

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Declarations under 37 CFR 1.130 to Establish AIA Exceptions to Prior Art

Biotechnology, Chemical, and Pharmaceutical (BCP) Partnership Meeting
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UNITED STATES
PATENT AND TRADEMARK OFFICE



Topics of Discussion

- Overview of statutes and regulations
 - 35 U.S.C. 102(b)(1) exceptions to 35 U.S.C. 102(a)(1) prior art
 - 35 U.S.C. 102(b)(2) exceptions to 35 U.S.C. 102(a)(2) prior art
 - 37 CFR 130(a) declarations of attribution
 - 37 CFR 130(b) declarations of prior public disclosure
- Analysis of hypothetical rule 130 declarations

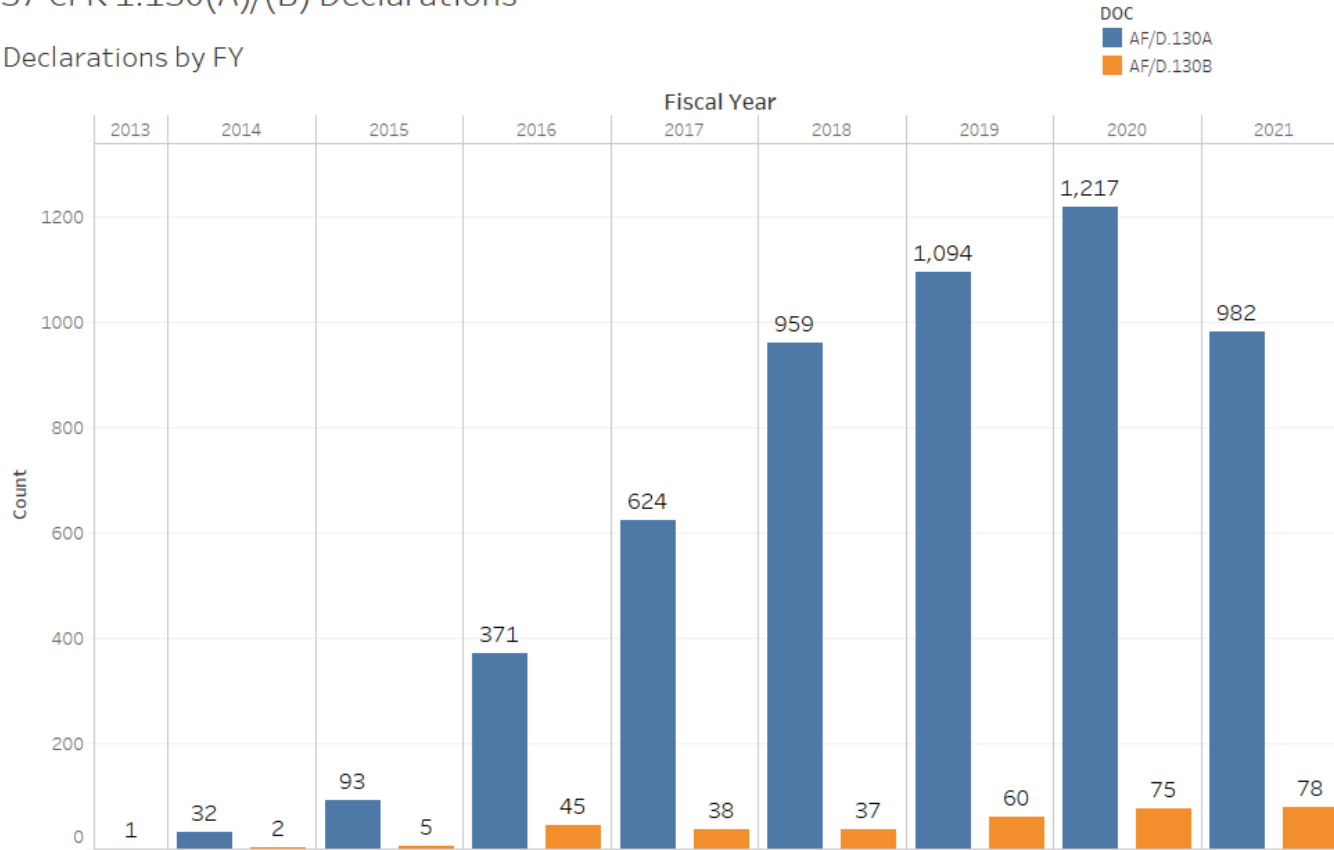
Summary of 37 CFR 1.130

- 37 CFR 1.130 was revised in 2013 as part of the USPTO's implementation of the first inventor to file provisions of the America Invents Act. It applies only to AIA(FITF) cases.*
- Rule 130(a) provides for a declaration of attribution, and is a way to invoke the 35 U.S.C. 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 35 U.S.C. 102(b)(1)(B) or 102(b)(2)(B) exception.

*The rarely-invoked common ownership provisions of pre-AIA 37 CFR 1.130 were relocated to 37 CFR 1.131(c).

37 CFR 1.130(A)/(B) Declarations

Declarations by FY

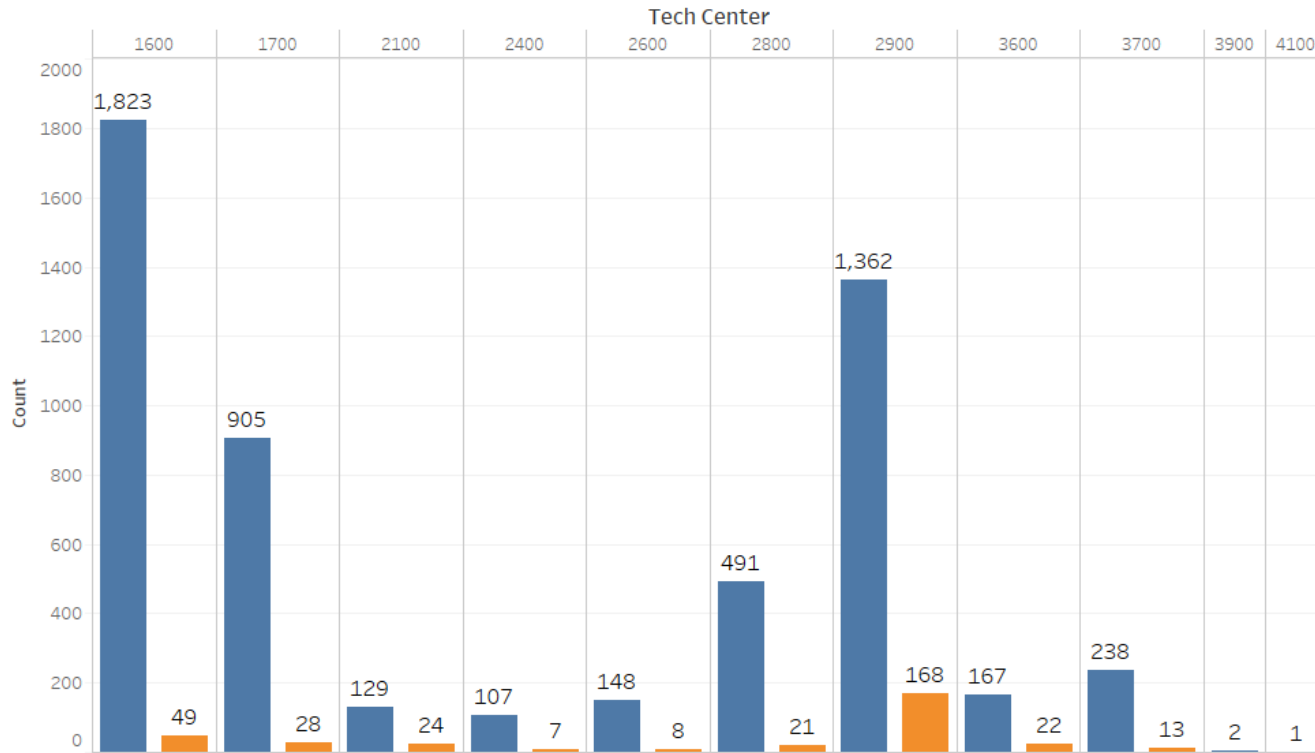


DOC	Fiscal Year									
	2013	2014	2015	2016	2017	2018	2019	2020	2021	
AF/D.130A	1	32	93	371	624	959	1,094	1,217	982	
AF/D.130B		2	5	45	38	37	60	75	78	

37 CFR 1.130(A)/(B) Declarations

Declarations by TC (FY 2013-2021)

