



## AIPPI's comments regarding importance of and requirements for abstracts in patent applications

*Prepared by Standing Committee on PCT*

### About AIPPI

The International Association for the Protection of Intellectual Property (Association Internationale Pour la Protection de la Propriété Intellectuelle ("AIPPI"), is an international organization, founded in 1897, dedicated to the development, improvement, and legal protection of intellectual property. AIPPI is a politically neutral, non-profit organization headquartered in Switzerland having over 9,000 members representing over 125 countries and operating mainly through National Groups in many of those countries and other regions.

The members of AIPPI include intellectual property lawyers, patent, copyright and trademark attorneys, and patent agents in corporate and private practice throughout the world, as well as academics and other persons interested in intellectual property, and including members from North America, South America, Europe, Asia, Australia and Africa. AIPPI is organized into 67 National and 2 Regional Groups, and its members participate by joining one of these groups.

AIPPI promotes the protection of intellectual property on a national and international basis by studying and comparing existing laws and proposing new laws and international and regional treaties and agreements relating to intellectual property. In its long history, AIPPI has adopted more than 700 Resolutions and Reports. AIPPI's Resolutions are published in English, French and German, and are provided to international and national intellectual property organizations around the world. The presentation of these Resolutions and Reports to international

Governmental Organizations, such as the World Intellectual Property Organization (“WIPO”), has contributed considerably to the development, improvement and harmonization of the international protection of intellectual property.

### Response to Circular 1517

AIPPI thanks WIPO for this opportunity to comment on the issues raised in Circular 1517. This response has been prepared by the AIPPI Standing Committee on PCT (“SCPCT”) and has been approved by the AIPPI Bureau.

Circular 1517 invites comments on potential revisions to current PCT guidance relating to abstracts. In particular, WIPO has identified potential issues with respect to abstract length, excessive text on figures, and inappropriate choice of the figure to accompany the abstract. AIPPI understands WIPO believes certain applicant practices may be increasing translation costs and creating inefficiencies at WIPO. WIPO is considering revising the *PCT Applicants’ Guide* and the *International Search and Preliminary Examination Guidelines* to provide further guidance to applicants and the International Search Authority (ISA). In this context, Circular 1517 asks for information about national guidelines or practices that may offer better or more specific guidance on aspects of abstract drafting and choice of figure.

In response to this request, the SCPCT has canvassed its membership and generated the attached chart summarizing national guidance on preparation of abstracts. This chart is not exhaustive; it reflects only those countries where a committee member was available to respond within the relatively short time available for this consultation. Therefore, while the SCPCT considers the chart useful for comparison of certain national practices, it is not a thorough representation of practices of all AIPPI National Groups and Independent Members.<sup>1</sup> The chart is primarily based on local rules and practice guidelines, but in some cases the content represents the general analysis of a local patent practitioner who provided the information based on his/her experience with abstracts and the local patent office.

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<sup>1</sup> Should additional time be available and if it would be useful to WIPO, the SCPCT would be pleased to engage in a more rigorous study of this topic through consultation with its National Groups and Independent Members.

The chart shows the abstract is, in general, a minor part of the patent application primarily intended to provide a technical description to assist patent searching. Computer searches now permit full text patent searching using key words. However, abstracts are still useful for initial review of search results done on a computer. Titles alone are usually insufficient for such review. Abstracts provide the only readily available summary of the patent contents. Thus, AIPPI agrees that it would be helpful to patent offices and patent practitioners alike if abstracts and any accompanying abstract figure did consistently provide precise technical content to the degree possible given the practical limitations on space. AIPPI believes such precision should be encouraged, although such guidance should also consider the need in some jurisdictions to ensure statements made in the abstract are no narrower than the broadest independent claim. With regard to selection of a figure in applications where figures are used, AIPPI considers that it would be desirable to encourage applicants to select a figure which, to the greatest extent possible, corresponds to the elements of the invention chosen by the applicant to be described in the abstract. When such correspondence is insufficient, often the text of the abstract cannot be understood without reference to other figures and the selected figure cannot be understood without reference to text other than the abstract. The applicant benefits from quick and accurate identification of applicant's publication or patent as relevant prior art to a third party application.

