

# Chapter 2100 Patentability

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**2101-2102** [Reserved]

**2103 Patent Examination Process [R-07.2022]**

**I. DETERMINE WHAT INVENTION IS SOUGHT TO BE PATENTED**

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, examiners should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, examiners and patent reexamination specialists should indicate how rejections may be overcome and how problems may be resolved. Where a rejection not based on prior art is proper (lack of adequate written description, enablement, or utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

The examination of reissue applications is covered in [MPEP Chapter 1400](#), reexamination proceedings are covered in [MPEP Chapters 2200](#) (*ex parte*) and [2600](#) (*inter partes*), and supplemental examination is covered in [MPEP Chapter 2800](#).

Prior to focusing on specific statutory requirements, examiners must begin examination by determining what, precisely, the inventor or joint inventor has invented and is seeking to patent, and how the claims relate to and define that invention. Examiners will review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims and any specific, substantial, and credible utilities that have been asserted for the invention.

After obtaining an understanding of the invention, the examiner will conduct a search of the prior art and determine whether the invention as claimed complies with all statutory requirements.

#### **A. Identify and Understand Any Utility for the Invention**

The claimed invention as a whole must be useful. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Examiners should review the application to identify any asserted utility. The applicant or the inventor is in the best position to explain why an invention is useful. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant asserts the claimed invention is useful. Such a statement will usually explain the purpose of the invention or how the invention may be used (e.g., a compound is believed to be useful in the treatment of a particular disorder). Note that the concept of a “practical application” in the evaluation of utility is different from the concept of whether a judicial

exception is integrated into a “practical application” in the evaluation of subject matter eligibility. Regardless of the form of statement of utility, it must enable one ordinarily skilled in the art to understand why the applicant asserts the claimed invention is useful. See [MPEP § 2106](#) for subject matter eligibility guidelines and [MPEP § 2107](#) for utility examination guidelines. The application may describe more than one utility and practical application, but only one is necessary. Alternatively, an applicant may rely on the contemporaneous art to provide that the claimed invention has a well-established utility.

#### **B. Review the Detailed Disclosure and Specific Embodiments of the Invention To Understand What the Applicant Has Asserted as the Invention**

The written description will provide the clearest explanation of the invention, by exemplifying the invention, explaining how it relates to the prior art and explaining the relative significance of various features of the invention. Accordingly, examiners should continue their evaluation by:

(A) determining the function of the invention, that is, what the invention does when used as disclosed (e.g., the functionality of a programmed computer); and

(B) determining the features necessary to accomplish at least one asserted practical application.

Patent applicants can assist the USPTO by preparing applications that clearly set forth these aspects of an invention.

#### **C. Review the Claims**

The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. Examiners must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523,

1529 (Fed. Cir. 1998) (“[T]he name of the game is the claim.”).

Examiners should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter.

Examiners should then correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, regardless of whether the claimed invention is defined using means- (or step-) plus- function language. The correlation step will ensure that examiners correctly interpret each claim limitation in light of the specification.

The subject matter of a properly construed claim is defined by the terms that limit the scope of the claim when given their broadest reasonable interpretation. It is this subject matter that must be examined. As a general matter, grammar and the plain meaning of terms as understood by one having ordinary skill in the art used in a claim will dictate whether, and to what extent, the language limits the claim scope. See [MPEP § 2111.01](#) for more information on the plain meaning of claim language. Language that suggests or makes a feature or step optional but does not require that feature or step does not limit the scope of a claim under the broadest reasonable claim interpretation. The following types of claim language may raise a question as to its limiting effect:

(A) statements of intended use or field of use, including statements of purpose or intended use in the preamble,

(B) “adapted to” or “adapted for” clauses,

(C) “wherein” or “whereby” clauses,

(D) contingent limitations,

(E) printed matter, or

(F) terms with associated functional language.

This list of examples is not intended to be exhaustive. The determination of whether particular language is a limitation in a claim depends on the

specific facts of the case. See, e.g., *Griffin v. Bertina*, 285 F.3d 1029, 1034, 62 USPQ2d 1431 (Fed. Cir. 2002)(finding that a “wherein” clause limited a process claim where the clause gave “meaning and purpose to the manipulative steps”). For more information about these types of claim language and how to determine whether they have a limiting effect on claim scope, see [MPEP §§ 2111.02](#) through [2111.05](#).

Examiners are to give claims their broadest reasonable interpretation in light of the supporting disclosure. See [MPEP § 2111](#). Disclosure may be express, implicit, or inherent. Examiners are to give claimed means- (or step-) plus- function limitations their broadest reasonable interpretation consistent with all corresponding structures (or materials or acts) described in the specification and their equivalents. See *In re Aoyama*, 656 F.3d 1293, 1297, 99 USPQ2d 1936, 1939 (Fed. Cir. 2011). Further guidance in interpreting the scope of equivalents is provided in [MPEP §§ 2181](#) through [2186](#).

While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not itself impose that limitation. See [MPEP § 2111.01](#), subsection II. As explained in [MPEP § 2111](#), giving a claim its broadest reasonable interpretation during prosecution will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified.

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Examiners may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) (“In determining the eligibility of respondents’ claimed process for patent protection under [§ 101](#), their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the



combination were well known and in common use before the combination was made.”).

## II. CONDUCT A THOROUGH SEARCH OF THE PRIOR ART

Prior to evaluating the claimed invention for patentability, examiners are expected to conduct a thorough search of the prior art. See [MPEP §§ 904 through 904.03](#) for more information about how to conduct a search. In many cases, the result of such a search will contribute to examiners' understanding of the invention. Both claimed and unclaimed aspects of the invention described in the specification should be searched if there is a reasonable expectation that the unclaimed aspects may be later claimed. A search must take into account any structure or material described in the specification and its equivalents which correspond to the claimed means- (or step-) plus- function limitation, in accordance with [35 U.S.C. 112\(f\)](#) and [MPEP § 2181](#) through [MPEP § 2186](#).

## III. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101

### A. Consider the Breadth of 35 U.S.C. 101 Under Controlling Law

[Section 101](#) of title 35, United States Code, provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[35 U.S.C. 101](#) has been interpreted as imposing four requirements: (i) only one patent may be obtained for an invention; (ii) the inventor(s) must be identified in an application filed on or after September 16, 2012 or must be the applicant in applications filed before September 16, 2012; (iii) the claimed invention must be eligible for patenting; and (iv) the claimed invention must be useful (have utility).

See [MPEP § 2104](#) for a discussion of the four requirements, [MPEP § 2106](#) for a discussion of

eligibility, and [MPEP § 2107](#) for the utility examination guidelines.

The patent eligibility inquiry under [35 U.S.C. 101](#) is a threshold inquiry. Even if a claimed invention qualifies as eligible subject matter under [35 U.S.C. 101](#), it must also satisfy the other conditions and requirements of the patent laws, including the requirements for novelty ([35 U.S.C. 102](#)), nonobviousness ([35 U.S.C. 103](#)), and adequate description and definite claiming ([35 U.S.C. 112](#)). *Bilski v. Kappos*, 561 U.S. 593, 602, 95 USPQ2d 1001, 1006 (2010). Therefore, examiners should avoid focusing on only issues of patent-eligibility under [35 U.S.C. 101](#) to the detriment of considering an application for compliance with the requirements of [35 U.S.C. 102](#), [35 U.S.C. 103](#), and [35 U.S.C. 112](#), and should avoid treating an application solely on the basis of patent-eligibility under [35 U.S.C. 101](#) except in the most extreme cases.

## IV. EVALUATE APPLICATION FOR COMPLIANCE WITH 35 U.S.C. 112

### A. Determine Whether the Claimed Invention Complies with 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph Requirements

[35 U.S.C. 112\(b\)](#) contains two separate and distinct requirements: (A) that the claim(s) set forth the subject matter the inventor or a joint inventor regards as the invention, and (B) that the claim(s) particularly point out and distinctly claim the invention. An application will be deficient under the first requirement of [35 U.S.C. 112\(b\)](#) when evidence outside the application as filed, e.g., admissions, shows that the inventor or a joint inventor regards the invention to be different from what is claimed (see [MPEP § 2171](#) - [MPEP § 2172.01](#)).

An application fails to comply with the second requirement of [35 U.S.C. 112\(b\)](#) when the claims do not set out and define the invention with a reasonable degree of precision and particularity. In this regard, the definiteness of the language must be analyzed, not in a vacuum, but always in light of the teachings of the disclosure as it would be interpreted by one of ordinary skill in the art. Applicant's claims, interpreted in light of the disclosure, must reasonably

apprise a person of ordinary skill in the art of the invention.

The scope of a limitation that invokes [35 U.S.C. 112\(f\)](#) is defined as the corresponding structure or material set forth in the written description and equivalents thereof that perform the claimed function. See [MPEP § 2181](#) through [MPEP § 2186](#). See [MPEP § 2173](#) *et seq.* for a discussion of a variety of issues pertaining to the [35 U.S.C. 112\(b\)](#) requirement that the claims particularly point out and distinctly claim the invention.

***B. Determine Whether the Claimed Invention Complies with 35 U.S.C. 112(a) or 35 U.S.C. 112, First Paragraph Requirements***

[35 U.S.C. 112\(a\)](#) contains three separate and distinct requirements:

- (A) adequate written description,
- (B) enablement, and
- (C) best mode.

**1. Adequate Written Description**

For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the inventor was in possession of the claimed invention as of the date of invention. See [MPEP § 2163](#) for further guidance with respect to the evaluation of a patent application for compliance with the written description requirement.

**2. Enabling Disclosure**

An applicant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex, however, will not make it undue if a person of skill in the art routinely engages in such experimentation.

See [MPEP § 2164](#) *et seq.* for detailed guidance with regard to the enablement requirement of [35 U.S.C. 112\(a\)](#).

**3. Best Mode**

Determining compliance with the best mode requirement requires a two-prong inquiry:

(1) at the time the application was filed, did the inventor possess a best mode for practicing the invention; and

(2) if the inventor did possess a best mode, does the written description disclose the best mode in such a manner that a person of ordinary skill in the art could practice the best mode.

See [MPEP § 2165](#) *et seq.* for additional guidance. Deficiencies related to disclosure of the best mode for carrying out the claimed invention are not usually encountered during examination of an application because evidence to support such a deficiency is seldom in the record. *Fonar Corp. v. General Elec. Co.*, 107 F.3d 1543, 1548-49, 41 USPQ2d 1801, 1804-05 (Fed. Cir. 1997).

**V. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 102 AND 103**

Reviewing a claimed invention for compliance with [35 U.S.C. 102](#) and [35 U.S.C.103](#) begins with a comparison of the claimed subject matter to what is known in the prior art. See [MPEP §§ 2131 - 2146](#) and [MPEP §§ 2150 - 2159](#) for specific guidance on patentability determinations under [35 U.S.C. 102](#) and [35 U.S.C. 103](#). If no differences are found between the claimed invention and the prior art, then the claimed invention lacks novelty and is to be rejected by USPTO personnel under [35 U.S.C. 102](#). Once differences are identified between the claimed invention and the prior art, those differences must be assessed and resolved in light of the knowledge possessed by a person of ordinary skill in the art. Against this backdrop, one must determine whether the invention would have been obvious to one of ordinary skill in the art. If not, the claimed invention satisfies [35 U.S.C. 103](#).

**VI. CLEARLY COMMUNICATE FINDINGS, CONCLUSIONS AND THEIR BASES**

Once examiners have completed the above analyses of the claimed invention under all the statutory

provisions, including [35 U.S.C. 101](#), [35 U.S.C. 112](#), [35 U.S.C. 102](#), and [35 U.S.C. 103](#), they should review all the proposed rejections and their bases to confirm that a *prima facie* case of unpatentability exists. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions and reasons which support them.

EXAMINERS SHOULD USE THE APPLICABLE FORM PARAGRAPHS IN OFFICE ACTIONS TO STATE THE BASIS FOR ANY OBJECTIONS OR REJECTIONS TO REDUCE THE CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF OBJECTION OR REJECTION.

## **2104 Requirements of 35 U.S.C. 101 [R-07.2022]**

Patents are not granted for all new and useful inventions and discoveries. For example, the subject matter of the invention or discovery must come within the boundaries set forth by [35 U.S.C. 101](#), which permits a patent to be granted only for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”

### **35 U.S.C. 101 Inventions patentable.**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[35 U.S.C. 101](#) has been interpreted as imposing four requirements, which are described below.

### **I. DOUBLE PATENTING PROHIBITED**

[35 U.S.C. 101](#) requires that whoever invents or discovers an eligible invention may obtain only ONE patent therefor. Thus, it prevents two patents issuing on the same invention to the same inventor (i.e., the same inventive entity) or where there is a common (joint) inventor or common applicant/assignee. The “same invention” means that identical subject matter is being claimed. This requirement forms the basis for statutory double patenting rejections. If more than one patent is sought, a patent applicant will receive a statutory double patenting rejection for

claims included in more than one application that are directed to the same invention.

See [MPEP § 804](#) for a full discussion of the prohibition against double patenting. Use form paragraphs 8.30, 8.31 and 8.32 for statutory double patenting rejections.

### **II. NAMING OF INVENTOR**

The inventor(s) must be the applicant in an application filed before September 16, 2012, (except as otherwise provided in [pre-AIA 37 CFR 1.41\(b\)](#)) and the inventor or each joint inventor must be identified in an application filed on or after September 16, 2012. See [MPEP § 2109](#) for a detailed discussion of inventorship and [MPEP § 602.01\(c\) et seq.](#) for details regarding correction of inventorship.

In the rare situation where it is clear the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship under [37 CFR 1.48](#), the examiner should reject the claims under [35 U.S.C. 101](#) and [115](#) for applications subject to [AIA 35 U.S.C. 102](#) (see [MPEP § 2157](#)) or under [pre-AIA 35 U.S.C. 102\(f\)](#) for applications subject to [pre-AIA 35 U.S.C. 102](#) (see [MPEP § 2137](#)).

### **III. SUBJECT MATTER ELIGIBILITY**

A claimed invention must be eligible for patenting. As explained in [MPEP § 2106](#), there are two criteria for determining subject matter eligibility: (a) first, a claimed invention must fall within one of the four statutory categories of invention set forth in [35 U.S.C. 101](#), i.e., process, machine, manufacture, or composition of matter; and (b) second, a claimed invention must be directed to patent-eligible subject matter and not a judicial exception (unless the claim as a whole includes additional limitations amounting to significantly more than the exception). The judicial exceptions are subject matter which courts have found to be outside of, or exceptions to, the four statutory categories of invention, and are limited to abstract ideas, laws of nature and natural phenomena (including products of nature). *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216, 110 USPQ2d 1976, 1980 (2014) (citing *Association for Molecular Pathology v. Myriad Genetics, Inc.*,

569 U.S. 66, 70, 106 USPQ2d 1972, 1979 (2013)). See also *Bilski v. Kappos*, 561 U.S. 593, 601, 95 USPQ2d 1001, 1005-06 (2010) (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980)).

See [MPEP § 2106](#) for a discussion of subject matter eligibility in general, and the analytical framework that is to be used during examination for evaluating whether a claim is drawn to patent-eligible subject matter, [MPEP § 2106.03](#) for a discussion of the statutory categories of invention, [MPEP § 2106.04](#) for a discussion of the judicial exceptions, and [MPEP § 2106.05](#) for a discussion of how to evaluate claims directed to a judicial exception for eligibility. See [MPEP § 2106.07\(a\)\(1\)](#) for form paragraphs for use in rejections under [35 U.S.C. 101](#) based on a lack of subject matter eligibility. See also [MPEP § 2105](#) for more information about claiming living subject matter, as well as the Leahy-Smith America Invents Act (AIA)'s prohibition against claiming human organisms.

Eligible subject matter is further limited by the Atomic Energy Act explained in [MPEP § 2104.01](#), which prohibits patents granted on any invention or discovery that is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

#### IV. UTILITY

A claimed invention must be useful or have a utility that is specific, substantial and credible.

A rejection on the ground of lack of utility is appropriate when (1) it is not apparent why the invention is “useful” because applicant has failed to identify any specific and substantial utility and there is no well established utility, or (2) an assertion of specific and substantial utility for the invention is not credible. Such a rejection can include the more specific grounds of inoperativeness, such as inventions involving perpetual motion. A rejection under [35 U.S.C. 101](#) for lack of utility should not be based on grounds that the invention is frivolous, fraudulent or against public policy. See *Juicy Whip Inc. v. Orange Bang Inc.*, 185 F.3d 1364, 1367-68, 51 USPQ2d 1700, 1702-03 (Fed. Cir. 1999) (“[Y]ears ago courts invalidated patents on gambling

devices on the ground that they were immoral..., but that is no longer the law...Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace and general welfare of the community are promoted...we find no basis in section 101 to hold that inventions can be ruled unpatentable for lack of utility simply because they have the capacity to fool some members of the public.”).

The statutory basis for this rejection is [35 U.S.C. 101](#). See [MPEP § 2107](#) for guidelines governing rejections for lack of utility. See [MPEP §§ 2107.01 - 2107.03](#) for legal precedent governing the utility requirement. See [MPEP § 2107.02](#), subsection IV, for form paragraphs to be used to reject claims under [35 U.S.C. 101](#) for failure to satisfy the utility requirement.

#### **2104.01 Barred by Atomic Energy Act [R-07.2022]**

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181(a)) thereof reads in part as follows:

No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms “atomic energy” and “special nuclear material” are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181(c) and (d)) set up categories of pending applications relating to atomic energy that must be brought to the attention of the Department of Energy. Under [37 CFR 1.14\(d\)](#), applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy and the Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in



fact discloses subject matter in categories specified by the Atomic Energy Act.

All applications received in the U.S. Patent and Trademark Office are screened by Licensing and Review personnel, under [37 CFR 1.14\(d\)](#), in order for the Director to fulfill his or her responsibilities under section 151(d) (42 U.S.C. 2181(d)) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review.

All rejections based upon sections 151(a) (42 U.S.C. 2181(a)), 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by Licensing and Review personnel.

## **2105 Patent Eligible Subject Matter — Living Subject Matter [R-10.2019]**

### **I. INTRODUCTION**

Prior to 1980, it was widely believed that living subject matter was not eligible for patenting, either because such subject matter did not fall within a statutory category, or because it was a judicial exception to patent eligibility. However, the decision of the Supreme Court in *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980), made it clear that the question of whether an invention embraces living matter is irrelevant to the issue of patent eligibility. Note, however, that Congress has excluded claims directed to or encompassing a human organism from eligibility. See The Leahy-Smith America Invents Act (AIA), Pub. L. 112-29, sec. 33(a), 125 Stat. 284 (September 16, 2011).

### **II. LIVING SUBJECT MATTER MAY BE PATENT ELIGIBLE**

#### ***A. Living Subject Matter May Be Directed To A Statutory Category***

In *Chakrabarty*, the Supreme Court held that a claim to a genetically engineered bacterium was directed to at least one of the four statutory categories,

because the bacterium was a “manufacture” and/or a “composition of matter.” In its opinion, the Court stated that “Congress plainly contemplated that the patent laws would be given wide scope” because it chose to draft [35 U.S.C. 101](#) using “such expansive terms as ‘manufacture’ and ‘composition of matter,’ modified by the comprehensive ‘any.’” 447 U.S. at 308, 206 USPQ at 197. The Court also determined that the distinction between living and inanimate things was not relevant for subject matter eligibility. 447 U.S. at 313, 206 USPQ at 199. Thus, the Court held that living subject matter with markedly different characteristics from any found in nature, such as the claimed bacterium produced by genetic engineering, is not excluded from patent protection by [35 U.S.C. 101](#). 447 U.S. at 310, 206 USPQ at 197.

Following the reasoning in *Chakrabarty*, the Board of Patent Appeals and Interferences determined that animals are patentable subject matter under [35 U.S.C. 101](#). In *Ex parte Allen*, 2 USPQ2d 1425 (Bd. Pat. App. & Inter. 1987), the Board decided that a non-naturally occurring polyploid Pacific coast oyster could have been the proper subject of a patent under [35 U.S.C. 101](#) if all the criteria for patentability were satisfied. Shortly after the *Allen* decision, the Commissioner of Patents and Trademarks issued a notice (Animals - Patentability, 1077 O.G. 24, April 21, 1987) stating that the Patent and Trademark Office “now considers nonnaturally occurring, non-human multicellular living organisms, including animals, to be patentable subject matter within the scope of [35 U.S.C. 101](#).”

With respect to plant subject matter, the Supreme Court held that patentable subject matter under [35 U.S.C. 101](#) includes newly developed plant breeds, even though plant protection is also available under the Plant Patent Act ([35 U.S.C. 161 - 164](#)) and the Plant Variety Protection Act (7 U.S.C. 2321 *et. seq.*). *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 143-46, 60 USPQ2d 1865, 1874 (2001) (The scope of coverage of [35 U.S.C. 101](#) is not limited by the Plant Patent Act or the Plant Variety Protection Act; each statute can be regarded as effective because of its different requirements and protections).

See [MPEP § 2106.03](#) for a discussion of the categories of statutory subject matter.

### ***B. Living Subject Matter May Be Eligible for Patent Protection***

The Supreme Court in *Chakrabarty* held a claim to a genetically engineered bacterium eligible, because the claimed bacterium was not a “product of nature” exception. As the Court explained, the modified bacterium was patentable because the patent claim was not to a “hitherto unknown natural phenomenon,” but instead had “markedly different characteristics from any found in nature,” due to the additional plasmids and resultant capacity for degrading oil. 447 U.S. at 309-10, 206 USPQ at 197.

Subsequent judicial decisions have made clear that the Supreme Court’s decision in *Chakrabarty* is “central” to the eligibility inquiry with respect to nature-based products. See, e.g., *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 590, 106 USPQ2d 1972, 1979 (2013). For example, the Federal Circuit has indicated that “discoveries that possess ‘markedly different characteristics from any found in nature,’ ... are eligible for patent protection.” *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1336, 110 USPQ2d 1668, 1671 (Fed. Cir. 2014) (quoting *Chakrabarty*, 447 U.S. at 310, 206 USPQ2d at 197). In *Roslin*, the claimed invention was a live-born clone of a pre-existing, non-embryonic, donor mammal selected from cattle, sheep, pigs, and goats. An embodiment of the claimed invention was the famous Dolly the Sheep, which the court stated was “the first mammal ever cloned from an adult somatic cell.” Despite acknowledging that the method used to create the claimed clones “constituted a breakthrough in scientific discovery”, the court relied on *Chakrabarty* in holding the claims ineligible because “Dolly herself is an exact genetic replica of another sheep and does not possess ‘markedly different characteristics from any [farm animals] found in nature.’” *Roslin*, 750 F.3d at 1337, 110 USPQ2d at 1671.

See [MPEP § 2106.04](#) for a discussion of the judicial exceptions in general, [MPEP § 2106.04\(b\)](#), subsection II, for a discussion of products of nature, and [MPEP § 2106.04\(c\)](#) for a discussion of the

markedly different characteristics analysis that examiners should use to determine whether a nature-based product such as living subject matter is eligible for patent protection.

### **III. HUMAN ORGANISMS ARE NONSTATUTORY SUBJECT MATTER**

Congress has excluded claims directed to or encompassing a human organism from patentability. The Leahy-Smith America Invents Act (AIA), Public Law 112-29, [sec. 33\(a\)](#), 125 Stat. 284, states:

Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.

The legislative history of the AIA includes the following statement, which sheds light on the meaning of this provision:

[T]he U.S. Patent Office has already issued patents on genes, stems cells, animals with human genes, and a host of non-biologic products used by humans, but it has not issued patents on claims directed to human organisms, including human embryos and fetuses. My amendment would not affect the former, but would simply affirm the latter.

157 Cong. Rec. E1177-04 (testimony of Representative Dave Weldon previously presented in connection with the Consolidated Appropriations Act, 2004, Public Law 108-199, 634, 118 Stat. 3, 101, and later resubmitted with regard to the AIA; see 149 Cong. Rec. E2417-01). Thus, [section 33\(a\) of the AIA](#) codifies existing Office policy that human organisms are not patent-eligible subject matter.

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human organism, then a rejection under [35 U.S.C. 101](#) and [AIA sec. 33\(a\)](#) must be made indicating that the claimed invention is directed to a human organism and is therefore nonstatutory subject matter. Furthermore, the claimed invention must be examined with regard to all issues pertinent to patentability, and any applicable rejections under [35 U.S.C. 102](#), [103](#), or [112](#) must also be made.

Use form paragraph 7.04.03 to reject a claim under [35 U.S.C. 101](#) and [AIA sec. 33\(a\)](#).

#### ¶ 7.04.03 Human Organism

Section 33(a) of the America Invents Act reads as follows

Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.

Claim [1] rejected under [35 U.S.C. 101](#) and section 33(a) of the America Invents Act as being directed to or encompassing a human organism. See also *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (indicating that human organisms are excluded from the scope of patentable subject matter under [35 U.S.C. 101](#)). [2]

#### Examiner Note:

1. This paragraph must be preceded by form paragraph 7.04.01 which quotes [35 U.S.C. 101](#).
2. In bracket 1, pluralize “Claim” if necessary, insert claim number(s), and insert “is” or “are” as appropriate.
3. In bracket 2, explain why the claim is interpreted to read on a human organism.

## 2106 Patent Subject Matter Eligibility [R-10.2019]

### I. TWO CRITERIA FOR SUBJECT MATTER ELIGIBILITY

First, the claimed invention must be to one of the four statutory categories. [35 U.S.C. 101](#) defines the four categories of invention that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed). See [35 U.S.C. 100\(b\)](#) (“The term ‘process’ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”). See [MPEP § 2106.03](#) for detailed information on the four categories.

Second, the claimed invention also must qualify as patent-eligible subject matter, i.e., the claim must not be directed to a judicial exception unless the claim as a whole includes additional limitations amounting to significantly more than the exception. The judicial exceptions (also called “judicially recognized exceptions” or simply “exceptions”) are

subject matter that the courts have found to be outside of, or exceptions to, the four statutory categories of invention, and are limited to abstract ideas, laws of nature and natural phenomena (including products of nature). *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216, 110 USPQ2d 1976, 1980 (2014) (citing *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589, 106 USPQ2d 1972, 1979 (2013)). See [MPEP § 2106.04](#) for detailed information on the judicial exceptions.

Because abstract ideas, laws of nature, and natural phenomenon “are the basic tools of scientific and technological work”, the Supreme Court has expressed concern that monopolizing these tools by granting patent rights may impede innovation rather than promote it. See *Alice Corp.*, 573 U.S. at 216, 110 USPQ2d at 1980; *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71, 101 USPQ2d 1961, 1965 (2012). However, the Court has also emphasized that an invention is not considered to be ineligible for patenting simply because it involves a judicial exception. *Alice Corp.*, 573 U.S. at 217, 110 USPQ2d at 1980-81 (citing *Diamond v. Diehr*, 450 U.S. 175, 187, 209 USPQ 1, 8 (1981)). See also *Thales Visionix Inc. v. United States*, 850 F.3d. 1343, 1349, 121 USPQ2d 1898, 1902 (Fed. Cir. 2017) (“That a mathematical equation is required to complete the claimed method and system does not doom the claims to abstraction.”). Accordingly, the Court has said that integration of an abstract idea, law of nature or natural phenomenon into a practical application may be eligible for patent protection. See, e.g., *Alice*, 573 U.S. at 217, 110 USPQ2d at 1981 (explaining that “in applying the [§101](#) exception, we must distinguish between patents that claim the ‘buildin[g] block[s]’ of human ingenuity and those that integrate the building blocks into something more” (quoting *Mayo*, 566 U.S. at 89, 110 USPQ2d at 1971) and stating that *Mayo* “set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts”); *Mayo*, 566 U.S. at 80, 84, 101 USPQ2d at 1969, 1971 (noting that the Court in *Diamond v. Diehr* found “the overall process patent eligible because of the way the additional steps of the process integrated the equation into the process as a whole.”

but the Court in *Gottschalk v. Benson* “held that simply implementing a mathematical principle on a physical machine, namely a computer, was not a patentable application of that principle”); *Bilski v. Kappos*, 561 U.S. 593, 611, 95 USPQ2d 1001, 1010 (2010) (“*Diehr* explained that while an abstract idea, law of nature, or mathematical formula could not be patented, ‘an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.’” (quoting *Diamond v. Diehr*, 450 U.S. 175, 187, 209 USPQ 1, 8 (1981)) (emphasis in original)); *Diehr*, 450 U.S. at 187, 192 n.14, 209 USPQ at 10 n.14 (explaining that the process in *Parker v. Flook* was ineligible not because it contained a mathematical formula, but because it did not provide an application of the formula). See *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981); *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972); *Parker v. Flook*, 437 U.S. 584, 198 USPQ 193 (1978).

The Supreme Court in *Mayo* laid out a framework for determining whether an applicant is seeking to patent a judicial exception itself, or a patent-eligible application of the judicial exception. See *Alice Corp.*, 573 U.S. at 217-18, 110 USPQ2d at 1981 (citing *Mayo*, 566 U.S. 66, 101 USPQ2d 1961). This framework, which is referred to as the *Mayo* test or the *Alice/Mayo* test, is discussed in further detail in subsection III, below. The first part of the *Mayo* test is to determine whether the claims are directed to an abstract idea, a law of nature or a natural phenomenon (i.e., a judicial exception). *Id.* If the claims are directed to a judicial exception, the second part of the *Mayo* test is to determine whether the claim recites additional elements that amount to significantly more than the judicial exception. *Id.* citing *Mayo*, 566 U.S. at 72-73, 101 USPQ2d at 1966). The Supreme Court has described the second part of the test as the “search for an ‘inventive concept’”. *Alice Corp.*, 573 U.S. at 217-18, 110 USPQ2d at 1981 (citing *Mayo*, 566 U.S. at 72-73, 101 USPQ2d at 1966).

The *Alice/Mayo* two-part test is the only test that should be used to evaluate the eligibility of claims under examination. While the machine-or-transformation test is an important clue to eligibility, it should not be used as a separate test for eligibility. Instead it should be considered as part

of the “integration” determination or “significantly more” determination articulated in the *Alice/Mayo* test. *Bilski v. Kappos*, 561 U.S. 593, 605, 95 USPQ2d 1001, 1007 (2010). See [MPEP § 2106.04\(d\)](#) for more information about evaluating whether a claim reciting a judicial exception is integrated into a practical application and [MPEP § 2106.05\(b\)](#) and [MPEP § 2106.05\(c\)](#) for more information about how the machine-or-transformation test fits into the *Alice/Mayo* two-part framework. Likewise, eligibility should not be evaluated based on whether the claim recites a “useful, concrete, and tangible result,” *State Street Bank*, 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998) (quoting *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994)), as this test has been superseded. *In re Bilski*, 545 F.3d 943, 959-60, 88 USPQ2d 1385, 1394-95 (Fed. Cir. 2008) (*en banc*), *aff’d* by *Bilski v. Kappos*, 561 U.S. 593, 95 USPQ2d 1001 (2010). See also *TLI Communications LLC v. AV Automotive LLC*, 823 F.3d 607, 613, 118 USPQ2d 1744, 1748 (Fed. Cir. 2016) (“It is well-settled that mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea”). The programmed computer or “special purpose computer” test of *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) (*i.e.*, the rationale that an otherwise ineligible algorithm or software could be made patent-eligible by merely adding a generic computer to the claim for the “special purpose” of executing the algorithm or software) was also superseded by the Supreme Court’s *Bilski* and *Alice Corp.* decisions. *Eon Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623, 114 USPQ2d 1711, 1715 (Fed. Cir. 2015) (“[W]e note that *Alappat* has been superseded by *Bilski*, 561 U.S. at 605–06, and *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 110 USPQ2d 1976 (2014)”); *Intellectual Ventures I LLC v. Capital One Bank (USA), N.A.*, 792 F.3d 1363, 1366, 115 USPQ2d 1636, 1639 (Fed. Cir. 2015) (“An abstract idea does not become nonabstract by limiting the invention to a particular field of use or technological environment, such as the Internet [or] a computer”). Lastly, eligibility should not be evaluated based on whether the claimed invention has utility, because “[u]tility is not the test for patent-eligible subject matter.” *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1380, 118 USPQ2d 1541, 1548 (Fed. Cir. 2016).



Examiners are reminded that [35 U.S.C. 101](#) is not the sole tool for determining patentability; [35 U.S.C. 112](#), [35 U.S.C. 102](#), and [35 U.S.C. 103](#) will provide additional tools for ensuring that the claim meets the conditions for patentability. As the Supreme Court made clear in *Bilski*, 561 U.S. at 602, 95 USPQ2d at 1006:

The [§ 101](#) patent-eligibility inquiry is only a threshold test. Even if an invention qualifies as a process, machine, manufacture, or composition of matter, in order to receive the Patent Act’s protection the claimed invention must also satisfy “the conditions and requirements of this title.” [§ 101](#). Those requirements include that the invention be novel, see [§ 102](#), nonobvious, see [§ 103](#), and fully and particularly described, see [§ 112](#).

## II. ESTABLISH BROADEST REASONABLE INTERPRETATION OF CLAIMS AS A WHOLE

It is essential that the broadest reasonable interpretation (BRI) of the claim be established prior to examining a claim for eligibility. The BRI sets the boundaries of the coverage sought by the claim and will influence whether the claim seeks to cover subject matter that is beyond the four statutory categories or encompasses subject matter that falls within the exceptions. See *MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373, 1379, 2019 USPQ2d 305789 (Fed. Cir. 2019) (“Determining patent eligibility requires a full understanding of the basic character of the claimed subject matter”), citing *Bancorp Servs., LLC v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1273-74, 103 USPQ2d 1425, 1430 (Fed. Cir. 2012); *In re Bilski*, 545 F.3d 943, 951, 88 USPQ2d 1385, 1388 (Fed. Cir. 2008) (*en banc*), *aff’d by Bilski v. Kappos*, 561 U.S. 593, 95 USPQ2d 1001 (2010) (“claim construction ... is an important first step in a [§ 101](#) analysis”). Evaluating eligibility based on the BRI also ensures that patent eligibility under [35 U.S.C. 101](#) does not depend simply on the draftsman’s art. *Alice*, 573 U.S. 208, 224, 110 USPQ2d at 1984, 1985 (citing *Parker v. Flook*, 437 U.S. 584, 593, 198 USPQ 193, 198 (1978) and *Mayo*, 566 U.S. at 72, 101 USPQ2d at 1966). See [MPEP § 2111](#) for more information about determining the BRI.

Claim interpretation affects the evaluation of both criteria for eligibility. For example, in *Mentor Graphics v. EVE-USA, Inc.*, 851 F.3d 1275, 112 USPQ2d 1120 (Fed. Cir. 2017), claim interpretation was crucial to the court’s determination that claims to a “machine-readable medium” were not to a statutory category. In *Mentor Graphics*, the court interpreted the claims in light of the specification, which expressly defined the medium as encompassing “any data storage device” including random-access memory and carrier waves. Although random-access memory and magnetic tape are statutory media, carrier waves are not because they are signals similar to the transitory, propagating signals held to be non-statutory in *Nuijten*. 851 F.3d at 1294, 112 USPQ2d at 1133 (citing *In re Nuijten*, 500 F.3d 1346, 84 USPQ2d 1495 (Fed. Cir. 2007)). Accordingly, because the BRI of the claims covered both subject matter that falls within a statutory category (the random-access memory), as well as subject matter that does not (the carrier waves), the claims as a whole were not to a statutory category and thus failed the first criterion for eligibility.

With regard to the second criterion for eligibility, the *Alice/Mayo* test, claim interpretation can affect the first part of the test (whether the claims are directed to a judicial exception). For example, the patentee in *Synopsys* argued that the claimed methods of logic circuit design were intended to be used in conjunction with computer-based design tools, and were thus not mental processes. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1147-49, 120 USPQ2d 1473, 1480-81 (Fed. Cir. 2016). The court disagreed, because it interpreted the claims as encompassing nothing other than pure mental steps (and thus falling within an abstract idea grouping) because the claims did not include any limitations requiring computer implementation. In contrast, the patentee in *Enfish* argued that its claimed self-referential table for a computer database was an improvement in an existing technology and thus not directed to an abstract idea. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336-37, 118 USPQ2d 1684, 1689-90 (Fed. Cir. 2016). The court agreed with the patentee, based on its interpretation of the claimed “means for configuring” under [35 U.S.C. 112\(f\)](#) as requiring a four-step algorithm that achieved the improvements, as opposed to merely any form of storing tabular data. See also *McRO*,

*Inc. v. Bandai Namco Games America, Inc.* 837 F.3d 1299, 1314, 120 USPQ2d 1091, 1102 (Fed. Cir. 2016) (the claim’s construction incorporated rules of a particular type that improved an existing technological process). Claim interpretation can also affect the second part of the *Alice/Mayo* test (whether the claim recites additional elements that amount to significantly more than the judicial exception). For example, in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, where the court relied on the construction of the term “enhance” (to require application of a number of field enhancements in a distributed fashion) to determine that the claim entails an unconventional technical solution to a technological problem. 841 F.3d 1288, 1300-01, 120 USPQ2d 1527, 1537 (Fed. Cir. 2016).

### III. SUMMARY OF ANALYSIS AND FLOWCHART

Examiners should determine whether a claim satisfies the criteria for subject matter eligibility by evaluating the claim in accordance with the following flowchart. The flowchart illustrates the steps of the subject matter eligibility analysis for products and processes that are to be used during examination for evaluating whether a claim is drawn to patent-eligible subject matter. It is recognized that under the controlling legal precedent there may be variations in the precise contours of the analysis for subject matter eligibility that will still achieve the same end result. The analysis set forth herein promotes examination efficiency and consistency across all technologies.

As shown in the flowchart, Step 1 relates to the statutory categories and ensures that the first criterion is met by confirming that the claim falls within one of the four statutory categories of invention. See [MPEP § 2106.03](#) for more information on Step 1. Step 2, which is the Supreme Court’s *Alice/Mayo* test, is a two-part test to identify claims that are directed to a judicial exception (Step 2A) and to then evaluate if additional elements of the claim provide an inventive concept (Step 2B) (also called “significantly more” than the recited judicial exception). See [MPEP § 2106.04](#) for more

information on Step 2A and [MPEP § 2106.05](#) for more information on Step 2B.

The flowchart also shows three pathways (A, B, and C) to eligibility:

Pathway A: Claims taken as a whole that fall within a statutory category (Step 1: YES) and, which may or may not recite a judicial exception, but whose eligibility is self-evident can be found eligible at Pathway A using a streamlined analysis. See [MPEP § 2106.06](#) for more information on this pathway and on self-evident eligibility.

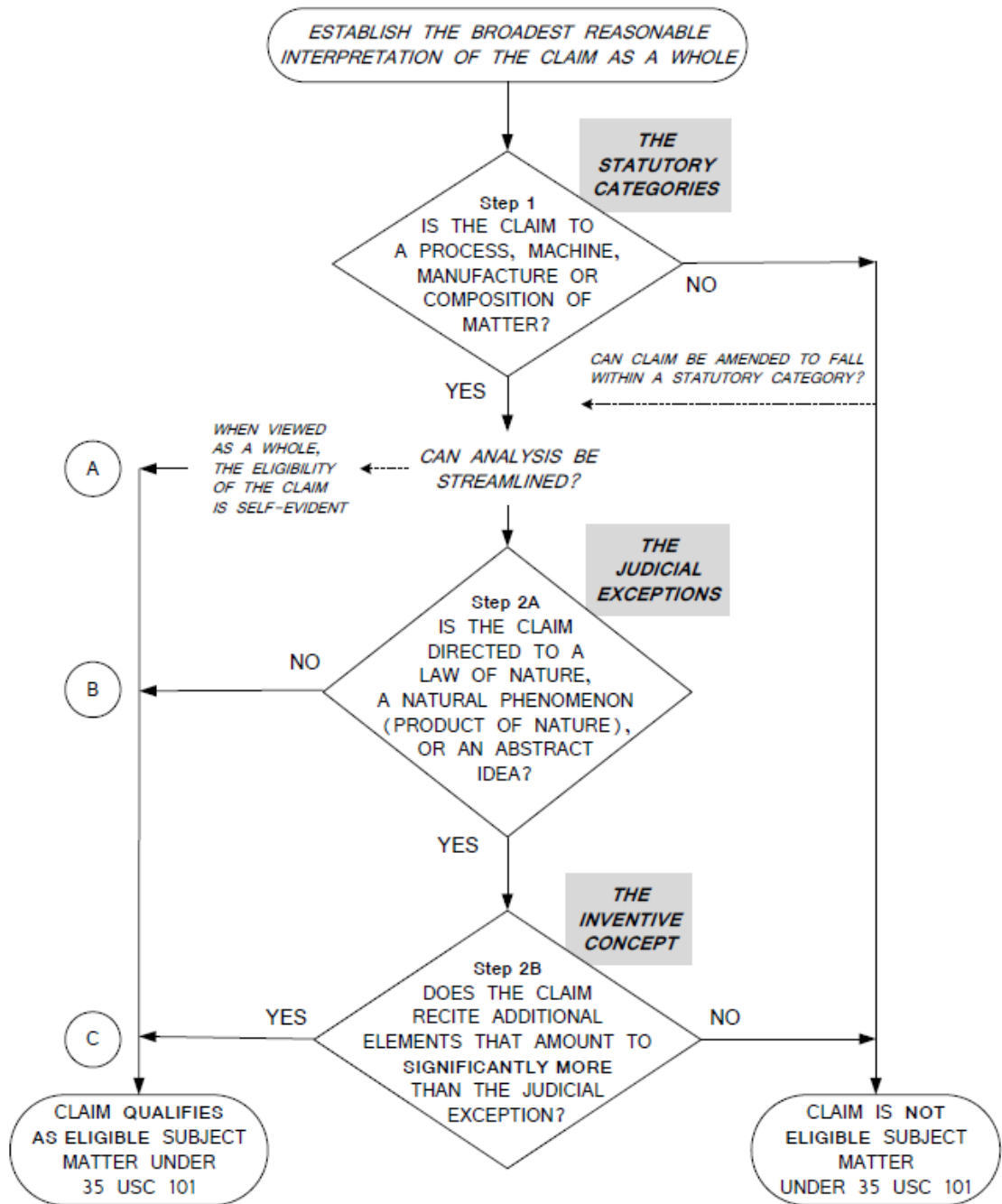
Pathway B: Claims taken as a whole that fall within a statutory category (Step 1: YES) and are not directed to a judicial exception (Step 2A: NO) are eligible at Pathway B. These claims do not need to go to Step 2B. See [MPEP § 2106.04](#) for more information about this pathway and Step 2A.

Pathway C: Claims taken as a whole that fall within a statutory category (Step 1: YES), are directed to a judicial exception (Step 2A: YES), and recite additional elements either individually or in an ordered combination that amount to significantly more than the judicial exception (Step 2B: YES) are eligible at Pathway C. See [MPEP § 2106.05](#) for more information about this pathway and Step 2B.

Claims that could have been found eligible at Pathway A (streamlined analysis), but are subjected to further analysis at Steps 2A or Step 2B, will ultimately be found eligible at Pathways B or C. Thus, if the examiner is uncertain about whether a streamlined analysis is appropriate, the examiner is encouraged to conduct a full eligibility analysis. However, if the claim is not found eligible at any of Pathways A, B or C, the claim is patent ineligible and should be rejected under [35 U.S.C. 101](#).

Regardless of whether a rejection under [35 U.S.C. 101](#) is made, a complete examination should be made for every claim under each of the other patentability requirements: [35 U.S.C. 102](#), [103](#), [112](#), and [101](#) (utility, inventorship and double patenting) and non-statutory double patenting. [MPEP § 2103](#).

**SUBJECT MATTER ELIGIBILITY TEST FOR PRODUCTS AND PROCESSES**



A B C → THE PATHWAYS TO ELIGIBILITY

**2106.01 [Reserved]****2106.02 [Reserved]****2106.03 Eligibility Step 1: The Four Categories of Statutory Subject Matter [R-07.2022]****I. THE FOUR CATEGORIES**

[35 U.S.C. 101](#) enumerates four categories of subject matter that Congress deemed to be appropriate subject matter for a patent: processes, machines, manufactures and compositions of matter. As explained by the courts, these “four categories together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of [§ 101](#) even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354, 84 USPQ2d 1495, 1500 (Fed. Cir. 2007).

A process defines “actions”, *i.e.*, an invention that is claimed as an act or step, or a series of acts or steps. As explained by the Supreme Court, a “process” is “a mode of treatment of certain materials to produce a given result. It is an *act, or a series of acts*, performed upon the subject-matter to be transformed and reduced to a different state or thing.” *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 USPQ 673, 676 (1972) (*italics added*) (quoting *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L. Ed. 139, 141 (1876)). See also *Nuijten*, 500 F.3d at 1355, 84 USPQ2d at 1501 (“The Supreme Court and this court have consistently interpreted the statutory term ‘process’ to require action”); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1316, 75 USPQ2d 1763, 1791 (Fed. Cir. 2005) (“[A] process is a series of acts.”) (quoting *Minton v. Natl. Ass’n. of Securities Dealers*, 336 F.3d 1373, 1378, 67 USPQ2d 1614, 1681 (Fed. Cir. 2003)). As defined in [35 U.S.C. 100\(b\)](#), the term “process” is synonymous with “method.”

The other three categories (machines, manufactures and compositions of matter) define the types of physical or tangible “things” or “products” that Congress deemed appropriate to patent. *Digitech*

*Image Techs. v. Electronics for Imaging*, 758 F.3d 1344, 1348, 111 USPQ2d 1717, 1719 (Fed. Cir. 2014) (“For all categories except process claims, the eligible subject matter must exist in some physical or tangible form.”). Thus, when determining whether a claimed invention falls within one of these three categories, examiners should verify that the invention is to at least one of the following categories **and** is claimed in a physical or tangible form.

- A machine is a “concrete thing, consisting of parts, or of certain devices and combination of devices.” *Digitech*, 758 F.3d at 1348-49, 111 USPQ2d at 1719 (quoting *Burr v. Duryee*, 68 U.S. 531, 570, 17 L. Ed. 650, 657 (1863)). This category “includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.” *Nuijten*, 500 F.3d at 1355, 84 USPQ2d at 1501 (quoting *Corning v. Burden*, 56 U.S. 252, 267, 14 L. Ed. 683, 690 (1854)).

- A manufacture is “a tangible article that is given a new form, quality, property, or combination through man-made or artificial means.” *Digitech*, 758 F.3d at 1349, 111 USPQ2d at 1719-20 (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980)). As the courts have explained, manufactures are articles that result from the process of manufacturing, *i.e.*, they were produced “from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct. 429, 120 USPQ2d 1749, 1752-3 (2016) (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980)); *Nuijten*, 500 F.3d at 1356-57, 84 USPQ2d at 1502. Manufactures also include “the parts of a machine considered separately from the machine itself.” *Samsung Electronics*, 137 S. Ct. at 435, 120 USPQ2d at 1753 (quoting 1 W. Robinson, *The Law of Patents for Useful Inventions* §183, p. 270 (1890)).

- A composition of matter is a “combination of two or more substances and includes all composite articles.” *Digitech*, 758 F.3d at 1348-49, 111 USPQ2d at 1719 (citation omitted). This category includes all compositions of two or more substances and all composite articles, “whether they be the results of chemical union or of mechanical mixture, or whether they be gases, fluids, powders or solids.”

*Chakrabarty*, 447 U.S. at 308, 206 USPQ at 197 (quoting *Shell Dev. Co. v. Watson*, 149 F. Supp. 279, 280 (D.D.C. 1957); *id.* at 310 holding genetically modified microorganism to be a manufacture or composition of matter).

It is not necessary to identify a single category into which a claim falls, so long as it is clear that the claim falls into at least one category. For example, because a microprocessor is generally understood to be a manufacture, a product claim to the microprocessor or a system comprising the microprocessor satisfies Step 1 regardless of whether the claim falls within any other statutory category (such as a machine). It is also not necessary to identify a “correct” category into which the claim falls, because although in many instances it is clear within which category a claimed invention falls, a claim may satisfy the requirements of more than one category. For example, a bicycle satisfies both the machine and manufacture categories, because it is a tangible product that is concrete and consists of parts such as a frame and wheels (thus satisfying the machine category), and it is an article that was produced from raw materials such as aluminum ore and liquid rubber by giving them a new form (thus satisfying the manufacture category). Similarly, a genetically modified bacterium satisfies both the composition of matter and manufacture categories, because it is a tangible product that is a combination of two or more substances such as proteins, carbohydrates and other chemicals (thus satisfying the composition of matter category), and it is an article that was genetically modified by humans to have new properties such as the ability to digest multiple types of hydrocarbons (thus satisfying the manufacture category).

Non-limiting examples of claims that are not directed to any of the statutory categories include:

- Products that do not have a physical or tangible form, such as information (often referred to as “data per se”) or a computer program per se (often referred to as “software per se”) when claimed as a product without any structural recitations;
- Transitory forms of signal transmission (often referred to as “signals per se”), such as a propagating electrical or electromagnetic signal or carrier wave; and

- Subject matter that the statute expressly prohibits from being patented, such as humans per se, which are excluded under The Leahy-Smith America Invents Act (AIA), Public Law 112-29, sec. 33, 125 Stat. 284 (September 16, 2011).

As the courts' definitions of machines, manufactures and compositions of matter indicate, a product must have a physical or tangible form in order to fall within one of these statutory categories. *Digitech*, 758 F.3d at 1348, 111 USPQ2d at 1719. Thus, the Federal Circuit has held that a product claim to an intangible collection of information, even if created by human effort, does not fall within any statutory category. *Digitech*, 758 F.3d at 1350, 111 USPQ2d at 1720 (claimed “device profile” comprising two sets of data did not meet any of the categories because it was neither a process nor a tangible product). Similarly, software expressed as code or a set of instructions detached from any medium is an idea without physical embodiment. See *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449, 82 USPQ2d 1400, 1407 (2007); see also *Benson*, 409 U.S. 67, 175 USPQ2d 675 (An “idea” is not patent eligible). Thus, a product claim to a software program that does not also contain at least one structural limitation (such as a “means plus function” limitation) has no physical or tangible form, and thus does not fall within any statutory category. Another example of an intangible product that does not fall within a statutory category is a paradigm or business model for a marketing company. *In re Ferguson*, 558 F.3d 1359, 1364, 90 USPQ2d 1035, 1039-40 (Fed. Cir. 2009).

Even when a product has a physical or tangible form, it may not fall within a statutory category. For instance, a transitory signal, while physical and real, does not possess concrete structure that would qualify as a device or part under the definition of a machine, is not a tangible article or commodity under the definition of a manufacture (even though it is man-made and physical in that it exists in the real world and has tangible causes and effects), and is not composed of matter such that it would qualify as a composition of matter. *Nuijten*, 500 F.3d at 1356-1357, 84 USPQ2d at 1501-03. As such, a transitory, propagating signal does not fall within any statutory category. *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1294, 112 USPQ2d



1120, 1133 (Fed. Cir. 2017); *Nuijten*, 500 F.3d at 1356-1357, 84 USPQ2d at 1501-03.

## II. ELIGIBILITY STEP 1: WHETHER A CLAIM IS TO A STATUTORY CATEGORY

As described in [MPEP § 2106](#), subsection III, Step 1 of the eligibility analysis asks: Is the claim to a process, machine, manufacture or composition of matter? Like the other steps in the eligibility analysis, evaluation of this step should be made after determining what the inventor has invented by reviewing the entire application disclosure and construing the claims in accordance with their broadest reasonable interpretation (BRI). See [MPEP § 2106](#), subsection II, for more information about the importance of understanding what has been invented, and [MPEP § 2111](#) for more information about the BRI.

In the context of the flowchart in [MPEP § 2106](#), subsection III, Step 1 determines whether:

- The claim as a whole does not fall within any statutory category (Step 1: NO) and thus is non-statutory, warranting a rejection for failure to claim statutory subject matter; or
- The claim as a whole falls within one or more statutory categories (Step 1: YES), and thus must be further analyzed to determine whether it qualifies as eligible at Pathway A or requires further analysis at Step 2A to determine if the claim is directed to a judicial exception.

A claim whose BRI covers both statutory and non-statutory embodiments embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter. Such claims fail the first step (Step 1: NO) and should be rejected under [35 U.S.C. 101](#), for at least this reason. In such a case, it is a best practice for the examiner to point out the BRI and recommend an amendment, if possible, that would narrow the claim to those embodiments that fall within a statutory category.

For example, the BRI of machine readable media can encompass non-statutory transitory forms of signal transmission, such as a propagating electrical or electromagnetic signal per se. See *In re Nuijten*, 500 F.3d 1346, 84 USPQ2d 1495 (Fed. Cir. 2007).

When the BRI encompasses transitory forms of signal transmission, a rejection under [35 U.S.C. 101](#) as failing to claim statutory subject matter would be appropriate. Thus, a claim to a computer readable medium that can be a compact disc or a carrier wave covers a non-statutory embodiment and therefore should be rejected under [35 U.S.C. 101](#) as being directed to non-statutory subject matter. See, e.g., *Mentor Graphics v. EVE-USA, Inc.*, 851 F.3d at 1294-95, 112 USPQ2d at 1134 (claims to a “machine-readable medium” were non-statutory, because their scope encompassed both statutory random-access memory and non-statutory carrier waves).

If a claim is clearly not within one of the four categories (Step 1: NO), then a rejection under [35 U.S.C. 101](#) must be made indicating that the claim is directed to non-statutory subject matter. Form paragraphs 7.05 and 7.05.01 should be used; see [MPEP § 2106.07\(a\)\(1\)](#). However, as shown in the flowchart in [MPEP § 2106](#) subsection III, when a claim fails under Step 1 (Step 1: NO), but it appears from applicant’s disclosure that the claim could be amended to fall within a statutory category (Step 1: YES), the analysis should proceed to determine whether such an amended claim would qualify as eligible at Pathway A, B or C. In such a case, it is a best practice for the examiner to recommend an amendment, if possible, that would resolve eligibility of the claim.

### 2106.04 Eligibility Step 2A: Whether a Claim is Directed to a Judicial Exception [R-07.2022]

#### I. JUDICIAL EXCEPTIONS

Determining that a claim falls within one of the four enumerated categories of patentable subject matter recited in [35 U.S.C. 101](#) (i.e., process, machine, manufacture, or composition of matter) in Step 1 does not end the eligibility analysis, because claims directed to nothing more than abstract ideas (such as a mathematical formula or equation), natural phenomena, and laws of nature are not eligible for patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216, 110 USPQ2d 1976, 1980 (2014) (citing *Association for Molecular*

*Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589, 106 USPQ2d 1972, 1979 (2013)); *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980); *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 67-68, 175 USPQ 673, 675 (1972). See also *Bilski v. Kappos*, 561 U.S. 593, 601, 95 USPQ2d 1001, 1005-06 (2010) (“The Court’s precedents provide three specific exceptions to § 101’s broad patent-eligibility principles: ‘laws of nature, physical phenomena, and abstract ideas’”) (quoting *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197 (1980)).

In addition to the terms “laws of nature,” “natural phenomena,” and “abstract ideas,” judicially recognized exceptions have been described using various other terms, including “physical phenomena,” “products of nature,” “scientific principles,” “systems that depend on human intelligence alone,” “disembodied concepts,” “mental processes,” and “disembodied mathematical algorithms and formulas.” It should be noted that there are no bright lines between the types of exceptions, and that many of the concepts identified by the courts as exceptions can fall under several exceptions. For example, mathematical formulas are considered to be a judicial exception as they express a scientific truth, but have been labelled by the courts as both abstract ideas and laws of nature. Likewise, “products of nature” are considered to be an exception because they tie up the use of naturally occurring things, but have been labelled as both laws of nature and natural phenomena. Thus, it is sufficient for this analysis for the examiner to identify that the claimed concept (the specific claim limitation(s) that the examiner believes may recite an exception) aligns with at least one judicial exception.

The Supreme Court has explained that the judicial exceptions reflect the Court’s view that abstract ideas, laws of nature, and natural phenomena are “the basic tools of scientific and technological work”, and are thus excluded from patentability because “monopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it.” *Alice Corp.*, 573 U.S. at 216, 110 USPQ2d at 1980 (quoting *Myriad*, 569 U.S. at 589, 106 USPQ2d at 1978 and

*Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 71, 101 USPQ2d 1961, 1965 (2012)). The Supreme Court’s concern that drives this “exclusionary principle” is pre-emption. *Alice Corp.*, 573 U.S. at 216, 110 USPQ2d at 1980. The Court has held that a claim may not preempt abstract ideas, laws of nature, or natural phenomena, even if the judicial exception is narrow (e.g., a particular mathematical formula such as the Arrhenius equation). See, e.g., *Mayo*, 566 U.S. at 79-80, 86-87, 101 USPQ2d at 1968-69, 1971 (claims directed to “narrow laws that may have limited applications” held ineligible); *Flook*, 437 U.S. at 589-90, 198 USPQ at 197 (claims that did not “wholly preempt the mathematical formula” held ineligible). This is because such a patent would “in practical effect [] be a patent on the [abstract idea, law of nature or natural phenomenon] itself.” *Benson*, 409 U.S. at 71- 72, 175 USPQ at 676. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”).

While preemption is the concern underlying the judicial exceptions, it is not a standalone test for determining eligibility. *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1052, 119 USPQ2d 1370, 1376 (Fed. Cir. 2016). Instead, questions of preemption are inherent in and resolved by the two-part framework from *Alice Corp. and Mayo* (the *Alice/Mayo* test referred to by the Office as Steps 2A and 2B). *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1150, 120 USPQ2d 1473, 1483 (Fed. Cir. 2016); *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379, 115 USPQ2d 1152, 1158 (Fed. Cir. 2015). It is necessary to evaluate eligibility using the *Alice/Mayo* test, because while a preemptive claim may be ineligible, the absence of complete preemption does not demonstrate that a claim is eligible. *Diamond v. Diehr*, 450 U.S. 175, 191-92 n.14, 209 USPQ 1, 10-11 n.14 (1981) (“We rejected in *Flook* the argument that because all possible uses of the mathematical formula were not pre-empted, the claim should be eligible for patent protection”). See also *Synopsys v. Mentor Graphics*, 839 F.3d at 1150, 120 USPQ2d at 1483; *FairWarning IP, LLC v. Iatric*

*Sys., Inc.*, 839 F.3d 1089, 1098, 120 USPQ2d 1293, 1299 (Fed. Cir. 2016); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1320-21, 120 USPQ2d 1353, 1362 (Fed. Cir. 2016); *Sequenom*, 788 F.3d at 1379, 115 USPQ2d at 1158. Several Federal Circuit decisions, however, have noted the absence of preemption when finding claims eligible under the *Alice/Mayo* test. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102-03 (Fed. Cir. 2016); *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1052, 119 USPQ2d 1370, 1376 (Fed. Cir. 2016); *BASCOM Global Internet v. AT&T Mobility, LLC*, 827 F.3d 1341, 1350-52, 119 USPQ2d 1236, 1243-44 (Fed. Cir. 2016).

The Supreme Court's decisions make it clear that judicial exceptions need not be old or long-prevalent, and that even newly discovered or novel judicial exceptions are still exceptions. For example, the mathematical formula in *Flook*, the laws of nature in *Mayo*, and the isolated DNA in *Myriad* were all novel or newly discovered, but nonetheless were considered by the Supreme Court to be judicial exceptions because they were “‘basic tools of scientific and technological work’ that lie beyond the domain of patent protection.” *Myriad*, 569 U.S. 576, 589, 106 USPQ2d at 1976, 1978 (noting that *Myriad* discovered the BRCA1 and BRCA1 genes and quoting *Mayo*, 566 U.S. 71, 101 USPQ2d at 1965); *Flook*, 437 U.S. at 591-92, 198 USPQ2d at 198 (“the novelty of the mathematical algorithm is not a determining factor at all”); *Mayo*, 566 U.S. 73-74, 78, 101 USPQ2d 1966, 1968 (noting that the claims embody the researcher's discoveries of laws of nature). The Supreme Court's cited rationale for considering even “just discovered” judicial exceptions as exceptions stems from the concern that “without this exception, there would be considerable danger that the grant of patents would ‘tie up’ the use of such tools and thereby ‘inhibit future innovation premised upon them.’” *Myriad*, 569 U.S. at 589, 106 USPQ2d at 1978-79 (quoting *Mayo*, 566 U.S. at 86, 101 USPQ2d at 1971). See also *Myriad*, 569 U.S. at 591, 106 USPQ2d at 1979 (“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the §101 inquiry.”). The Federal Circuit has also applied this principle, for example, when holding a concept of using advertising as an exchange or currency to be

an abstract idea, despite the patentee's arguments that the concept was “new”. *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714-15, 112 USPQ2d 1750, 1753-54 (Fed. Cir. 2014). Cf. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151, 120 USPQ2d 1473, 1483 (Fed. Cir. 2016) (“a *new* abstract idea is still an abstract idea”) (emphasis in original).

For a detailed discussion of abstract ideas, see [MPEP § 2106.04\(a\)](#); for a detailed discussion of laws of nature, natural phenomena and products of nature, see [MPEP § 2106.04\(b\)](#).

## II. ELIGIBILITY STEP 2A: WHETHER A CLAIM IS DIRECTED TO A JUDICIAL EXCEPTION

As described in [MPEP § 2106](#), subsection III, Step 2A of the Office's eligibility analysis is the first part of the *Alice/Mayo* test, *i.e.*, the Supreme Court's “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217-18, 110 USPQ2d 1976, 1981 (2014) (citing *Mayo*, 566 U.S. at 77-78, 101 USPQ2d at 1967-68). Like the other steps in the eligibility analysis, evaluation of this step should be made after determining what the inventor has invented by reviewing the entire application disclosure and construing the claims in accordance with their broadest reasonable interpretation. See [MPEP § 2106](#), subsection II for more information about the importance of understanding what has been invented, and [MPEP § 2111](#) for more information about the broadest reasonable interpretation.

Step 2A asks: Is the claim directed to a law of nature, a natural phenomenon (product of nature) or an abstract idea? In the context of the flowchart in [MPEP § 2106](#), subsection III, Step 2A determines whether:

- The claim as a whole is not directed to a judicial exception (Step 2A: NO) and thus is eligible at Pathway B, thereby concluding the eligibility analysis; or
- The claim as a whole is directed to a judicial exception (Step 2A: YES) and thus requires further analysis at Step 2B to determine if the claim as a



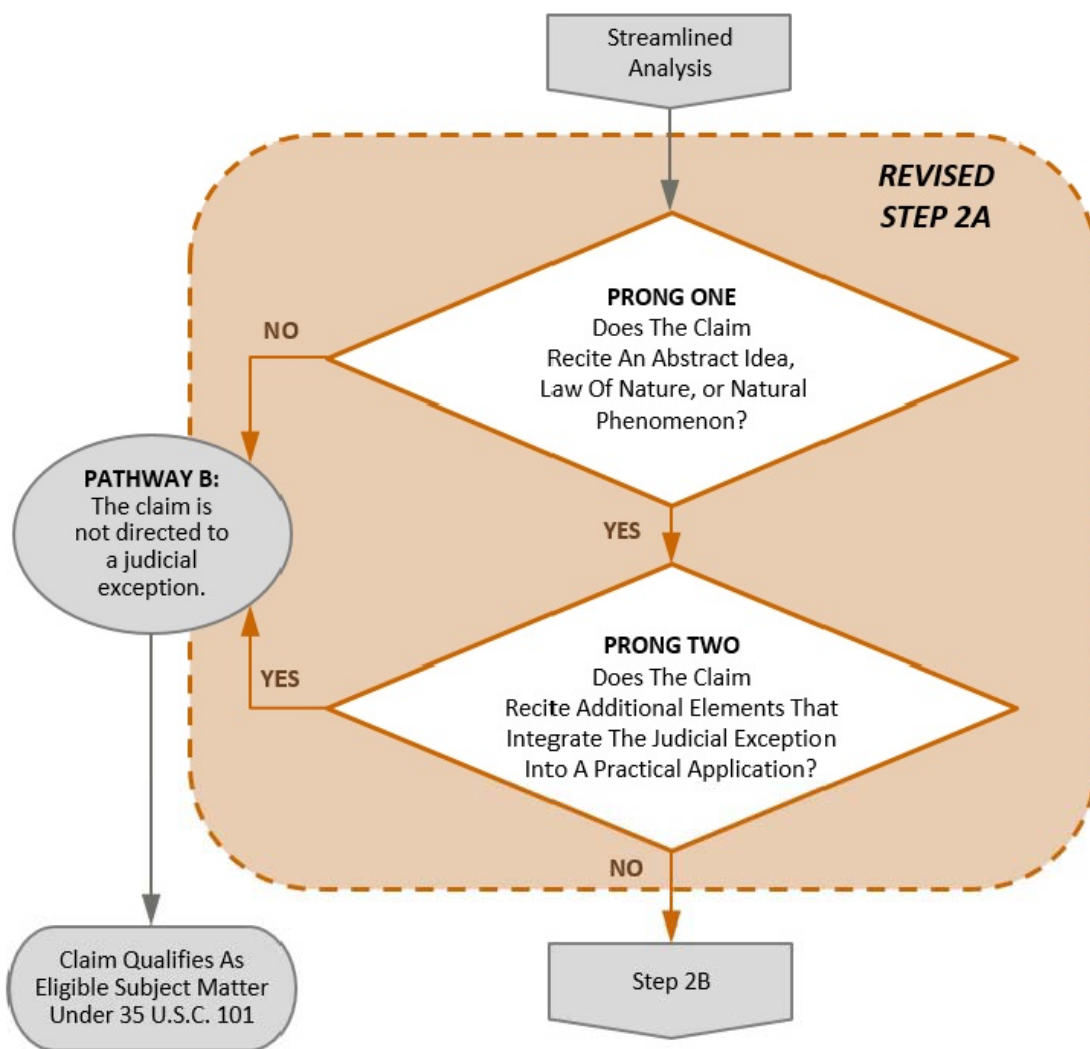
whole amounts to significantly more than the exception itself.

**A. Step 2A Is a Two-Prong Inquiry**

Step 2A is a two-prong inquiry, in which examiners determine in Prong One whether a claim recites a judicial exception, and if so, then determine in Prong Two if the recited judicial exception is integrated

into a practical application of that exception. Together, these prongs represent the first part of the *Alice/Mayo* test, which determines whether a claim is directed to a judicial exception.

The flowchart below depicts the two-prong analysis that is performed in order to answer the Step 2A inquiry.



**1. Prong One**

Prong One asks does the claim recite an abstract idea, law of nature, or natural phenomenon? In Prong One examiners evaluate whether the claim recites a judicial exception, i.e. whether a law of nature,

natural phenomenon, or abstract idea is **set forth** or **described** in the claim. While the terms "set forth" and "described" are thus both equated with "recite", their different language is intended to indicate that there are two ways in which an exception can be recited in a claim. For instance, the claims in *Diehr*,

450 U.S. at 178 n. 2, 179 n.5, 191-92, 209 USPQ at 4-5 (1981), clearly stated a mathematical equation in the repetitively calculating step, and the claims in *Mayo*, 566 U.S. 66, 75-77, 101 USPQ2d 1961, 1967-68 (2012), clearly stated laws of nature in the wherein clause, such that the claims “set forth” an identifiable judicial exception. Alternatively, the claims in *Alice Corp.*, 573 U.S. at 218, 110 USPQ2d at 1982, described the concept of intermediated settlement without ever explicitly using the words “intermediated” or “settlement.”

The Supreme Court has held that Section 101 contains an implicit exception for “[l]aws of nature, natural phenomena, and abstract ideas,” which are “the basic tools of scientific and technological work.” *Alice Corp.*, 573 U.S. at 216, 110 USPQ2d at 1980 (citing *Mayo*, 566 US at 71, 101 USPQ2d at 1965). Yet, the Court has explained that “[a]t some level, all inventions embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas,” and has cautioned “to tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Id.* See also *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335, 118 USPQ2d 1684, 1688 (Fed. Cir. 2016) (“The ‘directed to’ inquiry, therefore, cannot simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions involves a law of nature and/or natural phenomenon”). Examiners should accordingly be careful to distinguish claims that **recite** an exception (which require further eligibility analysis) and claims that merely **involve** an exception (which are eligible and do not require further eligibility analysis).

An example of a claim that recites a judicial exception is “A machine comprising elements that operate in accordance with  $F=ma$ .” This claim sets forth the principle that force equals mass times acceleration ( $F=ma$ ) and therefore recites a law of nature exception. Because  $F=ma$  represents a mathematical formula, the claim could alternatively be considered as reciting an abstract idea. Because this claim recites a judicial exception, it requires further analysis in Prong Two in order to answer the Step 2A inquiry. An example of a claim that merely involves, or is based on, an exception is a claim to “A teeter-totter comprising an elongated member

pivotably attached to a base member, having seats and handles attached at opposing sides of the elongated member.” This claim is based on the concept of a lever pivoting on a fulcrum, which involves the natural principles of mechanical advantage and the law of the lever. However, this claim does not recite these natural principles and therefore is not directed to a judicial exception (Step 2A: NO). Thus, the claim is eligible at Pathway B without further analysis.

If the claim recites a judicial exception (*i.e.*, an abstract idea enumerated in [MPEP § 2106.04\(a\)](#), a law of nature, or a natural phenomenon), the claim requires further analysis in Prong Two. If the claim does not recite a judicial exception (a law of nature, natural phenomenon, or abstract idea), then the claim cannot be directed to a judicial exception (Step 2A: NO), and thus the claim is eligible at Pathway B without further analysis.

For more information how to determine if a claim recites an abstract idea, see [MPEP § 2106.04\(a\)](#). For more information on how to determine if a claim recites a law of nature or natural phenomenon, see [MPEP § 2106.04\(b\)](#). For more information on how to determine if a claim recites a product of nature, see [MPEP § 2106.04\(c\)](#).

## 2. Prong Two

Prong Two asks does the claim recite additional elements that integrate the judicial exception into a practical application? In Prong Two, examiners evaluate whether the claim as a whole integrates the exception into a practical application of that exception. If the additional elements in the claim integrate the recited exception into a practical application of the exception, then the claim is not directed to the judicial exception (Step 2A: NO) and thus is eligible at Pathway B. This concludes the eligibility analysis. If, however, the additional elements do not integrate the exception into a practical application, then the claim is directed to the recited judicial exception (Step 2A: YES), and requires further analysis under Step 2B (where it may still be eligible if it amounts to an “inventive concept”). For more information on how to evaluate whether a judicial exception is integrated into a practical application, see [MPEP § 2106.04\(d\)\(2\)](#).

The mere inclusion of a judicial exception such as a mathematical formula (which is one of the mathematical concepts identified as an abstract idea in [MPEP § 2106.04\(a\)](#)) in a claim means that the claim “recites” a judicial exception under Step 2A Prong One. However, mere recitation of a judicial exception does not mean that the claim is “directed to” that judicial exception under Step 2A Prong Two. Instead, under Prong Two, a claim that recites a judicial exception is not directed to that judicial exception, if the claim as a whole integrates the recited judicial exception into a practical application of that exception. Prong Two thus distinguishes claims that are “directed to” the recited judicial exception from claims that are not “directed to” the recited judicial exception.

Because a judicial exception is not eligible subject matter, *Bilski*, 561 U.S. at 601, 95 USPQ2d at 1005-06 (quoting *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197 (1980)), if there are no additional claim elements besides the judicial exception, or if the additional claim elements merely recite another judicial exception, that is insufficient to integrate the judicial exception into a practical application. See, e.g., *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327, 122 USPQ2d 1377 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea (encoding and decoding) does not render the claim non-abstract”); *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1376, 118 USPQ2d 1541, 1546 (Fed. Cir. 2016) (eligibility “cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.”). For a claim reciting a judicial exception to be eligible, the additional elements (if any) in the claim must “transform the nature of the claim” into a patent-eligible application of the judicial exception, *Alice Corp.*, 573 U.S. at 217, 110 USPQ2d at 1981, either at Prong Two or in Step 2B. If there are no additional elements in the claim, then it cannot be eligible. In such a case, after making the appropriate rejection (see [MPEP § 2106.07](#) for more information on formulating a rejection for lack of eligibility), it is a best practice for the examiner to recommend an amendment, if possible, that would resolve eligibility of the claim.

### **B. Evaluating Claims Reciting Multiple Judicial Exceptions**

A claim may recite multiple judicial exceptions. For example, claim 4 at issue in *Bilski v. Kappos*, 561 U.S. 593, 95 USPQ2d 1001 (2010) recited two abstract ideas, and the claims at issue in *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 101 USPQ2d 1961 (2012) recited two laws of nature. However, these claims were analyzed by the Supreme Court in the same manner as claims reciting a single judicial exception, such as those in *Alice Corp.*, 573 U.S. 208, 110 USPQ2d 1976.

During examination, examiners should apply the same eligibility analysis to all claims regardless of the number of exceptions recited therein. Unless it is clear that a claim recites distinct exceptions, such as a law of nature and an abstract idea, care should be taken not to parse the claim into multiple exceptions, particularly in claims involving abstract ideas. Accordingly, if possible examiners should treat the claim for Prong Two and Step 2B purposes as containing a single judicial exception.

In some claims, the multiple exceptions are distinct from each other, e.g., a first limitation describes a law of nature, and a second limitation elsewhere in the claim recites an abstract idea. In these cases, for purposes of examination efficiency, examiners should select one of the exceptions and conduct the eligibility analysis for that selected exception. If the analysis indicates that the claim recites an additional element or combination of elements that integrate the selected exception into a practical application or that amount to significantly more than the selected exception, then the claim should be considered patent eligible. On the other hand, if the claim does not recite any additional element or combination of elements that integrate the selected exception into a practical application, and also does not recite any additional element or combination of elements that amounts to significantly more than the selected exception, then the claim should be considered ineligible. *University of Utah Research Foundation v. Ambry Genetics*, 774 F.3d 755, 762, 113 USPQ2d 1241, 1246 (Fed. Cir. 2014) (because claims did not amount to significantly more than the recited abstract idea, court “need not decide” if claims also recited a law of nature).

In other claims, multiple abstract ideas, which may fall in the same or different groupings, or multiple laws of nature may be recited. In these cases, examiners should not parse the claim. For example, in a claim that includes a series of steps that recite mental steps as well as a mathematical calculation, an examiner should identify the claim as reciting both a mental process and a mathematical concept for Step 2A Prong One to make the analysis clear on the record. However, if possible, the examiner should consider the limitations together as a single abstract idea for Step 2A Prong Two and Step 2B (if necessary) rather than as a plurality of separate abstract ideas to be analyzed individually.

### **2106.04(a) Abstract Ideas [R-07.2022]**

The abstract idea exception has deep roots in the Supreme Court’s jurisprudence. See *Bilski v. Kappos*, 561 U.S. 593, 601-602, 95 USPQ2d 1001, 1006 (2010) (citing *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 174–175 (1853)). Despite this long history, the courts have declined to define abstract ideas. However, it is clear from the body of judicial precedent that software and business methods are not excluded categories of subject matter. For example, the Supreme Court concluded that business methods are not “categorically outside of [§ 101](#)’s scope,” stating that “a business method is simply one kind of ‘method’ that is, at least in some circumstances, eligible for patenting under [§ 101](#).” *Bilski*, 561 U.S. at 607, 95 USPQ2d at 1008 (2010). See also *Content Extraction and Transmission, LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1347, 113 USPQ2d 1354, 1357 (Fed. Cir. 2014) (“there is no categorical business-method exception”). Likewise, software is not automatically an abstract idea, even if performance of a software task involves an underlying mathematical calculation or relationship. See, e.g., *Thales Visionix, Inc. v. United States*, 850 F.3d 1343, 121 USPQ2d 1898, 1902 (Fed. Cir. 2017) (“That a mathematical equation is required to complete the claimed method and system does not doom the claims to abstraction.”); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316, 120 USPQ2d 1091, 1103 (Fed. Cir. 2016) (methods of automatic lip synchronization and facial expression animation using computer-implemented rules were not directed to an abstract idea); *Enfish*, 822 F.3d 1327, 1336, 118 USPQ2d 1684, 1689 (Fed.

Cir. 2016) (claims to self-referential table for a computer database were not directed to an abstract idea).

To facilitate examination, the Office has set forth an approach to identifying abstract ideas that distills the relevant case law into enumerated groupings of abstract ideas. The enumerated groupings are firmly rooted in Supreme Court precedent as well as Federal Circuit decisions interpreting that precedent, as is explained in [MPEP § 2106.04\(a\)\(2\)](#). This approach represents a shift from the former case-comparison approach that required examiners to rely on individual judicial cases when determining whether a claim recites an abstract idea. By grouping the abstract ideas, the examiners’ focus has been shifted from relying on individual cases to generally applying the wide body of case law spanning all technologies and claim types.

The enumerated groupings of abstract ideas are defined as:

- 1) Mathematical concepts – mathematical relationships, mathematical formulas or equations, mathematical calculations (see [MPEP § 2106.04\(a\)\(2\)](#), subsection I);
- 2) Certain methods of organizing human activity – fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions) (see [MPEP § 2106.04\(a\)\(2\)](#), subsection II); and
- 3) Mental processes – concepts performed in the human mind (including an observation, evaluation, judgment, opinion) (see [MPEP § 2106.04\(a\)\(2\)](#), subsection III).

Examiners should determine whether a claim recites an abstract idea by (1) identifying the specific limitation(s) in the claim under examination that the examiner believes recites an abstract idea, and (2) determining whether the identified limitation(s) fall within at least one of the groupings of abstract ideas listed above. The groupings of abstract ideas, and



their relationship to the body of judicial precedent, are further discussed in [MPEP § 2106.04\(a\)\(2\)](#).

If the identified limitation(s) falls within at least one of the groupings of abstract ideas, it is reasonable to conclude that the claim recites an abstract idea in Step 2A Prong One. The claim then requires further analysis in Step 2A Prong Two, to determine whether any additional elements in the claim integrate the abstract idea into a practical application, see [MPEP § 2106.04\(d\)](#).

If the identified limitation(s) do not fall within any of the groupings of abstract ideas, it is reasonable to find that the claim does not recite an abstract idea. This concludes the abstract idea judicial exception eligibility analysis, except in the rare circumstance discussed in [MPEP § 2106.04\(a\)\(3\)](#), below. The claim is thus eligible at Pathway B unless the claim recites, and is directed to, another exception (such as a law of nature or natural phenomenon).

If the claims recites another judicial exception (i.e. law of nature or natural phenomenon), see [MPEP §§ 2106.04\(b\)](#) and [2106.04\(c\)](#) for more information on Step 2A analysis.

[MPEP § 2106.04\(a\)\(1\)](#) provides examples of claims that do not recite abstract ideas (or other judicial exceptions) and thus are eligible at Step 2A Prong One.

[MPEP § 2106.04\(a\)\(2\)](#) provides further explanation on the abstract idea groupings. It should be noted that these groupings are not mutually exclusive, i.e., some claims recite limitations that fall within more than one grouping or sub-grouping. For example, a claim reciting performing mathematical calculations using a formula that could be practically performed in the human mind may be considered to fall within the mathematical concepts grouping and the mental process grouping. Accordingly, examiners should identify at least one abstract idea grouping, but preferably identify all groupings to the extent possible, if a claim limitation(s) is determined to fall within multiple groupings and proceed with the analysis in Step 2A Prong Two.

## **2106.04(a)(1) Examples of Claims That Do Not Recite Abstract Ideas [R-10.2019]**

When evaluating a claim to determine whether it recites an abstract idea, examiners should keep in mind that while “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomenon, or abstract ideas”, not all claims recite an abstract idea. See *Alice Corp. Pty. Ltd. v. CLS Bank, Int’l*, 573 U.S. 208, 217, 110 USPQ2d 1976, 1980-81 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 US 66, 71, 101 USPQ2d 1961, 1965 (2012)). The Step 2A Prong One analysis articulated in [MPEP § 2106.04](#) accounts for this cautionary principle by requiring a claim to recite (i.e., set forth or describe) an abstract idea in Prong One before proceeding to the Prong Two inquiry about whether the claim is directed to that idea, thereby separating claims reciting abstract ideas from those that are merely based on or involve an abstract idea.

Some claims are not directed to an abstract idea because they do not recite an abstract idea, although it may be apparent that at some level they are based on or involve an abstract idea. Because these claims do not recite an abstract idea (or other judicial exception), they are eligible at Step 2A Prong One (Pathway B).

Non-limiting hypothetical examples of claims that do not recite (set forth or describe) an abstract idea include:

- i. a printer comprising a belt, a roller, a printhead and at least one ink cartridge;
- ii. a washing machine comprising a tub, a drive motor operatively connected to the tub, a controller for controlling the drive motor, and a housing for containing the tub, drive motor, and controller;
- iii. an earring comprising a sensor for taking periodic blood glucose measurements and a memory for storing measurement data from the sensor;
- iv. a method for sequencing BRCA1 gene sequences comprising: amplifying by a polymerization chain reaction technique all or part of a BRCA1 gene from a tissue sample from a human subject using a set of primers to produce

amplified nucleic acids; and sequencing the amplified nucleic acids;

v. a method for loading BIOS into a local computer system which has a system processor and volatile memory and non-volatile memory, the method comprising the steps of: responding to powering up of the local computer system by requesting from a memory location remote from the local computer system the transfer to and storage in the volatile memory of the local computer system of BIOS configured for effective use of the local computer system, transferring and storing such BIOS, and transferring control of the local computer system to such BIOS;

vi. a method of rearranging icons on a graphical user interface (GUI) comprising the steps of: receiving a user selection to organize each icon based on the amount of use of each icon, determining the amount of use of each icon by using a processor to track the amount of memory allocated to the application associated with the icon over a period of time, and automatically moving the most used icons to a position in the GUI closest to the start icon of the computer system based on the determined amount of use; and

vii. a method of training a neural network for facial detection comprising: collecting a set of digital facial images, applying one or more transformations to the digital images, creating a first training set including the modified set of digital facial images; training the neural network in a first stage using the first training set, creating a second training set including digital non-facial images that are incorrectly detected as facial images in the first stage of training; and training the neural network in a second stage using the second training set.

## **2106.04(a)(2) Abstract Idea Groupings [R-07.2022]**

### **I. MATHEMATICAL CONCEPTS**

The mathematical concepts grouping is defined as mathematical relationships, mathematical formulas or equations, and mathematical calculations. The Supreme Court has identified a number of concepts falling within this grouping as abstract ideas including: a procedure for converting binary-coded decimal numerals into pure binary form, *Gottschalk*

*v. Benson*, 409 U.S. 63, 65, 175 USPQ2d 673, 674 (1972); a mathematical formula for calculating an alarm limit, *Parker v. Flook*, 437 U.S. 584, 588-89, 198 USPQ2d 193, 195 (1978); the Arrhenius equation, *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 15 (1981); and a mathematical formula for hedging, *Bilski v. Kappos*, 561 U.S. 593, 611, 95 USPQ 2d 1001, 1004 (2010).

The Court's rationale for identifying these "mathematical concepts" as judicial exceptions is that a "mathematical formula as such is not accorded the protection of our patent laws," *Diehr*, 450 U.S. at 191, 209 USPQ at 15 (citing *Benson*, 409 U.S. 63, 175 USPQ 673), and thus "the discovery of [a mathematical formula] cannot support a patent unless there is some other inventive concept in its application." *Flook*, 437 U.S. at 594, 198 USPQ at 199. In the past, the Supreme Court sometimes described mathematical concepts as laws of nature, and at other times described these concepts as judicial exceptions without specifying a particular type of exception. See, e.g., *Benson*, 409 U.S. at 65, 175 USPQ2d at 674; *Flook*, 437 U.S. at 589, 198 USPQ2d at 197; *Mackay Radio & Telegraph Co. v. Radio Corp. of Am.*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("[A] scientific truth, or the mathematical expression of it, is not patentable invention[.]"). More recent opinions of the Supreme Court, however, have affirmatively characterized mathematical relationships and formulas as abstract ideas. See, e.g., *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 218, 110 USPQ2d 1976, 1981 (2014) (describing *Flook* as holding "that a mathematical formula for computing 'alarm limits' in a catalytic conversion process was also a patent-ineligible abstract idea."); *Bilski v. Kappos*, 561 U.S. 593, 611-12, 95 USPQ2d 1001, 1010 (2010) (noting that the claimed "concept of hedging, described in claim 1 and reduced to a mathematical formula in claim 4, is an unpatentable abstract idea,").

When determining whether a claim recites a mathematical concept (*i.e.*, mathematical relationships, mathematical formulas or equations, and mathematical calculations), examiners should consider whether the claim recites a mathematical concept or merely limitations that are based on or involve a mathematical concept. A claim does not

recite a mathematical concept (*i.e.*, the claim limitations do not fall within the mathematical concept grouping), if it is only based on or involves a mathematical concept. See, *e.g.*, *Thales Visionix, Inc. v. United States*, 850 F.3d 1343, 1348-49, 121 USPQ2d 1898, 1902-03 (Fed. Cir. 2017) (determining that the claims to a particular configuration of inertial sensors and a particular method of using the raw data from the sensors in order to more accurately calculate the position and orientation of an object on a moving platform did not merely recite “the abstract idea of using ‘mathematical equations for determining the relative position of a moving object to a moving reference frame’”). For example, a limitation that is merely based on or involves a mathematical concept described in the specification may not be sufficient to fall into this grouping, provided the mathematical concept itself is not recited in the claim.

It is important to note that a mathematical concept need not be expressed in mathematical symbols, because “[w]ords used in a claim operating on data to solve a problem can serve the same purpose as a formula.” *In re Grams*, 888 F.2d 835, 837 and n.1, 12 USPQ2d 1824, 1826 and n.1 (Fed. Cir. 1989). See, *e.g.*, *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163, 127 USPQ2d 1597, 1599 (Fed. Cir. 2018) (holding that claims to a “series of mathematical calculations based on selected information” are directed to abstract ideas); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1350, 111 USPQ2d 1717, 1721 (Fed. Cir. 2014) (holding that claims to a “process of organizing information through mathematical correlations” are directed to an abstract idea); and *Bancorp Servs., LLC v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1280, 103 USPQ2d 1425, 1434 (Fed. Cir. 2012) (identifying the concept of “managing a stable value protected life insurance policy by performing calculations and manipulating the results” as an abstract idea).

#### A. *Mathematical Relationships*

A mathematical relationship is a relationship between variables or numbers. A mathematical relationship may be expressed in words or using mathematical symbols. For example, pressure (p) can be described as the ratio between the magnitude

of the normal force (F) and area of the surface on contact (A), or it can be set forth in the form of an equation such as  $p = F/A$ .

Examples of mathematical relationships recited in a claim include:

i. a relationship between reaction rate and temperature, which relationship can be expressed in the form of a formula called the Arrhenius equation, *Diamond v. Diehr*; 450 U.S. at 178 n. 2, 179 n.5, 191-92, 209 USPQ at 4-5 (1981);

ii. a conversion between binary coded decimal and pure binary, *Benson*, 409 U.S. at 64, 175 USPQ at 674;

iii. a mathematical relationship between enhanced directional radio activity and antenna conductor arrangement (*i.e.*, the length of the conductors with respect to the operating wave length and the angle between the conductors), *Mackay Radio & Tel. Co. v. Radio Corp. of America*, 306 U.S. 86, 91, 40 USPQ 199, 201 (1939) (while the litigated claims 15 and 16 of U.S. Patent No. 1,974,387 expressed this mathematical relationship using a formula that described the angle between the conductors, other claims in the patent (*e.g.*, claim 1) expressed the mathematical relationship in words); and

iv. organizing information and manipulating information through mathematical correlations, *Digitech Image Techs., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344, 1350, 111 USPQ2d 1717, 1721 (Fed. Cir. 2014). The patentee in *Digitech* claimed methods of generating first and second data by taking existing information, manipulating the data using mathematical functions, and organizing this information into a new form. The court explained that such claims were directed to an abstract idea because they described a process of organizing information through mathematical correlations, like *Flook's* method of calculating using a mathematical formula. 758 F.3d at 1350, 111 USPQ2d at 1721.

#### B. *Mathematical Formulas or Equations*

A claim that recites a numerical formula or equation will be considered as falling within the “mathematical concepts” grouping. In addition, there are instances where a formula or equation is written

in text format that should also be considered as falling within this grouping. For example, the phrase “determining a ratio of A to B” is merely using a textual replacement for the particular equation (ratio = A/B). Additionally, the phrase “calculating the force of the object by multiplying its mass by its acceleration” is using a textual replacement for the particular equation ( $F = ma$ ).

Examples of mathematical equations or formulas recited in a claim include:

- i. a formula describing certain electromagnetic standing wave phenomena, *Mackay Radio & Tel. Co. v. Radio Corp. of America*, 306 U.S. 86, 91, 40 USPQ 199, 201 (1939) (50.9(1/lambda<-0.513>);
- ii. the Arrhenius equation, *Diamond v. Diehr*; 450 U.S. 175, 178 n. 2, 179 n.5, 191-92, 209 USPQ at 4-5 (1981) ( $\ln v = CZ + x$ );
- iii. a formula for computing an alarm limit, *Parker v. Flook*, 437 U.S. 584, 585, 198 USPQ 193, 195 (1978) ( $B_1 = B_0 (1.0 - F) + PVL(F)$ ); and
- iv. a mathematical formula for hedging (claim 4), *Bilski v. Kappos*, 561 U.S. 593, 599, 95 USPQ2d 1001, 1004 (2010) (Fixed Bill Price =  $F_i + [(C_i + T_i + LD_i) \times ( + E(W_i))]$ ).

### C. Mathematical Calculations

A claim that recites a mathematical calculation, when the claim is given its broadest reasonable interpretation in light of the specification, will be considered as falling within the “mathematical concepts” grouping. A mathematical calculation is a mathematical operation (such as multiplication) or an act of calculating using mathematical methods to determine a variable or number, *e.g.*, performing an arithmetic operation such as exponentiation. There is no particular word or set of words that indicates a claim recites a mathematical calculation. That is, a claim does not have to recite the word “calculating” in order to be considered a mathematical calculation. For example, a step of “determining” a variable or number using mathematical methods or “performing” a mathematical operation may also be considered mathematical calculations when the broadest reasonable interpretation of the claim in light of the specification encompasses a mathematical calculation.

Examples of mathematical calculations recited in a claim include:

- i. performing a resampled statistical analysis to generate a resampled distribution, *SAP America, Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163-65, 127 USPQ2d 1597, 1598-1600 (Fed. Cir. 2018), modifying *SAP America, Inc. v. InvestPic, LLC*, 890 F.3d 1016, 126 USPQ2d 1638 (Fed. Cir. 2018);
- ii. calculating a number representing an alarm limit value using the mathematical formula “ $B_1 = B_0 (1.0 - F) + PVL(F)$ ”, *Parker v. Flook*, 437 U.S. 584, 585, 198 USPQ 193, 195 (1978);
- iii. using a formula to convert geospatial coordinates into natural numbers, *Burnett v. Panasonic Corp.*, 741 Fed. Appx. 777, 780 (Fed. Cir. 2018) (non-precedential);
- iv. managing a stable value protected life insurance policy via performing calculations, *Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1280, 103 USPQ2d 1425, 1434 (Fed. Cir. 2012);
- v. using an algorithm for determining the optimal number of visits by a business representative to a client, *In re Maucorps*, 609 F.2d 481, 482, 203 USPQ 812, 813 (CCPA 1979); and
- vi. calculating the difference between local and average data values, *In re Abele*, 684 F.2d 902, 903, 214 USPQ 682, 683-84 (CCPA 1982).

## II. CERTAIN METHODS OF ORGANIZING HUMAN ACTIVITY

The phrase “methods of organizing human activity” is used to describe concepts relating to:

- fundamental economic principles or practices (including hedging, insurance, mitigating risk);
- commercial or legal interactions (including agreements in the form of contracts, legal obligations, advertising, marketing or sales activities or behaviors, and business relations); and
- managing personal behavior or relationships or interactions between people, (including social activities, teaching, and following rules or instructions).

The Supreme Court has identified a number of concepts falling within the “certain methods of



organizing human activity” grouping as abstract ideas. In particular, in *Alice*, the Court concluded that the use of a third party to mediate settlement risk is a “fundamental economic practice” and thus an abstract idea. 573 U.S. at 219–20, 110 USPQ2d at 1982. In addition, the Court in *Alice* described the concept of risk hedging identified as an abstract idea in *Bilski* as “a method of organizing human activity”. *Id.* Previously, in *Bilski*, the Court concluded that hedging is a “fundamental economic practice” and therefore an abstract idea. 561 U.S. at 611–612, 95 USPQ2d at 1010.

The term “certain” qualifies the “certain methods of organizing human activity” grouping as a reminder of several important points. First, not all methods of organizing human activity are abstract ideas (*e.g.*, “a defined set of steps for combining particular ingredients to create a drug formulation” is not a certain “method of organizing human activity”), *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160–61, 129 USPQ2d 1008, 1011 (Fed. Cir. 2018). Second, this grouping is limited to activity that falls within the enumerated sub-groupings of fundamental economic principles or practices, commercial or legal interactions, and managing personal behavior and relationships or interactions between people, and is not to be expanded beyond these enumerated sub-groupings except in rare circumstances as explained in [MPEP § 2106.04\(a\)\(3\)](#). Finally, the sub-groupings encompass both activity of a single person (for example, a person following a set of instructions or a person signing a contract online) and activity that involves multiple people (such as a commercial interaction), and thus, certain activity between a person and a computer (for example a method of anonymous loan shopping that a person conducts using a mobile phone) may fall within the “certain methods of organizing human activity” grouping. It is noted that the number of people involved in the activity is not dispositive as to whether a claim limitation falls within this grouping. Instead, the determination should be based on whether the activity itself falls within one of the sub-groupings.

#### A. *Fundamental Economic Practices or Principles*

The courts have used the phrases “fundamental economic practices” or “fundamental economic

principles” to describe concepts relating to the economy and commerce. Fundamental economic principles or practices include hedging, insurance, and mitigating risks.

The term “fundamental” is not used in the sense of necessarily being “old” or “well-known.” See, *e.g.*, *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364, 115 U.S.P.Q.2d 1090, 1092 (Fed Cir. 2015) (a new method of price optimization was found to be a fundamental economic concept); *In re Smith*, 815 F.3d 816, 818–19, 118 USPQ2d 1245, 1247 (Fed. Cir. 2016) (describing a new set of rules for conducting a wagering game as a “fundamental economic practice”); *In re Greenstein*, 774 Fed. Appx. 661, 664, 2019 USPQ2d 212400 (Fed Cir. 2019) (non-precedential) (claims to a new method of allocating returns to different investors in an investment fund was a fundamental economic concept). However, being old or well-known may indicate that the practice is fundamental. See, *e.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 219–20, 110 USPQ2d 1981–82 (2014) (describing the concept of intermediated settlement, like the risk hedging in *Bilski*, to be a “fundamental economic practice long prevalent in our system of commerce” and also as “a building block of the modern economy”) (citation omitted); *Bilski v. Kappos*, 561 U.S. 593, 611, 95 USPQ2d 1001, 1010 (2010) (claims to the concept of hedging are a “fundamental economic practice long prevalent in our system of commerce and taught in any introductory finance class.”) (citation omitted); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313, 120 USPQ2d 1353, 1356 (Fed. Cir. 2016) (“The category of abstract ideas embraces ‘fundamental economic practice[s] long prevalent in our system of commerce,’ ... including ‘longstanding commercial practice[s]’”).

An example of a case identifying a claim as reciting a fundamental economic practice is *Bilski v. Kappos*, 561 U.S. 593, 609, 95 USPQ2d 1001, 1009 (2010). The fundamental economic practice at issue was hedging or protecting against risk. The applicant in *Bilski* claimed “a series of steps instructing how to hedge risk,” *i.e.*, how to protect against risk. 561 U.S. at 599, 95 USPQ2d at 1005. The method allowed energy suppliers and consumers to minimize the risks resulting from fluctuations in market

demand for energy. The Supreme Court determined that hedging is “fundamental economic practice” and therefore is an “unpatentable abstract idea.” 561 U.S. at 611-12, 95 USPQ2d at 1010.

Another example of a case identifying a claim as reciting a fundamental economic practice is *Bancorp Services, L.L.C. v. Sun Life Assurance Co. of Canada (U.S.)*, 687 F.3d 1266, 103 USPQ2d 1425 (Fed. Cir. 2012). The fundamental economic practice at issue in *Bancorp* pertained to insurance. The patentee in *Bancorp* claimed methods and systems for managing a life insurance policy on behalf of a policy holder, which comprised steps including generating a life insurance policy including a stable value protected investment with an initial value based on a value of underlying securities, calculating surrender value protected investment credits for the life insurance policy; determining an investment value and a value of the underlying securities for the current day; and calculating a policy value and a policy unit value for the current day. 687 F.3d at 1270-71, 103 USPQ2d at 1427. The court described the claims as an “attempt to patent the use of the abstract idea of [managing a stable value protected life insurance policy] and then instruct the use of well-known [calculations] to help establish some of the inputs into the equation.” 687 F.3d at 1278, 103 USPQ2d at 1433 (alterations in original) (citing *Bilski*).

Other examples of “fundamental economic principles or practices” include:

- i. mitigating settlement risk, *Alice Corp. v. CLS Bank*, 573 U.S. 208, 218, 110 USPQ2d 1976, 1982 (2014);
- ii. rules for conducting a wagering game, *In re Smith*, 815 F.3d 816, 818-19, 118 USPQ2d 1245, 1247 (Fed. Cir. 2016);
- iii. financial instruments that are designed to protect against the risk of investing in financial instruments, *In re Chorna*, 656 Fed. App'x 1016, 1021 (Fed. Cir. 2016) (non-precedential);
- iv. offer-based price optimization, *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63, 115 USPQ2d 1090, 1092-93 (Fed. Cir. 2015);
- v. local processing of payments for remotely purchased goods, *Inventor Holdings, LLC v. Bed*

*Bath Beyond*, 876 F.3d 1372, 1378-79, 125 USPQ2d 1019, 1023 (Fed. Cir. 2017);

vi. using a marking affixed to the outside of a mail object to communicate information about the mail object, *i.e.*, the sender, recipient, and contents of the mail object, *Secured Mail Solutions LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 911, 124 USPQ2d 1502, 1506 (Fed. Cir. 2017); and

vii. placing an order based on displayed market information, *Trading Technologies Int'l, Inc. v. IBG LLC*, 921 F.3d 1084, 1092, 2019 USPQ2d 138290 (Fed. Cir. 2019).

### **B. Commercial or Legal Interactions**

“Commercial interactions” or “legal interactions” include agreements in the form of contracts, legal obligations, advertising, marketing or sales activities or behaviors, and business relations.

An example of a claim reciting a commercial or legal interaction, where the interaction is an agreement in the form of contracts, is found in *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 112 USPQ2d 1093 (Fed. Cir. 2014). The agreement at issue in *buySAFE* was a transaction performance guaranty, which is a contractual relationship. 765 F.3d at 1355, 112 USPQ2d at 1096. The patentee claimed a method in which a computer operated by the provider of a safe transaction service receives a request for a performance guarantee for an online commercial transaction, the computer processes the request by underwriting the requesting party in order to provide the transaction guarantee service, and the computer offers, via a computer network, a transaction guaranty that binds to the transaction upon the closing of the transaction. 765 F.3d at 1351-52, 112 USPQ2d at 1094. The Federal Circuit described the claims as directed to an abstract idea because they were “squarely about creating a contractual relationship--a ‘transaction performance guaranty’.” 765 F.3d at 1355, 112 USPQ2d at 1096.

Other examples of subject matter where the commercial or legal interaction is an agreement in the form of contracts include:

- i. managing a stable value protected life insurance policy via performing calculations, *Bancorp Servs., LLC v. Sun Life Assur. Co. of*

*Canada (U.S.)*, 687 F.3d 1266, 1280, 103 USPQ2d 1425, 1434 (Fed. Cir. 2012); and

ii. processing insurance claims for a covered loss or policy event under an insurance policy (*i.e.*, an agreement in the form of a contract), *Accenture Global Services v. Guidewire Software, Inc.*, 728 F.3d 1336, 1338-39, 108 USPQ2d 1173, 1175-76 (Fed. Cir. 2013).

An example of a claim reciting a commercial or legal interaction in the form of a legal obligation is found in *Fort Properties, Inc. v. American Master Lease, LLC*, 671 F.3d 1317, 101 USPQ2d 1785 (Fed. Cir. 2012). The patentee claimed a method of “aggregating real property into a real estate portfolio, dividing the interests in the portfolio into a number of deedshares, and subjecting those shares to a master agreement.” 671 F.3d at 1322, 101 USPQ2d at 1788. The legal obligation at issue was the tax-free exchanges of real estate. The Federal Circuit concluded that the real estate investment tool designed to enable tax-free exchanges was an abstract concept. 671 F.3d at 1323, 101 USPQ2d at 1789.

Other examples of subject matter where the commercial or legal interaction is a legal obligation include:

i. hedging, *Bilski v. Kappos*, 561 U.S. 593, 595, 95 USPQ2d 1001, 1004 (2010);

ii. mitigating settlement risk, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 218, 110 USPQ2d 1976, 1979 (2014); and

iii. arbitration, *In re Comiskey*, 554 F.3d 967, 981, 89 USPQ2d 1655, 1665 (Fed. Cir. 2009).

An example of a claim reciting advertising is found in *Ultracomercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714-15, 112 USPQ2d 1750, 1753-54 (Fed. Cir. 2014). The patentee in *Ultracomercial* claimed an eleven-step method for displaying an advertisement (ad) in exchange for access to copyrighted media, comprising steps of receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad. 772 F.3d. at 715, 112 USPQ2d at 1754. The Federal Circuit determined that the “combination of steps recites an

abstraction—an idea, having no particular concrete or tangible form” and thus was directed to an abstract idea, which the court described as “using advertising as an exchange or currency.” *Id.*

Other examples of subject matter where the commercial or legal interaction is advertising, marketing or sales activities or behaviors include:

i. structuring a sales force or marketing company, which pertains to marketing or sales activities or behaviors, *In re Ferguson*, 558 F.3d 1359, 1364, 90 USPQ2d 1035, 1038 (Fed. Cir. 2009);

ii. using an algorithm for determining the optimal number of visits by a business representative to a client, *In re Maucorps*, 609 F.2d 481, 485, 203 USPQ 812, 816 (CCPA 1979); and

iii. offer-based price optimization, which pertains to marketing, *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362-63, 115 USPQ2d 1090, 1092 (Fed. Cir. 2015).

An example of a claim reciting business relations is found in *Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 123 USPQ2d 1100 (Fed. Cir. 2017). The business relation at issue in *Credit Acceptance* is the relationship between a customer and dealer when processing a credit application to purchase a vehicle. The patentee claimed a “system for maintaining a database of information about the items in a dealer’s inventory, obtaining financial information about a customer from a user, combining these two sources of information to create a financing package for each of the inventoried items, and presenting the financing packages to the user.” 859 F.3d at 1054, 123 USPQ2d at 1108. The Federal Circuit described the claims as directed to the abstract idea of “processing an application for financing a loan” and found “no meaningful distinction between this type of financial industry practice” and the concept of intermediated settlement in *Alice* or the hedging concept in *Bilski*. 859 F.3d at 1054, 123 USPQ2d at 1108.

Another example of subject matter where the commercial or legal interaction is business relations includes:

i. processing information through a clearing-house, where the business relation is the relationship between a party submitted a credit application (e.g., a car dealer) and funding sources (e.g., banks) when processing credit applications, *Dealertrack v. Huber*, 674 F.3d 1315, 1331, 101 USPQ2d 1325, 1339 (Fed. Cir. 2012).

**C. Managing Personal Behavior or Relationships or Interactions Between People**

The sub-grouping “managing personal behavior or relationships or interactions between people” include social activities, teaching, and following rules or instructions.

An example of a claim reciting managing personal behavior is *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 115 USPQ2d 1636 (Fed. Cir. 2015). The patentee in this case claimed methods comprising storing user-selected pre-set limits on spending in a database, and when one of the limits is reached, communicating a notification to the user via a device. 792 F.3d. at 1367, 115 USPQ2d at 1639-40. The Federal Circuit determined that the claims were directed to the abstract idea of “tracking financial transactions to determine whether they exceed a pre-set spending limit (i.e., budgeting)”, which “is not meaningfully different from the ideas found to be abstract in other cases before the Supreme Court and our court involving methods of organizing human activity.” 792 F.3d. at 1367-68, 115 USPQ2d at 1640.

Other examples of managing personal behavior recited in a claim include:

- i. filtering content, *BASCOM Global Internet v. AT&T Mobility, LLC*, 827 F.3d 1341, 1345-46, 119 USPQ2d 1236, 1239 (Fed. Cir. 2016) (finding that filtering content was an abstract idea under step 2A, but reversing an invalidity judgment of ineligibility due to an inadequate step 2B analysis);
- ii. considering historical usage information while inputting data, *BSG Tech. LLC v. Buysseasons, Inc.*, 899 F.3d 1281, 1286, 127 USPQ2d 1688, 1691 (Fed. Cir. 2018); and
- iii. a mental process that a neurologist should follow when testing a patient for nervous system malfunctions, *In re Meyer*, 688 F.2d 789, 791-93, 215 USPQ 193, 194-96 (CCPA 1982).

An example of a claim reciting social activities is *Voter Verified, Inc. v. Election Systems & Software, LLC*, 887 F.3d 1376, 126 USPQ2d 1498 (Fed. Cir. 2018). The social activity at issue in *Voter Verified* was voting. The patentee claimed “[a] method for voting providing for self-verification of a ballot comprising the steps of” presenting an election ballot for voting, accepting input of the votes, storing the votes, printing out the votes, comparing the printed votes to votes stored in the computer, and determining whether the printed ballot is acceptable. 887 F.3d at 1384-85, 126 USPQ2d at 1503-04. The Federal Circuit found that the claims were directed to the abstract idea of “voting, verifying the vote, and submitting the vote for tabulation”, which is a “fundamental activity that forms the basis of our democracy” and has been performed by humans for hundreds of years. 887 F.3d at 1385-86, 126 USPQ2d at 1504-05.

Another example of a claim reciting social activities is *Interval Licensing LLC, v. AOL, Inc.*, 896 F.3d 1335, 127 USPQ2d 1553 (Fed. Cir. 2018). The social activity at issue was the social activity of “providing information to a person without interfering with the person’s primary activity.” 896 F.3d at 1344, 127 USPQ2d 1553 (citing *Interval Licensing LLC v. AOL, Inc.*, 193 F. Supp.3d 1184, 1188 (W.D. 2014)). The patentee claimed an attention manager for acquiring content from an information source, controlling the timing of the display of acquired content, displaying the content, and acquiring an updated version of the previously-acquired content when the information source updates its content. 896 F.3d at 1339-40, 127 USPQ2d at 1555. The Federal Circuit concluded that “[s]tanding alone, the act of providing someone an additional set of information without disrupting the ongoing provision of an initial set of information is an abstract idea,” observing that the district court “pointed to the nontechnical human activity of passing a note to a person who is in the middle of a meeting or conversation as further illustrating the basic, longstanding practice that is the focus of the [patent ineligible] claimed invention.” 896 F.3d at 1344-45, 127 USPQ2d at 1559.

An example of a claim reciting following rules or instructions is *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161, 129 USPQ2d 1008, 1011 (Fed.

Cir. 2018). The patentee claimed a method of playing a dice game including placing wagers on whether certain die faces will appear face up. 911 F.3d at 1160; 129 USPQ2d at 1011. The Federal Circuit determined that the claims were directed to the abstract idea of “rules for playing games”, which the court characterized as a certain method of organizing human activity. 911 F.3d at 1160-61; 129 USPQ2d at 1011.

Other examples of following rules or instructions recited in a claim include:

- i. assigning hair designs to balance head shape, *In re Brown*, 645 Fed. Appx. 1014, 1015-16 (Fed. Cir. 2016) (non-precedential); and
- ii. a series of instructions of how to hedge risk, *Bilski v. Kappos*, 561 U.S. 593, 595, 95 USPQ2d 1001, 1004 (2010).

### III. MENTAL PROCESSES

The courts consider a mental process (thinking) that “can be performed in the human mind, or by a human using a pen and paper” to be an abstract idea.

*CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372, 99 USPQ2d 1690, 1695 (Fed. Cir. 2011). As the Federal Circuit explained, “methods which can be performed mentally, or which are the equivalent of human mental work, are unpatentable abstract ideas the ‘basic tools of scientific and technological work’ that are open to all.” 654 F.3d at 1371, 99 USPQ2d at 1694 (citing *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972)). See also *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 71, 101 USPQ2d 1961, 1965 (2012) (“[M]ental processes[] and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work” (quoting *Benson*, 409 U.S. at 67, 175 USPQ at 675)); *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978) (same).

Accordingly, the “mental processes” abstract idea grouping is defined as concepts performed in the human mind, and examples of mental processes include observations, evaluations, judgments, and opinions. A discussion of concepts performed in the human mind, as well as concepts that cannot practically be performed in the human mind and thus

are not “mental processes”, is provided below with respect to point A.

The courts do not distinguish between mental processes that are performed entirely in the human mind and mental processes that require a human to use a physical aid (*e.g.*, pen and paper or a slide rule) to perform the claim limitation. See, *e.g.*, *Benson*, 409 U.S. at 67, 65, 175 USPQ at 674-75, 674 (noting that the claimed “conversion of [binary-coded decimal] numerals to pure binary numerals can be done mentally,” *i.e.*, “as a person would do it by head and hand.”); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1139, 120 USPQ2d 1473, 1474 (Fed. Cir. 2016) (holding that claims to a mental process of “translating a functional description of a logic circuit into a hardware component description of the logic circuit” are directed to an abstract idea, because the claims “read on an individual performing the claimed steps mentally or with pencil and paper”). Mental processes performed by humans with the assistance of physical aids such as pens or paper are explained further below with respect to point B.

Nor do the courts distinguish between claims that recite mental processes performed by humans and claims that recite mental processes performed on a computer. As the Federal Circuit has explained, “[c]ourts have examined claims that required the use of a computer and still found that the underlying, patent-ineligible invention could be performed via pen and paper or in a person’s mind.” *Versata Dev. Group v. SAP Am., Inc.*, 793 F.3d 1306, 1335, 115 USPQ2d 1681, 1702 (Fed. Cir. 2015). See also *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318, 120 USPQ2d 1353, 1360 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”); *Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324, 117 USPQ2d 1693, 1699 (Fed. Cir. 2016) (holding that computer-implemented method for “anonymous loan shopping” was an abstract idea because it could be “performed by humans without a computer”). Mental processes recited in claims that require computers are explained further below with respect to point C.

Because both product and process claims may recite a “mental process”, the phrase “mental processes” should be understood as referring to the type of abstract idea, and not to the statutory category of the claim. The courts have identified numerous product claims as reciting mental process-type abstract ideas, for instance the product claims to computer systems and computer-readable media in *Versata Dev. Group. v. SAP Am., Inc.*, 793 F.3d 1306, 115 USPQ2d 1681 (Fed. Cir. 2015). This concept is explained further below with respect to point D.

The following discussion is meant to guide examiners and provide more information on how to determine whether a claim recites a mental process. Examiners should keep in mind the following points A, B, C, and D when performing this evaluation.

**A. A Claim With Limitation(s) That Cannot Practically be Performed in the Human Mind Does Not Recite a Mental Process**

Claims do not recite a mental process when they do not contain limitations that can practically be performed in the human mind, for instance when the human mind is not equipped to perform the claim limitations. See *SRI Int’l, Inc. v. Cisco Systems, Inc.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019) (declining to identify the claimed collection and analysis of network data as abstract because “the human mind is not equipped to detect suspicious activity by using network monitors and analyzing network packets as recited by the claims”); *CyberSource*, 654 F.3d at 1376, 99 USPQ2d at 1699 (distinguishing *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859, 97 USPQ2d 1274 (Fed. Cir. 2010), and *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 94 USPQ2d 1607 (Fed. Cir. 2010), as directed to inventions that “could not, as a practical matter, be performed entirely in a human’s mind”).

Examples of claims that do not recite mental processes because they cannot be practically performed in the human mind include:

- a claim to a method for calculating an absolute position of a GPS receiver and an absolute time of reception of satellite signals, where the claimed GPS receiver calculated pseudoranges that estimated the distance from the GPS receiver to a plurality of

satellites, *SiRF Tech.*, 601 F.3d at 1331-33, 94 USPQ2d at 1616-17;

- a claim to detecting suspicious activity by using network monitors and analyzing network packets, *SRI Int’l*, 930 F.3d at 1304;

- a claim to a specific data encryption method for computer communication involving a several-step manipulation of data, *Synopsys*, 839 F.3d at 1148, 120 USPQ2d at 1481 (distinguishing the claims in *TQP Development, LLC v. Intuit Inc.*, 2014 WL 651935 (E.D. Tex. 2014)); and

- a claim to a method for rendering a halftone image of a digital image by comparing, pixel by pixel, the digital image against a blue noise mask, where the method required the manipulation of computer data structures (*e.g.*, the pixels of a digital image and a two-dimensional array known as a mask) and the output of a modified computer data structure (a halftoned digital image), *Research Corp. Techs.*, 627 F.3d at 868, 97 USPQ2d at 1280.

In contrast, claims do recite a mental process when they contain limitations that can practically be performed in the human mind, including for example, observations, evaluations, judgments, and opinions. Examples of claims that recite mental processes include:

- a claim to “collecting information, analyzing it, and displaying certain results of the collection and analysis,” where the data analysis steps are recited at a high level of generality such that they could practically be performed in the human mind, *Electric Power Group v. Alstom, S.A.*, 830 F.3d 1350, 1353-54, 119 USPQ2d 1739, 1741-42 (Fed. Cir. 2016);

- claims to “comparing BRCA sequences and determining the existence of alterations,” where the claims cover any way of comparing BRCA sequences such that the comparison steps can practically be performed in the human mind, *University of Utah Research Foundation v. Ambry Genetics*, 774 F.3d 755, 763, 113 USPQ2d 1241, 1246 (Fed. Cir. 2014);

- a claim to collecting and comparing known information (claim 1), which are steps that can be practically performed in the human mind, *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057, 1067, 100 USPQ2d 1492, 1500 (Fed. Cir. 2011); and

- a claim to identifying head shape and applying hair designs, which is a process that can be practically performed in the human mind, *In re Brown*, 645 Fed. App'x 1014, 1016-17 (Fed. Cir. 2016) (non-precedential).

***B. A Claim That Encompasses a Human Performing the Step(s) Mentally With or Without a Physical Aid Recites a Mental Process***

If a claim recites a limitation that can practically be performed in the human mind, with or without the use of a physical aid such as pen and paper, the limitation falls within the mental processes grouping, and the claim recites an abstract idea. See, *e.g.*, *Benson*, 409 U.S. at 67, 65, 175 USPQ at 674-75, 674 (noting that the claimed “conversion of [binary-coded decimal] numerals to pure binary numerals can be done mentally,” *i.e.*, “as a person would do it by head and hand.”); *Synopsys*, 839 F.3d at 1139, 120 USPQ2d at 1474 (holding that claims to the mental process of “translating a functional description of a logic circuit into a hardware component description of the logic circuit” are directed to an abstract idea, because the claims “read on an individual performing the claimed steps mentally or with pencil and paper”).

The use of a physical aid (*e.g.*, pencil and paper or a slide rule) to help perform a mental step (*e.g.*, a mathematical calculation) does not negate the mental nature of the limitation, but simply accounts for variations in memory capacity from one person to another. For instance, in *CyberSource*, the court determined that the step of “constructing a map of credit card numbers” was a limitation that was able to be performed “by writing down a list of credit card transactions made from a particular IP address.” In making this determination, the court looked to the specification, which explained that the claimed map was nothing more than a listing of several (*e.g.*, four) credit card transactions. The court concluded that this step was able to be performed mentally with a pen and paper, and therefore, it qualified as a mental process. 654 F.3d at 1372-73, 99 USPQ2d at 1695. See also *Flook*, 437 U.S. at 586, 198 USPQ at 196 (claimed “computations can be made by pencil and paper calculations”); *University of Florida Research Foundation, Inc. v. General Electric Co.*, 916 F.3d 1363, 1367, 129 USPQ2d 1409, 1411-12 (Fed. Cir. 2019) (relying on

specification’s description of the claimed analysis and manipulation of data as being performed mentally ““using pen and paper methodologies, such as flowsheets and patient charts””); *Symantec*, 838 F.3d at 1318, 120 USPQ2d at 1360 (although claimed as computer-implemented, steps of screening messages can be “performed by a human, mentally or with pen and paper”).

***C. A Claim That Requires a Computer May Still Recite a Mental Process***

Claims can recite a mental process even if they are claimed as being performed on a computer. The Supreme Court recognized this in *Benson*, determining that a mathematical algorithm for converting binary coded decimal to pure binary within a computer’s shift register was an abstract idea. The Court concluded that the algorithm could be performed purely mentally even though the claimed procedures “can be carried out in existing computers long in use, no new machinery being necessary.” 409 U.S. at 67, 175 USPQ at 675. See also *Mortgage Grader*, 811 F.3d at 1324, 117 USPQ2d at 1699 (concluding that concept of “anonymous loan shopping” recited in a computer system claim is an abstract idea because it could be “performed by humans without a computer”).

In evaluating whether a claim that requires a computer recites a mental process, examiners should carefully consider the broadest reasonable interpretation of the claim in light of the specification. For instance, examiners should review the specification to determine if the claimed invention is described as a concept that is performed in the human mind and applicant is merely claiming that concept performed 1) on a generic computer, or 2) in a computer environment, or 3) is merely using a computer as a tool to perform the concept. In these situations, the claim is considered to recite a mental process.

**1. Performing a mental process on a generic computer.** An example of a case identifying a mental process performed on a generic computer as an abstract idea is *Voter Verified, Inc. v. Election Systems & Software, LLC*, 887 F.3d 1376, 1385, 126 USPQ2d 1498, 1504 (Fed. Cir. 2018). In this case, the Federal Circuit relied upon the specification in explaining that the claimed steps of voting, verifying

the vote, and submitting the vote for tabulation are “human cognitive actions” that humans have performed for hundreds of years. The claims therefore recited an abstract idea, despite the fact that the claimed voting steps were performed on a computer. 887 F.3d at 1385, 126 USPQ2d at 1504. Another example is *Versata*, in which the patentee claimed a system and method for determining a price of a product offered to a purchasing organization that was implemented using general purpose computer hardware. 793 F.3d at 1312-13, 1331, 115 USPQ2d at 1685, 1699. The Federal Circuit acknowledged that the claims were performed on a generic computer, but still described the claims as “directed to the abstract idea of determining a price, using organizational and product group hierarchies, in the same way that the claims in *Alice* were directed to the abstract idea of intermediated settlement, and the claims in *Bilski* were directed to the abstract idea of risk hedging.” 793 F.3d at 1333; 115 USPQ2d at 1700-01.

**2. Performing a mental process in a computer environment.** An example of a case identifying a mental process performed in a computer environment as an abstract idea is *Symantec Corp.*, 838 F.3d at 1316-18, 120 USPQ2d at 1360. In this case, the Federal Circuit relied upon the specification when explaining that the claimed electronic post office, which recited limitations describing how the system would receive, screen and distribute email on a computer network, was analogous to how a person decides whether to read or dispose of a particular piece of mail and that “with the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper”. 838 F.3d at 1318, 120 USPQ2d at 1360. Another example is *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 120 USPQ2d 1293 (Fed. Cir. 2016). The patentee in *FairWarning* claimed a system and method of detecting fraud and/or misuse in a computer environment, in which information regarding accesses of a patient’s personal health information was analyzed according to one of several rules (*i.e.*, related to accesses in excess of a specific volume, accesses during a pre-determined time interval, or accesses by a specific user) to determine if the activity indicates improper access. 839 F.3d. at 1092, 120 USPQ2d at 1294. The court determined that these claims were directed to a mental process of detecting misuse, and that the claimed rules here

were “the same questions (though perhaps phrased with different words) that humans in analogous situations detecting fraud have asked for decades, if not centuries.” 839 F.3d. at 1094-95, 120 USPQ2d at 1296.

**3. Using a computer as a tool to perform a mental process.** An example of a case in which a computer was used as a tool to perform a mental process is *Mortgage Grader*, 811 F.3d. at 1324, 117 USPQ2d at 1699. The patentee in *Mortgage Grader* claimed a computer-implemented system for enabling borrowers to anonymously shop for loan packages offered by a plurality of lenders, comprising a database that stores loan package data from the lenders, and a computer system providing an interface and a grading module. The interface prompts a borrower to enter personal information, which the grading module uses to calculate the borrower’s credit grading, and allows the borrower to identify and compare loan packages in the database using the credit grading. 811 F.3d. at 1318, 117 USPQ2d at 1695. The Federal Circuit determined that these claims were directed to the concept of “anonymous loan shopping”, which was a concept that could be “performed by humans without a computer.” 811 F.3d. at 1324, 117 USPQ2d at 1699. Another example is *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 125 USPQ2d 1649 (Fed. Cir. 2018), in which the patentee claimed methods for parsing and evaluating data using a computer processing system. The Federal Circuit determined that these claims were directed to mental processes of parsing and comparing data, because the steps were recited at a high level of generality and merely used computers as a tool to perform the processes. 881 F.3d at 1366, 125 USPQ2d at 1652-53.

#### ***D. Both Product and Process Claims May Recite a Mental Process***

Examiners should keep in mind that both product claims (*e.g.*, computer system, computer-readable medium, etc.) and process claims may recite mental processes. For example, in *Mortgage Grader*, the patentee claimed a computer-implemented system and a method for enabling borrowers to anonymously shop for loan packages offered by a plurality of lenders, comprising a database that stores loan package data from the lenders, and a computer system providing an interface and a grading module. The Federal Circuit determined that both the



computer-implemented system and method claims were directed to “anonymous loan shopping”, which was an abstract idea because it could be “performed by humans without a computer.” 811 F.3d. at 1318, 1324-25, 117 USPQ2d at 1695, 1699-1700. See also *FairWarning IP*, 839 F.3d at 1092, 120 USPQ2d at 1294 (identifying both system and process claims for detecting improper access of a patient's protected health information in a health-care system computer environment as directed to abstract idea of detecting fraud); *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1345, 113 USPQ2d 1354, 1356 (Fed. Cir. 2014) (system and method claims of inputting information from a hard copy document into a computer program). Accordingly, the phrase “mental processes” should be understood as referring to the type of abstract idea, and not to the statutory category of the claim.

Examples of product claims reciting mental processes include:

- An application program interface for extracting and processing information from a diversity of types of hard copy documents – *Content Extraction*, 776 F.3d at 1345, 113 USPQ2d at 1356;
- A computer-implemented system for enabling anonymous loan shopping – *Mortgage Grader*, 811 F.3d at 1318, 117 USPQ2d at 1695;
- A computer readable medium containing program instructions for detecting fraud – *CyberSource*, 654 F.3d at 1368 n. 1, 99 USPQ2d at 1692 n.1;
- A post office for receiving and redistributing email messages on a computer network – *Symantec*, 838 F.3d at 1316, 120 USPQ2d at 1359;
- A self-verifying voting system – *Voter Verified*, 887 F.3d at 1384-85, 126 USPQ2d at 1504;
- A wide-area real-time performance monitoring system for monitoring and assessing dynamic stability of an electric power grid – *Electric Power Group*, 830 F.3d at 1351 and n.1, 119 USPQ2d at 1740 and n.1; and
- Computer readable storage media comprising computer instructions to implement a method for determining a price of a product offered to a purchasing organization – *Versata*, 793 F.3d at 1312-13, 115 USPQ2d at 1685.

Examples of process claims reciting mental process-type abstract ideas are discussed in the preceding subsections (A) through (C). See, for example, the discussion of *Flook*, 437 U.S. 584, 198 USPQ 193; *Benson*, 409 U.S. 63, 175 USPQ 673; *Berkheimer*, 881 F.3d 1360, 125 USPQ2d 1649; *Synopsys*, 839 F.3d 1138, 120 USPQ2d 1473; and *Ambry Genetics*, 774 F.3d 755, 113 USPQ2d 1241, *supra*.

### **2106.04(a)(3) Tentative Abstract Ideas [R-10.2019]**

There may be rare circumstances in which an examiner believes a claim limitation should be treated as an abstract idea even though it does not fall within any of the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#) (i.e., mathematical concepts, certain methods of organizing human activity, mental processes). This type of claim limitation is referred to as a “tentative abstract idea.”

In such circumstances, the examiner should evaluate the claim under the subject matter eligibility framework:

- If the claim as a whole integrates the tentative abstract idea into a practical application, the claim is not directed to a judicial exception (Step 2A; NO) and thus is **eligible** at Pathway B. This concludes the eligibility analysis.
- If the claim as a whole does not integrate the tentative abstract idea into a practical application, then the claim is directed to a judicial exception (Step 2A: YES) and thus requires further analysis at Step 2B. At Step 2B, if the claim as a whole provides an inventive concept (Step 2B: YES), the claim is **eligible** at Pathway C. This concludes the eligibility analysis.
- If the claim as a whole does not provide an inventive concept (Step 2B: NO), the application should be brought to the attention of the Technology Center (TC) director. A rejection of a claim reciting a tentative abstract idea must be approved by the TC director (which approval will be indicated in the file record of the application) and must provide a justification for why such claim limitation is being treated as reciting an abstract idea.

The TC Director will give approval for a Step 2B subject matter eligibility rejection of a claim reciting a tentative abstract idea. The ensuing Office action will identify that the claim(s) are directed to a previously non-enumerated abstract idea via form paragraph 7.05.017 and include the TC Director's signature. The TC Director will then inform Patents Management that this procedure has been used so that the public can be notified, for example, on USPTO.GOV at the Subject Matter Eligibility website.

In response to a Step 2B rejection of a claim reciting a tentative abstract idea, an interview with the examiner may be conducted, which may help advance prosecution and identify patent eligible subject matter. See [MPEP § 713](#). For applications in which an abstract idea has been identified using the tentative abstract idea procedure, an interview with the TC Director that provided approval is not necessary because the examiner retains the authority to withdraw or maintain a rejection upon consideration of applicant's reply. The examiner is not required to obtain TC Director approval to withdraw or maintain such a [§ 101](#) subject matter eligibility rejection.

## **2106.04(b) Laws of Nature, Natural Phenomena & Products of Nature [R-10.2019]**

Laws of nature and natural phenomena, as identified by the courts, include naturally occurring principles/relations and nature-based products that are naturally occurring or that do not have markedly different characteristics compared to what occurs in nature. The courts have often described these exceptions using other terms, including “physical phenomena,” “scientific principles,” “natural laws,” and “products of nature.”

### **I. LAWS OF NATURE AND NATURAL PHENOMENA, GENERALLY**

The law of nature and natural phenomenon exceptions reflect the Supreme Court's view that the basic tools of scientific and technological work are not patentable, because the “manifestations of laws of nature” are “part of the storehouse of knowledge,” “free to all men and reserved exclusively to none.”

*Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 76 USPQ 280, 281 (1948). Thus, “a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter” under [Section 101](#). *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980). “Likewise, Einstein could not patent his celebrated law that  $E=mc^2$ ; nor could Newton have patented the law of gravity.” *Id.* Nor can one patent “a novel and useful mathematical formula,” *Parker v. Flook*, 437 U.S. 584, 585, 198 USPQ 193, 195 (1978); electromagnetism or steam power, *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 113-114 (1853); or “[t]he qualities of ... bacteria, ... the heat of the sun, electricity, or the qualities of metals,” *Funk*, 333 U.S. at 130, 76 USPQ at 281; see also *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853).

The courts have identified the following concepts and products as examples of laws of nature or natural phenomena:

- i. isolated DNA, *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589-91, 106 USPQ2d 1972, 1978-79 (2013);
- ii. a cloned farm animal such as a sheep, *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1337, 110 USPQ2d 1668, 1671 (Fed. Cir. 2014);
- iii. a correlation between variations in non-coding regions of DNA and allele presence in coding regions of DNA, *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1375, 118 USPQ2d 1541, 1545 (Fed. Cir. 2016);
- iv. a correlation that is the consequence of how a certain compound is metabolized by the body, *Mayo Collaborative Servs. v. Prometheus Labs.*, 566 U.S. 66, 75-77, 101 USPQ2d 1961, 1967-68 (2012);
- v. a correlation between the presence of myeloperoxidase in a bodily sample (such as blood or plasma) and cardiovascular disease risk, *Cleveland Clinic Foundation v. True Health Diagnostics, LLC*, 859 F.3d 1352, 1361, 123 USPQ2d 1081, 1087 (Fed. Cir. 2017);
- vi. electromagnetism to transmit signals, *O'Reilly v. Morse*, 56 U.S. 62, 113 (1853);
- vii. qualities of bacteria such as their ability to create a state of inhibition or non-inhibition in other

bacteria, *Funk Bros.*, 333 U.S. at 130, 76 USPQ at 281;

viii. single-stranded DNA fragments known as “primers”, *University of Utah Research Foundation v. Ambry Genetics Corp.*, 774 F.3d 755, 761, 113 USPQ2d 1241, 1244 (Fed. Cir. 2014);

ix. the chemical principle underlying the union between fatty elements and water, *Tilghman v. Proctor*, 102 U.S. 707, 729 (1880);

x. the existence of cell-free fetal DNA (cffDNA) in maternal blood, *Ariosa Diagnostics, Inc. v. Sequenom*, 788 F.3d 1371, 1373, 115 USPQ2d 1152, 1153 (Fed. Cir. 2015); and

xi. the natural relationship between a patient’s CYP2D6 metabolizer genotype and the risk that the patient will suffer QTc prolongation after administration of a medication called iloperidone, *Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals*, 887 F.3d 1117, 1135-36, 126 USPQ2d 1266, 1281 (Fed. Cir. 2018).

The courts have also noted, however, that not every claim describing a natural ability or quality of a product, or describing a natural process, necessarily recites a law of nature or natural phenomenon. See *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1048-49, 119 USPQ2d 1370, 1374 (Fed. Cir. 2016) (claims reciting process steps of fractionating, recovering, and cryopreserving hepatocytes held to be eligible, because they are not focused on merely observing or detecting the ability of hepatocytes to survive multiple freeze-thaw cycles). Thus, in a claimed method of treating cancer with chemotherapy, the cancer cells’ inability to survive chemotherapy is not considered to be a law of nature. Similarly, in a claimed method of treating headaches with aspirin, the human body’s natural response to aspirin is not considered to be a law of nature. These claims are accordingly eligible at Prong One unless they recite another exception, in which case they require further analysis in Prong Two (and Step 2B, if needed) to determine their eligibility. Similarly, a method of producing a new compound is not directed to the individual components’ ability to combine to form the new compound. *Id.* See also *Tilghman v. Proctor*, 102 U.S. 707, 729 (1881) (claims reciting process steps for manufacturing fatty acids and glycerol by hydrolyzing fat at high temperature and pressure were held to be eligible,

because they are not focused on the chemical principle that fat can be hydrolyzed into its components).

Even if a claim does recite a law of nature or natural phenomenon, it may still be eligible at any of Pathways A through C. For example, claims reciting a naturally occurring relationship between a patient’s genotype and the risk of QTc prolongation (a law of nature) were held eligible as not “directed to” that relationship because they also recited a step of treating the patient with an amount of a particular medication that was tailored to the patient’s genotype. *Vanda Pharms.*, 887 F.3d at 1134-36, 126 USPQ2d at 1279-81. This particular treatment step applied the natural relationship in a manner that integrated it into a practical application. The court’s analysis in *Vanda* is equivalent to a finding of eligibility at Step 2A Prong Two (Pathway B).

As explained in [MPEP § 2106.04](#), a claim that recites a law of nature or a natural phenomenon requires further analysis in Step 2A Prong Two to determine whether the claim integrates the exception into a practical application.

A claim that does not recite a law of nature or natural phenomenon is eligible at Pathway B (Step 2A: NO) unless the claim recites, and is directed to, another exception (such as an abstract idea, or a product of nature).

## II. PRODUCTS OF NATURE

When a law of nature or natural phenomenon is claimed as a physical product, the courts have often referred to the exception as a “product of nature”. For example, the isolated DNA of *Myriad* and the primers of *Ambry Genetics* were described as products of nature by the courts. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 580, 106 USPQ2d 1972, 1975 (2013); *University of Utah Research Foundation v. Ambry Genetics*, 774 F.3d 755, 758-59, 113 USPQ2d 1241, 1243 (Fed. Cir. 2014). As explained in those decisions, products of nature are considered to be an exception because they tie up the use of naturally occurring things, but they have been labeled as both laws of nature and natural phenomena. See *Myriad Genetics, Inc.*, 569 U.S. at 590-91, 106 USPQ2d at

1979 (claims to isolated DNA held ineligible because they “claim naturally occurring phenomena” and are “squarely within the law of nature exception”); *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 76 USPQ 280, 281 (1948) (claims to bacterial mixtures held ineligible as “manifestations of laws of nature” and “phenomena of nature”). Step 2A of the Office’s eligibility analysis uses the terms “law of nature” and “natural phenomenon” as inclusive of “products of nature”.

It is important to keep in mind that product of nature exceptions include both naturally occurring products and non-naturally occurring products that lack markedly different characteristics from any naturally occurring counterpart. See, e.g., *Ambry Genetics*, 774 F.3d at 760, 113 USPQ2d at 1244 (“Contrary to *Myriad’s* argument, it makes no difference that the identified gene sequences are synthetically replicated. As the Supreme Court made clear, neither naturally occurring compositions of matter, nor synthetically created compositions that are structurally identical to the naturally occurring compositions, are patent eligible.”). Thus, a synthetic, artificial, or non-naturally occurring product such as a cloned organism or a human-made hybrid plant is not automatically eligible because it was created by human ingenuity or intervention. See, e.g., *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1337, 110 USPQ2d 1668, 1671-72 (Fed. Cir. 2014) (cloned sheep); cf. *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 130-132, 60 USPQ2d 1868-69 (2001) (hybrid plant). Instead, the key to the eligibility of all non-naturally occurring products is whether they possess markedly different characteristics from any naturally occurring counterpart.

When a claim recites a nature-based product limitation, examiners should use the markedly different characteristics analysis discussed in [MPEP § 2106.04\(c\)](#) to evaluate the nature-based product limitation and determine the answer to Step 2A. Nature-based products, as used herein, include both eligible and ineligible products and merely refer to the types of products subject to the markedly different characteristics analysis used to identify product of nature exceptions. Examples of nature-based products include the isolated gene and cDNA sequences of *Myriad*, the cloned farm

animals of *Roslin*, and the bacterium of *Chakrabarty*. As is evident from these examples, and as further discussed in [MPEP § 2105](#), a nature-based product that is a living organism (e.g., a plant, an animal, a bacterium, etc.) is not excluded from patent protection merely because it is alive, and such a product is eligible for patenting if it satisfies the markedly different characteristics analysis.

It is important to keep in mind that under the broadest reasonable interpretation (BRI) of the claims, a nature-based product limitation may encompass both eligible and ineligible products. For example, a claim to a “cloned giraffe” may have a BRI encompassing cloned giraffes with markedly different characteristics, as well as cloned giraffes that lack markedly different characteristics and thus are products of nature. Cf. *Roslin*, 750 F.3d at 1338-39, 110 USPQ2d at 1673 (applicant could not rely on unclaimed features to distinguish claimed mammals from donor mammals).

Such a claim recites a product of nature, and thus requires further analysis in Prong Two. If the claim is ultimately rejected as failing to encompass an inventive concept (Step 2B: NO), it is a best practice for the examiner to point out the broadest reasonable interpretation and recommend an amendment, if possible, that would narrow the claim to those embodiments that are not directed to products of nature, or that are otherwise eligible.

For claims that recite a nature-based product limitation (which may or may not be a product of nature exception) but which are directed to inventions that clearly do not seek to tie up any judicial exception, examiners should consider whether the streamlined eligibility analysis discussed in [MPEP § 2106.06](#) is appropriate. In such cases, it would not be necessary to conduct a markedly different characteristics analysis.

### **2106.04(c) The Markedly Different Characteristics Analysis [R-07.2022]**

The markedly different characteristics analysis is part of Step 2A Prong One, because the courts use this analysis to identify product of nature exceptions. For example, *Chakrabarty* relied on a comparison

of the claimed bacterium to naturally occurring bacteria when determining that the claimed bacterium was not a product of nature because it had “markedly different characteristics from any found in nature”. *Diamond v. Chakrabarty*, 447 U.S. 303, 310, 206 USPQ 193, 197 (1980). Similarly, *Roslin* relied on a comparison of the claimed sheep to naturally occurring sheep when determining that the claimed sheep was a product of nature because it “does not possess ‘markedly different characteristics from any [farm animals] found in nature.’” *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1337, 110 USPQ2d 1668, 1671-72 (Fed. Cir. 2014) (quoting *Chakrabarty*, 447 U.S. at 310, 206 USPQ at 197 (alterations in original)).

This section sets forth guidelines for performing the markedly different characteristics analysis, including information on when to perform the analysis, and how to perform the analysis. Examiners should consult these guidelines when performing an eligibility analysis of a claim that recites a nature-based product limitation. Nature-based products, as used herein, include both eligible and ineligible products and merely refer to the types of products subject to the markedly different characteristics analysis used to identify product of nature exceptions.

If the claim includes a nature-based product that has markedly different characteristics, then the claim does not recite a product of nature exception and is eligible (Step 2A: NO) at Pathway B unless the claim recites another exception (such as a law of nature or abstract idea, or a different natural phenomenon). For claims where the entire claim is a single nature-based product (e.g., a claim to “a *Lactobacillus* bacterium”), once a markedly different characteristic in that product is shown, no further analysis would be necessary for eligibility because no product of nature exception is recited (i.e., Step 2B is not necessary because the answer to Step 2A is NO). For claims including limitations in addition to the nature-based product, examiners should consider whether the claim recites another exception and thus requires further eligibility analysis.

If the claim includes a nature-based product that does not exhibit markedly different characteristics

from its naturally occurring counterpart in its natural state, then the claim recites a “product of nature” exception, and requires further analysis in Step 2A Prong Two to determine whether the claim as a whole integrates the exception into a practical application.

## I. WHEN TO PERFORM THE MARKEDLY DIFFERENT CHARACTERISTICS ANALYSIS

Because a nature-based product can be claimed by itself (e.g., “a *Lactobacillus* bacterium”) or as one or more limitations of a claim (e.g., “a probiotic composition comprising a mixture of *Lactobacillus* and milk in a container”), care should be taken not to overly extend the markedly different characteristics analysis to products that when viewed as a whole are not nature-based. Instead, the markedly different characteristics analysis should be applied only to the nature-based product limitations in the claim to determine whether the nature-based products are “product of nature” exceptions.

Examiners should keep in mind that if the nature-based product limitation is naturally occurring, there is no need to perform the markedly different characteristics analysis because the limitation is by definition directed to a naturally occurring product and thus falls under the product of nature exception. However, if the nature-based product limitation is not naturally occurring, for example due to some human intervention, then the markedly different characteristics analysis must be performed to determine whether the claimed product limitation is a product of nature exception.

### A. Product Claims

Where the claim is to a nature-based product by itself (e.g., a claim to “a *Lactobacillus* bacterium”), the markedly different characteristics analysis should be applied to the entire product. See, e.g., *Chakrabarty*, 447 U.S. at 305, 309-10, 206 USPQ at 195, 197-98 (applying analysis to entire claimed “bacterium from the genus *Pseudomonas* containing therein at least two stable energy-generating plasmids, each of said plasmids providing a separate hydrocarbon degradative pathway”).



Where the claim is to a nature-based product produced by combining multiple components (*e.g.*, a claim to “a probiotic composition comprising a mixture of *Lactobacillus* and milk”), the markedly different characteristics analysis should be applied to the resultant nature-based combination, rather than its component parts. For instance, for the probiotic composition example, the mixture of *Lactobacillus* and milk should be analyzed for markedly different characteristics, rather than the *Lactobacillus* separately and the milk separately. See subsection II, below, for further guidance on the markedly different characteristic analysis.

Where the claim is to a nature-based product in combination with non-nature based elements (*e.g.*, a claim to “a yogurt starter kit comprising *Lactobacillus* in a container with instructions for culturing *Lactobacillus* with milk to produce yogurt”), the markedly different characteristics analysis should be applied only to the nature-based product limitation. For instance, for the yogurt starter kit example, the *Lactobacillus* would be analyzed for markedly different characteristics. The container and instructions would not be subject to the markedly different characteristics analysis as they are not nature-based products, but would be evaluated as additional elements in Prong Two (and Step 2B if needed) if it is determined that the *Lactobacillus* does not have markedly different characteristics from any naturally occurring counterpart and thus is a product of nature exception. See, *e.g.*, *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130, 76 USPQ 280, 281 (1948) (although claims 7, 8, 13 and 14 recited an inoculant comprising a bacterial mixture and a powder base, only the bacterial mixture was analyzed).

### **B. Product-by-Process Claims**

For a product-by-process claim (*e.g.*, a claim to a cloned farm animal produced by a nuclear transfer cloning method), the analysis turns on whether the nature-based product in the claim has markedly different characteristics from its naturally occurring counterpart. See [MPEP § 2113](#) for more information on product-by-process claims.

### **C. Process Claims**

For a process claim, the general rule is that the claim is not subject to the markedly different analysis for nature-based products used in the process. This is because the analysis of a process claim should focus on the active steps of the process rather than the products used in those steps. For example, when evaluating a claimed process of cryopreserving hepatocyte cells comprising performing density gradient fractionation to separate viable and non-viable hepatocytes, recovering the viable hepatocytes, and cryopreserving the recovered viable hepatocytes, the court did not subject the claim to the markedly different characteristics analysis for the nature-based products (the hepatocytes) used in the process. *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1049, 119 USPQ2d 1370, 1374 (Fed. Cir. 2016) (claims are directed to a process of creating a preparation of multi-cryopreserved hepatocytes, not to the preparation itself).

However, in the limited situation where a process claim reciting a nature-based product is drafted in such a way that there is no difference in substance from a product claim, the claim is subject to the markedly different analysis for the recited nature-based product. These types of claims are drafted in a way that focuses on the product rather than the process steps. For example, consider a claim that recites, in its entirety, “a method of providing an apple.” Under the broadest reasonable interpretation, this claim is focused on the apple fruit itself, which is a nature-based product. Similarly, claims to detecting naturally occurring cell-free fetal DNA (cffDNA) in maternal blood were held to be directed to the cffDNA, because the “existence and location of cffDNA is a natural phenomenon [and thus] identifying its presence was merely claiming the natural phenomena itself.” *Rapid Litig. Mgmt.*, 827 F.3d at 1048, 119 USPQ2d at 1374, (explaining the holding in *Ariosa Diagnostics, Inc. v. Sequenom*, 788 F.3d 1371, 115 USPQ2d 1152 (Fed. Cir. 2015)).

## **II. HOW TO PERFORM THE MARKEDLY DIFFERENT CHARACTERISTICS ANALYSIS**

The markedly different characteristics analysis compares the nature-based product limitation to its naturally occurring counterpart in its natural state.

Markedly different characteristics can be expressed as the product's structure, function, and/or other properties, and are evaluated based on what is recited in the claim on a case-by-case basis. If the analysis indicates that a nature-based product limitation does not exhibit markedly different characteristics, then that limitation is a product of nature exception. If the analysis indicates that a nature-based product limitation does have markedly different characteristics, then that limitation is not a product of nature exception.

This section sets forth guidelines for performing the markedly different characteristics analysis, including information on (a) selecting the appropriate naturally occurring counterpart(s) to the nature-based product limitation, (b) identifying appropriate characteristics for analysis, and (c) evaluating characteristics to determine whether they are "markedly different".

#### A. *Selecting The Appropriate Counterpart(s)*

Because the markedly different characteristics analysis compares the nature-based product limitation to its naturally occurring counterpart in its natural state, the first step in the analysis is to select the appropriate counterpart(s) to the nature-based product.

When the nature-based product is derived from a naturally occurring thing, then the naturally occurring thing is the counterpart. For example, assume that applicant claims deoxyacid A, which is a chemical derivative of a naturally occurring chemical called acid A. Because the inventor created the claimed nature-based product (deoxyacid A) by modifying the naturally occurring acid A, the closest natural counterpart for deoxyacid A would be the natural product from which it was derived, *i.e.*, acid A. See, *e.g.*, *Chakrabarty*, 447 U.S. at 305 and n.1, 206 USPQ at 195 and n.1 (counterpart to genetically modified *Pseudomonas* bacterium containing multiple plasmids is the naturally occurring unmodified *Pseudomonas* bacterium from which the claimed bacterium was created); *Roslin*, 750 F.3d at 1337, 110 USPQ2d at 1671-72 (counterparts to cloned sheep are naturally occurring sheep such as the donor ewe from which the clone was created).

Although the selected counterpart should be in its natural state, examiners should take care not to confuse the counterpart with other material that may occur naturally with, or adjacent to, the counterpart. For example, assume that applicant claims a nucleic acid having a nucleotide sequence derived from naturally occurring gene B. Although gene B occurs in nature as part of a chromosome, the closest natural counterpart for the claimed nucleic acid is gene B, and not the whole chromosome. See, *e.g.*, *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591-94, 106 USPQ2d 1972, 1979-81 (2013) (comparing isolated BRCA1 genes and BRCA1 cDNA molecules to naturally occurring BRCA1 gene); *Roche Molecular System, Inc. v. CEPHEID*, 905 F.3d 1363, 1371, 128 USPQ2d 1221, 1227 (Fed. Cir. 2018) (comparing claimed primers to "their corresponding nucleotide sequences on the naturally occurring DNA"). Similarly, assume that applicant claims a single-stranded piece of DNA (a primer) having a nucleotide sequence derived from the sense strand of naturally occurring nucleic acid C. Although nucleic acid C occurs in nature as a double-stranded molecule having a sense and an antisense strand, the closest natural counterpart for the claimed nucleic acid is the sense strand of C only. See, *e.g.*, *University of Utah Research Foundation v. Ambry Genetics*, 774 F.3d 755, 760, 113 USPQ2d 1241, 1241 (Fed. Cir. 2014) (comparing single-stranded nucleic acid to the same strand found in nature, even though "single-stranded DNA cannot be found in the human body").

