

CHAPTER 5

THE DRAWINGS

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Introduction

- 5.01 A drawing or drawings, although not essential, may be used to supplement the description of an invention in a patent application. Where drawings are referred to in the description (whether or not they meet the requirements of the Act or Rules), they must be filed on the same date as the description to allow that date to be accorded as the date of filing the application (s.15(3)). Where drawings have not been filed refer to 5.34.
- 5.02 Drawings filed with an application on its day of filing will be distinguishable from later filed drawings in that the later filed drawings have an Office date stamp on their side.
- 5.03 At the preliminary examination stage (see chapter 7), the Formalities Examiner will examine the drawings for compliance with the Act and Rules and will judge them to be either "FORMAL" or "INFORMAL". Rule 14 and Schedule 2 set out the conditions to be met in order for the drawings to be considered "Formal". See Annex 5A.
- 5.04 It is particularly important to check the quality of drawings since, if the originally filed drawings are informal, the scan may not have adequately captured all of the detail in the drawings. If it appears that a drawing has not been scanned properly, a re-scan request should be submitted to the Index and Scanning team by e-mail. Images should not be set as handled unless and until the Formalities Examiner is satisfied that the quality of the image is acceptable.

Formal drawings

- 5.05 Formal drawings are those that meet the formal requirements in every respect.
- 5.06 When formal drawings are filed with an application, the Formalities Examiner should type in the annotation column that they are formal.

Informal drawings

- 5.07 Informal drawings are those that do not meet the formal requirements of r.14 and Sch.2. When informal drawings are filed with an application, the Formalities Examiner should type in the annotation column that they are informal.
- 5.08 Any second or further sets of informal drawings identical to the first set should be annotated "Informal".

- 5.09 It should be noted that any originally filed drawings must not be altered in any way.

Electronically filed drawings

- 5.10 For the purposes of filing only, applications which are filed electronically are exempt from many of the formal and other requirements for drawings and documents which apply to paper filed applications. This allows customers to file applications easily by electronic means and obtain a filing date.
- 5.11 Directions issued under section 124A govern how the Office will deal with applications after they have been delivered electronically. The latest directions are at: www.ipo.gov.uk/pro-types/pro-patent/p-law/p-legislation/p-direction/p-direction-electronic-1207.htm
- 5.12 Paragraph 17 of the Directions set out the formal requirements for drawings in an electronically delivered application as below:

The following provisions of the Rules shall apply to electronic applications and shall be formal requirements: Schedule 2 Part 1 paragraph 3,Schedule 2 Part 3 paragraphs 11, 12 and 14-20.

- 5.13 Once the electronic application has been filed all the formal requirements will apply in the same way as for any other application except those which relate specifically to paper filed applications (paragraphs 1, 2 and 13).

Part 4 of Schedule 2 applies to all applications.

Objecting to informal drawings

- 5.14 Compliance with the provisions of r.14 and Sch.2 (except for the specified exceptions) is a formal requirement (r.25). Therefore, when informal drawings are filed with an application, the Formalities Examiner must request formal copies. Any objection to the drawings and consequent request for formal drawings should be made using the appropriate paragraph(s) of letters FL1 or LFEPA on PROSE. (See Annex 5A)
- 5.15 The specified period for providing formal drawings is fifteen months calculated from the earliest declared priority date, or where there is no declaration of priority, the date of filing of the application. This period may be automatically extended under r.109 by two months at the Applicant/Agent's written request. This may be either a letter or an e-mail to the dedicated e-mail address PATEOT@ipo.gov.uk.

- 5.16 Where there is less than two months remaining of the fifteen month period, a period of two months, calculated from the date of issue of the FL1, should be allowed for a response. If the agent requests an extension before the end of the period, an automatic extension of two months can be given if the request is put in writing. This two month extension is available up until the end of the extended period.
- 5.17 If the formal drawings are received outside the time specified and outside the period of automatic extension available under r.109, the Applicant/Agent may request Comptroller's discretion be exercised to allow the late filing. The request for the Comptroller's discretion should be accompanied by an explanation as to the cause of the delay. In such cases, the file should be referred to the Formalities Manager for consideration.

