

C. PCT 1535

March 9, 2018

Madam,
Sir,

Proposed modifications of the Administrative Instructions under the PCT (“the Administrative Instructions”) and the PCT International Search and Preliminary Examination Guidelines (“the ISPE Guidelines”)

This Circular is addressed to your Office in its capacity as a receiving Office (RO), an International Searching Authority (ISA), an International Preliminary Examining Authority and/or a designated or elected Office (DO/EO) under the Patent Cooperation Treaty (PCT). It is also addressed to certain non-governmental organizations representing users of the PCT System.

The purpose of this Circular is to consult on proposed modifications of the Administrative Instructions and the ISPE Guidelines, to follow up on certain issues discussed in recent sessions of the PCT Working Group and the Meeting of International Authorities under the PCT (MIA). Specifically, the proposed modifications mainly relate to the following issues: (i) the review by ISAs of abstracts in international applications; (ii) allowing applicants to voluntarily submit a suggested English translation of the title of the invention for the purposes of international publication; and (iii) to implement certain proposals that have been agreed upon in the MIA meeting relating to linkage between the international phase and the national phase. In addition to the above, some modifications of the ISPE Guidelines are also proposed to streamline the structure and improve the wording in certain places.

I. *Proposed modifications of the Administrative Instructions*

It is recalled that, at the tenth session of the PCT Working Group, held in Geneva from May 8 to 12, 2017, the Korean Intellectual Property Office (KIPO) made a proposal to allow the applicant to voluntarily submit a suggested English translation of the title of the invention if the application had not been filed in English and no translation of the application into English had been required (see document PCT/WG/10/17). After discussion, the PCT Working Group invited KIPO to work with the International Bureau and other interested Offices to develop a detailed proposal to this effect (see document PCT/WG/10/25, paragraph 163).

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Consequently, the International Bureau and KIPO have been working together on this matter and hereby propose to add Section 406*bis* to provide a specific basis for the applicant to submit a suggested English translation of the title of the invention directly to the International Bureau. A time limit of 14 months from the priority date is proposed to allow sufficient time for the suggested translation to be taken into account by the International Bureau and to align that time limit with the time limit for furnishing translations under PCT Rule 12.4. Should an applicant submit such a translation to the receiving Office, either at the time of filing the international application or subsequently, the receiving Office should follow the guidance in paragraph 325 of the Receiving Office Guidelines and transmit such an item to the International Bureau.

./ The proposed modifications of the Administrative Instructions are set out in Annex I to this Circular.

II. *Proposed modifications of the ISPE Guidelines*

The proposed modifications of paragraphs 2.03, 9.02 to 9.03, 16.64, 16.82 and 16.82A relate to proposals made by the Japan Patent Office (JPO) at the twenty-fourth session of the MIA under the topic of “promoting linkage between the international phase and the national phase” (see document PCT/MIA/24/11). Following the recommendations of the Meeting (see document PCT/MIA/24/15, paragraph 38), the International Bureau worked with the JPO and agreed to propose herewith these modifications to the ISPE Guidelines.

The proposed modifications of paragraphs 16.33 to 16.51 relate to issues concerning the number of words in abstracts and in front page drawings presented by the International Bureau in the two most recent sessions of the PCT Working Group (see documents PCT/WG/9/16 and PCT/WG/10/23). Following the discussions and the decision of the PCT Working Group at its tenth session (see document PCT/WG/10/25, paragraphs 164 to 182), the International Bureau issued a Circular (C.PCT 1517), on July 31, 2017, inviting Offices to provide further comments concerning their experiences and suggestions on the drafting of abstracts with a view to providing better guidance to applicants on drafting and to ISA examiners on revising abstracts. In response to the Circular, the International Bureau received comments from 21 Offices and three observer organizations. Based on the above discussions and these comments, it is proposed to modify the ISPE Guidelines as indicated in the present Circular. Particularly, it is suggested to clarify the circumstances in which revision of the abstract by the examiner is required (paragraph 16.43) and to avoid selecting a figure containing significant amounts of text matter to accompany the abstract for international publication (paragraph 16.49).

