

First Inventor to File (FITF) Training



**Declarations of Attribution
or Prior Public Disclosure
Under 37 CFR 1.130**



Topics of Discussion



- **New Rule 37 CFR 1.130 and Evaluation of Declarations**
 - 130(a) Declarations of Attribution
 - 130(b) Declarations of Prior Public Disclosure
- **Formal Requirements for 130 Declarations**
- **Examples of 130(a) and (b) Declarations**
- **Acknowledging 130 Declarations in Office Actions**
- **Comparison of Declarations for Pre-AIA and AIA Applications**



Summary of New Regulation 37 CFR 1.130

- Revised 37 CFR 1.130 (aka rule 130) applies only to AIA(FITF) cases.*
- Rule 130(a) provides for a declaration of attribution, and is a way to invoke the 102(b)(1)(A) or 102(b)(2)(A) exception.
- Rule 130(b) provides for a declaration of prior public disclosure, and is a way to invoke the 102(b)(1)(B) or 102(b)(2)(B) exception.
- Although the term "declaration" is used in this presentation, rule 130 applies to affidavits as well. These two types of evidence differ as to formalities, but not as to substantive requirements.

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



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.



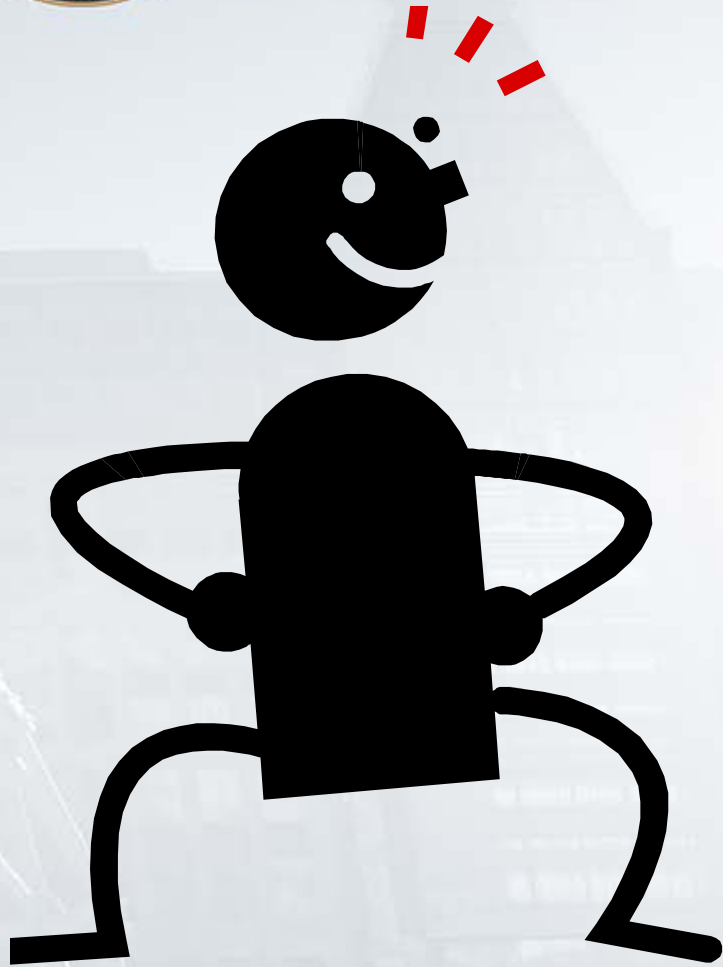
130(a) Declaration of Attribution

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.



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



**130(a)
Declaration
That's my
work!**



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 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.



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





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.



Evaluating Rule 130(b) Declarations of Prior Public Disclosure

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

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

See MPEP 717.01(b)(1).

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



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

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

See MPEP 717.01(b)(2).