DOC
■ AF/D.130A
■ AF/D.130B



	Tech Center										
DOC	1600	1700	2100	2400	2600	2800	2900	3600	3700	3900	4100
AF/D.130A	1,823	905	129	107	148	491	1,362	167	238	2	1
AF/D.130B	49	28	24	7	8	21	168	22	13		

Prior art exceptions for public disclosures

35 U.S.C. 102(b)(1) states:

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Exception provisions for potential 102(a)(1) art

↑
tied to one-year
grace period

35 U.S.C. 102(b)(1) states:

A disclosure made **1 year or less** before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

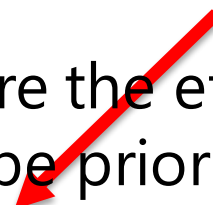
(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Exception provisions for potential 102(a)(1) art

35 U.S.C. 102(b)(1) states:

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention **under subsection (a)(1)** if—

(b)(1) exceptions apply to potential (a)(1) prior art



- (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Exception provisions for potential 102(a)(1) art

35 U.S.C. 102(b)(1) states:

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

**attribution
exception for
inventor-
originated
disclosure**

→ (A) the disclosure was made by **the inventor** or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

**prior public
disclosure
exception for
inventor-
originated
disclosure**

→ (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by **the inventor** or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

**“inventor” means the entire
inventive entity per 35 U.S.C. 100(f)**

Prior art exceptions for disclosures in patent applications

35 U.S.C. 102(b)(2) states:

A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

- (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

Exception provisions for potential 102(a)(2) art

(b)(2) exceptions apply to potential (a)(2) prior art

35 U.S.C. 102(b)(2) states:

A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

- (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

Exception provisions for potential 102(a)(2) art

35 U.S.C. 102(b)(2) states:

- attribution exception for inventor-originated disclosure** → (A) the subject matter disclosed was obtained directly or indirectly from **the inventor** or a joint inventor;
- prior public disclosure exception for inventor-originated disclosure** → (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by **the inventor** or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- common ownership exception** → (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

“inventor” means the entire inventive entity per 35 U.S.C. 100(f)

Exception provisions for potential 102(a)(2) art

Note: There is no one-year time limitation on applicability of the (b)(2) exceptions.

35 U.S.C. 102(b)(2) states:

A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

- (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
- (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
- (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

130(a) declarations of attribution

37 CFR 1.130(a) states:

(a) Affidavit or declaration of attribution. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

Statutory bases for rule 130(a) declarations of attribution

- 35 U.S.C. 102(b)(1)(A): “the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor”
- 35 U.S.C. 102(b)(2)(A): “the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor”

130(b) declarations of prior public disclosure

37 CFR 1.130(b) states in part:

Affidavit or declaration of prior public disclosure. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Statutory bases for rule 130(b) declarations of prior public disclosure

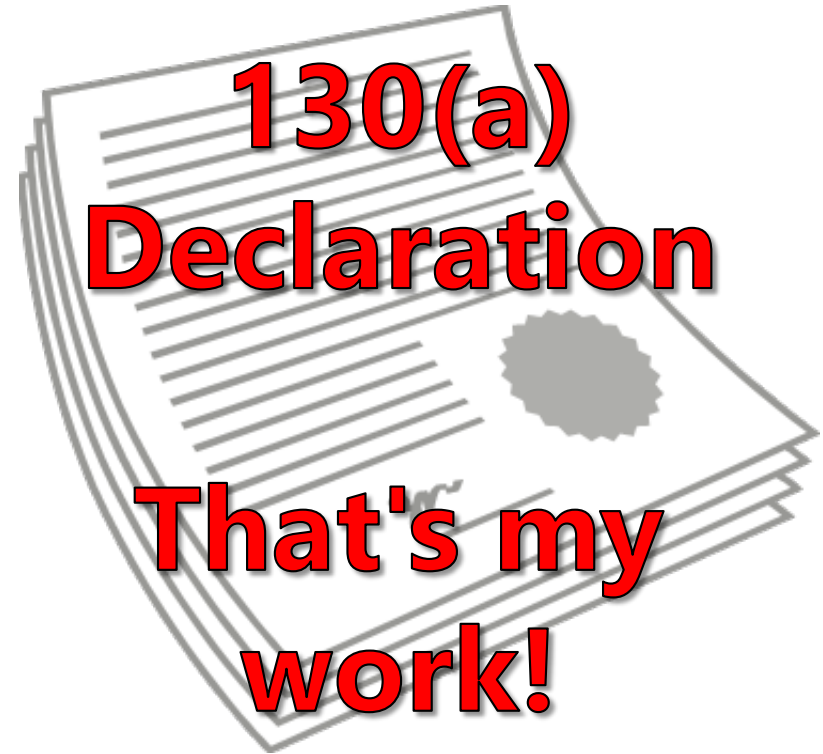
- 35 U.S.C. 102(b)(1)(B): “the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor”
- 35 U.S.C. 102(b)(2)(B): “the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor”

Declarations under 130(a) and 130(b)

declaration rule	applicable exception	purpose
130(a) see MPEP 717.01(a)	102(b)(1)(A) and (b)(2)(A)	<u>attribution</u> : showing that the potential prior art subject matter originated with one or more members of the inventive entity
130(b) see MPEP 717.01(b)	102(b)(1)(B) and (b)(2)(B)	<u>prior public disclosure</u> : showing that the potential prior art subject matter was preceded by an inventor-originated disclosure of the same subject matter

Note that a statement is sufficient (i.e., a declaration is not required) to invoke the 102(b)(2)(C) common ownership exception.

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).

130(b) declaration of prior public disclosure

37 CFR 1.130(b) states in part:

Affidavit or declaration of prior public disclosure. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

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. 37 CFR 1.130(b)(1) and (b)(2).

See MPEP 717.01(b)(1).

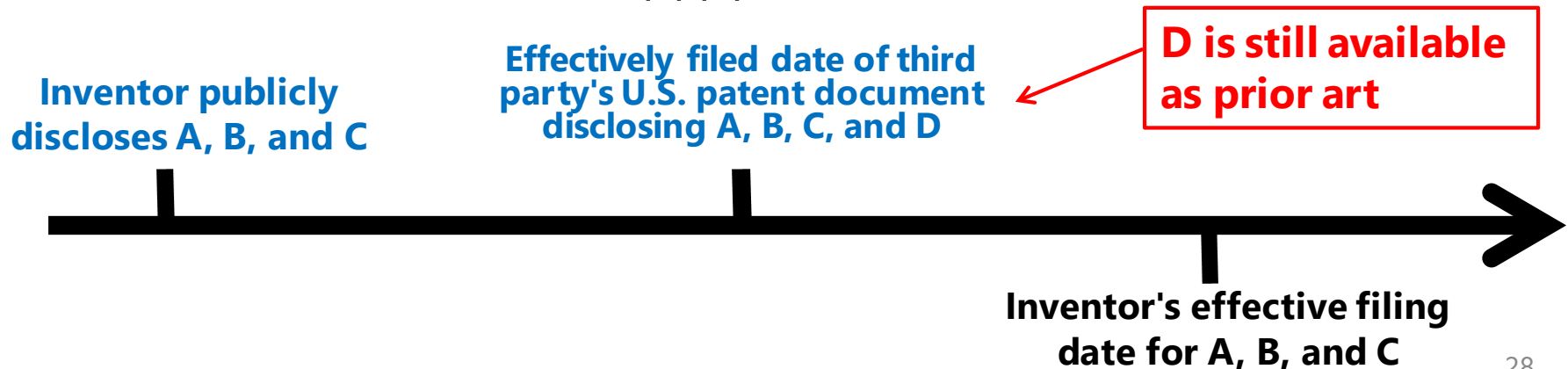
- It is not necessary to show that the inventor-originated disclosure was an enabling disclosure within the meaning of 35 U.S.C. 112(a). See MPEP 717.01(a)(1).

It is possible for only a portion of a third party's disclosure to be disqualified as prior art

- Only that portion of the third party's intervening disclosure that was in a previous inventor-originated disclosure (i.e., the same "subject matter") is disqualified as prior art under 35 U.S.C. 102(a)(1) or (a)(2) when the respective 102(b)(1)(B) or (b)(2)(B) exception applies.
- Any other portion of the third party's intervening disclosure that was not part of the previous inventor-originated disclosure is still available for use in a prior art rejection. In other words, the claimed invention is not shielded from any portion of the third party's disclosure that has not been disqualified.

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).



When is a 130(a) or (b) declaration not appropriate?

An applicant may not rely on a declaration under rule 130(a) or 130(b) to establish an exception to prior art when the disclosure was publicly available before the grace period.

