

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Rule 130 Declarations for First-Inventor-to-File Applications

**Biotech/Chem/Pharma Customer Partnership Meeting
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Topics for Discussion

- Purpose of rule 130 declarations
- Examiner evaluation of rule 130 declarations
- Tips and traps for drafters of rule 130 declarations

Declarations under 130(a) and 130(b)

declaration rule	applicable exception	purpose
130(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)	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.

130(a) Declaration 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.

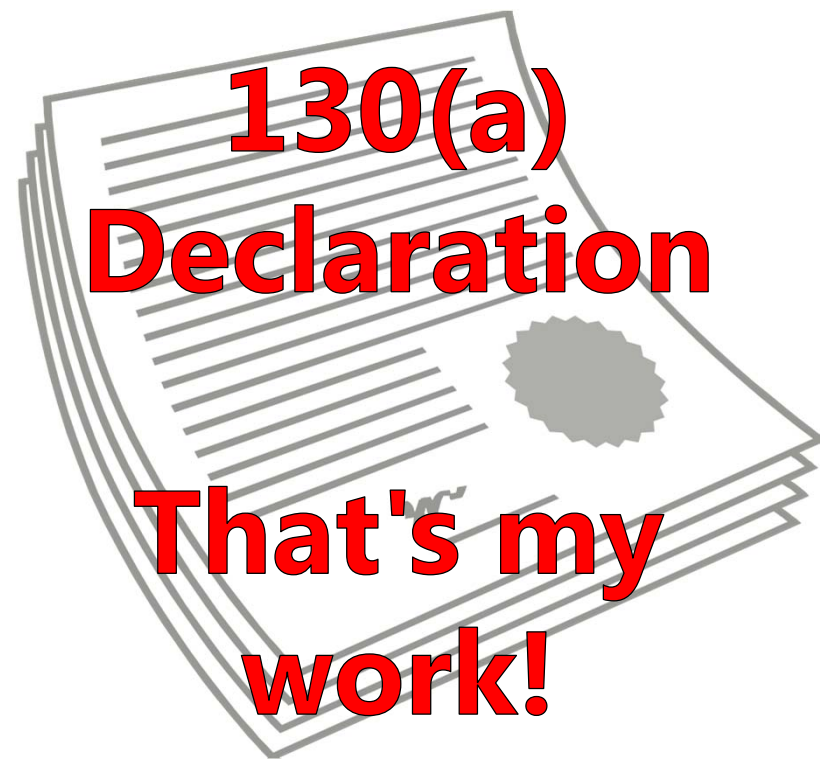
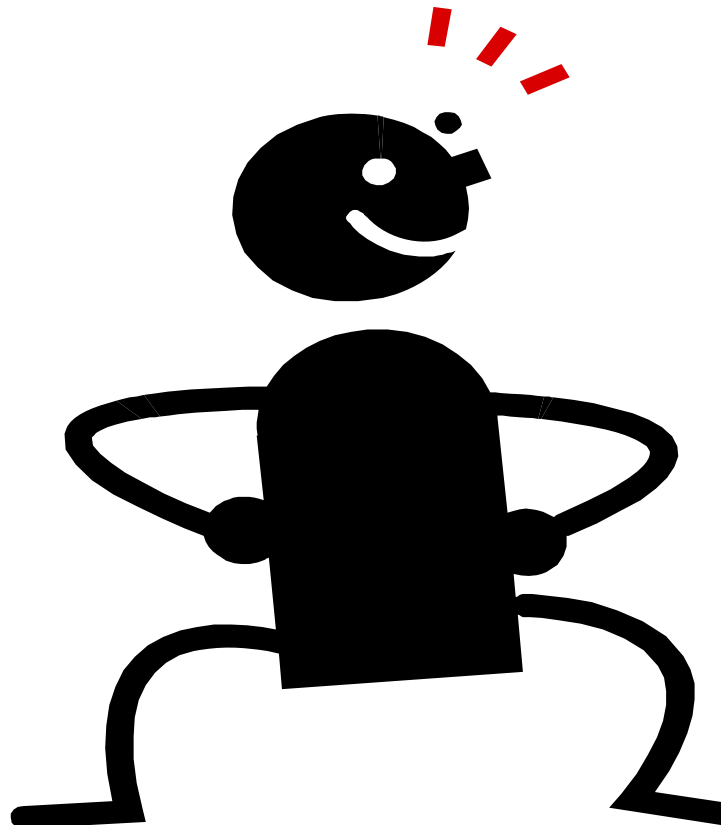
130(a) Declaration of Attribution

A declaration of attribution under rule 130(a) is used to invoke the exception under 35 U.S.C. 102(b)(1)(A) or 102(b)(2)(A).

