

Declaration practice under 37 CFR 1.132 (Rule 132)

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Objectives

- **Recognize** that rule 132 declarations are submitted to provide evidence to traverse a rejection or objection on a basis not otherwise provided for.
- **Recognize** when a rule 132 declaration is timely.
- **Recognize** that a rule 132 declaration must be addressed by a primary examiner in the next office action.
- **Recognize** evidence commonly submitted using rule 132 declarations.
- **Characterize** the differences between evidence that is factual and evidence that is based on opinion.

Purpose

“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.”

37 CFR 1.132

Note: Affidavits are rare so the term “declaration” will be used throughout the remainder of this presentation. What is said for declarations will also apply to affidavits.

Purpose (cont.)

- The rule gives applicants a way to provide evidence to overcome a ground of rejection or an objection.
- Any person who has knowledge of the facts being asserted in the declaration may make a declaration under rule 132:
 - e.g., Inventor, inventor's co-worker, independent expert, or others. No special qualifications are required.
- All declarations presented which do not fall within or under specific rules are to be treated or considered as falling under this rule. *MPEP 716*.
- Despite the language of the regulation, Office practice is that there does not have to be a rejection already of record in order for a rule 132 declaration to be submitted.
- Evidence may be submitted (sometimes) in non-declaration form.
 - e.g., Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention. *MPEP 716.01(a)*

Timeliness

A rule 132 declaration is considered timely if submitted:

- Prior to a final rejection.
- Before appeal in an application not having a 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.
- With a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995.
- With a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.

MPEP 716.01(A)

Timeliness (cont.)

A declaration under rule 132 may be admitted if received after appeal, but prior to filing an appeal brief, if the examiner determines that:

- The declaration overcomes all rejections under appeal, and
- A showing of good and sufficient reasons why the declaration or other evidence is necessary and was not earlier presented has been made.

MPEP 716.01(A); 1206(II); 37 CFR 41.33(d)

Examiner must acknowledge the declaration in the next action

If the examiner determines that the declaration meets the formal requirements (e.g., timeliness, signed, willful false statements clause, etc.) the examiner must consider it on the merits and explain in the next office action why it is sufficient or insufficient to overcome the traversed rejection(s).

- Where an examiner holds that the evidence is sufficient to overcome the prima facie case, the comments should be consistent with the guidelines for statements of reasons for allowance. MPEP 1302.14.
 - *"The declaration is sufficient to overcome the rejection..."*
- Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient.
 - *"The declaration is insufficient to overcome the rejection because ...", (explain why the evidence is not persuasive).*
 - General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

MPEP 716.01(A), 716.01(B), 37 CFR 1.68

Note: A primary examiner must sign an action that is responsive to a declaration (MPEP 716).



Knowledge check A

Examiner mailed a final rejection containing no new grounds of rejection or objection. Applicant responded to the final rejection with a rule 132 declaration within 15 days of the mail date of the final rejection by submitting test results to overcome a 103 rejection without good and sufficient reasons why the declaration was necessary and was not earlier presented.

Was the declaration timely submitted for the examiner to consider it on the merits?

- Yes
- No

Knowledge check A: Answer

The correct answer is **B, No**.

The declaration is not timely filed because it was filed after a final rejection, and applicant did not provide good and sufficient reasons why the declaration was necessary and not earlier presented.

MPEP 716.01(A)

Knowledge check B

Indicate True or False for the following statements:

- A. If the examiner determines that a declaration is not timely and not entitled to consideration, the examiner should explain the reasons in the next office action.
- B. If the examiner determines that a declaration is compliant with all formal requirements, the examiner must consider it on the merits and explain in the next office action why it is sufficient or insufficient to overcome the traversed rejection(s).
- C. If the examiner determines that a declaration is entitled to consideration but is insufficient to overcome the traversed rejection(s), general statements without an explanation supporting such findings are sufficient.



Knowledge check B: Answer

Statements	True/False
A. If the examiner determines that a declaration is not timely and not entitled to consideration on the merits, the examiner should explain the reasons in the next office action.	True
B. If the examiner determines that a declaration is compliant with all formal requirements, the examiner must consider it on the merits and explain in the next office action why it is sufficient or insufficient to overcome the traversed rejection(s).	True
C. If the examiner determines that a declaration is entitled to consideration on the merits but is insufficient to overcome the traversed rejections(s), general statements without an explanation supporting such findings are sufficient.	False

Answer C is False because general statements without an explanation supporting the findings are insufficient.