When there are multiple counterparts to the nature-based product, the comparison should be made to the closest naturally occurring counterpart. For example, assume that the inventor creates a cloned sheep D by transferring nuclear DNA from a Finn-Dorset sheep into an egg cell (which contains mitochondrial DNA) from a Scottish Blackface sheep. Applicant then claims sheep D. Here, because sheep D was created via combining DNA from two different naturally occurring sheep of different breeds, there is no single closest natural counterpart. The examiner should therefore select the counterpart most closely related to sheep D based on the examiner's expertise in the particular art. For the example discussed here, the closest counterparts might be naturally occurring Finn-Dorset or Scottish Blackface sheep, as opposed to sheep of a different

breed such as Bighorn sheep. *Cf. Roslin*, 750 F.3d at 1337, 110 USPQ2d at 1671-72 (claimed sheep produced by nuclear transfer into an oocyte and subsequent manipulation of natural embryonic development processes was compared to naturally occurring sheep such as the donor ewe from which the nuclear material was obtained). When the nature-based product is a combination produced from multiple components, the closest counterpart may be the individual nature-based components of the combination. For example, assume that applicant claims an inoculant comprising a mixture of bacteria from different species, *e.g.*, some bacteria of species E and some bacteria of species F. Because there is no counterpart mixture in nature, the closest counterparts to the claimed mixture are the individual components of the mixture, *i.e.*, each naturally occurring species by itself. See, *e.g.*, *Funk Bros.*, 333 U.S. at 130, 76 USPQ at 281 (comparing claimed mixture of bacterial species to each species as it occurs in nature); *Ambry Genetics*, 774 F.3d at 760, 113 USPQ2d at 1244 (although claimed as a pair, individual primer molecules were compared to corresponding segments of naturally occurring gene sequence); *In re Bhagat*, 726 Fed. Appx. 772, 778-79 (Fed. Cir. 2018) (non-precedential) (comparing claimed mixture of lipids with particular lipid profile to “naturally occurring lipid profiles of walnut oil and olive oil”). See subsection II.C.

If the claim is rejected as ineligible, it is a “best practice” for the examiner to identify the selected counterpart in the Office action if the record is not already clear. This practice assists the applicant in responding, and clarifies the record as to how the examiner is interpreting the claim.

### **B. Identifying Appropriate Characteristics For Analysis**

Because the markedly different characteristics analysis is based on comparing the characteristics of the claimed nature-based product and its counterpart, the second step in the analysis is to identify appropriate characteristics to compare.

Appropriate characteristics must be possessed by the claimed product, because it is the claim that must define the invention to be patented. *Cf. Roslin*, 750 F.3d at 1338, 110 USPQ2d at 1673 (unclaimed

characteristics could not contribute to eligibility). Examiners can identify the characteristics possessed by the claimed product by looking at what is recited in the claim language and encompassed within the broadest reasonable interpretation of the nature-based product. In some claims, a characteristic may be explicitly recited. For example, in a claim to “deoxyribose”, the recited chemical name informs those in the art of the structural characteristics of the product (*i.e.*, the “deoxy” prefix indicates that a hydroxyl group has been removed as compared to ribose). In other claims, the characteristic may be apparent from the broadest reasonable interpretation even though it is not explicitly recited in the claim. For example, in a claim to “isolated gene B,” the examiner would need to rely on the broadest reasonable interpretation of “isolated gene B” to determine what characteristics the isolated gene has, *e.g.*, what its nucleotide sequence is, and what, if any, protein it encodes.

Appropriate characteristics can be expressed as the nature-based product’s structure, function, and/or other properties, and are evaluated on a case-by-case basis. Non-limiting examples of the types of characteristics considered by the courts when determining whether there is a marked difference include:

- Biological or pharmacological functions or activities;
- Chemical and physical properties;
- Phenotype, including functional and structural characteristics; and
- Structure and form, whether chemical, genetic or physical.

Examples of biological or pharmacological functions or activities include, but are not limited to:

- i. the protein-encoding information of a nucleic acid, *Myriad*, 569 U.S. at 590-91, 106 USPQ2d at 1979;
- ii. the ability of complementary nucleotide sequences to bind to each other, *Ambry Genetics*, 774 F.3d at 760-61, 113 USPQ2d at 1244;
- iii. the properties and functions of bacteria such as the ability to infect certain leguminous plants,



*Funk Bros.*, 333 U.S. at 130-31, 76 USPQ2d at 281-82;

iv. the ability to degrade certain hydrocarbons, *Diamond v. Chakrabarty*, 447 U.S. at 310, 206 USPQ2d at 195; and

v. the ability of vitamin C to prevent and treat scurvy, *In re King*, 107 F.2d 618, 27 CCPA 754, 756-57, 43 USPQ 400, 401-402 (CCPA 1939).

Examples of chemical and physical properties include, but are not limited to:

i. the alkalinity of a chemical compound, *Parke-Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 103-04 (S.D.N.Y. 1911); and

ii. the ductility or malleability of metals, *In re Marden*, 47 F.2d 958, 959, 18 CCPA 1057, 1059, 8 USPQ 347, 349 (CCPA 1931).

Examples of phenotypic characteristics include, but are not limited to:

i. functional and structural characteristics such as the shape, size, color, and behavior of an organism, *Roslin*, 750 F.3d at 1338, 110 USPQ2d at 1672.

Examples of structure and form include, but are not limited to:

i. physical structure or form such as the physical presence of plasmids in a bacterial cell, *Chakrabarty*, 447 U.S. at 305 and n.1, 206 USPQ2d at 195 and n.1;

ii. chemical structure and form such as a chemical being a “nonsalt” and a “crystalline substance”, *Parke-Davis*, 189 F. at 100, 103;

iii. genetic structure such as the nucleotide sequence of DNA, *Myriad*, 569 U.S. at 590, 594-95, 106 USPQ2d at 1979, 1981; and

iv. the genetic makeup (genotype) of a cell or organism, *Roslin*, 750 F.3d at 1338-39, 110 USPQ2d at 1672-73.

### ***C. Evaluating Characteristics To Determine Whether They Are “Markedly Different”***

The final step in the markedly different characteristics analysis is to compare the characteristics of the claimed nature-based product

to its naturally occurring counterpart in its natural state, in order to determine whether the characteristics of the claimed product are markedly different. The courts have emphasized that to show a marked difference, a characteristic must be changed as compared to nature, and cannot be an inherent or innate characteristic of the naturally occurring counterpart or an incidental change in a characteristic of the naturally occurring counterpart. *Myriad*, 569 U.S. at 580, 106 USPQ2d at 1974-75. Thus, in order to be markedly different, the inventor must have caused the claimed product to possess at least one characteristic that is different from that of the counterpart.

If there is no change in any characteristic, the claimed product lacks markedly different characteristics, and is a product of nature exception. If there is a change in at least one characteristic as compared to the counterpart, and the change came about or was produced by the inventor’s efforts or influences, then the change will generally be considered a markedly different characteristic such that the claimed product is not a product of nature exception.

### **1. Examples of Products Having Markedly Different Characteristics**

In *Chakrabarty*, the Supreme Court identified a claimed bacterium as a nature-based product having markedly different characteristics. This bacterium had a changed functional characteristic, *i.e.*, it was able to degrade at least two different hydrocarbons as compared to naturally occurring *Pseudomonas* bacteria that can only degrade a single hydrocarbon. The claimed bacterium also had a different structural characteristic, *i.e.*, it was genetically modified to include more plasmids than are found in a single naturally occurring *Pseudomonas* bacterium. The Supreme Court considered these changed characteristics to be “markedly different characteristics from any found in nature” due to the additional plasmids and resultant capacity for degrading multiple hydrocarbon components of oil. Therefore, the bacterium was eligible. *Diamond v. Chakrabarty*, 447 U.S. 303, 310, 206 USPQ 193, 197 (1980).

In *Myriad*, the Supreme Court identified a claimed full-length complementary DNA (cDNA) of the BRCA1 gene as a nature-based product having markedly different characteristics. This claimed cDNA had the same functional characteristics (i.e., it encoded the same protein) as the naturally occurring gene, but had a changed structural characteristic, i.e., a different nucleotide sequence containing only exons, as compared to the naturally occurring sequence containing both exons and introns. The Supreme Court concluded that the “cDNA retains the naturally occurring exons of DNA, but it is distinct from the DNA from which it was derived. As a result, [this] cDNA is not a ‘product of nature’” and is eligible. *Myriad*, 569 U.S. at 595, 106 USPQ2d at 1981.

## 2. Examples of Products Lacking Markedly Different Characteristics

In *Myriad*, the Supreme Court made clear that not all changes in characteristics will rise to the level of a marked difference, e.g., the incidental changes resulting from isolation of a gene sequence are not enough to make the isolated gene markedly different. *Myriad*, 569 U.S. at 580, 106 USPQ2d at 1974-75. The patentee in *Myriad* had discovered the location of the BRCA1 and BRCA2 genes in the human genome, and isolated them, i.e., separated those specific genes from the rest of the chromosome on which they exist in nature. As a result of their isolation, the isolated genes had a different structural characteristic than the natural genes, i.e., the natural genes had covalent bonds on their ends that connected them to the rest of the chromosome, but the isolated genes lacked these bonds. However, the claimed genes were otherwise structurally identical to the natural genes, e.g., they had the same genetic structure and nucleotide sequence as the BRCA genes in nature. The Supreme Court concluded that these isolated but otherwise unchanged genes were not eligible, because they were not different enough from what exists in nature to avoid improperly tying up the future use and study of the naturally occurring BRCA genes. See, e.g., *Myriad*, 569 U.S. at 585, 106 USPQ2d at 1977 (“*Myriad's* patents would, if valid, give it the exclusive right to isolate an individual’s BRCA1 and BRCA2 genes ... But isolation is necessary to conduct genetic testing”) and 569 U.S. at 593, 106 USPQ2d at 1980

(describing how would-be infringers could not avoid the scope of *Myriad's* claims). In sum, the claimed genes were different, but not markedly different, from their naturally occurring counterparts (the BRCA genes), and thus were product of nature exceptions.

In *Ambry Genetics*, the court identified claimed DNA fragments known as “primers” as products of nature, because they lacked markedly different characteristics. *University of Utah Research Foundation v. Ambry Genetics Corp.*, 774 F.3d 755, 113 USPQ2d 1241 (Fed. Cir. 2014). The claimed primers were single-stranded pieces of DNA, each of which corresponded to a naturally occurring double-stranded DNA sequence in or near the BRCA genes. The patentee argued that these primers had markedly different structural characteristics from the natural DNA, because the primers were synthetically created and because “single-stranded DNA cannot be found in the human body”. The court disagreed, concluding that the primers’ structural characteristics were not markedly different than the corresponding strands of DNA in nature, because the primers and their counterparts had the same genetic structure and nucleotide sequence. 774 F.3d at 760, 113 USPQ2d at 1243-44. The patentee also argued that the primers had a different function than when they are part of the DNA strand because when isolated as a primer, a primer can be used as a starting material for a DNA polymerization process. The court disagreed, because this ability to serve as a starting material is innate to DNA itself, and was not created or altered by the patentee:

In fact, the naturally occurring genetic sequences at issue here do not perform a significantly new function. Rather, the naturally occurring material is used to form the first step in a chain reaction--a function that is performed because the primer maintains the exact same nucleotide sequence as the relevant portion of the naturally occurring sequence. One of the primary functions of DNA’s structure in nature is that complementary nucleotide sequences bind to each other. It is this same function that is exploited here--the primer binds to its complementary nucleotide sequence. Thus, just as in nature, primers utilize the innate ability of DNA to bind to itself.

*Ambry Genetics*, 774 F.3d at 760-61, 113 USPQ2d at 1244. In sum, because the characteristics of the claimed primers were innate to naturally occurring DNA, they lacked markedly different characteristics from nature and were thus product of nature exceptions. A similar result was reached in *Marden*, where the court held a claim to ductile vanadium ineligible, because the “ductility or malleability of vanadium is . . . one of its inherent characteristics and not a characteristic given to it by virtue of a new combination with other materials or which characteristic is brought about by some chemical reaction or agency which changes its inherent characteristics”. *In re Marden*, 47 F.2d 958, 959, 18 CCPA 1057, 1060, 8 USPQ 347, 349 (CCPA 1931).

In *Roslin*, the court concluded that claimed clones of farm animals were products of nature, because they lacked markedly different characteristics from the counterpart farm animals found in nature. *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1337, 110 USPQ2d 1668, 1671 (Fed. Cir. 2014). The inventor created its clones (which included the famous cloned sheep named Dolly) by transferring the genetic material of a donor into an oocyte (egg cell), letting the oocyte develop into an embryo, and then implanting the embryo into a surrogate animal where it developed into a baby animal. The applicant argued that the clones, including Dolly, were eligible because they were created via human ingenuity, and had phenotypic differences such as shape, size and behavior compared to their donors. The court was unpersuaded, explaining that the clones were exact genetic replicas of the donors and thus did not possess markedly different characteristics. 750 F.3d at 1337, 110 USPQ2d at 1671-72 (“Roslin’s chief innovation was the preservation of the donor DNA such that the clone is an exact copy of the mammal from which the somatic cell was taken. Such a copy is not eligible for patent protection.”). The court noted that the alleged phenotypic differences (*e.g.*, the fact that Dolly may have been taller or heavier than her donor) could not make the clones markedly different because these differences were not claimed. 750 F.3d at 1338, 110 USPQ2d at 1672. See also *Roche Molecular System, Inc. v. CEPHEID*, 905 F.3d 1363, 1370, 128 USPQ2d 1221, 1226 (Fed. Cir. 2018) (alleged structural differences between linear primers and their counterparts on a circular

chromosome were neither claimed nor relevant to the eligibility inquiry).

### **2106.04(d) Integration of a Judicial Exception Into A Practical Application [R-07.2022]**

The Supreme Court has long distinguished between principles themselves (which are not patent eligible) and the integration of those principles into practical applications (which are patent eligible). See, *e.g.*, *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 80, 84, 101 USPQ2d 1961, 1968-69, 1970 (2012) (noting that the Court in *Diamond v. Diehr* found “the overall process patent eligible because of the way the additional steps of the process integrated the equation into the process as a whole,” but the Court in *Gottschalk v. Benson* “held that simply implementing a mathematical principle on a physical machine, namely a computer, was not a patentable application of that principle”). Similarly, in a growing body of decisions, the Federal Circuit has distinguished between claims that are “directed to” a judicial exception (which require further analysis to determine their eligibility) and those that are not (which are therefore patent eligible), *e.g.*, claims that improve the functioning of a computer or other technology or technological field. See *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981); *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972). See, *e.g.*, [MPEP § 2106.06\(b\)](#) (summarizing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 118 USPQ2d 1684 (Fed. Cir. 2016), *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 120 USPQ2d 1091 (Fed. Cir. 2016), and other cases that were eligible as improvements to technology or computer functionality instead of being directed to abstract ideas).

Accordingly, after determining that a claim recites a judicial exception in Step 2A Prong One, examiners should evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception in Step 2A Prong Two. A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.

Whether or not a claim integrates a judicial exception into a practical application is evaluated using the considerations set forth in subsection I below, in accordance with the procedure described below in subsection II.

In the context of the flowchart in [MPEP § 2106](#), subsection III, Step 2A Prong Two determines whether:

- The claim as a whole integrates the judicial exception into a practical application, in which case the claim is not directed to a judicial exception (Step 2A: NO) and is eligible at Pathway B. This concludes the eligibility analysis.

- The claim as a whole does not integrate the exception into a practical application, in which case the claim is directed to the judicial exception (Step 2A: YES), and requires further analysis under Step 2B (where it may still be eligible if it amounts to an inventive concept). See [MPEP § 2106.05](#) for discussion of Step 2B.

#### **I. RELEVANT CONSIDERATIONS FOR EVALUATING WHETHER ADDITIONAL ELEMENTS INTEGRATE A JUDICIAL EXCEPTION INTO A PRACTICAL APPLICATION**

The Supreme Court and Federal Circuit have identified a number of considerations as relevant to the evaluation of whether the claimed additional elements demonstrate that a claim is directed to patent-eligible subject matter. The list of considerations here is not intended to be exclusive or limiting. Additional elements can often be analyzed based on more than one type of consideration and the type of consideration is of no import to the eligibility analysis. Additional discussion of these considerations, and how they were applied in particular judicial decisions, is provided in [MPEP § 2106.05\(a\)](#) through (c) and [MPEP § 2106.05\(e\)](#) through (h).

Limitations the courts have found indicative that an additional element (or combination of elements) may have integrated the exception into a practical application include:

- An improvement in the functioning of a computer, or an improvement to other technology

or technical field, as discussed in [MPEP §§ 2106.04\(d\)\(1\)](#) and [2106.05\(a\)](#);

- Applying or using a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition, as discussed in [MPEP § 2106.04\(d\)\(2\)](#);

- Implementing a judicial exception with, or using a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim, as discussed in [MPEP § 2106.05\(b\)](#);

- Effecting a transformation or reduction of a particular article to a different state or thing, as discussed in [MPEP § 2106.05\(c\)](#); and

- Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception, as discussed in [MPEP § 2106.05\(e\)](#).

The courts have also identified limitations that did not integrate a judicial exception into a practical application:

- Merely reciting the words “apply it” (or an equivalent) with the judicial exception, or merely including instructions to implement an abstract idea on a computer, or merely using a computer as a tool to perform an abstract idea, as discussed in [MPEP § 2106.05\(f\)](#);

- Adding insignificant extra-solution activity to the judicial exception, as discussed in [MPEP § 2106.05\(g\)](#); and

- Generally linking the use of a judicial exception to a particular technological environment or field of use, as discussed in [MPEP § 2106.05\(h\)](#).

Step 2A Prong Two is similar to Step 2B in that both analyses involve evaluating a set of judicial considerations to determine if the claim is eligible. See [MPEP §§ 2106.05\(a\)](#) through (h) for the list of considerations that are evaluated at Step 2B. Although most of these considerations overlap (i.e., they are evaluated in both Step 2A Prong Two and Step 2B), Step 2A specifically excludes consideration of whether the additional elements represent well-understood, routine, conventional activity. Accordingly, in Step 2A Prong Two,

examiners should ensure that they give weight to all additional elements, whether or not they are conventional, when evaluating whether a judicial exception has been integrated into a practical application. Additional elements that represent well-understood, routine, conventional activity may integrate a recited judicial exception into a practical application.

It is notable that mere physicality or tangibility of an additional element or elements is not a relevant consideration in Step 2A Prong Two. As the Supreme Court explained in *Alice Corp.*, mere physical or tangible implementation of an exception does not guarantee eligibility. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 224, 110 USPQ2d 1976, 1983-84 (2014) (“The fact that a computer ‘necessarily exist[s] in the physical, rather than purely conceptual, realm,’ is beside the point”). See also *Genetic Technologies Ltd. v. Merial LLC*, 818 F.3d 1369, 1377, 118 USPQ2d 1541, 1547 (Fed. Cir. 2016) (steps of DNA amplification and analysis are not “sufficient” to render claim 1 patent eligible merely because they are physical steps). Conversely, the presence of a non-physical or intangible additional element does not doom the claims, because tangibility is not necessary for eligibility under the *Alice/Mayo* test. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 118 USPQ2d 1684 (Fed. Cir. 2016) (“that the improvement is not defined by reference to ‘physical’ components does not doom the claims”). See also *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102 (Fed. Cir. 2016), (holding that a process producing an intangible result (a sequence of synchronized, animated characters) was eligible because it improved an existing technological process).

In addition, a specific way of achieving a result is not a stand-alone consideration in Step 2A Prong Two. However, the specificity of the claim limitations is relevant to the evaluation of several considerations including the use of a particular machine, particular transformation and whether the limitations are mere instructions to apply an exception. See [MPEP §§ 2106.05\(b\)](#), [2106.05\(c\)](#), and [2106.05\(f\)](#). For example, in *Parker v. Flook*, 437 U.S. 584, 198 USPQ 193 (1978), the Supreme Court noted that the “patent application does not

purport to explain how to select the appropriate margin of safety, the weighting factor, or any of the other variables” in the claimed mathematical formula, “[n]or does it purport to contain any disclosure relating to the chemical processes at work, the monitoring of process variables, or the means of setting off an alarm or adjusting an alarm system.” 437 U.S. at 586, 198 USPQ at 195. The Court found this failure to explain any specifics of how to use the claimed formula informative when deciding that the additional elements in the claim were insignificant post-solution activity and thus not meaningful enough to render the claim eligible. 437 U.S. at 589-90, 198 USPQ at 197.

## II. HOW TO EVALUATE WHETHER THE ADDITIONAL ELEMENTS INTEGRATE THE JUDICIAL EXCEPTION INTO A PRACTICAL APPLICATION

The analysis under Step 2A Prong Two is the same for all claims reciting a judicial exception, whether the exception is an abstract idea, a law of nature, or a natural phenomenon (including products of nature). Examiners evaluate integration into a practical application by: (1) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (2) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application, using one or more of the considerations introduced in subsection I *supra*, and discussed in more detail in [MPEP §§ 2106.04\(d\)\(1\)](#), [2106.04\(d\)\(2\)](#), [2106.05\(a\)](#) through [\(c\)](#) and [2106.05\(e\)](#) through [\(h\)](#).

Many of these considerations overlap, and often more than one consideration is relevant to analysis of an additional element. Not all considerations will be relevant to every element, or every claim. Because the evaluation in Prong Two is not a weighing test, it is not important how the elements are characterized or how many considerations apply from the list. It is important to evaluate the significance of the additional elements relative to the invention, and to keep in mind the ultimate question of whether the exception is integrated into a practical application. If the claim as a whole integrates the judicial exception into a practical application based upon evaluation of these considerations, the additional



limitations impose a meaningful limit on the judicial exception and the claim is eligible at Step 2A.

Examiners should examine each claim for eligibility separately, based on the particular elements recited therein. Claims should not be judged to automatically stand or fall with similar claims in an application. For instance, one claim may be ineligible because it is directed to a judicial exception without amounting to significantly more, but another claim dependent on the first may be eligible because it recites additional elements that do amount to significantly more, or that integrate the exception into a practical application.

For more information on how to evaluate claims reciting multiple judicial exceptions, see [MPEP § 2106.04](#), subsection II.B.

### **III. EXAMPLES OF HOW THE OFFICE EVALUATES WHETHER THE CLAIM AS A WHOLE INTEGRATES THE JUDICIAL EXCEPTION INTO A PRACTICAL APPLICATION**

The Prong Two analysis considers the claim as a whole. That is, the limitations containing the judicial exception as well as the additional elements in the claim besides the judicial exception need to be evaluated together to determine whether the claim integrates the judicial exception into a practical application. Because a judicial exception alone is not eligible subject matter, if there are no additional claim elements besides the judicial exception, or if the additional claim elements merely recite another judicial exception, that is insufficient to integrate the judicial exception into a practical application. However, the way in which the additional elements use or interact with the exception may integrate it into a practical application. Accordingly, the additional limitations should not be evaluated in a vacuum, completely separate from the recited judicial exception. Instead, the analysis should take into consideration all the claim limitations and how those limitations interact and impact each other when evaluating whether the exception is integrated into a practical application.

Two examples of how the Office evaluates whether the claim as a whole integrates the recited judicial exception into a practical application are provided.

In *Solutran, Inc. v. Elavon, Inc.*, 931 F.3d 1161, 2019 USPQ2d 281076 (Fed. Cir. 2019), the claims were to methods for electronically processing paper checks, all of which contained limitations setting forth receiving merchant transaction data from a merchant, crediting a merchant's account, and receiving and scanning paper checks after the merchant's account is credited. In part one of the *Alice/Mayo* test, the Federal Circuit determined that the claims were directed to the abstract idea of crediting the merchant's account before the paper check is scanned. The court first determined that the recited limitations of "crediting a merchant's account as early as possible while electronically processing a check" is a "long-standing commercial practice" like in *Alice* and *Bilski*. 931 F.3d at 1167, 2019 USPQ2d 281076, at \*5 (Fed. Cir. 2019). The Federal Circuit then continued with its analysis under part one of the *Alice/Mayo* test finding that the claims are not directed to an improvement in the functioning of a computer or an improvement to another technology. In particular, the court determined that the claims "did not improve the technical capture of information from a check to create a digital file or the technical step of electronically crediting a bank account" nor did the claims "improve how a check is scanned." *Id.* This analysis is equivalent to the Office's analysis of determining that the exception is not integrated into a practical application at Step 2A Prong Two, and thus that the claims are directed to the judicial exception (Step 2A: YES).

In *Finjan Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299, 125 USPQ2d 1282 (Fed. Cir. 2018), the claimed invention was a method of virus scanning that scans an application program, generates a security profile identifying any potentially suspicious code in the program, and links the security profile to the application program. 879 F.3d at 1303-04, 125 USPQ2d at 1285-86. The Federal Circuit noted that the recited virus screening was an abstract idea, and that merely performing virus screening on a computer does not render the claim eligible. 879 F.3d at 1304, 125 USPQ2d at 1286. The court then continued with its analysis under part one of the *Alice/Mayo* test by reviewing the patent's specification, which described the claimed security profile as identifying both hostile and potentially hostile operations. The court noted that the security profile thus enables the invention to protect the user

against both previously unknown viruses and “obfuscated code,” as compared to traditional virus scanning, which only recognized the presence of previously-identified viruses. The security profile also enables more flexible virus filtering and greater user customization. 879 F.3d at 1304, 125 USPQ2d at 1286. The court identified these benefits as improving computer functionality, and verified that the claims recite additional elements (*e.g.*, specific steps of using the security profile in a particular way) that reflect this improvement. Accordingly, the court held the claims eligible as not being directed to the recited abstract idea. 879 F.3d at 1304-05, 125 USPQ2d at 1286-87. This analysis is equivalent to the Office’s analysis of determining that the additional elements integrate the judicial exception into a practical application at Step 2A Prong Two, and thus that the claims were not directed to the judicial exception (Step 2A: NO).

**2106.04(d)(1) Evaluating Improvements in the Functioning of a Computer, or an Improvement to Any Other Technology or Technical Field in Step 2A Prong Two [R-10.2019]**

A claim reciting a judicial exception is not directed to the judicial exception if it also recites additional elements demonstrating that the claim as a whole integrates the exception into a practical application. One way to demonstrate such integration is when the claimed invention improves the functioning of a computer or improves another technology or technical field. The application or use of the judicial exception in this manner meaningfully limits the claim by going beyond generally linking the use of the judicial exception to a particular technological environment, and thus transforms a claim into patent-eligible subject matter. Such claims are eligible at Step 2A because they are not “directed to” the recited judicial exception.

The courts have not provided an explicit test for this consideration, but have instead illustrated how it is evaluated in numerous decisions. These decisions, and a detailed explanation of how examiners should evaluate this consideration are provided in [MPEP § 2106.05\(a\)](#). In short, first the specification should be evaluated to determine if the disclosure provides sufficient details such that one of ordinary skill in

the art would recognize the claimed invention as providing an improvement. The specification need not explicitly set forth the improvement, but it must describe the invention such that the improvement would be apparent to one of ordinary skill in the art. Conversely, if the specification explicitly sets forth an improvement but in a conclusory manner (*i.e.*, a bare assertion of an improvement without the detail necessary to be apparent to a person of ordinary skill in the art), the examiner should not determine the claim improves technology. Second, if the specification sets forth an improvement in technology, the claim must be evaluated to ensure that the claim itself reflects the disclosed improvement. That is, the claim includes the components or steps of the invention that provide the improvement described in the specification. The claim itself does not need to explicitly recite the improvement described in the specification (*e.g.*, “thereby increasing the bandwidth of the channel”).

While the courts usually evaluate “improvements” as part of the “directed to” inquiry in part one of the *Alice/Mayo* test (equivalent to Step 2A), they have also performed this evaluation in part two of the *Alice/Mayo* test (equivalent to Step 2B). See, *e.g.*, *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1349-50, 119 USPQ2d 1236, 1241-42 (Fed. Cir. 2016). However, the improvement analysis at Step 2A Prong Two differs in some respects from the improvements analysis at Step 2B. Specifically, the “improvements” analysis in Step 2A determines whether the claim pertains to an improvement to the functioning of a computer or to another technology without reference to what is well-understood, routine, conventional activity. That is, the claimed invention may integrate the judicial exception into a practical application by demonstrating that it improves the relevant existing technology although it may not be an improvement over well-understood, routine, conventional activity. It should be noted that while this consideration is often referred to in an abbreviated manner as the “improvements consideration,” the word “improvements” in the context of this consideration is limited to improvements to the functioning of a computer or any other technology/technical field, whether in Step 2A Prong Two or in Step 2B.



Examples of claims that improve technology and are not directed to a judicial exception include:

*Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339, 118 USPQ2d 1684, 1691-92 (Fed. Cir. 2016) (claims to a self-referential table for a computer database were directed to an improvement in computer capabilities and not directed to an abstract idea); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102-03 (Fed. Cir. 2016) (claims to automatic lip synchronization and facial expression animation were directed to an improvement in computer-related technology and not directed to an abstract idea); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253,1259-60, 123 USPQ2d 1712, 1717 (Fed. Cir. 2017) (claims to an enhanced computer memory system were directed to an improvement in computer capabilities and not an abstract idea); *Finjan Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299, 125 USPQ2d 1282 (Fed. Cir. 2018) (claims to virus scanning were found to be an improvement in computer technology and not directed to an abstract idea); *SRI Int'l, Inc. v. Cisco Systems, Inc.*, 930 F.3d 1295, 1303 (Fed. Cir. 2019) (claims to detecting suspicious activity by using network monitors and analyzing network packets were found to be an improvement in computer network technology and not directed to an abstract idea). Additional examples are provided in [MPEP § 2106.05\(a\)](#).

### **2106.04(d)(2) Particular Treatment and Prophylaxis in Step 2A Prong Two [R-07.2022]**

A claim reciting a judicial exception is not directed to the judicial exception if it also recites additional element(s) demonstrating that the claim as a whole integrates the exception into a practical application. One way to demonstrate such integration is when the additional elements apply or use the recited judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition. The application or use of the judicial exception in this manner meaningfully limits the claim by going beyond generally linking the use of the judicial exception to a particular technological environment, and thus transforms a claim into patent-eligible subject matter. Such claims are eligible at Step 2A, because they are not “directed to” the recited judicial exception.

The particular treatment or prophylaxis consideration originated as part of the other meaningful limitations consideration discussed in [MPEP § 2106.05\(e\)](#) and shares the same legal basis in Supreme Court jurisprudence as that consideration. However, recent jurisprudence has provided additional guidance that is especially relevant to only a subset of claims, thus warranting the elevation of the particular treatment or prophylaxis consideration to become a stand-alone consideration in the Step 2A Prong Two analysis.

*Vanda Pharm. Inc. v. West-Ward Pharm. Int'l Ltd.*, 887 F.3d 1117, 126 USPQ2d 1266 (Fed. Cir. 2018). The claims in *Vanda* recited a method of treating a patient having schizophrenia with iloperidone, a drug known to cause QTc prolongation (a disruption of the heart’s normal rhythm that can lead to serious health problems) in patients having a particular genotype associated with poor drug metabolism. 887 F.3d at 1121, 126 USPQ2d at 1269-70. In particular, the claims recited steps of: (1) performing a genotyping assay to determine if a patient has a genotype associated with poor drug metabolism; and (2) administering iloperidone to the patient in a dose range that depends on the patient’s genotype. *Id.* Although *Vanda’s* claims recited a law of nature (the naturally occurring relationship between the patient’s genotype and the risk of QTc prolongation) like the claims in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 101 USPQ2d 1961 (2012), the Federal Circuit distinguished them from the *Mayo* claims based on the differences in the administration steps. In particular, the court explained that *Mayo’s* step of administering a drug to a patient was performed in order to gather data about the recited laws of nature, and this step was thus ancillary to the overall diagnostic focus of the claims. 887 F.3d at 1134-35, 126 USPQ2d at 1280. In contrast, *Vanda’s* claims used the recited law of nature to more safely treat the patients with the drug, thereby reducing the patient’s risk of QTc prolongation. 887 F.3d at 1135, 126 USPQ2d at 1280. Accordingly, the court held *Vanda’s* claims eligible at the first part of the *Alice/Mayo* test (Step 2A) because the claims were not “directed to” the recited judicial exception. 887 F.3d at 1136, 126 USPQ2d at 1281.

Examples of “treatment” and prophylaxis” limitations encompass limitations that treat or prevent a disease or medical condition, including,

e.g., acupuncture, administration of medication, dialysis, organ transplants, phototherapy, physiotherapy, radiation therapy, surgery, and the like. For example, an immunization step that integrates an abstract idea into a specific process of immunizing that lowers the risk that immunized patients will later develop chronic immune-mediated diseases is considered to be a particular prophylaxis limitation that practically applies the abstract idea. See, e.g., *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057, 1066–68, 100 USPQ2d 1492, 1500-01 (Fed. Cir. 2011).

Examiners should keep in mind that in order to qualify as a “treatment” or “prophylaxis” limitation for purposes of this consideration, the claim limitation in question must affirmatively recite an action that effects a particular treatment or prophylaxis for a disease or medical condition. An example of such a limitation is a step of “administering amazonic acid to a patient” or a step of “administering a course of plasmapheresis to a patient.” If the limitation does not actually provide a treatment or prophylaxis, e.g., it is merely an intended use of the claimed invention or a field of use limitation, then it cannot integrate a judicial exception under the “treatment or prophylaxis” consideration. For example, a step of “prescribing a topical steroid to a patient with eczema” is not a positive limitation because it does not require that the steroid actually be used by or on the patient, and a recitation that a claimed product is a “pharmaceutical composition” or that a “feed dispenser is operable to dispense a mineral supplement” are not affirmative limitations because they are merely indicating how the claimed invention might be used.

When determining whether a claim applies or uses a recited judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition, the following factors are relevant.

#### a. The Particularity Or Generality Of The Treatment Or Prophylaxis

The treatment or prophylaxis limitation must be “particular,” *i.e.*, specifically identified so that it does not encompass all applications of the judicial exception(s). For example, consider a claim that recites mentally analyzing information to identify if

a patient has a genotype associated with poor metabolism of beta blocker medications. This falls within the mental process grouping of abstract ideas enumerated in [MPEP § 2106.04\(a\)](#). The claim also recites “administering a lower than normal dosage of a beta blocker medication to a patient identified as having the poor metabolizer genotype.” This administration step is particular, and it integrates the mental analysis step into a practical application. Conversely, consider a claim that recites the same abstract idea and “administering a suitable medication to a patient.” This administration step is not particular, and is instead merely instructions to “apply” the exception in a generic way. Thus, the administration step does not integrate the mental analysis step into a practical application. Examiners may find it helpful to evaluate other considerations such as the mere instructions to apply an exception consideration (see [MPEP § 2106.05\(f\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)), when making a determination of whether a treatment or prophylaxis limitation is particular or general.

#### b. Whether The Limitation(s) Have More Than A Nominal Or Insignificant Relationship To The Exception(s)

The treatment or prophylaxis limitation must have more than a nominal or insignificant relationship to the exception(s). For example, consider a claim that recites a natural correlation (law of nature) between blood glucose levels over 250 mg/dl and the risk of developing ketoacidosis (a life-threatening medical condition). The claim also recites “treating a patient having a blood glucose level over 250 mg/dl with insulin”. Insulin acts to lower blood glucose levels, and administering insulin to a patient will reduce the patient’s blood glucose level, thereby lowering the risk that the patient will develop ketoacidosis. Thus, in the context of this claim, the administration step is significantly related to the recited correlation between high blood glucose levels and the risk of ketoacidosis. Because insulin is also a “particular” treatment, this administration step integrates the law of nature into a practical application. Alternatively, consider a claim that recites the same law of nature and also recites “treating a patient having a blood glucose level over 250 mg/dl with aspirin.” Aspirin is not known in the art as a treatment for ketoacidosis or diabetes, although some patients with diabetes may be on

aspirin therapy for other medical reasons (*e.g.*, to control pain or inflammation, or to prevent blood clots). In the context of this claim and the recited correlation between high blood glucose levels and the risk of ketoacidosis, administration of aspirin has at best a nominal connection to the law of nature, because aspirin does not treat or prevent ketoacidosis. This step therefore does not apply or use the exception in any meaningful way. Thus, this step of administering aspirin does not integrate the law of nature into a practical application. Examiners may find it helpful to evaluate other considerations such as the insignificant extra-solution activity consideration (see [MPEP § 2106.05\(g\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)), when making a determination of whether a treatment or prophylaxis limitation has more than a nominal or insignificant relationship to the exception(s).

### c. Whether The Limitation(s) Are Merely Extra-Solution Activity Or A Field Of Use

The treatment or prophylaxis limitation must impose meaningful limits on the judicial exception, and cannot be extra-solution activity or a field-of-use. For example, consider a claim that recites (a) administering rabies and feline leukemia vaccines to a first group of domestic cats in accordance with different vaccination schedules, and (b) analyzing information about the vaccination schedules and whether the cats later developed chronic immune-mediated disorders to determine a lowest-risk vaccination schedule. Step (b) falls within the mental process grouping of abstract ideas enumerated in [MPEP § 2106.04\(a\)](#). While step (a) administers vaccines to the cats, this administration is performed in order to gather data for the mental analysis step, and is a necessary precursor for all uses of the recited exception. It is thus extra-solution activity, and does not integrate the judicial exception into a practical application. Conversely, consider a claim reciting the same steps (a) and (b), but also reciting step (c) “vaccinating a second group of domestic cats in accordance with the lowest-risk vaccination schedule.” Step (c) applies the exception, in that the information from the mental analysis in step (b) is used to alter the order and timing of the vaccinations so that the second group of cats has a lower risk of developing chronic immune-mediated disorders. Step (c) thus integrates the abstract idea into a practical application. Examiners may find it

helpful to evaluate other considerations such as the insignificant extra-solution activity consideration (see [MPEP § 2106.05\(g\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)), when making a determination of whether a treatment or prophylaxis limitation is merely extra-solution activity or a field of use.

## 2106.05 Eligibility Step 2B: Whether a Claim Amounts to Significantly More [R-07.2022]

### I. THE SEARCH FOR AN INVENTIVE CONCEPT

The second part of the *Alice/Mayo* test is often referred to as a search for an inventive concept. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217, 110 USPQ2d 1976, 1981 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71-72, 101 USPQ2d 1961, 1966 (2012)).

An inventive concept “cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.” *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1376, 118 USPQ2d 1541, 1546 (Fed. Cir. 2016). See also *Alice Corp.*, 573 U.S. at 21-18, 110 USPQ2d at 1981 (citing *Mayo*, 566 U.S. at 78, 101 USPQ2d at 1968 (after determining that a claim is directed to a judicial exception, “we then ask, ‘[w]hat else is there in the claims before us?’”) (emphasis added)); *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327, 122 USPQ2d 1377 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea (encoding and decoding) does not render the claim non-abstract”). Instead, an “inventive concept” is furnished by an element or combination of elements that is recited in the claim in addition to (beyond) the judicial exception, and is sufficient to ensure that the claim as a whole amounts to significantly more than the judicial exception itself. *Alice Corp.*, 573 U.S. at 27-18, 110 USPQ2d at 1981 (citing *Mayo*, 566 U.S. at 72-73, 101 USPQ2d at 1966).

Evaluating additional elements to determine whether they amount to an inventive concept requires considering them both individually and in combination to ensure that they amount to significantly more than the judicial exception itself. Because this approach considers all claim elements,

the Supreme Court has noted that “it is consistent with the general rule that patent claims ‘must be considered as a whole.’” *Alice Corp.*, 573 U.S. at 218 n.3, 110 USPQ2d at 1981 (quoting *Diamond v. Diehr*, 450 U.S. 175, 188, 209 USPQ 1, 8-9 (1981)). Consideration of the elements in combination is particularly important, because even if an additional element does not amount to significantly more on its own, it can still amount to significantly more when considered in combination with the other elements of the claim. See, e.g., *Rapid Litig. Mgmt. v. CellzDirect*, 827 F.3d 1042, 1051, 119 USPQ2d 1370, 1375 (Fed. Cir. 2016) (process reciting combination of individually well-known freezing and thawing steps was “far from routine and conventional” and thus eligible); *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350, 119 USPQ2d 1236, 1242 (Fed. Cir. 2016) (inventive concept may be found in the non-conventional and non-generic arrangement of components that are individually well-known and conventional).

Although the courts often evaluate considerations such as the conventionality of an additional element in the eligibility analysis, the search for an inventive concept should not be confused with a novelty or non-obviousness determination. See *Mayo*, 566 U.S. at 91, 101 USPQ2d at 1973 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). As made clear by the courts, the “‘novelty’ of any element or steps in a process, or even of the process itself, is of **no relevance** in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Intellectual Ventures I v. Symantec Corp.*, 838 F.3d 1307, 1315, 120 USPQ2d 1353, 1358 (Fed. Cir. 2016) (quoting *Diamond v. Diehr*, 450 U.S. at 188–89, 209 USPQ at 9). See also *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151, 120 USPQ2d 1473, 1483 (Fed. Cir. 2016) (“a claim for a **new** abstract idea is still an abstract idea. The search for a § 101 inventive concept is thus distinct from demonstrating § 102 novelty.”). In addition, the search for an inventive concept is different from an obviousness analysis under 35 U.S.C. 103. See, e.g., *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1350, 119 USPQ2d 1236, 1242 (Fed. Cir.

2016) (“The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art. . . . [A]n inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.”). Specifically, lack of novelty under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103 of a claimed invention does not necessarily indicate that additional elements are well-understood, routine, conventional elements. Because they are separate and distinct requirements from eligibility, patentability of the claimed invention under 35 U.S.C. 102 and 103 with respect to the prior art is neither required for, nor a guarantee of, patent eligibility under 35 U.S.C. 101. The distinction between eligibility (under 35 U.S.C. 101) and patentability over the art (under 35 U.S.C. 102 and/or 103) is further discussed in [MPEP § 2106.05\(d\)](#).

#### ***A. Relevant Considerations For Evaluating Whether Additional Elements Amount To An Inventive Concept***

The Supreme Court has identified a number of considerations as relevant to the evaluation of whether the claimed additional elements amount to an inventive concept. The list of considerations here is not intended to be exclusive or limiting. Additional elements can often be analyzed based on more than one type of consideration and the type of consideration is of no import to the eligibility analysis. Additional discussion of these considerations, and how they were applied in particular judicial decisions, is provided in [MPEP § 2106.05\(a\) through \(h\)](#).

Limitations that the courts have found to qualify as “significantly more” when recited in a claim with a judicial exception include:

- i. Improvements to the functioning of a computer, e.g., a modification of conventional Internet hyperlink protocol to dynamically produce a dual-source hybrid webpage, as discussed in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258-59, 113 USPQ2d 1097, 1106-07 (Fed. Cir. 2014) (see [MPEP § 2106.05\(a\)](#));
- ii. Improvements to any other technology or technical field, e.g., a modification of conventional rubber-molding processes to utilize a thermocouple inside the mold to constantly monitor the temperature



and thus reduce under- and over-curing problems common in the art, as discussed in *Diamond v. Diehr*, 450 U.S. 175, 191-92, 209 USPQ 1, 10 (1981) (see [MPEP § 2106.05\(a\)](#));

iii. Applying the judicial exception with, or by use of, a particular machine, *e.g.*, a Fourdrinier machine (which is understood in the art to have a specific structure comprising a headbox, a paper-making wire, and a series of rolls) that is arranged in a particular way to optimize the speed of the machine while maintaining quality of the formed paper web, as discussed in *Eibel Process Co. v. Minn. & Ont. Paper Co.*, 261 U.S. 45, 64-65 (1923) (see [MPEP § 2106.05\(b\)](#));

iv. Effecting a transformation or reduction of a particular article to a different state or thing, *e.g.*, a process that transforms raw, uncured synthetic rubber into precision-molded synthetic rubber products, as discussed in *Diehr*, 450 U.S. at 184, 209 USPQ at 21 (see [MPEP § 2106.05\(c\)](#));

v. Adding a specific limitation other than what is well-understood, routine, conventional activity in the field, or adding unconventional steps that confine the claim to a particular useful application, *e.g.*, a non-conventional and non-generic arrangement of various computer components for filtering Internet content, as discussed in *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1350-51, 119 USPQ2d 1236, 1243 (Fed. Cir. 2016) (see [MPEP § 2106.05\(d\)](#)); or

vi. Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment, *e.g.*, an immunization step that integrates an abstract idea of data comparison into a specific process of immunizing that lowers the risk that immunized patients will later develop chronic immune-mediated diseases, as discussed in *Classen Immunotherapies Inc. v. Biogen IDEC*, 659 F.3d 1057, 1066-68, 100 USPQ2d 1492, 1499-1502 (Fed. Cir. 2011) (see [MPEP § 2106.05\(e\)](#)).

Limitations that the courts have found not to be enough to qualify as “significantly more” when recited in a claim with a judicial exception include:

i. Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer, *e.g.*, a limitation indicating that a particular function such

as creating and maintaining electronic records is performed by a computer, as discussed in *Alice Corp.*, 573 U.S. at 225-26, 110 USPQ2d at 1984 (see [MPEP § 2106.05\(f\)](#));

ii. Simply appending well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, *e.g.*, a claim to an abstract idea requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry, as discussed in *Alice Corp.*, 573 U.S. at 225, 110 USPQ2d at 1984 (see [MPEP § 2106.05\(d\)](#));

iii. Adding insignificant extra-solution activity to the judicial exception, *e.g.*, mere data gathering in conjunction with a law of nature or abstract idea such as a step of obtaining information about credit card transactions so that the information can be analyzed by an abstract mental process, as discussed in *CyberSource v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375, 99 USPQ2d 1690, 1694 (Fed. Cir. 2011) (see [MPEP § 2106.05\(g\)](#)); or

iv. Generally linking the use of the judicial exception to a particular technological environment or field of use, *e.g.*, a claim describing how the abstract idea of hedging could be used in the commodities and energy markets, as discussed in *Bilski v. Kappos*, 561 U.S. 593, 595, 95 USPQ2d 1001, 1010 (2010) or a claim limiting the use of a mathematical formula to the petrochemical and oil-refining fields, as discussed in *Parker v. Flook*, 437 U.S. 584, 588-90, 198 USPQ 193, 197-98 (1978) ([MPEP § 2106.05\(h\)](#)).

It is notable that mere physicality or tangibility of an additional element or elements is not a relevant consideration in Step 2B. As the Supreme Court explained in *Alice Corp.*, mere physical or tangible implementation of an exception is not in itself an inventive concept and does not guarantee eligibility:

The fact that a computer “necessarily exist[s] in the physical, rather than purely conceptual, realm,” is beside the point. There is no dispute that a computer is a tangible system (in [§ 101](#) terms, a “machine”), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But

if that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept. Such a result would make the determination of patent eligibility “depend simply on the draftsman’s art,” *Flook, supra*, at 593, 98 S. Ct. 2522, 57 L. Ed. 2d 451, thereby eviscerating the rule that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable,” *Myriad*, 133 S. Ct. 1289, 186 L. Ed. 2d 124, 133).

*Alice Corp.*, 573 U.S. at 224, 110 USPQ2d at 1983-84 (alterations in original). See also *Genetic Technologies Ltd. v. Merial LLC*, 818 F.3d 1369, 1377, 118 USPQ2d 1541, 1547 (Fed. Cir. 2016) (steps of DNA amplification and analysis “do not, individually or in combination, provide sufficient inventive concept to render claim 1 patent eligible” merely because they are physical steps). Conversely, the presence of a non-physical or intangible additional element does not doom the claims, because tangibility is not necessary for eligibility under the *Alice/Mayo* test. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 118 USPQ2d 1684 (Fed. Cir. 2016) (“that the improvement is not defined by reference to ‘physical’ components does not doom the claims”). See also *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102 (Fed. Cir. 2016), (holding that a process producing an intangible result (a sequence of synchronized, animated characters) was eligible because it improved an existing technological process).

#### ***B. Examples Of How Courts Conduct The Search For An Inventive Concept***

*Alice Corp.* provides an example of how courts conduct the significantly more analysis. In this case, the Supreme Court analyzed claims to computer systems, computer readable media, and computer-implemented methods, all of which described a scheme for mitigating “settlement risk,” which is the risk that only one party to an agreed-upon financial exchange will satisfy its obligation. In part one of the *Alice/Mayo* test, the Court determined that the claims were directed to the abstract idea of mitigating settlement risk. *Alice*

*Corp.*, 573 U.S. at 221, 110 USPQ2d at 1982. The Court then walked through part two of the *Alice/Mayo* test, in which:

- The Court identified the additional elements in the claim, *e.g.*, by noting that the method claims recited steps of using a computer to “create electronic records, track multiple transactions, and issue simultaneous instructions”, and that the product claims recited hardware such as a “data processing system” with a “communications controller” and a “data storage unit” (573 U.S. at 224-26, 110 USPQ2d at 1984-85);

- The Court considered the additional elements individually, noting that all the computer functions were “‘well-understood, routine, conventional activit[ies]’ previously known to the industry,” each step “does no more than require a generic computer to perform generic computer functions”, and the recited hardware was “purely functional and generic” (573 U.S. at 225-26, 110 USPQ2d at 1984-85); and

- The Court considered the additional elements “as an ordered combination,” and determined that “the computer components ... ‘[a]dd nothing ... that is not already present when the steps are considered separately’” and simply recite intermediated settlement as performed by a generic computer.” 573 U.S. at 225 (citing *Mayo*, 566 U.S. at 79, 101 USPQ2d at 1972).

Based on this analysis, the Court concluded that the claims amounted to “‘nothing significantly more’ than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer”, and therefore held the claims ineligible because they were directed to a judicial exception and failed the second part of the *Alice/Mayo* test. *Alice Corp.*, 573 U.S. at 225-27, 110 USPQ2d at 1984.

*BASCOM* provides another example of how courts conduct the significantly more analysis, and of the critical importance of considering the additional elements in combination. In this case, the Federal Circuit vacated a judgment of ineligibility because the district court failed to properly perform the second step of the *Alice/Mayo* test when analyzing a claimed system for filtering content retrieved from an Internet computer network. *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 119



USPQ2d 1236 (Fed. Cir. 2016). The Federal Circuit agreed with the district court that the claims were directed to the abstract idea of filtering Internet content, and then walked through the district court’s analysis in part two of the *Alice/Mayo* test, noting that:

- The district court properly identified the additional elements in the claims, such as a “local client computer,” “remote ISP server,” “Internet computer network,” and “controlled access network accounts” (827 F.3d at 1349, 119 USPQ2d at 1242);
- The district court properly considered the additional elements individually, for example by consulting the specification, which described each of the additional elements as “well-known generic computer components” (827 F.3d at 1349, 119 USPQ2d at 1242); and
- The district court should have considered the additional elements in combination, because the “inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art” (827 F.3d at 1350, 119 USPQ2d at 1242).

Based on this analysis, the Federal Circuit concluded that the district court erred by failing to recognize that when combined, an inventive concept may be found in the non-conventional and non-generic arrangement of the additional elements, i.e., the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user. 827 F.3d at 1350, 119 USPQ2d at 1242.

## II. ELIGIBILITY STEP 2B: WHETHER THE ADDITIONAL ELEMENTS CONTRIBUTE AN “INVENTIVE CONCEPT”

As described in [MPEP § 2106](#), subsection III, Step 2B of the Office’s eligibility analysis is the second part of the *Alice/Mayo* test, i.e., the Supreme Court’s “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217, 110 USPQ2d 1976, 1981 (2014) (citing *Mayo*, 566 U.S. 66, 101 USPQ2d 1961 (2012)). Like the other steps in the eligibility analysis, evaluation of this step

should be made after determining what the inventor has invented by reviewing the entire application disclosure and construing the claims in accordance with their broadest reasonable interpretation. See [MPEP § 2106](#), subsection II for more information about the importance of understanding what has been invented, and [MPEP § 2111](#) for more information about the broadest reasonable interpretation.

Step 2B asks: Does the claim recite additional elements that amount to significantly more than the judicial exception? Examiners should answer this question by first identifying whether there are any additional elements (features/limitations/steps) recited in the claim beyond the judicial exception(s), and then evaluating those additional elements individually **and in combination** to determine whether they contribute an inventive concept (i.e., amount to significantly more than the judicial exception(s)).

This evaluation is made with respect to the considerations that the Supreme Court has identified as relevant to the eligibility analysis, which are introduced generally in Part I.A of this section, and discussed in detail in [MPEP § 2106.05\(a\) through \(h\)](#). Many of these considerations overlap, and often more than one consideration is relevant to analysis of an additional element. Not all considerations will be relevant to every element, or every claim. Because the evaluation in Step 2B is not a weighing test, it is not important how the elements are characterized or how many considerations apply from this list. It is important to evaluate the significance of the additional elements relative to the invention, and to keep in mind the ultimate question of whether the additional elements encompass an inventive concept.

Although the conclusion of whether a claim is eligible at Step 2B requires that all relevant considerations be evaluated, most of these considerations were already evaluated in Step 2A Prong Two. Thus, in Step 2B, examiners should:

- Carry over their identification of the additional element(s) in the claim from Step 2A Prong Two;
- Carry over their conclusions from Step 2A Prong Two on the considerations discussed in [MPEP §§ 2106.05\(a\) - \(c\), \(e\) \(f\) and \(h\)](#):

- Re-evaluate any additional element or combination of elements that was considered to be insignificant extra-solution activity per [MPEP § 2106.05\(g\)](#), because if such re-evaluation finds that the element is unconventional or otherwise more than what is well-understood, routine, conventional activity in the field, this finding may indicate that the additional element is no longer considered to be insignificant; and

- Evaluate whether any additional element or combination of elements are other than what is well-understood, routine, conventional activity in the field, or simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, per [MPEP § 2106.05\(d\)](#).

In the context of the flowchart in [MPEP § 2106](#), subsection III, Step 2B determines whether:

- The claim as a whole does not amount to significantly more than the exception itself (there is no inventive concept in the claim) (Step 2B: NO) and thus is not eligible, warranting a rejection for lack of subject matter eligibility and concluding the eligibility analysis; or

- The claim as a whole does amount to significantly more than the exception (there is an inventive concept in the claim) (Step 2B: YES), and thus is eligible at Pathway C, thereby concluding the eligibility analysis.

Examiners should examine each claim for eligibility separately, based on the particular elements recited therein. Claims should not be judged to automatically stand or fall with similar claims in an application. For instance, one claim may be ineligible because it is directed to a judicial exception without amounting to significantly more, but another claim dependent on the first may be eligible because it recites additional elements that do amount to significantly more.

For more information on how to evaluate claims reciting multiple judicial exceptions, see [MPEP § 2106.04](#), subsection II.B.

If the claim as a whole does recite significantly more than the exception itself, the claim is eligible (Step 2B: YES) at Pathway C, and the eligibility analysis

is complete. If there are no meaningful limitations in the claim that transform the exception into a patent-eligible application, such that the claim does not amount to significantly more than the exception itself, the claim is not patent-eligible (Step 2B: NO) and should be rejected under [35 U.S.C. 101](#). See [MPEP § 2106.07](#) for information on how to formulate an ineligibility rejection.

### **2106.05(a) Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field [R-07.2022]**

In determining patent eligibility, examiners should consider whether the claim “purport(s) to improve the functioning of the computer itself” or “any other technology or technical field.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 225, 110 USPQ2d 1976, 1984 (2014). This consideration has also been referred to as the search for a technological solution to a technological problem. See e.g., *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257, 113 USPQ2d 1097, 1105 (Fed. Cir. 2014); *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300-01, 120 USPQ2d 1527, 1537 (Fed. Cir. 2016).

While improvements were evaluated in *Alice Corp.* as relevant to the search for an inventive concept (Step 2B), several decisions of the Federal Circuit have also evaluated this consideration when determining whether a claim was directed to an abstract idea (Step 2A). See, e.g., *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36, 118 USPQ2d 1684, 1689 (Fed. Cir. 2016); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314-16, 120 USPQ2d 1091, 1102-03 (Fed. Cir. 2016); *Visual Memory, LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259-60, 123 USPQ2d 1712, 1717 (Fed. Cir. 2017). Thus, an examiner should evaluate whether a claim contains an improvement to the functioning of a computer or to any other technology or technical field at Step 2A Prong Two and Step 2B, as well as when considering whether the claim has such self-evident eligibility that it qualifies for the streamlined analysis. See [MPEP § 2106.04\(d\)\(1\)](#) for more information about evaluating improvements in Step 2A Prong Two, and [MPEP § 2106.07\(b\)](#) for more information about improvements in the streamlined analysis context.

If it is asserted that the invention improves upon conventional functioning of a computer, or upon conventional technology or technological processes, a technical explanation as to how to implement the invention should be present in the specification. That is, the disclosure must provide sufficient details such that one of ordinary skill in the art would recognize the claimed invention as providing an improvement. The specification need not explicitly set forth the improvement, but it must describe the invention such that the improvement would be apparent to one of ordinary skill in the art. Conversely, if the specification explicitly sets forth an improvement but in a conclusory manner (i.e., a bare assertion of an improvement without the detail necessary to be apparent to a person of ordinary skill in the art), the examiner should not determine the claim improves technology. An indication that the claimed invention provides an improvement can include a discussion in the specification that identifies a technical problem and explains the details of an unconventional technical solution expressed in the claim, or identifies technical improvements realized by the claim over the prior art. For example, in *McRO*, the court relied on the specification's explanation of how the particular rules recited in the claim enabled the automation of specific animation tasks that previously could only be performed subjectively by humans, when determining that the claims were directed to improvements in computer animation instead of an abstract idea. *McRO*, 837 F.3d at 1313-14, 120 USPQ2d at 1100-01. In contrast, the court in *Affinity Labs of Tex. v. DirecTV, LLC* relied on the specification's failure to provide details regarding the manner in which the invention accomplished the alleged improvement when holding the claimed methods of delivering broadcast content to cellphones ineligible. 838 F.3d 1253, 1263-64, 120 USPQ2d 1201, 1207-08 (Fed. Cir. 2016).

After the examiner has consulted the specification and determined that the disclosed invention improves technology, the claim must be evaluated to ensure the claim itself reflects the disclosed improvement in technology. *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1316, 120 USPQ2d 1353, 1359 (Fed. Cir. 2016) (patent owner argued that the claimed email filtering system improved technology by shrinking the protection gap and mooting the volume problem, but the court disagreed

because the claims themselves did not have any limitations that addressed these issues). That is, the claim must include the components or steps of the invention that provide the improvement described in the specification. However, the claim itself does not need to explicitly recite the improvement described in the specification (e.g., “thereby increasing the bandwidth of the channel”). The full scope of the claim under the BRI should be considered to determine if the claim reflects an improvement in technology (e.g., the improvement described in the specification). In making this determination, it is critical that examiners look at the claim “as a whole,” in other words, the claim should be evaluated “as an ordered combination, without ignoring the requirements of the individual steps.” When performing this evaluation, examiners should be “careful to avoid oversimplifying the claims” by looking at them generally and failing to account for the specific requirements of the claims. *McRO*, 837 F.3d at 1313, 120 USPQ2d at 1100.

An important consideration in determining whether a claim improves technology is the extent to which the claim covers a particular solution to a problem or a particular way to achieve a desired outcome, as opposed to merely claiming the idea of a solution or outcome. *McRO*, 837 F.3d at 1314-15, 120 USPQ2d at 1102-03; *DDR Holdings*, 773 F.3d at 1259, 113 USPQ2d at 1107. In this respect, the improvement consideration overlaps with other considerations, specifically the particular machine consideration (see [MPEP § 2106.05\(b\)](#)), and the mere instructions to apply an exception consideration (see [MPEP § 2106.05\(f\)](#)). Thus, evaluation of those other considerations may assist examiners in making a determination of whether a claim satisfies the improvement consideration.

It is important to note, the judicial exception alone cannot provide the improvement. The improvement can be provided by one or more additional elements. See the discussion of *Diamond v. Diehr*, 450 U.S. 175, 187 and 191-92, 209 USPQ 1, 10 (1981)) in subsection II, below. In addition, the improvement can be provided by the additional element(s) in combination with the recited judicial exception. See [MPEP § 2106.04\(d\)](#) (discussing *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303-04, 125 USPQ2d 1282, 1285-87 (Fed. Cir. 2018)). Thus, it

is important for examiners to analyze the claim as a whole when determining whether the claim provides an improvement to the functioning of computers or an improvement to other technology or technical field.

During examination, the examiner should analyze the “improvements” consideration by evaluating the specification and the claims to ensure that a technical explanation of the asserted improvement is present in the specification, and that the claim reflects the asserted improvement. Generally, examiners are not expected to make a qualitative judgement on the merits of the asserted improvement. If the examiner concludes the disclosed invention does not improve technology, the burden shifts to applicant to provide persuasive arguments supported by any necessary evidence to demonstrate that one of ordinary skill in the art would understand that the disclosed invention improves technology. Any such evidence submitted under [37 CFR 1.132](#) must establish what the specification would convey to one of ordinary skill in the art and cannot be used to supplement the specification. See, e.g. [MPEP § 716.09](#) on [37 CFR 1.132](#) practice with respect to rejections under [35 U.S.C. 112\(a\)](#). For example, in response to a rejection under [35 U.S.C. 101](#), an applicant could submit a declaration under [§ 1.132](#) providing testimony on how one of ordinary skill in the art would interpret the disclosed invention as improving technology and the underlying factual basis for that conclusion.

## I. IMPROVEMENTS TO COMPUTER FUNCTIONALITY

In computer-related technologies, the examiner should determine whether the claim purports to improve computer capabilities or, instead, invokes computers merely as a tool. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336, 118 USPQ2d 1684, 1689 (Fed. Cir. 2016). In *Enfish*, the court evaluated the patent eligibility of claims related to a self-referential database. *Id.* The court concluded the claims were not directed to an abstract idea, but rather an improvement to computer functionality. *Id.* It was the specification’s discussion of the prior art and how the invention improved the way the computer stores and retrieves data in memory in combination with the specific data structure recited

in the claims that demonstrated eligibility. 822 F.3d at 1339, 118 USPQ2d at 1691. The claim was not simply the addition of general purpose computers added post-hoc to an abstract idea, but a specific implementation of a solution to a problem in the software arts. 822 F.3d at 1339, 118 USPQ2d at 1691.

Examples that the courts have indicated may show an improvement in computer-functionality:

- i. A modification of conventional Internet hyperlink protocol to dynamically produce a dual-source hybrid webpage, *DDR Holdings*, 773 F.3d at 1258-59, 113 USPQ2d at 1106-07;
- ii. Inventive distribution of functionality within a network to filter Internet content, *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1350-51, 119 USPQ2d 1236, 1243 (Fed. Cir. 2016);
- iii. A method of rendering a halftone digital image, *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859, 868-69, 97 USPQ2d 1274, 1380 (Fed. Cir. 2010);
- iv. A distributed network architecture operating in an unconventional fashion to reduce network congestion while generating networking accounting data records, *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300-01, 120 USPQ2d 1527, 1536-37 (Fed. Cir. 2016);
- v. A memory system having programmable operational characteristics that are configurable based on the type of processor, which can be used with different types of processors without a tradeoff in processor performance, *Visual Memory, LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259-60, 123 USPQ2d 1712, 1717 (Fed. Cir. 2017);
- vi. Technical details as to how to transmit images over a cellular network or append classification information to digital image data, *TLI Communications LLC v. AV Auto. LLC*, 823 F.3d 607, 614-15, 118 USPQ2d 1744, 1749-50 (Fed. Cir. 2016) (holding the claims ineligible because they fail to provide requisite technical details necessary to carry out the function);
- vii. Particular structure of a server that stores organized digital images, *TLI Communications*, 823 F.3d at 612, 118 USPQ2d at 1747 (finding the use

of a generic server insufficient to add inventive concepts to an abstract idea);

viii. A particular way of programming or designing software to create menus, *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241, 120 USPQ2d 1844, 1854 (Fed. Cir. 2016);

ix. A method that generates a security profile that identifies both hostile and potentially hostile operations, and can protect the user against both previously unknown viruses and "obfuscated code," which is an improvement over traditional virus scanning. *Finjan Inc. v. Blue Coat Systems*, 879 F.3d 1299, 1304, 125 USPQ2d 1282, 1286 (Fed. Cir. 2018);

x. An improved user interface for electronic devices that displays an application summary of unlaunched applications, where the particular data in the summary is selectable by a user to launch the respective application. *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1362-63, 125 USPQ2d 1436, 1440-41 (Fed. Cir. 2018);

xi. Specific interface and implementation for navigating complex three-dimensional spreadsheets using techniques unique to computers; *Data Engine Techs., LLC v. Google LLC*, 906 F.3d 999, 1009, 128 USPQ2d 1381, 1387 (Fed. Cir. 2018); and

xii. A specific method of restricting software operation within a license, *Ancora Tech., Inc. v. HTC America, Inc.*, 908 F.3d 1343, 1345-46, 128 USPQ2d 1565, 1567 (Fed. Cir. 2018).

It is important to note that in order for a method claim to improve computer functionality, the broadest reasonable interpretation of the claim must be limited to computer implementation. That is, a claim whose entire scope can be performed mentally, cannot be said to improve computer technology. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 120 USPQ2d 1473 (Fed. Cir. 2016) (a method of translating a logic circuit into a hardware component description of a logic circuit was found to be ineligible because the method did not employ a computer and a skilled artisan could perform all the steps mentally). Similarly, a claimed process covering embodiments that can be performed on a computer, as well as embodiments that can be practiced verbally or with a telephone, cannot improve computer technology. See *RecogniCorp*,

*LLC v. Nintendo Co.*, 855 F.3d 1322, 1328, 122 USPQ2d 1377, 1381 (Fed. Cir. 2017) (process for encoding/decoding facial data using image codes assigned to particular facial features held ineligible because the process did not require a computer).

Examples that the courts have indicated may not be sufficient to show an improvement in computer-functionality:

i. Generating restaurant menus with functionally claimed features, *Ameranth*, 842 F.3d at 1245, 120 USPQ2d at 1857;

ii. Accelerating a process of analyzing audit log data when the increased speed comes solely from the capabilities of a general-purpose computer, *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1095, 120 USPQ2d 1293, 1296 (Fed. Cir. 2016);

iii. Mere automation of manual processes, such as using a generic computer to process an application for financing a purchase, *Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 1055, 123 USPQ2d 1100, 1108-09 (Fed. Cir. 2017) or speeding up a loan-application process by enabling borrowers to avoid physically going to or calling each lender and filling out a loan application, *LendingTree, LLC v. Zillow, Inc.*, 656 Fed. App'x 991, 996-97 (Fed. Cir. 2016) (non-precedential);

iv. Recording, transmitting, and archiving digital images by use of conventional or generic technology in a nascent but well-known environment, without any assertion that the invention reflects an inventive solution to any problem presented by combining a camera and a cellular telephone, *TLI Communications*, 823 F.3d at 611-12, 118 USPQ2d at 1747;

v. Affixing a barcode to a mail object in order to more reliably identify the sender and speed up mail processing, without any limitations specifying the technical details of the barcode or how it is generated or processed, *Secured Mail Solutions, LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 910-11, 124 USPQ2d 1502, 1505-06 (Fed. Cir. 2017);

vi. Instructions to display two sets of information on a computer display in a non-interfering manner, without any limitations specifying how to achieve the desired result, *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1344-45, 127 USPQ2d 1553, 1559-60 (Fed. Cir. 2018);



vii. Providing historical usage information to users while they are inputting data, in order to improve the quality and organization of information added to a database, because “an improvement to the information stored by a database is not equivalent to an improvement in the database’s functionality,” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1287-88, 127 USPQ2d 1688, 1693-94 (Fed. Cir. 2018); and

viii. Arranging transactional information on a graphical user interface in a manner that assists traders in processing information more quickly, *Trading Technologies v. IBG LLC*, 921 F.3d 1084, 1093-94, 2019 USPQ2d 138290 (Fed. Cir. 2019).

## II. IMPROVEMENTS TO ANY OTHER TECHNOLOGY OR TECHNICAL FIELD

The courts have also found that improvements in technology beyond computer functionality may demonstrate patent eligibility. In *McRO*, the Federal Circuit held claimed methods of automatic lip synchronization and facial expression animation using computer-implemented rules to be patent eligible under [35 U.S.C. 101](#), because they were not directed to an abstract idea. *McRO*, 837 F.3d at 1316, 120 USPQ2d at 1103. The basis for the *McRO* court’s decision was that the claims were directed to an improvement in computer animation and thus did not recite a concept similar to previously identified abstract ideas. *Id.* The court relied on the specification’s explanation of how the claimed rules enabled the automation of specific animation tasks that previously could not be automated. 837 F.3d at 1313, 120 USPQ2d at 1101. The *McRO* court indicated that it was the incorporation of the particular claimed rules in computer animation that “improved [the] existing technological process”, unlike cases such as *Alice* where a computer was merely used as a tool to perform an existing process. 837 F.3d at 1314, 120 USPQ2d at 1102. The *McRO* court also noted that the claims at issue described a specific way (use of particular rules to set morph weights and transitions through phonemes) to solve the problem of producing accurate and realistic lip synchronization and facial expressions in animated characters, rather than merely claiming the idea of a solution or outcome, and thus were not directed to an abstract idea. 837 F.3d at 1313, 120 USPQ2d at 1101.

Consideration of improvements is relevant to the eligibility analysis regardless of the technology of the claimed invention. That is, the consideration applies equally whether it is a computer-implemented invention, an invention in the life sciences, or any other technology. See, e.g., *Rapid Litigation Management v. CellzDirect, Inc.*, 827 F.3d 1042, 119 USPQ2d 1370 (Fed. Cir. 2016), in which the court noted that a claimed process for preserving hepatocytes could be eligible as an improvement to technology because the claim achieved a new and improved way for preserving hepatocyte cells for later use, even though the claim is based on the discovery of something natural. Notably, the court did not distinguish between the types of technology when determining the invention improved technology. However, it is important to keep in mind that an improvement in the abstract idea itself (e.g. a recited fundamental economic concept) is not an improvement in technology. For example, in *Trading Technologies Int’l v. IBG*, 921 F.3d 1084, 1093-94, 2019 USPQ2d 138290 (Fed. Cir. 2019), the court determined that the claimed user interface simply provided a trader with more information to facilitate market trades, which improved the business process of market trading but did not improve computers or technology.

Examples that the courts have indicated may be sufficient to show an improvement in existing technology include:

- i. Particular computerized method of operating a rubber molding press, e.g., a modification of conventional rubber-molding processes to utilize a thermocouple inside the mold to constantly monitor the temperature and thus reduce under- and over-curing problems common in the art, *Diamond v. Diehr*, 450 U.S. 175, 187 and 191-92, 209 USPQ 1, 8 and 10 (1981);
- ii. New telephone, server, or combination thereof, *TLI Communications LLC v. AVAuto, LLC*, 823 F.3d 607, 612, 118 USPQ2d 1744, 1747 (Fed. Cir. 2016);
- iii. An advance in the process of downloading content for streaming, *Affinity Labs of Tex. v. DirecTV, LLC*, 838 F.3d 1253, 1256, 120 USPQ2d 1201, 1202 (Fed. Cir. 2016);
- iv. Improved, particular method of digital data compression, *DDR Holdings, LLC v. Hotels.com*,



*L.P.*, 773 F.3d 1245, 1259, 113 USPQ2d 1097, 1107 (Fed. Cir. 2014); *Intellectual Ventures I v. Symantec Corp.*, 838 F.3d 1307, 1315, 120 USPQ2d 1353, 1358 (Fed. Cir. 2016);

v. Particular method of incorporating virus screening into the Internet, *Symantec Corp.*, 838 F.3d at 1321-22, 120 USPQ2d at 1362-63;

vi. Components or methods, such as measurement devices or techniques, that generate new data, *Electric Power Group, LLC v. Alstom, S.A.*, 830 F.3d 1350, 1355, 119 USPQ2d 1739, 1742 (Fed. Cir. 2016);

vii. Particular configuration of inertial sensors and a particular method of using the raw data from the sensors, *Thales Visionix, Inc. v. United States*, 850 F.3d 1343, 1348-49, 121 USPQ2d 1898, 1902 (Fed. Cir. 2017);

viii. A specific, structured graphical user interface that improves the accuracy of trader transactions by displaying bid and asked prices in a particular manner that prevents order entry at a changed price, *Trading Techs. Int'l, Inc. v. CQG, Inc.*, 675 Fed. App'x 1001 (Fed. Cir. 2017) (non-precedential); and

ix. Improved process for preserving hepatocytes for later use, *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050, 119 USPQ2d 1370, 1375 (Fed. Cir. 2016).

To show that the involvement of a computer assists in improving the technology, the claims must recite the details regarding how a computer aids the method, the extent to which the computer aids the method, or the significance of a computer to the performance of the method. Merely adding generic computer components to perform the method is not sufficient. Thus, the claim must include more than mere instructions to perform the method on a generic component or machinery to qualify as an improvement to an existing technology. See [MPEP § 2106.05\(f\)](#) for more information about mere instructions to apply an exception.

Examples that the courts have indicated may not be sufficient to show an improvement to technology include:

i. A commonplace business method being applied on a general purpose computer, *Alice Corp.*,

573 U.S. at 223, 110 USPQ2d at 1976; *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334, 115 USPQ2d 1681, 1701 (Fed. Cir. 2015);

ii. Using well-known standard laboratory techniques to detect enzyme levels in a bodily sample such as blood or plasma, *Cleveland Clinic Foundation v. True Health Diagnostics, LLC*, 859 F.3d 1352, 1355, 1362, 123 USPQ2d 1081, 1082-83, 1088 (Fed. Cir. 2017);

iii. Gathering and analyzing information using conventional techniques and displaying the result, *TLI Communications*, 823 F.3d at 612-13, 118 USPQ2d at 1747-48;

iv. Delivering broadcast content to a portable electronic device such as a cellular telephone, when claimed at a high level of generality, *Affinity Labs of Tex. v. Amazon.com*, 838 F.3d 1266, 1270, 120 USPQ2d 1210, 1213 (Fed. Cir. 2016); *Affinity Labs of Tex. v. DirecTV, LLC*, 838 F.3d 1253, 1262, 120 USPQ2d 1201, 1207 (Fed. Cir. 2016);

v. A general method of screening emails on a generic computer, *Symantec*, 838 F.3d at 1315-16, 120 USPQ2d at 1358-59;

vi. An advance in the informational content of a download for streaming, *Affinity Labs of Tex. v. DirecTV, LLC*, 838 F.3d 1253, 1263, 120 USPQ2d 1201, 1208 (Fed. Cir. 2016); and

vii. Selecting one type of content (e.g., FM radio content) from within a range of existing broadcast content types, or selecting a particular generic function for computer hardware to perform (e.g., buffering content) from within a range of well-known, routine, conventional functions performed by the hardware, *Affinity Labs of Tex. v. DirecTV, LLC*, 838 F.3d 1253, 1264, 120 USPQ2d 1201, 1208 (Fed. Cir. 2016).

### **2106.05(b) Particular Machine [R-07.2022]**

When determining whether a claim integrates a judicial exception, into a practical application in Step 2A Prong Two and whether a claim recites significantly more than a judicial exception in Step 2B, examiners should consider whether the judicial exception is applied with, or by use of, a particular machine. "The machine-or-transformation test is a useful and important clue, and investigative tool" for determining whether a claim is patent eligible

under [§ 101](#). *Bilski v. Kappos*, 561 U.S. 593, 604, 95 USPQ2d 1001, 1007 (2010).

It is noted that while the application of a judicial exception by or with a particular machine is an important clue, it is not a stand-alone test for eligibility. *Id.*

All claims must be evaluated for eligibility using the two-part test from *Alice/Mayo*. If a claim passes the *Alice/Mayo* test (*i.e.*, is not directed to an exception at Step 2A, or amounts to significantly more than any recited exception in Step 2B), then the claim is eligible even if it fails the machine-or-transformation test ("M-or-T test"). *Bilski v. Kappos*, 561 U.S. 593, 604, 95 USPQ2d 1001, 1007 (2010) (explaining that a claim may be eligible even if it does not satisfy the M-or-T test); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102 (Fed. Cir. 2016) (“[T]here is nothing that requires a method ‘be tied to a machine or transform an article’ to be patentable”). And if a claim fails the *Alice/Mayo* test (*i.e.*, is directed to an exception at Step 2A and does not amount to significantly more than the exception in Step 2B), then the claim is ineligible even if it passes the M-or-T test. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256, 113 USPQ2d 1097, 1104 (Fed. Cir. 2014) (“[I]n *Mayo*, the Supreme Court emphasized that satisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an ‘inventive concept.’”).

Examiners may find it helpful to evaluate other considerations such as the mere instructions to apply an exception consideration (see [MPEP § 2106.05\(f\)](#)), the insignificant extra-solution activity consideration (see [MPEP § 2106.05\(g\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)), when making a determination of whether an element (or combination of elements) is a particular machine. For information on the definition of the term “machine,” see [MPEP § 2106.03](#).

When determining whether a machine recited in a claim provides significantly more, the following factors are relevant.

## I. THE PARTICULARITY OR GENERALITY OF THE ELEMENTS OF THE MACHINE OR APPARATUS

The particularity or generality of the elements of the machine or apparatus, *i.e.*, the degree to which the machine in the claim can be specifically identified (not any and all machines). One example of applying a judicial exception with a particular machine is *Mackay Radio & Tel. Co. v. Radio Corp. of America*, 306 U.S. 86, 40 USPQ 199 (1939). In this case, a mathematical formula was employed to use standing wave phenomena in an antenna system. The claim recited the particular type of antenna and included details as to the shape of the antenna and the conductors, particularly the length and angle at which they were arranged. 306 U.S. at 95-96; 40 USPQ at 203. Another example is *Eibel Process*, in which gravity (a law of nature or natural phenomenon) was applied by a Fourdrinier machine (which was understood in the art to have a specific structure comprising a headbox, a paper-making wire, and a series of rolls) arranged in a particular way to optimize the speed of the machine while maintaining quality of the formed paper web. *Eibel Process Co. v. Minn. & Ont. Paper Co.*, 261 U.S. 45, 64-65 (1923).

It is important to note that a general purpose computer that applies a judicial exception, such as an abstract idea, by use of conventional computer functions does not qualify as a particular machine.

*Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716-17, 112 USPQ2d 1750, 1755-56 (Fed. Cir. 2014). See also *TLI Communications LLC v. AV Automotive LLC*, 823 F.3d 607, 613, 118 USPQ2d 1744, 1748 (Fed. Cir. 2016) (mere recitation of concrete or tangible components is not an inventive concept); *Eon Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623, 114 USPQ2d 1711, 1715 (Fed. Cir. 2015) (noting that *Alappat*’s rationale that an otherwise ineligible algorithm or software could be made patent-eligible by merely adding a generic computer to the claim was superseded by the Supreme Court’s *Bilski* and *Alice Corp.* decisions). If applicant amends a claim to add a generic computer or generic computer components and asserts that the claim recites significantly more because the generic computer is ‘specially programmed’ (as in *Alappat*, now considered

superseded) or is a 'particular machine' (as in *Bilski*), the examiner should look at whether the added elements integrate the exception into a practical application or provide significantly more than the judicial exception. Merely adding a generic computer, generic computer components, or a programmed computer to perform generic computer functions does not automatically overcome an eligibility rejection. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 223-24, 110 USPQ2d 1976, 1983-84 (2014). See *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994); *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)

## II. WHETHER THE MACHINE OR APPARATUS IMPLEMENTS THE STEPS OF THE METHOD

Integral use of a machine to achieve performance of a method may integrate the recited judicial exception into a practical application or provide significantly more, in contrast to where the machine is merely an object on which the method operates, which does not integrate the exception into a practical application or provide significantly more. See *CyberSource v. Retail Decisions*, 654 F.3d 1366, 1370, 99 USPQ2d 1690, 1694 (Fed. Cir. 2011) ("We are not persuaded by the appellant's argument that the claimed method is tied to a particular machine because it 'would not be necessary or possible without the Internet.' . . . Regardless of whether "the Internet" can be viewed as a machine, it is clear that the Internet cannot perform the fraud detection steps of the claimed method"). For example, as described in [MPEP § 2106.05\(f\)](#), additional elements that invoke computers or other machinery merely as a tool to perform an existing process will generally not amount to significantly more than a judicial exception. See, e.g., *Versata Development Group v. SAP America*, 793 F.3d 1306, 1335, 115 USPQ2d 1681, 1702 (Fed. Cir. 2015) (explaining that in order for a machine to add significantly more, it must "play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly").

## III. WHETHER ITS INVOLVEMENT IS EXTRA-SOLUTION ACTIVITY OR A FIELD-OF-USE

Whether its involvement is extra-solution activity or a field-of-use, *i.e.*, the extent to which (or how) the machine or apparatus imposes meaningful limits on the claim. Use of a machine that contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation) would not integrate a judicial exception or provide significantly more. See *Bilski*, 561 U.S. at 610, 95 USPQ2d at 1009 (citing *Parker v. Flook*, 437 U.S. 584, 590, 198 USPQ 193, 197 (1978)), and *CyberSource v. Retail Decisions*, 654 F.3d 1366, 1370, 99 USPQ2d 1690 (Fed. Cir. 2011) (citations omitted) ("[N]othing in claim 3 requires an infringer to use the Internet to obtain that data. The Internet is merely described as the source of the data. We have held that mere '[data-gathering] step[s]' cannot make an otherwise nonstatutory claim statutory.'" 654 F.3d at 1375, 99 USPQ2d at 1694 (citation omitted)). See [MPEP § 2106.05\(g\) & \(h\)](#) for more information on insignificant extra-solution activity and field of use, respectively.

### 2106.05(c) Particular Transformation [R-07.2022]

Another consideration when determining whether a claim integrates a judicial exception into a practical application in Step 2A Prong Two and whether a claim recites significantly more in Step 2B is whether the claim effects a transformation or reduction of a particular article to a different state or thing. "[T]ransformation and reduction of an article 'to a different state or thing' is the clue to patentability of a process claim that does not include particular machines." *Bilski v. Kappos*, 561 U.S. 593, 658, 95 USPQ2d 1001, 1007 (2010) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 USPQ 673, 676 (1972)). If such a transformation exists, the claims are likely to be significantly more than any recited judicial exception or to integrate any recited judicial exception into a practical application.

It is noted that while the transformation of an article is an important clue, it is not a stand-alone test for eligibility. *Id.*

All claims must be evaluated for eligibility using the two-part test from *Alice/Mayo*. If a claim passes the *Alice/Mayo* test (*i.e.*, is not directed to an exception at Step 2A, or amounts to significantly more than any recited exception in Step 2B), then the claim is eligible even if it “fails” the M-or-T test. *Bilski v. Kappos*, 561 U.S. 593, 604, 95 USPQ2d 1001, 1007 (2010) (explaining that a claim may be eligible even if it does not satisfy the M-or-T test); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1315, 120 USPQ2d 1091, 1102 (Fed. Cir. 2016) (“[T]here is nothing that requires a method ‘be tied to a machine or transform an article’ to be patentable”). And if a claim fails the *Alice/Mayo* test (*i.e.*, is directed to an exception at Step 2A and does not amount to significantly more than the exception in Step 2B), then the claim is ineligible even if it passes the M-or-T test. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256, 113 USPQ2d 1097, 1104 (Fed. Cir. 2014) (“[I]n *Mayo*, the Supreme Court emphasized that satisfying the machine-or-transformation test, by itself, is not sufficient to render a claim patent-eligible, as not all transformations or machine implementations infuse an otherwise ineligible claim with an “inventive concept.”).

Examiners may find it helpful to evaluate other considerations such as the mere instructions to apply an exception consideration (see [MPEP § 2106.05\(f\)](#)), the insignificant extra-solution activity consideration (see [MPEP § 2106.05\(g\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)), when making a determination of whether a claim satisfies the particular transformation consideration.

An “article” includes a physical object or substance. The physical object or substance must be particular, meaning it can be specifically identified. “Transformation” of an article means that the “article” has changed to a different state or thing. Changing to a different state or thing usually means more than simply using an article or changing the location of an article. A new or different function or use can be evidence that an article has been transformed. Purely mental processes in which thoughts or human based actions are “changed” are not considered an eligible transformation. For data, mere “manipulation of basic mathematical constructs

[*i.e.*,] the paradigmatic ‘abstract idea,’” has not been deemed a transformation. *CyberSource v. Retail Decisions*, 654 F.3d 1366, 1372 n.2, 99 USPQ2d 1690, 1695 n.2 (Fed. Cir. 2011) (quoting *In re Warmerdam*, 33 F.3d 1354, 1355, 1360, 31 USPQ2d 1754, 1755, 1759 (Fed. Cir. 1994)).

*Tilghman v. Proctor*, 102 U.S. 707 (1881), provides an example of effecting a transformation of a particular article to a different state or thing. In that case, the claim was directed to a process of subjecting a mixture of fat and water to a high degree of heat and included additional parameters relating to the level of heat, the quantities of fat and water, and the strength of the mixing vessel. The claimed process, which used the natural principle that the elements of neutral fat require that they be severally united with an atomic equivalent of water in order to separate and become free, resulted in the transformation of the fatty bodies into fat acids and glycerine. *Id. at 729*.

Where a transformation is recited in a claim, the following factors are relevant to the analysis:

1. **The particularity or generality of the transformation.** According to the Supreme Court, inventions comprising processes of “‘tanning, dyeing, making waterproof cloth, vulcanizing India rubber [or] smelting ores’ . . . are instances . . . where the use of chemical substances or physical acts, such as temperature control, changes articles or materials [in such a manner that is] sufficiently definite to confine the patent monopoly within rather definite bounds.” *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 USPQ 673, 676 (1972) (discussing *Corning v. Burden*, 15 How. (56 U.S.) 252, 267-68 (1854)). Therefore, a more particular transformation would likely provide significantly more.

2. **The degree to which the recited article is particular.** A transformation applied to a generically recited article or to any and all articles would likely not provide significantly more than the judicial exception. A transformation that can be specifically identified, or that applies to only particular articles, is more likely to provide significantly more (or integrates a judicial exception into a practical application).

3. **The nature of the transformation in terms of the type or extent of change in state or thing.**



A transformation resulting in the transformed article having a different function or use, would likely provide significantly more, but a transformation resulting in the transformed article merely having a different location, would likely not provide significantly more (or integrate a judicial exception into a practical application). For example, a process that transforms raw, uncured synthetic rubber into precision-molded synthetic rubber products, as discussed in *Diamond v. Diehr*, 450 U.S. 175, 184, 209 USPQ 1, 21 (1981)), provides significantly more (or integrate a judicial exception into a practical application).

#### 4. The nature of the article transformed.

Transformation of a physical or tangible object or substance is more likely to provide significantly more (or integrate a judicial exception into a practical application) than the transformation of an intangible concept such as a contractual obligation or mental judgment.

5. **Whether the transformation is extra-solution activity or a field-of-use (i.e., the extent to which (or how) the transformation imposes meaningful limits on the execution of the claimed method steps).** A transformation that contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation) would not provide significantly more (or integrate a judicial exception into a practical application). For example, in *Mayo* the Supreme Court found claims regarding calibrating the proper dosage of thiopurine drugs to be patent ineligible subject matter. The Federal Circuit had held that the step of administering the thiopurine drug demonstrated a transformation of the human body and blood. *Mayo*, 566 U.S. at 76, 101 USPQ2d at 1967. The Supreme Court disagreed, finding that this step was only a field-of-use limitation and did not provide significantly more than the judicial exception. *Id.* See [MPEP § 2106.05\(g\) & \(h\)](#) for more information on insignificant extra-solution activity and field of use, respectively.

### **2106.05(d) Well-Understood, Routine, Conventional Activity [R-07.2022]**

Another consideration when determining whether a claim recites significantly more than a judicial exception is whether the additional element(s) are

well-understood, routine, conventional activities previously known to the industry. This consideration is only evaluated in Step 2B of the eligibility analysis.

If the additional element (or combination of elements) is a specific limitation other than what is well-understood, routine and conventional in the field, for instance because it is an unconventional step that confines the claim to a particular useful application of the judicial exception, then this consideration favors eligibility. If, however, the additional element (or combination of elements) is no more than well-understood, routine, conventional activities previously known to the industry, which is recited at a high level of generality, then this consideration does not favor eligibility.

*DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 113 USPQ2d 1097 (Fed. Cir. 2014), provides an example of additional elements that favored eligibility because they were more than well-understood, routine conventional activities in the field. The claims in *DDR Holdings* were directed to systems and methods of generating a composite webpage that combines certain visual elements of a host website with the content of a third-party merchant. 773 F.3d at 1248, 113 USPQ2d at 1099. The court found that the claim had additional elements that amounted to significantly more than the abstract idea, because they modified conventional Internet hyperlink protocol to dynamically produce a dual-source hybrid webpage, which differed from the conventional operation of Internet hyperlink protocol that transported the user away from the host's webpage to the third party's webpage when the hyperlink was activated. 773 F.3d at 1258-59, 113 USPQ2d at 1106-07. Thus, the claims in *DDR Holdings* were eligible.

On the other hand, *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 67, 101 USPQ2d 1961, 1964 (2010) provides an example of additional elements that were not an inventive concept because they were merely well-understood, routine, conventional activity previously known to the industry, which were not by themselves sufficient to transform a judicial exception into a patent eligible invention. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79-80, 101 USPQ2d 1969



(2012) (citing *Parker v. Flook*, 437 U.S. 584, 590, 198 USPQ 193, 199 (1978) (the additional elements were “well known” and, thus, did not amount to a patentable application of the mathematical formula)). In *Mayo*, the claims at issue recited naturally occurring correlations (the relationships between the concentration in the blood of certain thiopurine metabolites and the likelihood that a drug dosage will be ineffective or induce harmful side effects) along with additional elements including telling a doctor to measure thiopurine metabolite levels in the blood using any known process. 566 U.S. at 77-79, 101 USPQ2d at 1967-68. The Court found this additional step of measuring metabolite levels to be well-understood, routine, conventional activity already engaged in by the scientific community because scientists “routinely measured metabolites as part of their investigations into the relationships between metabolite levels and efficacy and toxicity of thiopurine compounds.” 566 U.S. at 79, 101 USPQ2d at 1968. Even when considered in combination with the other additional elements, the step of measuring metabolite levels did not amount to an inventive concept, and thus the claims in *Mayo* were not eligible. 566 U.S. at 79-80, 101 USPQ2d at 1968-69.

### **I. EVALUATING WHETHER THE ADDITIONAL ELEMENTS ARE WELL-UNDERSTOOD, ROUTINE, CONVENTIONAL ACTIVITY**

When making a determination whether the additional elements in a claim amount to significantly more than a judicial exception, the examiner should evaluate whether the elements define only well-understood, routine, conventional activity. In this respect, the well-understood, routine, conventional consideration overlaps with other Step 2B considerations, particularly the improvement consideration (see [MPEP § 2106.05\(a\)](#)), the mere instructions to apply an exception consideration (see [MPEP § 2106.05\(f\)](#)), and the insignificant extra-solution activity consideration (see [MPEP § 2106.05\(g\)](#)). Thus, evaluation of those other considerations may assist examiners in making a determination of whether a particular element or combination of elements is well-understood, routine, conventional activity.

In addition, examiners should keep in mind the following points when determining whether additional elements define only well-understood, routine, conventional activity.

1. **An additional element (or combination of additional elements) that is known in the art can still be unconventional or non-routine.** The question of whether a particular claimed invention is novel or obvious is “fully apart” from the question of whether it is eligible. *Diamond v. Diehr*, 450 U.S. 175, 190, 209 USPQ 1, 9 (1981). For example, claims may exhibit an improvement over conventional computer functionality even if the improvement lacks novelty over the prior art. Compare, e.g., *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 118 USPQ2d 1684 (Fed. Cir. 2016) (holding several claims from U.S. Patent Nos. 6,151,604 and 6,163,775 eligible) with *Microsoft Corp. v. Enfish, LLC*, 662 Fed. App'x 981 (Fed. Cir. 2016) (holding some of the same claims to be anticipated by prior art). The eligible claims in *Enfish* recited a self-referential database having two key features: all entity types can be stored in a single table; and the table rows can contain information defining the table columns. *Enfish*, 822 F.3d at 1332, 118 USPQ2d at 1687. Although these features were taught by a single prior art reference (thus anticipating the claims), *Microsoft Corp.*, 662 Fed. App'x at 986, the features were not conventional and thus were considered to reflect an improvement to existing technology. In particular, they enabled the claimed table to achieve benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements. *Enfish*, 822 F.3d at 1337, 118 USPQ2d at 1690.

2. **A factual determination is required to support a conclusion that an additional element (or combination of additional elements) is well-understood, routine, conventional activity.** *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1368, 125 USPQ2d 1649, 1654 (Fed. Cir. 2018). However, this does not mean that a prior art search is necessary to resolve this inquiry. Instead, examiners should rely on what the courts have recognized, or those in the art would recognize, as elements that are well-understood, routine, conventional activity in the relevant field when making the required determination. For example, in many instances, the specification of the application

may indicate that additional elements are well-known or conventional. See, e.g., *Intellectual Ventures v. Symantec*, 838 F.3d 1307, 1317; 120 USPQ2d 1353, 1359 (Fed. Cir. 2016) (“The written description is particularly useful in determining what is well-known or conventional”); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348, 115 USPQ2d 1414, 1418 (Fed. Cir. 2015) (relying on specification’s description of additional elements as “well-known”, “common” and “conventional”); *TLI Communications LLC v. AV Auto. LLC*, 823 F.3d 607, 614, 118 USPQ2d 1744, 1748 (Fed. Cir. 2016) (Specification described additional elements as “either performing basic computer functions such as sending and receiving data, or performing functions ‘known’ in the art.”). As such, an examiner should determine that an element (or combination of elements) is well-understood, routine, conventional activity only when the examiner can readily conclude, based on their expertise in the art, that the element is widely prevalent or in common use in the relevant industry. The analysis as to whether an element (or combination of elements) is widely prevalent or in common use is the same as the analysis under [35 U.S.C. 112\(a\)](#) as to whether an element is so well-known that it need not be described in detail in the patent specification. See *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1377, 118 USPQ2d 1541, 1546 (Fed. Cir. 2016) (supporting the position that amplification was well-understood, routine, conventional for purposes of subject matter eligibility by observing that the patentee expressly argued during prosecution of the application that amplification was a technique readily practiced by those skilled in the art to overcome the rejection of the claim under [35 U.S.C. 112](#), first paragraph); see also *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (“[T]he specification need not disclose what is well known in the art.”); *In re Myers*, 410 F.2d 420, 424, 161 USPQ 668, 671 (CCPA 1969) (“A specification is directed to those skilled in the art and need not teach or point out in detail that which is well-known in the art.”); *Exergen Corp.*, 725 Fed. App’x 959, 965 (Fed. Cir. 2018) (holding that “[l]ike indefiniteness, enablement, or obviousness, whether a claim is directed to patent eligible subject matter is a question of law based on underlying facts,” and noting that the Supreme Court has recognized that “the inquiry ‘might sometimes overlap’ with other fact-intensive

inquiries like novelty under [35 U.S.C. § 102](#)”). If the element is not widely prevalent or in common use, or is otherwise beyond those elements recognized in the art or by the courts as being well-understood, routine or conventional, then the element will in most cases favor eligibility. For example, even if a particular technique (e.g., measuring blood glucose via an earring worn by a person with diabetes) would have been obvious to one of ordinary skill in the art because it was discussed in several widely-read scientific journals or used by a few scientists, mere knowledge of the particular technique or use of the particular technique by a few scientists is not necessarily sufficient to make the use of the particular technique routine or conventional in the relevant field. The examiner in this situation would already know, based on the examiner’s expertise in the field, that blood glucose is routinely and conventionally monitored by other techniques (e.g., via placing a small droplet of blood on a diagnostic test strip, or via an implanted insulin pump with a glucose sensor). Thus, the examiner would not need to perform a prior art search in order to determine that the particular claimed technique using the glucose-sensing earring was not well-understood, routine, conventional activity previously engaged in by scientists in the field. The required factual determination must be expressly supported in writing, as discussed in [MPEP § 2106.07\(a\)](#). Appropriate forms of support include one or more of the following: (a) A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s); (b) A citation to one or more of the court decisions discussed in Subsection II below as noting the well-understood, routine, conventional nature of the additional element(s); (c) A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s); and (d) A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). For more information on supporting a conclusion that an additional element (or combination of additional elements) is well-understood, routine, conventional activity, see [MPEP § 2106.07\(a\)](#), subsection III.

**3. Even if one or more additional elements are well-understood, routine, conventional activity when considered individually, the**

**combination of additional elements may amount to an inventive concept.** *Diamond v. Diehr*, 450 U.S. at 188, 209 USPQ at 9 (1981) (“[A] new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.”). For example, a microprocessor that performs mathematical calculations and a clock that produces time data may individually be generic computer components that perform merely generic computer functions, but when combined may perform functions that are not generic computer functions and thus be an inventive concept. See, e.g. *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1051, 119 USPQ2d 1370, 1375 (Fed. Cir. 2016) (holding that while the additional steps of freezing and thawing hepatocytes were well known, repeating those steps, contrary to what was taught in the art, was not routine or conventional). For example, in *BASCOM*, even though the court found that all of the additional elements in the claim recited generic computer network or Internet components, the elements in combination amounted to significantly more because of the non-conventional and non-generic arrangement that provided a technical improvement in the art.

*BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350-51, 119 USPQ2d 1236, 1243-44 (2016).

A rejection should only be made if an examiner relying on the examiner's expertise in the art can conclude in the Step 2B inquiry that the additional elements do not amount to significantly more (Step 2B: NO). If the elements or functions are beyond those recognized in the art or by the courts as being well understood, routine, conventional activity, then the elements or functions will in most cases amount to significantly more (Step 2B: YES). For more information on formulating a subject matter eligibility rejection involving well-understood, routine, conventional activity, see [MPEP § 2106.07\(a\)](#).

## II. ELEMENTS THAT THE COURTS HAVE RECOGNIZED AS WELL-UNDERSTOOD, ROUTINE, CONVENTIONAL ACTIVITY IN PARTICULAR FIELDS

Because examiners should rely on what the courts have recognized, or those of ordinary skill in the art

would recognize, as elements that describe well understood, routine activities, the following section provides examples of elements that have been recognized by the courts as well-understood, routine, conventional activity in particular fields. It should be noted, however, that many of these examples failed to satisfy other considerations (e.g., because they were recited at a high level of generality and thus were mere instructions to apply an exception, or were insignificant extra-solution activity). Thus, examiners should carefully analyze additional elements in a claim with respect to all relevant Step 2B considerations, including this consideration, before making a conclusion as to whether they amount to an inventive concept.

The courts have recognized the following computer functions as well understood, routine, and conventional functions when they are claimed in a merely generic manner (e.g., at a high level of generality) or as insignificant extra-solution activity.

i. Receiving or transmitting data over a network, e.g., using the Internet to gather data, *Symantec*, 838 F.3d at 1321, 120 USPQ2d at 1362 (utilizing an intermediary computer to forward information); *TLI Communications LLC v. AV Auto. LLC*, 823 F.3d 607, 610, 118 USPQ2d 1744, 1745 (Fed. Cir. 2016) (using a telephone for image transmission); *OIP Techs., Inc., v. Amazon.com, Inc.*, 788 F.3d 1359, 1363, 115 USPQ2d 1090, 1093 (Fed. Cir. 2015) (sending messages over a network); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355, 112 USPQ2d 1093, 1096 (Fed. Cir. 2014) (computer receives and sends information over a network); but see *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258, 113 USPQ2d 1097, 1106 (Fed. Cir. 2014) (“Unlike the claims in *Ultramercial*, the claims at issue here specify **how** interactions with the Internet are manipulated to yield a desired result a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink.” (emphasis added));

ii. Performing repetitive calculations, *Flook*, 437 U.S. at 594, 198 USPQ2d at 199 (recomputing or readjusting alarm limit values); *Bancorp Services v. Sun Life*, 687 F.3d 1266, 1278, 103 USPQ2d 1425, 1433 (Fed. Cir. 2012) (“The computer required by some of *Bancorp*’s claims is employed only for its most basic function, the performance of repetitive

calculations, and as such does not impose meaningful limits on the scope of those claims.”);

iii. Electronic recordkeeping, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 225, 110 USPQ2d 1984 (2014) (creating and maintaining “shadow accounts”); *Ultramercial*, 772 F.3d at 716, 112 USPQ2d at 1755 (updating an activity log);

iv. Storing and retrieving information in memory, *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334, 115 USPQ2d 1681, 1701 (Fed. Cir. 2015); *OIP Techs.*, 788 F.3d at 1363, 115 USPQ2d at 1092-93;

v. Electronically scanning or extracting data from a physical document, *Content Extraction and Transmission, LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1348, 113 USPQ2d 1354, 1358 (Fed. Cir. 2014) (optical character recognition); and

vi. A Web browser’s back and forward button functionality, *Internet Patent Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348, 115 USPQ2d 1414, 1418 (Fed. Cir. 2015).

This listing is not meant to imply that all computer functions are well understood, routine, conventional activities, or that a claim reciting a generic computer component performing a generic computer function is necessarily ineligible. See e.g. *Amdocs (Israel), Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1316, 120 USPQ2d 1527, 1549 (Fed. Cir. 2016), *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348, 119 USPQ2d 1236, 1241 (Fed. Cir. 2016). Courts have held computer implemented processes not to be significantly more than an abstract idea (and thus ineligible) where the claim as a whole amounts to nothing more than generic computer functions merely used to implement an abstract idea, such as an idea that could be done by a human analog (i.e., by hand or by merely thinking). On the other hand, courts have held computer-implemented processes to be significantly more than an abstract idea (and thus eligible), where generic computer components are able in combination to perform functions that are not merely generic. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257-59, 113 USPQ2d 1097, 1105-07 (Fed. Cir. 2014).

The courts have recognized the following laboratory techniques as well-understood, routine, conventional

activity in the life science arts when they are claimed in a merely generic manner (e.g., at a high level of generality) or as insignificant extra-solution activity:

i. Determining the level of a biomarker in blood by any means, *Mayo*, 566 U.S. at 79, 101 USPQ2d at 1968; *Cleveland Clinic Foundation v. True Health Diagnostics, LLC*, 859 F.3d 1352, 1362, 123 USPQ2d 1081, 1088 (Fed. Cir. 2017);

ii. Using polymerase chain reaction to amplify and detect DNA, *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1376, 118 USPQ2d 1541, 1546 (Fed. Cir. 2016); *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1377, 115 USPQ2d 1152, 1157 (Fed. Cir. 2015);

iii. Detecting DNA or enzymes in a sample, *Sequenom*, 788 F.3d at 1377-78, 115 USPQ2d at 1157; *Cleveland Clinic Foundation* 859 F.3d at 1362, 123 USPQ2d at 1088 (Fed. Cir. 2017);

iv. Immunizing a patient against a disease, *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057, 1063, 100 USPQ2d 1492, 1497 (Fed. Cir. 2011);

v. Analyzing DNA to provide sequence information or detect allelic variants, *Genetic Techs. Ltd.*, 818 F.3d at 1377; 118 USPQ2d at 1546;

vi. Freezing and thawing cells, *Rapid Litig. Mgmt.* 827 F.3d at 1051, 119 USPQ2d at 1375;

vii. Amplifying and sequencing nucleic acid sequences, *University of Utah Research Foundation v. Ambry Genetics*, 774 F.3d 755, 764, 113 USPQ2d 1241, 1247 (Fed. Cir. 2014); and

viii. Hybridizing a gene probe, *Ambry Genetics*, 774 F.3d at 764, 113 USPQ2d at 1247.

Below are examples of other types of activity that the courts have found to be well-understood, routine, conventional activity when they are claimed in a merely generic manner (e.g., at a high level of generality) or as insignificant extra-solution activity:

i. Recording a customer’s order, *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1244, 120 USPQ2d 1844, 1856 (Fed. Cir. 2016);

ii. Shuffling and dealing a standard deck of cards, *In re Smith*, 815 F.3d 816, 819, 118 USPQ2d 1245, 1247 (Fed. Cir. 2016);



- iii. Restricting public access to media by requiring a consumer to view an advertisement, *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716-17, 112 USPQ2d 1750, 1755-56 (Fed. Cir. 2014);
- iv. Presenting offers and gathering statistics, *OIP Techs.*, 788 F.3d at 1362-63, 115 USPQ2d at 1092-93;
- v. Determining an estimated outcome and setting a price, *OIP Techs.*, 788 F.3d at 1362-63, 115 USPQ2d at 1092-93; and
- vi. Arranging a hierarchy of groups, sorting information, eliminating less restrictive pricing information and determining the price, *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1331, 115 USPQ2d 1681, 1699 (Fed. Cir. 2015).

### **2106.05(e) Other Meaningful Limitations [R-10.2019]**

The analysis of whether the claim includes other meaningful limitations may be relevant for both eligibility analysis Step 2A Prong Two, and Step 2B.

The claim should add meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment to transform the judicial exception into patent-eligible subject matter. The phrase “meaningful limitations” has been used by the courts even before *Alice* and *Mayo* in various contexts to describe additional elements that provide an inventive concept to the claim as a whole. The considerations described in [MPEP § 2106.05\(a\)-\(d\)](#) are meaningful limitations when they amount to significantly more than the judicial exception, or when they integrate a judicial exception into a practical application. This broad label signals that there can be other considerations besides those described in [MPEP § 2106.05\(a\)-\(d\)](#) that when added to a judicial exception amount to meaningful limitations that can transform a claim into patent-eligible subject matter.

*Diamond v. Diehr* provides an example of a claim that recited meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment. 450 U.S. 175, 209 USPQ 1 (1981). In *Diehr*, the claim was

directed to the use of the Arrhenius equation (an abstract idea or law of nature) in an automated process for operating a rubber-molding press. 450 U.S. at 177-78, 209 USPQ at 4. The Court evaluated additional elements such as the steps of installing rubber in a press, closing the mold, constantly measuring the temperature in the mold, and automatically opening the press at the proper time, and found them to be meaningful because they sufficiently limited the use of the mathematical equation to the practical application of molding rubber products. 450 U.S. at 184, 187, 209 USPQ at 7, 8. In contrast, the claims in *Alice Corp. v. CLS Bank International* did not meaningfully limit the abstract idea of mitigating settlement risk. 573 U.S. 208, 110 USPQ2d 1976 (2014). In particular, the Court concluded that the additional elements such as the data processing system and communications controllers recited in the system claims did not meaningfully limit the abstract idea because they merely linked the use of the abstract idea to a particular technological environment (i.e., “implementation via computers”) or were well-understood, routine, conventional activity recited at a high level of generality. 573 U.S. at 225-26, 110 USPQ2d at 1984-85.

*Classen Immunotherapies Inc. v. Biogen IDEC* provides another example of claims that recited meaningful limitations. 659 F.3d 1057, 100 USPQ2d 1492 (Fed. Cir. 2011) (decision on remand from the Supreme Court, which had vacated the lower court’s prior holding of ineligibility in view of *Bilski v. Kappos*, 561 U.S. 593, 95 USPQ2d 1001 (2010)). In *Classen*, the claims recited methods that gathered and analyzed the effects of particular immunization schedules on the later development of chronic immune-mediated disorders in mammals in order to identify a lower risk immunization schedule, and then immunized mammalian subjects in accordance with the identified lower risk schedule (thereby lowering the risk that the immunized subject would later develop chronic immune-mediated diseases). 659 F.3d at 1060-61; 100 USPQ2d at 1495-96. Although the analysis step was an abstract mental process that collected and compared known information, the immunization step was meaningful because it integrated the results of the analysis into a specific and tangible method that resulted in the method “moving from abstract scientific principle



to specific application.” 659 F.3d at 1066-68; 100 USPQ2d at 1500-01. In contrast, in *OIP Technologies, Inc. v. Amazon.com, Inc.*, the court determined that the additional steps to “test prices and collect data based on the customer reactions” did not meaningfully limit the abstract idea of offer-based price optimization, because the steps were well-understood, routine, conventional data-gathering activities. 788 F.3d 1359, 1363-64, 115 USPQ2d 1090, 1093 (Fed. Cir. 2015).

With respect to treatment or prophylaxis limitations, such as the immunization step in *Classen*, examiners should note that the other meaningful limitations consideration overlaps with the particular treatment or prophylaxis consideration that is evaluated in Step 2A Prong Two (see [MPEP § 2106.04\(d\)\(2\)](#)).

When evaluating whether additional elements meaningfully limit the judicial exception, it is particularly critical that examiners consider the additional elements both individually and as a combination. When an additional element is considered individually by an examiner, the additional element may be enough to qualify as “significantly more” if it meaningfully limits the judicial exception, and may also add a meaningful limitation by integrating the judicial exception into a practical application. However, even in the situation where the individually-viewed elements do not add significantly more or integrate the exception, those additional elements when viewed in combination may render the claim eligible. See *Diamond v. Diehr*, 450 U.S. 175, 188, 209 USPQ2d 1, 9 (1981) (“a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made”); *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349, 119 USPQ2d 1236, 1242 (Fed. Cir. 2016). It is important to note that, when appropriate, an examiner may explain on the record why the additional elements meaningfully limit the judicial exception.

### **2106.05(f) Mere Instructions To Apply An Exception [R-10.2019]**

Another consideration when determining whether a claim integrates a judicial exception into a practical

application in Step 2A Prong Two or recites significantly more than a judicial exception in Step 2B is whether the additional elements amount to more than a recitation of the words “apply it” (or an equivalent) or are more than mere instructions to implement an abstract idea or other exception on a computer. As explained by the Supreme Court, in order to make a claim directed to a judicial exception patent-eligible, the additional element or combination of elements must do “more than simply stat[e] the [judicial exception] while adding the words ‘apply it’”. *Alice Corp. v. CLS Bank*, 573 U.S. 208, 221, 110 USPQ2d 1976, 1982-83 (2014) (quoting *Mayo Collaborative Servs. V. Prometheus Labs., Inc.*, 566 U.S. 66, 72, 101 USPQ2d 1961, 1965). Thus, for example, claims that amount to nothing more than an instruction to apply the abstract idea using a generic computer do not render an abstract idea eligible. *Alice Corp.*, 573 U.S. at 223, 110 USPQ2d at 1983. See also 573 U.S. at 224, 110 USPQ2d at 1984 (warning against a [§ 101](#) analysis that turns on “the draftsman’s art”).

The Supreme Court has identified additional elements as mere instructions to apply an exception in several cases. For instance, in *Mayo*, the Supreme Court concluded that a step of determining thiopurine metabolite levels in patients’ blood did not amount to significantly more than the recited laws of nature, because this additional element simply instructed doctors to apply the laws by measuring the metabolites in any way the doctors (or medical laboratories) chose to use. 566 U.S. at 79, 101 USPQ2d at 1968. In *Alice Corp.*, the claim recited the concept of intermediated settlement as performed by a generic computer. The Court found that the recitation of the computer in the claim amounted to mere instructions to apply the abstract idea on a generic computer. 573 U.S. at 225-26, 110 USPQ2d at 1984. The Supreme Court also discussed this concept in an earlier case, *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 USPQ 673, 676 (1972), where the claim recited a process for converting binary-coded-decimal (BCD) numerals into pure binary numbers. The Court found that the claimed process had no meaningful practical application except in connection with a computer. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676. The claim simply stated a judicial exception (e.g., law of nature or

abstract idea) while effectively adding words that “apply it” in a computer. *Id.*

Requiring more than mere instructions to apply an exception does not mean that the claim must be narrow in order to be eligible. The courts have identified some broad claims as eligible see, *e.g.*, *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 120 USPQ2d 1091 (Fed. Cir. 2016); *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 121 USPQ2d 1898 (Fed. Cir. 2017), and some narrow claims as ineligible see *e.g.*, *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 112 USPQ2d 1750 (Fed. Cir. 2014); *Electric Power Group, LLC v. Alstom, S.A.*, 830 F.3d 1350, 119 USPQ2d 1739 (Fed. Cir. 2016). Thus, examiners should carefully consider each claim on its own merits, as well as evaluate all other relevant considerations, before making a determination of whether an element (or combination of elements) is more than mere instructions to apply an exception. For example, because this consideration often overlaps with the improvement consideration (see [MPEP § 2106.05\(a\)](#)), the particular machine and particular transformation considerations (see [MPEP § 2106.05\(b\)](#) and [\(c\)](#), respectively), and the well-understood, routine, conventional consideration (see [MPEP § 2106.05\(d\)](#)), evaluation of those other considerations may assist examiners in making a determination of whether an element (or combination of elements) is more than mere instructions to apply an exception. Note, however, that examiners should not evaluate the well-understood, routine, conventional consideration in the Step 2A Prong Two analysis, because that consideration is only evaluated in Step 2B.

For claim limitations that do not amount to more than a recitation of the words “apply it” (or an equivalent), such as mere instructions to implement an abstract idea on a computer, examiners should explain why they do not meaningfully limit the claim in an eligibility rejection. For example, an examiner could explain that implementing an abstract idea on a generic computer, does not integrate the abstract idea into a practical application in Step 2A Prong Two or add significantly more in Step 2B, similar to how the recitation of the computer in the claim in *Alice* amounted to mere instructions to apply the abstract idea of intermediated settlement on a generic

computer. For more information on formulating a subject matter eligibility rejection. See [MPEP § 2106.07\(a\)](#).

When determining whether a claim simply recites a judicial exception with the words “apply it” (or an equivalent), such as mere instructions to implement an abstract idea on a computer, examiners may consider the following:

**(1) Whether the claim recites only the idea of a solution or outcome *i.e.*, the claim fails to recite details of how a solution to a problem is accomplished.** The recitation of claim limitations that attempt to cover any solution to an identified problem with no restriction on how the result is accomplished and no description of the mechanism for accomplishing the result, does not integrate a judicial exception into a practical application or provide significantly more because this type of recitation is equivalent to the words “apply it”. See *Electric Power Group, LLC v. Alstom, S.A.*, 830 F.3d 1350, 1356, 119 USPQ2d 1739, 1743-44 (Fed. Cir. 2016); *Intellectual Ventures I v. Symantec*, 838 F.3d 1307, 1327, 120 USPQ2d 1353, 1366 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348, 115 USPQ2d 1414, 1417 (Fed. Cir. 2015). In contrast, claiming a particular solution to a problem or a particular way to achieve a desired outcome may integrate the judicial exception into a practical application or provide significantly more. See *Electric Power*, 830 F.3d at 1356, 119 USPQ2d at 1743.

By way of example, in *Intellectual Ventures I v. Capital One Fin. Corp.*, 850 F.3d 1332, 121 USPQ2d 1940 (Fed. Cir. 2017), the steps in the claims described “the creation of a dynamic document based upon ‘management record types’ and ‘primary record types.’” 850 F.3d at 1339-40; 121 USPQ2d at 1945-46. The claims were found to be directed to the abstract idea of “collecting, displaying, and manipulating data.” 850 F.3d at 1340; 121 USPQ2d at 1946. In addition to the abstract idea, the claims also recited the additional element of modifying the underlying XML document in response to modifications made in the dynamic document. 850 F.3d at 1342; 121 USPQ2d at 1947-48. Although the claims purported to modify the underlying XML document in response to modifications made in the

dynamic document, nothing in the claims indicated what specific steps were undertaken other than merely using the abstract idea in the context of XML documents. The court thus held the claims ineligible, because the additional limitations provided only a result-oriented solution and lacked details as to how the computer performed the modifications, which was equivalent to the words “apply it”. 850 F.3d at 1341-42; 121 USPQ2d at 1947-48 (citing *Electric Power Group.*, 830 F.3d at 1356, 1356, USPQ2d at 1743-44 (cautioning against claims “so result focused, so functional, as to effectively cover any solution to an identified problem”)).

Other examples where the courts have found the additional elements to be mere instructions to apply an exception, because they recite no more than an idea of a solution or outcome include:

i. Remotely accessing user-specific information through a mobile interface and pointers to retrieve the information without any description of how the mobile interface and pointers accomplish the result of retrieving previously inaccessible information, *Intellectual Ventures v. Erie Indem. Co.*, 850 F.3d 1315, 1331, 121 USPQ2d 1928, 1939 (Fed. Cir. 2017);

ii. A general method of screening emails on a generic computer without any limitations that addressed the issues of shrinking the protection gap and mooting the volume problem, *Intellectual Ventures I v. Symantec Corp.*, 838 F.3d 1307, 1319, 120 USPQ2d 1353, 1361 (Fed. Cir. 2016); and

iii. Wireless delivery of out-of-region broadcasting content to a cellular telephone via a network without any details of how the delivery is accomplished, *Affinity Labs of Texas v. DirecTV, LLC*, 838 F.3d 1253, 1262-63, 120 USPQ2d 1201, 1207 (Fed. Cir. 2016).

In contrast, other cases have found that additional elements are more than “apply it” or are not “mere instructions” when the claim recites a technological solution to a technological problem. In *DDR Holdings*, the court found that the additional elements did amount to more than merely instructing that the abstract idea should be applied on the Internet. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259, 113 USPQ2d 1097, 1107 (Fed. Cir. 2014). The claims at issue specified how

interactions with the Internet were manipulated to yield a desired result—a result that overrode the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink. 773 F.3d at 1258; 113 USPQ2d at 1106. In *BASCOM*, the court determined that the claimed combination of limitations did not simply recite an instruction to apply the abstract idea of filtering content on the Internet. *BASCOM Global Internet Servs. v. AT&T Mobility, LLC*, 827 F.3d 1341, 1350, 119 USPQ2d 1236, 1243 (Fed. Cir. 2016). Instead, the claim recited a “technology based solution” of filtering content on the Internet that overcome the disadvantages of prior art filtering systems. 827 F.3d at 1350-51, 119 USPQ2d at 1243. Finally, in *Thales Visionix*, the particular configuration of inertial sensors and the particular method of using the raw data from the sensors was more than simply applying a law of nature. *Thales Visionix, Inc. v. United States*, 850 F.3d 1343, 1348-49, 121 USPQ2d 1898, 1902 (Fed. Cir. 2017). The court found that the claims provided a system and method that “eliminate[d] many ‘complications’ inherent in previous solutions for determining position and orientation of an object on a moving platform.” In other words, the claim recited a technological solution to a technological problem. *Id.*

**(2) Whether the claim invokes computers or other machinery merely as a tool to perform an existing process.** Use of a computer or other machinery in its ordinary capacity for economic or other tasks (e.g., to receive, store, or transmit data) or simply adding a general purpose computer or computer components after the fact to an abstract idea (e.g., a fundamental economic practice or mathematical equation) does not integrate a judicial exception into a practical application or provide significantly more. See *Affinity Labs v. DirecTV*, 838 F.3d 1253, 1262, 120 USPQ2d 1201, 1207 (Fed. Cir. 2016) (cellular telephone); *TLI Communications LLC v. AV Auto, LLC*, 823 F.3d 607, 613, 118 USPQ2d 1744, 1748 (Fed. Cir. 2016) (computer server and telephone unit). Similarly, “claiming the improved speed or efficiency inherent with applying the abstract idea on a computer” does not integrate a judicial exception into a practical application or provide an inventive concept. *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367, 115 USPQ2d 1636, 1639 (Fed. Cir. 2015). In contrast,

a claim that purports to improve computer capabilities or to improve an existing technology may integrate a judicial exception into a practical application or provide significantly more. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314-15, 120 USPQ2d 1091, 1101-02 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36, 118 USPQ2d 1684, 1688-89 (Fed. Cir. 2016). See [MPEP §§ 2106.04\(d\)\(1\)](#) and [2106.05\(a\)](#) for a discussion of improvements to the functioning of a computer or to another technology or technical field.

*TLI Communications* provides an example of a claim invoking computers and other machinery merely as a tool to perform an existing process. The court stated that the claims describe steps of recording, administration and archiving of digital images, and found them to be directed to the abstract idea of classifying and storing digital images in an organized manner. 823 F.3d at 612, 118 USPQ2d at 1747. The court then turned to the additional elements of performing these functions using a telephone unit and a server and noted that these elements were being used in their ordinary capacity (*i.e.*, the telephone unit is used to make calls and operate as a digital camera including compressing images and transmitting those images, and the server simply receives data, extracts classification information from the received data, and stores the digital images based on the extracted information). 823 F.3d at 612-13, 118 USPQ2d at 1747-48. In other words, the claims invoked the telephone unit and server merely as tools to execute the abstract idea. Thus, the court found that the additional elements did not add significantly more to the abstract idea because they were simply applying the abstract idea on a telephone network without any recitation of details of how to carry out the abstract idea.

Other examples where the courts have found the additional elements to be mere instructions to apply an exception, because they do no more than merely invoke computers or machinery as a tool to perform an existing process include:

i. A commonplace business method or mathematical algorithm being applied on a general purpose computer, *Alice Corp. Pty. Ltd. V. CLS Bank Int'l*, 573 U.S. 208, 223, 110 USPQ2d 1976,

1983 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 64, 175 USPQ 673, 674 (1972); *Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334, 115 USPQ2d 1681, 1701 (Fed. Cir. 2015);

ii. Generating a second menu from a first menu and sending the second menu to another location as performed by generic computer components, *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1243-44, 120 USPQ2d 1844, 1855-57 (Fed. Cir. 2016);

iii. A process for monitoring audit log data that is executed on a general-purpose computer where the increased speed in the process comes solely from the capabilities of the general-purpose computer, *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1095, 120 USPQ2d 1293, 1296 (Fed. Cir. 2016);

iv. A method of using advertising as an exchange or currency being applied or implemented on the Internet, *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715, 112 USPQ2d 1750, 1754 (Fed. Cir. 2014);

v. Requiring the use of software to tailor information and provide it to the user on a generic computer, *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370-71, 115 USPQ2d 1636, 1642 (Fed. Cir. 2015); and

vi. A method of assigning hair designs to balance head shape with a final step of using a tool (scissors) to cut the hair, *In re Brown*, 645 Fed. App'x 1014, 1017 (Fed. Cir. 2016) (non-precedential).

**(3) The particularity or generality of the application of the judicial exception.** A claim having broad applicability across many fields of endeavor may not provide meaningful limitations that integrate a judicial exception into a practical application or amount to significantly more. For instance, a claim that generically recites an effect of the judicial exception or claims every mode of accomplishing that effect, amounts to a claim that is merely adding the words “apply it” to the judicial exception. See *Internet Patents Corporation v. Active Network, Inc.*, 790 F.3d 1343, 1348, 115 USPQ2d 1414, 1418 (Fed. Cir. 2015) (The recitation of maintaining the state of data in an online form without restriction on how the state is maintained and with no description of the mechanism for maintaining the state describes “the effect or result dissociated from any method by which maintaining the state is accomplished” and does not provide a meaningful limitation because it merely states that



the abstract idea should be applied to achieve a desired result). See also *O'Reilly v. Morse*, 56 U.S. 62 (1854) (finding ineligible a claim for “the use of electromagnetism for transmitting signals at a distance”); The *Telephone Cases*, 126 U.S. 1, 209 (1888) (finding a method of “transmitting vocal or other sound telegraphically ... by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds,” to be ineligible, because it “monopolize[d] a natural force” and “the right to avail of that law by any means whatever.”).

In contrast, limitations that confine the judicial exception to a particular, practical application of the judicial exception may amount to significantly more or integrate the judicial exception into a practical application. For example, in *BASCOM*, the combination of additional elements, and specifically “the installation of a filtering tool at a specific location, remote from the end users, with customizable filtering features specific to each end user” where the filtering tool at the ISP was able to “identify individual accounts that communicate with the ISP server, and to associate a request for Internet content with a specific individual account,” were held to be meaningful limitations because they confined the abstract idea of content filtering to a particular, practical application of the abstract idea. 827 F.3d at 1350-51, 119 USPQ2d at 1243.

### **2106.05(g) Insignificant Extra-Solution Activity [R-10.2019]**

Another consideration when determining whether a claim integrates the judicial exception into a practical application in Step 2A Prong Two or recites significantly more in Step 2B is whether the additional elements add more than insignificant extra-solution activity to the judicial exception. The term “extra-solution activity” can be understood as activities incidental to the primary process or product that are merely a nominal or tangential addition to the claim. Extra-solution activity includes both pre-solution and post-solution activity. An example of pre-solution activity is a step of gathering data for use in a claimed process, *e.g.*, a step of obtaining information about credit card transactions, which is recited as part of a claimed process of analyzing and manipulating the gathered information by a series

of steps in order to detect whether the transactions were fraudulent. An example of post-solution activity is an element that is not integrated into the claim as a whole, *e.g.*, a printer that is used to output a report of fraudulent transactions, which is recited in a claim to a computer programmed to analyze and manipulate information about credit card transactions in order to detect whether the transactions were fraudulent.

As explained by the Supreme Court, the addition of insignificant extra-solution activity does not amount to an inventive concept, particularly when the activity is well-understood or conventional. *Parker v. Flook*, 437 U.S. 584, 588-89, 198 USPQ 193, 196 (1978). In *Flook*, the Court reasoned that “[t]he notion that post-solution activity, no matter how conventional or obvious in itself, can transform an unpatentable principle into a patentable process exalts form over substance. A competent draftsman could attach some form of post-solution activity to almost any mathematical formula”. 437 U.S. at 590; 198 USPQ at 197; *Id.* (holding that step of adjusting an alarm limit variable to a figure computed according to a mathematical formula was “post-solution activity”). See also *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 79, 101 USPQ2d 1961, 1968 (2012) (additional element of measuring metabolites of a drug administered to a patient was insignificant extra-solution activity).

Examiners should carefully consider each claim on its own merits, as well as evaluate all other relevant considerations, before making a determination of whether an element (or combination of elements) is insignificant extra-solution activity. In particular, evaluation of the particular machine and particular transformation considerations (see [MPEP § 2106.05\(b\)](#) and [\(c\)](#), respectively), the well-understood, routine, conventional consideration (see [MPEP § 2106.05\(d\)](#)), and the field of use and technological environment consideration (see [MPEP § 2106.05\(h\)](#)) may assist examiners in making a determination of whether an element (or combination of elements) is insignificant extra-solution activity. Note, however, that examiners should not evaluate the well-understood, routine, conventional consideration in the Step 2A Prong Two analysis,



because that consideration is only evaluated in Step 2B.

This consideration is similar to factors used in past Office guidance (for example, the now superseded *Bilski* and *Mayo* analyses) that were described as mere data gathering in conjunction with a law of nature or abstract idea. When determining whether an additional element is insignificant extra-solution activity, examiners may consider the following:

**(1) Whether the extra-solution limitation is well known.** See *Bilski v. Kappos*, 561 U.S. 593, 611-12, 95 USPQ2d 1001, 1010 (2010) (well-known random analysis techniques to establish the inputs of an equation were token extra-solution activity); *Flook*, 437 U.S. at 593-95, 198 USPQ at 197 (a formula would not be patentable by only indicating that it could be usefully applied to existing surveying techniques); *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328-29, 121 USPQ2d 1928, 1937 (Fed. Cir. 2017) (the use of a well-known XML tag to form an index was deemed token extra-solution activity). Because this overlaps with the well-understood, routine, conventional consideration, it should not be considered in the Step 2A Prong Two extra-solution activity analysis.

**(2) Whether the limitation is significant (i.e. it imposes meaningful limits on the claim such that it is not nominally or tangentially related to the invention).** See *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715-16, 112 USPQ2d 1750, 1755 (Fed. Cir. 2014) (restricting public access to media was found to be insignificant extra-solution activity); *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1242, 120 USPQ2d 1844, 1855 (Fed. Cir. 2016) (in patents regarding electronic menus, features related to types of ordering were found to be insignificant extra-solution activity). This is considered in Step 2A Prong Two and Step 2B.

**(3) Whether the limitation amounts to necessary data gathering and outputting, (i.e., all uses of the recited judicial exception require such data gathering or data output).** See *Mayo*, 566 U.S. at 79, 101 USPQ2d at 1968; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363, 115 USPQ2d 1090, 1092-93 (Fed. Cir. 2015) (presenting offers and gathering statistics amounted to mere data

gathering). This is considered in Step 2A Prong Two and Step 2B.

Below are examples of activities that the courts have found to be insignificant extra-solution activity:

**• Mere Data Gathering:**

i. Performing clinical tests on individuals to obtain input for an equation, *In re Grams*, 888 F.2d 835, 839-40; 12 USPQ2d 1824, 1827-28 (Fed. Cir. 1989);

ii. Testing a system for a response, the response being used to determine system malfunction, *In re Meyers*, 688 F.2d 789, 794; 215 USPQ 193, 196-97 (CCPA 1982);

iii. Presenting offers to potential customers and gathering statistics generated based on the testing about how potential customers responded to the offers; the statistics are then used to calculate an optimized price, *OIP Technologies*, 788 F.3d at 1363, 115 USPQ2d at 1092-93;

iv. Obtaining information about transactions using the Internet to verify credit card transactions, *CyberSource v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375, 99 USPQ2d 1690, 1694 (Fed. Cir. 2011);

v. Consulting and updating an activity log, *Ulramercial*, 772 F.3d at 715, 112 USPQ2d at 1754; and

vi. Determining the level of a biomarker in blood, *Mayo*, 566 U.S. at 79, 101 USPQ2d at 1968. See also *PerkinElmer, Inc. v. Intema Ltd.*, 496 Fed. App'x 65, 73, 105 USPQ2d 1960, 1966 (Fed. Cir. 2012) (assessing or measuring data derived from an ultrasound scan, to be used in a diagnosis).

**• Selecting a particular data source or type of data to be manipulated:**

i. Limiting a database index to XML tags, *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d at 1328-29, 121 USPQ2d at 1937;

ii. Taking food orders from only table-based customers or drive-through customers, *Ameranth*, 842 F.3d at 1241-43, 120 USPQ2d at 1854-55;

iii. Selecting information, based on types of information and availability of information in a power-grid environment, for collection, analysis and display, *Electric Power Group, LLC v. Alstom S.A.*,

830 F.3d 1350, 1354-55, 119 USPQ2d 1739, 1742 (Fed. Cir. 2016); and

iv. Requiring a request from a user to view an advertisement and restricting public access, *Ultramercial*, 772 F.3d at 715-16, 112 USPQ2d at 1754.

• **Insignificant application:**

i. Cutting hair after first determining the hair style, *In re Brown*, 645 Fed. App'x 1014, 1016-1017 (Fed. Cir. 2016) (non-precedential); and

ii. Printing or downloading generated menus, *Ameranth*, 842 F.3d at 1241-42, 120 USPQ2d at 1854-55.

Some cases have identified insignificant computer implementation as an example of insignificant extra-solution activity. See *e.g.*, *Fort Props., Inc. v. Am. Master Lease LLC*, 671 F.3d 1317, 1323-24, 101 USPQ2d 1785, 1789-90 (Fed. Cir. 2012); *Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1280-81, 103 USPQ2d 1425, 1434-35 (Fed. Cir. 2012). Other cases have considered these types of limitations as mere instructions to apply a judicial exception. See [MPEP § 2106.05\(f\)](#) for more information about insignificant computer implementation.

For claim limitations that add insignificant extra-solution activity to the judicial exception (*e.g.*, mere data gathering in conjunction with a law of nature or abstract idea), examiners should explain in an eligibility rejection why they do not meaningfully limit the claim. For example, an examiner could explain that adding a final step of storing data to a process that only recites computing the area of a space (a mathematical relationship) does not add a meaningful limitation to the process of computing the area. For more information on formulating a subject matter eligibility rejection, see [MPEP § 2106.07\(a\)](#).

## **2106.05(h) Field of Use and Technological Environment [R-10.2019]**

Another consideration when determining whether a claim integrates the judicial exception into a practical application in Step 2A Prong Two or recites significantly more than a judicial exception in Step 2B is whether the additional elements amount to

more than generally linking the use of a judicial exception to a particular technological environment or field of use. As explained by the Supreme Court, a claim directed to a judicial exception cannot be made eligible “simply by having the applicant acquiesce to limiting the reach of the patent for the formula to a particular technological use.” *Diamond v. Diehr*, 450 U.S. 175, 192 n.14, 209 USPQ 1, 10 n. 14 (1981). Thus, limitations that amount to merely indicating a field of use or technological environment in which to apply a judicial exception do not amount to significantly more than the exception itself, and cannot integrate a judicial exception into a practical application.

The courts often cite to *Parker v. Flook* as providing a classic example of a field of use limitation. See, *e.g.*, *Bilski v. Kappos*, 561 U.S. 593, 612, 95 USPQ2d 1001, 1010 (2010) (“*Flook* established that limiting an abstract idea to one field of use or adding token postsolution components did not make the concept patentable”) (citing *Parker v. Flook*, 437 U.S. 584, 198 USPQ 193 (1978)). In *Flook*, the claim recited steps of calculating an updated value for an alarm limit (a numerical limit on a process variable such as temperature, pressure or flow rate) according to a mathematical formula “in a process comprising the catalytic chemical conversion of hydrocarbons.” 437 U.S. at 586, 198 USPQ at 196. Processes for the catalytic chemical conversion of hydrocarbons were used in the petrochemical and oil-refining fields. *Id.* Although the applicant argued that limiting the use of the formula to the petrochemical and oil-refining fields should make the claim eligible because this limitation ensured that the claim did not preempt all uses of the formula, the Supreme Court disagreed. 437 U.S. at 588-90, 198 USPQ at 197-98. Instead, the additional element in *Flook* regarding the catalytic chemical conversion of hydrocarbons was not sufficient to make the claim eligible, because it was merely an incidental or token addition to the claim that did not alter or affect how the process steps of calculating the alarm limit value were performed. Further, the Supreme Court found that this limitation did not amount to an inventive concept. 437 U.S. at 588-90, 198 USPQ at 197-98. The Court reasoned that to hold otherwise would “exalt[] form over substance”, because a competent claim drafter could attach a similar type of limitation

to almost any mathematical formula. 437 U.S. at 590, 198 USPQ at 197.

In contrast, the additional elements in *Diamond v. Diehr* as a whole provided eligibility and did not merely recite calculating a cure time using the Arrhenius equation “in a rubber molding process”. Instead, the claim in *Diehr* recited specific limitations such as monitoring the elapsed time since the mold was closed, constantly measuring the temperature in the mold cavity, repetitively calculating a cure time by inputting the measured temperature into the Arrhenius equation, and opening the press automatically when the calculated cure time and the elapsed time are equivalent. 450 U.S. at 179, 209 USPQ at 5, n. 5. These specific limitations act in concert to transform raw, uncured rubber into cured molded rubber. 450 U.S. at 177-78, 209 USPQ at 4.

A more recent example of a limitation that does no more than generally link a judicial exception to a particular technological environment is *Affinity Labs of Texas v. DirecTV, LLC*, 838 F.3d 1253, 120 USPQ2d 1201 (Fed. Cir. 2016). In *Affinity Labs*, the claim recited a broadcast system in which a cellular telephone located outside the range of a regional broadcaster (1) requests and receives network-based content from the broadcaster via a streaming signal, (2) is configured to wirelessly download an application for performing those functions, and (3) contains a display that allows the user to select particular content. 838 F.3d at 1255-56, 120 USPQ2d at 1202. The court identified the claimed concept of providing out-of-region access to regional broadcast content as an abstract idea, and noted that the additional elements limited the wireless delivery of regional broadcast content to cellular telephones (as opposed to any and all electronic devices such as televisions, cable boxes, computers, or the like). 838 F.3d at 1258-59, 120 USPQ2d at 1204. Although the additional elements did limit the use of the abstract idea, the court explained that this type of limitation merely confines the use of the abstract idea to a particular technological environment (cellular telephones) and thus fails to add an inventive concept to the claims. 838 F.3d at 1259, 120 USPQ2d at 1204.

Examples of limitations that the courts have described as merely indicating a field of use or technological environment in which to apply a judicial exception include:

i. A step of administering a drug providing 6-thioguanine to patients with an immune-mediated gastrointestinal disorder, because limiting drug administration to this patient population did no more than simply refer to the relevant pre-existing audience of doctors who used thiopurine drugs to treat patients suffering from autoimmune disorders, *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66, 78, 101 USPQ2d 1961, 1968 (2012);

ii. Identifying the participants in a process for hedging risk as commodity providers and commodity consumers, because limiting the use of the process to these participants did no more than describe how the abstract idea of hedging risk could be used in the commodities and energy markets, *Bilski*, 561 U.S. at 595, 95 USPQ2d at 1010;

iii. Limiting the use of the formula  $C = 2(\pi)r$  to determining the circumference of a wheel as opposed to other circular objects, because this limitation represents a mere token acquiescence to limiting the reach of the claim, *Flook*, 437 U.S. at 595, 198 USPQ at 199;

iv. Specifying that the abstract idea of monitoring audit log data relates to transactions or activities that are executed in a computer environment, because this requirement merely limits the claims to the computer field, *i.e.*, to execution on a generic computer, *FairWarning v. Iatric Sys.*, 839 F.3d 1089, 1094-95, 120 USPQ2d 1293, 1295 (Fed. Cir. 2016);

v. Language specifying that the process steps of virus screening were used within a telephone network or the Internet, because limiting the use of the process to these technological environments did not provide meaningful limits on the claim, *Intellectual Ventures I v. Symantec Corp.*, 838 F.3d 1307, 1319-20, 120 USPQ2d 1353, 1361 (2016);

vi. Limiting the abstract idea of collecting information, analyzing it, and displaying certain results of the collection and analysis to data related to the electric power grid, because limiting application of the abstract idea to power-grid monitoring is simply an attempt to limit the use of

the abstract idea to a particular technological environment, *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354, 119 USPQ2d 1739, 1742 (Fed. Cir. 2016);

vii. Language informing doctors to apply a law of nature (linkage disequilibrium) for purposes of detecting a genetic polymorphism, because this language merely informs the relevant audience that the law of nature can be used in this manner, *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1379, 118 USPQ2d 1541, 1549 (Fed. Cir. 2016);

viii. Language specifying that the abstract idea of budgeting was to be implemented using a “communication medium” that broadly included the Internet and telephone networks, because this limitation merely limited the use of the exception to a particular technological environment, *Intellectual Ventures I v. Capital One Bank*, 792 F.3d 1363, 1367, 115 USPQ2d 1636, 1640 (Fed. Cir. 2015);

ix. Specifying that the abstract idea of using advertising as currency is used on the Internet, because this narrowing limitation is merely an attempt to limit the use of the abstract idea to a particular technological environment, *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716, 112 USPQ2d 1750, 1755 (Fed. Cir. 2014); and

x. Requiring that the abstract idea of creating a contractual relationship that guarantees performance of a transaction (a) be performed using a computer that receives and sends information over a network, or (b) be limited to guaranteeing online transactions, because these limitations simply attempted to limit the use of the abstract idea to computer environments, *buySAFE Inc. v. Google, Inc.*, 765 F.3d 1350, 1354, 112 USPQ2d 1093, 1095-96 (Fed. Cir. 2014).

Examiners should be aware that the courts often use the terms “technological environment” and “field of use” interchangeably, and thus for purposes of the eligibility analysis examiners should consider these terms interchangeable. Examiners should also keep in mind that this consideration overlaps with other considerations, particularly insignificant extra-solution activity (see [MPEP § 2106.05\(g\)](#)). For instance, a data gathering step that is limited to a particular data source (such as the Internet) or a particular type of data (such as power grid data or XML tags) could be considered to be both

insignificant extra-solution activity and a field of use limitation. See, e.g., *Ulramercial*, 772 F.3d at 716, 112 USPQ2d at 1755 (limiting use of abstract idea to the Internet); *Electric Power*, 830 F.3d at 1354, 119 USPQ2d at 1742 (limiting application of abstract idea to power grid data); *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1328-29, 121 USPQ2d 1928, 1939 (Fed. Cir. 2017) (limiting use of abstract idea to use with XML tags). Thus, examiners should carefully consider each claim on its own merits, as well as evaluate all other relevant considerations, before making a determination on this consideration.

For claim limitations that generally link the use of the judicial exception to a particular technological environment or field of use, examiners should explain in an eligibility rejection why they do not meaningfully limit the claim. For example, an examiner could explain that employing generic computer functions to execute an abstract idea, even when limiting the use of the idea to one particular environment, does not add significantly more, similar to how limiting the abstract idea in *Flook* to petrochemical and oil-refining industries was insufficient. For more information on formulating a subject matter eligibility rejection, see [MPEP § 2106.07\(a\)](#).

## 2106.06 Streamlined Analysis [R-10.2019]

For purposes of efficiency in examination, examiners may use a streamlined eligibility analysis (Pathway A) when the eligibility of the claim is self-evident, e.g., because the claim clearly improves a technology or computer functionality. However, if there is doubt as to whether the applicant is effectively seeking coverage for a judicial exception itself, the full eligibility analysis (the *Alice/Mayo* test described in [MPEP § 2106](#), subsection III) should be conducted to determine whether the claim integrates the judicial exception into a practical application or recites significantly more than the judicial exception.

The results of the streamlined analysis will always be the same as the full analysis, thus the streamlined analysis is not a means of avoiding a finding of ineligibility that would occur if a claim were to undergo the full eligibility analysis. Similarly, a

claim that qualifies as eligible after Step 2A (Pathway B) or Step 2B (Pathway C) of the full analysis would also be eligible if the streamlined analysis (Pathway A) were applied to that claim. It may not be apparent that an examiner employed the streamlined analysis because the result is a conclusion that the claim is eligible, and there will be no rejection of the claim on eligibility grounds. In practice, the record may reflect the conclusion of eligibility simply by the absence of an eligibility rejection or may include clarifying remarks, when appropriate.

In the context of the flowchart in [MPEP § 2106](#), subsection III, if, when viewed as a whole, the eligibility of the claim is self-evident (e.g., because the claim clearly improves a technology or computer functionality), the claim is eligible at Pathway A, thereby concluding the eligibility analysis.

### **2106.06(a) Eligibility is Self Evident [R-08.2017]**

A streamlined eligibility analysis can be used for a claim that may or may not recite a judicial exception but, when viewed as a whole, clearly does not seek to tie up any judicial exception such that others cannot practice it. Such claims do not need to proceed through the full analysis herein as their eligibility will be self-evident. On the other hand, a claim that does not qualify as eligible after Step 2B of the full analysis would not be suitable for the streamlined analysis, because the claim lacks self evident eligibility.

For instance, a claim directed to a complex manufactured industrial product or process that recites meaningful limitations along with a judicial exception may sufficiently limit its practical application so that a full eligibility analysis is not needed. As an example, a robotic arm assembly having a control system that operates using certain mathematical relationships is clearly not an attempt to tie up use of the mathematical relationships and would not require a full analysis to determine eligibility. Also, a claim that recites a nature-based product, but clearly does not attempt to tie up the nature-based product, does not require a markedly different characteristics analysis to identify a “product of nature” exception. As an example, a

claim directed to an artificial hip prosthesis coated with a naturally occurring mineral is not an attempt to tie up the mineral. Similarly, claimed products that merely include ancillary nature-based components, such as a claim that is directed to a cellphone with an electrical contact made of gold or a plastic chair with wood trim, would not require analysis of the nature-based component to determine whether the claims are directed to a “product of nature” exception because such claims do not attempt to improperly tie up the nature-based product.

### **2106.06(b) Clear Improvement to a Technology or to Computer Functionality [R-08.2017]**

As explained by the Federal Circuit, some improvements to technology or to computer functionality are not abstract when appropriately claimed, and thus claims to such improvements do not always need to undergo the full eligibility analysis. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36, 118 USPQ2d 1684, 1689 (Fed. Cir. 2016). [MPEP § 2106.05\(a\)](#) provides details regarding improvements to a technology or computer functionality.

For instance, claims directed to clear improvements to computer-related technology do not need the full eligibility analysis. *Enfish*, 822 F.3d at 1339, 118 USPQ2d at 1691-92 (claims to a self-referential table for a computer database held eligible at step 1 of the *Alice/Mayo* test as not directed to an abstract idea). Claims directed to improvements to other technologies or technological processes, beyond computer improvements, may also avoid the full eligibility analysis. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316, 120 USPQ2d 1091, 1103 (Fed. Cir. 2016) (claims to automatic lip synchronization and facial expression animation found eligible at Step 1 of the *Alice/Mayo* test as directed to an improvement in computer-related technology). In these cases, when the claims were viewed as a whole, their eligibility was self-evident based on the clear improvement, so no further analysis was needed. Although the Federal Circuit held these claims eligible at Step 2A as not being directed to abstract ideas, it would be reasonable for an examiner to have found these claims eligible at Pathway A based on the clear improvement, or at



Pathway B (Step 2A) as not being directed to an abstract idea.

If the claims are a “close call” such that it is unclear whether the claims improve technology or computer functionality, a full eligibility analysis should be performed to determine eligibility. See *BASCOM Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341, 1349, 119 USPQ2d 1236, 1241 (Fed. Cir. 2016). Only when the claims clearly improve technology or computer functionality, or otherwise have self-evident eligibility, should the streamlined analysis be used. For example, because the claims in *BASCOM* described the concept of filtering content, which is a method of organizing human behavior previously found to be abstract, the Federal Circuit considered them to present a “close call” in the first step of the *Alice/Mayo* test (Step 2A), and thus proceeded to the second step of the *Alice/Mayo* test (Step 2B) to determine their eligibility. *Id.* Although the Federal Circuit held these claims eligible at Step 2B (Pathway C) because they presented a “technology-based solution” of filtering content on the Internet that overcame the disadvantages of prior art filtering systems and that amounted to significantly more than the recited abstract idea, it also would be reasonable for an examiner to have found these claims eligible at Pathway A or B if the examiner had considered the technology-based solution to be an improvement to computer functionality.

