

IPLS PROCEEDINGS

STATE BAR OF MICHIGAN

View from the Chair

Members:

Volume 34 • Issue 2 • 2023

IN THIS ISSUE

View from the Chair	1
Upcoming Events	2
Intellectual Property Enforcement in E-Commerce—Amazon's Utility Patent Infringement Program	3
Pro Bono / Mentoring Opportunities ..	4
AI Disclosure Requirements are Coming	5
Drawings in Patent Applications – Are the Requirements Overly Broad?	8
Launch of the USPTO's New Patents for Humanity Green Energy Competition	12

As the weather warms up, I'm hoping I will see you all on the porch at the 48th Annual Intellectual Property Law Institute on Mackinac Island July 20th – 22nd. We have a terrific slate of speakers from across the country who will be presenting, including USPTO Deputy Director Derrick Brent who will provide us with information and insight on the USPTO's latest initiatives. In addition, please mark your calendars as we will once again be holding our Basic Trademark and Patent Practice for Lawyers and Paralegals seminar via livestream on October 12th.

In addition to planning our main educational seminars, the Intellectual Property Law Section (IPLS) Council continues its work on its Diversity, Equity, and Inclusion (DEI) initiatives, including the sponsorship of 4 robotics tournaments in Michigan and related scholarships, the Michigan Pro Bono Patent Project, and the establishment of endowed scholarships at our Michigan law schools. I would also like to thank IPLS Council member David Willoughby, whose Council term ends in July, for his years of service on the Council and as Council liaison to the Michigan Pro Bono Patent Project Committee.

As you may already know, the IPLS Council has also been busy establishing a LinkedIn group so that the Council can communicate more efficiently about topics of interest with our members. I would encourage all of our members to join the State Bar of Michigan Intellectual Property Law Section LinkedIn group at <https://www.linkedin.com/groups/12646050/> and to post about any topic relevant to the IPLS.

Finally, our section's annual meeting will take place at the Grand Hotel on Mackinac Island at 8:00 a.m. on Friday, July 21st. It will mark the end of my year as Chair and the start of a new year for the IPLS Council with Jennifer Carter-Johnson as incoming Chair. Thank you to our members for your continued support as we continue to tackle new initiatives and opportunities for Intellectual Property Law education in Michigan. See you on Mackinac!

--Kimberly A. Berger

Chair

Kimberly A. Berger, Detroit
P: (313) 496-7912
E: berger@millercanfield.com

Chair-Elect

Jennifer Carter-Johnson,
East Lansing
P: (517) 432-6944
E: jcj@law.msu.edu

Secretary-Treasurer

Pervin R. Taleyarkhan, Benton Harbor

Term Ending 2023

D. Stuart Atwater, Grand Rapids
Amber M. Underhill, Grand Rapids
David S. Willoughby, Troy

Term Ending 2024

David L. Atallah, Birmingham
Paul J. Palinski, Pontiac
Jennifer A. Puplava, Grand Rapids

Term Ending 2025

Glenn E. Forbis, Troy
Peter J. Mattei, Southfield
LeKeisha M. Suggs, Troy

Commissioner Liaison

Daniel D. Quick, Troy

ICLE

Jeffrey E. Kirkey, Ann Arbor
E: jkirkey@icle.org

© 2023

Intellectual Property Law Section
State Bar of Michigan

Upcoming Events

48th Annual IP Law Summer Institute

July 20-22, 2023, Grand Hotel, Mackinac Island

Join us in person to get essential updates in patent, trademark, and copyright law. Hear from USPTO Deputy Director Derrick Brent and federal Judge Kara Stoll. Get up to speed on cultural IP rights, Section 230, Copyright Claims Board proceedings, and more.

You will be able to:

- Gain insight on the USPTO's latest initiatives from Deputy Director Derrick Brent
- Bolster your appellate advocacy with advice from Judge Kara Stoll of the federal circuit
- Demystify Section 230 and grasp why it matters to you and your IP clients
- Review everyday ethical challenges and come away with advice that keeps you out of trouble
- Protect IP rights for cultures with long-standing traditions and heritage
- Stay current on many cases, including *ModernaTX Inc v Pfizer Inc* and *California Institute v Broadcom*
- Help clients navigate proceedings of the new Copyright Claims Board (CCB)

To register, go to www.icle.org/ip or call 877-229-4350. We look forward to seeing you there in person!

Basic Trademark and Patent Practice for Lawyers and Paralegals

Live October 12, 2023, On-Demand Seminar

Join us for a nuts-and-bolts seminar. In just one day get the fundamentals of IP law practice with practical advice from Michigan's top patent and trademark lawyers. Take away winning strategies from experienced practitioners for patent prosecution, patent litigation, trademark prosecution, and trademark litigation. It's the most cost-effective seminar for intellectual property lawyers and paralegals.

You will be able to:

- Improve your application and prosecution before U.S. and foreign patent offices
- Avoid non-substantive office actions when you register a trademark
- Identify key issues at the beginning of trademark litigation
- Understand how the America Invents Act impacts your patent practice
- Set realistic expectations about costs and results during litigation
- Think "big picture" to advise clients on patent and trademark prosecution

To register, go to www.icle.org/ipbasics or call 877-229-4350. 