Formal drawings filed later than the date of filing

- 5.18 Drawings filed later than the date of filing are identifiable by their having a perforated date "stamp" on each sheet.
- 5.19 These later filed drawings should be checked against those originally filed to ensure that:
- a) they fully meet the formal requirements of r.14 and Sch.2
 - b) they are true copies of the originally filed drawings.
- 5.20 Where the formal requirements have been met and there are no differences between the original and later filed drawings, the Formalities Examiner should carry out the following actions:
- a) annotate the drawings 'formal'
 - b) complete a printer's instruction on Optics with Footnote 1. Further information on the general completion of the printer's instruction can be found in Chapter 8;
 - c) check the application thoroughly for compliance with all of the formal requirements;
 - d) either prepare the dossier for publication or close it down to await further documents, diary or a checklist message.
- 5.21 Where the formal requirements of have been met but there are differences between the original and later filed drawings, the Formalities Examiner

should create a minute for the Patent Examiner's attention detailing the noted discrepancies.

- 5.22 The Patent Examiner will consider the later filed drawings and either decide that the drawings are acceptable, (in which case the Formalities Examiner should proceed as per 5.19), or will instruct Formalities to request replacement drawings which exactly match those originally filed.
- 5.23 Where replacement drawings are required, whether because of differences or because the drawings still do not fully meet the formal requirements, the Formalities Examiner should carry out the following actions:
- a) contact the agent by telephone and request replacement drawings, indicating the areas of deficiency in the previous submission;
 - b) set a period of reply - where the 15 month period has already expired, or less than one month remains, a period of one month should be set. Where the 15 month period has not expired and has more than one month remaining, then the expiry date of the 15 months should be set as the reply period;
 - c) issue a telephone report and import a copy on the dossier;
 - d) annotate the actions taken
 - e) set a suitable diary date to monitor the case;
 - f) close the dossier down and await the filing of the replacement drawings, or the diary date.

Formulae drawings

- 5.24 A drawing containing formulae which appear in the text of the specification is rarely needed. The applicant may wish the formulae to appear in the abstract and therefore may have prepared separate sheets containing the formulae for use in the abstract.
- 5.25 When such drawings are supplied by the applicant, the Formalities Examiner should compare the formulae on these sheets against those contained in the specification and bring any discrepancies to the Patent Examiner's attention. No objection should be raised at the initial formalities examination.
- 5.26 Any questions relating to formulae drawings should be referred in the first instance to the Formalities Manager. Further guidance may be found in MPP 15A.09 and 14.181.

Photographs

- 5.27 Photographs are often submitted with the intention that they are used as drawings. They may have been supplied in the form of specially prepared, A4 sized photographic sheets, or they may have been simply mounted on a card or paper backing sheet.
- 5.28 Photographs do not meet the formal requirements for drawings as they cannot normally be reproduced for publication. Line drawings should be therefore be requested in all cases except those where it is obvious that no drawing is possible (eg. slides in some microbiology applications).

Drawings on PCT S.89 applications

- 5.29 When the Office reprints a PCT s.89 application during the National Phase, it is the drawings attached to the WIPO pamphlet that are used for reprinting purposes.
- 5.30 If these drawings contain textual matter in a foreign language, the Formalities Examiner must request a translation of the textual matter (see 13.106 - for further information).
- 5.31 The drawing on the translation corresponding to that shown on the front page of the WIPO specification is flagged with a proforma "Drawing to accompany the abstract on the GB front page for republishing Fig....." The dossier is minuted to the Patent Examiner for confirmation.

