

Why Patent Drawings Get Rejected

Part 1

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You may have had the misfortune to receive a drawing rejection or objection from the United States Patent and Trademark Office (USPTO), or a Patent Cooperation Treaty (PCT) rejection or other patent office rejection notice. Hopefully this will come with an invitation to correct defects in the application. Patent drawings can be part of or the entire reason for such a notice.

Fortunately, many problems regarding patent drawings can be remedied. If drawings have been prepared and submitted without regard to the specific patent drawing rules, you stand a good chance that those drawings will be rejected. When this occurs, a communication from the USPTO will most often be in the form of an [“Office Action Summary-Form PTOL-326\(Rev.08-06\)”](#). (follow the link for a sample). This summary will indicate whether the action is final or non-final. It will also specify a time period within which you must respond. Other information regarding fees, examiners contact information and how to respond may be included. In the communication, a section termed “detailed action” can be helpful to remedy specific problems. Here the examiner may explain why the drawings or replacement drawings do not overcome the drawing objections. This section often holds the key, as not only does the examiner specify the problem, he or she often identifies exactly what is needed to overcome the objection(s).

For PCT applications an [“Invitation to Correct Defects in International Application, Form PCT/RO/106”](#) includes a standard form for drawing objections (follow the link for a sample). They get so many of the particular discrepancies noted that they have created a form so that examiners do not waste time writing out the same reasons repeatedly. On the form are indicated some of the most common reasons for drawing rejections, such as “the sheets are not A4 size (29.7cm x 21cm) or “the sheets contain photocopy marks”. The PCT form does not list all the reasons; however it does provide a small area at the bottom for “further observations if necessary.” Unfortunately, the form is outdated, referring to the type of paper drawings should be done on, even though most patent are filed electronically today.

An examiner will often check the appropriate boxes as cause of objection. Be careful, because an unchecked box does not necessarily mean that your drawings are acceptable. Examiners have a limited amount of time to spend on each application so when a reason to reject the drawings is found, it is not necessary to look further. If you have an application with 20 drawings, the examiner may only look at one figure or one page of drawings. If the examiner finds that the text and numerals are not the correct height in one figure, the drawings can be rejected based on the numerals and text been the wrong height. The examiner may not spend additional time to indicate other problems. This applies to USPTO and PCT rejections. If you only correct the figure cited you may have further objections in the remaining figures later.

When submitting corrected drawings, a complete set must be submitted even if only one figure is amended. Each drawing sheet must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the drawings for consistency.

In design patent applications, a drawing rejection/objection can be much more problematic. According to the USPTO “the drawing disclosure is the most important element of the application”¹ “As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawings or photographs be clear and complete, that nothing regarding the design sought to be patented is left to conjecture”².

The drawings should be accurate and include every feature of the design, enough so that a person specializing in the field that the patent covers could make the item from the drawings.

If drawings are inconsistent or if the design is not fully disclosed, you are not allowed to correct the drawings unless you can do so without adding new matter. New matter is anything that is added to, or removed from, the claim, drawings or specification, that was neither shown nor suggested in the original application.

IN NEXT MONTHS
FEATURE

Why Patent drawings
get rejected
Part 2

Printable Newsletter

It is unwise to file poor drawings, especially since “An incomplete or poorly prepared drawing may result in a fatally defective disclosure which cannot become a patent”³.

There may be no way to correct poor drawings without introducing new matter. You may find yourself in a proverbial “Catch 22” situation. Either the drawings will be rejected for being inconsistent or not fully disclosing the design, or they will be rejected for adding new matter.

Examiners do not always make the right call. If you need to address a specific rejection/objection with the examiner, gather as much support as you can. In some instances visual aids can be used to help an examiner understand the drawings.

In our next issue we’ll discuss actual rejections and objections from multiple notices, including suggested solutions.

ENDNOTES

1. USPTO A Guide to Filing a Design Patent Application, § Drawings or Black and White Photographs (3)
2. USPTO A Guide to Filing a Design Patent Application, § Drawings or Black and White Photographs (3) (4)
3. USPTO A Guide to Filing a Design Patent Application, § The Design Patent Application Process 132). (10)