

# **Prosecution Tips and Traps for Patent Applications Examined under the AIA**

Kathleen K. Fonda

Senior Legal Advisor

USPTO Office of Patent Legal Administration

Biotech/Chem/Pharma Customer Partnership Meeting

November 6, 2017

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Topics for Discussion

- Filing issues. What could go wrong?
- Invoking exceptions to prior art.

# Naming the Inventor

The inventor (i.e., the entire inventive entity) must be named when the application is filed, even if the inventor is not the applicant. The inventor may be named by submitting either:

- a signed ADS that names the entire inventive entity and is filed before or with one or more executed oaths or declarations under 37 CFR 1.63; or
- an executed oath or declaration under 37 CFR 1.63 that names the entire inventive entity.

## **Oath or Declaration under 37 CFR 1.63: Time of Submission**

- Applicants should continue to exercise reasonable diligence in determining who is the actual inventor.
- The Office recommends that applicants provide the oath or declaration on filing or shortly thereafter. The longer the delay, the more difficult it may be to obtain the signatures of all of the joint inventors.
- A substitute statement in lieu of the oath or declaration (37 CFR 1.64) may only be filed if a joint inventor is deceased, is legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute an oath or declaration.

# When Should an ADS Be Used?

- An ADS is required (except for national stage applications under 35 U.S.C. 371) when:
  - there is a claim for domestic benefit;
  - there is a claim for foreign priority; or
  - the applicant is the assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest in the invention.

Benefit or priority claims in the oath or declaration, or in the first paragraph of the specification, will not be recognized.

- An ADS is permitted in any provisional or nonprovisional application under 35 U.S.C. 111, and in any national stage application under 35 U.S.C. 371.

# Correcting or Updating Information After an Application Has Been Filed

- Submit an ADS to correct or update information after filing.
  - Such an ADS is no longer termed a “Supplemental ADS.”
  - It is permitted to include only those sections containing changed or updated information (37 CFR 1.76(c)(2)).
- Regardless of whether any ADS had previously been submitted, an ADS submitted after filing must indicate the information to be corrected or updated, using underlining for insertions and strike-through or brackets for deletions.
- Changes should be made relative to the most recent filing receipt.

# An ADS May be Used to Make a Required Statement under 37 CFR 1.55 or 1.78

|  |                        |  |
|--|------------------------|--|
| <small>PTO/AIA/14 (03-13)<br/>Approved for use through 01/31/2014. OMB 0651-0032<br/>U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE</small>                 |                        |  |
| <small>Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.</small> |                        |  |
| <b>Application Data Sheet 37 CFR 1.76</b>  | Attorney Docket Number |  |
|  | Application Number     |  |
| Title of Invention   |                        |  |

**Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications**

This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

# **Text of the 1.55/1.78 Statement As Provided on the ADS**

This application

- (1) claims priority to or the benefit of an application filed before March 16, 2013 and
- (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

**NOTE:** By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

# What Is a Transition Application?

- Transition applications are nonprovisional applications that are:
  - filed on or after March 16, 2013; and
  - claim foreign priority to, or domestic benefit of, an application filed before March 16, 2013.
- Transition applications may be either pre-AIA first-to-invent applications or AIA first-inventor-to-file applications depending on the effective filing date of the claims in the application.

# Only AIA First-Inventor-to-File Transition Applications Require a 1.55/1.78 Statement



## **Pre-AIA First-to-Invent transition application**

Only ever contains claimed inventions that have an effective filing date **before** March 16, 2013

**1.55/1.78 Statement  
NOT REQUIRED**

## **AIA First-Inventor-to-File transition application**

Contains or ever contained **any** claim that has an effective filing date that is **on or after** March 16, 2013

and/or  
is ever a CON, DIV, or CIP of an AIA application

**1.55/1.78 Statement  
REQUIRED**

# New Matter and 1.55/1.78 Statements

- An amendment submitted after the filing date that adds new matter to a pre-AIA (FTI) application would not convert the application into an AIA (FITF) application. Such an amendment would violate 35 U.S.C. 112(a) and/or 35 U.S.C. 132(a).
- If a transition application would otherwise be a pre-AIA (FTI) application, but a preliminary amendment submitted on the actual filing date adds previously unsupported subject matter to the claims, the application will be an AIA (FITF) application.

# Tips for 1.55/1.78 Statements

- Consider carefully whether your application requires a 1.55/1.78 statement.
- Making the statement when it is not appropriate, or vice versa, could cause an application to be examined under the wrong statutory framework.
- Do NOT make the 1.55/1.78 statement in transition applications that are proper CONs or DIVs of a parent application filed prior to March 16, 2013. Such transition applications should not be examined under the first-inventor-to-file provisions of the AIA.

# Correcting Missing 1.55/1.78 Statements

- An applicant should file a 1.55/1.78 statement as soon as the applicant becomes aware that the statement was needed and unintentionally overlooked in order to make sure that the application will be examined under the correct statutory framework.
- If the application has been allowed and the issue fee paid before applicant files the 1.55/1.78 statement, the applicant may have to withdraw the application from issue and file an RCE in order for the 1.55/1.78 statement to be considered, and the application examined under the correct statutory framework.

# Rescinding 1.55/1.78 Statements Made in Error

- If an applicant erroneously submits a statement under 37 CFR 1.55 or 1.78, the applicant should file a separate paper to rescind the statement.
- When filing the rescission electronically, applicant should select the document description "Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmtnt " to properly index the paper.

## 1.55/1.78 Statement Error in Issued Patent

- If an application has issued as a patent, reissue will be needed if there was a 1.55/1.78 statement error and applicant wishes to have the claims examined under a different statutory scheme.
- By itself, a 1.55/1.78 statement error is not grounds for reissue. However, applicant may be able to add a dependent claim and assert that the patent covers less than applicant was entitled to claim.