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

SAME SUBJECT MATTER

AI discloses X

Bob discloses X

AI's application

SAME SUBJECT MATTER

AI discloses X

Bob discloses broad class encompassing X, but not X itself

AI's application

NOT SAME SUBJECT MATTER

AI discloses X

Bob discloses obvious variant of X

AI's application

NOT SAME SUBJECT MATTER

AI discloses broad class encompassing X, but not X itself

Bob discloses X

AI's application



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) | Partially. 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) | Partially. 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. |



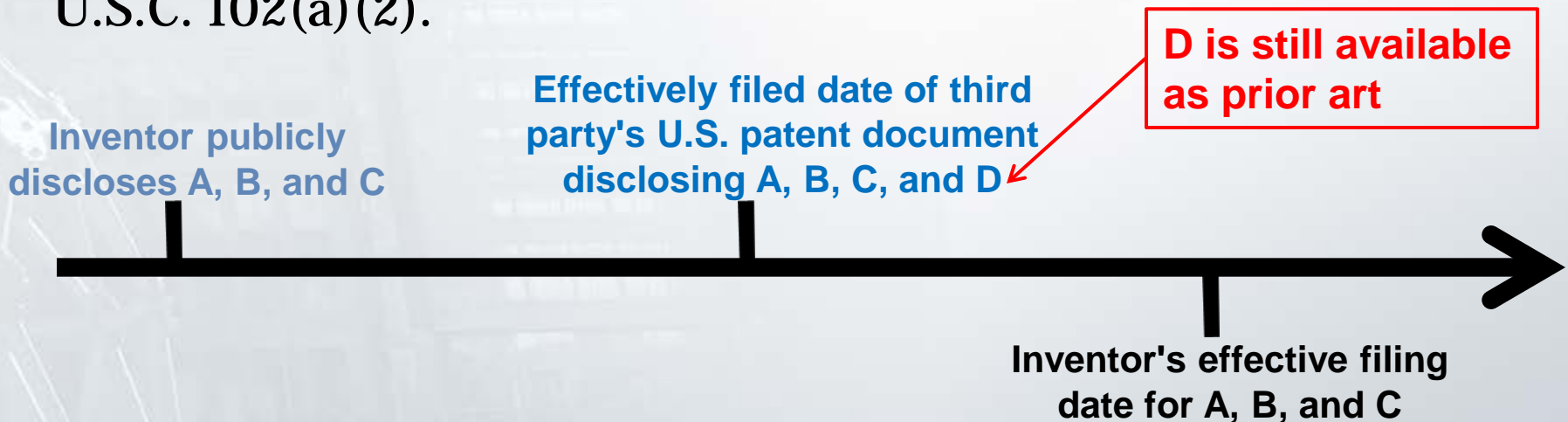
It Is Possible For Only a Portion of a Third Party's Disclosure to Be Disqualified as Prior Art

- 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).





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Formalities of Rule 130 Declarations

The examiner's responsibilities regarding formal requirements have not changed as compared with requirements for other evidentiary declarations that you may have encountered in pre-AIA cases.

1. Is it timely? See MPEP 717.01(f).
2. Does it include the necessary statements for declarations? See MPEP 717.01(c). If an affidavit has been submitted rather than a declaration, has it been properly witnessed? See MPEP 602 and 717.01(c).
3. If exhibits are included, do they comply with 37 CFR 1.91? See MPEP 717.01(c); see also MPEP 608.03(a).



Formalities of Rule 130 Declarations

4. Do 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) exception) should not be refused merely because it is not captioned as a rule 130(a) declaration.
5. Did an appropriate party sign the declaration? See MPEP 717.01(c). As with any evidentiary declaration, the person who signs a 130 declaration must be someone with knowledge of the facts addressed. This may be the inventor or a joint inventor, or someone else.

FYI: The person who files the declaration in the application (i.e., the person who signs the transmittal letter) must be someone who may sign a paper under 37 CFR 1.33(b). That person might not be the same as the person who signs the declaration itself. If the applicant is an organizational assignee, a registered patent practitioner must sign the transmittal letter to file the declaration; see 37 CFR 1.33(b)(3).



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).



The Preponderance Standard and Rule 130

From MPEP 2142:

"The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of 'a preponderance of evidence' requires the evidence to be more convincing than the evidence which is offered in opposition to it."

If a formally compliant rule 130 declaration has been filed, the examiner must consider it. However, the examiner is not required to withdraw any rejection merely because the declaration has been filed. The decision to make or maintain any rejection always requires evaluation of all evidence properly of record, according to the preponderance of evidence standard.