Intellectual Property Enforcement in E-Commerce—Amazon’s Utility Patent Infringement Program

By Matthew J. Schmidt

Virtually anyone can sell almost anything to anybody. And the cost and time for sellers to do so via various e-commerce sites is nominal, making the systems attractive to a wide range of people.

Such widely distributed sales opportunities might be great for sellers, but they make enforcement of intellectual property (IP) rights difficult not only logistically but also financially. Lower sales volumes by many different sellers often means that no one seller is responsible for a volume sufficient to justify filing a lawsuit against them in federal court. The more distributed the sales are among more sellers, the less effective and more costly it can become to enforce IP rights.

To combat this significant problem, most e-commerce platforms offer different programs via which IP rights owners can seek to have removed from their platform listings that include infringements, either in the listing itself or in or on the products being offered for sale in the listings. Most programs focus on copyright and trademark rights which can more easily and quickly be visually determined than, for example, utility patent infringement.

Examples of such programs exist for Amazon via their “Report Infringement Form” by which a trademark or copyright owner can manually report alleged infringements to Amazon. A Brand Registry portal also is provided by Amazon and after a probationary period in which a very high level of accurate/successful, manual infringement reports are made, enables a rights owner to join the Amazon Project Zero program that enables rights owners to directly remove infringing listings and provides an AI tool by which listings may be removed without direct human intervention.

Similar programs are available, for example, via eBay, with the Verified Rights Owner (VeRO) Program¹, Alibaba, with the IP Protection Platform², and Walmart with the Intellectual Property Claim Form³.

But utility patent infringement is more complex to determine, and to assist rights owners Amazon has arrived at a unique program to try and efficiently resolve claims that products sold via Amazon listings infringe a utility patent. Amazon created a relatively low-cost program called Amazon’s Patent Evaluation Express (APEX) Program. Using this program, a US utility patent owner can seek to have Amazon product listings removed on the basis of patent infringement. The request is ultimately reviewed by a patent attorney “Evaluator” selected from a pool of attorneys authorized

by Amazon. If the alleged infringement is confirmed by the Evaluator, the identified listings are removed. If not, the listings may remain on Amazon. Best of all, the winning party pays no fee to Amazon for the evaluation which is funded solely by the losing party.

The APEX evaluation process is relatively straightforward and is completed within a few months. The basic steps and considerations for parties to an evaluation are set forth below.

The Process

1. To initiate the evaluation process, a utility patent owner submits an executed APEX Agreement (“Agreement”) to Amazon indicating agreement to the terms of the APEX program, and a form identifying the patent at issue and one or more listings for the same or substantially identical products alleged to infringe the patent;
2. Amazon sends the Agreement to all sellers of the identified listings who must sign the Agreement to participate in the evaluation. The listings of any seller that refuses to sign the Agreement are removed from Amazon, and the process ends for any such seller.
3. Upon receipt of an executed Agreement from at least one seller, Amazon chooses an Evaluator, and each remaining party must wire to the Evaluator a deposit of \$4,000.
4. Written remarks may then be submitted to the Evaluator by the parties, with exhibits, such as a patent claim chart. The patent owner can submit opening and reply submissions, while the sellers can submit only a response to the patent owner’s opening submission.
5. Based upon the written submissions, the evaluator determines whether infringement is likely and issues a decision that determines both: a) the fate of the listings at issue, and b) which side is responsible to pay the evaluator. The winning side receives a refund of their deposit, and the deposit from the losing side is used to pay the evaluator.

Limitations of the Evaluation

1. Only a single claim from a single utility patent can be asserted in a request.

2. The program does not review alleged design or plant patent infringement.
3. Each evaluation is limited to 20 product listings.
4. While the listings can come from any number of sellers, each evaluation will be limited to listings from no more than 4 sellers. So if more than 4 sellers agree to participate in the program, then the patent owner must either pay additional deposits or Amazon will choose which 4 of the participating sellers will remain in the evaluation, and the other sellers will be removed from the evaluation and their listings will remain on Amazon.
5. If multiple sellers participate in the same evaluation, then they equally split the cost of the evaluator if the patent owner wins the evaluation. The total amount paid to the Evaluator by the losing party is \$4,000. If multiple sellers are involved, they each will pay an equal share of the \$4,000 fee (as little as \$1,000 each for 4 sellers) and receive a refund of the remainder of their initial \$4,000 payment. This makes it easier for sellers to participate together in a request, and patent owners should consider this when naming multiple sellers in a single request.
6. The defenses that can be asserted by sellers is limited. Sellers can assert: a) no infringement; b) invalidity of the patent *only* if they can submit a qualifying order (e.g. from a suitable court, the U.S. Patent and Trademark Office or the International Trade Commission) that the patent was held to be invalid; or c) prior invalidating sale *only* if there is independently verifiable proof of the invalidating sale;
7. There is no discovery permitted, nor is there a hearing or trial.
8. The parties may not contact the Evaluator unless by email in response to an inquiry from the Evaluator.
9. Amazon cannot be a party to the evaluation, so any listings of products offered by Amazon are not eligible for the evaluation. (Amazon selects the evaluators, so this makes some sense from a conflict of interest perspective).
10. The Evaluator's infringement determination is not appealable.
11. No injunction, damages or other monetary award to a prevailing party is possible. The sole outcome is whether the product listings remain on Amazon or are removed.

