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INTERIM COMMITTEE FOR TECHNICAL COOPERATION

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REVIEW OF THE COMPATIBILITY OF THE
"GENERAL GUIDELINES FOR THE PREPARATION OF ABSTRACTS"
WITH THE PROVISIONS OF THE PCT

prepared by the International Bureau

Background of this document

1. At its twelfth session, in June 1974, the Technical Coordination Committee of ICIREPAT requested that the "General Guidelines for the Preparation of Abstracts" (hereinafter referred to as "the Guidelines") drawn up by its Technical Committee for Search Systems be submitted to the PCT Interim Committee for Technical Cooperation (hereinafter referred to as the "Interim Committee") in order that the latter could review the compatibility of these Guidelines with the provisions of the PCT, meaning all relevant Articles, Rules, and Administrative Instructions, if any. (See paragraph 18 of the Report of the twelfth session, document IC/TCC/XII/13, and also paragraph 27 of the Report of the eleventh session, document IC/TCC/XI/12).
2. This document was prepared in response to that request.

Purpose of this document

3. The purpose of this document is to assist the Interim Committee in carrying out its review and in presenting its conclusions to the Technical Coordination Committee of ICIREPAT. Consequently, this document calls attention to the relevant provisions of the PCT by means of a comparison of these provisions with the Guidelines.

Relevant Provisions of the PCT

4. The relevant provisions of the PCT (Treaty and Regulations) dealing with abstracts are Article 3(3) and Rules 3.3(a)(iii), 8.1 and 3, 9.1(iii). The full texts of Article 3 and Rules 3, 8 and 9 are set forth in Annex A.

Guidelines

5. The Guidelines referred to above are set forth as Annex B to this document.

Comparison

- | 6. | <u>PCT</u> | <u>Guidelines</u> |
|--|---|---|
| (i) | "The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought." (Article 3(3)) | "The abstract is not intended nor designed for use in interpreting the scope or meaning of the claims." (Guidelines, Definition, last sentence) |
| <u>Comment:</u> It seems that there is no difference of substance between the two texts, but in this case it would be preferable to use the same wording. | | |
| (ii) | "A summary of the disclosure as contained in the description, the claims and any drawings;" (Rule 8.1(i), first sentence) | "An abstract of a patent document is a concise statement of its technical disclosure." (Guidelines, Definition, first sentence) |
| <u>Comment:</u> Same as on 6(i). | | |
| (iii) | "The summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention." (Rule 8.1(i), second and last sentence) | No counterpart in the Guidelines. |
| <u>Comment:</u> It would seem advisable to have a text analogous to the PCT in the Guidelines. | | |
| (iv) | "Where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention." (Rule 8.1(ii)) | No counterpart in the Guidelines. |
| <u>Comment:</u> Same as on 6(iii). | | |
| (v) | "The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English)." (Rule 8.1(b)) | "The abstract should be clear and concise and generally should not exceed 250 words." (Guidelines, Presentation, first sentence) |
| <u>Comment:</u> There is a clear difference in the contemplated length of the abstract, and the reference to the language (English) gives an extra clarification in the PCT text which is not present in the Guidelines. | | |
| (vi) | "The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application." (Rule 8.1(c)) | "The abstract should not contain speculative statements regarding the merits or applications of the invention and should not disparage or contain an appraisal of the prior art." (Guidelines, Content, item 4) |

PCT

Guidelines

(vi) (cont'd)

"Statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparison with the prior art shall not be considered disparaging per se)" (Rule 9.1(iii))

Comment: There is an obvious incompatibility between the two texts in so far as a comparison with the prior art seems to be forbidden in the Guidelines.

(vii) "Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses." (Rule 8.1(d))

No counterpart in the Guidelines.

Comment: Same as on 6(iii).

