37 CFR § 1.132 Practice

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Objectives

- To become familiar with 37 CFR 1.132 and why it is used by applicants.

- To understand the conditions under which 37 CFR 1.132 may be used.

- To recognize the various types of declarations that may be filed under 37 CFR 1.132.
Topics to be Covered

- What is 37 CFR 1.132?
- Overview and Formalities
- Types of Declarations under 37 CFR 1.132
37 CFR 1.132

“When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.”

“Affidavit” and “declaration” are used interchangeably in this presentation.

The rule permits applicants to provide evidence to overcome a ground of rejection or an objection.

Anyone may make a declaration under 37 CFR 1.132

- e.g., applicant, applicant’s co-worker, independent expert, or others. No special qualifications required.
Burden Shifts to Applicant

- Once the examiner has established a *prima facie* case of obviousness, the burden shifts to the applicant to show nonobviousness by presenting evidence of secondary considerations.
Examples of Types of Declarations under 37 CFR 1.132

1. Unexpected results – MPEP 716.02(a)-(g)
2. Commercial Success – MPEP 716.03(a)-(b)
3. Long-Felt Need and Failure of Others – MPEP 716.04
4. Inoperability of References – MPEP 716.07
5. Skepticism of Experts – MPEP 716.05
6. Copying – MPEP 716.06
Timeliness

A declaration under 37 CFR 1.132 is timely filed if received:

- Prior to a final rejection
- Before appeal in a case with no final rejection
- After final rejection but before or on the same date of filing an appeal (37 CFR 1.116(e))
  - Applicant must provide a showing of good and sufficient reasons why the declaration or other evidence is necessary and was not earlier presented
- After appeal, but prior to filing of an appeal brief, if compliant with 37 CFR 41.33(d)
- With a properly filed RCE under 37 CFR 1.114

See MPEP 716.01, Section A.
Declarations Must Be Addressed In The Next Office Action

- If the evidence is insufficient to overcome the rejection, the examiner must clearly and specifically explain why the evidence is insufficient. See MPEP 716.01, section B.

  - e.g., “The declaration under 37 CFR 1.132 filed May 1, 2007, is insufficient to overcome the rejection under 35 U.S.C. 103(a) of claims 1-5 based upon the Smith reference because . . .” (explain why the evidence presented was not persuasive).

  - General statements such as “the declaration lacks technical validity” or “the evidence is not commensurate in scope with the claims” without an explanation supporting such findings are unacceptable.
Declarations Must Be Addressed In The Next Office Action (cont’d)

- If the evidence is sufficient to overcome the rejection, the comments should be consistent with the guidelines for reasons for allowance provided in MPEP 1302.14.
  - e.g., “The declaration under 37 CFR 1.132 filed May 1, 2007, is sufficient to overcome the rejection of claims 1-5 under 35 U.S.C. 103 based upon the Smith reference because . . .” (provide reasons).

- Form Paragraphs 7.65, 7.66 and any of form paragraphs 7.66.01 through 7.66.05, may be used as appropriate.
Declarations Must Be Addressed In The Next Office Action (cont’d)

- If the examiner is not considering the declaration on the merits, the examiner must provide a clear explanation of the reason.

  - e.g., “The declaration under 37 CFR 1.132 filed May 1, 2007, is not timely because . . .” (provide reasons).

“When an applicant puts forth relevant rebuttal evidence . . . the Board must consider such evidence . . . That is not to suggest that the Board’s finding of obviousness must be overturned in light of the evidence; rather, the Board must give the declarations meaningful consideration before arriving at its conclusion.” In re Sullivan, 2007 U.S. App. 20600 (August 29, 2007).
Analysis of Declarations under 37 CFR 1.132

- To be of probative value, objective evidence must be **factually** supported by an appropriate declaration. See MPEP 716.01(c).

- Arguments of counsel cannot take the place of evidence in the record. See *In re Schulze*, 346 F.2d 500, 602, 145 USPQ 716, 718 (CCPA 1965).

- Attorney statements regarding, e.g. unexpected results, commercial success, long-felt need, inoperability of the prior art, skepticism of experts, and copying are not evidence without a supporting declaration.
Analysis of Declarations under 37 CFR 1.132 (cont’d)

- Declarations may include statements in the form of:
  - Evidence of a fact – comparative test results, sales figures
  - An opinion – statement expressing what the declarant thinks, believes, or infers with regard to certain facts.
  - An allegation – a totally unsupported or uncorroborated statement; e.g., conclusory statements unsupported by factual evidence
Analysis of Declarations under 37 CFR 1.132 (cont’d)

- Weight to be afforded:
  - Evidence of a fact – weight is governed by relevance
  - Opinion – weight is influenced by the underlying basis
  - Allegation – not entitled to any weight
Examples of types of evidence:

- Comparative test data are used to show unexpected results
- Sales figures are used to show commercial success
- Articles, publications, declarations by one of ordinary skill are used to show long-felt need
- Comparative test data and declarations by one of ordinary skill are used to show inoperability of a reference
Analysis of Declarations under 37 CFR 1.132 (cont’d)