MPEP 716.01(A) and (B)



Analysis of rule 132 declarations

- What is the specific purpose of the declaration?
- What does the declaration actually show and how does it attempt to show it?
- Does it show facts or opinions?

Analysis of rule 132 declarations (cont.)

Statement	Evidence submitted	Weighing evidence
Factual Evidence	<p>A witnessed event, act, or occurrence.</p> <p><i>Examples:</i> Comparative test results, sales figures, etc.</p>	<p>Influenced by the underlying bases:</p> <ul style="list-style-type: none"> • If factual, some weight is given. • If opinion, some weight is given so long as the opinion is not on the ultimate legal conclusion at issue.
Opinion	<p>A statement expressing what the person making it thinks, believes, or infers with regard to certain facts.</p> <p><i>Examples:</i></p> <ul style="list-style-type: none"> • Factually based expert opinions on the level of ordinary skill in the art to rebut the examiner's position of inherency. • Conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value. 	

MPEP 716.01(c)



Analysis of rule 132 declarations (cont.)

- The ultimate determination of patentability must be based on consideration of **the entire record** based on a preponderance of the evidence standard.
 - When a rule 132 declaration has been properly submitted, the examiner must make a "fresh" consideration of the rejection considering all the evidence.
- The rejection should be maintained where a preponderance of all the evidence indicates that the claimed subject matter is unpatentable.
 - An examiner should not reject a claim if it is "more likely than not" that the claim is patentable.
 - A determination of patentability must be based on consideration of the entire record which includes the prior art, the specification, and any declaration evidence.

MPEP 716.01(d)

Note: Preponderance means "more likely than not".



Reasons for rule 132 declarations

- Unexpected results - *MPEP 716.02*
- Commercial success - *MPEP 716.03*
- Long-felt need - *MPEP 716.04*
- Inoperability of references - *MPEP 716.07*
- Sufficiency of applicant's disclosure under 35 U.S.C. 112(a)- Enabling disclosure- *MPEP 716.09*
- Establish inherency in the instant application - *MPEP 2163.07(a)*
- Rebut allegations of inherency in the prior art - *MPEP 2112.02(l)*

Red box shows examples of common reasons for rule 132 declarations that will be addressed in more detail.

- Skepticism - *MPEP 716.05*
- Copying by others - *MPEP 716.06*
- Utility and operability of applicant's disclosure - *MPEP 716.08*
- Establishing claimed invention is operative – *MPEP 716.08*

ANY evidence that cannot be submitted under another section of the regulations can be submitted under rule 132.

Rule 132 declarations to overcome obviousness rejections under 35
U.S.C. 103

Nexus requirement and evidence of nonobviousness under 35 U.S.C. 103

- To be of probative value, evidence of secondary considerations (e.g., unexpected results, commercial success, long-felt need) must be related to the claimed invention.
- The examiner must determine whether there is a **nexus** between the invention as **claimed** and **the entirety of the evidence** in the declaration of secondary considerations.
 - “Nexus” designates a legally and factually sufficient connection between the claimed invention and the objective evidence provided in the declaration of nonobviousness such that the evidence should be considered in the determination of nonobviousness.

MPEP 716.01(b)



Unexpected results

A *prima facie* case of obviousness under 35 U.S.C. 103 may be rebutted by **evidence** establishing that applicant's invention produces **unexpected** results. Unexpected results are not relevant to anticipation under 35 U.S.C. 102.

- The declaration should present a comparison with the closest prior art.
 - Applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. Meaning, applicant is not required to provide evidence and compare the claimed invention against subject matter suggested by a combination of references relied upon in the rejection.
- The comparison must be under substantially the same conditions except for the allegedly novel features of the invention.
- The unexpected property or result should **actually be unexpected** and of statistical and practical significance.
- The feature or property in which the superiority or advantage resides must be disclosed or inherently flow from the written description.
 - Unexpected properties do not necessarily have to be claimed to be considered.
 - The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical.