This follows from the requirements of 102(b)(1) that a disclosure under 102(a)(1) is not subject to an exception if it was made more than one year before the effective filing date of the claimed invention.

An examiner need not consider such 130 declarations on the merits. The applicant should be informed that the declaration does not comply with 37 CFR 1.130(c).

See 37 CFR 1.130(c) and MPEP 717.01(a)(1).

When is a 130(a) declaration not appropriate?

An applicant may not rely on a declaration of attribution under rule 130(a) to establish an exception to prior art when both of the following apply:

- the disclosure is a U.S. patent or U.S. patent application publication having **patented or pending claims** drawn to an invention that is the same or substantially the same as (i.e., not patentably distinct from) the invention claimed in the application under examination, AND
- the declaration contends that an inventor named in the disclosure derived the claimed invention from the inventor or a joint inventor named in the application under examination.

The examiner need not consider the declaration on the merits. The applicant should be informed that the declaration does not comply with 37 CFR 1.130(c). The applicant may file a petition for a derivation proceeding.

See MPEP 717.01(a)(1) and 717.01(d).

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.)

It is possible for a 130(b) declaration to disqualify a disclosure in a U.S. patent document as prior art under 102(a)(1), but to be ineffective to disqualify the disclosure under 102(a)(2).

If a grace-period public disclosure in a U.S. patent document is not prior art under 102(a)(1) in view of a 130(b) declaration that establishes prior public disclosure of the relevant subject matter before the public availability (published or patented) date of the document,

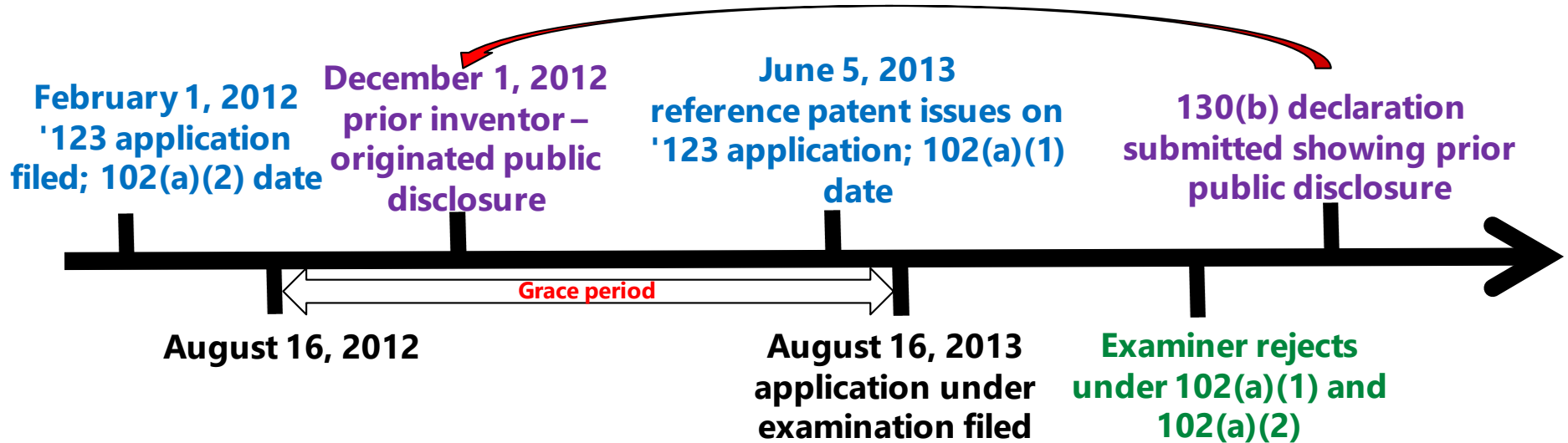
BUT

the date of the prior public disclosure of the relevant subject matter is after the effectively filed date of the U.S. patent document,

THEN

the disclosure in the U.S. patent document still qualifies as prior art under 102(a)(2) and may be used in an anticipation or obviousness rejection.

Timeline: A 130(b) declaration may be sufficient to disqualify a disclosure in a U.S. patent document as prior art under 102(a)(1) but not under 102(a)(2)



The 130(b) declaration disqualifies the relevant disclosure in the reference patent as prior art under 102(a)(1), provided that it establishes a prior inventor-originated disclosure of the same subject matter. However, the disclosure in the reference patent is not disqualified under 102(a)(2). It can still be used in an anticipation or obviousness rejection.

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:

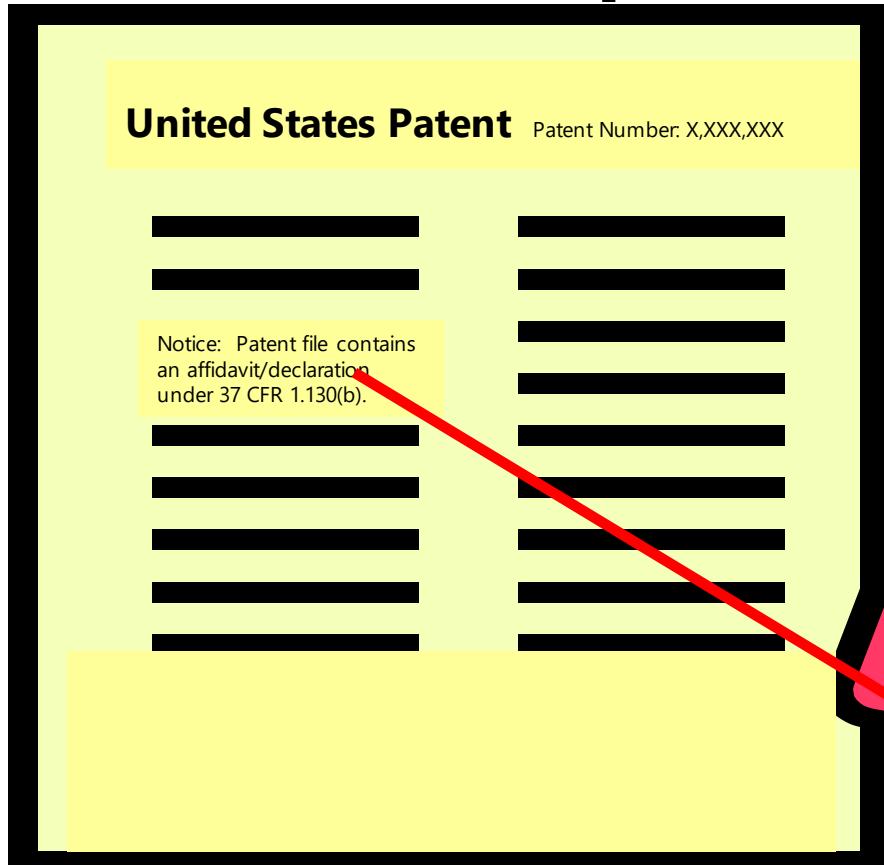
- in a non-statutory double patenting rejection when the disqualified disclosure is a U.S. patent or U.S. patent application publication and the patented or pending claims are not patentably distinct from the claims of the application under examination;
- in a statutory double patenting rejection under 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).

130(b) declaration information on the face of an issued patent



The 130(b) notice alerts examiners and the public that the file history of the patent may contain prior art with an earlier date than the effectively filed date of the patent.

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

Comparison of declarations for pre-AIA and AIA applications

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

Document Codes and Document Descriptions for Declarations

- Prior to March 16, 2013, there was only one document code for indexing declarations:
"AF/D – Rule 130, 131, or 132 Affidavits"
- Since March 16, 2013, there are five document codes and corresponding document descriptions (shown on the next slide) for indexing declarations.

Document codes and document descriptions for declarations after March 15, 2013

RULE FOR SUBMISSION OF DECLARATION	DOCUMENT DESCRIPTION	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

Analysis of hypothetical rule 130 declarations



Hypo 1, rule 130(a): Background

- The claims are drawn to composition X.
- The joint inventors are A, B, and C.
- The examiner rejected the claims under 35 U.S.C. 102(a)(1) as being anticipated by a disclosure of composition X in a journal article co-authored by A, B, C, D, and E.
- The journal article was published less than one year before the effective filing date of the claimed invention.
- The attorney for the corporate applicant MajorCorp submitted a declaration under 37 CFR 1.130(a) along with an argument that the declaration established that the reference was not prior art because the 35 U.S.C. 102(b)(1)(A) attribution exception applied.
- The rule 130(a) declaration was signed by an officer of MajorCorp.

Hypo 1, rule 130(a): The declaration

130(a)



That's my work!