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

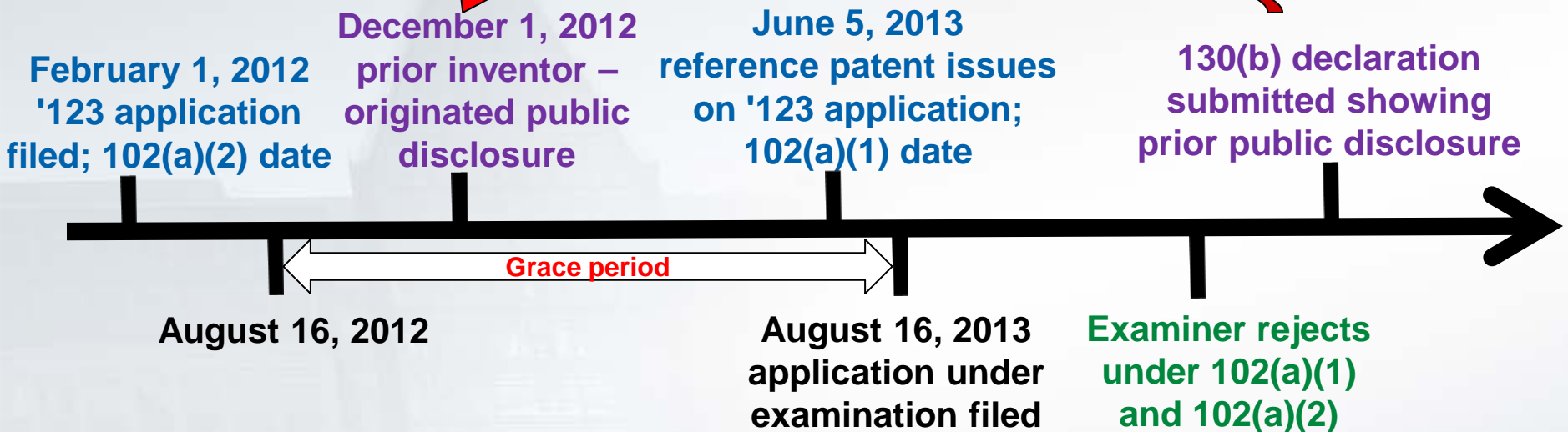
the date of the prior public disclosure of the relevant subject matter is after the effectively filed date of the U.S. patent document,

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 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
- 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;
- 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.



Additional Information

- A rule 130 declaration is not needed to invoke the common ownership exception under 35 U.S.C. 102(b)(2)(C). A statement is sufficient. See MPEP 717.02(b)(III).
- Although this slide set is focused on rule 130 declarations during prosecution of patent applications, rule 130 declarations may also be submitted during reexamination proceedings.



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Important Points to Learn from the Rule 130 Declaration Examples

For all 130 declarations:

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

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



Important 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(b)(1)(A) or 102(b)(2)(A) exception, and the reference names someone else in addition to the inventor, a reasonable explanation of the other person's involvement is required.

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

130(a)



That's my work!



Important 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.

130(b)



**I made it
public first!**



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



Al & Bob are authors of a journal article disclosing X



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

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



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



Answer: Yes.

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

- Because Al avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- Al 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 Al and Bob both invented X.

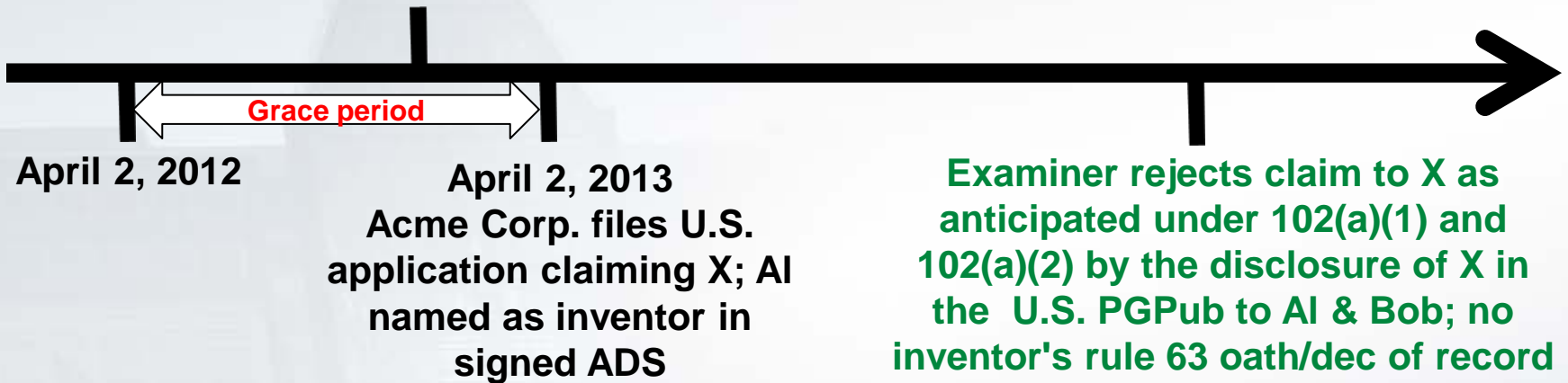
The examiner should use form paragraph 7.67.aia, and explain why the declaration is sufficient. A declaration from Bob stating that he did not invent X is not required. See *In re Katz*, 215 USPQ 14 (CCPA 1982) and MPEP 717.01(a)(1).