The Agreement with Amazon

1. The proceedings are confidential and submitted documents may not be disclosed to others.
2. Participants agree not to seek discovery relating to the evaluation program from any participant, Amazon or the Evaluator, in any litigation, arbitration or agency proceeding.
3. The parties must agree not to sue Amazon for infringement with respect to the products or "materially identical products." Thus, Amazon's immunity extends beyond not being subject to any evaluation but also to immunity from court actions alleging patent infringement.

Post Evaluation Options

The process normally takes 3 to 4 months and so is considerably faster and less costly than a patent infringement litigation. Further, upon prevailing in an APEX review for a patent, Amazon may grant the patent owner the ability to remove other listings for the same or substantially identical products without having to initiate new APEX reviews

Pro Bono / Mentoring Opportunities

If you are looking for more ways to engage with our community and truly make a difference, please consider being a mentor for Patent Pathways.

Patent Pathways is a Diversity & Inclusion Program focused on building a more inclusive environment in the field of patent law, specifically dedicated to increasing numbers of registered Black women patent attorneys and agents. The goal is to provide each participant with the tools to take and pass the patent bar and begin their pathway into a career in patent law. Each participant will be paired with mentors to provide individual support throughout their pathway. Mentors set up sessions with their mentees based on their own schedules and availability. The expected time commitment is two hours per month. Patent Pathways is currently seeking mentors for its 2023-2024 program. If you would like additional information, please visit www.patentpathways.org.

**Note: Mentors must be registered with the patent bar, or in the process of becoming registered.*

and by simply submitting a complaint form like that used in trademark and copyright infringement claims. This can be very powerful and is an important and often unreported benefit of the APEX program.

The Evaluator's determination is final insofar as the evaluation program is considered. Nonetheless, the fate of the listing can change upon the occurrence of certain events. A listing that has been taken down may be reinstated if the seller obtains a judgment or order in litigation or an arbitration that the product formerly listed on Amazon does not infringe the asserted patent. Further a listing may be reinstated when a patent expires or is found invalid or unenforceable by a tribunal of competent authority. In each instance, Amazon may restore a removed listing upon notification by a seller.

Similarly, if the Evaluator found in favor of a seller, and the patent owner subsequently obtains an order or judgment finding that a listed product does infringe a patent, the patent owner may submit that judgment or order to Amazon, and Amazon will remove the product listing(s).

In many instances, especially with lower volume sales widely distributed among different sellers, the limited remedy provided by Amazon is valuable to patent owners and should be considered as part of a plan to manage IP rights that may be implicated by products sold on Amazon.

Parties should seek guidance from experienced patent counsel before deciding whether to participate in the evaluation program, and before filing any document in response to a request from a patent owner, as patent infringement can

be difficult to determine, and the process moves quickly and includes many caveats and issues to consider. ?



About the Author

Matthew J. Schmidt, is a shareholder at Reising Ethington PC and his practice covers a broad range of domestic and international IP matters in mechanical and electro-mechanical technologies. His expertise includes patent portfolio management and counseling for some of the world's most innovative multinational enterprises, as well as litigation, infringement and clearance opinions, and licensing and joint development agreements. Matt also was coauthor of two editions of the law school textbook *Cases and Materials on Patent Law: Including Trade Secrets*, which is part of the American Casebook Series published by West Academic Publishing.

Endnotes

- 1 <https://www.ebay.com/sellercenter/ebay-for-business/verified-rights-owner-program#m17-1-tb2>
- 2 <https://ipp.alibabagroup.com/complaint/onlineForm/online.htm>
- 3 <https://brandportal.walmart.com/ipservices>

AI Disclosure Requirements are Coming

By Franklin Graves

As technology platforms continue adopting generative artificial intelligence (AI) tools and providing those tools to end users to assist with content creation, the question is coming up as to what disclosures, if any, are necessary or legally required to accompany such content. Government agencies and regulatory bodies around the world are weighing in with law and policy on the matter. Additionally, technology platforms themselves are beginning to publish updated content moderation policies that address generative AI and the publication of synthetic media.

Regulatory Oversight

For companies that are deploying AI tools within their products and services, the Federal Trade Commission has yet

another warning.¹ “If we haven’t made it obvious yet, FTC staff is focusing intensely on how companies may choose to use AI technology, including new generative AI tools, in ways that can have actual and substantial impact on consumers.”

It’s also important to note FTC Chair Lina Khan’s opinion piece in *The New York Times* that highlights a few key issues with AI: (1) large tech corporation dominance being further solidified; (2) control of raw materials needed for AI tool development, including processors, data, and cloud technology; and (3) the promotion of fair competition and protection of consumers from unfair and deceptive practices through the deployment of AI tech.²

In May, the White House hosted leaders from Google, Microsoft, OpenAI, and Anthropic to meet with Vice President Kamala Harris and senior Administration officials.³ The meeting joined the Administration's other efforts in establishing policy in the areas of AI, including the Blueprint for an AI Bill of Rights⁴ and executive actions from current and prior administrations.⁵

In June, the European Parliament adopted the Artificial Intelligence (AI) Act, sending the legislation to the EU member states for review and discussions.⁶ Among numerous other points, the AI Act includes a requirement that generative AI technology providers disclose content that was AI-generated.