Declaration under 37 CFR. 1.130(a)

I, an officer of MajorCorp, declare that:

1. MajorCorp is the owner of the above-identified patent application.
2. I have reviewed the claims and I understand that the USPTO has rejected them under 35 U.S.C. 102(a)(1) as being anticipated by a journal article co-authored by A, B, C, D, and E.
3. I have reviewed the journal article and understand that the USPTO is relying on this reference for its disclosure of X. This disclosure was made by joint inventors of the present application A and B less than one year before the effective filing date of the claimed invention. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the journal article is not available as prior art under 35 U.S.C. 102(a)(1).
4. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

Hypo 1, rule 130(a): Analysis

130(a)



That's my work!

Declaration under 37 CFR. 1.130(a)

I, **an officer of MajorCorp**, declare that:

1. MajorCorp is the owner of the above-identified patent application.
2. I have reviewed the claims and I understand that the USPTO has rejected them under 35 U.S.C. 102(a)(1) as being anticipated by a journal article co-authored by A, B, C, D, and E.
3. I have reviewed the journal article and understand that the USPTO is relying on this reference for its disclosure of X. This disclosure was made by joint inventors of the present application A and B less than one year before the effective filing date of the claimed invention. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the journal article is not available as prior art under 35 U.S.C. 102(a)(1).
4. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

A person with knowledge of the facts asserted must sign the declaration. When a person who is not the inventor or a joint inventor signs, the examiner will look for an explanation of how that person came to have knowledge of the relevant facts.



Hypo 1, rule 130(a): Analysis

130(a)



That's my work!

**joint
inventors**

Declaration under 37 CFR. 1.130(a)

**not joint
inventors**

I, an officer of MajorCorp, declare that:

1. MajorCorp is the owner of the above-identified patent application.
2. I have reviewed the claims and I understand that the USPTO has rejected them under 35 U.S.C. 102(a)(1) as being anticipated by a journal article co-authored by **A, B, C, D, and E.**
3. I have reviewed the journal article and understand that the USPTO is relying on this reference for its disclosure of X. This disclosure was made by joint inventors of the present application A and B less than one year before the effective filing date of the claimed invention. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the journal article is not available as prior art under 35 U.S.C. 102(a)(1).
4. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

Grace-period disclosures attributable to one or more joint inventors are not prior art in view of 102(b)(1)(A). When the authorship of a reference includes people who are not joint inventors, the examiner will look for an explanation of their roles, including whether or not they contributed to the conception of the claimed invention.

Hypo 1, rule 130(a): Analysis

130(a)



That's my work!

Declaration under 37 CFR. 1.130(a)

I, an officer of MajorCorp, declare that:

1. MajorCorp is the owner of the above-identified patent application.
2. I have reviewed the claims and I understand that the USPTO has rejected them under 35 U.S.C. 102(a)(1) as being anticipated by a journal article co-authored by A, B, C, D, and E.
3. I have reviewed the journal article and understand that the **USPTO is relying on this reference for its disclosure of X**. This disclosure was made by joint inventors of the present application A and B less than one year before the effective filing date of the claimed invention. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the journal article is not available as prior art under 35 U.S.C. 102(a)(1).
4. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The examiner will ensure that the declaration refers to the specific disclosure in the reference that is relevant to the rejection.



Hypo 1, rule 130(a): Conclusion

- The declaration is not sufficient to establish that the 102(b)(1)(A) exception applies.
- The declaration does not explain:
 - how the declarant knows that the disclosure of X is attributable to A and B alone even though A-E are all co-authors of the article
 - why joint inventor C, as well as D and E who are not joint inventors, were co-authors of the article



Hypo 2, rule 130(a): Background

- The claims are drawn to product X.
- Smith is the inventor named in the application, and the applicant is SmithCo.
- The examiner rejected the claims under 35 U.S.C. 102(a)(1) as being anticipated by a description of the product and an offer to sell it by JonesCo found on a web site less than one year before the effective filing date of the claimed invention.
- The attorney for the corporate applicant SmithCo submitted a declaration under 37 CFR 1.130(a) along with an argument that the declaration established that the web site disclosure was not prior art because the 35 U.S.C. 102(b)(1)(A) attribution exception applied.
- The rule 130(a) declaration was signed by Smith.



Hypo 2, rule 130(a): The declaration

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the JonesCo on-line description and offer for sale of product X is attributable to me and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



Hypo 2, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the JonesCo on-line description and offer for sale of product X is attributable to me and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The declarant is the named inventor. He declares that he invented the relevant subject matter.



Hypo 2, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the JonesCo on-line description and offer for sale of product X is attributable to me and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The transfer of knowledge of the subject matter from the inventor to the discloser must have happened before the purported prior art disclosure, and not just before the effective filing date.



Hypo 2, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the JonesCo on-line description and offer for sale of product X is attributable to me and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The declaration does not establish the relationship between purchaser John Joseph Jones and discloser JonesCo. The examiner cannot assume that John Joseph Jones was acting on behalf of JonesCo.



Hypo 2, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), the JonesCo on-line description and offer for sale of product X is attributable to me and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The declaration leaves open the possibility that the sale occurred more than one year before the effective filing date of the claimed invention, and is therefore prior art that could be used against the claims.



Hypo 2, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I, Inventor Smith, declare that:

1. I am the inventor of the above-identified patent application, and the president of SmithCo. SmithCo manufactures product X.
2. I understand that the USPTO has rejected claims to product X under 35 U.S.C. 102(a)(1) as being anticipated by the JonesCo on-line description and offer for sale of product X.
3. I understand that the USPTO considers the JonesCo description to have become available to the public less than one year before the effective filing date of the rejected claims to product X.
4. I, as president of SmithCo, sold product X to John Joseph Jones before the effective filing date of the rejected claims.
5. Accordingly, as provided under 35 U.S.C. 102(b)(1)(A), **the JonesCo on-line description and offer for sale of product X is attributable to me** and is not available as prior art under 35 U.S.C. 102(a)(1).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The conclusion of attribution does not follow because no tie between John Joseph Jones and JonesCo has been established.



Hypo 2, rule 130(a): Conclusion

- The declaration is not sufficient to establish that the 102(b)(1)(A) exception applies because it does not explain how the subject matter disclosed was transmitted from inventor Smith to discloser JonesCo.
- The declaration also leaves open the possibility that inventor Smith's sale to John Joseph Jones is itself prior art. Even if the exception were established, the examiner could not allow the claims without resolving that issue. A requirement for information under 37 CFR 1.105 would be appropriate.



Hypo 3, rule 130(a): Background

- The application under examination names A, B, and C as joint inventors; each of them has signed an inventor's declaration under 37 CFR 1.63.
- The examiner rejected the claims under 35 U.S.C. 102(a)(1) as being anticipated by embodiments shown in Figures 1-3 of a U.S. PGPub. **The U.S. PGPub was published less than one year before the effective filing date of the claims, and named X, Y, and Z as joint inventors.**
- The applicant's attorney submitted a declaration under 37 CFR 1.130(a) along with an argument that the declaration established that the U.S. PGPub was not prior art because the 35 U.S.C. 102(b)(1)(A) attribution exception applied.
- The rule 130(a) declaration was signed by A, who was one of the joint inventors of the application under examination.

Hypo 3, rule 130(a): The declaration

Declaration under 37 CFR. 1.130(a)

The undersigned declares that:

1. I, Inventor A, am a joint inventor of the instant application, in which the claimed inventions have an effective filing date of 01/01/2020.
2. I am the inventor of the embodiments shown in Figures 1-3 of the U.S. PGPub that have been cited as prior art under 35 U.S.C. 102(a)(1) against the claims of the instant application.
3. The U.S. PGPub that has been cited against the claims was published on 06/01/2019, which is less than one year before the effective filing date of the claimed inventions.
4. The disclosure of the embodiments shown in Figures 1-3 of the U.S. PGPub was made by me.
5. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'Inventor A', is written over a solid black horizontal line.

Hypo 3, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

The undersigned declares that:

1. I, Inventor A, am a joint inventor of the instant application, in which the claimed inventions have an effective filing date of 01/01/2020.
2. I am the inventor of the embodiments shown in Figures 1-3 of the U.S. PGPub that have been cited as prior art under 35 U.S.C. 102(a)(1) against the claims of the instant application.
3. The U.S. PGPub that has been cited against the claims was published on 06/01/2019, which is less than one year before the effective filing date of the claimed inventions.
4. The disclosure of the embodiments shown in Figures 1-3 of the U.S. PGPub was made by me.
5. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



The declarant asserts that he is one of the joint inventors of what is claimed in the application.