Formal drawings requested but not filed

- 5.32 If formal drawings have been requested at least once (i.e. a FL1 or LFEPa has been issued), and have not been filed within the specified period (as extendable under r.109), PROSE letter FL48 should be issued, provided that there is only this formal requirement outstanding. [It is possible that in addition to the formal drawings being overdue, formal pages and/or a correctly signed F1 are also outstanding, in which case a suitably amended FL48 should be issued.] Before issuing this letter, the Formalities Examiner should ensure that the drawings have not been received, and that the applicant has not asked for the objection to be reconsidered.
- 5.33 The dossier should be diarised for a period of 1 month from the refusal date specified and an action logged to show this. The dossier should then be closed down to await further action. This refusal date is not a specified period and is not extendable as of right by two months. It may however be possible to file a late response to the FL48 before the refusal decision has been issued providing reasons for the late response.

- 5.34 If, on or before the refusal date given in the FL48, satisfactory drawings are filed action should be taken as per 5.19 -20 above. The reason for the late filing should be referred to the Formalities Manager for consideration.
- 5.35 Where the drawings are not filed by the date given for refusal and the applicant has not asked to be heard in the matter, a decision of refusal should be issued under s.15A(7) (see chapter 12). Alternatively, the PROSE letter WR4 can be used if there are other formalities requirements outstanding such as a F7, claims and abstract.

Correction of drawings

- 5.36 In normal circumstances, no amendment of the drawings may be allowed before "A" publication as the application must be published "as filed" (s.16(1)). (For post publication amendment see chapter 9.) However, an applicant may request a correction of the drawings on file under the provisions of s.117, by filing a written request.
- 5.37 Any such request to correct a drawing should be referred to the Patent Examiner. If, after consideration, the Patent Examiner allows the request but is unable to correct the drawings on the dossier, replacement copies showing the correction will be required. A printer's footnote should be completed for correction under s.117 (Footnote 6).
- 5.38 The applicant should be advised that the request has been allowed and if appropriate, asked to submit replacement copies of the drawings. The Patent Examiner will either carry out this action or instruct the Formalities Examiner what action to take. When the replacement drawings are filed they should be actioned as per 5.19-20 above.

Missing or later filed drawings

Filed by the applicant

- 5.39 Where any drawing has been omitted from the application the agent/applicant can elect to file these missing drawings at any time between the filing date and the date of Preliminary Examination (r.18(1)). This time period can be extended under rule 108(3) by filing Form 52. The application will then be automatically re-dated to the date of filing the missing drawings unless the provisions set out below apply.
- a) If the applicant is to avoid re-dating of the application he must withdraw the missing drawings in writing (r.18(3)). If the applicant asks to withdraw the missing drawing(s) under s.15(6)(b) it will

not be included in the printed 'A' document, however it will become open for public inspection following s.16 publication.

b) Alternatively, he must request that re-dating does not take place because the provisions of s.15(7)(b) apply.

5.40 The provisions of s.15(7)(b) will only apply when there is a priority claim and the applicant can show that the missing drawings were included in the priority document. It is the applicant's responsibility to provide enough information to determine where in the priority document the missing drawings appear.

5.41 Every missing part must be included in the priority document if the earlier filing date is to be retained. If there is any doubt as to whether subject matter is being added then the Patent Examiner should be consulted.

5.42 Unless a copy of the document is already held in the office, a certified copy of the priority document containing the missing parts must be filed. This must be done within 16 months of the priority date or within 4 months of the request to retain the original filing date if that is earlier.

5.43 When missing drawings are filed by applicant/agent of his own accord the letter at Annex 5B should be issued explaining the options if automatic re-dating is not to take place and specifying a time for response.

5.44 If the applicant files missing drawings and requests that the application is NOT re-dated the Formalities Examiner should refer the case to the Formalities Manager to determine if all the conditions set out above have been satisfied. If there is any doubt as to whether all the missing parts are contained in the earlier application the case should be referred to the Patent Examiner for advice.

