

Patent Cooperation Treaty (PCT) Working Group

Tenth Session
Geneva, May 8 to 12, 2017

NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

Document prepared by the International Bureau

SUMMARY

1. There are many international applications where the length of abstract falls outside the number of words recommended in PCT Rule 8.1(b) or where the figure selected to accompany the abstract contains significant numbers of words, contrary to PCT Rule 11.11(a). The preferred range of lengths is only a guideline for typical cases and it will be necessary to diverge from this in specific cases in order to ensure an accurate and useful disclosure. However, the International Bureau wishes to encourage action to ensure the quality and utility of the abstracts in the international publication, while minimizing the cost of translation to the extent possible.

BACKGROUND

2. The objective of the abstract is set out in Rule 8.3 as follows:

“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.”

3. The abstracts and accompanying drawings are made available in several formats. They appear in printed form on the front page of the published international application in both English and the language of publication. They appear on PATENTSCOPE in English, French and the language of publication – the abstract text is searchable, whereas any text in the drawing is not. Abstracts and accompanying drawings are made available to national Offices and patent information providers to use in other systems and different concerns may apply to different modes of use.

4. Examples of abstracts and drawings as represented on the front page of published international applications were included in the Annex to document PCT/WG/9/16. The key issues from the perspective of users are that very long abstracts, or drawings with significant text to be translated

- (a) may make it difficult to identify the key aspects of the disclosure; and
- (b) may be extremely difficult to read in the formats in which they are published

Consequently, such abstracts and drawings may be of limited value despite the high cost of producing them.

5. Clearly, the number of words in the abstract is not a direct indicator of quality – some inventions can be well portrayed with few words, whereas others may require more extensive elaboration. However, the proportion outside the recommended range is large. Unless the information can be provided to Offices and patent information users in useful formats and with content relevant to their needs, the costs of translation and associated administrative activities are difficult to justify.

6. In terms of length of abstracts, an appropriate balance is needed:

- (a) The abstracts must be long enough to refer to the most important technical features which are relevant to users searching for technical information and gaining a general idea of the area in which protection is claimed;
- (b) The abstracts should be short enough for readers to take in the key information at a glance; in particular, most abstracts should fit onto the front page of the published application (for users looking at conventional documents) or into screen spaces optimized to allow searchers to view most typical abstracts without needing to scroll or reduce the size of the text.

7. In terms of content, the abstract needs to be sufficiently specific as to give useful technical information about disclosure without being misleading as to the breadth of alternatives which may be claimed.

8. For drawings accompanying abstracts, consideration should take into account whether any text which appears in the drawings:

- (a) will be readable when reduced in size to fit on the front page; and
- (b) will be easily understood if the translated text is presented below or at the side of the drawing, associated with reference numerals (given that this means of displaying translations of drawings is unlikely to be changed in the near future).

9. The PCT Working Group, at its ninth session, held in Geneva from May 17 to 20, 2016, discussed a working document which showed that a large proportion of international applications were published with abstracts which fall well outside the range of lengths recommended by Rule 8.1(b) and with significant quantities of text in the drawing chosen for the front page of the published international application. This results in increased translation and processing costs, but also raises the question of whether the abstract and drawing published on the front page might often not be optimal for the purpose of effective searching.

10. Paragraphs 110 to 116 of the Summary by the Chair of the session (document PCT/WG/9/27) outline the discussions of this proposal and the follow-up agreed by the PCT Working Group, as follows:

“110. Discussions were based on document PCT/WG/9/16.

“111. Several delegations representing Offices which acted as International Searching Authorities stated that the content and quality of the abstract and the selection of the accompanying figure were ultimately the responsibility of the International Searching Authority and that it was necessary for the Authorities to ensure that they met the appropriate standards and, where possible, to select drawings without too much text.

“112. Several delegations confirmed that there were significant difficulties for applicants and Offices in judging whether the length of abstracts established in languages other than English fell within the guideline set out in Rule 8.1(b) and suggested that improved guidance on this subject would be useful. One delegation pointed out that there was no direct evidence to prove the connection between the number of words in abstracts and high quality as well as the different characters of different languages should be considered. Delegations recalled that it was important to remember that “50 to 150 words” was only a guideline and that in some cases shorter or longer abstracts could be appropriate and of high quality. On the other hand, one delegation suggested that a strict limit might be enforced by receiving Offices, requiring the applicant to correct the abstract if falling outside a range established for each language. However another delegation stated that such a restrictive approach would not be desirable.

“113. Many delegations noted that methods of searching had changed considerably since Rule 8 had been written. Several delegations indicated that their Offices relied mainly on full text searching using text highlighting functions and machine translations, with limited use of abstracts prepared for search purposes. Nevertheless, other Offices and some patent information users relied heavily on abstracts for searching, noting that search facilities freely available to many users were less sophisticated than tools used by search examiners or other professional searchers. It was therefore important to understand the needs of all users of the abstract and accompanying drawing in order to determine suitable content and quality.