Hypo 3, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

The undersigned declares that:

1. I, Inventor A, am a joint inventor of the instant application, in which the claimed inventions have an effective filing date of 01/01/2020.
2. I am the inventor of **the embodiments shown in Figures 1-3 of the U.S. PGPub that have been cited as prior art** under 35 U.S.C. 102(a)(1) against the claims of the instant application.
3. The U.S. PGPub that has been cited against the claims was published on 06/01/2019, which is less than one year before the effective filing date of the claimed inventions.
4. The disclosure of the embodiments shown in Figures 1-3 of the U.S. PGPub was made by me.
5. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to read 'Inventor A', is written over a solid black horizontal line.

The declarant states that he invented the relevant subject matter of the purported prior art.

Hypo 3, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

The undersigned declares that:

1. I, Inventor A, am a joint inventor of the instant application, in which the claimed inventions have an effective filing date of 01/01/2020.
2. I am the inventor of the embodiments shown in Figures 1-3 of the U.S. PGPub that have been cited as prior art under 35 U.S.C. 102(a)(1) against the claims of the instant application.
3. The U.S. PGPub that has been cited against the claims was published on 06/01/2019, which is less than one year before the effective filing date of the claimed inventions.
4. **The disclosure of the embodiments shown in Figures 1-3 of the U.S. PGPub was made by me.**
5. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'A. A.', is written over a solid black horizontal line.

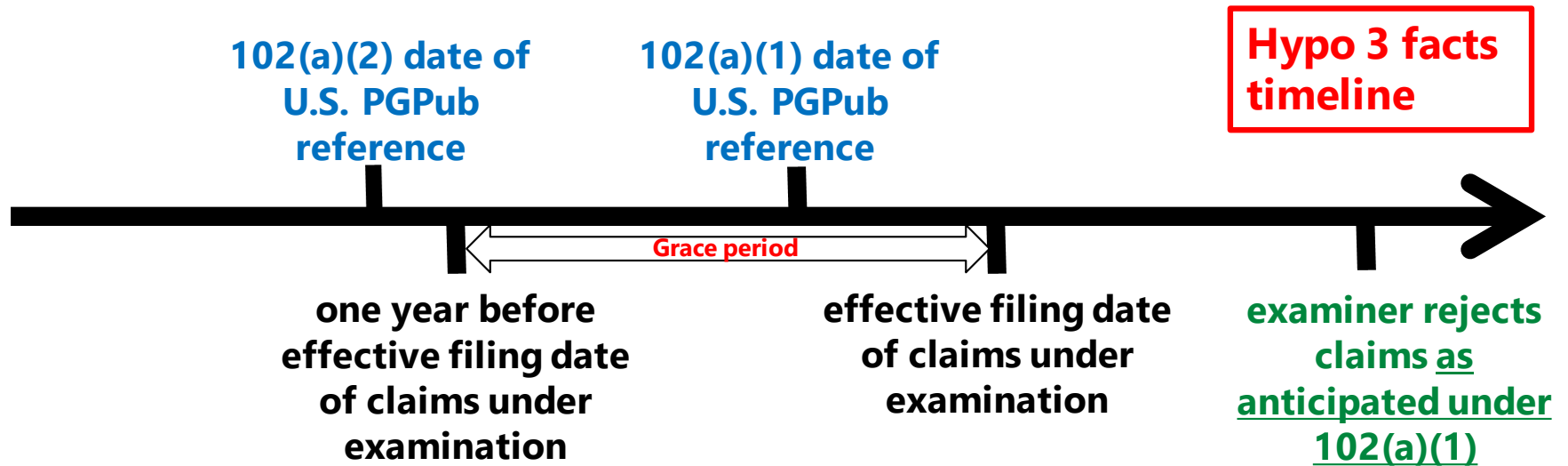
The declarant states, contrary to fact, that he disclosed the relevant subject matter of the purported prior art. Recall that the PGPub names X, Y, and Z as joint inventors.



Hypo 3, rule 130(a): Conclusion

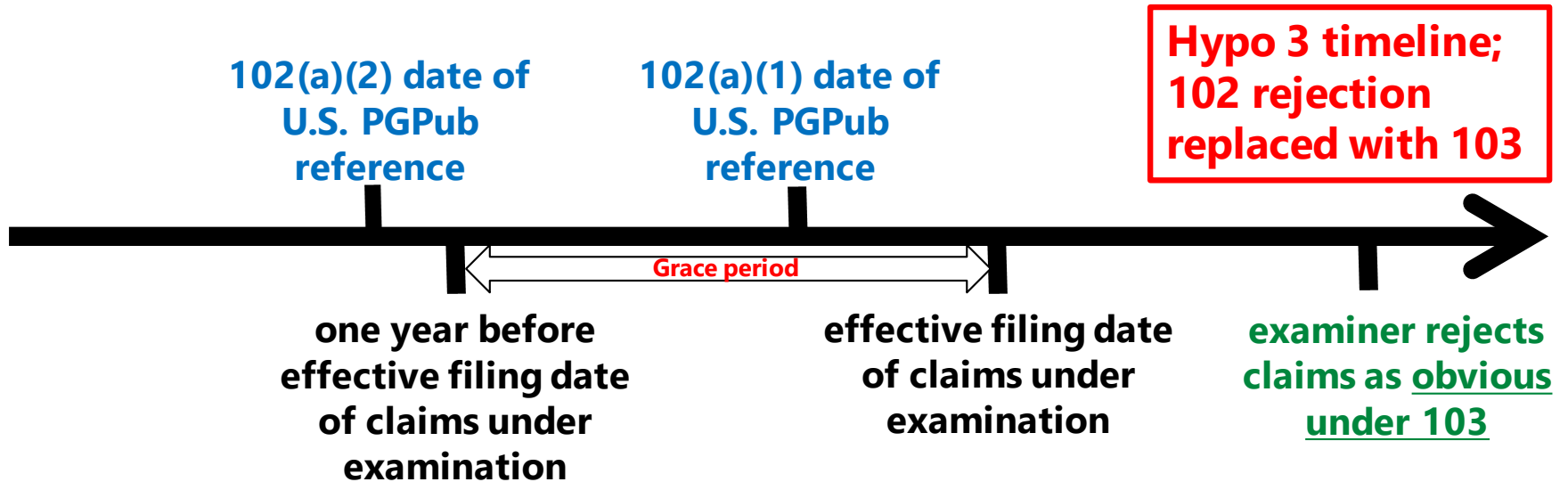
- The declaration is not sufficient to establish that the 102(b)(1)(A) exception applies.
 - The statement by Inventor A that he disclosed the subject matter of Figures 1-3 of the PGPub is counter to the inventor information shown on the PGPub itself.
 - If Inventor A had explained that he had conveyed the subject matter of Figures 1-3 to joint inventors X, Y, and Z of the PGPub, and that the subject matter had been included in the PGPub application as part of the background of the invention claimed therein, then the declaration may have been effective.

Hypo 3, rule 130(a): Further thoughts



- When the reference is a U.S. patent document and its 102(a)(1) date is within the grace period, the examiner should make both the 102(a)(1) and the 102(a)(2) rejection in accordance with compact prosecution.
- If only one of the two rejections is made in a first office action and it is overcome by invocation of a prior art exception, a second action that includes the previously-omitted rejection may not be made final.

Hypo 3, rule 130(a): Further thoughts



- If the examiner makes a 35 U.S.C. 103 rejection but the facts are otherwise the same as in hypo 3, the examiner is not required to point out that the reference has both a 102(a)(1) date and a 102(a)(2) date.
- It is possible for an applicant's response to establish that the reference does not qualify as art under 102(a)(1) while leaving intact its qualification under 102(a)(2) (and vice versa).



Hypo 4, rule 130(a): Background

- The application under examination names A and B as joint inventors; each of them has signed an inventor's declaration under 37 CFR 1.63.
- PharmCo is the applicant.
- The examiner rejected the claims under 35 U.S.C. 102(a)(1) as being anticipated by Figure 1 in an article by Author X. The article was published less than one year before the effective filing date of the claims.
- The applicant's attorney submitted a declaration under 37 CFR 1.130(a) along with an argument that the declaration established that the article was not prior art because the 35 U.S.C. 102(b)(1)(A) attribution exception applied.
- The rule 130(a) declaration was signed by the Chief Marketing Officer of applicant PharmCo.