### **2106.07 Formulating and Supporting Rejections For Lack Of Subject Matter Eligibility [R-10.2019]**

Eligibility rejections must be based on failure to comply with the substantive law under [35 U.S.C. 101](#) as interpreted by judicial precedent. The substantive law on eligibility is discussed in [MPEP §§ 2106.03](#) through [2106.06](#). Examination guidance, training, and explanatory examples discuss the substantive law and establish the policies and procedures to be followed by examiners in evaluating patent applications for compliance with the substantive law, but do not serve as a basis for a rejection. Accordingly, while it would be acceptable for applicants to cite training materials or examples in support of an argument for finding eligibility in an appropriate factual situation, applicants should

not be required to model their claims or responses after the training materials or examples to attain eligibility.

When evaluating a claimed invention for compliance with the substantive law on eligibility, examiners should review the record as a whole (*e.g.*, the specification, claims, the prosecution history, and any relevant case law precedent or prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. The evaluation of whether the claimed invention qualifies as patent-eligible subject matter should be made on a claim-by-claim basis, because claims do not automatically rise or fall with similar claims in an application. For example, even if an independent claim is determined to be ineligible, the dependent claims may be eligible because they add limitations that integrate the judicial exception into a practical application or amount to significantly more than the judicial exception recited in the independent claim. And conversely, even if an independent claim is determined to be eligible, a dependent claim may be ineligible because it adds a judicial exception without also adding limitations that integrate the judicial exception or provide significantly more. Thus, each claim in an application should be considered separately based on the particular elements recited therein.

If the evaluation of the claimed invention results in a conclusion that it is more likely than not that the claim as a whole does not satisfy both criteria for eligibility (Step 1: NO and/or Step 2B: NO), then examiners should formulate an appropriate rejection of that claim under Step 1 and/or Step 2B. The rejection should set forth a *prima facie* case of ineligibility under the substantive law. The concept of the *prima facie* case is a procedural tool of patent examination, which allocates the burdens going forward between the examiner and applicant. In particular, the initial burden is on the examiner to explain why a claim or claims are ineligible for patenting clearly and specifically, so that applicant has sufficient notice and is able to effectively respond.

When an examiner determines a claim does not fall within a statutory category (Step 1: NO), the rejection should provide an explanation of why the

claim does not fall within one of the four statutory categories of invention. See [MPEP § 2106.03](#) for a discussion of Step 1 and the statutory categories of invention.

When an examiner determines that a claim is directed to a judicial exception (Step 2A: YES) and does not provide an inventive concept (Step 2B: NO), the rejection should provide an explanation for each part of the Step 2 analysis. For example, the rejection should identify the judicial exception by referring to what is recited (*i.e.*, set forth or described) in the claim and explain why it is considered an exception, identify any additional elements (specifically point to claim features/limitations/steps) recited in the claim beyond the identified judicial exception, and explain the reason(s) that the additional elements taken individually, and also taken as a combination, 1) do not integrate the judicial exception into a practical application and 2) do not result in the claim as a whole amounting to significantly more than the judicial exception. See [MPEP § 2106.04](#) *et seq.* for a discussion of Step 2A and the judicial exceptions, [MPEP § 2106.05](#) *et seq.* for a discussion of Step 2B and the search for an inventive concept, and [MPEP § 2106.07\(a\)](#) for more information on formulating an ineligibility rejection.

If the evaluation of the claimed invention results in a conclusion that it is more likely than not that the claimed invention falls within a statutory category (Step 1: YES) and is either not directed to a judicial exception (Step 2A: NO) or is directed to a judicial exception and amounts to significantly more than the judicial exception (Step 2B: YES), then the examiner should not reject the claim. When evaluating a response by applicant to a subject matter eligibility rejection, examiners must carefully consider all of applicant's arguments and evidence presented to rebut the rejection. If applicant properly challenges the examiner's findings, the rejection should be withdrawn or, if the examiner deems it appropriate to maintain the rejection, a rebuttal must be provided in the next Office action. This is discussed in greater detail in [MPEP § 2106.07\(b\)](#).

## 2106.07(a) Formulating a Rejection For Lack of Subject Matter Eligibility [R-07.2022]

After determining what has been invented and establishing the broadest reasonable interpretation of the claimed invention (see [MPEP § 2111](#)), the eligibility of each claim should be evaluated as a whole using the analysis detailed in [MPEP § 2106](#). If it is determined that the claim does not recite eligible subject matter, a rejection under [35 U.S.C. 101](#) is appropriate. When making the rejection, the Office action must provide an explanation as to why each claim is unpatentable, which must be sufficiently clear and specific to provide applicant sufficient notice of the reasons for ineligibility and enable the applicant to effectively respond.

Subject matter eligibility rejections under Step 1 are discussed in [MPEP § 2106.03](#).

A subject matter eligibility rejection under Step 2 should provide an explanation for each part of the Step 2 analysis:

- For Step 2A Prong One, the rejection should identify the judicial exception by referring to **what is recited** (*i.e.*, set forth or described) in the claim and **explain why** it is considered an exception. For example, if the claim is directed to an **abstract idea**, the rejection should identify the abstract idea as it is recited (*i.e.*, set forth or described) in the claim and explain why it is an abstract idea. Similarly, if the claim is directed to a **law of nature** or a **natural phenomenon**, the rejection should identify the law of nature or natural phenomenon as it is recited (*i.e.*, set forth or described) in the claim and explain using a reasoned rationale why it is considered a law of nature or natural phenomenon.

- For Step 2A Prong Two, the rejection should identify any additional elements (specifically point to claim features/limitations/steps) recited in the claim beyond the identified judicial exception; and **evaluate** the integration of the judicial exception into a practical application **by explaining** that 1) there are no additional elements in the claim; or 2) the claim as a whole, looking at the additional elements individually and in combination, does not integrate the judicial exception into a practical application using the considerations set forth in [MPEP §§ 2106.04\(d\)](#), [2106.05\(a\)-\(c\)](#) and [\(e\)-\(h\)](#).

Examiners should give weight to all of the claimed additional elements in Prong Two, even if those elements represent well-understood, routine, conventional activity.

- For Step 2B, the rejection should **explain why** the additional elements, taken individually and in combination, do not result in the claim, as a whole, amounting to significantly more than the identified judicial exception. For instance, when the examiner has concluded that certain claim elements recite well understood, routine, conventional activities in the relevant field, the examiner must expressly support the rejection in writing with one of the four options specified in Subsection III.

Under the principles of compact prosecution, regardless of whether a rejection under [35 U.S.C. 101](#) is made based on lack of subject matter eligibility, a complete examination should be made for every claim under each of the other patentability requirements: [35 U.S.C. 102](#), [103](#), [112](#), and [101](#) (utility, inventorship and double patenting) and non-statutory double patenting. Thus, examiners should state all non-cumulative reasons and bases for rejecting claims in the first Office action.

#### **I. WHEN MAKING A REJECTION, IDENTIFY AND EXPLAIN THE JUDICIAL EXCEPTION RECITED IN THE CLAIM (STEP 2A PRONG ONE)**

A subject matter eligibility rejection should point to the specific claim limitation(s) that recites (*i.e.*, sets forth or describes) the judicial exception. The rejection must explain why those claim limitations set forth or describe a judicial exception (*e.g.*, a law of nature). Where the claim describes, but does not expressly set forth, the judicial exception, the rejection must also explain what subject matter those limitations describe, and why the described subject matter is a judicial exception. See [MPEP § 2106.04](#) for more information about Step 2A of the eligibility analysis.

When the examiner has determined the claim recites an **abstract idea**, the rejection should identify the abstract idea as it is recited (*i.e.*, set forth or described) in the claim, and explain why it falls within one of the groupings of abstract ideas (*i.e.*, mathematical concepts, mental processes, or certain methods of organizing human activity) enumerated

in [MPEP § 2106.04\(a\)\(2\)](#). Alternatively, the examiner should provide justification for why a specific limitation(s) recited in the claim is being treated as an abstract idea if it does not fall within the groupings of abstract ideas in accordance with the “tentative abstract idea” procedure (see [MPEP § 2106.04\(a\)\(3\)](#)). While not required, this explanation or justification may include citing to an appropriate court decision that supports the identification of the subject matter recited in the claim language as an abstract idea within one of the groupings. Examiners should be familiar with any cited decision relied upon in making or maintaining a rejection to ensure that the rejection is reasonably tied to the facts of the case and to avoid relying upon language taken out of context. Examiners should not go beyond those concepts that are enumerated as abstract ideas in [MPEP § 2106.04](#), unless they are identifying a tentative abstract idea in the claim, and should avoid relying upon or citing non-precedential decisions unless the facts of the application under examination uniquely match the facts at issue in the non-precedential decisions. Examiners are reminded that a chart of court decisions is available on the USPTO’s Internet website ([www.uspto.gov/PatentEligibility](http://www.uspto.gov/PatentEligibility)).

Sample explanation: The claim recites the step of comparing collected information to a predefined threshold, which is an act of evaluating information that can be practically performed in the human mind. Thus, this step is an abstract idea in the “mental process” grouping.

When the examiner has determined the claim recites a **law of nature** or a **natural phenomenon**, the rejection should identify the law of nature or natural phenomenon as it is recited (*i.e.*, set forth or described) in the claim and explain using a reasoned rationale why it is considered a law of nature or natural phenomenon. See [MPEP § 2106.04\(b\)](#) for more information about laws of nature and natural phenomena.

Sample explanation: The claim recites the correlation of X, and X is a law of nature because it describes a consequence of natural processes in the human body, *e.g.*, the naturally-occurring relationship between the presence of Y and the manifestation of Z.

Sample explanation: The claim recites X, which is a natural phenomenon because it occurs in nature and exists in principle apart from any human action.

When the examiner has determined the claim recites a **product of nature**, the rejection should identify the exception as it is recited (*i.e.*, set forth or described) in the claim, and explain using a reasoned rationale why the product does not have markedly different characteristics from its naturally occurring counterpart in its natural state. See [MPEP § 2106.04\(b\)](#) for more information about products of nature, and [MPEP § 2106.04\(c\)](#) for more information about the markedly different characteristics analysis.

**Sample explanation:** The claim recites X, which as explained in the specification was isolated from naturally occurring Y. X is a nature-based product, so it is compared to its closest naturally occurring counterpart (X in its natural state) to determine if it has markedly different characteristics. Because there is no indication in the record that isolation of X has resulted in a marked difference in structure, function, or other properties as compared to its counterpart, X is a product of nature exception.

## **II. WHEN MAKING A REJECTION, EXPLAIN WHY THE ADDITIONAL CLAIM ELEMENTS DO NOT RESULT IN THE CLAIM AS A WHOLE INTEGRATING THE JUDICIAL EXCEPTION INTO A PRACTICAL APPLICATION OR AMOUNTING TO SIGNIFICANTLY MORE THAN THE JUDICIAL EXCEPTION (STEP 2A PRONG TWO AND STEP 2B)**

After identifying the judicial exception in the rejection, identify any additional elements (features/limitations/steps) recited in the claim beyond the judicial exception and explain why they do not integrate the judicial exception into a practical application and do not add significantly more to the exception. The explanation should address the additional elements both individually and as a combination when determining whether the claim as whole recites eligible subject matter. It is important to remember that a new combination of steps in a process may be patent eligible even though all the steps of the combination were individually well known and in common use before the combination was made. *Diamond v. Diehr*, 450 U.S. 175, 188, 209 USPQ 1, 9 (1981). Thus, it is particularly critical to address the combination of additional elements, because while individually-viewed elements may not appear to integrate an exception into a practical application or add significantly more, those additional elements when viewed in combination may amount to

significantly more than the exception by meaningfully limiting the judicial exception. See [MPEP § 2106.05](#) for more information about Step 2B of the eligibility analysis.

A rejection should be made only if it is readily apparent to an examiner relying on the examiner's expertise in the art in the Step 2A Prong Two inquiry and Step 2B inquiry that the additional elements do not integrate the exception into a practical application and do not amount to claiming significantly more than the recited judicial exception. When making a rejection, it is important for the examiner to explain the rationale underlying the conclusion so that applicant can effectively respond. On the other hand, when appropriate, the examiner should explain why the additional elements integrate an exception into a practical application or provide an inventive concept by adding a meaningful limitation to the claimed exception. See [MPEP §§ 2106.04\(d\)](#) and [2106.05](#) for a listing of considerations that qualify, and to not qualify, as integrating an exception or providing significantly more than an exception, and [MPEP § 2106.07\(c\)](#) for more information on clarifying the record when a claim is found eligible.

In the Step 2B inquiry, if the examiner has concluded that particular claim limitations are well understood, routine, conventional activities (or elements) to those in the relevant field, the rejection should support this conclusion in writing with a factual determination in accordance with Subsection III below. See [MPEP § 2106.05\(d\)](#) for more information about well understood, routine, conventional activities and elements, and Subsection III below for more information about how to support a conclusion that a claim limitation is well understood, routine, conventional activity.

For claim limitations that recite a generic computer component performing generic computer functions at a high level of generality, such as using the Internet to gather data, examiners can explain why these generic computing functions do not meaningfully limit the claim. Examiners should keep in mind that the courts have held computer-implemented processes to be significantly more than an abstract idea (and thus eligible), where generic computer components are able in



combination to perform functions that are not merely generic. *DDR Holdings, LLC v. Hotels.com, LP*, 773 F.3d 1245, 1258-59, 113 USPQ2d 1097, 1106-07 (Fed. Cir. 2014). See [MPEP § 2106.05\(f\)](#) for more information about generic computing functions that the courts have found to be mere instructions to implement a judicial exception on a computer, and [MPEP § 2106.05\(d\)](#) for more information about well understood, routine, conventional activities and elements (a relevant consideration only in Step 2B).

For claim limitations that add insignificant extra-solution activity to the judicial exception (e.g., mere data gathering in conjunction with a law of nature or abstract idea), or that generally link the use of the judicial exception to a particular technological environment or field of use, examiners should explain why they do not meaningfully limit the claim. For example, adding a final step of storing data to a process that only recites computing the area of a two dimensional space (a mathematical relationship) does not add a meaningful limitation to the process of computing the area. As another example, employing well-known computer functions to execute an abstract idea, even when limiting the use of the idea to one particular environment, does not integrate the exception into a practical application or add significantly more, similar to how limiting the computer implemented abstract idea in *Flook* to petrochemical and oil-refining industries was insufficient. See *e.g., Parker v. Flook*, 437 U.S. 584, 588-90, 198 USPQ 193, 197-98 (1978) (limiting use of mathematical formula to use in particular industries did not amount to an inventive concept). See [MPEP § 2106.05\(g\)](#) for more information about insignificant extra-solution activity, and [MPEP § 2106.05\(h\)](#) for more information about generally linking use of a judicial exception to a particular technological environment or field of use.

In the event a rejection is made, it is a best practice for the examiner to consult the specification to determine if there are elements that could be added to the claim to make it eligible. If so, the examiner should identify those elements in the Office action and suggest them as a way to overcome the rejection.

### III. EVIDENTIARY REQUIREMENTS IN MAKING A § 101 REJECTION

The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. *Rapid Litig. Mgmt. v. CellzDirect*, 827 F.3d 1042, 1047, 119 USPQ2d 1370, 1372 (Fed. Cir. 2016); *OIP Techs. v. Amazon.com*, 788 F.3d 1359, 1362, 115 USPQ2d 1090, 1092 (Fed. Cir. 2015); *DDR Holdings v. Hotels.com*, 773 F.3d 1245, 1255, 113 USPQ2d 1097, 1104 (Fed. Cir. 2014); *In re Roslin Institute (Edinburgh)*, 750 F.3d 1333, 1335, 110 USPQ2d 1668, 1670 (Fed. Cir. 2014); *In re Bilski*, 545 F.3d 943, 951, 88 USPQ2d 1385, 1388 (Fed. Cir. 2008) (*en banc*), *aff'd by Bilski v. Kappos*, 561 U.S. 593, 95 USPQ2d 1001 (2010). Thus, the court does not require “evidence” that a claimed concept is a judicial exception, and generally decides the legal conclusion of eligibility without resolving any factual issues. *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1097, 120 USPQ2d 1293, 1298 (Fed. Cir. 2016) (citing *Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1373, 118 USPQ2d 1541, 1544 (Fed. Cir. 2016)); *OIP Techs.*, 788 F.3d at 1362, 115 USPQ2d at 1092; *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1349, 113 USPQ2d 1354, 1359 (Fed. Cir. 2014). In some cases, however, the courts have characterized the issue of whether additional elements are well-understood, routine, conventional activity as an underlying factual issue upon which the legal conclusion of eligibility may be based. See, *e.g., Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1342, 127 USPQ2d 1553, 1557 (Fed. Cir. 2018) (patent eligibility is a question of law that may contain underlying issues of fact), *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1368, 125 USPQ2d 1649, 1654 (Fed. Cir. 2018) (issue of whether additional elements are well-understood, routine, conventional activity is factual).

When performing the analysis at Step 2A Prong One, it is sufficient for the examiner to provide a reasoned rationale that identifies the judicial exception recited in the claim and explains why it is considered a judicial exception (e.g., that the claim limitation(s) falls within one of the abstract idea groupings). Therefore, there is no requirement for the examiner



to rely on evidence, such as publications or an affidavit or declaration under [37 CFR 1.104\(d\)\(2\)](#), to find that a claim recites a judicial exception. *Cf. Affinity Labs of Tex., LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271-72, 120 USPQ2d 1210, 1214-15 (Fed. Cir. 2016) (affirming district court decision that identified an abstract idea in the claims without relying on evidence); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362-64, 115 USPQ2d 1090, 1092-94 (Fed. Cir. 2015) (same); *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347, 113 USPQ2d 1354, 1357-58 (Fed. Cir. 2014) (same).

At Step 2A Prong Two or Step 2B, there is no requirement for evidence to support a finding that the exception is not integrated into a practical application or that the additional elements do not amount to significantly more than the exception unless the examiner asserts that additional limitations are well-understood, routine, conventional activities in Step 2B.

Examiners should not assert that an additional element (or combination of elements) is well-understood, routine, or conventional unless the examiner finds, and expressly supports the rejection in writing with one or more of the following:

(A) A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy [35 U.S.C. 112\(a\)](#). A finding that an element is well-understood, routine, or conventional cannot be based only on the fact that the specification is silent with respect to describing such element.

(B) A citation to one or more of the court decisions discussed in [MPEP § 2106.05\(d\)](#), subsection II, as noting the well-understood, routine, conventional nature of the additional element(s).

Examiners should be careful to ensure the claim limitations before the examiner are the same as those found to be well-understood, routine, conventional by the courts. The additional elements under examination should be recited in the same manner, meaning they should be recited at the same high level of generality as in those court decisions. It is not enough that the additional elements are similar to the elements at issue in those cases. In addition, the court decisions discussed in [MPEP § 2106.05\(d\)](#), subsection II, are not meant to imply that all computer functions are well-understood, routine, conventional functions, or that a claim reciting a generic computer component performing a generic computer function is necessarily ineligible. Examiners should keep in mind that the courts have held computer-implemented processes to be significantly more than an abstract idea (and thus eligible), where generic computer components are able in combination to perform functions that are not merely generic. *DDR Holdings, LLC v. Hotels.com, LP*, 773 F.3d 1245, 1258-59, 113 USPQ2d 1097, 1106-07 (Fed. Cir. 2014). See [MPEP § 2106.05\(f\)](#) for more information about generic computing functions that the courts have found to be mere instructions to implement a judicial exception on a computer.

(C) A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry. It does not include all items that might otherwise qualify as a "printed publication" as used in [35 U.S.C. 102](#). Whether something is disclosed in a document that is considered a "printed publication" under [35 U.S.C. 102](#) is a distinct inquiry from whether something is well-known, routine, conventional activity. A document may be a printed publication but still fail to establish that something it describes is well-understood, routine, conventional activity. See *Exergen Corp. v. Kaz USA*, 725 Fed. App'x. 959, 966 (Fed. Cir. 2018) (the single copy of a thesis, written in German and located in a German university library, considered to be a "printed publication" in *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) "would not suffice to establish that something is 'well-understood, routine, and conventional activity previously engaged in by scientists who work in the field'").

The nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy [35 U.S.C. 112\(a\)](#). For example, while U.S. patents and published applications are publications, merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, unless the patent or published application demonstrates that the additional element is widely prevalent or in common use in the relevant field.

(D) A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). This option should be used only when examiners are certain, based upon their personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy [35 U.S.C. 112\(a\)](#). For example, the examiner could take official notice that a generic computer component performing generic computer functions at a high level of generality, such as using the Internet to gather data, is well-understood, routine, conventional. Procedures for taking official notice and addressing an applicant's challenge to official notice are discussed in [MPEP § 2144.03](#).

### **2106.07(a)(1) Form Paragraphs for use in Lack of Subject Matter Eligibility Rejections [R-01.2024]**

Use form paragraphs 7.04.01, 7.05, and 7.05.01 for rejections based on a failure to claim an invention that falls within any of the statutory categories of invention (i.e., the claim is not to at least one of the four statutory categories of invention and is thus rejected at Step 1 of the eligibility analysis). As a reminder, it is not necessary to identify a single category into which a claim falls, so long as it is

clear that the claim falls into at least one category. See [MPEP § 2106.03](#).

Use form paragraphs 7.04.01, 7.05, and 7.05.016 for rejections based on a failure to claim an invention that is directed to patent-eligible subject matter, i.e., the claim is directed to a judicial exception without providing an inventive concept/significantly more, and is thus rejected at Step 2B of the eligibility analysis. If the judicial exception to which the claim is directed is a "tentative abstract idea," i.e., an abstract idea that does not fall within any of the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#), then the Step 2B rejection must also use form paragraph 7.05.017 (in addition to form paragraphs 7.04.01, 7.05, and 7.05.016) and include the TC Director's signature.

#### **¶ 7.04.01 Statement of Statutory Basis, 35 U.S.C. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

#### **Examiner Note:**

This form paragraph must precede the first use of [35 U.S.C. 101](#) in all first actions on the merits and final rejections.

#### **¶ 7.05 Rejection, 35 U.S.C. 101, -Heading Only- (Utility, Nonstatutory, Inoperative)**

Claim [1] rejected under [35 U.S.C. 101](#) because

#### **Examiner Note:**

1. This form paragraph must be preceded by form paragraph 7.04.01 in first actions and final rejections.
2. This form paragraph must be followed by a detailed explanation of the grounds of rejection using one or more of form paragraphs 7.05.01, 7.05.016, 7.05.017, 7.05.02, 7.05.03, or another appropriate reason.
3. See [MPEP §§ 2105 - 2107.03](#) for additional guidance.

#### **¶ 7.05.01 Rejection, 35 U.S.C. 101, Nonstatutory (Not One of the Four Statutory Categories)**

the claimed invention is directed to nonstatutory subject matter. The claim(s) does/do not fall within at least one of the four categories of patent eligible subject matter because [1]

#### **Examiner Note:**

1. This form paragraph should be preceded by form paragraph 7.05.
2. In bracket 1, explain why the claimed invention is not patent eligible subject matter by identifying what the claim(s) is/are directed to and explain why it does not fall within at least

one of the four categories of patent eligible subject matter recited in [35 U.S.C. 101](#) (process, machine, manufacture, or composition of matter), e.g., the claim(s) is/are directed to a signal *per se*, mere information in the form of data, a contract between two parties, or a human being. Note, it is not necessary for a claim to fall into only a single category, so long as it is clear that it falls into at least one category (see [MPEP § 2106.03](#)).

3. For a claim that is directed to a judicial exception and is nonstatutory, use form paragraph 7.05.016.

**¶ 7.05.016 Rejection, 35 U.S.C. 101, Nonstatutory (Directed to a Judicial Exception without an Inventive Concept/Significantly More)**

the claimed invention is directed to [1] without significantly more. The claim(s) recite(s) [2]. This judicial exception is not integrated into a practical application because [3]. The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because [4].

**Examiner Note:**

1. This form paragraph should be preceded by form paragraph 7.05. For claims that recite a tentative abstract idea (i.e., a limitation identified as an abstract idea even though it does not fall within the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#)), this form paragraph should be accompanied by form paragraph 7.05.017.

2. This form paragraph is for use with all product (machine, manufacture, and composition of matter) and process claims, and for all claims directed to a law of nature, natural phenomenon (including a product of nature), or abstract idea.

3. In bracket 1, identify whether the claim(s) are directed to a law of nature, a natural phenomenon (including a product of nature), or an abstract idea.

4. In bracket 2, identify the exception by referring to how it is recited in the claim and explain why it is considered an exception (e.g., for an abstract idea, identify the abstract idea grouping in [MPEP § 2106.04\(a\)\(2\)](#) into which the recited exception falls). For example, "the Arrhenius equation, which is a law of nature and a mathematical concept which describes the relationship between temperature and reaction rate" or "the series of steps instructing how to hedge risk, which is a fundamental economic practice and thus grouped as a certain method of organizing human interactions." For a product of nature exception, refer to how it is recited in the claim and explain why its characteristics are not markedly different from the product's naturally occurring counterpart in its natural state. For example, "the naturally occurring DNA segment, which is not markedly different from its naturally occurring counterpart because it conveys the same genetic information." Provide additional explanation regarding the exception and how it has been identified when appropriate.

5. In bracket 3, explain why the combination of additional elements fails to integrate the judicial exception into a practical application. For example, if the claim is directed to an abstract idea with additional generic computer elements, explain that the generically recited computer elements do not add a meaningful limitation to the abstract idea because they amount to simply implementing the abstract idea on a computer; or, if

the claim is directed to a method of using a naturally occurring correlation, explain that data gathering steps required to use the correlation do not add a meaningful limitation to the method as they are insignificant extra-solution activity. Similarly, if the claim recites a "naturally occurring DNA segment" with an additional element of a test tube, explain that merely placing the product of nature into a generic container such as a test tube does not add a meaningful limitation as it is merely a nominal or token extra-solution component of the claim, and is nothing more than an attempt to generally link the product of nature to a particular technological environment.

6. In bracket 4, identify the additional elements and explain why, when considered separately and in combination, they do not add significantly more (also known as an "inventive concept") to the exception. For example, if the additional limitations only store and retrieve information in memory, explain that these are well-understood, routine, conventional computer functions as recognized by the court decisions listed in [MPEP § 2106.05\(d\)](#).

**¶ 7.05.017 Rejection, 35 U.S.C. 101, TC Director Approval for "Tentative Abstract Idea"**

The identified claim limitation(s) that recite(s) an abstract idea do/does not fall within the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#), i.e., mathematical concepts, mental processes, or certain methods of organizing human activity. Nonetheless, the claim limitation(s) is/are being treated as reciting an abstract idea because [1].

This rejection has been approved by the Technology Center Director signing below.

[2]

**Examiner Note:**

1. This form paragraph should be preceded by form paragraph 7.05.016.

2. Approval from the TC Director is required to treat a tentative abstract idea (i.e., a claim limitation(s) that does not fall within the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#)) as an abstract idea. This form paragraph should be used to demonstrate that this approval has been obtained.

3. In bracket 1, provide the justification for why the claim limitation(s) is/are being treated as an abstract idea. For example, provide an explanation of why the claim limitation is among the "basic tools of scientific and technological work."

4. In bracket 2, insert the TC Director's signature. Approval of the TC Director is required to treat a claim limitation that does not fall within the groupings of abstract ideas discussed in [MPEP § 2106.04\(a\)\(2\)](#) as reciting an abstract idea. See [MPEP § 2106.04\(a\)\(3\)](#).

**2106.07(b) Evaluating Applicant's Response [R-10.2019]**

After examiners identify and explain in the record the reasons why a claim is directed to an abstract

idea, natural phenomenon, or law of nature without significantly more, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection.

In response to a rejection based on failure to claim patent-eligible subject matter, applicant may: (i) amend the claim, e.g., to add additional elements or modify existing elements so that the claim as a whole amounts to significantly more than the judicial exception, (or integrates the judicial exception into a practical application), (ii) present persuasive arguments based on a good faith belief as to why the rejection is in error and/or (iii) submit evidence traversing a subject matter eligibility rejection according to the procedures set forth in [MPEP § 716.01](#) and [37 CFR 1.132](#). When evaluating a response, examiners must carefully consider all of applicant's arguments and evidence rebutting the subject matter eligibility rejection. If applicant has amended the claim, examiners should determine the amended claim's broadest reasonable interpretation and again perform the subject matter eligibility analysis.

If applicant's claim amendment(s), evidence, and/or argument(s) persuasively establish that the claim is not directed to a judicial exception or is directed to significantly more than a judicial exception, the rejection should be withdrawn. Applicant may argue that a claim is eligible because the claim as a whole integrates the judicial exception into a practical application or amounts to significantly more than the judicial exception when the additional elements are considered both individually and in combination. When an additional element is considered individually by the examiner, the additional element may be enough to integrate the judicial exception into a practical application or to qualify as "significantly more" if it meaningfully limits the judicial exception, e.g., it improves another technology or technical field, improves the functioning of a computer itself.

In addition, even if an element does not integrate a judicial exception into a practical application or amount to significantly more on its own (e.g., because it is merely a generic computer component performing generic computer functions), it can still

integrate or amount to significantly more when considered in combination with the other elements of the claim. For example, generic computer components that individually perform merely generic computer functions (e.g., a CPU that performs mathematical calculations or a clock that produces time data) in some instances are able in combination to perform functions that are not generic computer functions and therefore integrate or amount to significantly more than an abstract idea (and are thus eligible).

If applicant properly challenges the examiner's findings but the examiner deems it appropriate to maintain the rejection, a rebuttal must be provided in the next Office action. Several examples of appropriate examiner responses are provided below.

(1) If applicant challenges the identification of a tentative abstract idea that was based on a court case and the challenge is not persuasive, an appropriate response would be an explanation as to why the abstract idea identified in the claim is similar to the concept in the cited case.

(2) If applicant responds to an examiner's assertion that something is well-known, routine, conventional activity with a specific argument or evidence that the additional elements in a claim are not well-understood, routine, conventional activities previously engaged in by those in the relevant art, the examiner should reevaluate whether the additional elements are in actuality well-known, routine, conventional activities to those who work in the relevant field. It is especially necessary for the examiner to fully reevaluate their position when such additional elements are not discussed in the specification as being known generic functions/components/activities or are not treated by the courts as well-understood, routine, conventional activities. If the rejection is to be maintained, the examiner should consider whether evidence should be provided to further support the rejection and clarify the record for appeal. See [MPEP § 2106.05\(d\)](#) for examples of elements that the courts have found to be well understood, routine and conventional activity. If the examiner has taken official notice per item (D) of subsection III above that an element(s) is well-understood, routine, conventional activity, and the applicant challenges the examiner's position, specifically stating that such



element(s) is not well-understood, routine, conventional activity, the examiner must then provide one of the items discussed in paragraphs (A) through (C) of subsection III above, or an affidavit or declaration under [37 CFR 1.104\(d\)\(2\)](#) setting forth specific factual statements and explanation to support the examiner's position. See also [MPEP § 2106.07\(b\)](#), item (2).

(3) If applicant amends a claim to add a generic computer or generic computer components and asserts that the claim is integrated into a practical application or recites significantly more because the generic computer is 'specially programmed' (as in *Alappat*, now considered superseded) or is a 'particular machine' (as in *Bilski*), the examiner should look at whether the added elements integrate the judicial exception into a practical application or provide significantly more than the judicial exception. Merely adding a generic computer, generic computer components, or a programmed computer to perform generic computer functions does not automatically overcome an eligibility rejection. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 224, 110 USPQ2d 1976, 1984 (2014). See also *OIP Techs. v. Amazon.com*, 788 F.3d 1359, 1364, 115 USPQ2d 1090, 1093-94 (Fed. Cir. 2015) ("Just as *Diehr* could not save the claims in *Alice*, which were directed to 'implement[ing] the abstract idea of intermediated settlement on a generic computer', it cannot save *OIP's* claims directed to implementing the abstract idea of price optimization on a generic computer.") (citations omitted).

(4) If applicant argues that the claim is specific and does not preempt all applications of the exception, the examiner should reconsider Step 2A of the eligibility analysis, *e.g.*, to determine whether the claim is directed to an improvement to the functioning of a computer or to any other technology or technical field. If an examiner still determines that the claim is directed to a judicial exception, the examiner should then reconsider in Step 2B whether the additional elements in combination (as well as individually) amount to an inventive concept, *e.g.*, because they are more than the non-conventional and non-generic arrangement of known, conventional elements. Such reconsideration is appropriate because, although preemption is not a standalone test for eligibility, it remains the underlying concern that drives the two-part framework from *Alice Corp.* and *Mayo* (Steps 2A and 2B). *Synopsys, Inc. v.*

*Mentor Graphics Corp.*, 839 F.3d 1138, 1150, 120 USPQ2d 1473, 1483 (Fed. Cir. 2016); *Rapid Litig. Mgmt. v. CellzDirect, Inc.*, 827 F.3d 1042, 1052, 119 USPQ2d 1370, 1376 (Fed. Cir. 2016); *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379, 115 USPQ2d 1152, 1158 (Fed. Cir. 2015).

### **2106.07(c) Clarifying the Record [R-08.2017]**

When the claims are deemed patent eligible, the examiner may make clarifying remarks on the record. For example, if a claim is found eligible because it improves upon existing technology, the examiner could reference the portion of the specification that describes the claimed improvement and note the claim elements that produce that improvement. The clarifying remarks may be made at any point during prosecution as well as with a notice of allowance.

Clarifying remarks may be useful in explaining the rationale for a rejection as well. For instance, explaining the broadest reasonable interpretation (BRI) of a claim will assist applicant in understanding and responding to a rejection. As an example, a rejection for failure to recite patent eligible subject matter in a claim to a computer readable medium could include an explanation that the broadest reasonable interpretation of the claim covers a carrier wave, which does not fall within one of the four categories of invention, and a suggestion to overcome the rejection by submitting a narrowing amendment to cover the statutory embodiments.

## **2107 Guidelines for Examination of Applications for Compliance with the Utility Requirement [R-11.2013]**

### **I. INTRODUCTION**

The following Guidelines establish the policies and procedures to be followed by Office personnel in the evaluation of any patent application for compliance with the utility requirements of [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#), or [pre-AIA 35 U.S.C. 112](#), first paragraph. These Guidelines have been promulgated to assist Office personnel in their review of applications for compliance with the utility requirement. The Guidelines do not alter the substantive requirements of [35 U.S.C. 101](#) and [35](#)



[U.S.C. 112](#), nor are they designed to obviate the examiner’s review of applications for compliance with all other statutory requirements for patentability. The Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law. Rejections will be based upon the substantive law, and it is these rejections which are appealable. Consequently, any perceived failure by Office personnel to follow these Guidelines is neither appealable nor petitionable.

## II. EXAMINATION GUIDELINES FOR THE UTILITY REQUIREMENT

Office personnel are to adhere to the following procedures when reviewing patent applications for compliance with the “useful invention” (“utility”) requirement of [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

(A) Read the claims and the supporting written description.

(1) Determine what the applicant has claimed, noting any specific embodiments of the invention.

(2) Ensure that the claims define statutory subject matter (i.e., a process, machine, manufacture, composition of matter, or improvement thereof).

(3) If at any time during the examination, it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.

(B) Review the claims and the supporting written description to determine if the applicant has asserted for the claimed invention any specific and substantial utility that is credible:

(1) If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a “specific and substantial utility”) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.

(i) A claimed invention must have a specific and substantial utility. This requirement excludes “throw-away,” “insubstantial,” or “nonspecific” utilities, such as the use of a complex invention as landfill, as a way of satisfying the utility requirement of [35 U.S.C. 101](#).

(ii) Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record (e.g., test data, affidavits or declarations from experts in the art, patents or printed publications) that is probative of the applicant’s assertions. An applicant need only provide one credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement.

(2) If no assertion of specific and substantial utility for the claimed invention made by the applicant is credible, and the claimed invention does not have a readily apparent well-established utility, reject the claim(s) under [35 U.S.C. 101](#) on the grounds that the invention as claimed lacks utility. Also reject the claims under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, on the basis that the disclosure fails to teach how to use the invention as claimed. The [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection imposed in conjunction with a [35 U.S.C. 101](#) rejection should incorporate by reference the grounds of the corresponding [35 U.S.C. 101](#) rejection.

(3) If the applicant has not asserted any specific and substantial utility for the claimed invention and it does not have a readily apparent well-established utility, impose a rejection under [35 U.S.C. 101](#), emphasizing that the applicant has not disclosed a specific and substantial utility for the invention. Also impose a separate rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, on the basis that the applicant has not disclosed how to use the invention due to the lack of a specific and substantial utility. The [35 U.S.C. 101](#) and [35 U.S.C. 112](#) rejections shift the burden of coming forward with evidence to the applicant to:

(i) Explicitly identify a specific and substantial utility for the claimed invention; and

(ii) Provide evidence that one of ordinary skill in the art would have recognized that the identified specific and substantial utility was

well-established at the time of filing. The examiner should review any subsequently submitted evidence of utility using the criteria outlined above. The examiner should also ensure that there is an adequate nexus between the evidence and the properties of the now claimed subject matter as disclosed in the application as filed. That is, the applicant has the burden to establish a probative relation between the submitted evidence and the originally disclosed properties of the claimed invention.

(C) Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the *prima facie* showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for his or her factual conclusions.

(1) Where the asserted utility is not specific or substantial, a *prima facie* showing must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. The *prima facie* showing must contain the following elements:

(i) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial nor well-established;

(ii) Support for factual findings relied upon in reaching this conclusion; and

(iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(2) Where the asserted specific and substantial utility is not credible, a *prima facie* showing of no specific and substantial credible utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention. The *prima facie* showing must contain the following elements:

(i) An explanation that clearly sets forth the reasoning used in concluding that the

asserted specific and substantial utility is not credible;

(ii) Support for factual findings relied upon in reaching this conclusion; and

(iii) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(3) Where no specific and substantial utility is disclosed or is well-established, a *prima facie* showing of no specific and substantial utility need only establish that applicant has not asserted a utility and that, on the record before the examiner, there is no known well-established utility.

(D) A rejection based on lack of utility should not be maintained if an asserted utility for the claimed invention would be considered specific, substantial, and credible by a person of ordinary skill in the art in view of all evidence of record.

Office personnel are reminded that they must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement. Similarly, Office personnel must accept an opinion from a qualified expert that is based upon relevant facts whose accuracy is not being questioned; it is improper to disregard the opinion solely because of a disagreement over the significance or meaning of the facts offered.

Once a *prima facie* showing of no specific and substantial credible utility has been properly established, the applicant bears the burden of rebutting it. The applicant can do this by amending the claims, by providing reasoning or arguments, or by providing evidence in the form of a declaration under [37 CFR 1.132](#) or a patent or a printed publication that rebuts the basis or logic of the *prima facie* showing. If the applicant responds to the *prima facie* rejection, the Office personnel should review the original disclosure, any evidence relied upon in establishing the *prima facie* showing, any claim amendments, and any new reasoning or evidence provided by the applicant in support of an asserted specific and substantial credible utility. It is essential for Office personnel to recognize, fully consider and

respond to each substantive element of any response to a rejection based on lack of utility. Only where the totality of the record continues to show that the asserted utility is not specific, substantial, and credible should a rejection based on lack of utility be maintained.

If the applicant satisfactorily rebuts a *prima facie* rejection based on lack of utility under [35 U.S.C. 101](#), withdraw the [35 U.S.C. 101](#) rejection and the corresponding rejection imposed under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

## 2107.01 General Principles Governing Utility Rejections [R-07.2022]

### 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

See [MPEP § 2107](#) for guidelines for the examination of applications for compliance with the utility requirement of [35 U.S.C. 101](#).

The Office must examine each application to ensure compliance with the “useful invention” or utility requirement of [35 U.S.C. 101](#). In discharging this obligation, however, Office personnel must keep in mind several general principles that control application of the utility requirement. [35 U.S.C. 101](#) has been interpreted as imposing four purposes. First, [35 U.S.C. 101](#) limits an inventor to ONE patent for a claimed invention. If more than one patent is sought, a patent applicant will receive a statutory double patenting rejection for claims included in more than one application that are directed to the same invention. See [MPEP § 804](#). Second, the inventor(s) must be the applicant in an application filed before September 16, 2012, (except as otherwise provided in [pre-AIA 37 CFR 1.41\(b\)](#)) and the inventor or each joint inventor must be identified in an application filed on or after September 16, 2012. See [MPEP § 2109](#) for a detailed discussion of inventorship, [MPEP § 602.01\(c\)](#) *et seq.* for details regarding correction of inventorship, [MPEP § 2157](#) for rejections under [35 U.S.C. 101](#) and [115](#) for failure to set forth the correct inventorship, and [MPEP § 2137](#) for rejections under [pre-AIA 35](#)

[U.S.C. 102\(f\)](#) (for applications subject to [pre-AIA 35 U.S.C. 102](#)) for failure to set forth the correct inventorship. Third, [35 U.S.C. 101](#) defines which categories of inventions are eligible for patent protection. An invention that is not a machine, an article of manufacture, a composition or a process cannot be patented. See *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981); *In re Nuijten*, 500 F.3d 1346, 1354, 84 USPQ2d 1495, 1500 (Fed. Cir. 2007). Fourth, [35 U.S.C. 101](#) serves to ensure that patents are granted on only those inventions that are “useful.” This second purpose has a Constitutional footing — Article I, Section 8 of the Constitution authorizes Congress to provide exclusive rights to inventors to promote the “useful arts.” See *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). Thus, to satisfy the requirements of [35 U.S.C. 101](#), an applicant must claim an invention that is statutory subject matter and must show that the claimed invention is “useful” for some purpose either explicitly or implicitly. Application of this latter element of [35 U.S.C. 101](#) is the focus of these guidelines.

Deficiencies under the “useful invention” requirement of [35 U.S.C. 101](#) will arise in one of two forms. The first is where it is not apparent why the invention is “useful.” This can occur when an applicant fails to identify any specific and substantial utility for the invention or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 26 USPQ2d 1600 (Fed. Cir. 1993). The second type of deficiency arises in the rare instance where an assertion of specific and substantial utility for the invention made by an applicant is not credible.

### I. SPECIFIC AND SUBSTANTIAL REQUIREMENTS

To satisfy [35 U.S.C. 101](#), an invention must be “useful.” Courts have recognized that the term “useful” used with reference to the utility requirement can be a difficult term to define.

*Brenner v. Manson*, 383 U.S. 519, 529, 148 USPQ 689, 693 (1966) (simple everyday word like “useful” can be “pregnant with ambiguity when applied to the facts of life.”). Where an applicant has set forth a specific and substantial utility, courts have been reluctant to uphold a rejection under [35 U.S.C. 101](#) solely on the basis that the applicant’s opinion as to the nature of the specific and substantial utility was inaccurate. For example, in *Nelson v. Bowler*, 626 F.2d 853, 206 USPQ 881 (CCPA 1980), the court reversed a finding by the Office that the applicant had not set forth a “practical” utility under [35 U.S.C. 101](#). In this case the applicant asserted that the composition was “useful” in a particular pharmaceutical application and provided evidence to support that assertion. Courts have used the labels “practical utility,” “substantial utility,” or “specific utility” to refer to this aspect of the “useful invention” requirement of [35 U.S.C. 101](#). The Court of Customs and Patent Appeals has stated:

Practical utility is a shorthand way of attributing “real-world” value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public.

*Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980).

Practical considerations require the Office to rely on the inventor’s understanding of the invention in determining whether and in what regard an invention is believed to be “useful.” Because of this, Office personnel should focus on and be receptive to assertions made by the applicant that an invention is “useful” for a particular reason.

#### A. *Specific Utility*

A “specific utility” is *specific* to the subject matter claimed and can “provide a well-defined and particular benefit to the public.” *In re Fisher*, 421 F.3d 1365, 1371, 76 USPQ2d 1225, 1230 (Fed. Cir. 2005). This contrasts with a *general* utility that would be applicable to the broad class of the invention. Office personnel should distinguish between situations where an applicant has disclosed

a specific use for or application of the invention and situations where the applicant merely indicates that the invention may prove useful without identifying with specificity why it is considered useful. For example, indicating that a compound may be useful in treating unspecified disorders, or that the compound has “useful biological” properties, would not be sufficient to define a specific utility for the compound. See, e.g., *In re Kirk*, 376 F.2d 936, 153 USPQ 48 (CCPA 1967); *In re Joly*, 376 F.2d 906, 153 USPQ 45 (CCPA 1967). Similarly, a claim to a polynucleotide whose use is disclosed simply as a “gene probe” or “chromosome marker” would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. See *In re Fisher*, 421 F.3d at 1374, 76 USPQ2d at 1232 (“Any EST [expressed sequence tag] transcribed from any gene in the maize genome has the potential to perform any one of the alleged uses.... Nothing about [applicant’s] seven alleged uses set the five claimed ESTs apart from the more than 32,000 ESTs disclosed in the [ ] application or indeed from any EST derived from any organism. Accordingly, we conclude that [applicant] has only disclosed general uses for its claimed ESTs, not specific ones that satisfy [§ 101](#).”). A general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed. Contrast the situation where an applicant discloses a specific biological activity and reasonably correlates that activity to a disease condition. Assertions falling within the latter category are sufficient to identify a specific utility for the invention. Assertions that fall in the former category are insufficient to define a specific utility for the invention, especially if the assertion takes the form of a general statement that makes it clear that a “useful” invention may arise from what has been disclosed by the applicant. *Knapp v. Anderson*, 477 F.2d 588, 177 USPQ 688 (CCPA 1973).

#### B. *Substantial Utility*

“[A]n application must show that an invention is useful to the public as disclosed in its current form, not that it may prove useful at some future date after further research. Simply put, to satisfy the ‘substantial’ utility requirement, an asserted use must show that the claimed invention has a significant

and presently available benefit to the public.” *Fisher*, 421 F.3d at 1371, 76 USPQ2d at 1230. The claims at issue in *Fisher* were directed to expressed sequence tags (ESTs), which are short nucleotide sequences that can be used to discover what genes and downstream proteins are expressed in a cell. The court held that “the claimed ESTs can be used only to gain further information about the underlying genes and the proteins encoded for by those genes. The claimed ESTs themselves are not an end of [the inventor’s] research effort, but only tools to be used along the way in the search for a practical utility.... [Applicant] does not identify the function for the underlying protein-encoding genes. Absent such identification, we hold that the claimed ESTs have not been researched and understood to the point of providing an immediate, well-defined, real world benefit to the public meriting the grant of a patent.”

*Id.* at 1376, 76 USPQ2d at 1233-34). Thus a “substantial utility” defines a “real world” use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a “real world” context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a “substantial utility” define a “real world” context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a “real world” context of use in identifying potential candidates for preventive measures or further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a “real world” context of use and, therefore, do not define “substantial utilities”:

- (A) Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved;
- (B) A method of treating an *unspecified* disease or condition;
- (C) A method of assaying for or identifying a material that itself has no specific and/or substantial utility;
- (D) A method of making a material that itself has no specific, substantial, and credible utility; and

(E) A claim to an intermediate product for use in making a final product that has no specific, substantial and credible utility.

Office personnel must be careful not to interpret the phrase “immediate benefit to the public” or similar formulations in other cases to mean that products or services based on the claimed invention must be “currently available” to the public in order to satisfy the utility requirement. See, e.g., *Brenner v. Manson*, 383 U.S. 519, 534-35, 148 USPQ 689, 695 (1966). Rather, any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining a “substantial” utility.

### C. Research Tools

Some confusion can result when one attempts to label certain types of inventions as not being capable of having a specific and substantial utility based on the setting in which the invention is to be used. One example is inventions to be used in a research or laboratory setting. Many research tools such as gas chromatographs, screening assays, and nucleotide sequencing techniques have a clear, specific and unquestionable utility (e.g., they are useful in analyzing compounds). An assessment that focuses on whether an invention is useful only in a research setting thus does not address whether the invention is in fact “useful” in a patent sense. Instead, Office personnel must distinguish between inventions that have a specifically identified substantial utility and inventions whose asserted utility requires further research to identify or reasonably confirm. Labels such as “research tool,” “intermediate” or “for research purposes” are not helpful in determining if an applicant has identified a specific and substantial utility for the invention.

## II. WHOLLY INOPERATIVE INVENTIONS; “INCREDIBLE” UTILITY

An invention that is “inoperative” (i.e., it does not operate to produce the results claimed by the patent applicant) is not a “useful” invention in the meaning of the patent law. See, e.g., *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) (“An inoperative



invention, of course, does not satisfy the requirement of [35 U.S.C. 101](#) that an invention be useful.”) However, as the Federal Circuit has stated, “[t]o violate [\[35 U.S.C.\] 101](#) the claimed device must be totally incapable of achieving a useful result.” *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added). See also *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980) (“A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial function . . . An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely . . . A commercially successful product is not required . . . Nor is it essential that the invention accomplish all its intended functions . . . or operate under all conditions . . . partial success being sufficient to demonstrate patentable utility . . . In short, the defense of non-utility cannot be sustained without proof of total incapacity.” If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a lack of utility is not appropriate. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA), *reh’g denied*, 480 F.2d 879 (CCPA 1973); *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971).

Situations where an invention is found to be “inoperative” and therefore lacking in utility are rare, and rejections maintained solely on this ground by a federal court even rarer. In many of these cases, the utility asserted by the applicant was thought to be “incredible in the light of the knowledge of the art, or factually misleading” when initially considered by the Office. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). Other cases suggest that on initial evaluation, the Office considered the asserted utility to be inconsistent with known scientific principles or “speculative at best” as to whether attributes of the invention necessary to impart the asserted utility were actually present in the invention. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977). However cast, the underlying finding by the court in these cases was that, based on the factual record of the case, it was

clear that the invention could not and did not work as the inventor claimed it did. Indeed, the use of many labels to describe a single problem (e.g., a false assertion regarding utility) has led to some of the confusion that exists today with regard to a rejection based on the “utility” requirement. Examples of such cases include: an invention asserted to change the taste of food using a magnetic field (*Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985)), a perpetual motion machine (*Newman v. Quigg*, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989)), a flying machine operating on “flapping or flutter function” (*In re Houghton*, 433 F.2d 820, 167 USPQ 687 (CCPA 1970)), a “cold fusion” process for producing energy (*In re Swartz*, 232 F.3d 862, 56 USPQ2d 1703 (Fed. Cir. 2000)), a method for increasing the energy output of fossil fuels upon combustion through exposure to a magnetic field (*In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966)), uncharacterized compositions for curing a wide array of cancers (*In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963)), and a method of controlling the aging process (*In re Eltgroth*, 419 F.2d 918, 164 USPQ 221 (CCPA 1970)). These examples are fact specific and should not be applied as a *per se* rule. Thus, in view of the rare nature of such cases, Office personnel should not label an asserted utility “incredible,” “speculative” or otherwise unless it is clear that a rejection based on “lack of utility” is proper.

### III. THERAPEUTIC OR PHARMACOLOGICAL UTILITY

Inventions asserted to have utility in the treatment of human or animal disorders are subject to the same legal requirements for utility as inventions in any other field of technology. *In re Chilowsky*, 229 F.2d 457, 461-2, 108 USPQ 321, 325 (CCPA 1956) (“There appears to be no basis in the statutes or decisions for requiring any more conclusive evidence of operativeness in one type of case than another. The character and amount of evidence needed may vary, depending on whether the alleged operation described in the application appears to accord with or to contravene established scientific principles or to depend upon principles alleged but not generally recognized, but the degree of certainty as to the ultimate fact of operativeness or inoperativeness should be the same in all cases”); *In re Gazave*, 379

F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967) (“Thus, in the usual case where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required.”). As such, pharmacological or therapeutic inventions that provide any “immediate benefit to the public” satisfy [35 U.S.C. 101](#). The utility being asserted in *Nelson* related to a compound with pharmacological utility.

*Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980). Office personnel should rely on *Nelson* and other cases as providing general guidance when evaluating the utility of an invention that is based on any therapeutic, prophylactic, or pharmacological activities of that invention.

Courts have repeatedly found that the mere identification of a pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an “immediate benefit to the public” and thus satisfies the utility requirement. As the Court of Customs and Patent Appeals held in *Nelson v. Bowler*:

Knowledge of the pharmacological activity of any compound is obviously beneficial to the public. It is inherently faster and easier to combat illnesses and alleviate symptoms when the medical profession is armed with an arsenal of chemicals having known pharmacological activities. Since it is crucial to provide researchers with an incentive to disclose pharmacological activities in as many compounds as possible, we conclude that adequate proof of any such activity constitutes a showing of practical utility.

*Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980).

In *Nelson v. Bowler*, the court addressed the practical utility requirement in the context of an interference proceeding. Bowler challenged the patentability of the invention claimed by Nelson on the basis that Nelson had failed to sufficiently and persuasively disclose in his application a practical utility for the invention. Nelson had developed and claimed a class of synthetic prostaglandins modeled

on naturally occurring prostaglandins. Naturally occurring prostaglandins are bioactive compounds that, at the time of Nelson’s application, had a recognized value in pharmacology (e.g., the stimulation of uterine smooth muscle which resulted in labor induction or abortion, the ability to raise or lower blood pressure, etc.). To support the utility he identified in his disclosure, Nelson included in his application the results of tests demonstrating the bioactivity of his new substituted prostaglandins relative to the bioactivity of naturally occurring prostaglandins. The court concluded that Nelson had satisfied the practical utility requirement in identifying the synthetic prostaglandins as pharmacologically active compounds. In reaching this conclusion, the court considered and rejected arguments advanced by Bowler that attacked the evidentiary basis for Nelson’s assertions that the compounds were pharmacologically active.

In *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980), an inventor claimed protection for pharmaceutical compositions for treating leukemia. The active ingredient in the compositions was a structural analog to a known anticancer agent. The applicant provided evidence showing that the claimed analogs had the same general pharmaceutical activity as the known anticancer agents. The court reversed the Board’s finding that the asserted pharmaceutical utility was “incredible,” pointing to the evidence that showed the relevant pharmacological activity.

In *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985), the Federal Circuit affirmed a finding by the Board of Patent Appeals and Interferences that a pharmacological utility had been disclosed in the application of one party to an interference proceeding. The invention that was the subject of the interference count was a chemical compound used for treating blood disorders. Cross had challenged the evidence in Iizuka’s specification that supported the claimed utility. However, the Federal Circuit relied extensively on *Nelson v. Bowler* in finding that Iizuka’s application had sufficiently disclosed a pharmacological utility for the compounds. It distinguished the case from cases where only a generalized “nebulous” expression, such as “biological properties,” had been disclosed in a specification. Such statements, the

court held, “convey little explicit indication regarding the utility of a compound.” *Cross*, 753 F.2d at 1048, 224 USPQ at 745 (citing *In re Kirk*, 376 F.2d 936, 941, 153 USPQ 48, 52 (CCPA 1967)).

Similarly, courts have found utility for therapeutic inventions despite the fact that an inventor is at a very early stage in the development of a pharmaceutical product or therapeutic regimen based on a claimed pharmacological or bioactive compound or composition. The Federal Circuit, in *Cross v. Iizuka*, 753 F.2d 1040, 1051, 224 USPQ 739, 747-48 (Fed. Cir. 1985), commented on the significance of data from *in vitro* testing that showed pharmacological activity:

We perceive no insurmountable difficulty, under appropriate circumstances, in finding that the first link in the screening chain, *in vitro* testing, may establish a practical utility for the compound in question. Successful *in vitro* testing will marshal resources and direct the expenditure of effort to further *in vivo* testing of the most potent compounds, thereby providing an immediate benefit to the public, analogous to the benefit provided by the showing of an *in vivo* utility.

The Federal Circuit has reiterated that therapeutic utility sufficient under the patent laws is not to be confused with the requirements of the FDA with regard to safety and efficacy of drugs to marketed in the United States.

FDA approval, however, is not a prerequisite for finding a compound useful within the meaning of the patent laws. *Scott v. Finney*, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 [(Fed.Cir. 1994)]. Usefulness in patent law, and in particular in the context of pharmaceutical inventions, necessarily includes the expectation of further research and development. The stage at which an invention in this field becomes useful is well before it is ready to be administered to humans. Were we to require Phase II testing in order to prove utility, the associated costs would prevent many companies from obtaining patent protection on promising new inventions, thereby eliminating an

incentive to pursue, through research and development, potential cures in many crucial areas such as the treatment of cancer.

*In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). Accordingly, Office personnel should not construe [35 U.S.C. 101](#), under the logic of “practical” utility or otherwise, to require that an applicant demonstrate that a therapeutic agent based on a claimed invention is a safe or fully effective drug for humans. See, e.g., *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Anthony*, 414 F.2d 1383, 162 USPQ 594 (CCPA 1969); *In re Watson*, 517 F.2d 465, 186 USPQ 11 (CCPA 1975).

These general principles are equally applicable to situations where an applicant has claimed a process for treating a human or animal disorder. In such cases, the asserted utility is usually clear — the invention is asserted to be useful in treating the particular disorder. If the asserted utility is credible, there is no basis to challenge such a claim on the basis that it lacks utility under [35 U.S.C. 101](#).

See [MPEP § 2107.03](#) for special considerations for asserted therapeutic or pharmacological utilities.

#### **IV. RELATIONSHIP BETWEEN 35 U.S.C. 112(a) or PRE-AIA 35 U.S.C. 112, FIRST PARAGRAPH, AND 35 U.S.C. 101**

A deficiency under the utility prong of [35 U.S.C. 101](#) also creates a deficiency under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Jolles*, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); *In re Fouche*, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) (“If such compositions are in fact useless, appellant’s specification cannot have taught how to use them.”). Courts have also cast the [35 U.S.C. 101/35 U.S.C. 112](#) relationship such that [35 U.S.C. 112](#) presupposes compliance with [35 U.S.C. 101](#). See *In re Ziegler*, 992 F.2d 1197, 1200-1201, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) (“The how to use prong of [section 112](#) incorporates as a matter of law the requirement of [35 U.S.C. 101](#) that the specification disclose as a matter of fact a practical

utility for the invention. ... If the application fails as a matter of fact to satisfy [35 U.S.C. § 101](#), then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under [35 U.S.C. § 112](#).”); *In re Kirk*, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) (“Necessarily, compliance with [§ 112](#) requires a description of how to use presently useful inventions, otherwise an applicant would anomalously be required to teach how to use a useless invention.”). For example, the Federal Circuit noted, “[o]bviously, if a claimed invention does not have utility, the specification cannot enable one to use it.” *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). As such, a rejection properly imposed under [35 U.S.C. 101](#) for lack of utility should be accompanied with a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. It is equally clear that a rejection based on “lack of utility,” whether grounded upon [35 U.S.C. 101](#) or [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rests on the same basis (i.e., the asserted utility is not credible). To avoid confusion, any lack of utility rejection that is imposed on the basis of [35 U.S.C. 101](#) should be accompanied by a rejection based on [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. The [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection should be set out as a separate rejection that incorporates by reference the factual basis and conclusions set forth in the [35 U.S.C. 101](#) rejection. The [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. A [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection based on lack of utility should not be imposed or maintained unless an appropriate basis exists for imposing a utility rejection under [35 U.S.C. 101](#). In other words, Office personnel should not impose a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection grounded on a “lack of utility” basis unless a [35 U.S.C. 101](#) rejection is proper. In particular, the factual showing needed to impose a rejection under [35 U.S.C. 101](#) must be provided if a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, is to be imposed on “lack of utility” grounds.

It is important to recognize that [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, addresses matters other than those related to the question of whether or not an invention lacks utility. These matters include whether the claims are fully supported by the disclosure (*In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)), whether the applicant has provided an enabling disclosure of the claimed subject matter (*In re Wright*, 999 F.2d 1557, 1561-1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)), whether the applicant has provided an adequate written description of the invention and whether the applicant has disclosed the best mode of practicing the claimed invention (*Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927-928, 16 USPQ2d 1033, 1036-1037 (Fed. Cir. 1990)). See also *Transco Products Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 34 USPQ2d 1565 (Fed. Cir. 1995). The fact that an applicant has disclosed a specific utility for an invention and provided a credible basis supporting that specific utility does not provide a basis for concluding that the claims comply with all the requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. For example, if an applicant has claimed a process of treating a certain disease condition with a certain compound and provided a credible basis for asserting that the compound is useful in that regard, but to actually practice the invention as claimed a person skilled in the relevant art would have to engage in an undue amount of experimentation, the claim may be defective under [35 U.S.C. 112](#), but not [35 U.S.C. 101](#). To avoid confusion during examination, any rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, based on grounds other than “lack of utility” should be imposed separately from any rejection imposed due to “lack of utility” under [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.



## 2107.02 Procedural Considerations Related to Rejections for Lack of Utility [R-07.2022]

### I. THE CLAIMED INVENTION IS THE FOCUS OF THE UTILITY REQUIREMENT

The claimed invention is the focus of the assessment of whether an applicant has satisfied the utility requirement. Each claim (i.e., each “invention”), therefore, must be evaluated on its own merits for compliance with all statutory requirements. Generally speaking, however, a dependent claim will define an invention that has utility if the independent claim from which the dependent claim depends is drawn to the same statutory class of invention as the dependent claim and the independent claim defines an invention having utility. An exception to this general rule is where the utility specified for the invention defined in a dependent claim differs from that indicated for the invention defined in the independent claim from which the dependent claim depends. Where an applicant has established utility for a species that falls within an identified genus of compounds, and presents a generic claim covering the genus, as a general matter, that claim should be treated as being sufficient under [35 U.S.C. 101](#). Only where it can be established that other species clearly encompassed by the claim do not have utility should a rejection be imposed on the generic claim. In such cases, the applicant should be encouraged to amend the generic claim so as to exclude the species that lack utility.

It is common and sensible for an applicant to identify several specific utilities for an invention, particularly where the invention is a product (e.g., a machine, an article of manufacture or a composition of matter). However, regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy [35 U.S.C. 101](#) and [35 U.S.C. 112](#); additional statements of utility, even if not “credible,” do not render the claimed invention lacking in utility. See, e.g., *Raytheon v. Roper*, 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984) (“When a properly claimed invention meets at least one stated objective, utility under [35 U.S.C. 101](#) is clearly shown.”); *In re Gottlieb*, 328 F.2d 1016, 1019, 140 USPQ 665, 668 (CCPA 1964)

(“Having found that the antibiotic is useful for some purpose, it becomes unnecessary to decide whether it is in fact useful for the other purposes ‘indicated’ in the specification as possibly useful.”); *In re Malachowski*, 530 F.2d 1402, 189 USPQ 432 (CCPA 1976); *Hoffman v. Klaus*, 9 USPQ2d 1657 (Bd. Pat. App. & Inter. 1988). Thus, if applicant makes one credible assertion of utility, utility for the claimed invention as a whole is established.

Statements made by the applicant in the specification or incident to prosecution of the application before the Office cannot, standing alone, be the basis for a lack of utility rejection under [35 U.S.C. 101](#) or [35 U.S.C. 112](#). *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.h.*, 945 F.2d 1546, 1553, 20 USPQ2d 1332, 1338 (Fed. Cir. 1991) (It is not required that a particular characteristic set forth in the prosecution history be achieved in order to satisfy [35 U.S.C. 101](#)). An applicant may include statements in the specification whose technical accuracy cannot be easily confirmed if those statements are not necessary to support the patentability of an invention with regard to any statutory basis. Thus, the Office should not require an applicant to strike nonessential statements relating to utility from a patent disclosure, regardless of the technical accuracy of the statement or assertion it presents. Office personnel should also be especially careful not to read into a claim unclaimed results, limitations or embodiments of an invention. See *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961). Doing so can inappropriately change the relationship of an asserted utility to the claimed invention and raise issues not relevant to examination of that claim.

### II. IS THERE AN ASSERTED OR WELL-ESTABLISHED UTILITY FOR THE CLAIMED INVENTION?

Upon initial examination, the examiner should review the specification to determine if there are any statements asserting that the claimed invention is useful for any particular purpose. A complete disclosure should include a statement which identifies a specific and substantial utility for the invention.



### ***A. An Asserted Utility Must Be Specific and Substantial***

A statement of specific and substantial utility should fully and clearly explain why the applicant asserts the invention is useful. Such statements will usually explain the purpose of or how the invention may be used (e.g., a compound is believed to be useful in the treatment of a particular disorder). Regardless of the form of statement of utility, it must enable one ordinarily skilled in the art to understand why the applicant asserts the claimed invention is useful.

Except where an invention has a well-established utility, the failure of an applicant to specifically identify why an invention is believed to be useful renders the claimed invention deficient under [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. In such cases, the applicant has failed to identify a “specific and substantial utility” for the claimed invention. For example, a statement that a composition has an unspecified “biological activity” or that does not explain why a composition with that activity is believed to be useful fails to set forth a “specific and substantial utility.” *Brenner v. Manson*, 383 US 519, 148 USPQ 689 (1966) (general assertion of similarities to known compounds known to be useful without sufficient corresponding explanation why claimed compounds are believed to be similarly useful insufficient under [35 U.S.C. 101](#)); *In re Ziegler*, 992 F.2d 1197, 1201, 26 USPQ2d 1600, 1604 (Fed. Cir. 1993) (disclosure that composition is “plastic-like” and can form “films” not sufficient to identify specific and substantial utility for invention); *In re Kirk*, 376 F.2d 936, 153 USPQ 48 (CCPA 1967) (indication that compound is “biologically active” or has “biological properties” insufficient standing alone). See also *In re Joly*, 376 F.2d 906, 153 USPQ 45 (CCPA 1967); *Kawai v. Metlesics*, 480 F.2d 880, 890, 178 USPQ 158, 165 (CCPA 1973) (contrasting description of invention as sedative which did suggest specific utility to general suggestion of “pharmacological effects on the central nervous system” which did not). In contrast, a disclosure that identifies a particular biological activity of a compound and explains how that activity can be utilized in a particular therapeutic application of the compound

does contain an assertion of specific and substantial utility for the invention.

Situations where an applicant either fails to indicate why an invention is considered useful, or where the applicant inaccurately describes the utility should rarely arise. One reason for this is that applicants are required to disclose the best mode known to them of practicing the invention at the time they file their application. An applicant who omits a description of the specific and substantial utility of the invention, or who incompletely describes that utility, may encounter problems with respect to the best mode requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

### ***B. No Statement of Utility for the Claimed Invention in the Specification Does Not Per Se Negate Utility***

Occasionally, an applicant will not explicitly state in the specification or otherwise assert a specific and substantial utility for the claimed invention. If no statements can be found asserting a specific and substantial utility for the claimed invention in the specification, Office personnel should determine if the claimed invention has a well-established utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible. If an invention has a well-established utility, rejections under [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, based on lack of utility should not be imposed. *In re Folkers*, 344 F.2d 970, 145 USPQ 390 (CCPA 1965). For example, if an application teaches the cloning and characterization of the nucleotide sequence of a well-known protein such as insulin, and those skilled in the art at the time of filing knew that insulin had a well-established use, it would be improper to reject the claimed invention as lacking utility solely because of the omitted statement of specific and substantial utility.

If a person of ordinary skill would not immediately recognize a specific and substantial utility for the claimed invention (i.e., why it would be useful) based on the characteristics of the invention or

statements made by the applicant, the examiner should reject the application under [35 U.S.C. 101](#) and under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as failing to identify a specific and substantial utility for the claimed invention. The rejection should clearly indicate that the basis of the rejection is that the application fails to identify a specific and substantial utility for the invention. The rejection should also specify that the applicant must reply by indicating why the invention is believed useful and where support for any subsequently asserted utility can be found in the specification as filed. See [MPEP § 2701](#).

If the applicant subsequently indicates why the invention is useful, Office personnel should review that assertion according to the standards articulated below for review of the credibility of an asserted utility.

### III. EVALUATING THE CREDIBILITY OF AN ASSERTED UTILITY

#### A. An Asserted Utility Creates a Presumption of Utility

In most cases, an applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of [35 U.S.C. 101](#). See, e.g., *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (CCPA 1965); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-13 (CCPA 1977). As the Court of Customs and Patent Appeals stated in *In re Langer*:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of [§ 101](#) for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope.

*In re Langer*, 503 F.2d at 1391, 183 USPQ at 297 (emphasis in original). The “Langer” test for utility has been used by both the Federal Circuit and the Court of Customs and Patent Appeals in evaluation

of rejections under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, where the rejection is based on a deficiency under [35 U.S.C. 101](#). In *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995), the Federal Circuit explicitly adopted the Court of Customs and Patent Appeals formulation of the “Langer” standard for [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph rejections, as it was expressed in a slightly reworded format in *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971), namely:

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of [§ 112](#) unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (emphasis added).

Thus, *Langer* and subsequent cases direct the Office to presume that a statement of utility made by an applicant is true. See *In re Langer*, 503 F.2d at 1391, 183 USPQ at 297; *In re Malachowski*, 530 F.2d 1402, 1404, 189 USPQ 432, 435 (CCPA 1976); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). For obvious reasons of efficiency and in deference to an applicant's understanding of the invention, when a statement of utility is evaluated, Office personnel should not begin by questioning the truth of the statement of utility. Instead, any inquiry must start by asking if there is any reason to question the truth of the statement of utility. This can be done by simply evaluating the logic of the statements made, taking into consideration any evidence cited by the applicant. If the asserted utility is credible (i.e., believable based on the record or the nature of the invention), a rejection based on “lack of utility” is not appropriate. Clearly, Office personnel should not begin an evaluation of utility by assuming that an asserted utility is likely to be false, based on the technical field of the invention or for other general reasons.

Compliance with [35 U.S.C. 101](#) is a question of fact. *Raytheon v. Roper*, 724 F.2d 951, 956, 220 USPQ

592, 596 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 835 (1984). Thus, to overcome the presumption of truth that an assertion of utility by the applicant enjoys, Office personnel must establish that it is more likely than not that one of ordinary skill in the art would doubt (i.e., “question”) the truth of the statement of utility. The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the totality of the evidence under consideration. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”); *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985). A preponderance of the evidence exists when it suggests that it is more likely than not that the assertion in question is true. *Herman v. Huddleston*, 459 U.S. 375, 390 (1983). To do this, Office personnel must provide evidence sufficient to show that the statement of asserted utility would be considered “false” by a person of ordinary skill in the art. Of course, a person of ordinary skill must have the benefit of both facts and reasoning in order to assess the truth of a statement. This means that if the applicant has presented facts that support the reasoning used in asserting a utility, Office personnel must present countervailing facts and reasoning sufficient to establish that a person of ordinary skill would not believe the applicant’s assertion of utility. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). The initial evidentiary standard used during evaluation of this question is a preponderance of the evidence (i.e., the totality of facts and reasoning suggest that it is more likely than not that the statement of the applicant is false).

#### ***B. When Is an Asserted Utility Not Credible?***

Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being “wrong,” even when there may be reason to believe that the assertion is not entirely accurate. Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of

evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility.

One situation where an assertion of utility would not be considered credible is where a person of ordinary skill would consider the assertion to be “incredible in view of contemporary knowledge” and where nothing offered by the applicant would counter what contemporary knowledge might otherwise suggest. Office personnel should be careful, however, not to label certain types of inventions as “incredible” or “speculative” as such labels do not provide the correct focus for the evaluation of an assertion of utility. “Incredible utility” is a conclusion, not a starting point for analysis under [35 U.S.C. 101](#). A conclusion that an asserted utility is incredible can be reached only after the Office has evaluated both the assertion of the applicant regarding utility and any evidentiary basis of that assertion. The Office should be particularly careful not to start with a presumption that an asserted utility is, *per se*, “incredible” and then proceed to base a rejection under [35 U.S.C. 101](#) on that presumption.

Rejections under [35 U.S.C. 101](#) based on a lack of credible utility have been sustained by federal courts when, for example, the applicant failed to disclose any utility for the invention or asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art. *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967). Special care should be taken when assessing the credibility of an asserted therapeutic utility for a claimed invention. In such cases, a previous lack of success in treating a disease or condition, or the absence of a proven animal model for testing the effectiveness of drugs for treating a disorder in humans, should not, standing alone, serve as a basis for challenging the asserted utility under [35 U.S.C. 101](#). See [MPEP § 2107.03](#) for additional guidance with regard to therapeutic or pharmacological utilities.

#### IV. INITIAL BURDEN IS ON THE OFFICE TO ESTABLISH A *PRIMA FACIE* CASE AND PROVIDE EVIDENTIARY SUPPORT THEREOF

To properly reject a claimed invention under [35 U.S.C. 101](#), the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975) "Accordingly, the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." If the Office cannot develop a proper *prima facie* case and provide evidentiary support for a rejection under [35 U.S.C. 101](#), a rejection on this ground should not be imposed. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.... If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent."). See also *Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985) (applying *prima facie* case law to [35 U.S.C. 101](#)); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The *prima facie* showing must be set forth in a well-reasoned statement. Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the *prima facie* showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for the examiner's factual conclusions.

Where the asserted utility is not specific or substantial, a *prima facie* showing must establish

that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. The *prima facie* showing must contain the following elements:

(A) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is neither both specific and substantial nor well-established;

(B) Support for factual findings relied upon in reaching this conclusion; and

(C) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

Where the asserted specific and substantial utility is not credible, a *prima facie* showing of no specific and substantial credible utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention. The *prima facie* showing must contain the following elements:

(A) An explanation that clearly sets forth the reasoning used in concluding that the asserted specific and substantial utility is not credible;

(B) Support for factual findings relied upon in reaching this conclusion; and

(C) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

Where no specific and substantial utility is disclosed or is well-established, a *prima facie* showing of no specific and substantial utility need only establish that applicant has not asserted a utility and that, on the record before the examiner, there is no known well-established utility.

It is imperative that Office personnel use specificity in setting forth and initial rejection under [35 U.S.C. 101](#) and support any factual conclusions made in the *prima facie* showing.

By using specificity, the applicant will be able to identify the assumptions made by the Office in setting forth the rejection and will be able to address those assumptions properly.



Use form paragraphs 7.04.01 and 7.05.02 through 7.05.04 to reject claims under [35 U.S.C. 101](#) for failure to satisfy the utility requirement.

**¶ 7.05.02 Rejection, 35 U.S.C. 101, Utility Lacking**

the claimed invention lacks patentable utility. [1]

**Examiner Note:**

In bracket 1, provide explanation of lack of utility. See [MPEP §§ 2105 - 2107.03](#).

**¶ 7.05.03 Rejection, 35 U.S.C. 101, Inoperative**

the disclosed invention is inoperative and therefore lacks utility. [1]

**Examiner Note:**

In bracket 1, explain why invention is inoperative.

**¶ 7.05.04 Utility Rejections Under 35 U.S.C. 101 and 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), First Paragraph**

Claim [1] rejected under [35 U.S.C. 101](#) because the claimed invention is not supported by either a [2] asserted utility or a well established utility.

[3]

Claim [4] also rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. Specifically, because the claimed invention is not supported by either a [5] asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

**Examiner Note:**

- Where the specification would not enable one skilled in the art to make the claimed invention, or where alternative reasons support the enablement rejection, a separate rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, enablement should be made using the factors set forth in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) and an undue experimentation analysis. See [MPEP §§ 2164 - 2164.08\(c\)](#).
- Use Format A, B, or C below as appropriate.

**Format A:**

- Insert the same claim numbers in brackets 1 and 4.
- Insert --specific and substantial-- in inserts 2 and 5.
- In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.
- Format A is to be used when there is no asserted utility and when there is an asserted utility but that utility is not specific and substantial.

**Format B:**

- Insert the same claim numbers in brackets 1 and 4.
- Insert --credible-- in inserts 2 and 5.
- In bracket 3, insert the explanation as to why the claimed invention is not supported by either a credible asserted utility or a well established utility.

**Format C:**

For claims that have multiple utilities, some of which are not specific and substantial, some of which are not credible, but none of which are specific, substantial and credible:

- Insert the same claim numbers in brackets 1 and 4.
- Insert --specific and substantial asserted utility, a credible-- in inserts 2 and 5.
- In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility, a credible asserted utility or a well established utility. Each utility should be addressed.

**V. EVIDENTIARY REQUESTS BY AN EXAMINER TO SUPPORT AN ASSERTED UTILITY**

In appropriate situations the Office may require an applicant to substantiate an asserted utility for a claimed invention. See *In re Pottier*, 376 F.2d 328, 330, 153 USPQ 407, 408 (CCPA 1967) (“When the operativeness of any process would be deemed unlikely by one of ordinary skill in the art, it is not improper for the examiner to call for evidence of operativeness.”). See also *In re Jolles*, 628 F.2d 1322, 1327, 206 USPQ 885, 890 (CCPA 1980); *In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963); *In re Novak*, 306 F.2d 924, 928, 134 USPQ 335, 337 (CCPA 1962). In *In re Citron*, the court held that when an “alleged utility appears to be incredible in the light of the knowledge of the art, or factually misleading, applicant must establish the asserted utility by acceptable proof.” 325 F.2d at 253, 139 USPQ at 520. The court approved of the board’s decision which affirmed the rejection under [35 U.S.C. 101](#) “in view of the art knowledge of the lack of a cure for cancer and the absence of any clinical data to substantiate the allegation.” 325 F.2d at 252, 139 USPQ at 519 (emphasis in original). The court thus established a higher burden on the applicant where the statement of use is incredible or misleading. In such a case, the examiner should challenge the use and require sufficient evidence of



operativeness. The purpose of this authority is to enable an applicant to cure an otherwise defective factual basis for the operability of an invention. Because this is a curative authority (e.g., evidence is requested to enable an applicant to support an assertion that is inconsistent with the facts of record in the application), Office personnel should indicate not only why the factual record is defective in relation to the assertions of the applicant, but also, where appropriate, what type of evidentiary showing can be provided by the applicant to remedy the problem.

Requests for additional evidence should be imposed rarely, and only if necessary to support the scientific credibility of the asserted utility (e.g., if the asserted utility is not consistent with the evidence of record and current scientific knowledge). As the Federal Circuit recently noted, “[o]nly after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention’s asserted utility.” *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). In *Brana*, the court pointed out that the purpose of treating cancer with chemical compounds does not suggest, *per se*, an incredible utility. Where the prior art disclosed “structurally similar compounds to those claimed by applicants which have been proven *in vivo* to be effective as chemotherapeutic agents against various tumor models . . ., one skilled in the art would be without basis to reasonably doubt applicants’ asserted utility on its face.” 51 F.3d at 1566, 34 USPQ2d at 1441. As courts have stated, “it is clearly improper for the examiner to make a demand for further test data, which as evidence would be essentially redundant and would seem to serve for nothing except perhaps to unduly burden the applicant.” *In re Isaacs*, 347 F.2d 887, 890, 146 USPQ 193, 196 (CCPA 1965).

## VI. CONSIDERATION OF A REPLY TO A *PRIMA FACIE* REJECTION FOR LACK OF UTILITY

If a rejection under [35 U.S.C. 101](#) has been properly imposed, along with a corresponding rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, the burden shifts to the applicant to rebut

the *prima facie* showing. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”). An applicant can do this using any combination of the following: amendments to the claims, arguments or reasoning, or new evidence submitted in an affidavit or declaration under [37 CFR 1.132](#), or in a printed publication. New evidence provided by an applicant must be relevant to the issues raised in the rejection. For example, declarations in which conclusions are set forth without establishing a nexus between those conclusions and the supporting evidence, or which merely express opinions, may be of limited probative value with regard to rebutting a *prima facie* case. *In re Grunwell*, 609 F.2d 486, 203 USPQ 1055 (CCPA 1979); *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991). See [MPEP § 716.01\(a\)](#) through [MPEP § 716.01\(c\)](#).

If the applicant responds to the *prima facie* rejection, Office personnel should review the original disclosure, any evidence relied upon in establishing the *prima facie* showing, any claim amendments, and any new reasoning or evidence provided by the applicant in support of an asserted specific and substantial credible utility. It is essential for Office personnel to recognize, fully consider and respond to each substantive element of any response to a rejection based on lack of utility. Only where the totality of the record continues to show that the asserted utility is not specific, substantial, and credible should a rejection based on lack of utility be maintained. If the record as a whole would make it more likely than not that the asserted utility for the claimed invention would be considered credible by a person of ordinary skill in the art, the Office cannot maintain the rejection. *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

## VII. EVALUATION OF EVIDENCE RELATED TO UTILITY

There is no predetermined amount or character of evidence that must be provided by an applicant to support an asserted utility, therapeutic or otherwise. Rather, the character and amount of evidence needed to support an asserted utility will vary depending on what is claimed (*Ex parte Ferguson*, 117 USPQ 229 (Bd. App. 1957)), and whether the asserted utility appears to contravene established scientific principles and beliefs. *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956). Furthermore, the applicant does not have to provide evidence sufficient to establish that an asserted utility is true “beyond a reasonable doubt.” *In re Irons*, 340 F.2d 974, 978, 144 USPQ 351, 354 (CCPA 1965). Nor must an applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty. *Nelson v. Bowler*, 626 F.2d 853, 856-57, 206 USPQ 881, 883-84 (CCPA 1980) (reversing the Board and rejecting Bowler’s arguments that the evidence of utility was statistically insignificant. The court pointed out that a rigorous correlation is not necessary when the test is reasonably predictive of the response). See also *Rey-Bellet v. Englehardt*, 493 F.2d 1380, 181 USPQ 453 (CCPA 1974) (data from animal testing is relevant to asserted human therapeutic utility if there is a “satisfactory correlation between the effect on the animal and that ultimately observed in human beings”). Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not true.

### 2107.03 Special Considerations for Asserted Therapeutic or Pharmacological Utilities [R-08.2012]

The federal courts have consistently reversed rejections by the Office asserting a lack of utility for inventions claiming a pharmacological or therapeutic utility where an applicant has provided evidence that reasonably supports such a utility. In view of this, Office personnel should be particularly careful in their review of evidence provided in support of an asserted therapeutic or pharmacological utility.

## I. A REASONABLE CORRELATION BETWEEN THE EVIDENCE AND THE ASSERTED UTILITY IS SUFFICIENT

As a general matter, evidence of pharmacological or other biological activity of a compound will be relevant to an asserted therapeutic use if there is a reasonable correlation between the activity in question and the asserted utility. *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 206 USPQ 881 (CCPA 1980). An applicant can establish this reasonable correlation by relying on statistically relevant data documenting the activity of a compound or composition, arguments or reasoning, documentary evidence (e.g., articles in scientific journals), or any combination thereof. The applicant does not have to prove that a correlation exists between a particular activity and an asserted therapeutic use of a compound as a matter of statistical certainty, nor does he or she have to provide actual evidence of success in treating humans where such a utility is asserted. Instead, as the courts have repeatedly held, all that is required is a reasonable correlation between the activity and the asserted use. *Nelson v. Bowler*, 626 F.2d 853, 857, 206 USPQ 881, 884 (CCPA 1980).

## II. STRUCTURAL SIMILARITY TO COMPOUNDS WITH ESTABLISHED UTILITY

Courts have routinely found evidence of structural similarity to a compound known to have a particular therapeutic or pharmacological utility as being supportive of an assertion of therapeutic utility for a new compound. In *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980), the claimed compounds were found to have utility based on a finding of a close structural relationship to daunorubicin and doxorubicin and shared pharmacological activity with those compounds, both of which were known to be useful in cancer chemotherapy. The evidence of close structural similarity with the known compounds was presented in conjunction with evidence demonstrating substantial activity of the claimed compounds in animals customarily employed for screening anticancer agents. Such evidence should be given appropriate weight in determining whether one

skilled in the art would find the asserted utility credible. Office personnel should evaluate not only the existence of the structural relationship, but also the reasoning used by the applicant or a declarant to explain why that structural similarity is believed to be relevant to the applicant's assertion of utility.

### III. DATA FROM *IN VITRO* OR ANIMAL TESTING IS GENERALLY SUFFICIENT TO SUPPORT THERAPEUTIC UTILITY

If reasonably correlated to the particular therapeutic or pharmacological utility, data generated using *in vitro* assays, or from testing in an animal model or a combination thereof almost invariably will be sufficient to establish therapeutic or pharmacological utility for a compound, composition or process. A cursory review of cases involving therapeutic inventions where [35 U.S.C. 101](#) was the dispositive issue illustrates the fact that the federal courts are not particularly receptive to rejections under [35 U.S.C. 101](#) based on inoperability. Most striking is the fact that in those cases where an applicant supplied a reasonable evidentiary showing supporting an asserted therapeutic utility, almost uniformly the [35 U.S.C. 101](#)-based rejection was reversed. See, e.g., *In re Brana*, 51 F.3d 1560, 34 USPQ 1436 (Fed. Cir. 1995); *Cross v. Iizuka*, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980); *In re Malachowski*, 530 F.2d 1402, 189 USPQ 432 (CCPA 1976); *In re Gaubert*, 530 F.2d 1402, 189 USPQ 432 (CCPA 1975); *In re Gazave*, 379 F.2d 973, 154 USPQ 92 (CCPA 1967); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961). Only in those cases where the applicant was unable to come forward with any relevant evidence to rebut a finding by the Office that the claimed invention was inoperative was a [35 U.S.C. 101](#) rejection affirmed by the court. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963) (therapeutic utility for an uncharacterized biological extract not supported or scientifically credible); *In re Buting*, 418 F.2d 540, 543, 163 USPQ 689, 690 (CCPA 1969) (record did not establish a credible basis for the assertion that the single class of compounds in question would be useful in treating disparate types

of cancers); *In re Novak*, 306 F.2d 924, 134 USPQ 335 (CCPA 1962) (claimed compounds did not have capacity to effect physiological activity upon which utility claim based). Contrast, however, *In re Buting* to *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973), *reh'g denied*, 480 F.2d 879 (CCPA 1973), in which the court held that utility for a genus was found to be supported through a showing of utility for one species. In no case has a federal court required an applicant to support an asserted utility with data from human clinical trials.

If an applicant provides data, whether from *in vitro* assays or animal tests or both, to support an asserted utility, and an explanation of why that data supports the asserted utility, the Office will determine if the data and the explanation would be viewed by one skilled in the art as being reasonably predictive of the asserted utility. See, e.g., *Ex parte Maas*, 9 USPQ2d 1746 (Bd. Pat. App. & Inter. 1987); *Ex parte Balzarini*, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991). Office personnel must be careful to evaluate all factors that might influence the conclusions of a person of ordinary skill in the art as to this question, including the test parameters, choice of animal, relationship of the activity to the particular disorder to be treated, characteristics of the compound or composition, relative significance of the data provided and, most importantly, the explanation offered by the applicant as to why the information provided is believed to support the asserted utility. If the data supplied is consistent with the asserted utility, the Office cannot maintain a rejection under [35 U.S.C. 101](#).

Evidence does not have to be in the form of data from an art-recognized animal model for the particular disease or disease condition to which the asserted utility relates. Data from any test that the applicant reasonably correlates to the asserted utility should be evaluated substantively. Thus, an applicant may provide data generated using a particular animal model with an appropriate explanation as to why that data supports the asserted utility. The absence of a certification that the test in question is an industry-accepted model is not dispositive of whether data from an animal model is in fact relevant to the asserted utility. Thus, if one skilled in the art would accept the animal tests as being reasonably predictive of utility in humans, evidence from those tests should

be considered sufficient to support the credibility of the asserted utility. *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Krimmel*, 292 F.2d 948, 953, 130 USPQ 215, 219 (CCPA 1961); *Ex parte Krepelka*, 231 USPQ 746 (Bd. Pat. App. & Inter. 1986). Office personnel should be careful not to find evidence unpersuasive simply because no animal model for the human disease condition had been established prior to the filing of the application. See *In re Chilowsky*, 229 F.2d 457, 461, 108 USPQ 321, 325 (CCPA 1956) (“The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it.”); *In re Wooddy*, 331 F.2d 636, 639, 141 USPQ 518, 520 (CCPA 1964) (“It appears that no one on earth is certain as of the present whether the process claimed will operate in the manner claimed. Yet absolute certainty is not required by the law. The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it.”).

#### IV. HUMAN CLINICAL DATA

Office personnel should not impose on applicants the unnecessary burden of providing evidence from human clinical trials. There is no decisional law that requires an applicant to provide data from human clinical trials to establish utility for an invention related to treatment of human disorders (see *In re Isaacs*, 347 F.2d 889, 146 USPQ 193 (CCPA 1963); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974)), even with respect to situations where no art-recognized animal models existed for the human disease encompassed by the claims. *Ex parte Balzarini*, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991) (human clinical data is not required to demonstrate the utility of the claimed invention, even though those skilled in the art might not accept other evidence to establish the efficacy of the claimed therapeutic compositions and the operativeness of the claimed methods of treating humans). Before a drug can enter human clinical trials, the sponsor, often the applicant, must provide a convincing rationale to those especially skilled in the art (e.g., the Food and Drug Administration (FDA)) that the investigation may be successful. Such a rationale would provide a basis for the sponsor’s expectation

that the investigation may be successful. In order to determine a protocol for phase I testing, the first phase of clinical investigation, some credible rationale of how the drug might be effective or could be effective would be necessary. Thus, as a general rule, if an applicant has initiated human clinical trials for a therapeutic product or process, Office personnel should presume that the applicant has established that the subject matter of that trial is reasonably predictive of having the asserted therapeutic utility.

#### V. SAFETY AND EFFICACY CONSIDERATIONS

The Office must confine its review of patent applications to the statutory requirements of the patent law. Other agencies of the government have been assigned the responsibility of ensuring conformance to standards established by statute for the advertisement, use, sale or distribution of drugs. The FDA pursues a two-prong test to provide approval for testing. Under that test, a sponsor must show that the investigation does not pose an unreasonable and significant risk of illness or injury and that there is an acceptable rationale for the study. As a review matter, there must be a rationale for believing that the compound could be effective. If the use reviewed by the FDA is not set forth in the specification, FDA review may not satisfy [35 U.S.C. 101](#). However, if the reviewed use is one set forth in the specification, Office personnel must be extremely hesitant to challenge utility. In such a situation, experts at the FDA have assessed the rationale for the drug or research study upon which an asserted utility is based and found it satisfactory. Thus, in challenging utility, Office personnel must be able to carry their burden that there is no sound rationale for the asserted utility even though experts designated by Congress to decide the issue have come to an opposite conclusion. “FDA approval, however, is not a prerequisite for finding a compound useful within the meaning of the patent laws.” *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995) (citing *Scott v. Finney*, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed. Cir. 1994)).

Thus, while an applicant may on occasion need to provide evidence to show that an invention will work as claimed, it is improper for Office personnel to request evidence of safety in the treatment of



humans, or regarding the degree of effectiveness. See *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Hartop*, 311 F.2d 249, 135 USPQ 419 (CCPA 1962); *In re Anthony*, 414 F.2d 1383, 162 USPQ 594 (CCPA 1969); *In re Watson*, 517 F.2d 465, 186 USPQ 11 (CCPA 1975); *In re Krimmel*, 292 F.2d 948, 130 USPQ 215 (CCPA 1961); *Ex parte Jovanovics*, 211 USPQ 907 (Bd. Pat. App. & Inter. 1981).

## VI. TREATMENT OF SPECIFIC DISEASE CONDITIONS

Claims directed to a method of treating or curing a disease for which there have been no previously successful treatments or cures warrant careful review for compliance with [35 U.S.C. 101](#). The credibility of an asserted utility for treating a human disorder may be more difficult to establish where current scientific understanding suggests that such a task would be impossible. Such a determination has always required a good understanding of the state of the art as of the time that the invention was made. For example, prior to the 1980's, there were a number of cases where an asserted use in treating cancer in humans was viewed as "incredible." *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Buting*, 418 F.2d 540, 163 USPQ 689 (CCPA 1969); *Ex parte Stevens*, 16 USPQ2d 1379 (Bd. Pat. App. & Inter. 1990); *Ex parte Busse*, 1 USPQ2d 1908 (Bd. Pat. App. & Inter. 1986); *Ex parte Krepelka*, 231 USPQ 746 (Bd. Pat. App. & Inter. 1986); *Ex parte Jovanovics*, 211 USPQ 907 (Bd. Pat. App. & Inter. 1981). The fact that there is no known cure for a disease, however, cannot serve as the basis for a conclusion that such an invention lacks utility. Rather, Office personnel must determine if the asserted utility for the invention is credible based on the information disclosed in the application. Only those claims for which an asserted utility is not credible should be rejected. In such cases, the Office should carefully review what is being claimed by the applicant. An assertion that the claimed invention is useful in treating a symptom of an incurable disease may be considered credible by a person of ordinary skill in the art on the basis of a fairly modest amount of evidence or support. In contrast, an assertion that the claimed invention will be useful in "curing" the disease may require a significantly greater amount of evidentiary support

to be considered credible by a person of ordinary skill in the art. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980). See also *Ex parte Ferguson*, 117 USPQ 229 (Bd. Pat. App. & Inter. 1957).

In these cases, it is important to note that the Food and Drug Administration has promulgated regulations that enable a party to conduct clinical trials for drugs used to treat life threatening and severely-debilitating illnesses, even where no alternative therapy exists. See 21 CFR 312.80-88 (1994). Implicit in these regulations is the recognition that experts qualified to evaluate the effectiveness of therapeutics can and often do find a sufficient basis to conduct clinical trials of drugs for incurable or previously untreatable illnesses. Thus, affidavit evidence from experts in the art indicating that there is a reasonable expectation of success, supported by sound reasoning, usually should be sufficient to establish that such a utility is credible.

### 2108 [Reserved]

### 2109 Inventorship [R-01.2024]

The requirement that the applicant for a patent in an application filed before September 16, 2012 be the inventor(s) (except as otherwise provided in [pre-AIA 37 CFR 1.41](#)), and that the inventor or each joint inventor be identified in applications filed on or after September 16, 2012, are characteristics of U.S. patent law not generally shared by other countries. Consequently, foreign applicants may misunderstand U.S. law regarding naming of the actual inventors causing an error in the inventorship of a U.S. application that may claim priority to a previous foreign application under [35 U.S.C. 119](#). A request under [37 CFR 1.48](#) is required to correct any error in the inventorship in the U.S. application as filed. See [MPEP § 602.01\(c\)](#) *et seq.* Foreign applicants may need to be reminded of the requirement for the same inventor or at least one common joint inventor between a U.S. application and a [35 U.S.C. 119](#) priority application. See [MPEP § 213.02](#), subsection II.



If a determination is made that the inventive entity named in a U.S. application is not correct, such as when a request under [37 CFR 1.48\(a\)](#) is not granted or is not entered for technical reasons, but the admission therein regarding the error in inventorship is uncontroverted, a rejection should be made on this basis. See [MPEP § 2157](#) for rejections under [35 U.S.C. 101](#) and [35 U.S.C. 115](#), and [MPEP § 2137](#) for rejections under [pre-AIA 35 U.S.C. 102\(f\)](#) (for applications subject to [pre-AIA 35 U.S.C. 102](#)), for failure to set forth the correct inventorship.

## I. NAMING INVENTORSHIP

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent (other than a provisional application) must execute an oath or declaration directed to the application, except as provided for in [37 CFR 1.64](#). See [MPEP § 602.01](#) for detailed information pertaining to naming the inventor. See [MPEP § 602.01\(a\)](#) for the requirements of an inventor's oath or declaration in an application filed on or after September 16, 2012. See [MPEP § 602.01\(b\)](#) for the requirements of an original oath or declaration in an application filed before September 16, 2012.

For applications filed before September 16, 2012, [pre-AIA 37 CFR 1.41\(a\)\(1\)](#) defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of [pre-AIA 37 CFR 1.63](#), except as otherwise provided. Thus the party or parties executing an oath or declaration under [pre-AIA 37 CFR 1.63](#) are presumed to be the inventors. *Driscoll v. Cebalo*, 5 USPQ2d 1477, 1481 (Bd. Pat. Inter. 1982); *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) (The inventor of an element, *per se*, and the inventor of that element as used in a combination may differ. “The existence of combination claims does not evidence inventorship by the patentee of the individual elements or subcombinations thereof if the latter are not separately claimed apart from the combination.” (quoting *In re Facius*, 408 F.2d 1396, 1406, 161 USPQ 294, 301 (CCPA 1969) (emphasis in original)); *Brader v. Schaeffer*, 193 USPQ 627, 631 (Bd. Pat. Inter. 1976) (in regard to an inventorship correction: “[a]s between inventors

their word is normally taken as to who are the actual inventors” when there is no disagreement).

## II. AN INVENTOR MUST CONTRIBUTE TO THE CONCEPTION OF THE INVENTION

The definition for inventorship can be simply stated: “The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. ... Insofar as defining an inventor is concerned, reduction to practice, *per se*, is irrelevant [except for simultaneous conception and reduction to practice, *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993)]. One must contribute to the conception to be an inventor.” *In re Hardee*, 223 USPQ 1122, 1123 (Comm’r Pat. 1984). A person who shares in the conception of a claimed invention is a joint inventor of that invention. *In re VerHoef*, 888 F.3d 1362, 1366-67, 126 F.2d 1561, 1564-65 (Fed. Cir. 2018). See also *Board of Education ex rel. Board of Trustees of Florida State Univ. v. American Bioscience Inc.*, 333 F.3d 1330, 1340, 67 USPQ2d 1252, 1259 (Fed. Cir. 2003) (“Invention requires conception.” With regard to the inventorship of chemical compounds, an inventor must have a conception of the specific compounds being claimed. “[G]eneral knowledge regarding the anticipated biological properties of groups of complex chemical compounds is insufficient to confer inventorship status with respect to specifically claimed compounds.”); *Ex parte Smernoff*, 215 USPQ 545, 547 (Bd. App. 1982) (“one who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an coinventor”). See [MPEP § 2138.04](#) - [§ 2138.05](#) for a discussion of what evidence is required to establish conception or reduction to practice.

## III. THE INVENTOR IS NOT REQUIRED TO REDUCE THE INVENTION TO PRACTICE

Difficulties arise in separating members of a team effort, where each member of the team has contributed something, into those members that actually contributed to the conception of the invention, such as the physical structure or operative steps, from those members that merely acted under the direction and supervision of the conceivers.

*Fritsch v. Lin*, 21 USPQ2d 1737, 1739 (Bd. Pat. App. & Inter. 1991) (The inventor “took no part in developing the procedures...for expressing the EPO gene in mammalian host cells and isolating the resulting EPO product.” However, “it is not essential for the inventor to be personally involved in carrying out process steps...where implementation of those steps does not require the exercise of inventive skill.”); *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982) (“there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf”).

See also *Mattor v. Coolegem*, 530 F.2d 1391, 1395, 189 USPQ 201, 204 (CCPA 1976) (one following oral instructions is viewed as merely a technician); *Tucker v. Naito*, 188 USPQ 260, 263 (Bd. Pat. Inter. 1975) (inventors need not “personally construct and test their invention”); *Davis v. Carrier*, 81 F.2d 250, 252, 28 USPQ 227, 229 (CCPA 1936) (noninventor’s work was merely that of a skilled mechanic carrying out the details of a plan devised by another).

#### IV. JOINT INVENTORSHIP

Pursuant to [35 U.S.C. 116](#), “[w]hen an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.”

The inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named joint inventors. See [MPEP § 2109.01](#) for a detailed discussion of the requirements for joint inventorship. See [MPEP § 602.09](#) regarding inquiries about the inventorship of each claimed invention and regarding correction of inventorship when an application is amended such that one (or more) of the named joint inventors is no longer a joint inventor of the subject matter of any claim remaining in the application.

#### V. INVENTORSHIP “BY ANOTHER”

Inventorship is generally “by another” where there are different inventive entities and there is at least one inventor that is not in common. For information relating to inventorship by “another” involving different inventive entities with at least one inventor in common, see [MPEP § 2153.01\(a\)](#) for applications subject to examination under the first inventor to file (FITF) provisions of the AIA, and [MPEP § 2136.04](#) for applications subject to examination under pre-AIA law.

#### VI. EXAMINATION OF CONTINUING APPLICATION COMMONLY OWNED WITH ABANDONED PARENT APPLICATION TO WHICH BENEFIT IS CLAIMED UNDER 35 U.S.C. 120

An application claiming the benefit of a prior filed copending national or international application under [35 U.S.C. 120](#) must name as an inventor at least one inventor named in the prior filed application. The prior filed application must also disclose the named inventor’s invention claimed in at least one claim of the later filed application in the manner provided by [35 U.S.C. 112\(a\)](#) for applications filed on or after September 16, 2012, or [35 U.S.C. 112](#), first paragraph for applications filed prior to September 16, 2012. This practice contrasts with the practice in effect prior to November 8, 1984 (the date of enactment of Public Law 98-622) where the inventorship entity in each of the applications was required to be the same for benefit under [35 U.S.C. 120](#).

So long as the applications have at least one inventor in common and the other requirements are met, the Office will permit a claim for [35 U.S.C. 120](#) benefit without any additional submissions or notifications from applicants regarding inventorship differences.

In addition to the normal examination conducted by the examiner, the examiner must examine the earlier filed application to determine if the earlier and later applications have at least one inventor in common and that the other [35 U.S.C. 120](#) and [37 CFR 1.78](#) requirements are met. See [MPEP § 211 et seq.](#) The claim for [35 U.S.C. 120](#) benefit will be permitted without examination of the earlier application for

disclosure and support of at least one claim of the later filed application under [35 U.S.C. 112](#) unless it becomes necessary to do so, for example, because of an intervening reference.

## VII. AN INVENTOR OR JOINT INVENTOR MUST BE A NATURAL PERSON

“The Patent Act expressly provides that inventors are ‘individuals.’ Since 2011, with the passage of the Leahy-Smith America Invents Act, the Patent Act has defined an ‘inventor’ as the ‘*individual*’ or, if a joint invention, the *individuals* collectively who invented or discovered the subject matter of the invention.’ [35 U.S.C. 100\(f\)](#) (emphasis added). The Act similarly defines ‘joint inventor and ‘coinventor’ as ‘any 1 of the individuals who invented or discovered the subject matter of a joint invention.’ [§ 100\(g\)](#)(emphasis added). In describing the statements required of an inventor when applying for a patent, the statute consistently refers to inventors and co-inventors as ‘individuals.’” *Thaler v. Vidal*, 43 F.4th 1207, 1211 (Fed. Cir. 2022).

[35 U.S.C. 115](#) requires that an application filed under [35 U.S.C. 111\(a\)](#) shall include the name of the inventor or inventors. [35 U.S.C. 100\(f\)](#) defines the term “inventor” as the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. [35 U.S.C. 100\(g\)](#) defines the terms “joint inventor” and “coinventor” as any one of the individuals who invented or discovered the subject matter of a joint invention. As provided in [37 CFR 1.41\(b\)](#), an applicant may name the inventorship of a non-provisional application under [35 U.S.C. 111\(a\)](#) in the Application Data Sheet in accordance with [37 CFR 1.76](#), or in the inventor’s oath or declaration in accordance with [37 CFR 1.63](#). See [MPEP § 602.01](#).

The inventor or joint inventors named on a patent or patent application must be a natural person, i.e., a human being. See *Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften E.V.*, 734 F.3d 1315, 1323, 107 USPQ2d 1989, 1994 (Fed. Cir. 2013) (“[I]nventors must be natural persons and cannot be corporations or sovereigns.”) (emphasis added); *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26

USPQ2d 1572, 1581 (Fed. Cir. 1993) (“[O]nly natural persons can be ‘inventors.’”).

## 2109.01 Joint Inventorship [R-07.2022]

### 35 U.S.C. 116 Inventors.

*[Editor Note: Applicable to proceedings commenced on or after Sept. 16, 2012. See [35 U.S.C. 116 \(pre-AIA\)](#) for the law otherwise applicable.]*

(a) JOINT INVENTIONS.—When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

(b) OMITTED INVENTOR.—If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

### 35 U.S.C. 116 (pre-AIA) Inventors.

*[Editor Note: Not applicable to proceedings commenced on or after September 16, 2012. See [35 U.S.C. 116](#) for the law otherwise applicable.]*

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

A person who shares in the conception of a claimed invention is a joint inventor of that invention. *In re VerHoef*, 888 F.3d 1362, 1366-67, 126 F.2d 1561, 1564-65 (Fed. Cir. 2018) (person who contributed the idea of a figure eight loop in the claimed dog harness, which figure eight loop is an essential feature of the invention not insignificant in quality or well-known in the art, should have been named as a joint inventor).

“Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.” [35 U.S.C. 116](#).

It is not necessary that joint inventors physically work together on a project, and it is permissible for one inventor to “take a step at one time, the other an approach at different times.” (*Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967)). However, “the statute neither states nor implies that two inventors can be ‘joint inventors’ if they have had no contact whatsoever and are completely unaware of each other’s work.” What is required is some “quantum of collaboration or connection.” In other words, “[f]or persons to be joint inventors under [Section 116](#), there must be some element of joint behavior, such as collaboration or working under common direction, one inventor seeing a relevant report and building upon it or hearing another’s suggestion at a meeting.” *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 916-17, 23 USPQ2d 1921, 1925-26 (Fed. Cir. 1992); *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960) (“it is not necessary that the inventive concept come to both [joint inventors] at the same time”).

While each joint inventor must generally contribute to the conception of the invention, each joint inventor does not have to “make the same type or amount of contribution” to the invention. “The fact that each

of the inventors play a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem.” *Monsanto Co. v. Kamp*, 269 F. Supp. at 824, 154 USPQ at 262. When a joint inventor contributed to the conception of an invention, publication of the joint inventor’s contribution before the date of conception of the total invention does not necessarily defeat joint inventorship of that invention. See *Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.*, 964 F.3d 1365, 1371-73, 2020 USPQ2d 10775 (Fed. Cir. 2020) (“a collaborative enterprise is not negated by a joint inventor disclosing ideas less than the total invention to others, especially when, as here, the collaborators had worked together for around one year prior to the disclosure, and the disclosure occurred just a few weeks prior to conception. Inventorship of a complex invention may depend on partial contributions to conception over time, and there is no principled reason to discount genuine contributions made by collaborators because portions of that work were published prior to conception for the benefit of the public.”).

A joint inventor or coinventor need not make a contribution to every claim of a patent; a contribution to one claim is enough. “The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor’s broader concept.” *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460-63, 45 USPQ2d 1545, 1548-1551 (Fed. Cir. 1998) (The electronics technician who contributed to one of the two alternative structures in the specification to define “the means for detaining” in a claim limitation was held to be a joint inventor.). In addition, there is no requirement that all the inventors be joint inventors of the subject matter of any one claim.

See [MPEP § 602.09](#) regarding inquiries about the inventorship of each claimed invention and regarding correction of inventorship when an application is amended such that one (or more) of the named joint inventors is no longer a joint inventor of the subject



matter of any claim remaining in the application. See [MPEP § 602.01\(c\)](#) *et seq.* for additional information pertaining to the correction of inventorship.

## 2110 [Reserved]

### 2111 Claim Interpretation; Broadest Reasonable Interpretation [R-10.2019]

#### CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION IN LIGHT OF THE SPECIFICATION

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827, 1830] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” [37 CFR 1.75\(d\)\(1\)](#).

See also *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259, 94 USPQ2d 1640, 1643 (Fed. Cir. 2010); *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Patented claims are not given the broadest reasonable interpretation during court proceedings involving

infringement and validity, and can be interpreted based on a fully developed prosecution record. In contrast, an examiner must construe claim terms in the broadest reasonable manner during prosecution as is reasonably allowed in an effort to establish a clear record of what applicant intends to claim. Thus, the Office does not interpret claims when examining patent applications in the same manner as the courts.

*In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989).

Because applicant has the opportunity to amend the claims during prosecution, giving a claim its broadest reasonable interpretation will reduce the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.”); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under [35 U.S.C. 101](#) and [35 U.S.C. 102](#). In the [35 U.S.C. 102](#) rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the USPTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court



would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”).

The broadest reasonable interpretation does not mean the broadest possible interpretation. Rather, the meaning given to a claim term must be consistent with the ordinary and customary meaning of the term (unless the term has been given a special definition in the specification), and must be consistent with the use of the claim term in the specification and drawings. Further, the broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board’s construction of the claim limitation “restore hair growth” as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant’s disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe “restore hair growth” to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.). Thus the focus of the inquiry regarding the meaning of a claim should be what would be reasonable from the perspective of one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010); *In re Buszard*, 504 F.3d 1364, 84 USPQ2d 1749 (Fed. Cir. 2007). In *Buszard*, the claim was directed to a flame retardant composition comprising a flexible polyurethane foam reaction mixture. 504 F.3d at 1365, 84 USPQ2d at 1750. The Federal Circuit found that the Board’s interpretation that equated a “flexible” foam with a crushed “rigid” foam was not reasonable. *Id.* at 1367, 84 USPQ2d at 1751. Persuasive argument was presented that persons experienced in the field of polyurethane foams know that a flexible mixture is different than a rigid foam mixture. *Id.* at 1366, 84 USPQ2d at 1751.

See [MPEP § 2173.02](#) for further discussion of claim interpretation in the context of analyzing claims for compliance with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

## 2111.01 Plain Meaning [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

### I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR “PLAIN MEANING” UNLESS SUCH MEANING IS INCONSISTENT WITH THE SPECIFICATION

Under a broadest reasonable interpretation (BRI), words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification. The plain meaning of a term means the ordinary and customary meaning given to the term by those of ordinary skill in the art at the relevant time. The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the specification, drawings, and prior art. However, the best source for determining the meaning of a claim term is the specification - the greatest clarity is obtained when the specification serves as a glossary for the claim terms. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005) (*en banc*) (“[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” (quoting *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). The words of the claim must

be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, “heating the resulting batter-coated dough to a temperature in the range of about 400<sup>o</sup>F to 850<sup>o</sup>F” required heating the dough, rather than the air inside an oven, to the specified temperature.). See also *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311, 1317-1318, 2023 USPQ2d 412 (Fed. Cir. 2023) (While the claim language, “a microprocessor for generating . . . , said microprocessor creating . . . , a plurality of parameter sets retrieved by said microprocessor . . . , said microprocessor generating . . . ,” does not require there be only one microprocessor, the limitations to “said microprocessor” require a singular element—“a microprocessor”—to be capable of performing all of the recited “generating,” “creating,” and “retrieving” functions. Similarly, “[f]or a dog owner to have ‘a dog that rolls over and fetches sticks,’ it does not suffice that he have two dogs, each able to perform just one of the tasks.” (quoting *In re Varma*, 816 F.3d 1352, 1363, 118 USPQ2d 1342, 1350 (Fed. Cir. 2016))).

The presumption that a term is given its ordinary and customary meaning may be rebutted by the applicant by clearly setting forth a different definition of the term in the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) (the USPTO looks to the ordinary use of the claim terms taking into account definitions or other “enlightenment” contained in the written description); *But c.f. In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (“We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.”). When the specification sets a clear path to the claim language, the scope of the claims is more easily determined

and the public notice function of the claims is best served.

## II. IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION

“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004) (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (“Interpretation of descriptive statements in a patent’s written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.”); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). See also subsection IV, below. When an element is claimed using language falling under the scope of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), 6<sup>th</sup> paragraph (often broadly referred to as means- (or step-) plus- function language), the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim, and the claimed

element is construed as limited to the corresponding structure, material, or acts described in the specification and equivalents thereof. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see [MPEP § 2181](#) - [MPEP § 2186](#)).

In *Zletz, supra*, the examiner and the Board had interpreted claims reading “normally solid polypropylene” and “normally solid polypropylene having a crystalline polypropylene content” as being limited to “normally solid linear high homopolymers of propylene which have a crystalline polypropylene content.” The court ruled that limitations, not present in the claims, were improperly imported from the specification. See also *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (“[C]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation.’” (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)). The court looked to the specification to construe “essentially free of alkali metal” as including unavoidable levels of impurities but no more.).

In *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231, 1236-37, 2023 USPQ2d 1030 (Fed. Cir. 2023), the court found that construing “connection rejection message” should be given its plain and ordinary meaning, and should not be construed in such a way as to improperly limit the claims to specific disclosed embodiments. The intrinsic evidence provided no basis to limit the claims to the preferred embodiments and a person of ordinary skill in the art would broadly interpret the claim language consistent with the broad statements in the specification.

### III. “PLAIN MEANING” REFERS TO THE ORDINARY AND CUSTOMARY MEANING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART

“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326

(Fed. Cir. 2005) (*en banc*); *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (“In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.”).

The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the specification, drawings, and prior art. However, the best source for determining the meaning of a claim term is the specification – the greatest clarity is obtained when the specification serves as a glossary for the claim terms. See, e.g., *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149-50, 104 USPQ2d 1337, 1342-43 (Fed. Cir. 2012) (construing the term “electrochemical sensor” as “devoid of external connection cables or wires to connect to a sensor control unit” to be consistent with “the language of the claims and the specification”); *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260-61, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010) (construing the term “material for finishing the top surface of the floor” to mean “a clear, uniform layer on the top surface of a floor that is the final treatment or coating of a surface” to be consistent with “the express language of the claim and the specification”); *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) (construing the term “solder reflow temperature” to mean “peak reflow temperature” of solder rather than the “liquidus temperature” of solder in order to remain consistent with the specification); *Malvern Panalytical Inc. v. TA Instruments-Waters LLC*, 85 F.4th 1365, 1374-75, 2023 USPQ2d 1297 (Fed. Cir. 2023) (the court construed “pipette guiding mechanism” as a mechanism that guides the pipette assembly either manually or automatically, and stated that the plain and ordinary meaning can be ascertained by examining the claim language, specification, and the prosecution history).

In some cases it is also appropriate to look to how the claim term is used in the prior art, which includes prior art patents, published applications, trade

publications, and dictionaries. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (“Although we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence, which “consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.”)

Any meaning of a claim term taken from the prior art must be consistent with the use of the claim term in the specification and drawings. Moreover, when the specification is clear about the scope and content of a claim term, there is no need to turn to extrinsic evidence for claim interpretation. *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326-28, 107 USPQ2d 1717, 1726-27 (Fed. Cir. 2013) (holding that “continuous microtextured skin layer over substantially the entire laminate” was clearly defined in the written description, and therefore, there was no need to turn to extrinsic evidence to construe the claim). See also *Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1290, 2021 USPQ2d 848 (Fed. Cir. 2021) (finding that where the intrinsic evidence (i.e., the claims, written description and prosecution history) clearly supports a claim interpretation, it is unnecessary to resort to extrinsic evidence.). However, in some instances where neither the claims, nor the specification, nor the prosecution history offer sufficient clarity on claim scope, extrinsic evidence may become a necessary part of claim interpretation. In *Actelion*, the claim language of “a pH of 13 or higher” was unclear after analysis of the intrinsic evidence. The court looked to the specification, which inconsistently described the level of specificity for a pH of 13. Finally, the court turned to the prosecution history, which also did not provide any clarity as to whether a pH of 13 includes values that round to 13, such as 12.5. The court found that in this case extrinsic evidence should be consulted to understand “the meaning of a term in the relevant art during the relevant time period”.

*Actelion Pharmaceuticals Ltd v. Mylan Pharmaceuticals Inc.*, 85 F.4th 1167, 1172-74, 2023 USPQ2d 1314 (Fed. Cir. 2023) (quoting *Teva Pharmaceuticals USA, Inc v. Sandoz, Inc.*, 574 U.S. 318, 331, 135 S. Ct. 831, 841, 113 USPQ2d 1269, 1276 (2015)).

#### **IV. APPLICANT MAY BE OWN LEXICOGRAPHER AND/OR MAY DISAVOW CLAIM SCOPE**

The only exceptions to giving the words in a claim their ordinary and customary meaning in the art are (1) when the applicant acts as their own lexicographer; and (2) when the applicant disavows or disclaims the full scope of a claim term in the specification. To act as their own lexicographer, the applicant must clearly set forth a special definition of a claim term in the specification that differs from the plain and ordinary meaning it would otherwise possess. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002). The specification may also include an intentional disclaimer, or disavowal, of claim scope. In both of these cases, “the inventor’s intention, as expressed in the specification, is regarded as dispositive.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). See also *Starhome GmbH v. AT&T Mobility LLC*, 743 F.3d 849, 857, 109 USPQ2d 1885, 1890-91 (Fed. Cir. 2014) (holding that the term “gateway” should be given its ordinary and customary meaning of “a connection between different networks” because nothing in the specification indicated a clear intent to depart from that ordinary meaning); *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1367-68, 101 USPQ2d 1457, 1460 (Fed. Cir. 2012) (The asserted claims of the patent were directed to a tactile feedback system for video game controllers comprising a flexible pad with a plurality of actuators “attached to said pad.” The court held that the claims were not limited to actuators attached to the external surface of the pad, even though the specification used the word “attached” when describing embodiments affixed to the external surface of the pad but the word “embedded” when describing embodiments affixed to the internal surface of the pad. The court explained that the plain and ordinary meaning of “attached” includes both external and internal attachments. Further, there is no clear and explicit statement in the specification to redefine “attached” or disavow the full scope of the term.).



### A. *Lexicography*

An applicant is entitled to be their own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s) in the specification at the relevant time. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (holding that an inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” and, if done, must “‘set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change” in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)).

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). Thus, if a claim term is used in its ordinary and customary meaning throughout the specification, and the written description clearly indicates its meaning, then the term in the claim has that meaning. *Old Town Canoe Co. v. Confluence Holdings Corp.*, 448 F.3d 1309, 1317, 78 USPQ2d 1705, 1711 (Fed. Cir. 2006) (The court held that “completion of coalescence” must be given its ordinary and customary meaning of reaching the end of coalescence. The court explained that even though coalescence could theoretically be “completed” by halting the molding process earlier, the specification clearly intended that completion of coalescence occurs only after the molding process reaches its optimum stage.).

However, it is important to note that any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir.

1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and [MPEP § 2173.05\(a\)](#). In *Apple Inc. v. Corephotonics, Ltd.*, 81 F.4th 1353, 1358-60, 2023 USPQ2d 1056 (Fed. Cir. 2023), the claim phrase “a point of view of the Wide camera” was held to only require a “Wide perspective point of view or Wide position point of view” after reviewing the specification. In particular, the court found that a reasonable reading of the specification defined two different types of Wide point of view – perspective and position, whereas the claim language was broad as to the point of view. The court also explained that claims should not be interpreted in a way that would omit a disclosed embodiment, absent evidence to the contrary. Thus, given the review of the intrinsic evidence, the court held that the claim language only required Wide perspective or Wide position point of view, but not both.

In some cases, the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in the context in the specification. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320-21, 75 USPQ2d 1321, 1332 (Fed. Cir. 2005) (*en banc*); *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). But where the specification is ambiguous as to whether the inventor used claim terms inconsistent with their ordinary meaning, the ordinary meaning will apply. *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005) (The Federal Circuit reversed the district court’s construction of the claim term “about” as “exactly.” The appellate court explained that a passage in the specification the district court relied upon for the definition of “about” was too ambiguous to redefine “about” to mean “exactly” in clear enough terms. The appellate court held that “about” should instead be given its plain and ordinary meaning of “approximately.”).

### B. *Disavowal*

Applicant may also rebut the presumption of plain meaning by clearly disavowing the full scope of the claim term in the specification. Disavowal, or disclaimer of claim scope, is only considered when



it is clear and unmistakable. See *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341, 58 USPQ2d 1059, 1063 (Fed. Cir. 2001) (“Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.”); see also *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1365-67, 70 USPQ2d 1827, 1831-33 (Fed. Cir. 2004) (refusing to limit claim term “user computer” to only “single-user computers” even though “some of the language of the specification, when viewed in isolation, might lead a reader to conclude that the term . . . is meant to refer to a computer that serves only a single user, the specification as a whole suggests a construction that is not so narrow”). But, in some cases, disavowal of a broader claim scope may be made by implication, such as where the specification contains only disparaging remarks with respect to a feature and every embodiment in the specification excludes that feature. *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149-50, 104 USPQ2d 1337, 1342-43 (Fed. Cir. 2012) (holding that the broadest reasonable interpretation of the claim term “electrochemical sensor” does not include a sensor having “external connection cables or wires” because the specification “repeatedly, consistently, and exclusively depict[s] an electrochemical sensor without external cables or wires while simultaneously disparaging sensors with external cables or wires”). But see *In re Clarke*, 809 Fed. Appx. 787, 794, 2020 USPQ2d 10253 (Fed. Cir. 2020) (“The doctrine of prosecution history estoppel is *inapplicable* during prosecution. Instead the doctrine is applicable only to *issued* patents.”) (emphasis in the original). If the examiner believes that the broadest reasonable interpretation of a claim is narrower than what the words of the claim otherwise suggest as the result of implicit disavowal in the specification, then the examiner should make the interpretation clear on the record.

See also [MPEP § 2173.05\(a\)](#).

## V. SUMMARY OF DETERMINING THE MEANING OF A CLAIM TERM THAT DOES NOT INVOKE 35 U.S.C. 112(f)

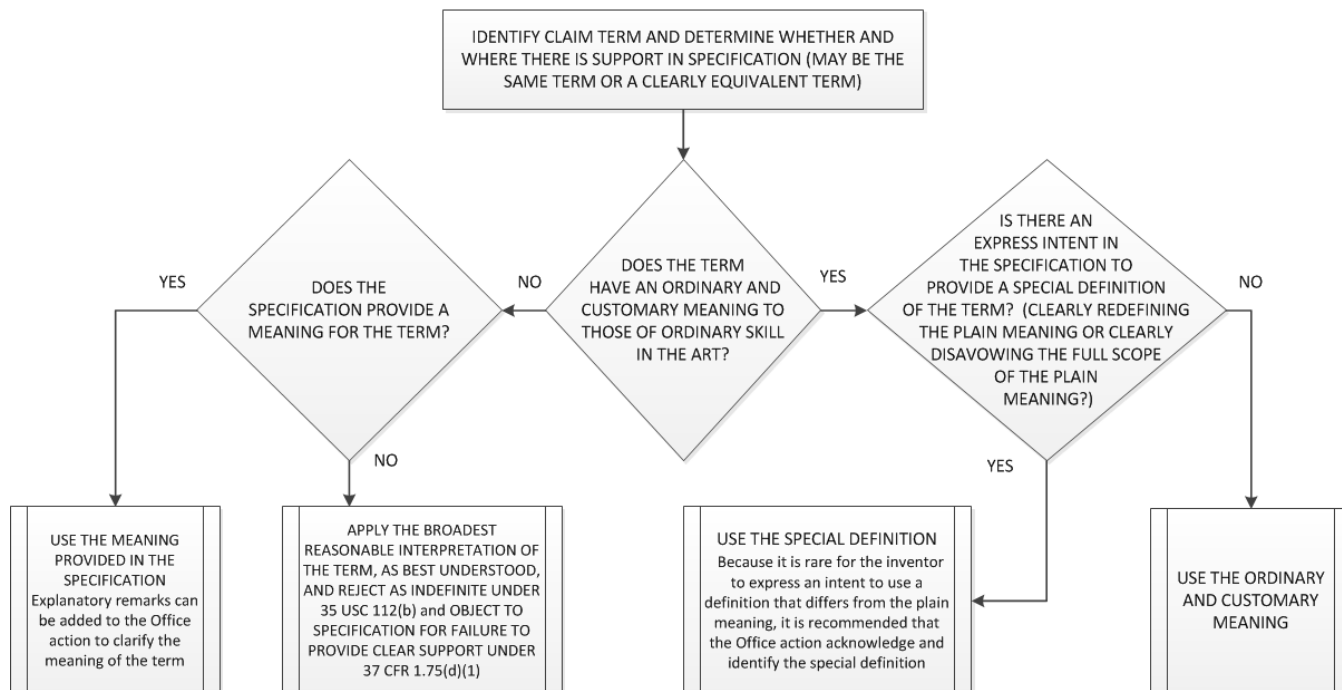
This flow chart indicates the decisions an examiner would follow in order to ascertain the proper claim interpretation based on the plain meaning definition of BRI. With each decision in the flow chart, a different path may need to be taken to conclude whether plain meaning applies or a special definition applies.

The first question is to determine whether a claim term has an ordinary and customary meaning to those of ordinary skill in the art. If so, then the examiner should check the specification to determine whether it provides a special definition for the claim term. If the specification does not provide a special definition for the claim term, the examiner should apply the ordinary and customary meaning to the claim term. If the specification provides a special definition for the claim term, the examiner should use the special definition. However, because there is a presumption that claim terms have their ordinary and customary meaning and the specification must provide a clear and intentional use of a special definition for the claim term to be treated as having a special definition, an Office action should acknowledge and identify the special definition in this situation.

Moving back to the first question, if a claim term does not have an ordinary and customary meaning, the examiner should check the specification to determine whether it provides a meaning to the claim term. If no reasonably clear meaning can be ascribed to the claim term after considering the specification and prior art, the examiner should apply the broadest reasonable interpretation to the claim term as it can be best understood. Also, the claim should be rejected under [35 U.S.C. 112\(b\)](#) and the specification objected to under [37 CFR 1.75\(d\)](#).

If the specification provides a meaning for the claim term, the examiner should use the meaning provided by the specification. It may be appropriate for an Office action to acknowledge and identify the meaning provided by the specification in this situation.

### HOW TO DETERMINE THE MEANING OF A CLAIM TERM THAT DOES NOT INVOLVE 35 USC 112(f)



#### 2111.02 Effect of Preamble [R-07.2022]

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.

*Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See *id.* at 808-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir.

1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.). *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,

481 (CCPA 1951) (A preamble reciting “[a]n abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Therefore, the preamble served to further define the structure of the article produced.).

### I. PREAMBLE STATEMENTS LIMITING STRUCTURE

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim” as drafted without importing “‘extraneous’ limitations from the specification.”); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) (The claim at issue was directed to a driver for setting a joint of a threaded collar; however, the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. “[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited.” *Id.* at 1073, 828 F.2d at 754.).

### II. PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim” as drafted without importing “‘extraneous’ limitations from the specification.” *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 2020 USPQ2d 10701 (Fed. Cir. 2020) (The court found that the preamble in one patent’s claim is limiting but is not in a related patent); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim); *STX LLC v. Brine*, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000) (holding that the preamble phrase “which provides improved playing and handling characteristics” in a claim drawn to a head for a lacrosse stick was not a claim limitation). Compare *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to “a human in need thereof,” the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated,

but rather is a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia.); *Nantkwest, Inc. v. Lee*, 686 Fed. App'x 864, 867 (Fed. Cir. 2017) (nonprecedential) (The court found that the preamble phrase “treating a cancer” “require[s] lysis of many cells, in order to accomplish the goal of treating cancer’ and not merely lysing one or a few cancer cells.”); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) (A claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase “rich in glucosinolates” helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently “rich in glucosinolates”).

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether or not the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. The court held that the intended use of hair curling was of no significance to the structure and process of making.); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus). To satisfy an intended use limitation which is limiting, a prior art structure which is capable of performing the intended use as recited in the preamble meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board’s factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant’s claim

1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also [MPEP § 2112](#) - [MPEP § 2112.02](#).

However, a “preamble may provide context for claim construction, particularly, where ... that preamble’s statement of intended use forms the basis for distinguishing the prior art in the patent’s prosecution history.” *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004). The patent claim at issue was directed to a two-step method for detecting a deficiency of vitamin B<sub>12</sub> or folic acid, involving (i) assaying a body fluid for an “elevated level” of homocysteine, and (ii) “correlating” an “elevated” level with a vitamin deficiency. *Id.* at 1358-59, 71 USPQ2d at 1084. The court stated that the disputed claim term “correlating” can include comparing with either an unelevated level or elevated level, as opposed to only an elevated level because adding the “correlating” step in the claim during prosecution to overcome prior art tied the preamble directly to the “correlating” step. *Id.* at 1362, 71 USPQ2d at 1087. The recitation of the intended use of “detecting” a vitamin deficiency in the preamble rendered the claimed invention a method for “detecting,” and, thus, was not limited to detecting “elevated” levels. *Id.*

See also *Catalina Mktg. Int’l*, 289 F.3d at 808-09, 62 USPQ2d at 1785 (“[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.... Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.” Consequently, “preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.”). In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004), the court stated that “a [r]eview of the entirety of the ’047 patent reveals that the preamble language relating to ‘blown-film’ does not state a purpose or an

intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim.” Compare *Intirtool, Ltd. v. Texar Corp.*, 369 F.3d 1289, 1294-96, 70 USPQ2d 1780, 1783-84 (Fed. Cir. 2004) (holding that the preamble of a patent claim directed to a “hand-held punch pliers for simultaneously punching and connecting overlapping sheet metal” was not a limitation of the claim because (i) the body of the claim described a “structurally complete invention” without the preamble, and (ii) statements in prosecution history referring to “punching and connecting” function of invention did not constitute “clear reliance” on the preamble needed to make the preamble a limitation).

### 2111.03 Transitional Phrases [R-01.2024]

The transitional phrases “comprising”, “consisting essentially of” and “consisting of” define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. The determination of what is or is not excluded by a transitional phrase must be made on a case-by-case basis in light of the facts of each case.

#### I. COMPRISING

The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) (“[L]ike the term ‘comprising,’ the terms ‘containing’ and ‘mixture’ are open-ended.”). *Invitrogen Corp. v. Biocrest Manufacturing, L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) (“The transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803

(CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). In *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to “a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades” encompasses razors with more than three blades because the transitional phrase “comprising” in the preamble and the phrase “group of” are presumptively open-ended. “The word ‘comprising’ transitioning from the preamble to the body signals that the entire claim is presumptively open-ended.” *Id.* In contrast, the court noted the phrase “group consisting of” is a closed term, which is often used in claim drafting to signal a “Markush group” that is by its nature closed. *Id.* The court also emphasized that reference to “first,” “second,” and “third” blades in the claim was not used to show a serial or numerical limitation but instead was used to distinguish or identify the various members of the group. *Id.*

In *Amgen Inc. v. Amneal Pharmaceuticals LLC*, 945 F.3d 1368, 1379, 2020 USPQ2d 3197 (Fed. Cir. 2020), in an infringement suit, the court interpreted a claim for a pharmaceutical composition having a “comprising” transition phrase and following limitations, including limitations requiring “at least one” binder and “at least one” disintegrant, each “consisting of” items listed in a Markush group. The court found that the Markush grouping recited particular binders or disintegrants, but while the components of the Markush grouping are closed as to the components therein, the claim transition “comprising” allowed for additional component(s) that were functionally similar to the members of the Markush grouping. Thus, the plain language of the claim requires “at least one” of the Markush members and does not further limit the claim to only binders and disintegrants listed in the Markush grouping. See also [MPEP § 2117](#) for further discussion of a Markush group.

#### II. CONSISTING OF

The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255



(CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith”). But see *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004) (holding that a bone repair kit “consisting of” claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals because the presence of the spatula was unrelated to the claimed invention). A claim which depends from a claim which “consists of” the recited elements or steps cannot add an element or step.

A claim element defined by selection from a group of alternatives (a Markush grouping; see [MPEP §§ 2117](#) and [2173.05\(h\)](#)) requires selection from a closed group “consisting of” (rather than “comprising” or “including”) the alternative members. *Abbott Labs. v. Baxter Pharmaceutical Products Inc.*, 334 F.3d 1274, 1280, 67 USPQ2d 1191, 1196-97 (Fed. Cir. 2003). If the claim element is intended to encompass combinations or mixtures of the alternatives set forth in the Markush grouping, the claim may include qualifying language preceding the recited alternatives (such as “at least one member” selected from the group), or within the list of alternatives (such as “or mixtures thereof”). *Id.* In the absence of such qualifying language there is a presumption that the Markush group is closed to combinations or mixtures. Cf. *Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 831 F.3d 1350, 1363-64, 119 USPQ2d 1773, 1784-85 (Fed. Cir. 2016) (presumption that Markush grouping does not encompass mixtures of listed resins overcome by intrinsic evidence in a dependent claim and the specification). See also *Amgen Inc. v. Amneal Pharmaceuticals LLC*, 945 F.3d 1368, 1378-79, 2020 USPQ2d 3179 (Fed. Cir. 2020) (the claim’s “comprising” transition phrase does not foreclose additional binders and disintegrants when an accused infringing product contains and meets the limitation’s requirements for one of the binders or disintegrants recited in the Markush groupings – there is no inconsistency with another binder or disintegrant outside of the Markush group also being part of the claimed formulation).

When the phrase “consisting of” appears in a clause of the body of a claim, rather than immediately following the preamble, there is an “exceptionally strong presumption that a claim term set off with ‘consisting of’ is closed to unrecited elements.”

*Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 831 F.3d 1350, 1359, 119 USPQ2d 1773, 1781 (Fed. Cir. 2016) (a layer “selected from the group consisting of” specific resins is closed to resins other than those listed). However, the “consisting of” phrase limits only the element set forth in that clause; other elements are not excluded from the claim as a whole.

*Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004) (The claims at issue “related to purified DNA molecules having promoter activity for the human involucrin gene (hINV).” *Id.*, 73 USPQ2d at 1365. In determining the scope of applicant’s claims directed to “a purified oligonucleotide comprising at least a portion of the nucleotide sequence of SEQ ID NO:1 wherein said portion consists of the nucleotide sequence from ... to 2473 of SEQ ID NO:1, and wherein said portion of the nucleotide sequence of SEQ ID NO:1 has promoter activity,” the court stated that the use of “consists” in the body of the claims did not limit the open-ended “comprising” language in the claims (emphases added). *Id.* at 1257, 73 USPQ2d at 1367. The court held that the claimed promoter sequence designated as SEQ ID NO:1 was obtained by sequencing the same prior art plasmid and was therefore anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. *Id.* at 1256 and 1259, 73 USPQ2d at 1366 and 1369. The court affirmed the Board’s interpretation that the transition phrase “consists” did not limit the claims to only the recited numbered nucleotide sequences of SEQ ID NO:1 and that “the transition language ‘comprising’ allowed the claims to cover the entire involucrin gene plus other portions of the plasmid, as long as the gene contained the specific portions of SEQ ID NO:1 recited by the claim[s].” *Id.* at 1256, 73 USPQ2d at 1366.).

### III. CONSISTING ESSENTIALLY OF

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid “consisting essentially of” certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants’ specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). “A ‘consisting essentially of’ claim occupies a middle ground between closed claims that are written in a ‘consisting of’ format and fully open claims that are drafted in a ‘comprising’ format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under [35 U.S.C. 102](#) and [103](#), absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase ‘consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). See also *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1240-41, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003) (Applicant’s statement in the specification that “silicon contents in the coating metal should not exceed about 0.5% by weight” along with a

discussion of the deleterious effects of silicon provided basis to conclude that silicon in excess of 0.5% by weight would materially alter the basic and novel properties of the invention. Thus, “consisting essentially of” as recited in the preamble was interpreted to permit no more than 0.5% by weight of silicon in the aluminum coating.); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of the claimed invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) (“Although ‘consisting essentially of’ is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant’s burden to establish that a step practiced in a prior art method is excluded from his claims by ‘consisting essentially of’ language.”).

### IV. OTHER TRANSITIONAL PHRASES

Transitional phrases such as “having” must be interpreted in light of the specification to determine whether open or closed claim language is intended. See, e.g., *Lampi Corp. v. American Power Products Inc.*, 228 F.3d 1365, 1376, 56 USPQ2d 1445, 1453 (Fed. Cir. 2000) (interpreting the term “having” as open terminology, allowing the inclusion of other components in addition to those recited); *Crystal Semiconductor Corp. v. TriTech Microelectronics Int’l Inc.*, 246 F.3d 1336, 1348, 57 USPQ2d 1953, 1959 (Fed. Cir. 2001) (term “having” in transitional phrase “does not create a presumption that the body of the claim is open”); *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1573, 43 USPQ2d 1398, 1410 (Fed. Cir. 1997) (in the context of a cDNA having a sequence coding for human PI, the term “having” still permitted inclusion of other

moieties). The transitional phrase “composed of” has been interpreted in the same manner as either “consisting of” or “consisting essentially of,” depending on the facts of the particular case. See *AFG Industries, Inc. v. Cardinal IG Company*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001) (based on specification and other evidence, “composed of” interpreted in same manner as “consisting essentially of”); *In re Bertsch*, 132 F.2d 1014, 1019-20, 56 USPQ 379, 384 (CCPA 1942) (“Composed of” interpreted in same manner as “consisting of”; however, the court further remarked that “the words ‘composed of’ may under certain circumstances be given, in patent law, a broader meaning than ‘consisting of.’”).

#### **2111.04 “Adapted to,” “Adapted for,” “Wherein,” “Whereby,” and Contingent Clauses [R-10.2019]**

##### **I. “ADAPTED TO,” “ADAPTED FOR,” “WHEREIN,” and “WHEREBY”**

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. See, e.g., *Griffin v. Bertina*, 285 F.3d 1029, 1034, 62 USPQ2d 1431 (Fed. Cir. 2002) (finding that a “wherein” clause limited a process claim where the clause gave “meaning and purpose to the manipulative steps”). In *In re Giannelli*, 739 F.3d 1375, 1378, 109 USPQ2d 1333, 1336 (Fed. Cir. 2014), the court found that an “adapted to” clause limited a machine claim where “the written description makes clear that ‘adapted to,’ as used in the [patent] application, has a narrower meaning, viz., that the claimed machine is designed or constructed to be used as a rowing machine whereby a pulling force is exerted on the handles.” In *Hoffer*

*v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted that a “‘whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.* (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

##### **II. CONTINGENT LIMITATIONS**

The broadest reasonable interpretation of a method (or process) claim having contingent limitations requires only those steps that must be performed and does not include steps that are not required to be performed because the condition(s) precedent are not met. For example, assume a method claim requires step A if a first condition happens and step B if a second condition happens. If the claimed invention may be practiced without either the first or second condition happening, then neither step A or B is required by the broadest reasonable interpretation of the claim. If the claimed invention requires the first condition to occur, then the broadest reasonable interpretation of the claim requires step A. If the claimed invention requires both the first and second conditions to occur, then the broadest reasonable interpretation of the claim requires both steps A and B.

The broadest reasonable interpretation of a system (or apparatus or product) claim having structure that performs a function, which only needs to occur if a condition precedent is met, requires structure for performing the function should the condition occur. The system claim interpretation differs from a method claim interpretation because the claimed structure must be present in the system regardless of whether the condition is met and the function is actually performed.

See *Ex parte Schulhauser*, Appeal 2013-007847 (PTAB April 28, 2016) for an analysis of contingent claim limitations in the context of both method claims and system claims. In *Schulhauser*, both method claims and system claims recited the same contingent step. When analyzing the claimed method

as a whole, the PTAB determined that giving the claim its broadest reasonable interpretation, “[i]f the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed” (quotation omitted). *Schulhauser* at 10. When analyzing the claimed system as a whole, the PTAB determined that “[t]he broadest reasonable interpretation of a system claim having structure that performs a function, which only needs to occur if a condition precedent is met, still requires structure for performing the function should the condition occur.” *Schulhauser* at 14. Therefore “[t]he Examiner did not need to present evidence of the obviousness of the [ ] method steps of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim (e.g., instances in which the electrocardiac signal data is not within the threshold electrocardiac criteria such that the condition precedent for the determining step and the remaining steps of claim 1 has not been met);” however to render the claimed system obvious, the prior art must teach the structure that performs the function of the contingent step along with the other recited claim limitations. *Schulhauser* at 9, 14.

See also [MPEP § 2143.03](#).

### **2111.05 Functional and Nonfunctional Descriptive Material [R-07.2022]**

USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Since a claim must be read as a whole, USPTO personnel may not disregard claim limitations that include printed matter. See *Id.* at 1384, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). The first step of the printed matter analysis is the determination that the limitation in question is in fact directed toward printed matter. “Our past cases establish a necessary condition for falling into the category of printed matter: a limitation is printed matter only if it claims the content of information.” See *In re DiStefano*, 808 F.3d 845, 848, 117 USPQ2d 1265, 1267 (Fed. Cir. 2015). “[O]nce it is determined that the limitation is directed to printed matter, [the

examiner] must then determine if the matter is functionally or structurally related to the associated physical substrate, and only if the answer is ‘no’ is the printed matter owed no patentable weight.” *Id.* at 850, 117 USPQ2d at 1268. If a new and nonobvious functional relationship between the printed matter and the substrate does exist, the examiner should give patentable weight to printed matter. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). The rationale behind the printed matter cases, in which, for example, written instructions are added to a known product, has been extended to method claims in which an instructional limitation is added to a method known in the art. Similar to the inquiry for products with printed matter thereon, in such method cases the relevant inquiry is whether a new and nonobvious functional relationship with the known method exists. See *In re DiStefano*, 808 F.3d 845, 117 USPQ2d 1265 (Fed. Cir. 2015); *In re Kao*, 639 F.3d 1057, 1072-73, 98 USPQ2d 1799, 1811-12 (Fed. Cir. 2011); *King Pharmaceuticals Inc. v. Eon Labs Inc.*, 616 F.3d 1267, 1279, 95 USPQ2d 1833, 1842 (Fed. Cir. 2010).

#### **I. DETERMINING WHETHER A FUNCTIONAL RELATIONSHIP EXISTS BETWEEN PRINTED MATTER AND ASSOCIATED SUBSTRATE**

##### **A. Evidence Supporting a Functional Relationship**

To be given patentable weight, the printed matter and associated product must be in a functional relationship. A functional relationship can be found where the printed matter performs some function with respect to the product to which it is associated. See *Lowry*, 32 F.3d at 1584, 32 USPQ2d at 1035 (citing *Gulack*, 703 F.2d at 1386, 217 USPQ at 404). For instance, indicia on a measuring cup perform the function of indicating volume within that measuring cup. See *In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (CCPA 1969). A functional relationship can also be found where the product performs some function with respect to the printed matter to which it is associated. For instance, where a hatband places a string of numbers in a certain physical relationship to each other such that a

claimed algorithm is satisfied due to the physical structure of the hatband, the hatband performs a function with respect to the string of numbers. See *Gulack*, 703 F.2d at 1386-87, 217 USPQ at 405.

### **B. Evidence Against a Functional Relationship**

Where a product merely serves as a support for printed matter, no functional relationship exists. These situations may arise where the claim as a whole is directed towards conveying a message or meaning to a human reader independent of the supporting product. For example, a hatband with images displayed on the hatband but not arranged in any particular sequence was found to only serve as support and display for the printed matter. See *Gulack*, 703 F.2d at 1386, 217 USPQ at 404. Another example in which a product merely serves as a support would occur for a deck of playing cards having images on each card. See *In re Bryan*, 323 Fed. App'x 898 (Fed. Cir. 2009) (unpublished). In *Bryan* the applicant asserted that the printed matter allowed the cards to be “collected, traded, and drawn”; “identify and distinguish one deck of cards from another”; and “enable[] the card to be traded and blind drawn”. However, the court found that these functions do not pertain to the structure of the apparatus and were instead drawn to the method or process of playing a game. See also *Ex parte Gwinn*, 112 USPQ 439, 446-47 (Bd. Pat. App. & Int. 1955), in which the invention was directed to a set of dice by means of which a game may be played. The claims differed from the prior art solely by the printed matter in the dice. The claims were properly rejected on prior art because there was no new feature of physical structure and no new relation of printed matter to physical structure. For example, a claimed measuring tape having electrical wiring information thereon, or a generically claimed substrate having a picture of a golf ball thereupon, would lack a functional relationship as the claims as a whole are directed towards conveying wiring information (unrelated to the measuring tape) or an aesthetically pleasing image (unrelated to the substrate) to the reader. Additionally, where the printed matter and product do not depend upon each other, no functional relationship exists. For example, in a kit containing a set of chemicals and a printed set of instructions for using the chemicals, the instructions are not related to that particular set of

chemicals. *In re Ngai*, 367 F.3d at 1339, 70 USPQ2d at 1864.

## **II. FUNCTIONAL RELATIONSHIP BETWEEN PRINTED MATTER AND ASSOCIATED SUBSTRATE MUST BE NEW AND NONOBVIOUS**

Once a functional relationship between the product and associated printed matter is found, the investigation shifts to the determination of whether the relationship is new and nonobvious. For example, a claim to a color-coded indicia on a container in which the color indicates the expiration date of the container may give rise to a functional relationship. The claim may, however, be anticipated by prior art that reads on the claimed invention, or by a combination of prior art that teaches the claimed invention.

## **III. MACHINE-READABLE MEDIA**

When determining the scope of a claim directed to a computer-readable medium containing certain programming, the examiner should first look to the relationship between the programming and the intended computer system. Where the programming performs some function with respect to the computer with which it is associated, a functional relationship will be found. For instance, a claim to computer-readable medium programmed with attribute data objects that perform the function of facilitating retrieval, addition, and removal of information in the intended computer system, establishes a functional relationship such that the claimed attribute data objects are given patentable weight. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

However, where the claim as a whole is directed to conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists. For example, a claim to a memory stick containing tables of batting averages, or tracks of recorded music, utilizes the intended computer system merely as a support for the information. Such claims are directed toward conveying meaning to the human reader rather than



towards establishing a functional relationship between recorded data and the computer.

A claim directed to a computer readable medium storing instructions or executable code that recites an abstract idea must be evaluated for eligibility under [35 U.S.C. 101](#). See [MPEP § 2106](#).

## 2112 Requirements of Rejection Based on Inherency; Burden of Proof [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to pre-AIA [35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to pre-AIA [35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under [35 U.S.C. 102](#) or [103](#). “The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a [35 U.S.C. 103](#) rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

### I. SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir.

1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. The court stated that “just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel.” *Id.* See also [MPEP § 2112.01](#) with regard to inherency and product-by-process claims and [MPEP § 2141.02](#) with regard to inherency and rejections under [35 U.S.C. 103](#).

