

Jay Yin and David O'Dell Author Bloomberg Law Column: Using Unscaled Drawings as Patent Prior Art

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It is important to understand what does, and does not, constitute prior art for a patent— both during patent prosecution and after the patent has issued. It is well known that drawings may serve as prior art in anticipating or rendering obvious claims. Judge Learned Hand in a 1928 patent infringement case reasoned, “[w]e know of no rule that figures can never of themselves be an adequate anticipation of mechanical inventions.” *Jockmus v. Leviton*, [28 F.2d 812, 815](#) (2d Cir. 1928). Subsequent cases take this rule even further, holding that an accidental or an unintentional disclosure, such as a mistake, in a drawing is available as prior art as long as the drawing is clear. See *In re Bager*, [47 F.2d 951, 954](#) (Cust. Ct. 1931).

However, the use of drawings as prior art is not without bounds, and this is particularly important when issues of scale, or even relative dimensions, are in question—e.g., whether one item is larger than another item. With respect to patent drawings that are not described as being drawn to scale, the U.S. Court of Appeals for the Federal Circuit cautioned that these “may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt v. Avia Group Int'l*, [222 F.3d 951, 957](#) (Fed. Cir. 2000). While *Hockerson* does not prevent unscaled drawings from serving as prior art, it nevertheless creates hurdles for patent challengers or examiners who seek to rely on unscaled drawings to disclose relative dimensions or positions.

This article discusses three circumstances where an unscaled drawing can legally qualify as a prior art in providing dimensional or positional disclosure. Although different tribunals have taken different approaches, there appears a sliding scale between the particularity of the challenged claim limitation and sufficiency of the disclosure.

Excerpted from *Bloomberg Law*. To read the full article, click [here](#).