“114. One delegation suggested that a more relaxed approach might be appropriate for translation of text in drawings in some cases. For example, at present, applications filed in German sometimes included drawings with text in English, which the receiving Office requested to be replaced with translations into German and the International Bureau might translate one of the figures back into English. Perhaps, in some cases, the English language technical terms in the figures might be appropriate for all languages.

“115. In response to a query from one delegation, the International Bureau confirmed that the text in figures accompanying the abstract was currently made available only in image format and not in searchable form, both in the original language and any translation.

“116. The Working Group agreed that the International Bureau should issue a Circular inviting more detailed feedback on the issues set out in paragraph 23 of document PCT/WG/9/16, especially from designated Offices and representatives of applicants and patent information users, to help inform discussions to take place at the next session of the Meeting of International Authorities.”

CIRCULAR C. PCT 1486

11. Circular C. PCT 1486, issued in response to the above discussions, provided further detail on the extent to which the abstracts and drawings fell outside the recommended ranges and how the distributions of numbers of words varied by subject matter, language, receiving Office and International Searching Authority. The Circular invited Offices and patent information users to provide information on abstracts and the way in which they are currently used.

12. Responses were received from 26 national and regional Offices. The key elements of the responses were:

- (a) Offices use abstracts in different ways – in some cases, several different ways for different purposes at the same Office. Examiners are increasingly using the full text for most searches and also use commercially prepared abstracts, but the original abstract remains important for some searches and for efficient scanning of results to determine which publications to read in greater detail.
- (b) The ideal requirements for abstracts vary depending on a large number of factors, including subject matter, language and issues specific to individual applicants or patent information users.
- (c) There are considerable differences in view on the proportion of abstracts which are of a poor quality. Some Offices consider that a large majority are appropriate. Others consider that the common approach of filing an abstract almost identical to Claim 1 fails to allow “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”. Some Offices indicate that professionally prepared abstracts are essential for effective search. Others again are uncertain and indicate that they have not yet been able to analyze the issue.
- (d) Many Offices consider the length of the abstract to be an interesting indicator to the extent that very long or very short abstracts will often be sub-optimal for one reason or another, but it is generally emphasized that this is not true in all cases and that the length provides no measure of the quality of the information which is provided in individual cases.
- (e) Large quantities of text in drawings is generally unhelpful and can readily be seen by the receiving Office, the International Bureau and the International Searching Authority alike. However, in some cases, flowcharts with text are a genuinely useful way of explaining the invention. More generally, particularly in the context of the PCT, where the consideration by substantive examiners is for the purpose of non-binding opinions, requiring the applicant to correct this type of formalities defect once the application has been filed risks introducing substantive problems (notably, addition of subject matter) which will be difficult or impossible to overcome in the national phase.
- (f) It would, in principle, be useful to be able to search and better view text in non-paragraph formats such as flowcharts, but it is not clear what should be done to facilitate this.
- (g) Some Offices indicate that it might be desirable for receiving Offices to intervene on abstracts, for example by inviting replacement abstracts to be provided or charging additional fees if the abstracts fall significantly outside the recommended range of lengths. However, several Offices indicated that any such procedures should not introduce new burdens such as counting words. Moreover, it was emphasized that only the International Searching Authority was in a position to evaluate the quality of an individual abstract.
- (h) Several Offices suggested that it was important to provide training for users and to raise awareness of the importance to applicants of drafting the abstract well. Relevant issues might be the value of the publication for due diligence searches, reducing the risk of infringement of any granted patent and providing a good “advert” for the technology of the applicant.
- (i) It was suggested that filing systems might offer machine translation services to estimate the length of abstracts once translated into English.
- (j) One Office suggested that an analysis of the use of Form PCT/RO/106 might be useful to determine differences in patterns of formalities examination at different Office.

(k) Some Offices emphasize that input from patent attorneys would be useful – the Circular was sent to a number of organizations representing business, patent professional and patent information user organizations, but at the time of writing, responses have been received only from Offices.

IMPROVING THE QUALITY OF ABSTRACTS RECEIVED

Guidance to Applicants

13. The International Bureau notes the suggestions received in response to Circular C. PCT 1486 which suggest that many applicants might be willing to draft better abstracts if given suitable guidelines and explanations as to why a good abstract may be in their own interest. The International Bureau will review the advice given in Chapter 5 of the PCT Applicant's Guide. To assist this, it will take into account WIPO Standard ST.12, but would also welcome any information concerning national guidelines on drafting abstracts, as well as views on other concerns sometimes stated. For example, some applicants see using the text of Claim 1 as a "safe" option in that there are concerns that any discrepancies between the abstract and Claim 1 might affect the interpretation of the claims, despite the clear statement of PCT Article 3(3) that "[t]he 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".