# AIA Statutory Framework

| <b>Prior Art</b><br><b>35 U.S.C. 102(a)</b><br>(Basis for Rejection)  | <b>Exceptions</b><br><b>35 U.S.C. 102(b)</b><br>(Not Basis for Rejection) |  |
|---|---|--|
| <b>102(a)(1)</b><br>Disclosure with Prior<br>Public Availability Date   | <b>102(b)(1)</b>  | <b>(A)</b><br>Grace Period Disclosure by Inventor or<br>Obtained from Inventor |
|   |   | <b>(B)</b><br>Grace Period Intervening Disclosure by<br>Third Party            |
| <b>102(a)(2)</b><br>U.S. Patent,<br>Published U.S. Patent<br>Application, and<br>Published PCT<br>Application with Prior<br>Filing Date | <b>102(b)(2)</b>  | <b>(A)</b><br>Disclosure Obtained from Inventor                                |
|   |   | <b>(B)</b><br>Intervening Disclosure by Third Party                            |
|   |   | <b>(C)</b><br>Commonly Owned Disclosures                                       |

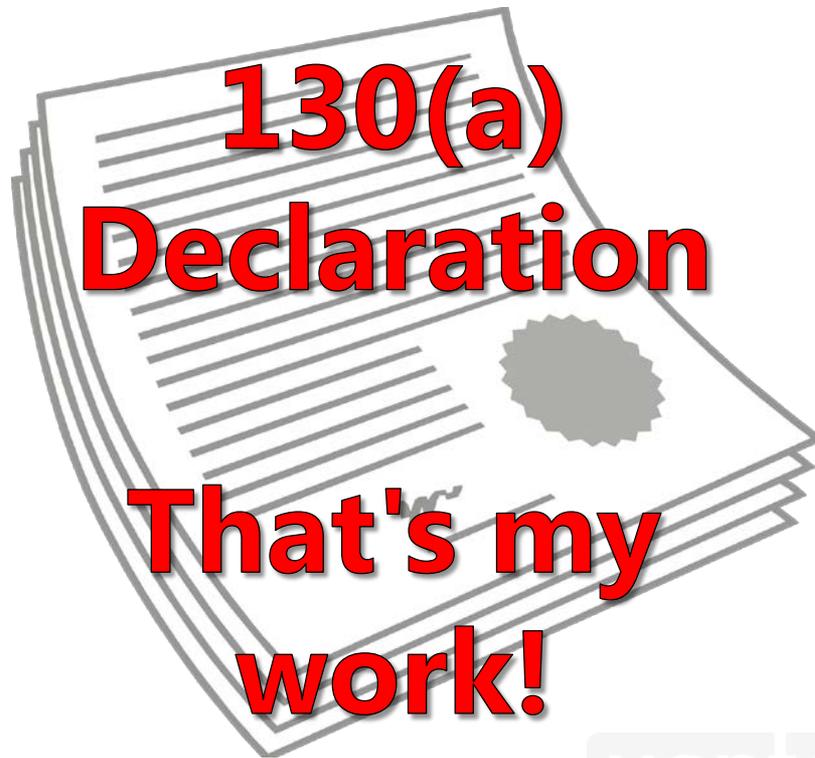
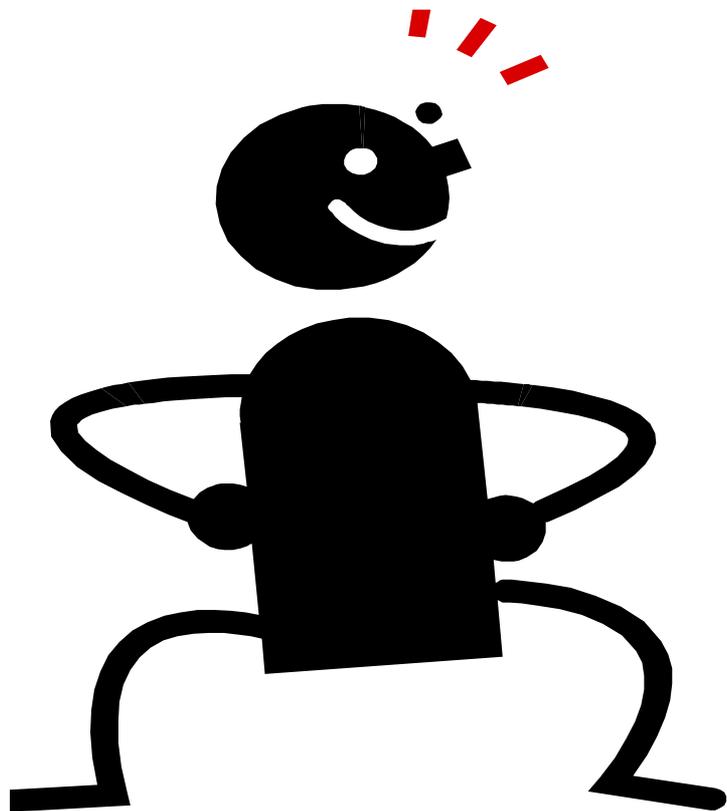


# Summary of New Regulation 37 CFR 1.130

- Revised 37 CFR 1.130 (aka rule 130) applies only to AIA(FITF) cases.\*
- Rule 130(a) provides for a declaration of attribution, and is a way to invoke the 102(b)(1)(A) or 102(b)(2)(A) exception.
- Rule 130(b) provides for a declaration of prior public disclosure, and is a way to invoke the 102(b)(1)(B) or 102(b)(2)(B) exception.
- Although the term "declaration" is used in this presentation, rule 130 applies to affidavits as well. These two types of evidence differ as to formalities, but not as to substantive requirements.
- The 102(b)(2)(C) exception does not require a declaration. A statement on the record regarding either common ownership in accordance with 102(b)(2)(C) or a joint research agreement in accordance with 102(c) is sufficient.

\*The common ownership provisions of pre-AIA 37 CFR 1.130 have been relocated to 37 CFR 1.131(c).

# Declarations under 37 CFR 1.130(a) for 102(b)(1)(A) and 102(b)(2)(A) Exceptions



# Evaluating Rule 130(a) Declarations of Attribution

- When considered together with other evidence of record, a rule 130(a) declaration must show sufficient facts, in weight and character, to establish that the potential prior art disclosure is **an inventor-originated disclosure**.

If the declaration provides both

1. an unequivocal statement from one or more joint inventors that he/she/they invented the potential prior art subject matter, and
2. a reasonable explanation of the presence of additional authors/inventors of the potential prior art subject matter then it will generally be acceptable unless there is evidence to the contrary.

(See MPEP 717.01(a)(1))

- It is not necessary to show that the inventor-originated disclosure was an enabling disclosure within the meaning of 35 U.S.C. 112(a). See MPEP 717.01(a)(1) and 2155.04.