### II. INHERENT FEATURE NEED NOT BE RECOGNIZED AT THE RELEVANT TIME

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure *at the relevant time*, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) (“[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.”); *Abbott Labs v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed. Cir. 1999) (“If a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics.”); *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1348-49, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999) (“Because ‘sufficient

aeration' was inherent in the prior art, it is irrelevant that the prior art did not recognize the key aspect of [the] invention.... An inherent structure, composition, or function is not necessarily known.”); *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343-44, 74 USPQ2d 1398, 1406-07 (Fed. Cir. 2005) (holding that a prior art patent to an anhydrous form of a compound “inherently” anticipated the claimed hemihydrate form of the compound because practicing the process in the prior art to manufacture the anhydrous compound “inherently results in at least trace amounts of” the claimed hemihydrate even if the prior art did not discuss or recognize the hemihydrate); *In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1373, 82 USPQ2d 1643, 1650 (Fed. Cir. 2007) (The court noted that although the inventors may not have recognized that a characteristic of the ingredients in the prior art method resulted in an *in situ* formation of a separating layer, the *in situ* formation was nevertheless inherent. “The record shows formation of the *in situ* separating layer in the prior art even though that process was not recognized at the time. The new realization alone does not render that necessary [sic] prior art patentable.”).

### III. A REJECTION UNDER 35 U.S.C. 102 AND 103 CAN BE MADE WHEN THE PRIOR ART PRODUCT SEEMS TO BE IDENTICAL EXCEPT THAT THE PRIOR ART IS SILENT AS TO AN INHERENT CHARACTERISTIC

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both [35 U.S.C. 102](#) and [103](#). “There is nothing inconsistent in concurrent rejections for obviousness under [35 U.S.C. 103](#) and for anticipation under [35 U.S.C. 102](#).” *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a [35 U.S.C. 102](#) and [103](#) rejection is appropriate for these types of claims as well as for composition claims.

### IV. EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TO SHOW INHERENCY

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. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Also, “[a]n invitation to investigate is not an inherent disclosure” where a prior art reference “discloses no more than a broad genus of potential applications of its discoveries.” *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that “[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category” but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species).

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In *PAR Pharmaceutical, Inc. v. TWI Pharmaceuticals, Inc.*, 773 F.3d 1186, 112 USPQ2d 1945 (Fed. Cir. 2014), the Federal Circuit remanded a decision to the district court because the record did not present sufficient evidence to prove inherency in the context of obviousness. The district court concluded the pharmacokinetic parameters of a claim are inherent properties of the obvious formulation. The Federal Circuit stated that while “inherency may support a missing claim limitation in an obviousness analysis”, “the use of inherency, a doctrine originally rooted in anticipation, must be carefully circumscribed in the context of obviousness.” *Id.* at 1194-95, 112 USPQ2d at 1952. “[I]n order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis – the limitation at issue necessarily must be present, or the natural result of the combination of elements

explicitly disclosed by the prior art.” *Id.* at 1195-96, 112 USPQ2d at 1952. But see, *Persion Pharms. LLC v. Alvogen Malta Operations LTD.*, 945 F.3d 1184, 1191, 2019 USPQ2d 494084 (Fed. Cir. 2019), where the court stated that a proper finding of inherency does not require that all limitations are taught in a single reference, and that inherency may meet a missing claim limitation when the limitation is “the natural result of the *combination of prior art elements*.” (emphasis in original). The court found that pharmacokinetic limitations of the asserted claims were inherently met by combining prior art references because the limitations were necessarily present in the prior art combination. *Id.* See also *Hospira, Inc. v. Fresenius Kabi USA, LLC*, 946 F.3d 1322, 1329-32, 2020 USPQ2d 6227 (Fed. Cir. 2020).

In *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997), the court affirmed a finding that a prior patent to a conical spout used primarily to dispense oil from an oil can inherently performed the functions recited in applicant’s claim to a conical container top for dispensing popped popcorn. The examiner had asserted inherency based on the structural similarity between the patented spout and applicant’s disclosed top, i.e., both structures had the same general shape. The court stated:

[N]othing in Schreiber’s [applicant’s] claim suggests that Schreiber’s container is ‘of a different shape’ than Harz’s [patent]. In fact, [ ] an embodiment according to Harz (Fig. 5) and the embodiment depicted in figure 1 of Schreiber’s application have the same general shape. For that reason, the examiner was justified in concluding that the opening of a conically shaped top as disclosed by Harz is inherently of a size sufficient to ‘allow [ ] several kernels of popped popcorn to pass through at the same time’ and that the taper of Harz’s conically shaped top is inherently of such a shape ‘as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted to the container.’ The examiner therefore correctly found that Harz established a prima facie case of anticipation.

*Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432.

#### **V. ONCE A REFERENCE TEACHING PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS MADE THE BASIS OF A REJECTION, AND THE EXAMINER PRESENTS EVIDENCE OR REASONING TO SHOW INHERENCY, THE BURDEN OF PRODUCTION SHIFTS TO THE APPLICANT**

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on ‘inherency’ under [35 U.S.C. 102](#), on ‘prima facie obviousness’ under [35 U.S.C. 103](#), jointly or alternatively, the burden of proof is the same.” *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) (footnote and citation omitted). The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (citing *Best*, 562 F.2d at 1255).

In *Fitzgerald*, the claims were directed to a self-locking screw-threaded fastener comprising a metallic threaded fastener having patches of crystallizable thermoplastic bonded thereto. The claim further specified that the thermoplastic had a reduced degree of crystallization shrinkage. The specification disclosed that the locking fastener was made by heating the metal fastener to melt a thermoplastic blank which is pressed against the metal. After the thermoplastic adheres to the metal fastener, the end product is cooled by quenching in water. The examiner made a rejection based on a U.S. patent to Barnes. Barnes taught a self-locking fastener in which the patch of thermoplastic was made by depositing thermoplastic powder on a metallic fastener which was then heated. The end product was cooled in ambient air, by cooling air or by contacting the fastener with a water trough. The court first noted that the two fasteners were identical or only slightly different from each other. “Both fasteners possess the same utility, employ the same crystallizable polymer (nylon 11), and have an adherent plastic patch formed by melting and then cooling the polymer.” *Id.* at 596 n.1, 619 F.2d at 70 n.1. The court then noted that the Board had found that Barnes’ cooling rate could reasonably be expected to result in a polymer possessing the claimed crystallization shrinkage rate. Applicants had not rebutted this finding with evidence that the

shrinkage rate was indeed different. They had only argued that the crystallization shrinkage rate was dependent on the cool down rate and that the cool down rate of Barnes was much slower than theirs. Because a difference in the cool down rate does not necessarily result in a difference in shrinkage, objective evidence was required to rebut the [35 U.S.C. 102/103](#) *prima facie* case.

In *Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed.Cir.1997), the court held that applicant's declaration failed to overcome a *prima facie* case of anticipation because the declaration did not specify the dimensions of either the dispensing top that was tested or the popcorn that was used. Applicant's declaration merely asserted that a conical dispensing top built according to a figure in the prior art patent was too small to jam and dispense popcorn and thus could not inherently perform the functions recited in applicant's claims. The court pointed out the disclosure of the prior art patent was not limited to use as an oil can dispenser, but rather was broader than the precise configuration shown in the patent's figure. The court also noted that the Board found as a factual matter that a scaled-up version of the top disclosed in the patent would be capable of performing the functions recited in applicant's claim.

See [MPEP § 2113](#) for more information on the analogous burden of proof applied to product-by-process claims.

## 2112.01 Composition, Product, and Apparatus Claims [R-10.2019]

### I. PRODUCT AND APPARATUS CLAIMS — WHEN THE STRUCTURE RECITED IN THE REFERENCE IS SUBSTANTIALLY IDENTICAL TO THAT OF THE CLAIMS, CLAIMED PROPERTIES OR FUNCTIONS ARE PRESUMED TO BE INHERENT

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products

of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims were directed to a titanium alloy containing 0.2-0.4% Mo and 0.6-0.9% Ni having corrosion resistance. A Russian article disclosed a titanium alloy containing 0.25% Mo and 0.75% Ni but was silent as to corrosion resistance. The Federal Circuit held that the claim was anticipated because the percentages of Mo and Ni were squarely within the claimed ranges. The court went on to say that it was immaterial what properties the alloys had or who discovered the properties because the composition is the same and thus must necessarily exhibit the properties.).

See also *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971) (Claim 1 was directed to a parachute canopy having concentric circumferential panels radially separated from each other by radially extending tie lines. The panels were separated “such that the critical velocity of each successively larger panel will be less than the critical velocity of the previous panel, whereby said parachute will sequentially open and thus gradually decelerate.” The court found that the claim was anticipated by Menget. Menget taught a parachute having three circumferential panels separated by tie lines. The court upheld the rejection finding that applicant had failed to show that Menget did not possess the functional characteristics of the claims.); *Northam Warren Corp. v. D. F. Newfield Co.*, 7 F.Supp. 773, 22 USPQ 313 (E.D.N.Y. 1934) (A patent to a pencil for cleaning fingernails was held invalid because a pencil of the same structure for writing was found in the prior art.).

### II. COMPOSITION CLAIMS — IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES

“Products of identical chemical composition can not have mutually exclusive properties.” *In re Spada*,



911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *Id.* (Applicant argued that the claimed composition was a pressure sensitive adhesive containing a tacky polymer while the product of the reference was hard and abrasion resistant. “The Board correctly found that the virtual identity of monomers and procedures sufficed to support a *prima facie* case of unpatentability of Spada’s polymer latexes for lack of novelty.”).

### **III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT**

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed, explaining “[i]f we were to adopt [applicant’s] position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product.”). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability....[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.”); *In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969) (finding a new and nonobvious relationship between a measuring cup and writing showing how to “half” a recipe); *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art); *In re Xiao*, 462 Fed. App’x 947,

950-51 (Fed. Cir. 2011) (non-precedential) (affirming an obviousness rejection of claims directed to a tumbler lock that used letters instead of numbers and had a wild-card label instead of one of the letters); *In re Bryan*, 323 Fed. App’x 898, 901 (Fed. Cir. 2009) (non-precedential) (printed matter on game cards bears no new and nonobvious functional relationship to game board).

The court has extended the rationale in the printed matter cases, in which, for example, written instructions are added to a known product, to method claims in which “an instruction limitation” (i.e., a limitation “informing” someone about the existence of an inherent property of that method) is added to a method known in the art. *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279, 95 USPQ2d 1833, 1842 (2010). Similar to the inquiry for products with printed matter thereon, for such method cases the relevant inquiry is whether a new and nonobvious functional relationship with the known method exists. In *King Pharma*, the court found that the relevant determination is whether the “instruction limitation” has a “new and unobvious functional relationship” with the known method of administering the drug with food. *Id.* The court held that the relationship was non-functional because “[i]nforming a patient about the benefits of a drug in no way transforms the process of taking the drug with food.” *Id.* That is, the actual method of taking a drug with food is the same regardless of whether the patient is informed of the benefits. *Id.* “In other words, the ‘informing’ limitation ‘in no way depends on the method, and the method does not depend on the ‘informing’ limitation.’” *Id.* (citing *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)); see also *In re Kao*, 639 F.3d 1057, 1072-73, 98 USPQ2d 1799, 1811-12 (Fed. Cir. 2011).

## **2112.02 Process Claims [R-01.2024]**

### **I. PROCESS CLAIMS — PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION**

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated



by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) (The claims were directed to a method of enhancing color effects produced by ambient light through a process of absorption and reflection of the light off a coated substrate. A prior art reference to *Donley* disclosed a glass substrate coated with silver and metal oxide 200-800 angstroms thick. While *Donley* disclosed using the coated substrate to produce architectural colors, the absorption and reflection mechanisms of the claimed process were not disclosed. However, *King*'s specification disclosed using a coated substrate of *Donley*'s structure for use in his process. The Federal Circuit upheld the Board's finding that "Donley inherently performs the function disclosed in the method claims on appeal when that device is used in 'normal and usual operation'" and found that a *prima facie* case of anticipation was made out. *Id.* at 138, 801 F.2d at 1326. It was up to applicant to prove that *Donley*'s structure would not perform the claimed method when placed in ambient light.). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Applicant claimed a process for preparing a hydrolytically-stable zeolitic aluminosilicate which included a step of "cooling the steam zeolite ... at a rate sufficiently rapid that the cooled zeolite exhibits an X-ray diffraction pattern ..." All the process limitations were expressly disclosed by a U.S. patent to *Hansford* except the cooling step. The court stated that any sample of *Hansford*'s zeolite would necessarily be cooled to facilitate subsequent handling. Therefore, rejections under [35 U.S.C. 102](#) and [103](#) were properly made. Applicant had failed to introduce any evidence comparing X-ray diffraction patterns showing a difference in cooling rate between the claimed process and that of *Hansford* or any data showing that the process of *Hansford* would result in a product with a different X-ray diffraction. Either type of evidence would have rebutted the rejections under [35 U.S.C. 102](#). A further analysis would be necessary to determine if the process was nonobvious under [35 U.S.C. 103](#).); *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes

by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to *Dart* disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. *Dart* was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.).

## II. PROCESS OF USE CLAIMS — NEW AND NONOBVIOUS USES OF OLD STRUCTURES AND COMPOSITIONS MAY BE PATENTABLE

The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. *In re May*, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978) (Claims 1 and 6, directed to a method of effecting nonaddictive analgesia (pain reduction) in animals, were found to be anticipated by the applied prior art which disclosed the same compounds, as well as a method of using them for effecting analgesia but which was silent as to addiction. The court upheld the rejection and stated that the inventors had merely found a new property of the compound and such a discovery did not constitute a new use. The court went on to reverse the obviousness rejection of claims 2-5 and 7-10 which recited a process of using a new compound. The court relied on evidence showing that the nonaddictive property of the new compound was unexpected.). See also *In re Tomlinson*, 363 F.2d 928, 150 USPQ 623 (CCPA 1966) (The claim was directed to a process of inhibiting light degradation of polypropylene by mixing it with one of a genus of compounds, including nickel dithiocarbamate. A reference taught mixing polypropylene with nickel dithiocarbamate to lower heat degradation. The court held that the claims read on the obvious process of mixing polypropylene with the nickel dithiocarbamate and that the preamble of the claim was merely directed to the result of mixing the two materials. "While the references do not show a

specific recognition of that result, its discovery by appellants is tantamount only to finding a property in the old composition.” 363 F.2d at 934, 150 USPQ at 628 (emphasis in original)).

## 2113 Product-by-Process Claims [R-01.2024]

### I. PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE IMPLIED BY THE STEPS

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product.). Furthermore, “[b]ecause validity is determined based on the requirements of patentability, a patent is invalid if a product made by the process recited in a product-by-process claim is anticipated by or obvious from prior art products, even if those prior art products are made by different processes.” *Amgen Inc. v. F. Hoffmann-La Roche Ltd.*, 580 F.3d 1340, 1370 n. 14, 92 USPQ2d 1289, 1312, n. 14 (Fed. Cir. 2009). See also *Biogen MA Inc. v. EMD Serono, Inc.*, 976 F.3d 1326, 1334, 2020 USPQ2d 11129 (Fed. Cir. 2020) (“Biogen is certainly correct that the scope of composition and method of treatment claims is generally subject to distinctly different analyses. But where, as here, the novelty of the method of administration rests wholly on the novelty of the composition administered, which in

turn rests on the novelty of the source limitation, the *Amgen* analysis will necessarily result in the same conclusion on anticipation for both forms of claims.”); *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1373, 2023 USPQ2d 862 (Fed. Cir. 2023) (the court held that product-by-process claims were properly rejected as “anticipated by a disclosure of the same product irrespective of the processes by which they are made.”); and *Purdue Pharma v. Epic Pharma*, 811 F.3d 1345, 117 USPQ2d 1733 (Fed. Cir. 2016). However, in the context of an infringement analysis, a product-by-process claim is only infringed by a product made by the process recited in the claim. *Id.* at 1370 (“a product in the prior art made by a different process can anticipate a product-by-process claim, but an accused product made by a different process cannot infringe a product-by-process claim”).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding “interbonded by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations). See also *In re Nordt Dev. Co.*, 881 F.3d 1371, 1375-76, 125 USPQ2d 1817, 1820 (Fed. Cir. 2018) (holding “the specification demonstrates that ‘injected molded’ connotes an integral structure,” and discussing several cases since *Garner* that held “limitations to convey structure even when they also describe a process of manufacture”).

### II. ONCE A PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS FOUND AND A PRIOR ART REJECTION IS MADE, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN NONOBVIOUS DIFFERENCE

“The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for

product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). 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 a nonobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-33 (Fed. Cir. 1983) (The claims were directed to a zeolite manufactured by mixing together various inorganic materials in solution and heating the resultant gel to form a crystalline metal silicate essentially free of alkali metal. The prior art described a process of making a zeolite which, after ion exchange to remove alkali metal, appeared to be “essentially free of alkali metal.” The court upheld the rejection because the applicant had not come forward with any evidence that the prior art was not “essentially free of alkali metal” and therefore a different and nonobvious product.).

See also *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (The prior art disclosed human nerve growth factor (b-NGF) isolated from human placental tissue. The claim was directed to b-NGF produced through genetic engineering techniques. The factor produced seemed to be substantially the same whether isolated from tissue or produced through genetic engineering. While the applicant questioned the purity of the prior art factor, no concrete evidence of a nonobvious difference was presented. The Board stated that the dispositive issue is whether the claimed factor exhibits any unexpected properties compared with the factor disclosed by the prior art. The Board further stated that the applicant should have made some comparison between the two factors to establish unexpected properties since the materials appeared to be identical or only slightly different.).

### III. A REJECTION BASED ALTERNATIVELY ON 35 U.S.C. 102 OR 103 FOR PRODUCT-BY-PROCESS CLAIMS HAS BEEN APPROVED BY THE COURTS

“[T]he lack of physical description in a product-by-process claim makes determination of

the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either [section 102](#) or [section 103](#) of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Office personnel should note that reliance on the alternative grounds of [35 U.S.C. 102](#) or [35 U.S.C. 103](#) does not eliminate the need to explain both the anticipation and obviousness aspects of the rejections.

### 2114 Apparatus and Article Claims — Functional Language [R-07.2015]

For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see [MPEP § 2181 - § 2186](#).

#### I. INHERENCY AND FUNCTIONAL LIMITATIONS IN APPARATUS CLAIMS

Features of an apparatus may be recited either structurally or functionally. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). See also [MPEP § 2173.05\(g\)](#). If an examiner concludes that a functional limitation is an inherent characteristic of the prior art, then to establish a prima case of anticipation or obviousness, the examiner should explain that the prior art structure inherently possesses the functionally defined limitations of the claimed apparatus. *In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432. See also *Bettcher Industries, Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 639-40, 100 USPQ2d 1433, 1440 (Fed. Cir. 2011). The burden then shifts to applicant to establish that the prior art does not possess the characteristic relied on. *In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432; *In re Swinehart*, 439

F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971) (“where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on”).

## II. MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART

“[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material.” The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

## III. A PRIOR ART DEVICE CAN PERFORM ALL THE FUNCTIONS OF THE APPARATUS CLAIM AND STILL NOT ANTICIPATE THE CLAIM

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. It should be noted, however, that means-plus-function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994). See also

*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

## IV. DETERMINING WHETHER A COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATION IS PATENTABLE OVER THE PRIOR ART UNDER 35 U.S.C. 102 AND 103

Functional claim language that is not limited to a specific structure covers all devices that are capable of performing the recited function. Therefore, if the prior art discloses a device that can inherently perform the claimed function, a rejection under [35 U.S.C. 102](#) and/or [35 U.S.C. 103](#) may be appropriate. See *In re Translogic Technology, Inc.*, 504 F.3d 1249, 1258, 84 USPQ2d 1929, 1935-1936 (Fed. Cir. 2007) (The claims were drawn to multiplexer circuit. The patent at issue claimed “coupled to” and “coupled to receive” between various portions of the circuitry. In reference to the claim phrase “input terminals ‘coupled to receive’ first and second input variables,” the court held that “the claimed circuit does not require any specific input or connection ... [a]s such, ‘coupled to’ and ‘coupled to receive’ are clearly different ... [a]s shown in [the figures of the] patent, input terminals ... only need to be ‘capable of receiving’ an input variable for the multiplexer circuit as claimed”. Therefore, the specification supported the claim construction “that ‘coupled to receive’ means ‘capable of receiving.’”); *Intel Corp. v. U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832, 20 USPQ2d 1161, 1171 (Fed. Cir. 1991) (The court held that “programmable” claim language required only that the accused product could be programmed to perform the claimed functionality.); *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 566-67 (CCPA 1971); *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971) (“[I]t is elementary that the mere recitation of a



newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art”). See [MPEP § 2112](#) for more information.

Conversely, computer-implemented functional claim limitations may narrow the functionality of the device, by limiting the specific structure capable of performing the recited function. *Nazomi Communications, Inc. v. Nokia Corp.*, 739 F.3d 1339, 1345, 109 USPQ2d 1258, 1262 (Fed. Cir. 2014) (The claims were drawn to a CPU that can perform processing of both register-based and stack-based instructions. Appellant alleged infringement of the claims based on claim construction requiring only hardware capable of performing the claimed functionalities. Contrasted with the finding of *Intel Corp. v. U.S. Int’l Trade Comm’n*, 846 F.2d 821, 832, 20 USPQ2d 1161, 1171 (Fed. Cir. 1991), the court found that “[s]ince hardware cannot meet these limitations in the absence of enabling software, the claims are properly construed as claiming an apparatus comprising a combination of hardware and software capable of practicing the claim limitations.”).

Computer-implemented functional claim limitations may also be broad because the term “computer” is commonly understood by one of ordinary skill in the art to describe a variety of devices with varying degrees of complexity and capabilities. *In re Paulsen*, 30 F.3d 1475, 1479-80, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Therefore, a claim containing the term “computer” should not be construed as limited to a computer having a specific set of characteristics and capabilities, unless the term is modified by other claim terms or clearly defined in the specification to be different from its common meaning. *Id.* In *Paulsen*, the claims, directed to a portable computer, were rejected as anticipated under [35 U.S.C. 102](#) by a reference that disclosed a calculator, because the term “computer” was given the broadest reasonable interpretation consistent with the specification to include a calculator, and a calculator was considered to be a particular type of computer by those of ordinary skill in the art. *Id.*

When determining whether a computer-implemented functional claim would have been obvious, examiners should note that broadly claiming an

automated means to replace a manual function to accomplish the same result does not distinguish over the prior art. See *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (“Accommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children’s learning devices. Applying modern electronics to older mechanical devices has been commonplace in recent years.”); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958); see also [MPEP § 2144.04](#). Furthermore, implementing a known function on a computer has been deemed obvious to one of ordinary skill in the art if the automation of the known function on a general purpose computer is nothing more than the predictable use of prior art elements according to their established functions. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 82 USPQ2d 1385, 1396 (2007); see also [MPEP § 2143](#), Exemplary Rationales D and F. Likewise, it has been found to be obvious to adapt an existing process to incorporate Internet and Web browser technologies for communicating and displaying information because these technologies had become commonplace for those functions. *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1326-27, 87 USPQ2d 1350, 1357 (Fed. Cir. 2008).

For more information on the obviousness determination, see [MPEP § 2141](#).

## **2115 Material or Article Worked Upon by Apparatus [R-07.2015]**

### **MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS**

Claim analysis is highly fact-dependent. A claim is only limited by positively recited elements. Thus, “[i]nclusion of the material or article worked upon by a structure being claimed does not impart patentability to the claims.” *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963); see also *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935).

In *Otto*, the claims were directed to a core member for hair curlers (i.e., a particular device) and a method of making the core member (i.e., a particular



method of making that device) and “not to a method of curling hair wherein th[e] particular device is used.” 312 F.2d at 940. The court held that patentability of the claims cannot be based “upon a certain procedure for curling hair using th[e] device and involving a number of steps in the process.” The court noted that “the process is irrelevant as is the recitation involving the hair being wound around the core” in terms of determining patentability of the particular device. *Id.* Therefore, the inclusion of the material or article worked upon by a structure being claimed does not impart patentability to the claims.

In *Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited “[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface.” An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that “the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle.” *Id.* at 580-81. The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and “the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.” *Id.* at 580.

Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use.

## 2116 Novel, Nonobvious Starting Material or End Product [R-07.2022]

### 2116.01 Novel, Nonobvious Starting Material or End Product [R-10.2019]

All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. See [MPEP § 2143.03](#).

*In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In both cases, the Federal Circuit held that the use of *per se* rules is improper in applying the test for obviousness under [35 U.S.C. 103](#). Rather, [35 U.S.C. 103](#) requires a highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art. “A process yielding a novel and nonobvious product may nonetheless be obvious; conversely, a process yielding a well-known product may yet be nonobvious.” *TorPharm, Inc. v. Ranbaxy Pharmaceuticals, Inc.*, 336 F.3d 1322, 1327, 67 USPQ2d 1511, 1514 (Fed. Cir. 2003).

Interpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. The decision in *Ochiai* specifically dispelled any distinction between processes of making a product and methods of using a product with regard to the effect of any product limitations in either type of claim.

As noted in *Brouwer*, 77 F.3d at 425, 37 USPQ2d at 1666, the inquiry as to whether a claimed invention would have been obvious is “highly fact-specific by design.” Accordingly, obviousness must be assessed on a case-by-case basis. The following decisions are illustrative of the lack of *per se* rules in applying the test for obviousness

under [35 U.S.C. 103](#) and of the fact-intensive comparison of claimed processes with the prior art: *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985) (The examiner rejected a claim directed to a process in which patentable starting materials were reacted to form patentable end products. The prior art showed the same chemical reaction mechanism applied to other chemicals. The court held that the process claim was obvious over the prior art.); *In re Albertson*, 332 F.2d 379, 141 USPQ 730 (CCPA 1964) (Process of chemically reducing one novel, nonobvious material to obtain another novel, nonobvious material was claimed. The process was held obvious because the reduction reaction was old.); *In re Kanter*, 399 F.2d 249, 158 USPQ 331 (CCPA 1968) (Process of siliconizing a patentable base material to obtain a patentable product was claimed. Rejection based on prior art teaching the siliconizing process as applied to a different base material was upheld.); Cf. *In re Pleuddemann*, 910 F.2d 823, 15 USPQ2d 1738 (Fed. Cir. 1990) (Methods of bonding polymer and filler using a novel silane coupling agent held patentable even though methods of bonding using other silane coupling agents were well known because the process could not be conducted without the new agent); *In re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973) (Process of cracking hydrocarbons using novel zeolite catalyst found to be patentable even though catalytic cracking process was old. “The test under 103 is whether in view of the prior art the invention as a whole would have been obvious at the time it was made, and the prior art here does not include the zeolite, ZK-22. The obviousness of the process of cracking hydrocarbons with ZK-22 as a catalyst must be determined without reference to knowledge of ZK-22 and its properties.” 475 F.2d at 664-665, 177 USPQ at 255); and *In re Mancy*, 499 F.2d 1289, 182 USPQ 303 (CCPA 1974) (Claim to a process for the production of a known antibiotic by cultivating a novel, nonobvious microorganism was found to be patentable.).

## 2117 Markush Claims [R-01.2024]

### I. MARKUSH CLAIM

A “Markush” claim recites a list of alternatively useable members. *In re Harnisch*, 631 F.2d 716, 719-20, 206 USPQ 300, 302-304 (CCPA 1980); *Ex*

*parte Markush*, 1925 Dec. Comm'r Pat. 126, 127 (1924). The listing of specified alternatives within a Markush claim is referred to as a Markush group or Markush grouping. *Abbott Labs v. Baxter Pharmaceutical Products, Inc.*, 334 F.3d 1274, 1280-81, 67 USPQ2d 1191, 1196-97 (Fed. Cir. 2003) (citing to several sources that describe Markush groups). Claim language defined by a Markush grouping requires selection from a closed group “consisting of” the alternative members. *Id.* at 1280, 67 USPQ2d at 1196. See also *Amgen Inc. v. Amneal Pharmaceuticals LLC*, 945 F.3d 1368, 1376-78, 2020 USPQ2d 3197 (Fed. Cir. 2020) (stating that there is a strong presumption that a claim element set off with “consisting of” is closed to unrecited elements.). See [MPEP § 2111.03](#), subsection II, for a discussion of the term “consisting of” in the context of Markush groupings.

Treatment of claims reciting alternatives is not governed by the particular format used (e.g., alternatives may be set forth as “a material selected from the group consisting of A, B, and C” or “wherein the material is A, B, or C”). See, e.g., the *Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications* (“*Supplementary Guidelines*”), 76 Fed. Reg. 7162 (February 9, 2011). Claims that set forth a list of alternatives from which a selection is to be made are typically referred to as Markush claims, after the appellant in *Ex parte Markush*, 1925 Dec. Comm'r Pat. 126, 127 (1924). Although the term “Markush claim” is used throughout the MPEP, any claim that recites alternatively usable members, regardless of format, should be treated as a Markush claim. Inventions in metallurgy, refractories, ceramics, chemistry, pharmacology and biology are most frequently claimed under the Markush formula, but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See, e.g., *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1297-98, 92 USPQ2d 1163, 1170-1172 (Fed. Cir. 2009) (claim to a hemodialysis apparatus required “at least one unit selected from the group consisting of (i) a dialysate-preparation unit, (ii) a dialysate-circulation unit, (iii) an ultrafiltrate-removal unit, and (iv) a dialysate-monitoring unit” and a user/machine interface operably connected thereto); *In re*

*Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980)(defining alternative moieties of a chemical compound with Markush groupings).

A Markush grouping is proper if the members of a group share a single structural similarity and a common use. See subsections II - IV, below, for guidelines regarding the determination of whether a Markush grouping is improper.

See [MPEP § 2111.03](#) and [MPEP § 2173.05\(h\)](#) for discussions of when a Markush grouping may be indefinite under [35 U.S.C. 112\(b\)](#) (e.g., if the list of alternatives is not a closed grouping, or if a Markush group is so expansive that persons skilled in the art cannot determine the metes and bounds of the claimed invention).

See [MPEP § 803.02](#) for information pertaining to the election, search, and examination of claims that include at least one Markush grouping.

## II. IMPROPER MARKUSH GROUPING

A Markush claim may be rejected under judicially approved “improper Markush grouping” principles when the claim contains an improper grouping of alternatively useable members. A Markush claim contains an “improper Markush grouping” if either: (1) the members of the Markush group do not share a “single structural similarity” or (2) the members do not share a common use. *Supplementary Guidelines* at 7166 (citing *In re Harnisch*, 631 F.2d 716, 721-22, 206 USPQ 300, 305 (CCPA 1980)).

Where a Markush grouping describes part of a combination or process, the members following “selected from the group consisting of” (or a similar introductory phrase) must be substitutable, one for the other, with the expectation that the same intended result would be achieved. *Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 831 F.3d 1350, 1357, 119 USPQ2d 1773, 1779 (Fed. Cir. 2016)(“It is generally understood that ... the members of the Markush group ... are alternatively usable for the purposes of the invention ...”)(citations omitted). Where a Markush grouping describes part of a chemical compound, regardless of whether the claim is limited to a compound per se or the compound is recited as part of a

combination or process, the members following “selected from the group consisting of” (or similar introductory phrase) need not share a community of properties themselves; the propriety of the grouping is determined by a consideration of the compound as a whole. See *Harnisch*, 631 F.2d at 722, 206 USPQ at 305 (“in determining the propriety of a Markush grouping the compounds must be considered as wholes and not broken down into elements or other components”). See also *In re Jones*, 162 F.2d 479, 481, 74 USPQ 149, 151 (CCPA 1947) (“In determining the propriety of a Markush grouping, moreover, the compounds which are grouped must each be considered as a whole and should not be broken down into elements or other components”).

The alternatives defined by the Markush group are either alternative chemical compounds as a whole (e.g., if a claim includes a compound R-OH wherein R is selected from the group consisting of methyl, propyl, and butyl, then the alternatives are methanol, propanol, or butanol) or in the context of a combination or process, the alternatives from which a selection is to be made (e.g., the alternatives in a list following the phrase “selected from the group consisting of”). The alternatives (1) share a “single structural similarity” when they belong to the same recognized physical or chemical class or to the same art-recognized class, and (2) share a common function or use when they are disclosed in the specification or known in the art to be functionally equivalent in the context of the claimed invention. See *Supplementary Guidelines* at 7166 and subsection II.A, below.

Where a Markush grouping describes alternative chemical compounds, whether by words or chemical formulas, and the compounds do not appear to be members of a recognized physical or chemical class or members of an art-recognized class, the members are considered to share a “single structural similarity” and common use when the alternatively usable compounds share a substantial structural feature that is essential to a common use. *Ex parte Hozumi*, 3 USPQ2d 1059, 1060 (Bd. Pat. App. & Int. 1984). See also subsection II.B, below.

### A. “Single Structural Similarity” - Members of a Physical, Chemical, or Art-Recognized Class

Members of a Markush group share a “single structural similarity” when they belong to the same recognized physical or chemical class or to the same art-recognized class. A recognized physical class, a recognized chemical class, or an art-recognized class is a class wherein there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved. For example, in the context of a claim covering a disposable diaper, a limitation “the fastener selected from the group consisting of a pressure sensitive adhesive and complementary release material, a complementary hook and loop structure, a snap, and a buckle” would likely be considered an art recognized class because a review of the prior art would establish that it was well known that each member could be substituted for each other with the expectation that the intended result (repositionable and refastenable) would occur.

Note that where a Markush group includes only materials from a recognized scientific class of equivalent materials or from an art-recognized class, “the mere existence of such a group in an application tend[s] to prove the equivalence of its members and when one of them [is] anticipated the group [is] therefore rendered unpatentable, in the absence of some convincing evidence of some degree of non-equivalency of one or more of the remaining members.” *In re Ruff*, 256 F.2d 590, 598-99, 118 USPQ 340, 348 (CCPA 1958) (“[A]ctual equivalence is not enough to justify refusal of a patent on one member of a group when another member is in the prior art. The equivalence must be disclosed in the prior art or be obvious within the terms of Section 103.” *Id.* at 599, 118 USPQ at 348).

Thus, a Markush grouping is ordinarily proper if all the members of the group belong to a recognized class (whether physical, chemical, or art recognized) and are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed invention, and it is clear from their very nature or

from the prior art that all members possess this property. See also [MPEP § 803.02](#).

### B. Common Use Flows From Substantial Structural Feature

Where a Markush grouping describes alternative chemical compounds, whether by words or chemical formulas, and the alternatives do not belong to a recognized class as explained in subsection II.A, above, the members of the Markush grouping may still be considered to be proper where the alternatives share a substantial structural feature that is essential to a common use.

For example, in *Harnisch*, the claims were directed to a Markush group of coumarin derivatives disclosed to be useful as dyes. The claimed coumarin derivatives were not members of a recognized chemical class, encompassing “polyfused N-heterocyclics, cyclic, acyclic and aromatic amines, aryloxyalkylamines, amides, sulfonamides, [and] phthalimides” among others. *Harnisch*, 631 F.2d at 718, 206 USPQ at 302. Furthermore, they were not members of an art-recognized class (“[n]owhere in the record has it been established or even alleged that the variety of compounds included within the explicit scope of the claims are recognized by the art as being functionally equivalent” (*Id.*)). However, the court found that the Markush grouping was proper because the claimed compounds, viewed as a whole, all share a coumarin group and the property of being a dye. See also *In re Jones*, 162 F.2d 479, 481, 74 USPQ 149, 151 (1947).

See also *Ex parte Hozumi*, 3 USPQ2d 1059, 1060 (Bd. Pat. App. & Int. 1984)). See subsection IV, below, for a discussion of the *Harnisch* and *Hozumi* decisions.

## III. REJECTION BASED ON IMPROPER MARKUSH GROUPING

When an examiner determines that the species of a Markush group do not share a single structural similarity or do not share a common use, then a rejection on the basis that the claim contains an “improper Markush grouping” is appropriate (see subsection II). Note that this is a rejection on the merits and may be appealed to the Patent Trial and



Appeal Board in accordance with [35 U.S.C. 134](#) and [37 CFR 41.31\(a\)\(1\)](#). Use Form Paragraph 8.40 to reject a claim on the basis that it includes an improper Markush grouping.

#### ¶ 8.40 Improper Markush Grouping Rejection

Claim [1] rejected on the basis that it contains an improper Markush grouping of alternatives. See *In re Harnisch*, 631 F.2d 716, 721-22 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d 1059, 1060 (Bd. Pat. App. & Int. 1984). A Markush grouping is proper if the alternatives defined by the Markush group (i.e., alternatives from which a selection is to be made in the context of a combination or process, or alternative chemical compounds as a whole) share a “single structural similarity” and a common use. A Markush grouping meets these requirements in two situations. First, a Markush grouping is proper if the alternatives are all members of the same recognized physical or chemical class or the same art-recognized class, and are disclosed in the specification or known in the art to be functionally equivalent and have a common use. Second, where a Markush grouping describes alternative chemical compounds, whether by words or chemical formulas, and the alternatives do not belong to a recognized class as set forth above, the members of the Markush grouping may be considered to share a “single structural similarity” and common use where the alternatives share both a substantial structural feature and a common use that flows from the substantial structural feature. See [MPEP § 2117](#).

The Markush grouping of [2] is improper because the alternatives defined by the Markush grouping do not share both a single structural similarity and a common use for the following reasons: [3].

To overcome this rejection, Applicant may set forth each alternative (or grouping of patentably indistinct alternatives) within an improper Markush grouping in a series of independent or dependent claims and/or present convincing arguments that the group members recited in the alternative within a single claim in fact share a single structural similarity as well as a common use.

#### Examiner Note:

1. In bracket 1, insert claim number(s) and “is” or “are” as appropriate.
2. In bracket 2, insert a description of the Markush group(s) that are improper.
3. In bracket 3, explain why these alternatives do not meet the requirements for a proper Markush grouping, i.e., why the alternatives are not all members of the same recognized physical or chemical class or the same art-recognized class; and/or why the members are not considered to be functionally equivalent and have a common use; and/or why (if the Markush grouping describes alternative chemical compounds), the alternatives do not share both a substantial structural feature and a common use that flows from the substantial structural feature. See [MPEP § 2117](#).

4. If an election of species requirement is appropriate, this form paragraph should only be used after applicant has made an election.

In accordance with the principles of compact prosecution, a rejection based on an improper Markush grouping should be made in the first action on the merits after presentation of the claim with the improper Markush grouping (e.g., first Office action on the merits or next Office action following presentation of the claim). In addition, if the examiner determines that one or more claims include an improper Markush grouping, the examiner should also require the applicant to elect an alternative or group of indistinct alternatives for search and examination (i.e., an election of species), if such an election requirement was not previously made. See [MPEP § 803.02](#) for more information on election of species requirements in Markush claims. Note that if a written provisional election of species requirement must be made separate from the first Office action on the merits, it should not include a rejection on the basis of an improper Markush grouping. Any appropriate improper Markush grouping rejection should be made in an Office action on the merits.

The examiner should include suggestions for the applicant as to how to overcome the rejection, e.g., by suggesting a proper Markush grouping based on the specification as filed and/or by suggesting that applicant set forth each alternative (or grouping of patentably indistinct alternatives) within an improper Markush grouping in a series of independent or dependent claims. There may be more than one way to formulate a proper Markush grouping. The examiner should not suggest any grouping that clearly would not meet the requirements of [35 U.S.C. 112\(a\)](#). For example, the examiner should not suggest a grouping that meets the requirements for a proper Markush grouping, but would clearly lack adequate written description if presented in a separate claim.

In addition to a rejection based on an improper Markush grouping, the claim should also be rejected under [35 U.S.C. 112\(b\)](#) if one skilled in the art cannot determine the metes and bounds of the Markush claim due to an inability to envision all of the members of the Markush grouping. In other words, if a boundary cannot be drawn separating



embodiments encompassed by the claim from those that are not, the claim is indefinite and should be rejected under [35 U.S.C. 112\(b\)](#). See also [MPEP § 2173.05\(h\)](#).

The claim should be examined for patentability with respect to all other conditions of patentability (e.g., [35 U.S.C. 101](#), [102](#), [103](#), [112](#), and nonstatutory double patenting). As explained with regard to election of species practice as set forth in detail in [MPEP § 803.02](#), the search need not be extended to species that fall outside a proper Markush grouping.

The improper Markush grouping rejection of the claim should be maintained until (1) the claim is amended such that the Markush grouping includes only members that share a single structural similarity and a common use; or (2) the applicant presents convincing arguments why the members of the Markush grouping share a single structural similarity and common use (i.e., are members of a physical, chemical, or art-recognized class that share a common use, or are chemical compounds that share a substantial structural feature that is essential to the common use). In addition, even if the applicant does not take action sufficient to overcome the improper Markush grouping rejection, when all of the claims are otherwise in condition for allowance the examiner should reconsider the propriety of the improper Markush grouping rejection. If the examiner determines that in light of the prior art and the record as a whole the alternatives of the Markush grouping share a single structural similarity and a common use, then the rejection should be withdrawn. Note that no Markush claim can be allowed until any improper Markush grouping rejection has been overcome or withdrawn, and all other conditions of patentability have been satisfied.

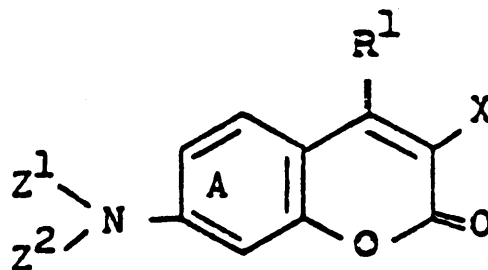
#### IV. MARKUSH GROUPING EXAMPLES

The propriety of Markush groupings must be decided on a case-by-case basis. The following examples illustrate Markush groupings that have been found to be proper and improper. Office personnel should note that the cases from which these examples are drawn have been selected for their treatment of Markush groupings. The cases may not necessarily reflect current practice as to other issues discussed therein.

#### A. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980)

##### Representative Claim:

1. Coumarin compounds which in one of their mesomeric limiting structures correspond to the general formula



wherein

X represents aldehyde, azomethine, or hydrazone,

R<sup>1</sup> represents hydrogen or alkyl,

Z<sup>1</sup> represents hydrogen, alkyl, cycloalkyl, aralkyl, aryl or a 2- or 3-membered alkylene radical connected to the 6-position of the coumarin ring and

Z<sup>2</sup> represents hydrogen, alkyl, cycloalkyl, aralkyl or a 2- or 3-membered alkylene radical connected to the 8-position of the coumarin ring

and wherein

Z<sup>1</sup> and Z<sup>2</sup> conjointly with the N atom by which they are bonded can represent the remaining members of an optionally benz-fused heterocyclic ring which, like the ring A and the alkyl, aralkyl, cycloalkyl and aryl radicals mentioned, can carry further radicals customary in dye-stuff chemistry.

*Background:* The Board had entered a rejection – later reversed by the CCPA – of claim 1 under [37 CFR 1.196\(b\)](#) on the ground that it was drawn to an improper Markush group. The Board had focused on the wide variety of functional groups that could be present in the claimed compounds, and had stressed the different physical and chemical properties of the compounds in view of the functional groups. The Board had observed that

“[n]owhere in the record has it been established or even alleged that the variety of compounds included within the explicit scope of the claims are recognized by the art as being functionally equivalent.” In the Board’s view, “the mere fact” that all of the compounds encompassed by claim 1 shared “a single structural similarity (i.e., the coumarin group),” and as a result were useful either as dyes or intermediates for the preparation of dyes, was insufficient to render the Markush grouping proper because the compounds could “be subject to different modes of application and use.”

*Analysis/Conclusion:* The CCPA reversed the Board’s decision and held that the Markush grouping was proper. The court pointed out that all of the claimed compounds are dyes, even if some might also be seen as synthetic intermediates. The court noted the Board’s admission, despite the significant variation in functional groups, that all of the compounds shared “a single structural similarity” which is the coumarin core. The court held that “the claimed compounds all belong to a subgenus, as defined by appellant [in the specification], which is not repugnant to scientific classification.” Stating that “[u]nder these circumstances we consider the claimed compounds to be part of a single invention,” the court concluded that the Markush grouping of claim 1 was proper. The CCPA also stressed that they decide cases involving the propriety of Markush groupings “on their facts on a case-by-case basis.”

The *Harnisch* court also cited its earlier decision in *In re Jones*, 162 F.2d 479, 74 USPQ 149 (CCPA 1947) with approval as to the proper approach to evaluating claims containing Markush groups. According to the *Harnisch* court, “in determining the propriety of a Markush grouping the compounds must be considered as wholes and not broken down into elements or other components.” In other words, when considering whether the members of a Markush group have sufficient structural similarity and common use to meet prongs 1 and 2 above, the proper focus should be on the commonality across all of the alternative embodiments of the invention within the scope of the claim. Note that in the *Harnisch* decision, the court looked to the common structure of the coumarin core and its associated common function as a dye, even though the coumarin core was not part of the variable Markush groups of

substituents. A Markush grouping is not improper simply because the members of a list of alternative elements or substituents of the invention, as distinguished from a list of complete embodiments of the invention, lack “a single structural similarity” or a common use. When assessing whether a Markush grouping defining a chemical compound is proper, each claimed chemical compound as a whole must be compared and analyzed to determine whether the claimed compounds share both a substantial single structural similarity and a common use.

**B. *Ex parte Dams*, Appeal No. 1997-2193, 07/986,648, decision mailed 9-13-2000 (unpublished); USP 6,201,122**

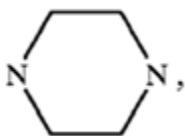
*Representative Claims:*

1. A fluoroaliphatic radical-containing anionic sulfonamido compound which comprises a fluoroaliphatic radical-containing sulfonamido group and an ethylenecarbonyl group whose beta ethylene carbon atom is bonded to a sulfur or nitrogen atom which is bonded to a linking group bonded to the nitrogen atom of said sulfonamido group, and the carbonyl carbon atom of said carbonyl is bonded to an anionic hydrophilic polar group comprising at least one carbon, nitrogen, oxygen, or sulfur atom.
2. The fluoroaliphatic radical-containing sulfonamido compound of claim 1 wherein said compound has the formula



where  $R_f$  is a fluoroaliphatic radical; A is S or  $NR'''$ ; W is siloxylene, silylene, alkylene, arylene, or combinations thereof; R, R', R'', and R''' are independently hydrogen, lower alkyl, aryl, or combinations thereof, and can contain functional groups, or R and R''' together with the nitrogen atoms to which they are bonded and W, form a ring; and Y is an anionic hydrophilic polar group comprising at least one carbon, nitrogen, oxygen, or sulfur atom.

6. The fluoroaliphatic radical-containing sulfonamido compound of claim 2 wherein said  $N(R)WA$  is selected from the group consisting of  $N(R)CH_2CH_2NH$ ,



$N(R)CH_2CH_2CH_2Si(CH_3)_2OSi(CH_3)_2CH_2CH_2CH_2NH$ ,  
 $N(R)CH(CH_3)CH_2(CH_2CH_2O)_q(CH(CH_3)CH_2O)_zCH_2CH(CH_3)NH$   
 where  $q$  and  $z$  are from 1 to 20, and  $N(R)CH_2CH_2S$ , where  $R$   
 is  $H$ ,  $CH_3$  or  $CH_2CH_3$ .

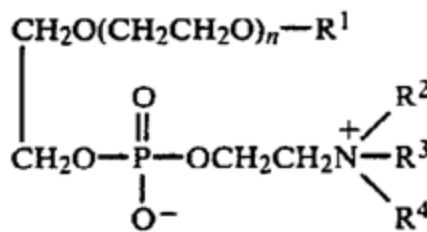
**Background:** The examiner had rejected the claims on a number of grounds, including the ground of improper Markush groupings. It had been the examiner's position that the Markush groups of the claims lacked a common structural feature. The examiner had also stated that in his view, the members of the Markush group were separately classifiable and separately patentable. This rejection was later reversed by the Board.

**Analysis/Conclusion:** The Board stated that the examiner erred by failing to treat the compounds of the claims as a whole. The examiner had improperly "focused on the individual moiety defined by the Markush terminology." Referring to claim 6 and relying on *In re Harnisch*, the Board explained that even though Markush terminology was used to define the substituent  $N(R)WA$ , the proper inquiry was "whether the compounds defined by the different moieties" have the necessary common structure and common use. The Board held that the compounds shared "a common structural feature disclosed as essential to the disclosed utility of being an anionic surfactant." Thus the compounds satisfied prongs 1 and 2 above, and the Markush grouping was proper.

**C. Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Interf. 1984) Appeal No. 559-94, Application No. 06/257,771, decision mailed 06-26-1984 (USP 4,551,532)**

**Representative Claim:**

Claim 1. A compound of the formula:

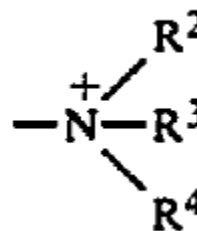


wherein

$n$  is an integer of 1 to 15;

$R^1$  is  $C_{6-26}$  alkyl,  $C_{6-26}$  alkenyl or  $C_{6-26}$  alkynyl, each of said groups being unsubstituted or substituted by hydroxyl, mercapto, amino, oxo, carbamoyl, carboxyl, halogen,  $C_{3-7}$  cycloalkyl or phenyl; and

$R^2$ ,  $R^3$  and  $R^4$  are independently hydrogen or  $C_{1-5}$  alkyl, or



represents cyclic ammonio selected from the group consisting of pyridinio, oxazolio, thiazolio, pyridazinio, quinolinio, isoquinolinio,  $N-C_{1-4}$  alkylmorpholinio and  $N-C_{1-4}$  alkylpiperazinio, each of said groups being unsubstituted or substituted by  $C_{1-4}$  alkyl, hydroxyl, hydroxyethyl, aminoethyl, amino, carbamoyl or ureido,

or a pharmaceutically acceptable salt thereof.

**Background:** The examiner had rejected claim 1 on the ground that it included an improper Markush grouping.

**Analysis/Conclusion:** The Board reversed the examiner's improper Markush grouping rejection of

claim 1, once again relying on the *Harnisch* decision. The Board summarized *Harnisch* by stating that the Markush grouping of coumarin compounds in that case was proper because there was “in common a functional utility related to a substantial structural feature disclosed as being essential to that utility.” In this case, as in others already discussed, the Board emphasized the case-by-case nature of the inquiry.

Applying the *Harnisch* criteria to the facts of this case, the Board pointed out that structurally “the compounds claimed are phosphoric acid diesters in which one esterifying moiety is derived from a poly(ethylene glycol) monoether and the other is derived from a beta-aminoethanol.” The Board acknowledged that as a result of the variable number of repeating oxyethylene units indicated by the “n” index, the molecular weight could “vary over a fairly broad range,” and that further structural variation was seen in the etherifying groups and the substituents on the nitrogen atom. Despite the breadth of the claim, the Board focused on “the relatively large proportion of the structure of the compounds in the claimed class which is common to the entire class,” and determined that the prong 1 requirement for structural similarity was met. As for the prong 2 common use requirement, the Board stated that all of the compounds shared antimycotic activity. Thus the Board found that in this case, as was also the case in *Harnisch*, there was “a substantial structural feature of the class of compounds claimed disclosed as being essential to at least one disclosed utility.” Thus the Markush grouping was proper and the examiner’s rejection was reversed.

#### ***D. Based On PCT International Search and Preliminary Examination Guidelines Example 33***

Claim 1: A herbicidal composition consisting essentially of an effective amount of the mixture of (a) 2,4-D (2,4-dichloro-phenoxy acetic acid) and (b) a second herbicide selected from the group consisting of copper sulfate, sodium chlorate, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamid (an amide), ioxynil (nitrile), dinoseb (phenol), trifluralin (dinitroaniline), EPTC (thiocarbamate),

and simazine (triazine) along with an inert carrier or diluent.

*Background/Prior Art:* A review of the art demonstrates that the alternatives are not all members of the same recognized physical or chemical recognized class of compounds. The prior art explains that mixing herbicides can be risky and can result in physical or chemical incompatibilities, e.g., increasing or decreasing the effectiveness of each or all of the herbicides, increasing toxicity, or reacting to form a precipitate. The prior art also shows that the many of the herbicides set forth in component (b) are effective against one type of weed (e.g., algae, woody weeds, or grasses), but are not effective against other types of weeds. In addition, many of the herbicides listed in the Markush group are tolerated by one type of crop (e.g., legumes, tomato, or corn) or in one type of environment (e.g., ponds, golf courses, or orchards), but are not tolerated by other crops or in other environments.

*Analysis:* All members of the Markush grouping have a common disclosed use as herbicides. However, the alternatives set forth in the Markush grouping are not all members of the same physical or chemical recognized class of compounds. Furthermore, the members of the Markush group defining component (b) are not in an art recognized class because a person of ordinary skill in the art would not expect that members of the class will behave in the same way in the context of the claimed invention. Specifically, a person of ordinary skill in the art would not expect that any one herbicide of component (b) could be substituted with any other member of the Markush group with the expectation that the same intended result would be achieved because of the unpredictability of results when mixing herbicides, the different weeds that are controlled by one member of the Markush group as compared to another, the different crops that do (or do not) tolerate the alternatives within the Markush group, and the different environments in which the each second herbicide is suitable for use.

Although the members of the Markush grouping are not members of a recognized class (physical, chemical, or art-recognized) for the reasons set forth above, the Markush grouping describes alternative chemical compounds. Therefore, the members of

the Markush grouping may be considered to share a “single structural similarity” and common use if the alternatives share both a substantial structural feature and a common use that flows from the substantial structural feature.

In this case, the members of the Markush grouping do not share a substantial structural feature. Rather, the members of the Markush group defining component (b) represent a plurality of chemical classes with varying structures which may be identified as follows:

(a) inorganic salts: copper sulfate, sodium chlorate, ammonium sulfamate (no ring structure)

(b) organic salts and carboxylic acids: sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid (only the third chemical has a ring structure, which is a benzoic acid)

(c) amides: diphenamid (ring structure is diphenyl)

(d) nitriles: ioxynil (ring structure is dinitrophenol)

(e) phenols: dinoseb

(f) amines: trifluralin, (ring structure is dinitroaniline), and

(g) heterocyclic: simazine (ring structure is triazine).

*Conclusion:* The claim sets forth an improper Markush grouping because the alternatives are not all members of the same recognized physical or chemical class or the same art-recognized class, nor do the alternative chemical compounds share both a substantial structural feature and a common use that flows from the substantial structural feature.

## 2118-2119 [Reserved]

## 2120 Rejection on Prior Art [R-01.2024]

### 35 U.S.C. 102 Conditions for patentability; novelty.

*[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See pre-AIA 35 U.S.C. 102 for the law applicable to applications and patents not subject to the first inventor to file provisions of the AIA.]*

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under [section 151](#), or in an application for patent published or deemed published under [section 122\(b\)](#), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

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

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

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.



(d) **PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.**—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under [section 119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#), or to claim the benefit of an earlier filing date under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

**35 U.S.C. 102 (pre-AIA) Conditions for patentability; novelty and loss of right to patent.**

*[Editor Note: With the exception of subsection (g) in limited circumstances, not applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). For an application or patent subject to the first inventor to file provisions of the AIA, see [35 U.S.C. 102](#).]*

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under [section 135](#) or [section 291](#), another inventor involved therein establishes, to the extent permitted in [section 104](#), that before such person's invention thereof the invention was made by such

other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.**

*[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). See [pre-AIA 35 U.S.C. 102](#) for the law applicable to applications and patents not subject to the first inventor to file provisions of the AIA.]*

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in [section 102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**35 U.S.C. 103 (pre-AIA) Conditions for patentability; non-obvious subject matter.**

*[Editor Note: Not applicable to any patent application subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#)). For an application or patent subject to the first inventor to file provisions of the AIA, see [35 U.S.C. 103](#).]*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in [section 102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b)

(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under [section 102](#) and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding [section 154](#).

(3) For purposes of paragraph (1), the term “biotechnological process” means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

- (i) express an exogenous nucleotide sequence,
- (ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or
- (iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [section 102](#), shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

## I. CHOICE OF PRIOR ART; BEST AVAILABLE

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a [35 U.S.C. 102](#) or [103](#) rejection depends on a particular interpretation of a claim;

(B) a claim is met by a prior art disclosure which does not disclose the inventive concept involved;

(C) for cases examined under the first inventor to file provisions of the AIA, the most pertinent disclosure could be shown not to be prior art by invoking an exception in a [37 CFR 1.130](#) affidavit or declaration of attribution or prior public disclosure;

(D) for cases examined under pre-AIA law, an obviousness rejection is based on prior art that qualifies only under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) so that the rejection could be overcome by establishing that the prior art is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#); or

(E) for cases examined under pre-AIA law, the most pertinent disclosure could be antedated by a [37 CFR 1.131](#) affidavit or declaration of prior invention.

In the interest of compact prosecution, such rejections should be backed up by the best other art rejections available. Keep in mind the best backup rejection(s) could be based on alternate embodiments from the same “best available” reference(s). For example, if an anticipation rejection could be overcome by invoking an exception in a [37 CFR 1.130\(b\)](#) declaration, it would be appropriate to make an additional obviousness rejection over another disclosure in the same reference. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

See also [MPEP § 707.05](#).

## II. RELIANCE UPON ABSTRACTS AND FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When both the abstract and the underlying document qualify as prior art, the underlying document should

normally be used to support a rejection. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under [35 U.S.C. 103](#), when the abstract alone appears to support the rejection. An abstract can have a different publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action.

Examiners may rely on a machine translation of a foreign language document unless the machine translation is not of sufficient quality to be adequate evidence of the contents of the document. See *In re Orbital Technologies Corporation*, 603 Fed. App'x 924, 932 (Fed. Cir. 2015). A request by the applicant

for the examiner to obtain a human language translation should be granted if the applicant provides evidence (e.g., a translation inconsistent with the machine translation) showing the machine translation does not accurately represent the document's contents.

An Office action supplying a full text document and/or translation may be made final if the conditions described in [MPEP § 706.07\(a\)](#) or for a first Office action or RCE, in [MPEP § 706.07\(b\)](#), have been met.

Some translation resources available to examiners are discussed in [MPEP § 901.05\(d\)](#).

### III. DISTINCTION BETWEEN 35 U.S.C. 102 AND 103

The distinction between rejections based on [35 U.S.C. 102](#) and those based on [35 U.S.C. 103](#) should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under [35 U.S.C. 102](#), the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on [35 U.S.C. 103](#), the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention for applications or patents subject to the first inventor to file provisions of the AIA or at the time the invention was made for applications or patents subject to pre-AIA law. See [MPEP §§ 2131 - 2146](#) and [2150 - 2159.04](#) for guidance on patentability determinations under [35 U.S.C. 102](#) and [103](#).

#### **2120.01 Rejections Under 35 U.S.C. 102(a)(1) and (a)(2) and Pre-AIA 35 U.S.C. 102(a), (b), or (e): Printed Publication or Patent [R-01.2024]**

Once the examiner conducts a search and finds a printed publication or patent which discloses the claimed invention, the examiner should determine whether the rejection should be made under [35 U.S.C. 102\(a\)\(1\) or \(a\)\(2\)](#) or, if the application is

subject to the former prior art regime, [pre-AIA 35 U.S.C. 102\(a\), \(b\), or \(e\)](#). See [MPEP § 2159](#) for guidance. Form paragraph 7.03.aia or 7.03.fti should be used in an Office action to indicate whether the application is being examined under the first inventor to file provisions of the AIA or the pre-AIA prior art provisions, respectively.

**¶ 7.03.aia Application Examined Under AIA First Inventor to File Provisions**

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

**Examiner Note:**

This form paragraph should be used in any application subject to the first inventor to file provisions of the AIA.

**¶ 7.03.fti Application Examined Under First to Invent provisions**

The present application, filed on or after March 16, 2013, is being examined under the pre-AIA first to invent provisions.

**Examiner Note:**

This form paragraph should be used in any application filed on or after March 16, 2013 that is subject to the pre-AIA prior art provisions.

In order to determine which paragraph of [35 U.S.C. 102](#) applies, the effective filing date of each claimed invention must be determined and compared with the date of the reference. See [MPEP § 2139.01](#) regarding determination of effective filing date of the claimed invention under pre-AIA law and [MPEP § 2152.01](#) regarding determination of effective filing date of the claimed invention under AIA law.

The examiner must also determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made. See [MPEP §§ 2124, 2126, 2128 - 2128.02](#), and [2152.02 - 2154.02\(c\)](#) for case law relevant to reference date determination.

See [MPEP § 2152.05](#) for determining whether to apply [35 U.S.C. 102\(a\)\(1\) or \(a\)\(2\)](#). See [MPEP § 2139.02](#) for determining whether to apply [pre-AIA 35 U.S.C. 102\(a\), \(b\), or \(e\)](#).

In all applications, an applicant may overcome a [35 U.S.C. 102](#) rejection by persuasively arguing that the claims are patentably distinguishable from the prior art, or by amending the claims to patentably

distinguish over the prior art. Additional ways available to overcome a rejection based on [35 U.S.C. 102](#) prior art depend on whether or not any claim in the application being examined is subject to the first inventor to file provisions of the AIA.

See [MPEP § 2152.06](#) for overcoming a rejection under [35 U.S.C. 102\(a\)\(1\) or \(a\)\(2\)](#). See [MPEP §§ 2132.01, 2133.02\(a\), and 2136.05](#) *et seq.* for overcoming prior art rejections under [pre-AIA 35 U.S.C. 102\(a\), \(b\), and \(e\)](#), respectively.

**2120.02 Rejections Under 35 U.S.C. 102(a)(1) or Pre-AIA 35 U.S.C. 102(a) or (b): Knowledge by Others, or Public Use, or On Sale [R-07.2022]**

An applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was sold by applicant or known by others. See [MPEP §§ 2152.02\(c\)-2152.02\(e\)](#) for a discussion of when public use of a claimed invention, placing a claimed invention on sale, or otherwise making a claimed invention available to the public might preclude patentability under [35 U.S.C. 102\(a\)\(1\)](#). See [MPEP §§ 2132](#) and [2133.03](#) *et seq.* for a discussion of when public knowledge, public use, or sale of a claimed invention might preclude patentability under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#). If the activity is by an entity other than the inventor or assignee, such as sale by another, manufacture by another or disclosure of the invention by applicant or the inventor to another then both [pre-AIA 35 U.S.C. 102\(a\) and \(b\)](#) may be applicable. If the evidence only points to knowledge within the year prior to the effective filing date then [pre-AIA 35 U.S.C. 102\(a\)](#) applies. However, no rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) should be made if there is evidence that the inventor made the invention and only disclosed it to others within the year prior to the effective filing date.

Note that as an aid to resolving public use or on sale issues, as well as to other related matters of public availability or public knowledge, an applicant may be required to answer specific questions posed by the examiner and to explain or supplement any evidence of record. See [35 U.S.C. 132](#) and [37 CFR 1.104\(a\)\(2\)](#). Information sought should be restricted



to that which is reasonably necessary for the examiner to render a decision on patentability. The examiner may consider making a requirement for information under [37 CFR 1.105](#) where the evidence of record indicates reasonable necessity. See [MPEP § 704.10](#) *et seq.*

A 2-month time period should be set by the examiner for any reply to the requirement, unless the requirement is part of an Office action having a shortened statutory period, in which case the period for reply to the Office action will also apply to the requirement. If applicant fails to reply in a timely fashion to a requirement for information, the application will be regarded as abandoned. [35 U.S.C. 133](#).

If there is not enough information on which to base a public use or on sale rejection, the examiner should make a requirement for more information. Form paragraph 7.104.aia or 7.104.fti can be used.

#### ¶ 7.104.aia Requirement for Information, Public Use or Sale or Other Public Availability

An issue of public use, on sale activity, or other public availability has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under [35 U.S.C. 102\(a\)\(1\)](#), additional information regarding this issue is required as follows: [1]

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

#### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
3. Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability. See [MPEP § 2133.03](#).
4. A two month time period should be set by the examiner for reply to the requirement unless it is part of an Office action having a shortened statutory period (SSP), in which case the period for reply will apply also to the requirement.
5. If sufficient evidence already exists to establish a *prima facie* case of public use, sale, or other public availability use form paragraph 7.16.aia to make a rejection under [35 U.S.C. 102\(a\)\(1\)](#). See [MPEP § 2133.03](#).

#### ¶ 7.104.fti Requirement for Information, Public Use or Sale

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under [pre-AIA 35 U.S.C. 102\(b\)](#), additional information regarding this issue is required as follows: [1]

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

#### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability. See [MPEP § 2133.03](#).
3. A two month time period should be set by the examiner for reply to the requirement unless it is part of an Office action having an SSP, in which case the SSP will apply also to the requirement.
4. If sufficient evidence already exists to establish a *prima facie* case of public use or on sale, use form paragraph 7.16.fti to make a rejection under [pre-AIA 35 U.S.C. 102\(b\)](#). See [MPEP § 2133.03](#).

## 2121 Prior Art; General Level of Operability Required to Make a *Prima Facie* Case [R-01.2024]

### I. PRIOR ART IS PRESUMED TO BE OPERABLE/ENABLING

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to rebut the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also [MPEP § 716.07](#). See also *In re Antor Media Corp.*, 689 F.3d 1282, 103 USPQ2d 1555 (Fed. Cir. 2012). Specifically, in *In re Antor Media Corp.*, the court stated:

“Consistent with the statutory framework and our precedent, we therefore hold that, during patent prosecution, an examiner is entitled to reject claims as anticipated by a prior art publication or patent without conducting an inquiry into whether or not that prior art reference is enabling. As long as an examiner makes a proper *prima facie* case of anticipation by giving adequate



notice under [§ 132](#), the burden shifts to the applicant to submit rebuttal evidence of nonenablement.”

*In re Antor Media Corp.*, 689 F.3d at 1289, 103 USPQ2d at 1559.

Where a reference appears to not be enabling on its face, however, an applicant may successfully challenge the cited prior art for lack of enablement by argument without supporting evidence. *In re Morsa*, 713 F.3d 104, 110, 106 USPQ2d 1327, 1332 (Fed. Cir. 2013).

See also [MPEP § 716.07](#).

## II. WHAT CONSTITUTES AN “ENABLING DISCLOSURE” DOES NOT DEPEND ON THE TYPE OF PRIOR ART THE DISCLOSURE IS CONTAINED IN

The level of disclosure required within a reference to make it an “enabling disclosure” is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. There is no basis in the statute ([35 U.S.C. 102](#) or [103](#)) for discriminating either in favor of or against prior art references on the basis of nationality. *In re Moreton*, 288 F.2d 708, 129 USPQ 227 (CCPA 1961).

## III. EFFICACY IS NOT A REQUIREMENT FOR PRIOR ART ENABLEMENT

A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention; “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation.” *Impax Labs. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006) (citing *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1326, 75 USPQ2d 1297, 1302 (Fed. Cir. 2005)). See also [MPEP § 2122](#).

## 2121.01 Use of Prior Art in Rejections Where Operability is in Question [R-07.2022]

“In determining that quantum of prior art disclosure which is necessary to declare an ... invention ‘not novel’ or ‘anticipated’ within [section 102](#), the stated test is whether a reference contains an ‘enabling disclosure’ ... .” *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference enabled one of ordinary skill in the art to produce Elan’s claimed transgenic mouse without undue experimentation. Without a disclosure enabling one skilled in the art to produce a transgenic mouse without undue experimentation, the reference would not be applicable as prior art.). A reference contains an “enabling disclosure” if the public was in possession of the claimed invention before the effective filing date of the claimed invention for applications or patents subject to the first inventor to file provisions of the AIA or at the time the invention was made for applications or patents subject to pre-AIA law. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.” *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

### I. 35 U.S.C. 102 REJECTIONS AND ADDITION OF EVIDENCE SHOWING REFERENCE IS OPERABLE

It is possible to make a [35 U.S.C. 102](#) rejection even if the reference does not itself teach one of ordinary skill how to practice the invention, i.e., how to make the article disclosed or use the method disclosed. If the reference teaches every claimed element of the article or every claimed step of the method, secondary evidence, such as other patents or publications, can be cited to show public possession of the method of making the article or using the method. *In re Donohue*, 766 F.2d at 533, 226 USPQ

at 621. See [MPEP § 2131.01](#) for more information on [35 U.S.C. 102](#) rejections using secondary references to show that the primary reference contains an “enabling disclosure.”

## II. 35 U.S.C. 103 REJECTIONS AND USE OF INOPERATIVE PRIOR ART

“Even if a reference discloses an inoperative device, it is prior art for all that it teaches.” *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under [35 U.S.C. 103](#).” *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

### 2121.02 Compounds and Compositions — What Constitutes Enabling Prior Art [R-01.2024]

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

#### I. ONE OF ORDINARY SKILL IN THE ART MUST BE ABLE TO MAKE OR SYNTHESIZE

Where a process for making the compound is not developed until after the date of invention, the mere naming of a compound in a reference, without more, cannot constitute a description of the compound. *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). Note, however, that a reference is presumed operable until applicant provides facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d

675, 207 USPQ 107 (CCPA 1980). Therefore, applicant must provide evidence showing that a process for making was not known at the relevant time. See the following subsection for the evidentiary standard to be applied.

#### II. A REFERENCE DOES NOT CONTAIN AN “ENABLING DISCLOSURE” IF ATTEMPTS AT MAKING THE COMPOUND OR COMPOSITION WERE UNSUCCESSFUL BEFORE THE RELEVANT TIME

When a prior art reference merely discloses the structure of the claimed compound, evidence showing that attempts to prepare that compound were unsuccessful before the relevant time will be adequate to show inoperability. *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973). However, the fact that an author of a publication did not attempt to make the compound disclosed, without more, will not overcome a rejection based on that publication. *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) (In this case, the examiner had made a rejection under [pre-AIA 35 U.S.C. 102\(b\)](#) over a publication, which disclosed the claimed compound, in combination with two patents teaching a general process of making the particular class of compounds. The applicant submitted an affidavit stating that the authors of the publication had not actually synthesized the compound. The court held that the fact that the publication’s author did not synthesize the disclosed compound was immaterial to the question of reference operability. The patents were evidence that synthesis methods were well known. The court distinguished *Wiggins*, in which a very similar rejection was reversed. In *Wiggins*, attempts to make the compounds using the prior art methods were all unsuccessful.). Compare *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968) (A claim to a compound was rejected over a patent to *De Boer* which disclosed compounds similar in structure to those claimed (obvious homologs) and a process of making these compounds. Applicant responded with an affidavit by an expert named Wiley which stated that there was no indication in the *De Boer* patent that the process disclosed in *De Boer* could be used to produce the claimed compound and that he did not believe that the process disclosed in *De Boer* could be adapted to the production of the claimed compound. The court held that the facts

stated in this affidavit were legally sufficient to overcome the rejection and that applicant need not show that all known processes are incapable of producing the claimed compound for this showing would be practically impossible.).

### **2121.03 Plant Genetics — What Constitutes Enabling Prior Art [R-01.2024]**

#### **THOSE OF ORDINARY SKILL MUST BE ABLE TO GROW AND CULTIVATE THE PLANT**

When the claims are drawn to plants, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) (National Rose Society Annual of England and various other catalogues showed color pictures of the claimed roses and disclosed that applicant had raised the roses. The publications were published more than 1 year before applicant's filing date. The court held that the publications did not place the rose in the public domain. Information on the grafting process required to reproduce the rose was not included in the publications and such information was necessary for those of ordinary skill in the art (plant breeders) to reproduce the rose.). Compare *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) (Seeds were commercially available more than 1 year prior to applicant's filing date. One of ordinary skill in the art could grow the claimed cotton cultivar from the commercially available seeds. Thus, the publications describing the cotton cultivar had "enabled disclosures." The Board distinguished *In re LeGrice* by finding that the catalogue picture of the rose of *In re LeGrice* was the only evidence in that case. There was no evidence of commercial availability in enabling form since the asexually reproduced rose could not be reproduced from seed. Therefore, the public would not have possession of the rose by its picture alone, but the public would have possession of the cotton cultivar based on the publications and the availability of the seeds.). In *In re Elsner*, 381 F.3d 1125, 1126, 72 USPQ2d 1038, 1040 (Fed. Cir. 2004), prior to the critical date of a plant patent application, the plant had been sold in Germany and a foreign Plant Breeder's Rights (PBR) application for the same plant had been published in the Community Plant Variety Office *Official Gazette*. The court held that

when (i) a publication identifies the plant, (ii) a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, and (iii) such possession permits asexual reproduction of the plant without undue experimentation by one of ordinary skill in the art, then that combination of facts and events directly conveys the essential knowledge of the invention and constitutes a [pre-AIA 35 U.S.C. 102\(b\)](#) statutory bar. *Id.* at 1129, 72 USPQ2d at 1041. Although the court agreed with the Board that foreign sales may enable an otherwise non-enabling printed publication, the case was remanded for additional fact-finding in order to determine if the foreign sales of the plant were known to be accessible to the skilled artisan and if the skilled artisan could have reproduced the plant asexually after obtaining it without undue experimentation. *Id.* at 1131, 72 USPQ2d at 1043. See [MPEP § 2152.02\(d\)](#) for information on foreign sales being prior art for applications subject to the first inventor to file provisions of the AIA.

### **2121.04 Apparatus and Articles — What Constitutes Enabling Prior Art [R-10.2019]**

#### **PICTURES MAY CONSTITUTE AN "ENABLING DISCLOSURE"**

Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. However, the picture must show all the claimed structural features and how they are put together. *In re Bager*, 47 F.2d 951, 953, 8 USPQ 484, 486 (CCPA 1931) ("Description for the purposes of anticipation can be by drawings alone as well as by words.") (citing *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928)). See also [MPEP § 2125](#) for a discussion of drawings as prior art.

### **2122 Discussion of Utility in the Prior Art [R-01.2024]**

#### **UTILITY NEED NOT BE DISCLOSED IN REFERENCE**

In order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility need be disclosed by the

reference. *In re Schoenwald*, 964 F.2d 1122, 1124, 22 USPQ2d 1671, 1673 (Fed. Cir. 1992) (The application claimed compounds used in ophthalmic compositions to treat dry eye syndrome. The examiner found a printed publication which disclosed the claimed compound but did not disclose a use for the compound. The court found that the claim was anticipated since the compound and a process of making it were taught by the reference. The court explained that “no utility need be disclosed for a reference to be anticipatory of a claim to an old compound.” It is enough that the claimed compound is taught by the reference.). See also *Impax Labs. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006) (citing *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1326, 75 USPQ2d 1297, 1302 (Fed. Cir. 2005)); (“[P]roof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation.”).

### **2123 Rejection Over Prior Art’s Broad Disclosure Instead of Preferred Embodiments [R-07.2022]**

#### **I. PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN**

“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Labs., Inc.* 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 975 (1989). See also *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) (reference disclosing optional inclusion of a particular component teaches compositions that both do and do not contain that component); *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The

court held that the prior art anticipated the claims even though it taught away from the claimed invention. “The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.”).

See also [MPEP § 2131.05](#) and [§ 2145](#), subsection X.D., which discuss prior art that teaches away from the claimed invention in the context of anticipation and obviousness, respectively.

#### **II. NONPREFERRED AND ALTERNATIVE EMBODIMENTS CONSTITUTE PRIOR ART**

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have “relatively acceptable dimensional stability” and “some degree of flexibility,” but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant’s argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since “Gurley asserted no discovery beyond what was known in the art.” *Id.* at 554, 31 USPQ2d at 1132.). Furthermore, “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).



## 2124 Exception to the Rule That the Reference Must be Prior Art [R-01.2024]

### IN SOME CIRCUMSTANCES A FACTUAL REFERENCE NEED NOT ANTEDATE THE FILING DATE

In certain circumstances, references cited to show a universal fact need not be available as prior art before the effective filing date of applicant's claimed invention. *In re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962). Such facts include the characteristics and properties of a material or a scientific truism. Some specific examples in which later publications showing factual evidence can be cited include situations where the facts shown in the reference are evidence “that, as of an application's filing date, undue experimentation would have been required, *In re Corneil*, 347 F.2d 563, 568, 145 USPQ 702, 705 (CCPA 1965), or that a parameter absent from the claims was or was not critical, *In re Rainer*, 305 F.2d 505, 507 n.3, 134 USPQ 343, 345 n.3 (CCPA 1962), or that a statement in the specification was inaccurate, *In re Marzocchi*, 439 F.2d 220, 223 n.4, 169 USPQ 367, 370 n.4 (CCPA 1971), or that the invention was inoperative or lacked utility, *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974), or that a claim was indefinite, *In re Glass*, 492 F.2d 1228, 1232 n.6, 181 USPQ 31, 34 n.6 (CCPA 1974), or that characteristics of prior art products were known, *In re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962).” *In re Koller*, 613 F.2d 819, 824 n.5, 204 USPQ 702, 706 n.5 (CCPA 1980) (quoting *In re Hogan*, 559 F.2d 595, 605 n.17, 194 USPQ 527, 537 n.17 (CCPA 1977) (emphasis in original)). See also *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1375, 124 USPQ2d 1354, 1359 (Fed. Cir. 2017)(post-effective-filing-date evidence could be relied upon to show that patent failed to disclose a representative number of species of a claimed genus, and to show that patentees may have engaged in undue experimentation to enable the full scope of the claims before the effective filing date). However, it is impermissible to use a later factual reference showing the state of the art existing after the effective filing date of the claimed invention to determine whether the application is enabled or described as required under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. *In re Koller*,

613 F.2d 819, 823 n. 5, 204 USPQ 702, 706 n.5 (CCPA 1980). Post-effective-filing-date evidence offered to illuminate the post-effective-filing-date state of the art is improper. *Amgen*, 872 F.3d at 1374, 124 USPQ2d at 1359. References which do not qualify as prior art because they postdate the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the relevant time. See *Ex parte Erlich*, 22 USPQ2d 1463 (Bd. Pat. App. & Inter. 1992).

### 2124.01 Tax Strategies Deemed Within the Prior Art [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2150 et seq.](#) Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

#### I. OVERVIEW

[The Leahy-Smith America Invents Act \(AIA\), Public Law 112-29, sec. 14](#), 125 Stat. 284 (September 16, 2011) provides that for purposes of evaluating an invention for novelty and nonobviousness under [35 U.S.C. 102](#) and [35 U.S.C. 103](#), any strategy for reducing, avoiding, or deferring tax liability (hereinafter “tax strategy”), whether known or unknown at the relevant time, shall be deemed insufficient to differentiate a claimed invention from the prior art. As a result, applicants will no longer be able to rely on the novelty or non-obviousness of a tax strategy embodied in their claims to distinguish them from the prior art. Any tax strategy will be considered indistinguishable from all other publicly available information that is relevant to a patent's claim of originality. This provision aims to keep the ability to interpret the tax law and to implement such



interpretation in the public domain, available to all taxpayers and their advisors.

The term “tax liability” is defined for purposes of this provision as referring to any liability for a tax under any federal, state, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or assesses such tax liability.

There are two exclusions to this provision. The first is that the provision does not apply to that part of an invention that is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing.

The second is that the provision does not apply to that part of an invention that is a method, apparatus, technology, computer program product, or system, that is used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.

This provision took effect on September 16, 2011, and applies to any patent application that is pending on, or filed on or after, September 16, 2011, and to any patent issued on or after September 16, 2011. Accordingly, this provision will apply in a reexamination or other post-grant proceeding only to patents issued on or after September 16, 2011.

## II. EXAMINATION GUIDANCE FOR CLAIMS RELATING TO TAX STRATEGIES

The following procedure should be followed when examining claims relating to tax strategies.

1. Construe the claim in accordance with [MPEP § 2111](#) *et seq.*
2. Analyze the claim for compliance with [35 U.S.C. 101](#) and [112](#) in accordance with current guidance, which is unaffected by this provision.
3. Identify any limitations relating to a tax strategy, as defined above (note the listed exclusions).

a. Inventions that fall within the scope of [AIA section 14](#) include those tax strategies especially suitable for use with tax-favored structures that must meet certain requirements, such as employee benefit plans, tax-exempt organizations, or other entities that must be structured or operated in a particular manner to obtain certain tax consequences.

b. Thus, [AIA section 14](#) applies if the effect of an invention is to aid in satisfying the qualification requirements for a desired tax-favored entity status, to take advantage of the specific tax benefits offered in a tax-favored structure, or to allow for tax reduction, avoidance, or deferral not otherwise automatically available in such entity or structure.

4. Evaluate the claim in view of the prior art under [35 U.S.C. 102](#) and [103](#), treating any limitations relating to a tax strategy as being within the prior art, and not as a patentable difference between the claim and the prior art. This approach is analogous to the treatment of printed matter limitations in a claim as discussed at [MPEP § 2112.01](#), subsection III.

Form paragraph 7.06.01 may be used to indicate claim limitation(s) interpreted as a tax strategy.

### ¶ 7.06.01 Claim Limitation Relating to a Tax Strategy Deemed To Be Within the Prior Art under 35 U.S.C. 102 and/or 103

Claim limitation “[1]” has been interpreted as a strategy for reducing, avoiding, or deferring tax liability (“tax strategy”) pursuant to Section 14 of the Leahy-Smith America Invents Act. Accordingly, this claim limitation is being treated as being within the prior art and is insufficient to differentiate the invention of claim [2] from the prior art.

#### Examiner Note:

1. In bracket 1, recite the claim limitation that relates to a tax strategy. For more information see [MPEP § 2124.01](#).
2. In bracket 2, insert claim number(s), pluralize “claim” as appropriate.

## III. EXAMPLES DIRECTED TO COMPUTER-IMPLEMENTED METHODS

A computer-implemented method that is deemed novel and non-obvious would not be affected by this provision even if used for a tax purpose. For example, a novel and non-obvious computer-implemented method for manipulating data would not be affected by this provision even if the method organized data for a future tax filing.

However, a prior art computer-implemented method would not become non-obvious by implementing a novel and non-obvious tax strategy. That is, the presence of limitations relating to the tax strategy would not cause a claim that is otherwise within the prior art to become novel or non-obvious over the prior art.

Thus, for purposes of applying art to a software-related invention under [35 U.S.C. 102](#) and [35 U.S.C. 103](#), claim limitations that are directed solely to enabling individuals to file their income tax returns or assisting them with managing their finances should be given patentable weight, except that claim limitations directed to a tax strategy should not be given patentable weight.

## 2125 Drawings as Prior Art [R-10.2019]

### I. DRAWINGS CAN BE USED AS PRIOR ART

Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). See [MPEP § 2121.04](#) for more information on prior art drawings as “enabled disclosures.”

### II. PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*,

222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”). However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 1127-28, 193 USPQ 332, 335-36 (CCPA 1977) (“We disagree with the Solicitor’s conclusion, reached by a comparison of the relative dimensions of appellant’s and Bauer’s [the reference’s] drawing figures, that Bauer ‘clearly points to the use of a chime length of roughly 1/2 to 1 inch for a whiskey barrel.’ This ignores the fact that Bauer does not disclose that his drawings are to scale. ... However, we agree with the Solicitor that Bauer’s teaching that whiskey losses are influenced by the distance the liquor needs to ‘traverse the pores of the wood’ (albeit in reference to the thickness of the barrelhead)” would have suggested the desirability of an increased chime length to one of ordinary skill in the art bent on further reducing whiskey losses.” 569 F.2d at 1127, 193 USPQ at 335-36.)

## 2126 Availability of a Document as a “Patent” for Purposes of Rejection Under 35 U.S.C. 102(a) or Pre-AIA 35 U.S.C. 102(a), (b), and (d) [R-08.2017]

### I. THE NAME “PATENT” ALONE DOES NOT MAKE A DOCUMENT AVAILABLE AS A PRIOR ART PATENT UNDER 35 U.S.C. 102(a) or Pre-AIA 35 U.S.C. 102(a) OR (b)

What a foreign country designates to be a patent may not be a patent for purposes of rejection under [35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(a\) and \(b\)](#); it is the substance of the rights conferred and the way information within the “patent” is controlled that is determinative. *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). See the next subsection for further explanation with respect to when a document can be applied in a rejection as a “patent.” See [MPEP § 2135.01](#) for a further discussion of the use of “patents” in [pre-AIA 35 U.S.C. 102\(d\)](#) rejections.

**II. A SECRET PATENT IS NOT AVAILABLE AS A REFERENCE UNDER 35 U.S.C. 102(a) or Pre-AIA 35 U.S.C. 102(a) or (b) UNTIL IT IS AVAILABLE TO THE PUBLIC BUT IT MAY BE AVAILABLE UNDER Pre-AIA 35 U.S.C. 102(d) AS OF GRANT DATE**

Secret patents are defined as patents which are insufficiently accessible to the public to constitute “printed publications.” Decisions on the issue of what is sufficiently accessible to be a “printed publication” are located in [MPEP § 2128](#) - [MPEP § 2128.01](#).

Even if a patent grants an exclusionary right (is enforceable), it is not available as prior art under [35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) if it is secret or private. *In re Carlson*, 983 F.2d 1032, 1037, 25 USPQ2d 1207, 1211 (Fed. Cir. 1992). The document must be at least minimally available to the public to constitute prior art. The patent is sufficiently available to the public for the purposes of [35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) if it is laid open for public inspection or disseminated in printed form. See, e.g., *In re Carlson*, 983 F.2d at 1037, 25 USPQ2d at 1211 (“We recognize that *Geschmacksmuster* on display for public view in remote cities in a far-away land may create a burden of discovery for one without the time, desire, or resources to journey there in person or by agent to observe that which was registered under German law. Such a burden, however, is by law imposed upon the hypothetical person of ordinary skill in the art who is charged with knowledge of all contents of the relevant prior art.”). The date that the patent is made available to the public is the date it is available as a [35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) reference. *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). But a period of secrecy after granting the patent has been held to have no effect in connection with [pre-AIA 35 U.S.C. 102\(d\)](#). These patents are usable in rejections under [pre-AIA 35 U.S.C. 102\(d\)](#) as of the date patent rights are granted. *In re Kathawala*, 9 F.3d 942, 946, 28 USPQ2d 1785, 1788-89 (Fed. Cir. 1993). See [MPEP § 2135](#) - [MPEP § 2135.01](#) for more information on [pre-AIA 35 U.S.C. 102\(d\)](#).

**2126.01 Date of Availability of a Patent as a Reference [R-11.2013]**

**DATE FOREIGN PATENT IS EFFECTIVE AS A REFERENCE IS USUALLY THE DATE PATENT RIGHTS ARE FORMALLY AWARDED TO ITS APPLICANT**

The date the patent is available as a reference is generally the date that the patent becomes enforceable. This date is the date the sovereign formally bestows patent rights to the applicant. *In re Monks*, 588 F.2d 308, 200 USPQ 129 (CCPA 1978). There is an exception to this rule when the patent is secret as of the date the rights are awarded.

*In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958).

Note that [MPEP § 901.05](#) summarizes in tabular form dates of patenting for many foreign patents. For a list of cases that discuss the date of patenting countries for purposes of [pre-AIA 35 U.S.C. 102](#) in particular, see *Chisum*, Patents § 3.06[4] n.2.

**2126.02 Scope of Reference’s Disclosure Which Can Be Used to Reject Claims When the Reference Is a “Patent” but Not a “Publication” [R-11.2013]**

**OFTEN UNCLAIMED DETAILS FOUND IN THE PATENT SPECIFICATION CAN BE RELIED ON EVEN IF PATENT IS SECRET**

When the patented document is used as a patent and not as a publication, the examiner is not restricted to the information conveyed by the patent claims but may use any information provided in the specification which relates to the subject matter of the patented claims when making a rejection under [35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(a\), \(b\) or \(d\)](#). *Ex parte Ovist*, 152 USPQ 709, 710 (Bd. App. 1963) (The claim of an Italian patent was generic and thus embraced the species disclosed in the examples; the Board added that the entire specification was germane to the claimed invention and upheld the examiner’s [pre-AIA 35 U.S.C. 102\(b\)](#) rejection.); *In re Kathawala*, 9 F.3d 942, 28 USPQ2d 1785 (Fed. Cir. 1993) (The claims at issue were rejected under [pre-AIA 35 U.S.C. 102\(d\)](#) by applicant’s own parent applications in Greece and

Spain. The applicant argued that the “invention ... patented in Spain was not the same ‘invention’ claimed in the U.S. application because the Spanish patent claimed processes for making [compounds for inhibition of cholesterol biosynthesis] and claims 1 and 2 were directed to the compounds themselves.” *Id.* at 944, 28 USPQ2d at 1786. The Federal Circuit held that “when an applicant files a foreign application fully disclosing his invention and having the potential to claim his invention in a number of ways, the reference in [section 102\(d\)](#) to ‘invention ... patented’ necessarily includes all disclosed aspects of the invention.” *Id.* at 945-46, 28 USPQ2d at 1789.).

Note that *In re Fuge*, 272 F.2d 954, 957, 124 USPQ 105, 107 (CCPA 1959), does not conflict with the above decisions. This decision simply states “that, at the least, the scope of the patent embraces everything included in the [claim].” (emphasis added).

The courts have interpreted the phrase “invention ... patented” in [pre-AIA 35 U.S.C. 102\(a\), \(b\), and \(d\)](#) the same way and have cited decisions without regard to which of these subsections of [pre-AIA 35 U.S.C. 102](#) was at issue in the particular case at hand. Therefore, it does not seem to matter to which subsection of [pre-AIA 35 U.S.C. 102](#) the cases are directed; the court decisions are interchangeable as to this issue.

## 2127 Domestic and Foreign Patent Applications as Prior Art [R-01.2024]

### I. ABANDONED APPLICATIONS, INCLUDING PROVISIONAL APPLICATIONS

#### Abandoned Applications Disclosed to the Public Can Be Used as Prior Art

“An abandoned patent application may become evidence of prior art only when it has been appropriately disclosed, as, for example, when the abandoned patent [application] is reference[d] in the disclosure of another patent, in a publication, or by voluntary disclosure under [former Defensive Publication rule] [37 CFR 1.139](#) [Reserved].” *Lee Pharmaceutical v. Kreps*, 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978). An abandoned

patent application becomes available as prior art only as of the date the public gains access to it. See [37 CFR 1.14\(a\)\(1\)\(ii\)](#) and [\(iv\)](#). However, the subject matter of an abandoned application, including both provisional and nonprovisional applications, referred to in a prior art U.S. patent or U.S. patent application publication may be relied on in a [35 U.S.C. 102\(a\)\(2\)](#) or [pre-AIA 35 U.S.C. 102\(e\)](#) rejection based on that patent or patent application publication if the disclosure of the abandoned application is actually included or incorporated by reference in the patent or patent application publication. Compare *In re Lund*, 376 F.2d 982, 991, 153 USPQ 625, 633 (CCPA 1967) (The court reversed a rejection over a patent which was a continuation-in-part of an abandoned application. Applicant’s filing date preceded the issue date of the patent reference. The abandoned application contained subject matter which was essential to the rejection but which was not carried over into the continuation-in-part. The court held that the subject matter embodied in the canceled example 2 could not be relied on as of either parent or child filing date. Thus, the use of example 2 subject matter to reject the claims under [pre-AIA 35 U.S.C. 102\(e\)](#) was improper.). See also [MPEP § 901.02](#). See [MPEP § 2136.02](#) and [MPEP § 2136.03](#) for the [35 U.S.C. 102\(e\)](#) date of a U.S. patent claiming priority under [35 U.S.C. 119](#) or [35 U.S.C. 120](#). See [MPEP § 2154](#) for prior art under [35 U.S.C. 102\(a\)\(2\)](#).

### II. APPLICATIONS WHICH HAVE ISSUED AS PATENTS

*A. A 35 U.S.C. 102(a)(2) or Pre-AIA 35 U.S.C. 102(e) Rejection Cannot Rely on Matter Which Was Canceled from the Application and Thus Did Not Get Published in the Issued Patent or Application Publication*

Canceled matter in the application file of a U.S. patent or application publication cannot be relied upon in a rejection under [35 U.S.C. 102\(a\)\(2\)](#) or [pre-AIA 35 U.S.C. 102\(e\)](#). *Ex Parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966). The canceled matter only becomes available as prior art as of the date the application file history becomes available to the public. *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). However, as discussed below, such matter may be available as prior art under [35 U.S.C. 102\(a\)\(1\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#). For more information on available prior art for use in [pre-AIA](#)



[35 U.S.C. 102\(e\)](#) rejections, see [MPEP § 2136.02](#). For more information on available prior art for use in [35 U.S.C. 102\(a\)\(2\)](#) rejections, see [MPEP § 2154](#) *et seq.*

***B. A 35 U.S.C. 102(a)(1) or Pre-AIA 35 U.S.C. 102(b) Rejection Over a Published Application May Rely on Information that Was Canceled Prior to Publication***

Figures that had been canceled from a Canadian patent application before issuance of the patent were available as prior art under [pre-AIA 35 U.S.C. 102\(b\)](#) as of the date the application became publicly accessible. The patent at issue and its underlying application were available for public inspection at the Canadian Patent Office more than one year before the effective filing date of the claimed inventions in the patents in suit. *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 78 USPQ2d 1684 (Fed. Cir. 2006).

**III. FOREIGN APPLICATIONS OPEN FOR PUBLIC INSPECTION (LAID OPEN APPLICATIONS)**

**Laid Open Applications May Constitute “Published” Documents**

When the specification is not issued in printed form but is announced in an official journal and anyone can inspect or obtain copies, it is sufficiently accessible to the public to constitute a “publication” within the meaning of [35 U.S.C. 102\(a\)\(1\)](#) or [pre-AIA 35 U.S.C. 102\(a\) and \(b\)](#). See *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981).

One board decision, however, has held that laid open patent applications are not “published” and cannot constitute prior art. *Ex parte Haller*, 103 USPQ 332 (Bd. App. 1953). Whether or not a document is “published” for the purposes of [35 U.S.C. 102](#) and [35 U.S.C. 103](#) depends on how accessible the document is to the public. As technology has made reproduction of documents easier, the accessibility of the laid open applications has increased. Items provided in easily reproducible form have thus become “printed publications” as the phrase is used in [35 U.S.C. 102](#). *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981) (Laid open Australian patent application held to be a “printed

publication” even though only the abstract was published because it was laid open for public inspection, microfilmed, “diaz copies” were distributed to five suboffices having suitable reproduction equipment and the diazo copies were available for sale.). The contents of a foreign patent application should not be relied upon as prior art until the date of publication (i.e., the insertion into the laid open application) can be confirmed by an examiner’s review of a copy of the document. See [MPEP § 901.05](#).

**IV. PENDING U.S. APPLICATIONS**

As specified in [37 CFR 1.14\(a\)](#), all pending U.S. patent applications are preserved in confidence except for published applications (see also [35 U.S.C. 122\(b\)](#)), reissue applications, and applications in which a request to open the complete application to inspection by the public has been granted by the Office ([37 CFR 1.11\(b\)](#)). However, if an application that has not been published has an assignee or at least one inventor in common with the application being examined, a rejection will be proper in some circumstances. For instance, when the claims between the two applications are not independent or distinct, a provisional double patenting rejection is made. See [MPEP § 804](#). If the copending applications differ by at least one joint inventor and at least one of the applications would have been obvious in view of the other, a provisional rejection over [35 U.S.C. 102\(a\)\(2\)](#) or [pre-AIA 35 U.S.C. 102\(e\)](#) or [35 U.S.C. 103](#) is made when appropriate. See [MPEP §§ 2136.01, 2146.03\(a\) and 2154.01\(d\)](#).

See [MPEP §§ 804, 2120.01, 2136](#) *et seq.* and [2154](#) *et seq.* for information pertaining to rejections relying on U.S. application publications.

**2128 “Printed Publications” as Prior Art [R-01.2024]**

*[Editor Note: For applications subject to the first inventor to file (FITF) provisions of the AIA, see also [MPEP §§ 2152.02\(b\) and 2152.02\(e\)](#)]*



## I. A REFERENCE IS A “PRINTED PUBLICATION” IF IT IS ACCESSIBLE TO THE PUBLIC

A reference is proven to be a “printed publication” “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) (“We agree that ‘printed publication’ should be approached as a unitary concept. The traditional dichotomy between ‘printed’ and ‘publication’ is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the ‘probability of dissemination’ of an item very often has little to do with whether or not it is ‘printed’ in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words ‘printed’ and ‘publication’ to mean ‘probability of dissemination’ and ‘public accessibility’ respectively, now seems to render their use in the phrase ‘printed publication’ somewhat redundant.”) *In re Wyer*, 655 F.2d at 226, 210 USPQ at 794. See also *Voter Verified, Inc. v. Premier Election Solutions*, 698 F.3d 1374, 1380, 104 USPQ2d 1553, 1556-57 (Fed. Cir. 2012) (“the ultimate question is whether the reference was ‘available to the extent that persons interested and ordinary skilled in the subject matter or art[,] exercising reasonable diligence, can locate it’” (citations omitted)).

The Federal Circuit stated the following in *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380, 127 USPQ2d 1208, 1216-17 (Fed. Cir. 2018):

Whether a reference qualifies as a “printed publication” is a legal conclusion based on underlying factual determinations. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014) (citation omitted). “The ‘printed publication’ provision of § 102(b) ‘was designed to prevent withdrawal by an inventor ... of that which was already in the possession of the public.’ ” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (alteration in original) (quoting *In re*

*Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981)); see *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (“This rule is grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone.” (internal quotation marks and citations omitted) ). *Medtronic*, as the patent challenger, bears the burden of establishing that a particular document is a printed publication. See *Blue Calypso*, 815 F.3d at 1350–51 (holding that petitioner failed to carry its burden of proving public accessibility of the allegedly invalidating reference).

The determination of whether a document is a “printed publication” under [35 U.S.C. § 102\(b\)](#) “involves a case-by- case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under [35 U.S.C. § 102\(b\)](#).” *Blue Calypso*, 815 F.3d at 1348 (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). “A reference will be considered publicly accessible if it was ‘disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence[] can locate it.’” *Id.* (quoting *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

See also *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (Starlight Archery argued that Carella’s patent claims to an archery sight were anticipated under [pre-AIA 35 U.S.C. 102\(a\)](#) by an advertisement in a Wisconsin Bow Hunter Association (WBHA) magazine and a WBHA mailer prepared prior to Carella’s filing date. However, there was no evidence as to when the mailer was received by any of the addressees. Plus, the magazine had not been mailed until 10 days after Carella’s filing date. The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before

the filing date there could be no rejection under [pre-AIA 35 U.S.C. 102\(a\)](#).

When a document is cited in a rejection of a claim in an examination of a patent application or during an reexamination proceeding, an applicant or patent owner may challenge its public availability and/or the date it became publicly accessible, even when the document itself contains a publication date, by filing a proper affidavit or declaration under [37 CFR 1.132](#) that includes facts and evidence to support the applicant or patent owner's position. See [MPEP § 716 et seq.](#)

## II. ELECTRONIC PUBLICATIONS AS PRIOR ART

### A. Status as a “Printed Publications”

An electronic publication, including an online database or Internet publication (e.g., discussion group, forum, digital video, or social media post), is considered to be a “printed publication” within the meaning of [35 U.S.C. 102\(a\)\(1\)](#) and [pre-AIA 35 U.S.C. 102\(a\) and \(b\)](#) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) (“Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a ‘printed publication’ ... should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” (citations omitted)). See also *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999) (Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged.); *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that the software products referenced therein were “first installed” or “released” more than one year prior to applicant’s filing date.); *Suffolk Tech v. AOL and Google*, 752 F.3d 1358, 110 USPQ2d 2034 (Fed.

Cir. 2014) (A newsgroup posting constituted prior art as it was directed to those having ordinary skill in the art and was publicly accessible because the post was sufficiently disseminated.)

The Office policy requiring recordation of the field of search and search results (see [MPEP § 719.05](#)) weighs in favor of finding that internet and online database references cited by the examiner are “accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *Wyer*, 655 F.2d at 221, 210 USPQ at 790. Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources obtained from the internet and online databases.

### B. Date of Availability

Electronic publications on the internet or on an online database are considered to be publicly available as of the date the item was publicly posted. See subsection I above. Absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art under [35 U.S.C. 102\(a\)\(1\)](#) and [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#). However, it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication or posting. See [MPEP § 901.06\(a\)](#), subsection IV.G.

### C. Extent of Teachings Relied Upon

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See [MPEP § 2121.01](#) and [§ 2123](#). Note, however, that if an electronic document which is the abstract of a patent or printed publication is relied upon in a rejection under [35 U.S.C. 102](#) or [35 U.S.C. 103](#), only the text of the abstract (and not the underlying document) may be relied upon to support the rejection. In situations where the electronic version and the published paper version of the same or a corresponding patent or printed publication differ appreciably, each may need to be cited and relied

upon as independent references based on what they disclose.

#### D. Internet Usage Policy

See [MPEP § 904.02\(c\)](#) for the portions of the Internet Usage Policy pertaining to internet searching and documenting search strategies. See [MPEP § 707.05\(e\)](#) for the proper citation of electronic documents.

#### E. Wayback Machine<sup>®</sup>

The Wayback Machine<sup>®</sup> is a digital library maintained by the Internet Archive (a non-profit organization) for viewing archived versions of websites. Simply, the Wayback Machine<sup>®</sup> uses software programs, known as crawlers, to surf the internet and automatically store copies of web objects (web pages, images, videos, etc.), preserving these objects as they exist at the point and time of capture. These web objects are stored as web captures. Each capture has a time stamp including the year/month/day/hour/minute/second the capture was made and the URL of the original website.

Accordingly, the Wayback Machine<sup>®</sup> provides the ability to view and browse internet information that may no longer be available on the original website.

Publications obtained via the Wayback Machine<sup>®</sup> are *prima facie* deemed to be publicly accessible at the date and time provided in the time stamp. The burden then shifts to the applicant should they wish to challenge the authenticity, reliability or accessibility of such information. See *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374-75, 2021 USPQ2d 867 (Fed. Cir. 2021) (relying on Wayback Machine<sup>®</sup> to establish date of publication).

#### F. Social Media

Social media websites on the internet, such as YouTube<sup>®</sup>, Twitter<sup>®</sup>, Facebook<sup>®</sup>, and public forum posts, can be a source of prior art, provided the public accessibility requirements, as laid out in subsection I are met. Thus, all information on social media is not necessarily publicly accessible. Public

accessibility is determined on a case-by-case basis taking into consideration factors such as, where the information is posted, privacy restrictions placed on the posting, the length of time it was posted, and whether the information is indexed for searching.

Some social media websites are not archived by the Wayback Machine<sup>®</sup>. Therefore, examiners may have to rely on the timestamps on the social media sites to establish the public accessibility date. However, the accuracy of timestamps on social media websites may need to be scrutinized with care, as the reliability of some websites do not approach those of other types of internet publications, such as those providing peer-reviewed material. When a document is cited in a rejection of a claim, an applicant or patent owner may challenge its public availability and/or date that it became publicly available, even where the information self-contains a publication date, by filing a proper affidavit or declaration under [37 CFR 1.132](#). See [MPEP § 716 et seq.](#)

For examples of social media website citation formats see [MPEP § 707.05\(e\)](#).

### III. EXAMINER NEED NOT PROVE ANYONE ACTUALLY LOOKED AT THE DOCUMENT

There is no need to prove that someone actually looked at a publication when that publication is accessible to the public through a library or patent office. See *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). “A reference is considered publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’ If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1355-1356 (Fed. Cir. 2018) (quoting *Wyer*, 655 F.2d at 226) and *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569, 7 USPQ2d 1057, 1062-63 (Fed. Cir. 1988)).

## 2128.01 Level of Public Accessibility Required [R-07.2022]

The statutory phrase “printed publication” has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was “published.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568, 7 USPQ2d 1057, 1062 (Fed. Cir. 1988).

### I. A THESIS PLACED IN A UNIVERSITY LIBRARY OR A DOCUMENT PLACED IN AN ONLINE DATABASE MAY BE PRIOR ART IF SUFFICIENTLY ACCESSIBLE TO THE PUBLIC

A doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior art as a “printed publication.” *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). Even if access to the library is restricted, a reference will constitute a “printed publication” as long as a presumption is raised that the portion of the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978).

In *In re Hall*, general library cataloging and shelving practices showed that a doctoral thesis deposited in university library would have been indexed, cataloged and shelved and thus available to the public before the critical date. Compare *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989) wherein doctoral theses were shelved and indexed by index cards filed alphabetically by student name and kept in a shoe box in the chemistry library. The index cards only listed the student name and title of the thesis. In *Cronyn*, the court held that the students’ theses were not accessible to the public because they had not been either cataloged or indexed in a meaningful way, e.g., by title or in some other way that bears a relationship to the subject of the thesis, but instead were cataloged by the researcher’s name. Compare *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978) (A reference will constitute a “printed publication” as long as a presumption is raised that the portion of the public concerned with the art would know of the invention

even if accessibility is restricted to only this part of the public. But accessibility to applicant’s thesis was restricted to only three members of a graduate committee. There can be no presumption that those concerned with the art would have known of the invention in this case.).

In determining whether a document in an online database is a printed publication, public accessibility is key. See [MPEP § 2128](#), subsection I. In *Voter Verified, Inc. v. Premier Election Sols., Inc.* the court found that “(i)ndexing is not ‘a necessary condition for a reference to be publicly accessible’; it is but one among many factors that may bear on public accessibility.” *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1381, 104 USPQ2d 1553, 1557 (Fed. Cir. 2012) (quoting *In re Lister*, 583 F.3d 1307, 1312, 92 USPQ2d 1225, 1228 (Fed. Cir. 2009)). The court further stated that “indexing is no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media”. *Id.* See also *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1346-47, 2019 USPQ2d 428076 (Fed. Cir. 2019) (The court found the Jentschel reference was available to the public based on a declaration and evidence that the reference was received and shelved in a German library. Ericsson argued that public accessibility required something more than simply shelving of the reference in a library. The court found Ericsson’s argument unpersuasive because it was undisputed that the library was accessible to the public and that the reference was published as a journal for at least 30 years. The court pointed out that Ericsson produced no evidence to counter the public accessibility evidence of record.).

A document in an online database is not always deemed a printed publication. In *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773, USPQ2d 1507, 1514 (Fed. Cir. 2018), the court agreed with the Board that an electronic technical report did not constitute a “printed publication” within the meaning of [\(pre-AIA\) 35 U.S.C. 102\(a\)](#). The court agreed with the Board that an interested skilled artisan, using reasonable diligence, would not have been able to find the technical report on the CSE Technical Reports Library website despite some indexing and search functionality on the website that



permitted technical accessibility. Technical reports were listed only by author or year, and there was no evidence how many reports were in the Library's database in 1999. It was determined that at best, an artisan might have located the cited technical report by skimming through potentially hundreds of titles in the same year, with most containing unrelated subject matter, or by viewing all titles in the database listed by author, when the authors were not particularly well known. Also, the website's advanced search form was found to be deficient because the ability to search keywords for author, title, and abstract fields was not reliable.

## **II. ORALLY PRESENTED PAPER CAN CONSTITUTE A "PRINTED PUBLICATION" IF WRITTEN COPIES ARE AVAILABLE WITHOUT RESTRICTION**

A paper which is orally presented in a forum open to all interested persons constitutes a "printed publication" if written copies are disseminated without restriction. *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985) (Paper orally presented to between 50 and 500 persons at a scientific meeting open to all persons interested in the subject matter, with written copies distributed without restriction to all who requested, is a printed publication. Six persons requested and obtained copies.); see also *M & K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376, 2021 USPQ2d 123 (Fed. Cir. 2021). An oral presentation at a scientific meeting or a demonstration at a trade show may be prior art under [35 U.S.C. 102\(a\)\(1\)](#)'s provision: "otherwise available to the public." See [MPEP § 2152.02\(e\)](#).

## **III. INTERNAL DOCUMENTS INTENDED TO BE CONFIDENTIAL ARE NOT "PRINTED PUBLICATIONS"**

Documents and items only distributed internally within an organization which are intended to remain confidential are not "printed publications" no matter how many copies are distributed. There must be an existing policy of confidentiality or agreement to remain confidential within the organization. Mere intent to remain confidential is insufficient. *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Inter. 1987) (Research reports disseminated in-house to

only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing.); *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl.1970) ("While distribution to government agencies and personnel alone may not constitute publication ... distribution to commercial companies without restriction on use clearly does."); *Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990) (Four reports on the AESOP-B military computer system which were not under security classification were distributed to about fifty organizations involved in the AESOP-B project. One document contained the legend "Reproduction or further dissemination is not authorized." The other documents were of the class that would contain this legend. The documents were housed in Mitre Corporation's library. Access to this library was restricted to those involved in the AESOP-B project. The court held that public access was insufficient to make the documents "printed publications.").

## **IV. PUBLICLY DISPLAYED REFERENCES CAN CONSTITUTE A "PRINTED PUBLICATION" EVEN IF THE REFERENCES ARE NOT DISSEMINATED BY COPIES OR INDEXED IN A LIBRARY OR DATABASE**

A publicly displayed document where persons of ordinary skill in the art could see it and are not precluded from copying it can constitute a "printed publication," even if it is not disseminated by the distribution of reproductions or copies and/or indexed in a library or database.

As stated in *In re Klopfenstein*, 380 F.3d 1345, 1348, 72 USPQ2d 1117, 1119 (Fed. Cir. 2004), "the key inquiry is whether or not a reference has been made 'publicly accessible.'" Prior to the critical date, a fourteen-slide presentation disclosing the invention was printed and pasted onto poster boards. The printed slide presentation was displayed with no confidentiality restrictions for approximately three cumulative days at two different industry events. *Id.* at 1347, 72 USPQ2d at 1118. The court noted that "an entirely oral presentation at a scientific conference that includes neither slides nor copies of the presentation is without question not a 'printed publication' for the purposes of [\[pre-AIA\] 35 U.S.C.](#)



[§ 102\(b\)](#). Furthermore, a presentation that includes a transient display of slides is likewise not necessarily a ‘printed publication.’” *Id.* at 1349 n.4, 72 USPQ2d at 1120 n.4. In resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a “printed publication” under [pre-AIA 35 U.S.C. 102\(b\)](#), the court considered the following factors: “the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied.” *Id.* at 1350, 72 USPQ2d at 1120. Upon reviewing the above factors, the court concluded that the display “was sufficiently publicly accessible to count as a ‘printed publication.’” *Id.* at 1352, 72 USPQ2d at 1121.

Similarly, in *Medtronic Inc., v. Barry* (891 F.3d 1368, 127 USPQ 1208) (Fed. Cir. 2018) a video and slides presented at two conferences prior to the critical date were found to be publically accessible. When considering the factors set forth in *In re Klopfenstein*, the court stated “[i]t may be relevant to determine whether ... members were expected to maintain the confidentiality of received materials or would be permitted to share or even publicize the insights gained and materials collected...”. *Id.* at 127 USPQ2d at 1218. In addition, in *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 128 USPQ2d 1447 (Fed. Cir. 2018), the court stated that the expertise of the target audience is a factor in determining public accessibility but is not dispositive of the inquiry. “Rather, our case law directs us to also consider the nature of the conference or meeting; whether there are restrictions on public disclosure of the information; expectations of confidentiality; and expectations of sharing the information.” *Id.* at 695, 128 USPQ2d at 1451.

See also *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 127 USPQ2d 1485 (Fed. Cir. 2018) (A notice in the Federal Register which included instructions on accessing reference materials was sufficient for the materials to be considered publicly accessible; the Board did not need to find that specific persons actually received or examined the materials).

“We have consistently held that indexing or searchability is unnecessary for a reference to be a printed publication.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1359, 127 USPQ2d 1485,1493 (Fed. Cir. 2018). But see *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773, USPQ2d 1507, 1514 (Fed. Cir. 2018)(an electronic technical report did not constitute a “printed publication” because the indexing or searchability was deficient, and an interested skilled artisan, using reasonable diligence, would have to skim through potentially hundreds of titles in the same year, with most containing unrelated subject matter).

Note that an oral presentation at a scientific meeting or a demonstration at a trade show may be prior art under [35 U.S.C. 102\(a\)\(1\)](#)'s provision: “otherwise available to the public.” See [MPEP § 2152.02\(e\)](#). “Trade shows are not unlike conferences - a trade show is directed to individuals interested in the commercial and developmental aspects of products. If one desires to examine certain new products on the market, attending a trade show involving identical or similar products is a good option.” *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 694, 128 USPQ2d 1447, 1451 (Fed. Cir. 2018).

## **2128.02 Date Publication Is Available as a Reference [R-10.2019]**

### **I. DATE OF ACCESSIBILITY CAN BE SHOWN THROUGH EVIDENCE OF ROUTINE BUSINESS PRACTICES**

Evidence showing routine business practices can be used to establish the date on which a publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), *cert. denied*, 988 U.S. 892 (1988) (Court held that evidence submitted by Intel regarding undated specification sheets showing how the company usually treated such specification sheets was enough to show that the sheets were accessible by the public before the critical date.); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) (Librarian’s affidavit establishing normal time frame and practice for

indexing, cataloging and shelving doctoral theses established that the thesis in question would have been accessible by the public before the critical date.); *In re Lister*, 583 F.3d 1307, 1317, 92 USPQ2d 1225, 1231-32 (Fed. Cir. 2009) (“The government urges us that it is appropriate in this case to presume that the manuscript information was added to the Westlaw and Dialog databases prior to the critical date because the critical date was more than a year after the certificate of registration was granted. However, absent any evidence pertaining to the general practices of the Copyright Office, Westlaw, and Dialog, or the typical time that elapses between copyright registration, inclusion in the Copyright Office’s automated catalog, and subsequent incorporation into one of the commercial databases, any presumption along those lines would be pure speculation.”).

## II. A JOURNAL ARTICLE OR OTHER PUBLICATION BECOMES AVAILABLE AS PRIOR ART ON DATE IT IS RECEIVED BY A MEMBER OF THE PUBLIC

A publication disseminated by mail is not prior art until it is received by at least one member of the public. Thus, a magazine or technical journal is effective as of the date when the first person receives it, not the date it was mailed or sent to the publisher.

*In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956).

### 2129 Admissions as Prior Art [R-07.2022]

#### I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART

A statement by an applicant in the specification or made during prosecution identifying the work of another as “prior art” is an admission which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of [35 U.S.C. 102](#). *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988). Where the admitted prior art anticipates the claim but does not qualify as prior art under any

of the paragraphs of [35 U.S.C. 102](#), the claim may be rejected as being anticipated by the admitted prior art without citing to [35 U.S.C. 102](#).

However, even if labeled as “prior art,” the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) (“[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.”).

Consequently, the examiner must determine whether the subject matter identified as “prior art” is the inventor’s own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

#### II. DISCUSSION OF PRIOR ART IN SPECIFICATION

Where the specification identifies work done by another as “prior art,” the subject matter so identified is treated as admitted prior art. *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant’s labeling of two figures in the application drawings as “prior art” to be an admission that what was pictured was prior art relative to the claimed improvement).

#### III. JEPSON CLAIMS

Drafting a claim in *Jepson* format (i.e., the format described in [37 CFR 1.75\(e\)](#); see [MPEP § 608.01\(m\)](#)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982) (holding preamble of *Jepson*-type claim to be admitted prior art where applicant’s specification credited another as the inventor of the subject matter of the preamble). However, this implication may be overcome where applicant gives another credible reason for drafting

the claim in *Jepson* format. *In re Ehrreich*, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979) (holding preamble not to be admitted prior art where applicant explained that the *Jepson* format was used to avoid a double patenting rejection in a co-pending application and the examiner cited no art showing the subject matter of the preamble). Moreover, where the preamble of a *Jepson* claim describes the inventor’s own work, such may not be used against the claims. *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984); *Ehrreich*, 590 F.2d at 909-910, 200 USPQ at 510.

#### IV. INFORMATION DISCLOSURE STATEMENT (IDS)

Mere listing of a reference in an information disclosure statement is not taken as an admission that the reference is prior art against the claims. *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354-55, 66 USPQ2d 1331, 1337-38 (Fed. Cir. 2003) (listing of the inventor’s own prior patent in an IDS does not make it available as prior art absent a statutory basis); *see also* [37 CFR 1.97\(h\)](#) (“The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in [§ 1.56\(b\)](#).”).

#### 2130 [Reserved]

#### 2131 Anticipation — Application of 35 U.S.C. 102 [R-08.2017]

A claimed invention may be rejected under [35 U.S.C. 102](#) when the invention is anticipated (or is “not novel”) over a disclosure that is available as prior art. To reject a claim as anticipated by a reference, the disclosure must teach every element required by the claim under its broadest reasonable interpretation. *See, e.g.,* [MPEP § 2114](#), subsections II and IV.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of*

*California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). *See also* [MPEP § 2131.02](#). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a [35 U.S.C. 102](#) rejection. *See* [MPEP § 2131.01](#).

#### 2131.01 Multiple Reference 35 U.S.C. 102 Rejections [R-01.2024]

Normally, only one reference should be used in making a rejection under [35 U.S.C. 102](#). However, a [35 U.S.C. 102](#) rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an “enabled disclosure;”
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

*See* subsections I-III below for more explanation of each circumstance.

## I. TO PROVE REFERENCE CONTAINS AN “ENABLED DISCLOSURE”

### *Extra References and Extrinsic Evidence Can Be Used To Show the Primary Reference Contains an “Enabled Disclosure”*

When the claimed composition or machine is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an “enabled disclosure.” *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) (Compound claims were rejected under [pre-AIA 35 U.S.C. 102\(b\)](#) over a publication in view of two patents. The publication disclosed the claimed compound structure while the patents taught methods of making compounds of that general class. The applicant argued that there was no motivation to combine the references because no utility was previously known for the compound and that the [35 U.S.C. 102](#) rejection over multiple references was improper. The court held that the publication taught all the elements of the claim and thus motivation to combine was not required. The patents were only submitted as evidence of what was in the public's possession before the invention.)

## II. TO EXPLAIN THE MEANING OF A TERM USED IN THE PRIMARY REFERENCE

### *Extra References or Other Evidence Can Be Used to Show Meaning of a Term Used in the Primary Reference*

Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Baxter Travenol Labs. invention was directed to a blood bag system incorporating a bag containing DEHP, an additive to the plastic which improved the bag's red blood cell storage capability. The examiner rejected the claims over a technical progress report by Becker which taught the same blood bag system but did not expressly disclose the presence of DEHP. The report, however, did disclose using commercial blood bags. It also disclosed the blood bag system as “very similar to [Baxter] Travenol's commercial two bag blood container.” Extrinsic evidence (depositions, declarations and

Baxter Travenol's own admissions) showed that commercial blood bags, at the time Becker's report was written, contained DEHP. Therefore, one of ordinary skill in the art would have known that “commercial blood bags” meant bags containing DEHP. The claims were thus held to be anticipated.)

In *Actelion Pharmaceuticals Ltd v. Mylan Pharmaceuticals Inc.*, 85 F.4th 1167, 1171-74, 2023 USPQ2d 1314 (Fed. Cir. 2023), the court reviewed the intrinsic evidence including the claims, specification, and prosecution history and held that the meaning of the claim term “a pH of 13 or higher” could not be determined without turning to extrinsic evidence. It was unclear from the claims whether “a pH of 13 or higher” “carries any meaning to a person of ordinary skill in the art as regards precision of measurement, significant digits, or rounding.” *Id.* at 1171-1172. The specification also was unclear about any desired level of precision for the term, inconsistently describing the level of specificity for a pH of 13. *Id.* at 1172-1173. Finally, the prosecution history also did not illuminate a level of precision and whether “pH of 13” encompassed values that round to 13, such as 12.5. *Id.* at 1173. The court therefore found that in this case extrinsic evidence should be consulted to understand “the meaning of a term in the relevant art during the relevant time period”. *Actelion*, 85 F.4th at 1174 (quoting *Teva Pharmaceuticals USA, Inc v. Sandoz, Inc.*, 574 U.S. 318, 331, 135 S. Ct. 831, 841, 113 USPQ2d 1269, 1276 (2015)).

## III. TO SHOW THAT A CHARACTERISTIC NOT DISCLOSED IN THE REFERENCE IS INHERENT

### *Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference*

“To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991) (The court went on to explain that



“this modest flexibility in the rule that ‘anticipation’ requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges.” 948 F.2d at 1268, 20 USPQ at 1749-50.). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was “sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree.” The Federal Circuit found that the emulsions described in both references would inevitably and inherently have “sufficient aeration” to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.). See also *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 139 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985). See [MPEP § 2112 - § 2112.02](#) for case law on inherency. Also note that the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See [MPEP § 2124](#).

## **2131.02 Genus-Species Situations [R-07.2022]**

### **I. A SPECIES WILL ANTICIPATE A CLAIM TO A GENUS**

“A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus.” The species in that case will anticipate the genus. *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (Gosteli claimed a genus of 21 specific

chemical species of bicyclic thia-aza compounds in Markush claims. The prior art reference applied against the claims disclosed two of the chemical species. The parties agreed that the prior art species would anticipate the claims unless applicant was entitled to his foreign priority date.).

### **II. A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED**

A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. See *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the *Merck Index*, saying that “the tenth edition of the *Merck Index* lists ten thousand compounds. In our view, each and every one of those compounds is ‘described’ as that term is used in [\[pre-AIA\] 35 U.S.C. 102\(a\)](#), in that publication.”). *Id.* at 1718. See also *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board’s finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and because the claim was anticipated, the unexpected properties were immaterial.).

### **III. A GENERIC DISCLOSURE WILL ANTICIPATE A CLAIMED SPECIES COVERED BY THAT DISCLOSURE WHEN THE SPECIES**



## CAN BE “AT ONCE ENVISAGED” FROM THE DISCLOSURE

“[W]hether a generic disclosure necessarily anticipates everything within the genus ... depends on the factual aspects of the specific disclosure and the particular products at issue.” *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1083, 89 USPQ2d 1370, 1375 (Fed. Cir. 2008). See also *Osrham Sylvania Inc. v. American Induction Tech. Inc.*, 701 F.3d 698, 706, 105 USPQ2d 1368, 1374 (Fed. Cir. 2012) (“how one of ordinary skill in the art would understand the relative size of a genus or species in a particular technology is of critical importance”).

A reference disclosure can anticipate a claim when the reference describes the limitations but “does not expressly spell out the limitations as arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381, 114 USPQ2d 1250, 1254 (Fed. Cir. 2015) (quoting *In re Petering*, 301 F.2d 676, 681 (CCPA 1962)). In *Kennametal*, the challenged claim was to a cutting tool requiring a ruthenium binding agent with a physical vapor deposition (PVD) coating. The reference described all the elements of the claimed coated cutting tool but did not explicitly disclose the specific combination of ruthenium binding agent with a PVD coating. However, the reference disclosed that ruthenium was one of five specified binding agents and PVD was one of three suitable coating techniques. The Federal Circuit stated that the reference’s “express ‘contemplat[ion]’ of PVD coatings provided sufficient evidence that a reasonable mind could find that a person of skill in the art... would immediately envisage applying a PVD coating. Thus, substantial evidence supports the Board’s conclusion that [the reference] effectively teaches 15 combinations, of which one anticipates pending claim 1. Though it is true that there is no evidence in [the reference] of ‘actual performance’ of combining the ruthenium binder and PVD coatings, this is not required.” *Kennametal*, 780 F.3d at 1383, 114 USPQ2d at 1255 (citations omitted). See also *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 1274, 122 USPQ2d 1116, 1120 (Fed. Cir. 2017) (“*Kennametal* does not stand for the proposition

that a reference missing a limitation can anticipate a claim if a skilled artisan viewing the reference would “at once envisage” the missing limitation. Rather, *Kennametal* addresses whether the disclosure of a limited number of combination possibilities discloses one of the possible combinations.”).

When a claimed compound is not specifically named in a reference, but instead it is necessary to select portions of teachings within the reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to “at once envisage” the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be “at once envisaged.” One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962).

In *In re Petering*, the prior art disclosed a generic chemical formula “wherein X, Y, Z, P, and R represent either hydrogen or alkyl radicals, R a side chain containing an OH group.” The court held that this formula, without more, could not anticipate a claim to 7-methyl-9-[d, l-riboityl]-isoalloxazine because the generic formula encompassed a vast number and perhaps even an infinite number of compounds. However, the reference also disclosed preferred substituents for X, Y, Z, P, R, and R as follows: where X, P, and R are hydrogen, where Y and Z may be hydrogen or methyl, and where R is one of eight specific isoalloxazines. The court determined that this more limited generic class consisted of about 20 compounds. The limited number of compounds covered by the preferred formula in combination with the fact that the number of substituents was low at each site, the ring positions were limited, and there was a large unchanging structural nucleus, resulted in a finding

that the reference sufficiently described “each of the various permutations here involved as fully as if he had drawn each structural formula or had written each name.” The claimed compound was 1 of these 20 compounds. Therefore, the reference “described” the claimed compound and the reference anticipated the claims.

In *In re Schauman*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), claims to a specific compound were anticipated because the prior art taught a generic formula embracing a limited number of compounds closely related to each other in structure and the properties possessed by the compound class of the prior art was that disclosed for the claimed compound. The broad generic formula seemed to describe an infinite number of compounds but claim 1 was limited to a structure with only one variable substituent R. This substituent was limited to low alkyl radicals. One of ordinary skill in the art would at once envisage the subject matter within claim 1 of the reference.

Compare *In re Meyer*, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979) (A reference disclosing “alkaline chlorine or bromine solution” embraces a large number of species and cannot be said to anticipate claims to “alkali metal hypochlorite.”); *Akzo N.V. v. International Trade Comm’n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) (Claims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.). See [MPEP § 2144.08](#) for a discussion of obviousness in genus-species situations.

### 2131.03 Anticipation of Ranges [R-01.2024]

#### I. A SPECIFIC EXAMPLE IN THE PRIOR ART WHICH IS WITHIN A CLAIMED RANGE ANTICIPATES THE RANGE

“[W]hen, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is ‘anticipated’ if *one* of them is in the prior art.”

*Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280

(CCPA 1962)) (emphasis in original) (Claims to titanium (Ti) alloy with 0.6-0.9% nickel (Ni) and 0.2-0.4% molybdenum (Mo) were held anticipated by a graph in a Russian article on Ti-Mo-Ni alloys because the graph contained an actual data point corresponding to a Ti alloy containing 0.25% Mo and 0.75% Ni and this composition was within the claimed range of compositions.). “If the prior art discloses a point within the claimed range, the prior art anticipates the claim.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 65 F.4th 679, 687, 2023 USPQ2d 448 (Fed. Cir. 2023).

#### II. PRIOR ART WHICH TEACHES A RANGE OVERLAPPING OR TOUCHING THE CLAIMED RANGE ANTICIPATES IF THE PRIOR ART RANGE DISCLOSES THE CLAIMED RANGE WITH “SUFFICIENT SPECIFICITY”

When the prior art discloses a range which touches or overlaps the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. If the claims are directed to a narrow range, and the reference teaches a broader range, other facts of the case, must be considered when determining whether the narrow range is disclosed with “sufficient specificity” to constitute an anticipation of the claims. Compare *ClearValue Inc. v. Pearl River Polymers Inc.*, 668 F.3d 1340, 101 USPQ2d 1773 (Fed. Cir. 2012) with *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006).

In *ClearValue*, the claim at issue was directed to a process of clarifying water with alkalinity below 50 ppm, whereas the prior art taught that the same process works for systems with alkalinity of 150 ppm or less. In holding the claim anticipated, the court observed that “there is no allegation of criticality or any evidence demonstrating any difference across the range.” *Id.* at 1345, 101 USPQ2d at 1777. In *Atofina*, the court held that a reference temperature range of 100-500 degrees C did not describe the claimed range of 330-450

degrees C with sufficient specificity to be anticipatory, even though there was a slight overlap between the reference's preferred range (150-350 degrees C) and the claimed range. "[T]he disclosure of a range is no more a disclosure of the end points of the range than it is each of the intermediate points." *Id.* at 1000, 78 USPQ2d at 1424. Patentee described claimed temperature range as "critical" to enable the process to operate effectively, and showed that one of ordinary skill would have expected the synthesis process to operate differently outside the claimed range.

If the prior art disclosure does not disclose a claimed range with "sufficient specificity" to anticipate a claimed invention, any evidence of unexpected results within the narrow range may render the claims nonobvious. See [MPEP § 716.02](#) *et seq.* The question of "sufficient specificity" is similar to that of "clearly envisaging" a species from a generic teaching. See [MPEP § 2131.02](#).

A [35 U.S.C. 102](#) and [103](#) combination rejection is permitted if it is unclear if the reference teaches the range with "sufficient specificity." The examiner must, in this case, provide reasons for anticipation as well as a reasoned statement regarding obviousness. *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993) (expanded Board). For a discussion of the obviousness of ranges see [MPEP § 2144.05](#).

### III. PRIOR ART WHICH TEACHES A VALUE OR RANGE THAT IS VERY CLOSE TO, BUT DOES NOT OVERLAP OR TOUCH, THE CLAIMED RANGE DOES NOT ANTICIPATE THE CLAIMED RANGE

"[A]nticipation under [§ 102](#) can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on [§ 103](#) which takes differences into account." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims to titanium (Ti) alloy with 0.8% nickel (Ni) and 0.3% molybdenum (Mo) were not anticipated by, although they were held obvious over, a graph in a Russian article on Ti-Mo-Ni alloys in which the graph

contained an actual data point corresponding to a Ti alloy containing 0.25% Mo and 0.75% Ni.).

### 2131.04 Secondary Considerations [R-08.2012]

Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to [35 U.S.C. 102](#) rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

### 2131.05 Nonanalogous or Disparaging Prior Art [R-08.2012]

"Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not 'germane' to a rejection under [section 102](#)." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (The question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.).

A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). See *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(claimed composition

that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient); see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of “sufficient aeration” even though reference taught away from air entrapment or purposeful aeration.).

## 2132 Pre-AIA 35 U.S.C. 102(a) [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152 et seq.](#) for a detailed discussion of [AIA 35 U.S.C. 102\(a\) and \(b\)](#).]*

### Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

\*\*\*\*\*

#### I. “KNOWN OR USED”

##### A. “Known or Used” Means Publicly Known or Used

“The statutory language ‘known or used by others in this country’ [[pre-AIA 35 U.S.C. 102\(a\)](#)], means knowledge or use which is accessible to the public.”

*Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). The knowledge or use is accessible to the public if there has been no deliberate attempt to keep it secret. *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

See [MPEP § 2128 - § 2128.02](#) for case law concerning public accessibility of publications.

##### B. Another’s Sale of a Product Made by a Secret Process Can Be a Pre-AIA 35 U.S.C. 102(a) Public Use if the Process Can Be Determined by Examining the Product

“The nonsecret use of a claimed process in the usual course of producing articles for commercial purposes is a public use.” But a secret use of the process coupled with the sale of the product does not result in a public use of the process unless the public could learn the claimed process by examining the product. Therefore, secret use of a process by another, even if the product is commercially sold, cannot result in a rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) if an examination of the product would not reveal the process. *Id.*

#### II. “IN THIS COUNTRY”

##### Only Knowledge or Use in the U.S. Can Be Used in a Pre-AIA 35 U.S.C. 102(a) Rejection

The knowledge or use relied on in a [pre-AIA 35 U.S.C. 102\(a\)](#) rejection must be knowledge or use “in this country.” Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under [pre-AIA 35 U.S.C. 102\(a\)](#). *In re Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). Note that the changes made to [pre-AIA 35 U.S.C. 104](#) by NAFTA (Public Law 103-182) and Uruguay Round Agreements Act (Public Law 103-465) do not modify the meaning of “in this country” as used in [pre-AIA 35 U.S.C. 102\(a\)](#) and thus “in this country” means in the United States only and does not include other WTO or NAFTA member countries for purposes of [pre-AIA 35 U.S.C. 102\(a\)](#) rejections.

#### III. “BY OTHERS”

##### “Others” Means Any Combination of Authors or Inventors Different From the Inventive Entity

The term “others” in [pre-AIA 35 U.S.C. 102\(a\)](#) refers to any entity which is different from the inventive entity. The entity need only differ by one person to be “by others.” This holds true for all types of references eligible as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#) including publications as well as public knowledge and use. Any other interpretation



of [pre-AIA 35 U.S.C. 102\(a\)](#) “would negate the one year [grace] period afforded under [§ 102\(b\)](#).” *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

#### IV. “PATENTED IN THIS OR A FOREIGN COUNTRY”

See [MPEP § 2126](#) for information on the use of secret patents as prior art.

### 2132.01 Overcoming a Pre-AIA 35 U.S.C. 102(a) Rejection based on a Printed Publication or Patent [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152 et seq.](#) for a detailed discussion of [AIA 35 U.S.C. 102\(a\) and \(b\)](#).*

“Derivation” or “derived” as used in the discussion below is in the context of pre-AIA law. “Derivation proceedings” as created in the AIA are discussed in [MPEP § 2310 et seq.](#)

In all applications, an applicant may overcome a [pre-AIA 35 U.S.C. 102](#) rejection by persuasively arguing that the claims are patentably distinguishable from the prior art, or by amending the claims to patentably distinguish over the prior art. Additional ways to overcome a rejection based on [pre-AIA 35 U.S.C. 102](#) prior art depend on the applicable paragraph of [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2133.02\(a\)](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(b\)](#) and [MPEP § 2136.05 et seq.](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(e\)](#).

A rejection based on [pre-AIA 35 U.S.C. 102\(a\)](#) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under [37 CFR 1.131\(a\)](#) showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming interfering subject matter as defined in [37 CFR 41.203\(a\)](#) (subject matter of a claim of one party that would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa). See [MPEP § 715](#) for information on the requirements of [37 CFR 1.131\(a\)](#) affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under [37 CFR 1.131\(a\)](#) is not appropriate to overcome the rejection;

(D) Filing an affidavit or declaration under [37 CFR 1.132](#) showing that the reference invention is not by “another,” i.e., showing a reference’s disclosure was derived from the inventor’s or at least one joint inventor’s own work. See [MPEP §§ 715.01\(a\), 715.01\(c\), and 716.10](#);

(E) Submitting and perfecting a claim to priority under [35 U.S.C. 119\(a\) - \(d\)](#). See [MPEP § 216](#);

(F) Submitting and perfecting a benefit claim under [35 U.S.C. 119\(e\)](#) or [120](#). See [MPEP § 211 et seq.](#) for detailed information pertaining to benefit claims.

#### I. SHOWING REFERENCE’S DISCLOSURE WAS DERIVED FROM INVENTOR’S OR AT LEAST ONE JOINT INVENTOR’S OWN WORK

A *prima facie* case is made out under [pre-AIA 35 U.S.C. 102\(a\)](#) if, within 1 year of the filing date, the invention, or an obvious variant thereof, is described in a “printed publication” whose authorship differs in any way from the inventive entity unless it is stated within the publication itself that the publication is describing the inventor’s or at least one joint inventor’s work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See [MPEP § 2128](#) for case law on what constitutes a “printed publication.” Note that when the reference is a U.S. patent, U.S. patent application publication, or certain international application publication published within the year prior to the application filing date, a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection should be made. See [MPEP § 2136 - § 2136.05](#) for case law dealing with [pre-AIA 35 U.S.C. 102\(e\)](#).



An inventor's or at least one joint inventor's disclosure of his or her own work within the year before the application filing date cannot be used against the application as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982) (discussed below). Therefore, where the inventor or at least one joint inventor is one of the co-authors of a publication cited against the application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, the inventor or at least one joint inventor. Such affidavits are called disclaiming affidavits. *Ex parte Hirschler*, 110 USPQ 384 (Bd. App. 1952). The rejection can also be overcome by submission of a specific declaration by the inventor or at least one joint inventor establishing that the article is describing the inventor's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). However, an affidavit or declaration under [37 CFR 1.132](#) that is only a naked assertion of inventorship and that fails to provide any context, explanation or evidence to support that assertion is insufficient to show that the relied-upon subject matter was the inventor's own work. See *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017) (finding that a declaration submitted by inventor Campbell insufficient to establish that he and Guth (now deceased) were the inventors of the subject matter disclosed in a patent naming Campbell, Guth, Danziger, and Padron as inventors because “[n]othing in the declaration itself, or in addition to the declaration, provides any context, explanation, or evidence to lend credence to the inventor's bare assertion” and more than twenty years had passed since the alleged events occurred. *Id.* at 1345; 123 USPQ2d at 1149). However, if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, the inventor's affidavit or declaration will not be enough to establish that the inventor or the at least one joint inventor is the sole inventor of the subject matter in the article and the rejection will stand. *Ex parte Kroger*, 219 USPQ 370 (Bd. App. 1982) (discussed below). It is also possible to overcome the rejection by adding the coauthors as joint inventors to the application if the requirements of [35 U.S.C. 116](#),

third paragraph, are met. *In re Searles*, 422 F.2d 431, 164 USPQ 623 (CCPA 1970).

In *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), Katz stated in a declaration that the coauthors of the publication, Chiorazzi and Eshhar, “were students working under the direction and supervision of the inventor, Dr. David H. Katz.” The court held that this declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work described in the publication was his own. In research papers, students involved only with assay and testing are normally listed as coauthors but are not considered joint inventors.

In *Ex parte Kroger*, 219 USPQ 370 (Bd. App. 1982), Kroger, Knaster and others were listed as authors on an article on photovoltaic power generation. The article was used to reject the claims of an application listing Kroger and Rod as joint inventors. Kroger and Rod submitted affidavits declaring themselves to be the joint inventors. The affidavits also stated that Knaster merely carried out assignments and worked under the supervision and direction of Kroger. The Board stated that if this were the only evidence in the case, it would be established, under *In re Katz*, that Kroger and Rod were the only joint inventors. However, in this case, there was evidence that Knaster had refused to sign an affidavit disclaiming inventorship and Knaster had introduced evidence into the case in the form of a letter to the USPTO in which he alleged that he was a joint inventor. The Board held that the evidence had not been fully developed enough to overcome the rejection. Note that the rejection had been made under [pre-AIA 35 U.S.C. 102\(f\)](#) but the Board treated the issue the same as if it had arisen under [pre-AIA 35 U.S.C. 102\(a\)](#). See also case law dealing with overcoming [pre-AIA 35 U.S.C. 102\(e\)](#) rejections as presented in [MPEP § 2136.05](#). Many of the issues are the same.

## **II. A 37 CFR 1.131 AFFIDAVIT CAN BE USED TO OVERCOME A PRE-AIA 35 U.S.C. 102(a) REJECTION**

When the reference is not a statutory bar under [pre-AIA 35 U.S.C. 102\(b\), \(c\), or \(d\)](#), applicant can overcome the rejection by swearing back of the

reference through the submission of an affidavit under [37 CFR 1.131](#). *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). If the reference is disclosing the inventor's or at least one joint inventor's own work as derived from the inventor or joint inventor, either a [37 CFR 1.131](#) affidavit to antedate the reference or a [37 CFR 1.132](#) affidavit to show derivation of the reference subject matter from the inventor or joint inventor and invention by the inventor or joint inventor may be submitted. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969). See [MPEP § 715](#) for more information on when an affidavit under [37 CFR 1.131](#) can be used to overcome a reference and what evidence is required.

### 2133 Pre-AIA 35 U.S.C. 102(b) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152](#) et seq. for a detailed discussion of [AIA 35 U.S.C. 102\(a\) and \(b\)](#).]*

#### Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

\*\*\*\*\*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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### I. THE 1-YEAR GRACE PERIOD IS EXTENDED TO THE NEXT BUSINESS DAY IF IT WOULD OTHERWISE END ON A HOLIDAY OR WEEKEND

Publications, patents, public uses and sales must occur “more than one year prior to the date of application for patent in the United States” in order to bar a patent under [pre-AIA 35 U.S.C. 102\(b\)](#). However, publications, patents, public uses and sales will not bar a patent if the 1-year grace period otherwise ends on a Saturday, Sunday, or federal

holiday and the application’s U.S. filing date is the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) and [35 U.S.C. 21\(b\)](#). The provisions of [35 U.S.C. 21\(b\)](#) still apply notwithstanding the provisions of [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which accord a filing date as of the date of deposit as Priority Mail Express® with the U.S. Postal Service and [37 CFR 1.6\(a\)\(4\)](#), which accords a filing date as of the date of submission using the USPTO patent electronic filing system.

### II. THE 1-YEAR TIME BAR IS MEASURED FROM THE U.S. FILING DATE

If one discloses one's own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. *In re Katz*, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. In addition, the prior art need not be identical to the claimed invention but will bar patentability if it is an obvious variant thereof. *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1966). See [MPEP § 2139.01](#) regarding the effective U.S. filing date of a claimed invention in an application.

### 2133.01 Rejections of Continuation-In-Part (CIP) Applications [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152](#) et seq. for a detailed discussion of [AIA 35 U.S.C. 102\(a\) and \(b\)](#).]*

The effective filing date of a claimed invention is determined on a claim-by-claim basis and not an application-by-application basis. See [MPEP §](#)

[2139.01](#) for guidance in determining the effective filing date of a claimed invention under [pre-AIA 35 U.S.C. 102](#).

When applicant files a continuation-in-part application, none of whose claims are supported by the parent application under [pre-AIA 35 U.S.C. 112](#), first paragraph, the effective filing date is the filing date of the child CIP. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under [pre-AIA 35 U.S.C. 102\(b\)](#). *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

Any claim that only contains subject matter that is fully supported in compliance with the statutory requirements of [pre-AIA 35 U.S.C. 112](#), first paragraph, by the parent application of a CIP will have the effective filing date of the parent application. On the other hand, any claim that contains a limitation that is only supported as required by [pre-AIA 35 U.S.C. 112](#), first paragraph, by the disclosure of the CIP application will have the effective filing date of the CIP application. See, e.g., *Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 104 USPQ2d 1641 (Fed. Cir. 2012)(patent issuing from parent application was relied upon as prior art against the claims in CIPs that did not find support in the parent application); *Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674 (Fed. Cir. 1997)(“To qualify for an earlier filing date, section 120 requires, *inter alia*, that the earlier-filed U.S. patent application contain a disclosure which complies with [35 U.S.C. § 112](#), p 1 (1994) for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter adequately described in an earlier application, and does not extend to claims with subject matter outside the description in the earlier application.”).

## 2133.02 Rejections Based on Publications and Patents [R-11.2013]

*[Editor Note: This MPEP section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et](#)*

*seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152 et seq.](#) for a detailed discussion of [AIA 35 U.S.C. 102\(a\) and \(b\)](#).]*

### I. APPLICANT’S OWN WORK WHICH WAS AVAILABLE TO THE PUBLIC BEFORE THE GRACE PERIOD MAY BE USED IN A PRE-AIA 35 U.S.C. 102(b) REJECTION

“Any invention described in a printed publication more than one year prior to the date of a patent application is prior art under [Section 102\(b\)](#), even if the printed publication was authored by the patent applicant.” *De Graffenried v. United States*, 16 USPQ2d 1321, 1330 n.7 (Cl. Ct. 1990). “Once an inventor has decided to lift the veil of secrecy from his [or her] work, he [or she] must choose between the protection of a federal patent, or the dedication of his [or her] idea to the public at large.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 9 USPQ2d 1847, 1851 (1989).

### II. A PRE-AIA 35 U.S.C. 102(b) REJECTION CREATES A STATUTORY BAR TO PATENTABILITY OF THE REJECTED CLAIMS

A rejection under [pre-AIA 35 U.S.C. 102\(b\)](#) cannot be overcome by affidavits and declarations under [37 CFR 1.131](#) (Rule 131 Declarations), foreign priority dates, or evidence that applicant himself invented the subject matter. Outside the 1-year grace period, applicant is barred from obtaining a patent containing any anticipated or obvious claims. *In re Foster*, 343 F.2d 980, 984, 145 USPQ 166, 170 (CCPA 1965).

### 2133.02(a) Overcoming a Pre-AIA 35 U.S.C. 102(b) Rejection Based on a Printed Publication or Patent [R-10.2019]

In all applications, an applicant may overcome a [pre-AIA 35 U.S.C. 102](#) rejection by persuasively arguing that the claims are patentably distinguishable from the prior art, or by amending the claims to patentably distinguish over the prior art. Additional ways available to overcome a rejection based on [pre-AIA 35 U.S.C. 102](#) prior art depend on the

applicable paragraph of [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2132.01](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) and [MPEP § 2136.05 et seq.](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(e\)](#).

A rejection based on [pre-AIA 35 U.S.C. 102\(b\)](#) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Submitting and perfecting a benefit claim under [35 U.S.C. 120](#), within the time period set in [37 CFR 1.78](#) (or by filing a grantable petition to accept an unintentionally delayed claim under [37 CFR 1.78](#) as explained in [MPEP § 211.04](#)):

(1)

(a) for applications filed on or after September 16, 2012, by filing a corrected application data sheet under [37 CFR 1.76](#) which contains a specific reference to a prior application in accordance with [37 CFR 1.78](#), or

(b) for applications filed prior to September 16, 2012, by amending the specification of the application to contain a specific reference to a prior application or by filing a corrected application data sheet under [37 CFR 1.76](#) which contains a specific reference to a prior application in accordance with [37 CFR 1.78](#), and

(2) by establishing that the prior application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#) (for applications filed on or after September 16, 2012), or [35 U.S.C. 112](#), first paragraph (for applications filed prior to September 16, 2012). See [MPEP § 211 et seq.](#); or

(D) Submitting and perfecting a benefit claim under [35 U.S.C. 119\(e\)](#) by complying with the requirements of [37 CFR 1.78](#) or filing a grantable petition to accept an unintentionally delayed claim under [37 CFR 1.78](#) (see item (C) above). Because a provisional application could not have been filed more than one year prior to the filing of a nonprovisional application that claims benefit to the provisional application, once the benefit claim under

[35 U.S.C. 119\(e\)](#) is perfected, the rejection must be reconsidered to determine whether the prior art still qualifies as prior art under [pre-AIA 35 U.S.C. 102\(b\)](#) or whether the prior art qualifies as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#). Note, however, effective December 18, 2013, title II of the Patent Law Treaties Implementation Act (PLTIA) provides for restoration of the right to claim benefit of a provisional application filed after the expiration of the twelve-month period in [35 U.S.C. 119\(e\)](#). See [MPEP § 211.01\(a\)](#), subsection II. If the prior art qualifies as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#), see [MPEP § 2132.01](#) as to how to overcome the [pre-AIA 35 U.S.C. 102\(a\)](#) rejection.