Platform Tools and (Lack of) Controls

Platforms are beginning to release new and updated policies that address synthetic content, as well as built-in tools that support the generation of content. LinkedIn is reportedly piloting a new generative AI-powered tool that will provide job seekers with generated messages they can send to hiring managers.⁷ TikTok is exploring official guidance and tools for disclosure. Meta's Mark Zuckerberg teased AI tools that are in the works for integration across all its platforms, from social to messaging.⁸

In March, TikTok published its "[Synthetic and Manipulated Media](#)" policy. While the platform "welcome[s] the creativity" AI "may unlock", it notes that "synthetic or manipulated media that shows realistic scenes must be clearly disclosed. It recommends the use of a sticker or caption as the platform is reportedly working on a disclosure tool.⁹ The depiction of real private figures is prohibited, while the depiction of real public fixtures is prohibited within the context of endorsements or other policy violations.

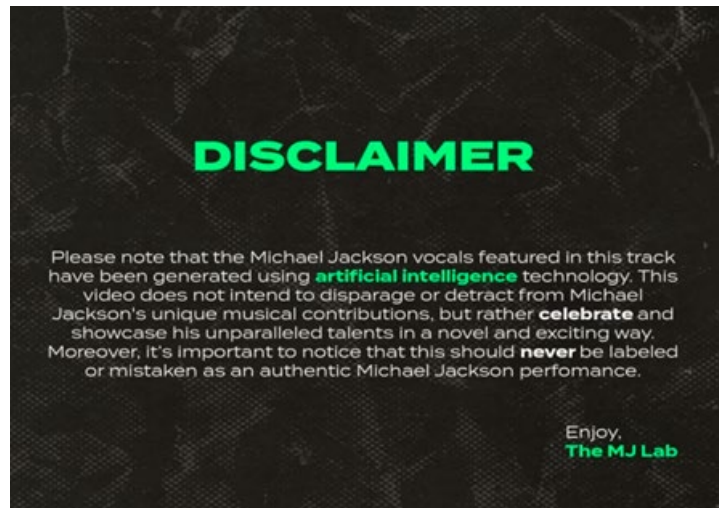
LinkedIn recently published a policy titled "Best practices for content created with the help of AI".¹⁰ The company notes, "AI, when used responsibly, can act as a catalyst for creation and add value to a member's original thoughts." The policy recommends as a best practice that users posting content with the help of AI disclose such use if they relied "heavily" on AI.

Meta's [Misinformation](#) policy covers manipulated media, which includes AI/ML and other synthetic media, that may be posted to Facebook and Instagram.¹¹ An additional policy from Meta that may be applied to generative AI outputs is the platform's Inauthentic Behavior policy which includes as part of the definition of "inauthentic behavior" the use of the platform to "mislead people or Facebook [...] About the source or origin of content."¹²

For Twitter, it remains unclear whether or not the company continues to have an established policy on synthetic media. In 2020, prior to the company's acquisition by Elon Musk, a blog post, "Building rules in public: Our approach

to synthetic & manipulated media", was published that detailed the platform's approach to updating its rules to account for such content.¹³

In lieu of platform controls, creators and brands can consider adding their own disclosure as part of their content. A recent example is an opening card included on a YouTube video featuring an AI-generated version of the Britney Spears track 'Circus' re-imagined as a duet with Michael Jackson.¹⁴ The disclaimer clearly identifies the voice of Michael Jackson as "generated using artificial intelligence technology."



Does a disclosure in this instance change anything, legally speaking? It's potentially unclear, even under a First Amendment argument in light of the right of publicity.¹⁵ Also, this particular AI-generated track is heavily reliant upon (1) music publishing controlled by major music publishers; and (2) a significant portion of the original sound recording. Both the composition and master for "Circus" would require licenses for use in this manner.

Technical Solutions for Disclosure


Technology companies can implement three options when designing their platforms to detect synthetic media:

First, a self-disclosure toggle that users can use and which would be backed by regulatory requirements in the future. Similar to the way in which YouTube currently offers a "Contains paid endorsement" option for creators upon upload, a toggle that is part of the UX and UI allows for a means of disclosure that is built into the product. This could be regulatory oversight within the purview of the FTC, as is the case with influencer and brand advertising disclosure obligations.¹⁶

Second, platforms could implement copy-and-paste detection. Social media sites already have the means of tracking users' every move, including keyboard inputs and clipboard data access. The same tracking technologies can be a means of detecting whether or not a user is drafting a post

over a period of time, with one or more versions. Or, did they paste a block of text and then hit post? This detection method is not perfect, since a user may be manually typing the output of a text generator into the posting tool on a platform. A user also may have been drafting a post in their Notes app, waiting to then paste it into a post instead of using a scheduler tool. And, third-party applications operating via APIs, such as scheduling tools, pose a problem here, too, since a platform would be relying on data captured by that platform, if any, at the time of composing.