## **Situations Where the Record Is Clear and No 130(a) Declaration is Needed: 102(a)(1)**

A rejection should not be made based on a 102(a)(1) disclosure during the grace period (or if made should be withdrawn without requiring a declaration), if:

- the disclosure is by one or more joint inventor(s) or the entire inventive entity of the application under examination and does not name anyone else,

OR

- the specification of the application under examination, as filed, identifies the disclosure as being an inventor-originated disclosure in accordance with 37 CFR 1.77(b)(6).

## **Situations Where the Record Is Clear and No 130(a) Declaration is Needed: 102(a)(2)**

A rejection should not be made based on a 102(a)(2) disclosure (or if made should be withdrawn without requiring a declaration), if:

- the inventive entity of the disclosure only includes one or more joint inventor(s), but not the entire inventive entity, of the application under examination, and does not name anyone else,

OR

- the specification of the application under examination, as filed, identifies the disclosure as being an inventor-originated disclosure in accordance with 37 CFR 1.77(b)(6).

**Declarations under 37 CFR 1.130(b)  
for 102(b)(1)(B) and 102(b)(2)(B) Exceptions**



# Evaluating Rule 130(b) Declarations of Prior Public Disclosure

- When considered together with other evidence of record, a rule 130(b) declaration must show sufficient facts, in weight and character, to establish that the potential prior art subject matter disclosed was **previously publicly disclosed** in an inventor-originated disclosure.

The declaration must describe the subject matter disclosed with sufficient detail and particularity, provide the date of disclosure, and be accompanied by a copy of the disclosure if it was a printed publication.

See MPEP 717.01(b)(1).

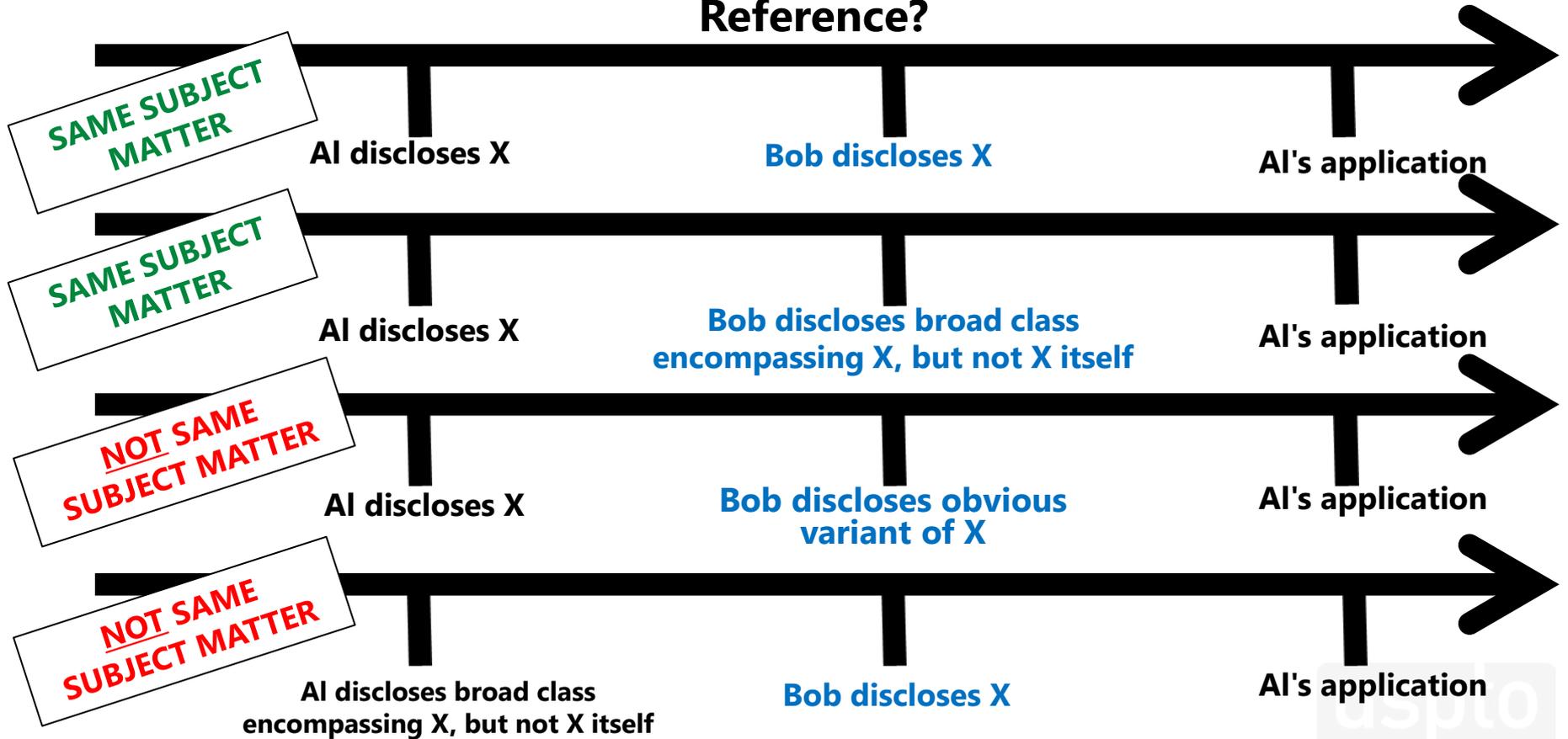
- It is not necessary to show that the inventor-originated disclosure was an enabling disclosure within the meaning of 35 U.S.C. 112(a). See MPEP 717.01(a)(1).

# Same "Subject Matter" Requirement for a 130(b) Declaration

- The 102(b)(1)(B) or 102(b)(2)(B) exception applies only when there has been a previous inventor-originated public disclosure of **the same subject matter** as that of a third party's potential prior art disclosure.
- If the third party's potential prior art disclosure (the intervening disclosure) is merely a more general description of the subject matter of the previous inventor-originated public disclosure, the inventor-originated disclosure is considered to have disclosed the same subject matter.
- Even if an intervening disclosure by a third party would have been obvious over an inventor-originated prior public disclosure, it would not be a disclosure of the same subject matter, and the exceptions under 35 U.S.C. 102(b)(1)(B) and 102(b)(2)(B) would not apply.

