

Applicant-suggested drawing figure in the publication of patent applications

Summary

The United States Patent and Trademark Office (USPTO) continually looks for opportunities to streamline and improve its processes. In order to streamline its process of publishing patent applications, reduce costs and increase applicant satisfaction, the USPTO will begin exclusively using the drawing figure suggested by the applicant for the front page of a patent application publication when the suggestion is included on a compliant Application Data Sheet (ADS), timely filed before the USPTO begins its process of publishing the application.

Background

The USPTO publishes nonprovisional utility and plant patent applications in accordance with 35 U.S.C. 122(b). These patent application publications, commonly referred to as pre-grant publications, may include a drawing figure on the front page of the publication as an illustration of the invention. Currently, the applicant can suggest which figure should appear on the front page of the publication by indicating the figure number on the application transmittal letter or an ADS filed in compliance with 37 CFR 1.76. The USPTO is not bound by the applicant's suggestion, and the figure which appears on the front page of the publication sometimes differs from the applicant's suggestion. See, e.g., 37 CFR 1.76(b)(3) and Manual of Patent Examining Procedure (9th ed., Rev. 7.2022) (MPEP) section 601.05(a), subsection I.

Process Change

Beginning two months from the execution date of this notice, the USPTO will exclusively use the drawing figure suggested by the applicant for the front page of the pre-grant publication when the suggestion is included on a compliant ADS, timely filed before the USPTO begins its process of publishing the application. Accordingly, the applicant should make sure to include the drawing figure suggestion on a compliant and timely filed ADS, and not on an application transmittal letter, such as the USPTO form PTO/AIA/15 titled "Utility Patent Application Transmittal." The USPTO is eliminating its: (1) consideration of the application transmittal letter for the applicant's figure suggestion; and (2) review of the applicant's figure suggestion. If the applicant does not include a figure suggestion in a compliant ADS filed before the USPTO begins its publishing process, the USPTO will select a figure.

The USPTO strongly recommends providing the figure suggestion on a compliant ADS filed concurrently with the application. In the event that an applicant includes the figure suggestion on a compliant ADS which is filed after the initial filing of the application, such as an updated ADS filed in compliance with 37 CFR 1.76(c), please note that the USPTO's process of publishing the application typically begins more than 14 weeks before the projected publication date listed on the filing receipt. See MPEP section 1120, subsection IV.

The new process notwithstanding, though the USPTO will make every effort to use the figure selected by the applicant if the applicant follows these procedures, the USPTO continues to not be bound by the applicant's figure suggestion. Accordingly, the USPTO will not treat its failure to use the figure suggested by the applicant for the first page of the pre-grant publication as a

material mistake in the publication for purposes of a corrected patent application publication under 37 CFR 1.221(b).

Contact information

Any inquiry regarding this notice may be directed to Andrew St.Clair, Legal Advisor, Office of Patent Legal Administration, Office of the Commissioner for Patents, at 571-270-0238 or PatentPractice@uspto.gov.

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Under Secretary of Commerce for Intellectual Property and
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