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.

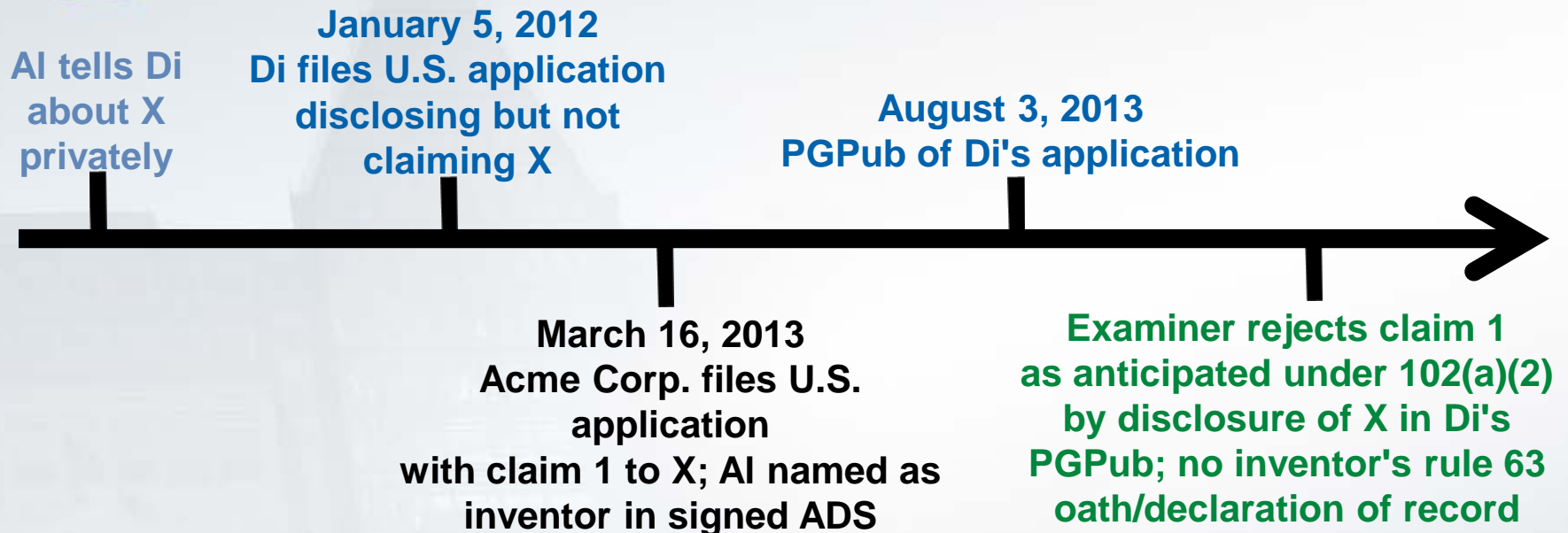
The 130(a) declaration is not sufficient to disqualify the disclosure of X in the PGPub as prior art under either 102(a)(1) or 102(a)(2).

- Because Al 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 Al, 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 Al.

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 AI in which AI 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 AI 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.

- Al has not established that he invented X.
- It would be consistent with Al's declaration to conclude that Al 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.

