Treatment of Drawings in Utility Applications

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Changes to Drawing Practice in Utility Applications

- The changes to the Office procedures for handling drawings are set forth in:
USPTO Web Site

- For more information on the implementation of the American Inventors Protection Act of 1999 (AIPA) and Final Rules of Patent Business Goals (PBG), see the following web pages:
  - AIPA web page:
    http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm
  - PBG web page:

- The web pages include: Consolidated Patent Laws and Rules, Legislation, Presentations, Forms, Qs&As, Training and Implementation Guide, Final Rules, etc.
Procedures for Handling Drawings in OIPE

Review for Formal Matters is done in OIPE

- OIPE will be reviewing drawings in utility and plant applications (other than CPA’s) filed on or after 11/29/00
  - If drawings are not acceptable, a Notice to File Corrected Application Papers will be mailed to applicant
  - Note: Drawings in design applications are not reviewed by OIPE

- Applications will not be released to the technology centers unless acceptable drawings are present
  - The drawings in these applications are “acceptable” for the purposes of publishing as an application publication and as a patent

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Procedures for Processing Drawings
During Examination

Optional Review for Formal Matters in TCs

• Draftsperson’s review and approval are no longer required in the TCs for drawings in utility applications regardless of the application filing date
  – Draftsperson’s stamp on drawings is no longer required
  – Examiners are not required to take the drawings to the draftsperson for review

• An examiner may request Draftsperson’s review if examiner has doubts as to the acceptability of any corrected, new, or substitute drawings
  – If the drawings have been reviewed by OIPE, the examiner should assume that the drawings are acceptable for publishing purposes

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Procedures for Processing Drawings During Examination

“Informal” drawings could be acceptable

• “Formal” drawings should not be required merely because the drawings have been indicated by applicant to be “informal”

• FP 6.24 should not be used

• The check box on the Notice of Allowability, PTO-37, requiring applicant to submit formal drawings because the originally filed drawings were indicated to be “informal” has been deleted (examiner should not check this box when using an old PTO-37)

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Procedures for Processing Drawings
During Examination

First Office Action (Non-Allowance)

• Any completed PTO-948 in the file should be mailed with the first Office action
  – (including a written restriction or a requirement for information under §1.105)

• If the completed PTO-948 is Rev. 03/01 or earlier, cross-out the pre-printed text on the back of the form under the heading “Information on How to Effect Drawing Changes”
  – The pre-printed text on PTO-948 (Rev. 03/01 or earlier) permits submission of drawing corrections to be deferred until after allowance

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Procedures for Processing Drawings During Examination

First Office Action on the Merits

- Drawings and the description of the drawings in the specification should be reviewed by the Examiner for **substantive compliance** with drawing content requirements set forth in MPEP 608.01 and 608.02
Procedures for Processing Drawings During Examination

Review for substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02

• Examiner should check:
  – Every claimed feature is illustrated
  – Figures are correctly described in the specification, including brief and detailed description of the drawings (see MPEP 608.01(f) and 608.01(g))
  – Every brief description must have a corresponding drawing
  – Every drawing must have a brief description

Example:
  – Brief description for figures 1A, 1B and 1C reads “Figure 1 shows a telephone system” – acceptable
  – If figure 1A is described, but figures 1B and 1C are not, applicant should amend the brief description to add description for figures 1B and 1C

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Procedures for Processing Drawings During Examination

Review for substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02 (cont.)

- Examiner should check:
  - All drawings are properly labeled (e.g., the figures are labeled consecutively and prior art figures are clearly labeled as "prior art")
  - All section lines used are referred to and all needed section lines are used
  - Reference characters in the drawings are properly applied
    - No single reference character being used for two different parts
    - Two or more reference characters should not be used for a single part
    - Reference characters used in the drawings are consistent with the reference characters used in the specification
  - Any proposed, corrected, substitute, and new drawings contain no new matter

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Procedures for Processing Drawings During Examination

First Office Action on the Merits (Non-Allowance)

- Any substantive drawing objections and objections to the specification if drawing description is not consistent with the drawings should be made in the FAOM
- The Office action must not permit drawing objections to be held in abeyance
  - The drawing objection in FAOM should include an appropriate FP with the following text:

  “A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.”
Procedures for Processing Drawings During Examination

Subsequent Actions

If the prior action permits the drawing objections to be held in abeyance and the reply did not include any corrections (e.g., corrected drawings, proposed corrections or a reply to drawing requirements), then

• The drawing objections should be repeated by the Examiner

  – The Office action must not permit drawing objections to be held in abeyance

  • The drawing objection should include an appropriate FP with the text in the prior slide

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Procedures for Processing Drawings During Examination

Subsequent Actions

If the prior action did not state that the objections can be held in abeyance until the application is allowed, then

• The reply to the prior action must include:
  – Corrected drawings,
  – A proposed correction, or
  – A reply to the drawing requirements
Procedures for Processing Drawings During Examination

Subsequent Actions

- A request to hold drawing objections in abeyance should not be considered a bona fide attempt to advance prosecution.
- If the reply does not include corrected drawings, proposed corrections, or a reply to the drawing requirements, the reply should be held non-responsive (using FP 7.91)
  - Applicant will be given the remainder of the period set in the prior action (and not a new period) within which to correct the objection.
  - The application will be abandoned if the period set in the prior action has expired.