- 102(b)(1)(A) exception:
 - A potential prior art 102(a)(1) disclosure made one year or less before the effective filing date of a claimed invention is not prior art to the claimed invention if it was an inventor-originated disclosure.
- 102(b)(2)(A) exception:
 - A potential prior art 102(a)(2) disclosure is not prior art to the claimed invention if it was an inventor-originated disclosure. The one-year grace period is not relevant to any of the 102(b)(2) exceptions.

See MPEP 2153.01 and 2154.02(a) for more information about the 102(b)(1)(A) and 102(b)(2)(A) exceptions.

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



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.

130(b) Declaration of Prior Public Disclosure

A declaration of prior public disclosure under rule 130(b) is used to invoke the exception under 35 U.S.C. 102(b)(1)(B) or 102(b)(2)(B).

- 102(b)(1)(B) exception:
 - A potential prior art 102(a)(1) disclosure made one year or less before the effective filing date of a claimed invention is not prior art to the claimed invention if the subject matter of the potential prior art disclosure was disclosed in a previous inventor-originated public disclosure.
- 102(b)(2)(B) exception:
 - A 102(a)(2) disclosure is not prior art to the claimed invention if the subject matter of the potential prior art disclosure was disclosed in a previous inventor-originated public disclosure. The grace period is not relevant to any of the 102(b)(2) exceptions.

See MPEP 2153.02 and 2154.02(b) for more information about the 102(b)(1)(B) and 102(b)(2)(B) exceptions.

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



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

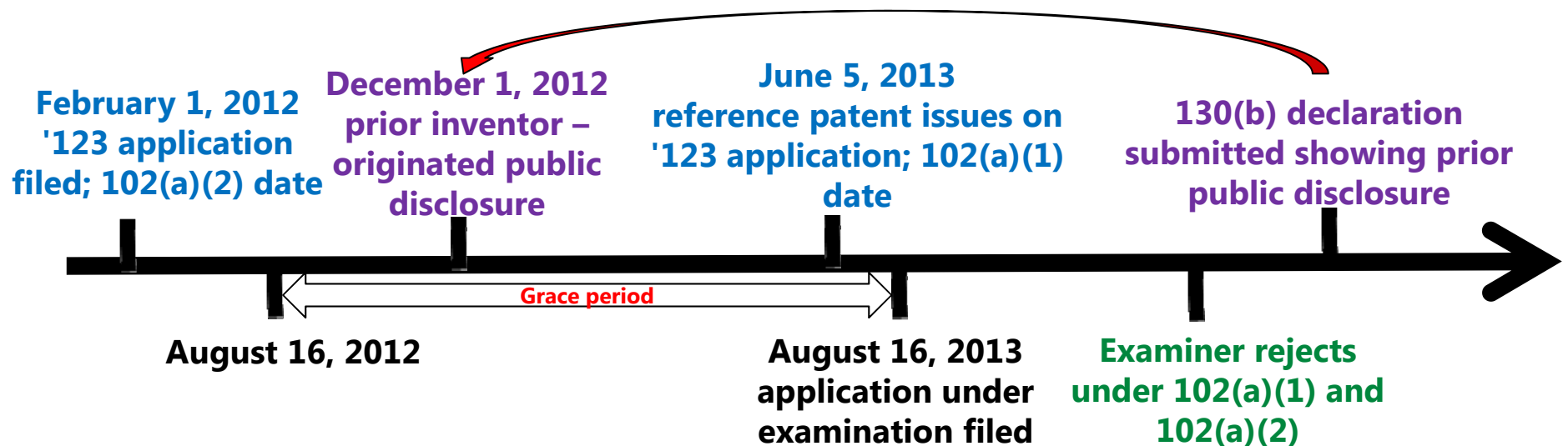
- An effective 130(a) or (b) declaration disqualifies a disclosure (which may be just a portion of a reference) as prior art, either under 102(a)(1) or 102(a)(2), or both.

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.

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.

Some Rule 130 Declaration Statistics

- Since the first-inventor-to-file provisions of the AIA took effect on March 16, 2013, the USPTO has received 431 rule 130 declarations (as of the end of FY16).
- Of these 431 declarations,
 - 383 were 130(a) declarations (first one June 20, 2013)
 - 48 were 130(b) declarations (first one September 8, 2014)

Topics for Discussion

- Purpose of rule 130 declarations
- Examiner evaluation of rule 130 declarations
- Tips and traps for drafters of rule 130 declarations

Examiner Evaluation of 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 any 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)

Examiners should not make a rejection based on a 102(a)(1) disclosure during the one-year grace period (or if made, it 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)

Examiners should not make a rejection 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).

