

Committee on WIPO Standards (CWS)

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REVISION OF WIPO STANDARD ST.14

Document prepared by the Secretariat

INTRODUCTION

1. The Committee on WIPO Standards (CWS), at its second session held in April-May 2012, agreed to create Task No. 45 for the revision of WIPO Standard ST.14, which concerns references cited in patent documents. The CWS also decided to establish the ST.14 Task Force to handle such revision. (See paragraphs 28 to 31 of CWS/2/14).
2. The abovementioned Task No. 45 has two components:
 - (a) 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.
 - (b) 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.
3. At its third session, held in April 2013, the CWS noted the status report on the revision of WIPO Standard ST.14 prepared by the International Bureau and, as requested, provided comments and guidance on certain issues that had been raised by the ST.14 Task Force. (See document CWS/3/4 and paragraphs 29 to 41 of CWS/3/14). On this basis and in accordance with the request by the CWS, the ST.14 Task Force continued its discussions. The results of the work done so far are presented in this document.

4. The main objective of the revision of category codes (first component of the Task) is to introduce a distinction in search reports between documents cited for novelty and documents cited for their relevance to inventive step when taken alone. In practical terms this would mean the replacement of the category "X" with two new categories "N" and "I", where category "N" would apply for a document showing that the claimed invention cannot be considered novel when the document is taken alone; and 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. At the same time, the Task Force was requested that the proposal for revision provided guidance on a transition period when these three codes, namely, "X", "N" and "I", could be used in parallel and the details of the transition be reflected in an Editorial Note.

5. However, during the discussion that followed the third session of the CWS, the practical advantages of this change for the whole system, i.e., the positive balance between the additional value of providing more detailed information in the search reports and the additional burden on the examiners for providing these details, were questioned again by some Task Force members. Understanding that this issue has an impact on the basis of the proposal, as well as on the mandate given by the Committee, in particular on the convenience of revising category codes, the Task Force would like to submit the arguments expressed during the discussion for consideration and decision by the CWS (see paragraphs 8 and 9, below).

6. With regard to the second component of the Task, work will recommence after the present (fourth) session of the CWS on the basis of comments submitted earlier and the results of the analysis presented by the EPO in January 2014 (see paragraphs 11 to 13, below).

TASK FORCE DISCUSSION

Revision of Category Codes

7. After the third session of the CWS, following the request by the CWS, the Task Force has prepared the proposal for revision of paragraph 14 of WIPO Standard ST.14, which is reproduced in Annex I to the present document, and the draft Editorial Note, which is reproduced in Annex II to the present document.

8. However it was not possible to reach consensus with respect to the advisability of the proposed revision, i.e., with respect to the balance between the expected advantages of making new categories "N" and "I" mandatory and the possible drawbacks of this decision (see paragraph 4 above). The issue has also been presented for comments at the twenty-first session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT), February 11 to 13, 2014 (see document PCT/MIA/21/5).

9. Benefits and disadvantages of replacing the category "X" with "N" and "I", that have been considered by the Task Force, can be summarized as follows:

- (a) inclusion of new categories "N" and "I" would mean that more detailed information on the relevance of document cited would be available in the search report;
- (b) for PCT 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. Equivalent arguments would be applicable to national and regional applications;
- (c) extra information on the relevance of a document when considered alone could be particularly useful for work-sharing initiatives and cooperative projects;
- (d) 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. The longstanding definition of the category “X” has shown that its use by IPOs is rather uniform;

(e) 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 and, consequently, it could increase examination backlogs in patent offices;

(f) proposed removal of category “X” would prevent search examiners from taking the pragmatic approach with respect to documents with many complex claims and multiple complex citations.

10. Considering the above, the Task Force requests the CWS to take a definitive decision concerning the convenience of the proposed revision.

11. In case that the CWS considers the revision beneficial, the draft revised paragraph 14 and the draft Editorial Note, as prepared by the Task Force and reproduced in Annexes I and II of the present document, are proposed for consideration by the CWS.

12. It should be noted that the above-mentioned draft revision and Editorial Note, though having been discussed and supported by some Task Force members and not contested by others, have not been formally agreed on by the Task Force as the versions to be presented for consideration and approval by the CWS. Therefore the CWS is invited to either adopt the proposed drafts as presented, or send them back to the Task Force, along with the decision taken with respect to the question raised in paragraphs 5 and 8 to 10, above, for confirmation of the necessary support to the proposed revision.

