

Do Drawings Really Need to Show Every Feature of the Invention?

by Jens Jenkins

A patent application will sometimes be rejected in view of drawing objections. One type of drawing objection is based on a claim reciting a particular feature (e.g., feature 'x') that is not explicitly shown in the drawings. For instance, an Office Action might object to drawings under 37 C.F.R. §1.83(a) on the grounds that "the drawings must show every feature of the invention specified in the claims and feature 'x' of the claims is not shown in the drawings." Question: Is this type of objection well-grounded and/or traversable? Maybe, maybe not.

35 U.S.C. §113 is the statute governing drawing requirements. The corresponding drawing regulations are found in 37 CFR §1.81 and 37 CFR §1.83. Notably, the drawing requirements found in 35 U.S.C. §113 and 37 CFR §1.81, which are very similar, appear to articulate a standard that is much less onerous than the standard that is often imposed by the Patent Office in view of 37 CFR §1.83. Here are the key passages related to the different drawing standards for your own analysis:

35 U.S.C. §113

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented...

37 CFR §1.81(a)

The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented...

37 CFR §1.83(a)

The drawing in a non provisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

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The different drawing standards appear to provide some wiggle room for traversing examiner rejections that are solely based on the more stringent standard of 37 CFR §1.83. Like many rejections, the ability to traverse the rejection will likely depend on how critical the claimed feature is to the claim and how well-known the feature is to one of ordinary skill and/or how well the feature is described in the Specification.

Here is an example of some language a practitioner might consider incorporating into their traversal of a drawing objection under 37 CFR §1.83, when appropriate:

Applicant respectfully traverses the objection to the drawings under 37 C.F.R. §1.83(a). In particular, Applicant notes that, as outlined in *MPEP 608.02 Drawing [R-07.2015]*, the statutory requirement for showing the claimed invention only requires that the “applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented...” (See *35 U.S.C. 113*, See also 37 CFR §1.81(a), which states “[t]he applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented...”). In the pending application, Applicant respectfully submits that an express illustration of feature ‘X’ is not necessary for understanding by one of ordinary skill in the art of the subject matter to be patented. Accordingly, withdrawal of this objection is respectfully requested.