Examiner Evaluation of 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).

Examiners Should Focus on the Substance of a Declaration, Regardless of Its Caption

- Examiners should not refuse to consider a declaration merely because it is not captioned properly. See MPEP 717.01(a)(1).
- For example, a declaration purporting to show attribution (the 102(b)(1)(A) or 102(b)(2)(A) exceptions) should not be refused merely because it is not captioned as a rule 130(a) declaration.

Acknowledging 130(b) Declarations on Forms



- The examiner will **mark the 130(b) declaration acknowledgment checkbox** and provide the filing date of the 130(b) declaration on various 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.

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

130(b)



I made it public first!

Office Action Summary	Application No. 99/XXX,XXX	Applicant(s) SMITH ET AL.	
	Examiner PAT N. LEGAL	Art Unit 1xxx	AIA (First Inventor to File) Status 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 []

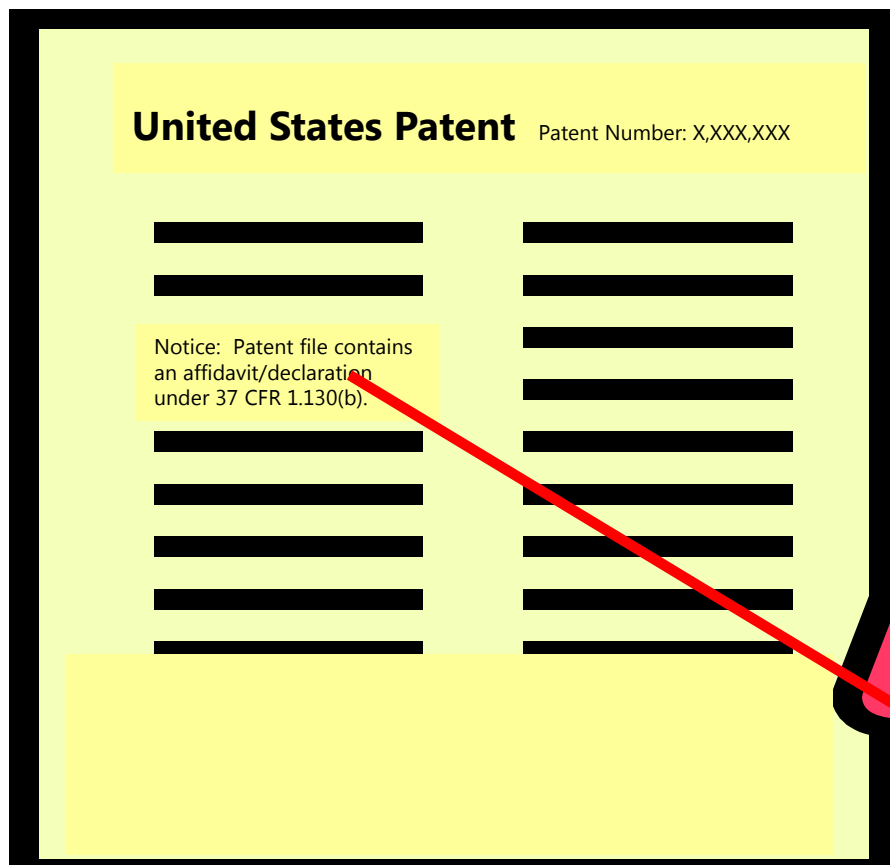
☐ A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on []

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) Declaration Information on the Face of an Issued Patent May Be Useful During Prosecution of a Different Application



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).

Topics for Discussion

- Purpose of rule 130 declarations
- Examiner evaluation of rule 130 declarations
- Tips and traps for drafters of rule 130 declarations

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

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 one-year 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).

Common Mistakes in Rule 130 Declarations

Do not file any rule 130 declaration –

- in a provisional application
- in place of an inventor's oath or declaration under rule 63
- to invoke the 102(b)(2)(C) common ownership exception; a statement is sufficient

Common Mistakes in Rule 130 Declarations (cont.)

Do not file a rule 130(a) declaration –

- to show attribution when the public availability date of the reference is before the one-year grace period
- when the public disclosure is made only by one or more members of the inventive entity within the one-year grace period

Common Mistakes in Rule 130 Declarations

Do not file a rule 130(a) declaration –

- when a 102(a)(2) disclosure in a U.S. patent document names only one or more joint inventors but not the entire inventive entity, and does not name anyone else.