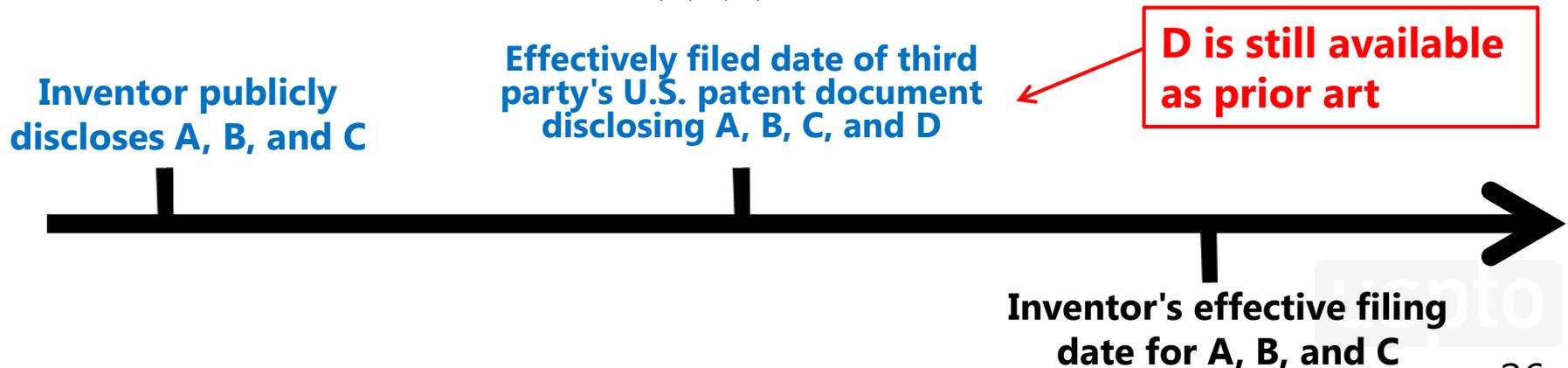
See MPEP 717.01(b)(2).

# Evaluating 130(b) Declarations: Is the Inventor's Previous Disclosure the Same "Subject Matter" As the Intervening Reference?



## Example: It Is Possible for Only a Portion of a Third Party's Disclosure to Be Disqualified as Prior Art

- The inventor publicly discloses and later claims A, B, and C.
- A U.S. patent document to a third party, which was effectively filed before the inventor's effective filing date but after the inventor's public disclosure (i.e., an intervening reference), discloses A, B, C, and D.
- D, as disclosed in the U.S. patent document, is still available for use in an obviousness rejection because it qualifies as prior art under 35 U.S.C. 102(a)(2).



## **Significance of An Effective 130(a) or (b) Declaration**

- An effective 130(a) or (b) declaration disqualifies a disclosure (which may be just a portion of a reference) as prior art, either under 102(a)(1) or 102(a)(2), or both.

# **Significance of An Effective 130(a) or (b) Declaration (cont.)**

A disclosure that has been disqualified as prior art in view of an exception may still be used:

- in a non-statutory double patenting rejection when the disqualified disclosure is a U.S. patent or U.S. patent application publication and the patented or pending claims are not patentably distinct from the claims of the application under examination;
- in a statutory double patenting rejection under 35 U.S.C. 101 when the disqualified disclosure is a U.S. patent or U.S. patent application publication and the patented or pending claims are drawn to the same subject matter as the claims of the application under examination; and/or
- as evidence relevant to an inquiry concerning statutory subject matter under 35 U.S.C. 101, or enablement, written description, or definiteness under 35 U.S.C. 112.

## Decisions Made By a Primary Examiner

A primary examiner must sign an Office action that is responsive to a rule 130 declaration.

- A primary examiner decides whether a declaration is sufficient as to formal matters, including timeliness. If the applicant is unsatisfied with the examiner's decision, review is by way of a petition under 37 CFR 1.181, which is decided by the TC Director. See MPEP 717.01(e).
- A primary examiner decides whether a declaration is sufficient on the merits. If the applicant is unsatisfied with the examiner's decision, review is by way of appeal of a rejection to the PTAB. See MPEP 717.01(f).

# Acknowledging 130(b) Declarations



- The examiner must mark the 130(b) declaration acknowledgment checkbox and provide the date that a 130(b) declaration on the Office action forms (e.g., Office Action Summary, Notice of Allowability, Advisory, etc.).
- If the checkbox is properly marked and a U.S. patent eventually issues on the application, information about the 130(b) declaration will be printed on the face of the patent.
- Examiners and practitioners who find the patent during a future prior art search for another application will thereby be alerted to the existence of potential prior art having an earlier date than the patent itself.

# Acknowledging a 130(b) Declaration on the Office Action Summary

130(b)



I made it public first!

|                              |                                      |                                     |   |
|------------------------------|--------------------------------------|-------------------------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b><br>99/XXX,XXX | <b>Applicant(s)</b><br>SMITH ET AL. |   |
|                              | <b>Examiner</b><br>PAT N. LEGAL      | <b>Art Unit</b><br>1xxx             | <b>AIA (First Inventor to File) Status</b><br>Yes |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE [ ] MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

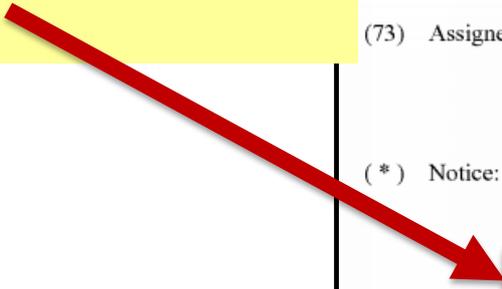
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on [ ]
- A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on [ ]
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on [ ]; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

# 130(b) Notice

Notice: Patent file contains an affidavit/declaration under 37 CFR 1.130(b).