In addition to the above considerations, it is also proposed to streamline the structure of the relevant paragraphs. In particular, it is suggested to move the subsection dealing with abstracts directly after the subsection on titles so that they follow the order of examination more naturally. Some editorial changes are also proposed.

Should the proposed modifications of the ISPE Guidelines be acceptable, the International Bureau intends to make corresponding modifications to the text of the *PCT Applicant's Guide* with respect to the drafting of abstracts and the selection of the figure accompanying the abstract in order to provide improved guidance to applicants.

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./ The paragraphs of the ISPE Guidelines which are proposed to be modified or added are set out in Annex II to this Circular. Certain paragraphs that are not proposed to be modified have been included for ease of reference.

Comments on the proposed modifications of the Administrative Instructions and the ISPE Guidelines

Your Office is invited to provide comments, if any, by April 20, 2018, by e-mail to: pct.legal@wipo.int.

Yours sincerely,



John Sandage
Deputy Director General

Enclosures: Annex I — Proposed modifications of the Administrative Instructions

Annex II — Proposed modifications of the ISPE Guidelines

PROPOSED MODIFICATIONS
OF THE ADMINISTRATIVE INSTRUCTIONS

Section 406bis

Suggested English Translation of the Title of the Invention

(a) Where the international application is to be published in a language other than English and a translation of the application into English is not required under Rule 12.3(a), the applicant may furnish a suggested translation of the title of the invention into English to the International Bureau before the expiration of 14 months from the priority date.

(b) The International Bureau shall, to the extent possible, take the suggested translation into account in the preparation of the translation referred to in Rule 48.3(c) if it is received within the time limit specified in paragraph (a).

[End of Annex I]

PROPOSED MODIFICATIONS
OF THE INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Chapter 2

Overview of the International Search Stage

2.01 to 2.02 [No change]

Rule 43bis

2.03 At the same time as establishing the international search report, the search examiner establishes a written opinion. The written opinion has the primary objective of formulating a preliminary and non-binding opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. A secondary objective is to identify whether there appear to be any defects in the form or contents of the international application (for example, failure to comply with one or more of the requirements specified in Rules 5 to 11), or any significant and pertinent issues as to ~~for example with regard to~~ the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description.

2.03 to 2.22 [No change]

Chapter 9

**Exclusions from, and Limitations of, International Search and
International Preliminary Examination**

9.01 [No change]

Excluded Subject Matter

Articles 17(2)(a)(i), 34(4)(a)(i); Rules 39, 67

9.02 Rule 39 specifies certain subject matter which an International Searching Authority is not required to search. Rule 67 sets out an identical list of subject matter, on which an International Preliminary Examining Authority is not required to perform an international preliminary examination (and also, in accordance with Rule 43bis.1(b), for which the International Searching Authority is not required to establish a written opinion concerning novelty, inventive step and industrial applicability). While the subject matter in these Rules may be excluded from search or examination, there is no requirement that it be excluded. Depending on the policy of the Authority, such subject matter may be searched or examined, for example, where it is searched or examined under the national law of the Office acting as the International Searching Authority or the International Preliminary Examining Authority. This may also be the case even though the subject matter is not considered patentable under the respective national law. Any such subject matter which a

particular Authority is prepared to search or examine is set forth in an Annex to the Agreement between that Authority and the International Bureau. Accordingly, the subject matter excluded from the international search or international preliminary examination may vary between the various Authorities.

9.03 Any such restriction to the search, or to the international preliminary examination should be accompanied by a reasoned explanation in the written opinion or international preliminary examination report issued by the Authority. If no search is to be carried out the search examiner will complete Form PCT/ISA/203 (Declaration of Non-Establishment of International Search Report). As a general principle, a search or examination is to be carried out wherever practicable, including in the case where the relevant Authority has decided to search or examine any subject matter listed in Rule 39 or 67 although it is not considered patentable under the national law of the Office acting as the Authority.