Common Mistakes in Rule 130 Declarations

Do not file a rule 130(b) declaration –

- in place of an IDS. A rule 130(b) declaration needs to be in the context of a third party potential prior art reference. It should not be used to provide information about inventor disclosures outside the context of invoking the 102(b)(1)(B) or 102(b)(2)(B) exception.

Tips for Clarity in Rule 130 Declarations

- Avoid bare statements with no explanation or factual support.
- In 130(a) declarations, attribution must clearly be to the inventor or a joint inventor, and not to an assignee applicant.
- In 130(b) declarations, prior public disclosure must be traceable to the inventor or a joint inventor, and not just to an assignee applicant.

Tips for Clarity in Rule 130 Declarations (cont.)

- Avoid the “belt and suspenders” approach in a single rule 130 declaration. File two separate declarations if you want to show both attribution under rule 130(a) and prior public disclosure under rule 130(b).
- Do not include material suitable for a rule 132 declaration (e.g., evidence of nonobviousness) in a rule 130 declaration. File separate declarations.



Tips for Clarity in Rule 130 Declarations (cont.)

- Identify the particular disclosure of the potential prior art that is subject to an exception. Recall that exceptions apply to disclosures, and not necessarily to entire documents.



For More Information . . .

. . . see the First-Inventor-to-File materials
available at

<https://www.uspto.gov/patent/laws-and-regulations/america-invents-act-aia/patents-examination#heading-10>.

Appendix A

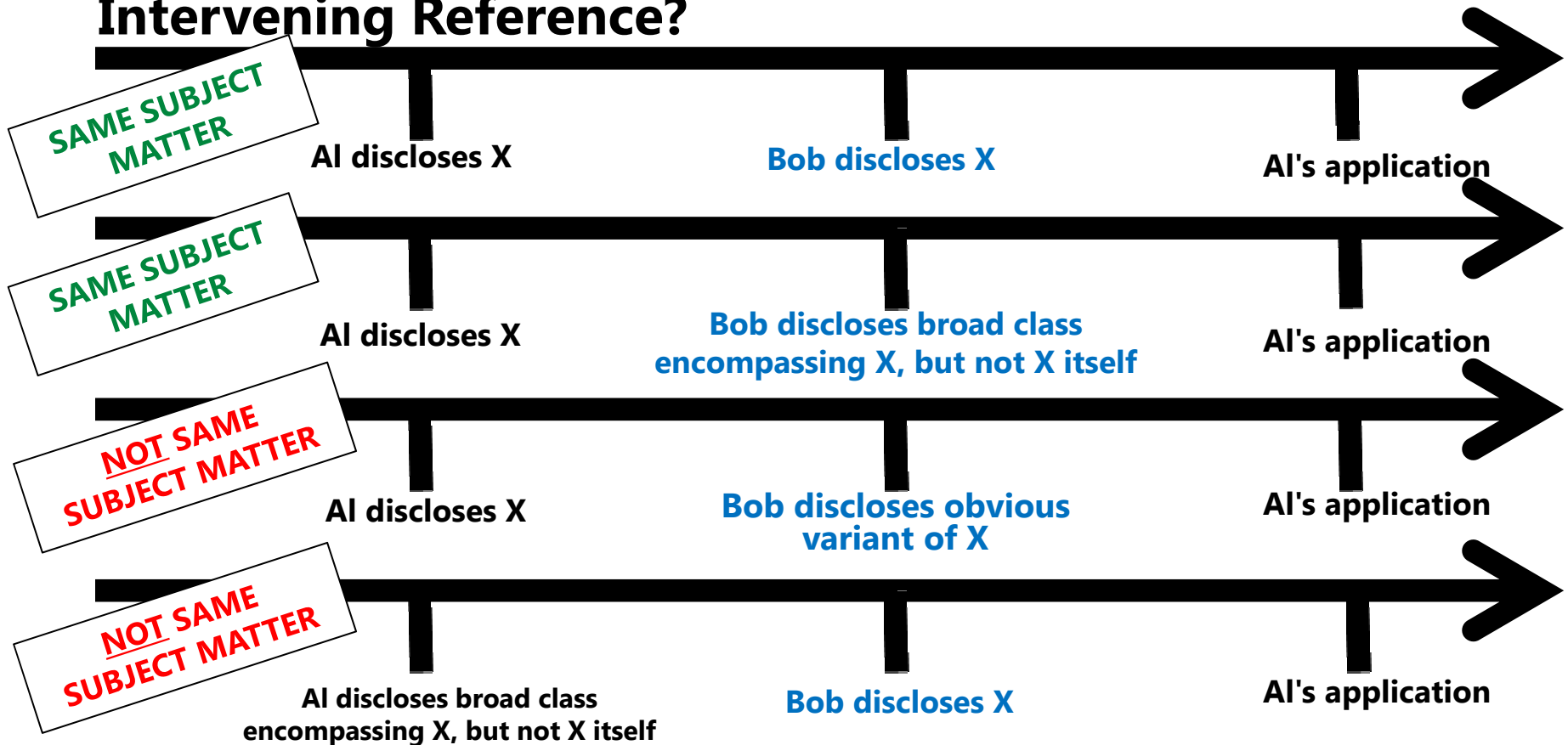
- The slides in Appendix A explain the approach that the USPTO is taking to the prior public disclosure exceptions of 102(b)(1)(B) and 102(b)(2)(B) in view of the statutory language, “the subject matter disclosed.”
- Prompt filing of patent applications is advisable due to the narrow range of subject matter that can typically be shielded from prior art by way of prior public disclosure.