### **2133.03 Rejections Based on “Public Use” or “On Sale” [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102](#). Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

An applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was sold by applicant or known by others. If the activity is by an entity other than the inventors, one or more joint inventors, or the assignee, such as sale by another, manufacture by another or disclosure of the invention by the inventor, one or more joint inventors, or the assignee to another then both [pre-AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#) may be applicable. If the evidence only points to knowledge within the year prior to the effective filing date then [pre-AIA 35 U.S.C.](#)



[102\(a\)](#) applies. However, no rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) should be made if there is evidence that inventor made the invention and only disclosed it to others within the year prior to the effective filing date. [Pre-AIA 35 U.S.C. 102\(b\)](#) is applicable if the activity occurred more than 1 year prior to the effective filing date of a claimed invention in the application.

[Pre-AIA 35 U.S.C. 102\(b\)](#) “contains several distinct bars to patentability, each of which relates to activity or disclosure more than one year prior to the date of the application. Two of these - the ‘public use’ and the ‘on sale’ objections - are sometimes considered together although it is quite clear that either may apply when the other does not.” *Dart Indus. v. E.I. du Pont de Nemours & Co.*, 489 F.2d 1359, 1365, 179 USPQ 392, 396 (7th Cir. 1973). There may be a public use of an invention absent any sales activity. Likewise, there may be a nonpublic, e.g., “secret,” sale or offer to sell an invention which nevertheless constitutes a statutory bar. *Hobbs v. United States*, 451 F.2d 849, 859-60, 171 USPQ 713, 720 (5th Cir. 1971). It is noted that [AIA 35 U.S.C. 102\(a\)\(1\)](#) uses the same “on sale” term as [pre-AIA 35 U.S.C. 102\(b\)](#) and is treated as having the same meaning. *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S.Ct. 628, 129 USPQ2d 1189 (2019). See [MPEP § 2152.02\(d\)](#).

In similar fashion, not all “public use” and “on sale” activities will necessarily occasion the identical result. Although both activities affect how an inventor may use an invention prior to the filing of a patent application, “non-commercial” [pre-AIA 35 U.S.C. 102\(b\)](#) activity may not be viewed the same as similar “commercial” activity. See [MPEP § 2133.03\(a\)](#) and [§ 2133.03\(e\)\(1\)](#). Likewise, “public use” activity by an applicant may not be considered in the same light as similar “public use” activity by one other than an applicant. See [MPEP § 2133.03\(a\)](#) and [§ 2133.03\(e\)\(7\)](#). Additionally, the concept of “experimental use” may have different significance in “commercial” and “non-commercial” environments. See [MPEP § 2133.03\(c\)](#) and [§ 2133.03\(e\) - § 2133.03\(e\)\(6\)](#).

It should be noted that [pre-AIA 35 U.S.C. 102\(b\)](#) may create a bar to patentability either alone, if the device in public use or placed on sale anticipates a

later claimed invention, or in conjunction with [35 U.S.C. 103](#), if the claimed invention would have been obvious from the device in conjunction with the prior art. *LaBounty Mfg. v. United States Int’l Trade Comm’n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992).

## POLICY CONSIDERATIONS

(A) “One policy underlying the [on-sale] bar is to obtain widespread disclosure of new inventions to the public via patents as soon as possible.” *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1062, 12 USPQ2d 1449, 1454 (Fed. Cir. 1989).

(B) Another policy underlying the public use and on-sale bars is to prevent the inventor from commercially exploiting the exclusivity of the invention substantially beyond the statutorily authorized period. *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1062, 12 USPQ2d 1449, 1454 (Fed. Cir. 1989). See [MPEP § 2133.03\(e\)\(1\)](#).

(C) Another underlying policy for the public use and on-sale bars is to discourage “the removal of inventions from the public domain which the public justifiably comes to believe are freely available.” *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549, 16 USPQ2d 1587, 1591 (Fed. Cir. 1990).

## 2133.03(a) “Public Use” [R-07.2022]

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note) . See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2150 et seq. for examination of applications subject to those provisions. See MPEP § 2152.02(c) through (e) for a detailed discussion of the public use and on sale provisions of AIA 35 U.S.C. 102.]*

### I. TEST FOR “PUBLIC USE”

The public use bar under [pre-AIA 35 U.S.C. 102\(b\)](#) arises where the invention is in public use before the critical date and is ready for patenting. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 76 USPQ2d 1741 (Fed. Cir. 2005). As explained by the court,



The proper test for the public use prong of the [\[pre-AIA\] § 102\(b\)](#) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Commercial exploitation is a clear indication of public use, but it likely requires more than, for example, a secret offer for sale. Thus, the test for the public use prong includes the consideration of evidence relevant to experimentation, as well as, *inter alia*, the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation.... That evidence is relevant to discern whether the use was a public use that could raise a bar to patentability, but it is distinct from evidence relevant to the ready for patenting component of *Pfaff*'s two-part test, another necessary requirement of a public use bar.

*Id.* at 1380, 76 USPQ2d at 1744 (citations omitted). See [MPEP § 2133.03\(c\)](#) for a discussion of the “ready for patenting” prong of the public use and on sale statutory bars.

“[T]o constitute the public use of an invention it is not necessary that more than one of the patent articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well defined case of such use is just as effectual to annul the patent as many.” Likewise, it is not necessary that more than one person use the invention. *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

## II. PUBLIC KNOWLEDGE IS NOT NECESSARILY PUBLIC USE UNDER PRE-AIA 35 U.S.C. 102(b)

Mere knowledge of the invention by the public does not warrant rejection under [pre-AIA 35 U.S.C. 102\(b\)](#). [Pre-AIA 35 U.S.C. 102\(b\)](#) bars public use or sale, not public knowledge. *TP Labs., Inc. v. Professional Positioners, Inc.*, 724 F.2d 965, 970, 220 USPQ 577, 581 (Fed. Cir. 1984).

Note, however, that public knowledge may provide grounds for rejection under [pre-AIA 35 U.S.C. 102\(a\)](#). See [MPEP § 2132](#).

### A. Commercial Versus Noncommercial Use and the Impact of Secrecy

There are limited circumstances in which a secret or confidential use of an invention may give rise to the public use bar. “[S]ecrecy of use alone is not sufficient to show that existing knowledge has not been withdrawn from public use; commercial exploitation is also forbidden.” *Invitrogen*, 424 F.3d at 1382, 76 USPQ2d at 1745-46 (The fact that patentee secretly used the claimed invention internally before the critical date to develop future products that were never sold was by itself insufficient to create a public use bar to patentability.).

#### 1. “Public Use” and “Non-secret Use” Are Not Necessarily Synonymous

“Public” is not necessarily synonymous with “non-secret.” The fact “that non-secret uses of the device were made [by the inventor or someone connected with the inventor] prior to the critical date is not itself dispositive of the issue of whether activity barring a patent under [pre-AIA 35 U.S.C. 102\(b\)](#) occurred. The fact that the device was not hidden from view may make the use not secret, but nonsecret use is not *ipso facto* ‘public use’ activity. Nor, it must be added, is all secret use *ipso facto* not ‘public use’ within the meaning of the statute,” if the inventor is making commercial use of the invention under circumstances which preserve its secrecy. *TP Labs., Inc. v. Professional Positioners, Inc.*, 724 F.2d 965, 972, 220 USPQ 577, 583 (Fed. Cir. 1983) (citations omitted).

#### 2. Even If the Invention Is Hidden, Inventor Who Puts Machine or Article Embodying the Invention in Public View Is Barred from Obtaining a Patent as the Invention Is in Public Use

When the inventor or someone connected to the inventor puts the invention on display or sells it, there is a “public use” within the meaning of [pre-AIA 35 U.S.C. 102\(b\)](#) even though by its very nature an invention is completely hidden from view as part of a larger machine or article, if the invention is otherwise used in its natural and intended way and the larger machine or article is accessible to the public. *In re Blaisdell*, 242 F.2d 779, 783, 113 USPQ 289, 292 (CCPA 1957); *Hall v. Macneale*,

107 U.S. 90, 96-97 (1882); *Ex parte Kuklo*, 25 USPQ2d 1387, 1390 (Bd. Pat. App. & Inter. 1992) (Display of equipment including the structural features of the claimed invention to visitors of laboratory is public use even though public did not see inner workings of device. The person to whom the invention is publicly disclosed need not understand the significance and technical complexities of the invention.).

### **3. There Is No Public Use If Inventor Restricted Use to Locations Where There Was a Reasonable Expectation of Privacy and the Use Was for His or Her Own Enjoyment**

An inventor's private use of the invention, for his or her own enjoyment is not a public use. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986) (Inventor showed inventive puzzle to close friends while in his dorm room and later the president of the company at which he was working saw the puzzle on the inventor's desk and they discussed it. Court held that the inventor retained control and thus these actions did not result in a "public use.").

### **4. The Presence or Absence of a Confidentiality Agreement is Not Dispositive of the Public Use Issue**

"The presence or absence of a confidentiality agreement is not dispositive of the public use issue, but 'is one factor to be considered in assessing all the evidence.'" *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1380-81, 72 USPQ2d 1901, 1909 (Fed. Cir. 2004) (quoting *Moleculon Research Corp. v. CBS Inc.*, 793 F.2d 1261, 1266, 229 USPQ 805, 808 (Fed. Cir. 1986)). The court stressed that it is necessary to analyze the evidence of public use in the context of policies that underlie the public use and on sale bar that include "discouraging removal of inventions from the public domain that the public justifiably believes are freely available, prohibiting an extension of the period for exploiting an invention, and favoring prompt and widespread disclosure of inventions.'" *Bernhardt*, 386 F.3d at 1381, 72 USPQ2d at 1909. See also *Invitrogen*, 424 F.3d at 1379, 76 USPQ2d at 1744; [MPEP § 2133.03](#), subsection I. Evidence that the court emphasized included the "nature of the activity that occurred in public; the public access to

and knowledge of the public use; [and] whether there were any confidentiality obligations imposed on persons who observed the use.'" *Bernhardt*, 386 F.3d at 1381, 72 USPQ2d at 1909. For example, the court in *Bernhardt* noted that an exhibition display at issue in the case "was not open to the public, that the identification of attendees was checked against a list of authorized names by building security and later at a reception desk near the showroom, that attendees were escorted through the showroom, and that the attendees were not permitted to make written notes or take photographs inside the showroom."

*Id.* The court remanded the issue of whether the exhibition display was a public use for further proceedings since the district court "focused on the absence of any confidentiality agreements and did not discuss or analyze how the totality of the circumstances surrounding" the exhibition "comports with the policies underlying the public use bar." *Id.*

### **B. Use by Third Parties Deriving the Invention from Applicant**

#### **An Invention Is in Public Use If the Inventor Allows Another To Use the Invention Without Restriction or Obligation of Secrecy**

"Public use" of a claimed invention under [pre-AIA 35 U.S.C. 102\(b\)](#) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor." *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). The presence or absence of a confidentiality agreement is not itself determinative of the public use issue, but is one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986). See *Ex parte C*, 27 USPQ2d 1492, 1499 (Bd. Pat. App. & Inter. 1992) (Inventor sold inventive soybean seeds to growers who contracted and were paid to plant the seeds to increase stock for later sale. The commercial nature of the use of the seed coupled with the "on-sale" aspects of the contract and apparent lack of confidentiality requirements rose to the level of a "public use" bar.); *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881) (Public use found where inventor allowed another to use

inventive corset insert, though hidden from view during use, because he did not impose an obligation of secrecy or restrictions on its use.).

### C. Use by Independent Third Parties

#### Use by an Independent Third Party Is Public Use If It Sufficiently “Informs” the Public of the Invention or a Competitor Could Reasonably Ascertain the Invention

Any “nonsecret” use of an invention by someone unconnected to the inventor, such as someone who has independently made the invention, in the ordinary course of a business for trade or profit may be a “public use,” *Bird Provision Co. v. Owens Country Sausage, Inc.*, 568 F.2d 369, 374-76, 197 USPQ 134, 138-40 (5th Cir. 1978). Additionally, even a “secret” use by another inventor of a machine or process to make a product is “public” if the details of the machine or process are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 114 F.2d 28, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings, Ltd. v. Ram Golf Corp.*, 524 F.2d 33, 36-7, 188 USPQ 481, 483-484 (7th Cir. 1975). If the details of an inventive process are not ascertainable from the product sold or displayed and the third party has kept the invention as a trade secret then that use is not a public use and will not bar a patent issuing to someone unconnected to the user. *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 310 (Fed. Cir. 1983). However, a device qualifies as prior art if it places the claimed features in the public's possession before the critical date even if other unclaimed aspects of the device were not publicly available. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1505, 1570-71, 41 USPQ2d 1961, 1964-65 (Fed. Cir. 1997) (Computer reservation system was prior art even though “essential algorithms of the SABRE software were proprietary and confidential and...those aspects of the system that were readily apparent to the public would not have been sufficient to enable one skilled in the art to duplicate the [unclaimed aspects of the] system.”). The extent that the public becomes “informed” of an invention involved in public use activity by one other than an inventor depends upon the factual circumstances surrounding the activity and how these comport with the policies underlying

the on sale and public use bars. *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549, 16 USPQ2d 1587, 1591 (Fed. Cir. 1990) (quoting *King Instrument Corp. v. Otari Corp.*, 767 F.2d 833, 860, 226 USPQ 402, 406 (Fed. Cir. 1985)). By way of example, in an allegedly “secret” use by a third party other than an inventor, if a large number of employees of such a party, who are not under a promise of secrecy, are permitted unimpeded access to an invention, with affirmative steps by the party to educate other employees as to the nature of the invention, the public is “informed.” *Chemithon Corp. v. Proctor & Gamble Co.*, 287 F. Supp. 291, 308, 159 USPQ 139, 154 (D.Md. 1968), *aff'd.*, 427 F.2d 893, 165 USPQ 678 (4th Cir. 1970).

Even if public use activity by one other than an inventor is not sufficiently “informing,” there may be adequate grounds upon which to base a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#) and [pre-AIA 35 U.S.C. 102\(g\)](#). See *Dunlop Holdings Ltd. v. Ram Golf Corp.*, 524 F.2d 33, 188 USPQ 481 (7th Cir. 1975). See [MPEP § 2137](#) and [§ 2138](#).

### 2133.03(b) “On Sale” [R-07.2022]

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). [AIA 35 U.S.C. 102\(a\)\(1\)](#) uses the same “on sale” term as [pre-AIA 35 U.S.C. 102\(b\)](#) and is treated as having the same meaning. *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S.Ct. 628 (2019). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102](#).]*

An impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the claimed invention and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed.

Cir. 1995). The on-sale bar of [pre-AIA 35 U.S.C. 102\(b\)](#) is triggered if the invention is both (1) the subject of a commercial offer for sale not primarily for experimental purposes and (2) ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998). Traditional contract law principles are applied when determining whether a commercial offer for sale has occurred. See *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1048, 61 USPQ2d 1225, 1229 (Fed. Cir. 2001), *petition for cert. filed*, 71 USLW 3093 (July 03, 2002) (No. 02-39); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1047, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001) (“As a general proposition, we will look to the Uniform Commercial Code (‘UCC’) to define whether ... a communication or series of communications rises to the level of a commercial offer for sale.”).

## I. THE MEANING OF “SALE”

A sale is a contract between parties wherein the seller agrees “to give and to pass rights of property” in return for the buyer’s payment or promise “to pay the seller for the things bought or sold.” *In re Caveney*, 761 F.2d 671, 676, 226 USPQ 1, 4 (Fed. Cir. 1985). A contract for the sale of goods requires a concrete offer and acceptance of that offer. See, e.g., *Linear Tech.*, 275 F.3d at 1052-54, 61 USPQ2d at 1233-34 (Court held there was no sale within the meaning of [pre-AIA 35 U.S.C. 102\(b\)](#) where prospective purchaser submitted an order for goods at issue, but received an order acknowledgement reading “will advise-not booked.” Prospective purchaser would understand that order was not accepted.).

“[T]o be ‘on sale’ under [\[pre-AIA\] § 102\(b\)](#), a product must be the subject of a commercial sale or offer for sale,” and to be a commercial sale it must be “one that bears the general hallmarks of a sale pursuant to Section 2-106 of the Uniform Commercial Code.” *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1364, 119 USPQ2d 1329, 1330 (Fed. Cir. 2016) (*en banc*). The court in *Medicines Co.* went on to explain “[s]ection 2-106(1) of the Uniform Commercial Code describes a ‘sale’ as ‘the passing of title from the seller to the buyer for a price.’ U.C.C. § 2-106(1). The passage of title is a helpful indicator of whether a product is ‘on sale,’

as it suggests when the inventor gives up its interest and control over the product.” *Id.* at 1375, 119 USPQ2d at 1338. The *Medicines Co.* court held “a contract manufacturer’s sale to the inventor of manufacturing services where neither title to the embodiments nor the right to market the same passes to the supplier does not constitute an invalidating sale under [§ 102\(b\)](#).” *Id.* at 1381, 119 USPQ2d at 1342.

### A. Conditional Sale May Bar a Patent

An invention may be deemed to be “on sale” even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).

### B. Nonprofit Sale May Bar a Patent

A “sale” need not be for profit to bar a patent. If the sale was for the commercial exploitation of the invention, it is “on sale” within the meaning of [pre-AIA 35 U.S.C. 102\(b\)](#). *In re Dybel*, 524 F.2d 1393, 1401, 187 USPQ 593, 599 (CCPA 1975) (“Although selling the devices for a profit would have demonstrated the purpose of commercial exploitation, the fact that appellant realized no profit from the sales does not demonstrate the contrary.”).

### C. A Single Sale or Offer To Sell May Bar a Patent

Even a single sale or offer to sell the invention may bar patentability under [pre-AIA 35 U.S.C. 102\(b\)](#). *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92, 94 (1876); *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 836-37, 23 USPQ2d 1481, 1483 (Fed. Cir. 1992).

### D. A Sale of Rights Is Not a Sale of the Invention and Will Not in Itself Bar a Patent

“[A]n assignment or sale of the rights in the invention and potential patent rights is not a sale of ‘the invention’ within the meaning of [\[pre-AIA\] section 102\(b\)](#).” *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1267, 229 USPQ 805, 809 (Fed. Cir. 1986); see also *Elan Corp., PLC v. Andrx*



*Pharms. Inc.*, 366 F.3d 1336, 1341, 70 USPQ2d 1722, 1728 (Fed. Cir. 2004); *In re Kollar*, 286 F.3d 1326, 1330 n.3, 1330-1331, 62 USPQ2d 1425, 1428 n.3, 1428-1429 (Fed. Cir. 2002) (distinguishing licenses which trigger the on-sale bar (e.g., a standard computer software license wherein the product is just as immediately transferred to the licensee as if it were sold), from licenses that merely grant rights to an invention which do not *per se* trigger the on-sale bar (e.g., exclusive rights to market the invention or potential patent rights)); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1049 n. 2, 59 USPQ2d 1121, 1129 n. 2 (Fed. Cir. 2001).

“[T]he mere sale of manufacturing services by a contract manufacturer to an inventor to create embodiments of a patented product for the inventor does not constitute a ‘commercial sale’ of the invention.” *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1373, 119 USPQ2d 1329, 1336 (Fed. Cir. 2016) (*en banc*). The court in *Medicines Co.* further stated that “commercial benefit—even to both parties in a transaction—is not enough to trigger the on-sale bar of [§ 102\(b\)](#); the transaction must be one in which the product is ‘on sale’ in the sense that it is ‘commercially marketed.’” *Id.* at 1373-74, 119 USPQ2d at 1336-37.

#### ***E. Buyer Must Be Uncontrolled by the Seller or Offerer***

A sale or offer for sale must take place between separate entities. *In re Caveney*, 761 F.2d 671, 676, 226 USPQ 1, 4 (Fed. Cir. 1985). Where the parties to the alleged sale are related, whether there is a statutory bar under [pre-AIA 35 U.S.C. 102\(b\)](#) depends on whether the seller so controls the purchaser that the invention remains out of the public’s hands. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1566, 33 USPQ2d 1512, 1515 (Fed. Cir. 1995) (Where the seller is a parent company of the buyer company, but the President of the buyer company had “essentially unfettered” management authority over the operations of the buyer company, the sale was a statutory bar.).

## **II. OFFERS FOR SALE**

“Only an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under [\[pre-AIA\] §102\(b\)](#).” *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1048, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001).

#### ***A. Rejected or Unreceived Offer for Sale Is Enough To Bar a Patent***

Since the statute creates a bar when an invention is placed “on sale,” a mere offer to sell is sufficient commercial activity to bar a patent. *In re Theis*, 610 F.2d 786, 791, 204 USPQ 188, 192 (CCPA 1979). Even a rejected offer may create an on sale bar. *UMC Elecs. v. United States*, 816 F.2d 647, 653, 2 USPQ2d 1465, 1469 (Fed. Cir. 1987). In fact, the offer need not even be actually received by a prospective purchaser. *Wende v. Horine*, 225 F. 501 (7th Cir. 1915).

#### ***B. Delivery of the Offered Item Is Not Required***

“It is not necessary that a sale be consummated for the bar to operate.” *Buildex v. Kason Indus., Inc.*, 849 F.2d 1461, 1463-64, 7 USPQ2d 1325, 1327-28 (Fed. Cir. 1988) (citations omitted). See also *Weatherchem Corp. v. J.L. Clark, Inc.*, 163 F.3d 1326, 1333, 49 USPQ2d 1001, 1006-07 (Fed. Cir. 1998) (A signed purchase agreement prior to the critical date constituted a commercial offer; it was immaterial that there was no delivery of later patented caps and no exchange of money until after critical date.).

#### ***C. Seller Need Not Have the Goods “On Hand” When the Offer for Sale Is Made***

Goods need not be “on hand” and transferred at the time of the sale or offer. The date of the offer for sale is the effective date of the “on sale” activity. *J. A. La Porte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577, 1582, 229 USPQ 435, 438 (Fed. Cir. 1986). However, the invention must be complete and “ready for patenting” (see [MPEP § 2133.03\(c\)](#)) before the critical date. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1647 (1998). See also *Micro*



*Chemical, Inc. v. Great Plains Chemical Co.*, 103 F.3d 1538, 1545, 41 USPQ2d 1238, 1243 (Fed. Cir. 1997) (The on-sale bar was not triggered by an offer to sell because the inventor “was not close to completion of the invention at the time of the alleged offer and had not demonstrated a high likelihood that the invention would work for its intended purpose upon completion.”); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985) (Where there was no evidence that the samples shown to the potential customers were made by the new process and apparatus, the offer to sell did not rise to the level of an on sale bar.). Compare *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 221 USPQ 561 (Fed. Cir. 1984) (Where a “make shift” model of the inventive product was shown to the potential purchasers in conjunction with the offer to sell, the offer was enough to bar a patent under [pre-AIA 35 U.S.C. 102\(b\)](#).).

#### **D. Material Terms of an Offer for Sale Must be Present**

“[A] communication that fails to constitute a definite offer to sell the product and to include material terms is not an ‘offer’ in the contract sense.” *Elan Corp., PLC v. Andrx Pharms. Inc.*, 366 F.3d 1336, 1341, 70 USPQ2d 1722, 1728 (Fed. Cir. 2004). The court stated that an “offer to enter into a license under a patent for future sale of the invention covered by the patent when and if it has been developed... is not an offer to sell the patented invention that constitutes an on-sale bar.” *Id.*, 70 USPQ2d at 1726. Accordingly, the court concluded that Elan’s letter was not an offer to sell a product. In addition, the court stated that the letter lacked material terms of a commercial offer such as pricing for the product, quantities, time and place of delivery, and product specifications and that the dollar amount in the letter was not a price term for the sale of the product but rather the amount requested was to form and continue a partnership, explicitly referred to as a “licensing fee.” *Id.*

### **III. SALE BY INVENTOR, ASSIGNEE OR OTHERS ASSOCIATED WITH THE INVENTOR IN THE COURSE OF BUSINESS**

#### **A. Sale Activity Need Not Be Public**

Unlike questions of public use, there is no requirement that “on sale” activity be “public.” “Public” as used in [pre-AIA 35 U.S.C. 102\(b\)](#) modifies “use” only. “Public” does not modify “sale.” *Hobbs v. United States*, 451 F.2d 849, 171 USPQ 713, 720 (5th Cir. 1971). It is noted that [AIA 35 U.S.C. 102\(a\)\(1\)](#) uses the same “on sale” term as [pre-AIA 35 U.S.C. 102\(b\)](#) and is treated as having the same meaning. *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S.Ct. 628, 129 USPQ2d 1189 (2019). See [MPEP § 2152.02\(d\)](#).

#### **B. Inventor’s Consent to the Sale Is Not a Prerequisite To Finding an On Sale Bar under pre-AIA 35 U.S.C. 102(b)**

If the invention was placed on sale by a third party who obtained the invention from the inventor, a patent is barred even if the inventor did not consent to the sale or have knowledge that the invention was embodied in the sold article. *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5, 41 USPQ 155 (1938); *In re Blaisdell*, 242 F.2d 779, 783, 113 USPQ 289, 292 (CCPA 1957); *CTS Corp. v. Electro Materials Corp. of America*, 469 F. Supp. 801, 819, 202 USPQ 22, 38 (S.D.N.Y. 1979).

#### **C. Objective Evidence of Sale or Offer To Sell Is Needed**

In determining if a sale or offer to sell the claimed invention has occurred, a key question to ask is whether the inventor sold or offered for sale a product that embodies the invention claimed in the application. Objective evidence such as a description of the inventive product in the contract of sale or in another communication with the purchaser controls over an uncommunicated intent by the seller to deliver the inventive product under the contract for sale. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1567, 33 USPQ2d 1512, 1516 (Fed. Cir. 1995) (On sale bar found where initial negotiations and agreement containing contract for sale neither clearly specified nor precluded use of the inventive design, but an order confirmation prior to the critical date did

specify use of inventive design.). The purchaser need not have actual knowledge of the invention for it to be on sale. The determination of whether “the offered product is in fact the claimed invention may be established by any relevant evidence, such as memoranda, drawings, correspondence, and testimony of witnesses.” *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1060, 12 USPQ2d 1449, 1452 (Fed. Cir. 1989). However, “what the purchaser reasonably believes the inventor to be offering is relevant to whether, on balance, the offer objectively may be said to be of the patented invention.” *Envirotech Corp. v. Westech Eng’g, Inc.*, 904 F.2d 1571, 1576, 15 USPQ2d 1230, 1234 (Fed. Cir. 1990) (Where a proposal to supply a general contractor with a product did not mention a new design but, rather, referenced a prior art design, the uncommunicated intent of the supplier to supply the new design if awarded the contract did not constitute an “on sale” bar to a patent on the new design, even though the supplier’s bid reflected the lower cost of the new design.).

#### IV. SALES BY INDEPENDENT THIRD PARTIES

##### A. Sales or Offers for Sale by Independent Third Parties May be Prior Art

A sale or offer for sale of the invention by an independent third party more than 1 year before the effective filing date of applicant’s claimed invention may be applied as prior art and may prevent applicant from obtaining a patent. “An exception to this rule exists where a patented method is kept secret and remains secret after a sale of the unpatented product of the method. Such a sale prior to the critical date is a bar if engaged in by the patentee or patent applicant, but not if engaged in by another.” *In re Caveney*, 761 F.2d 671, 675-76, 226 USPQ 1, 3-4 (Fed. Cir. 1985).

##### B. Nonprior Art Publications Can Be Used as Evidence of Sale Before the Critical Date

Abstracts identifying a product’s vendor containing information useful to potential buyers such as whom to contact, price terms, documentation, warranties, training and maintenance along with the date of product release or installation before the inventor’s critical date may provide sufficient evidence of prior

sale by a third party to support a rejection based on [pre-AIA 35 U.S.C. 102\(b\)](#) or [103](#). *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Examiner’s rejection was based on nonprior art published abstracts which disclosed software products meeting the claims. The abstracts specified software release dates and dates of first installation which were more than 1 year before applicant’s filing date.).

#### 2133.03(c) The “Invention” [R-07.2022]

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]*

#### Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

\*\*\*\*\*

(b) the invention was...in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

\*\*\*\*\*

(Emphasis added).

#### I. THE INVENTION MUST BE “READY FOR PATENTING”

In *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 66-68, 48 USPQ2d 1641, 1647 (1998), the Supreme Court enunciated a two-prong test for determining whether an invention was “on sale” within the meaning of [pre-AIA 35 U.S.C. 102\(b\)](#) even if it had not yet been reduced to practice. “[T]he on-sale bar applies when two conditions are satisfied before the critical date [more than one year before the effective filing date of the claimed invention]. First, the product must be the subject of a commercial offer for sale.... Second, the invention must be ready for patenting.” *Id.* at 67, 119 S.Ct. at 311-12, 48 USPQ2d at 1646-47.

The Federal Circuit explained that the Supreme Court’s “ready for patenting” prong applies in the context of both the on sale and public use bars. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 1379, 76 USPQ2d 1741, 1744 (Fed. Cir. 2005) (“A bar under [\[pre-AIA\] section 102\(b\)](#) arises where, before the critical date, the invention is in public use and ready for patenting.”). “Ready for patenting,” the second prong of the *Pfaff* test, “may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” *Id.* at 67, 199 S.Ct. at 311-12, 48 USPQ2d at 1647 (The patent was held invalid because the invention for a computer chip socket was “ready for patenting” when it was offered for sale more than one year prior to the application filing date. Even though the invention had not yet been reduced to practice, the manufacturer was able to produce the claimed computer chip sockets using the inventor’s detailed drawings and specifications, and those sockets contained all elements of invention claimed in the patent.). See also *Weatherchem Corp. v. J.L. Clark Inc.*, 163 F.3d 1326, 1333, 49 USPQ2d 1001, 1006-07 (Fed. Cir. 1998) (The invention was held “ready for patenting” since the detailed drawings of plastic dispensing caps offered for sale “contained each limitation of the claims and were sufficiently specific to enable person skilled in art to practice the invention”).

If the invention had been actually reduced to practice before being sold or offered for sale more than 1 year before filing of the application, a patent will be barred. *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366-67, 53 USPQ2d 1377, 1379 (Fed. Cir. 2000) (“Here the pre-critical date sales were of completed cartridges made to specifications that remained unchanged to the present day, showing that any invention embodied in the accused cartridges was reduced to practice before the critical date. The *Pfaff* ready for patenting condition is also satisfied because the specification drawings, available prior to the critical date, were actually used to produce the accused cartridges.”); *In re Hamilton*, 882 F.2d 1576, 1580, 11 USPQ2d 1890, 1893 (Fed. Cir. 1989). “If a product that is offered for sale

inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics.” *Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed. Cir. 1999) (Claim for a particular anhydrous crystalline form of a pharmaceutical compound was held invalid under the on-sale bar of [pre-AIA 35 U.S.C. 102\(b\)](#), even though the parties to the U.S. sales of the foreign manufactured compound did not know the identity of the particular crystalline form.); *STX LLC v. Brine Inc.*, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000) (Claim for a lacrosse stick was held invalid under the on-sale bar despite the argument that it was not known at the time of sale whether the sticks possessed the recited “improved playing and handling characteristics.” “Subjective qualities inherent in a product, such as ‘improved playing and handling’, cannot serve as an escape hatch to circumvent an on-sale bar.”). Actual reduction to practice in the context of an on-sale bar issue usually requires testing under actual working conditions in such a way as to demonstrate the practical utility of an invention for its intended purpose beyond the probability of failure, unless by virtue of the very simplicity of an invention its practical operativeness is clear. *Field v. Knowles*, 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950); *Steinberg v. Seitz*, 517 F.2d 1359, 1363, 186 USPQ 209, 212 (CCPA 1975).

The invention need not be ready for satisfactory commercial marketing for sale to bar a patent. *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 836-37, 23 USPQ2d 1481, 1483 (Fed. Cir. 1992).

## **II. INVENTOR HAS SUBMITTED A 37 CFR 1.131 AFFIDAVIT OR DECLARATION**

Affidavits or declarations submitted under [37 CFR 1.131](#) to swear behind a reference may constitute, among other things, an admission that an invention was “complete” more than 1 year before the filing of an application. See *In re Foster*, 343 F.2d 980, 987-88, 145 USPQ 166, 173 (CCPA 1965); *Dart Indus. v. E.I. duPont de Nemours & Co.*, 489 F.2d

1359, 1365, 179 USPQ 392, 396 (7th Cir. 1973). Also see [MPEP § 715.10](#).

### III. SALE OF A PROCESS

A claimed process, which is a series of acts or steps, is not sold in the same sense as is a claimed product, device, or apparatus, which is a tangible item. “‘Know-how’ describing what the process consists of and how the process should be carried out may be sold in the sense that the buyer acquires knowledge of the process and obtains the freedom to carry it out pursuant to the terms of the transaction. However, such a transaction is not a ‘sale’ of the invention within the meaning of [\[pre-AIA\] § 102\(b\)](#) because the process has not been carried out or performed as a result of the transaction.” *In re Kollar*, 286 F.3d 1326, 1332, 62 USPQ2d 1425, 1429 (Fed. Cir. 2002). However, sale of a product made by the claimed process by the patentee or a licensee would constitute a sale of the process within the meaning of [pre-AIA 35 U.S.C. 102\(b\)](#). See *id.* at 1333, 62 USPQ2d at 1429; *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147-48, 219 USPQ 13, 15-16 (Fed. Cir. 1983) (Even though the sale of a product made by a claimed method before the critical date did not reveal anything about the method to the public, the sale resulted in a “forfeiture” of any right to a patent to that method); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 310 (Fed. Cir. 1983). The application of [pre-AIA 35 U.S.C. 102\(b\)](#) would also be triggered by actually performing the claimed process itself for consideration. See *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 269 F.3d 1321, 1328, 60 USPQ2d 1687, 1691 (Fed. Cir. 2001) (Patent was held invalid under [pre-AIA 35 U.S.C. 102\(b\)](#) based on patentee’s offer to perform the claimed process for treating oil refinery waste more than one year before filing the patent application). Moreover, the sale of a device embodying a claimed process may trigger the on-sale bar. *Minton v. National Ass’n. of Securities Dealers, Inc.*, 336 F.3d 1373, 1378, 67 USPQ2d 1614, 1618 (Fed. Cir. 2003) (finding a fully operational computer program implementing and thus embodying the claimed method to trigger the on-sale bar). However, the sale of a prior art device different from that disclosed in a patent that is asserted after the critical date to be capable of performing the

claimed method is not an on-sale bar of the process. *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1308-09, 72 USPQ2d 1685, 1688-89 (Fed. Cir. 2004) (stating that the transaction involving the sale of the prior art device did not involve a transaction of the claimed method but instead only a device different from that described in the patent for carrying out the claimed method, where the device was not used to practice the claimed method until well after the critical date, and where there was evidence that it was not even known whether the device could perform the claimed process).

### 2133.03(d) “In This Country” [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]*

The language “in this country” in [pre-AIA 35 U.S.C. 102\(b\)](#) does not include other WTO or NAFTA member countries, but includes any State of the United States, the District of Columbia, and any commonwealth, territory, or possession of the United States. See also [35 U.S.C. 105](#). For purposes of judging the applicability of the [pre-AIA 35 U.S.C. 102\(b\)](#) bars, public use or on sale activity must take place in the United States. The “on sale” bar does not generally apply where both manufacture and delivery occur in a foreign country. *Gandy v. Main Belting Co.*, 143 U.S. 587, 593 (1892). However, “on sale” status can be found if substantial activity prefatory to a “sale” occurs in the United States. *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426, 433, 178 USPQ 577, 583 (9th Cir. 1973). An offer for sale, made or originating in this country, may be sufficient prefatory activity to bring the offer within the terms of the statute, even though sale and delivery take place in a foreign country. The same rationale applies to an offer by a foreign manufacturer which is communicated to a prospective purchaser in the United States prior to



the critical date. *CTS Corp. v. Piher Int'l Corp.*, 593 F.2d 777, 201 USPQ 649 (7th Cir. 1979).

### 2133.03(e) Permitted Activity; Experimental Use [R-07.2022]

[Editor Note: This MPEP section **may be applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102](#).]

The question posed by the experimental use doctrine is “whether the primary purpose of the inventor at the time of the sale, as determined from an objective evaluation of the facts surrounding the transaction, was to conduct experimentation.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1354, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002) (quoting *EZ Dock v. Schafer Sys., Inc.*, 276 F.3d 1347, 1356-57, 61 USPQ2d 1289, 1295-96 (Fed. Cir. 2002)) (Linn, J., concurring). Experimentation must be the primary purpose and any commercial exploitation must be incidental in order for the sale to be a permitted activity that does not create a bar under [pre-AIA 35 U.S.C. 102\(b\)](#).

If the use or sale was experimental, there is no bar under [pre-AIA 35 U.S.C. 102\(b\)](#). “A use or sale is experimental for purposes of [\[pre-AIA\] section 102\(b\)](#) if it represents a *bona fide* effort to perfect the invention or to ascertain whether it will answer its intended purpose.... If any commercial exploitation does occur, it must be merely incidental to the primary purpose of the experimentation to perfect the invention.” *LaBounty Mfg. v. United States Int’l Trade Comm’n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992) (quoting *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1581, 222 USPQ 833, 838 (Fed. Cir. 1984)). “The experimental use exception...does not include market testing where the inventor is attempting to gauge consumer demand for his claimed invention. The purpose of such activities is commercial exploitation and not experimentation.” *In re Smith*,

714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983).

### 2133.03(e)(1) Commercial Exploitation [R-07.2022]

[Editor Note: This MPEP section **may be applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102](#).]

One policy of the on sale and public use provisions of [35 U.S.C. 102](#) is the prevention of inventors from exploiting their inventions commercially more than 1 year prior to the filing of a patent application. Therefore, if applicant’s precritical date activity is a sale or offer for sale that is an attempt at market penetration, the activity may be cited as prior art. Thus, even if there is *bona fide* experimental activity, an inventor may not commercially exploit an invention more than 1 year prior to the effective filing date of a claimed invention. See *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979).

#### I. THE COMMERCIAL ACTIVITY MUST LEGITIMATELY ADVANCE DEVELOPMENT OF THE INVENTION TOWARDS COMPLETION

As the degree of commercial exploitation in public use or sale activity increases, the burden on an applicant to establish clear and convincing evidence of experimental activity with respect to a public use becomes more difficult. Where the examiner has found a *prima facie* case of a sale or an offer to sell, this burden will rarely be met unless clear and convincing necessity for the experimentation is established by the applicant. See *Sunoco Partners Mktg. & Terminals LP v. U.S. Venture, Inc.*, 32 F.4th 1161, 1171-72, 2022 USPQ2d 417 (Fed. Cir. 2022) (performing testing at a third party’s location instead of at the buyer’s facility, along with the fact that the testing could have been performed before the offer to sell, showed that “[t]he need to perform this



testing ... cannot have been the primary purpose for the ... sale”). This does not mean, of course, that there are no circumstances which would permit alleged experimental activity in an atmosphere of commercial exploitation. In certain circumstances, even a sale may be necessary to legitimately advance the experimental development of an invention if the primary purpose of the sale is experimental. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979); *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426, 433, 178 USPQ 577, 582 (9th Cir. 1973). However, careful scrutiny by the examiner of the objective factual circumstances surrounding such a sale is essential. See *Ushakoff v. United States*, 327 F.2d 669, 140 USPQ 341 (Ct.Cl. 1964); *Cloud v. Standard Packaging Corp.*, 376 F.2d 384, 153 USPQ 317 (7th Cir. 1967).

## II. SIGNIFICANT FACTORS INDICATIVE OF “COMMERCIAL EXPLOITATION”

As discussed in [MPEP § 2133.03](#), a policy consideration in questions of sales activity is premature “commercial exploitation” of a “completed” or “ready for patenting” invention (see [MPEP § 2133.03\(c\)](#)). The extent of commercial activity which constitutes “on sale” status depends upon the circumstances of the activity, the basic indicator being the subjective intent of the inventor as manifested through objective evidence. The following activities should be used by the examiner as indicia of this subjective intent:

(A) Preparation of various contemporaneous “commercial” documents, e.g., orders, invoices, receipts, delivery schedules, etc.;

(B) Preparation of price lists (*Akron Brass Co. v. Elkhart Brass Mfg. Co.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965)) and distribution of price quotations (*Amphenol Corp. v. Gen'l Time Corp.*, 397 F.2d 431, 436, 158 USPQ 113, 117 (7th Cir. 1968));

(C) Display of samples to prospective customers (*Cataphote Corp. v. DeSoto Chemical Coatings, Inc.*, 356 F.2d 24, 27, 148 USPQ 527, 529 (9th Cir. 1966) *mod. on other grounds*, 358 F.2d 732, 149 USPQ 159 (9th Cir.), *cert. denied*, 385 U.S. 832 (1966); *Chicopee Mfg. Corp. v. Columbus Fiber Mills Co.*, 165 F.Supp. 307, 323-325, 118 USPQ 53, 65-67 (M.D.Ga. 1958));

(D) Demonstration of models or prototypes (*General Elec. Co. v. United States*, 206 USPQ 260, 266-67 (Ct. Cl. 1979); *Red Cross Mfg. v. Toro Sales Co.*, 525 F.2d 1135, 1140, 188 USPQ 241, 244-45 (7th Cir. 1975); *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 815-16, 131 USPQ 413, 429-30 (D. Del. 1961)), especially at trade conventions (*Interroyal Corp. v. Simmons Co.*, 204 USPQ 562, 563-65 (S.D. N.Y. 1979)), and even though no orders are actually obtained (*Monogram Mfg. v. F. & H. Mfg.*, 144 F.2d 412, 62 USPQ 409, 412 (9th Cir. 1944));

(E) Use of an invention where an admission fee is charged (*In re Josserand*, 188 F.2d 486, 491, 89 USPQ 371, 376 (CCPA 1951); *Greenewalt v. Stanley*, 54 F.2d 195, 12 USPQ 122 (3d Cir. 1931)); and

(F) Advertising in publicity releases, brochures, and various periodicals (*In re Theis*, 610 F.2d 786, 792 n.6, 204 USPQ 188, 193 n. 6 (CCPA 1979); *Interroyal Corp. v. Simmons Co.*, 204 USPQ 562, 564-66 (S.D.N.Y. 1979); *Akron Brass, Co. v. Elkhart Brass Mfg., Inc.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965); *Tucker Aluminum Prods. v. Grossman*, 312 F.2d 393, 394, 136 USPQ 244, 245 (9th Cir. 1963)).

See [MPEP § 2133.03\(e\)\(4\)](#) for factors indicative of an experimental purpose.

### 2133.03(e)(2) Intent [R-07.2022]

[Editor Note: This MPEP section **may be applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]

“When sales are made in an ordinary commercial environment and the goods are placed outside the inventor’s control, an inventor’s secretly held subjective intent to ‘experiment,’ even if true, is unavailing without objective evidence to support the contention. Under such circumstances, the customer at a minimum must be made aware of the

experimentation.” *LaBounty Mfg., Inc. v. United States Int’l Trade Comm’n*, 958 F.2d 1066, 1072, 22 USPQ2d 1025, 1029 (Fed. Cir. 1992) (quoting *Harrington Mfg. Co. v. Powell Mfg. Co.*, 815 F.2d 1478, 1480 n.3, 2 USPQ2d 1364, 1366 n.3 (Fed. Cir. 1986); *Sunoco Partners Mktg. & Terminals LP v. U.S. Venture, Inc.*, 32 F.4th 1161, 1171-72, 2022 USPQ2d 417 (Fed. Cir. 2022) (The Federal Circuit relied on the objective evidence of the contract over the inventors’ testimony that their intent for the agreement was experimental); *Paragon Podiatry Laboratory, Inc. v. KLM Labs., Inc.*, 984 F.2d 1182, 25 USPQ2d 1561 (Fed. Cir. 1993) (Paragon sold the inventive units to the trade as completed devices without any disclosure to either doctors or patients of their involvement in alleged testing. Evidence of the inventor’s secretly held belief that the units were not durable and may not be satisfactory for consumers was not sufficient, alone, to avoid a statutory bar.).

### **2133.03(e)(3) “Completeness” of the Invention [R-07.2022]**

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2150 et seq. for examination of applications subject to those provisions. See MPEP § 2152.02(c) through (e) for a detailed discussion of the public use and on sale provisions of AIA 35 U.S.C. 102.]*

#### **I. EXPERIMENTAL USE ENDS WHEN THE INVENTION IS ACTUALLY REDUCED TO PRACTICE**

Experimental use “means perfecting or completing an invention to the point of determining that it will work for its intended purpose.” Therefore, experimental use “ends with an actual reduction to practice.” *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1061, 12 USPQ2d 1449, 1453 (Fed. Cir. 1989). If the examiner concludes from the evidence of record that the inventor was satisfied that an invention was in fact “complete,” awaiting approval by the inventor from an organization such as Underwriters’ Laboratories will not normally

overcome this conclusion. *Interroyal Corp. v. Simmons Co.*, 204 USPQ 562, 566 (S.D.N.Y. 1979); *Skil Corp. v. Rockwell Manufacturing Co.*, 358 F. Supp. 1257, 1261, 178 USPQ 562, 565 (N.D.Ill. 1973), *aff’d in part, rev’d in part sub nom. Skil Corp. v. Lucerne Products Inc.*, 503 F.2d 745, 183 USPQ 396, 399 (7th Cir. 1974), *cert. denied*, 420 U.S. 974, 185 USPQ 65 (1975). See [MPEP § 2133.03\(c\)](#) for more information of what constitutes a “complete” invention.

The fact that alleged experimental activity does not lead to specific modifications or refinements of an invention is evidence, although not conclusive evidence, that such activity is not within the realm permitted by the statute. This is especially the case where the evidence of record clearly demonstrates to the examiner that an invention was considered “complete” by an inventor at the time of the activity. Nevertheless, any modifications or refinements which did result from such experimental activity must at least be a feature of the claimed invention to be of any probative value. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979).

#### **II. DISPOSAL OF PROTOTYPES**

Where a prototype of an invention has been disposed of by an inventor before the critical date, inquiry by the examiner should focus upon the intent of the inventor and the reasonableness of the disposal under all circumstances. The fact that an otherwise reasonable disposal of a prototype involves incidental income is not necessarily fatal. *In re Dybel*, 524 F.2d 1393, 1399, n.5, 187 USPQ 593, 597 n.5 (CCPA 1975). However, if a prototype is considered “complete” by an inventor and all experimentation on the underlying invention has ceased, unrestricted disposal of the prototype constitutes a bar under [pre-AIA 35 U.S.C. 102\(b\)](#). *In re Blaisdell*, 242 F.2d 779, 113 USPQ 289 (CCPA 1957); *contra, Watson v. Allen*, 254 F.2d 342, 117 USPQ 68 (D.C. Cir. 1958).

### **2133.03(e)(4) Factors Indicative of an Experimental Purpose [R-07.2022]**

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set*

forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]

The courts have considered a number of factors in determining whether a claimed invention was the subject of a commercial offer for sale primarily for purposes of experimentation. “These factors include: (1) the necessity for public testing, (2) the amount of control over the experiment retained by the inventor, (3) the nature of the invention, (4) the length of the test period, (5) whether payment was made, (6) whether there was a secrecy obligation, (7) whether records of the experiment were kept, (8) who conducted the experiment, ... (9) the degree of commercial exploitation during testing[,] ... (10) whether the invention reasonably requires evaluation under actual conditions of use, (11) whether testing was systematically performed, (12) whether the inventor continually monitored the invention during testing, and (13) the nature of contacts made with potential customers.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1353, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002) (quoting *EZ Dock v. Schafer Sys., Inc.*, 276 F.3d 1347, 1357, 61 USPQ2d 1289, 1296 (Fed. Cir. 2002)) (Linn, J., concurring). Another critical attribute of experimentation is the “customer’s awareness of the purported testing in the context of a sale.” *Electromotive Div. of Gen. Motors Corp. v. Transportation Sys. Div. of Gen. Elec. Co.*, 417 F.3d 1203, 1241, 75 USPQ2d 1650, 1658 (Fed. Cir. 2005).

Once alleged experimental activity is advanced by an applicant to explain a *prima facie* case of unpatentability, the examiner must determine whether the scope and length of the activity were reasonable in terms of the experimental purpose intended by the applicant and the nature of the subject matter involved. No one of, or particular combination of, factors is necessarily determinative of this purpose.

See [MPEP § 2133.03\(e\)\(1\)](#) for factors indicative of commercial exploitation.

### **2133.03(e)(5) Experimentation and Degree of Supervision and Control [R-07.2022]**

[Editor Note: This MPEP section *may be applicable* to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]

#### **THE INVENTOR MUST MAINTAIN SUFFICIENT CONTROL OVER THE INVENTION DURING TESTING BY THIRD PARTIES**

The significant determinative factors in questions of experimental purpose are the extent of supervision and control maintained by an inventor over an invention during an alleged period of experimentation, and the customer’s awareness of the experimentation. *Electromotive Div. of Gen. Motors Corp. v. Transportation Sys. Div. of Gen. Elec. Co.*, 417 F.3d 1203, 1214, 75 USPQ2d 1650, 1658 (Fed. Cir. 2005) (“control and customer awareness ordinarily must be proven if experimentation is to be found”). Once a period of experimental activity has ended and supervision and control has been relinquished by an inventor without any restraints on subsequent use of an invention, an unrestricted subsequent use of the invention is a [pre-AIA 35 U.S.C. 102\(b\)](#) bar. *In re Blaisdell*, 242 F.2d 779, 784, 113 USPQ 289, 293 (CCPA 1957).

### **2133.03(e)(6) Permitted Experimental Activity and Testing [R-07.2022]**

[Editor Note: This MPEP section *may be applicable* to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]

## I. DEVELOPMENTAL TESTING IS PERMITTED

Testing of an invention in the normal context of its technological development is generally within the realm of permitted experimental activity. Likewise, experimentation to determine utility, as that term is applied in [35 U.S.C. 101](#), may also constitute permissible activity. See *General Motors Corp. v. Bendix Aviation Corp.*, 123 F. Supp. 506, 521, 102 USPQ 58, 69 (N.D.Ind. 1954). For example, where an invention relates to a chemical composition with no known utility, i.e., a patent application for the composition could not be filed ([35 U.S.C. 101](#); [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph), continued testing to find utility would likely be permissible, absent a sale of the composition or other evidence of commercial exploitation.

## II. MARKET TESTING IS NOT PERMITTED

Experimentation to determine product acceptance, i.e., market testing, is typical of a trader's and not an inventor's experiment and is thus not within the area of permitted experimental activity. *Smith & Davis Mfg. Co. v. Mellon*, 58 F. 705, 707 (8th Cir. 1893). Likewise, testing of an invention for the benefit of appeasing a customer, or to conduct "minor 'tune up' procedures not requiring an inventor's skills, but rather the skills of a competent technician," are also not within the scope of experimentation. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 193-94 (CCPA 1979).

## III. EXPERIMENTAL ACTIVITY IN THE CONTEXT OF DESIGN APPLICATIONS

The public use of an ornamental design which is directed toward generating consumer interest in the aesthetics of the design is not an experimental use.

*In re Mann*, 861 F.2d 1581, 8 USPQ2d 2030 (Fed. Cir. 1988) (display of a wrought iron table at a trade show held to be public use). However, "experimentation directed to functional features of a product also containing an ornamental design may negate what otherwise would be considered a public use." *Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 1196, 31 USPQ2d 1321, 1326 (Fed. Cir. 1994) (A study wherein students evaluated the effect of

the functional features of a spice container design may be considered an experimental use.)

## 2133.03(e)(7) Activity of an Independent Third Party Inventor [R-07.2022]

*[Editor Note: This MPEP section may be applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152.02\(c\) through \(e\)](#) for a detailed discussion of the public use and on sale provisions of [AIA 35 U.S.C. 102.](#)]*

## EXPERIMENTAL USE IS PERSONAL TO AN INVENTOR

Public use and sales activity may be prior art even if by a party other than an inventor. Where an inventor presents evidence of experimental activity by such other party, the evidence will not overcome the *prima facie* case of unpatentability based upon the activity of such party unless the activity was under the supervision and control of the inventor. *In re Hamilton*, 882 F.2d 1576, 1581, 111 USPQ2d 1890, 1894 (Fed. Cir. 1989) ("The experimental use doctrine operates in the inventor's favor to allow *the inventor* to refine his invention or to assess its value relative to the time and expense of prosecuting a patent application. If it is not the inventor or someone under his control or 'surveillance' who does these things, there appears to us no reason why he should be entitled to rely upon them to avoid the statute.") (citing *Magnetics, Inc. v. Arnold Engineering Co.*, 438 F.2d 72, 74, 168 USPQ 392, 394 (7th Cir. 1971)). In other words, the experimental use activity exception is personal to the inventor.

## 2134 Pre-AIA 35 U.S.C. 102(c) [R-10.2019]

*[Editor Note: This MPEP section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and*



*MPEP § 2150 et seq. for examination of applications subject to those provisions.]*

Under [pre-AIA 35 U.S.C. 102\(c\)](#), abandonment of the “invention” (as distinguished from abandonment of an application) results in loss of right to a patent.

**Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless -

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(c) he has abandoned the invention.

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**I. UNDER 35 U.S.C. 102(c), AN ABANDONMENT MUST BE INTENTIONAL**

“Actual abandonment under [pre-AIA 35 U.S.C. 102\(c\)](#) requires that the inventor intend to abandon the invention, and intent can be implied from the inventor’s conduct with respect to the invention. *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971). Such intent to abandon the invention will not be imputed, and every reasonable doubt should be resolved in favor of the inventor.” *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991).

**II. DELAY IN MAKING FIRST APPLICATION**

Abandonment under [pre-AIA 35 U.S.C. 102\(c\)](#) requires a deliberate, though not necessarily express, surrender of any rights to a patent. To abandon the invention the inventor must intend a dedication to the public. Such dedication may be either express or implied, by actions or inactions of the inventor.

*U.S. Rifle & Cartridge Co. v. Whitney Arms Co.*, 118 U.S. 22, 25 (1886); *Consolidated Fruit–Jar Co. v. Wright*, 94 U.S. 92, 96 (1876). Delay alone is not sufficient to infer the requisite intent to abandon.

*Lovell v. Peer*, 148 F.2d 212, 214, 65 USPQ 127, 129 (CCPA 1945). See also *Moore v. United States*, 194 USPQ 423, 428 (Ct. Cl. 1977) (The drafting and retention in his own files of two patent applications by inventor indicates an intent to retain his invention; delay in filing the applications was not sufficient to establish abandonment); but see *Davis Harvester Co., Inc. v. Long Mfg. Co.*, 252 F. Supp. 989, 1009-10, 149 USPQ 420, 435-436 (E.D. N.C. 1966) (Where the inventor does nothing over a period of time to develop or patent his invention, ridicules the

attempts of another to develop that invention and begins to show active interest in promoting and developing his invention only after successful marketing by another of a device embodying that invention, the inventor has abandoned his invention under [pre-AIA 35 U.S.C. 102\(c\)](#)).

**III. DELAY IN REAPPLYING FOR PATENT AFTER ABANDONMENT OF PREVIOUS PATENT APPLICATION**

Where there is no evidence of expressed intent or conduct by inventor to abandon the invention, delay in reapplying for patent after abandonment of a previous application does not constitute abandonment under [pre-AIA 35 U.S.C. 102\(c\)](#).

*Petersen v. Fee Int’l, Ltd.*, 381 F. Supp. 1071, 182 USPQ 264 (W.D. Okla. 1974).

**IV. DISCLOSURE WITHOUT CLAIMING IN A PRIOR ISSUED PATENT**

Any inference of abandonment (i.e., intent to dedicate to the public) of subject matter disclosed but not claimed in a previously issued patent is rebuttable by an application filed at any time before a statutory bar arises. Accordingly, a rejection of a claim of a patent application under [pre-AIA 35 U.S.C. 102\(c\)](#) predicated solely on the issuance of a patent which discloses the subject matter of the claim in the application without claiming it would be improper, regardless of whether there is copendency between the application at issue and the application which issued as the patent. *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

**V. ONLY WHEN THERE IS A PRIORITY CONTEST CAN A LAPSE OF TIME BAR A PATENT**

The mere lapse of time will not bar a patent. The only exception is when there is a priority contest under [pre-AIA 35 U.S.C. 102\(g\)](#) and applicant abandons, suppresses or conceals the invention. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101, 227 USPQ 337, 350 (Fed. Cir. 1985). Abandonment, suppression and concealment are treated by the courts under [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2138.03](#) for more information on this issue.



**2135 Pre-AIA 35 U.S.C. 102(d) [R-10.2019]**

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions.]*

**Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless -

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(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

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**I. GENERAL REQUIREMENTS OF PRE-AIA 35 U.S.C. 102(d)**

[Pre-AIA 35 U.S.C. 102\(d\)](#) establishes four conditions which, if all are present, establish a statutory bar against the granting of a patent in this country:

(A) The foreign application must be filed more than 12 months before the effective filing date of the claimed invention in the United States (see [MPEP § 2139.01](#) regarding determination of the effective U.S. filing date when an application is subject to [pre-AIA 35 U.S.C. 102](#));

(B) The foreign and United States applications must have been filed by the same applicant or by the same applicant's legal representatives or assigns.

(C) The foreign application must have actually issued as a patent or inventor's certificate (e.g., granted by sealing of the papers in Great Britain) before the filing in the United States. It need not be published but the patent rights granted must be enforceable.

(D) The same invention must be involved.

If such a foreign patent or inventor's certificate is discovered by the examiner, the rejection is made

under [pre-AIA 35 U.S.C. 102\(d\)](#) on the ground of statutory bar. See [MPEP § 2135.01](#) for further clarification of each of the four requirements of [pre-AIA 35 U.S.C. 102\(d\)](#).

**II. SEARCHING FOR PRE-AIA 35 U.S.C. 102(d) PRIOR ART**

The examiner should undertake a search for an issued foreign patent for use as [pre-AIA 35 U.S.C. 102\(d\)](#) prior art only if there is a reasonable possibility that a foreign patent covering the same subject matter as the U.S. application has been granted to the same inventive entity before the U.S. effective filing date, i.e., the time period between foreign and U.S. filings is greater than the usual time it takes for a patent to issue in the foreign country. The document must be a patent or inventor's certificate and not merely a published or laid open application. Normally, the probability of the inventor's foreign patent issuing before the U.S. filing date is so slight as to make such a search unproductive. However, it should be kept in mind that the average pendency varies greatly between foreign countries.

The search for a granted patent can be accomplished on an electronic database either by the examiner or by the staff of the Scientific and Technical Information Center. See [MPEP § 901.06\(a\)](#), subsection IV.B., for more information on online searching. Alternatively, if the examiner has a reasonable basis for concluding that [pre-AIA 35 U.S.C. 102\(d\)](#) prior art might exist, the examiner may make a requirement for information under [37 CFR 1.105](#). See [MPEP § 704.10](#) et seq.

**2135.01 The Four Requirements of Pre-AIA 35 U.S.C. 102(d) [R-10.2019]**

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions.]*

## I. FOREIGN APPLICATION MUST BE FILED MORE THAN 12 MONTHS BEFORE THE EFFECTIVE U.S. FILING DATE

### A. *An Anniversary Date Ending on a Weekend or Holiday Results in an Extension to the Next Business Day*

The U.S. application is filed in time to prevent a [pre-AIA 35 U.S.C. 102\(d\)](#) bar from arising if it is filed on the 1 year anniversary date of the filing date of the foreign application. If this day is a Saturday, Sunday or federal holiday, the year would be extended to the following business day. See *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). Despite changes to [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which require the USPTO to accord a filing date to an application as of the date of deposit as Priority Mail Express® with the U.S. Postal Service in accordance with [37 CFR 1.10](#) (e.g., a Saturday filing date), the rule changes do not affect applicant's concurrent right to defer the filing of an application until the next business day when the last day for "taking any action" falls on a Saturday, Sunday, or a federal holiday (e.g., the last day of the 1-year grace period falls on a Saturday).

### B. *A Continuation-in-Part Breaks the Chain of Priority as to Foreign as Well as U.S. Parents*

In the case where applicant files a foreign application, later files a U.S. application claiming priority based on the foreign application, and then files a continuation-in-part (CIP) application whose claims are not entitled to the filing date of the U.S. parent, the effective filing date is the filing date of the CIP and applicant cannot obtain the benefit of either the U.S. parent or foreign application filing dates. *In re Van Langenhoven*, 458 F.2d 132, 137, 173 USPQ 426, 429 (CCPA 1972). If the foreign application issues into a patent before the filing date of the CIP, it may be used in a [pre-AIA 35 U.S.C. 102\(d\)/103](#) rejection if the subject matter added to the CIP does not render the claims nonobvious over the foreign patent. *Ex parte Appeal No. 242-47*, 196 USPQ 828 (Bd. App. 1976) (Foreign patent can be combined with other prior art to bar a U.S. patent in an obviousness rejection based on [pre-AIA 35 U.S.C. 102\(d\)/103](#)).

## II. FOREIGN APPLICATION MUST HAVE BEEN FILED BY SAME APPLICANT, HIS OR HER LEGAL REPRESENTATIVE OR ASSIGNS

Note that where the U.S. application was made by two or more inventors, it is permissible for these inventors to claim priority from separate applications, each to one of the inventors or a subcombination of inventors. For instance, a U.S. application naming inventors A and B may be entitled to priority from one application to A and one to B filed in a foreign country.

## III. THE FOREIGN PATENT OR INVENTOR'S CERTIFICATE WAS ACTUALLY GRANTED BEFORE THE U.S. FILING DATE

### A. *To Be "Patented" an Exclusionary Right Must Be Awarded to the Applicant*

"Patented" means "a formal bestowal of patent rights from the sovereign to the applicant." *In re Monks*, 588 F.2d 308, 310, 200 USPQ 129, 131 (CCPA 1978); *American Infra-Red Radiant Co. v. Lambert Indus.*, 360 F.2d 977, 149 USPQ 722 (8th Cir.), *cert. denied*, 385 U.S. 920 (1966) (German Gebrauchsmuster petty patent was held to be a patent usable in a [pre-AIA 35 U.S.C. 102\(d\)](#) rejection. A Gebrauchsmuster petty patent is not examined and, at the time of the decision, had only a 6-year patent term. However, except as to duration, the exclusionary patent right granted is as extensive as in the U.S.).

### B. *A Published Application Is Not a "Patent"*

An application must issue into a patent before it can be applied in a [pre-AIA 35 U.S.C. 102\(d\)](#) rejection. *Ex parte Fujishiro*, 199 USPQ 36 (Bd. App. 1977) ("Patenting," within the meaning of [pre-AIA 35 U.S.C. 102\(d\)](#), does not occur upon laying open of a Japanese utility model application (kokai or kohyo)); *Ex parte Links*, 184 USPQ 429 (Bd. App. 1974) (German applications, which have not yet been published for opposition, are published in the form of printed documents called Offenlegungsschriften 18 months after filing. These applications are unexamined or in the process of being examined at the time of publication. The Board held that an Offenlegungsschrift is not a patent under [pre-AIA 35 U.S.C. 102\(d\)](#) even though some

provisional rights are granted. The Board explained that the provisional rights are minimal and do not come into force if the application is withdrawn or refused.).

***C. An Allowed Application Can Be a “Patent” for Purposes of Pre-AIA 35 U.S.C. 102(d) as of the Date Published for Opposition Even Though It Has Not Yet Been Granted as a Patent***

An examined application which has been allowed by the examiner and published to allow the public to oppose the grant of a patent has been held to be a “patent” for purposes of rejection under [pre-AIA 35 U.S.C. 102\(d\)](#) as of the date of publication for opposition if substantial provisional enforcement rights arise. *Ex parte Beik*, 161 USPQ 795 (Bd. App. 1968) (This case dealt with examined German applications. After a determination that an application is allowable, the application is published in the form of a printed document called an Auslegeschrift. The publication begins a period of opposition where the public can present evidence showing unpatentability. Provisional patent rights are granted which are substantially the same as those available once the opposition period is over and the patent is granted. The Board found that an Auslegeschrift provides the legal effect of a patent for purposes of rejection under [pre-AIA 35 U.S.C. 102\(d\)](#).).

***D. Grant Occurs When Patent Becomes Enforceable***

The critical date of a foreign patent as a reference under [pre-AIA 35 U.S.C. 102\(d\)](#) is the date the patent becomes enforceable (issued, sealed or granted). *In re Monks*, 588 F.2d 308, 310, 200 USPQ 129, 131 (CCPA 1978) (British reference became available as prior art on date the patent was “sealed” because as of this date applicant had the right to exclude others from making, using or selling the claimed invention.).

***E. Pre-AIA 35 U.S.C. 102(d) Applies as of Grant Date Even If There Is a Period of Secrecy After Patent Grant***

A period of secrecy after granting the patent, as in Belgium and Spain, has been held to have no effect in connection with [pre-AIA 35 U.S.C. 102\(d\)](#). These patents are usable in rejections under [pre-AIA 35](#)

[U.S.C. 102\(d\)](#) as of the date patent rights are granted. *In re Kathawala*, 9 F.3d 942, 28 USPQ2d 1789 (Fed. Cir. 1993) (An invention is “patented” for purposes of [pre-AIA 35 U.S.C. 102\(d\)](#) when the patentee’s rights under the patent become fixed. The fact that applicant’s Spanish application was not published until after the U.S. filing date is immaterial since the Spanish patent was granted before U.S. filing.); *Gramme Elec. Co. v. Arnoux and Hochhausen Elec. Co.*, 17 F. 838, 1883 C.D. 418 (S.D.N.Y. 1883) (Rejection made under a predecessor of [pre-AIA 35 U.S.C. 102\(d\)](#) based on an Austrian patent granted an exclusionary right for 1 year but was kept secret, at the option of the patentee, for that period. The court held that the Austrian patent grant date was the relevant date under the statute for purposes of [pre-AIA 35 U.S.C. 102\(d\)](#) but that the patent could not have been used to in a rejection under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#)); *In re Talbott*, 443 F.2d 1397, 170 USPQ 281 (CCPA 1971) (Applicant cannot avoid a [pre-AIA 35 U.S.C. 102\(d\)](#) rejection by exercising an option to keep the subject matter of a German Gebrauchsmuster (petty patent) in secrecy until time of U.S. filing.).

**IV. THE SAME INVENTION MUST BE INVOLVED**

***“Same Invention” Means That the Application Claims Could Have Been Presented in the Foreign Patent***

Under [pre-AIA 35 U.S.C. 102\(d\)](#), the “invention... patented” in the foreign country must be the same as the invention sought to be patented in the U.S. When the foreign patent contains the same claims as the U.S. application, there is no question that “the invention was first patented... in a foreign country.” *In re Kathawala*, 9 F.3d 942, 945, 28 USPQ2d 1785, 1787 (Fed. Cir. 1993). However, the claims need not be identical or even within the same statutory class. If applicant is granted a foreign patent which fully discloses the invention and which gives applicant a number of different claiming options in the U.S., the reference in [pre-AIA 35 U.S.C. 102\(d\)](#) to “‘invention... patented’ necessarily includes all the disclosed aspects of the invention. Thus, the [\[pre-AIA\] section 102\(d\)](#) bar applies regardless whether the foreign patent contains claims to less than all aspects of the invention.” 9 F.3d at 946, 28 USPQ2d at 1788. In essence, a [pre-AIA 35 U.S.C.](#)

[102\(d\)](#) rejection applies if applicant’s foreign application supports the subject matter of the U.S. claims. *Id.* at 944, 947, 28 USPQ2d at 1786, 1789 (Applicant was granted a Spanish patent claiming a method of making a composition. The patent disclosed compounds, methods of use and processes of making the compounds. After the Spanish patent was granted, the applicant filed a U.S. application with claims directed to the compound but not the process of making it. The Federal Circuit held that it did not matter that the claims in the U.S. application were directed to the composition instead of the process because the foreign specification would have supported claims to the composition. It was immaterial that the formulations were unpatentable pharmaceutical compositions in Spain.).

### 2136 Pre-AIA 35 U.S.C. 102(e) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#), except for determining eligibility of SIRs as eligible prior art. See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions.]*

#### **Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless-

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(e) the invention was described in — (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language.

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[Pre-AIA 35 U.S.C. 102\(e\)](#) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of their respective U.S. filing dates, including certain

international filing dates. The prior art date of a reference under [pre-AIA 35 U.S.C. 102\(e\)](#) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty ([PCT](#)) [Article 21\(2\)](#) in the English language. References based on international applications that were filed prior to November 29, 2000 are subject to the pre-AIPA version of 35 U.S.C. 102(e) (i.e., the version in force on November 28, 2000). See [MPEP § 2136.03](#) for additional information.

In accordance with former [35 U.S.C. 157\(c\)](#), a published SIR will be treated the same as a U.S. patent for all defensive purposes, usable as a reference as of its filing date in the same manner as a U.S. patent. A SIR is prior art under all applicable sections of [35 U.S.C. 102](#) including [pre-AIA 35 U.S.C. 102\(e\)](#). See [MPEP § 1111](#).

[Pre-AIA 35 U.S.C. 102\(e\)](#) is mostly utilized when the publication or issue date is too recent for the reference to be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#). For a patent, the statute only requires that it be “granted” and does not require that the patent be currently valid to be applied under [pre-AIA 35 U.S.C. 102\(e\)\(2\)](#). *Becton, Dickinson & Co. v. Baxter Corp.* Englewood, 998 F.3d 1337, 1345, 2021 USPQ2d 586 (Fed. Cir. 2021). In order to apply a reference under [pre-AIA 35 U.S.C. 102\(e\)](#), the inventive entity of the application must be different from that of the cited reference. Note that, where there are joint inventors, only one inventor needs to be different for the inventive entities to be different; put another way, a rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) is applicable even if there are some inventors in common between the application and the cited reference.

Below are examination guidelines on the application of [pre-AIA 35 U.S.C. 102\(e\)](#).

#### **I. DETERMINE THE APPROPRIATE PRE-AIA 35 U.S.C. 102(e) DATE FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES,**



## EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

(A) The potential reference must be a U.S. patent, a U.S. application publication ([35 U.S.C. 122\(b\)](#)) or a WIPO publication of an international application under [PCT Article 21\(2\)](#) in order to apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#).

(B) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below. The [pre-AIA 35 U.S.C. 102\(e\)](#) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under [35 U.S.C. 119\(e\)](#) or [120](#). For all benefit claims, the prior application(s) must properly support the subject matter used to make the rejection in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See [MPEP § 2136.02](#). In addition, for benefit claims under [35 U.S.C. 119\(e\)](#), at least one claim of the potential reference must be supported by the written description of the relied upon provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#), in order for the potential reference to be usable as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of a relied upon provisional application's filing date. See [MPEP § 2136.03](#), subsection III.

(C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(1) If the international application meets the following three conditions:

- (a) an international filing date on or after November 29, 2000;
- (b) designated the United States; and
- (c) published under [PCT Article 21\(2\)](#) in English,

then the international filing date is a U.S. filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#). If such an international application properly claims benefit to an earlier-filed U.S. or international application, or to an earlier-filed U.S. provisional application, apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the earlier filing date, provided all the conditions of [pre-AIA](#)

[35 U.S.C. 102\(e\)](#), [119\(e\)](#), [120](#), [365\(c\)](#), or [386\(c\)](#) are met. For all benefit claims, the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#), in order for that subject matter to be entitled to the earlier filing date under [pre-AIA 35 U.S.C. 102\(e\)](#). See [MPEP § 2136.02](#). In addition, for benefit claims under [35 U.S.C. 119\(e\)](#), at least one claim of the potential reference must be supported by the written description of the relied upon provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#), in order for the potential reference to be usable as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of a relied upon provisional application's filing date. See [MPEP § 2136.03](#), subsection III. Note, where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under [PCT Article 21\(2\)](#)) for the earlier international filing date to be a U.S. filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#).

(2) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under [PCT Article 21\(2\)](#), do **not** treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do **not** apply the reference as of its international filing date, its date of completion of the [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#) as of its publication date, or [pre-AIA 35 U.S.C. 102\(e\)](#) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

(3) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of [pre-AIA 35 U.S.C. 102](#) and [374](#), prior to the AIPA amendments:

(a) For U.S. patents, apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the earlier of the date of completion of the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) or the filing date of

the later-filed U.S. application that claimed the benefit of the international application;

(b) For U.S. application publications and WIPO publications directly resulting from international applications under [PCT Article 21\(2\)](#), never apply these references under [pre-AIA 35 U.S.C. 102\(e\)](#). These references may be applied as of their publication dates under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#);

(c) For U.S. application publications of applications that claim the benefit under [35 U.S.C. 120](#) or [365\(c\)](#) of an international application filed prior to November 29, 2000, apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

(4) Examiners should be aware that although a publication of, or a U.S. Patent issued from, an international application may not have a [pre-AIA 35 U.S.C. 102\(e\)](#) date at all, or may have a [pre-AIA 35 U.S.C. 102\(e\)](#) date that is after the effective filing date of the claimed invention in an application being examined (so it is not “prior art”), the corresponding WIPO publication of an international application may have an earlier [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#) date.

(D) Foreign application filing dates that are claimed (via [35 U.S.C. 119\(a\)-\(d\)](#), [\(f\)](#), or [365\(a\)](#) or [\(b\)](#)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as [pre-AIA 35 U.S.C.](#)

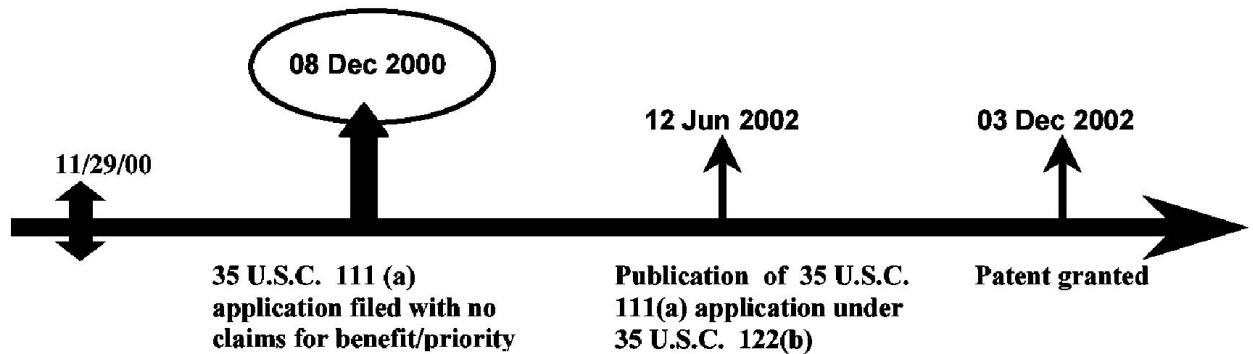
[102\(e\)](#) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under [35 U.S.C. 365\(a\)](#) or [\(b\)](#).

## II. EXAMPLES

In order to illustrate the prior art dates of U.S. and WIPO **publications** of patent applications and U.S. **patents** under [pre-AIA 35 U.S.C. 102\(e\)](#), nine examples are presented below. The examples only cover the most common factual situations that might be encountered when determining the [pre-AIA 35 U.S.C. 102\(e\)](#) date of a reference. Examples 1 and 2 involve only U.S. application publications and U.S. patents. Example 3 involves a priority claim to a foreign patent application. Examples 4-9 involve international applications. The **time lines** in the examples below show the history of the prior art **references** that could be applied against the claims of the application under examination, or the patent under reexamination.

The examples show only the information necessary to determine a prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#). Also, the dates in the examples below are arbitrary and are presented for illustrative purposes only. Thus, for example, correlation of patent grant dates with Tuesdays or application publication dates with Thursdays may not be portrayed in the examples. All references to [35 U.S.C. 102](#) in the examples and flowcharts below are to the version of [35 U.S.C. 102](#) in effect on March 15, 2013 (the pre-AIA version).

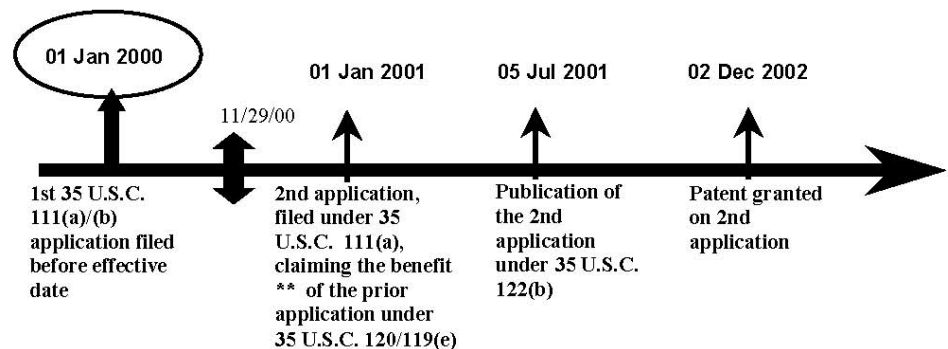
**Example 1:** Reference Publication and Patent of [35 U.S.C. 111\(a\)](#) Application with no Priority/Benefit Claims. For reference publications and patents of patent applications filed under [35 U.S.C. 111\(a\)](#) with no claim for the benefit of, or priority to, a prior application's filing date, the prior art dates under [pre-AIA 35 U.S.C. 102\(e\)](#) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a [35 U.S.C. 111\(a\)](#) application, which does not claim any benefit under either [35 U.S.C. 119\(e\)](#), [120](#), [365\(c\)](#) or [386\(c\)](#), would be accorded the application's actual filing date as its prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#).



The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication is 08 Dec. 2000. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 08 Dec. 2000.

**Example 2: Reference Publication and Patent of 35 U.S.C. 111(a) Application with a Benefit Claim to a Prior U.S. Provisional or Nonprovisional Application.**

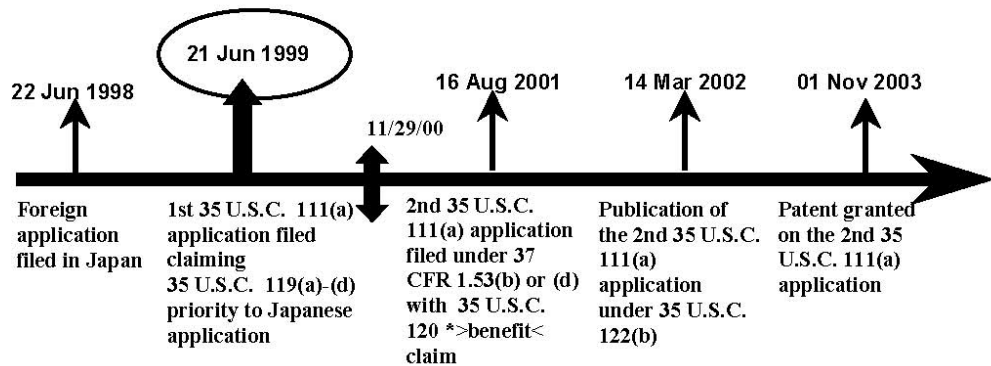
For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under pre-AIA 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. A publication and patent of a 35 U.S.C. 111(a) application that claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application would be accorded the earlier filing date as its prior art date under pre-AIA 35 U.S.C. 102(e), provided the earlier-filed nonprovisional application has proper support for the subject matter as required by 35 U.S.C. 120. A publication and patent of a 35 U.S.C. 111(a) application that claims benefit under 35 U.S.C. 119(e) to a prior provisional application would be accorded the earlier filing date as its prior art date under pre-AIA 35 U.S.C. 102(e), provided that the provisional application has proper support for the subject matter as required by 35 U.S.C. 119(e) and that at least one claim of the reference is supported by the written description of the relied upon provisional application in compliance with pre-AIA 35 U.S.C. 112, first paragraph, or 35 U.S.C. 112(a). See MPEP § 2136.03, subsection III.



The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication is: 01 Jan. 2000. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 01 Jan. 2000.

**Example 3:** Reference Publication and Patent of [35 U.S.C. 111\(a\)](#) Application with [35 U.S.C. 119\(a\)-\(d\)](#) Priority Claim to a Prior Foreign Application.

For reference publications and patents of patent applications filed under [35 U.S.C. 111\(a\)](#), the prior art dates under [pre-AIA 35 U.S.C. 102\(e\)](#) accorded to these references are the earliest effective U.S. filing dates. No benefit of the filing date of the foreign application is given under [pre-AIA 35 U.S.C. 102\(e\)](#) for prior art purposes (*In re Hilmer*, 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a [35 U.S.C. 111\(a\)](#) application, which claims priority under [35 U.S.C. 119\(a\)-\(d\)](#) to a prior foreign-filed application (or under [35 U.S.C. 365\(a\)](#) to an international application), would be accorded its U.S. filing date as its prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#). In the example below, it is assumed that the earlier-filed U.S. application has proper support for the subject matter of the later-filed U.S. application as required by [35 U.S.C. 120](#).

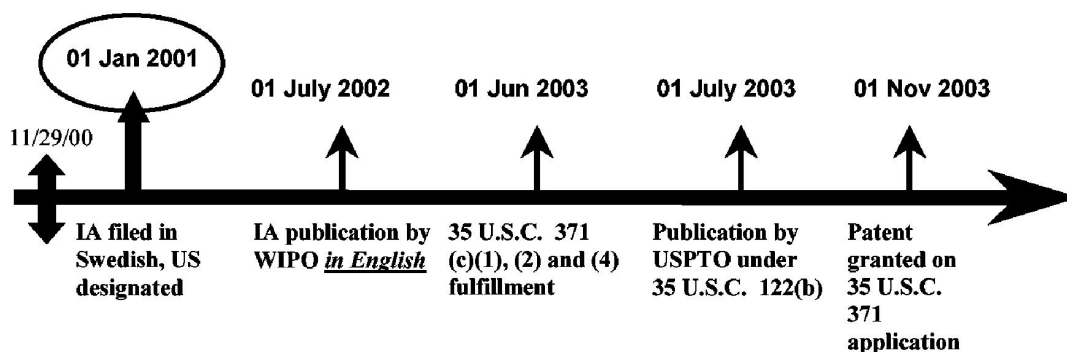


The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication is: 21 June 1999. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 21 June 1999.

**Example 4:** References based on the **national stage** ([35 U.S.C. 371](#)) of an **International Application filed on or after November 29, 2000** and which was published in **English** under [PCT Article 21\(2\)](#).

All references have the [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date of the international filing date or earlier effective U.S. filing date, regardless of whether the references are a WIPO publication, a U.S. patent application publication or a U.S. patent, of an international application (IA) that was filed on or after November 29, 2000, designated the U.S., and was published in English under [PCT Article 21\(2\)](#) by WIPO. No benefit of the international filing date (or of any U.S. filing dates prior to the IA), however, is given for [pre-AIA 35 U.S.C. 102\(e\)](#) prior art purposes if the IA was published under [PCT Article 21\(2\)](#) in a language other than English.





The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: 01 Jan. 2001. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Jan. 2001. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 01 Jan. 2001.

#### Additional Benefit Claims:

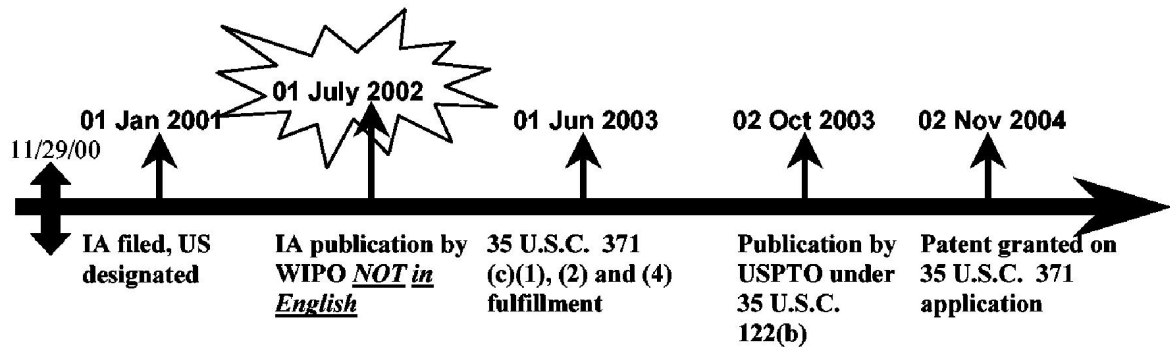
If a later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the IA in the example above, the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent or publication of the later-filed U.S. application would be the international filing date, provided the earlier-filed IA has proper support for the subject matter relied upon as required by [35 U.S.C. 120](#).

If the IA properly claimed the benefit of an earlier-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application, the [pre-AIA 35 U.S.C. 102\(e\)](#) date for all the references would be the filing date of the earlier-filed U.S. application, provided the earlier-filed application has proper support for the subject matter relied upon as required by [35 U.S.C. 120](#).

If the IA properly claimed the benefit of an earlier-filed U.S. provisional ([35 U.S.C. 111\(b\)](#)) application, the [pre-AIA 35 U.S.C. 102\(e\)](#) date would be the filing date of the provisional application provided that the provisional application has proper support for the subject matter as required by [35 U.S.C. 119\(e\)](#) and that at least one claim of the IA is supported by the written description of the relied upon provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#). See [MPEP § 2136.03](#), subsection III.

**Example 5:** References based on the **national stage** ([35 U.S.C. 371](#)) of an **International Application filed on or after November 29, 2000** and which was **not** published in **English** under [PCT Article 21\(2\)](#).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000, but was **not** published in **English** under [PCT Article 21\(2\)](#) have no [35 U.S.C. 102\(e\)](#) prior art date at all. According to [pre-AIA 35 U.S.C. 102\(e\)](#), no benefit of the international filing date (or of any U.S. filing dates prior to the IA) is given for [pre-AIA 35 U.S.C. 102\(e\)](#) prior art purposes if the IA was published under [PCT Article 21\(2\)](#) in a language other than English, regardless of whether the international application entered the national stage. Such references may be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of their publication dates, but never under [pre-AIA 35 U.S.C. 102\(e\)](#).



The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: None.

The IA publication by WIPO can be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date (01 July 2002).

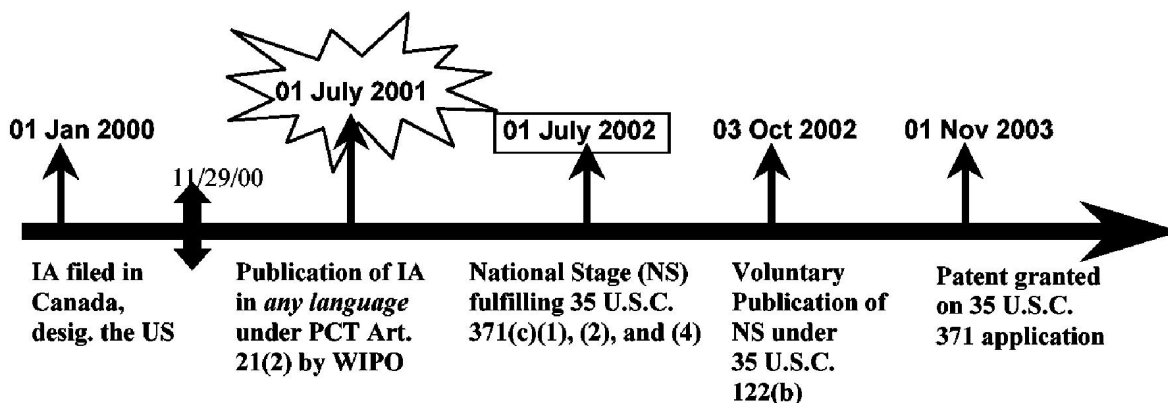
#### Additional Benefit Claims:

If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no [pre-AIA 35 U.S.C. 102\(e\)](#) date for all the references.

If a later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the IA in the example above, the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.

**Example 6:** References based on the national stage ([35 U.S.C. 371](#)) of an **International Application filed prior to November 29, 2000** (language of the publication under [PCT Article 21\(2\)](#) is not relevant).

The reference U.S. patent issued from an international application (IA) that was filed prior to November 29, 2000, has a [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date of the date of fulfillment of the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#). This is the former pre-AIPA 35 U.S.C. 102(e). The application publications, both the WIPO publication and the U.S. publication, published from an international application that was filed prior to November 29, 2000, do not have any [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date. According to the effective date provisions as amended by Public Law 107-273, the amendments to [pre-AIA 35 U.S.C. 102\(e\)](#) and [374](#) are not applicable to international applications having international filing dates prior to November 29, 2000. The application publications can be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of their publication dates.



The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None. The pre-AIA 35 U.S.C. 102(e) date for the Patent is: 01 July 2002.

The IA publication by WIPO can be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [\(b\)](#) as of its publication date (01 July 2001).

#### Additional Benefit Claims:

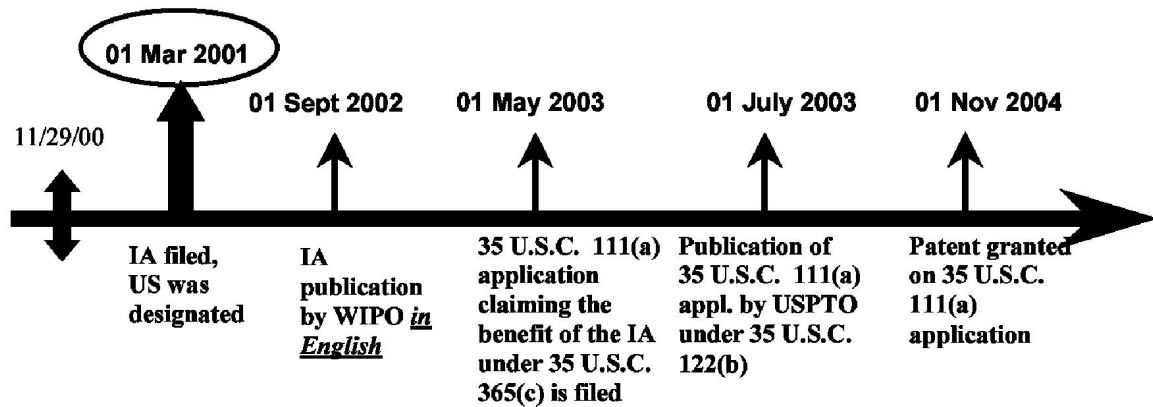
If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) date for the U.S. and WIPO application publications, and the [pre-AIA 35 U.S.C. 102\(e\)](#) date for the patent will still be 01 July 2002 (the date of fulfillment of the requirements under [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#)).

If a later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the IA in the example above, the [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) date of the application publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application, and the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#)).

If the patent was based on a later-filed U.S. application that claimed the benefit of the international application and the later filed U.S. application's filing date is before the date the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled (if fulfilled at all), the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent would be the filing date of the later-filed U.S. application that claimed the benefit of the international application.

**Example 7:** References based on a [35 U.S.C. 111\(a\)](#) Application which is a **Continuation of an International Application**, which was filed on or after **November 29, 2000, designated the U.S.** and was **published in English** under [PCT Article 21\(2\)](#).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of or claiming the benefit of, an international application (IA) that was filed on or after November 29, 2000, designated the U.S., and was published in English under [PCT Article 21\(2\)](#) have the [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date of the international filing date or earlier effective U.S. filing date. No benefit of the international filing date (or of any U.S. filing dates prior to the IA), however, is given for [pre-AIA 35 U.S.C. 102\(e\)](#) purposes if the IA was published under [PCT Article 21\(2\)](#) by WIPO in a language other than English. In the example below, it is assumed that the earlier-filed IA has proper support for the subject matter of the later-filed U.S. application as required by [35 U.S.C. 120](#) and [365\(c\)](#).



The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: 01 Mar. 2001. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Mar. 2001. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 01 Mar. 2001.

Additional Benefit Claims:

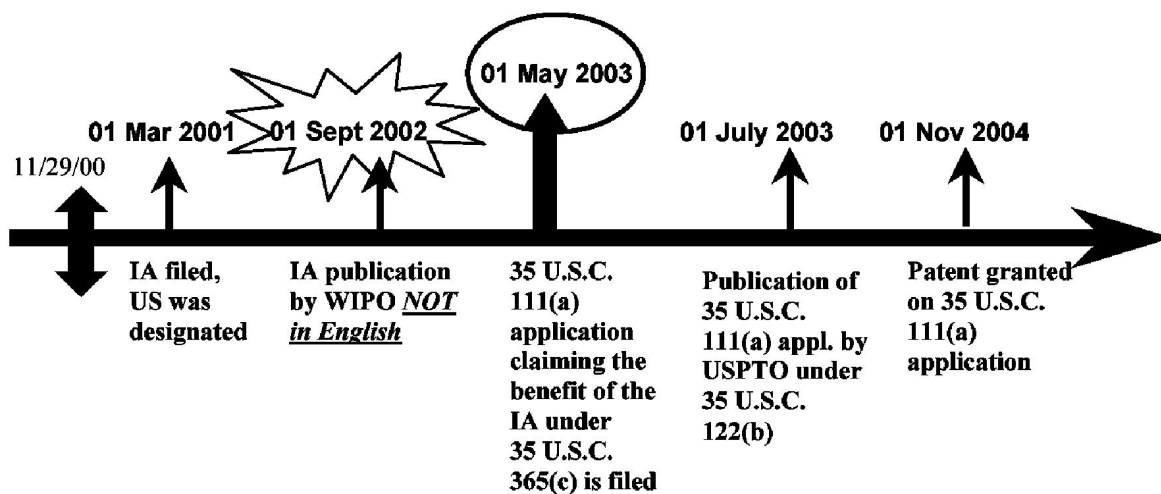
If the IA properly claimed the benefit of an earlier-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application, the [pre-AIA 35 U.S.C. 102\(e\)](#) date for all the references would be the filing date of the earlier-filed U.S. application, provided the earlier-filed application has proper support for the subject matter relied upon as required by [35 U.S.C. 120](#).

If the IA properly claimed the benefit of an earlier-filed U.S. provisional ([35 U.S.C. 111\(b\)](#)) application, the [pre-AIA 35 U.S.C. 102\(e\)](#) date for all the references would be the filing date of the earlier-filed U.S. application provided that the provisional application has proper support for the subject matter as required by [35 U.S.C. 119\(e\)](#) and that at least one claim of the IA is supported by the written description of the relied upon provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#). See [MPEP § 2136.03](#), subsection III.

If a second, later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the [35 U.S.C. 111\(a\)](#) application in the example above, the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent or publication of the second, later-filed U.S. application would still be the international filing date of the IA, provided the earlier-filed IA has proper support for the subject matter relied upon as required by [35 U.S.C. 120](#) and [365\(c\)](#).

**Example 8:** References based on a [35 U.S.C. 111\(a\)](#) Application which is a **Continuation of an International Application**, which was **filed on or after November 29, 2000** and was **not published in English** under [PCT Article 21\(2\)](#).

Both the U.S. publication and the U.S. patent of the [35 U.S.C. 111\(a\)](#) continuation of an international application (IA) that was filed on or after November 29, 2000 but **not** published in English under [PCT Article 21\(2\)](#) have the [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date of the actual U.S. filing date of the [35 U.S.C. 111\(a\)](#) application. No benefit of the international filing date (or of any U.S. filing dates prior to the IA) is given for [pre-AIA 35 U.S.C. 102\(e\)](#) purposes because the IA was published under [PCT Article 21\(2\)](#) in a language other than English. The IA publication under [PCT Article 21\(2\)](#) does not have a prior art date under [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) because the IA was not published in English under [PCT Article 21\(2\)](#). The IA publication under [PCT Article 21\(2\)](#) can be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date.



The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 May 2003. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 01 May 2003

The IA publication by WIPO can be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date (01 Sept 2002).

#### Additional Benefit Claims:

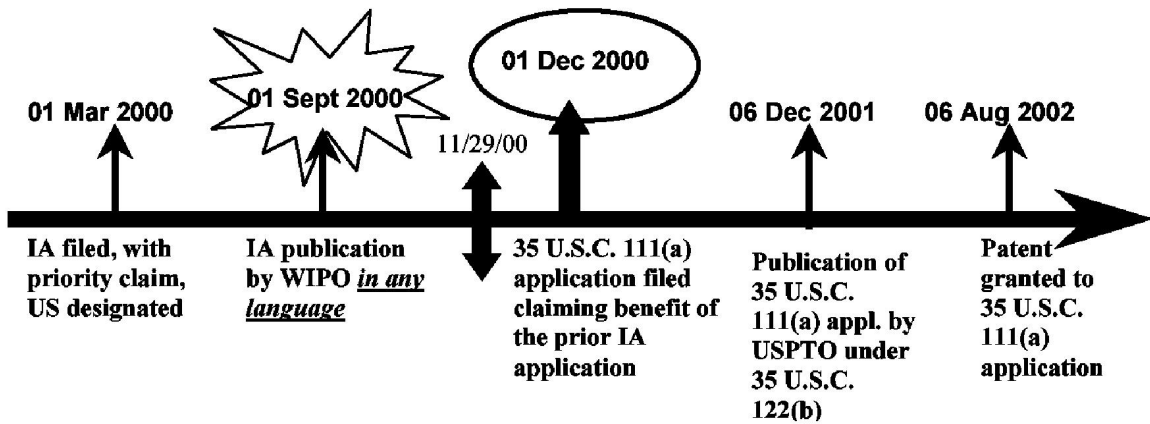
If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) date for the IA publication by WIPO, and the U.S. patent application publication and patent would still have a [pre-AIA 35 U.S.C. 102\(e\)](#) date of the actual filing date of the later-filed [35 U.S.C. 111\(a\)](#) application in the example above (01 May 2003).

If a second, later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the [35 U.S.C. 111\(a\)](#) application in the example above, the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the [35 U.S.C. 111\(a\)](#) application in the example above (01 May 2003).

**Example 9:** References based on a [35 U.S.C. 111\(a\)](#) Application which is a **Continuation** (filed prior to any entry of the national stage) of an **International Application**, which was **filed prior to November 29, 2000** (language of the publication under [PCT Article 21\(2\)](#) is not relevant).

Both the U.S. publication and the U.S. patent of the [35 U.S.C. 111\(a\)](#) continuation (filed prior to any entry of the national stage) of an international application (IA) that was filed prior to November 29, 2000, have the [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date of their actual U.S. filing date under [35 U.S.C. 111\(a\)](#). No benefit of the international filing date (or of any U.S. filing dates prior to the IA) is given for [pre-AIA 35 U.S.C. 102\(e\)](#) prior art purposes since the IA was filed prior to November 29, 2000. The IA publication under [PCT Article 21\(2\)](#) does not have a prior art date under [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) because the IA was filed prior to November 29, 2000. The IA publication under [PCT Article 21\(2\)](#) can be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date.





The pre-AIA 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None. The pre-AIA 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Dec. 2000. The pre-AIA 35 U.S.C. 102(e)(2) date for the Patent is: 01 Dec. 2000.

The IA publication by WIPO can be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or (b) as of its publication date (01 Sept 2000).

**Additional Benefit Claims:**

If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a [pre-AIA 35 U.S.C. 102\(e\)](#) date of the actual filing date of the later-filed [35 U.S.C. 111\(a\)](#) application in the example above (01 Dec 2000).

If a second, later-filed U.S. nonprovisional ([35 U.S.C. 111\(a\)](#)) application claimed the benefit of the [35 U.S.C. 111\(a\)](#) application in the example above, the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the [35 U.S.C. 111\(a\)](#) application in the example above (01 Dec 2000).

**III. FLOWCHARTS**

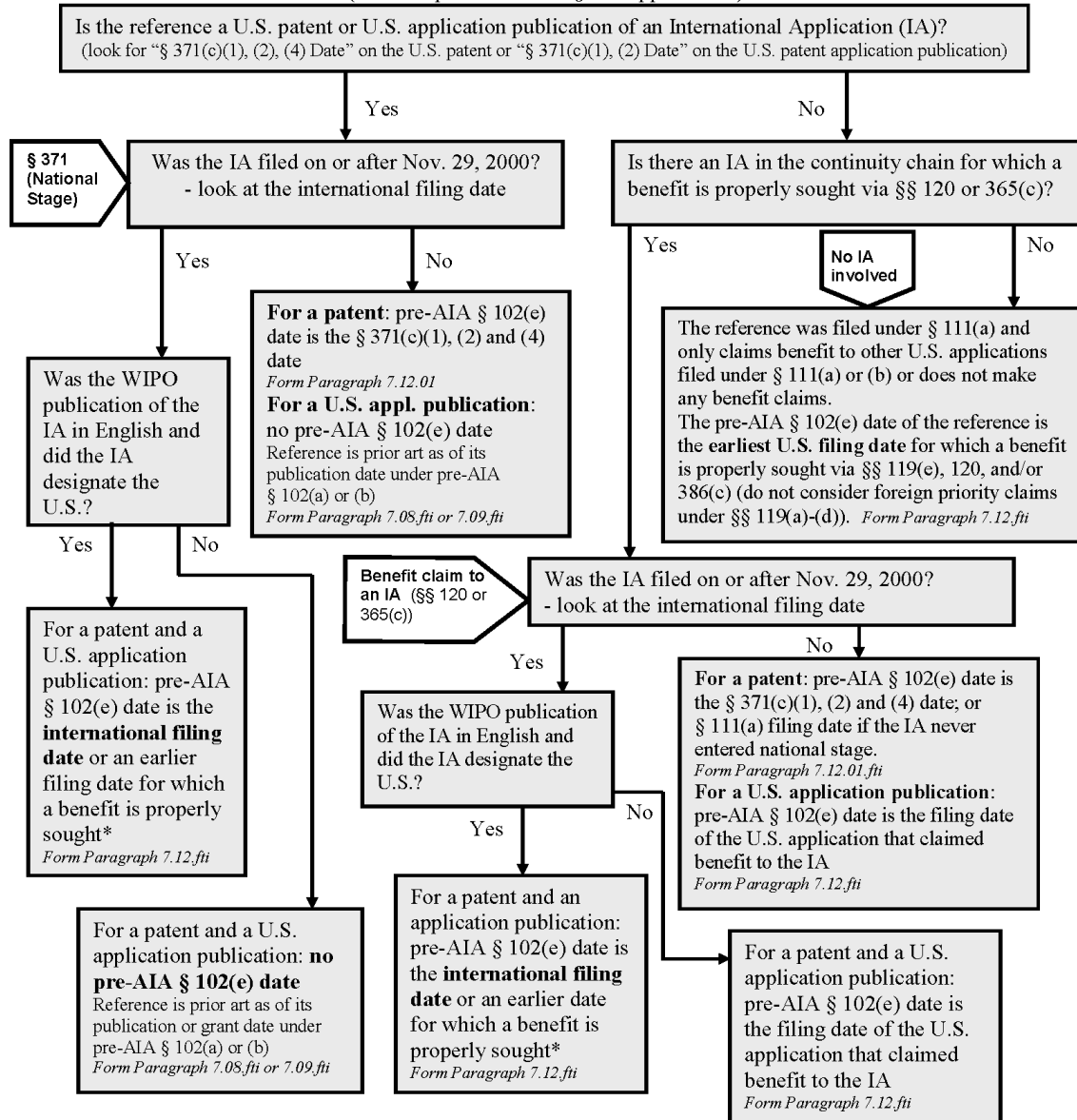
The following flowcharts provide guidance for determining the [pre-AIA 35 U.S.C. 102\(e\)](#) date, if any, for a U.S. patent, U.S. patent application publication, or international application publication. Note that for benefit claims under [35 U.S.C. 119\(e\)](#), the critical reference date under [pre-AIA 35 U.S.C.](#)

[102\(e\)](#) may be the filing date of a relied upon provisional application **only** if at least one of the claims in the reference patent, patent application publication, or international application publication is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#). See [MPEP § 2136.03](#), subsection III.

**FLOWCHARTS FOR PRE-AIA 35 U.S.C. § 102(e) DATES:**

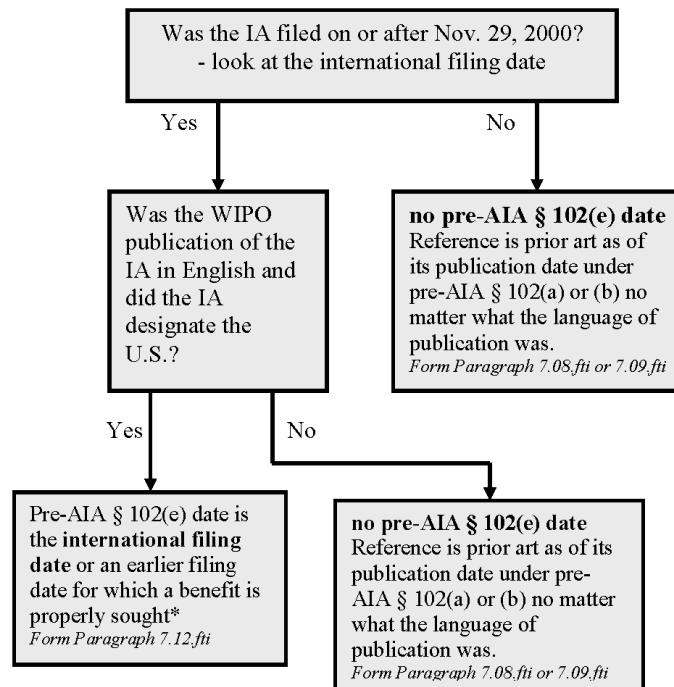
**Apply to all applications and patents, whenever filed**

**Chart I:** For U.S. patent or U.S. patent application publication under §122(b)  
(includes publications of § 371 applications)



\* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

**FLOWCHARTS FOR PRE-AIA 35 U.S.C. § 102(e) DATES:**  
**Apply to all applications and patents, whenever filed**  
**Chart II: For WIPO publication of International Applications (IAs)**



\* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

**Glossary of Terms:**

**U.S. patent application publication** = pre-grant publication by the USPTO under § 122(b)

**International application (IA)** = an application filed under the Patent Cooperation Treaty (PCT)

**§ 371 application** = an IA that has entered the national stage in the U.S. (35 U.S.C. § 371(c)(1), (2) and (4))

**November 29, 2000** = the effective date for the amendments to pre-AIA § 102(e) and § 374

**WIPO** = World Intellectual Property Organization

**WIPO Publication** = a publication of an IA under PCT Article 21(2) (e.g., Publication No. WO 99/12345)

**§ 111(a)** = provision of the patent code that states the **filing** requirements for **nonprovisional applications**

**§ 111(b)** = provision of the patent code that states the **filing** requirements for **provisional applications**

**§ 119(e)** = provision of the patent code that allows for **priority claims to provisional applications**

**§ 119(a)-(d)** = provision of the patent code that allows for **priority claims to foreign applications**

**§ 120** = provision of the patent code that allows for **benefit claims to nonprovisional applications**

**§ 365(c)** = provision of the patent code that allows for **benefit claims to international applications**

**§ 386(c)** = provision of the patent code that allows for **benefit claims to international design applications**

## 2136.01 Status of Unpublished or Published as Redacted U.S. Application as a Reference Under Pre-AIA 35 U.S.C. 102(e) [R-10.2019]

[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions.]

If an earlier filed, copending, and unpublished U.S. patent application discloses subject matter which would anticipate the claims in a later filed pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) of the later filed application can be made. In addition, a provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) may be made, in certain circumstances as described below, if the earlier filed, pending application has been published as redacted ([37 CFR 1.217](#)) and the subject matter relied upon in the rejection is not supported in the redacted publication of the patent application.

### I. WHEN THERE IS NO COMMON ASSIGNEE, APPLICANT, OR INVENTOR, A U.S. APPLICATION MUST ISSUE AS A PATENT OR BE PUBLISHED AS A SIR OR AS AN APPLICATION PUBLICATION BEFORE IT IS AVAILABLE AS PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e)

In addition to U.S. patents and SIRs, certain U.S. application publications and certain international application publications are also available as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of their effective U.S. filing dates (which will include certain international filing dates).

If there is no common assignee, common applicant, or common inventor and the application was not published pursuant to [35 U.S.C. 122\(b\)](#), the confidential status of applications under [35 U.S.C. 122\(a\)](#) must be maintained and no rejection can be made relying on the earlier filed, unpublished application, or subject matter not supported in a

redacted application publication, as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#). For applications subject to [pre-AIA 35 U.S.C. 102\(g\)](#), if the filing dates of the applications are within 6 months of each other (3 months for simple subject matter) then interference may be proper. See [MPEP Chapter 2300](#). If the application with the earliest effective U.S. filing date will not be published pursuant to [35 U.S.C. 122\(b\)](#), it must be allowed to issue once all the statutory requirements are met. After the patent has issued, it may be used as a reference in a rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) in the still pending application as appropriate. See [MPEP § 2136 et seq.](#)

### II. WHEN THERE IS A COMMON ASSIGNEE, APPLICANT, OR INVENTOR, A PROVISIONAL PRE-AIA 35 U.S.C. 102(e) REJECTION OVER AN EARLIER FILED UNPUBLISHED APPLICATION CAN BE MADE

Based on the assumption that an application will ripen into a U.S. patent (or into an application publication), it is permissible to provisionally reject a later application over an earlier filed, and unpublished, application under [pre-AIA 35 U.S.C. 102\(e\)](#) when there is a common assignee, applicant, or inventor. See, e.g., *In re Irish*, 433 F.2d 1342, 167 USPQ 764 (CCPA 1970). In addition, a provisional [pre-AIA 35 U.S.C. 102\(e\)](#) rejection may be made if the earlier filed copending U.S. application has been published as redacted ([37 CFR 1.217](#)) and the subject matter relied upon in the rejection is not supported in the redacted publication of the patent application. Such a provisional rejection “serves to put applicant on notice at the earliest possible time of the possible prior art relationship between copending applications” and gives applicant the fullest opportunity to overcome the rejection by amendment or submission of evidence. In addition, since both applications are pending and usually have the same assignee, more options are available to applicant for overcoming the provisional rejection than if the other application were already issued. *Ex parte Bartfeld*, 16 USPQ2d 1714 (Bd. Pat. App. & Int. 1990) *aff’d on other grounds*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). Note that provisional rejections over [pre-AIA 35 U.S.C. 102\(e\)](#) are only authorized when there is a common inventor or assignee, otherwise the copending application prior to publication must remain confidential.

Therefore, if (1) at least one common inventor or applicant exists between the applications or the applications are commonly assigned, and (2) the effective filing dates are different; then a provisional rejection of the later-filed application should be made. The provisional rejection is appropriate in circumstances where, if the earlier-filed application is published or becomes a patent, it would constitute actual prior art under [35 U.S.C. 102](#). Because the earlier-filed application is not published at the time of the rejection, the rejection must be provisionally made under [pre-AIA 35 U.S.C. 102\(e\)](#).

A provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) can be overcome in the same manner that a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection can be overcome. See [MPEP § 2136.05](#). The provisional rejection can also be overcome by abandoning the applications and filing a new application containing the subject matter of both. Form paragraph 7.15.01.fti should be used when making a provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#).

### III. PROVISIONAL REJECTION UNDER PRE-AIA 35 U.S.C. 103(a) CAN BE MADE USING PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e)

For applications filed on or after November 29, 1999 or pending on or after December 10, 2004, a provisional rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) using prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) is not proper if the application contains evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made. See [pre-AIA 35 U.S.C. 103\(c\)](#).

In addition, certain non-commonly owned references may be disqualified from being applied in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) due to the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act) (Public Law 108-453; 118 Stat. 3596 (2004)), which was enacted on December 10, 2004 and was effective for all patents granted on or after December 10, 2004.

See [MPEP §§ 2146-2146.03](#) for information pertaining to prior art disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#), evidence of common ownership,

and examination procedure with respect to [pre-AIA 35 U.S.C. 103\(c\)](#); see [MPEP § 2146.03\(a\)](#) for a discussion of provisional rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) using provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#).

[Pre-AIA 35 U.S.C.103\(c\)](#), as amended by the CREATE Act, continues to apply only to subject matter which qualifies as prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) or \(g\)](#), and which is being relied upon in a rejection under [35 U.S.C. 103](#). It does not apply to or affect subject matter which is applied in a rejection under [pre-AIA 35 U.S.C. 102](#) or a double patenting rejection (see [37 CFR 1.78\(c\)](#) and [MPEP § 804](#)). In addition, if the subject matter qualifies as prior art under any other subsection of [pre-AIA 35 U.S.C. 102](#) (e.g., [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#)) it will not be disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#). See also [MPEP § 2146 et seq.](#) for information relating to rejections under [pre-AIA 35 U.S.C. 103](#) and evidence of joint research agreements.

### 2136.02 Content of the Prior Art Available Against the Claims [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions.]*

#### I. A 35 U.S.C. 102(e) REJECTION MAY RELY ON ANY PART OF THE PATENT OR APPLICATION PUBLICATION DISCLOSURE

Under [pre-AIA 35 U.S.C. 102\(e\)](#), the entire disclosure of a U.S. patent, a U.S. patent application publication, or an international application publication having an earlier effective U.S. filing date (which will include certain international filing dates) can be relied on to reject the claims. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989). See [MPEP § 2120.01](#).



## II. REFERENCE MUST ITSELF CONTAIN THE SUBJECT MATTER RELIED ON IN THE REJECTION

When a U.S. patent, a U.S. patent application publication, or an international application publication is used to reject claims under [pre-AIA 35 U.S.C. 102\(e\)](#), the disclosure relied on in the rejection must be present in the issued patent or application publication. It is the earliest effective U.S. filing date (which will include certain international filing dates) of the U.S. patent or application publication being relied on as the critical reference date and subject matter not included in the patent or application publication itself can only be used when that subject matter becomes public. Portions of the patent application which were canceled are not part of the patent or application publication and thus cannot be relied on in a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection over the issued patent or application publication. *Ex parte Stalego*, 154 USPQ 52 (Bd. App. 1966). Similarly, subject matter that is disclosed in an abandoned, unpublished parent application but was not carried over into the child patent or application publication may not be relied on as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#). *In re Klesper*, 397 F.2d 882, 886, 158 USPQ 256, 258 (CCPA 1968). See [MPEP § 901.02](#) for more information on availability of abandoned applications as prior art. Likewise, subject matter which is disclosed in a parent application, but not included in the child continuation-in-part (CIP) cannot be relied on in a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection over the issued or published CIP. *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967) (The examiner made a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection over an issued U.S. patent which was a continuation-in-part (CIP). The parent application of the U.S. patent reference contained an example 2 which was not carried over to the CIP. The court held that the subject matter embodied in the canceled example 2 could not be relied on as of either parent or child filing date. Thus, the use of example 2 subject matter to reject the claims under [pre-AIA 35 U.S.C. 102\(e\)](#) was improper.).

Where a U.S. patent claims benefit to a provisional application, at least one claim of the patent must be supported by the disclosure of the relied upon provisional application in compliance with [pre-AIA](#)

[35 U.S.C. 112, first paragraph](#), in order for the patent to be usable as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the relied upon provisional application's filing date. See [MPEP § 2136.03](#), subsection III.

## III. THE SUPREME COURT HAS AUTHORIZED 35 U.S.C. 103 REJECTIONS BASED ON PRE-AIA 35 U.S.C. 102(e)

U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. Obviousness can be shown by combining other prior art with the U.S. patent reference in a [35 U.S.C. 103](#) rejection. *Hazeltine Research v. Brenner*, 382 U.S. 252, 147 USPQ 429 (1965). Similarly, certain U.S. application publications and certain international application publications may also be used as of their earliest effective U.S. filing dates (which will include certain international filing dates) to show that the claimed subject matter would have been anticipated or obvious.

See [MPEP § 2146](#) *et seq.* for additional information on rejections under [35 U.S.C. 103](#) and evidence of common ownership or a joint research agreement.

## 2136.03 Critical Reference Date [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) *et seq.* for examination of applications subject to those provisions.]*

### I. FOREIGN PRIORITY DATE

*Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the Pre-AIA 35 U.S.C. 102(e) Reference Date*

[Pre-AIA 35 U.S.C. 102\(e\)](#) is explicitly limited to certain references “filed in the United States before the invention thereof by the applicant” (emphasis added). Foreign applications' filing dates that are claimed (via [35 U.S.C. 119\(a\)–\(d\), \(f\)](#) or [35 U.S.C. 365\(a\)](#)) in applications, which have been published as U.S. or WIPO application publications or patented

in the U.S., may not be used as [pre-AIA 35 U.S.C. 102\(e\)](#) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under [35 U.S.C. 365\(a\)](#). Therefore, the foreign priority date of the reference under [35 U.S.C. 119\(a\)-\(d\), \(f\)](#), and [35 U.S.C. 365\(a\)](#) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the [pre-AIA 35 U.S.C. 102\(e\)](#) rejection by proving the applicant is entitled to the [35 U.S.C. 119](#) priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection. Because the U.S. filing date of Habicht was later than the German priority date of the application, the rejection was reversed.). See [MPEP § 216](#) for information on procedures to be followed in considering applicant's right of priority.

Note that certain international application (PCT) filings are considered to be "filings in the United States" for purposes of applying an application publication as prior art. See [MPEP § 2120.01](#).

## II. INTERNATIONAL (PCT) APPLICATIONS; INTERNATIONAL APPLICATION PUBLICATIONS

### A. *International Application Filed On or After November 29, 2000*

If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(A) If the international application meets the following three conditions:

- (1) an international filing date on or after November 29, 2000;
- (2) designated the United States; and
- (3) published under [PCT Article 21\(2\)](#) in English,

the international filing date is a U.S. filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#). If such an international application properly claims benefit to an earlier-filed U.S. or international application, apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the earlier filing date, provided all the conditions of [pre-AIA 35 U.S.C. 102\(e\)](#) and [35 U.S.C. 120](#) or [365\(c\)](#) are met. In addition, the subject matter relied upon in the rejection must be disclosed in the earlier-filed application in compliance with [35 U.S.C. 112\(a\)](#) /[pre-AIA 35 U.S.C. 112](#), first paragraph, in order to give that subject matter the benefit of the earlier filing date under [pre-AIA 35 U.S.C. 102\(e\)](#). If such an international application properly claims benefit to an earlier-filed U.S. provisional application, apply the reference under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the earlier filing date, provided that the provisional application has proper support for the subject matter as required by [35 U.S.C. 119\(e\)](#) and that at least one claim of the international application is supported by the written description of the relied upon provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See [MPEP § 2136.03](#), subsection III. Note: where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and published in English under [PCT Article 21\(2\)](#)) for the earlier international filing date to be the U.S. filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#).

(B) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under [PCT Article 21\(2\)](#), do **not** treat the international filing date as a U.S. filing date. In this situation, do **not** apply the reference as of its international filing date, its date of completion of the [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date, or [pre-AIA 35 U.S.C. 102\(e\)](#) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

### ***B. International Application Filed Before November 29, 2000***

References based on international applications that were filed prior to November 29, 2000 are subject to the pre-AIPA version of 35 U.S.C. 102(e) (i.e., the version in force on November 28, 2000) as set forth below.

#### **Former 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent (as in force on November 28, 2000).**

A person shall be entitled to a patent unless-

\*\*\*\*\*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of [section 371\(c\)](#) of this title before the invention thereof by the applicant for patent.

\*\*\*\*\*

If an international application has an international filing date prior to November 29, 2000, the reference should be applied under the provisions of 35 U.S.C. 102 and 374 as in force on November 28, 2000 (prior to the AIPA amendments):

(1) For U.S. patents, apply the reference under [35 U.S.C. 102\(e\)](#) as in force on November 28, 2000 as of the earlier of the date of completion of the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) or the filing date of the later-filed U.S. application that claimed the benefit of the international application;

(2) For U.S. application publications and WIPO publications directly resulting from international applications under [PCT Article 21\(2\)](#), never apply these references under [35 U.S.C. 102\(e\)](#) as in force on November 28, 2000. These references may be applied as of their publication dates under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#);

(3) For U.S. application publications of applications that claim the benefit under [35 U.S.C. 120](#) or [365\(c\)](#) of an international application filed prior to November 29, 2000, apply the reference under [35 U.S.C. 102\(e\)](#) as in force on November 28, 2000 as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

Examiners should be aware that although a publication of, or a U.S. patent issued from, an international application may not be available as prior art under former 35 U.S.C. 102(e) as in force on November 28, 2000 or under [pre-AIA 35 U.S.C. 102\(e\)](#), the corresponding WIPO publication of an international application may have an earlier [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) date.

### **III. BENEFIT OF PROVISIONAL APPLICATION UNDER 35 U.S.C. 119(e)**

The critical reference date under [pre-AIA 35 U.S.C. 102\(e\)](#) of a U.S. patent, a U.S. patent application publication, as well as an international application publication having prior art effect under [pre-AIA 35 U.S.C. 102\(e\)](#), may be the filing date of a relied upon provisional application only if at least one of the claims in the reference patent, patent application publication, or international application publication is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#). See *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380, 124 USPQ2d 1354, 1363 (Fed. Cir. 2017); *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015). *Dynamic Drinkware* does not apply to [AIA 35 U.S.C. 102\(d\)](#). In other words, *Dynamic Drinkware* only applies to applications and patents subject to [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2154.01\(b\)](#) for information on determining the effectively filed date under [AIA 35 U.S.C. 102\(d\)](#). The provisional application must also describe, in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, or [35 U.S.C. 112\(a\)](#), the subject matter relied upon in the reference patent or publication to make the rejection. See [MPEP § 2136](#), examples 2, 4, and 7.

Note that international applications which (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under [PCT Article 21\(2\)](#) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#).

#### IV. BENEFIT OF NONPROVISIONAL APPLICATION UNDER 35 U.S.C. 120

##### *Filing Date of U.S. Parent Application Can Only Be Used as the Pre-AIA 35 U.S.C. 102(e) Date If It Supports the Subject Matter Relied Upon in the Continuing Application*

For prior art purposes, a U.S. patent or patent application publication that claims the benefit of an earlier filing date under [35 U.S.C. 120](#) of a prior nonprovisional application (i.e., a continuation, divisional, or continuation-in-part application) would be accorded the earlier filing date as its prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#), provided the earlier-filed application properly supports the subject matter relied upon in any rejection in compliance with [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. In other words, the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, in order for that subject matter to be entitled to the earlier filing date under [pre-AIA 35 U.S.C. 102\(e\)](#).

See also [MPEP § 2136](#), examples 2 and 5 to 9.

#### V. DATE OF CONCEPTION OR REDUCTION TO PRACTICE

##### *Pre-AIA 35 U.S.C. 102(e) Reference Date Is the Filing Date, Not Date of Inventor's Conception or Reduction to Practice*

If a reference available under [pre-AIA 35 U.S.C. 102\(e\)](#) discloses, but does not claim the subject matter of the claims being examined or an obvious variant, the reference is not prior art under [pre-AIA 35 U.S.C. 102\(g\)](#). Furthermore, the reference does not qualify as “prior art” under [35 U.S.C. 102](#) as of a date earlier than its filing date based upon any prior inventive activity that is disclosed in the U.S. patent or U.S. patent application publication in the absence of evidence that the subject matter was actually reduced to practice in this country on an earlier date. See [MPEP § 2138](#). When the cases are not in interference, the effective date of the reference as prior art is its filing date in the United States (which will include certain international filing dates), as stated in [pre-AIA 35 U.S.C. 102\(e\)](#). See [MPEP §§](#)

[2120.01](#) and [2136](#). The date that the prior art subject matter was conceived or reduced to practice is of no importance when [pre-AIA 35 U.S.C. 102\(g\)](#) is not at issue. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989) (The defendant sought to invalidate patents issued to Mason and Sohn assigned to Sun Studs. The earliest of these patents issued in June 1973. A U.S. patent to Mouat was found which issued in March 1976 and which disclosed the invention of Mason and Sohn. While the patent to Mouat issued after the Mason and Sohn patents, it was filed 7 months earlier than the earliest of the Mason and Sohn patents. Sun Studs submitted affidavits showing conception in 1969 and diligence to the constructive reduction to practice and therefore antedated the patent to Mouat. The defendant sought to show that Mouat conceived the invention in 1966. The court held that conception of the subject matter of the [reference](#) only becomes an issue when the claims of the conflicting patents cover inventions which are the same or obvious over one another. When [pre-AIA 35 U.S.C. 102\(e\)](#) applies but not [pre-AIA 35 U.S.C. 102\(g\)](#), the filing date of the prior art patent is the earliest date that can be used to reject or invalidate claims.).

#### 2136.04 Different Inventive Entity; Meaning of “By Another” [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions.]*

##### I. IF THERE IS ANY DIFFERENCE IN THE INVENTIVE ENTITY, THE REFERENCE IS “BY ANOTHER”

“Another” means other than applicants, *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966), in other words, a different inventive entity. The inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App.



& Inter. 1992) (The examiner made a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection based on an issued U.S. patent to three inventors. The rejected application was a continuation-in-part of the issued parent with an extra inventor. The Board found that the patent was “by another” and thus could be used in a [pre-AIA 35 U.S.C. 102\(e\)/103](#) rejection of the application.).

## II. A DIFFERENT INVENTIVE ENTITY IS *PRIMA FACIE* EVIDENCE THAT THE REFERENCE IS “BY ANOTHER”

As stated by the House and Senate reports on the bills enacting section [pre-AIA 35 U.S.C. 102\(e\)](#) as part of the 1952 Patent Act, this subsection of [102](#) codifies the Milburn rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390, 1926 C.D. 303, 344 O.G. 817 (1926). The Milburn rule authorized the use of a U.S. patent containing a disclosure of the invention as a reference against a later filed application as of the U.S. patent filing date. The existence of an earlier filed U.S. application containing the subject matter claimed in the application being examined indicates that applicant was not the first inventor. Therefore, a U.S. patent, a U.S. patent application publication or international application publication, by a different inventive entity, whether or not the application shares some inventors in common with the patent, is *prima facie* evidence that the invention was made “by another” as set forth in [pre-AIA 35 U.S.C. 102\(e\)](#). *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969); *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). See [MPEP § 2136.05](#) *et seq.* for discussion of methods of overcoming [pre-AIA 35 U.S.C. 102\(e\)](#) rejections.

### 2136.05 Overcoming a Rejection Under Pre-AIA 35 U.S.C. 102(e) [R-10.2019]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) *et seq.* for examination of applications subject to those provisions. Information pertaining*

*to overcoming [pre-AIA 35 U.S.C. 102\(e\)](#) rejections has been moved to [MPEP § 2136.05\(a\)](#) for affidavits or declarations under [37 CFR 1.131](#) and benefit or priority claims, and to [MPEP § 2136.05\(b\)](#) for affidavits or declarations under [37 CFR 1.132](#).]*

In all applications, an applicant may overcome a [pre-AIA 35 U.S.C. 102](#) rejection by persuasively arguing that the claims are patentably distinguishable from the prior art, or by amending the claims to patentably distinguish over the prior art. Additional ways available to overcome a rejection based on [pre-AIA 35 U.S.C. 102](#) prior art depend on the applicable paragraph of [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2132.01](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) and [MPEP § 2133.02\(a\)](#) for overcoming a rejection under [pre-AIA 35 U.S.C. 102\(b\)](#).

A rejection based on [pre-AIA 35 U.S.C. 102\(e\)](#) can be overcome by:

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (B) Amending the claims to patentably distinguish over the prior art;
- (C) Filing an affidavit or declaration under [37 CFR 1.132](#) showing that the reference invention is not by “another.” See [MPEP §§ 715.01\(a\), 715.01\(c\), 716.10](#), and [2136.05\(b\)](#);
- (D) Filing an affidavit or declaration under [37 CFR 1.131\(a\)](#) showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming interfering subject matter as defined in [37 CFR 41.203\(a\)](#) (subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa). See [MPEP §§ 715](#) and [2136.05\(b\)](#) for more information on [37 CFR 1.131\(a\)](#) affidavits;
- (E) Submitting and perfecting a claim to priority under [35 U.S.C. 119\(a\) - \(d\)](#) within the time period set in [37 CFR 1.55](#) and establishing that prior foreign application disclosure satisfies the enablement and written description requirements of [35 U.S.C. 112](#) for the subject matter claimed in the application under examination (see [MPEP § 2136.05\(a\)](#) for a summary of priority requirements, and [MPEP §§ 213-216](#) for detailed information); and/or



(F) Submitting a benefit claim under [35 U.S.C. 119\(e\)](#) or [120](#), within the time periods set in [37 CFR 1.78](#) and establishing that the prior application satisfies the enablement and written description requirements of [35 U.S.C. 112](#) for the subject matter claimed in the application under examination (see [MPEP § 2136.05\(a\)](#) for a summary of benefit requirements, and [MPEP § 211](#) *et seq.* for detailed information).

### **2136.05(a) Antedating a Pre-AIA 35 U.S.C. 102(e) Reference [R-10.2019]**

When a prior U.S. patent, U.S. patent application publication, or international application publication is not a statutory bar, a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection can be overcome by antedating the filing date (see [MPEP § 2136.03](#) regarding critical reference date of [pre-AIA 35 U.S.C. 102\(e\)](#) prior art) of the reference by submitting an affidavit or declaration under [37 CFR 1.131](#). The filing date of a [pre-AIA 35 U.S.C. 102\(e\)](#) reference can also be antedated by establishing priority to, or the benefit of, the filing date of an earlier application under [35 U.S.C. 119](#) or [35 U.S.C. 120](#).

#### **I. AFFIDAVIT OR DECLARATION UNDER 37 CFR 1.131**

An affidavit or declaration under [37 CFR 1.131\(a\)](#) can overcome a prior art rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) by proving invention of the claimed subject matter by the inventor or at least one joint inventor prior to the effective date of the reference relied upon in the rejection.

When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under [37 CFR 1.131\(a\)](#) is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See [MPEP § 804](#). Note that a terminal disclaimer does not overcome a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection. See, e.g., *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). If there is

no common assignee or inventor and the rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) is the only possible rejection, the examiner must determine whether an interference should be declared. See [MPEP Chapter 2300](#) for more information regarding interferences.

For information on the required contents of a [37 CFR 1.131](#) affidavit or declaration and the situations in which such affidavits and declarations are permitted, see [MPEP § 715](#) *et seq.*

An affidavit or declaration under [37 CFR 1.131](#) is not appropriate if the reference describes an inventor's or at least one joint inventor's own work. In this case, applicant must submit an affidavit or declaration under [37 CFR 1.132](#). See [MPEP § 2136.05\(b\)](#) for more information concerning the requirements of [37 CFR 1.132](#) affidavits and declarations.

#### **II. ESTABLISHING PRIORITY TO, OR THE BENEFIT OF, AN EARLIER FILING DATE**

A rejection based on [pre-AIA 35 U.S.C. 102\(e\)](#) can be overcome by:

(A) Submitting a claim to priority under [35 U.S.C. 119\(a\) - \(d\)](#) within the time period set in [37 CFR 1.55](#):

(1)

(a) for applications filed on or after September 16, 2012, by filing a corrected application data sheet under [37 CFR 1.76](#) which identifies a prior foreign application in accordance with [37 CFR 1.55](#), or

(b) for applications filed prior to September 16, 2012, by filing a corrected application data sheet under [37 CFR 1.76](#) which identifies a prior foreign application in accordance with [37 CFR 1.55](#) or by identifying the prior foreign application in the oath or declaration under [pre-AIA 37 CFR 1.63](#),  
and

(2) by establishing that the prior foreign application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#) (for applications filed on or after September 16, 2012), or [35 U.S.C. 112](#), first paragraph (for applications filed prior to September 16, 2012); or filing a

grantable petition to accept an unintentionally delayed priority claim under [37 CFR 1.55](#). See [MPEP §§ 213 - 216](#). The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see [37 CFR 1.55](#)); and/or

(B) Submitting a benefit claim under [35 U.S.C. 119\(e\)](#) or [120](#), within the time periods set in [37 CFR 1.78](#):

(1)

(a) for applications filed on or after September 16, 2012, filing an application data sheet under [37 CFR 1.76](#) which contains a specific reference to a prior application in accordance with [37 CFR 1.78](#), or

(b) for applications filed prior to September 16, 2012, amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under [37 CFR 1.76](#) which contains a specific reference to a prior application in accordance with [37 CFR 1.78](#), and

(2) establishing that the prior application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#) (for applications filed on or after September 16, 2012), or [35 U.S.C. 112](#), first paragraph (for applications filed prior to September 16, 2012) or filing a grantable petition to accept an unintentionally delayed claim under [37 CFR 1.78](#).

The filing date of a prior application cannot be used to antedate a reference if the application at issue is not entitled to claim the benefit of the prior application under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), or [365\(c\)](#). *In re Costello*, 717 F.2d 1346, 219 USPQ 389 (Fed. Cir. 1983).

### **2136.05(b) Showing The Reference Is Describing An Inventor's Or At Least One Joint Inventor's Own Work [R-07.2022]**

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set*

*forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. Information pertaining to overcoming [pre-AIA 35 U.S.C. 102\(e\)](#) rejections has been moved to [MPEP § 2136.05\(a\)](#) for affidavits or declarations under [37 CFR 1.131](#).]*

A rejection based on [pre-AIA 35 U.S.C. 102\(e\)](#) can be overcome by filing an affidavit or declaration under [37 CFR 1.132](#) showing that the reference invention is not by “another.” “The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). The issue turns on what the evidence of record shows as to who invented the subject matter. *In re Whittle*, 454 F.2d 1193, 1195, 172 USPQ 535, 537 (CCPA 1972). In fact, even if an inventor's or at least one joint inventor's work was publicly disclosed prior to the patent application, the inventor's or at least one joint inventor's own work may not be used against the application subject to [pre-AIA 35 U.S.C. 102](#) unless there is a time bar under [pre-AIA 35 U.S.C. 102\(b\)](#). *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). However, an affidavit or declaration under [37 CFR 1.132](#) that is only a naked assertion of inventorship and that fails to provide any context, explanation or evidence to support that assertion is insufficient to show that the relied-upon subject matter was the inventor's own work. See *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017) (finding that a declaration submitted by inventor Campbell insufficient to establish that he and Guth (now deceased) were inventors of the subject matter disclosed in a patent naming Campbell, Guth, Danziger, and Padron because “[n]othing in the declaration itself, or in addition to the declaration, provides any context, explanation, or evidence to lend credence to the inventor's bare assertion” and more than twenty years had passed since the alleged events occurred. *Id.* at 1345; 123 USPQ2d at 1149). Therefore, when the unclaimed subject matter of a reference is an inventor's or at least one joint inventor's own invention, a *prima*

*facie* case based on the patent, U.S. patent application publication, or international application publication, may be overcome by showing that the disclosure is a description of the inventor's or at least one joint inventor's own previous work. Such a showing can be made by proving that the inventor(s) of the U.S. patent, U.S. patent application publication, or the international application publication, was associated with applicant (e.g., same assignee) and learned of the inventor's or at least one joint inventor's invention from the inventor or at least one joint inventor directly or indirectly. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969).

In the situation where one application is first filed naming sole inventor X and then a later application is filed naming joint inventors X & Y, it must be proven that the joint invention was made first, was thereafter described in the sole inventor's patent, or was thereafter described in the sole inventor's U.S. patent application publication or international application publication, and then the joint application was filed. *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966).

In *In re Land*, separate U.S. patents to Rogers and to Land were used to reject a joint application to Rogers and Land under [pre-AIA 35 U.S.C. 102\(e\)/103](#). The inventors worked for the same company (Polaroid) and in the same laboratory. All the patents flowed from the same research. In addition, the patent applications were prepared by the same attorneys, were interrelated and contained cross-references to each other. The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to Land) were different from the inventive entity of the joint application (Rogers and Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. There was no indication that the portions of the references relied on disclosed anything they did jointly. Nor was there a showing that what they did jointly was done before the filing of the reference patent applications.

See also *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (The examiner rejected claims to a joint application to Carreira, Kyrakakis, Solodar,

and Labana under [pre-AIA 35 U.S.C. 102\(e\)](#) and 103 in view of a U.S. patent issued to Tulagin and Carreira or a patent issued to Clark. The applicants submitted declarations under [37 CFR 1.132](#) by Tulagin and Clark in which each declarant stated he was “not the inventor of the use of compounds having a hydroxyl group in a position ortho to an azo linkage.” The court held that these statements were vague and inconclusive because the declarants did not disclose the use of this generic compound but rather species of this generic compound in their patents and it was the species which met the claims. The declaration that each did not invent the use of the generic compound does not establish that Tulagin and Clark did not invent the use of the species.)

[MPEP § 715.01\(a\)](#), [§ 715.01\(c\)](#), and [§ 716.10](#) set forth more information pertaining to the contents and uses of affidavits and declarations under [37 CFR 1.132](#) for antedating references. See [MPEP § 2146](#) for information pertaining to rejections under [pre-AIA 35 U.S.C. 102\(e\)/103](#) and the applicability of [pre-AIA 35 U.S.C. 103\(c\)](#).

#### **I. APPLICANT NEED NOT SHOW DILIGENCE OR REDUCTION TO PRACTICE WHEN THE SUBJECT MATTER DISCLOSED IN THE REFERENCE IS APPLICANT'S OWN WORK**

When the reference reflects an inventor's or at least one joint inventor's own work, evidence of diligence or reduction to practice does not need to be provided in order to establish that the inventor or at least one joint inventor invented the subject matter disclosed in the reference. A showing that the reference disclosure arose from an inventor's or at least one joint inventor's work coupled with a showing of conception by the inventor or at least one joint inventor before the filing date of the reference will overcome the [pre-AIA 35 U.S.C. 102\(e\)](#) rejection. The showing can be made by submission of an affidavit under [37 CFR 1.132](#) by the inventor or at least one joint inventor who invented the subject matter. The other joint inventors, if applicable, need not submit an affidavit disclaiming inventorship, but, if submitted, a disclaimer by all other joint inventors should be considered by the examiner. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (Declaration submitted by DeBaun stated that he was the inventor of subject matter disclosed in

the U.S. patent reference of DeBaun and Noll. Exhibits were attached to the declaration showing conception and included drawings DeBaun had prepared and given to counsel for purposes of preparing the application which issued as the reference patent. The court held that, even though the evidence was not sufficient to antedate the prior art patent under [37 CFR 1.131](#), diligence and/or reduction to practice was not required to show DeBaun invented the subject matter. Declarant's exhibits and statement that he conceived the invention was enough to show that the subject matter in the U.S. patent reference was declarant's own invention.).

## II. CLAIMING OF INDIVIDUAL ELEMENTS OR SUBCOMBINATIONS IN A COMBINATION CLAIM OF THE REFERENCE DOES NOT ITSELF ESTABLISH THAT THE INVENTOR OR AT LEAST ONE JOINT INVENTOR INVENTED THOSE ELEMENTS

The existence of combination claims in a reference is not evidence that the inventor or at least one joint inventor invented the individual elements or subcombinations included if the elements and subcombinations are not separately claimed apart from the combination. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Facius*, 408 F.2d 1396, 1406, 161 USPQ 294, 301 (CCPA 1969)).

See also *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969) (On September 15, 1961, Dewey filed an application disclosing and claiming a time delay protective device for an electric circuit. In disclosing the invention, Dewey completely described, but did not claim, a "gating means 19" invented by Mathews which was usable in the protective device. Dewey and Mathews were coworkers at General Electric Company, the assignee. Mathews filed his application on March 7, 1963, before the Dewey patent issued but almost 18 months after its filing. The Mathews application disclosed that "one illustration of a circuit embodying the present invention is shown in copending patent application S.N. 138,476-Dewey." The examiner used Dewey to reject all the Mathews claims under [pre-AIA 35 U.S.C. 102\(e\)](#). In response, Mathews submitted an affidavit by Dewey under [37 CFR 1.132](#). In the affidavit, Dewey stated that

he did not invent the gating means 19 but had learned of the gating means through Mathews and that GE attorneys had advised that the gating means be disclosed in Dewey's application to comply with [35 U.S.C. 112](#), first paragraph. The examiner argued that the only way to overcome a [pre-AIA 35 U.S.C. 102\(e\)](#) rejection was by submitting an affidavit or declaration under [37 CFR 1.131](#) to antedate the filing date of the reference. The court reversed the rejection, holding that the totality of the evidence on record showed that Dewey derived his knowledge from Mathews who is "the original, first and sole inventor.").

### 2137 Pre-AIA 35 U.S.C. 102(f) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2157](#) for rejections based on improper naming of the inventor in applications subject to the first inventor to file provisions of the AIA.]*

*"Derivation" or "derived" as used in the discussion below is in the context of pre-AIA law. "Derivation proceedings" as created in the AIA are discussed in [MPEP § 2310 et seq.](#)]*

#### **Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless -

\*\*\*\*\*

(f) he did not himself invent the subject matter sought to be patented.

\*\*\*\*\*

[Pre-AIA 35 U.S.C. 102\(f\)](#) bars the issuance of a patent where an applicant did not invent the subject matter being claimed and sought to be patented. Thus [pre-AIA 35 U.S.C. 102\(f\)](#) requires that the correct inventorship of a claimed invention be named in the patent application (and any subsequently issued patent). *In re VerHoef*, 888 F.3d 1362, 1365, 126 USPQ2d 1561, 1563 (Fed. Cir. 2018); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349-50, 47 USPQ2d



1657, 1662 (Fed. Cir. 1998). See also [35 U.S.C. 101](#), which requires that whoever invents or discovers is the party who may obtain a patent for the particular invention or discovery.

The examiner must presume the applicants are the proper inventor unless there is evidence of record that another made the invention and that the applicants derived the invention from the true inventor. In the uncommon situation where it is clear the application does not name the correct inventorship and there has been no request to correct inventorship under [37 CFR 1.48](#), the examiner should reject the claims under [pre-AIA 35 U.S.C. 102\(f\)](#). *In re VerHoef*, 888 F.3d 1362, 1368, 126 USPQ2d 1561, 1566 (Fed. Cir. 2018) (an affidavit by applicant made it “clear that he did not himself solely invent the subject matter sought to be patented” because it established that another person was a joint inventor of the claimed invention).

Where it can be shown that an inventor or at least one joint inventor “derived” an invention from another, a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#) is proper. *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) (“most, if not all, determinations under [section 102\(f\)](#) involve the question of whether one party derived an invention from another”).

While derivation will bar the issuance of a patent to the deriver, a disclosure by the deriver, absent a bar under [pre-AIA 35 U.S.C. 102\(b\)](#), will not bar the issuance of a patent to the party from which the subject matter was derived. *In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 390-91 (Fed. Cir. 1983) (“[a] prior art reference that is not a statutory bar may be overcome [in an application subject to [pre-AIA 35 U.S.C. 102](#)] by two generally recognized methods”: an affidavit under [37 CFR 1.131](#), or an attribution affidavit under [37 CFR 1.132](#)); *In re Facius*, 408 F.2d 1396, 1407, 161 USPQ 294, 302 (CCPA 1969) (if an inventor or at least one joint inventor “... invented the subject matter upon which the relevant disclosure in the patent was based, then the patent may not be used as a reference against him notwithstanding the patent's silence as to the patentee's [inventive entity's] source of that subject matter.”). See [MPEP §§ 715.01 et seq.](#) and [716.10](#)

Where there is a published article identifying the authorship ([MPEP § 715.01\(c\)](#)) or a patent identifying the inventorship ([MPEP § 715.01\(a\)](#)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#). However, it is incumbent upon the applicant of the application, in reply to an inquiry regarding the appropriate inventorship under [pre-AIA subsection \(f\)](#), or to rebut a rejection under [pre-AIA 35 U.S.C. 102\(a\) or \(e\)](#), to provide a satisfactory showing by way of an affidavit or declaration under [37 CFR 1.132](#) that the inventorship of the application is correct in that the reference discloses subject matter invented by the inventor or at least one joint inventor rather than derived from the author or inventive entity notwithstanding the authorship of the article or the inventorship of the patent, respectively. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship, and it is then incumbent upon the applicant to provide “a satisfactory showing that would lead to a reasonable conclusion that [inventor or at least one joint inventor] is the...inventor” of the subject matter disclosed in the article and claimed in the application).

In addition, subject matter qualifying as prior art only under [pre-AIA 35 U.S.C. 102\(f\)](#) may also be the basis for an *ex parte* rejection under [pre-AIA 35 U.S.C. 103](#). However, [pre-AIA 35 U.S.C. 103\(c\)](#) states that subsection (f) of [pre-AIA 35 U.S.C. 102](#) will not preclude patentability where subject matter developed by another person, that would otherwise qualify under [pre-AIA 35 U.S.C. 102\(f\)](#), and the claimed invention of an application under examination were owned by the same person, subject to an obligation of assignment to the same person, or involved in a joint research agreement, which meets the requirements of [pre-AIA 35 U.S.C. 103\(c\)\(2\) and \(c\)\(3\)](#), at the time the invention was made. See [MPEP § 2146](#).



## I. DERIVATION REQUIRES COMPLETE CONCEPTION BY ANOTHER AND COMMUNICATION TO THE ALLEGED DERIVER

“The mere fact that a claim recites the use of various components, each of which can be argumentatively assumed to be old, does not provide a proper basis for a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#).” *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976). Derivation requires complete conception by another and communication of that conception by any means to the party charged with derivation prior to any date on which it can be shown that the one charged with derivation possessed knowledge of the invention. *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter. 1978).