|  |   |
|--|---|
| (12) <b>United States Patent</b><br><b>Park et al.</b>   | (10) <b>Patent No.:</b> <b>US 9,602,244 B2</b>  |
|  | (45) <b>Date of Patent:</b> <b>Mar. 21, 2017</b>  |
| (54) <b>LOW DENSITY PARITY CHECK ENCODER HAVING LENGTH OF 16200 AND CODE RATE OF 4/15, AND LOW DENSITY PARITY CHECK ENCODING METHOD USING THE SAME</b> | (52) <b>U.S. Cl.</b><br>CPC ..... <i>H04L 1/0057</i> (2013.01); <i>H03M 13/036</i> (2013.01); <i>H03M 13/1165</i> (2013.01); <i>H04L 1/0043</i> (2013.01)   |
| (71) Applicant: <b>Electronics and Telecommunications Research Institute, Daejeon (KR)</b>   | (58) <b>Field of Classification Search</b><br>CPC ..... H03M 13/1165; H03M 13/152; H03M 13/255; H03M 13/2906; H03M 13/036; H03M 13/616; G06F 11/107<br>See application file for complete search history.  |
| (72) Inventors: <b>Sung-Ik Park, Daejeon (KR); Heung-Mook Kim, Daejeon (KR); Sun-Hyoung Kwon, Daejeon (KR); Nam-Ho Hur, Daejeon (KR)</b>               | (56) <b>References Cited</b><br><br>U.S. PATENT DOCUMENTS<br><br>9,450,611 B2* 9/2016 Park ..... H03M 13/1177<br>9,479,289 B2* 10/2016 Park ..... H04L 1/0057<br>(Continued)<br><br>FOREIGN PATENT DOCUMENTS<br><br>KR 10-2007-0058438 A2 6/2007<br>KR 10-2013-0135746 A 12/2013<br>WO WO 2006/001666 A2 1/2006<br><br>OTHER PUBLICATIONS<br><br>Yiyan Wu et al., "Cloud Transmission: A New Spectrum-Reuse Friendly Digital Terrestrial Broadcasting Transmission System", IEEE Transactions on Broadcasting, Sep. 2012, pp. 329-337, vol. 58, No. 3.<br><br>(Continued) |
| (73) Assignee: <b>ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE, Daejeon (KR)</b>  |   |
| (*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 218 days.                             |   |
|  | <div style="border: 2px solid red; padding: 5px; display: inline-block;">Patent file contains an affidavit/declaration under 37 CFR 1.130(b).</div>   |
| (21) Appl. No.: <b>14/496,375</b>  |   |
| (22) Filed: <b>Sep. 25, 2014</b>   |   |

**EXAMPLES:**

**Declarations under 37 CFR 1.130**

# Important Lessons about Rule 130 Declarations

For all 130 declarations:

When a declaration states that a disclosure by another is an inventor-originated disclosure, it must be clear on the record of the application under examination that the subject matter in the disclosure was not only obtained from but also invented by a person named as an inventor in the application.

- A statement that the declarant is the inventor of the subject matter may be made in the rule 130 declaration itself.
- A rule 63 inventor's oath or declaration signed by the declarant and made of record in the application is also acceptable.
- An ADS naming the declarant as the inventor is not acceptable for this purpose.

## Important Lessons about Rule 130 Declarations (cont.)

For 130(a) declarations:

When an inventor is attributing a reference to him- or herself to invoke the 102(a)(1)(A) or 102(a)(2)(A) exception, and the reference names someone else in addition to the inventor, a reasonable explanation of the other person's involvement is required.

It is not necessary for the other person to provide a confirmatory statement or declaration.

**130(a)**



**That's my work!**

## Important Lessons about Rule 130 Declarations (cont.)

For 130(b) declarations:

In order for the 102(a)(1)(B) or 102(a)(2)(B) exception to apply, the inventor-originated prior public disclosure must have disclosed the same subject matter as the potential prior art disclosure.

Obviousness is not the standard for "same subject matter."

**130(b)**



**I made it  
public first!**

# Example 1: 130(a) Declaration to Invoke 102(b)(1)(A) Exception for Inventor-Originated Disclosure Within the Grace Period

130(a)



That's my work!

Al & Bob are authors of a journal article disclosing X



April 2, 2012

April 2, 2013  
Acme Corp. files U.S. application claiming X; Al named as inventor in signed ADS

Examiner rejects claim to X as anticipated under 102(a)(1) by the disclosure of X in the journal article by Al & Bob; no inventor's rule 63 oath/dec of record

**Applicant's Reply:** The attorney for Acme Corp. files a 130(a) declaration signed by Al averring that Al is the sole inventor of X as disclosed in the journal article. Al also explains in the declaration that Bob was a graduate student working under his direction and supervision, and that Bob did not contribute to the conception (i.e., Bob was not an inventor) of X.

**Question:** Is the declaration sufficient to disqualify the disclosure of X in Al and Bob's journal article as prior art?





# Example 1: 130(a) Declaration to Invoke 102(b)(1)(A) Exception for Inventor-Originated Disclosure Within the Grace Period (cont.)

**Answer:** Yes.

The declaration is sufficient to establish that the disclosure of X in the journal article is not prior art.

- Because AI avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- AI provides a reasonable explanation of Bob's involvement.
- There is no evidence in the record that contradicts the declaration. For example, the specification of the application under examination does not state that AI and Bob both invented X.

The examiner should use form paragraph 7.67.aia, and explain why the declaration is sufficient. A declaration from Bob stating that he did not invent X is not required. See *In re Katz*, 215 USPQ 14 (CCPA 1982) and MPEP 717.01(a)(1).

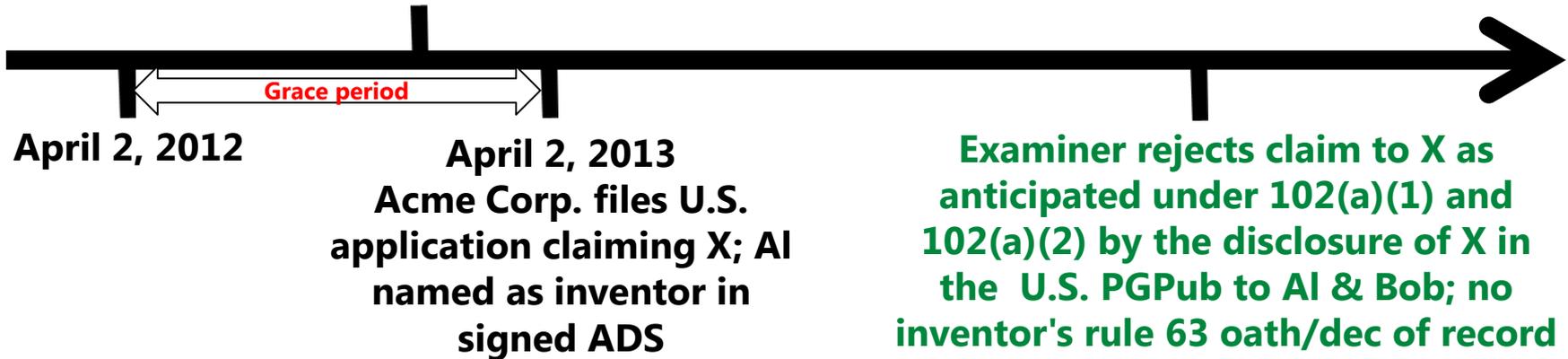
## Example 2: 130(a) Declaration to Invoke 102(b)(1)(A) and (b)(2)(A) Exceptions for Inventor-Originated Disclosure

130(a)



That's my work!