MPEP 716.02(f)



Unexpected results (cont.)

- The scope of the showing must be commensurate with the scope of the claimed subject matter.
- Synergism is merely a property like any other property; it may be expected or unexpected depending on the particular art.

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**.

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**.
 - **The evidence should be commensurate in scope with the claims.**

MPEP 716.02(b)(III)



Unexpected results (cont.)

The declaration should include the following:

- Description of what was tested
 - Must compare the claimed invention with the closest prior art.
 - Can be prior art that is more closely related to the invention than the prior art relied up on by the examiner.
- Description of test conditions
 - Test conditions need to be commensurate in scope with the claims.
- Test results
 - Must include the results of the test performed on the claimed invention and on the closest prior art.
- Analysis of test results

MPEP 716.02(e)

Unexpected results (cont.)

- Precisely what was done should be recited in the declaration, (e.g., the actual steps carried out, the materials employed, and the results obtained).
- 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 the claimed invention is insufficient.

Unexpected results (cont.)

- 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.”
 - For example: Assume that the closest prior art is the Smith reference, and that the examiner cannot apply a 35 U.S.C. 102(a)(1) rejection for AIA applications based on Smith because Smith fails to disclose one of the claimed limitations. The Jones reference teaches the missing limitation. The examiner applies a rejection of the claims under 35 U.S.C. 103 over Smith in view of Jones, which establishes a *prima facie* case of obviousness. To rebut the *prima facie* case of obviousness, applicant may compare the claimed invention **with only the Smith reference**. Applicant is NOT required to compare the claimed invention with an invention (e.g., a product, device, or process) suggested by the combination of Smith in view of Jones, since this would be comparing applicant’s invention against itself.

MPEP 716.02(e)(III)



Unexpected results (cont.)

- The unexpected 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 recited in the claims.

MPEP 716.02(d)

- The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical.

MPEP 716.02(f)



Examples that may or may not result in unexpected results - Example 1

- Evidence submitted for the claimed composition showed an additive result when a diminished result would have been expected.
- Result was equal to that of one component alone.
- With this set of facts, the court held that the evidence established unexpected results. See: *In re Corkhill*, 771 F. 2d 1496, 226 USPQ 1005 (Fed. Cir. 1985).

Examples that may or may not result in unexpected results - Example 2

- Evidence was submitted that showed greater than additive results for the claimed mixture.
- Prior art taught the general expectation of greater than additive results when using the claimed mixture.
- With this record the total evidence would indicate that the results were not unexpected.
 - See: *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991).

Further examples that may or may not result in unexpected results

- Superiority of a property shared with the prior art.
 - See: *In re Chupp*, 816 F.2d. 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987).
- Unexpected property.
 - See: *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).
- Prior art taught that the claimed antioxidant is very efficient and provides better results compared with the prior art antioxidants.
 - See: *Ex Parte, Blanc*, 13 USPQ2d 1383 (Bd. App. & Intr. 1989).

Commensurate in scope evidence

- Claims recited an elevated temperature range which allowed temperatures as low as 60°C.
- Evidence was submitted that showed unexpected results at 110°C and 130°C.
- Dependent claim 8 limited the recited temperature range to being “in excess of 100°C”.
- Prior art taught improved results at 60°C.
 - The evidence was found to be commensurate in scope only with dependent claim 8.
 - See *In re Clemens*, 622 F. 2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980).

Commercial success

“Commercial success” is a secondary consideration with respect to obviousness. It is not relevant to anticipation under 35 U.S.C. 102.

- The declaration must establish a **nexus** between the claimed features of the invention and the commercial success.
- The commercial success must be due to the claimed features, and not due to unclaimed features.
 - For example, evidence of how much customers like cups with handles would lack nexus if the claim did not require a cup with handles.

Commercial success

- In a declaration concerning 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 derived from the claimed invention and not to some other factor, e.g., some other feature of the item sold, advertising, sales strategy.

MPEP 716.03

Commercial success (cont.)