Lastly, automatic disclosures from the generative AI tool itself may be a workable solution. This would apply to platforms that offer generative technologies to their end users to assist (or replace) content creation, as well as tools that are commercially available. Adobe's Firefly is one example of such disclosure-by-design. As the company notes, "Firefly will automatically attach a tag in the embedded Content Credentials to make AI-generated art and content easily distinguishable from work created without generative AI."

There's also an interesting liability twist under Section 230 of the Communication Decency Act if the content is no longer user-generated content, but rather AI-generated content from a tool the platform (or its partners) provides. It remains unclear whether or not such content is covered under the safe harbor. 



About the Author

Franklin Graves is an experienced in-house counsel and is currently a member of the technology law group at HCA Healthcare, Inc. He is an Affiliated Faculty with Emerson College's Business of Creative Enterprises MA program where he teaches business and IP law. He previously held roles on the commercial legal team at

Eventbrite, Inc. and the business and legal affairs team at Naxos Music Group. Franklin also runs the weekly newsletter, Creator Economy Law, on LinkedIn. He is based in Nashville, TN.

Endnotes

- 1 Atleson, M. (2023, May 1). The Luring Test: AI and the engineering of consumer trust. Federal Trade Commission Business Blog. Retrieved June 21, 2023, from <https://www.ftc.gov/business-guidance/blog/2023/05/luring-test-ai-engineering-consumer-trust>.
- 2 Khan, L. M. (2023, May 3). (Opinion) Lina Khan: We Must Regulate A.I. Here's How. The New York Times. <https://www.nytimes.com/2023/05/03/opinion/ai-lina-khan-ftc-technology.html>.
- 3 The White House. (2023, May 4). FACT SHEET: Biden-Harris Administration Announces New Actions to Promote Responsible AI Innovation that Protects Americans' Rights and Safety. The White House. Retrieved June 21, 2023, from <https://www.whitehouse.gov/briefing-room/statements-releases/2023/05/04/fact-sheet-biden-harris-administration-announces-new-actions-to-promote-responsible-ai-innovation-that-protects-americans-rights-and-safety/>.
- 4 Office of Science and Technology Policy. (2022, October 4). Blueprint for an AI Bill of Rights. The White House. Retrieved June 21, 2023, from <https://www.whitehouse.gov/ostp/ai-bill-of-rights/>.
- 5 Legislative and Executive Orders. (n.d.). National Artificial Intelligence Initiative. Retrieved June 21, 2023, from <https://www.ai.gov/legislation-and-executive-orders/>.
- 6 Press Release. (2023, June 14). MEPs ready to negotiate first-ever rules for safe and transparent AI | News. European Parliament. Retrieved June 21, 2023, from <https://www.europarl.europa.eu/news/en/press-room/20230609IPR96212/meps-ready-to-negotiate-first-ever-rules-for-safe-and-transparent-ai>.
- 7 Bell, K. (2023, May 2). LinkedIn's new AI will write messages to hiring managers. Engadget. <https://www.engadget.com/linkedin-s-new-ai-will-write-messages-to-hiring-managers-162528197.html>.
- 8 Heath, A. (2023, April 26). Mark Zuckerberg says Meta wants to "introduce AI agents to billions of people". The Verge. <https://www.theverge.com/2023/4/26/23699633/mark-zuckerberg-meta-generative-ai-chatbots-instagram-facebook-whatsapp>.
- 9 Yurieff, K. (2023, May 1). TikTok Is Developing AI-Generated Video Disclosures as Deepfakes Rise. The Information. <https://www.theinformation.com/articles/tiktok-is-developing-ai-generated-video-disclosures-as-deepfakes-rise>.
- 10 LinkedIn. (n.d.). Best practices for content created with the help of AI. LinkedIn Help. Retrieved June 21, 2023, from <https://www.linkedin.com/help/linkedin/answer/a1481496>.
- 11 Meta Platforms, Inc. (n.d.). Misinformation. Transparency Center. Retrieved June 21, 2023, from <https://transparency.fb.com/policies/community-standards/misinformation/>.
- 12 Meta Platforms, Inc. (n.d.). Inauthentic Behavior. Transparency Center. Retrieved June 21, 2023, from <https://transparency.fb.com/policies/community-standards/inauthentic-behavior/>.
- 13 Roth, Y., & Achuthan, A. (2020, February 4). Building rules in public: Our approach to synthetic & manipulated media. Twitter Blog. Retrieved June 21, 2023, from https://blog.twitter.com/en_us/topics/company/2020/new-approach-to-synthetic-and-manipulated-media.
- 14 The MJ Lab. (2023, April 22). Michael Jackson - Circus (Feat. Britney Spears) (A.I.). YouTube. Retrieved June 21, 2023, from <https://www.youtube.com/watch?v=CbavFTSgOaU>.
- 15 Post, R. C., & Rothman, J. E. (2020, October). The First Amendment and the Right(s) of Publicity. The Yale Law Journal, 130(1), 86-172. <https://www.yalelawjournal.org/article/the-first-amendment-and-the-rights-of-publicity> ("Courts have disagreed about the circumstances under which the First Amendment protects the use of well-known persons' identities[.]")
- 16 Federal Trade Commission. (n.d.). Endorsements, Influencers, and Reviews. Federal Trade Commission. Retrieved June 21, 2023, from <https://www.ftc.gov/business-guidance/advertising-marketing/endorsements-influencers-reviews>.