Hypo 4, rule 130(a): The declaration

Declaration under 37 CFR. 1.130(a)

I declare and state as follows:

1. I am the Chief Marketing Officer for applicant PharmCo.
2. Joint inventors A and B named in patent application xx/xxx,xxx invented the claimed subject matter and assigned their rights to PharmCo.
3. I understand that the article by Author X that has been cited against the claims was published less than one year before the effective filing date of the claimed invention. The examiner asserts that Figure 1 in the article is relevant to the claimed invention.
4. Figure 1 was transmitted to Author X on behalf of PharmCo as follows: Jane Doe of CommCo, a communications agency representing PharmCo, sent Figure 1 to Author X for publication in the article.
5. Author X was not involved in the invention of the subject matter of Figure 1.
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'Jane Doe', is written over a solid black horizontal line.

Hypo 4, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I declare and state as follows:

1. **I am the Chief Marketing Officer for applicant PharmCo.**
2. Joint inventors A and B named in patent application xx/xxx,xxx invented the claimed subject matter and assigned their rights to PharmCo.
3. I understand that the article by Author X that has been cited against the claims was published less than one year before the effective filing date of the claimed invention. The examiner asserts that Figure 1 in the article is relevant to the claimed invention.
4. Figure 1 was transmitted to Author X on behalf of PharmCo as follows: Jane Doe of CommCo, a communications agency representing PharmCo, sent Figure 1 to Author X for publication in the article.
5. Author X was not involved in the invention of the subject matter of Figure 1.
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'J. Doe', is written over a horizontal line at the end of the declaration.

A person with knowledge of the facts asserted must sign the declaration. When a person who is not the inventor or a joint inventor signs, the examiner will look for an explanation of how that person came to have knowledge of the relevant facts.

Hypo 4, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I declare and state as follows:

1. I am the Chief Marketing Officer for applicant PharmCo.
2. Joint inventors A and B named in patent application xx/xxx,xxx invented the claimed subject matter and assigned their rights to PharmCo.
3. I understand that the article by Author X that has been cited against the claims was published less than one year before the effective filing date of the claimed invention. The examiner asserts that Figure 1 in the article is relevant to the claimed invention.
4. Figure 1 was transmitted to Author X on behalf of PharmCo as follows: Jane Doe of CommCo, a communications agency representing PharmCo, sent Figure 1 to Author X for publication in the article.
5. Author X was not involved in the invention of the subject matter of Figure 1.
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'Jane Doe', is written over a horizontal line at the bottom of the declaration text.

It must be established on the record that the named joint inventors invented the claimed subject matter. A third party cannot attest that A and B invented. However, in this hypo the Background information confirms that inventorship has been established by way of an inventor's declaration under 37 CFR 1.63.

Hypo 4, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I declare and state as follows:

1. I am the Chief Marketing Officer for applicant PharmCo.
2. Joint inventors A and B named in patent application xx/xxx,xxx invented the claimed subject matter and assigned their rights to PharmCo.
3. I understand that the article by Author X that has been cited against the claims was published less than one year before the effective filing date of the claimed invention. The examiner asserts that Figure 1 in the article is relevant to the claimed invention.
4. **Figure 1 was transmitted to Author X on behalf of PharmCo as follows: Jane Doe of CommCo, a communications agency representing PharmCo, sent Figure 1 to Author X for publication in the article.**
5. Author X was not involved in the invention of the subject matter of Figure 1.
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



The chain of transmission does not begin with one or more joint inventors. Furthermore, the declarant does not explain how he knows these facts.

Hypo 4, rule 130(a): Analysis

Declaration under 37 CFR. 1.130(a)

I declare and state as follows:

1. I am the Chief Marketing Officer for applicant PharmCo.
2. Joint inventors A and B named in patent application xx/xxx,xxx invented the claimed subject matter and assigned their rights to PharmCo.
3. I understand that the article by Author X that has been cited against the claims was published less than one year before the effective filing date of the claimed invention. The examiner asserts that Figure 1 in the article is relevant to the claimed invention.
4. Figure 1 was transmitted to Author X on behalf of PharmCo as follows: Jane Doe of CommCo, a communications agency representing PharmCo, sent Figure 1 to Author X for publication in the article.
5. Author X was not involved in the invention of the subject matter of Figure 1.
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A handwritten signature in black ink, appearing to be 'John Doe', is written over a horizontal line at the bottom of the declaration box.

Once again, the declarant does not explain how he knows this fact.



Hypo 4, rule 130(a): Conclusion

- The declaration is not sufficient to establish that the 102(b)(1)(A) exception applies.
 - The declarant asserts facts concerning other people without explaining how he acquired knowledge of those facts.
 - The chain of transmission of the disclosed the subject matter does not begin with the inventor (or one or more joint inventors). This is required because the statute associates the prior art exceptions with the inventor rather than with the applicant.



Hypo 5, rule 130(b): Background

- The application under examination names Wang as the inventor. Wang's inventor's declaration under 37 CFR 1.63 is of record.
- The applicant is AllGadgets.
- The examiner rejected claims drawn to Gadget123 under 35 U.S.C. 102(a)(1) as being anticipated by a YouTube video posted by Li less than one year before the effective filing date of the claims. The video demonstrates the use of Gadget123.
- The applicant's attorney submitted a declaration under 37 CFR 1.130(b) along with an argument that the declaration established that the article was not prior art because the 35 U.S.C. 102(b)(1)(B) prior public disclosure exception applied.
- The rule 130(b) declaration was signed by Zhao, who is the eCommerce Manager of applicant AllGadgets.

Hypo 5, rule 130(b): Analysis

130(b)



**I made it
public first!**

Declaration under 37 CFR. 1.130(b)

I declare and state as follows:

1. **I, Manager Zhao, am the eCommerce Manager for AllGadgets.**
2. I understand that patent application xx/xxx,xxx, which claims Gadget123, was filed by AllGadgets on June 1, 2021.
3. I understand that the patent examiner has rejected the claims to Gadget123 over a YouTube video posted by Li on March 1, 2021 that is said to demonstrate the use of Gadget123.
4. On August 1, 2020, I posted an article on a publicly available AllGadgets blog describing Gadget123. In accordance with 37 CFR 1.130(b)(1), a copy of that blog post accompanies this declaration.
5. Because my public disclosure of Gadget123 on the AllGadgets blog was prior to Li's YouTube video, the YouTube video is not prior art in view of 35 U.S.C. 102(b)(1)(B).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



A person with knowledge of the facts asserted must sign the declaration. When a person who is not the inventor or a joint inventor signs, the examiner will look for an explanation of how that person came to have knowledge of the relevant facts.

A handwritten signature in black ink, appearing to be 'Zhao', is written over a horizontal line.

Hypo 5, rule 130(b): Analysis

130(b)



**I made it
public first!**

Declaration under 37 CFR. 1.130(b)

I declare and state as follows:

1. I, Manager Zhao, am the eCommerce Manager for AllGadgets.
2. I understand that patent application xx/xxx,xxx, which claims Gadget123, was filed by AllGadgets on June 1, 2021.
3. I understand that the patent examiner has rejected the claims to Gadget123 over a YouTube video posted by Li on March 1, 2021 that is said to demonstrate the use of Gadget123.
4. On August 1, 2020, I posted an article on a publicly available AllGadgets blog describing Gadget123. In accordance with 37 CFR 1.130(b)(1), a copy of that blog post accompanies this declaration.
5. Because my public disclosure of Gadget123 on the AllGadgets blog was prior to Li's YouTube video, the YouTube video is not prior art in view of 35 U.S.C. 102(b)(1)(B).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true



There is no explanation of how Zhao came to know of Wang's invention.

A handwritten signature in black ink, appearing to be 'Zhao'.

Hypo 5, rule 130(b): Analysis

130(b)



**I made it
public first!**

Declaration under 37 CFR. 1.130(b)

I declare and state as follows:

1. I, Manager Zhao, am the eCommerce Manager for AllGadgets.
2. I understand that patent application xx/xxx,xxx, which claims Gadget123, was filed by AllGadgets on June 1, 2021.
3. I understand that the patent examiner has rejected the claims to Gadget123 over a YouTube video posted by Li on March 1, 2021 that is said to demonstrate the use of Gadget123.
4. On August 1, 2020, I posted an article on a publicly available AllGadgets blog describing Gadget123. **In accordance with 37 CFR 1.130(b)(1), a copy of that blog post accompanies this declaration.**
5. Because my public disclosure of Gadget123 on the AllGadgets blog was prior to Li's YouTube video, the YouTube video is not prior art in view of 35 U.S.C. 102(b)(1)(B).
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

The declaration complies with 37 CFR 1.130(b) by providing a copy of the prior public disclosure.

A handwritten signature in black ink, appearing to be 'Zhao', written over a horizontal line.

