in considering the additional time for an examiner to decide whether a relevant document should be cited "N" or "I". This additional time will also depend on whether a written opinion is being drawn up by the search examiner at the same time as the search report, as is the case in the PCT. If so, the task of including the extra information in the search report should not be unduly burdensome since the distinction between novelty and inventive step will have to be made in the written opinion, which is drawn up at the same time as the international search report.

16. The potential use of search reports by other Offices is another factor in the overall added value of the proposed citation categories "N" and "I". When an Office searching an application does not draw up or publish a written opinion or examination report at the same time as the search report, the extra detail compared to that shown in current "X" citations would help other Offices better understand the relevance of the document. Even in cases where an opinion is published, there may be some benefit to seeing this information in the search report itself. This will be the case for developing the CCD application discussed in paragraph 6, above, but it will also apply in any work sharing arrangements based on search reports. The added value of the revised citation category codes would, however, be less significant if written opinions become the primary information source when Offices utilize previous work on patent family members.

17. On the other hand, the Offices acting as International Authorities have experience both as International Searching Authorities and as designated Offices and may see the issues differently. If there are strong concerns about the time which would be involved in changing IT systems to deal with new codes, the amount of additional examiner time required to apply the new codes, or about the utility of codes to the end users, such matters should be reported to the CWS.

DISCUSSION BY THE MEETING

18. In light of the benefits and drawbacks to revising the citation category codes outlined in paragraphs 6 and 11, above, respectively, the International Authorities are invited to comment on the implementation and utility of the proposed revisions to ST.14 set out in the Annex to the present document. The results of this discussion will be forwarded to the Task Force and can thus be taken into account by the CWS in its deliberations on whether to adopt the proposed revision to paragraph 14 of WIPO Standard ST.14.

19. *The Meeting is invited to comment on the issues raised in the present document.*

[Annex follows]



HANDBOOK ON INDUSTRIAL PROPERTY INFORMATION AND DOCUMENTATION

Ref. Standards ST.14

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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": The claimed invention cannot be considered novel 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"¹: 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, published on or after the international filing date. Code "E" should preferably be accompanied by one of the categories "N", "I", "X"², "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 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.

[End of Annex and of document]

² Category "X" is no longer recommended to be used by the industrial property offices, but the search reports established earlier than July 1, 2015 may contain this category either as the main one, or accompanying categories "E", "O" or "P".