Notified at Preliminary Examination

5.45 During the Preliminary Examination, the Formalities Examiner must ensure that all drawings referred to in the description are present and that there are no obviously missing drawings. If it is discovered that a drawing or drawings are missing, the Formalities Examiner should carry out one of the following actions in accordance with s.15A(4) & 15A(9)(b):-

a) where the application makes no claim to priority, issue the appropriate paragraph inviting the applicant to file the missing drawings. The standard paragraph gives the applicant 2 months in which he can file the missing drawing(s) and have the application re-dated to the date they are filed. This period is extendable under rule 108(1) – Comptroller's discretion. If he does not file them

then the application will proceed in the 'as filed' state and references to the missing drawing(s) will be treated as omitted.

or

- b) where the application claims priority from an earlier application the missing drawings may be contained in this priority application and s.15(7)(b) may apply (see 5.40 -42) This possibility should be made available to the applicant by including the appropriate paragraph in the Preliminary Examination report.

5.46 In either case the Formalities Examiner should complete the Preliminary Examination. The case should be diarised for a suitable period and an action logged accordingly and a minute imported into the dossier to the Examiner that this issue is still outstanding and the application may be re-dated.

5.47 Where an application contains a claim to priority under s.5(2), the Formalities Examiner should consider whether the possibility of re-dating would render such a priority claim invalid. If any priority claim would become invalid as a result of re-dating, the following paragraph should be inserted into the standard paragraph of the Preliminary Examination report:

"It should be noted that the application claims the earlier date of {DATE} under Section 5(2) of the Patents Act 1977. Therefore, the filing of the missing drawing(s) and the consequent re-dating of the application would render the claim to priority invalid."

5.48 If, in response to the Preliminary Examination Report, the applicant files the omitted drawing(s) and requests that the application is NOT re-dated the Formalities Examiner should refer the case to the Formalities Manager to determine if all the conditions set out in 5.40 – 42 above have been satisfied. If there is any doubt as to whether all the missing parts are contained in the earlier application the case should be referred to the Patent Examiner for advice. If the provisions of s15(7)(b) outlined previously in 5.40- 42 do not apply the application must be re-dated.

Re-dating

5.49 In order to re-date an application, the Formalities Examiner should carry out the following actions:

- a) import a minute into the dossier clearly indicating the date to which the application is to be re-dated. Where the application contains a claim to priority that will be rendered invalid by the re-

dating action, the minute should also request the cancellation of the priority details.

- b) create a message and send to the Formalities Manager.

5.50 The Formalities Manager will carry out the following actions:

- a) approve the re-dating, print off a copy of the F1 and delete where appropriate the declared priority date, have this altered copy scanned into the dossier and annotate this is as the “Working copy” F1. The originally filed F1 can then be closed.
- b) create a message for the relevant sections to effect the re-dating (ie Document Reception for issue of a new filing receipt, Index and Scanning to re-date all documents to the date of filing of the omitted drawings) and if appropriate, place a notice in the Patents Journal.

5.51 When a message is received that the re-dating has been carried out, the Formalities Examiner should carry out the following actions:

- a) check the drawing(s) to ensure that they meet the requirements of r.14 and Sch.2
- b) advise the applicant, in writing, that the application has been re-dated, and where appropriate, that the claim to priority has been lost;
- c) create a minute advising the Patent Examiner that the application has been re-dated, and where appropriate, that the claim to priority has been lost.

5.52 If the applicant does not respond or in replying elects to have references to the missing drawings withdrawn under s.15(6)(b), the Formalities Examiner should carry out the following actions:

- a) complete a printer's instruction on Optics, indicating the first non-standard text and entering the relevant drawing number(s). Add an action log to show that this has been done.
- b) create a minute advising the Patent Examiner that the references to the missing drawing(s) are to be treated as withdrawn and that the printer's notice has been completed.
- c) send a message to the appropriate Examining group.

