

the American Inventors Protection Act of 1999, 1233 Off. Gaz. Pat. Office 54 (Apr. 11, 2000)) and MPEP § 706.02(l)(1). Additionally, the first sentence of § 1.78(c) is proposed to be amended by changing the word "party" to "person" in order to use terminology consistent with 35 U.S.C. 103(c).

Section 1.83: Section 1.83(a) is proposed to be amended to provide that tables and sequence listings that are in the specification are not permitted to also be included in the drawings. Applicants should not be obliged to include tables or the sequence listing in the drawings due to the current requirement of § 1.83(a) that all claimed features must be shown in the drawings. Under the proposed amendment, if the specification includes a sequence listing or a table, such a sequence listing or table would not be permitted to be repeated in the drawings.

See § 1.58(a) for a similar proposed change to require that tables be included in only one of the drawings and the specification.

Section 1.84: Section 1.84 is proposed to be amended by revising § 1.84(a)(2)(iii) to remove the requirement for submission of a black and white copy of any color drawings or photographs. Section 1.84(a)(2)(iv) is proposed to be amended to become (a)(2)(iii). Section 1.84(c) is proposed to be amended to clarify that identification (labeling) of the drawings is recommended, but not required, and to change the recommended location of any identification of the drawings.

Section 1.84(a)(2) is proposed to be amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 Off. Gaz. Pat. Office 106 (May 22, 2001).

Section 1.84(c) is proposed to be amended to remove the requirement that the identification of drawings must be placed on the front of each sheet of drawing, if the information is provided. The Office prefers that the identification of drawings be placed on the front of each sheet of drawing so that photocopies and scanned images of the drawings will be properly identified with the application. The Office has new scanners that will endorse in the top margin starting 3.5 inch from the right edge and ending 1 inch from the right edge of the paper. Therefore, applicants are strongly encouraged to place the information on the front of each sheet, to the left of the center on

the top margin so that the identification does not overlap the endorsement, and so that the identification will be included in any photocopies of the drawings. The Office, however, recognizes that some applications have long titles or identification that could not be placed completely on the front within the top margin. In such a situation, the identification of drawings may be placed on the back of each sheet (understanding that the backs of drawing sheets will not be scanned), but placing part of the identification (e.g., the application number and the first inventor's name) on the front is recommended. If the identification of drawings is placed on the front of each sheet, the identification must be placed to the left of center within the top margin.

Section 1.91: Section 1.91 is proposed to be amended to add a paragraph (c), which provides that a model or exhibit must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84. Material features are considered to be those features which represent that portion(s) of the model or exhibit forming the basis for which the model or exhibit has been submitted. Since the Office generally returns or otherwise disposes of models or exhibits when they are no longer necessary for the conduct of business before the Office (§ 1.94), such photographs are necessary for the file of the application or proceeding to contain an adequate record of the model or exhibit submitted to the Office. Section 1.91(c) would also provide that this requirement does not apply if the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding.

In applications where the exhibit is not intended to display the medium of submission (e.g., video tapes, DVDs, and compact discs) but the content of the submission, the requirement that the photographs be of the substantive content is included in this paragraph. Video tapes, DVDs, and compact discs are usually submitted with movies or multimedia images. The requirement that the photographs submitted should show the material features that were being exhibited is intended to require that the photograph be that of the content of the material, not a photograph of the medium of submission. Hence, if video or multimedia submission is contained on

a tape or disc, the corresponding photograph should be a still image single frame of a movie, and not a submission of a photograph of a video cassette, DVD disc or compact disc.

A video or DVD is not the type of model or exhibit that would substantially conform to the requirements of §§ 1.52 or 1.84. The Office does not intend to store bulky items, such as videos, particularly as the Office is moving toward an Image File Wrapper. See *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 38611 (June 30, 2003). Accordingly, where a video or DVD or similar item is submitted as a model or exhibit, the requirement of § 1.91(c) for supplying photographs of what is depicted in the video or DVD, pursuant to § 1.84, would need to be met.

The Office is interested in comments as to whether the requirement for supplying photographs, particularly for a video or DVD, is overly broad and an adequate description could be presented by some other type of description, such as a written statement.

Section 1.94: Section 1.94 is proposed to be amended to be divided into paragraphs (a) through (c). Paragraph (a) provides that once notification is sent to applicant, arrangements must be made by applicant for the return of the model, exhibit, or specimen at applicant's expense, in response to such notification. Where the model, exhibit or specimen is a perishable, it will be presumed that the Office has permission to dispose of the item without notice to applicant, unless applicant notifies the Office upon submission of the item that a return is desired and arrangements are promptly made for its return upon notification by the Office.

Paragraph (b) provides that applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. Section 1.94 would also provide that its provisions do not apply: (1) If the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding; (2) where a model, exhibit, or specimen has been described by photographs that conform to § 1.84, or (3) where the model, exhibit, or specimen is a perishable.

Paragraph (c) provides that the notification to applicant will set a period of time within which applicant must make arrangements for a return of a model, exhibit, or specimen, with