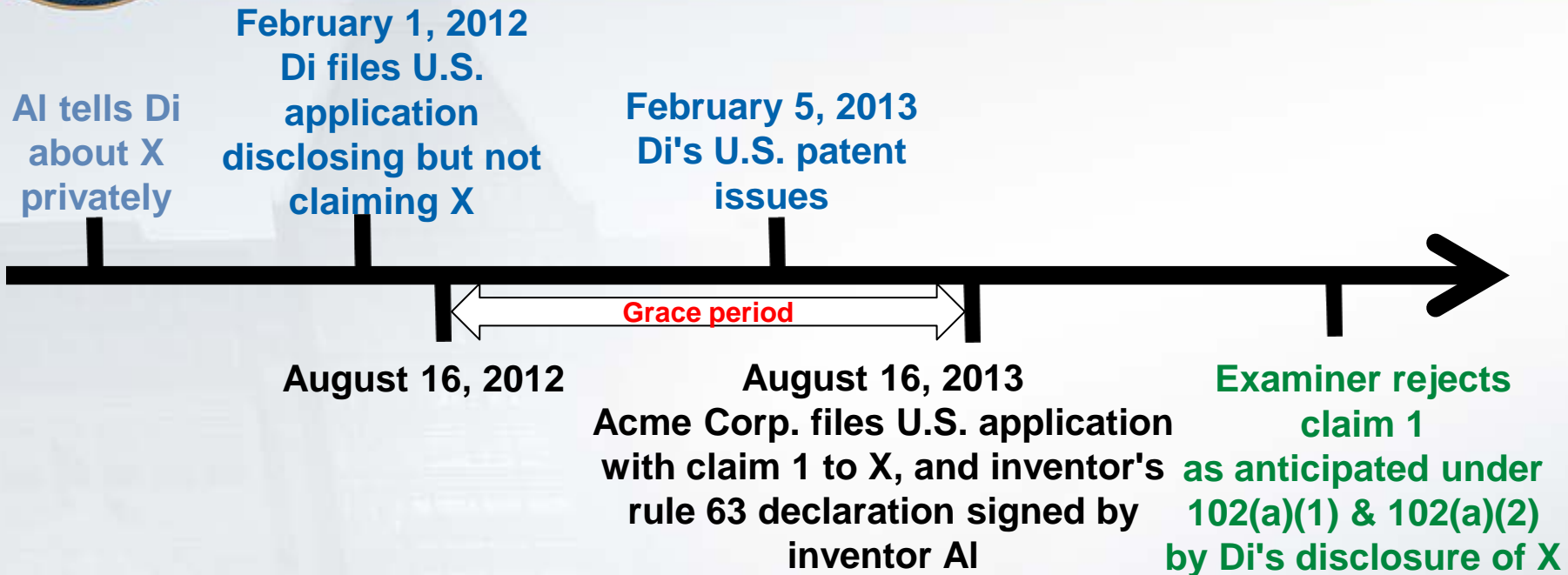
The declaration would have been sufficient if an inventor's rule 63 oath/declaration signed by Al had been of record.

Alternatively, if Acme Corp.'s attorney had submitted a timely 130(a) declaration signed by Al averring that Al 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 Al 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 Al 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.

