

To the Board of Governors and Division Chairpersons:

Summary of the Statement on Behalf of Division 14,
Patent, Trademark and Copyright Law,
Regarding the Proposed Change in Submission of
Drawings to the Patent and Trademark Office

Attached hereto is the statement of Division 14 (Patent, Trademark and Copyright Law) recommending modifications in the above-captioned proposal. Division 14 supports the proposed change in procedure, under which an applicant will retain the drawings and submit only copies to the Patent and Trademark Office. This will simplify the procedure of making any necessary corrections in the drawings. The modification recommended by Division 14 is to change the one month period after mailing of the Notice of Allowability for submission of substitute drawings in the proposal to three months, and to provide that if substitute drawings are submitted within two months and are determined to be informal, the applicant will be given one month from the date of the letter stating that the drawings are unacceptable to correct the drawings or to submit new substitute drawings. These modifications are necessary because the one month period in the proposal is too short. The provision of one month to correct any problem with the substitute drawings if they are submitted within two months of the Notice of Allowability will encourage early submission of substitute drawings and prevent delay in the process of publishing patents.

STATEMENT ON BEHALF OF DIVISION 14
PATENT, TRADEMARK AND COPYRIGHT LAW
DISTRICT OF COLUMBIA BAR* REGARDING
THE PROPOSED CHANGE IN SUBMISSION OF DRAWINGS
TO THE PATENT AND TRADEMARK OFFICE

To the Commissioner of Patents and Trademarks

Prepared By:

Charles L. Gholz
Helen M. McCarthy
Joseph M. Potenza
Edward M. Prince
Watson T. Scott
Allen M. Sokal
Robert G. Weilacher

*MANDATORY DISCLAIMER

The views exposed herein represent only those of Division 14 (Patent, Trademark and Copyright Law) of the District of Columbia Bar and not those of the D.C. Bar or of its Board of Governors.

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PATENT, TRADEMARK AND COPYRIGHT LAW
DISTRICT OF COLUMBIA BAR REGARDING
THE PROPOSED CHANGE IN SUBMISSION OF DRAWINGS
TO THE PATENT AND TRADEMARK OFFICE

The District of Columbia Bar, Division of Patent, Trademark and Copyright Law (Division 14), is pleased to submit its comments on the proposed change in submission of drawings. As indicated in the attached comments, we agree with the general thrust of the proposed change, but we have specific proposals that we feel are necessary to improve the proposal.

The District of Columbia Bar, Division of Patent, Trademark and Copyright Law, has a membership of over 900 persons who specialize in intellectual property law, including many who reside and practice in other states. Consequently, these comments should be given careful consideration.

COMMENTS ON AND RECOMMENDATIONS FOR THE
PROPOSED CHANGE IN SUBMISSION OF DRAWINGS

The steering committee of Division 14 supports the proposed change in submission of drawings, and, in particular, Alternative II, but recommends changing Alternative II to read as follows:

Same as Alternative I except that any substitute drawings will be required to be submitted within three months of the date of mailing of the Notice of Allowability instead of in response to the examiner's first action indicating the presence of allowable subject matter. If substitute drawings are submitted within two months of the date of mailing of the Notice of Allowability and the substitute drawings are determined to be informal, the applicant will be given one month from the date of the letter stating that the drawings are unacceptable to either submit new substitute drawings or have a bonded draftsman charge out and correct the drawings in the file.

We favor Alternative II because substitute drawings may be unnecessary even if there is an indication of allowable subject matter. The one month period for filing substitute drawings after the Notice of Allowability, however, is much too short a time period, particularly in applications requiring correspondence with foreign applicants. Under the existing procedure, three months are provided after the Notice of Allowance has been issued for correcting drawings. We recommend maintaining this three month period, but encouraging the submission of substitute drawings within two months by providing a one month period to correct any problem with the substitute drawings if they are submitted within two months of the Notice of Allowability. If the PTO acts promptly on reviewing substitute drawings, there should be no delay in the process of publishing the patent.