Procedure to add omitted drawings

- 5.53 In s.15(3A), provision is made for the late filing of previously omitted drawings to be considered as a correction of a clerical error under s.117.
- 5.54 If a written request is received asking to have late filed drawing(s) considered as a correction under s.117, a message should be sent to the Patent Examiner for consideration of the request.
- 5.55 If the request is allowed, a message will be sent to the Formalities Examiner, who should carry out the following actions:
- a) check whether the drawings meet the formal requirements of r.14 and Sch.2 . Where the drawings are formal, proceed as per 5.05-06. Where the drawings are informal, proceed as per 5.07-09;
 - b) if the Examiner has not already done so, advise the applicant, by PROSE letter that the request has been allowed
 - c) complete a printer's instruction on Optics, using Footnote 6 and add an action log accordingly.
- 5.56 Should the Examiner refuse the request, the dossier should be checked to ascertain which way the applicant wishes to proceed should the request not be allowed and what options (eg. re-dating) are now available.
- 5.57 Where the applicant's intentions if the request is refused are not clear, the Formalities Examiner should carry out the following actions:
- a) contact the applicant by telephone to confirm the Patent Examiner's decision and discuss any remaining options. The applicant should be asked to file written confirmation, within two weeks, of the way they wish to proceed;
 - b) issue a telephone report and import a copy onto the dossier;
 - c) set a suitable diary date to monitor the case and add an action log accordingly;
 - d) close the dossier down to await the written instructions, or the diary date
 - e) follow 5.49-52 for re-dating or treating the drawings as omitted.

Drawings

Rule 14 and Schedule2

<u>Rule 14</u>	
(1)	Any text must be in English or Welsh
(5)	Schedule 2 parts 1 and 3 do not apply to electronically or web filed applications
<u>Schedule 2</u>	
<u>Part 1*</u>	ALL DOCUMENTS
(1)	A4 matt white paper must be used
(2)	Paper must be free from tears, folds or similar damage Contents must be suitable for reproduction
(3)	Frames must not be used
<u>Part 3*</u>	DRAWINGS
(11)	Margins must be at least:- Top – 20mm Bottom – 10mm Left – 20mm Right – 15mm
(12)	Drawings must be consecutively numbered in one series
(13)	Drawings section of the application must begin on a new sheet
(14)	Pages of drawings must be consecutively numbered in one series
(15)	Drawings must consist of black lines without shading
(16)	Drawings can include cross-hatching to illustrate cross sections
(17)	Scales must be represented diagrammatically
(18)	Drawings must remain clear if reduced by one third
(19)	F1, description, claims and abstract must not include drawings
(20)	Capital letters in drawings must be more than 3mm high
<u>Part 4</u>	OTHER REQUIREMENTS
(21)	Only references mentioned in description or claims can be included in drawings
(23)	Terminology and references must be consistent throughout the application
(24 &25)	Standard units of measurement should be used or equivalent standard international units of measurement should be provided. Only technical terms, signs and symbols which are generally accepted in the field may be used.

* Parts 1 and 3 do not apply to electronically or web filed applications

A. N. Other
c/o An Agent
Any Street
Any Town
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Your reference: xx
Application number: GB *** ***

Date

Dear Sir(s)

Patents Act 1977: Patent Rules 2007
Report under Section 15(5) - late filed drawing(s)

On DD/MM/YYYY, you filed at this office all the figures which should have been included when the application was filed.

The drawings will be included in your application and the application filing date will be changed to DD/MM/YYYY.

If you wish to retain the earlier filing date you must either withdraw the missing drawings in writing by **DD/MM/YYYY** or show that all the missing drawings were present in an earlier application from which you claim priority.

If we do not hear from you by **DD/MM/YYYY** the application will be re-dated to DD/MM/YYYY.

Yours faithfully

Formalities Examiner

September 2011

†Use of E-mail: Please note that e-mail should be used for correspondence only.