Drawings in Patent Applications – Are the Requirements Overly Broad?

By Fulchand P. Shende and Joseph P. Carrier

Overview

In the U.S., an application for patent must contain a full and clear disclosure of the invention.¹ This requirement is generally satisfied by submission of a specification, including: title, abstract, claims, and drawings, where necessary. The specification is required to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains to make and use the invention.² With regard to the drawings, an applicant must furnish a drawing where necessary for the understanding of the subject matter to be patented.³ The drawing in a nonprovisional application must show every feature of the invention specified in the claims.⁴ Any structural detail that is of sufficient importance to be described should be shown in the drawing.^{5,6} The basic form and content of U.S. patents, which begin with illustrative drawings and end with claims, have changed very little since 1904.⁷ Although illustrative drawings help one interpret the patent claims by showing the invention as a real-world object,⁸ the drawings statutes and rules, 35 USC §113 and 37 CFR §§1.81 and 1.83 (a), may be overly broad.

Introduction

Title 35 of the United States Code (U.S.C.) is dedicated to patents.⁹ Title 35 is one of the 53 titles passed by the United States Congress – the legislative branch of the Federal Government. Section 113 of the 35 U.S.C. entitled, “Drawings” promulgates drawing requirements for application for a patent.¹⁰

Title 37, one of the 50 titles of the Code of Federal Regulations (CFR), is dedicated to Patents, Trademarks, and Copyrights. The CFR is the codification of the general and permanent rules published in the Federal Register by departments and agencies – the executive branch of the Federal Government. Agencies, such as the United States Patent and Trademark Office (USPTO), have authority delegated by Congress to create or promulgate regulations, codified in the CFR. 37 CFR §§ 1.81 and 1.83 provide procedural guidance on the requirements and contents of drawings for a nonprovisional application for a patent. The requirements in 37 CFR §§ 1.81 and 1.83 are framed with the primary goal of structuring the patent examination process to facilitate accurate and efficient assessment of claim patentability.¹¹ Nonetheless, these rules no doubt have some incidental effect

on the substance of applicants’ patent rights.¹² This paper attempts to explore whether the provisions 35 U.S.C. §113 and 37 CFR §§ 1.81 and 1.83 are overly broad, and concludes that they are broad.

The Statutes and Rules

A single statute, 35 U.S.C. §113, and two codified rules, 37 CFR §§1.81 and 1.83, provide the framework for the drawing requirements in a nonprovisional application for a patent.

35 U.S.C. §113

35 U.S.C. §113 states:

§113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.¹³

37 CFR §1.81

37 CFR §1.81 states:

1.81 Drawings required in patent application.

(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. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for

example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.¹⁴

It may be noted that some of the provisions of the 37 CFR 1.81 are similar to that of 35 U.S.C. §113.

37 CFR §1.83

37 CFR §1.83 states:

1.83 Content of drawing.

(a) The drawing in a nonprovisional 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). In addition, tables that are included in the specification and sequences that are included in sequence listings should not be duplicated in the drawings.

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration

within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).¹⁵

Features in Claims

A patent claim may include both structural and functional features. Thus, a patent applicant is free to recite features of an apparatus either structurally or functionally.¹⁶ A claim feature is structural when it recites a structure, a part, an ingredient, or an arrangement. A claim feature is functional when it recites a feature “by what it does rather than by what it is.”¹⁷

A functional feature is often used in association with a structural element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.¹⁸ Claims including functional terms are generally drafted by reciting a structure followed by its function.¹⁹ An often used claim term “operatively connected” is intended as “a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components.”²⁰ That is, the term “means the claimed components must be connected in a way to perform a designated function.”

Moreover, there is nothing inherently wrong with defining some part of an invention in functional terms.²¹ Functional language does not, in and of itself, render a claim improper.²² Functional claiming language incorporating means-plus-function claim features is proper and expressly authorized.^{23, 24} Functional language may also be employed to limit the claims without using the means-plus-function format. In patent applications involving complex technologies, claims are often drafted to include functional terms. It is generally difficult to present functional features in a drawing. The governing statutes and rules are silent about functional features.