- Merely showing that there was commercial success of an article which embodied the invention is not sufficient.
- The declaration should include at least:
 - A description of what was sold.
 - The features of the invention **as claimed**.
 - A description of the relevant market for the product.
 - Information on advertising within the relevant market.
 - Any other information relevant to the inquiry.

Commercial success (cont.)

The declaration should include at least:

- **Sales results.** The results should include evidence of market share such as:
 - Total sales for competing products in the market.
 - Differences between these products and the applicant's.
 - Total sales for products embodying the invention.
 - Pricing of the various products.

MPEP 716.03

Commercial success (cont.)

Factors that do not support commercial success being attributable to the claimed invention may include:

- Heavy promotion or advertising, or position as market leader before the introduction of the patented product
- Brand name recognition
- Recent changes in related technology or consumer demand
- Consumption by purchasers normally tied to applicant or assignee
- Sales programs

MPEP 716.03(b)

Commercial success (cont.)

- Gross sales figures do not show commercial success absent evidence as to market share.
- Inventor's opinion as to the purchaser's reason for buying the product, alone, is generally insufficient to demonstrate a nexus between the sales and the claimed invention.

MPEP 716.03(b)

Long-felt need

“Long-felt need” is a secondary consideration with respect to obviousness. It is not relevant to anticipation under 35 U.S.C. 102.

- 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.
 - The long-felt need must not have been satisfied by another before the effective filing date of the claimed invention.
 - The claimed invention must in fact satisfy the long-felt need.

Long-felt need and failure of others

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."

MPEP 716.04(I); In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967)



Long-felt need and failure of others (cont.)

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

MPEP 716.04(I)

- The existence of a prior art reference showing a solution to the problem is evidence that there is no long-felt need.
- The mere passage of time is insufficient to demonstrate nonobviousness.

MPEP 716.04 & MPEP 2144.05(III)(B)



Skepticism of experts

- “Expressions of disbelief by experts constitute strong evidence of nonobviousness.”
- “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.”

MPEP 716.05

Copying by others

- More than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as
 - Lack of concern for patent property.
 - Contempt for patentee's ability to enforce patent.
- Although evidence of copying may be presented by applicants during prosecution of an application, it is more often presented during litigation.

MPEP 716.06

Copying by others (cont.)

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 claimed invention.

MPEP 716.06

Rule 132 declarations other than the obviousness context

Inoperability of references

- It is not sufficient to merely show that the results of the reference were not achieved.
- The declaration must also show that the steps a person of ordinary skill would take in attempting to achieve the claimed results in the reference would not result in an operative invention.
- Where the declaration presented asserts inoperability in features of the reference which are not relied upon, the reference is still effective as to other features which are operative.
- Where a declaration presented asserts that the reference relied upon is inoperative, applicant's claims must distinguish from the alleged inoperative reference disclosure.

MPEP 716.07



Inoperability of references

The declaration should show that the steps a person of ordinary skill would take in attempting to achieve the claimed results in the reference 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.

MPEP 716.07



Inoperability of references (cont.)

- 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.**
- Where a declaration presented asserts that the reference relied upon is inoperative, applicant's claims must distinguish from the alleged inoperative reference disclosure.
- 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.

MPEP 716.07

Sufficiency of applicant's disclosure under 35 U.S.C. 112(a) – Enabling disclosure

- The evidence must support that a person of skill in the art would have been able to make and use the claimed invention based on the disclosure without undue experimentation.
- Evidence to supplement a specification which on its face appears deficient under 35 U.S.C. 112 must establish that the information which must be read into the specification to make it complete would have been known to those of ordinary skill in the art.

MPEP 716.09

Establish inherent disclosure in the application under examination

- Examples where a rule 132 declaration may be used to establish inherency:
 - A claim is amended to recite a particular limitation which is not explicitly recited in the application as originally filed.
 - A continuing application is filed reciting something which is not expressly mentioned in the parent case, and the benefit of the filing date of the parent application is necessary to the applicant for some reason.
- An appropriate response to a rejection of a claim under 35 U.S.C. 112(a) for new matter (and/or an objection to the specification under 35 U.S.C. 132) can include the filing of a declaration establishing the inherency of the feature which had not been previously disclosed *in haec verba*.



Establish inherent disclosure in the application under examination (cont.)