The chart shows that national laws and practices on abstracts vary greatly. The perception of importance of the abstract ranges from being of little importance in Australia to quite important in Argentina. Guidelines for minimum length range from no guideline to 50 words; guidelines for maximum length range from no guideline to 400 words. Some jurisdictions provide guidance for a figure to accompany the abstract; others do not. Hence, it is not surprising that the ISAs encounter a wide variety of practices falling outside PCT Rules 8.1(b) and 11.11(a) notwithstanding the guidance currently provided in the *PCT Applicant's Guide* and the PCT International Search and Preliminary Examination Guidelines.

Circular 1517 contemplates addressing these issues through improving the guidance provided to applicants and ISA examiners for drafting and revising of abstracts. While the guidance could be clarified and improved, AIPPI notes that the current guidance is not followed in many cases

and thus even improvements to that guidance may not have the desired effect. It is an unfortunate fact that many practitioners do not consult the guidance before preparing their abstracts for international applications, and it is likely that many do not even know that such guidance exists. Thus, if these issues are problematic for the ISAs, AIPPI suggests as a first step, with or without a contemporaneous updating of the guidance, an outreach program to educate practitioners as to the existence of the guidance and of the practical importance of the issues raised in C. PCT 1517. Such an outreach program could be timed together with a phased increase in enforcement of PCT rules, thus in due course giving ISA examiners greater authority to ensure abstracts and figures accompanying abstracts serve their intended purpose of facilitating effective searching (PCT Rule 8.3).

In a specific case where an ISA examiner has concerns about an abstract in a patent application being searched (or if the abstract is missing and the receiving office has not requested correction of the defect), the examiner should have the ability to invite the applicant to correct the defect. Although the ISA has the authority under PCT Rule 38 to establish the abstract on its own in these situations, AIPPI believes that the scope or key features of the invention as described in the abstract are best set forth by the applicant and should not be established or revised by the ISA. Relative to the applicant, the ISA has a lesser understanding of the invention and thus is at risk of making a substantive misstatement.

Word length of the abstract should, ideally, be less of a concern than quality of content. However, practical considerations and usability for the intended purpose dictate that minimum and maximum length guidelines are needed. AIPPI considers the current guidance provided in PCT Rule 8.1(b) to be reasonable and appropriate.

AIPPI notes that further adoption of ePCT may be helpful to address issues relating to the abstract. Although ePCT currently allows abstracts longer than the recommended 50-150 words to be submitted, the software could presumably be modified to provide a yellow flag (caution) with respect to abstracts that exceed a maximum desired length, suggesting that the applicant consider reducing it, if appropriate. Depending on technical feasibility, a similar warning might be possible for figures selected with included text, generating a reminder of

policy on this topic. Outreach might then address not only issues relating to the abstract and selected figure, but also to encouraging use of ePCT in general.

AIPPI is grateful for this opportunity to provide comments, and looks forward to further discussion on this topic in the future.