Patent Prosecution – Objection to the Drawings

After meticulously preparing a patent application, a common issue patent practitioners may face during patent prosecution is objection to the drawings. Disputes regarding objections to the drawings are petitionable.²⁵ However, the Patent Trial and Appeal Board has jurisdiction over an appellant seeking review of the Examiner’s decision to reject claims and object to the drawings on the basis that the later submitted drawings contain new matter.²⁶

Under MPEP § 608.02(d) entitled, “Complete Illustration in Drawings,” there are mainly three types of objections to the drawings the patent Examiner may make –

- (1) Drawings Objected To, Details Not Shown
- The drawings are objected to under 37 CFR

1.83(a) because they fail to show an “x” structural feature as described in the specification;

(2) Drawings Objected to, Incomplete - The drawings are objected to under 37 CFR 1.83(b) because they are incomplete; and

(3) Drawings Do Not Show Claimed Subject Matter - The drawings are objected to under 37 CFR 1.83(a); the drawings must show every feature of the invention specified in the claims.²⁷

Discussion of Some Relevant Cases

The MPEP cites only one case – more than a century old – from 1911 with regard to complete illustrations in drawings.²⁸ In *Ex parte Good*, the court ruled that “Any structural detail that is of sufficient importance to be described and claimed should be shown in the drawing.”²⁹ In this case, requirement for the submission of a corrected drawing was held proper upon determination that it was very desirable that the drawings be so clearly and artistically executed as to facilitate the ready understanding of the invention.³⁰ It is great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation.³¹

The language of *Ex parte Good* is inconsistent with the requirement that “The drawing in a nonprovisional applica-

tion must show every feature of the invention specified in the claims” of 37 CFR §1.83. The language used in *Ex parte Good* is “should” – expressing advice, rather than a requirement. In contrast, the language in 37 CFR §1.83 is “must” – expressing a requirement. Further, *Ex parte Good* specifies “structural detail,” which may be construed as ‘a structural feature,’ but fails to mention any ‘functional feature.’ 37 CFR §1.83 recites ‘every feature,’ but does not clarify whether this refers to both structural features and functional features, or only structural features.

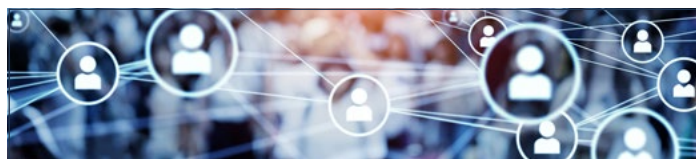
Thus, it is incumbent upon the USPTO to provide comprehensive guidance on the phrase ‘every feature’ of 37 CFR §1.83.

However, it has also been ruled that 37 CFR §1.83 does not require drawings illustrating every possible embodiment encompassed by the scope of the claims.³² If that were so, patents would soon become massive.³³ Further, drawings in a patent application need not illustrate the full scope of the invention.³⁴ On the other hand, 37 CFR 1.83(a) states, “The drawing in a nonprovisional application must show every feature of the invention specified in the claims.” Also, such language may mistakenly lead to the interpretation that every feature in a claim must be shown in a single drawing, although there is no such requirement. Moreover, in case of a restriction requirement (applicant’s election to one invention where more than one is present in the application), an argument that the non-elected invention(s) figure drawings cannot be used to satisfy 37 CFR §1.83(a) requirement is futile. The phrase “the drawing” as stated in 37 CFR §1.83(a) must refer to a plural of drawings based on the interpretation of 37 CFR §1.83(c).

On the other hand, it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.³⁵ At the same time, it does not mean that things patent drawings clearly show are to be disregarded.³⁶ A drawing teaches all that it reasonably discloses and suggests to a person of ordinary skill in the art.³⁷

The Drawings Requirements are Overly Broad

35 USC §113 does not limit the USPTO Director’s discretion in cases where the subject matter admits of illustration, even though a drawing is not necessary for the understanding of the subject matter.³⁸ Moreover, ignoring the discretionary nature of the statute, the USPTO has adopted an absolute requirement in 37 CFR §1.81 which states “Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the



Social Media

Don't forget to join the *State Bar of Michigan Intellectual Property Law Section* LinkedIn group and join the conversation! Our LinkedIn group is open to all attorneys as a means for our IP community to engage with one another on issues relevant to the IP profession. We hope that each of you take advantage of this great opportunity to connect with the Michigan IP community and support IPLS in furtherance of our mission to provide IP education to our members and the greater Michigan community.

**To join our LinkedIn Group, go to:
<https://www.linkedin.com/groups/12646050/>**



examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.”³⁹

In addition, with regard to drawing content, 37 CFR §1.83 in part states: “The drawing in a nonprovisional application must show every feature of the invention specified in the claims...” This requirement is of exacting nature and requires submission of drawings even when not useful, and in some cases, not even necessary for a person of ordinary skill in the art to understand the claimed feature. This begs the question: why must all claimed features be shown in the drawing?

37 CFR §§ 1.81 and 1.83 have created overly broad drawing requirements. The USPTO requires drawings unless the subject matter does not admit of illustration and the content must extend well beyond what is required for an understanding of the invention.⁴⁰ The rules in 37 CFR §§ 1.81 and 1.83 have formed a policy to require drawings and require that such drawings have a certain scope, without regard to whether such drawings are necessary or even useful.⁴¹ There can be four scenarios for drawing requirements – necessary and useful, necessary but not useful, not necessary but useful, and not necessary and not useful.


Accordingly, the USPTO should mandate submission of drawings only when they are necessary and also useful in order to ease the burden on applicants.

In some situations, drawings could be useful, but not necessary. For instance, a representative figure for the front page of an issued patent could aid searching, and for that reason may be useful, but not necessary.⁴² In such situations, the 37 CFR §§ 1.81 and 1.83 should be revised.