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?



Does the Inventor's Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

inventor's prior public disclosure	third party's intervening disclosure	Does the inventor's prior public disclosure act as a shield?
X (e.g., a flat-head screw)	General category that includes X (e.g., a screw)	<u>Yes</u> . Rejection cannot be based on third party's disclosure of a general category that includes X.
X (e.g., a flat-head screw)	List of species that includes X (e.g., flat-head screw, Phillips head screw, and hex head screw)	<u>Partially</u> . Rejection can be based on third party's disclosure of other species, but not on the disclosure of X.
General category (e.g., screws)	A species within the general category (e.g., flat-head screw)	<u>No</u> . Rejection can be based on third party's disclosure of the species.

Does the Inventor's Disclosure Shield the Claimed Invention from the Third Party's Intervening Disclosure under 102(b)(1)(B)?

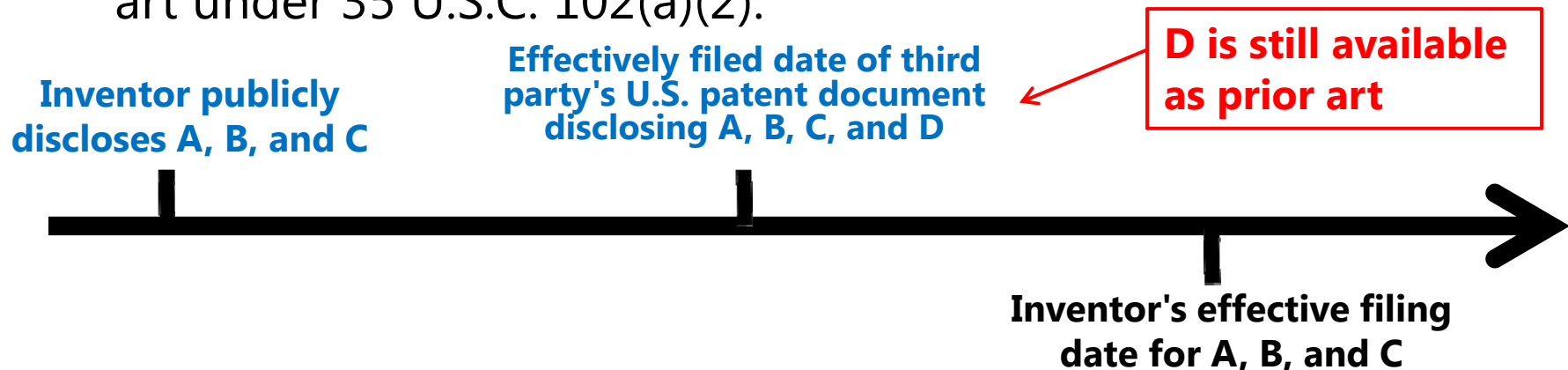
inventor's prior public disclosure	third party's intervening disclosure	Does the inventor's prior public disclosure act as a shield?
X (e.g., methyl)	General category (e.g., alkyl)	<u>Yes</u> . Rejection cannot be based on third party's disclosure of a general category that includes X.
X (e.g., methyl)	List of species that includes X (e.g., methyl, ethyl, and propyl)	<u>Partially</u> . Rejection can be based on third party's disclosure of other species, but not on the disclosure of X.
General category (e.g., alkyl)	Species X (e.g., methyl) within the general category	<u>No</u> . Rejection can be based on third party's disclosure of the species.

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).



Appendix B

- The slides of Appendix B provides six examples involving Rule 130(a) and Rule 130(b) declarations.
- The examples are drawn from examiner training on 37 CFR 1.130, which is available to the public at <https://www.uspto.gov/sites/default/files/documents/FITF%20Evidentiary%20Declarations.pdf>.