See also *Price v. Symsek*, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993); *Hedgewick v. Akers*, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974). “Communication of a complete conception must be sufficient to enable one of ordinary skill in the art to construct and successfully operate the invention.” *Hedgewick*, 497 F.2d at 908, 182 USPQ at 169. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1577, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (Issue in proving derivation is “whether the communication enabled one of ordinary skill in the art to make the patented invention.”).

## II. PARTY ALLEGING DERIVATION DOES NOT HAVE TO PROVE AN ACTUAL REDUCTION TO PRACTICE, DERIVATION OF PUBLIC KNOWLEDGE, OR DERIVATION IN THIS COUNTRY

The party alleging derivation “need not prove an actual reduction to practice in order to show derivation.” *Scott v. Brandenburger*, 216 USPQ 326, 327 (Bd. App. 1982). Furthermore, the application of [subsection \(f\)](#) is not limited to public knowledge derived from another, and “the site of derivation need not be in this country to bar a deriver from patenting the subject matter.” *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. App. 1981).

## III. DERIVATION DISTINGUISHED FROM PRIORITY OF INVENTION

Although derivation and priority of invention both focus on inventorship, derivation addresses originality (i.e., who invented the subject matter), whereas priority focuses on which party first invented the subject matter. *Price v. Symsek*, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).

## IV. PRE-AIA 35 U.S.C. 102(f) MAY APPLY WHERE PRE-AIA 35 U.S.C. 102(a) AND PRE-AIA 35 U.S.C. 102(e) ARE NOT AVAILABLE STATUTORY GROUNDS FOR REJECTION

[Pre-AIA 35 U.S.C. 102\(f\)](#) does not require an inquiry into the relative dates of a reference and the application, and therefore may be applicable where [pre-AIA subsections \(a\) and \(e\)](#) are not available for references having an effective date subsequent to the effective filing date of the claimed invention in the application being examined. However, for a reference having a date later than the effective filing date of the claimed invention in the application some evidence may exist that the subject matter of the reference was derived from the inventor or at least one joint inventor in view of the relative dates. *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) (The relative dates of the events are important in determining derivation; a publication dated more than a year after the effective filing date of the claimed invention that merely lists as literary coauthors individuals other than the inventor is not the strong evidence needed to rebut a declaration by the inventor that he is the sole inventor.).

### 2137.01 [Reserved]

[Editor Note: Information pertaining to inventorship has been moved to [MPEP § 2109](#), and information specific to joint inventorship has been moved to [MPEP § 2109.01](#).]

### 2137.02 [Reserved]

[Editor Note: Information pertaining to the applicability of [pre-AIA 35 U.S.C. 103\(c\)](#) to obviousness rejections relying on [pre-AIA 35 U.S.C.](#)

[102\(f\)](#) subject matter has been moved to [MPEP § 2137](#). Information regarding inventorship “by another” has been moved to [MPEP § 2109](#), subsection V.]

## 2138 Pre-AIA 35 U.S.C. 102(g) [R-01.2024]

[Editor Note: This MPEP section *has limited applicability* to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159](#) et seq.]

### Pre-AIA 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

\*\*\*\*\*

(g) (1) during the course of an interference conducted under [section 135](#) or [section 291](#), another inventor involved therein establishes, to the extent permitted in [section 104](#), that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

[Pre-AIA 35 U.S.C. 102\(g\)](#) bars the issuance of a patent where another made the invention in the United States before the inventor and had not abandoned, suppressed, or concealed it. This section of [pre-AIA 35 U.S.C. 102](#) forms a basis for interference practice. See [MPEP Chapter 2300](#) for more information on interference procedure. See below and [MPEP §§ 2138.01-2138.06](#) for more information on the requirements of [pre-AIA 35 U.S.C. 102\(g\)](#).

[Pre-AIA 35 U.S.C. 102\(g\)](#) issues such as conception, reduction to practice and diligence, while more

commonly applied to interference matters, also arise in other contexts.

[Pre-AIA 35 U.S.C. 102\(g\)](#) may form the basis for an *ex parte* rejection if: (1) the subject matter at issue has been actually reduced to practice by another before the inventor’s invention; and (2) there has been no abandonment, suppression or concealment. See, e.g., *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1205, 18 USPQ2d 1016, 1020 (Fed. Cir. 1991); *New Idea Farm Equipment Corp. v. Sperry Corp.*, 916 F.2d 1561, 1566, 16 USPQ2d 1424, 1428 (Fed. Cir. 1990); *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1434, 7 USPQ2d 1129, 1132 (Fed. Cir. 1988); *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1444-46, 223 USPQ 603, 606-08 (Fed. Cir. 1984). To qualify as prior art under [pre-AIA 35 U.S.C. 102\(g\)](#), however, there must be evidence that the subject matter was actually reduced to practice, in that conception alone is not sufficient. See *Kimberly-Clark*, 745 F.2d at 1445, 223 USPQ at 607. While the filing of an application for patent is a constructive reduction to practice, the filing of an application does not in itself provide the evidence necessary to show an actual reduction to practice of any of the subject matter disclosed in the application as is necessary to provide the basis for an *ex parte* rejection under [pre-AIA 35 U.S.C. 102\(g\)](#). Thus, absent evidence showing an actual reduction to practice (which is generally not available during *ex parte* examination), the disclosure of a United States patent application publication or patent falls under [pre-AIA 35 U.S.C. 102\(e\)](#) and not under [pre-AIA 35 U.S.C. 102\(g\)](#). Cf. *In re Zletz*, 893 F.2d 319, 323, 13 USPQ2d 1320, 1323 (Fed. Cir. 1989) (the disclosure in a reference United States patent does not fall under [pre-AIA 35 U.S.C. 102\(g\)](#) but under [pre-AIA 35 U.S.C. 102\(e\)](#)).

In addition, subject matter qualifying as prior art only under [pre-AIA 35 U.S.C. 102\(g\)](#) may also be the basis for an *ex parte* rejection under [pre-AIA 35 U.S.C. 103](#). See *In re Bass*, 474 F.2d 1276, 1283, 177 USPQ 178, 183 (CCPA 1973) (in an unsuccessful attempt to utilize a [37 CFR 1.131](#) affidavit relating to a combination application, the inventors admitted that the subcombination screen of a copending application which issued as a patent was earlier conceived than the combination).

[Pre-AIA 35 U.S.C. 103\(c\)](#), however, states that subsection (g) of [pre-AIA 35 U.S.C. 102](#) will not preclude patentability where subject matter developed by another person, that would otherwise qualify under [pre-AIA 35 U.S.C. 102\(g\)](#), and the claimed invention of an application under examination were owned by the same person, subject to an obligation of assignment to the same person, or involved in a joint research agreement, which meets the requirements of [pre-AIA 35 U.S.C. 103\(c\)\(2\) and \(c\)\(3\)](#), at the time the invention was made. See [MPEP § 2146](#).

For additional examples of [pre-AIA 35 U.S.C. 102\(g\)](#) issues such as conception, reduction to practice and diligence outside the context of interference matters, see *In re Costello*, 717 F.2d 1346, 219 USPQ 389 (Fed. Cir. 1983) (discussing the concepts of conception and constructive reduction to practice in the context of a declaration under [37 CFR 1.131](#)), and *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973) (holding constructive reduction to practice for foreign priority under [35 U.S.C. 119](#) requires meeting the requirements of [35 U.S.C. 101](#) and [35 U.S.C. 112](#)).

## 2138.01 Interference Practice [R-01.2024]

*[Editor Note: This MPEP section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159](#) et seq.]*

### I. PRE-AIA 35 U.S.C. 102(g) IS THE BASIS OF INTERFERENCE PRACTICE

Subsection (g) of [pre-AIA 35 U.S.C. 102](#) is the basis of interference practice for determining priority of invention between two parties. See *Bigham v. Godfredsen*, 857 F.2d 1415, 1416, 8 USPQ2d 1266, 1267 (Fed. Cir. 1988); *Paulik v. Rizkalla*, 760 F.2d 1270, 1276-81, 226 USPQ 224, 225 (Fed. Cir. 1985)

(reviews the legislative history of the subsection in a concurring opinion by Judge Rich). [35 U.S.C. 135](#), 37 CFR Part 41, Subparts D and E and [MPEP Chapter 2300](#). An interference is an *inter partes* proceeding directed at determining the first to invent as among the parties to the proceeding, involving two or more pending applications naming different inventors or one or more pending applications and one or more unexpired patents naming different inventors. The first of many to reduce an invention to practice around the same time will be the sole party to obtain a patent in some instances, *Radio Corp. of America v. Radio Eng'g Labs., Inc.*, 293 U.S. 1, 2, 21 USPQ 353, 353-4 (1934), unless another was the first to conceive and couple a later-in-time reduction to practice with diligence from a time just prior to when the second conceiver entered the field to the first conceiver's reduction to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). See the priority time charts below illustrating this point. Upon conclusion of an interference, subject matter claimed by the losing party that was the basis of the interference is rejected under [pre-AIA 35 U.S.C. 102\(g\)](#), unless the acts showing prior invention were not in this country.

It is noted that [35 U.S.C. 101](#) requires that whoever invents or discovers the claimed invention is the party that must be named as the inventor before a patent may be granted. Where it can be shown that a named inventor has “derived” an invention from another, a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#) is proper if applicable. *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) (“most, if not all, determinations under [\[pre-AIA\] Section 102\(f\)](#) involve the question of whether one party derived an invention from another”); *Price v. Symsek*, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993) (Although derivation and priority of invention both focus on inventorship, derivation addresses originality, i.e., who invented the subject matter, whereas priority focuses on which party invented the subject matter first.).

### II. PRIORITY TIME CHARTS

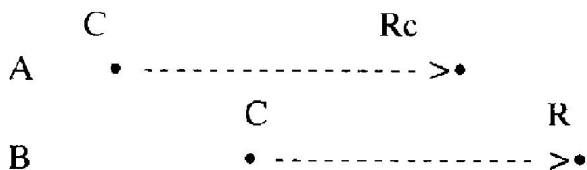
The following priority time charts illustrate the award of invention priority in several situations. The time charts apply to interference proceedings and are also applicable to declarations or affidavits filed

under [37 CFR 1.131](#) to antedate references which are available as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#) or [102\(e\)](#). Note, however, in the context of [37 CFR 1.131](#), an inventor does not have to show that the invention was not abandoned, suppressed, or concealed from the time of an actual reduction to practice to a constructive reduction to practice because the length of time taken to file a patent application after an actual reduction to practice is generally of no consequence except in an interference proceeding. *Paulik v. Rizkalla*, 760 F.2d 1270, 226 USPQ 224 (Fed. Cir. 1985). See the discussion of abandonment, suppression, and concealment in [MPEP § 2138.03](#).

For purposes of analysis under [37 CFR 1.131](#), the conception and reduction to practice of the reference to be antedated are both considered to be on the effective filing date of domestic patent or foreign patent or the date of printed publication.

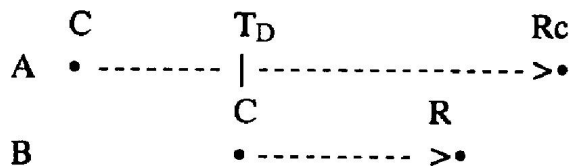
In the charts, C = conception, R = reduction to practice (either actual or constructive), Ra = actual reduction to practice, Rc = constructive reduction to practice, and TD = commencement of diligence.

**Example 1**



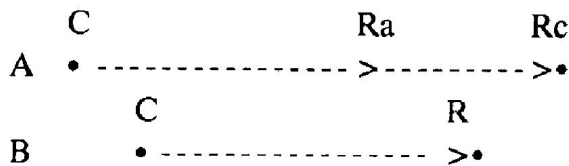
A is awarded priority in an interference, or antedates B as a reference in the context of a declaration or affidavit filed under [37 CFR 1.131](#), because A conceived the invention before B and constructively reduced the invention to practice before B reduced the invention to practice. The same result would be reached if the conception date was the same for both inventors A and B.

**Example 2**



A is awarded priority in an interference, or antedates B as a reference in the context of a declaration or affidavit filed under [37 CFR 1.131](#), if A can show reasonable diligence from T<sub>D</sub> (a point just prior to B’s conception) until R<sub>c</sub> because A conceived the invention before B, and diligently constructively reduced the invention to practice even though this was after B reduced the invention to practice.

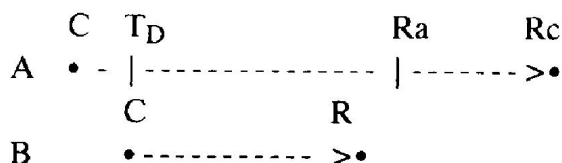
**Example 3**



A is awarded priority in an interference in the absence of abandonment, suppression, or concealment from R<sub>a</sub> to R<sub>c</sub>, because A conceived the invention before B, actually reduced the invention to practice before B reduced the invention to practice, and did not abandon, suppress, or conceal the invention after actually reducing the invention to practice and before constructively reducing the invention to practice.

A antedates B as a reference in the context of a declaration or affidavit filed under [37 CFR 1.131](#) because A conceived the invention before B and actually reduced the invention to practice before B reduced the invention to practice.



**Example 4**

A is awarded priority in an interference if A can show reasonable diligence from T<sub>D</sub> (a point just prior to B's conception) until R<sub>a</sub> in the absence of abandonment, suppression, or concealment from R<sub>a</sub> to R<sub>c</sub>, because A conceived the invention before B, diligently actually reduced the invention to practice (after B reduced the invention to practice), and did not abandon, suppress, or conceal the invention after actually reducing the invention to practice and before constructively reducing the invention to practice.

A antedates B as a reference in the context of a declaration or affidavit filed under [37 CFR 1.131](#) because A conceived the invention before B, and diligently actually reduced the invention to practice, even though this was after B reduced the invention to practice.

### III. 37 CFR 1.131 DOES NOT APPLY IN INTERFERENCE PROCEEDINGS

Interference practice operates to the exclusion of *ex parte* practice under [37 CFR 1.131](#) which permits an inventor to show an actual date of invention prior to the effective date of a reference or activity applied under [pre-AIA 35 U.S.C. 102](#) or [103](#), as long as the reference is not a statutory bar under [pre-AIA 35 U.S.C. 102\(b\)](#) or a U.S. patent application publication claiming the same patentable invention. *Ex parte Standish*, 10 USPQ2d 1454, 1457 (Bd. Pat. App. & Inter. 1988) (An application claim to the “same patentable invention” claimed in a domestic patent requires interference rather than an affidavit under [37 CFR 1.131](#) to antedate the patent. The term “same patentable invention” encompasses a claim that is either anticipated by or obvious in view of the subject matter recited in the patent claim.). Subject matter which is prior art under [pre-AIA 35 U.S.C. 102\(g\)](#) and is subject to an interference is not open to further inquiry under [37 CFR 1.131](#) during the interference proceeding.

### IV. LOST COUNTS IN AN INTERFERENCE ARE NOT, *PER SE*, STATUTORY PRIOR ART

Loss of an interference count alone does not make its subject matter statutory prior art to losing party; however, lost count subject matter that is available as prior art under [pre-AIA 35 U.S.C. 102](#) may be used alone or in combination with other references under [pre-AIA 35 U.S.C. 103](#). But see *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (Under the principles of *res judicata* and *collateral estoppel*, Deckler was not entitled to claims that were patentably indistinguishable from the claim lost in interference even though the subject matter of the lost count was not available for use in an obviousness rejection under [35 U.S.C. 103](#).)

### 2138.02 “The Invention Was Made in This Country” [R-01.2024]

*[Editor Note: This MPEP section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159 et seq.](#)]*

An invention is made when there is a conception and a reduction to practice. *Dunn v. Ragin*, 50 USPQ 472, 474 (Bd. Pat. Inter. 1941). Prior art under [pre-AIA 35 U.S.C. 102\(g\)](#) is limited to an invention that is made. *In re Katz*, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982) (the publication of an article, alone, is not deemed a constructive reduction to practice, and therefore its disclosure does not prove that any invention within the meaning of [pre-AIA 35 U.S.C. 102\(g\)](#) has ever been made).

Subject matter under [pre-AIA 35 U.S.C. 102\(g\)](#) is available only if made in this country. [Pre-AIA 35 U.S.C. 104](#). *Kondo v. Martel*, 220 USPQ 47 (Bd. Pat. Inter. 1983) (acts of conception, reduction to practice and diligence must be demonstrated in this country). Compare *Colbert v. Lofdahl*, 21 USPQ2d



1068, 1071 (Bd. Pat. App. & Inter. 1991) (“[i]f the invention is reduced to practice in a foreign country and knowledge of the invention was brought into this country and disclosed to others, the inventor can derive no benefit from the work done abroad and such knowledge is merely evidence of conception of the invention”).

In accordance with [pre-AIA 35 U.S.C. 102\(g\)\(1\)](#), a party involved in an interference proceeding under [pre-AIA 35 U.S.C. 135](#) or [291](#) may establish a date of invention under [pre-AIA 35 U.S.C. 104](#). [Pre-AIA 35 U.S.C. 104](#), as amended by GATT (Public Law 103-465, 108 Stat. 4809 (1994)) and NAFTA (Public Law 103-182, 107 Stat. 2057 (1993)), provides that an inventor can establish a date of invention in a NAFTA member country on or after December 8, 1993 or in WTO member country other than a NAFTA member country on or after January 1, 1996. Accordingly, an interference count may be won or lost on the basis of establishment of invention by one of the parties in a NAFTA or WTO member country, thereby rendering the subject matter of that count unpatentable to the other party under the principles of *res judicata* and *collateral estoppel*, even though such subject matter is not available as statutory prior art under [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2138.01](#) regarding lost interference counts which are not statutory prior art.

### **2138.03 “By Another Who Has Not Abandoned, Suppressed, or Concealed It” [R-01.2024]**

*[Editor Note: This MPEP section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159 et seq.](#)]*

[Pre-AIA 35 U.S.C. 102\(g\)](#) generally makes available as prior art within the meaning of [35 U.S.C. 103](#), the prior invention of another who has not abandoned,

suppressed or concealed it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973); *In re Suska*, 589 F.2d 527, 200 USPQ 497 (CCPA 1979) (The result of applying the suppression and concealment doctrine is that the inventor who did not conceal (but was the *de facto* last inventor) is treated legally as the first to invent, while the *de facto* first inventor who suppressed or concealed is treated as a later inventor. The *de facto* first inventor, by suppression and concealment, lost the right to rely on the actual date of invention not only for priority purposes, but also for purposes of avoiding the invention of the counts as prior art.).

“The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known. Thus, failure to file a patent application; to describe the invention in a publicly disseminated document; or to use the invention publicly, have been held to constitute abandonment, suppression, or concealment.” *Correge v. Murphy*, 705 F.2d 1326, 1330, 217 USPQ 753, 756 (Fed. Cir. 1983) (quoting *International Glass Co. v. United States*, 408 F.2d 395, 403, 159 USPQ 434, 441 (Ct. Cl. 1968)). In *Correge*, an invention was actually reduced to practice, 7 months later there was a public disclosure of the invention, and 8 months thereafter a patent application was filed. The court held filing a patent application within 1 year of a public disclosure is not an unreasonable delay, therefore reasonable diligence must only be shown between the date of the actual reduction to practice and the public disclosure to avoid the inference of abandonment.

#### **I. DURING AN INTERFERENCE PROCEEDING, AN INFERENCE OF SUPPRESSION OR CONCEALMENT MAY ARISE FROM DELAY IN FILING PATENT APPLICATION**

Once an invention is actually reduced to practice an inventor need not rush to file a patent application.

*Shindelar v. Holdeman*, 628 F.2d 1337, 1341, 207 USPQ 112, 116 (CCPA 1980). The length of time taken to file a patent application after an actual reduction to practice is generally of no consequence except in an interference proceeding. *Paulik v. Rizkalla*, 760 F.2d 1270, 1271, 226 USPQ 225, 226

(Fed. Cir. 1985) (suppression or concealment may be deliberate or may arise due to an inference from a “too long” delay in filing a patent application).

*Peeler v. Miller*, 535 F.2d 647, 656, 190 USPQ 117,124 (CCPA 1976) (“mere delay, without more, is not sufficient to establish suppression or concealment.” “What we are deciding here is that Monsanto’s delay is not ‘merely delay’ and that Monsanto’s justification for the delay is inadequate to overcome the inference of suppression created by the excessive delay.” The word “mere” does not imply a total absence of a limit on the duration of delay. Whether any delay is “mere” is decided only on a case-by-case basis.)

Where a junior party in an interference relies upon an actual reduction to practice to demonstrate first inventorship, and where the hiatus in time between the date for the junior party’s asserted reduction to practice and the filing of its application is unreasonably long, the hiatus may give rise to an inference that the junior party in fact suppressed or concealed the invention and the junior party will not be allowed to rely upon the earlier actual reduction to practice. *Young v. Dworkin*, 489 F.2d 1277, 1280 n.3, 180 USPQ 388, 391 n.3 (CCPA 1974) (suppression and concealment issues are to be addressed on a case-by-case basis).

## II. SUPPRESSION OR CONCEALMENT NEED NOT BE ATTRIBUTED TO INVENTOR

Suppression or concealment need not be attributed to the inventor. *Peeler v. Miller*, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976) (“four year delay from the time an inventor ... completes his work ... and the time his assignee-employer files a patent application is, *prima facie*, unreasonably long in an interference with a party who filed first”);

*Shindelar v. Holdeman*, 628 F.2d 1337, 1341-42, 207 USPQ 112, 116-17 (CCPA 1980) (A patent attorney’s workload will not preclude a holding of an unreasonable delay—the court identified that a total of 3 months was possibly excusable in regard to the filing of an application.)

## III. INFERENCE OF SUPPRESSION OR CONCEALMENT IS REBUTTABLE

Notwithstanding an inference of suppression or concealment due to time(s) of inactivity after reduction to practice, the senior party may still prevail if the senior party shows renewed activity on the invention that is just prior to the junior party’s entry into field coupled with the diligent filing of an application. *Lutzker v. Plet*, 843 F.2d 1364, 1367-69, 6 USPQ2d 1370, 1371-72 (Fed. Cir. 1988) (activities directed towards commercialization not sufficient to rebut inference); *Holmwood v. Cherpeck*, 2 USPQ2d 1942, 1945 (Bd. Pat. App. & Inter. 1986) (the inference of suppression or concealment may be rebutted by showing activity directed to perfecting the invention, preparing the application, or preparing other compounds within the scope of the generic invention); *Engelhardt v. Judd*, 369 F.2d 408, 411, 151 USPQ 732, 735 (CCPA 1966) (“We recognize that an inventor of a new series of compounds should not be forced to file applications piecemeal on each new member as it is synthesized, identified and tested for utility. A reasonable amount of time should be allowed for completion of the research project on the whole series of new compounds, and a further reasonable time period should then be allowed for drafting and filing the patent application(s) thereon.”); *Bogoslowsky v. Huse*, 142 F.2d 75, 77, 61 USPQ 349, 351 (CCPA 1944) (The doctrine of suppression and concealment is not applicable to conception without an actual reduction to practice.)

## IV. ABANDONMENT

A finding of suppression or concealment may not amount to a finding of abandonment wherein a right to a patent is lost. *Steierman v. Connelly*, 197 USPQ 288, 289 (Comm’r Pat. 1976); *Correge v. Murphy*, 705 F.2d 1326, 1329, 217 USPQ 753, 755 (Fed. Cir. 1983) (an invention cannot be abandoned until it is first reduced to practice).

### 2138.04 “Conception” [R-01.2024]

*[Editor Note: This MPEP section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). Patents and applications that contain (or contained at any*

time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159 et seq.](#)]

Conception has been defined as “the complete performance of the mental part of the inventive act” and it is “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice....” *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1929). “[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.” *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (Inventor’s “hope” that a genetically altered yeast would produce antigen particles having the particle size and sedimentation rates recited in the claims did not establish conception, since the inventor did not show that he had a “definite and permanent understanding” as to whether or how, or a reasonable expectation that, the yeast would produce the recited antigen particles.); *Staehelin v. Secher*, 24 USPQ2d 1513, 1522 (Bd. Pat. App. & Inter. 1992) (“evidence of conception naming only one of the actual inventive

entity inures to the benefit of and serves as evidence of conception by the complete inventive entity”).

## I. CONCEPTION MUST BE DONE IN THE MIND OF THE INVENTOR

The inventor must form a definite and permanent idea of the complete and operable invention to establish conception. *Bosies v. Benedict*, 27 F.3d 539, 543, 30 USPQ2d 1862, 1865 (Fed. Cir. 1994) (Testimony by a noninventor as to the meaning of a variable of a generic compound described in an inventor’s notebook was insufficient as a matter of law to establish the meaning of the variable because the testimony was not probative of what the inventor conceived.). A person who shares in the conception of a claimed invention is a joint inventor of that invention. *In re VerHoef*, 888 F.3d 1362, 1366-67, 126 F.2d 1561, 1564-65 (Fed. Cir. 2018).

## II. CONCEPTION REQUIRES CONTEMPORANEOUS RECOGNITION AND APPRECIATION OF THE INVENTION

There must be a contemporaneous recognition and appreciation of the invention for there to be conception. *Silvestri v. Grant*, 496 F.2d 593, 596, 181 USPQ 706, 708 (CCPA 1974) (“an accidental and unappreciated duplication of an invention does not defeat the patent right of one who, though later in time was the first to recognize that which constitutes the inventive subject matter”); *Invitrogen, Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1064, 77 USPQ2d 1161, 1169 (Fed. Cir. 2005) (In situations where there is unrecognized accidental duplication, establishing conception requires evidence that the inventor actually made the invention and understood the invention to have the features that comprise the inventive subject matter at issue). *Langer v. Kaufman*, 465 F.2d 915, 918, 175 USPQ 172, 174 (CCPA 1972) (new form of catalyst was not recognized when it was first produced; conception cannot be established *nunc pro tunc*). However, an inventor does not need to know that the invention will work for there to be complete conception. *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228, 32 USPQ2d 1915, 1919 (Fed. Cir. 1994) (Draft patent application disclosing treatment of AIDS with AZT reciting dosages, forms, and routes of administration was

sufficient to collaborate conception whether or not the inventor believed the inventions would work based on initial screening tests.) Furthermore, the inventor does not need to appreciate the patentability of the invention. *Dow Chem. Co. v. Astro-Valcour, Inc.*, 267 F.3d 1334, 1341, 60 USPQ2d 1519, 1523 (Fed. Cir. 2001).

The first to conceive of a species is not necessarily the first to conceive of the generic invention. *In re Jolley*, 308 F.3d 1317, 1323 n.2, 64 USPQ2d 1901, 1905 n.2 (Fed. Cir. 2002). Further, while conception of a species within a genus may constitute conception of the genus, conception of one species and the genus may not constitute conception of another species in the genus. *Oka v. Youssefeyeh*, 849 F.2d 581, 7 USPQ2d 1169 (Fed. Cir. 1988) (conception of a chemical requires both the idea of the structure of the chemical and possession of an operative method of making it). See also *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (in the isolation of a gene, defining a gene by its principal biological property is not sufficient for conception absent an ability to envision the detailed constitution as well as a method for obtaining it); *Fiers v. Revel*, 984 F.2d 1164, 1170, 25 USPQ2d 1601, 1605 (Fed. Cir. 1993) (“[b]efore reduction to practice, conception only of a process for making a substance, without conception of a structural or equivalent definition of that substance, can at most constitute a conception of the substance claimed as a process” but cannot constitute conception of the substance; as “conception is not enablement,” conception of a purified DNA sequence coding for a specific protein by function and a method for its isolation that could be carried out by one of ordinary skill in the art is not conception of that material). See [MPEP §§ 2106.04\(b\)](#) and [2106.04\(c\)](#) for information on the subject matter eligibility of inventions involving isolated genes.

On rare occasions conception and reduction to practice occur simultaneously in unpredictable technologies. *Alpert v. Slatin*, 305 F.2d 891, 894, 134 USPQ 296, 299 (CCPA 1962). “[I]n some unpredictable areas of chemistry and biology, there is no conception until the invention has been reduced to practice.” *MacMillan v. Moffett*, 432 F.2d 1237, 1234-40, 167 USPQ 550, 552-553 (CCPA 1970).

See also *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (conception simultaneous with reduction to practice where appellant lacked reasonable certainty that yeast’s performance of certain intracellular processes would result in the claimed antigen particles); *Dunn v. Ragin*, 50 USPQ 472, 475 (Bd. Pat. Inter. 1941) (a new variety of asexually reproduced plant is conceived and reduced to practice when it is grown and recognized as a new variety). Under these circumstances, conception is not complete if subsequent experimentation reveals factual uncertainty which “so undermines the specificity of the inventor’s idea that it is not yet a definite and permanent reflection of the complete invention as it will be used in practice.” *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1229, 32 USPQ2d 1915, 1920 (Fed. Cir. 1994).

### III. A PREVIOUSLY ABANDONED APPLICATION WHICH WAS NOT COPENDING WITH A SUBSEQUENT APPLICATION IS EVIDENCE ONLY OF CONCEPTION

An abandoned application with which no subsequent application was copending serves to abandon benefit of the application’s filing as a constructive reduction to practice and the abandoned application is evidence only of conception. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

#### 2138.05 “Reduction to Practice” [R-01.2024]

[Editor Note: This MPEP section **has limited applicability** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159 et seq.](#)]

Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. The filing of a patent application serves as



conception and constructive reduction to practice of the subject matter described in the application. Thus, the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application.

*Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). A reduction to practice can be done by another on behalf of the inventor.

*De Solms v. Schoenwald*, 15 USPQ2d 1507, 1510 (Bd. Pat. App. & Inter. 1990). “While the filing of the original application theoretically constituted a constructive reduction to practice at the time, the subsequent abandonment of that application also resulted in an abandonment of the benefit of that filing as a constructive reduction to practice. The filing of the original application is, however, evidence of conception of the invention.” *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983) (The second application was not co-pending with the original application and it did not reference the original application. Because of the requirements of [35 U.S.C. 120](#) had not been satisfied, the filing of the original application was not recognized as constructive reduction to practice of the invention.).

#### **I. CONSTRUCTIVE REDUCTION TO PRACTICE REQUIRES COMPLIANCE WITH 35 U.S.C. 112(a) or PRE-AIA 35 U.S.C. 112, FIRST PARAGRAPH**

When a party to an interference seeks the benefit of an earlier-filed U.S. patent application, the earlier application must meet the requirements of [35 U.S.C. 120](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph for the subject matter of the count. The earlier application must meet the enablement requirement and must contain a written description of the subject matter of the interference count. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). Proof of a constructive reduction to practice requires sufficient disclosure under the “how to use” and “how to make” requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. *Kawai v. Metlesics*, 480 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973) (A constructive reduction to practice is not proven unless the specification discloses a practical utility where one would not be obvious. Prior art which disclosed an anticonvulsant compound which differed from the claimed compound only in the

absence of a -CH<sub>2</sub>- group connecting two functional groups was not sufficient to establish utility of the claimed compound because the compounds were not so closely related that they could be presumed to have the same utility.). The purpose of the written description requirement is “to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.” *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The written description must include all of the limitations of the interference count, or the inventor must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed. Furthermore, the written description must be sufficient, when the entire specification is considered, such that the “necessary and only reasonable construction” that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count. *Hyatt v. Boone*, 146 F.3d at 1354-55, 47 USPQ2d at 1130-1132 (Fed. Cir. 1998) (The claim could be read as describing subject matter other than that of the count and thus did not establish that the inventor was in possession of the invention of the count.). See also *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) (“[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species,” except where the halogen species are patentably distinct).

#### **II. REQUIREMENTS TO ESTABLISH ACTUAL REDUCTION TO PRACTICE**

“In an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose.” *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

The same evidence sufficient for a constructive reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible



form that shows every element of the count.

*Wetmore v. Quick*, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. See, e.g., *Scott v. Finney*, 34 F.3d 1058, 1062, 32 USPQ2d 1115, 1118-19 (Fed. Cir. 1994) (citing numerous cases wherein the character of the testing necessary to support an actual reduction to practice varied with the complexity of the invention and the problem it solved). If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

For additional cases pertaining to the requirements necessary to establish actual reduction to practice see *DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) (“events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred”); *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) (“the reduction to practice of a three-dimensional design invention requires the production of an article embodying that design” in “other than a mere drawing”); *Birmingham v. Randall*, 171 F.2d 957, 80 USPQ 371, 372 (CCPA 1948) (To establish an actual reduction to practice of an invention directed to a method of making a product, it is not enough to show that the method was performed. “[S]uch an invention is not reduced to practice until it is established that the product made by the process is satisfactory, and [ ] this may require successful testing of the product.”).

### III. TESTING REQUIRED TO ESTABLISH AN ACTUAL REDUCTION TO PRACTICE

“The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention.”

*Gellert v. Wanberg*, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) (“an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests”); *Wells v.*

*Fremont*, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) (“even where tests are conducted under ‘bench’ or laboratory conditions, those conditions must ‘fully duplicate each and every condition of actual use’ or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention,” but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water).

### IV. REDUCTION TO PRACTICE REQUIRES RECOGNITION AND APPRECIATION OF THE INVENTION

The invention must be recognized and appreciated for a reduction to practice to occur. “The rule that conception and reduction to practice cannot be established nunc pro tunc simply requires that in order for an experiment to constitute an actual reduction to practice, there must have been contemporaneous appreciation of the invention at issue by the inventor.... Subsequent testing or later recognition may not be used to show that a party had contemporaneous appreciation of the invention. However, evidence of subsequent testing may be admitted for the purpose of showing that an embodiment was produced and that it met the limitations of the count.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) (citations omitted). *Meitzner v. Corte*, 537 F.2d 524, 528, 190 USPQ 407, 410 (CCPA 1976) (there can be no conception or reduction to practice of a new form or of a process using such a new form of an otherwise old composition where there has been no recognition or appreciation of the existence of the new form); *Estee Lauder, Inc. v. L’Oreal S.A.*, 129 F.3d 588, 593, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997) (“[W]hen testing is necessary to establish utility, there must be recognition and appreciation that the tests were successful for reduction to practice to occur.” A showing that testing was completed before the critical date, and that testing ultimately proved successful, was held insufficient to establish a reduction to practice before the critical date, since the success of the testing was not appreciated or recognized until after the critical date.); *Parker v. Frilette*, 462 F.2d 544, 547, 174 USPQ 321, 324 (CCPA 1972) (“[an] inventor need not understand

precisely why his invention works in order to achieve an actual reduction to practice”).

#### **V. RECOGNITION OF THE INVENTION BY ANOTHER MAY INURE TO THE BENEFIT OF THE INVENTOR**

“Inurement involves a claim by an inventor that, as a matter of law, the acts of another person should accrue to the benefit of the inventor.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998). Before a non-inventor’s recognition of the utility of the invention can inure to the benefit of the inventor, the following three-prong test must be met: (1) the inventor must have conceived of the invention, (2) the inventor must have had an expectation that the embodiment tested would work for the intended purpose of the invention, and (3) the inventor must have submitted the embodiment for testing for the intended purpose of the invention. *Genentech, Inc. v. Chiron Corp.*, 220 F.3d 1345, 1354, 55 USPQ2d 1636, 1643 (Fed. Cir. 2000). In *Genentech*, a non-inventor hired by the inventor to test yeast samples for the presence of the fusion protein encoded by the DNA construct of the invention recognized the growth-enhancing property of the fusion protein, but did not communicate this recognition to the inventor. The court found that because the inventor did not submit the samples for testing growth-promoting activity, the intended purpose of the invention, the third prong was not satisfied and the uncommunicated recognition of the activity of the fusion protein by the non-inventor did not inure to the benefit of the inventor. See also *Cooper v. Goldfarb*, 240 F.3d 1378, 1385, 57 USPQ2d 1990, 1995 (Fed. Cir. 2001) (Cooper sent to Goldfarb samples of a material for use in vascular grafts. At the time the samples were sent, Cooper was unaware of the importance of the fibril length of the material. Cooper did not at any time later convey to, or request from, Goldfarb any information regarding fibril length. Therefore, Goldfarb’s determination of the fibril lengths of the material could not inure to Cooper’s benefit.).

#### **VI. IN AN INTERFERENCE PROCEEDING, ALL LIMITATIONS OF A COUNT MUST BE REDUCED TO PRACTICE**

The device reduced to practice must include every limitation of the count. *Fredkin v. Irasek*, 397 F.2d 342, 158 USPQ 280, 285 (CCPA 1968); every limitation in a count is material and must be proved to establish an actual reduction to practice. *Meitzner v. Corte*, 537 F.2d 524, 528, 190 USPQ 407, 410 (CCPA 1976). See also *Hull v. Bonis*, 214 USPQ 731, 734 (Bd. Pat. Inter. 1982) (no doctrine of equivalents—remedy is a preliminary motion to amend the count to conform to the proofs).

#### **VII. CLAIMED INVENTION IS NOT ACTUALLY REDUCED TO PRACTICE UNLESS THERE IS A KNOWN UTILITY**

Utility for the invention must be known at the time of the reduction to practice. *Wiesner v. Weigert*, 666 F.2d 582, 588, 212 USPQ 721, 726 (CCPA 1981) (except for plant and design inventions); *Azar v. Burns*, 188 USPQ 601, 604 (Bd. Pat. Inter. 1975) (a composition and a method cannot be actually reduced to practice unless the composition and the product produced by the method have a practical utility); *Ciric v. Flanigen*, 511 F.2d 1182, 1185, 185 USPQ 103, 105-6 (CCPA 1975) (“when a count does not recite any particular utility, evidence establishing a substantial utility for any purpose is sufficient to prove a reduction to practice”; “the demonstrated similarity of ion exchange and adsorptive properties between the newly discovered zeolites and known crystalline zeolites ... have established utility for the zeolites of the count”); *Engelhardt v. Judd*, 369 F.2d 408, 411, 151 USPQ 732, 735 (CCPA 1966) (When considering an actual reduction to practice as a bar to patentability for claims to compounds, it is sufficient to successfully demonstrate utility of the compounds in animals for somewhat different pharmaceutical purposes than those asserted in the specification for humans.); *Rey-Bellet v. Engelhardt*, 493 F.2d 1380, 1384, 181 USPQ 453, 455 (CCPA 1974) (Two categories of tests on laboratory animals have been considered adequate to show utility and reduction to practice: first, tests carried out to prove utility in humans where there is a satisfactory correlation between humans and animals, and second, tests carried out to prove utility for treating animals.).

## VIII. A PROBABLE UTILITY MAY NOT BE SUFFICIENT TO ESTABLISH UTILITY

A probable utility does not establish a practical utility, which is established by actual testing or where the utility can be “foretold with certainty.” *Bindra v. Kelly*, 206 USPQ 570, 575 (Bd. Pat. Inter. 1979) (Reduction to practice was not established for an intermediate useful in the preparation of a second intermediate with a known utility in the preparation of a pharmaceutical. The record established there was a high degree of probability of a successful preparation because one skilled in the art may have been motivated, in the sense of [35 U.S.C. 103](#), to prepare the second intermediate from the first intermediate. However, a strong probability of utility is not sufficient to establish practical utility.); *Wu v. Jucker*, 167 USPQ 467, 472 (Bd. Pat. Inter. 1968) (screening test where there was an indication of possible utility is insufficient to establish practical utility). But see *Nelson v. Bowler*, 628 F.2d 853, 858, 206 USPQ 881, 885 (CCPA 1980) (Relevant evidence is judged as a whole for its persuasiveness in linking observed properties to suggested uses. Reasonable correlation between the two is sufficient for an actual reduction to practice.).

### 2138.06 “Reasonable Diligence” [R-01.2024]

*[Editor Note: This MPEP section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). Patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date (before March 16, 2013) and at least one claim with a post-AIA effective filing date (on or after March 16, 2013) are subject to the patentability requirements in [AIA 35 U.S.C. 102-103](#) and subject to [pre-AIA 35 U.S.C. 102\(g\)](#). See [MPEP § 2159](#) et seq.]*

The diligence of [pre-AIA 35 U.S.C. 102\(g\)](#) relates to reasonable “attorney-diligence” and “engineering-diligence” (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved....” *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

## I. CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO PRACTICE

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) (“lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts”). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under [35 U.S.C. 119](#) of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under [35 U.S.C. 119](#) and [120](#), priority under [35 U.S.C. 119](#) denied for failure to supply certified copy of the foreign application during pendency of the application that was filed within the twelve month period prescribed by [35 U.S.C. 119](#))).

## II. THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

“A patent owner need not prove the inventor continuously exercised reasonable diligence throughout the critical period; it must show there was reasonably continuous diligence.” *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1009, 120 USPQ2d 1605, 1609 (Fed. Cir. 2016) (emphasis in original) (citing *Tyco Healthcare Grp. v. Ethicon EndoSurgery, Inc.*, 774 F.3d 968, 975, 112 USPQ2d 1979 (Fed. Cir. 2014) and *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261

F.3d 1356, 1370, 59 USPQ2d 1930, 1939 (Fed. Cir. 2001)).

An inventor must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) ([37 CFR 1.131](#) issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during the critical period shows a lack of diligence. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Evidence of diligence must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 255 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless the party has shown that the party was first to conceive and that the party exercised reasonable diligence during the critical period from just prior to opponent’s entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there

may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus”); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

Examiners should weigh the body of evidence to make the determination of whether there was reasonably continuous diligence for the entire critical period. This determination should be made with the purpose of the diligence requirement in mind, which “is to assure that, in light of the evidence as a whole, ‘the invention was not abandoned or unreasonably delayed.’” *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc. (Perfect Surgical)*, 841 F.3d 1004, 1009, 120 USPQ2d 1605, 1609 (Fed. Cir. 2016) (citations omitted). In *Perfect Surgical*, the Federal Circuit stated:

Under this standard, an inventor is not required to work on reducing his invention to practice every day during the critical period. ... And periods of inactivity within the critical period do not automatically vanquish a patent owner's claim of reasonable diligence.... In determining whether an invention antedates another, the point of the diligence analysis is not to scour the patent owner's corroborating evidence in search of intervals of time where the patent owner has failed to substantiate some sort of activity. It is to assure that, in light of the evidence as a whole, “the invention was not abandoned or unreasonably delayed.” ... That an inventor overseeing a study did not record its progress on a daily, weekly, or even monthly basis does not mean the inventor necessarily

abandoned his invention or unreasonably delayed it. The same logic applies to the preparation of a patent application: the absence of evidence that an inventor and his attorney revised or discussed the application on a daily basis is alone insufficient to determine that the invention was abandoned or unreasonably delayed. One must weigh the collection of evidence over the entire critical period to make such a determination.

Our decision in *In re Mulder*, 716 F.2d 1542, 1542-46 [219 USPQ 189] (Fed. Cir. 1983), does not instruct otherwise. The Board cites *In re Mulder* for the proposition that “[e]ven a short period of unexplained inactivity may be sufficient to defeat a claim of diligence.” ... In *In re Mulder*, a competing reference was published just days before the patent at issue was constructively reduced to practice. .... The patent owner was tasked with showing reasonable diligence during a critical period lasting only two days. ... But the patent owner did not produce any evidence of diligence during the critical period. ... Nor could it point to any activity during the months between the drafting of the application and the start of the critical period. ... Although the critical period spanned just two days, we declined to excuse the patent owner’s complete lack of evidence. ... *In re Mulder* does not hold that an inventor’s inactivity during a portion of the critical period can, without more, destroy a patent owner’s claim of diligence.

*Perfect Surgical*, 841 F.3d at 1009, 120 USPQ2d at 1609 (citations omitted).

### III. WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY RELATED TO THE REDUCTION TO PRACTICE

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), *cert. denied*, 439 U.S. 826 (1978). See also *Scott v. Koyama*, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) (Activities directed at building a plant to practice the claimed process of producing tetrafluoroethane on a large scale constituted efforts toward actual reduction to practice, and thus were evidence of diligence. The court distinguished cases where diligence was not found because inventors either discontinued development or failed to complete the invention while pursuing financing or other commercial activity.); *In re Jolley*, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and

procurement activities related to the subject matter of the interference count). “[U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue.” *Ginos v. Nedelec*, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983) (work on other closely related compounds that were considered to be part of the same invention and which were included as part of a grandparent application). “The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter.” *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973) (An actual reduction to practice of the invention at issue which occurred when the inventor was working on a different invention “was fortuitous, and not the result of a continuous intent or effort to reduce to practice the invention here in issue. Such fortuitousness is inconsistent with the exercise of diligence toward reduction to practice of that invention.” 181 USPQ at 761. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor’s circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); *Huelster v. Reiter*, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (an inventor who was not able to make an actual reduction to practice of the invention, must also show why constructive reduction to practice by filing an application was not possible).

### IV. DILIGENCE REQUIRED IN PREPARING AND FILING PATENT APPLICATION

The diligence of an attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the



inventor. Conception is less a matter of signature than it is one of disclosure. An attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 806 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which the attorney takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.). In “the preparation” of a patent application, “the absence of evidence that an inventor and his attorney revised or discussed the application on a daily basis is alone insufficient to determine that the invention was abandoned or unreasonably delayed.” *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1009, 120 USPQ2d 1605, 1609 (Fed. Cir. 2016).

#### **V. END OF DILIGENCE PERIOD IS MARKED BY EITHER ACTUAL OR CONSTRUCTIVE REDUCTION TO PRACTICE**

“[I]t is of no moment that the end of that period [for diligence] is fixed by a constructive, rather than an actual, reduction to practice.” *Justus v. Appenzeller*, 177 USPQ 332, 340-41 (Bd. Pat. Inter. 1971).

#### **2139 Rejections Under Pre-AIA 35 U.S.C. 102 [R-10.2019]**

Any application filed before March 16, 2013, is governed by [pre-AIA 35 U.S.C. 102](#) and [103](#) (i.e., the application is a pre-AIA first to invent application). Note that neither the filing of a request for continued examination, nor entry into the national stage under [35 U.S.C. 371](#), constitutes the filing of a new application. Accordingly, such an application remains subject to [pre-AIA 35 U.S.C. 102](#) and [103](#) even if a request for continued examination under [37 CFR 1.114](#) is filed on or after March 16, 2013, in an application that was filed before March 16,

2013. Similarly, a PCT application filed under [35 U.S.C. 363](#) before March 16, 2013, is subject to [pre-AIA 35 U.S.C. 102](#) and [103](#), regardless of whether the application enters the national stage under [35 U.S.C. 371](#) before or after March 16, 2013.

Certain applications filed on or after March 16, 2013 that claim the benefit of a filing date earlier than March 16, 2013 under [35 U.S.C. 120](#), [121](#), or [365](#) are also governed by [pre-AIA 35 U.S.C. 102](#); see [MPEP § 2159 et seq.](#) for guidance in determining whether such an application is subject to examination under the first to invent prior art regime.

#### **2139.01 Effective Filing Date of a Claimed Invention Under Pre-AIA 35 U.S.C. 102 [R-10.2019]**

In examining applications subject to [pre-AIA 35 U.S.C. 102](#), the effective filing date of the claimed invention is the actual filing date of the U.S. application, unless situation (A), (B), or (C) as set forth below applies. Note that the actual U.S. filing date of an application that entered the national stage under [35 U.S.C. 371](#) is the international filing date. See [35 U.S.C. 363](#) and [MPEP § 1893.03\(b\)](#).

(A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of [35 U.S.C. 120](#) or [365\(c\)](#) have been satisfied, the effective filing date of the claimed invention is the same as the earliest filing date in the line of continuation or divisional applications.

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the actual filing date of the new application. Any claims which are fully supported under [35 U.S.C. 112](#) by the earlier parent application have the effective filing date of that earlier parent application.

(C) If the application properly claims benefit under [35 U.S.C. 119\(e\)](#) to a provisional application, the effective filing date of the claimed invention is the filing date of the provisional application for any claims which are fully supported under the first paragraph of [35 U.S.C. 112](#) by the provisional application.

The effective filing date for claims subject to [pre-AIA 35 U.S.C. 102](#) is not the filing date of the foreign priority document, although the filing date of the foreign priority document may be used to overcome certain references. See [MPEP § 2136.05 et seq.](#)

See [MPEP § 1893.03\(c\)](#), subsection III for benefit claims under [35 U.S.C. 119\(e\)](#), [120](#), or [365\(c\)](#) in an application that entered the national stage under [35 U.S.C. 371](#). See [MPEP §§ 211.01\(c\)](#) and [1895](#) for additional information on determining the effective filing dates of claimed inventions in a continuation, divisional, or continuation-in-part of a PCT application designating the U.S. See also [MPEP §§ 1895.01](#) and [1896](#) which discuss differences between applications filed under [35 U.S.C. 111\(a\)](#) and international applications that enter national stage under [35 U.S.C. 371](#).

## **2139.02 Determining Whether To Apply Pre-AIA 35 U.S.C. 102(a), (b), or (e) [R-01.2024]**

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the first inventor to file (FITF) provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2152.05](#) for the examination of applications subject to the first inventor to file provisions of the AIA.]*

### **I. PRE-AIA 35 U.S.C. 102(b)**

First, the examiner should consider whether the reference qualifies as prior art under [pre-AIA 35 U.S.C. 102\(b\)](#) because this section results in a statutory bar to obtaining a patent. If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the claimed invention ([MPEP § 2139.01](#)), the reference qualifies as prior art under [pre-AIA 35 U.S.C. 102\(b\)](#).

Publications, patents, public uses and sales, however, will not bar a patent if the 1-year grace period otherwise ends on a Saturday, Sunday, or federal

holiday and the application's U.S. filing date is the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) and [35 U.S.C. 21\(b\)](#). The provisions of [35 U.S.C. 21\(b\)](#) still apply notwithstanding the provisions of [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which accord a filing date as of the date of deposit as Priority Mail Express<sup>®</sup> with the U.S. Postal Service and [37 CFR 1.6\(a\)\(4\)](#), which accords a filing date as of the date of submission using the USPTO patent electronic filing system.

If there is evidence of public use or sale activity more than one year prior to the effective filing date of the claimed invention, a rejection should be made under [pre-AIA 35 U.S.C. 102\(b\)](#), which results in a statutory bar to obtaining a patent, rather than under [pre-AIA 35 U.S.C. 102\(a\)](#). Note that mere knowledge of the invention by the public does not warrant rejection under [pre-AIA 35 U.S.C. 102\(b\)](#), although public knowledge may provide grounds for rejection under [pre-AIA 35 U.S.C. 102\(a\)](#). See [MPEP §§ 2132](#) and [2133.03\(a\)](#).

### **II. PRE-AIA 35 U.S.C. 102(e)**

If the publication or issue date of the reference is too recent for [pre-AIA 35 U.S.C. 102\(b\)](#) to apply, then the examiner should consider [pre-AIA 35 U.S.C. 102\(e\)](#).

[Pre-AIA 35 U.S.C. 102\(e\)](#) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under [pre-AIA 35 U.S.C. 102\(e\)](#) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty ([PCT](#)) [Article 21\(2\)](#) in the English language. See [MPEP § 2136](#) for examination guidelines on the application of [pre-AIA 35 U.S.C. 102\(e\)](#). References based on international applications that were filed prior to November 29, 2000 are subject to the "pre-AIPA" version of [35 U.S.C. 102\(e\)](#) in force on

November 28, 2000. See [subsection III](#), below and [MPEP § 2136.03](#) for additional information.

In order to apply a reference under [pre-AIA 35 U.S.C. 102\(e\)](#), the inventive entity of the application must be different from that of the reference. Note that, where there are joint inventors, only one joint inventor needs to be different for the inventive entities to be different and a rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) is applicable even if there are some joint inventors in common between the application and the reference.

**35 U.S.C. 102 (pre-AIA) Conditions for patentability; novelty and loss of right to patent.**

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(e) the invention was described in — (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language; or

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[Pre-AIA 35 U.S.C. 102\(e\)](#) has two separate clauses, namely, [pre-AIA 35 U.S.C. 102\(e\)\(1\)](#) for publications of patent applications and [pre-AIA 35 U.S.C. 102\(e\)\(2\)](#) for U.S. patents. [Pre-AIA 35 U.S.C. 102\(e\)\(1\)](#), in combination with [pre-AIA 35 U.S.C. 374](#), created a new category of prior art by providing prior art effect for certain publications of patent applications, including certain international applications, as of their effectively filed dates in the United States (which include certain international filing dates). Under [pre-AIA 35 U.S.C. 102\(e\)](#), an international filing date which is on or after November 29, 2000 is the United States filing date if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty ([PCT Article 21\(2\)](#)) in the English language. Therefore, the prior art date of a reference under [pre-AIA 35 U.S.C. 102\(e\)](#) may be the international filing date (if all three conditions noted above are met) or an earlier U.S. filing date for which priority or benefit is properly claimed.

Publication under [PCT Article 21\(2\)](#) may result from a request for early publication by an applicant of an international application or after the expiration of 18-months after the earliest claimed priority date in an international application. International applications, which: (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under [PCT Article 21\(2\)](#) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#). An international filing date which is on or after November 29, 2000 is a United States filing date for purposes of determining the earliest effective prior art date of a patent if the international application designated the United States and was published in the English language under [PCT Article 21\(2\)](#) by WIPO. No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#).

**III. “PRE-AIPA” 35 U.S.C. 102(e) AS IN FORCE ON NOVEMBER 28, 2000**

**“Pre-AIPA” 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent (as in force on November 28, 2000).**

A person shall be entitled to a patent unless -

\*\*\*\*\*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Patents issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of pre-AIPA 35 U.S.C. 102(e) as in force on November 28, 2000. Thus, the pre-AIPA 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. Publications of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the national

stage (35 U.S.C. 371)) do not have a pre-AIPA 35 U.S.C. 102(e) date at all (however, such publications are available as prior art under [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#) as of their publication date).

#### IV. PRE-AIA 35 U.S.C. 102(a)

Even if the reference is prior art under [pre-AIA 35 U.S.C. 102\(e\)](#), the examiner should still consider [pre-AIA 35 U.S.C. 102\(a\)](#) for two reasons. First, if the reference is a U.S. patent or patent application publication of, or claims benefit of, an international application, the publication of the international application under [PCT Article 21\(2\)](#) may be the earliest prior art date under [pre-AIA 35 U.S.C. 102\(a\)](#) for the disclosure. Second, references that are only prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) and applied in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) are subject to being disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) if the reference and the application were commonly owned, or subject to an obligation of common assignment, at the time the invention was made. For [pre-AIA 35 U.S.C. 102\(a\)](#) to apply, the reference must have a publication date earlier in time than the effective filing date of the claimed invention in the application under examination, and must not be the inventor or at least one joint inventor's own work.

If the claimed invention is the subject of activity by an entity other than the inventor, such as sale by another, manufacture by another or disclosure of the invention by at least one joint inventor to another entity then both [pre-AIA 35 U.S.C. 102\(a\) and \(b\)](#) may be applicable. If the evidence only points to knowledge within the year prior to the effective filing date then [pre-AIA 35 U.S.C. 102\(a\)](#) applies. However, no rejection under [pre-AIA 35 U.S.C. 102\(a\)](#) should be made if there is evidence that applicant made the invention and only disclosed it to others within the year prior to the effective filing date.

### 2139.03 Form Paragraphs for Use in Rejections Under Pre-AIA 35 U.S.C. 102 [R-07.2022]

The following form paragraphs should be used in making the appropriate rejections. Note that the

particular part of the reference relied upon to support the rejection should be identified.

#### ¶ 7.06 Notice re prior art available under both pre-AIA and AIA

In the event the determination of the status of the application as subject to AIA [35 U.S.C. 102](#) and [103](#) (or as subject to [pre-AIA 35 U.S.C. 102](#) and [103](#)) is incorrect, any correction of the statutory basis (i.e., changing from AIA to pre-AIA) for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

#### Examiner Note:

1. This form paragraph must be used in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013, that claims priority to, or the benefit of, an application filed before March 16, 2013.
2. This form paragraph should only be used ONCE in an Office action.

#### ¶ 7.07.fti Statement of Statutory Basis, pre-AIA 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of [pre-AIA 35 U.S.C. 102](#) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

#### Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use form paragraph 7.103.
2. Form paragraphs 7.07.fti to 7.14.fti are to be used ONLY ONCE in a given Office action.
3. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

#### ¶ 7.08.fti Pre-AIA 102(a), Activity by Another Before Invention by Applicant

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

#### Examiner Note:

This form paragraph must be preceded by form paragraph 7.07.fti .

#### ¶ 7.09.fti Pre-AIA 102(b), Activity More Than One Year Prior to Filing

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on



sale in this country, more than one year prior to the date of application for patent in the United States.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by form paragraph 7.08.fti.

**¶ 7.10.fti Pre-AIA 102(c), Invention Abandoned**

(c) he has abandoned the invention.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti and 7.09.fti.

**¶ 7.11.fti Pre-AIA 102(d), Foreign Patenting**

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.10.fti.

**¶ 7.12.fti Pre-AIA 35 U.S.C 102(e), Patent Application Publication or Patent to Another with Earlier Filing Date, in view of the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002**

(e) the invention was described in (1) an application for patent, published under section [122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section [351\(a\)](#) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language.

**Examiner Note:**

1. This form paragraph should only be used if the reference is one of the following:

- (a) a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);
- (b) a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application (i.e., a PCT application) if the international application has an international filing date on or after November 29, 2000;

(c) a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States.

2. In determining the [pre-AIA 35 U.S.C. 102\(e\)](#) date, consider benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), and to earlier-filed U.S. nonprovisional applications and international applications under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\) - \(d\)](#), [365\(a\) or \(b\)](#), or [386\(a\) or \(b\)](#).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

3. In order to rely on an international filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#), the international application (PCT) must have been filed on or after November 29, 2000, it must have designated the U.S., and the international publication under [PCT Article 21\(2\)](#) by WIPO must have been in English. If any one of the conditions is not met, the international filing date is not a U.S. filing date for prior art purposes under [pre-AIA 35 U.S.C. 102\(e\)](#).

4. If an international application (PCT) was published by WIPO in a language other than English, or did not designate the U.S., the international application's publication by WIPO, the U.S. publication of the national stage application ([35 U.S.C. 371](#)) of the international application and a U.S. patent issued from the national stage of the international application may not be applied as a reference under [pre-AIA 35 U.S.C. 102\(e\)](#). The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [\(b\)](#) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

5. If an international application (PCT) was published by WIPO in a language other than English, the U.S. publication of, or a U.S. patent issued from, a continuing application claiming benefit under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) to such an international application, has a [pre-AIA 35 U.S.C. 102\(e\)](#) date as of the earliest U.S. filing date after the international filing date.

6. If the reference is a U.S. patent issued directly, or indirectly, from an international application (PCT) that has an international filing date prior to November 29, 2000, use form paragraph 7.12.01.fti. In that situation, [pre-AIPA 35 U.S.C. 102\(e\)](#) is applicable in the determination of the prior art date of the patent issued from such an international application.

7. If the reference is a publication of an international application (PCT), including the U.S. publication of a national stage ([35 U.S.C. 371](#)), that has an international filing date prior to November 29, 2000, do not use this form paragraph. Such a reference may not be applied as a prior art reference under



[pre-AIA 35 U.S.C. 102\(e\)](#). The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [\(b\)](#) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

8. This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.11.fti.

**¶ 7.12.01.fti Pre-AIPA 35 U.S.C. 102(e), Patent to Another with Earlier Filing Date, Reference is a U.S. Patent Issued Directly or Indirectly From a National Stage of, or a Continuing Application Claiming Benefit to, an International Application Having an International Filing Date Prior to November 29, 2000**

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section [371\(c\)](#) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA ([pre-AIPA 35 U.S.C. 102\(e\)](#)).

**Examiner Note:**

1. This form paragraph should only be used if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit to an international application having an international filing date prior to November 29, 2000.

2. If the reference is a U.S. patent issued directly from a national stage of such an international application, the reference's [pre-AIPA 35 U.S.C. 102\(e\)](#) date is the date that the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. The language of WIPO publication (PCT) is not relevant in this situation. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 102\(b\)](#).

3. If the reference is a U.S. patent issued directly from a continuing application claiming benefit under [35 U.S.C. 120, 121](#) or [365\(c\)](#) to such an international application (which had not entered the national stage prior to the continuing application's filing date, otherwise see note 4), the prior art reference's [pre-AIPA 35 U.S.C. 102\(e\)](#) date is the actual U.S. filing date of the continuing application. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 102\(b\)](#).

4. In determining the [pre-AIPA 35 U.S.C. 102\(e\)](#) date, consider benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), and to earlier-filed U.S.

nonprovisional applications and international applications under [35 U.S.C. 120, 121, 365\(c\)](#), or [386\(c\)](#) only if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application may only result in an effective U.S. filing date as of the date the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\)-\(d\), 365\(a\) or \(b\)](#), or [386\(a\) or \(b\)](#).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

5. This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.11.fti.

**¶ 7.13.fti Pre-AIA 102(f), Applicant Not the Inventor**

(f) he did not himself invent the subject matter sought to be patented.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.12.fti.

**¶ 7.14.fti Pre-AIA 102(g), Priority of Invention**

(g)(1) during the course of an interference conducted under section [135](#) or section [291](#), another inventor involved therein establishes, to the extent permitted in section [104](#), that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.13.fti.

**¶ 7.15.fti Rejection, Pre-AIA 35 U.S.C. 102(a), (b) Patent or Publication, and (g)**

Claim(s) [1] is/are rejected under [pre-AIA 35 U.S.C. 102](#) [2] as being [3] by [4].

**Examiner Note:**

1. In bracket 2, insert the appropriate paragraph letter or letters of [pre-AIA 35 U.S.C. 102](#) in parentheses. If paragraph (e) of [pre-AIA 35 U.S.C. 102](#) is applicable, use form paragraph 7.15.01.fti, 7.15.02.fti or 7.15.03.fti.
2. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 4, insert the prior art relied upon.
4. This rejection must be preceded either by form paragraph 7.07.fti and form paragraphs 7.08.fti, 7.09.fti, and 7.14.fti as appropriate, or by form paragraph 7.103.
5. If [pre-AIA 35 U.S.C. 102\(e\)](#) is also being applied, this form paragraph must be followed by either form paragraph 7.15.01.fti, 7.15.02.fti or 7.15.03.fti.
6. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

**¶ 7.15.01.fti Provisional Rejection, Pre-AIA 35 U.S.C. 102(e) - Common Assignee, Common Applicant, or At Least One Common (Joint) Inventor**

Claim(s) [1] is/are provisionally rejected under [pre-AIA 35 U.S.C. 102\(e\)](#) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.

The copending application would constitute prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) if published under [35 U.S.C. 122\(b\)](#) or patented. This provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) is based upon a presumption of future publication or patenting of the copending application. [4].

This provisional rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under [37 CFR 1.131\(a\)](#).

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

**Examiner Note:**

1. This form paragraph is used to provisionally reject over a copending application that discloses the claimed invention and would constitute prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) if published under [35 U.S.C. 122](#) or patented. The copending application must have either a common assignee, a common applicant ([35 U.S.C. 118](#)), or at least one common (joint) inventor.
2. Use [pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12.fti) to determine the copending application’s prior art date, unless the copending application is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the

copending application is either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under [35 U.S.C. 120, 121, 365\(c\), or 386\(c\)](#) to an international application having an international filing date prior to November 29, 2000, use [pre-AIPA 35 U.S.C. 102\(e\)](#) (form paragraph 7.12.01.fti). See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference’s [35 U.S.C. 102\(e\)](#) date.

3. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.fti.
4. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.
5. In bracket 4, an appropriate explanation may be provided in support of the examiner’s position on anticipation, if necessary.
6. Under [35 U.S.C. 101](#), two patents are not permitted to issue on identical subject matter. Any claims in the instant application directed to the same invention claimed in the reference should be provisionally rejected using form paragraphs 8.30 and 8.32. Additionally, the applicant should be required to amend or cancel claims such that the applied reference and the instant application no longer contain claims directed to the same invention using form paragraph 8.27.fti.
7. Any claims in the instant application that are directed to subject matter that is not patentably distinct from an invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of nonstatutory double patenting using form paragraph 8.33 and at least one of form paragraphs 8.34 - 8.39.
8. If evidence is additionally of record to show that either invention is prior art to the other under [pre-AIA 35 U.S.C. 102\(f\)](#) or (g), a rejection using form paragraphs 7.13.fti and/or 7.14.fti should also be made.
9. For applications with an actual filing date on or after March 16, 2013 that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

**¶ 7.15.02.fti Rejection, Pre-AIA 35 U.S.C. 102(e), Common Assignee, Applicant, or Joint Inventor**

Claim(s) [1] is/are rejected under [pre-AIA 35 U.S.C. 102\(e\)](#) as being anticipated by [2].

The applied reference has a common [3] with the instant application. Based upon the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference, it constitutes prior art. This rejection under [pre-AIA 35 U.S.C. 102\(e\)](#) might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the reference was derived from the inventor or joint inventors (i.e., the inventive entity) of this application and is thus not the invention “by another,” or if the same invention is not being claimed, by an appropriate showing under [37 CFR 1.131\(a\)](#).

**Examiner Note:**

1. This form paragraph is used to reject over a patent or patent application publication that is prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) to the claimed invention. The patent or patent application publication must have either a common assignee, a common applicant ([35 U.S.C. 118](#)), or a common (joint) inventor.

2. [Pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12.fti) must be applied if the reference is by another and is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, **an international application (PCT) if the international application has an international filing date on or after November 29, 2000;**

c. a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States. See the Examiner Notes for form paragraph 7.12.fti to assist in the determination of the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference.

3. [Pre-AIPA 35 U.S.C. 102\(e\)](#) (form paragraph 7.12.01.fti) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01.fti to assist in the determination of the [pre-AIPA 35 U.S.C. 102\(e\)](#) date of the reference.

4. In determining the [pre-AIA 35 U.S.C. 102\(e\)](#) date, consider benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), and to earlier-filed U.S. nonprovisional applications and international applications under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in a prior art date under [pre-AIA 35 U.S.C. 102\(e\)](#) as of the date the requirements of [35 U.S.C. 371\(c\)\(1\)](#), [\(2\)](#) and [\(4\)](#) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\) - \(d\)](#), [365\(a\) or \(b\)](#), or [386\(a\) or \(b\)](#).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

5. If the reference is a publication of an international application (PCT), including voluntary U.S. publication under [35 U.S.C. 122](#) of the national stage or a WIPO PCT publication, that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under [pre-AIA 35 U.S.C. 102\(e\)](#). The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [\(b\)](#) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

6. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.

7. This form paragraph must be preceded by either of form paragraphs 7.12.fti or 7.12.01.fti.

8. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.fti.

9. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

10. Under [35 U.S.C. 101](#), two patents are not permitted to issue on identical subject matter. Any claims in the instant application directed to the same invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) using form paragraphs 8.30 - 8.32. Additionally, the applicant should be required to resolve any issue of priority under [pre-AIA 35 U.S.C. 102\(g\)](#) and possibly [pre-AIA 35 U.S.C. 102\(f\)](#) using form paragraph 8.27.fti. See [MPEP § 804](#), subsection II.A.

11. Any claims in the instant application that are directed to subject matter that is not patentably distinct from an invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of nonstatutory double patenting using form paragraph 8.33 and at least one of form paragraphs 8.34 - 8.39.

**¶ 7.15.03.fti Rejection, pre-AIA 35 U.S.C. 102(e), No Common Assignee or Inventor(s)**

Claim(s) [1] is/are rejected under [pre-AIA 35 U.S.C. 102\(e\)](#) as being [2] by [3].

**Examiner Note:**

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date. The patent or patent application publication is not required to have a common assignee or a common inventor.

2. [Pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12.fti) must be applied if the reference is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application (PCT) if

the international application has an international filing date on or after November 29, 2000;

c. a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States. See the Examiner Notes for form paragraph 7.12.fti to assist in the determination of the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference.

3. [Pre-AIPA 35 U.S.C. 102\(e\)](#) (form paragraph 7.12.01.fti) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01.fti to assist in the determination of the pre-AIPA 35 U.S.C. 102(e) date of the reference.

4. In determining the [pre-AIA 35 U.S.C. 102\(e\)](#) date, consider benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), and to earlier-filed U.S. nonprovisional applications and international applications under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in a prior art date under pre-AIPA 35 U.S.C. 102(e) as of the date the requirements of [35 U.S.C. 371\(c\)\(1\)](#), [\(2\)](#) and [\(4\)](#) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\) - \(d\)](#), [365\(a\) or \(b\)](#), or [35 U.S.C. 386\(a\) or \(b\)](#).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph or [35 U.S.C. 112\(a\)](#). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

5. If the reference is a publication of an international application (PCT), including voluntary U.S. publication under [35 U.S.C. 122](#) of the national stage or a WIPO (PCT) publication, that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under [pre-AIA 35 U.S.C. 102\(e\)](#). The reference may be applied under [pre-AIA 35 U.S.C. 102\(a\)](#) or [\(b\)](#) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

6. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

7. In bracket 3, insert the prior art relied upon.

8. This form paragraph must be preceded by either of form paragraphs 7.12.fti or 7.12.01.fti.

9. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.fti.

**¶ 7.16.fti Rejection, pre-AIA 35 U.S.C. 102(b), Public Use or on Sale**

Claim [1] rejected under [pre-AIA 35 U.S.C. 102\(b\)](#) based upon a public use or sale of the invention. [2]

**Examiner Note:**

1. This form paragraph must be preceded either by form paragraphs 7.07.fti and 7.09.fti or by form paragraph 7.103.
2. A full explanation of the evidence establishing a public use or sale must be provided in bracket 2.

**¶ 7.17.fti Rejection, pre-AIA 35 U.S.C. 102(c), Abandonment of Invention**

Claim [1] rejected under [pre-AIA 35 U.S.C. 102\(c\)](#) because the invention has been abandoned. [2]

**Examiner Note:**

1. This form paragraph must be preceded either by form paragraph 7.07.fti and 7.10.fti or by form paragraph 7.103.
2. In bracket 2, insert a full explanation of the evidence establishing abandonment of the invention. See [MPEP § 2134](#).

**¶ 7.18.fti Rejection, pre-AIA 35 U.S.C. 102(d), Foreign Patenting**

Claim [1] rejected under [pre-AIA 35 U.S.C. 102\(d\)](#) as being barred by applicants [2]. [3]

**Examiner Note:**

1. This form paragraph must be preceded either by form paragraphs 7.07.fti and 7.11.fti or by form paragraph 7.103.
2. In bracket 3, insert an explanation of this rejection which must include appropriate dates and how they make the foreign patent available under [pre-AIA 35 U.S.C. 102\(d\)](#).
3. Refer to [MPEP § 2135](#) for applicable [pre-AIA 35 U.S.C. 102\(d\)](#) prior art.

**¶ 7.19.fti Rejection, pre-AIA 35 U.S.C. 102(f), Applicant Not the Inventor**

Claim [1] is/are rejected under [pre-AIA 35 U.S.C. 102\(f\)](#) because the applicant did not invent the claimed subject matter. [2]

**Examiner Note:**

1. This paragraph must be preceded either by paragraphs 7.07.fti and 7.13.fti or by paragraph 7.103.
2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See [MPEP § 2137](#).



**2140 [Reserved]****2141 Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150 et seq.](#) Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

**35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.**

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in [section 102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**Pre-AIA 35 U.S.C. 103 Conditions for patentability; nonobvious subject matter.**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in [section 102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**EXAMINATION GUIDELINES FOR DETERMINING OBVIOUSNESS UNDER 35 U.S.C. 103**

These guidelines are intended to assist Office personnel to make a proper determination of obviousness under [35 U.S.C. 103](#), and to provide an appropriate supporting rationale in view of the decision by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007). The guidelines are based on the Office's current understanding of the law, and are believed to be fully consistent with the binding precedent of the Supreme Court. The *KSR* decision reinforced earlier decisions that validated a more flexible approach to providing reasons for obviousness. However, the Supreme Court's pronouncement in *KSR* overruled cases such as *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), insofar as those cases require record evidence of an express reason to modify the prior art. As the Federal Circuit has explained:

At the time [of the decision in *In re Lee*], we required the PTO to identify record evidence of a teaching, suggestion, or motivation to combine references because "[o]mission of a relevant factor required by precedent is both legal error and arbitrary agency action." However, this did not preclude examiners from employing common sense. More recently [in *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1366 (Fed. Cir. 2006)], we explained that use of common sense does not require a "specific hint or suggestion in a particular reference," only a reasoned explanation that avoids conclusory generalizations.

*Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329, 92 USPQ2d 1849, 1854 (Fed. Cir. 2009) (citations omitted).

In another case, the Federal Circuit also stated that:

"... we conclude that while 'common sense' can be invoked, even potentially to supply a limitation missing from the prior art, it must still be supported by evidence and a reasoned



explanation....[T]his is particularly true where the missing limitation goes to the heart of an invention.”

*Arendi v. Apple*, 832 F.3d 1355, 1363, 119 USPQ2d 1822, 1827 (Fed. Cir. 2016).

These guidelines do not constitute substantive rule making and hence do not have the force and effect of law. They have been developed as a matter of internal Office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the Office. Rejections continue to be based upon the substantive law, and it is these rejections that are appealable. Consequently, any failure by Office personnel to follow the guidelines is neither appealable nor petitionable.

## I. THE KSR DECISION AND PRINCIPLES OF THE LAW OF OBVIOUSNESS

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at 404, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) “by holding that courts and patent examiners should look only to the problem the patentee was trying to solve” (*Id.* at 420, 82 USPQ2d at 1397); (2) by assuming “that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem” (*Id.*); (3) by concluding “that a patent claim cannot be proved obvious merely by showing that the combination of elements was ‘obvious to try’” (*Id.* at 421, USPQ2d at 1397); and (4) by overemphasizing “the risk of courts and patent examiners falling prey to hindsight bias” and as a result applying “[r]igid preventative rules that deny factfinders recourse to common sense” (*Id.*). See also *Novartis Pharms. Corp. v. West-Ward Pharms. Int’l Ltd.*, 923 F.3d 1051, 1059, 2019 USPQ2d 171676 (Fed. Cir. 2019); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1047-48, 120 USPQ2d 1400, 1410 (Fed. Cir. 2016); and *Aventis Pharma*

*S.A. v. Hospira, Inc.*, 675 F.3d 1324, 1332, 102 USPQ2d 1445, 1449 (Fed. Cir. 2012).

In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 415, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 415-16, 82 USPQ2d at 1395. The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at 416, 82 USPQ2d at 1395. (1) “In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* (2) “In *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *Id.* at 416-17, 82 USPQ2d at 1395. (3) “[I]n *Sakraida v. AG Pro, Inc.*, the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 417, 82 USPQ2d at 1395-96 (Internal quotations omitted.). The principles underlining these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art would have been obvious. The Supreme Court further stated that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual

application is beyond his or her skill. *Id.* at 417, 82 USPQ2d at 1396.

When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court’s flexible approach to the obviousness inquiry is reflected in numerous pre- *KSR* decisions; see [MPEP § 2144](#). That section provides many lines of reasoning to support a determination of obviousness based upon earlier legal precedent that had condoned the use of particular examples of what may be considered common sense or ordinary routine practice (e.g., making integral, changes in shape, making adjustable). Thus, the type of reasoning sanctioned by the opinion in *KSR* has long been part of the patent examination process.

## II. THE BASIC FACTUAL INQUIRIES OF *GRAHAM v. JOHN DEERE CO.*

An invention that would have been obvious to a person of ordinary skill at the relevant time is not patentable. See [35 U.S.C. 103](#) or [pre-AIA 35 U.S.C. 103\(a\)](#). As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under [35 U.S.C. 103](#) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Id.* at 17-18, 148 USPQ at 467. Such evidence, sometimes referred to as “secondary considerations,” may include evidence of commercial success,

long-felt but unsolved needs, failure of others, and unexpected results. The evidence may be included in the specification as filed, accompany the application on filing, or be provided in a timely manner at some other point during the prosecution. The weight to be given any objective evidence is determined on a case-by-case basis. The mere fact that an applicant has presented evidence does not mean that the evidence is dispositive of the issue of obviousness.

The question of obviousness must be resolved on the basis of the factual inquiries set forth above. While each case is different and must be decided on its own facts, these factual inquiries, as well as secondary considerations when present, must be analyzed. The *Graham* factors were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR*, 550 U.S. at 406-07, 82 USPQ2d at 1391 (2007). The Supreme Court has utilized the *Graham* factors in each of its obviousness decisions since *Graham*. See *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, *reh’g denied*, 426 U.S. 955 (1976); *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976); and *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [ *Graham* ] factors continue to define the inquiry that controls.” *KSR*, 550 U.S. at 407, 82 USPQ2d at 1391.

### *Office Personnel As Factfinders*

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office

personnel are the necessary underpinnings to establish obviousness.

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under [35 U.S.C. 103](#). [35 U.S.C. 132](#) requires that the applicant be notified of the reasons for the rejection of the claim so that the applicant can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.

In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the relevant time, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. What follows is a discussion of the *Graham* factual inquiries.

#### A. *Determining the Scope and Content of the Prior Art*

In determining the scope and content of the prior art, Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application under examination by reading the specification, including the claims, to understand what has been invented. See [MPEP § 904](#). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and [MPEP § 2111](#). Once the scope of the claimed invention is determined, Office personnel must then determine what to search for and where to search.

#### 1. What To Search For:

The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed. See [MPEP § 904.02](#). Although a rejection need not be based on a teaching or suggestion to combine, a preferred search will be directed to finding references

that provide such a teaching or suggestion if they exist.

#### 2. Where To Search:

Office personnel should continue to follow the general search guidelines set forth in [MPEP § 904](#) to [§ 904.03](#) regarding search of the prior art. Office personnel are reminded that, for purposes of [35 U.S.C. 103](#), prior art can be either in the field of the inventor’s endeavor or be reasonably pertinent to the particular problem with which the inventor was concerned. See [MPEP § 2141.01\(a\)](#) for a discussion of analogous art and [MPEP § 1504.03](#) for a discussion of analogous art for design applications. Furthermore, prior art that is in a field of endeavor other than that of the inventor (as noted by the Court in *KSR*, “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one,” 550 U.S. at 417, 82 USPQ2d at 1396 (emphasis added)), or solves a problem which is different from that which the inventor was trying to solve, may also be considered for the purposes of [35 U.S.C. 103](#). (The Court in *KSR* stated that “[t]he first error...in this case was...holding that courts and patent examiners should look only to the problem the patentee was trying to solve. The Court of Appeals failed to recognize that the problem motivating the patentee may be only one of many addressed by the patent’s subject matter...The second error [was]...that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem.” 550 U.S. at 420, 82 USPQ2d at 1397. Federal Circuit case law prior to the Supreme Court’s decision in *KSR* is generally in accord with these statements by the *KSR* Court. See e.g., *In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1902 (Fed. Cir. 1990) (*en banc*) (“[I]t is not necessary in order to establish a *prima facie* case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from **the prior art** that the claimed compound or composition will have the same or a similar utility **as one newly discovered by applicant**”) (emphasis added); *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972) (“The fact that appellant uses sugar for a different

purpose does not alter the conclusion that its use in a prior art composition would be *prima facie* obvious from the purpose disclosed in the references.”).

For a discussion of what constitutes prior art, see [MPEP § 901](#) to [§ 901.06\(d\)](#) and [§ 2121](#) to [§ 2129](#). See [MPEP § 2141.01\(a\)](#) for a discussion of analogous art and [MPEP § 1504.03](#) for a discussion of analogous art for design applications.

### ***B. Ascertaining the Differences Between the Claimed Invention and the Prior Art***

Ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, see [MPEP § 2111](#), and considering both the invention and the prior art as a whole. See [MPEP § 2141.02](#).

### ***C. Resolving the Level of Ordinary Skill in the Art***

Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill. See [MPEP § 2141.03](#), subsection II, regarding implicit indication of the level of ordinary skill. A finding as to the level of ordinary skill may be used as a partial basis for a resolution of the issue of obviousness.

The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the relevant time. Factors that may be considered in determining the level of ordinary skill in the art may include: (1) “type of problems encountered in the art;” (2) “prior art solutions to those problems;” (3) “rapidity with which innovations are made;” (4) “sophistication of the technology; and” (5) “educational level of active workers in the field.” *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). “In a given case, every factor may not be present, and one or more factors may predominate.” *Id.* See also *Custom Accessories, Inc. v. Jeffrey-Allan Indust., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983).

“A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 421, 82 USPQ2d at 1397. “[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420, 82 USPQ2d at 1397. Office personnel may also take into account “the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418, 82 USPQ2d at 1396.

In addition to the factors above, Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art. The Federal Circuit has stated that examiners and administrative patent judges on the Board are “persons of scientific competence in the fields in which they work” and that their findings are “informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art.” *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003). In addition, examiners “are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 86 USPQ2d 1385 (Fed. Cir. 2008) (quoting *Am. Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1360, 220 USPQ 763, 770 (Fed. Cir. 1984)). See [MPEP § 2141.03](#) for a discussion of the level of ordinary skill.

## **III. RATIONALES TO SUPPORT REJECTIONS UNDER 35 U.S.C. 103**

Once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious as of the relevant time to one of ordinary skill in the art.

The obviousness analysis cannot be confined by . . . overemphasis on the importance of published articles and the explicit content of issued patents. . . . In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. *KSR*, 550 U.S. at 419, 82 USPQ2d at 1396.



Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The “mere existence of differences between the prior art and an invention does not establish the invention’s nonobviousness.” *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.” *Id.* In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious as of the relevant time to one of ordinary skill in the art after consideration of all the facts. See [35 U.S.C. 103](#) or [pre-AIA 35 U.S.C. 103\(a\)](#). Factors other than the disclosures of the cited prior art may provide a basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap. The rationales discussed below outline reasoning that may be applied to find obviousness in such cases.

If the search of the prior art and the resolution of the *Graham* factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection is appropriate. Although the Supreme Court in *KSR* cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness. (According to the Supreme Court, establishment of the TSM approach to the question of obviousness “captured a helpful insight.” 550 U.S. at 418, 82 USPQ2d at 1396 (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 207-208 (1961)). Furthermore, the Court explained that “[t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.” 550 U.S. at 419, 82 USPQ2d at 1396. The Supreme Court also commented that the Federal Circuit “no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases.” *Id.* Office personnel

should also consider whether one or more of the other rationales set forth below supports a conclusion of obviousness. The Court in *KSR* identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. *KSR*, 550 U.S. at 415-21, 82 USPQ2d at 1395-97. Note that the list of rationales provided below is not intended to be an all-inclusive list. Other rationales to support a conclusion of obviousness may be relied upon by Office personnel. Consistent with *KSR*, the Federal Circuit stated that the obviousness analysis is not “confined by a formalistic conception of the words teaching, suggestion, and motivation.” *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 795, 2021 USPQ2d 1259 (Fed. Cir. 2021) (quoting *KSR*, 550 U.S. at 419, 82 USPQ2d at 1396). See also *In re Ethicon, Inc.*, 844 F.3d 1344, 1350, 121 USPQ2d 1139, 1143 (Fed. Cir. 2017) (recalling that the Supreme Court has instructed decisionmakers to “apply ‘an expansive and flexible approach’ to obviousness”) (quoting *KSR*, 550 U.S. at 415, 82 USPQ2d at 1395).

The key to supporting any rejection under [35 U.S.C. 103](#) is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under [35 U.S.C. 103](#) should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396. See also *Adapt Pharma Operations Ltd. v. Teva Pharms. USA, Inc.*, 25 F.4th 1354, 1365, 2022 USPQ2d 144 (Fed. Cir. 2022) (stating that a determination of obviousness “requires ‘identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’” (quoting *KSR*, 550 U.S. at 418, 82 USPQ2d at 1395)). Examples of rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;



(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

See [MPEP § 2143](#) for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness. See also [MPEP § 2144 - § 2144.09](#) for additional guidance regarding support for obviousness determinations.

#### IV. APPLICANT’S REPLY

Once Office personnel have issued a rejection that establishes the *Graham* factual findings and concludes, in view of the relevant evidence of record at that time, that the claimed invention would have been obvious as of the relevant time, the burden then shifts to the applicant to (A) show that the Office erred in these findings or (B) provide other evidence to show that the claimed subject matter would have been nonobvious. [37 CFR 1.111\(b\)](#) requires applicant to distinctly and specifically point out the supposed errors in the Office’s action and reply to every ground of objection and rejection in the Office action. The reply must present arguments pointing out the specific distinction believed to render the claims patentable over any applied references.

If an applicant disagrees with any factual findings by the Office, an effective traverse of a rejection based wholly or partially on such findings must

include a reasoned statement explaining why the applicant believes the Office has erred substantively as to the factual findings. A mere statement or argument that the Office has not established a *prima facie* case of obviousness or that the Office’s reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection or an effective traverse of the rejection under [37 CFR 1.111\(b\)](#). Office personnel addressing this situation may repeat the rejection made in the prior Office action and make the next Office action final. See [MPEP § 706.07\(a\)](#).

An applicant’s reply could also establish that a disclosure relied on in an obviousness rejection is not in fact prior art in view of a [35 U.S.C. 102\(b\)](#) exception, or that subject matter, although prior art, is disqualified for use in an obviousness rejection in view of [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP §§ 2146, 2153.01 and 2154.02](#). See also [MPEP § 2155](#) regarding affidavits or declarations under [37 CFR 1.130](#) to overcome prior art rejections.

#### V. CONSIDERATION OF APPLICANT’S REBUTTAL EVIDENCE

Office personnel should consider all rebuttal evidence that is timely presented by the applicants when reevaluating any obviousness determination. Rebuttal evidence may include evidence of “secondary considerations,” such as “commercial success, long felt but unsolved needs, [and] failure of others” (*Graham v. John Deere Co.*, 383 U.S. at 17, 148 USPQ at 467), and may also include evidence of unexpected results. As set forth above, Office personnel must articulate findings of fact that support the rationale relied upon in an obviousness rejection. As a result, applicants are likely to submit evidence to rebut the fact finding made by Office personnel. For example, in the case of a claim to a combination, applicants may submit evidence or argument to demonstrate that:

(A) one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties);

(B) the elements in combination do not merely perform the function that each element performs separately; or

(C) the results of the claimed combination were unexpected.

Once the applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. See, e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). All the rejections of record and proposed rejections and their bases should be reviewed to confirm their continued viability. The Office action should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings. The procedures set forth in [MPEP § 706.07\(a\)](#) are to be followed in determining whether an action may be made final.

See [MPEP § 2145](#) concerning consideration of applicant's rebuttal evidence. See also [MPEP § 716](#) to [§ 716.10](#) regarding affidavits or declarations filed under [37 CFR 1.132](#) for purposes of traversing grounds of rejection.

### **2141.01 Scope and Content of the Prior Art [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to pre-AIA 35 U.S.C. 102, the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to pre-AIA 35 U.S.C. 102. These court decisions may be applicable to applications and patents subject to AIA 35 U.S.C. 102 but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

#### **I. PRIOR ART AVAILABLE UNDER 35 U.S.C. 102 IS AVAILABLE UNDER 35 U.S.C. 103**

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in

the prior art under [35 U.S.C. § 102.](#)" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Subject matter that is prior art under [35 U.S.C. 102](#) can be used to support a rejection under [section 103](#). *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed [section 103](#) as including all of the various bars to a patent as set forth in [section 102.](#)"). See also *In re Wertheim*, 646 F.2d 527, 532, 209 USPQ 554, 560 (CCPA 1981) ("Commensurate with the Senate Report and Mr. Federico's commentary, we have held that the term 'prior art' refers 'to at least the statutory prior art material named in [§ 102.](#)'"); and *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968) ("[w]hile [35 U.S.C. 102](#) is not directly involved in the issue on review, the conditions for patentability, novelty and loss of right to patent, there stated, may have relevance as to the disclosure which must be found in the prior art to find obviousness of an invention under [section 103.](#)").

Furthermore, admitted prior art can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of [35 U.S.C. 102](#). *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988). See [MPEP § 2129](#) for discussion of admissions as prior art.

An obviousness rejection is ordinarily based on a disclosure that qualifies as prior art under [35 U.S.C. 102](#) or [pre-AIA 35 U.S.C. 102](#). If it is established that a disclosure does not qualify as prior art under an appropriate section of [35 U.S.C. 102](#), then the disclosure is also not prior art that can be used in an obviousness rejection. For instance, for a claimed invention subject to [35 U.S.C. 102](#), a [35 U.S.C. 102\(a\)\(2\)](#) reference used in an anticipation rejection but overcome by submitting a declaration under [37 CFR 1.130\(a\)](#) cannot be used in an obviousness rejection. Likewise, for a claimed invention subject to [pre-AIA 35 U.S.C. 102](#), a [pre-AIA 35 U.S.C. 102\(a\)](#) reference used in an anticipation rejection

but overcome by submitting a declaration under [37 CFR 1.131](#) cannot be used in an obviousness rejection.

For an overview of what constitutes prior art under [35 U.S.C. 102](#), see [MPEP § 901 - § 901.06\(d\)](#), [§ 2121 - § 2129](#) and [§ 2151 - § 2155](#).

## II. SUBSTANTIVE CONTENT OF THE PRIOR ART

See [MPEP § 2121 - § 2129](#) for case law relating to the substantive content of the prior art (e.g., availability of inoperative devices, extent to which prior art must be enabling, broad disclosure rather than preferred embodiments, admissions, etc.).

### III. CONTENT OF THE PRIOR ART IS DETERMINED AT THE RELEVANT TIME TO AVOID HINDSIGHT

The purpose of the [pre-AIA 35 U.S.C. 103\(a\)](#) requirement “at the time the invention was made” is to avoid impermissible hindsight. Likewise, the [AIA 35 U.S.C. 103](#) requirement “before the effective filing date of the claimed invention” serves the same purpose. See [MPEP § 2145](#), subsection X.A. for a discussion of rebutting applicants’ arguments that a rejection is based on hindsight.

In the pre-AIA context, the Federal Circuit stated, “[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art. . . .” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Although the AIA has changed the relevant time focus to “before the effective filing date of the claimed invention,” the observation expressed by the Federal Circuit otherwise continues to apply.

## IV. PRE-AIA 35 U.S.C. 103(c) COMMON OWNERSHIP— REQUIRED FOR THE CONDITIONS OF PRE-AIA 35 U.S.C. 103(c)

An applicant subject to [pre-AIA 35 U.S.C. 102](#) who wants to rely on [pre-AIA 35 U.S.C. 103\(c\)](#) to

overcome an obviousness rejection has the burden of establishing that subject matter which only qualifies as prior art under subsection (e), (f) or (g) of [pre-AIA 35 U.S.C. 102](#) used in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Likewise, an applicant who wants to rely on the joint research provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) (for applications pending on or after December 10, 2004) has the burden of establishing that:

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

These prior art disqualifications under [pre-AIA 35 U.S.C. 103\(c\)](#) are only applicable for subject matter which only qualifies as prior art under subsection (e), (f) or (g) of [pre-AIA 35 U.S.C. 102](#) and is used in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#).

Note that for applications filed prior to November 29, 1999, and granted as patents prior to December 10, 2004, [pre-AIA 35 U.S.C. 103\(c\)](#) is limited on its face to subject matter developed by another person which qualifies as prior art only under subsection (f) or (g) of [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2146.01](#). See also *In re Bartfeld*, 925 F.2d 1450, 1453-54, 17 USPQ2d 1885, 1888 (Fed. Cir. 1991) (Applicant attempted to overcome a [pre-AIA 35 U.S.C. 102\(e\)/103](#) rejection with a terminal disclaimer by alleging that the public policy intent of [pre-AIA 35 U.S.C. 103\(c\)](#) was to prohibit the use of “secret” prior art in obviousness determinations. The court rejected this argument, holding “We may not disregard the unambiguous exclusion of [§ 102\(e\)](#) from the statute’s purview.”).

See [MPEP § 2146.02](#) for the requirements which must be met to establish common ownership or a joint research agreement.

## 2141.01(a) Analogous and Nonanalogous Art [R-01.2024]

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150 et seq.](#) Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

### I. TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS ART TO THE CLAIMED INVENTION

In order for a reference to be proper for use in an obviousness rejection under [35 U.S.C. 103](#), the reference must be analogous art to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004). A reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). Note that "same field of endeavor" and "reasonably pertinent" are two separate tests for establishing analogous art; it is not necessary for a reference to fulfill both tests in order to qualify as analogous art. See *Bigio*, 381 F.3d at 1325, 72 USPQ2d at 1212. The examiner must determine whether a reference is analogous art to the claimed invention when analyzing the obviousness of the subject matter under examination. When more than one prior art reference is used as the basis of an obviousness rejection, it is not required that the references be analogous art to each other. See *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1380, 2023 USPQ2d 552 (Fed. Cir. 2023) and *Corephotonics, Ltd. v.*

*Apple Inc.*, 84 F.4th 990, 1007, 2023 USPQ2d 1202 (Fed. Cir. 2023). If a reference is not analogous art to the claimed invention, it may not be used in an obviousness rejection under [35 U.S.C. 103](#). However, there is no analogous art requirement for a reference being applied in an anticipation rejection under [35 U.S.C. 102](#). *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

When determining whether the "relevant field of endeavor" test is met, the examiner should consider "explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention." *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1380, 2019 USPQ2d 430083 (Fed. Cir. 2019) (quoting *Bigio*, 381 F.3d at 1325, 72 USPQ2d at 1212). When determining whether a prior art reference meets the "same field of endeavor" test for the analogous art, the primary focus is on what the reference discloses. *Airbus*, 41 F.3d at 1380. The examiner must consider the disclosure of each reference "in view of the 'the reality of the circumstances.'" *Airbus*, 41 F.3d at 1380 (quoting *Bigio*, 381 F.3d at 1326, 72 USPQ2d at 1212). These circumstances are to be weighed "from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor." *Airbus*, 41 F.3d at 1380. See also *Donner Technology, LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 2020 USPQ2d 11335 (Fed. Cir. 2020); *Sanofi-Aventis*, 66 F.4th at 1378; and *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358-59, 2023 USPQ2d 1057 (Fed. Cir. 2023) ("The field of endeavor is 'not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.'") (quoting *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001, 120 USPQ2d 1593, 1597 (Fed. Cir. 2016)).

As for the "reasonably pertinent" test, the examiner should consider the problem faced by the inventor, as reflected - either explicitly or implicitly - in the specification. In order for a reference to be "reasonably pertinent" to the problem, it must "logically [] have commended itself to an inventor's attention in considering his problem." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80



(Fed. Cir. 2007) (quoting *In re Clay*, 966 F.2d 656,658, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992)). See also *In re Klein*, 647 F.3d 1343, 1348, 98 USPQ2d 1991, 1993 (Fed. Cir. 2011) An inventor is not expected to have been aware of all prior art outside of the field of endeavor. *Airbus*, 41 F.3d at 1380-82. A reference outside of the field of endeavor is reasonably pertinent if a person of ordinary skill would have consulted it and applied its teachings when faced with the problem that the inventor was trying to solve. *Airbus*, 41 F.3d at 1380-82. In order to support a determination that a reference is reasonably pertinent, it may be appropriate to include a statement of the examiner's understanding of the problem. The question of whether a reference is reasonably pertinent often turns on how the problem to be solved is perceived. If the problem to be solved is viewed in a narrow or constrained way, and such a view is not consistent with the specification, the scope of available prior art may be inappropriately limited. It may be necessary for the examiner to explain why an inventor seeking to solve the identified problem would have looked to the reference in an attempt to find a solution to the problem, i.e., factual reasons why the prior art is pertinent to the identified problem. See *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359, 2020 USPQ2d 11335 (Fed. Cir. 2020) (“Thus, when addressing whether a reference is analogous art with respect to the claimed invention under a reasonable-pertinence theory, the problems to which both relate must be identified and compared.”).

The Supreme Court's decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), did not change the test for analogous art as stated in *Bigio*. Under *Bigio*, a reference need not be from the same field of endeavor as the claimed invention in order to be analogous art. *Bigio*, 381 F.3d at 1325, 72 USPQ2d at 1212. This is consistent with the Supreme Court's instruction in *KSR* that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one.” *KSR*, 550 U.S. at 417, 82 USPQ2d at 1396. The Federal Circuit reads *KSR* as “direct[ing] us to construe the scope of analogous art broadly” because “*familiar items may have obvious uses beyond their primary purposes*, and a person of ordinary skill often will be able to fit the teachings of multiple

patents together like pieces of a puzzle.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238, 95 USPQ2d 1525, 1530 (Fed. Cir. 2010) (quoting *KSR*, 550 U.S. at 402, 127 S. Ct. at 1727).

Any argument by the applicant that the examiner has misconstrued the problem to be solved, and as a result has improperly relied on nonanalogous art, should be fully considered in light of the specification. In evaluating the applicant's argument, the examiner should look to the teachings of the specification and the inferences that would reasonably have been drawn from the specification by a person of ordinary skill in the art as a guide to understanding the problem to be solved. A prior art reference not in the same field of endeavor as the claimed invention must be reasonably pertinent to the problem to be solved in order to qualify as analogous art and be applied in an obviousness rejection.

## II. CONSIDER SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION

While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of “nonanalogy” or “analogy” respectively, the court has found “the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings).).

## III. ANALOGY IN THE CHEMICAL ARTS

Examples of analogous art in the chemical arts include: *Ex parte Bland*, 3 USPQ2d 1103 (Bd. Pat. App. & Inter. 1986) (Claims were drawn to a particulate composition useful as a preservative for an animal foodstuff (or a method of inhibiting fungus growth in an animal foodstuff therewith) comprising verxite having absorbed thereon

propionic acid. All references were concerned with absorbing biologically active materials on carriers, and therefore the teachings in each of the various references would have been pertinent to the problems in the other references and the invention at hand.); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) (Problem confronting inventor was preventing electrostatic buildup in PTFE tubing caused by hydrocarbon fuel flow while precluding leakage of fuel. Two prior art references relied upon were in the rubber hose art, both referencing the problem of electrostatic buildup caused by fuel flow. The court found that because PTFE and rubber are used by the same hose manufacturers and experience the same and similar problems, a solution found for a problem experienced with either PTFE or rubber hosing would be looked to when facing a problem with the other.); *In re Mlot-Fijalkowski*, 676 F.2d 666, 213 USPQ 713 (CCPA 1982) (Problem faced by inventor was enhancement and immobilization of dye penetrant indications. References which taught the use of dyes and finely divided developer materials to produce colored images preferably in, but not limited to, the duplicating paper art were properly relied upon because the court found that inventor's problem was one of dye chemistry, and a search for its solution would include the dye arts in general.).

#### IV. ANALOGY IN THE MECHANICAL ARTS

Examples of analogous art in the mechanical arts include: *Stevenson v. Int'l Trade Comm.*, 612 F.2d 546, 550, 204 USPQ 276, 280 (CCPA 1979) (“In a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist.”). See also *In re Bigio*, 381 F.3d 1320, 1325-26, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004). The patent application claimed a “hair brush” having a specific bristle configuration. The Board affirmed the examiner’s rejection of the claims as being obvious in view of prior art patents disclosing toothbrushes. *Id.* at 1323, 72 USPQ2d at 1210. The appellant disputed that the patent references constituted analogous art. On appeal, the court upheld the Board’s interpretation of the claim term “hair brush” to encompass any brush that may be used for any bodily hair, including facial hair. *Id.*

at 1323-24, 72 USPQ2d at 1211. With this claim interpretation, the court applied the “field of endeavor test” for analogous art and determined that the references were within the field of the inventor’s endeavor and hence were analogous art because toothbrushes are structurally similar to small brushes for hair, and a toothbrush could be used to brush facial hair. *Id.* at 1326, 72 USPQ2d at 1212.

Also see *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) (Appellant's claims related to double-acting high pressure gas transmission line compressors in which the valves could be removed easily for replacement. The Board relied upon references which taught either a double-acting piston pump or a double-acting piston compressor. The court agreed that since the cited pumps and compressors have essentially the same function and structure, the field of endeavor includes both types of double-action piston devices for moving fluids.); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (Claims at issue were directed to an instrument marker pen body, the improvement comprising a pen arm holding means having an integrally molded hinged member for folding over against the pen body. Although the patent owners argued the hinge and fastener art was nonanalogous, the court held that the problem confronting the inventor was the need for a simple holding means to enable frequent, secure attachment and easy removal of a marker pen to and from a pen arm, and one skilled in the pen art trying to solve that problem would have looked to the fastener and hinge art.); and *Ex parte Goodyear Tire & Rubber Co.*, 230 USPQ 357 (Bd. Pat. App. & Inter. 1985) (A reference in the clutch art was held reasonably pertinent to the friction problem faced by the inventor, whose claims were directed to a braking material, because brakes and clutches utilize interfacing materials to accomplish their respective purposes.).

#### V. ANALOGY IN THE ELECTRICAL ARTS

See, for example, *Medtronic, Inc. v. Cardiac Pacemakers*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983) (Patent claims were drawn to a cardiac pacemaker which comprised, among other components, a runaway inhibitor means for preventing a pacemaker malfunction from causing

pulses to be applied at too high a frequency. Two references disclosed circuits used in high power, high frequency devices which inhibited the runaway of pulses from a pulse source. The court held that one of ordinary skill in the pacemaker designer art faced with a rate-limiting problem would look to the solutions of others faced with rate limiting problems, and therefore the references were in an analogous art.).

## VI. EXAMPLES OF ANALOGY IN THE DESIGN ARTS

See [MPEP § 1504.03](#) for a discussion of the relevant case law setting forth the general requirements for analogous art in design applications.

### 2141.02 Differences Between Prior Art and Claimed Invention [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See [MPEP § 2111](#) - [§ 2116.01](#) for case law pertaining to claim interpretation. See also [MPEP § 2143.03](#) for examples of types of claim language that may raise a question as to its limiting effect.

## I. THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED

In determining the differences between the prior art and the claims, the question under [35 U.S.C. 103](#) is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." *Nortron* argued the invention is just making integral what had been made in four bolted pieces, improperly limiting the focus to a structural difference from the prior art and failing to consider the invention as a whole. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).).

See also *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) (Claims were directed to a three step process for preparing sweetened foods and drinks. The first two steps were directed to a process of producing high purity maltose (the sweetener), and the third was directed to adding the maltose to foods and drinks. The parties agreed that the first two steps were nonobvious but formed a known product and the third step was obvious. The Solicitor argued the preamble was directed to a process for preparing foods and drinks sweetened mildly and thus the specific method of making the high purity maltose (the first two steps in the claimed process) should not be given weight, analogizing with product-by-process claims. The court disagreed and held "due to the admitted unobviousness of the first two steps of the claimed combination of steps, the subject matter as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made." 535 F.2d at 69, 190 USPQ at 17 (emphasis in original). The preamble only

recited the purpose of the process and did not limit the body of the claim. Therefore, the claimed process was a three-step process, not the product formed by two steps of the process or the third step of using that product.)

## II. DISTILLING THE INVENTION DOWN TO A “GIST” OR “THRUST” OF AN INVENTION DISREGARDS “AS A WHOLE” REQUIREMENT

Distilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (District court focused on the “concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material,” but “disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer.”). See also *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) (“treating the advantage as the invention disregards the statutory requirement that the invention be viewed ‘as a whole’”); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

## III. DISCOVERING SOURCE/CAUSE OF A PROBLEM IS PART OF “ASA WHOLE” INQUIRY

“[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under [35 U.S.C. § 103](#).” *In re Sponnoble*, 405 F.2d 578,

585, 160 USPQ 237, 243 (CCPA 1969). However, “discovery of the cause of a problem . . . does not always result in a patentable invention. . . . [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem.” *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original).

In *In re Sponnoble*, the claim was directed to a plural compartment mixing vial wherein a center seal plug was placed between two compartments for temporarily isolating a liquid-containing compartment from a solids-containing compartment. The claim differed from the prior art in the selection of butyl rubber with a silicone coating as the plug material instead of natural rubber. The prior art recognized that leakage from the liquid to the solids compartment was a problem, and considered the problem to be a result of moisture passing around the center plug because of microscopic fissures inherently present in molded or blown glass. The court found the inventor discovered the cause of moisture transmission was through the center plug, and there was no teaching in the prior art which would suggest the necessity of selecting applicant's plug material which was more impervious to liquids than the natural rubber plug of the prior art.

In *In re Wiseman*, 596 F.2d at 1022, 201 USPQ at 661, claims directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action to minimize fading of the brakes were rejected as obvious over a reference showing carbon disc brakes without grooves in combination with a reference showing grooves in noncarbon disc brakes for the purpose of cooling the faces of the braking members and eliminating dust, thereby reducing fading of the brakes. The court affirmed the rejection, holding that even if the inventor discovered the cause of a problem, the solution would have been obvious from the prior art which contained the same solution (inserting grooves in disc brakes) for a similar problem.



#### IV. APPLICANTS ALLEGING DISCOVERY OF A SOURCE OF A PROBLEM MUST PROVIDE SUBSTANTIATING EVIDENCE

Applicants who allege the inventor discovered the source of a problem must provide evidence substantiating the allegation, either by way of affidavits or declarations, or by way of a clear and persuasive assertion in the specification. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (unsubstantiated statement of counsel was insufficient to show appellants discovered source of the problem); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) (Claims were directed to a method for redeeming merchandising coupons which contain a UPC “5-by-5” bar code wherein, among other steps, the memory at each supermarket would identify coupons by manufacturer and transmit the data to a central computer to provide an audit, thereby eliminating the need for clearinghouses and preventing retailer fraud. In challenging the propriety of an obviousness rejection, appellant argued he discovered the source of a problem (retailer fraud and manual clearinghouse operations) and its solution. The court found appellant’s specification did not support the argument that he discovered the source of the problem with respect to retailer fraud, and that the claimed invention failed to solve the problem of manual clearinghouse operations.).

#### V. DISCLOSED INHERENT PROPERTIES ARE PART OF “AS A WHOLE” INQUIRY

“In determining whether the invention as a whole would have been obvious under [35 U.S.C. 103](#), we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention *as a whole*, and not some part of it, which must be obvious under [35 U.S.C. 103](#).” *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (emphasis in original) (citations omitted) (The claimed wastewater treatment device had a tank volume to contactor area of 0.12 gal./sq.

ft. The court found the invention as a whole was the ratio of 0.12 and its inherent property that the claimed devices maximized treatment capacity regardless of other variables in the devices. The prior art did not recognize that treatment capacity was a function of the tank volume to contactor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.). Note, however, that after *KSR*, the presence of a known result-effective variable would be one, but not necessarily the only, motivation for a person of ordinary skill in the art to experiment to reach another workable product or process. See [MPEP § 2144.05](#), subsection II.B. See also *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963) (“From the standpoint of patent law, a compound and all its properties are inseparable.”).

Obviousness cannot be predicated on what is not known at the relevant time, even if the inherency of a certain feature is later established. See *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). See [MPEP § 2112](#) for the requirements of rejections based on inherency.

#### VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (Claims were directed to a process of producing a porous article by expanding shaped, unsintered, highly crystalline poly(tetrafluoroethylene) (PTFE) by stretching said PTFE at a 10% per second rate to more than five times the original length. The prior art teachings with regard to unsintered PTFE indicated the material does not respond to conventional plastics processing, and the material should be stretched slowly. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE would not suggest rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene

should have reduced crystallinity before stretching, and that PTFE should be stretched slowly). *Allied Erecting v. Genesis Attachments*, 825 F.3d 1373, 1381, 119 USPQ2d 1132, 1138 (Fed. Cir. 2016) (“Although modification of the movable blades may impede the quick change functionality disclosed by Caterpillar, ‘[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.’” (quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 USPQ2d 1865, 1870 (Fed. Cir. 2006) (citation omitted))).

However, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also [MPEP § 2123](#).

### **2141.03 Level of Ordinary Skill in the Art [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

#### **I. FACTORS TO CONSIDER IN DETERMINING LEVEL OF ORDINARY SKILL**

The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the relevant time. Factors that may be considered in determining the level of ordinary skill in the art may include: (A) “type of problems encountered in the art;” (B) “prior art solutions to

those problems;” (C) “rapidity with which innovations are made;” (D) “sophistication of the technology; and” (E) “educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate.” *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983).

“A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007). “[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420, 82 USPQ2d 1397. Office personnel may also take into account “the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418, 82 USPQ2d at 1396.

The level of disclosure in the specification of the application under examination or in relevant references may also be informative of the knowledge and skills of a person of ordinary skill in the art. For example, if the specification is entirely silent on how a certain step or function is achieved, that silence may suggest that figuring out how to achieve that step or function is within the ordinary skill in the art, provided that the specification complies with [35 U.S.C. 112](#). *Uber Techs., Inc. v. X One, Inc.*, 957 F.3d 1334, 1339, 2020 USPQ2d 10476 (Fed. Cir. 2020) (“The specification of the '593 patent is entirely silent on how to transmit user locations and maps from a server to a user's mobile device, suggesting that a person of ordinary skill in the art was more than capable of selecting between the known methods of accomplishing this. The '593 patent confirms that its invention, including any necessary plotting, ‘utilizes existing platforms and infrastructure’ and does not ‘require development of new cell phone or PDA technology, nor do[es it] require development of new cellular communication infrastructure.’”)

The “hypothetical ‘person having ordinary skill in the art’ to which the claimed subject matter pertains

would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art.” *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988) (The Board disagreed with the examiner’s definition of one of ordinary skill in the art (a doctorate level engineer or scientist working at least 40 hours per week in semiconductor research or development), finding that the hypothetical person is not definable by way of credentials, and that the evidence in the application did not support the conclusion that such a person would require a doctorate or equivalent knowledge in science or engineering.).

References which are not prior art may be relied upon to demonstrate the level of ordinary skill in the art at or around the relevant time. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1098, 231 USPQ 375, 380 (Fed. Cir. 1986) (“Evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’” (citing *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983))); *Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1379, 56 USPQ2d 1065, 1079 (Fed. Cir. 2000) (“The fact of near-simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.” (quoting *The Int’l Glass Co. v. United States*, 408 F.2d 395, 405, 159 USPQ 434, 442 (Ct. Cl. 1969))). See also *Thomas & Betts Corp. v. Litton Sys., Inc.*, 720 F.2d 1572, 1580-81, 220 USPQ 1, 7 (Fed. Cir. 1983) (“Thus, the [unpublished internal materials], though not technically prior art, were, in effect, properly used as indicators of the level of ordinary skill in the art to which the invention pertained.”).

Moreover, references not available as prior art may be relevant to establishing “a motivation to combine which is implicit in the knowledge of one of ordinary skill in the art.” *Nat’l Steel Car, Ltd. v. Can. Pac. Ry., Ltd.*, 357 F.3d 1319, 1337-38, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004) (holding that a drawing made by an engineer that was not prior art can, nonetheless, “... be used to demonstrate a motivation to combine implicit in the knowledge of one of ordinary skill in the art.”).

## II. SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

## III. ASCERTAINING LEVEL OF ORDINARY SKILL IS NECESSARY TO MAINTAIN OBJECTIVITY

“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious as of the relevant time to one of ordinary skill in the art, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

### 2142 Legal Concept of *Prima Facie* Obviousness [R-01.2024]

[Editor Note: Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

“During patent examination and reexamination, the concept of prima facie obviousness establishes the framework for the obviousness determination and the burdens the parties face. Under this framework, the patent examiner must first set forth a prima facie case, supported by evidence, showing why the claims

at issue would have been obvious in light of the prior art. Once the examiner sets out this *prima facie* case, the burden shifts to the patentee to provide evidence, in the prior art or beyond it, or argument sufficient to rebut the examiner's evidence. The examiner then reaches the final determination on obviousness by weighing the evidence establishing the *prima facie* case with the rebuttal evidence.” *ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1365–66, 117 USPQ2d 1951, 1553-54 (Fed. Cir. 2016) (internal citations omitted).

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence or arguments in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of using facts and reasoning to establish a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence or arguments to show nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses properties not expected by the prior art, or rebuttal arguments. The decision of whether to submit evidence after a rejection should be influenced by the goals of compact prosecution, which encourages the early submission of such evidence. It is also noted that evidence submitted after final rejection may be denied entry into the record.

To reach a proper determination under [35 U.S.C. 103](#), the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art”. That time is “before the effective filing date of the claimed invention” for [35 U.S.C. 103](#) or “at the time the invention was made”

for [pre-AIA 35 U.S.C. 103](#). In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to a hypothetical person of ordinary skill in the art. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search, and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

[35 U.S.C. 103](#) authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under [35 U.S.C. 103](#), the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the relevant time.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference



should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n.3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid ([35 U.S.C. 282](#)) and constitute a property right ([35 U.S.C. 261](#)), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see [MPEP § 1701.01](#)), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

See [MPEP §§ 2141 - 2144.09](#) generally for guidance on patentability determinations under [35 U.S.C. 103](#), including a discussion of the requirements of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). See [MPEP § 2145](#) for consideration of applicant's rebuttal arguments. See [MPEP §§ 2154](#) and [2154.02](#) for a discussion of exceptions to prior art under [35 U.S.C. 102\(b\)](#), and [MPEP § 2156](#) for a discussion of [35 U.S.C. 102\(c\)](#) and references of joint researchers. See [MPEP § 2146 et seq.](#) for a discussion of prior art disqualified under [pre-AIA 35 U.S.C. 103\(a\)](#). Note that [MPEP § 2158](#) provides a comparison of the provisions of [AIA 35 U.S.C. 103](#) and [pre-AIA 35 U.S.C. 103](#).

#### **ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS**

The key to supporting any rejection under [35 U.S.C. 103](#) is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under [35 U.S.C. 103](#) should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support

the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396 (quoting Federal Circuit's statement in *Kahn* with approval).

It remains true that "[t]he determination of obviousness is dependent on the facts of each case." *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1089, 89 USPQ2d 1370, 1379 (Fed. Cir. 2008) (citing *Graham*, 383 U.S. at 17-18, 148 USPQ 459, 467 (1966)). If the examiner determines there is factual support for rejecting the claimed invention under [35 U.S.C. 103](#), the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. 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 evidence properly made of record. *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. With regard to rejections under [35 U.S.C. 103](#), the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., a *prima facie* case of obviousness has been established) is more probable than not.

When an applicant properly submits evidence, whether in the specification as originally filed, prior to a rejection, or in reply to a rejection, the examiner must consider the patentability of the claims in light of the evidence. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a discussion of the proper roles of the examiner’s *prima facie* case and applicant’s rebuttal evidence in the final determination of obviousness.

### 2143 Examples of Basic Requirements of a *Prima Facie* Case of Obviousness [R-01.2024]

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

The Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-421, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under [35 U.S.C. 103](#) is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under [35 U.S.C. 103](#) should be made explicit. In *Ball Aerosol v. Ltd. Brands*, 555 F.3d 984, 89 USPQ2d 1870 (Fed. Cir. 2009), the Federal Circuit offered additional instruction as to the need for an explicit analysis. The Federal Circuit explained that the Supreme Court’s requirement for an explicit analysis does not require record evidence of an explicit teaching of a motivation to combine in the prior art.

“[T]he analysis that “should be made explicit” refers not to the teachings in the prior art of a motivation to combine, but to the court’s analysis. . . . Under the flexible inquiry set forth by the Supreme Court,

the district court therefore erred by failing to take account of ‘the inferences and creative steps,’ or even routine steps, that an inventor would employ and by failing to find a motivation to combine related pieces from the prior art.” *Ball Aerosol*, 555 F.3d at 993, 89 USPQ2d at 1877.

The Federal Circuit’s directive in *Ball Aerosol* was addressed to a lower court, but it applies to Office personnel as well. When setting forth a rejection, Office personnel are to continue to make appropriate findings of fact as explained in [MPEP § 2141](#) and [§ 2143](#), and must provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the relevant time. This requirement for explanation remains even in situations in which Office personnel may properly rely on common sense or ordinary ingenuity. *In re Van Os*, 844 F.3d 1359, 1361, 121 USPQ2d 1209, 1211 (Fed. Cir. 2017) (“Absent some articulated rationale, a finding that a combination of prior art would have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious.’”).

#### I. EXAMPLES OF RATIONALES

Examples of rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Note that the list of rationales provided is not intended to be an all-inclusive list. Other rationales to support a conclusion of obviousness may be relied upon by Office personnel. Any rationale employed must provide a link between the factual findings and the legal conclusion of obviousness.

It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed herein, they are to adhere to the guidance provided regarding the necessary factual findings. It remains Office policy that appropriate factual findings are required in order to apply the enumerated rationales properly.

The subsections below include discussions of each rationale along with examples illustrating how the cited rationales may be used to support a finding of obviousness. Some examples use the facts of pre-*KSR* cases to show how the rationales suggested by the Court in *KSR* may be used to support a finding of obviousness. The cases cited (from which the facts were derived) may not necessarily stand for the proposition that the particular rationale is the basis for the court's holding of obviousness, but they do illustrate consistency of past decisions with the lines of reasoning laid out in *KSR*. Other examples are post-*KSR* decisions that show how the Federal Circuit has applied the principles of *KSR*. Cases are included that illustrate findings of obviousness as well as nonobviousness. Note that, in some instances, a single case is used in different subsections to illustrate the use of more than one rationale to support a finding of obviousness. It will often be the case that, once the *Graham* inquiries have been satisfactorily resolved, a conclusion of obviousness may be supported by more than one line of reasoning.

#### ***A. Combining Prior Art Elements According to Known Methods To Yield Predictable Results***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual

inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at 416, 82 USPQ2d at 1395; *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379, 2020 USPQ2d 10706 (Fed. Cir. 2020); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atl. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

#### **Example 1:**

The claimed invention in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969) was

a paving machine which combined several well-known elements onto a single chassis. Standard prior art paving machines typically combined equipment for spreading and shaping asphalt onto a single chassis. The patent claim included the well-known element of a radiant-heat burner attached to the side of the paver for the purpose of preventing cold joints during continuous strip paving. The prior art used radiant heat for softening the asphalt to make patches, but did not use radiant heat burners to achieve continuous strip paving. All of the component parts were known in the prior art. The only difference was the combination of the “old elements” into a single device by mounting them on a single chassis. The Court found that the operation of the heater was in no way dependent on the operation of the other equipment, and that a separate heater could also be used in conjunction with a standard paving machine to achieve the same results. The Court concluded that “[t]he convenience of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a ‘new’ or ‘different function’” and that to those skilled in the art the use of the old elements in combination would have been obvious. *Id.* at 60, 163 USPQ at 674.

Note that combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966). In *Adams*, the claimed invention was to a battery with one magnesium electrode and one cuprous chloride electrode that could be stored dry and activated by the addition of plain water or salt water. Although magnesium and cuprous chloride were individually known battery components, the Court concluded that the claimed battery was nonobvious. The Court stated that “[d]espite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore” the teaching away of the prior art that such batteries were impractical and that water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium electrodes. *Id.* at 42-43, 50-52, 148 USPQ at 480, 483. “[W]hen the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR*, 550 U.S. at 416, 82 USPQ2d at 1395.

#### Example 2:

The claimed invention in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004) was directed to a system which employs a screw anchor for underpinning existing foundations and a metal bracket to transfer the building load onto the screw anchor. The prior art (Fuller) used screw anchors for underpinning existing structural foundations. Fuller used a concrete haunch to transfer the load of the foundation to the screw anchor. The prior art (Gregory) used a push pier for underpinning existing structural foundations. Gregory taught a method of transferring load using a bracket, wherein a metal bracket transfers the foundation load to the push pier. The pier is driven into the ground to support the load. Neither reference showed the two elements of the claimed invention – screw anchor and metal bracket – used together. The court found that “artisans knew that a foundation underpinning system requires

a means of connecting the foundation to the load-bearing member.” *Id.* at 1276, 69 USPQ2d at 1691.

The nature of the problem to be solved – underpinning unstable foundations – as well as the need to connect the member to the foundation to accomplish this goal, would have led one of ordinary skill in the art to choose an appropriate load bearing member and a compatible attachment. Therefore, it would have been obvious to use a metal bracket (as shown in Gregory) in combination with the screw anchor (as shown in Fuller) to underpin unstable foundations.

#### Example 3:

The case of *In re Omeprazole Patent Litigation*, 536 F.3d 1361, 87 USPQ2d 1865 (Fed. Cir. 2008), is one in which the claims in question were found to be nonobvious in the context of an argument to combine prior art elements. The invention involved applying enteric coatings to a drug in pill form for the purpose of ensuring that the drug did not disintegrate before reaching its intended site of action. The drug at issue was omeprazole, the generic name for gastric acid inhibitor marketed as Prilosec<sup>®</sup>. The claimed formulation included two layers of coatings over the active ingredient.

The district court found that Astra’s patent in suit was infringed by defendants Apotex and Impax. The district court rejected Apotex’s defense that the patents were invalid for obviousness. Apotex had argued that the claimed invention was obvious because coated omeprazole tablets were known from a prior art reference, and because secondary subcoatings in pharmaceutical preparations generally were also known. There was no evidence of unpredictability associated with applying two different enteric coatings to omeprazole. However, Astra’s reason for applying an intervening subcoating between the prior art coating and omeprazole had been that the prior art coating was actually interacting with omeprazole, thereby contributing to undesirable degradation of the active ingredient. This degradation of omeprazole by interaction with the prior art coating had not been recognized in the prior art. Therefore, the district court reasoned that based on the evidence available, a person of ordinary skill in the art would have had no reason to include a subcoating in an omeprazole pill formulation.

The Federal Circuit affirmed the district court’s decision that the claimed invention was not obvious. Even though subcoatings for enteric drug formulation were known, and there was no evidence of undue technical hurdles or lack of a reasonable expectation of success, the formulation was nevertheless not obvious because the flaws in the prior art formulation that had prompted the modification had not been recognized. Thus there would have been no reason to modify the initial formulation, even though the modification could have been done. Moreover, a person of ordinary skill in the art likely would have chosen a different modification even if they had recognized the problem.

Office personnel should note that in this case the modification of the prior art that had been presented as an argument for obviousness was an extra process step that added an additional component to a known, successfully marketed formulation. The



proposed modification thus amounted to extra work and greater expense for no apparent reason. This is not the same as combining known prior art elements A and B when each would have been expected to contribute its own known properties to the final product. In the *Omeprazole* case, in view of the expectations of those of ordinary skill in the art, adding the subcoating would not have been expected to confer any particular desirable property on the final product. Rather, the final product obtained according to the proposed modifications would merely have been expected to have the same functional properties as the prior art product.

The *Omeprazole* case can also be analyzed in view of the discovery of a previously unknown problem by the patentee. If the adverse interaction between active agent and coating had been known, it might well have been obvious to use a subcoating. However, since the problem had not been previously known, there would have been no reason to incur additional time and expense to add another layer, even though the addition would have been technologically possible. This is true because the prior art of record failed to mention any stability problem, despite the acknowledgment during testimony at trial that there was a known theoretical reason that omeprazole might be subject to degradation in the presence of the known coating material.

#### Example 4:

The case of *Crocs, Inc. v. U.S. Int'l Trade Comm'n*, 598 F.3d 1294, 93 USPQ 1777 (Fed. Cir. 2010), is a decision in which the claimed foam footwear was held by the Federal Circuit to be nonobvious over a combination of prior art references.

The claims involved in the obviousness issue were from Crocs' U.S. Patent No. 6,993,858, and were drawn to footwear in which a one-piece molded foam base section formed the top of the shoe (the upper) and the sole. A strap also made of foam was attached to the foot opening of the upper, such that the strap could provide support to the Achilles portion of the wearer's foot. The strap was attached via connectors that allowed it to be in contact with the base section, and to pivot relative to the base section. Because both the base portion and the strap were made of foam, friction between the strap and the base section allowed the strap to maintain its position after pivoting. In other words, the foam strap did not fall under the force of gravity to a position adjacent to the heel of the base section.

The International Trade Commission (ITC) determined that the claims were obvious over the combination of two pieces of prior art. The first was the Aqua Clog, which was a shoe that corresponded to the base section of the footwear of the '858 patent. The second was the Aguerre patent, which taught heel straps made of elastic or another flexible material. In the ITC's view, the claimed invention was obvious because the prior art Aqua Clog differed from the claimed invention only as to the presence of the strap, and a suitable strap was taught by Aguerre.

The Federal Circuit disagreed. The Federal Circuit stated that the prior art did not teach foam heel straps, or that a foam heel strap should be placed in contact with a foam base. The Federal

Circuit pointed out that the prior art actually counseled against using foam as a material for the heel strap of a shoe.

The record shows that the prior art would actually discourage and teach away from the use of foam straps. An ordinary artisan in this field would not add a foam strap to the foam Aqua Clog because foam was likely to stretch and deform, in addition to causing discomfort for a wearer. The prior art depicts foam as unsuitable for straps.

*Id.* at 1309, 93 USPQ2d at 1787-88.

The Federal Circuit continued, stating that even if – contrary to fact – the claimed invention had been a combination of elements that were known in the prior art, the claims still would have been nonobvious. There was testimony in the record that the loose fit of the heel strap made the shoe more comfortable for the wearer than prior art shoes in which the heel strap was constantly in contact with the wearer's foot. In the claimed footwear, the foam heel strap contacted the wearer's foot only when needed to help reposition the foot properly in the shoe, thus reducing wearer discomfort that could arise from constant contact. This desirable feature was a result of the friction between the base section and the strap that kept the strap in place behind the Achilles portion of the wearer's foot. The Federal Circuit pointed out that this combination “yielded more than predictable results.” *Id.* at 1310, 93 USPQ2d at 1788. Aguerre had taught that friction between the base section and the strap was a problem rather than an advantage, and had suggested the use of nylon washers to reduce friction. Thus the Federal Circuit stated that even if all elements of the claimed invention had been taught by the prior art, the claims would not have been obvious because the combination yielded more than predictable results.

The Federal Circuit's discussion in *Crocs* serves as a reminder to Office personnel that merely pointing to the presence of all claim elements in the prior art is not a complete statement of a rejection for obviousness. In accordance with [MPEP § 2143](#), subsection I.A.(3), a proper rejection based on the rationale that the claimed invention is a combination of prior art elements also includes a finding that results flowing from the combination would have been predictable to a person of ordinary skill in the art. [MPEP § 2143](#), subsection I.A.(3). If results would not have been predictable, Office personnel should not enter an obviousness rejection using the combination of prior art elements rationale, and should withdraw such a rejection if it has been made.

#### Example 5:

*Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 89 USPQ2d 1535 (Fed. Cir. 2008), involved a segmented and mechanized cover for trucks, swimming pools, or other structures. The claim was found to be obvious over the prior art applied.

A first prior art reference taught that a reason for making a segmented cover was ease of repair, in that a single damaged

segment could be readily removed and replaced when necessary. A second prior art reference taught the advantages of a mechanized cover for ease of opening. The Federal Circuit noted that the segmentation aspect of the first reference and the mechanization function of the second perform in the same way after combination as they had before. The Federal Circuit further observed that a person of ordinary skill in the art would have expected that adding replaceable segments as taught by the first reference to the mechanized cover of the other would result in a cover that maintained the advantageous properties of both of the prior art covers.

Thus, the Sundance case points out that a hallmark of a proper obviousness rejection based on combining known prior art elements is that one of ordinary skill in the art would reasonably have expected the elements to maintain their respective properties or functions after they have been combined.

#### Example 6:

In the case of *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 91 USPQ2d 1225 (Fed. Cir. 2009), an “apparent reason to combine” in conjunction with the technical ability to optimize led to the conclusion that the claimed invention would have been obvious.

The invention in question was a method of treating meat to reduce the incidence of pathogens, by spraying the meat with an antibacterial solution under specified conditions. The parties did not dispute that a single prior art reference had taught all of the elements of the claimed invention, except for the pressure limitation of “at least 50 psi.”

FMC had argued at the district court that the claimed invention would have been obvious in view of the first prior art reference mentioned above in view of a second reference that had taught the advantages of spray-treating at pressures of 20 to 150 psi when treating meat with a different antibacterial agent. The district court did not find FMC’s argument to be convincing, and denied the motion for judgment as a matter of law that the claim was obvious.

Disagreeing with the district court, the Federal Circuit stated that “there was an apparent reason to combine these known elements – namely to increase contact between the [antibacterial solution] and the bacteria on the meat surface and to use the pressure to wash additional bacteria off the meat surface.” *Id.* at 1350, 91 USPQ2d at 1234. The Federal Circuit explained that because the second reference had taught “using high pressure to improve the effectiveness of an antimicrobial solution when sprayed onto meat, and because an ordinarily skilled artisan would have recognized the reasons for applying [the claimed antibacterial solution] using high pressure and would have known how to do so, Ecolab’s claims combining high pressure with other limitations disclosed in FMC’s patent are invalid as obvious.” *Id.*

When considering the question of obviousness, Office personnel should keep in mind the capabilities of a person of ordinary skill. In *Ecolab*, the Federal Circuit stated:

Ecolab’s expert admitted that one skilled in the art would know how to adjust application parameters to determine the optimum parameters for a particular solution. The question then is whether it would have been obvious to combine the high pressure parameter disclosed in the Bender patent with the PAA methods disclosed in FMC’s ’676 patent. The answer is yes. *Id.*

If optimization of the application parameters had not been within the level of ordinary skill in the art, the outcome of the *Ecolab* case may well have been different.

#### Example 7:

In the case of *Wyers v. Master Lock Co.*, 616 F.3d 1231, 95 USPQ2d 1525 (Fed. Cir. 2010), the Federal Circuit held that the claimed barbell-shaped hitch pin locks used to secure trailers to vehicles were obvious.

The court discussed two different sets of claims in *Wyers*, both drawn to improvements over the prior art hitch pin locks. The first improvement was a removable sleeve that could be placed over the shank of the hitch pin lock so that the same lock could be used with towing apertures of varying sizes. The second improvement was an external flat flange seal adapted to protect the internal lock mechanism from contaminants. *Wyers* had admitted that each of several prior art references taught every element of the claimed inventions except for the removable sleeve and the external covering. Master Lock had argued that these references, in combination with additional references teaching the missing elements, would have rendered the claims obvious. The court first addressed the question of whether the additional references relied on by Master Lock were analogous prior art. As to the reference teaching the sleeve improvement, the court concluded that it dealt specifically with using a vehicle to tow a trailer, and was therefore in the same field of endeavor as *Wyers*’ sleeve improvement. The reference teaching the sealing improvement dealt with a padlock rather than a lock for a tow hitch. The court noted that *Wyers*’ specification had characterized the claimed invention as being in the field of locking devices, thus at least suggesting that the sealed padlock reference was in the same field of endeavor. However, the court also observed that even if sealed padlocks were not in the same field of endeavor, they were nevertheless reasonably pertinent to the problem of avoiding contamination of a locking mechanism for tow hitches. The court explained that the Supreme Court’s decision in *KSR* “directs [it] to construe the scope of analogous art broadly.” *Id.* at 1238, 95 USPQ2d at 1530. For these reasons, the court found that Master Lock’s asserted references were analogous prior art, and therefore relevant to the obviousness inquiry.

The court then turned to the question of whether there would have been adequate motivation to combine the prior art elements as had been urged by Master Lock. The court recalled the *Graham* inquiries, and also emphasized the “expansive and flexible” post-*KSR* approach to obviousness that must not “deny factfinders recourse to common sense.” *Id.* at 1238, 95 USPQ2d at 1530-31. (quoting *KSR*, 550 U.S. at 415, 421, 82 USPQ2d at 1395, 1397). The court stated:

*KSR* and our later cases establish that the legal determination of obviousness may include recourse to logic, judgment, and common sense, in lieu of expert testimony. . . . Thus, in appropriate cases, the ultimate inference as to the existence of a motivation to combine references may boil down to a question of “common sense,” appropriate for resolution on summary judgment or JMOL.

*Id.* at 1240, 82 USPQ2d at 1531 (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330, 92 USPQ2d, 1849, 1854 (Fed. Cir. 2009); *Ball Aerosol*, 555 F.3d at 993, 89 USPQ2d 1870, 1875 (Fed. Cir. 2009)).

After reviewing these principles, the court proceeded to explain why adequate motivation to combine had been established in this case. With regard to the sleeve improvement, it pointed out that the need for different sizes of hitch pins was well known in the art, and that this was a known source of inconvenience and expense for users. The court also mentioned the marketplace aspect of the issue, noting that space on store shelves was at a premium, and that removable sleeves addressed this economic concern. As to the sealing improvement, the court pointed out that both internal and external seals were well-known means to protect locks from contaminants. The court concluded that the constituent elements were being employed in accordance with their recognized functions, and would have predictably retained their respective functions when combined as suggested by Master Lock. The court cited *In re O’Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988) for the proposition that a reasonable expectation of success is a requirement for a proper determination of obviousness.

Office personnel should note that although the Federal Circuit invoked the idea of common sense in support of a conclusion of obviousness, it did not end its explanation there. Rather, the court explained why a person of ordinary skill in the art at the time of the invention, in view of the facts relevant to the case, would have found the claimed inventions to have been obvious. The key to supporting any rejection under [35 U.S.C. 103](#) is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under [35 U.S.C. 103](#) should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See [MPEP § 2141](#), subsection III. Office personnel should continue to provide a reasoned explanation for every obviousness rejection.

#### Example 8:

The claim in *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 90 USPQ2d 1865 (Fed. Cir. 2009), was directed to a polyaxial pedicle screw used in spinal surgeries that included a compression member for pressing a screw head against a receiver member. A prior art reference (Puno) disclosed all of the elements of the claim except for the compression

member. Instead, the screw head in Puno was separated from the receiver member to achieve a shock absorber effect, allowing some motion between receiver member and the vertebrae. The missing compression member was readily found in another prior art reference (Anderson), which disclosed an external fracture immobilization splint for immobilizing long bones with a swivel clamp capable of polyaxial movement until rigidly secured by a compression member. It was asserted during trial that a person of ordinary skill would have recognized that the addition of Anderson’s compression member to Puno’s device would have achieved a rigidly locked polyaxial pedicle screw covered by the claim.

In conducting its analysis, the Federal Circuit noted that the “predictable result” discussed in *KSR* refers not only to the expectation that prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose. In this case, it was successfully argued that Puno “teaches away” from a rigid screw because Puno warned that rigidity increases the likelihood that the screw will fail within the human body, rendering the device inoperative for its intended purpose. In fact, the reference did not merely express a general preference for pedicle screws having a “shock absorber” effect, but rather expressed concern for failure and stated that the shock absorber feature “decrease[s] the chance of failure of the screw of the bone-screw interface” because “it prevent[s] direct transfer of load from the rod to the bone-screw interface.” Thus, the alleged reason to combine the prior art elements of Puno and Anderson—increasing the rigidity of the screw—ran contrary to the prior art that taught that increasing rigidity would result in a greater likelihood of failure. In view of this teaching and the backdrop of collective teachings of the prior art, the Federal Circuit determined that Puno teaches away from the proposed combination such that a person of ordinary skill would have been deterred from combining the references as proposed. Secondary considerations evaluated by the Federal Circuit relating to failure by others and copying also supported the view that the combination would not have been obvious at the time of the invention.

#### ***B. Simple Substitution of One Known Element for Another To Obtain Predictable Results***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known element for

another, and the results of the substitution would have been predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that the substitution of one known element for another yields predictable results to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

#### Example 1:

The claimed invention in *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982) was directed to a method for decaffeinating coffee or tea. The prior art (Pagliaro) method produced a decaffeinated vegetable material and trapped the caffeine in a fatty material (such as oil). The caffeine was then removed from the fatty material by an aqueous extraction process. Applicant (Fout) substituted an evaporative distillation step for the aqueous extraction step. The prior art (Waterman) suspended coffee in oil and then directly distilled the caffeine through the oil. The court found that “[b]ecause both Pagliaro and Waterman teach a method for separating caffeine from oil, it would have been *prima facie* obvious to substitute one method for the other. Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *Id.* at 301, 213 USPQ at 536.

#### Example 2:

The claimed invention in *In re O’Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988) was directed to a method for synthesizing a protein in a transformed bacterial host species by substituting a heterologous gene for a gene native to the host species. Generally speaking, protein synthesis *in vivo* follows a path from DNA to mRNA. Although the prior art Polisky article (authored by two of the three joint inventors of the application) had explicitly suggested employing the method described for protein synthesis, the inserted heterologous gene exemplified in the article was one that normally did not proceed all the way to the protein production step, but instead terminated with the mRNA. A second reference to Bahl had described a general method of inserting chemically synthesized DNA into a plasmid. Thus, it would have been obvious to one of ordinary skill in the art to replace the prior art gene with another gene known to lead to protein production, because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable.

In response to applicant’s argument that there had been significant unpredictability in the field of molecular biology at the time of the invention, the court stated that the level of skill was quite high and that the teachings of Polisky, even taken

alone, contained detailed enabling methodology and included the suggestion that the modification would be successful for synthesis of proteins.

This is not a situation where the rejection is a statement that it would have been “obvious to try” without more. Here there was a reasonable expectation of success. “Obviousness does not require absolute predictability of success.” *Id.* at 903, 7 USPQ2d at 1681.

#### Example 3:

The fact pattern in *Ruiz v. AB Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004) is set forth above in Example 2 in subsection I.A., above.

The prior art showed differing load-bearing members and differing means of attaching the foundation to the member. Therefore, it would have been obvious to one of ordinary skill in the art to substitute the metal bracket taught in Gregory for Fuller’s concrete haunch for the predictable result of transferring the load.

#### Example 4:

The claimed invention in *Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007), was a pocket insert for a bound book made by gluing a base sheet and a pocket sheet of paper together to form a continuous two-ply seam defining a closed pocket. The prior art (Wyant) disclosed at least one pocket formed by folding a single sheet and securing the folder portions along the inside margins using any convenient bonding method. The prior art (Wyant) did not disclose bonding the sheets to form a continuous two-ply seam. The prior art (Dick) disclosed a pocket that is made by stitching or otherwise securing two sheets along three of its four edges to define a closed pocket with an opening along its fourth edge.

In considering the teachings of Wyant and Dick, the Board “found that (1) each of the claimed elements is found within the scope and content of the prior art; (2) one of ordinary skill in the art could have combined the elements as claimed by methods known at the time the invention was made; and (3) one of ordinary skill in the art would have recognized at the time the invention was made that the capabilities or functions of the combination were predictable.” Citing *KSR*, the Board concluded that “[t]he substitution of the continuous, two-ply seam of Dick for the folded seam of Wyant thus is no more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

#### Example 5:

The claimed invention in *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 83 USPQ2d 1746 (Fed. Cir. 2007), was directed to a treadmill with a folding tread base that swivels into an upright storage position, including a gas spring connected between the tread base and the upright structure to assist in stably retaining the tread base in the storage position. On reexamination, the examiner rejected the claims as obvious



based on a combination of references including an advertisement (Damark) for a folding treadmill demonstrating all of the claim elements other than the gas spring, and a patent (Teague) with a gas spring. Teague was directed to a bed that folds into a cabinet using a novel dual-action spring that reverses force as the mechanism passes a neutral position, rather than a single-action spring that would provide a force pushing the bed closed at all times. The dual-action spring reduced the force required to open the bed from the closed position, while reducing the force required to lift the bed from the open position.

The Federal Circuit addressed the propriety of making the combination since Teague was in a different field than the application. Teague was found to be reasonably pertinent to the problem addressed in the application because the folding mechanism did not require any particular focus on treadmills, but rather generally addressed problems of supporting the weight of such a mechanism and providing a stable resting position.

The court also considered whether one skilled in the art would have been led to combine the teachings of Damark and Teague. Appellant argued that Teague teaches away from the invention because it directs one skilled in the art not to use single-action springs and does not satisfy the claim limitations as the dual-action springs would render the invention inoperable. The Federal Circuit considered these arguments and found that, while Teague at most teaches away from using single-action springs to decrease the opening force, it actually instructed that single-action springs provide the result desired by the inventors, which was to increase the opening force provided by gravity. As to inoperability, the claims were not limited to single-action springs and were so broad as to encompass anything that assists in stably retaining the tread base, which is the function that Teague accomplished. Additionally, the fact that the counterweight mechanism from Teague used a large spring, which appellant argued would overpower the treadmill mechanism, ignores the modifications that one skilled in the art would make to a device borrowed from the prior art. One skilled in the art would size the components from Teague appropriately for the application.

*ICON* is another useful example for understanding the scope of analogous art. The art applied concerned retaining mechanisms for folding beds, not treadmills. When determining whether a reference may properly be applied to an invention in a different field of endeavor, it is necessary to consider the problem to be solved. It is certainly possible that a reference may be drawn in such a way that its usefulness as a teaching is narrowly restricted. However, in *ICON*, the problem to be solved was not limited to the teaching of the “treadmill” concept. The Teague reference was analogous art because “Teague and the current application both address the need to stably retain a folding mechanism,” and because “nothing about *ICON*’s folding mechanism requires any particular focus on treadmills,” *Id.* at 1378, 1380, 83 USPQ2d at 1749-50.

*ICON* is also informative as to the relationship between the problem to be solved and existence of a reason to combine. “Indeed, while perhaps not dispositive of the issue, the finding that Teague, by addressing a similar problem, provides

analogous art to *ICON*’s application goes a long way towards demonstrating a reason to combine the two references. Because *ICON*’s broad claims read on embodiments addressing that problem as described by Teague, the prior art here indicates a reason to incorporate its teachings.” *Id.* at 1380-81, 83 USPQ2d at 1751.

The Federal Circuit’s discussion in *ICON* also makes clear that if the reference does not teach that a combination is undesirable, then it cannot be said to teach away. An assessment of whether a combination would render the device inoperable must not “ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.” *Id.* at 1382, 83 USPQ2d at 1752.

#### **Example 6:**

*Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 86 USPQ2d 1110 (Fed. Cir. 2008), involved a stationary pest control device for electrocution of pests such as rats and gophers, in which the device is set in an area where the pest is likely to encounter it. The only difference between the claimed device and the prior art stationary pest control device was that the claimed device employed a resistive electrical switch, while the prior art device used a mechanical pressure switch. A resistive electrical switch was taught in two prior art patents, in the contexts of a hand-held pest control device and a cattle prod.

In determining that the claimed invention was obvious, the Federal Circuit noted that “[t]he asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch” employed in the prior art device. *Id.* at 1344, 86 USPQ2d at 1115. In this case, the prior art concerning the hand-held devices revealed that the function of the substituted resistive electrical switch was well known and predictable, and that it could be used in a pest control device. According to the Federal Circuit, the references that taught the hand-held devices showed that “the use of an animal body as a resistive switch to complete a circuit for the generation of an electric charge was already well known in the prior art.” *Id.* Finally, the Federal Circuit noted that the problem solved by using the resistive electrical switch in the prior art hand-held devices – malfunction of mechanical switches due to dirt and dampness – also pertained to the prior art stationary pest control device.

The Federal Circuit recognized *Agrizap* as “a textbook case of when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results.” *Id.* *Agrizap* exemplifies a strong case of obviousness based on simple substitution that was not overcome by the objective evidence of nonobviousness offered. It also demonstrates that analogous art is not limited to the field of the inventor’s endeavor, in that one of the references that used an animal body as a resistive switch to complete a circuit for the generation of an electric charge was not in the field of pest control.

#### **Example 7:**

The invention at issue in *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 87 USPQ2d 1350 (Fed. Cir. 2008), was a method

for auctioning municipal bonds over the Internet. A municipality could offer a package of bond instruments of varying principal amounts and maturity dates, and an interested buyer would then submit a bid comprising a price and interest rate for each maturity date. It was also possible for the interested buyer to bid on a portion of the offering. The claimed invention considered all of the noted parameters to determine the best bid. It operated on conventional Web browsers and allowed participants to monitor the course of the auction.

The only difference between the prior art bidding system and the claimed invention was the use of a conventional Web browser. At trial, the district court had determined that Muniauction's claims were not obvious. Thomson argued that the claimed invention amounted to incorporating a Web browser into a prior art auction system, and was therefore obvious in light of *KSR*. Muniauction rebutted the argument by offering evidence of skepticism by experts, copying, praise, and commercial success. Although the district court found the evidence to be persuasive of nonobviousness, the Federal Circuit disagreed. It noted that a nexus between the claimed invention and the proffered evidence was lacking because the evidence was not coextensive with the claims at issue. For this reason, the Federal Circuit determined that Muniauction's evidence of secondary considerations was not entitled to substantial weight.

The Federal Circuit analogized this case to *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007). The *Leapfrog* case involved a determination of obviousness based on application of modern electronics to a prior art mechanical children's learning device. In *Leapfrog*, the court noted that market pressures would have prompted a person of ordinary skill to use modern electronics in the prior art device. Similarly in *Muniauction*, market pressures would have prompted a person of ordinary skill to use a conventional Web browser in a method of auctioning municipal bonds.

#### Example 8:

In *Aventis Pharma Deutschland v. Lupin Ltd.*, 499 F.3d 1293, 84 USPQ2d 1197 (Fed. Cir. 2007), the claims were drawn to the 5(S) stereoisomer of the blood pressure drug ramipril in stereochemically pure form, and to compositions and methods requiring 5(S) ramipril. The 5(S) stereoisomer is one in which all five stereocenters in the ramipril molecule are in the S rather than the R configuration. A mixture of various stereoisomers including 5(S) ramipril had been taught by the prior art. The question before the court was whether the purified single stereoisomer would have been obvious over the known mixture of stereoisomers.

The record showed that the presence of multiple S stereocenters in drugs similar to ramipril was known to be associated with enhanced therapeutic efficacy. For example, when all of the stereocenters were in the S form in the related drug enalapril (SSS enalapril) as compared with only two stereocenters in the S form (SSR enalapril), the therapeutic potency was 700 times as great. There was also evidence to indicate that conventional methods could be used to separate the various stereoisomers of ramipril.