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Procedures for Processing Drawings During Examination

Proposed Drawing Corrections

- If proposed corrections satisfy any earlier requirements and are acceptable (i.e., substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02, see slides 9-10),
  - Examiner should write “approved,” initials, and date on the cover letter or first page of proposed corrections
  - Applicant should be notified of the drawing approval (using PTO-326 and FP 6.38), and any objections to the specification (if the drawing description is not consistent with the proposed corrections)
  - The Office action should state that:
    “Corrected drawings are required in reply to the Office action. The correction may not be deferred.”

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Procedures for Processing Drawings During Examination

Proposed Drawing Corrections

- If the proposed corrections are **not** acceptable,
  - Examiner should write "disapproved," initials, and date on the cover letter or first page of proposed corrections
  - Applicant should be notified of the drawing disapproval and the reason for the disapproval (using FP 6.38 and PTO-326), and any objections to the specification (if the drawing description is not consistent with the proposed corrections)
  - The Office action should state that:
    “A proper proposed drawing correction or corrected drawings are required in reply to the Office action. The objection to the drawings will not be held in abeyance.”

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Procedures for Processing Drawings
During Examination

When Corrected Drawings are submitted

• If the corrected drawings are acceptable (i.e., substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02, see slides 9-10),
  – Receipt of drawings should be acknowledged (FP 6.37)

• If the corrected drawings are **not** acceptable,
  – Applicant should be notified of the disapproval of corrected drawings and reason for disapproval (FP 6.37)
  – The Office action should state that:
    “Proper corrected drawings are required in reply to the Office action. The correction may not be deferred.”

• Object to the specification if drawing description is not consistent with the corrected drawings

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Procedures for Processing Drawings During Examination

When Arguments Re Drawing Requirements are Submitted

- Applicant's arguments regarding the drawing requirement should be considered

- The Office action should include:
  - A statement that the arguments were persuasive and the drawing correction is no longer required, or
  - An explanation of why the arguments are not persuasive, and the drawing objection should be repeated

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Procedures for Processing Drawings
During Examination

If New or Substitute Drawings are Filed After Initial Examination

• New or substitute drawings should be reviewed for substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02, see slides 9-10
• Examiner may request Draftsperson’s review if examiner has doubts as to the acceptability of the drawings
• Drawings labeled “informal” could be acceptable
• Any substantive drawing objections and objections to the specification if drawing description is not consistent with the drawings should be made in the next Office communication
• The communication must not permit drawing objections to be held in abeyance
  – The drawing objection should include an appropriate FP with the text in slide 11

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Procedures for Processing Drawings During Examination

First Office Action (non-allowance) in a CPA or after the filing of a RCE

- Any prior drawing requirement that is outstanding should be repeated in the Office action
- Any new substantive drawing objections should be made in the Office action
- The Office action must not permit drawing objections to be held in abeyance
  - The drawing objection should include an appropriate FP with the text in slide 11

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Procedures for Processing Drawings During Examination

When Allowing an Application

- Examiner should indicate approval or disapproval of any proposed drawing corrections
- All drawings should be in substantive compliance with drawing content requirements set forth in MPEP 608.01 and 608.02, see slides 9-10
- Draftsperson’s stamp on drawings is no longer required
- “Informal” drawings could be acceptable
  - “Formal” drawings should not be required merely because the drawings have been indicated by applicant to be “informal”
- If drawing corrections are required, appropriate box on PTO-37 should be marked
- “Yellow Tag” is no longer required

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Procedures for Processing Drawings in Office of Publication

After Allowance Drawing Practice

- Extensions of time to provide acceptable drawings after Notice of Allowability are no longer permitted
- Corrected, new, or substitute drawings will not generally be returned to examiner for review or approval
  - All drawings submitted after allowance are handled by the Office of Publication if the file is in the Office of Pub
  - Applicant has the responsibility to ensure that no new matter is added
- If Office of Publication receives an application with drawings that are unacceptable for publication,
  - A notice will be sent by the Office of Pub to applicant providing two months to file corrected drawings

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Thank you

Please turn in your evaluation sheet as you leave

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