Important Points to Learn from the Rule 130 Declaration Examples (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.



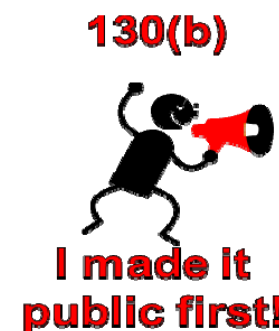
It is not necessary for the other person to provide a confirmatory statement or declaration.

Important Points to Learn from the Rule 130 Declaration Examples (cont.)

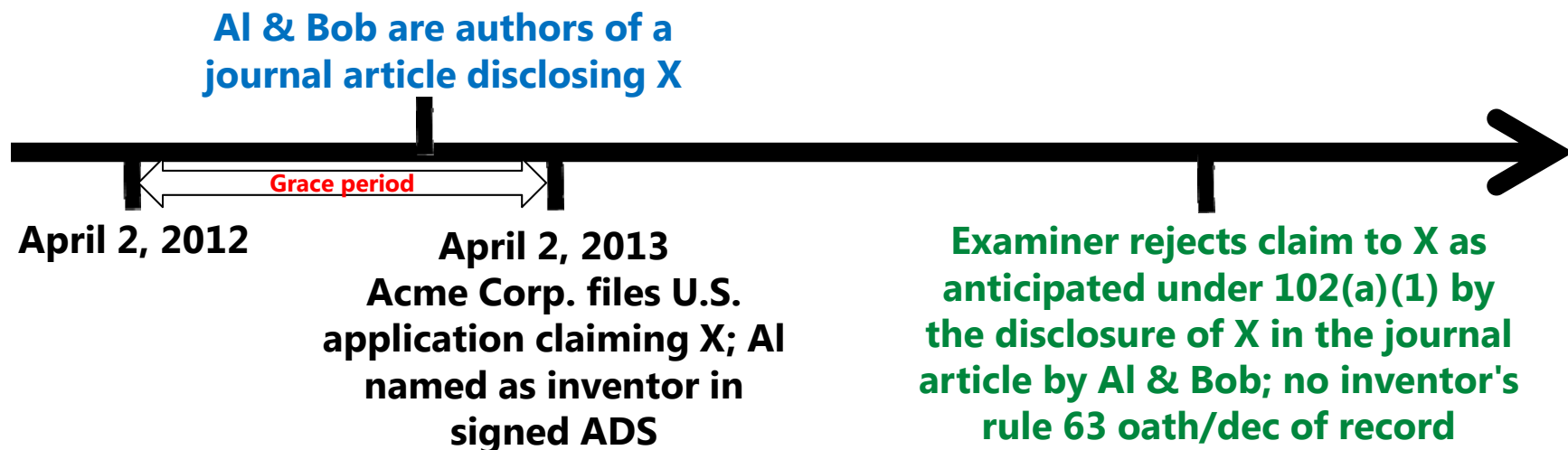
For 130(b) declarations:

In order for the 102(b)(1)(B) or 102(b)(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." For more information, click the "First Inventor to File" button on the USPTO Intranet home page, and review the "First Inventor to File Live Comprehensive Training Slides" document.



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



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.)



Answer: Yes.

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

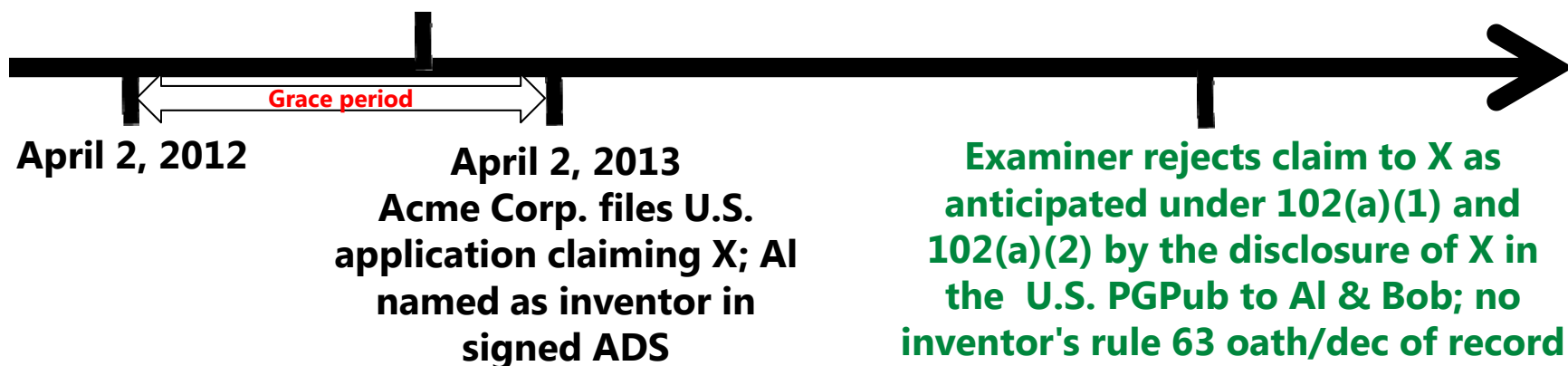
- Because AI avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- AI provides a reasonable explanation of Bob's involvement.
- There is no evidence in the record that contradicts the declaration. For example, the specification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