The district court saw the issue as a close case, because, in its view, there was no clear motivation in the prior art to isolate 5(S) ramipril. However, the Federal Circuit disagreed, and found that the claims would have been obvious. The Federal Circuit cautioned that requiring such a clearly stated motivation in the prior art to isolate 5(S) ramipril ran counter to the Supreme Court's decision in *KSR*, and the court stated:

Requiring an explicit teaching to purify the 5(S) stereoisomer from a mixture in which it is the active ingredient is precisely the sort of rigid application of the TSM test that was criticized in *KSR*.

*Id.* at 1301, 84 USPQ2d at 1204. The *Aventis* court also relied on the settled principle that in chemical cases, structural similarity can provide the necessary reason to modify prior art teachings. The Federal Circuit also addressed the kind of teaching that would be sufficient in the absence of an explicitly stated prior art-based motivation, explaining that an expectation of similar properties in light of the prior art can be sufficient, even without an explicit teaching that the compound will have a particular utility.

In the chemical arts, the cases involving so-called "lead compounds" form an important subgroup of the obviousness cases that are based on substitution. The Federal Circuit has had a number of opportunities since the *KSR* decision to discuss the circumstances under which it would have been obvious to modify a known compound to arrive at a claimed compound. The following cases explore the selection of a lead compound, the need to provide a reason for any proposed modification, and the predictability of the result.

#### Example 9:

*Eisai Co. Ltd. v. Dr. Reddy's Labs., Ltd.*, 533 F.3d 1353, 87 USPQ2d 1452 (Fed. Cir. 2008), concerns the pharmaceutical compound rabeprazole. Rabeprazole is a proton pump inhibitor for treating stomach ulcers and related disorders. The Federal Circuit affirmed the district court's summary judgment of nonobviousness, stating that no reason had been advanced to modify the prior art compound in a way that would destroy an advantageous property.

Co-defendant Teva based its obviousness argument on the structural similarity between rabeprazole and lansoprazole. The compounds were recognized as sharing a common core, and the Federal Circuit characterized lansoprazole as a "lead compound." The prior art compound lansoprazole was useful for the same indications as rabeprazole, and differed from rabeprazole only in that lansoprazole has a trifluoroethoxy substituent at the 4-position of the pyridine ring, while rabeprazole has a methoxypropoxy substituent. The trifluoro substituent of lansoprazole was known to be a beneficial feature because it conferred lipophilicity to the compound. The ability of a person of ordinary skill to carry out the modification to introduce the methoxypropoxy substituent, and the predictability of the result were not addressed.

Despite the significant similarity between the structures, the Federal Circuit did not find any reason to modify the lead compound. According to the Federal Circuit:

Obviousness based on structural similarity thus can be proved by identification of some motivation that would have led one of ordinary skill in the art to select and then modify a known compound (i.e. a lead compound) in a particular way to achieve the claimed compound. . . . In keeping with the flexible nature of the obviousness inquiry, the requisite motivation can come from any number of sources and need not necessarily be explicit in the art. Rather “it is sufficient to show that the claimed and prior art compounds possess a ‘sufficiently close relationship . . . to create an expectation,’ in light of the totality of the prior art, that the new compound will have ‘similar properties’ to the old.” *Id.* at 1357, 87 USPQ2d at 1455. (citations omitted)

The prior art taught that introducing a fluorinated substituent was known to increase lipophilicity, so a skilled artisan would have expected that replacing the trifluoroethoxy substituent with a methoxypropoxy substituent would have reduced the lipophilicity of the compound. Thus, the prior art created the expectation that rabeprazole would be less useful than lansoprazole as a drug for treating stomach ulcers and related disorders because the proposed modification would have destroyed an advantageous property of the prior art compound. The compound was not obvious as argued by Teva because, upon consideration of all of the facts of the case, a person of ordinary skill in the art at the time of the invention would not have had a reason to modify lansoprazole so as to form rabeprazole.

Office personnel are cautioned that the term “lead compound” in a particular opinion can have a contextual meaning that may vary from the way a pharmaceutical chemist might use the term. In the field of pharmaceutical chemistry, the term “lead compound” has been defined variously as “a chemical compound that has pharmacological or biological activity and whose chemical structure is used as a starting point for chemical modifications in order to improve potency, selectivity, or pharmacokinetic parameters;” “[a] compound that exhibits pharmacological properties which suggest its development;” and “a potential drug being tested for safety and efficacy.” See, e.g., [http://en.wikipedia.org/wiki/Lead\\_compound](http://en.wikipedia.org/wiki/Lead_compound), accessed January 13, 2010; [www.combichemistry.com/glossary\\_k.html](http://www.combichemistry.com/glossary_k.html), accessed January 13, 2010; and [www.buildingbiotechnology.com/glossary4.php](http://www.buildingbiotechnology.com/glossary4.php), accessed January 13, 2010.

The Federal Circuit in *Eisai* makes it clear that from the perspective of the law of obviousness, any known compound might possibly serve as a lead compound: “Obviousness based on structural similarity thus can be proved by identification of some motivation that would have led one of ordinary skill in the art to select and then modify a known compound (i.e. a lead compound) in a particular way to achieve the claimed compound.” *Eisai*, 533 F.3d at 1357, 87 USPQ2d at 1455. Thus, Office personnel should recognize that a proper obviousness

rejection of a claimed compound that is useful as a drug might be made beginning with an inactive compound, if, for example, the reasons for modifying a prior art compound to arrive at the claimed compound have nothing to do with pharmaceutical activity. The inactive compound would not be considered to be a lead compound by pharmaceutical chemists, but could potentially be used as such when considering obviousness. Office personnel might also base an obviousness rejection on a known compound that pharmaceutical chemists would not select as a lead compound due to expense, handling issues, or other business considerations. However, there must be some reason for starting with that particular lead compound other than the mere fact that the “lead compound” exists. See *Altana Pharma AG v. Teva Pharm. USA, Inc.*, 566 F.3d 999, 1007, 91 USPQ2d 1018, 1024 (Fed. Cir. 2009) (holding that there must be some reason “to select and modify a known compound”); *Ortho-McNeil Pharm., Inc. v. Mylan Labs, Inc.*, 520 F.3d 1358, 1364, 86 USPQ2d 1196, 1201 (Fed. Cir. 2008).

#### Example 10:

The claimed chemical compound was also found to be nonobvious in *Procter & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 90 USPQ2d 1947 (Fed. Cir. 2009). The compound at issue was risedronate – the active ingredient of Procter & Gamble’s osteoporosis drug Actonel<sup>®</sup>. Risedronate is an example of a bisphosphonate, which is a class of compounds known to inhibit bone resorption.

When Procter & Gamble sued Teva for infringement, Teva defended by arguing invalidity for obviousness over one of Procter & Gamble’s earlier patents. The prior art patent did not teach risedronate, but instead taught thirty-six other similar compounds including 2-pyr EHDP that were potentially useful with regard to osteoporosis. Teva argued obviousness on the basis of structural similarity to 2-pyr EHDP, which is a positional isomer of risedronate.

The district court found no reason to select 2-pyr EHDP as a lead compound in light of the unpredictable nature of the art, and no reason to modify it so as to obtain risedronate. In addition, there were unexpected results as to potency and toxicity. Therefore the district court found that Teva had not made a *prima facie* case, and even if it had, it was rebutted by evidence of unexpected results.

The Federal Circuit affirmed the district court’s decision. The Federal Circuit did not deem it necessary in this case to consider the question of whether 2-pyr EHDP had been appropriately selected as a lead compound. Rather, the Federal Circuit reasoned that, if 2-pyr EHDP is presumed to be an appropriate lead compound, there must be both a reason to modify it so as to make risedronate and a reasonable expectation of success. Here, there was no evidence that the necessary modifications would have been routine, so there would have been no reasonable expectation of success.

*Procter & Gamble* is also informative in its discussion of the treatment of secondary considerations of non-obviousness. Although the court found that no *prima facie* case of

obviousness had been presented, it proceeded to analyze Procter & Gamble's proffered evidence countering the alleged *prima facie* case in some detail, thus shedding light on the proper treatment of such evidence.

The Federal Circuit noted in dicta that even if a *prima facie* case of obviousness had been established, sufficient evidence of unexpected results was introduced to rebut such a showing. At trial, the witnesses consistently testified that the properties of risedronate were not expected, offering evidence that researchers did not predict either the potency or the low dose at which the compound was effective. Tests comparing risedronate to a compound in the prior art reference showed that risedronate outperformed the other compound by a substantial margin, could be administered in a greater amount without an observable toxic effect, and was not lethal at the same levels as the other compound. The weight of the evidence and the credibility of the witnesses were sufficient to show unexpected results that would have rebutted an obviousness determination. Thus, nonobviousness can be shown when a claimed invention is shown to have unexpectedly superior properties when compared to the prior art.

The court then addressed the evidence of commercial success of risedronate and the evidence that risedronate met a long felt need. The court pointed out that little weight was to be afforded to the commercial success because the competing product was also assigned to Procter & Gamble. However, the Federal Circuit affirmed the district court's conclusion that risedronate met a long-felt, but unsatisfied need. The court rejected Teva's contention that because the competing drug was available before Actonel<sup>®</sup>, there was no unmet need that the invention satisfied. The court emphasized that whether there was a long-felt but unsatisfied need is to be evaluated based on the circumstances as of the filing date of the challenged invention – not as of the date that the invention is brought to market.

It should be noted that the lead compound cases do not stand for the proposition that identification of a single lead compound is necessary in every obviousness rejection of a chemical compound. For example, one might envision a suggestion in the prior art to formulate a compound having certain structurally defined moieties, or moieties with certain properties. If a person of ordinary skill would have known how to synthesize such a compound, and the structural and/or functional result could reasonably have been predicted, then a *prima facie* case of obviousness of the claimed chemical compound might exist even without identification of a particular lead compound. As a second example, it could be possible to view a claimed compound as consisting of two known compounds attached via a chemical linker. The claimed compound might properly be found to have been obvious if there would have been a reason to link the two, if one of ordinary skill would have known how to do so, and if the resulting compound would have been the predictable result of the linkage procedure. Thus, Office personnel should recognize that in certain situations, it may be proper to reject a claimed chemical compound as obvious even without identifying a single lead compound.

### Example 11:

The decision reached by the Federal Circuit in *Altana Pharma AG v. Teva Pharm. USA, Inc.*, 566 F.3d 999, 91 USPQ2d 1018 (Fed. Cir. 2009), as discussed below, involved a motion for preliminary injunction and did not include a final determination of obviousness. However, the case is instructive as to the issue of selecting a lead compound.

The technology involved in *Altana* was the compound pantoprazole, which is the active ingredient in Altana's antiulcer drug Protonix<sup>®</sup>. Pantoprazole belongs to a class of compounds known as proton pump inhibitors that are used to treat gastric acid disorders in the stomach.

Altana accused Teva of infringement. The district court denied Altana's motion for preliminary injunction for failure to establish a likelihood of success on the merits, determining that Teva had demonstrated a substantial question of invalidity for obviousness in light of one of Altana's prior patents. Altana's patent discussed a compound referred to as compound 12, which was one of eighteen compounds disclosed. The claimed compound pantoprazole was structurally similar to compound 12. The district court found that one of ordinary skill in the art would have selected compound 12 as a lead compound for modification, and the Federal Circuit affirmed.

Obviousness of a chemical compound in view of its structural similarity to a prior art compound may be shown by identifying some line of reasoning that would have led one of ordinary skill in the art to select and modify the prior art compound in a particular way to produce the claimed compound. The necessary line of reasoning can be drawn from any number of sources and need not necessarily be explicitly found in the prior art of record. The Federal Circuit determined that ample evidence supported the district court's finding that compound 12 was a natural choice for further development. For example, Altana's prior art patent claimed that its compounds, including compound 12, were improvements over the prior art; compound 12 was disclosed as one of the more potent of the eighteen compounds disclosed; the patent examiner had considered the compounds of Altana's prior art patent to be relevant during the prosecution of the patent in suit; and experts had opined that one of ordinary skill in the art would have selected the eighteen compounds to pursue further investigation into their potential as proton pump inhibitors.

In response to Altana's argument that the prior art must point to only a single lead compound for further development, the Federal Circuit stated that a "restrictive view of the lead compound test would present a rigid test similar to the teaching-suggestion-motivation test that the Supreme Court explicitly rejected in *KSR* . . . . The district court in this case employed a flexible approach – one that was admittedly preliminary – and found that the defendants had raised a substantial question that one of skill in the art would have used the more potent compounds of [Altana's prior art] patent, including compound 12, as a starting point from which to pursue further development efforts. That finding was not clearly erroneous." *Id.* at 1008, 91 USPQ2d at 1025.

### ***C. Use of Known Technique To Improve Similar Devices (Methods, or Products) in the Same Way***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a “comparable” device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices (methods, or products) has been made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a “base” device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art. “It’s enough ... to show that there was a known problem ... in the art, that [another reference] ... helped address that issue, and that combining the teachings of [the two references] wasn’t beyond the skill of an ordinary artisan. Nothing more is required to show a motivation to combine under *KSR*.” See *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380-81, 2023 USPQ2d 297 (Fed. Cir. 2023) (finding that both prior art references “address the same problem and that [the secondary reference’s] cache was a known way to address that problem is precisely the reason that there’s a motivation to combine under *KSR* and our precedent.”).

The Supreme Court in *KSR* noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. *KSR*, 550 U.S. at 417, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

#### **Example 1:**

The claimed invention in *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) was directed to a “means by which the self-oscillating inverter in a power-line-operated inverter-type fluorescent lamp ballast is disabled in case the output current from the inverter exceeds some pre-established threshold level for more than a very brief period.” *Id.* at 1402, 7 USPQ2d at 1501 That is, the current output was monitored, and if the current output exceeded some threshold for a specified short time, an actuation signal was sent and the inverter was disabled to protect it from damage.

The prior art (a USSR certificate) described a device for protecting an inverter circuit in an undisclosed manner via a control means. The device indicated the high-load condition by way of the control means, but did not indicate the specific manner of overload protection. The prior art (Kammiller) disclosed disabling the inverter in the event of a high-load current condition in order to protect the inverter circuit. That is, the overload protection was achieved by disabling the inverter by means of a cutoff switch.

The court found “it would have been obvious to one of ordinary skill in the art to use the threshold signal produced in the USSR device to actuate a cutoff switch to render the inverter inoperative as taught by Kammiller.” *Id.* at 1403, 7 USPQ2d at 1502. That is, using the known technique of a cutoff switch for protecting a circuit to provide the protection desired in the inverter circuit of the USSR document would have been obvious to one of ordinary skill.

#### **Example 2:**

The fact pattern in *Ruiz v. AB Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004) is set forth above in Example 2 in subsection I.A.

The nature of the problem to be solved may lead inventors to look at references relating to possible solutions to that problem. *Id.* at 1277, 69 USPQ2d at 1691. Therefore, it would have been obvious to use a metal bracket (as shown in Gregory) with the screw anchor (as shown in Fuller) to underpin unstable foundations.



***D. Applying a Known Technique to a Known Device (Method, or Product) Ready for Improvement To Yield Predictable Results***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);

(3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

**Example 1:**

The claimed invention in *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976) was directed towards a system (i.e., computer) for automatic record keeping of bank checks and deposits. In this system, a customer would put a numerical category code on each check or deposit slip. The check processing system would record these on the check in magnetic ink, just as it does for amount and account information. With this system in place, the bank can provide statements to customers that are broken down to give subtotals for each category. The claimed system also allowed the bank to print reports according to a style requested by the customer. As characterized by the Court, “[u]nder respondent’s invention, then, a general purpose computer is programmed to provide bank customers with an

individualized and categorized breakdown of their transactions during the period in question.” *Id.* at 222, 189 USPQ at 259.

**BASE SYSTEM** - The nature of the use of data processing equipment and computer software in the banking industry was that banks routinely did much of the record-keeping automatically. In routine check processing, the system read any magnetic ink characters identifying the account and routing. The system also read the amount of the check and then printed that value in a designated area of the check. The check was then sent through a further data processing step which used the magnetic ink information to generate the appropriate records for transactions and for posting to the appropriate accounts. These systems included generating periodic statements for each account, such as the monthly statement sent to checking account customers.

**IMPROVED SYSTEM** - The claimed invention supplemented this system by recording a category code which could be used to track expenditures by category. Again, the category code will be a number recorded on the check (or deposit slip) which will be read, converted into a magnetic ink imprint, and then processed in the data system to include the category code. This enabled reporting of data by category as opposed to only allowing reporting by account number.

**KNOWN TECHNIQUE** - This is an application of a technique from the prior art – the use of account numbers (generally used to track an individual’s total transactions) to solve the problem of how to track categories of expenditures to more finely account for a budget. That is, account numbers (identifying data capable of processing in the automatic data processing system) were used to distinguish between different customers. Furthermore, banks have long segregated debits attributable to service charges within any given separate account and have rendered their customers subtotals for those charges. Previously, one would have needed to set up separate accounts for each category and thus receive separate reports. Supplementing the account information with additional digits (the category codes) solved the problem by effectively creating a single account that can be treated as distinct accounts for tracking and reporting services. That is, the category code merely allowed what might previously have been separate accounts to be handled as a single account, but with a number of sub-accounts indicated in the report.

The basic technique of putting indicia on data to enable standard sorting, searching, and reporting yielded no more than the predictable outcome which one of ordinary skill would have expected to achieve with this common tool of the trade and was therefore an obvious expedient. The Court held that “[t]he gap between the prior art and respondent’s system is simply not so great as to render the system nonobvious to one reasonably skilled in the art.” *Id.* at 230, 189 USPQ at 261.

**Example 2:**

The fact pattern in *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) is set forth above in Example 1 in subsection C.

The court found “it would have been obvious to one of ordinary skill in the art to use the threshold signal produced in the USSR device to actuate a cutoff switch to render the inverter inoperative as taught by Kammiller.” *Id.* at 1403, 7 USPQ2d at 1502. The known technique of using a cutoff switch would have predictably resulted in protecting the inverter circuit. Therefore, it would have been within the skill of the ordinary artisan to use a cutoff switch in response to the actuation signal to protect the inverter.

### Example 3:

The claimed invention in *In re Urbanski*, 809 F.3d 1237, 1244, 117 USPQ2d 1499, 1504 (Fed. Cir. 2016) was directed to a method of enzymatic hydrolysis of soy fiber to reduce water holding capacity, requiring reacting the soy fiber and enzyme in water for about 60-120 minutes. The claims were rejected over two references, wherein the primary reference, Gross, taught using a reaction time of 5 to 72 hours and the secondary reference, Wong, taught using a reaction time of 100 to 240 minutes, preferably 120 minutes. The applicant argued that modifying the primary reference in the manner suggested by the secondary reference would forego the benefits taught by the primary reference, thereby teaching away from the combination. The court found there was sufficient motivation to combine because both references recognized reaction time and degree of hydrolysis as result-effective variables, which can be varied to have a predictable effect on the final product; and the primary reference does not contain an express teaching away from the proposed modification. “Substantial evidence thus supports the Board’s finding that a person of ordinary skill would have been motivated to modify the Gross process by using a shorter reaction time, in order to obtain the favorable properties disclosed in Wong.”

### ***E. “Obvious To Try” – Choosing From a Finite Number of Identified, Predictable Solutions, With a Reasonable Expectation of Success***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that at the relevant time, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
- (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;
- (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view

of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [§ 103](#).” *KSR*, 550 U.S. at 421, 82 USPQ2d at 1397. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The question of whether a claimed invention can be shown to be obvious based on an “obvious to try” line of reasoning has been explored extensively by the Federal Circuit in several cases since the *KSR* decision. The case law in this area is developing quickly in the chemical arts, although the rationale has been applied in other art areas as well.

Some commentators on the *KSR* decision have expressed a concern that because inventive activities are always carried out in the context of what has come before and not in a vacuum, few inventions will survive scrutiny under an obvious to try standard. The cases decided since *KSR* have proved this fear to have been unfounded. Courts appear to be applying the *KSR* requirement for “a finite number of identified predictable solutions” in a manner that places particular emphasis on predictability and the reasonable expectations of those of ordinary skill in the art.

The Federal Circuit pointed out the challenging nature of the task faced by the courts – and likewise by Office personnel – when considering the viability of an obvious to try argument: “The evaluation of the choices made by a skilled scientist, when such choices lead to the desired result, is a challenge to judicial understanding of how technical advance is achieved in the particular field of science or technology.” *Abbott Labs. v. Sandoz, Inc.*, 544 F.3d 1341, 1352, 89 USPQ2d 1161, 1171 (Fed. Cir. 2008). The Federal Circuit cautioned that an obviousness inquiry based on an obvious to try rationale must always be undertaken in the context

of the subject matter in question, “including the characteristics of the science or technology, its state of advance, the nature of the known choices, the specificity or generality of the prior art, and the predictability of results in the area of interest.” *Id.*

#### Example 1:

The claimed invention in *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 82 USPQ2d 1321 (Fed. Cir. 2007), was directed to the amlodipine besylate drug product, which was sold in tablet form in the United States under the trademark Norvasc<sup>®</sup>. Amlodipine and the use of besylate anions were both known at the time of the invention. Amlodipine was known to have the same therapeutic properties as were being claimed for the amlodipine besylate, but Pfizer discovered that the besylate form had better manufacturing properties (e.g., reduced “stickiness”).

Pfizer argued that the results of forming amlodipine besylate would have been unpredictable and therefore nonobvious. The court rejected the notion that unpredictability could be equated with nonobviousness here, because there were only a finite number (53) of *pharmaceutically acceptable* salts to be tested for improved properties.

The court found that one of ordinary skill in the art having problems with the machinability of amlodipine would have looked to forming a salt of the compound and would have been able to narrow the group of potential salt-formers to a group of 53 anions known to form pharmaceutically acceptable salts, which would be an acceptable number to form “a reasonable expectation of success.”

#### Example 2:

The claimed invention in *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 80 USPQ2d 1001 (Fed. Cir. 2006) was drawn to sustained-release formulations of the drug oxybutynin in which the drug is released at a specified rate over a 24-hour period. Oxybutynin was known to be highly water-soluble, and the specification had pointed out that development of sustained-release formulations of such drugs presented particular problems.

A prior art patent to Morella had taught sustained-release compositions of highly water-soluble drugs, as exemplified by a sustained-release formulation of morphine. Morella had also identified oxybutynin as belonging to the class of highly water-soluble drugs. The Baichwal prior art patent had taught a sustained-release formulation of oxybutynin that had a different release rate than the claimed invention. Finally, the Wong prior art patent had taught a generally applicable method for delivery of drugs over a 24-hour period. Although Wong mentioned applicability of the disclosed method to several categories of drugs to which oxybutynin belonged, Wong did not specifically mention its applicability to oxybutynin.

The court found that because the absorption properties of oxybutynin would have been reasonably predictable at the time

of the invention, there would have been a reasonable expectation of successful development of a sustained-release formulation of oxybutynin as claimed. The prior art, as evidenced by the specification, had recognized the obstacles to be overcome in development of sustained-release formulations of highly water-soluble drugs, and had suggested a finite number of ways to overcome these obstacles. The claims were obvious because it would have been obvious to try the known methods for formulating sustained-release compositions, with a reasonable expectation of success. The court was not swayed by arguments of a lack of absolute predictability.

#### Example 3:

The Federal Circuit’s decision in *In re Kubin*, 561 F.3d 1351, 90 USPQ2d 1417 (Fed. Cir. 2009), affirmed the Office’s determination in *Ex parte Kubin*, 83 USPQ2d 1410 (Bd. Pat. App. & Int. 2007) that the claims in question, directed to an isolated nucleic acid molecule, would have been obvious over the prior art applied. The claim stated that the nucleic acid encoded a particular polypeptide. The encoded polypeptide was identified in the claim by its partially specified sequence, and by its ability to bind to a specified protein.

A prior art patent to Valiante taught the polypeptide encoded by the claimed nucleic acid, but did not disclose either the sequence of the polypeptide, or the claimed isolated nucleic acid molecule. However, Valiante did disclose that by employing conventional methods such as those disclosed by a prior art laboratory manual by Sambrook, the sequence of the polypeptide could be determined, and the nucleic acid molecule could be isolated. In view of Valiante’s disclosure of the polypeptide, and of routine prior art methods for sequencing the polypeptide and isolating the nucleic acid molecule, the Board found that a person of ordinary skill in the art would have had a reasonable expectation that a nucleic acid molecule within the claimed scope could have been successfully obtained.

Relying on *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995), appellant argued that it was improper for the Office to use the polypeptide of the Valiante patent together with the methods described in Sambrook to reject a claim drawn to a specific nucleic acid molecule without providing a reference showing or suggesting a structurally similar nucleic acid molecule. Citing *KSR*, the Board stated that “when there is motivation to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *KSR*, 550 U.S. at 402-03, 82 USPQ2d at 1390. The Board noted that the problem facing those in the art was to isolate a specific nucleic acid, and there were a limited number of methods available to do so. The Board concluded that the skilled artisan would have had reason to try these methods with the reasonable expectation that at least one would be successful. Thus, isolating the specific nucleic acid molecule claimed was “the product not of innovation but of ordinary skill and common sense.” *Id.*

The Board's reasoning was substantially adopted by the Federal Circuit. However, it is important to note that in the *Kubin* decision, the Federal Circuit held that "the Supreme Court in *KSR* unambiguously discredited" the Federal Circuit's decision in *Deuel*, insofar as it "implies the obviousness inquiry cannot consider that the combination of the claim's constituent elements was 'obvious to try.'" *Kubin*, 561 F.3d at 1358, 90 USPQ2d at 1422. Instead, *Kubin* stated that *KSR* "resurrects" the Federal Circuit's own wisdom in *O'Farrell*, in which "to differentiate between proper and improper applications of 'obvious to try,'" the Federal Circuit "outlined two classes of situations where 'obvious to try' is erroneously equated with obviousness under § 103." *Kubin*, 561 F.3d at 1359, 90 USPQ2d at 1423. These two classes of situations are: (1) when what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful; and (2) when what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *Id.* (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)).

#### Example 4:

*Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 83 USPQ2d 1169 (Fed. Cir. 2007), is an example of a chemical case in which the Federal Circuit found that the claimed invention was not obvious. The claimed compound was pioglitazone, a member of a class of drugs known as thiazolidinediones (TZDs) marketed by Takeda as a treatment for Type 2 diabetes. The *Takeda* case brings together the concept of a "lead compound" and the obvious-to-try argument.

Alphapharm had filed an Abbreviated New Drug Application with the Food and Drug Administration, which was a technical act of infringement of Takeda's patent. When Takeda brought suit, Alphapharm's defense was that Takeda's patent was invalid due to obviousness. Alphapharm argued that a two-step modification – involving homologation and ring-walking – of a known compound identified as "compound b" would have produced pioglitazone, and that it was therefore obvious.

The district court found that there would have been no reason to select compound b as a lead compound. There were a large number of similar prior art TZD compounds; fifty-four were specifically identified in Takeda's prior patent, and the district court observed that "hundreds of millions" were more generally disclosed. Although the parties agreed that compound b represented the closest prior art, one reference taught certain disadvantageous properties associated with compound b, which according to the district court would have taught the skilled artisan not to select that compound as a lead compound. The district court found no *prima facie* case of obviousness, and stated that even if a *prima facie* case had been established, it would have been overcome in this case in view of the unexpected lack of toxicity of pioglitazone.

The Federal Circuit affirmed the decision of the district court, citing the need for a reason to modify a prior art compound. The Federal Circuit quoted *KSR*, stating:

The *KSR* Court recognized that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *KSR*, 550 U.S. at 421, 82 USPQ2d at 1397. In such circumstances, "the fact that a combination was obvious to try might show that it was obvious under § 103." *Id.* That is not the case here. Rather than identifying predictable solutions for antidiabetic treatment, the prior art disclosed a broad selection of compounds any one of which could have been selected as a lead compound for further investigation. Significantly, the closest prior art compound (compound b, the 6-methyl) exhibited negative properties that would have directed one of ordinary skill in the art away from that compound. Thus, this case fails to present the type of situation contemplated by the Court when it stated that an invention may be deemed obvious if it was "obvious to try." The evidence showed that it was not obvious to try.

*Takeda*, 492 F.3d at 1359, 83 USPQ2d at 1176.

Accordingly, Office personnel should recognize that the obvious to try rationale does not apply when the appropriate factual findings cannot be made. In *Takeda*, there was a recognized need for treatment of diabetes. However, there was no finite number of identified, predictable solutions to the recognized need, and no reasonable expectation of success. There were numerous known TZD compounds, and although one clearly represented the closest prior art, its known disadvantages rendered it unsuitable as a starting point for further research, and taught the skilled artisan away from its use. Furthermore, even if there had been reason to select compound b, there had been no reasonable expectation of success associated with the particular modifications necessary to transform compound b into the claimed compound pioglitazone. Thus, an obviousness rejection based on an obvious to try rationale was not appropriate in this situation.

#### Example 5:

The case of *Ortho-McNeil Pharm., Inc. v. Mylan Labs, Inc.*, 520 F.3d 1358, 86 USPQ2d 1196 (Fed. Cir. 2008), provides another example in which a chemical compound was determined not to be obvious. The claimed subject matter was topiramate, which is used as an anti-convulsant.

In the course of working toward a new anti-diabetic drug, Ortho-McNeil's scientist had unexpectedly discovered that a reaction intermediate had anti-convulsant properties. Mylan's defense of invalidity due to obviousness rested on an obvious to try argument. However, Mylan did not explain why it would have been obvious to begin with an anti-diabetic drug precursor, especially the specific one that led to topiramate, if one had been seeking an anti-convulsant drug. The district court ruled on

summary judgment that Ortho-McNeil's patent was not invalid for obviousness.

The Federal Circuit affirmed. The Federal Circuit pointed out that there was no apparent reason a person of ordinary skill would have chosen the particular starting compound or the particular synthetic pathway that led to topiramate as an intermediate. Furthermore, there would have been no reason to test that intermediate for anticonvulsant properties if treating diabetes had been the goal. The Federal Circuit recognized an element of serendipity in this case, which runs counter to the requirement for predictability. Summarizing their conclusion with regard to Mylan's obvious to try argument, the Federal Circuit stated:

[T]his invention, contrary to Mylan's characterization, does not present a finite (and small in the context of the art) number of options easily traversed to show obviousness. . . . *KSR* posits a situation with a finite, and in the context of the art, small or easily traversed, number of options that would convince an ordinarily skilled artisan of obviousness. . . . [T]his clearly is not the easily traversed, small and finite number of alternatives that *KSR* suggested might support an inference of obviousness. *Id.* at 1364, 86 USPQ2d at 1201.

Thus, *Ortho-McNeil* helps to clarify the Supreme Court's requirement in *KSR* for "a finite number" of predictable solutions when an obvious to try rationale is applied: under the Federal Circuit's case law "finite" means "small or easily traversed" in the context of the art in question. As taught in *Abbott*, discussed above, it is essential that the inquiry be placed in the context of the subject matter at issue, and each case must be decided on its own facts.

#### Example 6:

In *Bayer Schering Pharma A.G. v. Barr Labs., Inc.*, 575 F.3d 1341, 91 USPQ2d 1569 (Fed. Cir. 2009), the claimed invention was an oral contraceptive containing micronized drospirenone marketed as Yasmin<sup>®</sup>. The prior art compound drospirenone was known to be a poorly water-soluble, acid-sensitive compound with contraceptive effects. It was also known in the art that micronization improves the solubility of poorly water soluble drugs.

Based on the known acid sensitivity, Bayer had studied how effectively an enteric-coated drospirenone tablet delivered a formulation as compared to an intravenous injection of the same formulation to measure the "absolute bioavailability" of the drug. Bayer added an unprotected (normal) drospirenone tablet and compared its bioavailability to that of the enteric-coated formulation and the intravenous delivery. Bayer expected to find that the enteric-coated tablet would produce a lower bioavailability than an intravenous injection, while the normal pill would produce an even lower bioavailability than the enteric-coated tablet. However, they found that despite observations that drospirenone would quickly isomerize in a highly acidic environment (supporting the belief that an enteric coating would be necessary to preserve bioavailability), the

normal pill and the enteric-coated pill resulted in the same bioavailability. Following this study, Bayer developed micronized drospirenone in a normal pill, the basis for the disputed patent.

The district court found that a person having ordinary skill in the art would have considered the prior art result that a structurally related compound, spirorenone, though acid-sensitive, would nevertheless absorb *in vivo*, would have suggested the same result for drospirenone. It also found that while another reference taught that drospirenone isomerizes *in vitro* when exposed to acid simulating the human stomach, a person of ordinary skill would have been aware of the study's shortcomings, and would have verified the findings as suggested by a treatise on the science of dosage form design, which would have then showed that no enteric coating was necessary.

The Federal Circuit held that the patent was invalid because the claimed formulation was obvious. The Federal Circuit reasoned that the prior art would have funneled the formulator toward two options. Thus, the formulator would not have been required to try all possibilities in a field unreduced by the prior art. The prior art was not vague in pointing toward a general approach or area of exploration, but rather guided the formulator precisely to the use of either a normal pill or an enteric-coated pill.

It is important for Office personnel to recognize that the mere existence of a large number of options does not in and of itself lead to a conclusion of nonobviousness. Where the prior art teachings lead one of ordinary skill in the art to a narrower set of options, then that reduced set is the appropriate one to consider when determining obviousness using an obvious to try rationale.

#### Example 7:

The case of *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 89 USPQ2d 1370 (Fed. Cir. 2008), also sheds light on the obvious to try line of reasoning. The claimed compound was clopidogrel, which is the dextrorotatory isomer of methyl alpha-5(4,5,6,7-tetrahydro(3,2-c)thienopyridyl)(2-chlorophenyl)-acetate. Clopidogrel is an anti-thrombotic compound used to treat or prevent heart attack or stroke. The racemate, or mixture of dextrorotatory and levorotatory (D- and L-) isomers of the compound, was known in the prior art. The two forms had not previously been separated, and although the mixture was known to have anti-thrombotic properties, the extent to which each of the individual isomers contributed to the observed properties of the racemate was not known and was not predictable.

The district court assumed that in the absence of any additional information, the D-isomer would have been *prima facie* obvious over the known racemate. However, in view of the evidence of unpredicted therapeutic advantages of the D-isomer presented in the case, the district court found that any *prima facie* case of obviousness had been overcome. At trial, the experts for both parties testified that persons of ordinary skill in the art could not have predicted the degree to which the isomers would have exhibited different levels of therapeutic activity and toxicity. Both parties' experts also agreed that the isomer with greater



therapeutic activity would most likely have had greater toxicity. Sanofi witnesses testified that Sanofi’s own researchers had believed that the separation of the isomers was unlikely to have been productive, and experts for both parties agreed that it was difficult to separate isomers at the time of the invention. Nevertheless, when Sanofi ultimately undertook the task of separating the isomers, it found that they had the “rare characteristic of ‘absolute stereoselectivity,’” whereby the D-isomer provided all of the favorable therapeutic activity but no significant toxicity, while the L-isomer produced no therapeutic activity but virtually all of the toxicity. Based on this record, the district court concluded that Apotex had not met its burden of proving by clear and convincing evidence that Sanofi’s patent was invalid for obviousness. The Federal Circuit affirmed the district court’s conclusion.

Office personnel should recognize that even when only a small number of possible choices exist, the obvious to try line of reasoning is not appropriate when, upon consideration of all of the evidence, the outcome would not have been reasonably predictable and the inventor would not have had a reasonable expectation of success. In *Bayer*, there were art-based reasons to expect that both the normal pill and the enteric-coated pill would be therapeutically suitable, even though not all prior art studies were in complete agreement. Thus, the result obtained was not unexpected. In *Sanofi*, on the other hand, there was strong evidence that persons of ordinary skill in the art, prior to the separation of the isomers, would have had no reason to expect that the D-isomer would have such strong therapeutic advantages as compared with the L-isomer. In other words, the result in *Sanofi* was unexpected.

#### Example 8:

In *Rolls-Royce, PLC v. United Tech. Corp.*, 603 F.3d 1325, 95 USPQ2d 1097 (Fed. Cir. 2010), the Federal Circuit addressed the obvious to try rationale in the context of a fan blade for jet engines. The case had arisen out of an interference proceeding. Finding that the district court had correctly determined that there was no interference-in-fact because Rolls-Royce’s claims would not have been obvious in light of United’s application, the Federal Circuit affirmed.

The Federal Circuit described the fan blade of the count as follows:

Each fan blade has three regions – an inner, an intermediate, and an outer region. The area closest to the axis of rotation at the hub is the inner region. The area farthest from the center of the engine and closest to the casing surrounding the engine is the outer region. The intermediate region falls in between. The count defines a fan blade with a swept-forward inner region, a swept-rearward intermediate region, and forward-leaning outer region.

*Id.* at 1328, 95 USPQ2d at 1099.

United had argued that it would have been obvious for a person of ordinary skill in the art to try a fan blade design in which the

sweep angle in the outer region was reversed as compared with prior art fan blades from rearward to forward sweep, in order to reduce endwall shock. The Federal Circuit disagreed with United’s assessment that the claimed fan blade would have been obvious based on an obvious to try rationale. The Federal Circuit pointed out that in a proper obvious to try approach to obviousness, the possible options for solving a problem must have been “known and finite.” *Id.* at 1339, 95 USPQ2d at 1107 (citing *Abbott*, 544 F.3d at 1351, 89 USPQ2d at 1171). In this case, nothing in the prior art would have suggested that changing the sweep angle as Rolls-Royce had done would have addressed the issue of endwall shock. Thus, the Federal Circuit concluded that changing the sweep angle “would not have presented itself as an option at all, let alone an option that would have been obvious to try.” *Id.* The decision in *Rolls-Royce* is a reminder to Office personnel that the obvious to try rationale can properly be used to support a conclusion of obviousness only when the claimed solution would have been selected from a finite number of potential solutions known to persons of ordinary skill in the art.

#### Example 9:

The case of *Perfect Web Tech., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29, 92 USPQ2d 1849, 1854 (Fed. Cir. 2009), provides an example in which the Federal Circuit held that a claimed method for managing bulk email distribution was obvious on the basis of an obvious to try argument. In *Perfect Web*, the method required selecting the intended recipients, transmitting the emails, determining how many of the emails had been successfully received, and repeating the first three steps if a pre-determined minimum number of intended recipients had not received the email.

The Federal Circuit affirmed the district court’s determination on summary judgment that the claimed invention would have been obvious. Failure to meet a desired quota of email recipients was a recognized problem in the field of email marketing. The prior art had also recognized three potential solutions: increasing the size of the initial recipient list; resending emails to recipients who did not receive them on the first attempt; and selecting a new recipient list and sending emails to them. The last option corresponded to the fourth step of the invention as claimed.

The Federal Circuit noted that based on “simple logic,” selecting a new list of recipients was more likely to result in the desired outcome than resending to those who had not received the email on the first attempt. There had been no evidence of any unexpected result associated with selecting a new recipient list, and no evidence that the method would not have had a reasonable likelihood of success. Thus, the Federal Circuit concluded that, as required by *KSR*, there were a “finite number of identified, predictable solutions,” and that the obvious to try inquiry properly led to the legal conclusion of obviousness.

The Federal Circuit in *Perfect Web* also discussed the role of common sense in the determination of obviousness. The district court had cited *KSR* for the proposition that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton,” and found that “the final step [of the claimed invention] is merely the logical result of common sense

application of the maxim ‘try, try again.’” In affirming the district court, the Federal Circuit undertook an extended discussion of common sense as it has been applied to the obviousness inquiry, both before and since the *KSR* decision.

The Federal Circuit pointed out that application of common sense is not really an innovation in the law of obviousness when it stated, “Common sense has long been recognized to inform the analysis of obviousness if explained with sufficient reasoning.” *Perfect Web*, 587 F.3d at 1328, 92 USPQ2d at 1853 (emphasis added). The Federal Circuit then provided a review of a number of precedential cases that inform the understanding of common sense, including *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (explaining that a patent examiner may rely on “common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference”) and *In re Zurko*, 258 F.3d 1379, 1383, 1385, 59 USPQ2d 1693 at 1695, 1697 (Fed. Cir. 2001) (clarifying that a factual foundation is needed in order for an examiner to invoke “good common sense” in a case in which “basic knowledge and common sense was not based on any evidence in the record”). The Federal Circuit implicitly acknowledged in *Perfect Web* that the kind of strict evidence-based teaching, suggestion, or motivation required in *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), is not an absolute requirement for an obviousness rejection in light of the teachings of *KSR*. The Federal Circuit explained that “[a]t the time [of the Lee decision], we required the PTO to identify record evidence of a teaching, suggestion, or motivation to combine references.” However, *Perfect Web* went on to state that even under *Lee*, common sense could properly be applied when analyzing evidence relevant to obviousness. Citing *DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 80 USPQ2d 1641 (Fed. Cir. 2006), and *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329 (Fed. Cir. 2006), two cases decided shortly before the Supreme Court’s decision in *KSR*, the Federal Circuit noted that although “a reasoned explanation that avoids conclusory generalizations” is required to use common sense, identification of a “specific hint or suggestion in a particular reference” is not. See also *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1380-81, 2020 USPQ2d 10706 (Fed. Cir. 2020) (stating that “the Board’s invocation of common sense was properly accompanied by reasoned analysis and evidentiary support” to show why it would be obvious to incorporate a second recess to receive an airplane seat support). But see *Arendi v. Apple*, 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016) (finding that the Board had not provided a reasoned analysis, supported by the evidence of record, for why “common sense” taught the missing process step).

***F. Known Work in One Field of Endeavor May Prompt Variations of It for Use in Either the Same Field or a Different One Based on Design Incentives or Other Market Forces if the Variations Are Predictable to One of Ordinary Skill in the Art***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual

inquiries. Then, Office personnel must articulate the following:

(1) a finding that the scope and content of the prior art, whether in the same field of endeavor as that of the applicant’s invention or a different field of endeavor, included a similar or analogous device (method, or product);

(2) a finding that there were design incentives or market forces which would have prompted adaptation of the known device (method, or product);

(3) a finding that the differences between the claimed invention and the prior art were encompassed in known variations or in a principle known in the prior art;

(4) a finding that one of ordinary skill in the art, in view of the identified design incentives or other market forces, could have implemented the claimed variation of the prior art, and the claimed variation would have been predictable to one of ordinary skill in the art; and

(5) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claimed invention would have been obvious is that design incentives or other market forces could have prompted one of ordinary skill in the art to vary the prior art in a predictable manner to result in the claimed invention. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

**Example 1:**

The fact pattern in *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976) is set forth above in Example 1 in subsection D.

The Court found that the problem addressed by applicant – the need to give more detailed breakdown by a category of transactions – was closely analogous to the task of keeping track of the transaction files of individual business units. *Id.* at 229, 189 USPQ at 261. Thus, an artisan in the data processing area would have recognized the similar class of problem and the known solutions of the prior art and it would have been well within the ordinary skill level to implement the system in the different environment. The Court held that “[t]he gap between the prior art and respondent’s system is simply not so great as

to render the system nonobvious to one reasonably skilled in the art.” *Id.* at 230, 189 USPQ at 261.

#### Example 2:

The claimed invention in *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007) was directed to a learning device to help young children read phonetically. The claim read as follows:

An interactive learning device, comprising:

a housing including a plurality of switches;

a sound production device in communication with the switches and including a processor and a memory;

at least one depiction of a sequence of letters, each letter being associable with a switch; and

a reader configured to communicate the identity of the depiction to the processor,

wherein selection of a depicted letter activates an associated switch to communicate with the processor, causing the sound production device to generate a signal corresponding to a sound associated with the selected letter, the sound being determined by a position of the letter in the sequence of letter.

The court concluded that the claimed invention would have been obvious in view of the combination of two pieces of prior art, (1) Bevan (which showed an electro-mechanical toy for phonetic learning), (2) the Super Speak & Read device (SSR) (an electronic reading toy), and the knowledge of one of ordinary skill in the art.

The court made clear that there was no technological advance beyond the skill shown in the SSR device. The court stated that “one of ordinary skill in the art of children’s learning toys would have found it obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. While the SSR only permits generation of a sound corresponding to the first letter of a word, it does so using electronic means. The combination is thus the adaptation of an old idea or invention (Bevan) using newer technology that is commonly available and understood in the art (the SSR).”

The court found that the claimed invention was but a variation on already known children’s toys. This variation presented no nonobvious advance over other toys. The court made clear that there was no technological advance beyond the skill shown in the SSR device. The court found that “[a]ccommodating a prior art mechanical device that accomplishes that goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children’s learning devices. Applying modern electronics to older mechanical devices has been commonplace in recent years.”

#### Example 3:

The claimed invention in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), was an adjustable pedal assembly with a fixed pivot point and an electronic pedal-position sensor attached to the assembly support. The fixed pivot point meant that the pivot was not changed as the pedal was adjusted. The placement of the sensor on the assembly support kept the sensor fixed while the pedal was adjusted.

Conventional gas pedals operated by a mechanical link which adjusted the throttle based on the travel of the pedal from a set position. The throttle controlled the combustion process and the available power generated by the engine. Newer cars used computer controlled throttles in which a sensor detected the motion of the pedal and sent signals to the engine to adjust the throttle accordingly. At the time of the invention, the marketplace provided a strong incentive to convert mechanical pedals to electronic pedals, and the prior art taught a number of methods for doing so. The prior art (Asano) taught an adjustable pedal with a fixed pivot point with mechanical throttle control. The prior art (‘936 patent to Byler) taught an electronic pedal sensor which was placed on a pivot point in the pedal assembly and that it was preferable to detect the pedal’s position in the pedal mechanism rather than in the engine. The prior art (Smith) taught that to prevent the wires connecting the sensor to the computer from chafing and wearing out, the sensor should be put on a fixed part of the pedal assembly rather than in or on the pedal’s footpad. The prior art (Rixon) taught an adjustable pedal assembly (sensor in the footpad) with an electronic sensor for throttle control. There was no prior art electronic throttle control that was combined with a pedal assembly which kept the pivot point fixed when adjusting the pedal.

The Court stated that “[t]he proper question to have asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading Asano with a sensor.” *Id.* at 424, 82 USPQ2d at 1399. The Court found that technological developments in the automotive design would have prompted a designer to upgrade Asano with an electronic sensor. The next question was where to attach the sensor. Based on the prior art, a designer would have known to place the sensor on a nonmoving part of the pedal structure and the most obvious nonmoving point on the structure from which a sensor can easily detect the pedal’s position was a pivot point. The Court concluded that it would have been obvious to upgrade Asano’s fixed pivot point adjustable pedal by replacing the mechanical assembly for throttle control with an electronic throttle control and to mount the electronic sensor on the pedal support structure.

#### Example 4:

The claimed invention in *Ex parte Catan*, 83 USPQ2d 1569 (Bd. Pat. App. & Int. 2007), was a consumer electronics device using bioauthentication to authorize sub-users of an authorized credit account to place orders over a communication network up to a pre-set maximum sub-credit limit.

The prior art (Nakano) disclosed a consumer electronics device like the claimed invention, except that security was provided

by a password authentication device rather than a bioauthentication device. The prior art (Harada) disclosed that the use of a bioauthentication device (fingerprint sensor) on a consumer electronics device (remote control) to provide bioauthentication information (fingerprint) was known in the prior art at the time of the invention. The prior art (Dethloff) also disclosed that it was known in the art at the time of the invention to substitute bioauthentication for PIN authentication to enable a user to access credit via a consumer electronics device.

The Board found that the prior art “shows that one of ordinary skill in the consumer electronic device art at the time of the invention would have been familiar with using bioauthentication information interchangeably with or in lieu of PINs to authenticate users.” The Board concluded that one of ordinary skill in the art of consumer electronic devices would have found it obvious to update the prior art password device with the modern bioauthentication component and thereby gain, predictably, the commonly understood benefits of such adaptation, that is, a secure and reliable authentication procedure.

***G. Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art Reference Teachings To Arrive at the Claimed Invention***

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). If any of these

findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. “[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.” *Id.* at 1368, 80 USPQ2d at 1651.

**2143.01 Suggestion or Motivation To Modify the References [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching test as a guard against using hindsight in an obviousness analysis).

*Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 957-58, 2023 USPQ2d 795 (Fed. Cir. 2023) (the court found an erroneous framing of the motivation inquiry led to an incorrect conclusion of nonobviousness). A “motivation to combine may be found explicitly or implicitly in market forces; design incentives; the ‘interrelated teachings of multiple patents’; ‘any need or problem known in the field of endeavor at the time of invention and addressed by the patent’; and the background knowledge, creativity, and common sense of the person of ordinary skill.” *Zup v. Nash Mfg.*, 896 F.3d 1365, 1371, 127 USPQ2d 1423, 1427 (Fed. Cir. 2018) (quoting *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 [107 USPQ2d 1706] (Fed. Cir. 2013) (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328 [92 USPQ2d 1849] (Fed. Cir. 2009) (quoting *KSR*, 550 U.S. at 418-21)). See [MPEP § 2143](#) regarding the need to provide a reasoned explanation even in situations involving common sense or ordinary ingenuity. See also [MPEP § 2144.05](#), subsection II, B.

#### **I. PRIOR ART SUGGESTION OF THE CLAIMED INVENTION NOT NECESSARILY NEGATED BY DESIRABLE ALTERNATIVES**

The disclosure of desirable alternatives does not necessarily negate a suggestion for modifying the prior art to arrive at the claimed invention. In *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004), the claims of a utility patent application were directed to a shoe sole with increased traction having hexagonal projections in a “facing orientation.” 391 F.3d at 1196-97, 73 USPQ2d at 1142. The Board combined a design patent having hexagonal projections in a facing orientation with a utility patent having other limitations of the independent claim. 391 F.3d at 1199, 73 USPQ2d at 1144. Applicant argued that the combination was improper because (1) the prior art did not suggest having the hexagonal projections in a facing (as opposed to a

“pointing”) orientation was the “most desirable” configuration for the projections, and (2) the prior art “taught away” by showing desirability of the “pointing orientation.” 391 F.3d at 1200-01, 73 USPQ2d at 1145-46. The court stated that “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *Id.* In affirming the Board’s obviousness rejection, the court held that the prior art as a whole suggested the desirability of the combination of shoe sole limitations claimed, thus providing a motivation to combine, which need not be supported by a finding that the prior art suggested that the combination claimed by the applicant was the preferred, or most desirable combination over the other alternatives. *Id.* See also *In re Urbanski*, 809 F.3d 1237, 1244, 117 USPQ2d 1499, 1504 (Fed. Cir. 2016).

In *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the patent claimed underpinning a slumping building foundation using a screw anchor attached to the foundation by a metal bracket. One prior art reference taught a screw anchor with a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed “to precisely the same problem of underpinning slumping foundations.” *Id.* at 1276, 69 USPQ2d at 1690. The court also *rejected* the notion that “an express written motivation to combine must appear in prior art references....” *Id.* at 1276, 69 USPQ2d at 1690.

#### **II. WHERE THE TEACHINGS OF THE PRIOR ART CONFLICT, THE EXAMINER MUST WEIGH THE SUGGESTIVE POWER OF EACH REFERENCE**

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the



examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991) (Prior art patent to Carlisle disclosed controlling and minimizing bubble oscillation for chemical explosives used in marine seismic exploration by spacing seismic sources close enough to allow the bubbles to intersect before reaching their maximum radius so the secondary pressure pulse was reduced. An article published several years later by Knudsen opined that the Carlisle technique did not yield appreciable improvement in bubble oscillation suppression. However, the article did not test the Carlisle technique under comparable conditions because Knudsen did not use Carlisle's spacing or seismic source. Furthermore, where the Knudsen model most closely approximated the patent technique there was a 30% reduction of the secondary pressure pulse. On these facts, the court found that the Knudsen article would not have deterred one of ordinary skill in the art from using the Carlisle patent teachings.).

### **III. FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED MAY NOT BE SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 82 USPQ2d 1385, 1396 (2007) (“If a person of ordinary skill can implement a predictable variation, [§ 103](#) likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

### **IV. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT**

### **SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

### **V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there may be no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device were turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated

would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.). But see *In re Urbanski*, 809 F.3d 1237, 1244, 117 USPQ2d 1499, 1504 (Fed. Cir. 2016) (The patent claims were directed to a method of enzymatic hydrolysis of soy fiber to reduce water holding capacity, requiring reacting the soy fiber and enzyme in water for about 60-120 minutes. The claims were rejected over two prior art references, wherein the primary reference taught using a longer reaction time of 5 to 72 hours and the secondary reference taught using a reaction time of 100 to 240 minutes, preferably 120 minutes. The applicant argued that modifying the primary reference in the manner suggested by the secondary reference would forego the benefits taught by the primary reference, thereby teaching away from the combination. The court held that both prior art references “suggest[ed] that hydrolysis time may be adjusted to achieve *different* fiber properties. Nothing in the prior art teaches that the proposed modification would have resulted in an ‘inoperable’ process or a dietary fiber product with undesirable properties.” (emphasis in original)).

“Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function.” *In re Dance*, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a “means for recovering fluid and debris” in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.). Similarly, in *Allied Erecting v. Genesis Attachments*, 825 F.3d 1373, 1381, 119 USPQ2d 1132, 1138 (Fed. Cir. 2016), the court stated “[a]lthough modification of the movable blades may impede the quick change functionality disclosed by Caterpillar, ‘[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine’” (quoting *Medichem, S.A.*

*v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 USPQ2d 1865, 1870 (Fed. Cir. 2006) (citation omitted)).

#### **VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. The seal construction taught in the primary reference required rigidity for operation, whereas the seal in the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.”).

#### **2143.02 Reasonable Expectation of Success Is Required [R-01.2024]**

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2150 et seq.](#) Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

## I. OBVIOUSNESS REQUIRES A REASONABLE EXPECTATION OF SUCCESS

Where there is a reason to modify or combine the prior art to achieve the claimed invention, the claims may be rejected as *prima facie* obvious provided there is also a reasonable expectation of success. The reasonable expectation of success requirement refers to “the likelihood of success” in combining or modifying prior art disclosures to meet the limitations of the claimed invention. See *Elekta Ltd. v. ZAP Surgical Sys., Inc.*, 81 F.4th 1368, 1375, 2023 USPQ2d 1100 (Fed. Cir. 2023) and *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367, 119 USPQ2d 1171, 1176 (Fed. Cir. 2016). See [MPEP § 2143](#) for guidance on rationales for modifying or combining the prior art. In *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), the Board affirmed a rejection of claims directed to a method of treating depression with amitriptyline (or nontoxic salts thereof) as *prima facie* obvious. The prior art disclosed that amitriptyline is a compound known to possess psychotropic properties and that imipramine is a structurally similar psychotropic compound known to possess antidepressive properties. Additional prior art, suggested that these compounds would have been expected to have similar activity because the structural difference between them involved a known bioisosteric replacement, and because a research paper comparing the pharmacological properties of these two compounds suggested clinical testing of amitriptyline as an antidepressant. The court affirmed the Board’s determination, finding that the teachings of the prior art provided a sufficient basis for a reasonable expectation of success.) In *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (the claims were directed to a process of sterilizing a polyolefinic composition with high-energy radiation in the presence of a phenolic polyester antioxidant to inhibit discoloration or degradation of the polyolefin. Appellant argued that it is unpredictable whether a particular antioxidant will solve the problem of discoloration or degradation. However, the Board found that because the prior art taught that appellant’s preferred antioxidant is very efficient and provides better results compared with other prior art antioxidants, there would have been a reasonable expectation of success.)

As discussed above, reasonable expectation of success can be implicitly shown via the prior art teachings or as part of the obviousness analysis. See *Elekta Ltd. v. ZAP Surgical Sys., Inc.*, 81 F.4th 1368, 1376-77, 2023 USPQ2d 1100 (Fed. Cir. 2023) (“[W]e can reasonably discern that the Board considered and implicitly addressed reasonable expectation of success based on the arguments and evidence presented to the Board on motivation to combine.”). In this decision, the court found the Board’s explanation on why the patent owner’s arguments and evidence presented on motivation to combine were not persuasive implicitly addressed reasonable expectation of success and was supported by substantial evidence. On the other hand, depending on the situation (e.g., the technology, the prior art teachings and the obviousness analysis), reliance on an implicit showing of reasonable expectation of success may not be sufficient to establish a *prima facie* showing of obviousness. *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1344, 2021 USPQ2d 862 (Fed. Cir. 2021) (A finding that a patent challenger in an *inter partes* review had demonstrated a motivation to combine references does not necessarily imply that the challenger had also met its burden of showing a reasonable expectation of success in achieving a claimed method of treatment.). In this case, the court found that the challenged method of treating claims “contain limitations related to their intended purpose for treating vasomotor symptoms [as stated in the preamble], and thus those limitations are undoubtedly relevant to the reasonable expectation of success.” *Id.* at 1345. In other words, the court found that the preamble was limiting and applicable to reasonable expectation of success. However, the limitations in the preamble were not addressed in the motivation to combine analysis. Any obviousness rejection should include, either explicitly or implicitly, an indication of a reasonable expectation of success.

Conclusive proof of efficacy is not required to show a reasonable expectation of success. *OSI Pharm., LLC v. Apotex Inc.*, 939 F.3d 1375, 1385, 2019 USPQ2d 379681 (Fed. Cir. 2019) (“To be clear, we do not hold today that efficacy data is always required for a reasonable expectation of success. Nor are we requiring ‘absolute predictability of success.’”); *Acorda Therapeutics, Inc. v. Roxane*

*Lab., Inc.*, 903 F.3d 1310, 1333, 128 USPQ2d 1001, 1018 (Fed. Cir. 2018) (“This court has long rejected a requirement of ‘[c]onclusive proof of efficacy’ for obviousness.” (citing to *Hoffmann-La Roche Inc. v. Apotex Inc.*, 748 F.3d 1326, 1331 (Fed. Cir. 2014); *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1364 (Fed. Cir. 2007); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1364, 1367–68 (Fed. Cir. 2007) (reasoning that “the expectation of success need only be reasonable, not absolute”))).

## II. AT LEAST SOME DEGREE OF PREDICTABILITY IS REQUIRED; APPLICANTS MAY PRESENT EVIDENCE SHOWING THERE WAS NO REASONABLE EXPECTATION OF SUCCESS

Obviousness does not require absolute predictability, but at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be commercially scaled up successfully.). See also *OSI Pharm., LLC v. Apotex Inc.*, 939 F.3d 1375, 1385, 2019 USPQ2d 379681 (Fed. Cir. 2019) (“These references provide no more than hope—and hope that a potentially promising drug will treat a particular cancer is not enough to create a reasonable expectation of success in a highly unpredictable art such as this. Indeed, given a 99.5% failure rate and no efficacy data or any other reliable indicator of success, the only reasonable expectation at the time of the invention was failure, not success.”); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1207–08, 18 USPQ2d 1016, 1022–23 (Fed. Cir. 1991), *cert. denied*, 502 U.S. 856 (1991) (In the context of a biotechnology case, testimony supported the conclusion that the references did not show that there was a reasonable expectation of success.); *In re*

*O’Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

## III. PREDICTABILITY IS DETERMINED AT THE RELEVANT TIME

Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made for pre-AIA obviousness analysis. *Ex parte Erlich*, 3 USPQ2d 1011, 1016 (Bd. Pat. App. & Inter. 1986) (Although an earlier case reversed a rejection because of unpredictability in the field of monoclonal antibodies, the court found “in this case at the time this invention was made, one of ordinary skill in the art would have been motivated to produce monoclonal antibodies specific for human fibroblast interferon using the method of [the prior art] with a reasonable expectation of success.”) (emphasis in original). For obviousness analysis under the AIA, the relevant time is “before the effective filing date of the claimed invention.”

### 2143.03 All Claim Limitations Must Be Considered [R-01.2024]

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Examiners must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403–04 (Fed. Cir. 1983). The subject matter of a properly construed claim is defined by the terms that limit the scope of the claim when given their broadest reasonable interpretation. In *Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 958–59, 2023 USPQ2d 795 (Fed. Cir. 2023), the court found the claims were improperly narrowed based on a preferred embodiment to sacral anatomy or sacral neuromodulation, whereas the patent claims



made no reference to sacral anatomy or sacral neuromodulation. Thus, the relevant prior art was improperly limited to a narrow subset of claim scope. See also [MPEP § 2111](#) *et seq.* It is the subject matter of the properly construed claim that must be examined. The determination of whether particular language is a limitation in a claim depends on the specific facts of the case. See, e.g., *Griffin v. Bertina*, 285 F.3d 1029, 1034, 62 USPQ2d 1431 (Fed. Cir. 2002).

As a general matter, the grammar and ordinary meaning of terms as understood by one having ordinary skill in the art used in a claim will dictate whether, and to what extent, the language limits the claim scope. Language that suggests or makes a feature or step optional but does not require that feature or step does not limit the scope of a claim under the broadest reasonable claim interpretation. In addition, when a claim requires selection of an element from a list of alternatives, the prior art teaches the element if one of the alternatives is taught by the prior art. See, e.g., *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1298, 92 USPQ2d 1163, 1171 (Fed. Cir. 2009).

The following types of claim language may raise a question as to its limiting effect (this list is not exhaustive):

- preamble ([MPEP § 2111.02](#));
- clauses such as “adapted to,” “adapted for,” “wherein,” and “whereby” ([MPEP § 2111.04](#), subsection I);
- contingent limitations ([MPEP § 2111.04](#), subsection II);
- printed matter ([MPEP § 2111.05](#)); and
- functional language associated with a claim term ([MPEP § 2181](#)).

If an independent claim is nonobvious under [35 U.S.C. 103](#), then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). However, this conclusion of the *Fine* court may not apply if a claim is not properly dependent or if the effective filing date of a dependent claim is later than the effective filing date of an independent claim from which the dependent claim depends. See [MPEP § 608.01\(n\)](#)

for a discussion of dependent claims and [MPEP § 2133.01](#) and [§ 2152.01](#) for a discussion of effective filing date of a claimed invention determined on a claim-by-claim basis.

## I. INDEFINITE LIMITATIONS MUST BE CONSIDERED

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph (see [MPEP § 2175](#)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Making both rejections, when appropriate, avoids piecemeal appellate review. See *Ionescu*, 222 USPQ at 540 n.9 (citing CCPA and Federal Circuit cases.). See also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (The Board erred because it ignored claim language that it considered to be indefinite, and reached a conclusion that the claim would have been obvious based only on the rest of the claim.). However, an examiner should not simply speculate about the meaning of the claim language and then enter an obviousness rejection in view of that speculative interpretation. *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (The “considerable speculation” by the examiner and the Board as to the scope of the claims did not provide a proper basis for an obviousness rejection.). A claim should not be rejected over prior art just because it is indefinite. *Ionescu*, 222 USPQ at 540 (citing *Steele*). Although a claim that is indefinite because it is susceptible to more than one interpretation may be rejected over prior art, an examiner should not base a prior art rejection on a claim interpretation that is not reasonable; see [MPEP § 2111](#) regarding proper claim interpretation.



## II. LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under [35 U.S.C. 103](#), all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984) (Claim to a catalyst expressly excluded the presence of sulfur, halogen, uranium, and a combination of vanadium and phosphorous. Although the negative limitations excluding these elements did not appear in the specification as filed, it was error to disregard these limitations when determining whether the claimed invention would have been obvious in view of the prior art.). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Miller*, 441 F.2d 689, 694, 169 USPQ 597, 600 (CCPA 1971) (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

### 2144 Supporting a Rejection Under 35 U.S.C. 103 [R-01.2024]

When considering obviousness, Office personnel are cautioned against treating any line of reasoning as a *per se* rule. This section discusses supporting a rejection under [35 U.S.C. 103](#) by reliance on scientific theory and legal precedent. In keeping with the flexible approach to obviousness under *KSR*, as well as the requirement for explanation, Office personnel may invoke legal precedent as a source of supporting rationale when warranted and appropriately supported. See [MPEP § 2144.04](#). So, for example, automating a manual activity, making portable, making separable, reversing or duplicating parts, or purifying an old product may form the basis of a rejection. However, such rationales should not be treated as *per se* rules, but rather must be explained and shown to apply to the facts at hand. A similar caveat applies to any obviousness analysis. Simply stating the principle (e.g., “art recognized equivalent,” “structural similarity”) without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.

## I. RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART-RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); see also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

## II. THE EXPECTATION OF SOME ADVANTAGE IS THE STRONGEST RATIONALE FOR COMBINING REFERENCES

The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). See also *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick*, 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006) (“Indeed, we have repeatedly held that an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or

more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves.”).

### III. LEGAL PRECEDENT CAN PROVIDE THE RATIONALE SUPPORTING OBVIOUSNESS ONLY IF THE FACTS IN THE CASE ARE SUFFICIENTLY SIMILAR TO THOSE IN THE APPLICATION

The examiner must apply the law consistently to each application after considering all the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. In this context, “sufficiently similar” does not necessarily require that the facts of the prior legal decision and those of the application under examination come from the same technological area. Rather, facts are sufficiently similar when they can be analogized to each other such that they present the same legal issue. For example, the combining prior art elements rationale was applied to a claimed vehicle pedal assembly in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 82 USPQ2d 1385, 1396 (2007), but that rationale applies broadly across a wide range of technologies; see, for example, the cases discussed in [MPEP § 2143](#), subsection I.A. See also [MPEP § 2145](#), subsection X.E. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on the rationale used by the court to support an obviousness rejection. “The value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts.” *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

### IV. RATIONALE DIFFERENT FROM APPLICANT’S IS PERMISSIBLE

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (discussed below).

In *In re Lintner*, the claimed invention was a laundry composition consisting essentially of a dispersant, cationic fabric softener, sugar, sequestering phosphate, and brightener in specified proportions. The claims were rejected over the combination of a primary reference which taught all the claim limitations except for the presence of sugar, and secondary references which taught the addition of sugar as a filler or weighting agent in compositions containing cationic fabric softeners. Appellant argued that in the claimed invention, the sugar is responsible for the compatibility of the cationic softener with the other detergent components. The court sustained the rejection, stating “The fact that appellant uses sugar for a different purpose does not alter the conclusion that its use in a prior art composition would be [ *sic*, would have been] *prima facie* obvious from the purpose disclosed in the references.” 173 USPQ at 562.

In *In re Dillon*, applicant claimed a composition comprising a hydrocarbon fuel and a sufficient amount of a tetra-orthoester of a specified formula to reduce the particulate emissions from the combustion of the fuel. The claims were rejected as obvious over a reference which taught hydrocarbon

fuel compositions containing tri-orthoesters for dewatering fuels, in combination with a reference teaching the equivalence of tri-orthoesters and tetra-orthoesters as water scavengers in hydraulic (nonhydrocarbon) fluids. The Board affirmed the rejection finding “there was a ‘reasonable expectation’ that the tri- and tetra-orthoester fuel compositions would have similar properties based on ‘close structural and chemical similarity’ between the tri- and tetra-orthoesters and the fact that both the prior art and Dillon use these compounds ‘as fuel additives.’” 919 F.2d at 692, 16 USPQ2d at 1900. The court held “it is not necessary in order to establish a *prima facie* case of obviousness . . . that there be a suggestion or expectation from *the prior art* that the claimed [invention] will have the same or a similar utility as *one newly discovered by applicant*,” and concluded that here a *prima facie* case was established because “[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties.” 919 F.2d at 693, 16 USPQ2d at 1901 (emphasis in original).

See [MPEP § 2145](#), subsection II, for case law pertaining to the presence of additional advantages or latent properties not recognized in the prior art.

### 2144.01 Implicit Disclosure [R-10.2019]

“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) (A process for catalytically producing carbon disulfide by reacting sulfur vapor and methane in the presence of charcoal at a temperature of “about 750-830°C” was found to be met by a reference which expressly taught the same process at 700°C because the reference recognized the possibility of using temperatures greater than 750°C. The reference disclosed that catalytic processes for converting methane with sulfur vapors into carbon disulfide at temperatures greater than 750°C (albeit without charcoal) was known, and that 700°C was “much lower than had previously proved feasible.”); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (Reference disclosure of a compound

where the R-S-R' portion has “at least one methylene group attached to the sulfur atom” implies that the other R group attached to the sulfur atom can be other than methylene and therefore suggests asymmetric dialkyl moieties.).

### 2144.02 Reliance on Scientific Theory [R-08.2012]

The rationale to support a rejection under [35 U.S.C. 103](#) may rely on logic and sound scientific principle. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963). However, when an examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979) (Court held that different crystal forms of zeolites would not have been structurally obvious one from the other because there was no chemical theory supporting such a conclusion. The known chemical relationship between structurally similar compounds (homologs, analogs, isomers) did not support a finding of *prima facie* obviousness of claimed zeolite over the prior art because a zeolite is not a compound but a mixture of compounds related to each other by a particular crystal structure.).

### 2144.03 Reliance on Common Knowledge in the Art or “Well Known” Prior Art [R-01.2024]

In certain circumstances where appropriate, an examiner may take official notice of facts not in the record or rely on “common knowledge” in making a rejection, however such rejections should be judiciously applied.

#### PROCEDURE FOR RELYING ON COMMON KNOWLEDGE OR TAKING OFFICIAL NOTICE

The standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA), 5 U.S.C. 500 *et seq.* See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also [MPEP § 1216.01](#). In light of recent Federal Circuit decisions as discussed below and the substantial evidence standard of review now applied to USPTO

Board decisions, the following guidance is provided in order to assist the examiners in determining when it is appropriate to take official notice of facts without supporting documentary evidence or to rely on common knowledge in the art in making a rejection, and if such official notice is taken, what evidence is necessary to support the examiner's conclusion of common knowledge in the art.

***A. Determining When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support the Examiner's Conclusion***

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. It is always preferable, when reasonably possible, for the examiner to cite a prior art reference rather than to rely on official notice. When an application is under final rejection or action under [37 CFR 1.113](#), official notice should be rarely used.

Official notice unsupported by documentary evidence may be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art, are "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." Note that in this case the noticed fact was beyond dispute, so the court affirmed even though no evidence had been presented as to any prior art disclosure providing "instant and unquestionable demonstration" of that fact. See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might be reasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might be reasonable for the examiner in a first Office action to take official notice of facts by asserting that

certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not beyond dispute, or are not capable of instant and unquestionable demonstration as being well-known. See *Ahlert*, 424 F.2d at 1091, 165 USPQ at 420. Even if the examiner appropriately believes such fact may be of beyond dispute, it is not advisable to rely on official notice when an examiner can find a prior art disclosure to support the fact at issue. Assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("When the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal



the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *Arendi v. Apple*, 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016) (finding that the Board had not provided a reasoned analysis, supported by the evidence of record, for why “common sense” taught the missing process step). See also *In re Van Os*, 844 F.3d 1359, 1361, 121 USPQ2d 1209, 1211 (Fed. Cir. 2017) (“Absent some articulated rationale, a finding that a combination of prior art would have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious.’ ... Here, neither the Board nor the examiner provided any reasoning or analysis to support finding a motivation to add Gillespie's disclosure to Hawkins beyond stating it would have been an ‘intuitive way’ to initiate Hawkins’ editing mode.”).

***B. If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable***

In certain older cases, official notice has been taken of a fact that is asserted to be “common knowledge” without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner’s assertion that the use of “a control is standard procedure throughout the entire field of bacteriology” because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner’s finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). If such notice is

taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to allow the applicant an opportunity to adequately traverse the rejection in the next reply after the Office action in which the “common knowledge” statement was made.

***C. If Applicant Traverses a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence***

To adequately traverse a finding based on official notice, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A mere request by the applicant that the examiner provide documentary evidence in support of an officially-noticed fact is not a proper traversal. See [37 CFR 1.111\(b\)](#). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See [37 CFR 1.104\(d\)\(2\)](#).

If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. See *Ahlert*, 424



F.2d at 1091, 165 USPQ at 420. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

#### ***D. Determine Whether the Next Office Action Should Be Made Final***

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement or a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See [MPEP § 706.07\(a\)](#).

#### ***E. Summary***

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. Also, official notice should be rarely used when an application is under final rejection or action under [37 CFR 1.113](#).

### **2144.04 Legal Precedent as Source of Supporting Rationale [R-07.2022]**

As discussed in [MPEP § 2144](#), an examiner may utilize legal precedent as a source of supporting rationale when warranted and appropriately supported. In formulating any rejection invoking

legal precedent, the examiner must take care to ensure that the rationale is explained and shown to apply to the facts at hand. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

#### **I. AESTHETIC DESIGN CHANGES**

*In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). But see *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965) (Claims were directed to fried potato chips with a specified moisture and fat content, whereas the prior art was directed to french fries having a higher moisture content. While recognizing that in some cases the particular shape of a product is of no patentable significance, the Board held in this case the shape (chips) is important because it results in a product which is distinct from the reference product (french fries)).

#### **II. ELIMINATION OF A STEP OR AN ELEMENT AND ITS FUNCTION**

##### ***A. Omission of an Element and Its Function Is Obvious if the Function of the Element Is Not Desired***

*Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed

an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

***B. Omission of an Element with Retention of the Element's Function Is an Indicium of Nonobviousness***

Note that the omission of an element and retention of its function is an indicium of nonobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (Claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet wherein said thin layer obscured the original print until removal by erasure. The prior art disclosed a similar printed sheet which further comprised an intermediate transparent and erasure-proof protecting layer which prevented erasure of the printing when the top layer was erased. The claims were found nonobvious over the prior art because although the transparent layer of the prior art was eliminated, the function of the transparent layer was retained since appellant's metal layer could be erased without erasing the printed indicia.).

**III. AUTOMATING A MANUAL ACTIVITY**

*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold

structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

**IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS**

***A. Changes in Size/Proportion***

*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Syst., Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

***B. Changes in Shape***

*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

### C. Changes in Sequence of Adding Ingredients

*Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.).

## V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS

### A. Making Portable

*In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

### B. Making Integral

*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, “that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.”); but see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form “a single integral and gaplessly continuous piece.” Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument

unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.).

### C. Making Separable

*In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and therefore not manually removable. The court held that “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.”).

### D. Making Adjustable

*In re Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954) (Claims were directed to a handle for a fishing rod wherein the handle has a longitudinally adjustable finger hook, and the hand grip of the handle connects with the body portion by means of a universal joint. The court held that adjustability, where needed, is not a patentable advance, and because there was an art-recognized need for adjustment in a fishing rod, the substitution of a universal joint for the single pivot of the prior art would have been obvious.).

### E. Making Continuous

*In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963) (Claim directed to a method of producing a cementitious structure wherein a stable air foam is introduced into a slurry of cementitious material differed from the prior art only in requiring the addition of the foam to be continuous. The court held the claimed continuous operation would have been obvious in light of the batch process of the prior art.).

## VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS

### A. *Reversal of Parts*

*In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious modification.).

### B. *Duplication of Parts*

*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a “web” which lies in the joint, and a plurality of “ribs” projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.).

### C. *Rearrangement of Parts*

*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

## VII. PURIFYING AN OLD PRODUCT

Pure materials are novel *vis-à-vis* less pure or impure materials because there is a difference between pure and impure materials. Therefore, the issue is whether claims to a pure material are nonobvious over the prior art. *In re Bergstrom*, 427

F.2d 1394, 166 USPQ 256 (CCPA 1970). Purer forms of known products may be patentable, but the mere purity of a product, by itself, does not render the product nonobvious.

Factors to be considered in determining whether a purified form of an old product is obvious over the prior art include whether the claimed chemical compound or composition has the same utility as closely related materials in the prior art, and whether the prior art suggests the particular form or structure of the claimed material or suitable methods of obtaining that form or structure. *In re Cofer*, 354 F.2d 664, 148 USPQ 268 (CCPA 1966) (Claims to the free-flowing crystalline form of a compound were held nonobvious over references disclosing the viscous liquid form of the same compound because the prior art of record did not suggest the claimed compound in crystalline form or how to obtain such crystals.). However, in the case of product-by-process claims, if a first prior art process is improved to enhance the purity of the product produced by the process, and if the purified product has no structural or functional difference from the products produced by other prior art processes, then the improvement in the first process that improves the purity of the product does not give rise to patentability. See *Purdue Pharma v. Epic Pharma*, 811 F.3d 1345, 117 USPQ2d 1733 (Fed. Cir. 2016). See also [MPEP § 2113](#).

See also *Ex parte Stern*, 13 USPQ2d 1379 (Bd. Pat. App. & Inter. 1987) (Claims to interleukin-2 (a protein with a molecular weight of over 12,000) purified to homogeneity were held unpatentable over references which recognized the desirability of purifying interleukin-2 to homogeneity in a view of a reference which taught a method of purifying proteins having molecular weights in excess of 12,000 to homogeneity wherein the prior art method was similar to the method disclosed by appellant for purifying interleukin-2).

### 2144.05 Obviousness of Similar and Overlapping Ranges, Amounts, and Proportions [R-01.2024]

See [MPEP § 2131.03](#) for case law pertaining to rejections based on the anticipation of ranges under [35 U.S.C. 102](#) and [35 U.S.C. 102/103](#).

## I. OVERLAPPING, APPROACHING, AND SIMILAR RANGES, AMOUNTS, AND PROPORTIONS

In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of “about 1-5%” while the claim was limited to “more than 5%.” The court held that “about 1-5%” allowed for concentrations slightly above 5% thus the ranges overlapped.); *In re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of “50 to 100 Angstroms” considered *prima facie* obvious in view of prior art reference teaching that “for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms].” The court stated that “by stating that ‘suitable protection’ is provided if the protective layer is ‘about’ 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant’s] claimed range.”). See also *In re Bergen*, 120 F.2d 329, 332, 49 USPQ 749, 751-52 (CCPA 1941) (The court found that the overlapping endpoint of the prior art and claimed range was sufficient to support an obviousness rejection, particularly when there was no showing of criticality of the claimed range).

Similarly, a *prima facie* case of obviousness exists where the claimed ranges or amounts do not overlap with the prior art but are merely close. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium. “The proportions are so close that *prima facie* one skilled in the art would have expected them to have the same properties.”). See also *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997) (under the doctrine of equivalents, a purification process using a pH of 5.0

could infringe a patented purification process requiring a pH of 6.0-9.0); *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%); *In re Scherl*, 156 F.2d 72, 74-75, 70 USPQ 204, 205-206 (CCPA 1946) (prior art showed an angle in a groove of up to 90° and an applicant claimed an angle of no less than 120°); *In re Becket*, 88 F.2d 684 (CCPA 1937) (“Where the component elements of alloys are the same, and where they approach so closely the same range of quantities as is here the case, it seems that there ought to be some noticeable difference in the qualities of the respective alloys.”); *In re Dreyfus*, 73 F.2d 931, 934, 24 USPQ 52, 55 (CCPA 1934)(the prior art, which taught about 0.7:1 of alkali to water, renders unpatentable a claim that increased the proportion to at least 1:1 because there was no showing that the claimed proportions were critical); *In re Lilienfeld*, 67 F.2d 920, 924, 20 USPQ 53, 57 (CCPA 1933)(the prior art teaching an alkali cellulose containing minimal amounts of water, found by the Examiner to be in the 5-8% range, the claims sought to be patented were to an alkali cellulose with varying higher ranges of water (e.g., “not substantially less than 13%,” “not substantially below 17%,” and “between about 13[%] and 20%”); *K-Swiss Inc. v. Glide N Lock GmbH*, 567 Fed. App’x 906 (Fed. Cir. 2014)(reversing the Board’s decision, in an appeal of an *inter partes* reexamination proceeding, that certain claims were not *prima facie* obvious due to non-overlapping ranges); *In re Brandt*, 886 F.3d 1171, 1177, 126 USPQ2d 1079, 1082 (Fed. Cir. 2018)(the court found a *prima facie* case of obviousness had been made in a predictable art wherein the claimed range of “less than 6 pounds per cubic feet” and the prior art range of “between 6 lbs./ft<sup>3</sup> and 25 lbs./ft<sup>3</sup>” were so mathematically close that the difference between the claimed ranges was virtually negligible absent any showing of unexpected results or criticality.).

“[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of



obviousness." *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). See also *In re Harris*, 409 F.3d 1339, 74 USPQ2d 1951 (Fed. Cir. 2005) (claimed alloy held obvious over prior art alloy that taught ranges of weight percentages overlapping, and in most instances completely encompassing, claimed ranges; furthermore, narrower ranges taught by reference overlapped all but one range in claimed invention). However, if the reference's disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus. *Id.* See also *In re Baird*, 16 F.3d 380, 383, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("[a] disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds."); [MPEP § 2144.08](#); and subsection III.D below for an additional discussion on consideration of prior art disclosures of a broad range.

A range can be disclosed in multiple prior art references instead of in a single prior art reference depending on the specific facts of the case. *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). The patent claim at issue was directed to a weight plate having 3 elongated openings that served as handles for transporting the weight plate. Multiple prior art patents each disclosed weight plates having 1, 2 or 4 elongated openings. 392 F.3d at 1319, 73 USPQ2d at 1226. The court stated that the claimed weight plate having 3 elongated openings fell within the "range" of the prior art and was thus presumed obvious. 392 F.3d at 1322, 73 USPQ2d at 1228. The court further stated that the "range" disclosed in multiple prior art patents is "a distinction without a difference" from previous range cases which involved a range disclosed in a single patent since the "prior art suggested that a larger number of elongated grips in the weight plates was beneficial... thus plainly suggesting that one skilled in the art look to the range appearing in the prior art." *Id.*

## II. ROUTINE OPTIMIZATION

### A. Optimization Within Prior Art Conditions or Through Routine Experimentation

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Lab. Inc.*, 874 F.2d 804, 809, 10 USPQ2d 1843, 1848 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 975 (1989) (Claimed ratios were obvious as being reached by routine procedures and producing predictable results); *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990) (Claimed amount of wash solution was found to be unpatentable as a matter of routine optimization in the pertinent art, further supported by the prior art disclosure of the need to avoid undue amounts of wash solution); and *In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) (Claims were unpatentable because appellants failed to submit evidence of criticality to demonstrate that the wear resistance of the protective layer

in the claimed thickness range of 50-100 Angstroms was “unexpectedly good”); *Smith v. Nichols*, 88 U.S. 112, 118-19 (1874) (a change in form, proportions, or degree “will not sustain a patent”); *In re Williams*, 36 F.2d 436, 438, 4 USPQ 237 (CCPA 1929) (“It is a settled principle of law that a mere carrying forward of an original patented conception involving only change of form, proportions, or degree, or the substitution of equivalents doing the same thing as the original invention, by substantially the same means, is not such an invention as will sustain a patent, even though the changes of the kind may produce better results than prior inventions.”). See also *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416, 82 USPQ2d 1385, 1395 (2007) (identifying “the need for caution in granting a patent based on the combination of elements found in the prior art.”).

#### ***B. There Must Be an Articulated Rationale Supporting the Rejection***

In order to properly support a rejection on the basis that an invention is the result of “routine optimization”, the examiner must make findings of relevant facts, and present the underpinning reasoning in sufficient detail. The articulated rationale must include an explanation of why it would have been routine optimization to arrive at the claimed invention and why a person of ordinary skill in the art would have had a reasonable expectation of success to formulate the claimed range. See *In re Stepan*, 868 F.3d 1342, 1346, 123 USPQ2d 1838, 1841 (Fed. Cir. 2017). See also *In re Van Os*, 844 F.3d 1359, 1361, 121 USPQ2d 1209, 1211 (Fed. Cir. 2017) (“Absent some articulated rationale, a finding that a combination of prior art would have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious.’”); *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362, 119 USPQ2d 1822 (Fed. Cir. 2016) (“[R]eferences to ‘common sense’ ... cannot be used as a wholesale substitute for reasoned analysis and evidentiary support ...”).

The Supreme Court has clarified that an “obvious to try” line of reasoning may properly support an obviousness rejection. In *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977), the CCPA held that a particular parameter must first be recognized as a

result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation, because “obvious to try” is not a valid rationale for an obviousness finding. However, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the Supreme Court held that “obvious to try” was a valid rationale for an obviousness finding, for example, when there is a “design need” or “market demand” and there are a “finite number” of solutions. 550 U.S. at 421, 82 USPQ2d at 1397 (“The same constricted analysis led the Court of Appeals to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was ‘[o]bvious to try.’ ... When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.”). Thus, after *KSR*, the presence of a known result-effective variable would be one, but not the only, motivation for a person of ordinary skill in the art to experiment to reach another workable product or process.

### **III. REBUTTAL OF PRIMA FACIE CASE OF OBVIOUSNESS**

#### ***A. Showing That the Range Is Critical***

Applicants can rebut a *prima facie* case of obviousness by showing the criticality of the range. “The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.” *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See also *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 271 (1916) (a patent based on a change in the proportions of a prior product or process (changing from 4-10% oil to 1% oil) must be confined to the

proportions that were shown to be critical (1%)); *In re Scherl*, 156 F.2d 72, 74-75, 70 USPQ 204, 205 (CCPA 1946) (“Where the issue of criticality is involved, the applicant has the burden of establishing his position by a proper showing of the facts upon which he relies.”); *In re Becket*, 88 F.2d 684 (CCPA 1937) (“Where the component elements of alloys are the same, and where they approach so closely the same range of quantities as is here the case, it seems that there ought to be some noticeable difference in the qualities of the respective alloys.”); *In re Lilienfeld*, 67 F.2d 920, 924 (CCPA 1933) (“It is well established that, while a change in the proportions of a combination shown to be old, such as is here involved, may be inventive, such changes must be critical as compared with the proportions used in the prior processes, producing a difference in kind rather than degree.”); *In re Wells*, 56 F.2d 674, 675, 12 USPQ 430 (CCPA 1932) (“Changes in proportions of agents used in combinations . . . in order to be patentable, must be critical as compared with the proportions of the prior processes.”); *E.I. DuPont de Nemours & Company v. Synvina C.V.*, 904 F.3d 996, 1006, 128 USPQ2d 1193, 1201 (Fed. Cir. 2018.) (“[A] modification of a process parameter may be patentable if it ‘produce[s] a new and unexpected result which is different in kind and not merely in degree from the results of the prior art.’” (citing *Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); *UCB, Inc. v. Actavis Labs, UT, Inc.*, 65 F.4th 679, 693, 2023 USPQ2d 448 (Fed. Cir. 2023) (“A difference of degree is not as persuasive as a difference in kind – i.e., if the range produces ‘a new property dissimilar to the known property,’ rather than producing a predictable result but to an unexpected extent.”)).

See [MPEP § 716.02 - § 716.02\(g\)](#) for a discussion of criticality and unexpected results.

### **B. Showing That the Prior Art Teaches Away**

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *U.S. v. Adams*, 383 U.S. 39, 51-2 (1966). See also *Deputy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326, 90 USPQ2d 1865, 1873 (Fed. Cir. 2009) (“An inference of nonobviousness is especially strong where the prior art’s teachings

undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.”) and *Allergan, Inc. v. Sandoz Inc.*, 796 F.3d 1293, 1305, 115 USPQ2d 2012, 2019 (Fed. Cir. 2015) (The prior art taught away from use of 200 ppm benzalkonium chloride (“BAK”), as claimed, teaching “that BAK should be minimized in ophthalmic formulations to avoid safety problems”).

Teaching away was not established in *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) (Applicant argued that the prior art taught away from use of a protective layer for a reflective article having a thickness within the claimed range of “50 to 100 Angstroms.” Specifically, a patent to Zehender, which was relied upon to reject applicant’s claim, included a statement that the thickness of the protective layer “should be not less than about [100 Angstroms].” The court held that the patent did not teach away from the claimed invention. “Zehender suggests that there are benefits to be derived from keeping the protective layer as thin as possible, consistent with achieving adequate protection. A thinner coating reduces light absorption and minimizes manufacturing time and expense. Thus, while Zehender expresses a preference for a thicker protective layer of 200-300 Angstroms, at the same time it provides the motivation for one of ordinary skill in the art to focus on thickness levels at the bottom of Zehender’s ‘suitable’ range- about 100 Angstroms- and to explore thickness levels below that range. The statement in Zehender that ‘[i]n general, the thickness of the protective layer should be not less than about [100 Angstroms]’ falls far short of the kind of teaching that would discourage one of skill in the art from fabricating a protective layer of 100 Angstroms or less. [W]e are therefore ‘not convinced that there was a sufficient teaching away in the art to overcome [the] strong case of obviousness’ made out by Zehender.”). See [MPEP § 2145](#), subsection X.D., for a discussion of “teaching away” references.

Applicant can rebut a presumption of obviousness based on a claimed invention that falls within a prior art range by showing “(1) [t]hat the prior art taught away from the claimed invention...or (2) that there are new and unexpected results relative to the prior art.” *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*,

392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). The court found that patentee offered neither evidence of teaching away of the prior art nor new and unexpected results of the claimed invention drawn to a weight plate having three elongated handle openings. 392 F.3d at 1323, 73 USPQ2d at 1229. The court then turned to the patentee's secondary considerations evidence of nonobviousness, such as commercial success, satisfaction of a long-felt need, and copying by others and found that Iron Grip had failed to establish: (A) a nexus between the licensing of its patent to three competitors and the "merits of the invention"; (B) that a competitor copied the claimed three-hole grip plate because "[n]ot every competing product that falls within the scope of a patent is evidence of copying" and "[o]therwise every infringement suit would automatically confirm the nonobviousness of the patent"; and (C) a long-felt but unmet need for the claimed three-hole grip plate prior to its patent because "[a]bsent a showing of a long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness." 392 F.3d at 1324-25, 73 USPQ2d at 1229-30. See also *In re Brandt*, 886 F.3d 1171, 1178, 126 USPQ2d 1079, 1083-1084 (Fed. Cir. 2018) (The court determined the prior art did not teach away from the claimed invention because it only suggested that a denser coverboard could serve to protect a less dense insulation board and did not require a coverboard denser than 6 lbs./ft<sup>3</sup>).

### C. Showing That the Claimed Parameter Was Not Recognized as "Result-Effective"

Applicants may rebut a *prima facie* case of obviousness based on optimization of a variable disclosed in a range in the prior art by showing that the claimed variable was not recognized in the prior art to be a result-effective variable. *E.I. Dupont de Nemours & Company v. Synvina C.V.*, 904 F.3d 996, 1008, 128 USPQ2d 1193, 1202 (Fed. Cir. 2018). ("The idea behind the 'result-effective variable' analysis is straightforward. Our predecessor court reasoned that a person of ordinary skill would not always be motivated to optimize a parameter 'if there is no evidence in the record that the prior art recognized that [that] particular parameter affected the result.' *Antonie*, 559 F.2d at 620.) For example,

in *Antonie* the claimed device was characterized by a certain ratio, and the prior art did not disclose that ratio and was silent regarding one of the variables in the ratio. *Id.* at 619. Our predecessor court thus reversed the Board's conclusion of obviousness. *Id.* at 620. *Antonie* described the situation where a 'parameter optimized was not recognized to be a result-effective variable' as an 'exception' to the general principle in *Aller* that 'the discovery of an optimum value of a variable in a known process is normally obvious.' *Id.* at 620. Our subsequent cases have confirmed that this exception is a narrow one. ... In summarizing the relevant precedent from our predecessor court, we observed in *Applied Materials* that '[i]n cases in which the disclosure in the prior art was insufficient to find a variable result-effective, there was essentially no disclosure of the relationship between the variable and the result in the prior art.' 692 F.3d at 1297. Likewise, if the prior art does recognize that the variable affects the relevant property or result, then the variable is result-effective. *Id.* ('A recognition in the prior art that a property is affected by the variable is sufficient to find the variable result-effective.'). Applicants must articulate why the variable at issue would not have been recognized in the prior art as result-effective. However, it should be noted that after *KSR*, the presence of a known result-effective variable would be one, but not the only, motivation for a person of ordinary skill in the art to experiment to reach another workable product or process. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). See subsection II.B above for additional information about consideration of result-effective variables within an obviousness analysis.

### D. Showing That a Claimed Parameter is Disclosed in a Very Broad Range in Prior Art

One factor that may weigh against maintaining an obviousness rejection based on optimization of a variable disclosed in a range in the prior art is where an applicant establishes that the prior art disclosure of the variable is within a range that is so broad in light of the dissimilar characteristics of the members of the range as to not invite optimization by one of skill in the art. *Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1306, 99 USPQ2d 1713, 1725 (Fed. Cir. 2011) (holding



that ordinary motivation to optimize did not apply where disclosure was 68,000 protein variants including 2,332 amino acids where one of skill in the art would appreciate that the claimed truncated proteins vary enormously in structure). See [MPEP §§ 2131.02](#), [2131.03](#), and [2144.08](#) for additional discussion on consideration of range limitations.

## **2144.06 Art Recognized Equivalence for the Same Purpose [R-01.2024]**

### **I. COMBINING EQUIVALENTS KNOWN FOR THE SAME PURPOSE**

“It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be *prima facie* obvious.). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious); and *In re Couvaras*, 70 F.4th 1374, 1378-79, 2023 USPQ2d 697 (Fed. Cir. 2023) (That the two claimed types of active agents, GABA-agonists and ARBs, were known to be useful for the same purpose—alleviating hypertension—alone can serve as a motivation to combine).

### **II. SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE**

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical

equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components. However, an applicant’s expressed recognition of an art-recognized or obvious equivalent may be used to refute an argument that such equivalency does not exist.); *Smith v. Hayashi*, 209 USPQ 754 (Bd. of Pat. Inter. 1980) (The mere fact that phthalocyanine and selenium function as equivalent photoconductors in the claimed environment was not sufficient to establish that one would have been obvious over the other. However, there was evidence that both phthalocyanine and selenium were known photoconductors in the art of electrophotography. “This, in our view, presents strong evidence of obviousness in substituting one for the other in an electrophotographic environment as a photoconductor.” 209 USPQ at 759.).

An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

## **2144.07 Art Recognized Suitability for an Intended Purpose [R-01.2024]**

The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol.)

See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d



1323 (Fed. Cir. 1988) (Claimed agricultural bagging machine, which differed from a prior art machine only in that the brake means were hydraulically operated rather than mechanically operated, was held to be obvious over the prior art machine in view of references which disclosed hydraulic brakes for performing the same function, albeit in a different environment.).

## 2144.08 Obviousness of Species When Prior Art Teaches Genus [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to pre-AIA 35 U.S.C. 102, the relevant time is "at the time of the invention". See MPEP § 2150 et seq. Many of the court decisions discussed in this section involved applications or patents subject to pre-AIA 35 U.S.C. 102. These court decisions may be applicable to applications and patents subject to AIA 35 U.S.C. 102 but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

### I. EXAMINATION OF CLAIMS DIRECTED TO SPECIES BASED UPON A SINGLE PRIOR ART REFERENCE

When a single prior art reference which discloses a genus encompassing the claimed species or subgenus but does not expressly disclose the particular claimed species or subgenus, Office personnel should attempt to find additional prior art to show that the differences between the prior art primary reference and the claimed invention as a whole would have been obvious. Where such additional prior art is not found, Office personnel should consider the factors discussed below to determine whether a single reference [35 U.S.C. 103](#) rejection would be appropriate.

### II. DETERMINE WHETHER THE CLAIMED SPECIES OR SUBGENUS WOULD HAVE BEEN

### OBVIOUS TO ONE OF ORDINARY SKILL IN THE PERTINENT ART AT THE RELEVANT TIME

The patentability of a claim to a specific compound, species, or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of [35 U.S.C. 103](#). “The section 103 requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions.” *In re Papesch*, 315 F.2d 381, 385, 137 USPQ 43, 47 (CCPA 1963). A determination of patentability under [35 U.S.C. 103](#) should be made upon the facts of the particular case in view of the totality of the circumstances. See, e.g., *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). Use of *per se* rules by Office personnel is improper for determining whether claimed subject matter would have been obvious under [35 U.S.C. 103](#). See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has “decline[d] to extract from *Merck [ & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.”).

#### A. Establishing a Prima Facie Case of Obviousness

Office personnel must consider the factors set out by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) in order to establish a *prima facie* case of obviousness. See, e.g., *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (“The PTO bears the burden of establishing a case of *prima facie* obviousness.”); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re*

*Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham* at 17-18, 148 USPQ at 467 requires that to make out a case of obviousness, one must:

- (A) determine the scope and contents of the prior art;
- (B) ascertain the differences between the prior art and the claims in issue;
- (C) determine the level of ordinary skill in the pertinent art; and
- (D) evaluate any evidence of secondary considerations.

If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case. See, e.g., *Bell*, 991 F.2d at 783-84, 26 USPQ2d at 1531; *Rijckaert*, 9 F.3d at 1532, 28 USPQ2d at 1956; *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. Office personnel should evaluate, when appropriate, the totality of the facts and all of the evidence to determine whether they still support a conclusion that the claimed invention would have been obvious to one of ordinary skill in the art at the relevant time. See *Graham*, at 17-18, 148 USPQ at 467. See, e.g., [MPEP §§ 714.12, 714.13](#), and [715.09](#) for guidance when rebuttal evidence or argument may not be considered.

### 1. Determine the Scope and Content of the Prior Art

After construing the claims, Office personnel should determine the scope and content of the relevant prior art. Each reference to be applied as the basis for an obviousness rejection must qualify as prior art under [35 U.S.C. 102](#) (e.g., *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987) (“Before answering *Graham’s* ‘content’ inquiry, it must be known whether a patent or publication is in the prior art under [35 U.S.C. § 102.](#)”)) and must also be analogous art to the claimed invention. See [MPEP § 2141.01\(a\)](#).

In the case of a prior art reference disclosing a genus, Office personnel should make findings as to:

- (A) the structure of the disclosed prior art genus and that of any expressly described species or subgenus within the genus;

- (B) any physical or chemical properties and utilities disclosed for the genus, as well as any suggested limitations on the usefulness of the genus, and any problems alleged to be addressed by the genus;

- (C) the predictability of the technology; and

- (D) the number of species encompassed by the genus taking into consideration all of the variables possible.

### 2. Ascertain the Differences Between the Closest Disclosed Prior Art Species or Subgenus of Record and the Claimed Species or Subgenus

Once the structure of the disclosed prior art genus and that of any expressly described species or subgenus within the genus are identified, Office personnel should compare it to the claimed species or subgenus to determine the differences. Through this comparison, the closest disclosed species or subgenus in the prior art reference should be identified and compared to that claimed. Office personnel should make explicit findings on the similarities and differences between the closest disclosed prior art species or subgenus of record and the claimed species or subgenus including findings relating to similarity of structure, properties and utilities. In *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537, 218 USPQ 871, 877 (Fed. Cir. 1983), the court noted that “the question under [35 U.S.C. § 103](#) is not whether the differences [between the claimed invention and the prior art] would have been obvious” but “whether the claimed invention *as a whole* would have been obvious.” (emphasis in original).

### 3. Determine the Level of Skill in the Art

Office personnel should evaluate the prior art from the standpoint of the hypothetical person having ordinary skill in the art at the time the claimed invention was made. See, *Ryko Mfg. Co. v. Nu-Star Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991) (“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.”); *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (evidence must be viewed from position of ordinary skill, not of an expert). In most cases,

the only facts of record pertaining to the level of skill in the art will be found within the prior art reference and a discussion of the level of ordinary skill will not be needed. See [MPEP § 2141.03](#), subsection II. However, any additional evidence presented by applicant should be evaluated. See [MPEP §§ 2141](#), subsection II, and [2141.03](#), subsection III.

#### 4. Determine Whether One of Ordinary Skill in the Art Would Have Had a Reason To Select the Claimed Species or Subgenus

In light of the findings made relating to the *Graham* factors, Office personnel should determine whether it would have been obvious to one of ordinary skill in the relevant art to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus. To address this key issue, Office personnel should consider all relevant prior art teachings, focusing on the following, where present.

##### (a) Consider the Size of the Genus

Consider the size of the prior art genus, bearing in mind that size alone cannot support an obviousness rejection. There is no absolute correlation between the size of the prior art genus and a conclusion of obviousness. See, e.g., *Baird*, 16 F.3d at 383, 29 USPQ2d at 1552. Thus, the mere fact that a prior art genus contains a small number of members does not create a *per se* rule of obviousness. Even where the genus contains a small number of members, the disclosed genus may not possess a recognizable class of compounds with common properties. This is a distinction between an obviousness rejection and an anticipation rejection. Contrast the obviousness consideration with an anticipation rejection where it is clear that each member of the small genus contains common properties. A genus may be so small that, when considered in light of the totality of the circumstances, it would anticipate the claimed species or subgenus. For example, it has been held that a prior art genus containing only 20 compounds and a limited number of variations in the generic chemical formula inherently anticipated a claimed species within the genus because “one skilled in [the] art would... envisage *each member*” of the genus. *In re Petering*, 301 F.2d 676, 681, 133 USPQ 275,

280 (CCPA 1962) (emphasis in original). More specifically, the court in *Petering* stated:

A simple calculation will show that, excluding isomerism within certain of the R groups, the limited class we find in Karrer contains only 20 compounds. However, we wish to point out that it is not the mere number of compounds in this limited class which is significant here but, rather, the total circumstances involved, including such factors as the limited number of variations for R, only two alternatives for Y and Z, no alternatives for the other ring positions, and a large unchanging parent structural nucleus. With these circumstances in mind, it is our opinion that Karrer has described to those with ordinary skill in this art each of the various permutations here involved as fully as if he had drawn each structural formula or had written each name.

*Id.* (emphasis in original). *Accord In re Schaumann*, 572 F.2d 312, 316, 197 USPQ 5, 9 (CCPA 1978) (prior art genus encompassing claimed species which disclosed preference for lower alkyl secondary amines, as well as properties possessed by the claimed compound constituted description of claimed compound for purposes of [pre-AIA 35 U.S.C. 102\(b\)](#)). *Cf.*, *In re Ruschig*, 343 F.2d 965, 974, 145 USPQ 274, 282 (CCPA 1965) (Rejection of claimed compound in light of prior art genus based on *Petering* is not appropriate where the prior art does not disclose a small recognizable class of compounds with common properties.).

##### (b) Consider the Express Teachings

If the prior art reference expressly teaches a particular reason to select the claimed species or subgenus, Office personnel should point out the express disclosure and explain why it would have been obvious to one of ordinary skill in the art to select the claimed invention. An express teaching may be based on a statement in the prior art reference such as an art recognized equivalence. For example, see *Merck & Co. v. Biocraft Labs.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) (holding claims directed to diuretic compositions comprising a specific mixture of amiloride and hydrochlorothiazide were obvious over a prior art

reference expressly teaching that amiloride was a pyrazinoylguanidine which could be coadministered with potassium excreting diuretic agents, including hydrochlorothiazide which was a named example, to produce a diuretic with desirable sodium and potassium eliminating properties). See also, *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding it would have been obvious to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

### (c) Consider the Teachings of Structural Similarity

Consider any teachings of a “typical,” “preferred,” or “optimum” species or subgenus within the disclosed genus. If such a prior art species or subgenus is structurally similar to that claimed, its disclosure may provide a reason for one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties. See, e.g., *Dillon*, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also *In re Deuel*, 51 F.3d 1552, 1558, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995) (“Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties.”).

In making an obviousness determination, Office personnel should consider the number of variables which must be selected or modified, and the nature and significance of the differences between the prior art and the claimed invention. See, e.g., *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (reversing obviousness rejection of novel dicamba salt with acyclic structure over broad prior art genus encompassing claimed salt, where disclosed examples of genus were dissimilar in structure, lacking an ether linkage or being cyclic); *In re Susi*, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971) (the difference from the particularly preferred subgenus of the prior art was a hydroxyl group, a difference conceded by applicant “to be of little importance”). In the area of biotechnology, an

exemplified species may differ from a claimed species by a conservative substitution (“the replacement in a protein of one amino acid by another, chemically similar, amino acid... [which] is generally expected to lead to either no change or only a small change in the properties of the protein.” *Dictionary of Biochemistry and Molecular Biology* 97 (John Wiley & Sons, 2d ed. 1989)). The effect of a conservative substitution on protein function depends on the nature of the substitution and its location in the chain. Although at some locations a conservative substitution may be benign, in some proteins only one amino acid is allowed at a given position. For example, the gain or loss of even one methyl group can destabilize the structure if close packing is required in the interior of domains. James Darnell *et al.*, *Molecular Cell Biology* 51 (W. H. Freeman & Co., 2d ed. 1990).

The closer the physical and/or chemical similarities between the claimed species or subgenus and any exemplary species or subgenus disclosed in the prior art, the greater the expectation that the claimed subject matter will function in an equivalent manner to the genus. See, e.g., *Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (and cases cited therein). *Cf. Baird*, 16 F.3d at 382-83, 29 USPQ2d at 1552 (disclosure of dissimilar species can provide teaching away).

Similarly, consider any teaching or suggestion in the reference of a preferred species or subgenus that is significantly different in structure from the claimed species or subgenus. Such a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness. *Baird*, 16 F.3d at 382-83, 29 USPQ2d at 1552 (reversing obviousness rejection of species in view of large size of genus and disclosed “optimum” species which differed greatly from and were more complex than the claimed species); *Jones*, 958 F.2d at 350, 21 USPQ2d at 1943 (reversing obviousness rejection of novel dicamba salt with acyclic structure over broad prior art genus encompassing claimed salt, where disclosed examples of genus were dissimilar in structure, lacking an ether linkage or being cyclic). For example, teachings of preferred species of a complex nature within a disclosed genus may motivate an artisan of ordinary skill to make similar complex species and thus teach away from making simple species within the genus. *Baird*, 16

F.3d at 382, 29 USPQ2d at 1552. See also *Jones*, 958 F.2d at 350, 21 USPQ2d at 1943 (disclosed salts of genus held not sufficiently similar in structure to render claimed species *prima facie* obvious).

Concepts used to analyze the structural similarity of chemical compounds in other types of chemical cases are equally useful in analyzing genus-species cases. For example, a claimed tetra-orthoester fuel composition was held to be obvious in light of a prior art tri-orthoester fuel composition based on their structural and chemical similarity and similar use as fuel additives. *Dillon*, 919 F.2d at 692-93, 16 USPQ2d at 1900-02. Likewise, claims to amitriptyline used as an antidepressant were held obvious in light of the structural similarity to imipramine, a known antidepressant prior art compound, where both compounds were tricyclic dibenzo compounds and differed structurally only in the replacement of the unsaturated carbon atom in the center ring of amitriptyline with a nitrogen atom in imipramine. *In re Merck & Co.*, 800 F.2d 1091, 1096-97, 231 USPQ 375, 378-79 (Fed. Cir. 1986). Other structural similarities have been found to support a *prima facie* case of obviousness. See, e.g., *In re May*, 574 F.2d 1082, 1093-95, 197 USPQ 601, 610-11 (CCPA 1978) (stereoisomers); *In re Wilder*, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 USPQ 39, 41 (CCPA 1963) (omission of methyl group from pyrazole ring). Generally, some teaching of a structural similarity will be necessary to suggest selection of the claimed species or subgenus. *Id.*

#### **(d) Consider the Teachings of Similar Properties or Uses**

Consider the properties and utilities of the structurally similar prior art species or subgenus. It is the properties and utilities that provide real world motivation for a person of ordinary skill to make species structurally similar to those in the prior art. *Dillon*, 919 F.2d at 697, 16 USPQ2d at 1905; *In re Stemniski*, 444 F.2d 581, 586, 170 USPQ 343, 348 (CCPA 1971). Conversely, lack of any known useful properties weighs against a finding of motivation to make or select a species or subgenus. *In re Albrecht*,

514 F.2d 1389, 1392, 1395-96, 185 USPQ 585, 587, 590 (CCPA 1975) (The prior art compound so irritated the skin that it could not be regarded as useful for the disclosed anesthetic purpose, and therefore a person skilled in the art would not have been motivated to make related compounds.); *Stemniski*, 444 F.2d at 586, 170 USPQ at 348 (close structural similarity alone is not sufficient to create a *prima facie* case of obviousness when the reference compounds lack utility, and thus there is no motivation to make related compounds.). However, the prior art need not disclose a newly discovered property in order for there to be a *prima facie* case of obviousness. *Dillon*, 919 F.2d at 697, 16 USPQ2d at 1904-05 (and cases cited therein). If the claimed invention and the structurally similar prior art species share any useful property, that will generally be sufficient to motivate an artisan of ordinary skill to make the claimed species, e.g., *id.* For example, based on a finding that a tri-orthoester and a tetra-orthoester behave similarly in certain chemical reactions, it has been held that one of ordinary skill in the relevant art would have been motivated to select either structure. 919 F.2d at 692, 16 USPQ2d at 1900-01. In fact, similar properties may normally be presumed when compounds are very close in structure. *Dillon*, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also *In re Grabiak*, 769 F.2d 729, 731, 226 USPQ 870, 871 (Fed. Cir. 1985) (“When chemical compounds have ‘very close’ structural similarities and similar utilities, without more a *prima facie* case may be made.”). Thus, evidence of similar properties or evidence of any useful properties disclosed in the prior art that would be expected to be shared by the claimed invention weighs in favor of a conclusion that the claimed invention would have been obvious. *Dillon*, 919 F.2d at 697-98, 16 USPQ2d at 1905; *In re Wilder*, 563 F.2d 457, 461, 195 USPQ 426, 430 (CCPA 1977); *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

#### **(e) Consider the Predictability of the Technology**

Consider the predictability of the technology. See, e.g., *Dillon*, 919 F.2d at 692-97, 16 USPQ2d at 1901-05; *In re Grabiak*, 769 F.2d 729, 732-33, 226 USPQ 870, 872 (Fed. Cir. 1985). If the technology is unpredictable, it is less likely that structurally similar species will render a claimed species obvious



because it may not be reasonable to infer that they would share similar properties. See, e.g., *In re May*, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) (*prima facie* obviousness of claimed analgesic compound based on structurally similar prior art isomer was rebutted with evidence demonstrating that analgesia and addiction properties could not be reliably predicted on the basis of chemical structure); *In re Schechter*, 205 F.2d 185, 191, 98 USPQ 144, 150 (CCPA 1953) (unpredictability in the insecticide field, with homologs, isomers and analogs of known effective insecticides having proven ineffective as insecticides, was considered as a factor weighing against a conclusion of obviousness of the claimed compounds). However, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties. See, e.g., *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

**(f) Consider Any Other Teaching To Support the Selection of the Species or Subgenus**

The categories of relevant teachings enumerated above are those most frequently encountered in a genus-species case, but they are not exclusive. Office personnel should consider the totality of the evidence in each case. In unusual cases, there may be other relevant teachings sufficient to support the selection of the species or subgenus and, therefore, a conclusion of obviousness.

**5. Make Express Fact-Findings and Determine Whether They Support a *Prima Facie* Case of Obviousness**

Based on the evidence as a whole (*In re Bell*, 991 F.2d 781,784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1057 (Fed. Cir. 1990)), Office personnel should make express fact-findings relating to the *Graham* factors, focusing primarily on the prior art teachings discussed above. The fact-findings should specifically articulate any teachings or suggestions in the prior art that would have motivated one of ordinary skill in the art to select the claimed species or subgenus. *Kulling*, 897 F.2d at 1149, 14 USPQ2d at 1058; *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1579 n.42, 1

USQP2d 1593, 1606 n.42 (Fed. Cir. 1987). The fact-findings should state a rationale, as required by *KSR*, that supports a conclusion that the claimed invention would have been obvious. Thereafter, it should be determined whether these findings, considered as a whole, establish a *prima facie* case that the claimed invention would have been obvious to one of ordinary skill in the relevant art at the relevant time.

**2144.09 Close Structural Similarity Between Chemical Compounds (Homologs, Analogues, Isomers) [R-01.2024]**

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

**I. REJECTION BASED ON CLOSE STRUCTURAL SIMILARITY IS FOUNDED ON THE EXPECTATION THAT COMPOUNDS SIMILAR IN STRUCTURE WILL HAVE SIMILAR PROPERTIES**

A *prima facie* case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) (discussed below and in [MPEP § 2144](#)) for

an extensive review of the case law pertaining to obviousness based on close structural similarity of chemical compounds. See also [MPEP § 2144.08](#), subsection II.A.4.(c).

## II. HOMOLOGY AND ISOMERISM ARE FACTS WHICH MUST BE CONSIDERED WITH ALL OTHER RELEVANT FACTS IN DETERMINING OBVIOUSNESS

Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>-groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers *prima facie* obvious); *Aventis Pharma Deutschland v. Lupin Ltd.*, 499 F.3d 1293, 84 USPQ2d 1197 (Fed. Cir. 2007) (5(S) stereoisomer of ramipril obvious over prior art mixture of stereoisomers of ramipril.).

Isomers having the same empirical formula but different structures are not necessarily considered equivalent by chemists skilled in the art and therefore are not necessarily suggestive of each other. *Ex parte Mowry*, 91 USPQ 219 (Bd. App. 1950) (claimed cyclohexylstyrene not *prima facie* obvious over prior art isohexylstyrene). Similarly, homologs which are far removed from adjacent homologs may not be expected to have similar properties. *In re Mills*, 281 F.2d 218, 221 126 USPQ 513, 516 (CCPA 1960) (in the absence of “some way to bridge the factual gap between” them, prior art disclosure of C(8) to C(12) alkyl sulfates was not sufficient to render *prima facie* obvious claimed C(1) alkyl sulfate).

Homology and isomerism involve close structural similarity which must be considered with all other relevant facts in determining the issue of obviousness. *In re Mills*, 281 F.2d 218, 126 USPQ 513 (CCPA 1960); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). Homology should not be automatically equated with *prima facie* obviousness because the claimed invention and the

prior art must each be viewed “as a whole.” *In re Langer*, 465 F.2d 896, 175 USPQ 169 (CCPA 1972) (Claims to a polymerization process using a sterically hindered amine were held nonobvious over a similar prior art process because the prior art disclosed a large number of unhindered amines and only one sterically hindered amine (which differed from a claimed amine by 3 carbon atoms), and therefore the reference as a whole did not apprise the ordinary artisan of the significance of hindered amines as a class.).

## III. PRESENCE OF A TRUE HOMOLOGOUS OR ISOMERIC RELATIONSHIP IS NOT CONTROLLING

Prior art structures do not have to be true homologs or isomers to render structurally similar compounds *prima facie* obvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979) (Claimed and prior art compounds were both directed to heterocyclic carbamoyloximino compounds having pesticidal activity. The only structural difference between the claimed and prior art compounds was that the ring structures of the claimed compounds had two carbon atoms between two sulfur atoms whereas the prior art ring structures had either one or three carbon atoms between two sulfur atoms. The court held that although the prior art compounds were not true homologs or isomers of the claimed compounds, the similarity between the chemical structures and properties is sufficiently close that one of ordinary skill in the art would have been motivated to make the claimed compounds in searching for new pesticides.).

See also *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997) (claimed protein was held to be obvious in light of structural similarities to the prior art, including known structural and functional similarity of the amino acids leucine and isoleucine); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (claimed and prior art compounds used in a method of treating depression would have been expected to have similar activity because the structural difference between the compounds involved a known bioisosteric replacement); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) (The tri-orthoester fuel compositions of the prior art and the claimed

tetra-orthoester fuel compositions would have been expected to have similar properties based on close structural and chemical similarity between the orthoesters and the fact that both the prior art and applicant used the orthoesters as fuel additives.) (See [MPEP § 2144](#) for a more detailed discussion of the facts in the *Dillon* case.).

Compare *In re Grabiak*, 769 F.2d 729, 226 USPQ 871 (Fed. Cir. 1985) (substitution of a thioester group for an ester group in an herbicidal safener compound was not suggested by the prior art); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993) (The established relationship between a nucleic acid and the protein it encodes in the genetic code does not render a gene *prima facie* obvious over its corresponding protein in the same way that closely related structures in chemistry may create a *prima facie* case because there are a vast number of nucleotide sequences that might encode for a specific protein as a result of degeneracy in the genetic code (i.e., the fact that most amino acids are specified by more than one nucleotide sequence or codon).); *In re Deuel*, 51 F.3d 1552, 1558-59, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995) (“A prior art disclosure of the amino acid sequence of a protein does not necessarily render particular DNA molecules encoding the protein obvious because the redundancy of the genetic code permits one to hypothesize an enormous number of DNA sequences coding for the protein.” The existence of a general method of gene cloning in the prior art is not sufficient, without more, to render obvious a particular cDNA molecule.).

#### **IV. PRESENCE OR ABSENCE OF PRIOR ART SUGGESTION OF METHOD OF MAKING A CLAIMED COMPOUND MAY BE RELEVANT IN DETERMINING *PRIMA FACIE* OBVIOUSNESS**

“[T]he presence—or absence—of a suitably operative, obvious process for making a composition of matter may have an ultimate bearing on whether that composition is obvious—or nonobvious—under [35 U.S.C. 103](#).” *In re Maloney*, 411 F.2d 1321, 1323, 162 USPQ 98, 100 (CCPA 1969).

“[I]f the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be

legally concluded that the compound itself is in the possession of the public. In this context, we say that the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on the close relationships between their structures and those of prior art compounds.” *In re Hoeksema*, 399 F.2d 269, 274-75, 158 USPQ 597, 601 (CCPA 1968).

See *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979) for a general discussion of circumstances under which the prior art suggests methods for making novel compounds which are of close structural similarity to compounds known in the prior art. It may be proper to apply “methodology in rejecting product claims under [35 U.S.C. 103](#), depending on the particular facts of the case, the manner and context in which methodology applies, and the overall logic of the rejection.” *Ex parte Goldgaber*, 41 USPQ2d 1172, 1176 (Bd. Pat. App. & Inter. 1996).

#### **V. PRESUMPTION OF OBVIOUSNESS BASED ON STRUCTURAL SIMILARITY IS OVERCOME WHERE THERE IS NO REASONABLE EXPECTATION OF SIMILAR PROPERTIES**

The presumption of obviousness based on a reference disclosing structurally similar compounds may be overcome where there is evidence showing there is no reasonable expectation of similar properties in structurally similar compounds. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (appellant produced sufficient evidence to establish a substantial degree of unpredictability in the pertinent art area, and thereby rebutted the presumption that structurally similar compounds have similar properties); *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). See also *Ex parte Blattner*, 2 USPQ2d 2047 (Bd. Pat. App. & Inter. 1987) (Claims directed to compounds containing a 7-membered ring were rejected as *prima facie* obvious over a reference which taught 5- and 6-membered ring homologs of the claimed compounds. The Board reversed the rejection because the prior art taught that the compounds containing a 5-membered ring possessed the opposite utility of the compounds containing the 6-membered ring, undermining the examiner’s asserted *prima facie* case arising from

an expectation of similar results in the claimed compounds which contain a 7-membered ring.).

#### **VI. IF PRIOR ART COMPOUNDS HAVE NO UTILITY, OR UTILITY ONLY AS INTERMEDIATES, CLAIMED STRUCTURALLY SIMILAR COMPOUNDS MAY NOT BE *PRIMA FACIE* OBVIOUS OVER THE PRIOR ART**

If the prior art does not teach any specific or significant utility for the disclosed compounds, then the prior art is unlikely to render structurally similar claims *prima facie* obvious in the absence of any reason for one of ordinary skill in the art to make the reference compounds or any structurally related compounds. *In re Stemniski*, 444 F.2d 581, 170 USPQ 343 (CCPA 1971).

See also *In re Albrecht*, 514 F.2d 1389, 1396, 185 USPQ 585, 590 (CCPA 1975) (prior art reference studied the local anesthetic activity of various compounds, and taught that compounds structurally similar to those claimed were irritating to human skin and therefore “cannot be regarded as useful anesthetics.” 514 F.2d at 1393, 185 USPQ at 587).

Similarly, if the prior art merely discloses compounds as intermediates in the production of a final product, one of ordinary skill in the art would not ordinarily stop the reference synthesis and investigate the intermediate compounds with an expectation of arriving at claimed compounds which have different uses. *In re Lahu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984).

#### **VII. *PRIMA FACIE* CASE REBUTTABLE BY EVIDENCE OF UNEXPECTED RESULTS**

A *prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (affidavit evidence which showed that claimed triethylated compounds possessed anti-inflammatory activity whereas prior art trimethylated compounds did not was sufficient to overcome obviousness rejection based on the homologous relationship between the prior art and claimed compounds); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967) (a 7-fold

improvement of activity over the prior art held sufficient to rebut *prima facie* obviousness based on close structural similarity).

However, a claimed compound may be obvious because it was suggested by, or structurally similar to, a prior art compound even though a particular benefit of the claimed compound asserted by patentee is not expressly disclosed in the prior art. It is the differences, in fact, in their respective properties which are determinative of nonobviousness. If the prior art compound does in fact possess a particular benefit, even though the benefit is not recognized in the prior art, applicant’s recognition of the benefit is not in itself sufficient to distinguish the claimed compound from the prior art. *In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (*en banc*).

See [MPEP § 716.02](#) - [§ 716.02\(g\)](#) for a discussion of evidence alleging unexpectedly advantageous or superior results.

#### **2145 Consideration of Applicant’s Rebuttal Arguments and Evidence [R-01.2024]**

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is “before the effective filing date of the claimed invention”. For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is “at the time of the invention”. See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

If a *prima facie* case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. See, e.g., *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). Applicant may also present rebuttal evidence and arguments prior to an Office action in



anticipation of possible prior art rejections. Examiners should consider all evidence of obviousness and nonobviousness of record before making a determination under [35 U.S.C. 103](#).

Rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), by way of an affidavit or declaration under [37 CFR 1.132](#), e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984), or otherwise presented during prosecution. See, e.g., [MPEP §§ 714 to 716 et seq.](#) However, arguments presented by applicant cannot take the place of factually supported objective evidence. See, e.g., *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). C.f., *In re Kao*, 639 F.3d 1057, 1067, 98 USPQ2d 1799, 1807 (Fed. Cir. 2011) (“[W]hen secondary considerations are present, though they are not always dispositive, it is error not to consider them.”); *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a [35 U.S.C. 112](#) rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.); *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 (“[Rebuttal evidence] may relate to any of the *Graham* factors including the so-called secondary considerations.”). The Federal Circuit has “emphasized that consideration of the objective indicia is part of the whole obviousness analysis, not just an afterthought.” *Leo Pharm. Prod., Ltd. v. Rea*, 726 F.3d 1346, 1357, 107 USPQ2d 1943, 1952 (Fed. Cir. 2013) (emphasis in original). Even though court decisions “have used the ‘prima facie’ and ‘rebuttal’ language [the decisions have] generally have made clear that a fact finder must consider *all* evidence of obviousness and nonobviousness before reaching a determination.” *In re Cyclobenzaprine*

*Hydrochloride Extended- Release Capsule Patent Litig.*, 676 F.3d 1063, 1077, 102 USPQ2d 1760, 1772 (Fed. Cir. 2012) (emphasis in the original).

Rebuttal evidence may include evidence of “secondary considerations,” such as “commercial success, long felt but unsolved needs, [and] failure of others.” *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 4459, 467. See also, e.g., *In re Piasecki*, 745 F.2d 1468, 1473, 223 USPQ 785, 788 (Fed. Cir. 1984) (commercial success). Rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties. *Dillon*, 919 F.2d at 692-93, 16 USPQ2d at 1901. A showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997) (conclusory statements regarding unusually low immune response or unexpected biological activity that were unsupported by comparative data held insufficient to overcome *prima facie* case of obviousness). Rebuttal evidence may include evidence that the claimed invention was copied by others. See, e.g., *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *Hybritech Inc. v. Monoclonal Antibodies*, 802 F.2d 1367, 1380, 231 USPQ 81, 90 (Fed. Cir. 1986). It may also include evidence of the state of the art, the level of skill in the art, and the beliefs of those skilled in the art. See, e.g., *In re Oelrich*, 579 F.2d 86, 91-92, 198 USPQ 210, 214 (CCPA 1978) (Expert opinions regarding the level of skill in the art were probative of the nonobviousness of the claimed invention.); *Piasecki*, 745 F.2d at 1471, 1473-74, 223 USPQ at 790 (Evidence of nontechnological nature is pertinent to the conclusion of obviousness. The declarations of those skilled in the art regarding the need for the invention and its reception by the art were improperly discounted by the Board.); *Beattie*, 974 F.2d at 1313, 24 USPQ2d at 1042-43 (Seven declarations provided by music teachers opining that the art teaches away from the claimed invention must be considered, but were not probative because they did not contain facts and did not deal with the specific prior art that was the subject of the rejection.). For example, rebuttal evidence may include a showing that the prior art



fails to disclose or render obvious a method for making the compound, which would preclude a conclusion of obviousness of the compound. A conclusion of obviousness requires that the reference(s) relied upon, together with the knowledge of a person skilled in the art, be enabling in that it put the public in possession of the claimed invention. *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968) (citing *In re Le Grice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)). The *Hoeksema*, court stated:

Thus, upon careful reconsideration it is our view that if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public. [footnote omitted.] In this context, we say that the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds.

See *Hoeksema*, 399 F.2d at 274, 158 USPQ at 601. The *Hoeksema* court further noted that once a *prima facie* case of obviousness is made by the USPTO through citation of references, the burden is on the applicant to produce contrary evidence. In *Hoeksema*, the contrary evidence was that the applied reference did not disclose or render obvious a process for producing the claimed compounds. *Id.* at 274-75, 158 USPQ at 601. See also *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 295, 297, 227 USPQ 657, 666, 667 (Fed. Cir. 1985) (citing *Hoeksema* for the proposition above); *In re Grose*, 592 F.2d 1161, 1168, 201 USPQ 57, 63-64 (CCPA 1979) ("One of the assumptions underlying a *prima facie* obviousness rejection based upon a structural relationship between compounds, such as adjacent homologs, is that a method disclosed for producing one would provide those skilled in the art with a method for producing the other... Failure of the prior art to disclose or render obvious a method for making any composition of matter, whether a compound or a mixture of compounds like a zeolite, precludes a conclusion that the composition would have been obvious.").

Consideration of rebuttal evidence and arguments requires Office personnel to weigh the proffered evidence and arguments. *Id.*; see also *In re Alton*, 76 F.3d 1168, 1174-75, 37 USPQ2d 1578, 1582-83 (Fed. Cir. 1996). Office personnel should avoid giving no weight to evidence submitted by applicant, except in rare circumstances. However, to be entitled to substantial weight, the applicant should establish a nexus between the rebuttal evidence and the claimed invention, i.e., objective evidence of nonobviousness must be attributable to the claimed invention. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 ([BPAI] 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

*In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *GPAC*, 57 F.3d at 1580, 35 USPQ2d at 1121; *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the [35 U.S.C. 103](#) rejection was not probative of nonobviousness.). Additionally, the evidence must be reasonably commensurate in scope with the claimed invention. See, e.g., *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 777 (Fed. Cir. 1983). *In re Soni*, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) does not change this analysis. In *Soni*, the court declined to consider the Office's argument that the evidence of nonobviousness was not commensurate in scope with the claim because it had not been raised by the examiner. *Id.* 54 F.3d at 751, 34 USPQ2d at 1688.

In other words, in order for evidence of secondary considerations to be accorded substantial weight, there must be a nexus, i.e., a legally and factually sufficient connection or correspondence between the submitted evidence and the claimed invention.

*Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373, 2019 USPQ2d 483355 (Fed. Cir. 2019), cert. denied, 141 S.Ct. 373 (2020). “A presumption of nexus requires both that the product embodies the invention and is coextensive with it.” *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, 81 F.4th 1202,1211-12, 2023 USPQ2d 1000 (Fed. Cir. 2023) (While Volvo Penta provided insufficient evidence to show a presumption of nexus, they did provide sufficient evidence to show nexus, independent of the presumption, through evidence of commercial success and copying due to the unique features of the claimed invention.). See [MPEP § 716.01\(b\)](#).

When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition. See, e.g., *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Evidence that the compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a *prima facie* case of obviousness. *Id.*

For example, a showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a *prima facie* case of obviousness if a skilled artisan “could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof.” *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980) (Evidence of the nonobviousness of a broad range can be proven by a narrower range when one skilled in the art could ascertain a trend that would allow him to reasonably extend the probative value thereof.). But see, *Grasselli*, 713 F.2d at 743, 218 USPQ at 778 (evidence of superior properties for sodium containing composition insufficient to establish the non-obviousness of broad claims for a catalyst with “an alkali metal” where it was well known in the catalyst art that different alkali metals were not interchangeable and applicant had shown

unexpected results only for sodium containing materials); *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978) (evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (one test not sufficient where there was no adequate basis for concluding the other claimed compounds would behave the same way). However, an exemplary showing may be sufficient to establish a reasonable correlation between the showing and the entire scope of the claim, when viewed by a skilled artisan. See, e.g., *Chupp*, 816 F.2d at 646, 2 USPQ2d at 1439; *Clemens*, 622 F.2d at 1036, 206 USPQ at 296. On the other hand, evidence of an unexpected property may not be sufficient regardless of the scope of the showing. Usually, a showing of unexpected results is sufficient to overcome a *prima facie* case of obviousness. See, e.g., *In re Albrecht*, 514 F.2d 1389, 1396, 185 USPQ 585, 590 (CCPA 1975). However, where the claims are not limited to a particular use, and where the prior art provides other motivation to select a particular species or subgenus, a showing of a new use alone may not be sufficient to confer patentability. See *Dillon*, 919 F.2d at 692, 16 USPQ2d at 1900-01. Accordingly, each case should be evaluated individually based on the totality of the circumstances.

Evidence pertaining to secondary considerations must be taken into account whenever it has been properly presented; however, it does not necessarily control the obviousness conclusion. See, e.g., *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372, 82 USPQ2d 1321, 1339 (Fed. Cir. 2007) (“the record establish[ed] such a strong case of obviousness” that allegedly unexpectedly superior results were ultimately insufficient to overcome obviousness conclusion); *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007) (“given the strength of the *prima facie* obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion” of obviousness); and *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). Office personnel should not evaluate rebuttal evidence for its “knockdown” value against the *prima facie* case, *Piasecki*, 745 F.2d at 1473, 223 USPQ at 788, or

summarily dismiss it as not compelling or insufficient. Office personnel should weigh all relevant evidence of record in order to determine whether the claims would have been obvious based on a preponderance (more likely than not) standard, and then explain their conclusions. See [MPEP § 716](#) - [§ 716.10](#) for additional information pertaining to the evaluation of rebuttal evidence submitted under [37 CFR 1.132](#).

The following cases exemplify the continued application of the principle that when evidence has been presented to rebut an obviousness rejection, it should not be evaluated simply for its “knockdown” value. Rather, all evidence must be reweighed to determine whether the claims are nonobvious.

#### Example 1:

The claims at issue in *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 83 USPQ2d 1289 (Fed. Cir. 2007), were directed to compositions comprising hematopoietic stem cells from umbilical cord or placental blood, and to methods of using such compositions for treatment of blood and immune system disorders. The composition claims required that the stem cells be present in an amount sufficient to effect hematopoietic reconstitution when administered to a human adult. The trial court had found that PharmaStem’s patents were infringed and not invalid on obviousness or other grounds. On appeal, the Federal Circuit reversed the district court, determining that the claims were invalid for obviousness.

The Federal Circuit discussed the evidence presented at trial. It pointed out that the patentee, PharmaStem, had not invented an entirely new procedure or new composition. Rather, PharmaStem’s own specification acknowledged that it was already known in the prior art that umbilical cord and placental blood-based compositions contained hematopoietic stem cells, and that hematopoietic stem cells were useful for the purpose of hematopoietic reconstitution. PharmaStem’s contribution was to provide experimental proof that umbilical cord and placental blood could be used to effect hematopoietic reconstitution in mice. By extrapolation, one of ordinary skill in the art would have expected this reconstitution method to work in humans as well.

The court rejected PharmaStem’s expert testimony that hematopoietic stem cells had not been proved to exist in cord blood prior to the experiments described in PharmaStem’s patents. The court explained that the expert testimony was contrary to the inventors’ admissions in the specification, as well as prior art teachings that disclosed stem cells in cord blood. In this case, PharmaStem’s evidence of nonobviousness was outweighed by contradictory evidence.

Despite PharmaStem’s useful experimental validation of hematopoietic reconstitution using hematopoietic stem cells

from umbilical cord and placental blood, the Federal Circuit found that the claims at issue would have been obvious. There had been ample suggestion in the prior art that the claimed method would have worked. Absolute predictability is not a necessary prerequisite to a case of obviousness. Rather, a degree of predictability that one of ordinary skill would have found to be reasonable is sufficient. The Federal Circuit concluded that “[g]ood science and useful contributions do not necessarily result in patentability.” *Id.* at 1364, 83 USPQ2d at 1304.

#### Example 2:

It was found to be an error in *In re Sullivan*, 498 F.3d 1345, 84 USPQ2d 1034 (Fed. Cir. 2007), for the Board to fail to consider evidence submitted to rebut a *prima facie* case of obviousness.

The claimed invention was directed to an antivenom composition comprising F(ab) fragments used to treat venomous rattlesnake bites. The composition was created from antibody molecules that include three fragments, F(ab)2, F(ab) and F(c), which have separate properties and utilities. There had been commercially available antivenom products that consisted of whole antibodies and F(ab)2 fragments, but researchers had not experimented with antivenoms containing only F(ab) fragments because it was believed that their unique properties would prevent them from decreasing the toxicity of snake venom. The inventor, Sullivan, discovered that F(ab) fragments are effective at neutralizing the lethality of rattlesnake venom, while reducing the occurrence of adverse immune reactions in humans. On appeal of the examiner’s rejection, the Board held that the claim was obvious because all the elements of the claimed composition were accounted for in the prior art, and that the composition taught by that prior art would have been expected by a person of ordinary skill in the art at the time the invention was made (the case was examined under [pre-AIA 35 U.S.C. 103](#)) to neutralize the lethality of the venom of a rattlesnake.

Rebuttal evidence had not been considered by the Board because it considered the evidence to relate to the intended use of the claimed composition as an antivenom, rather than the composition itself. Appellant successfully argued that even if the Board had shown a *prima facie* case of obviousness, the extensive rebuttal evidence must be considered. The evidence included three expert declarations submitted to show that the prior art taught away from the claimed invention, an unexpected property or result from the use of F(ab) fragment antivenom, and why those having ordinary skill in the art expected antivenoms comprising F(ab) fragments to fail. The declarations related to more than the use of the claimed composition. While a statement of intended use may not render a known composition patentable, the claimed composition was not known, and whether it would have been obvious depends upon consideration of the rebuttal evidence. Appellant did not concede that the only distinguishing factor of its composition is the statement of intended use and extensively argued that its claimed composition exhibits the unexpected property of neutralizing the lethality of rattlesnake venom while reducing the occurrence of adverse immune reactions in humans. The Federal Circuit found that such a use and unexpected property cannot be ignored – the unexpected property is relevant and thus the declarations describing it should have been considered.

Nonobviousness can be shown when a person of ordinary skill in the art would not have reasonably predicted the claimed invention based on the prior art, and the resulting invention would not have been expected. All evidence must be considered when properly presented.

### Example 3:

The case of *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357, 94 USPQ2d 1385 (Fed. Cir. 2010), involved a disposable protective covering for the portion of a hearing aid that is inserted into the ear canal. The covering was such that it could be readily replaced by a user as needed.

At the district court, Shure had argued that Hearing Components' patents were obvious over one or more of three different combinations of prior art references. The jury disagreed, and determined that the claims were nonobvious. The district court upheld the jury verdict, stating that in view of the conflicting evidence presented by the parties as to the teachings of the references, motivation to combine, and secondary considerations, the nonobviousness verdict was sufficiently grounded in the evidence.

Shure appealed to the Federal Circuit, but the Federal Circuit agreed with the district court that the jury's nonobviousness verdict had been supported by substantial evidence. Although Shure had argued before the jury that the Carlisle reference taught an ear piece positioned inside the ear canal, Hearing Components' credible witness countered that only the molded duct and not the ear piece itself was taught by Carlisle as being inside the ear canal. On the issue of combining references, Shure's witness had given testimony described as "rather sparse, and lacking in specific details." *Id.* at 1364, 94 USPQ2d at 1397. In contradistinction, Hearing Components' witness "described particular reasons why one skilled in the art would not have been motivated to combine the references." *Id.* Finally, as to secondary considerations, the Federal Circuit determined that Hearing Components had shown a nexus between the commercial success of its product and the patent by providing evidence that "the licensing fee for a covered product was more than cut in half immediately upon expiration" of the patent.

Although the *Hearing Components* case involves substantial evidence of nonobviousness in a jury verdict, it is nevertheless instructive for Office personnel on the matter of weighing evidence. Office personnel routinely must consider evidence in the form of prior art references, statements in the specification, or declarations under [37 CFR 1.130](#) (for cases examined under the [AIA 35 U.S.C. 102](#) and [103](#)), [37 CFR 1.131](#) (for cases examined under [pre-AIA 35 U.S.C. 102](#) and [103](#)), or [1.132](#) (for cases examined either under the AIA or under pre-AIA law). Other forms of evidence may also be presented during prosecution. Office personnel are reminded that evidence that has been presented in a timely manner should not be ignored, but rather should be considered on the record. However, not all evidence need be accorded the same weight. In determining the relative weight to accord to rebuttal evidence, considerations such as whether a nexus exists between the claimed invention and the proffered evidence, and whether the evidence is commensurate in scope with the claimed invention, are

appropriate. The mere presence of some credible rebuttal evidence does not dictate that an obviousness rejection must always be withdrawn. See [MPEP § 2145](#). Office personnel must consider the appropriate weight to be accorded to each piece of evidence. An obviousness rejection should be made or maintained only if evidence of obviousness outweighs evidence of nonobviousness. See [MPEP § 706](#), subsection I. ("The standard to be applied in all cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable."). [MPEP § 716.01\(d\)](#) provides further guidance on weighing evidence in making a determination of patentability.

### Example 4:

*Yita LLC, v MacNeil IP LLC*, 69 F.4th 1356, 2023 USPQ2d 667 (Fed. Cir. 2023) involved consideration of Yita's challenge to MacNeil's patent in two *inter partes* reviews (IPRs). In IPR2020-01139, the Board found the patent claims nonobvious due to MacNeil's "evidence of secondary considerations [which was] compelling and indicative of non-obviousness." On appeal, the Federal Circuit reversed the Board's final written decision.

MacNeil's patent claims were directed to a vehicle floor tray "closely conforming" to certain walls of the vehicle foot well, a feature that the Board recognized was disclosed in one of the asserted prior art references (Rabbe). The Board had found that MacNeil was entitled to a presumption of nexus because its marketed vehicle trays embodied the claimed invention and were coextensive with the claims.

On appeal, the Federal Circuit determined that the finding of nexus rested on two legal errors: (1) the finding that Rabbe's disclosure needed to but did not establish that close conformance was well-known; and (2) the misapplication of *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 119 USPQ2d 1301 (Fed. Cir. 2016), which did not speak to the present situation where the secondary consideration evidence is linked to an individual element of the claimed invention, specifically the close-conformity element taught by Rabbe.

As to the first error, the court determined that their previous case law made clear that "objective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was 'known in the prior art'—not necessarily well-known." *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257, 108 USPQ2d 1400 (Fed. Cir. 2013) (emphasis in the original) (quoting *Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1312, 79 USPQ2d 1931 (Fed. Cir. 2006)) (internal quotation marks omitted). Additionally, the court noted that the finding of coextensiveness is only relevant to the presumption of nexus and it alone does not decide the overall nexus question.

As to the second error, the court determined the secondary consideration evidence was related solely to the individual element of close-conformance disclosed in the prior art to Rabbe. This circumstance was different than the one present in *WBIP* in which no single feature (but only the combination) was responsible for the secondary consideration evidence.



The secondary consideration evidence was the only *Graham* factor that the Board deemed to weigh in favor of nonobviousness. Because the Board determined that an artisan of ordinary skill would have been motivated to combine the teachings of the prior art references to arrive at the claimed invention with a reasonable expectation of success, the court reversed the final written decision.

[MPEP § 716.01\(b\)](#) provides further guidance on the nexus requirement and evidence of nonobviousness.

See [MPEP § 2155](#) regarding affidavits or declarations under [37 CFR 1.130](#) to overcome prior art rejections.

See [MPEP §§ 715](#) et seq. and [2136.05\(a\)](#) regarding affidavits or declarations under [37 CFR 1.131](#) to overcome prior art rejections.

See [MPEP §§ 716](#) et seq. and [2136.05\(b\)](#) regarding affidavits or declarations under [37 CFR 1.132](#) to overcome prior art rejections.

## I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS NECESSARY

An argument by the applicant is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See [MPEP § 2129](#) and [§ 2144.03](#) for a discussion of admissions as prior art.

Arguments presented by applicant cannot take the place of evidence in the record. See *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness.”). See [MPEP § 716.01\(c\)](#) for examples of applicant statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

## II. ARGUING ADDITIONAL ADVANTAGES OR LATENT PROPERTIES

### *Prima Facie Obviousness Is Not Rebutted by Merely Recognizing Additional Advantages or Latent Properties Present But Not Recognized in the Prior Art*

Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) “would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art.” 596 F.2d at 1022, 201 USPQ at 661.); *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Appellant argued that the presence of DEHP as the plasticizer in a blood collection bag unexpectedly suppressed hemolysis and therefore rebutted any *prima facie* showing of obviousness. However, the closest prior art utilizing a DEHP plasticized blood collection bag inherently achieved same result, although this fact was unknown in the prior art.).

“The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed that an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also



*Lantech Inc. v. Kaufman Co. of Ohio Inc.*, 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) (“The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.”).

*In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) discussed in [MPEP § 2144](#) are also pertinent to this issue.

See [MPEP § 716.02](#) - [§ 716.02\(g\)](#) for a discussion of declaratory evidence alleging unexpected results.

### III. ARGUING THAT PRIOR ART DEVICES ARE NOT PHYSICALLY COMBINABLE

“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332, 103 USPQ2d 1219, 1226 (Fed. Cir. 2012) (citing *In re Etter*, 756 F.2d 852, 859, 225 USPQ 1, 6 (Fed. Cir. 1985) (*en banc*)) (“*Etter's* assertions that Azure cannot be incorporated in Ambrosio are basically irrelevant, the criterion being not whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.”). See also *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.”); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

However, the claimed combination cannot change the principle of operation of the primary reference

or render the reference inoperable for its intended purpose. See [MPEP § 2143.01](#), subsection VI.

### IV. ARGUING AGAINST REFERENCES INDIVIDUALLY

**One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.** *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Where a rejection of a claim is based on two or more references, a reply that is limited to what a subset of the applied references teaches or fails to teach, or that fails to address the combined teaching of the applied references may be considered to be an argument that attacks the reference(s) individually. Where an applicant’s reply establishes that each of the applied references fails to teach a limitation and addresses the combined teachings and/or suggestions of the applied prior art, the reply as a whole does not attack the references individually as the phrase is used in *Keller* and reliance on *Keller* would not be appropriate. This is because “[T]he test for obviousness is what the combined teachings of the references would have suggested to [a PHOSITA].” *In re Mouttet*, 686 F.3d 1322, 1333, 103 USPQ2d 1219, 1226 (Fed. Cir. 2012).

### V. ARGUING ABOUT THE NUMBER OF REFERENCES COMBINED

Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) (Court affirmed a rejection of a detailed claim to a candy sucker shaped like a thumb on a stick based on thirteen prior art references.).

### VI. ARGUING LIMITATIONS WHICH ARE NOT CLAIMED

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) (Claims to a superconducting magnet which generates a “uniform magnetic field” were not limited to the

degree of magnetic field uniformity required for Nuclear Magnetic Resonance (NMR) imaging. Although the specification disclosed that the claimed magnet may be used in an NMR apparatus, the claims were not so limited.); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571-72, 7 USPQ2d 1057, 1064-1065 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) (Various limitations on which appellant relied were not stated in the claims; the specification did not provide evidence indicating these limitations must be read into the claims to give meaning to the disputed terms.); *Ex parte McCullough*, 7 USPQ2d 1889, 1891 (Bd. Pat. App. & Inter. 1987) (Claimed electrode was rejected as obvious despite assertions that electrode functions differently than would be expected when used in nonaqueous battery since “although the demonstrated results may be germane to the patentability of a battery containing appellant’s electrode, they are not germane to the patentability of the invention claimed on appeal.”).

See [MPEP § 2111](#) - [§ 2116.01](#), for additional case law relevant to claim interpretation.

## VII. ARGUING ECONOMIC INFEASIBILITY

The fact that a "combination would not be made by businessmen for economic reasons" does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983) (Prior art reference taught that addition of inhibitors to radioimmunoassay is the most convenient, but costliest solution to stability problem. The court held that the additional expense associated with the addition of inhibitors would not discourage one of ordinary skill in the art from seeking the convenience expected therefrom.).

## VIII. ARGUING ABOUT THE AGE OF REFERENCES

“The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem.” *In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977) (100 year

old patent was properly relied upon in a rejection based on a combination of references.). See also *Ex parte Meyer*, 6 USPQ2d 1966 (Bd. Pat. App. & Inter. 1988) (length of time between the issuance of prior art patents relied upon (1920 and 1976) was not persuasive of nonobviousness).

## IX. ARGUING THAT PRIOR ART IS NONANALOGOUS

See [MPEP § 2141.01\(a\)](#) for case law pertaining to analogous art.

## X. ARGUING IMPROPER RATIONALES FOR COMBINING REFERENCES

### A. *Impermissible Hindsight*

Applicants may argue that the examiner’s conclusion of obviousness is based on improper hindsight reasoning. However, “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. . . . Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007) (internal quotations omitted). Applicants may also argue that the combination of two or more references is “hindsight” because “express” motivation to combine the references is lacking. However, there is no requirement that an “express, written motivation to combine must appear in prior art references before a finding of obviousness.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). See *KSR*, 550 U.S. at 402, 82 USPQ2d at 1389 (“The diversity of inventive pursuits and of modern technology counsels against confining the obviousness analysis by a formalistic conception of the words teaching, suggestion, and motivation, or

by overemphasizing the importance of published articles and the explicit content of issued patents.”) See also *Uber Techs., Inc. v. X One, Inc.*, 957 F.3d 1334, 1339-40, 2020 USPQ2d 10476 (Fed. Cir. 2020) (“[W]e hold that the Board erred when it determined that a person of ordinary skill in the art would not have been motivated to combine the teachings of Okubo with Konishi’s server-side plotting to render obvious the limitation ‘software ... to transmit the map with plotted locations to the first individual.’ This combination does not represent ‘impermissible hindsight’.... Rather, because Okubo’s terminal-side plotting and Konishi’s server-side plotting were both well known in the art, and were the only two identified, predictable solutions for transmitting a map and plotting locations, it would have been obvious to substitute server-side plotting for terminal-side plotting in a combination of Okubo and Konishi.”).