(viii) "The number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases the applicant may suggest more than one figure." (Rule 3.3(a)(iii))

"Such regulations may enable the abstract to be accompanied by one or more drawings." (Guidelines, Introduction, third sentence)

"If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall indicate the figure or figures which it so considers. Publications by the International Bureau shall then use the figure or figures so indicated by the International Searching Authority. Otherwise, the figure or figures suggested by the applicant shall be used in the said publications." (Rule 8.2)

Comment: Whereas the PCT is specific on prescribing that a drawing (if any in the application) should accompany the abstract, the Guidelines contain no specific indication to this effect. The Introduction of the Guidelines contains a general reference to the provisions of the national laws, leaving the question open. Consequently, the same comment as on 6(iii) applies.

PCT

- (ix) "The abstract shall be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is a need for consulting the international application itself." (Rule 8.3)

Guidelines

"The abstract should enable the reader thereof, regardless of his degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure. The abstract should sufficiently describe the disclosure to assist readers in deciding whether to consult the full text of the patent document for details." (Guidelines, Definition, second and third sentences)

Comment: Same as on 6(i).

Additional Provisions

7. In addition, the Guidelines contain several provisions which could be considered as compatible (and as useful additions) to the PCT provisions relating to abstracts. (Paragraphs 3 and 5 of the Guidelines)

8. It should also be noted that the PCT contains certain requirements as to Description (Rule 5), Claims (Rule 6), Drawings (Rule 7), Expressions, Etc., Not to be Used (Rule 9), Terminology and Signs (Rule 10) and Physical Requirements of the International Application (Rule 11) which should be taken into consideration in the Guidelines.

9. The Interim Committee is invited to express its views as to the compatibility of the Guidelines with the provisions of the PCT, and formulate recommendations concerning further action of ICIREPAT on the Guidelines.

[Annexes follow]

ARTICLE 3

The International Application

(1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.

(2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.

(3) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought.

(4) The international application shall:

- (i) be in a prescribed language;
- (ii) comply with the prescribed physical requirements;
- (iii) comply with the prescribed requirement of unity of invention;
- (iv) be subject to the payment of the prescribed fees.

RULE 3

*The Request (Form)*3.1 *Printed Form*

The request shall be made on a printed form.

3.2 *Availability of Forms*

Copies of the printed form shall be furnished free of charge to the applicants by the receiving Office, or, if the receiving Office so desires, by the International Bureau.

3.3 *Check List*

(a) The printed form shall contain a list which, when filled in, will show:

- (i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application (request, description, claims, drawings, abstract),
- (ii) whether or not the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a priority document, a receipt for the fees paid or a check for the payment of the fees, an international or an international-type search report, a document in evidence of the fact that the applicant is the successor in title of the inventor, and any other document (to be specified in the check list),
- (iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be filled in by the applicant, failing which the receiving Office shall fill it in and make the necessary annotations, except that the number referred to in paragraph (a)(iii) shall not be filled in by the receiving Office.

3.4 *Particulars*

Subject to Rule 3.3, particulars of the printed form shall be prescribed by the Administrative Instructions.

RULE 8

*The Abstract*8.1 *Contents and Form of the Abstract*

(a) The abstract shall consist of the following:

- (i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;
- (ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention.

(b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).

(c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

8.2 *Failure to Suggest a Figure to be Published with the Abstract*

If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall indicate the figure or figures which it so considers. Publications by the International Bureau shall then use the figure or figures so indicated by the International Searching Authority. Otherwise, the figure or figures suggested by the applicant shall be used in the said publications.

8.3 *Guiding Principles in Drafting*

The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art, especially by assisting the scientist, engineer or researcher in formulating an opinion on whether there is a need for consulting the international application itself.

RULE 9

*Expressions, etc., Not To Be Used*9.1 *Definition*

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

9.2 *Noting of Lack of Compliance*

The receiving Office and the International Searching Authority may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly. If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.

9.3 *Reference to Article 21(6)*

"Disparaging statements," referred to in Article 21(6), shall have the meaning as defined in Rule 9.1 (iii).