Country / Jurisdiction	Relevant Regulation	Requirements	Length	Figures	Amendments Accepted	Relevance of abstracts / Other
Argentina	Patentability Guidelines	The Argentine PTO considers abstracts to be quite important. Our Patentability Guidelines establish that abstract should clearly portray what the invention is about allowing the reader to quickly have an idea of what the invention refers to. It should be an efficient tool for prior art search so it is relevant that its content is accurate. In principle it should not contain more than 250 words and preferably, it should have between 50 and 150 words. Chemical formulas, charts and figures may be included. The abstract should concentrate on what is new in the technical field of the invention. While the abstract is suggested initially by the applicant the Examiner has to define its final content before the application proceeds to publication. When performing the preliminary or formal examination a thorough review of the corresponding abstract is performed by the Examiner. At that point in time the Examiner will check that the abstract is clear, concise, that it accurately represents the invention and that it clearly states the technical field of the invention. The Examiner can amend the abstract depending on the defects observed. If amendments are introduced in the preliminary examination report he or she must state clearly what are those. If the Examiner considers that a totally new abstract needs to be submitted by the applicant, then he or she will issue an Office Action requesting same.	Max. 250. Preferably between 50 and 150	Yes	Yes both voluntary and as requested by Examiner	Quite Important. Should be an efficient tool for prior art search.
Australia	Regulation 3.3	Although IP Australia has to comply with regulation 3.3, it really pays little attention to the abstracts that are submitted. Accordingly we can currently submit a version of the main independent claim. The situation is very different in New Zealand where they examine and reject abstracts.	Preferably 50 to 150 words	Yes	-	IP Australia pays little attention to abstracts
Canada	Manual of Patent Office Practice (MOPOP), Chapter 8 states that Section 79 of the Patent Rules	<ul style="list-style-type: none"> <li>Must contain a concise summary of the matter contained in the application and, where applicable, the chemical formula that, among all the formulae included in the application, best characterizes the invention;</li> <li>specify the technical field to which the invention relates;</li> <li>be drafted in a way that 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;</li> <li>be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art; and</li> <li>not contain more than 150 words. (emphasis added)</li> </ul>	Not more than 150 words	Yes	-	Should allow clear understanding of the invention and allow search in the particular art
Chile	Industrial Property Law 19039	Chilean Industrial Property Law No. 19039 on abstracts mimic Rules 8.1, and 8.2 (b) of the PCT Regulations. There is one difference with respect to 8.1 (b), which is the length of the abstract: maximum 1600 characters Article 38 of the Regulations). There is nothing in CL Law or Regulations following Rule 8.3 of the Regulations of the Patent Cooperation Treaty. Under our IP Law and Regulations, the abstract is considered technical information useful for publication purposes. Prior art searches conducted by the Chilean Industrial Property Institute Examiners are based on the abstract already published: pending, issued, abandoned or rejected patents. Upon acceptance for prosecution of a patent application, the applicant shall publish an abstract thereof in the Official Gazette only once within a period of 60 days as from the date of acceptance for prosecution of the respective application, indicating the antecedents that best interprets the object of the privilege being requested. After the Publication of the abstract is made all administrative files shall be laid open to the public as from the date when an abstract of the application is published. The publication generates a period of 45 working days for third parties to file oppositions. When the original set of claims is amended during the prosecution of the Patent Application, the Head of the technical area Examiner shall request to prepare a title and abstract that, in their opinion, best interprets the object of the privilege being requested. The abstract shall allow to obtain an essential understanding of the technical problem being solved, its solution and the field of application, but does not have any effects for determining the scope of the invention	Maximum 1600 characters	-	If claims are amended the abstract should be amended	Technical information useful for publication purposes and should allow obtaining an essential understanding of the technical problem being solved.
Colombia	Article 32 Andean Community Decision 486 and Handbook of Substantive Examination of the Colombian Patent Office	<b><i>"The abstract shall consist of a summary of the technical disclosure contained in the patent application. The abstract shall serve only for the purposes of technical information and shall in no way influence the interpretation of the scope of protection afforded by the patent"</i></b> . There is no further article (besides article 32 of Decision 486) in our IP legislation that specifies the content and form of the Abstract. The abstract is not considered a relevant part of the specification. No length is suggested and the inclusion of figures is not mandatory. Nevertheless, the Handbook of Substantive Examination of the Colombian Patent Office (2012) suggests guidelines for the drafting of the abstract that includes several guides of rule 8.1 of the PCT. In particular, the Handbook mentions that when receiving a patent application, an examiner must verify if the abstract concisely indicates the disclosure of the technique and the technical field to which the invention belongs, to allow a rapid understanding of the technical problem and to check its correspondence with the description, claims and drawings originally presented. Furthermore, said Handbook mentions that the abstract is an indispensable and effective instrument for the search of background and that it must have the following structure: object of the invention, characteristics of the invention and technical field, in order to deal (essentially) with what is new and what is being brought to the prior art with the invention.	No length suggested	Yes	-	Indispensable and effective instrument for background search