9.04 to 9.42 [No change]

Chapter 16

International Search Report

16.01 to 16.32 [No change]

~~Abstract, Title, Abstract and Figure~~

Articles 3(2), 4(1)(iv); Rules 8, 44.2

16.33 The international application must contain ~~an abstract and~~ a title and an abstract. The examiner conducting the main international search indicates approval or amendment of ~~the text of the abstract,~~ the title of the invention, the text of the abstract, and the selection of the figure that is to accompany the abstract in items 4 to 6 of the first sheet of the international search report. Box No. IV (~~an~~ "continuation of first sheet (3)") is used to record any new or amended abstract.

16.34 This procedure does not apply to supplementary international searches. Consequently paragraphs 16.35 to 16.51 do not apply to supplementary international search reports. For international-type searches, it is a matter for agreement between the International Searching Authority and the national Office on whose behalf the international search is conducted whether the title and abstract are reviewed by the International Authority. Form PCT/ISA/201 does not include specific space for such matters; if required, the appropriate information should be recorded on separate sheets.

~~Abstract~~

Article 14(1)(a)(iv), (1)(b); Rules 26, 38.1

~~16.35 Where the international application lacks an abstract, the relevant receiving Office should find this in their routine check and issue the invitation to correct accordingly, allowing at least one month from the mailing date of the invitation for a reply. The receiving Office should notify the International Searching Authority that the invitation has been sent. The receiving Office may declare the international application withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. However the International~~

~~Searching Authority proceeds with the international search unless and until it receives notification that the application is considered withdrawn.~~

~~Article 3(3); Rule 8.3~~

~~16.36—In determining the definitive contents of the abstract, or establishing the text of the abstract anew, where it is missing, the examiner should take into consideration the fact that the abstract is merely for use as technical information and, in particular, must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be drafted so that it constitutes an efficient instrument for the purpose of assisting the scientist, engineer or researcher in searching in the particular technical field and should in particular make it possible to assess whether there is need for consulting the international application itself. WIPO guidelines for the preparation of abstracts are found in WIPO Standard ST.12/A.~~

~~Rule 8.1(a), 8.3~~

~~16.37—In considering the adequacy of the applicant's abstract and figure, because of practical difficulties experienced by the International Bureau with publication, examiners when assessing or drafting abstracts, should have particular regard to the following:~~

~~(a)—It is important that the abstract be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). Within this constraint the abstract must provide a summary of the technical information about the disclosure as contained in the description, claims and drawings. It should be drafted so as to serve as an efficient scanning tool for searching purposes in the art.~~

~~(b)—Phrases should not be used which can be implied, such as, "This disclosure concerns", "The invention defined by this disclosure" and "This invention relates to".~~

~~Rule 8.2(b)~~

~~(c)—Only one figure should normally be selected unless this would lead to inadequate disclosure. The inclusion of more than two figures should not be considered except in extreme circumstances where necessary information cannot be otherwise conveyed. Where none of the figures is considered useful for the understanding of the invention (even where the applicant has suggested a figure), no figure should be selected.~~

~~(d)—Abstracts may be incomprehensible if the numerals on the selected figure(s) do not correspond with those in the abstract.~~

~~(e)—An absence of reference numerals on the figures must be accepted as the examiner has no mechanism to initiate their provision.~~

~~Rule 8.1(d)~~

~~(f)—Each main technical feature mentioned in the abstract and illustrated by a drawing should be followed by a reference sign, placed between parentheses.~~

~~Rule 38.2~~

~~16.38—If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it establishes an abstract itself.~~

~~16.39—The review of the abstract should be conducted in a way that does not impact upon the date of actual completion of the search. This review should be completed in parallel with other steps in the process.~~