- Factual evidence is preferable to opinion testimony. See MPEP 716.01(c), Section III.
  - Declarant should lay out facts, supported by evidence.
  - Expert opinion supported by documentary evidence may be given weight. See In re Carroll, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979).
  - Opinion on the ultimate legal conclusion at issue is not entitled to any weight, although the underlying basis for the opinion may be given some weight. See In re Chilowsky, 306 F.2d 908, 134 USPQ 515 (CCPA 1962).
  - Any interest of the expert in the outcome of the case should be taken into consideration.
Analysis of Declarations under 37 CFR 1.132 (cont’d)

- To be of probative value, evidence of secondary considerations must be related to the claimed invention. See MPEP 716.01(b).

- The examiner must determine whether there is a nexus between the invention as claimed and the evidence of secondary considerations.

  “Nexus” designates a legally and factually sufficient connection between the claimed invention and the objective evidence of nonobviousness such that the evidence should be considered in the determination of nonobviousness. See Demaco Corp. v. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988).
Analysis of Declarations Under 37 CFR 1.132 – The Last Step

- The ultimate determination of patentability must be based on consideration of the entire record by a preponderance of the evidence. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). See also MPEP 716.01(d).

- In other words, an examiner should reject a claim if, in view of the prior art and and any secondary evidence of record, it is “more likely than not” that the claim is unpatentable.
Analysis of Declarations Under 37 CFR 1.132 – The Last Step (cont’d)

- The submission of objective evidence of patentability does not mandate a conclusion of patentability. See In re Payne, 606 F.2d 303, 203 USPQ 245 (CCPA 1979).

- A strong case of obviousness may be established such that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. See MPEP 716.01(d).

- See MPEP 2145 for guidance in determining whether rebuttal evidence is sufficient to overcome a prima facie case of obviousness.
Review of the examiner’s decision that the declaration under 37 CFR 1.132 does not overcome a rejection is by appeal to the Board.
1. Unexpected Results

- Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is **really unexpected**. See MPEP 716.02.

- Evidence of unexpected results is frequently in the form of a **direct comparison** of the claimed invention with the closest prior art which is **commensurate in scope with the claims**.

See, e.g., *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).
1. Unexpected Results (cont’d)

- The declaration should include:
  - A description of precisely what was tested. It must include both:
    - The invention as claimed, AND
    - The closest prior art
  - A description of all of the test conditions.
  - Test results. The results must include both:
    - The results of the test performed on the invention as claimed, AND
    - The results of the test performed on the closest prior art
  - An analysis of the test results.
1. Unexpected Results (cont’d)

- The comparison must be under the identical conditions except for the novel features of the invention.

- Precisely what was done should be recited in the declaration. The actual steps carried out, the materials employed, and the results obtained should be spelled out. Nothing concerning the work relied upon should be left to conjecture.

- Conclusory statements such as “the prior art invention did not perform well” without a showing of the actual results of the test performed on the prior art AND on the claimed invention is insufficient.
1. Unexpected Results (cont’d)

- The claimed invention must be compared with the closest subject matter that exists in the prior art. See MPEP 716.02(e).

- Applicant cannot be required to compare the claimed invention with an invention suggested by a combination of references relied upon by the examiner in a 103 rejection. This would be “requiring comparison of the results of the invention with the results of the invention.” *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966).

- The claimed invention may be compared with prior art that is closer than that applied by the examiner. See *In re Holladay*, 584 F.2d 384, 199 USPQ 5416 (CCPA 1978).
1. Unexpected Results (cont’d)

- The showing of unexpected results must be commensurate in scope with the invention as claimed. See MPEP 716.02(d).

- The results must be due to the *claimed* features, not to *unclaimed* features.

  - The examiner must also consider whether there are features which are included in the tests reported in the declaration which are not in the claims.
1. Unexpected Results (cont’d)

- The unexpected property or result must actually be unexpected and of statistical and practical significance. See MPEP 716.02(a).

- Synergism is merely a property like any other property – it may be expected or unexpected depending on the particular art.

- The burden is on the applicant to establish that the results are in fact unexpected, unobvious, and of statistical and practical significance. See MPEP 716.02(b). See also Ex parte Gelles, 22 USPQ2d 1318 (Bd. Pat. App. & Inter. 1992).
1. Unexpected Results (cont’d)

- The specification does not need to teach superiority over the prior art, or the advantage of having or using a feature.

- The feature or property in which the superiority or advantage resides must be disclosed, or must inherently flow from the disclosure.

  - The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971).

See MPEP 716.02(f).
2. Commercial Success

- In a declaration of commercial success, the declarant attempts to show that the claimed invention has broad acceptance in the marketplace, which is used as evidence of nonobviousness.