Hypo 5, rule 130(b): Analysis

130(b)



**I made it
public first!**

Declaration under 37 CFR. 1.130(b)

I declare and state as follows:

1. I, Manager Zhao, am the eCommerce Manager for AllGadgets.
2. I understand that patent application xx/xxx,xxx, which claims Gadget123, was filed by AllGadgets on June 1, 2021.
3. I understand that the patent examiner has rejected the claims to Gadget123 over a YouTube video posted by Li on March 1, 2021 that is said to demonstrate the use of Gadget123.
4. On August 1, 2020, I posted an article on a publicly available AllGadgets blog describing Gadget123. In accordance with 37 CFR 1.130(b)(1), a copy of that blog post accompanies this declaration.
5. **Because my public disclosure of Gadget123 on the AllGadgets blog was prior to Li's YouTube video, the YouTube video is not prior art in view of 35 U.S.C. 102(b)(1)(B).**
6. All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true

A handwritten signature in black ink, appearing to be 'Zhao', written over a horizontal line.

The prior public disclosure must have been made by the inventor, or by someone who obtained the subject matter disclosed from the inventor.



Hypo 5, rule 130(b): Conclusion

- The declaration is not sufficient to establish that the 102(b)(1)(A) exception applies.
 - The declarant asserts facts concerning other people without explaining how he acquired knowledge of those facts.
 - The chain of transmission of the disclosed the subject matter does not begin with the inventor (or one or more joint inventors). Note that the statute associates the prior art exceptions with the inventor rather than with the applicant.

Tips for drafting rule 130 declarations

- The inventor (or one or more joint inventors) should sign the declaration when possible.
- When the inventor (or one or more joint inventors) signs the declaration, a statement asserting that they invented the relevant subject matter should be included in the declaration when possible.
- Ensure that the declaration addresses the particular subject matter that is relevant to the rejection to be overcome.
- When a disclosure of subject matter is made by someone who is not part of the inventive entity, explain how knowledge of the subject matter was passed from the inventive entity to the discloser.

Tips for drafting rule 130 declarations (cont.)

- If a (joint) inventor's communication of subject matter to a discloser is non-public and/or within the one-year grace period, say so in the declaration in order to avoid the question of whether the communication itself constitutes prior art.
- The declaration should be clear as to how the declarant came to have knowledge of the asserted facts. Tell the story! This is particular relevant when a non-inventor is the declarant.
- When attempting to attribute a potential prior art disclosure to the inventor (rule 130(a)), explain the role of any co-authors of the disclosure who are not also joint inventors named in the application.
- When asserting prior public disclosure (rule 130(b)), include a copy of the disclosure if it was made by way of a printed publication.

Additional information

- See the rule 130 declaration examiner training available at <https://www.uspto.gov/sites/default/files/documents/FITF%20Evidentiary%20Declarations.pdf>.
- For questions, contact the Office of Patent Legal Administration (OPLA) help line at (571) 272-7754.

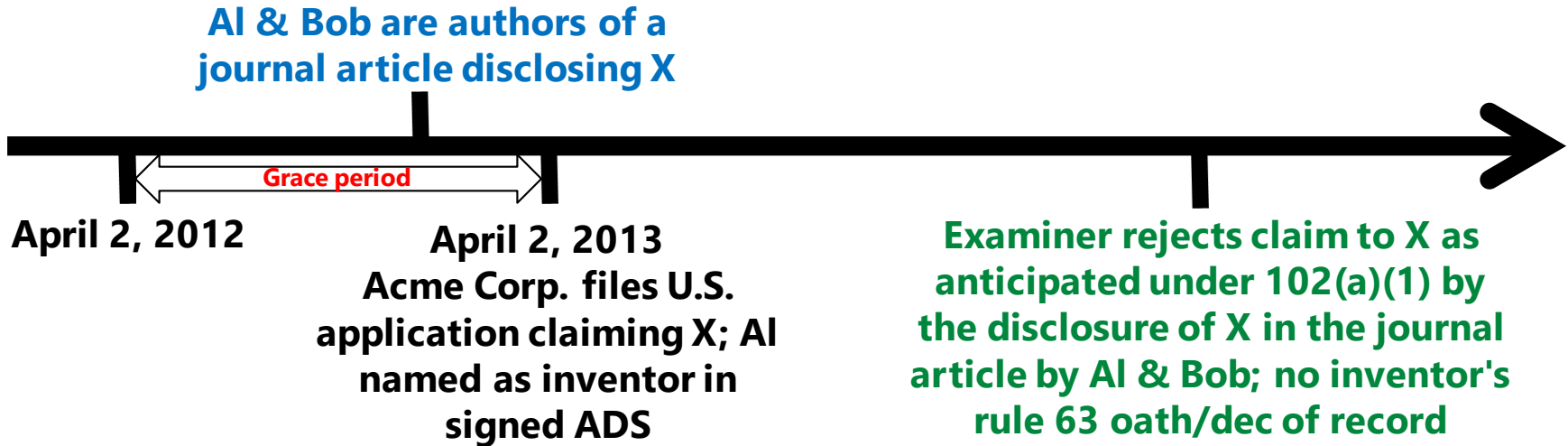
Appendix: Rule 130 declaration examples from examiner training

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!



Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration signed by AI averring that AI is the sole inventor of X as disclosed in the journal article. AI 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 AI 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.)

130(a)



That's my work!

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).

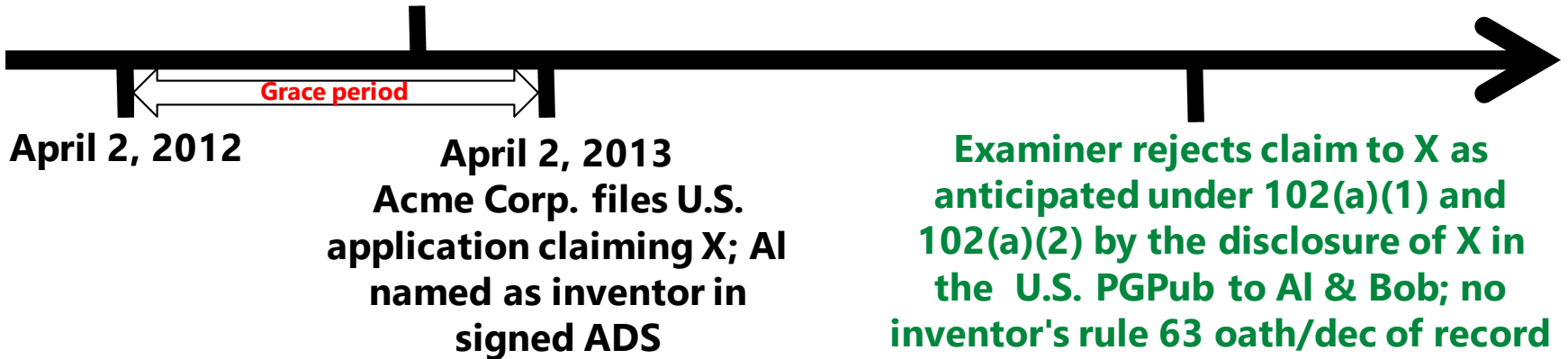
Example 2: 130(a) Declaration to Invoke 102(b)(1)(A) and (b)(2)(A) Exceptions for Inventor-Originated Disclosure

130(a)



That's my work!

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



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.