Publication date of Al & Bob's  
U.S. PGPub that claims X and Y



April 2, 2012

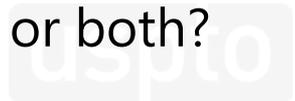
April 2, 2013

Acme Corp. files U.S.  
application claiming X; Al  
named as inventor in  
signed ADS

Examiner rejects claim to X as  
anticipated under 102(a)(1) and  
102(a)(2) by the disclosure of X in  
the U.S. PGPub to Al & Bob; no  
inventor's rule 63 oath/dec of record

**Applicant's Reply:** The attorney for Acme Corp. files a 130(a) declaration signed by Al averring that he invented X as disclosed in the U.S. PGPub.

**Question:** Is the declaration sufficient to disqualify the disclosure of X in Al and Bob's U.S. PGPub as prior art under 102(a)(1), 102(a)(2), or both?



## Example 2: 130(a) Declaration to Invoke 102(b)(1)(A) and (b)(2)(A) Exceptions for Inventor-Originated Disclosure (cont.)

130(a)



That's my work!

**Answer:** No, for both.

The 130(a) declaration is not sufficient to disqualify the disclosure of X in the PGPub as prior art under either 102(a)(1) or 102(a)(2).

- Because AI avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- However, it is not clear whether Bob, in addition to AI, is also a joint inventor of X. In other words, the declaration is consistent with the conclusion that Bob contributed to the conception of the invention.
- The declaration does not establish that Bob obtained his knowledge of X as disclosed in the U.S. PGPub from AI.

The examiner should use form paragraph 7.68.aia, and explain in the next Office action why the declaration is insufficient.

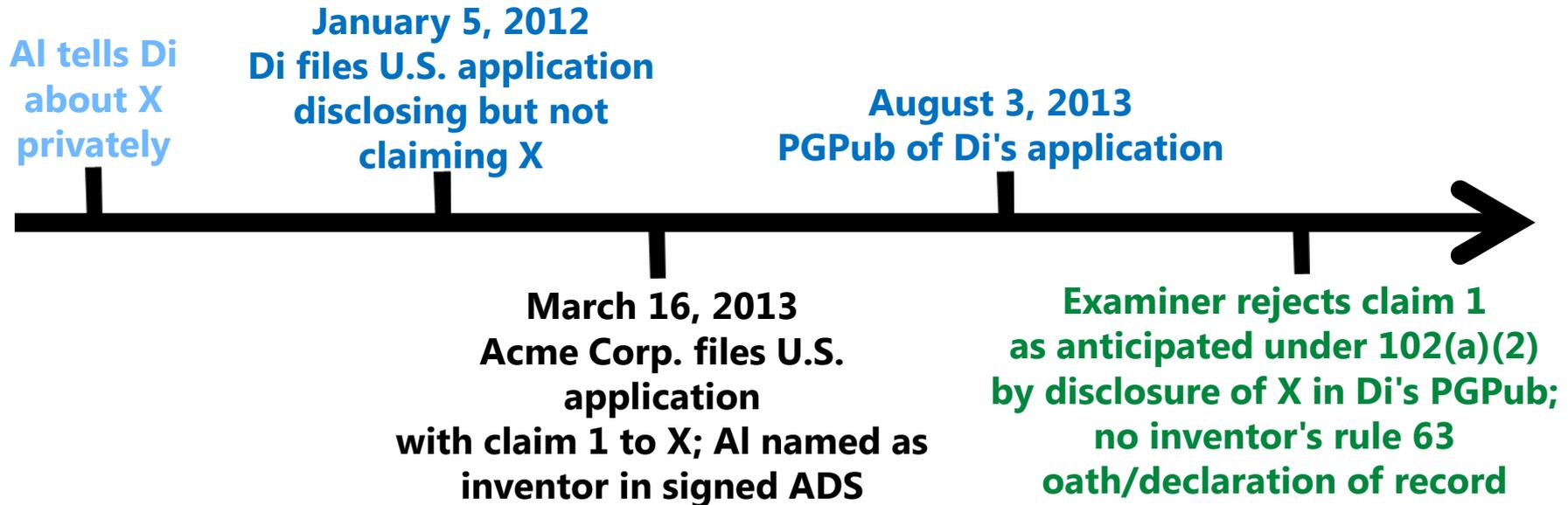


# Example 3: 130(a) Declaration to Invoke 102(b)(2)(A) Exception for Inventor-Originated Disclosure

130(a)



That's my work!



**Applicant's Reply:** The attorney for Acme Corp. files a 130(a) declaration that was signed by Al in which Al explains the circumstance under which he privately told Di about X (i.e., not a public disclosure) before Di's filing date. The declaration does not state that Al invented X.

**Question:** Is the declaration sufficient to disqualify the disclosure of X in Di's PGPub as prior art?

## Example 3: 130(a) Declaration to Invoke 102(b)(2)(A) Exception for Inventor-Originated Disclosure (cont.)

130(a)



That's my work!

**Answer:** No.

The 130(a) declaration is not sufficient to disqualify the disclosure of X in the PGPub as prior art.

- AI has not established that he invented X.
- It would be consistent with AI's declaration to conclude that AI learned of X from a third party and communicated it to Di. In that case, Di's PGPub would not be an inventor-originated disclosure.

An inventor-originated disclosure is a disclosure of subject matter that was invented by someone who is named as the inventor or a joint inventor in the application under examination.

The declaration would have been sufficient if an inventor's rule 63 oath/declaration signed by AI had been of record.

Alternatively, if Acme Corp.'s attorney had submitted a timely 130(a) declaration signed by AI averring that AI invented X as disclosed in the PGPub to Di, it would have been sufficient.