GENERAL GUIDELINES FOR THE PREPARATION OF ABSTRACTSIntroduction

1. ICIREPAT, considering it important that abstracts prepared by or on behalf of applicants reach the maximum level of quality and uniformity at the earliest possible date, recommends the following general guidelines for their preparation. Applicants are additionally advised to give due consideration to the regulations concerning abstracts of the Office to which the abstract is to be submitted. Such regulations may enable the abstract to be accompanied by one or more drawings. In such case, the abstract should be drafted with this possibility in mind.

Definition

2. AN ABSTRACT OF A PATENT DOCUMENT IS A CONCISE STATEMENT OF ITS TECHNICAL DISCLOSURE. The abstract should enable the reader thereof, regardless of his degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure. The abstract should sufficiently describe the disclosure to assist readers in deciding whether to consult the full text of the patent document for details. The abstract is not intended nor designed for use in interpreting the scope or meaning of the claims.

Content

3. THE ABSTRACT SHOULD BE PRIMARILY DIRECTED TO THAT WHICH IS NEW IN THE ART TO WHICH THE INVENTION PERTAINS. If the invention is in the nature of a modification to an apparatus, process, product or composition, the abstract should be directed to the technical disclosure of the modification. If the invention is of a basic nature the entire technical disclosure may be new in the art and the abstract should be directed to the entire disclosure. If a patent relating to a product, particularly a compound or composition, also contains significant disclosure of its method of preparation or use, this matter should also be abstracted. If the disclosure involves alternatives, the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative.

4. The abstract should not contain speculative statements regarding the merits or applications of the invention and should not disparage or contain an appraisal of the prior art.

5. Where applicable and provided the document contains the information, the abstract should include at least the following: (1) if a machine, apparatus or system, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and preparation, (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given. With regard particularly to chemical inventions for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., "the compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics". Exemplification of a class should be by a typical example. For processes, the type of reaction, reagents and process conditions should be stated, generally illustrated by a single example.

6. As the abstract, when published, will be accompanied by data items which identify the applicant and the patent document to which it pertains, such data should not be included in the abstract by the applicant.

Presentation

7. THE ABSTRACT SHOULD BE CLEAR AND CONCISE AND GENERALLY SHOULD NOT EXCEED 250 WORDS. Phrases should not be used which can be implied, such as "This

disclosure concerns", "The disclosure defined by this invention", "This disclosure describes", etc. The legal phraseology used in patent claims often employing such words as "said" and "means" should also be avoided.

Sample Abstracts

8. (a) A heart valve with an annular valve body defining an orifice and having a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between the open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.
- (b) A method for sealing, by application of heat, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. The bond forms at any one surface point immediately after heating for a period of time less than the total time of exposure to heated air of that point. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.
- (c) Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 70°C. under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating.

CHECKLIST TO ACCOMPANY
"GENERAL GUIDELINES FOR THE PREPARATION OF ABSTRACTS"

In the following checklist, the abstractor should, after having studied the disclosure to be abstracted, place a check in the second column after the applicable terms listed in the first column. The requirements listed in the third column corresponding to the checked items of the first column should be borne in mind by the abstractor as he prepares his abstract. Finally, the abstractor may compare his finished abstract with the checked requirements and place a corresponding checkmark in the fourth column if he is satisfied that the requirements have been met.

| If the invention is a(n): | Check here | the abstract should deal with: | If so, check here |
|---|------------|---|-------------------|
| Article | | its identity, use; construction, organization; method of manufacture. | |
| Chemical compound | | its identity (structure if appropriate); method of preparation; properties, uses. | |
| Mixture | | its nature, properties, use; essential ingredients (identity, function); proportion of ingredients, if significant; preparation. | |
| Machine, apparatus or system | | its nature, use; construction, organization; operation. | |
| Process or operation | | its nature and characterizing features; material and conditions employed; product, if significant; nature of and relationship between the steps, if more than one. | |
| If the disclosure involves alternatives | | the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative. | |

Total number of words does not exceed 250:

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