Also, in an application where claims directed to the configuration of an item having left and right sides and there is a single drawing figure of the left side and the specification indicates that the right side is a mirror image,⁴³ then the submission of additional drawings to show the right side or both sides of an item would be not necessary and not useful. Also, the USPTO should provide guidance on the drawings when useful and necessary, and when not useful and not necessary. The submission of drawings which are other than necessary and useful – i.e., drawings which are necessary but not useful, not necessary but useful, and not necessary and not useful – should not be required.

Conclusion

The provisions 35 U.S.C. §113 and 37 CFR §§ 1.81 and 1.83 are overly broad. Both 37 CFR §§1.81 and 1.83 entirely disregard the notion of usefulness of the drawings requirement, and unduly place a burden on applicants. The USPTO should provide further guidance on usefulness and necessity of the drawings, and should revise 37 CFR §§1.81

and 1.83 to spell out that submission of only necessary and useful drawings is required. 



About the Authors

Fulchand P. Shende is a partner at Carrier, Shende and Associates, PC. He represents clients in matters involving domestic and foreign patent prosecution in electromechanical arts including automotives, mobility services, electro-mechanical systems, autonomous vehicles and trademark prosecution. He received his Ph.D.

for his thesis on Engineering Mechanics Applications from Queen's University, Canada, and his J.D. from the Wayne State University School of Law.



Joseph P. Carrier is a Managing Partner at Carrier, Shende and Associates, PC. He began his career in intellectual property as a Patent Examiner in 1983 at the United States Patent and Trademark Office, where he worked for two years. He represents clients in matters involving intellectual property in mechanical and chemical arts, counsels clients on patent strategy, trademark procurement and trade secrets

counseling and litigation. He received his B.S. in Chemical Engineering from University of Detroit Mercy and his J.D. from the Wayne State University School of Law.

The opinions or views expressed in this publication are those of authors. They do not purport to reflect the opinions and views of Carrier, Shende and Associates, PC, or its members.

Endnotes


- 1 35 U.S.C. §112(a).
- 2 *Id.*
- 3 35 USC §113.
- 4 37 CFR §1.83 (a).
- 5 MPEP § 608.02(d).
- 6 *Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911).
- 7 Enhancing Patent Disclosure For Faithful Claim Construction, 9 Lewis & Clark L. Rev. 177, 180-181
- 8 *Id.*
- 9 U.S. Code: Title 35.
- 10 35 U.S.C. §113.
- 11 The Proven Key: Roles And Rules For Dictionaries At The Patent Office And The Courts, 54 Am. U.L. Rev. 829, 890-891.

- 12 *Id.*
- 13 35 U.S.C. §113.
- 14 37 CFR 1.81 (2022).
- 15 37 CFR §1.83.
- 16 *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).
- 17 *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 229 (CCPA 1971).
- 18 *In Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004).
- 19 *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).
- 20 *In Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004).
- 21 *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).
- 22 *Id.*
- 23 35 U.S.C. §112(f).
- 24 MPEP § 2181.
- 25 MPEP § 706.01.
- 26 35 U.S.C. § 6(b).
- 27 MPEP § 608.02(d).
- 28 *Id.*
- 29 *Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911).
- 30 *Id.*
- 31 *Ex parte Sturtevant*, C.D. 1904, 26; 108 O.G., 563.
- 32 *Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc.*, 2005 U.S. Dist. LEXIS 48751, *132, 2005 WL 6309276.
- 33 *Id.*
- 34 *Arlington Industries, Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1254 (Fed. Cir. 2011).
- 35 *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000).
- 36 *In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972).
- 37 *In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979); *In re Wright*, 471 F.3d 1264 (Fed. Cir. 2006).
- 38 Article: Ten Things That Should Be Changed About Patent Law, 86 J. Pat. & Trademark Off. Soc'y 959, 961-962
- 39 *Id.*
- 40 *Id.*
- 41 *Id.*
- 42 *Id.*
- 43 *Id.*

Launch of the USPTO's New Patents for Humanity Green Energy Competition

Launched in February 2012, the USPTO's Patents for Humanity Award was recently codified into law when President Biden signed the Patents for Humanity Act of 2022. It is the USPTO's top honor for patent applicants devising game-changing innovations to address long-standing development challenges. Their success stories can inspire others to harness innovation for human progress.

This year, the Patents for Humanity Awards will focus on innovations that address the challenges of climate change through green energy innovations, including wind, solar, hydrogen, hydropower, geothermal, and biofuels technologies. Winners of this year's program will receive a certificate to accelerate USPTO processing for one eligible matter (such as an ex parte reexamination proceeding or a patent application), as well as public recognition of their work. Under the Patents for Humanity Program Improvement Act, award winners may transfer their acceleration certificates to third parties, including for compensation, and can leverage the acceleration certificate to obtain funds.

The deadline for submission is September 15, 2023. To apply and obtain additional information, go to [Patents for Humanity: Green Energy | USPTO](#). 

Call for Authors

Are you interested in writing for IPLS Proceedings? IPLS welcomes members from our IP community to submit articles for future publications of IPLS Proceedings.

If interested, please contact LeKeisha Suggs (lekeisha.suggs@schaeffler.com).