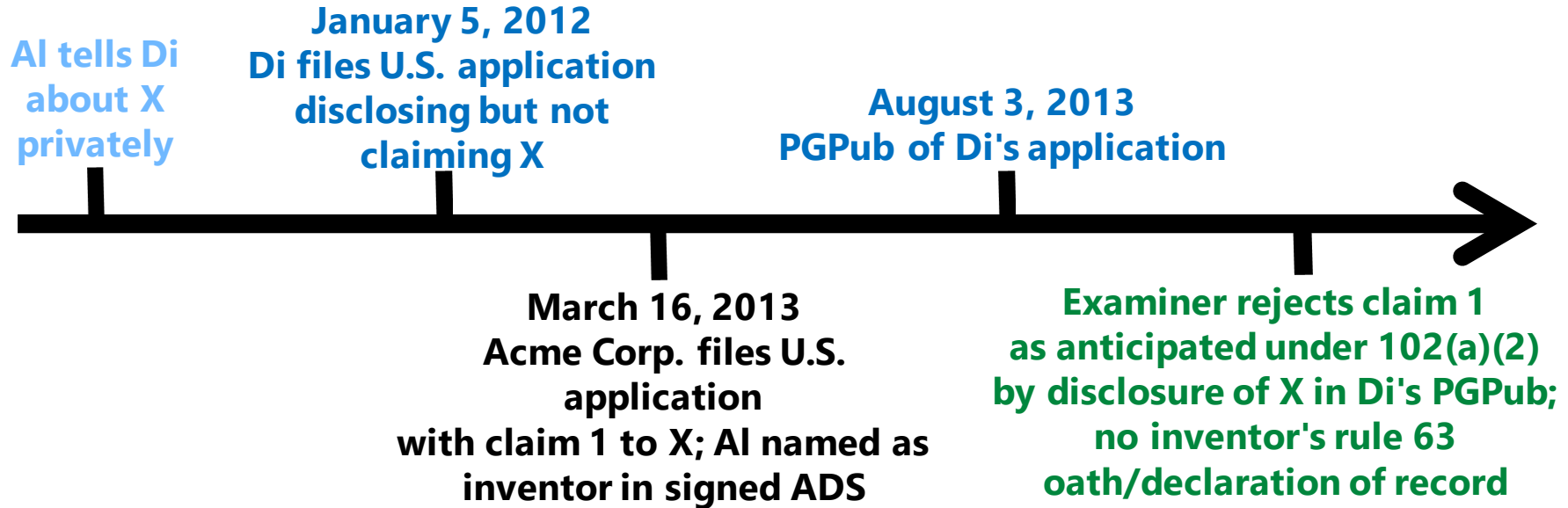
The examiner should use form paragraph 7.68.aia, and explain in the next Office action why the declaration is insufficient.

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.

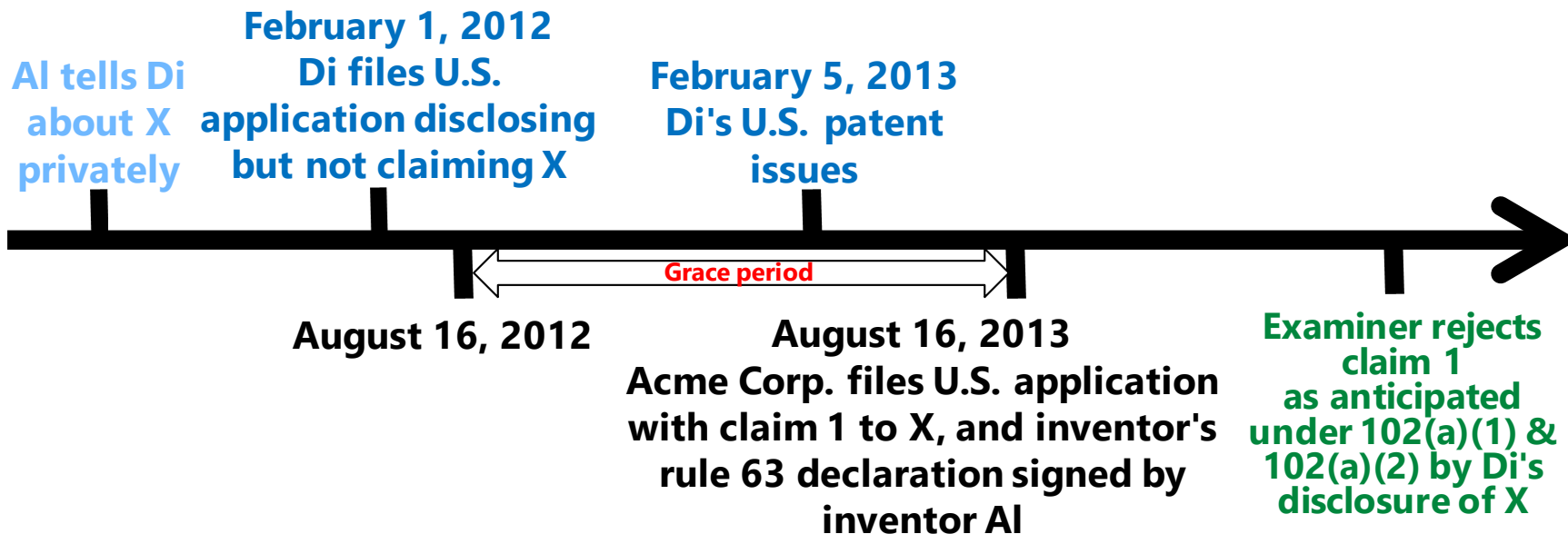
See *In re Facius*, 161 USPQ 294 (CCPA 1969) and MPEP 717.01(a)(1).

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 (cont.)

130(a)



That's my work!

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

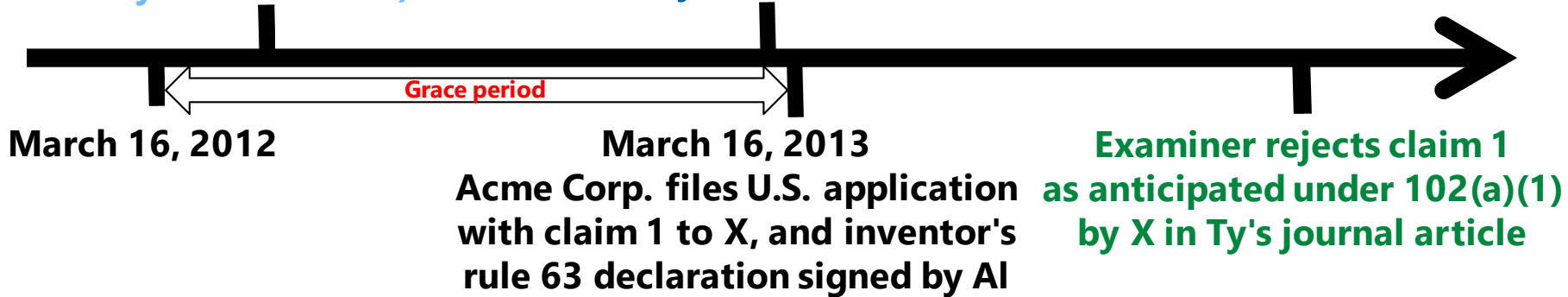


June 7, 2012

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



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.

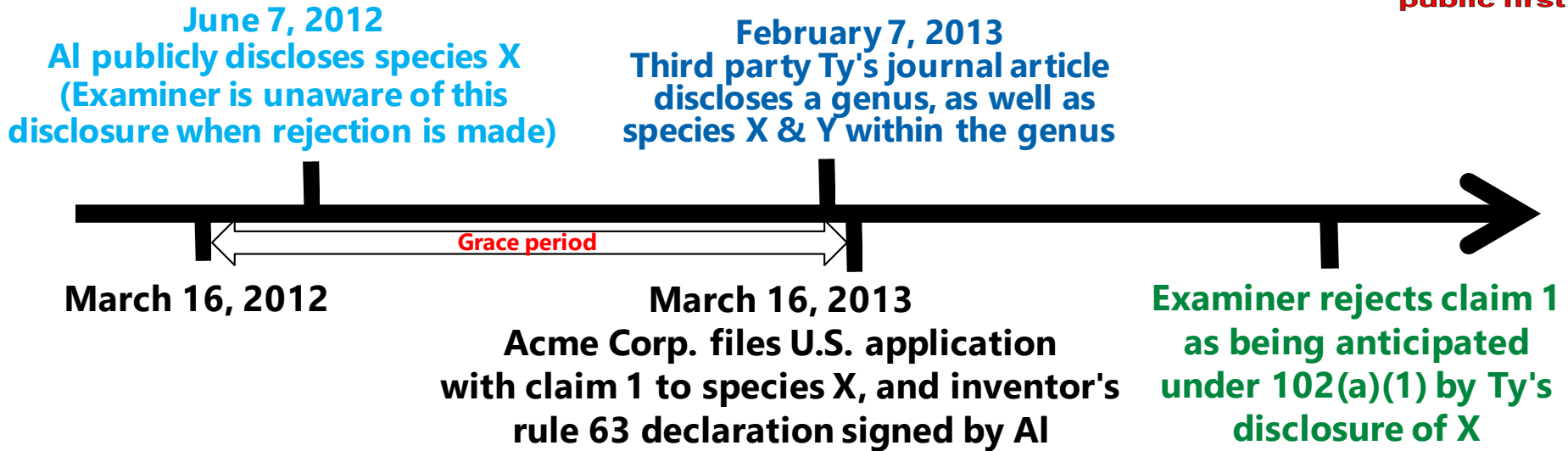
If the examiner had been aware of Al's June 7, 2012 disclosure of X, the rejection over the disclosure of X in Ty's journal article would not have been appropriate.

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

130(b)



I made it public first!



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.