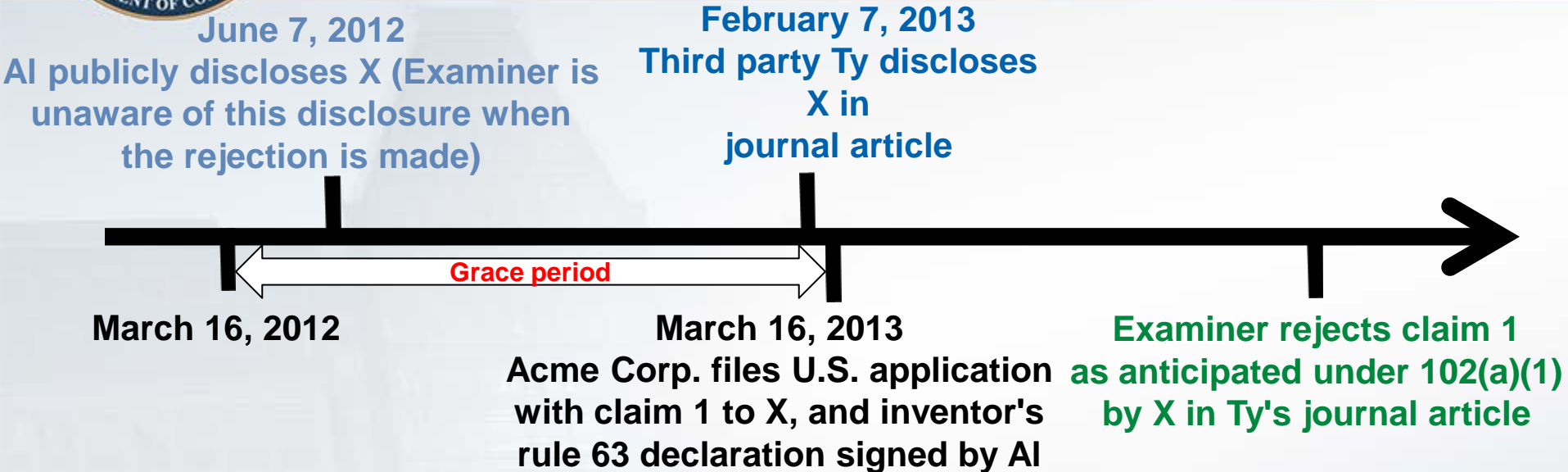


Example 5: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure

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 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)



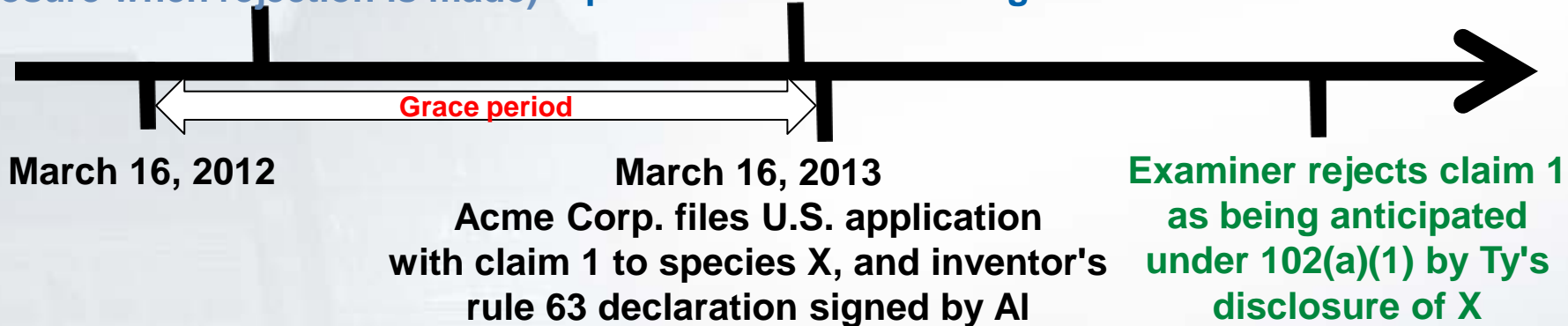
I made it public first!

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

130(b)



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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.



Topics of Discussion



- **New Rule 37 CFR 1.130 and Evaluation of Declarations**
 - 130(a) Declarations of Attribution
 - 130(b) Declarations of Prior Public Disclosure
- **Formal Requirements for 130 Declarations**
- **Examples of 130(a) and (b) Declarations**
- **Acknowledging 130 Declarations in Office Actions**
- **Comparison of Declarations for Pre-AIA and AIA Applications**



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(a) and (b) Declarations Must Be Addressed in the Next Office Action

- **Declaration not considered**: The examiner must provide a clear explanation of the reason(s) why the declaration is not being considered.
- **Declaration considered but not sufficient**: The examiner must clearly and specifically explain why the evidence is insufficient by using form paragraph 7.68.aia, "Affidavit or Declaration Under 37 CFR 1.130: Ineffective to Disqualify a Reference as Prior Art Via 35 U.S.C. 102(b)."
- **Declaration sufficient**: The examiner must clearly and specifically explain why the evidence is sufficient by using form paragraph 7.67.aia, "Affidavit or Declaration Under 37 CFR 1.130: Effective to Disqualify a Reference as Prior Art Via 35 U.S.C. 102(b)." If claims are allowed on the basis of the 130(a) or (b) declaration, the examiner should include a statement in the reasons for allowance to explain why the declaration was persuasive. See MPEP 1302.14.



IMPORTANT! Acknowledging 130(b) Declarations on OACS Forms

130(b)



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



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

130(b)



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| | | | |
|------------------------------|--------------------------------------|-------------------------------------|---|
| 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

- 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.



Acknowledging a 130(b) Declaration on the Notice of Allowability

130(b)



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| | | | |
|--|--|---|---|
| <p>██████████</p> <p><i>Notice of Allowability</i></p> | <p>Application No. 99/XXX,XXX</p> | <p>Applicant(s) SMITH ET AL.</p> | |
| | <p>Examiner PAT N. LEGAL</p> | <p>Art Unit 1XXX</p> | <p>AIA (First Inventor to File) Status Yes</p> |

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to ██████████.