~~16.40—The applicant can only comment on the abstract prepared by the examiner after it has been established in the international search report (see search report Form PCT/ISA/210, first sheet, item 5). This is the only invitation to comment issued to the applicant. It occurs either when no abstract has been filed or when the originally filed abstract does not comply with Rule 8, and the examiner must prepare a compliant abstract. In this event the examiner establishes an appropriate abstract.~~

Rule 38.3

~~16.41~~—The applicant is allowed one month from the date of mailing of the international search report to respond to the examiner's abstract in the report by filing at the International Searching Authority proposed modifications of the abstract, or, where the abstract has been established by the Authority, proposed modifications of and/or comments on that abstract. The Authority shall decide whether to modify the abstract accordingly, and shall notify any modification to the International Bureau.

~~16.42~~—If the applicant does comment, the examiner takes the applicant's comments into consideration. It is not necessary for the examiner to reply to the applicant's comment even if adverse.

Rule 38.3; Section 515

~~16.43~~—If the International Searching Authority amends the abstract established in the international search report it notifies the International Bureau and the applicant using Form PCT/ISA/205.

– Title

Rules 4.3, 26.1, 37.2, 44.2

~~16.44~~16.35 According to Rule 4.3, the title must be short and precise (~~preferable~~ preferably from two to seven words in English or when translated into English). Furthermore, the title should clearly and concisely state the technical designation of the invention. In this regard the following should be taken into account:

(a) personal names or trade names or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(b) the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(c) titles such as "Method", "Apparatus", "Chemical Compounds" alone or similar vague titles do not clearly state the technical designation of the invention."

Article 14(1)(a)(iii), 14(1)(b); Rules 26, 37.1

~~16.45~~16.36 Where the international application lacks a title, the relevant receiving Office should find this in its routine check and issue the invitation to correct accordingly, allowing at least one month from the mailing date of the invitation for a reply. The receiving Office should notify the International Searching Authority that the invitation has been sent. The receiving Office may declare the international application withdrawn if no title is furnished to the receiving Office within the time limit fixed. However, the International Searching Authority proceeds with the international search unless and until it receives notification that the application is considered withdrawn.

Rule 37

~~16.46~~16.37 The examiner is required to draft a title where:

(i) the applicant has not responded to the invitation from the receiving Office to provide a title within the time allowed, but the International Searching Authority has not received notification that the application is considered withdrawn,

(ii) no title was filed and the receiving Office omitted to invite the applicant to rectify the deficiency, or

(iii) the title is deficient because it does not comply with the requirements of Rule 4.3.

16.38 The examiner is not required to gain the approval of the applicant for the title and the establishment of the title by the examiner is by suitable completion of item 4 of the first sheet of the international search report ~~Form (see check box 4 of the first sheet of Form PCT/ISA/210).~~

– Abstract

Article 14(1)(a)(iv), (1)(b); Rules 26, 38.1

16.39 Where the international application lacks an abstract, the receiving Office should find this in their routine check and issue the invitation to correct accordingly, allowing at least one month from the mailing date of the invitation for a reply. The receiving Office should notify the International Searching Authority that the invitation has been sent. The receiving Office may declare the international application withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. However the International Searching Authority proceeds with the international search unless and until it receives notification that the application is considered withdrawn.

Rule 38.2

16.40 If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, it establishes an abstract itself. Where the international application contains an abstract or the applicant has furnished an abstract upon invitation by the receiving Office, the International Searching Authority will review the abstract for compliance with the requirements set forth in Rule 8. If it is found that the abstract does not comply with this Rule, the International Searching Authority amends the abstract to bring it into compliance.