Abstracts Drafted in Languages Other than English

14. One aspect of drafting which was of key concern was that applicants filing in languages other than English could not know how long the abstract would be when translated into English. It is suggested that guidelines be established in each of the languages of publication containing recommended ranges based on the ratio of the average numbers of words or characters in the language of publication to the average number of words in English from the translations of abstracts established by the International Bureau for publication during 2016, as follows:

Publication language	Number of abstracts published in 2016	Average number of words in abstract (source language)	Average number of words in abstract (English translation)	Multiplier	Equivalent of 50	Equivalent of 150	Suggested range in original language
Arabic	26	127	172	0.74	36.9	110.8	35 to 110 words
Chinese	26,001	236 chars	150	1.57	78.7	236.0	80 to 240 characters
French	6183	125	126	0.99	49.6	148.8	50 to 150 words
German	16,088	109	141	0.77	38.7	116.0	40 to 120 words
Japanese	41,847	274 chars	135	2.03	101.5	304.4	100 to 300 characters
Korean	11,866	77	132	0.58	29.2	87.5	30 to 130 words
Portuguese	480	131	129	1.02	50.8	152.3	50 to 150 words
Russian	824	122	171	0.71	35.7	107.0	35 to 110 words
Spanish	1,497	118	116	1.02	50.9	152.6	50 to 150 words

REVIEW BY RECEIVING OFFICES

15. The International Bureau notes the suggestions received in response to Circular C. PCT 1486 which suggest measures which might be taken at receiving Offices and will consider whether to bring proposals to the PCT Working Group. However, the initial view is that any action is likely to be limited to a review of whether the Receiving Office Guidelines are sufficiently clear. Paragraph 147 currently states:

“The receiving Office checks whether the application contains an abstract as provided for in Article 14(1)(a)(iv) but not whether the abstract complies with Rule 8 (in particular, it is not the receiving Office’s responsibility to check whether the abstract contains more than 150 words in English or when translated into English). ...”

16. It might be appropriate for receiving Offices also to bring the most extreme cases of very short, very long or obviously incorrect text to the attention of the applicant. However, in general the receiving Office will not be in a position to judge the substantive quality of the text and consequently whether it is appropriate for the length to fall outside the normal recommended range of lengths. As such, it may be desirable to adapt filing systems to provide warnings to applicants prior to filing if the abstract length falls outside the expected range, but it would not seem useful to ask receiving Offices to check word counts. Nor does the International Bureau consider fee-related incentives to be desirable, since these would be likely to reduce the overall efficiency of the process. Further, they may cost more to implement than the likely improvement to quality would justify if the process was administered by the receiving Office, which is not competent to judge the quality of the result.

REVIEW BY INTERNATIONAL AUTHORITIES

17. It is clear that only the International Searching Authority is in a position to judge the merits of an individual abstract. Rule 38.2 provides a mandate for the International Searching Authority to establish an abstract if either no abstract has been received from the applicant, or if the abstract does not comply with Rule 8. The International Bureau hopes that translation costs can be reduced by long abstracts being shortened and fewer figures containing large numbers of words being selected to accompany abstracts. However, ultimately, the key factor must be to ensure that abstracts and accompanying drawings are fit for purpose.

18. The main guidance to International Authorities on how to decide whether an abstract is suitable and how to draft modifications is provided in paragraphs 16.36 and 16.37 of the PCT International Search and Preliminary Examination Guidelines. At the twenty-fourth session of the Meeting of International Authorities under the PCT, the International Authorities agreed to review this guidance to ensure that it was appropriate and properly followed (see paragraphs 43 to 51 of document PCT/MIA/24/15). However, it was emphasized that it was a duty of the applicant to provide a suitable abstract and significant revision of the abstract by the International Searching Authority should not become the normal case. Consequently, this review should be conducted in the context of related modifications to the Applicant’s Guide.

NEXT STEPS

19. The International Bureau intends to consult on potential modifications to the PCT Applicant’s Guide and the PCT International Search and Preliminary Examination Guidelines. As noted in paragraph 13, above, information would be welcomed on any national or other guidelines which may be useful in drafting such modifications. Comments are also welcome on the subject of how applicants might be persuaded of the benefits to themselves of providing higher quality abstracts.

20. In addition, ePCT-Filing will be modified to count, where possible, the number of words in an abstract and to provide warnings where this falls outside the expected range. This will, however, not prevent an applicant filing longer or shorter abstracts. Receiving Offices which maintain their own filing systems are invited to consider similar measures.

21. The Working Group is invited to comment on measures which might be taken to reduce translation costs and improve the quality of information relating to abstracts and accompanying drawings.

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