- The key is to show that the success is linked to the claimed invention and not to some extraneous factor.
2. Commercial Success (cont’d)

The declaration should include at least:

- A description of what was sold.
  - It must include the features of invention as claimed.
- A description of the relevant market for the product.
- Sales results. The results should include evidence of market share such as:
  - Total sales for competing products in the market
    - Indicate differences between these products and the applicant’s
  - Total sales for products embodying the invention
  - Pricing of the various products.
- Information on advertising within the relevant market.
- Any other information relevant to the inquiry.
2. Commercial Success

- The declaration must establish a **nexus** between the claimed features of the invention and the commercial success. See MPEP 716.03(a).

  - The commercial success must be due to the **claimed** features, and not due to **unclaimed** features. For example, evidence showing commercial success of “cups” is not commensurate in scope with claims directed to “containers” broadly.

- Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498 (Bd. Pat. App. & Interf. 1990).
2. Commercial Success (cont’d)

- The examiner should determine that the commercial success is not derived from other factors (see MPEP 716.03(b)), for example:
  - heavy promotion or advertising, or position as market leader before the introduction of the patented product. See *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir 1985).
  - brand name recognition
  - recent changes in related technology or consumer demand. See *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973).
  - consumption by purchasers normally tied to applicant or assignee
2. Commercial Success (cont’d)

- Gross sales figures do not show commercial success absent evidence as to market share. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1025, 226 USPQ 881 (Fed. Cir. 1985)

- Inventor’s opinion as to the purchaser’s reason for buying the product, alone, is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang*, 100 F.3d 135, 40 USPQ 2d 1685 (Fed. Cir. 1996)
3. Long-Felt Need and Failure of Others

A successful showing of long-felt need should include evidence of three factors:

- The need must have been a persistent one that was recognized by those of ordinary skill in the art. See *In re Gershon*, 372 F.2d 535, 152 USPQ 602 (CCPA 1967).

- The long-felt need must not have been satisfied by another before the invention by applicant. See *Newell Companies v. Kenney Mfg. Co*, 864 F.2d 757, 9 USPQ2d 1417 (Fed. Cir. 1988).

- The invention must in fact satisfy the long-felt need. See *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

See MPEP 716.04
3. Long-Felt Need and Failure of Others (cont’d)

- Applicant’s claim that the problem was “first recognized” by him contradicts a showing of long-felt need.

  “Since the alleged problem . . . was first recognized by appellants, and others have not yet become aware of its existence, . . . there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others . . . to solve a problem of which they were not aware.” *In re Gershon*, 372 F.2d 535, 152 USPQ 602 (CCPA 1967).

- The evidence must show unsuccessful efforts to solve the problem.

  See *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result, there was no evidence of any prior unsuccessful attempts to do so.)
3. Long-Felt Need and Failure of Others (cont’d)

- The existence of a prior art reference showing a solution to the problem is evidence that there is no long-felt need.

- Evidence of persistent need may be a series of patents or publications showing the problem to be solved and a solution which declarant claims is inoperable.
4. Inoperability of References

- Every patent is presumed to be valid and operable. Allegations that a U.S. patent is inoperative should be treated with **considerable skepticism**. See MPEP 716.07.

- The declaration must show that the steps a person of ordinary skill would take in attempting to achieve the claimed results would not result in an operative invention.
  - If a desired result is not immediately obtained, a skilled worker would make certain adaptations. The failures of experimenters who have no interest in succeeding should not be accorded great weight. See *in re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947).
4. Inoperability of References (cont’d)

- Where a declaration asserts inoperability in features of the reference that are not relied upon, **the reference is still effective as to other features which are operative.** See *In re Shephard*, 172 F.2d 560, 80 USPQ 495 (CCPA 1949).

- Applicant’s claims must distinguish from the alleged inoperative disclosure. See *In re Crosby*, 157 F.2d 198, 71 USPQ 73 (CCPA 1946).

- If a patent teaches the claimed invention, a declaration by patentee that he did not intend the disclosed invention to be used as claimed by applicant is immaterial. See *In re Pio*, 217 F.2d 956, 104 USPQ 177 (CCPA 1954).
5. Skepticism of Experts

- “Expressions of disbelief by experts constitute strong evidence of nonobviousness.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693 218 USPQ 865 (Fed.Cir. 1983).

- “The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention.” *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ 2d 1529 (Fed.Cir. 1988).

See MPEP 716.05.
6. Copying

- The declaration must show more than the mere fact of copying. The examiner should determine that the copying is not attributable to other factors such as:
  - lack of concern for patent property
  - contempt for patentees ability to enforce patent

See *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985).

- Evidence of copying was persuasive when alleged infringer tried for a substantial length of time to design a product similar to the claimed invention, but failed and then copied the invention instead. See *Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 459, 2 USPQ2d 1350 (Fed. Cir. 1987).

See MPEP 716.06.
Reminder

- The weight given to a declaration also depends on whether it presents allegations, opinions or facts.

- The weight to be given declarations is a judgment call based on the particular facts of the case.
Thank You!

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