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.)



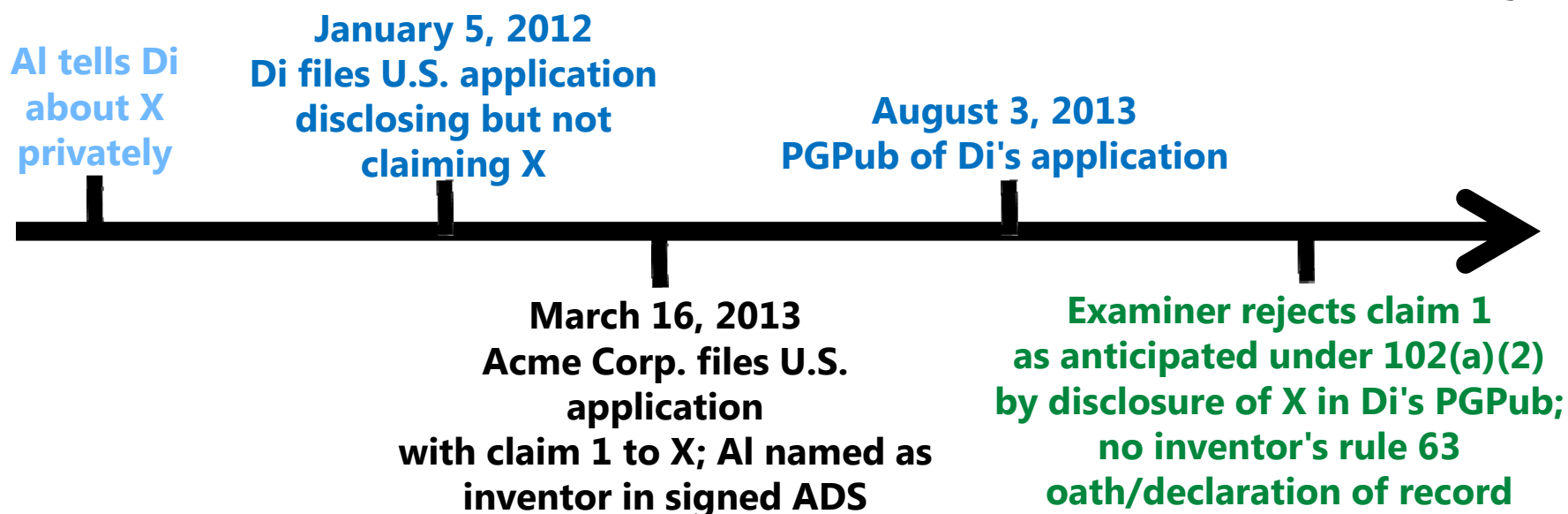
Answer: No, for both.

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



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.)



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.