BEVERIDGE, DEGRANDI & WEILACHER

ATTORNEYS AND COUNSELORS AT LAW
FEDERAL BAR BUILDING WEST
1819 H STREET, N.W.
WASHINGTON, D.C. 20006
(202) 659-2811

JOSEPH A. DEGRANDI
ROBERT G. WEILACHER
RICHARD G. YOUNG
KENNETH J. MEYERS
JAMES N. DRESSER

MICHAEL A. MAKUCH*
*OHIO BAR

ANDREW B. BEVERIDGE
1916-1972

OF COUNSEL
WILLARD M. HANGER

TELEX
WU 89-2393
WUI 64470
CABLE-JEMEAD
TELECOPIER
(202) 659-1462

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REGISTERED HENDERSON
FARMER, GARRETT & DUNNEK

To: All Members of the Ad Hoc Committee

I am enclosing a copy of the "Proposed Change in Submission of Drawings" which I just received from Rene Tegtmeier. This matter was discussed at the Ad Hoc Committee meeting on April 10.

The PTO is interested in receiving input on the proposal. The AIPLA committee under Herb Mintz should consider the proposal at the Spring Meeting in Cleveland and provide its input to Rene. Everyone else on the Ad Hoc Committee is also asked to submit his or her comments to Rene as soon as possible.

Sincerely,


Joseph A. DeGrandi

JAD:rrd

Enclosure


Write Comments as agreed

PROPOSED CHANGE IN SUBMISSION OF DRAWINGS

The PTO is considering changing the requirements for submitting drawings and their corrections.

In the present procedure, all drawings are reviewed by the Official Draftsman shortly after filing. If informalities are found, they are noted on a form and forwarded to the examiner with the application. The examiner will otherwise review the drawings for acceptability and note informalities and other corrections necessary in the first Office action. Correction of the drawings is not required at this time unless the action is a first action allowance. At the time of the Notice of Allowability, correction of the drawings is required within the 3-month period that the issue fee must be paid. In order to have drawings corrected, the applicant or attorney must have a bonded draftsman come to the PTO to retrieve the original drawings and make the corrections or submit substitute drawings.

Several problems are being experienced. Many cases are being delayed in the issuing process due to delays in obtaining the corrected drawings. Sometimes the bonded draftsmen request the drawings before the application has left the Patent Examining Group and is therefore not available. In other cases, bonded draftsmen do not pick up the drawings until the last part of the 3-month period. Some bonded draftsmen routinely return corrected drawings on the latest possible date. In all cases where a correction of the drawings in the file is involved, the applicant must rely on a bonded draftsman.

The PTO will currently accept as drawings suitable for examination and publication, either master drawings which are inked and otherwise meet the requirements of PTO rules or copies of drawings which copies meet the requirements of PTO rules.

The PTO is considering two alternatives which would resolve these problems for the Office and the applicant.

Alternative I

High quality copies of the ~~master~~ drawings (not the ~~master~~ drawings themselves) are to be submitted at time of filing.

If the original drawings submitted with the application were determined to be formal at time of filing and no changes are required by the examiner, then no substitute drawings would be necessary.

If corrections are needed, either as a result of the formality review by the Official Draftsman or of the review by the patent examiner, applicant will be required to submit substitute drawings at the time of notification that an application contains allowable subject matter or when at least one claim is allowed.

In such case, applicant must prepare and submit substitute drawings with the necessary corrections to the examining group within the response period set in the Office action or, if the action was a first action allowance, to the Official Draftsman within the response period set in the Notice of Allowability, normally three months. Since the applicant or the attorney has the master drawings available for correction, a bonded draftsman is not required to make corrections on the drawings.

After the Notice of Allowance has been issued, the substitute drawings will be reviewed by the Official Draftsman. If the substitute drawings are determined to be informal, a letter of unacceptable drawings will be mailed to the applicant. The applicant will have one month to either submit substitute drawings or have a bonded draftsman charge out and correct the drawings in the file.

If the application is filed with master drawings instead of copies, the Office will follow the same procedure as noted above. The applicant will not be allowed to have a bonded draftsman retrieve the master drawings during the examination process. Therefore, if corrections are needed, substitute drawings with the corrections will have to be prepared and submitted.

Alternative II

Same as Alternative I except that any substitute drawings will be required to be submitted within ^{three} ~~one~~ month^s of the date of mailing of the Notice of Allowability instead of in response to the examiner's first action indicating the presence of allowable subject matter.

what if submit formal & still a problem

If submit w/ 2 mos, automatic 1 mos to further correct if problem - from time of notification.

Definition of Terms

The terms "original", "substitute", "informal" and "formal" are used as defined in MPEP §608.02.

"Master drawings" are defined as the first generation drawings prepared by the draftsman.

with master

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