A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____
2. 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.
3. The allowed claim(s) is/are ██████████. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.



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

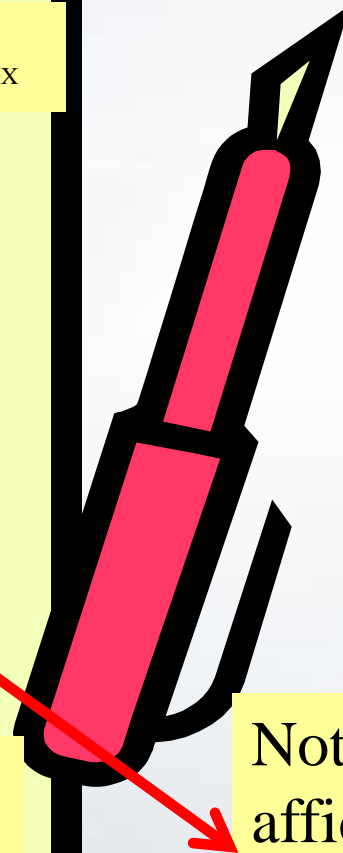
130(b)



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United States Patent Patent Number: X,XXX,XXX

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



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 of Discussion



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 - 130(a) Declarations of Attribution
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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 <u>current common ownership 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 |



Examiners Should Not Refuse to Consider Declarations Solely on the Basis of Mislabeling

| Incorrect label on declaration | Intent of declaration in view of substance | Treat as . . . |
|---------------------------------------|---|-----------------------|
| 131 or 132 | Attribution in AIA case | 130(a) |
| 131 or 132 | Prior public disclosure in AIA case | 130(b)* |
| 130(a) | Attribution in pre-AIA case | 132 |
| 131 | Prior invention in pre-AIA case | 131(a) |
| 130 | Common ownership in pre-AIA case, where prior art is U.S. patent or PGPub, claims are not patentably distinct, inventor named in application is prior inventor, and prior art is not available under pre-AIA 102(b) (rarely used) | 131(c) |

*If a mislabeled declaration is treated as a 130(b) declaration, the IFW document code should be corrected as "AF/D.130B" so that the declaration will be noted on the face of the patent. Similarly, if a declaration is labeled "130(b)" but is not intended to invoke a prior public disclosure exception in an AIA case, the "AF/D.130B" document code is not appropriate, and the 130(b) checkbox on OACS forms should not be checked. Examiners who notice such discrepancies should consult an AIA specialist so that appropriate corrections may be made.



Document Codes and Document Descriptions for Declarations

- **Prior to March 16, 2013, there was only one image file wrapper (IFW) document code for indexing declarations:**

AF/D – Rule 130, 131, or 132 Affidavits

- **Since March 16, 2013, there are five IFW 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 IN IFW | DOC CODE |
|---|---|-------------------|
| 130(a) | Affidavit-Rule 130(a)-AIA (FITF) ONLY | AF/D.130A |
| 130(b) | Affidavit-Rule 130(b)-AIA (FITF) ONLY | AF/D.130B |
| 131(a) or 131(c) | Affidavit-Rule 131-pre-AIA (FTI) ONLY | AF/D.131 |
| 132 | Affidavit-traversing rejections or objections rule 132 | AF/D.132 |
| Not Covered by a Specific Rule | Affidavit-not covered under specific rule | AF/D.OTHER |



For Questions...

- Intranet link:
<http://ptoweb.uspto.gov/patents/fitf>
- Mail box for questions:
FITF_examiner_questions@uspto.gov
- Lead FITF Points of Contact



Lead FITF Points of Contact

| Contact | Business Unit |
|------------------|----------------------------|
| Cassandra Spyrou | TC 2600 & 2800 |
| Chris Grant | TC 2100, 2400 & OPT |
| Tom Hughes | TC 3600, 3700 & CRU |
| Kathleen Bragdon | TC 1600, 1700 & 2900 |
| Gerald Leffers | OPQA/ TC 1600, 1700 & 2900 |
| Steve Saras | OPQA/ TC 2600 & 2800 |
| MaryBeth Jones | OPQA/ TC 3600, 3700 & CRU |
| Don Sparks | OPQA/ TC 2100, 2400 & OPT |



Thank You!