Costa Rica	Patent Law, Regulations to the Patent Law and Patent Guidelines	In the case of Costa Rica requirements for abstract drafting are contained in the Patent Law, the Regulations to the Patent Law and the Examiner's Guide to Patent Applications. In general, the provisions of PCT Rule 8 are followed, but no specific restriction to the length of the abstract is established. No mention is made either to the fact that the abstract should be drafted taking into consideration that it will be used as a scanning tool when searching in a particular art. It is our opinion that national rules in Costa Rica should follow the PCT Guidelines regarding drafting of the abstract and not the other way around. Traditionally the main purpose of the abstract in national applications has been to confer an adequate understanding of the claimed invention for publication purposes. Since the main purpose of the abstract today is to provide adequate information about the application when searching for the state of the art, an effort should be made to make sure that national laws include provisions forcing abstracts to comply with this objective. Anyway, the abstract of the granted patent at the national patent office will be a much more accurate search than one relying on the abstract contained in the international application, which does not reflect amendments to the invention covered by the patent.	No specific restriction established	-	-	To confer an adequate understanding of the claimed invention for publication purposes
Ecuador	-	There is nothing in the EC Law or Regulations following Rule 8.3 of the Regulations of the Patent Cooperation Treaty. Under our IP Law, the abstract is the technical information useful for publication purposes. Prior art searches conducted by the EC IP Office, rely on the abstract of pending and issued Patents. When a set of claims are amended during prosecution, the abstract should be amended accordingly	No length suggested	-	Yes when the claims are amended	Technical information useful for publication purposes
El Salvador	Patent Law	In El Salvador abstracts are a minor aspect of patent applications. In accordance to the Salvadorian Law, it has only purposes of technical information, but is not taken into consideration as a relevant part of the application. The most important part to take in to examination is the complete Technical document composed by description of the invention, specifications, claims and drawings. The abstract is often the main claim reworded in a more descriptive form and might be useful to give a somewhat preliminary but precise idea of the technical content of the patent/application (What is the invention about in general terms). The recommendation for abstracts in El Salvador might be that it should summarily indicate all the main technical features dealt with by the invention referred to in the related PCT application, limiting its length to less than one full page and preferably to half a page.	Less than one full page and preferably half a page	-	-	Purposes of technical information and should portray a precise idea of the technical content of the invention
Europe	Article 85 and R 47 of the European Patent Convention	Article 85 EPC: The abstract shall serve the purpose of technical information only. R. 47 EPC ("Form and content of the abstract") establishes that: "(1) The abstract shall indicate the title of the invention. (2) The abstract shall contain a concise 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 manner allowing 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. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterizes the invention. It shall not contain statements on the alleged merits or value of the invention or on speculative applications thereof. (3) Preferably no more than 150 words. (4) The figure or exceptionally the figures that should be published should be indicated. The EPO can decide to publish other figures. Each essential feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed in parentheses. (5) The abstract shall be drafted in such a manner as to constitute an efficient instrument for the purpose of searching in the particular technical field. In particular, it shall make it possible to assess whether consultation of the European patent application itself is necessary." Case-law of the EPO has established that the abstract cannot be used either to define the scope of protection or for picking features to be introduced in the claims during prosecution or opposition.	Preferably not more than 150 words	Yes	-	Should be an efficient instrument for search purposes
Guatemala	Industrial Property Law	The Guatemalan Industrial Property Law contains a description of the content or form of the summary similar to that described in Rules 8.1, 8.2 and 8.3 of the Regulations of the PCT. It does not describe or specify the national law that the abstract may be of the minimum or maximum number of words when written in English or translated into English, however it regulates that the Registry may, officially and without prejudice to the applicant, make the summarize the clarifications or extensions that it deems appropriate to conform it according to the standard that must explain the content of the abstract. Under our Intellectual Property Law, the abstract will comprise a synthesis of the technical disclosure contained in the patent application description and main use of the invention, will serve only for technical information purposes and not for interpreting the scope of the protection conferred by the patent	Not suggested	-	Yes by the PTO	Should serve for technical information purposes
Italy	Article 160(4) of the Italian code of Industrial	The abstract has "informative purpose only". NO specific provisions as to the form of the abstract are present any more in the Italian Patent Law.	Not suggested	-	-	Serves for informative
Japan	Form 31 of Regulations under JIP Patent Act	Should include two sections: abstract + figure. Figure must be best representation of the invention. No more than 400 words, preferably between 200 and 400 words. Features must be followed by reference signs. Registered trademarks should not be included unless it is necessary and if so, should be clearly mentioned as such. Formulas should not exceed 170 mm in width and 255 mm in height. Any amendments should be introduced within 16 months of the application's filing date. Has no effect on the scope of the claimed invention.	Not more than 400 words, preferably between 200 and 400 words	Yes	Yes within 16 months of filing of application	Should be the best representation of the invention