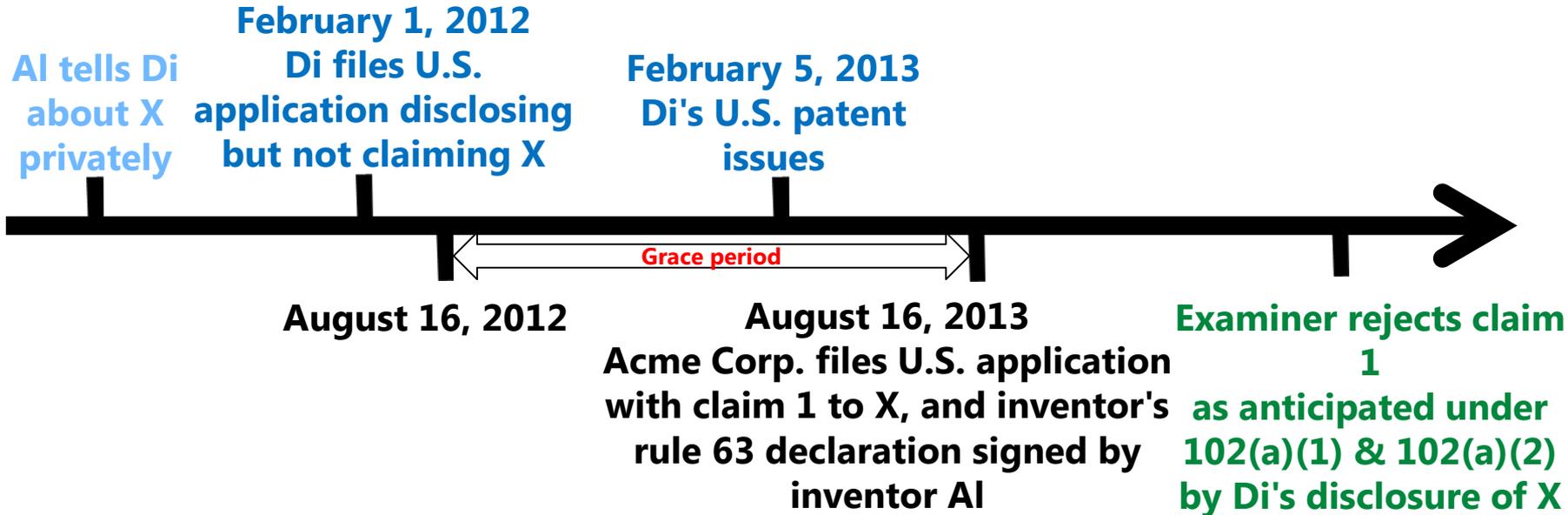
See *In re Facius*, 161 USPQ 294 (CCPA 1969) and MPEP 717.01(a)(1).

# Example 4: 130(a) Declaration to Invoke 102(b)(1)(A) and 102(b)(2)(A) Exceptions for Inventor-Originated Disclosure

130(a)

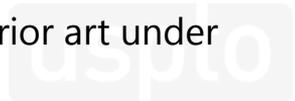


That's my work!



**Applicant's Reply:** The attorney for Acme Corp. files a 130(a) declaration signed by Di in which she explains the circumstances under which AI privately told her about X (i.e., not a public disclosure). The attorney also points out that an inventor's oath or declaration under 37 CFR 1.63 signed by inventor AI is already of record.

**Question:** Is the declaration sufficient to disqualify the disclosure of X in Di's patent as prior art under 102(a)(1) and 102(a)(2)?



## Example 4: 130(a) Declaration to Invoke 102(b)(1)(A) and 102(b)(2)(A) Exceptions for Inventor-Originated Disclosure

130(a)



That's my work!

(cont.)

**Answer:** Yes, for both.

The declaration is sufficient to disqualify the disclosure of X in Di's patent as both 102(a)(1) and 102(a)(2) prior art.

- The declaration establishes that Di learned about X from Al.
- Al's inventor's declaration under 37 CFR 1.63, which is of record in Acme Corp.'s application, establishes that Al is the inventor of X.

See *In re Mathews*, 161 USPQ 276 (CCPA 1969) and MPEP 717.01(a)(1).

Note that because Di's patent is a 102(a)(1) disclosure within the grace period, in accordance with compact prosecution the examiner should make the rejection under both 102(a)(1) and 102(a)(2) to guard against the possibility that the applicant could overcome the 102(a)(1) rejection but not the 102(a)(2) rejection. Also, although Di's patent issued on a pre-AIA application, there is no possibility of an interference or derivation proceeding because Di did not claim X.

# Example 5: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure

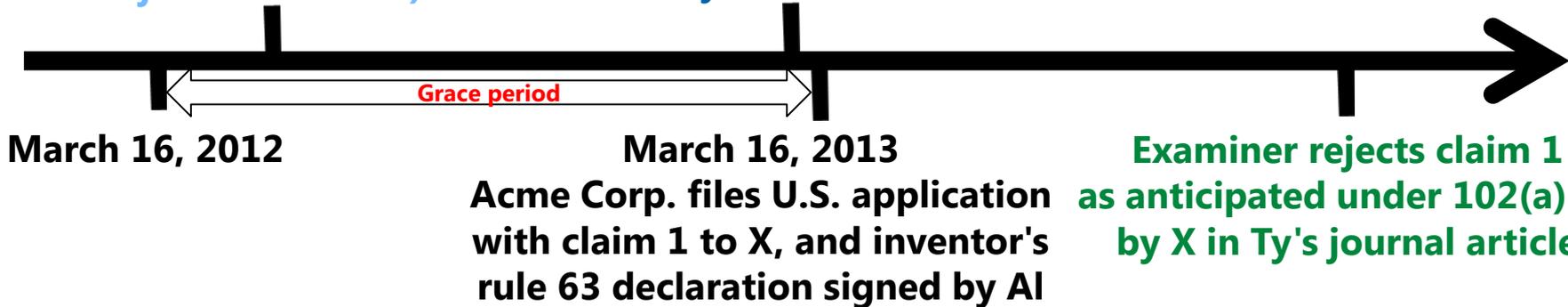


June 7, 2012

AI publicly discloses X (Examiner is unaware of this disclosure when the rejection is made)

February 7, 2013

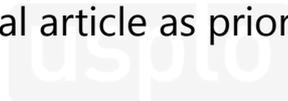
Third party Ty discloses X in journal article



Acme Corp. files U.S. application with claim 1 to X, and inventor's rule 63 declaration signed by AI

**Applicant's Reply:** Acme Corp.'s attorney files a 130(b) declaration signed by AI in which AI avers that he disclosed X at a conference on June 7, 2012. A copy of the printed conference proceeding, which is not prior art, is also filed. The proceeding indicates that the conference was held on June 7, 2012; it includes an abstract by AI that discloses X. The attorney points out that an inventor's oath or declaration under 37 CFR 1.63 signed by AI is already of record.