Article 3(3); Rule 8.3

16.41 When reviewing the abstract provided by the applicant, or establishing the text of the abstract where it is missing, the examiner should take into consideration that the abstract is, for the purposes of the international phase, merely for use as technical information and, in particular, must not be used for the purpose of interpreting the scope of the protection sought, but that in certain designated States the abstract may in fact have further legal implications. The abstract should be drafted so that it constitutes an efficient instrument for the purpose of assisting the scientist, engineer or researcher in searching in the particular technical field and should in particular make it possible to assess whether there is a need to consult the international application itself. Guidelines for the preparation of abstracts can be found in WIPO Standard ST.12/A.

Rules 8.1, 8.3

16.42 When considering the compliance of the abstract with Rule 8, or when establishing an abstract, the examiner should have particular regard to the following:

(a) The abstract should provide a summary of the disclosure as contained in the description, claims and drawings. The summary should indicate the technical field to which the invention pertains and be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution to that problem through the invention, and the principal use or uses of the invention. It should be drafted so as to serve as an efficient scanning tool for searching purposes in the art.

(b) The abstract should be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). Lengthy abstracts and unnecessary words should be avoided. The abstract should not contain statements on the alleged merits or value of the claimed invention or on its speculative application. Phrases should not be used which can be implied, such as, "This disclosure concerns", "The invention defined by this disclosure" and "This invention relates to".

(c) The abstract should also be clear and easy to understand. Each main technical feature mentioned in the abstract and illustrated by a drawing should be followed by a reference sign, placed between parentheses. An abstract may be incomprehensible if the reference numerals used in the abstract do not correspond to those indicated in the relevant figures. However, an absence of reference numerals on the figures must be accepted as the examiner has no mechanism to initiate their inclusion.

16.43 It should be noted that providing a high quality abstract for the application is primarily the responsibility of the applicant. Nevertheless, when reviewing the abstract provided by the applicant, the examiner should amend the abstract to bring it into compliance with Rule 8, at least in the following circumstances:

(a) the abstract provided by the applicant is overly lengthy which cannot be justified by the nature of the invention;

(b) the abstract contains statements on the alleged merits or value of the claimed invention or on its speculative application; or

(c) the abstract fails to indicate the gist of the solution provided by the claimed invention to the technical problem described in the application.

16.44 The review of the abstract should be conducted in a way that does not impact the date of actual completion of the search. This review should be completed in parallel with other steps in the process.

16.45 The applicant can only comment on the abstract prepared by the examiner after it has been established in the international search report (see Form PCT/ISA/210, first sheet, item 5). This is the only invitation to comment issued to the applicant. It occurs either when no abstract has been filed or when the originally filed abstract does not comply with Rule 8. In this event the examiner establishes an appropriate abstract.

Rule 38.3

16.46 The applicant is allowed one month from the date of mailing of the international search report to submit to the International Searching Authority proposed modifications of the abstract, or, where the abstract has been established by the Authority, proposed modifications of and/or comments on that abstract. The examiner shall then consider the proposed modifications and/or comments and decide whether to modify the abstract.

Rule 38.3; Section 515

16.47 If the International Searching Authority modifies the abstract established in the international search report, it notifies the International Bureau and the applicant using Form PCT/ISA/205. The examiner need not reply to the comments submitted by the applicant.

~~16.47~~

— Drawings to Be Published

— Rules 3.3(a)(iii), 8.2

16.48 Where the international application contains drawings, the applicant should suggest a figure of the drawings to accompany the abstract for publication. ~~When indicating the Figure No. of the drawings, the applicant's suggestion is found~~ which is indicated in-at Box No. IX of the request form (PCT/RO/101). ~~If the applicant fails to do so, or if the figure suggested by the applicant is not the best one to characterize the invention, the examiner should select a figure of the drawings that best characterizes the invention to be published with the abstract.~~

16.49 Only one figure should normally be selected unless this would lead to inadequate disclosure. The inclusion of more than two figures should only be considered in exceptional circumstances where necessary information cannot be otherwise conveyed. Furthermore, a figure containing significant amounts of text matter should generally be avoided as this can cause difficulty in reading and understanding when the figure is published with the abstract. Where none of the figures is considered useful for the understanding of the invention (even where the applicant has suggested a figure), no figure should be selected. ~~Where none of the figures is considered useful for the understanding of the abstract, this is indicated at the appropriate box (item 6, first sheet of the international search report).~~

16.50 The indication of the figure that is to accompany the abstract when the latter is published is made under item 6 of the first sheet of the international search report. If the International Searching Authority determines that no figure is to be published with the abstract, it is so indicated. ~~When no drawings accompany~~ Where the application contains no drawings, none of the boxes are checked.