- Examiner will evaluate the declaration to determine if it presents facts that affirmatively establish that the purported inherent feature is necessarily present.
 - The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

MPEP 2112



Rebut allegations of inherency in prior art

Evidence might be presented in a rule 132 declaration to rebut examiner's position of inherency in the prior art relevant to anticipation under 35 U.S.C. 102 and obviousness under 35 U.S.C. 103.

- **Product by process** claims rejected under 35 U.S.C. 102 or 103
 - Once the examiner provides a rationale tending to show that the claimed **product** appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with **evidence** establishing an **unobvious** difference between the claimed product and the prior art product.
- Similarly, **product** claims rejected under 35 U.S.C. 102 or 103 may have claimed properties or functions that are presumed to be inherent in a prior art product found by the examiner.
 - Once the examiner provides a rationale to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a difference process, applicant then has the burden of showing that property is not inherent in the prior art.

Knowledge check C

Which evidence commonly submitted in a rule 132 declaration is relevant to anticipation rejections under 35 U.S.C. 102? (Mark each as True or False.)

- A. Evidence of unexpected results
- B. Evidence of long-felt need
- C. Evidence of lack of inherency in prior art
- D. Evidence of commercial success

Knowledge check C: Answer

Evidence	True/False
A. Evidence of unexpected results	False
B. Evidence of long-felt need	False
C. Evidence of lack of inherency in prior art	True
D. Evidence of commercial success	False

Unexpected results, long-felt need, and **commercial success** are evidence with respect to obviousness and are not relevant to anticipation under 35 U.S.C. 102.

Lack of inherency in the prior art is the only answer relevant to anticipation rejections under 35 U.S.C. 102.



Knowledge check D

Provided that a rule 132 declaration is relevant to the issue at hand, which evidence submitted should be given weight? (Mark each as True or False.)

- A. Factually based expert opinions on the level of ordinary skill in the art to overcome a 35 U.S.C. 103 rejection.
- B. Data attempting to overcome a 35 U.S.C. 103 rejection by showing unexpected results for the claimed invention.
- C. Conclusory statement that the claimed invention meets the requirements of 35 U.S.C. 112.
- D. Declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention to overcome a 35 U.S.C. 103 rejection.

Knowledge check D: Answer

Answer options	True/False
A. Factually based expert opinions on the level of ordinary skill in the art to overcome a 35 U.S.C. 103 rejection.	True
B. Data attempting to overcome a 103 rejection by showing unexpected results for the claimed invention.	True
C. Conclusory statement that the claimed invention meets the requirements of 35 U.S.C. 112.	False
D. Declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention to overcome a 35 U.S.C. 103 rejection.	True

Answer options A and B are fact based.

Answer option C is a conclusory statement of an ultimate legal conclusion at issue.

Answer option D is an opinion but not of the ultimate legal conclusion at issue.



Remember, with respect to all rule 132 declarations

- Attorney arguments cannot take the place of evidence. Meaning, attorneys can argue but attorney arguments do not suffice when evidence is needed.
 - Examples of attorney statements which are not evidence and which must be supported by an appropriate declaration include:
 - Statements regarding unexpected results
 - Commercial success
 - Solution of a long-felt need
 - Inoperability of the prior art

MPEP 716.01(c)(II)

Remember, with respect to all rule 132 declarations (cont.)

- Applicant has the right to petition formal matters (e.g., denial of entry).
 - Formal sufficiency and propriety of 1.132 declarations are delegated from the Director of the USPTO to be decided by the Technology Center Directors. *MPEP 1002.02(c)*
- Applicant has the right to appeal substantive matters to the Patent Trial and Appeal Board (PTAB).
 - PTAB will consider the examiner's review of the declaration only as part of the review of the rejection that was appealed.



Summary

- **Recognize** that rule 132 declarations are submitted to provide evidence to traverse a rejection or objection on a basis not otherwise provided for.
- **Recognize** when a rule 132 declaration is timely.
- **Recognize** that a rule 132 declaration must be addressed by a primary examiner in the next office action.
- **Recognize** evidence commonly submitted using rule 132 declarations.
- **Characterize** the differences between evidence that is factual and evidence that is based on opinion.



Thank you!

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