Recommendations for Non-Patent Literature

13. As indicated in paragraph 2 above, the second component of Task No. 45 relates to the possible alignment between WIPO Standard ST.14 and the International Standard ISO 690:2010 (*Information and documentation – Guidelines for bibliographic references and citations to information resources*). At the third session of the CWS, the scope of this component was extended to include the issue of citing documents in languages other than the language of the search report.

14. The EPO has finalized the analysis of the International Standard ISO 690:2010 and shared the results with the Task Force in January 2014 (see paragraph 19 of document CWS/3/4).

15. On the basis of the materials provided by the EPO, Task Force members plan to start preparing the proposal concerning this component of Task No. 45 after CWS/4.

16. *The CWS is invited to:*

(a) *note the status report on the work of ST.14 Task Force provided in the present document;*

(b) *note the considerations referred to in paragraphs 5, 8 and 9, above;*

(c) *agree on the convenience of the proposed revision, as requested in paragraph 10, above;*

(d) in case of a positive decision with respect to the issue referred to in paragraph 16 (c), above, consider the draft revised paragraph 14 of ST.14, as reproduced in the Appendix to Annex I to the present document, and either to adopt the proposed revision or to send it back to the Task Force for confirmation (see paragraphs 10 to 12, above); and

(e) in case of a positive decision with respect to the revision proposed in the previous paragraph, consider the draft Editorial Note to be included in the Standard along with the follow-up actions to be taken by the International Bureau (see paragraphs 4 and 5 of Annex II) and either approve them or send them back to the Task Force for confirmation (see paragraphs 10 to 12, above).

[Annexes follow]

PROPOSAL FOR THE REVISION OF PARAGRAPH 14 OF WIPO STANDARD ST.14

1. This Annex contains the proposal for revision of paragraph 14 of WIPO Standard ST.14 prepared by the ST.14 Task Force under the first component of Task No. 45 of the CWS work program. The draft revised version of the said paragraph is reproduced in the Appendix to the present Annex I.

2. The revised version of paragraph 14 of WIPO Standard ST.14 contains the following changes (changes are highlighted):

(a) new category "N":

Category "N": The claimed invention cannot be considered novel when the document is taken alone;

(b) new category "I":

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

(c) revised definition of category "X" with the recommendation that new search reports should no longer use this category:

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

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;

(d) amended definitions of categories "E" and "O" with the recommendation that these categories should preferably be accompanied by other categories:

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 "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";

(e) amended definition of category "P" to extend its scope to the documents published on the priority date claimed in the application:

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";

(f) new footnote reflecting implementation provisions in line with the Editorial Note (see Annex II to document CWS/4/5):

¹ 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".

[Appendix follows]

APPENDIX

DRAFT REVISED VERSION OF PARAGRAPH 14 OF WIPO STANDARD ST.14

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"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 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.

¹ 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".

PROPOSAL REGARDING THE IMPLEMENTATION OF THE REVISED PARAGRAPH 14 OF WIPO STANDARD ST.14

1. This document contains the proposal regarding the implementation of the revised paragraph 14 of WIPO Standard ST.14, which is prepared by the ST.14 Task Force under the first component of Task No. 45 of the CWS work program and following the request by the CWS (see paragraph 39 of document CWS/3/14).

2. In order to allow sufficient time (not less than one year) for implementation of the revised Standard in the Industrial Property Offices (IPOs) and to align the revision of ST.14 with the revision of PCT Administrative Instruction, the proposed implementation date is July 1, 2015, provided that the revision is adopted by the CWS at its fourth session in May 2014.

3. With respect to the transition period when the three codes “X”, “N” and “I” could be used in parallel, the Task Force members came to the conclusion that it is not advisable to establish such period. It was stated that the parallel use of the three codes “X”, “N” and “I” might cause confusion and therefore the Task Force would propose the CWS to consider the “clean transition” from the category “X” to categories “N” and “I”, i.e., starting from July 1, 2015, the search reports should no longer contain the code “X”.

4. Under the condition that the Committee agrees on the revision of paragraph 14 of ST.14, the following draft Editorial Note is presented for consideration and approval by the CWS:

“Editorial Note by the International Bureau

“The Committee on WIPO Standards (CWS) adopted the revision of the present Standard at its fourth session on May 16, 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 July 1, 2015, onwards. For search reports established prior to that date, the previous version of paragraph 14 of the Standard (see Annex) should continue to be used.”

5. As it is indicated in the draft Editorial Note, it is proposed that the current version of paragraph 14 of ST.14 be kept in the Annex to the Standard at least until July 1, 2015. The International Bureau should thereafter remove the Editorial Note and the Annex as the editorial change and report to the CWS accordingly.

[End of Annex II and of document]