16.51 It is not recommended to select more than one figure; however, if it is necessary to do so then the wording of the Form should be changed to reflect the change from single case to plural case. For example, "figure" is changed to "figures", "is" to "are" and "No." to "Nos.". (These recommendations will be followed, *mutatis mutandis*, when the international search report is being prepared in a language, such as Japanese, that does not have distinction between singular and plural forms.)

16.52 to 16.62 [No change]

Documents Considered to Be Relevant

Rule 43.5

16.63 The completion of Box C of the second sheet of the international search report can be considered as having three components. These are: the citation category; the citation of the document together with identification of relevant passages where appropriate; and the identification of relevant claim numbers. These three components are discussed separately in paragraphs 16.65 to 16.75, 16.78, 16.77 and 16.80, respectively, below.

16.64 Some general points to note are:

(a) Documents selected for citation should be the prior art that is closest to the applicant's invention. The duplication of teachings by way of citation of multiple documents showing the same inventive elements should be kept to a minimum (see paragraphs 15.67 and 15.69).

(b) When citing a document, the examiner should clearly indicate which portions and specific pages of the document are most relevant (see paragraph 15.69). Where the cited document is a patent document in a language other than English and another member of the same patent family is available in English, the examiner should preferably also indicate the corresponding part or passage of the English member of the patent family. In doing so, the examiner should not cite the English member as a separate document, but briefly mention it and indicate the relevant part or passage of that English member in the place following the indications of specific part or passage of the cited document. Alternatively, the indication of the corresponding part or passage of the English member of the patent family may be given in the patent family annex of the international search report (see paragraph 16.82A).

(c) In the case of supplementary international searches, the examiner need not include in the report the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report. Noting that the supplementary search is intended to supplement the main international search rather than to make a reassessment, inclusion of such citations and reassessment of their relevance should be avoided. Usually, the reason for including such a citation is where it is necessary to cite the document as category "Y" (see paragraph 16.68) to indicate a lack of inventive step when the disclosure of the document is taken together with that of a newly discovered citation, further to any lack of

inventive step indicated in the main international search report. Nevertheless, recitation of a document may also be appropriate where the main international search report has clearly failed to recognize the extent of a document's relevance, for example because the first examiner was relying on an abstract or machine translation because he did not understand the original language of the document.

16.65 to 16.81 [No change]

16.82 The [international](#) search report is published with the specification and distributed worldwide. To enable any reader in any country to consider the citation in the most convenient document/language, the known family members of each citation are normally listed in the patent family annex ~~sheet~~ of the international search report. The box on the second sheet of Form PCT/ISA/210 entitled "See patent family annex" is checked if a family member listing is included with the report. Where INPADOC is used to check the family member, it should be noted that:

- (a) INPADOC does not provide family listings for documents published prior to 1968;
- (b) If INPADOC indicates there are no family members for a cited document then indicate this by entering the word "NONE" where the family members would appear. This indicates to the applicant that a search for family members has been carried out and there was a nil result; and
- (c) If INPADOC indicates that none of the citations has a family member the "See patent family annex" box should still be checked and the practice indicated in the paragraph (b) above should be followed for all citations.

[16.82A The patent family annex may also be used to indicate the corresponding part or passage of the English member of a patent family if the cited patent document is in a language other than English \(see paragraph 15.69\).](#)

16.83 to 16.87 [No change]

[End of Annex II and of the Circular]