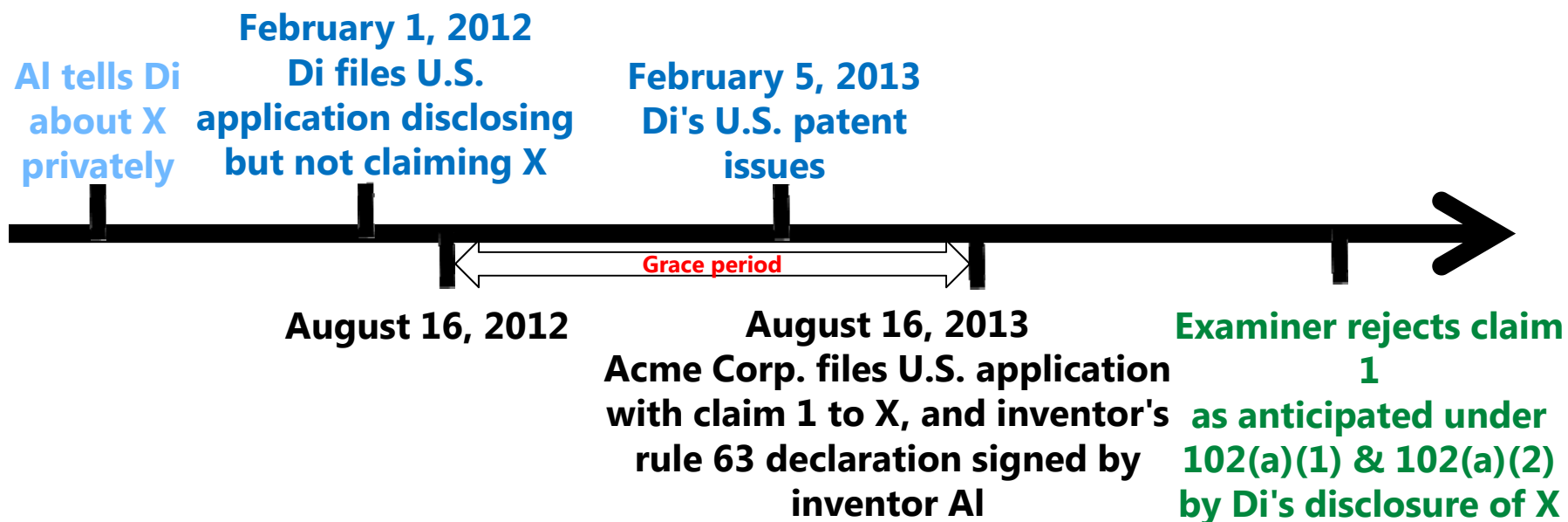
An inventor-originated disclosure is a disclosure of subject matter that was invented by someone who is named as the inventor or a joint inventor in the application under examination.

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



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.)



Answer: Yes, for both.

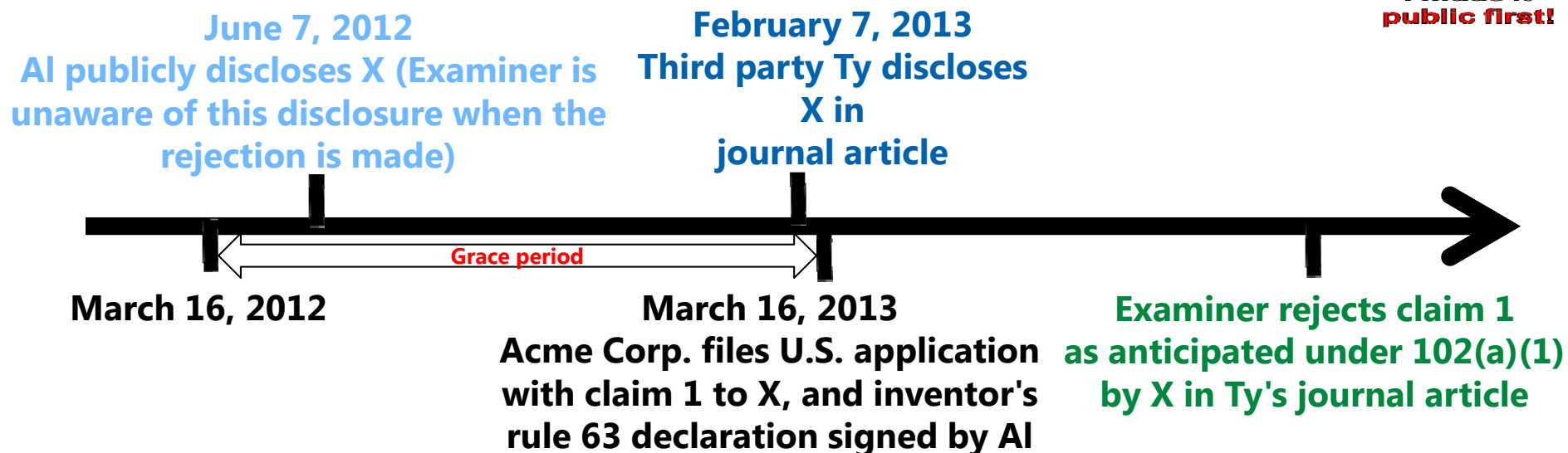
The declaration is sufficient to disqualify the disclosure of X in Di's patent as both 102(a)(1) and 102(a)(2) prior art.

- 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



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
Al 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



Applicant's Reply: Acme Corp.'s attorney files a 130(b) declaration signed by Al in which Al 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 Al 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 Al 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.