**Question:** Is the declaration sufficient to disqualify Ty's disclosure of X in the journal article as prior art?



## Example 5: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure



**Answer:** Yes.

The declaration is sufficient to disqualify the disclosure of X in Ty's journal article as prior art.

- A copy of the printed conference proceeding is included with the declaration, as required by 37 CFR 1.130(b)(1).
- Al's inventor's oath or declaration under 37 CFR 1.63 establishes that he invented X.
- Al publicly disclosed the same subject matter X before it had been disclosed by the third party Ty.

If the examiner had been aware of Al's June 7, 2012 disclosure of X, the rejection over the disclosure of X in Ty's journal article would not have been appropriate.

# Example 6: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure

130(b)

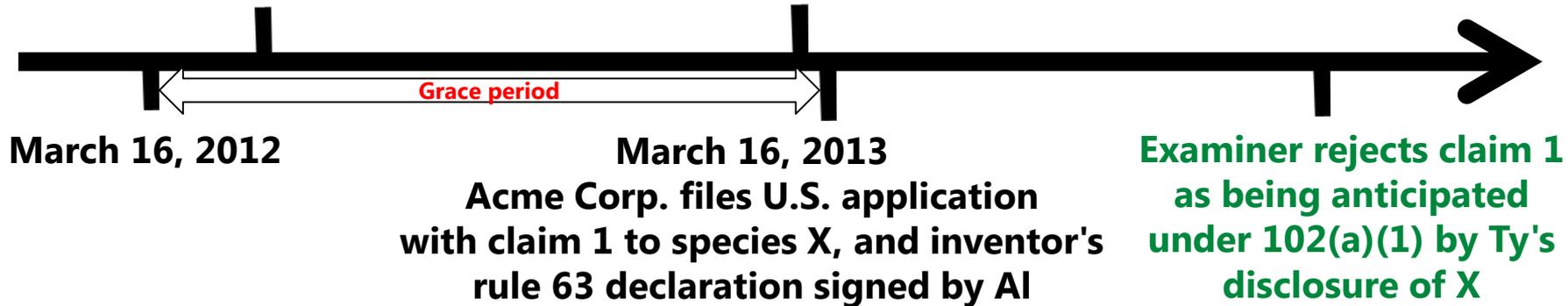


June 7, 2012

AI publicly discloses species X  
(Examiner is unaware of this disclosure when rejection is made)

February 7, 2013

Third party Ty's journal article discloses a genus, as well as species X & Y within the genus



March 16, 2012

March 16, 2013

Acme Corp. files U.S. application with claim 1 to species X, and inventor's rule 63 declaration signed by AI

Examiner rejects claim 1 as being anticipated under 102(a)(1) by Ty's disclosure of X

**Applicant's Reply:** Acme Corp.'s attorney files a 130(b) declaration signed by AI in which AI avers that he disclosed species X at a conference on June 7, 2012. A copy of the printed conference proceeding, which is not prior art, is included. The proceeding contains an abstract by AI disclosing species X, and lists the date of June 7, 2012 for the conference. The attorney points out that an inventor's oath or declaration under 37 CFR 1.63 signed by AI is already of record.

**Question:** Is the declaration sufficient to disqualify Ty's disclosure of X as prior art?



## Example 6: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure



**Answer:** Yes.

The declaration is sufficient to disqualify the disclosures of the genus and species X in Ty's journal article as prior art.

- A copy of the printed conference proceeding is included with the declaration, as required by 37 CFR 1.130(b)(1).
- Al's inventor's oath or declaration under 37 CFR 1.63 establishes that he invented X.
- Al publicly disclosed the same subject matter X before it had been disclosed by the third party Ty.

However, Ty's disclosure of species Y is not disqualified as prior art. In accordance with compact prosecution, since Ty made a 102(a)(1) disclosure less than one year before the effective filing date of the claimed invention (i.e., within the grace period), the examiner should have considered whether to make a back-up rejection for obviousness of species X over species Y.

If the examiner had been aware of Al's June 7, 2012 disclosure of X, the rejection over the disclosure of X in Ty's journal article would not have been appropriate.



# Comparison of Declarations for Pre-AIA and AIA Applications

| Purpose   | Current Rule (as of MPEP 9 <sup>th</sup> ed.) |  |
|---|---|--|
|   | Pre-AIA (First-to-Invent)<br>Applications     | AIA (First-Inventor-to-File)<br>Applications |
| Earlier date of invention<br>(formerly rule 131)  | 131(a)  | Not available                                |
| Attribution<br>(Katz Type Declaration)  | 132   | 130(a)                                       |
| Prior public disclosure   | Not available                                 | 130(b)                                       |
| Rare current common ownership<br><u>declaration</u> with terminal disclaimer (not the<br>more frequently used common ownership<br><u>statement</u> under pre-AIA 103(c) or AIA<br>102(b)(2)(C)) | 131(c)<br>Formerly pre-AIA 130(a)             | Not available                                |
| Other traversal of rejection or objection<br>(e.g., unexpected results, commercial<br>success, etc.)  | 132   | 132  |

## Document Codes and Document Descriptions for Declarations after March 15, 2013

| RULE FOR SUBMISSION OF DECLARATION | DOCUMENT DESCRIPTION IN IFW                            | DOC CODE   |
|------------------------------------|--|------------|
| 130(a)                             | Affidavit-Rule 130(a)-AIA (FITF) ONLY                  | AF/D.130A  |
| 130(b)                             | Affidavit-Rule 130(b)-AIA (FITF) ONLY                  | AF/D.130B  |
| 131(a) or 131(c)                   | Affidavit-Rule 131-pre-AIA (FTI) ONLY                  | AF/D.131   |
| 132                                | Affidavit-traversing rejections or objections rule 132 | AF/D.132   |
| Not Covered by a Specific Rule     | Affidavit-not covered under specific rule              | AF/D.OTHER |

# For more information...

- MPEP chapter 2100, entitled “Patentability,” is available at <https://www.uspto.gov/web/offices/pac/mpep/mpep-2100.pdf>; see sections 2151-2155 for FITF issues.
- USPTO examiner training materials, as well as public presentations about FITF, may be accessed at <https://www.uspto.gov/patent/laws-and-regulations/america-invents-act-aia/patents-examination#heading-10>.
- More questions? Call the Office of Patent Legal Administration’s help line at (571) 272-7701.