Mexico	Mexican Industrial Property Law and its Regulations	The provisions of the Mexican Industrial Property Law and its Regulations dealing with the contents and form of the abstract, mimic Rules 8.1, and 8.2 (b) of the Regulations of the Patent Cooperation Treaty. There is one difference, which is the length of the abstract: minimum 100 words, maximum 200 words. The Examiner may indicate, for publication purposes, a figure/drawing different from the one indicated by the applicant. Under our IP Law and Regulations the abstract is considered technical information, useful for publication purposes of the corresponding pending Patent Application, and of the issued Patent. When the original set of claims were amended during the prosecution of the Patent Application, the abstract must be amended accordingly. There is nothing in our Law or Regulations following Rule 8.3 of the Regulations of the Patent Cooperation Treaty. Prior art searches conducted by the Mexican Industrial Property Institute Examiners, rely on the abstract of pending and issued Patents. The substantive examination of Patent Applications are carried out by the Mexican Industrial Property Institute Examiners, relying on the claims.	Between 100 and 200 words	Yes	If claims are amended the abstract should be amended	Technical information useful for publication purposes and for conducting searches
New Zealand	Regulation 33 of the 2014 NZ Patent Law Regulations	The form and content of an abstract is set in law in NZ. Under NZ Patent Regulations 2014, regulation 33 stipulates the following: (1) An abstract must consist of the following: (a) a summary of the disclosure of the complete specification as contained in the description, the claims, and any drawings; and (b) if applicable, the chemical formula which, among all the formulas contained in the patent application, best characterizes the invention. (2) The summary referred to in sub clause (1)(a) must— (a) indicate the technical field to which the invention pertains; and (b) be written in a way that 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. (3) The abstract must be as concise as the disclosure of the complete specification permits. (4) The abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application. It is sub para (2)(b) which IPONZ is rather strict on. IPONZ requires the problem to be clearly outlined and the gist of a solution of the problem be described in the abstract. Just rewording of an independent claim would not be suitable as an abstract.	Not suggested	Yes	-	Should describe clearly the problem and the gist of the solution to the problem
Peru	Decision 486 of the Andean Community and Regulations	The provisions of the Peruvian IP Law and its complementary Regulations dealing with the contents and form of the abstract do not limit the amount of words or length of the abstract. It is simply stated by Decision 486 of the Andean Community that "the abstract shall consist of a summary of the technical disclosure contained in the patent application. The abstract shall serve only for the purposes of technical information and shall in no way influence the interpretation of the scope of protection afforded by the patent." As for the practice concerning PCT applications the National IP Office mimics Rules 8.1, and 8.2 (b) of the Regulations of the Patent Cooperation Treaty. There is one difference, which is the length of the abstract: minimum 100 words, maximum 200 words. As provided under Rule 8.2 (a), the Examiner may indicate, for publication purposes, a figure/drawing different from the one indicated by the applicant. There is nothing in our Law or Regulations following Rule 8.3 of the Regulations of the Patent Cooperation Treaty. Prior art searches conducted by the Examiners at the Patents Office of INDECOPi rely on the abstract of pending and issued Patents. However, the substantive examination of all Patent Applications are carried out by the Patents Office of INDECOPi Examiners, relying on the claims.	Minimum 100 and maximum 200 words	Yes		Serve for purposes of technical information and for prior art searches
Turkey	Turkish Industrial Property Code and Regulations	The abstract shall indicate the title of the invention given in the application form. The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings and shall indicate the technical field to which the invention pertains, and shall be drafted in a manner allowing 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. The abstract shall be drafted in such a manner as to constitute an efficient instrument for the purpose of searching in the particular technical field. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterizes the invention. It shall not contain statements on the alleged merits or value of the invention or on speculative applications thereof. The abstract shall preferably not contain more than one hundred and fifty words. If the patent application contains drawings, each essential feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed in parentheses. At the end of abstract the applicant shall indicate the figure which should be published with the abstract. The Office may decide to publish one or more other figures if it considers that they better characterize the invention.	Preferably not more than 150 words	Yes	May be rearranged by the Office and sent to the applicant together with the search report.	Serve for purposes of technical information

U.S.A.	MPEP 1826 The Abstract [R-07.2015], and 37 CFR 1.438	<p>(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to. (b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn. MPEP 1826 summarizes abstract requirements (see also PCT Rule 8 attached): Preferably 50-150 words. Should contain: (A) Indication of field of invention. (B) Clear indication of the technical problem. (C) Gist of invention's solution of the problem. (D) Principal use or uses of the invention. (E) Reference numbers of the main technical features placed between parentheses. (F) Where applicable, chemical formula which best characterizes the invention. Should not contain: (A) Superfluous language. (B) Legal phraseology such as "said" and "means." (C) Statements of alleged merit or speculative application. (D) Prohibited items as defined in PCT Rule 9. Prohibited items as defined in PCT Rule 9 are as follows: 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. Purpose of Abstract MPEP 1826 states that "the abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art".</p>	Preferably 50 to 150 words	Yes	-	Must efficiently serve as a scanning tool for the purposes of searching in the particular art
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