See [MPEP § 2141](#) and [§ 2143](#) for guidance regarding establishment of a *prima facie* case of obviousness.

### **B. Obvious To Try Rationale**

An applicant may argue the examiner is applying an improper “obvious to try” rationale in support of an obviousness rejection.

An “obvious to try” rationale may support a conclusion that a claim would have been obvious where one skilled in the art is choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. “[A] person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [§ 103](#).” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 82 USPQ2d 1385, 1397 (2007).

“The admonition that ‘obvious to try’ is not the standard under [§ 103](#) has been directed mainly at two kinds of error. In some cases, what would have been ‘obvious to try’ would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result,

where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was ‘obvious to try’ was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” *In re O’Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

### **C. Lack of Suggestion To Combine References**

A teaching, suggestion, or motivation to combine references that is found in the prior art is an appropriate rationale for determining obviousness.

*KSR*, 550 U.S. at 418, 82 USPQ2d at 1396. However, it is just one of a number of valid rationales for doing so. The Court in *KSR* identified several exemplary rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. *KSR*, 550 U.S. at 415-21, 82 USPQ2d at 1395-97. See [MPEP § 2141](#) and [§ 2143](#).

### **D. References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose**

In addition to the material below, see [MPEP § 2141.02](#) (prior art must be considered in its entirety, including disclosures that teach away from the claims) and [MPEP § 2143.01](#), subsection VI (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

#### **1. The Nature of the Teaching Is Highly Relevant**

A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. However, “the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious

composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for the inventor’s purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

Furthermore, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also *UCB, Inc. v. Actavis Labs, UT, Inc.*, 65 F.4th 679, 692, 2023 USPQ2d 448 (Fed. Cir. 2023) (“a reference does not teach away if it merely expresses a general preference for an alternative invention but does not criticize, discredit or otherwise discourage investigation into the invention claimed.”) (internal quotations omitted) (quoting *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009)); and *Schwendimann v. Neenah, Inc.*, 82 F.4th 1371, 1381, 2023 USPQ2d 1173 (Fed. Cir. 2023) (“Although Oez [the prior art] used a white pigment with a cross-linking polymer, it does not discourage a skilled artisan from using the white pigment without a cross-linking polymer or lead the skilled artisan in a direction divergent from the path taken in the Appealed Patents. Thus, Oez’s disclosure is substantial evidence that supports the Board’s finding that Oez does not teach away from the proposed combination.”).

## 2. References Cannot Be Combined Where Reference Teaches Away from Their Combination

It is improper to combine references where the references teach away from their combination. *In*

*re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

## 3. Proceeding Contrary to Accepted Wisdom Is Evidence of Nonobviousness

The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986) (Applicant’s claimed process for sulfonating diphenyl sulfone at a temperature above 127°C was contrary to accepted wisdom because the prior art as a whole suggested using lower temperatures for optimum results as evidenced by charring, decomposition, or reduced yields at higher temperatures.).

Furthermore, “[k]nown disadvantages in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness.” *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966).

### E. Applicability of KSR to All Technologies

At the time the *KSR* decision was handed down, some observers questioned whether the principles discussed were intended by the Supreme Court to apply to all fields of inventive endeavor. Arguments were made that because the technology at issue in *KSR* involved the relatively well-developed and predictable field of vehicle pedal assemblies, the decision was relevant only to such fields. The Federal Circuit has soundly repudiated such a notion, stating that *KSR* applies across technologies:

This court also declines to cabin *KSR* to the “predictable arts” (as opposed to the “unpredictable art” of biotechnology). In fact, this record shows that one of skill in this advanced art would find these claimed “results” profoundly “predictable.”

*In re Kubin*, 561 F.3d 1351, 1360, 90 USPQ2d 1417, 1424 (Fed. Cir. 2009). Thus, Office personnel should not withdraw any rejection solely on the basis that the invention lies in a technological area ordinarily considered to be unpredictable. See also [MPEP § 2143.02](#).

## XI. FORM PARAGRAPHS

See [MPEP § 707.07\(f\)](#) for form paragraphs 7.37 through 7.38 which may be used where applicant's arguments are not persuasive or are moot.

### 2146 Pre-AIA 35 U.S.C. 103(c) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP §§ 717.02](#) et seq., [2154.02\(c\)](#) and [2156](#) for the examination of applications subject to the first inventor to file provisions of the AIA involving, inter alia, commonly owned subject matter or a joint research agreement.]*

#### Pre-AIA 35 U.S.C. 103 Conditions of patentability; non-obvious subject matter.

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(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [section 102](#), shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or

cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

It is important to recognize that [pre-AIA 35 U.S.C. 103\(c\)](#) applies only to consideration of prior art for purposes of obviousness under [35 U.S.C. 103\(a\)](#). It does not apply to or affect subject matter which is applied in a rejection under [35 U.S.C. 102](#) or a double patenting rejection. In addition, if the subject matter qualifies as prior art under any subsection of [pre-AIA 35 U.S.C. 102](#) other than (e), (f), or (g) (e.g., [pre-AIA 35 U.S.C. 102\(a\)](#) or (b)) it will not be disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#).

A patent applicant or patentee urging that subject matter is disqualified has the burden of establishing that the prior art is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#). Absent such disqualification, the appropriate rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) applying prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) should be made. See [MPEP § 2146.02](#) for information pertaining to establishing prior art disqualifications due to common ownership or joint research agreements.

The term “subject matter” will be construed broadly, in the same manner the term is construed in the remainder of [pre-AIA 35 U.S.C. 103](#). The term “another” as used in [pre-AIA 35 U.S.C. 103](#) means any inventive entity other than the inventor and would include the inventor and any other persons. The term “developed” is to be read broadly and is not limited by the manner in which the development occurred. The term “commonly owned” means wholly owned by the same person(s) or organization(s) at the time the invention was made. The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. See [MPEP § 2146.02](#).

#### I. APPLICABILITY OF PRE-AIA 35 U.S.C. 103(c)

Prior to November 29, 1999, pre-AIPA 35 U.S.C. 103(c) provided that subject matter developed by another which qualifies as prior art only under [pre-AIA 35 U.S.C. 102\(f\)](#) or [pre-AIA 35 U.S.C.](#)



[102\(g\)](#) is not to be considered when determining whether an invention sought to be patented is obvious under [pre-AIA 35 U.S.C. 103](#), provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See subsection II, below, for a discussion of pre-AIPA 35 U.S.C. 103(c) for applications filed prior to November 29, 1999.

Effective November 29, 1999, subject matter which was prior art under former [35 U.S.C. 103\(a\)](#) via [pre-AIA 35 U.S.C. 102\(e\)](#) was disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This amendment to [pre-AIA 35 U.S.C. 103\(c\)](#) was made pursuant to section 4807 of the American Inventors Protection Act of 1999 (AIPA); see Public Law 106-113, 113 Stat. 1501, 1501A-591 (1999). The changes to [pre-AIA 35 U.S.C. 102\(e\)](#) in the Intellectual Property and High Technology Technical Amendments Act of 2002 (Public Law 107-273, 116 Stat. 1758 (2002)) did not affect the prior art disqualification under [pre-AIA 35 U.S.C. 103\(c\)](#) as amended on November 29, 1999. Subsequently, the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act) (Public Law 108-453, 118 Stat. 3596 (2004)) further amended [pre-AIA 35 U.S.C. 103\(c\)](#) to provide that subject matter developed by another person shall be treated as owned by the same person or subject to an obligation of assignment to the same person for purposes of determining obviousness if three conditions are met:

- (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
- (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
- (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement (hereinafter “joint research agreement disqualification”).

These changes to [pre-AIA 35 U.S.C. 103\(c\)](#) apply to all patents (including reissue patents) granted on or after December 10, 2004 that are subject to [pre-AIA 35 U.S.C. 102](#). The amendment to [pre-AIA 35 U.S.C. 103\(c\)](#) made by the AIPA to change “subsection (f) or (g)” to “one of more of subsections (e), (f), or (g)” applies to applications filed on or after November 29, 1999. It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to [pre-AIA 35 U.S.C. 103\(c\)](#), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to [pre-AIA 35 U.S.C. 103\(c\)](#) is no longer relevant. In a reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004 to determine whether [pre-AIA 35 U.S.C. 103\(c\)](#), as amended by the CREATE Act, applies. For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed on or after November 29, 1999, it is the 1999 changes to pre-AIPA 35 U.S.C. 103(c) that are applicable to the disqualifying commonly assigned/owned prior art provisions of [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP § 2146.01](#) for additional information regarding disqualified prior art under [pre-AIA 35 U.S.C. 102\(e\)/103](#). For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to [pre-AIA 35 U.S.C. 103\(c\)](#) are applicable. Therefore, only prior art under [pre-AIA 35 U.S.C. 102\(f\) or \(g\)](#) used in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) may be disqualified under the commonly assigned/owned prior art provision [pre-AIA of 35 U.S.C. 103\(c\)](#).

[Pre-AIA 35 U.S.C. 103\(c\)](#), as amended by the CREATE Act, applies only to subject matter which qualifies as prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), and which is being relied upon in a rejection under [35 U.S.C. 103\(a\)](#). If the rejection is anticipation under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), [pre-AIA 35 U.S.C. 103\(c\)](#) cannot be relied upon to disqualify the subject matter in order to overcome or prevent the anticipation rejection. Likewise, [pre-AIA 35 U.S.C. 103\(c\)](#) cannot be relied upon to overcome or prevent a double patenting rejection. See [37 CFR 1.78\(c\)](#) and [MPEP § 804](#).

## II. FOR APPLICATIONS FILED PRIOR TO NOVEMBER 29, 1999, AND GRANTED AS PATENTS PRIOR TO DECEMBER 10, 2004

For applications filed prior to November 29, 1999, and granted as patents prior to December 10, 2004, the subject matter that is disqualified as prior art under pre-AIPA 35 U.S.C. 103(c) is strictly limited to subject matter that A) qualifies as prior art only under [pre-AIA 35 U.S.C. 102\(f\)](#) or [pre-AIA 35 U.S.C. 102\(g\)](#), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under [pre-AIA 35 U.S.C. 102\(f\)](#) or [pre-AIA 35 U.S.C. 102\(g\)](#) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under pre-AIPA 35 U.S.C. 103(c) in effect on December 9, 2004. See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997) (“We therefore hold that subject matter derived from another not only is itself unpatentable to the party who derived it under § 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of §§ 102(f) and 103.”).

Inventors of subject matter not commonly owned at the time of the invention, but currently commonly owned, may file as joint inventors in a single application. However, the claims in such an application are not protected from a [35 U.S.C. 103\(a\)](#) rejection based on prior art under [pre-AIA 35 U.S.C. 102\(f\)](#) or [pre-AIA 35 U.S.C. 102\(g\)](#). Applicants in such cases have an obligation pursuant to [37 CFR 1.56](#) to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made to enable the examiner to consider the applicability of a [35 U.S.C. 103\(a\)](#) rejection based on prior art under [pre-AIA 35 U.S.C. 102\(f\)](#) or [pre-AIA 35 U.S.C. 102\(g\)](#). The examiner will assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure.

Foreign applicants will sometimes combine the subject matter of two or more related applications with different inventors into a single U.S. application naming joint inventors. The examiner will make the assumption, absent contrary evidence, that the

applicants are complying with their duty of disclosure if no information is provided relative to invention dates and common ownership at the time the later invention was made. Such a claim for [35 U.S.C. 119\(a\)-\(d\)](#) priority based upon the foreign filed applications is appropriate and [35 U.S.C. 119\(a\)-\(d\)](#) priority can be accorded based upon each of the foreign filed applications.

For rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) using prior art under [pre-AIA 35 U.S.C. 102\(f\)](#) or [\(g\)](#) in applications pending on or after December 10, 2004, see [MPEP § 2146.01](#).

### 2146.01 Prior Art Disqualification Under Pre-AIA 35 U.S.C. 103(c) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP §§ 717.02 et seq.](#), [2154.02\(c\)](#) and [2156](#) for the examination of applications subject to the first inventor to file provisions of the AIA involving, inter alia, commonly owned subject matter or a joint research agreement.]*

#### 35 U.S.C. 103 (pre-AIA) Conditions for patentability; non-obvious subject matter.

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(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [section 102](#), shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

### **I. COMMON OWNERSHIP OR ASSIGNEE PRIOR ART DISQUALIFICATION UNDER PRE-AIA 35 U.S.C. 103(c)**

Enacted on November 29, 1999, the American Inventors Protection Act (AIPA) added subject matter which was prior art under former [35 U.S.C. 103\(a\)](#) via [pre-AIA 35 U.S.C. 102\(e\)](#) as disqualified prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The 1999 change to [pre-AIA 35 U.S.C. 103\(c\)](#) applied to all utility, design and plant patent applications filed on or after November 29, 1999. The Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), in part, redesignated the former 35 U.S.C. 103(c) to [pre-AIA 35 U.S.C. 103\(c\)\(1\)](#) and made this provision effective to all applications in which the patent is granted on or after December 10, 2004, but the AIA provides that certain applications are subject to the current [35 U.S.C. 102](#) and [103](#), see [MPEP § 2159](#). Therefore, the provision of [pre-AIA 35 U.S.C.103\(c\)\(1\)](#) is effective for all applications (utility, design, plant and reissue) pending on or after December 10, 2004, including applications filed prior to November 29, 1999, except those applications subject to the current [35 U.S.C. 102](#) and [103](#). The amendment to [pre-AIA 35 U.S.C. 103\(c\)\(1\)](#) does not affect any application filed before November 29, 1999 and issued as a patent prior to December 10, 2004. See [MPEP § 2159](#).

In a reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004, and whether the patent is subject the current [35 U.S.C. 102](#) to determine whether [pre-AIA 35 U.S.C. 103\(c\)](#), as amended by the CREATE Act, applies. For a reexamination proceeding of a patent granted prior to December 10, 2004, on an application filed on or after November 29, 1999, it is the 1999 changes to

[pre-AIA 35 U.S.C. 103\(c\)](#) that are applicable to the disqualifying commonly assigned/owned prior art provisions of [pre-AIA 35 U.S.C. 103\(c\)](#). For a reexamination proceeding of a patent granted prior to December 10, 2004, on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to [pre-AIA 35 U.S.C. 103\(c\)](#) are applicable. Therefore, only prior art under [pre-AIA 35 U.S.C. 102\(f\) or \(g\)](#) used in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) may be disqualified under the commonly assigned/owned prior art provisions of [35 U.S.C. 103\(c\)](#).

For reissue applications, the doctrine of recapture may prevent the presentation of claims in the reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to overcome a rejection under [35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) which was not able to be disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) in the application that issued as a patent. If an examiner determines that this situation applies in the reissue application under examination, a consultation with the Office of Patent Legal Administration should be initiated via the Technology Center Quality Assurance Specialist.

[Pre-AIA 35 U.S.C. 103\(c\)](#) applies only to prior art usable in an obviousness rejection under [35 U.S.C. 103\(a\)](#). Subject matter that qualifies as anticipatory prior art under [pre-AIA 35 U.S.C. 102](#) is not affected, and may still be used to reject claims as being anticipated. In addition, double patenting rejections, based on subject matter now disqualified as prior art in amended [pre-AIA 35 U.S.C. 103\(c\)](#), should still be made as appropriate. See [37 CFR 1.78\(c\)](#) and [MPEP § 804](#).

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter. For example, the fact that the reference and the application have the same assignee is not, by itself, sufficient to disqualify the prior art under [pre-AIA 35 U.S.C. 103\(c\)](#). There must be a statement that the common ownership was “at the time the invention was made.”

See [MPEP § 2146.02](#) for information regarding establishing common ownership. See [MPEP § 2146.03](#) for examination procedure with respect to [pre-AIA 35 U.S.C. 103\(c\)](#).

## II. JOINT RESEARCH AGREEMENT DISQUALIFICATION UNDER PRE-AIA 35 U.S.C. 103(c) BY THE CREATE ACT

The CREATE Act (Public Law 108-453, 118 Stat. 3596 (2004)) was enacted on December 10, 2004, and is effective for applications for which the patent is granted on or after December 10, 2004, except those patents subject to the current [35 U.S.C. 102](#) and [35 U.S.C. 103](#). Specifically, the CREATE Act amended [pre-AIA 35 U.S.C. 103\(c\)](#) to provide that:

- subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of [pre-AIA 35 U.S.C. 102](#) shall not preclude patentability under [35 U.S.C. 103](#) where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person;
- for purposes of [35 U.S.C. 103](#), subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if
  - the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made,
  - the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and
  - the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement;
- the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made,
- the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and
- the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement;

- the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made,
- the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and
- the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement;

- for purposes of [pre-AIA 35 U.S.C. 103\(c\)](#), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, development, or research work in the field of the claimed invention.

The effective date provision of the CREATE Act provided that its amendments shall apply to any patent (including any reissue patent) granted on or after December 10, 2004, except those patents subject to the current [35 U.S.C. 102](#) and [103](#). The CREATE Act also provided that its amendment shall not affect any final decision of a court or the Office rendered before December 10, 2004, and shall not affect the right of any party in any action pending before the Office or a court on December 10, 2004, to have that party’s rights determined on the basis of the provisions of title 35, United States Code, in effect on December 9, 2004. Since the CREATE Act also includes the amendment to [pre-AIA 35 U.S.C. 103\(c\)](#) made by section 4807 of the AIPA (see Public Law 106-113, 113 Stat. 1501, 1501A-591 (1999)), the change of “subsection (f) or (g)” to “one or more of subsections (e), (f), or (g)” in [pre-AIA 35 U.S.C. 103\(c\)](#) is now also applicable to applications filed prior to November 29, 1999, that were pending on December 10, 2004.

[Pre-AIA 35 U.S.C. 103\(c\)](#), as amended by the CREATE Act, continues to apply only to subject matter which qualifies as prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), and which is being relied upon in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#). If the rejection is anticipation under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), [pre-AIA 35 U.S.C. 103\(c\)](#) cannot be relied upon to disqualify the subject matter in order to overcome or prevent the anticipation



rejection. Likewise, [pre-AIA 35 U.S.C. 103\(c\)](#) cannot be relied upon to overcome or prevent a double patenting rejection. See [37 CFR 1.78\(c\)](#) and [MPEP § 804](#).

Because the CREATE Act applies only to patents granted on or after December 10, 2004, the recapture doctrine may prevent the presentation of claims in the reissue applications that had been amended or cancelled (e.g., to avoid a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based on subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent being reissued.

## **2146.02 Establishing Common Ownership or Joint Research Agreement Under Pre-AIA 35 U.S.C. 103(c) [R-01.2024]**

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions. See [MPEP §§ 717.02](#) et seq., [2154.02\(c\)](#) and [2156](#) for the examination of applications subject to the first inventor to file provisions of the AIA involving, inter alia, commonly owned subject matter or a joint research agreement.]*

In order to be disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#), the subject matter which would otherwise qualify as [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) prior art to the claimed invention and the claimed invention must be commonly owned, or subject to an obligation of assignment to the same person, at the time the claimed invention was made or be subject to a joint research agreement at the time the invention was made. See [MPEP § 2146](#) for rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(f\)](#) or [102\(g\)](#) and prior art disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) in applications granted as patents prior to December 10, 2004. See [MPEP § 2146.01](#) for rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), and prior art disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#).

## **I. DEFINITION OF COMMON OWNERSHIP UNDER PRE-AIA 35 U.S.C. 103(c)**

The term “commonly owned” is intended to mean that the subject matter which would otherwise [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) prior art to the claimed invention and the claimed invention are entirely or wholly owned by, or under an obligation to assign to, the same person(s) or organization(s)/business entity(ies). For purposes of [pre-AIA 35 U.S.C. 103\(c\)](#), common ownership must be at the time the claimed invention was made. If the person(s) or organization(s) owned less than 100 percent of the subject matter which would otherwise [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist. Common ownership requires that the person(s) or organization(s)/business entity(ies) own 100 percent of the subject matter and 100 percent of the claimed invention.

Specifically, if an invention claimed in an application is owned by more than one entity and those entities seek to disqualify the use of a reference as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#), then the reference must be owned by, or subject to an obligation of assignment to, the same entities that owned the application, at the time the later invention was made. For example, assume Company A owns twenty percent of patent Application X and Company B owns eighty percent of patent Application X at the time the invention of Application X was made. In addition, assume that Companies A and B seek to disqualify Reference Z as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#). Reference Z must have been co-owned, or have been under an obligation of assignment to both companies, on the date the invention was made in order for the disqualification to be properly requested. A statement such as “Application X and Patent Z were, at the time the invention of Application X was made, jointly owned by Companies A and B” would be sufficient to establish common ownership.

For applications owned by a joint venture of two or more entities, both the application and the reference must have been owned by, or subject to an obligation of assignment to, the joint venture at the time the invention was made. For example, if Company A



and Company B formed a joint venture, Company C, both Application X and Reference Z must have been owned by, or subject to an obligation of assignment to, Company C at the time the invention was made in order for Reference Z to be properly disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#). If Company A by itself owned Reference Z at the time the invention of Application X was made and Application X was owned by Company C on the date the invention was made, then disqualification of Reference Z as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#) would not be proper.

As long as principal ownership rights to either the subject matter or the claimed invention under examination reside in different persons or organizations, common ownership does not exist. A license of the claimed invention under examination to another by the owner where basic ownership rights are retained would not defeat ownership.

The requirement for common ownership at the time the claimed invention was made is intended to preclude obtaining ownership of subject matter after the claimed invention was made in order to disqualify that subject matter as prior art against the claimed invention.

The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual(s) or organization(s) or a legal obligation to assign both the subject matter and the claimed invention to the same individual(s) or organization(s)/business entity(ies) must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art. A moral or unenforceable obligation would not provide the basis for common ownership.

Under [pre-AIA 35 U.S.C. 103\(c\)](#), an applicant's admission that subject matter was developed prior to the invention would not make the subject matter prior art to the application for obviousness analysis if the subject matter qualifies as prior art only under sections [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), and if the subject matter and the claimed invention were commonly owned at the time the invention was

made. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982), for a decision involving an applicant's admission which was used as prior art against their application. If the subject matter and invention were not commonly owned, an admission that the subject matter is prior art would be usable under [pre-AIA 35 U.S.C. 103](#).

The burden of establishing that subject matter is disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#) is intended to be placed and reside upon the person or persons urging that the subject matter is disqualified. For example, a patent applicant urging that subject matter is disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#), would have the burden of establishing that it was commonly owned at the time the claimed invention was made. To place the burden upon the patent examiner or the defendant in litigation would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee.

In view of [pre-AIA 35 U.S.C. 103\(c\)](#), the Director has reinstated in appropriate circumstances the practice of rejecting claims in commonly owned applications of different inventive entities on the grounds of nonstatutory double patenting. Such rejections can be overcome in appropriate circumstances by the filing of terminal disclaimers. This practice has been judicially authorized. See *In re Bowers*, 359 F.2d 886, 149 USPQ 57 (CCPA 1966). The use of nonstatutory double patenting rejections which then could be overcome by terminal disclaimers precludes patent protection from being improperly extended while still permitting inventors and their assignees to obtain the legitimate benefits from their contributions. See also [MPEP §§ 804 and 1490](#), subsection VI.

The following examples are provided for illustration only:

**Example 1**

Parent Company owns 100% of Subsidiaries A and B

- inventions of A and B are commonly owned by the Parent Company.

**Example 2**

Parent Company owns 100% of Subsidiary A and 90% of Subsidiary B

- inventions of A and B are not commonly owned by the Parent Company.

**Example 3**

If same person owns the reference subject matter and the invention, at time invention was made, the reference subject matter and the invention are commonly owned even if that person grants a license for reference the subject matter to another.

**Example 4**

Different Government inventors retaining certain rights (e.g. foreign filing rights) in separate inventions owned by Government precludes common ownership of inventions.

**Example 5**

Company A and Company B form joint venture Company C. Employees of A, while working for C with an obligation to assign inventions to C, invent invention #1; employees of B while working for C with an obligation to assign inventions to C, invent invention #2, with knowledge of #1.

Question: Are #1 and #2 commonly owned at the time the later invention was made so as to preclude a rejection under [pre-AIA 35 U.S.C. 102\(e\), \(f\) or \(g\)](#) in view of [pre-AIA 35 U.S.C. 103\(a\)](#)?

Answer: Yes- If the required submission of common ownership is made of record in the patent application file. If invention #1 was invented by employees of Company A **not** working for Company C and Company A maintained sole ownership of invention #1 at the time invention #2 was made, inventions #1 and #2 would not be commonly owned as required by [pre-AIA 35 U.S.C. 103\(c\)](#).

**Example 6**

Company A owns 40% of invention #1 and 60% of invention #2, and Company B owns 60% of invention #1 and 40% of invention #2 at the time invention #2 was made.

-inventions #1 and #2 are commonly owned.

**Example 7**

Company B has a joint research agreement with University A. Under the terms of the joint research agreement, University A has agreed that all of its patents will be jointly owned by Company B and University A. Professor X, who works for University A, has an employee agreement with University A assigning all his patents only to University A. After the joint research agreement is executed, University A files patent application #1 for the invention of Professor X, before Company B files patent application #2 on a similar invention.

- inventions #1 and #2 are commonly owned because Professor X's obligation to assign patents to University A who has an obligation to assign patents to the A-B joint venture legally establishes Professor X's obligation to assign patents to the A-B joint venture.

**Example 8**

Inventor X working at Company A invents and files patent application #1 on technology T, owned by Company A. After application #1 is filed, Company A spins off a 100% owned Subsidiary B for technology T including the transfer of the ownership of patent application #1 to Subsidiary B. After Subsidiary B is formed, inventor Y (formerly a Company A employee, but now an employee of Subsidiary B obligated to assign to Subsidiary B) jointly files application #2 with inventor X (now also an employee of Subsidiary B with an obligation to assign to Subsidiary B), which is directed to a possibly nonobvious improvement to technology T.

- the inventions of applications #1 and #2 are commonly owned since Subsidiary B is a wholly owned subsidiary of Company A.

The examiner must examine the application as to all grounds except [pre-AIA 35 U.S.C. 102\(e\), \(f\) and \(g\)](#) as they apply through [pre-AIA 35 U.S.C. 103\(a\)](#) only if the application file(s) establishes common ownership at the time the later invention was made. Thus, it is necessary to look to the time at which common ownership exists. If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) and \(g\)](#) as they apply through [pre-AIA 35 U.S.C. 103\(a\)](#). An invention is "made" when conception is complete as defined in *Mergenthaler v. Scudder*, 11 App.D.C. 264, 81 OG 1417, 1897 C.D. 724 (D.C. Cir. 1897); *In re Tansel*, 253 F.2d 241, 117 USPQ 188 (CCPA 1958). See *Pfaff v. Wells Elecs.*, 525 U.S. 55, 48 USPQ2d 1641, 1647 (1998) ("the invention must be ready for patenting . . . by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.") Common ownership at the time the invention was made for purposes of obviating a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) or \(g\)](#) may be established irrespective of whether the invention was made in the United States or abroad. The provisions of [pre-AIA 35 U.S.C. 104](#), however, will continue to apply to other proceedings in the U.S. Patent and

Trademark Office, e.g. in an interference proceeding, with regard to establishing a date of invention by knowledge or use thereof, or other activity with respect thereto, in a foreign country, except the provisions do not apply to applications subject to the current [35 U.S.C. 102](#) as [pre-AIA 35 U.S.C. 104](#) was repealed effective March 16, 2013. The foreign filing date will continue to be used for interference purposes under [35 U.S.C. 119\(a\) - \(d\)](#) and [35 U.S.C. 365](#).

## II. REQUIREMENTS TO ESTABLISH COMMON OWNERSHIP

It is important to recognize what constitutes a sufficient submission to establish common ownership at the time the invention was made. Common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. *In re Onda*, 229 USPQ 235 (Comm’r Pat. 1985).

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or patent owner(s) make(s) a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. The statement must be signed in accordance with [37 CFR 1.33\(b\)](#). See “Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by [35 U.S.C. 103\(c\)](#),” 1241 OG 96 (December 26, 2000). The applicant(s) or the representative(s) have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient because of their paramount obligation of candor and good faith to the USPTO.

The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper) to ensure the examiner notices the statement. Applicants or patent owners may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to*

the above-mentioned statement concerning common ownership.

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under [pre-AIA 35 U.S.C. 103\(a\)](#) using Patent A in view of Patent B wherein Patent A is only available as prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\), and/or \(g\)](#). In response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.”

This statement alone is sufficient to disqualify Patent A from being used in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) against the claims of Application X.

In rare instances, the examiner may have independent evidence that raises a material doubt as to the accuracy of applicant’s representation of either (1) the common ownership of, or (2) the existence of an obligation to commonly assign, the application being examined and the applied U.S. patent or U.S. patent application publication reference. In such cases, the examiner may explain why the accuracy of the representation is doubted. The examiner may also require objective evidence of common ownership of, or the existence of an obligation to assign, the application being examined and the applied reference as of the date of invention of the application being examined. Examiners should note that the execution dates in assignment documents may not reflect the date a party was under an obligation to assign the claimed invention.

As mentioned above, applicant(s) or patent owner(s) may submit, *in addition to* the above-mentioned statement regarding common ownership, the following objective evidence:

(A) Reference to assignments, which are recorded in the U.S. Patent and Trademark Office in accordance with [37 CFR Part 3](#), and which convey the entire rights in the applications to the same person(s) or organization(s);

(B) Copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s), and which are filed in each of the applications;

(C) An affidavit or declaration by the common owner, which is filed in the application or patent, and which states that there is common ownership, states facts which explain why the affiant or declarant believes there is common ownership, and is properly signed (i.e., the affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization); and

(D) Other evidence, which is submitted in the application or patent, and which establishes common ownership.

### III. REQUIREMENTS TO ESTABLISH A JOINT RESEARCH AGREEMENT

Once an examiner has established a *prima facie* case of obviousness under [pre-AIA 35 U.S.C. 103\(a\)](#), the burden of overcoming the rejection by invoking the joint research agreement provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) as amended by the CREATE Act is on the applicant or the patentee. [Pre-AIA 35 U.S.C. 103\(c\)\(3\)](#) defines a “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention, that was in effect on or before the date the claimed invention (under examination or reexamination) was made.

Like the common ownership or assignment provision, the joint research agreement must be shown to be in effect on or before the time the later invention was made. The joint research agreement may be in effect prior to the effective date (December 10, 2004) of the CREATE Act. In addition, the joint research agreement is NOT required to be in effect on or before the prior art date of the reference that is sought to be disqualified.

To overcome a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based upon subject matter (whether a patent document, publication, or other evidence) which qualifies as prior art under only one or more of

[pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect.

#### *37 CFR 1.71 Detailed description and specification of the invention.*

\*\*\*\*\*

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in [§ 1.9\(e\)](#).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in [§ 1.17\(i\)](#) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in [§ 1.491](#) in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under [§ 1.114](#).

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under [35 U.S.C. 255](#) and [§ 1.323](#) for the amendment to be effective.

#### *37 CFR 1.104 Nature of examination.*

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(c) *Rejection of claims.*

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(5)

(i) Subject matter which qualifies as prior art under [35 U.S.C. 102\(e\), \(f\), or \(g\)](#) in effect prior to March 16, 2013, and a claimed invention in an application filed on or after November 29, 1999, or any patent issuing thereon, in an application filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of [35 U.S.C. 103\(c\)](#) in effect prior to March 16, 2013, if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which qualifies as prior art under [35 U.S.C. 102\(e\), \(f\), or \(g\)](#) in effect prior to March 16, 2013, and a claimed invention in an application pending on or after December 10, 2004, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of [35 U.S.C. 103\(c\)](#) in effect prior to March 16, 2013,



on the basis of a joint research agreement under [35 U.S.C. 103\(c\)\(2\)](#) in effect prior to March 16, 2013, if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of [35 U.S.C. 100\(h\)](#) and [§ 1.9\(e\)](#), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(6) Patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to [35 U.S.C. 103\(c\)](#) in effect on November 28, 1999.

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[37 CFR 1.71\(g\)](#) provides for the situation in which an application discloses or is amended to disclose the names of the parties to a joint research agreement. [37 CFR 1.71\(g\)\(1\)](#) specifically provides that the specification may disclose or be amended to disclose the name of each party to the joint research agreement because this information is required by [35 U.S.C. 102\(c\)](#) or [pre-AIA 35 U.S.C. 103\(c\)\(2\)\(C\)](#).

[37 CFR 1.71\(g\)\(2\)](#) provides that an amendment under [37 CFR 1.71\(g\)\(1\)](#) must be accompanied by the processing fee set forth in [37 CFR 1.17\(i\)](#) if it is not filed within one of the following time periods: (1) within three months of the filing date of a national application; (2) within three months of the date of entry of the national stage as set forth in [37 CFR 1.491](#) in an international application; (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after the filing of a request for continued examination under [37 CFR 1.114](#).

[37 CFR 1.71\(g\)\(3\)](#) provides that if an amendment under [37 CFR 1.71\(g\)\(1\)](#) is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. [37 CFR 1.71\(g\)\(3\)](#) also provides that if the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under [35 U.S.C. 255](#) and [37 CFR 1.323](#) for the amendment

to be effective. The requirements of [37 CFR 1.71\(g\)\(3\)](#) (correction of the patent by a certificate of correction under [35 U.S.C. 255](#) and [37 CFR 1.323](#)) also apply in the situation in which such an amendment is not filed until after the date the patent was granted (in a patent granted on or after December 10, 2004). It is unnecessary to file a reissue application or request for reexamination of the patent to submit the amendment and other information necessary to take advantage of [pre-AIA 35 U.S.C. 103\(c\)](#) as amended by the CREATE Act. See H.R. Rep. No. 108-425, at 9 (“[t]he omission of the names of parties to the agreement is not an error that would justify commencement of a reissue or reexamination proceeding”).

The submission of such an amendment remains subject to the rules of practice: e.g., [37 CFR 1.116](#), [1.121](#), and [1.312](#). For example, if an amendment under [37 CFR 1.71\(g\)](#) is submitted in an application under final rejection to overcome a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based upon a U.S. patent which qualifies as prior art only under [pre-AIA 35 U.S.C. 102\(e\)](#), the examiner may refuse to enter the amendment under [37 CFR 1.71\(g\)](#) if it is not accompanied by an appropriate terminal disclaimer ([37 CFR 1.321\(d\)](#)). This is because such an amendment may necessitate the reopening of prosecution (e.g., for entry of a nonstatutory double patenting rejection).

If an amendment under [37 CFR 1.71\(g\)](#) is submitted to overcome a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based upon a U.S. patent or U.S. patent application publication which qualifies as prior art only under [pre-AIA 35 U.S.C. 102\(e\)](#), and the examiner withdraws the rejection under [pre-AIA 35 U.S.C. 103\(a\)](#), the examiner may need to issue an Office action containing a new nonstatutory double patenting rejection based upon the disqualified patent or patent application publication. In these situations, such Office action can be made final, provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#). The Office action is properly made final because the new nonstatutory double patenting rejection was necessitated by amendment of the application by



applicant. This is the case regardless of whether the claims themselves have been amended.

In addition to amending the specification to disclose the names of the parties to the joint research agreement, applicant must submit the required statement to invoke the prior art disqualification under the CREATE Act. [37 CFR 1.104\(c\)\(5\)](#) sets forth the requirement for the statement, which includes a statement to the effect that the prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement, within the meaning of [pre-AIA 35 U.S.C. 103\(c\)\(3\)](#), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. The statement should either be on or begin on a separate sheet and must not be directed to other matters ([37 CFR 1.4\(c\)](#)). The statement must be signed in accordance with [37 CFR 1.33\(b\)](#). As is the case with establishing common ownership, the applicant or patent owner may, but is not required to, present evidence supporting the existence of the joint research agreement.

If the applicant disqualifies the subject matter relied upon by the examiner in accordance with [pre-AIA 35 U.S.C. 103\(c\)](#) as amended by the CREATE Act and the procedures set forth in the rules, the examiner will treat the application under examination and the [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) prior art as if they are commonly owned for purposes of [pre-AIA 35 U.S.C. 103\(a\)](#).

The following examples are provided for illustration only:

#### Example 1

Company A and University B have a joint research agreement (JRA) in place prior to the date Company A's invention X' was made. Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. Invention X' was made as a result of the activities undertaken within the scope of the JRA. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could invoke the joint research agreement provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) to disqualify University

B's application as prior art in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#).

#### Example 2

Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. Company A and University B have a joint research agreement (JRA), which goes into effect on December 20, 2004. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could **not** invoke the joint research agreement provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) to disqualify University B's application as prior art in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) because the JRA was not in effect until after the later invention was made.

#### Example 3

Company A and University B have a joint research agreement (JRA) in place prior to the date invention X' was made but the JRA is limited to activities for invention Y, which is distinct from invention X. Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could **not** invoke the joint research agreement provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) to disqualify University B's application as prior art in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) because the claimed invention was not made as a result of the activities undertaken within the scope of the JRA.

### 2146.03 Examination Procedure With Respect to Pre-AIA 35 U.S.C. 103(c) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP §§ 717.02 et seq.](#), [2154.02\(c\)](#) and [2156](#) for the examination of applications subject to the first inventor to file provisions of the AIA involving, inter alia, commonly owned subject matter or a joint research agreement.]*

Examiners are reminded that a reference used in an anticipatory rejection under [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#) is not disqualified as prior art if the reference is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#). Generally, such a reference is only disqualified when

(A) a proper submission is filed,

(B) the reference *only* qualifies as prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) or \(g\)](#) (e.g., not [pre-AIA 35 U.S.C. 102\(a\) or \(b\)](#)), and

(C) the reference was used in an obviousness rejection under [pre-AIA 35 U.S.C. 103\(a\)](#).

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or patent owner(s) make(s) a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s). In order to overcome a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based upon a reference which qualifies as prior art under only one or more of [pre-AIA 35 U.S.C. 102\(e\), \(f\), or \(g\)](#), via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect.

See [MPEP § 2146.02](#) for additional information pertaining to establishing common ownership.

#### **I. EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES WHERE COMMON OWNERSHIP OR A JOINT RESEARCH AGREEMENT HAS NOT BEEN ESTABLISHED**

If the application file being examined has not established that the reference is disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#), the examiner will:

(A) assume the reference is not disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#);

(B) examine the application on all grounds other than any conflict between the reference patent(s) or application(s) arising from a possible [35 U.S.C. 103](#) rejection based on prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) and/or \(g\)](#);

(C) consider the applicability of any references under [35 U.S.C. 103](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) and/or \(g\)](#), including provisional rejections under [35 U.S.C. 103\(a\)](#) based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) (see [MPEP § 2146.03\(a\)](#)); and

(D) apply the best references against the claimed invention by rejections under [35 U.S.C. 102](#) and [103\(a\)](#), including any rejections under [35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\), \(f\) and/or \(g\)](#), until such time that the reference is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#).

When applying any references that qualify as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) in a rejection under [35 U.S.C. 103\(a\)](#) against the claims, the examiner should anticipate that the reference may be disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) and consider making an appropriate additional, alternative rejection. See [MPEP § 2120](#), subsection I. If a statement of common ownership or assignment is filed in reply to the [35 U.S.C. 103\(a\)](#) rejection based on prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See [MPEP § 706.07\(a\)](#). If the reference is disqualified under the joint research agreement provision of [pre-AIA 35 U.S.C. 103\(c\)](#) and a new subsequent nonstatutory double patenting rejection based upon the disqualified reference is applied, the next Office action, which contains the new nonstatutory double patenting rejection, may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#)). The Office action is properly made final because the new nonstatutory double patenting rejection was necessitated by amendment of the application by applicant.

#### **II. EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES WHERE**

### COMMON OWNERSHIP OR A JOINT RESEARCH AGREEMENT HAS BEEN ESTABLISHED

If the application being examined has established that the reference is disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#) the examiner will:

(A) examine the applications as to all grounds, except [pre-AIA 35 U.S.C. 102\(e\), \(f\) and \(g\)](#) including provisional rejections based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#), as they apply through [35 U.S.C. 103\(a\)](#);

(B) examine the applications for double patenting, including statutory and nonstatutory double patenting, and make a provisional rejection, if appropriate; and

(C) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate (see [37 CFR 1.321](#)).

### III. DOUBLE PATENTING REJECTIONS

Commonly owned applications of different inventive entities may be rejected on the ground of double patenting, even if the later filed application claims [35 U.S.C. 120](#) benefit to the earlier application, subject to the conditions discussed in [MPEP § 804 et seq.](#) In addition, a double patenting rejection may arise as a result of the amendment to [pre-AIA 35 U.S.C. 103\(c\)](#) by the CREATE Act (Public Law 108-453, 118 Stat. 3596 (2004)). Congress recognized that this amendment to [35 U.S.C. 103\(c\)](#) would result in situations in which there would be double patenting rejections between applications not owned by the same party (see H.R. Rep. No. 108-425, at 5-6 (2003)). For purposes of double patenting analysis, the application or patent and the subject matter disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) as amended by the CREATE Act will be treated as if commonly owned.

A rejection based on a pending application would be a provisional rejection. The practice of rejecting claims on the ground of nonstatutory double patenting in commonly owned applications of different inventive entities is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject

matter. See [MPEP § 804](#) for guidance on nonstatutory double patenting issues. In accordance with established patent law doctrines, nonstatutory double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the existing provisions of [37 CFR 1.321](#), the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life. For a nonstatutory double patenting rejection based on a non-commonly owned patent (treated as if commonly owned pursuant to the CREATE Act), the nonstatutory double patenting rejection may be obviated by filing a terminal disclaimer in accordance with [37 CFR 1.321\(d\)](#). See [MPEP §§ 804, 804.02](#) and [1490](#), subsection VI.

### 2146.03(a) Provisional Rejection (Obviousness) Under 35 U.S.C. 103(a) Using Provisional Prior Art Under Pre-AIA 35 U.S.C. 102(e) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions. See [MPEP § 2154 et seq.](#) for the examination of applications subject to the first inventor to file provisions of the AIA involving, inter alia, rejections based on U.S. patent documents.]*

Where two applications of different inventive entities are copending, not published under [35 U.S.C. 122\(b\)](#), and the filing dates differ, a provisional rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) should be made in the later filed application unless the application has been disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP § 2146.03](#) for examination procedure with respect to [pre-AIA 35 U.S.C. 103\(c\)](#). See also [MPEP § 2136.01](#) for examination procedure in determining when provisional rejections are appropriate. Otherwise the

confidential status of unpublished application, or any part thereof, under [35 U.S.C. 122](#) must be maintained. Such a rejection alerts the applicant that the applicant can expect a nonprovisional rejection on the same ground if one of the applications issues and also lets applicant know that action must be taken to avoid the rejection.

This gives applicant the opportunity to analyze the propriety of the rejection and possibly avoid the loss of rights to desired subject matter. Provisional rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) are rejections applied to copending applications wherein each application has a common assignee or a common inventor. The application with the earlier [pre-AIA 35 U.S.C. 102\(e\)](#) date, if patented or published, would constitute prior art against the other application. The rejection can be overcome by:

(A) Arguing patentability over the earlier filed application;

(B) Combining the subject matter of the copending applications into a single application claiming benefit under [35 U.S.C. 120](#) of the prior applications and abandoning the copending applications (note that a claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under [35 U.S.C. 120](#) if the earlier filed application does not contain a disclosure which complies with [35 U.S.C. 112](#) for the claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997));

(C) Filing an affidavit or declaration under [37 CFR 1.132](#) showing that any unclaimed invention disclosed in the copending application was derived from the inventor of the other application and is thus not invention “by another” (see [MPEP §§ 715.01\(a\), 715.01\(c\)](#), and [716.10](#));

(D) Filing an affidavit or declaration under [37 CFR 1.131\(a\)](#) showing a date of invention prior

to the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the copending application. See [MPEP § 715](#); or

(E) For an application that is pending on or after December 10, 2004, a showing that (1) the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, or (2) the subject matter is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) (i.e., common ownership or joint research agreement disqualification).

Where the applications are claiming interfering subject matter as defined in [37 CFR 41.203\(a\)](#), a terminal disclaimer and an affidavit or declaration under [37 CFR 1.131\(c\)](#) may be used to overcome a rejection under [35 U.S.C. 103\(a\)](#) in a common ownership situation if the earlier filed application has been published or matured into a patent. See [MPEP § 718](#).

If an obviousness rejection based on provisional [pre-AIA 35 U.S.C. 102\(e\)](#) prior art is made and the copending applications are combined into a single application, and the resulting combined application is subject to a restriction requirement, a proper divisional application would not be subject to a provisional or nonprovisional rejection under [35 U.S.C. 103\(a\)](#) in view of the combined application. This is because the provisions of [35 U.S.C. 121](#) would preclude the use of a patent issuing from the combined application as a reference against the divisional application. Additionally, the combined application would be a continuation-in-part application entitled to [35 U.S.C. 120](#) benefit of each of the prior applications. This is illustrated in Example 2, below.

The following examples are illustrative of the application of [35 U.S.C. 103\(a\)](#) in applications filed prior to November 29, 1999 for which a patent was granted prior to December 10, 2004:

**Example 1.** Assumption: Employees A and B work for C, each with knowledge of the other’s work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1. A invents X and later files application.	This is permissible.
2. B modifies X to XY. B files application before A’s filing.	No <a href="#">35 U.S.C. 103(a)</a> rejection based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(f)</a> or <a href="#">102(g)</a> ; provisional <a href="#">35</a>



SITUATIONS	RESULTS
	<a href="#">U.S.C. 103(a)</a> rejection made in A's later-filed application based on B's application as provisional prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> . Provisional nonstatutory double patenting rejection made.
3. B's patent issues.	A's claims rejected over B's patent under <a href="#">35 U.S.C. 103(a)</a> based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> and nonstatutory double patenting.
4. A files <a href="#">37 CFR 1.131(c)</a> affidavit to disqualify B's patent as prior art where interfering subject matter as defined in <a href="#">37 CFR 41.203(a)</a> is being claimed. Terminal disclaimer filed under <a href="#">37 CFR 1.321(c)</a> .	Rejection under <a href="#">35 U.S.C.103(a)</a> based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> may be overcome and nonstatutory double patenting rejection may be overcome if inventions X and XY are commonly owned and all requirements of <a href="#">37 CFR 1.131(c)</a> and <a href="#">1.321</a> are met.

In situation (2.) above, the result is a provisional rejection under [35 U.S.C. 103\(a\)](#) made in the later-filed application based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#). The rejection is

provisional since the subject matter and the prior art are pending applications.

*Example 2.* Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files application establishing that A and B were both under obligation to assign inventions to C at the time the inventions were made.	Provisional <a href="#">35 U.S.C. 103(a)</a> rejection made in B's later-filed application based on A's application as provisional prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> made; provisional nonstatutory double patenting rejection made; no <a href="#">35 U.S.C. 103(a)</a> rejection based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(f)</a> or <a href="#">102(g)</a> made.
3. A and B jointly file continuing application claiming priority to both their earlier applications and abandon the earlier applications.	Assume it is proper that restriction be required between X and XY.
4. X is elected, a patent issues on X, and a divisional application is timely filed on XY.	No rejection of divisional application under <a href="#">35 U.S.C. 103(a)</a> based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> in view of <a href="#">35 U.S.C. 121</a> .

The following examples are illustrative of rejections under [35 U.S.C. 103\(a\)](#) based on prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) in applications that are pending on or after December 10, 2004:

*Example 3.* Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed. Employee A's application, which is pending on or after December 10, 2004, is being examined.

SITUATIONS	RESULTS
1. A invents X and later files application.	This is permissible.
2. B modifies X to XY. B files application before A's filing. A files an application on invention X.	Provisional <a href="#">35 U.S.C. 103(a)</a> rejection of A's later-filed application based on B's application as provisional prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> and a provisional nonstatutory double patenting rejection are made.



SITUATIONS	RESULTS
3. B's patent issues.	A's claims are rejected under <a href="#">35 U.S.C. 103(a)</a> based on B's patent under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> and nonstatutory double patenting.
4. A files evidence of common ownership of inventions X and XY at the time invention XY was made to disqualify B's patent as prior art. In addition, A files a terminal disclaimer under <a href="#">37 CFR 1.321(c)</a> .	Rejection of A's claims under <a href="#">35 U.S.C. 103(a)</a> based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> will be withdrawn and nonstatutory double patenting rejection will be obviated if inventions X and XY are commonly owned at the time invention XY was made and all requirements of <a href="#">37 CFR 1.321</a> are met.

In situation (2.) above, the result is a provisional rejection under [35 U.S.C. 103\(a\)](#) made in the later-filed application based on provisional prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) (the earlier-filed application). The rejection is provisional since the subject matter and the prior art are pending applications.

**Example 4.** Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed. Employee B's application, which is pending on or after December 10, 2004, is being examined.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files evidence in B's application establishing that A and B were both under obligation to assign inventions to C at the time the invention XY was made.	Provisional <a href="#">35 U.S.C. 103(a)</a> rejection of B's claims based on A's application as provisional prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> cannot be made; provisional nonstatutory double patenting rejection is made; no <a href="#">35 U.S.C. 103(a)</a> rejection based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(f)</a> or <a href="#">102(g)</a> is made.
3. B files a terminal disclaimer under <a href="#">37 CFR 1.321(c)</a> .	The provisional nonstatutory double patenting rejection made in B's application would be obviated if all requirements of <a href="#">37 CFR 1.321</a> are met.

**Example 5.** Assumption: Employee A works for assignee I and Employee B works for assignee J. There is a joint research agreement, pursuant to [pre-AIA 35 U.S.C. 103\(c\)](#), between assignees I and J. Employees A and B each filed an application as set forth below. Employee B's invention claimed in his application was made after the joint research agreement was

entered into, and it was made as a result of activities undertaken within the scope of the joint agreement. Employee B's application discloses assignees I and J as the parties to the joint research agreement. Employee B's application, which is pending on or after December 10, 2004, is being examined.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files evidence in B's application establishing a joint research agreement in compliance with <a href="#">pre-AIA 35 U.S.C. 103(c)</a> .	Provisional <a href="#">35 U.S.C. 103(a)</a> rejection of B's claims based on A's application as provisional prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> cannot be made; provisional nonstatutory double patenting rejection is made; no <a href="#">35 U.S.C. 103(a)</a> rejection based on prior art under <a href="#">pre-AIA 35 U.S.C. 102(f)</a> or <a href="#">35 U.S.C. 102(g)</a> made.

SITUATIONS	RESULTS
3. B files a terminal disclaimer under <a href="#">37 CFR 1.321</a> .	The provisional nonstatutory double patenting rejection made in B's application would be obviated if all requirements of <a href="#">37 CFR 1.321</a> are met.

### 2147 Biotechnology Process Applications; Pre-AIA 35 U.S.C. 103(b) [R-01.2024]

*[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150](#) et seq. for examination of applications subject to those provisions.]*

#### Pre-AIA 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

\*\*\*\*\*

(b)

(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under [section 102](#) and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding [section 154](#).

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,  
(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

\*\*\*\*\*

[Pre-AIA 35 U.S.C. 103\(b\)](#) is applicable to biotechnological processes only. [Pre-AIA 35 U.S.C. 103\(b\)](#) precludes a rejection of process claims which involve the use or making of certain nonobvious biotechnological compositions of matter under [pre-AIA 35 U.S.C. 103\(a\)](#). Only applications subject to [pre-AIA 35 U.S.C. 102](#) are subject to [pre-AIA 35 U.S.C. 103\(b\)](#). See [MPEP § 2159](#).

[Pre-AIA 35 U.S.C. 103\(b\)](#) requires that:

(A) the biotechnological process and composition of matter be contained in either the same application or in separate applications having the same effective filing date;

(B) both the biotechnological process and composition of matter be owned or subject to an assignment to the same person at the time the process was invented;

(C) a patent issued on the process also contain the claims to the composition of matter used in or made by the process, or, if the process and composition of matter are in different patents, the patents expire on the same date;

(D) the biotechnological process falls within the definition set forth in [pre-AIA 35 U.S.C. 103\(b\)](#); and

(E) a timely election be made to proceed under the provisions of [pre-AIA 35 U.S.C. 103\(b\)](#).

An election to proceed under [pre-AIA 35 U.S.C. 103\(b\)](#) shall be made by way of petition under [37 CFR 1.182](#). The petition must establish that all the requirements set forth in [pre-AIA 35 U.S.C. 103\(b\)](#) have been satisfied.

An election will normally be considered timely if it is made no later than the earlier of either the payment of the issue fee or the filing of an appeal brief in an

application which contains a composition of matter claim which has not been rejected under [pre-AIA 35 U.S.C. 102](#) or [103\(a\)](#).

In an application where at least one composition of matter claim has not been rejected under [pre-AIA 35 U.S.C. 102](#) or [103\(a\)](#), a [pre-AIA 35 U.S.C. 103\(b\)](#) election may be made by submitting the petition and an amendment requesting entry of process claims which correspond to the composition of matter claim.

For applications pending on or after November 1, 1995, in which the issue fee has been paid prior to March 26, 1996, the timeliness requirement for an election under [pre-AIA 35 U.S.C. 103\(b\)](#) will be considered satisfied if the conditions of [37 CFR 1.312\(b\)](#) are met. However, if a patent is granted on an application entitled to the benefit of [pre-AIA 35 U.S.C. 103\(b\)](#) without an election having been made as a result of error, patentees may file a reissue application to permit consideration of process claims which qualify for [pre-AIA 35 U.S.C. 103\(b\)](#) treatment. See [MPEP § 1412.02](#), subsection II.

See [MPEP § 2116.01](#) for a discussion of the Federal Circuit's decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) which address the general issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In view of the Federal Circuit's decisions in *Ochiai* and *Brouwer*, an applicant's need to rely upon [pre-AIA 35 U.S.C. 103\(b\)](#) should be rare. See also 1184 OG 86 (Comm'r Pat. 1996). See [35 U.S.C. 282](#) for the effect of a determination of nonobviousness under [pre-AIA 35 U.S.C. 103\(b\)\(1\)](#) on the presumption of validity.

## 2148 Form Paragraphs for Use in Rejections Under Pre-AIA 35 U.S.C. 103 [R-07.2022]

The following form paragraphs should be used in making the appropriate rejections under [pre-AIA 35 U.S.C. 103](#).

### ¶ 7.06 Notice re prior art available under both pre-AIA and AIA

In the event the determination of the status of the application as subject to AIA [35 U.S.C. 102](#) and [103](#) (or as subject to [pre-AIA](#)

[35 U.S.C. 102](#) and [103](#)) is incorrect, any correction of the statutory basis (i.e., changing from AIA to pre-AIA) for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

### Examiner Note:

1. This form paragraph must be used in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013, that claims priority to, or the benefit of, an application filed before March 16, 2013.
2. This form paragraph should only be used ONCE in an Office action.

### ¶ 7.20.fti Statement of Statutory Basis, Pre-AIA 35 U.S.C. 103(a)

The following is a quotation of [pre-AIA 35 U.S.C. 103\(a\)](#) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section [102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### Examiner Note:

1. The statute is not to be cited in all Office actions. It is only required in first actions on the merits employing [pre-AIA 35 U.S.C. 103\(a\)](#) and final rejections. Where the statute is being applied, but is not cited in an action on the merits, use paragraph 7.103.
2. This form paragraph should only be used ONCE in a given Office action.
3. This form paragraph must precede form paragraphs 7.20.01.fti - 7.22.fti when this form paragraph is used to cite the statute in first actions and final rejections.

### ¶ 7.20.01.fti Pre-AIA 103(a) Rejection Using Prior Art Under Pre-AIA 102(e), (f), or (g) That Is Not Disqualified Under Pre-AIA 35 U.S.C. 103(c) Because Reference Is Prior Art Under Another Subsection of Pre-AIA 35 U.S.C. 102

Applicant has provided a submission in this file that the invention was owned by, or subject to an obligation of assignment to, the same entity as [1] at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference [2] qualifies as prior art under another subsection of [pre-AIA 35 U.S.C. 102](#), and therefore is not disqualified as prior art under [pre-AIA 35 U.S.C. 103\(c\)](#).

Applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore,

not the invention “by another,” or by antedating the applied art under [37 CFR 1.131\(a\)](#).

**Examiner Note:**

1. This form paragraph must be included following form paragraph 7.20.fti in all actions containing rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) using art that is disqualified under [pre-AIA 103\(c\)](#) using [pre-AIA 102\(e\)](#), [\(f\)](#), or [\(g\)](#), but which qualifies under another section of [pre-AIA 35 U.S.C. 102](#).
2. In bracket 1, identify the common assignee.
3. In bracket 2, identify the reference which has been disqualified.

**¶ 7.20.02.fti Joint Inventors, Common Ownership Presumed**

This application currently names joint inventors. In considering patentability of the claims under [pre-AIA 35 U.S.C. 103\(a\)](#), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under [37 CFR 1.56](#) to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of [pre-AIA 35 U.S.C. 103\(c\)](#) and potential [pre-AIA 35 U.S.C. 102\(e\)](#), [\(f\)](#) or [\(g\)](#) prior art under [pre-AIA 35 U.S.C. 103\(a\)](#).

**Examiner Note:**

This paragraph must be used in all applications with joint inventors (unless the claims are clearly restricted to only one claimed invention, e.g., only a single claim is presented in the application).

**¶ 7.20.04.fti Pre-AIA 103(a) Rejection Using Prior Art Under Pre-AIA 102(e), (f), or (g) That Is Attempted To Be Disqualified Under pre-AIA 35 U.S.C. 103(c) Using the Common Ownership or Assignment Provision**

Applicant has attempted to disqualify reference [1] under [pre-AIA 35 U.S.C. 103\(c\)](#) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as [2] at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, the reference is not disqualified as prior art under [pre-AIA 35 U.S.C. 103\(a\)](#). Applicant must file the required submission in order to properly disqualify the reference under [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP § 2146.02](#), subsection II.

In addition, applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore not the invention “by another,” or by antedating the applied art under [37 CFR 1.131\(a\)](#).

**Examiner Note:**

1. This form paragraph must be included in all actions containing rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) where an attempt has been made to disqualify the reference under [pre-AIA 35 U.S.C. 103\(c\)](#), but where the applicant has not provided a

proper statement indicating common ownership or assignment **at the time the invention was made.**

2. In brackets 1 and 2, identify the commonly owned applied art (e.g., patent or co-pending application).

**¶ 7.20.05.fti Pre-AIA 103(a) Rejection Using Prior Art Under Pre-AIA 102(e), (f), or (g) That Is Attempted To Be Disqualified Under Pre-AIA 35 U.S.C. 103(c) Using the Joint Research Agreement Provisions**

Applicant has attempted to disqualify reference [1] under [pre-AIA 35 U.S.C. 103\(c\)](#) by showing that the invention was subject to a joint research agreement at the time this invention was made. However, applicant has failed to [2]. Applicant must file the missing requirements in order to properly disqualify the reference under [pre-AIA 35 U.S.C. 103\(c\)](#). See [37 CFR 1.71\(g\)](#) and [1.104\(c\)](#) and [MPEP § 2146.02](#), subsection III.

In addition, applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention “by another,” or by antedating the applied art under [37 CFR 1.131\(a\)](#).

**Examiner Note:**

1. This form paragraph must be included in all actions containing rejections under [pre-AIA 35 U.S.C. 103\(a\)](#) where an attempt has been made to disqualify the reference under [pre-AIA 35 U.S.C. 103\(c\)](#) using the joint research agreement provisions but the disqualification attempt is ineffective.
2. In bracket 1, identify the reference which is sought to be disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#).
3. In bracket 2, identify the reason(s) why the disqualification attempt is ineffective. The reason(s) could be noncompliance with the statutory requirements of [pre-AIA 35 U.S.C. 103\(c\)](#) or rule requirements relating to the CREATE Act, such as failure to submit the required statement or failure to amend the specification to include the names of the parties to the joint research agreement. See [37 CFR 1.104\(c\)\(5\)\(ii\)](#).

**¶ 7.21.fti Rejection, Pre-AIA 35 U.S.C. 103(a)**

Claim [1] is/are rejected under [pre-AIA 35 U.S.C. 103\(a\)](#) as being unpatentable over [2].

**Examiner Note:**

1. This paragraph must be preceded by either form paragraph 7.20.fti or form paragraph 7.103.
2. An explanation of the rejection must follow this form paragraph. See [MPEP § 2144](#).
3. If the rejection relies upon prior art under [pre-AIA 35 U.S.C. 102\(e\)](#), use [pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act to determine the reference’s prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use [pre-AIPA 35 U.S.C. 102\(e\)](#) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a continuing application claiming



benefit under [35 U.S.C. 120, 121](#) or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's [35 U.S.C. 102\(e\)](#) date.

4. If the applicability of this rejection (e.g., the availability of the prior art as a reference under [pre-AIA 35 U.S.C. 102\(a\)](#) or [pre-AIA 35 U.S.C. 102\(b\)](#)) prevents the reference from being disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#), form paragraph 7.20.01.fti must follow this form paragraph.

5. If this rejection is a provisional [pre-AIA 35 U.S.C. 103\(a\)](#) rejection based upon a copending application that would comprise prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) if patented or published, use form paragraph 7.21.01.fti instead of this paragraph.

6. In bracket 1, insert the claim numbers which are under rejection.

7. In bracket 2, insert the prior art relied upon.

**¶ 7.21.01.fti Provisional Rejection, Pre-AIA 35 U.S.C. 103(a), Common Assignee, Common Applicant, or at Least One Common (Joint) Inventor**

Claim [1] is/are provisionally rejected under [pre-AIA 35 U.S.C. 103\(a\)](#) as being obvious over copending Application No. [2] which has a common [3] with the instant application. The copending application would constitute prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) if published or patented. This provisional rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) is based upon a presumption of future publication or patenting of the copending application. [4]

This provisional rejection might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the copending application was derived from the inventor or joint inventors (i.e., the inventive entity) of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the copending application under [37 CFR 1.131\(a\)](#). This rejection might also be overcome by showing that the copending application is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) as prior art in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#). See [MPEP § 2146](#) et seq.

**Examiner Note:**

1. This paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application that would be prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) to the claimed invention if published or issued as a patent and also has either a common assignee, a common applicant ([35 U.S.C. 118](#)), or at least one common (joint) inventor. This form paragraph should not be used when the copending application is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) as prior art in a [pre-AIA 35 U.S.C. 103\(a\)](#) rejection. See [MPEP § 2146.03\(a\)](#).

2. Use [pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act (AIPA) to determine the copending application's prior art date, unless the copending application is based directly, or indirectly, from an international application which has an international filing date prior to November 29,

2000. If the copending application is either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under [35 U.S.C. 120, 121, 365\(c\)](#), or [386\(c\)](#) to an international application having an international filing date prior to November 29, 2000, use [pre-AIPA 35 U.S.C. 102\(e\)](#) to determine the copending application's prior art date. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's pre-AIA and pre-AIPA 35 U.S.C. 102(e) dates, respectively.

3. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.fti.

4. In bracket 1, insert the claim number(s) which is/are under rejection.

5. In bracket 2, insert the application number.

6. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.

7. In bracket 4, insert an explanation of obviousness. See [MPEP § 2144](#).

8. If the claimed invention is not patentably distinct from the invention claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using form paragraphs 8.33 and 8.37.

9. A rejection should additionally be made under [pre-AIA 35 U.S.C. 103\(a\)](#) using form paragraph 7.21.fti if:

a. evidence indicates that the copending application is also prior art under [pre-AIA 35 U.S.C. 102\(f\)](#) or [\(g\)](#) (e.g., applicant has named the prior inventor in response to a requirement made using form paragraph 8.28.fti); and

b. the copending application has not been disqualified as prior art in a [pre-AIA 35 U.S.C. 103\(a\)](#) rejection pursuant to [pre-AIA 35 U.S.C. 103\(c\)](#).

**¶ 7.21.02.fti Rejection, pre-AIA 35 U.S.C. 103(a), Common Assignee, Common Applicant, or at Least One Common (Joint) Inventor**

Claim [1] is/are rejected under [pre-AIA 35 U.S.C. 103\(a\)](#) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference, it constitutes prior art. This rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) might be overcome by: (1) a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference under [37 CFR 1.131\(a\)](#); or (3) an oath or declaration under [37 CFR 1.131\(c\)](#) stating that the application and reference are currently owned by the same party and that the inventor or joint inventors (i.e., the inventive entity) named in the application is the prior inventor under [pre-AIA 35 U.S.C. 104](#) as in effect on March 15, 2013, together with a terminal



disclaimer in accordance with [37 CFR 1.321\(c\)](#). This rejection might also be overcome by showing that the reference is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) as prior art in a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#). See [MPEP § 2146](#) et seq. [4]

#### Examiner Note:

1. This paragraph is used to reject over a reference (patent or published application) that discloses the claimed invention, and that only qualifies as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#). If the reference qualifies as prior art under [pre-AIA 35 U.S.C. 102\(a\)](#) or (b), then this form paragraph should not be used (form paragraph 7.21.fti should be used instead). The reference must have either a common assignee, a common applicant ([35 U.S.C. 118](#)), or at least one common (joint) inventor. This form paragraph should not be used in applications when the reference is disqualified under [pre-AIA 35 U.S.C. 103\(c\)](#) as prior art in a [pre-AIA 35 U.S.C. 103\(a\)](#) rejection. See [MPEP § 2146.03](#).

2. [Pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) must be applied if the reference is by another and is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application (PCT) if the international application has **an international filing date on or after November 29, 2000**;
- c. a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States. See the Examiner Notes for form paragraph 7.12.fti to assist in the determination of the [pre-AIA 35 U.S.C. 102\(e\)](#) date of the reference.

3. [Pre-AIPA 35 U.S.C. 102\(e\)](#) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01.fti to assist in the determination of the [pre-AIPA 35 U.S.C. 102\(e\)](#) date of the reference.

4. In bracket 1, insert the claim number(s) which is/are under rejection.

5. In bracket 2, insert the prior art reference(s) relied upon for the obviousness rejection.

6. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.

7. In bracket 4, insert an explanation of obviousness. See [MPEP § 2144](#).

#### ¶ 7.22.fti Rejection, pre-AIA 35 U.S.C. 103(a), Further in View Of

Claim [1] rejected under [pre-AIA 35 U.S.C. 103\(a\)](#) as being unpatentable over [2] as applied to claim [3] above, and further in view of [4].

#### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.21.fti.

2. An explanation of the rejection must follow this form paragraph. See [MPEP § 2144](#).

3. If the rejection relies upon prior art under [pre-AIA 35 U.S.C. 102\(e\)](#), use [pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under [35 U.S.C. 120](#), [121](#), [365\(c\)](#) or [386\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination of the reference's [35 U.S.C. 102\(e\)](#) date.

#### ¶ 7.23.fti Test for Obviousness

The factual inquiries for establishing a background for determining obviousness under [pre-AIA 35 U.S.C. 103\(a\)](#) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

#### Examiner Note:

This form paragraph may be used, if appropriate, in response to an argument regarding the applicability of the factors for determining obviousness.

#### ¶ 7.27.fti Rejection, pre-AIA 35 U.S.C. 102 or pre-AIA 103(a)

Claim(s) [1] is/are rejected under [pre-AIA 35 U.S.C. 102](#) ([2]) as anticipated by or, in the alternative, under [pre-AIA 35 U.S.C. 103\(a\)](#) as obvious over [3].

#### Examiner Note:

1. This form paragraph is NOT intended to be commonly used as a substitute for a rejection under [pre-AIA 35 U.S.C. 102](#). In other words, a single rejection under either [pre-AIA 35 U.S.C. 102](#) or [pre-AIA 35 U.S.C. 103\(a\)](#) should be made whenever possible using appropriate form paragraphs 7.15.fti to 7.19.fti, 7.21.fti and 7.22.fti. Examples of circumstances where this paragraph may be used are as follows:

a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under [pre-AIA 35 U.S.C. 102](#) is appropriate and given another interpretation, a rejection under [pre-AIA 35 U.S.C. 103\(a\)](#) is appropriate. See [MPEP §§ 2111 - 2116.01](#) for guidelines on claim interpretation.

b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties

which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See [MPEP §§ 2112 - 2112.02](#).

c. When the reference teaches a small genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under [35 U.S.C. 102](#). See [MPEP §§ 2131.02](#) and [2144.08](#) for more information on anticipation and obviousness of species by a disclosure of a genus.

d. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also [MPEP § 2113](#).

e. When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent of the claimed element and therefore anticipatory, or whether the prior art element is an obvious variant of the claimed element. See [MPEP §§ 2183 - 2184](#).

f. When the ranges disclosed in the reference and claimed by applicant overlap in scope but the reference does not contain a specific example within the claimed range. See the concurring opinion in *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). See [MPEP § 2131.03](#).

2. If the interpretation of the claim(s) renders the claim(s) indefinite, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), 2nd paragraph, may be appropriate.

3. In bracket 1, insert the claim number(s) which is/are under rejection.

4. In bracket 2, insert the appropriate paragraph letter(s) in parenthesis.

5. In bracket 3, insert the prior art reference relied upon for the rejection.

6. A full explanation should follow this form paragraph.

7. If the rejection relies upon prior art under [pre-AIA 35 U.S.C. 102\(e\)](#), use [pre-AIA 35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act (AIPA) to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use [pre-AIPA 35 U.S.C. 102\(e\)](#) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under [35 U.S.C. 120](#), [121](#) or [365\(c\)](#), or [386\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12.fti and 7.12.01.fti to assist in the determination

of the reference's pre-AIA and pre-AIPA [35 U.S.C. 102\(e\)](#) dates, respectively.

8. This form paragraph must be preceded by 7.07.fti, one or more of form paragraphs 7.08.fti to 7.14.fti as appropriate, and form paragraph 7.20.fti or by form paragraph 7.103.

9. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

## 2149 [Reserved]

## 2150 Examination Guidelines for 35 U.S.C. 102 and 103 as Amended by the First Inventor To File Provisions of the Leahy-Smith America Invents Act [R-11.2013]

[Editor Note: See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]

Continued Applicability of [pre-AIA 35 U.S.C. 102](#) and [103](#): The Leahy-Smith America Invents Act (AIA) revised [35 U.S.C. 102](#) and thereby, the standard to determine what prior art is available during examination of an application. See Public Law 112-29, 125 Stat. 284 (2011). The changes to [35 U.S.C. 102](#) and [103](#) in the AIA do not apply to any application filed before March 16, 2013. Thus, any application filed before March 16, 2013, is governed by [pre-AIA 35 U.S.C. 102](#) and [103](#) (i.e., the application is a pre-AIA (first to invent) application (hereinafter "pre-AIA application")). Note that neither the filing of a request for continued examination, nor entry into the national stage under [35 U.S.C. 371](#), constitutes the filing of a new application. Accordingly, even if a request for continued examination under [37 CFR 1.114](#) is filed on or after March 16, 2013, in an application that was filed before March 16, 2013, the application remains subject to [pre-AIA 35 U.S.C. 102](#) and [103](#). Submission of an amendment including a claim that includes new matter on or after March 16, 2013, also does not affect an application's status as a pre-AIA application. See [35 U.S.C. 132\(a\)](#). Similarly, a PCT application filed under [35 U.S.C. 363](#) before March 16, 2013, is subject to [pre-AIA 35 U.S.C. 102](#) and

[103](#), regardless of whether the application enters the national stage under [35 U.S.C. 371](#) before or after March 16, 2013. Applications filed on or after March 16, 2013 are also subject to [pre-AIA 35 U.S.C. 102](#) if the application has never contained a claim with an effective filing date on or after March 16, 2013 and has never claimed the benefit of an application that ever contained such a claim. [MPEP §§ 2131-2138](#) provide examination guidance on the prior art available in the examination of applications subject to [pre-AIA 35 U.S.C. 102](#).

## **2151 Overview of the Changes to 35 U.S.C. 102 and 103 in the AIA [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

After the AIA, [35 U.S.C. 102](#) continues to set forth the scope of prior art that will preclude the grant of a patent on a claimed invention, but revises what qualifies as prior art. Specifically, [AIA 35 U.S.C. 102\(a\)\(1\)](#) and [\(a\)\(2\)](#) set forth what qualifies as prior art. [AIA 35 U.S.C. 102\(a\)\(1\)](#) provides that a person is not entitled to a patent if the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. [AIA 35 U.S.C. 102\(a\)\(2\)](#) provides that a person is not entitled to a patent if the claimed invention was described in a patent issued under [35 U.S.C. 151](#), or in an application for patent published or deemed published under [35 U.S.C. 122\(b\)](#), in which the patent or application, as the case may be, names another inventor, and was effectively filed before the effective filing date of the claimed invention. [AIA 35 U.S.C. 102\(b\)](#) sets forth exceptions to prior art established in [AIA 35 U.S.C. 102\(a\)](#). Specifically, [AIA 35 U.S.C. 102\(b\)\(1\)](#) sets forth exceptions to prior art established in [AIA 35 U.S.C. 102\(a\)\(1\)](#), and [AIA 35 U.S.C. 102\(b\)\(2\)](#) sets forth exceptions to prior art established in [AIA 35 U.S.C. 102\(a\)\(2\)](#).

The AIA also provides definitions in [35 U.S.C. 100](#) of the meaning of the terms “claimed invention,” “effective filing date,” “inventor,” and “joint inventor” (or “coinventor”). The AIA defines the term “claimed invention” in [35 U.S.C. 100\(j\)](#) as the subject matter defined by a claim in a patent or an application for a patent. The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) in [35 U.S.C. 100\(i\)\(1\)](#) as meaning the earlier of: (1) The actual filing date of the patent or the application for the patent containing the claimed invention; or (2) the filing date of the earliest provisional, nonprovisional, international (PCT), or foreign patent application to which the patent or application is entitled to benefit or priority as to such claimed invention. The AIA defines the term “inventor” in [35 U.S.C. 100\(f\)](#) as the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention, and in [35 U.S.C. 100\(g\)](#) defines the term “joint inventor” and “coinventor” to mean any one of the individuals who invented or discovered the subject matter of a joint invention.

As discussed previously, [AIA 35 U.S.C. 102\(a\)\(1\)](#) provides that a person is not entitled to a patent if the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. Under [pre-AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#), knowledge or use of the invention ([pre-AIA 35 U.S.C. 102\(a\)](#)), or public use or sale of the invention ([pre-AIA 35 U.S.C. 102\(b\)](#)), was required to be in the United States to qualify as a prior art activity. Under the AIA, a prior public use, sale activity, or other disclosure has no geographic requirement (i.e., need not be in the United States) to qualify as prior art.

[AIA 35 U.S.C. 102\(b\)\(1\)](#) provides that certain disclosures made one year or less before the effective filing date of a claimed invention shall not be prior art under [35 U.S.C. 102\(a\)\(1\)](#) with respect to the claimed invention if: (1) The disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor

or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Thus, [AIA 35 U.S.C. 102\(b\)\(1\)](#) effectively provides a one-year grace period (grace period) after a first inventor-originated disclosure of an invention (i.e., a disclosure by an inventor or joint inventor, or another who obtained directly or indirectly from the inventor or a joint inventor) within which the inventor, assignee, obligated assignee, or other party having sufficient interest may file a patent application which is not subject to such disclosure and certain other disclosures as prior art. The one-year grace period in [AIA 35 U.S.C. 102\(b\)\(1\)](#) is measured from the filing date of the earliest U.S. or foreign patent application to which a proper benefit or priority claim to such invention has been asserted in the patent or application and the earlier application supports the claimed invention in the manner required by [35 U.S.C. 112\(a\)](#). Under [pre-AIA 35 U.S.C. 102\(b\)](#), the one-year grace period is measured from the filing date of the earliest application filed in the United States (directly or through the PCT) and not from the dates of earlier filed foreign patent applications. Similar to [pre-AIA 35 U.S.C. 102\(b\)](#), the one-year grace period in [AIA 35 U.S.C. 102\(b\)\(1\)](#) is extended to the next succeeding business day if the end of the one-year grace period otherwise falls on a Saturday, Sunday, or federal holiday. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) and [35 U.S.C. 21\(b\)](#). The provisions of [35 U.S.C. 21\(b\)](#) still apply notwithstanding the provisions of [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which accord a filing date as of the date of deposit as Priority Mail Express<sup>®</sup> with the U.S. Postal Service, and [37 CFR 1.6\(a\)\(4\)](#), which accords a filing date as of the date of submission using the USPTO patent electronic filing system. See also [MPEP §§ 2153.01\(a\)](#) and [2153.02](#).

The date of invention is not relevant under [AIA 35 U.S.C. 102](#). Thus, a prior art disclosure could not be antedated by showing that the inventor invented the claimed invention prior to the effective date of the prior art disclosure of the subject matter (e.g., under the provisions of [37 CFR 1.131](#)).

As discussed previously, [AIA 35 U.S.C. 102\(a\)\(2\)](#) provides that a person is not entitled to a patent if the claimed invention was described in a U.S. patent,

a U.S. patent application publication, or an application for patent deemed published under [35 U.S.C. 122\(b\)](#) (collectively referred to as “U.S. patent documents”), that names another inventor and was effectively filed before the effective filing date of the claimed invention. Under [35 U.S.C. 374](#), a World Intellectual Property Organization (WIPO) publication of a Patent Cooperation Treaty (PCT) international application that designates the United States is an application for patent deemed published under [35 U.S.C. 122\(b\)](#) for purposes of [AIA 35 U.S.C. 102\(a\)\(2\)](#). Thus, under the AIA, WIPO publications of PCT applications that designate the United States are treated as U.S. patent application publications for prior art purposes, regardless of the international filing date, whether they are published in English, or whether the PCT international application enters the national stage in the United States. Accordingly, a WIPO publication of a PCT application (WIPO published application) that designates the United States, a U.S. patent, or a U.S. patent application publication that names another inventor and was effectively filed before the effective filing date of the claimed invention, is prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). Under [pre-AIA 35 U.S.C. 102\(e\)](#), a WIPO published application designating the United States is treated as a U.S. patent application publication only if the PCT application was filed on or after November 29, 2000, and published under [PCT Article 21\(2\)](#) in the English language. See [MPEP § 2136.03](#), subsection III.

[AIA 35 U.S.C. 102\(d\)](#) defines “effectively filed” for the purpose of determining whether a particular U.S. patent document is prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) to a claimed invention. A U.S. patent document is considered to have been effectively filed for purposes of its prior art effect under [35 U.S.C. 102\(a\)\(2\)](#) with respect to any subject matter it describes on the earlier of: (1) The actual filing date of the patent or the application for patent; or (2) if the patent or application for patent is entitled to claim the benefit of, or priority to, the filing date of an earlier U.S. provisional, U.S. nonprovisional, international (PCT), or foreign patent application, the filing date of the earliest such application that describes the subject matter of the claimed invention. Thus, a U.S. patent document is effective as prior art as of the filing date of the earliest application to which benefit or priority is claimed and which



describes the subject matter relied upon, regardless of whether the earliest such application is a U.S. provisional or nonprovisional application, an international (PCT) application, or a foreign patent application.

[AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) and [\(B\)](#) provide that a disclosure shall not be prior art to a claimed invention under [35 U.S.C. 102\(a\)\(2\)](#) if: (1) The subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such subject matter was effectively filed under [35 U.S.C. 102\(a\)\(2\)](#), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Thus, under the AIA, a U.S. patent document that was not issued or published more than one year before the effective filing date of the claimed invention is not prior art to the claimed invention if: (1) The U.S. patent document was by another who obtained the subject matter disclosed from the inventor or a joint inventor; or (2) the inventor or a joint inventor, or another who obtained the subject matter disclosed from an inventor or joint inventor, had publicly disclosed the subject matter before the [35 U.S.C. 102\(d\)](#) (“effectively filed”) date of the U.S. patent document.

Additionally, [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) provides that a disclosure made in a U.S. patent document shall not be prior art to a claimed invention under [35 U.S.C. 102\(a\)\(2\)](#) if, not later than the effective filing date of the claimed invention, the subject matter disclosed and the claimed invention were owned by the same person or subject to an obligation of assignment to the same person. This provision replaces the exception in [pre-AIA 35 U.S.C. 103\(c\)](#) that applied only in the context of an obviousness analysis under [35 U.S.C. 103\(a\)](#) to prior art that was commonly owned at the time the claimed invention was made, and which qualified as prior art only under [pre-AIA 35 U.S.C. 102\(e\)](#), [\(f\)](#), and/or [\(g\)](#). Thus, the AIA provides that certain prior patents and published patent applications of co-workers and collaborators are not prior art either for purposes of determining novelty ([35 U.S.C. 102](#)) or nonobviousness ([35 U.S.C. 103](#)). This exception, however, only removes disclosures as prior art under

[AIA 35 U.S.C. 102\(a\)\(2\)](#), namely, U.S. patent documents that were not published before, but that were effectively filed before, the effective filing date of the claimed invention. This exception is not effective to except prior art that is also available under [35 U.S.C. 102\(a\)\(1\)](#), that is, patents, printed publications, public uses, sale activities, or other publicly available disclosures published or occurring before the effective filing date of the claimed invention. A prior disclosure, as defined in [AIA 35 U.S.C. 102\(a\)\(1\)](#), by a co-worker or collaborator is prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) unless it falls within an exception under [AIA 35 U.S.C. 102\(b\)\(1\)](#), regardless of whether the subject matter of the prior disclosure and the claimed invention was commonly owned not later than the effective filing date of the claimed invention.

The AIA eliminates the provisions in [pre-AIA 35 U.S.C. 102\(c\)](#) (abandonment of the invention), [102\(d\)](#) (premature foreign patenting), [102\(f\)](#) (derivation), and [102\(g\)](#) (prior invention by another, but see below for discussion of continued limited applicability). Under the AIA, abandonment of the invention or premature foreign patenting is not relevant to patentability. Prior invention by another is likewise not relevant to patentability under the AIA unless there is a prior disclosure or filing of an application by another. A situation in which an application names a person who is not the actual inventor as the inventor ([pre-AIA 35 U.S.C. 102\(f\)](#)) will be handled in a derivation proceeding under [35 U.S.C. 135](#), by a correction of inventorship under [37 CFR 1.48](#) to name the actual inventor, or through a rejection under [35 U.S.C. 101](#) and [35 U.S.C. 115](#). See [MPEP § 2157](#).

[AIA 35 U.S.C. 102\(c\)](#) provides for deemed common ownership of subject matter made pursuant to joint research agreements. Under [35 U.S.C. 100\(h\)](#), the term “joint research agreement” as used in [AIA 35 U.S.C. 102\(c\)](#) is defined as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. [AIA 35 U.S.C. 102\(c\)](#) specifically provides that subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person



in applying the provisions of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) if: (1) The subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention; (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

[AIA 35 U.S.C. 103](#) provides that a patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in [35 U.S.C. 102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. In addition, [AIA 35 U.S.C. 103](#) provides that patentability shall not be negated by the manner in which the invention was made. This provision tracks [pre-AIA 35 U.S.C. 103\(a\)](#), except that the temporal focus for the obviousness inquiry is before the effective filing date of the claimed invention, rather than at the time of the invention. The provisions of [pre-AIA 35 U.S.C. 103\(c\)](#) have been replaced with [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [\(c\)](#), and the provisions of [pre-AIA 35 U.S.C. 103\(b\)](#) pertaining to biotechnological processes have been eliminated.

[AIA 35 U.S.C. 102](#) and [103](#) took effect on March 16, 2013. These provisions apply to any patent application that contains or contained at any time: (1) a claim to a claimed invention that has an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is on or after March 16, 2013; or (2) a designation as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013. Such an application is referred to as an AIA (first inventor to file) application (hereinafter “AIA application”). [AIA 35 U.S.C. 102](#) and [103](#) also apply to any patent resulting from an AIA application. See Public Law 112-29,

§ 3(n)(1), 125 Stat. at 293. See also [MPEP § 2159 et seq.](#) for guidance in determining whether an application is subject to [AIA 35 U.S.C. 102](#) and [103](#).

The AIA provides that the provisions of [pre-AIA 35 U.S.C. 102\(g\)](#) apply to each claim of an AIA application for patent if the patent application: (1) contains or contained at any time a claim to a claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claim to a claimed invention that has an effective filing date before March 16, 2013. Public Law 112-29, § 3(n)(2), 125 Stat. at 293. [Pre-AIA 35 U.S.C. 102\(g\)](#) also applies to any patent resulting from an AIA application to which [pre-AIA 35 U.S.C. 102\(g\)](#) applied. See [MPEP § 2138](#) for guidance on application of [pre-AIA 35 U.S.C. 102\(g\)](#) and form paragraph 7.14.aia.

If an application (1) contains or contained at any time a claimed invention having an effective filing date that is before March 16, 2013, or ever claimed the benefit of an earlier filing date under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) based upon an earlier application that ever contained a claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is before March 16, 2013, and (2) also contains or contained at any time any claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is on or after March 16, 2013, or ever claimed the benefit of an earlier filing date under [35 U.S.C. 119](#), [120](#), [121](#), [365](#) or [386](#) based upon an earlier application that ever contained a claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is on or after March 16, 2013, then [AIA 35 U.S.C. 102](#) and [103](#) apply to the application, and each claimed invention in the application is also subject to [pre-AIA 35 U.S.C. 102\(g\)](#).

## **2152 Detailed Discussion of AIA 35 U.S.C. 102(a) and (b) [R-11.2013]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et](#)*

*seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2131-MPEP § 2138 for examination of applications subject to pre-AIA 35 U.S.C. 102.]*

[AIA 35 U.S.C. 102\(a\)](#) defines the prior art that will preclude the grant of a patent on a claimed invention unless an exception in [AIA 35 U.S.C. 102\(b\)](#) is applicable. Specifically, [AIA 35 U.S.C. 102\(a\)](#) provides that:

[a] person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under [section 151](#), or in an application for patent published or deemed published under [section 122\(b\)](#), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

As an initial matter, Office personnel should note that the introductory phrase “[a] person shall be entitled to a patent unless” remains unchanged from the pre-AIA version of [35 U.S.C. 102](#). Thus, [35 U.S.C. 102](#) continues to provide that the Office bears the initial burden of explaining why the applicable statutory or regulatory requirements have not been met if a claim in an application is to be rejected. The AIA also does not change the requirement that whenever a claim for a patent is rejected or an objection or requirement is made, the Office shall notify the applicant thereof and state the reasons for such rejection, objection, or requirement, and provide such information and references as may be useful to the applicant in judging of the propriety of continuing the prosecution of the application. See [35 U.S.C. 132](#), [37 CFR 1.104\(c\)](#) and [MPEP § 706](#).

The categories of prior art documents and activities are set forth in [AIA 35 U.S.C. 102\(a\)\(1\)](#) and the categories of prior art patent documents are set forth in [AIA 35 U.S.C. 102\(a\)\(2\)](#). These documents and activities are used to determine whether a claimed

invention is novel or nonobvious. The documents upon which a prior art rejection under [35 U.S.C. 102\(a\)\(1\)](#) may be based are an issued patent, a published application, and a non-patent printed publication. The documents upon which a prior art rejection under [35 U.S.C. 102\(a\)\(2\)](#) may be based are U.S. patent documents only (see discussion of U.S. patent documents in [MPEP § 2151](#)). Evidence that the claimed invention was in public use, on sale, or otherwise available to the public may also be used as the basis for a prior art rejection under [35 U.S.C. 102\(a\)\(1\)](#). Note that a printed publication that does not have a sufficiently early publication date to itself qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) may be competent evidence of a previous public use, sale activity, or other availability of a claimed invention to the public where the public use, sale activity, or other public availability does have a sufficiently early date to qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). See *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) and [MPEP § 2133.03\(b\)](#), subsection III.C.

[AIA 35 U.S.C. 102\(b\)](#) sets out exceptions to [AIA 35 U.S.C. 102\(a\)](#), in that prior art that otherwise would be included in [AIA 35 U.S.C. 102\(a\)](#) shall not be prior art if it falls within an exception under [AIA 35 U.S.C. 102\(b\)](#).

Exceptions to the categories of prior art defined in [AIA 35 U.S.C. 102\(a\)\(1\)](#) are provided in [AIA 35 U.S.C. 102\(b\)\(1\)](#). Specifically, [AIA 35 U.S.C. 102\(b\)\(1\)](#) states that “[a] disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

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

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

Exceptions to the categories of prior art defined in [AIA 35 U.S.C. 102\(a\)\(2\)](#) are provided in [AIA 35 U.S.C. 102\(b\)\(2\)](#). Specifically, [AIA 35 U.S.C.](#)

[102\(b\)\(2\)](#) states that “[a] disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.”

Although some of the provisions of [AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#) are similar to [pre-AIA 35 U.S.C. 102\(a\)](#), [\(b\)](#), and [\(e\)](#), the AIA has introduced a number of important changes with respect to prior art documents and activities (collectively, “disclosures”). First, the availability of a U.S. patent document as prior art to a claimed invention is measured from the effective filing date of the claimed invention as defined in [35 U.S.C. 100\(i\)](#), which takes into account both foreign priority and domestic benefit dates. Note that this differs from practice under [pre-AIA 35 U.S.C. 102](#) wherein the availability of a patent document as prior art is measured from either “the date of the application for patent in the United States” ([pre-AIA 35 U.S.C. 102\(b\)](#)) or “the invention thereof by the applicant for patent” ([pre-AIA 35 U.S.C. 102\(a\)](#) and [\(e\)](#)). Second, the AIA adopts a global view of prior art disclosures and thus does not require that a public use or sale activity be “in this country” to be a prior art activity. Finally, a catch-all “otherwise available to the public” category of prior art is added.

## 2152.01 Effective Filing Date of the Claimed Invention [R-07.2022]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject*

*to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[Pre-AIA 35 U.S.C. 102\(a\)](#) and [\(e\)](#) reference patent-defeating activities occurring before the inventor invented the claimed invention. [AIA 35 U.S.C. 102\(a\)\(1\)](#) and [\(a\)\(2\)](#) make no mention of the date of the invention, but instead concern documents that existed or activities that occurred “before the effective filing date of the claimed invention.” As a result, it is no longer possible to antedate or “swear behind” certain prior art disclosures by making a showing under [37 CFR 1.131](#) that the inventor invented the claimed subject matter prior to the effective date of the prior art disclosure.

The AIA defines the term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent) as the earliest of: (1) the actual filing date of the patent or the application for the patent containing the claimed invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under [35 U.S.C. 119](#), [120](#), [121](#), [365](#), or [386](#). See [35 U.S.C. 100\(i\)\(1\)](#).

In examining applications subject to [AIA 35 U.S.C. 102](#), the effective filing date of a claimed invention is the actual filing date of the U.S. application, unless situation (A), (B), (C), or (D) as set forth below applies. Note that the actual filing date of an application that entered the national stage under [35 U.S.C. 371](#) is the international filing date (see [35 U.S.C. 363](#) and [MPEP § 1893.03\(b\)](#)); the actual the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (in the absence of a petition for review)(see [37 CFR 1.1023](#) and [MPEP § 2908](#)).

(A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of [35 U.S.C. 120](#), [365\(c\)](#), or [386\(c\)](#) have been satisfied, the effective filing date of a claimed invention is the same as the earliest filing date in the line of continuation or divisional applications.

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the actual filing date of the new application. Any claims which are fully supported under [35 U.S.C. 112](#) by the earlier parent application have the effective filing date of that earlier parent application.

(C) If the application properly claims benefit under [35 U.S.C. 119\(e\)](#) to a provisional application, the effective filing date of a claimed invention is the filing date of the provisional application for any claims which are fully supported under [35 U.S.C. 112](#) by the provisional application.

(D) If the application properly claims foreign priority under [35 U.S.C. 119\(a\)-\(d\)](#), [365\(a\) or \(b\)](#), or [386\(a\) or \(b\)](#), the effective filing date of a claimed invention is the filing date of the foreign priority document if the claim is adequately supported in the foreign priority document. See [MPEP §§ 216](#) and [2152.06](#).

See [MPEP § 1893.03\(c\)](#) for a discussion of claims for priority to, or the benefit of, the filing date of a prior-filed foreign or domestic application in an application that entered the national stage under [35 U.S.C. 371](#). See [MPEP §§ 211.01\(c\)](#) and [1895](#) for additional information on determining the effective filing date of a claimed invention in a continuation, divisional, or continuation-in-part of a PCT application designating the United States. See also [MPEP §§ 1895.01](#) and [1896](#) which discuss differences between applications filed under [35 U.S.C. 111\(a\)](#) and international applications that enter national stage under [35 U.S.C. 371](#).

See [MPEP §§ 2920.05\(d\)](#) and [2920.05\(e\)](#) for a discussion of claims for priority to, or the benefit of, the filing date of a prior-filed foreign or domestic application in international design applications.

The one-year grace period (as defined in [MPEP § 2151](#)) in [AIA 35 U.S.C. 102\(b\)\(1\)](#) is measured from the filing date of any U.S. or foreign patent application to which the patent or application is entitled to benefit or priority as to such invention, whereas the one-year grace period in [pre-AIA 35 U.S.C. 102\(b\)](#) is measured from only the filing date

of the earliest application filed in the United States (directly or through the PCT).

As under pre-AIA law, the effective filing date of a claimed invention is determined on a claim-by-claim basis and not an application-by-application basis. That is, the principle that different claims in the same application may be entitled to different effective filing dates vis-à-vis the prior art remains unchanged by the AIA. See [MPEP § 2133.01](#) for a discussion of relevant pre-AIA case law in the context of continuation-in-part applications. However, it is important to note that although prior art is applied on a claim-by-claim basis, the determination of whether [pre-AIA 35 U.S.C. 102](#) and [35 U.S.C. 103](#) or [AIA 35 U.S.C. 102](#) and [103](#) apply is made on an application-by-application basis. [MPEP § 2151](#) and [MPEP § 2159](#) discuss the applicability date provisions of section 3 of the AIA.

Finally, the AIA provides that the “effective filing date” for a claimed invention in a reissued patent or application for a reissue patent shall be determined by deeming the claim to the claimed invention to have been contained in the patent for which reissue was sought. See [35 U.S.C. 100\(i\)\(2\)](#).

## **2152.02 Prior Art Under AIA 35 U.S.C. 102(a)(1) (Patented, Described in a Printed Publication, or in Public Use, on Sale, or Otherwise Available to the Public) [R-08.2017]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

Prior art documents and activities which may preclude patentability are set forth in [AIA 35 U.S.C. 102\(a\)\(1\)](#). Such documents and activities include prior patenting of the claimed invention, descriptions of the claimed invention in a printed publication, public use of the claimed invention, placing the claimed invention on sale, and otherwise making the



claimed invention available to the public. [MPEP §§ 2152.02\(a\)–2152.02\(f\)](#) discuss each prior art document and activity that might preclude patentability under AIA in turn. [35 U.S.C. 102\(a\)\(1\)](#)

### 2152.02(a) Patented [R-11.2013]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131–MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

[AIA 35 U.S.C. 102\(a\)\(1\)](#) indicates that a prior patent of a claimed invention will preclude the grant of a subsequent patent on the claimed invention. This means that if a claimed invention was patented in this or a foreign country before the effective filing date of the claimed invention, [AIA 35 U.S.C. 102\(a\)\(1\)](#) precludes the grant of a patent on the claimed invention. The effective date of the patent for purposes of determining whether the patent qualifies as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) is the grant date of the patent. There is an exception to this rule if the patent is secret as of the date the rights are awarded. See *In re Ekenstam*, 256 F.2d 321, 323, 118 USPQ 349, 353 (CCPA 1958); see also [MPEP § 2126.01](#). In such situations, the patent is available as prior art as of the date the patent was made available to the public by being laid open for public inspection or disseminated in printed form. See *In re Carlson*, 983 F.2d 1032, 1037, 25 USPQ2d 1207 (Fed. Cir. 1992); see also [MPEP § 2126](#). The phrase “patented” in [AIA 35 U.S.C. 102\(a\)\(1\)](#) has the same meaning as “patented” in [pre-AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#). For a discussion of “patented” as used in [pre-AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#), see generally [MPEP § 2126](#).

Although an invention may be described in a patent and not claimed therein, the grant date would also be the applicable prior art date for purposes of relying on the subject matter disclosed therein as “described in a printed publication,” provided that the patent was made available to the public on its grant date. Note that a U.S. patent that issues after the effective filing date of a claimed invention and

is not available as prior art against that invention under [AIA 35 U.S.C. 102\(a\)\(1\)](#) could be available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#).

### 2152.02(b) Described in a Printed Publication [R-11.2013]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131–MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

If a claimed invention is described in a patent, published patent application, or printed publication, such a document may be available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). Both [pre-AIA 35 U.S.C. 102\(a\)](#) and [\(b\)](#) and [AIA 35 U.S.C. 102\(a\)\(1\)](#) use the term “described” with respect to an invention in a prior art printed publication. Likewise, [AIA 35 U.S.C. 102\(a\)\(2\)](#) uses that term with respect to U.S. patents, U.S. patent application publications, and WIPO published applications. Thus, the Office does not view the AIA as changing the extent to which a claimed invention must be described for a prior art document to anticipate the claimed invention under [35 U.S.C. 102](#).

While the conditions for patentability of [AIA 35 U.S.C. 112\(a\)](#) require a written description of the claimed invention that would have enabled a person skilled in the art to make as well as use the invention, the prior art provisions of [AIA 35 U.S.C. 102\(a\)\(1\)](#) and [\(a\)\(2\)](#) require only that the claimed invention is “described” in a prior art document (patent, published patent application, or printed publication). The two basic requirements that must be met by a prior art document in order to describe a claimed invention such that it is anticipated under [AIA 35 U.S.C. 102](#) are the same as those under [pre-AIA 35 U.S.C. 102](#). First, “each and every element of the claimed invention” must be disclosed either explicitly or inherently, and the elements must be “arranged or combined in the same way as in the claim.” See *In re Gleave*, 560 F.3d 1331, 1334, 90 USPQ2d 1235, 1237-38 (Fed. Cir. 2009), citing *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471



F.3d 1369, 1375, 81 USPQ2d 1324,1328 (Fed. Cir. 2006); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008); *In re Bond*, 910 F.2d 831, 832-33, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Second, a person of ordinary skill in the art must have been enabled to make the invention without undue experimentation. See *Gleave*, 560 F.3d at 1334, 90 USPQ2d at 1238 (citing *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314, 88 USPQ2d 1381, 1383 (Fed. Cir. 2008), and *In re LeGrice*, 301 F.2d 929, 940-44, 133 USPQ 365, 372 (CCPA 1962)). Thus, in order for a prior art document to describe a claimed invention such that it is anticipated under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [\(a\)\(2\)](#), it must disclose all elements of the claimed invention arranged as they are in the claim, and also provide sufficient guidance to enable a person skilled in the art to make the claimed invention. There is, however, no requirement that a prior art document meet the “how to use” requirement of [35 U.S.C. 112\(a\)](#) in order to qualify as prior art. See *Gleave*, 560 F.3d at 1334, 90 USPQ2d at 1237-38; see also *In re Schoenwald*, 964 F.2d 1122, 1124, 22 USPQ2d 1671, 1673 (Fed. Cir. 1992) (holding that a claimed compound was anticipated even though the prior art reference did not disclose a use for the compound); *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1380-81, 67 USPQ2d 1664, 1670 (Fed. Cir. 2003) (pointing out that actually reducing the invention to practice is not necessary in order for a prior art reference to anticipate); *Impax Labs*, 468 F.3d at 1382 (stating that “proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation”). Furthermore, compliance with the “how to make” requirement is judged from the viewpoint of a person of ordinary skill in the art, and thus does not require that the prior art document explicitly disclose information within the knowledge of such a person. See *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).

There is an additional important distinction between the written description that is necessary to support a claim under [35 U.S.C. 112\(a\)](#) and the description sufficient to anticipate the subject matter of the claim under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [\(a\)\(2\)](#). See *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 75 USPQ2d 1297 (Fed. Cir. 2005). To provide support for a claim under [35 U.S.C. 112\(a\)](#), it is

necessary that the specification describe and enable the entire scope of the claimed invention. However, in order for a prior art document to describe a claimed invention under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [\(a\)\(2\)](#), the prior art document need only describe and enable one skilled in the art to make a single species or embodiment of the claimed invention. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (“As the court pointed out, ‘the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes..., whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure.’”) (quoting *In re Lukach*, 442 F.2d 967, 970, 169 USPQ 795, 797 (CCPA 1971)); see also *In re Van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972), and *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958).

An anticipatory description it is not required in order for a disclosure to qualify as prior art, unless the disclosure is being used as the basis for an anticipation rejection. In accordance with pre-AIA case law concerning obviousness, a disclosure may be cited for all that it would reasonably have made known to a person of ordinary skill in the art. Thus, the description requirement of [AIA 35 U.S.C. 102\(a\)\(1\)](#) and [\(a\)\(2\)](#) does not preclude an examiner from applying a disclosure in an obviousness rejection under [AIA 35 U.S.C. 103](#) simply because the disclosure is not adequate to anticipate the claimed invention.

### **2152.02(c) In Public Use [R-07.2022]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

Public use rejections under [35 U.S.C. 102\(a\)\(1\)](#) may be based on uses that are public anywhere in the world. While there is no requirement that the use or

sale activity be by another, it should be noted that certain uses or sales are subject to the exceptions in [35 U.S.C. 102\(b\)\(1\)](#), e.g., uses or sales by the inventor or a joint inventor (or have originated with the inventor) that precede the effective filing date by less than one year. See [MPEP § 2154.02](#).

Under [pre-AIA 35 U.S.C. 102\(b\)](#), an invention that was “in public use” precluded the grant of a patent only if such public use occurred “in this country.” See [MPEP § 2133.03\(d\)](#).

Under [AIA 35 U.S.C. 102\(a\)\(1\)](#), there is no geographic limitation on where prior public use or public availability occurs. Furthermore, a public use would need to occur before the effective filing date of the claimed invention to constitute prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#).

The pre-AIA case law also indicates that a public use will bar patentability if the public use occurs before the critical date and the invention is ready for patenting. Under [pre-AIA 35 U.S.C. 102\(b\)](#), the critical date is the date that is one year prior to the date of application for patent in the United States. See *Invitrogen Corp. v. Biocrest Manufacturing, L.P.*, 424 F.3d 1374, 1379-80, 76 USPQ2d 1741, 1744 (Fed. Cir. 2005) and [MPEP § 2133](#). Under [pre-AIA 35 U.S.C. 102\(b\)](#), the uses of an invention before the patent's critical date that constitute a “public use” fall into two categories: the use either “(1) was accessible to the public; or (2) was commercially exploited.” See *American Seating Co. v. USSC Group, Inc.*, 514 F.3d 1262, 1267, 85 USPQ2d 1683, 1685 (Fed. Cir. 2008) and [MPEP § 2133.03\(a\)](#). Whether a use is a [pre-AIA 35 U.S.C. 102\(b\)](#) public use also depends on who is making the use of the invention. “[W]hen an asserted prior use is not that of the applicant, [\[pre-AIA 35 U.S.C.\] 102\(b\)](#) is not a bar when that prior use or knowledge is not available to the public.” See *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371, 47 USPQ2d 1363, 1366 (Fed. Cir. 1998). In other words, a use by a third party who did not obtain the invention from the inventor named in the application or patent is an invalidating use under [pre-AIA 35 U.S.C. 102\(b\)](#) only if it falls into the first category: That the use was accessible to the public. See [MPEP § 2133.03\(a\)](#), subsection II.C. On the other hand, “an inventor's own prior commercial use, albeit kept

secret, may constitute a public use or sale under [\[pre-AIA 35 U.S.C.\] 102\(b\)](#), barring him from obtaining a patent.” See *Woodland Trust*, 148 F.3d at 1370, 47 USPQ2d at 1366 and [MPEP § 2133.03\(a\)](#), subsection II.A. Also, an inventor creates a public use bar under [pre-AIA 35 U.S.C. 102\(b\)](#) when the inventor shows the invention to, or allows it to be used by, another person who is “under no limitation, restriction, or obligation of confidentiality” to the inventor. See *American Seating*, 514 F.3d at 1267, 85 USPQ2d at 1685 and [MPEP § 2133.03\(a\)](#), subsection II.B.

Further, under [pre-AIA 35 U.S.C. 102\(a\)](#), “in order to invalidate a patent based on prior knowledge or use” by another in this country prior to the patent's priority date, “that knowledge or use must have been available to the public.” See *Woodland Trust*, 148 F.3d at 1370, 47 USPQ2d at 1366 and [MPEP § 2132](#), subsection I. Patent-defeating “use,” under [pre-AIA 35 U.S.C. 102\(a\)](#) includes only that “use which is accessible to the public.” See *id.* (quoting *Carella v. Starlight Archery*, 804 F.2d 135, 139, 231 USPQ 644, 646 (Fed. Cir. 1986)).

As discussed previously, public use under [AIA 35 U.S.C. 102\(a\)\(1\)](#) is limited to those uses that are available to the public. The public use provision of [AIA 35 U.S.C. 102\(a\)\(1\)](#) thus has the same substantive scope, with respect to uses by either the inventor or a third party, as public uses under [pre-AIA 35 U.S.C. 102\(b\)](#) by unrelated third parties or others under [pre-AIA 35 U.S.C. 102\(a\)](#).

As also discussed previously, once an examiner becomes aware that a claimed invention has been the subject of a potentially public use, the examiner should require the applicant to provide information showing that the use did not make the claimed process accessible to the public.

## 2152.02(d) On Sale [R-07.2022]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2133.03](#) et seq. for information about on*

*sale in regard to applications subject to [pre-AIA 35 U.S.C. 102](#).*]

On sale rejections under [35 U.S.C. 102\(a\)\(1\)](#) may be based on sales or offers for sale without regard to where the sale activity took place. While there is no requirement that the sale activity be by another, it should be noted that certain uses or sales are subject to the exceptions in [35 U.S.C. 102\(b\)\(1\)](#), e.g., uses or sales by the inventor or a joint inventor (or have originated with the inventor) that precede the effective filing date by less than one year. See [MPEP § 2154.02](#).

The pre-AIA case law indicates that on sale activity will bar patentability if the claimed invention was: (1) the subject of a commercial sale or offer for sale, not primarily for experimental purposes; and (2) ready for patenting. See *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998). Contract law and commercial law principles apply in order to determine whether a commercial sale or offer for sale occurred. *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1373, 119 USPQ2d 1329, 1336 (Fed. Cir. 2016) (*en banc*). In addition, the enablement inquiry is not applicable to the question of whether a claimed invention is “on sale” under [pre-AIA 35 U.S.C. 102\(b\)](#). See *In re Epstein*, 32 F.3d 1559, 1568, 31 USPQ2d 1817, 1824 (Fed. Cir. 1994). The phrase “on sale” in [AIA 35 U.S.C. 102\(a\)\(1\)](#) is treated as having the same meaning as “on sale” in [pre-AIA 35 U.S.C. 102\(b\)](#). For a discussion of “on sale” as used in [pre-AIA 35 U.S.C. 102\(b\)](#), see generally [MPEP § 2133.03\(b\)](#) *et seq.*

Under [pre-AIA 35 U.S.C. 102\(b\)](#), if an invention was “on sale,” patentability was precluded only if the invention was on sale “in this country.” See [MPEP § 2133.03\(d\)](#). Under [AIA 35 U.S.C. 102\(a\)\(1\)](#), there is no geographic limitation on where the sale or offer for sale may occur. When formulating a rejection, Office personnel should consider evidence of sales activity, regardless of where the sale activity took place.

The [pre-AIA 35 U.S.C. 102\(b\)](#) “on sale” provision has been interpreted as including commercial activity even if the activity is secret. See [MPEP § 2133.03\(b\)](#), subsection III.A. [AIA 35 U.S.C. 102\(a\)\(1\)](#) uses the same “on sale” term as [pre-AIA 35 U.S.C. 102\(b\)](#)

and is treated as having the same meaning. In *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S.Ct. 628, 129 USPQ2d at 1193 (2019), the Supreme Court “determine[d] that Congress did not alter the meaning of ‘on sale’ when it enacted the AIA, [and held] that an inventor’s sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art under [AIA 35 U.S.C.] § 102(a).” *Id.* at 634, 129 USPQ2d at 1193. Thus, a sale or offer for sale that does not disclose the subject matter of an invention or make the invention available to the general public may nevertheless qualify as prior art in an anticipation or obviousness rejection, regardless of whether the application or patent under consideration is subject to the FITF provisions of the AIA or the first to invent provisions of pre-AIA law.

### **2152.02(e) Otherwise Available to the Public [R-10.2019]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(a\)\(1\)](#) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in [pre-AIA 35 U.S.C. 102](#). Specifically, a claimed invention is not entitled to a patent if it was “otherwise available to the public” before its effective filing date. This “catch-all” provision permits decision makers to focus on whether the disclosure was “available to the public,” rather than on the means by which the claimed invention became available to the public or whether a disclosure constitutes a “printed publication” or falls within another category of prior art as defined in [AIA 35 U.S.C. 102\(a\)\(1\)](#). The availability of the subject matter to the public may arise in situations such as a student thesis in a university library (see, e.g., *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986); *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978) and [MPEP § 2128.01](#), subsection I.); a poster

display or other information disseminated at a scientific meeting (see, e.g., *In re Klopfenstein*, 380 F.3d 1345, 72 USPQ2d 1117 (Fed. Cir. 2004), *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985), *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 127 USPQ2d 1485 (Fed. Cir. 2018), and [MPEP § 2128.01](#), subsection IV.); subject matter in a laid-open patent application or patent (see, e.g., *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); see also *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 78 USPQ2d 1684 (Fed. Cir. 2006)); a document electronically posted on the Internet (see, e.g., *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 104 USPQ2d 1553 (Fed. Cir. 2012), *In re Lister*, 583 F.3d 1307, 92 USPQ2d 1225 (Fed. Cir. 2009), *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 85 USPQ2d 1489 (Fed. Cir. 2008), and [MPEP § 2128](#)); or a commercial transaction that does not constitute a sale under the Uniform Commercial Code (see, e.g., *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 59 USPQ2d 1121 (Fed. Cir. 2001) and [MPEP § 2133.03\(e\)\(1\)](#)). Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the “otherwise available to the public” provision of [AIA 35 U.S.C. 102\(a\)\(1\)](#), provided that the claimed invention is made sufficiently available to the public.

### **2152.02(f) No Requirement of “By Others” [R-11.2013]**

*[Editor Note: This MPEP section is only applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2131-MPEP § 2138 for examination of applications subject to pre-AIA 35 U.S.C. 102.]*

A key difference between [pre-AIA 35 U.S.C. 102\(a\)](#) and [AIA 35 U.S.C. 102\(a\)\(1\)](#) is the requirement in [pre-AIA 35 U.S.C. 102\(a\)](#) that the prior art relied on was “by others.” Under [AIA 35 U.S.C. 102\(a\)\(1\)](#), there is no requirement that the prior art relied upon be by others. Thus, any prior art which falls under [AIA 35 U.S.C. 102\(a\)\(1\)](#) need not be by another to constitute potentially available prior art. However,

disclosures of the subject matter made one year or less before the effective filing date of the claimed invention by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or a joint inventor may fall within an exception under [AIA 35 U.S.C. 102\(b\)\(1\)](#) to [AIA 35 U.S.C. 102\(a\)\(1\)](#).

### **2152.03 Admissions [R-11.2013]**

*[Editor Note: This MPEP section is only applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2131-MPEP § 2138 for examination of applications subject to pre-AIA 35 U.S.C. 102.]*

The Office will continue to treat admissions by the applicant as prior art under the AIA. A statement by an applicant in the specification or made during prosecution identifying the work of another as “prior art” is an admission which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under [AIA 35 U.S.C. 102](#). See *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988). For a discussion of admissions as prior art, see generally [MPEP § 2129](#).

### **2152.04 The Meaning of “Disclosure” [R-11.2013]**

*[Editor Note: This MPEP section is only applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2131-MPEP § 2138 for examination of applications subject to pre-AIA 35 U.S.C. 102.]*

The AIA does not define the term “disclosure,” and [AIA 35 U.S.C. 102\(a\)](#) does not use the term “disclosure.” [AIA 35 U.S.C. 102\(b\)\(1\)](#) and [\(b\)\(2\)](#),



however, each state conditions under which a “disclosure” that otherwise falls within [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [102\(a\)\(2\)](#) is not prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [102\(a\)\(2\)](#). Thus, the Office is treating the term “disclosure” as a generic expression intended to encompass the documents and activities enumerated in [AIA 35 U.S.C. 102\(a\)](#) (i.e., being patented, described in a printed publication, in public use, on sale, or otherwise available to the public, or being described in a U.S. patent, U.S. patent application publication, or WIPO published application).

## **2152.05 Determining Whether To Apply 35 U.S.C. 102(a)(1) or 102(a)(2) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) and [MPEP § 2139.02](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

### **I. 35 U.S.C. 102(a)(1)**

First, the examiner should consider whether the reference qualifies as prior art under [35 U.S.C. 102\(a\)\(1\)](#). Next the examiner must determine if any exceptions in [35 U.S.C. 102\(b\)\(1\)](#) apply.

Patents claiming or describing the claimed inventions, descriptions of the claimed invention in a printed publication, public use of the claimed invention, placing the claimed invention on sale, and otherwise making the claimed invention available to the public qualify as prior art under [35 U.S.C. 102\(a\)\(1\)](#) if the reference predates the effective filing date of the claim. The sale or use of the invention need not occur in the United States to qualify. See [MPEP § 2152](#).

A disclosure in a potential prior art reference within the one-year grace period is excepted as prior art under [35 U.S.C. 102\(b\)\(1\)\(A\)](#) if the disclosure was the inventor’s or at least one joint inventor’s own work that was publicly disclosed by the inventor, a joint inventor, or another who obtained the subject

matter directly or indirectly from the inventor or joint inventor. [35 U.S.C. 102\(b\)\(1\)\(A\)](#) provides that a disclosure which would otherwise qualify as prior art under [35 U.S.C. 102\(a\)\(1\)](#) is not prior art if the disclosure was made: (1) one year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor, or by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. See [MPEP § 2153.01\(a\)](#).

Disclosures in potential prior art references within the one-year grace period are also excepted as prior art under [35 U.S.C. 102\(b\)\(1\)\(B\)](#) if the reference discloses subject matter that was previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. Specifically, [35 U.S.C. 102\(b\)\(1\)\(B\)](#) provides that a disclosure which would otherwise qualify as prior art under [35 U.S.C. 102\(a\)\(1\)](#) (patent, printed publication, public use, sale, or other means of public availability) is excepted as prior art if: (1) the disclosure was made one year or less before the effective filing date of the claimed invention; and (2) the subject matter disclosed had been previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. See [MPEP §§ 2153.02](#) and [717.01\(b\)\(2\)](#).

### **II. 35 U.S.C. 102(a)(2)**

First, the examiner should consider whether the reference qualifies as prior art under [35 U.S.C. 102\(a\)\(2\)](#). Next the examiner must determine if any exceptions in [35 U.S.C. 102\(b\)\(2\)](#) apply.

U.S. patents, U.S. patent applications published under [35 U.S.C. 122\(b\)](#), and international patent applications designating the United States that are published under the Patent Cooperation Treaty to another are prior art under [35 U.S.C. 102\(a\)\(2\)](#) if the effectively filed date of the disclosure of the reference is before the effective filing date of the claimed invention, unless an exception under [35 U.S.C. 102\(b\)\(2\)](#) applies. Even if the issue or publication date of the reference is not before the effective filing date of the claimed invention, such that the reference does not qualify as [102\(a\)\(1\)](#) prior



art, the reference may still be applicable as prior art under [35 U.S.C. 102\(a\)\(2\)](#) if it was “effectively filed” before the effective filing date of the claimed invention with respect to the subject matter relied upon to reject the claim. [MPEP § 2152.01](#) discusses the “effective filing date” of a claimed invention. [35 U.S.C. 102\(d\)](#) sets forth the criteria to determine when subject matter described in a U.S. patent, U.S. patent application publication, or WIPO published application was “effectively filed” for purposes of [35 U.S.C. 102\(a\)\(2\)](#). See [MPEP § 2154](#).

Disclosures in potential prior art references are not prior art under [35 U.S.C. 102\(a\)\(2\)](#) if one of the three exception provisions of [35 U.S.C. 102\(b\)\(2\)](#) applies. [35 U.S.C. 102\(b\)\(2\)\(A\)](#) limits the use of an inventor’s or at least one joint inventor’s own work as prior art when the inventor’s or at least one joint inventor’s own work is disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. [35 U.S.C. 102\(b\)\(2\)\(B\)](#) excepts as prior art subject matter that was effectively filed by another after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. [35 U.S.C. 102\(b\)\(2\)\(C\)](#) excepts subject matter disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application from constituting prior art under [35 U.S.C. 102\(a\)\(2\)](#) if the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, “were owned by the same person or subject to an obligation of assignment to the same person.” [35 U.S.C. 102\(b\)\(2\)\(C\)](#) resembles [pre-AIA 35 U.S.C. 103\(c\)](#) in that both concern common ownership, and both offer an avenue by which an applicant may avoid certain disclosures that are commonly owned or deemed commonly owned. However, there are significant differences between [35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP § 2154.02\(b\)](#).

### **2152.06 Overcoming a 35 U.S.C. 102(a)(1) or 102(a)(2) Rejection [R-07.2022]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first*

*inventor to file provisions of the AIA as explained in [35 U.S.C. 100 \(note\)](#) and [MPEP § 2159](#). See [MPEP § 2139 et seq.](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

In addition to persuasively arguing that the claims are patentably distinguishable over the prior art or amending the claims to overcome the prior art rejection, a rejection under [35 U.S.C. 102\(a\)\(1\)](#) or [102\(a\)\(2\)](#) can be overcome by:

(A) Submitting a benefit claim under [35 U.S.C. 120](#) within the time period set in [37 CFR 1.78](#) by providing the required reference to a prior application in a corrected application data sheet under [37 CFR 1.76](#) and by establishing that the prior application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#), or filing a grantable petition to accept an unintentionally delayed benefit claim under [37 CFR 1.78](#). See [MPEP § 211 et seq.](#); or

(B) Submitting a benefit claim under [35 U.S.C. 119\(e\)](#) within the time period set in [37 CFR 1.78](#) by providing the required reference to a prior provisional application in a corrected application data sheet under [37 CFR 1.76](#) and by establishing that the prior application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#) or filing a grantable petition to accept an unintentionally delayed benefit claim under [37 CFR 1.78](#). See [MPEP § 211 et seq.](#); or

(C) Submitting a claim to priority under [35 U.S.C. 119\(a\) - \(d\)](#) within the time period set in [37 CFR 1.55](#) by identifying a prior foreign application in a corrected application data sheet under [37 CFR 1.76](#) and by establishing that the prior foreign application satisfies the enablement and written description requirements of [35 U.S.C. 112\(a\)](#) or filing a grantable petition to accept a delayed priority claim under [37 CFR 1.55](#). See [MPEP §§ 213 - 216](#). The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see [37 CFR 1.55\(g\)](#)); or

(D) Filing an affidavit or declaration under [37 CFR 1.130](#) to establish that an applied disclosure that was not made under [35 U.S.C. 102\(a\)\(1\)](#) more

than one year before the effective filing date of the claimed invention is not prior art under [35 U.S.C. 102\(a\)](#) due to an exception listed in [35 U.S.C. 102\(b\)](#). Under [37 CFR 1.130\(a\)](#), an affidavit or declaration of attribution may be submitted to except a disclosure as prior art because it 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. Under [37 CFR 1.130\(b\)](#), an affidavit or declaration of prior public disclosure may be submitted to except an intervening disclosure as prior art if the subject matter disclosed had 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 joint inventor (1) before the date the intervening disclosure was made on which the rejection is based, or (2) before the date the subject matter in the U.S. patent, U.S. patent application publication, or WIPO published application on which the rejection is based was effectively filed. See [MPEP §§ 717](#) and [2155](#); or

(E) Establishing common ownership or establishing evidence of a Joint Research Agreement to overcome a [35 U.S.C. 102\(a\)\(2\)](#) rejection or a [35 U.S.C. 103](#) rejection based on prior art under [35 U.S.C. 102\(a\)\(2\)](#) by establishing entitlement to the [35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception. See [MPEP §§ 717.02](#) and [2154.02\(c\)](#).

Note that all of the ways of overcoming a [35 U.S.C. 102\(a\)\(1\)](#) or [102\(a\)\(2\)](#) rejection mentioned in this subsection may also be used to overcome a rejection under 35 U.S.C. 103 that is based on [35 U.S.C. 102\(a\)\(1\)](#) or [102\(a\)\(2\)](#) prior art.

## **2152.07 Form Paragraphs for Use in Rejections Under AIA 35 U.S.C. 102 [R-07.2022]**

The following form paragraphs should be used in making the appropriate rejections. Note that the particular part of the reference relied upon to support the rejection should be identified.

### **¶ 7.06 Notice re prior art available under both pre-AIA and AIA**

In the event the determination of the status of the application as subject to AIA [35 U.S.C. 102](#) and [103](#) (or as subject to [pre-AIA 35 U.S.C. 102](#) and [103](#)) is incorrect, any correction of the statutory basis (i.e., changing from AIA to pre-AIA) for the

rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

### **Examiner Note:**

1. This form paragraph must be used in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013, that claims priority to, or the benefit of, an application filed before March 16, 2013.
2. This form paragraph should only be used ONCE in an Office action.

### **¶ 7.07.aia Statement of Statutory Basis, 35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of [35 U.S.C. 102](#) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

### **Examiner Note:**

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use form paragraph 7.103.
2. Form paragraphs 7.07.aia, 7.08.aia, 7.12.aia and 7.14.aia are to be used ONLY ONCE in a given Office action.
3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

### **¶ 7.08.aia 102(a)(1), Activity Before the Effective Filing Date of Claimed Invention**

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

### **Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act.
2. This form paragraph must be preceded by form paragraphs 7.03.aia and 7.07.aia.

### **¶ 7.12.aia 102(a)(2), U.S. Patent, U.S. Patent Application Publication or WIPO Published Application That Names Another Inventor and Has an Earlier Effectively Filed Date**

(a)(2) the claimed invention was described in a patent issued under section [151](#), or in an application for patent published or deemed published under section [122\(b\)](#), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

### **Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being

examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act.

2. This form paragraph must be preceded by form paragraphs 7.03.aia and 7.07.aia and may be preceded by 7.08.aia.

3. This form paragraph should only be used if the reference is one of the following:

(a) a U.S. patent granted under [35 U.S.C. 151](#) having an effectively filed date earlier than the application;

(b) a U.S. Patent Application Publication published under [35 U.S.C. 122\(b\)](#) having an effectively filed date earlier than the application; or

(c) a WIPO publication of an international application (PCT) or international design application that designates the United States where the WIPO publication has an effectively filed date earlier than the application.

If any of these three types of prior art documents under [35 U.S.C. 102\(a\)\(2\)](#) was published before the effective filing date of the claims under examination, then the prior art document is also applicable under [35 U.S.C. 102\(a\)\(1\)](#).

#### ¶ 7.14.aia Pre-AIA 102(g), Priority of Invention

(g)(1) during the course of an interference conducted under section [135](#) or section [291](#), another inventor involved therein establishes, to the extent permitted in section [104](#), that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

A rejection on this statutory basis ([35 U.S.C. 102\(g\)](#)) as in force on March 15, 2013) is appropriate in an application or patent that is examined under the first to file provisions of the AIA if it also contains or contained at any time (1) a claim to an invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is before March 16, 2013 or (2) a specific reference under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) to any patent or application that contains or contained at any time such a claim.

#### Examiner Note:

This form paragraph must be preceded by form paragraph 7.07.aia.

#### ¶ 7.15.aia Rejection, 35 U.S.C. 102(a)(1)/102(a)(2)

Claim(s) [1] is/are rejected under [35 U.S.C. 102](#) [2] as being [3] by [4].

#### Examiner Note:

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the

Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. In bracket 1, insert the claim numbers which are under rejection.

3. In bracket 2, insert either "(a)(1)" or "(a)(2)" or both. If paragraph (a)(2) of [35 U.S.C. 102](#) is applicable, use form paragraph 7.15.01.aia, 7.15.02.aia or 7.15.03.aia where applicable.

4. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

5. In bracket 4, insert the prior art relied upon.

6. This rejection must be preceded either by form paragraph 7.07.aia and form paragraphs 7.08.aia, and 7.12.aia as appropriate, or by form paragraph 7.103.

7. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

#### ¶ 7.15.01.aia Provisional Rejection, 35 U.S.C. 102(a)(2) - Common Assignee, Common Applicant, or At Least One Common (Joint) Inventor

Claim(s) [1] is/are provisionally rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.

The copending application would constitute prior art under [35 U.S.C. 102\(a\)\(2\)](#) if published under [35 U.S.C. 122\(b\)](#) or patented under [35 U.S.C. 151](#). This provisional rejection under [35 U.S.C. 102\(a\)\(2\)](#) is based upon a presumption of future publication or patenting of the copending application. [4].

This provisional rejection under [35 U.S.C. 102\(a\)\(2\)](#) might be overcome by: (1) a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the copending application was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with [35 U.S.C. 102\(b\)\(2\)\(A\)](#); (2) a showing under [37 CFR 1.130\(b\)](#) of a prior public disclosure under [35 U.S.C. 102\(b\)\(2\)\(B\)](#); or (3) a statement pursuant to [35 U.S.C. 102\(b\)\(2\)\(C\)](#) establishing that, not later than the effective filing date of the claimed invention, the subject matter disclosed in the copending application and the claimed invention were either owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

#### Examiner Note:

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph is used to provisionally reject over a copending application that discloses the claimed invention and

would constitute prior art under [35 U.S.C. 102\(a\)\(2\)](#) if published under [35 U.S.C. 122](#) or patented. The copending application must have either a common assignee, common applicant ([35 U.S.C. 118](#)) or at least one common (joint) inventor.

3. [35 U.S.C. 102\(a\)\(2\)](#) may be applied if the reference names another inventor (i.e., a different inventive entity) and is one of the following:

- a. a U.S. patent granted under [35 U.S.C. 151](#) that has an effectively filed date earlier than the application;
  - b. a U.S. Patent Application Publication published under [35 U.S.C. 122\(b\)](#) that has an effectively filed date earlier than the effective filing date of the claimed invention; or
  - c. a WIPO publication of an international application (PCT) or international design application that designates the United States where the WIPO publication has an effectively filed date earlier than the effective filing date of the claimed invention. If any of the three types of prior art documents under [35 U.S.C. 102\(a\)\(2\)](#) issued or was published before the effective filing date of the claimed invention under examination, then the prior art document is also applicable under [35 U.S.C. 102\(a\)\(1\)](#).
4. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.aia.
5. In bracket 1, insert claim number(s) under rejection.
6. In bracket 2, insert the application number.
7. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.

8. In bracket 4, provide an appropriate explanation of the examiner's position on anticipation.

9. Under [35 U.S.C. 101](#), two patents are not permitted to issue on identical subject matter. Any claims in the instant application directed to the same invention claimed in the reference should be provisionally rejected using form paragraphs 8.30 and 8.32. Additionally, the applicant should be required to amend or cancel claims such that the applied reference and the instant application no longer contain claims directed to the same invention using form paragraph 8.27.aia.

10. Any claims in the instant application that are directed to subject matter that is not patentably distinct from an invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of nonstatutory double patenting using form paragraph 8.33 and at least one of form paragraphs 8.34 - 8.39.

11. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

**¶ 7.15.02.aia Rejection, 35 U.S.C. 102(a)(2), Common Assignee, Applicant, or Joint Inventor(s)**

Claim(s) [1] is/are rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being [2] by [3].

The applied reference has a common [4] with the instant application. Based upon the earlier effectively filed date of the

reference, it constitutes prior art under [35 U.S.C. 102\(a\)\(2\)](#). This rejection under [35 U.S.C. 102\(a\)\(2\)](#) might be overcome by: (1) a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with [35 U.S.C. 102\(b\)\(2\)\(A\)](#); (2) a showing under [37 CFR 1.130\(b\)](#) of a prior public disclosure under [35 U.S.C. 102\(b\)\(2\)\(B\)](#) if the same invention is not being claimed; or (3) a statement pursuant to [35 U.S.C. 102\(b\)\(2\)\(C\)](#) establishing that, not later than the effective filing date of the claimed invention, the subject matter disclosed in the reference and the claimed invention were either owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph is used to reject claims as anticipated over a U.S. patent, U.S. patent application publication, or WIPO publication with an earlier prior art date under [35 U.S.C. 102\(a\)\(2\)](#). These references must have either a common assignee, a common applicant ([35 U.S.C. 118](#)), or at least one common (joint) inventor.

3. [35 U.S.C. 102\(a\)\(2\)](#) may be applied if the reference names another inventor (i.e., a different inventive entity) and is one of the following:

a. a U.S. patent granted under [35 U.S.C. 151](#) that has an effectively filed date earlier than the effective filing date of the claimed invention;

b. a U.S. Patent Application Publication published under [35 U.S.C. 122\(b\)](#) that has an effectively filed date earlier than the effective filing date of the claimed invention; or

c. a WIPO publication of an international application (PCT) or international design application that designates the United States where the WIPO publication has an effectively filed date earlier than the effective filing date of the claimed invention.

If any of the three types of prior art documents under [35 U.S.C. 102\(a\)\(2\)](#) was published before the effective filing date of the claimed invention under examination, then the prior art document is also applicable under [35 U.S.C. 102\(a\)\(1\)](#).

4. In bracket 1, insert the claim numbers which are under rejection.

5. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

6. In bracket 3, insert the prior art relied upon.

7. In bracket 4, insert --assignee--, --applicant--, or --joint inventor--.

8. This form paragraph must be preceded by form paragraph 7.12.aia.

9. Under [35 U.S.C. 101](#), two patents are not permitted to issue on identical subject matter. Any claims in the instant application



directed to the same invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of statutory double patenting using form paragraphs 8.30 - 8.32. Additionally, the applicant should be required to amend or cancel claims such that the reference and the instant application no longer contain claims directed to the same invention using form paragraph 8.27.aia.

10. Any claims in the instant application that are directed to subject matter that is not patentably distinct from an invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of nonstatutory double patenting using form paragraph 8.33 and at least one of form paragraphs 8.34 - 8.39.

11. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

**¶ 7.15.03.aia Rejection, 35 U.S.C. 102(a)(2), No Common Assignee or Inventor(s)**

Claim(s) [1] is/are rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being [2] by [3].

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph is used to reject a claim over a U.S. patent, U.S. patent application publication or WIPO patent application publication with an earlier prior art date under [35 U.S.C. 102\(a\)\(2\)](#). The reference is not required to have a common assignee or inventor.

3. [35 U.S.C. 102\(a\)\(2\)](#) may be applied if the reference is one of the following:

a. a U.S. patent granted under [35 U.S.C. 151](#) that has an effectively filed date earlier than the effective filing date of the claimed invention;

b. a U.S. Patent Application Publication published under [35 U.S.C. 122\(b\)](#) that has an effectively filed date earlier than the effective filing date of the claimed invention; or

c. a WIPO publication of an international application where the WIPO publication has an effectively filed date earlier than the effective filing date of the claimed invention.

If any of the three types of prior art documents under [35 U.S.C. 102\(a\)\(2\)](#) was published before the effective filing date of the claimed invention under examination, then the prior art document is also applicable under [35 U.S.C. 102\(a\)\(1\)](#).

4. In bracket 1, insert the claim numbers which are under rejection.

5. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

6. In bracket 3, insert the prior art relied upon.

7. This form paragraph must be preceded by form paragraph 7.12.aia.

**¶ 7.16.aia Rejection, 35 U.S.C. 102(a)(1), Public Use, On Sale, or Otherwise Publicly Available**

Claim [1] rejected under [35 U.S.C. 102\(a\)\(1\)](#) based upon a public use or sale or other public availability of the invention. [2]

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph must be preceded either by form paragraphs 7.07.aia and 7.08.aia or by form paragraph 7.103.

3. In bracket 1, insert the claim numbers which are under rejection.

4. A full explanation of the evidence establishing a public use or sale or other public availability must be provided in bracket 2.

**¶ 7.17.aia 102(a)(1) Rejection Using Prior Art Excepted under 102(b)(2)(C)**

Applicant has provided evidence in this file showing that the claimed invention and the subject matter disclosed in the prior art reference were owned by, or subject to an obligation of assignment to, the same entity as [1] not later than the effective filing date of the claimed invention, or the subject matter disclosed in the prior art reference was developed and the claimed invention was made by, or on behalf of one or more parties to a joint research agreement in effect not later than the effective filing date of the claimed invention. However, although reference [2] has been excepted as prior art under [35 U.S.C. 102\(a\)\(2\)](#), it is still applicable as prior art under [35 U.S.C. 102\(a\)\(1\)](#) that cannot be excepted under [35 U.S.C. 102\(b\)\(2\)\(C\)](#).

Applicant may rely on the exception under [35 U.S.C. 102\(b\)\(1\)\(A\)](#) to overcome this rejection under [35 U.S.C. 102\(a\)\(1\)](#) by a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application, and is therefore not prior art under [35 U.S.C. 102\(a\)\(1\)](#). Alternatively, applicant may rely on the exception under [35 U.S.C. 102\(b\)\(1\)\(B\)](#) by providing evidence of a prior public disclosure via an affidavit or declaration under [37 CFR 1.130\(b\)](#).

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph must be included following form paragraph 7.20.aia or 7.15.aia where the anticipation rejection is based on a reference that has been excepted under [35 U.S.C. 102\(b\)\(2\)\(C\)](#) but still qualifies as prior art under [35 U.S.C. 102\(a\)\(1\)](#).

3. In bracket 1, identify the common assignee.

4. In bracket 2, identify the reference which has been excepted.



**¶ 7.18.aia Rejection, Pre-AIA 35 U.S.C. 102(g)**

Claim [1] rejected under [pre-AIA 35 U.S.C. 102 \(g\)](#) as being [2] by [3].

**Examiner Note:**

1. This form paragraph should only be used for an application or a patent that is being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act (must be preceded by form paragraph 7.03.aia) and **MUST** contain or have contained a claim to an invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is before March 16, 2013 or a specific reference under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) to any patent or application that contains or contained such a claim.
2. In bracket 1, insert the claim numbers which are under rejection.
3. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
4. In bracket 3, insert the prior art relied upon.
5. This rejection must be preceded either by form paragraph 7.14.aia, or by form paragraph 7.103.

**2153 Prior Art Exceptions Under 35 U.S.C. 102(b)(1) to AIA 35 U.S.C. 102(a)(1) [R-07.2022]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

See [MPEP § 2153.01](#) for prior art exceptions based on grace period inventor-originated disclosures as provided for under [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#). See [MPEP § 2153.02](#) for prior art exceptions based on inventor-originated prior public disclosures.

**2153.01 Prior Art Exception Under AIA 35 U.S.C. 102(b)(1)(A) To AIA 35 U.S.C. 102(a)(1) (Grace Period Inventor-Originated Disclosure Exception) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and*

*[MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) provides exceptions to the prior art provisions of [AIA 35 U.S.C. 102\(a\)\(1\)](#). These exceptions limit the use of an inventor's or at least one joint inventor's own work as prior art, when the inventor's or at least one joint inventor's own work has been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor not more than one year before the effective filing date of the claimed invention. [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) provides that a disclosure which would otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) is not prior art if the disclosure was made: (1) One year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor, or by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. [MPEP § 2153.01\(a\)](#) discusses issues pertaining to inventor-originated disclosures within the grace period. [MPEP § 2152.01](#) discusses the "effective filing date" of a claimed invention.

**2153.01(a) Grace Period Inventor-Originated Disclosure Exception [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) first provides that a disclosure which would otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) is excepted as prior art if the disclosure is made: (1) one year or less before the effective filing date of the claimed invention; and (2) by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor (i.e., an inventor-originated disclosure). Thus, a disclosure that would otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) may not be used as prior art by Office personnel if

the disclosure is made one year or less before the effective filing date of the claimed invention, and the evidence shows that the disclosure is an inventor-originated disclosure. What evidence is necessary to show that the disclosure is an inventor-originated disclosure requires case-by-case treatment, depending upon whether it is apparent from the disclosure itself or the patent application specification that the disclosure is an inventor-originated disclosure.

A disclosure made within the grace period is not prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if it is apparent from the disclosure itself that it is an inventor-originated disclosure. Specifically, Office personnel may not apply a disclosure as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if the disclosure: (1) was made one year or less before the effective filing date of the claimed invention; (2) names the inventor or a joint inventor as an author or an inventor; and (3) does not name additional persons as authors on a printed publication or joint inventors on a patent. This means that in circumstances where an application names additional persons as joint inventors relative to the persons named as authors in the publication (e.g., the application names as joint inventors A, B, and C, and the publication names as authors A and B), and the publication is one year or less before the effective filing date, it is apparent that the disclosure is a grace period inventor disclosure, and the publication is not prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). If, however, the application names fewer joint inventors than a publication (e.g., the application names as joint inventors A and B, and the publication names as authors A, B and C), it would not be readily apparent from the publication that it is an inventor-originated disclosure and the publication would be treated as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) unless there is evidence of record that an exception under [AIA 35 U.S.C. 102\(b\)\(1\)](#) applies.

Applicants can include a statement regarding any grace period inventor-originated public disclosures in the specification upon filing. See [37 CFR 1.77\(b\)\(6\)](#) and [MPEP § 608.01\(a\)](#). In order to be effective to show that a grace period inventor-originated public disclosure is not prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) because the [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) exception applies, the statement

must convey the same information as would be required in a declaration under [37 CFR 1.130\(a\)](#). See [MPEP §§ 717.01\(a\)\(1\)](#), [2155.01](#), and [2155.03](#). An applicant is not required to identify any grace period inventor-originated public disclosures or to use the format specified in [37 CFR 1.77](#), but identifying any such disclosures may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification as filed contains a specific reference to a grace period inventor-originated public disclosure, and an oath or declaration under [37 CFR 1.63](#) from the inventor or the appropriate joint inventor(s) has been made of record, the Office will consider it apparent from the specification that the grace period public disclosure is attributable to the inventor or a joint inventor, provided there is a sufficient explanation of why the exception applies to a particular disclosure and there is no other evidence to the contrary. The applicant should also provide a copy of the grace period inventor-originated public disclosure (e.g., copy of a printed publication). The format specified in [37 CFR 1.77\(b\)\(6\)](#) may not be the basis to add information about inventor-originated grace period public disclosures to the specification after the filing date of the application. Such an amendment may be considered new matter. Applicants should use [37 CFR 1.130\(a\)](#) to submit such information after filing.

The Office has provided a mechanism for filing an affidavit or declaration (under [37 CFR 1.130](#)) to establish that a disclosure is not prior art under [AIA 35 U.S.C. 102\(a\)](#) due to an exception in [AIA 35 U.S.C. 102\(b\)](#). See [MPEP § 717](#). In the situations in which it is not apparent from the grace period disclosure itself or the patent application specification that the disclosure is an inventor-originated disclosure, the applicant may establish that the [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) exception applies by way of an affidavit or declaration under [37 CFR 1.130\(a\)](#). [MPEP § 2155.01](#) discusses the use of affidavits or declarations to show that a disclosure was an inventor-originated disclosure made during the grace period.

The one-year grace period in [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) is extended to the next succeeding business day if the end of the one-year grace period

otherwise falls on a Saturday, Sunday, or federal holiday. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) and [35 U.S.C. 21\(b\)](#). The provisions of [35 U.S.C. 21\(b\)](#) still apply notwithstanding the provisions of [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which accord a filing date as of the date of deposit as Priority Mail Express<sup>®</sup> with the U.S. Postal Service, and [37 CFR 1.6\(a\)\(4\)](#), which accords a filing date as of the date of submission using the USPTO patent electronic filing system.

## 2153.01(b) [Reserved]

### 2153.02 Prior Art Exception Under AIA 35 U.S.C. 102(b)(1)(B) to AIA 35 U.S.C. 102(a)(1) (Inventor-Originated Prior Public Disclosure Exception) [R-01.2024]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) provides an additional exception to the prior art provision of [AIA 35 U.S.C. 102\(a\)\(1\)](#). [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) excepts as prior art a disclosure of subject matter that occurs after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor (i.e., an inventor-originated public disclosure). Specifically, [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) provides that a disclosure which would otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) (patent, printed publication, public use, sale, or other means of public availability) is excepted as prior art if: (1) the disclosure was made one year or less before the effective filing date of the claimed invention; and (2) the subject matter disclosed had been previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The previous inventor-originated public disclosure of the subject matter typically will be a disclosure within

the one-year grace period (i.e., a grace period inventor-originated disclosure). However, if the previous inventor-originated public disclosure of the subject matter was made outside the grace period, that disclosure itself would qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#), and could not be excepted under [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#). In other words, a previous inventor-originated public disclosure of the subject matter can be effective to establish that a grace period disclosure is excepted as prior art regardless of whether the previous inventor-originated disclosure was made within the grace period or not. [MPEP § 2152.01](#) discusses the “effective filing date” of a claimed invention. [MPEP § 2155.02](#) discusses the use of affidavits or declarations to show that the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor, and [MPEP § 2155.03](#) discusses the use of affidavits or declarations to show that the disclosure was made, or that the subject matter had been previously publicly disclosed, by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

The exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) applies if the “subject matter disclosed [in the intervening disclosure] had, before such [intervening] disclosure, been publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor).” See [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#). The exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) focuses on the “subject matter” that had been previously publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor). The subject matter in the prior disclosure being relied upon under [AIA 35 U.S.C. 102\(a\)](#) must be the same “subject matter” as the subject matter previously publicly disclosed by the inventor for the exceptions in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [AIA 102\(b\)\(2\)\(B\)](#) to apply. The exceptions in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [AIA 102\(b\)\(2\)\(B\)](#) do not apply even if the only differences between the subject matter in the prior art disclosure that is relied upon under [AIA 35 U.S.C. 102\(a\)](#) and the subject matter previously publicly disclosed by the inventor are mere insubstantial changes, or only trivial or obvious variations. This guidance maintains the

identical subject matter interpretation of [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [AIA 102\(b\)\(2\)\(B\)](#).

There is no requirement under [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) that the mode of disclosure by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor) be the same as the mode of disclosure of the intervening grace period disclosure (e.g., patenting, publication, public use, sale activity). There is also no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of the intervening grace period disclosure. See *In re Kao*, 639 F.3d 1057, 1066 98 USPQ2d 1799, 1806 (Fed. Cir. 2011) (subject matter does not change as a function of how one chooses to describe it). What is required for subject matter in an intervening grace period disclosure to be excepted under [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) is that the same subject matter as in the intervening disclosure must have been previously publicly disclosed by the inventor or a joint inventor (or by another who obtained the subject matter therefrom).

The exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) applies to the subject matter in the intervening grace period disclosure being relied upon as prior art for a rejection under [AIA 35 U.S.C. 102\(a\)\(1\)](#) (an intervening disclosure) that was also publicly disclosed by the inventor or a joint inventor (or by another who obtained the subject matter therefrom) before such intervening disclosure. The subject matter of an intervening grace period disclosure that is not in the inventor-originated prior public disclosure is available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). For example, if the inventor or a joint inventor had publicly disclosed A, B, and C, and a subsequent intervening grace period disclosure discloses A, B, C, and D, then D remains available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) even though the [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) exception applies such that A, B, and C are not prior art. In other words, the exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) does not necessarily remove the entire disclosure in the intervening reference from being prior art.

In addition, if subject matter of an intervening grace period disclosure is simply a more general

description of the subject matter in an inventor-originated prior public disclosure, the exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) applies to such subject matter of the intervening grace period disclosure. To hold otherwise would unfairly deprive an inventor of a patent merely because a third party became aware of the inventor's public disclosure and then publicized a genericized version of it. For example, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses a genus (i.e., provides a more generic disclosure of the species), the intervening grace period disclosure of the genus is not available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). Conversely, if the inventor or a joint inventor had publicly disclosed a genus, and a subsequent intervening grace period disclosure discloses a species, the intervening grace period disclosure of the species would be available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#). Likewise, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening grace period disclosure discloses an alternative species not also disclosed by the inventor or a joint inventor, the intervening grace period disclosure of the alternative species would be available as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) because the "subject matter disclosed" requirement of [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) would not have been met.

Finally, [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) does not discuss "the claimed invention" with respect to either the subject matter disclosed by the inventor or a joint inventor, or the subject matter of the subsequent intervening grace period disclosure. The only inquiry with respect to the claimed invention is whether or not the subject matter in the prior art disclosure being relied upon anticipates or renders obvious the claimed invention. A determination of whether the exception in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) is applicable to subject matter in an intervening grace period disclosure does not involve a comparison of the subject matter of the claimed invention to either the subject matter in the inventor-originated prior public disclosure, or to the subject matter of the subsequent intervening grace period disclosure.

Applicants can include a statement in the specification upon filing regarding any inventor-originated public disclosures of subject



matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of that same subject matter. See [37 CFR 1.77\(b\)\(6\)](#) and [MPEP § 608.01\(a\)](#). In order to be effective to show that a potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of subject matter is not prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) because the [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) exception applies, the statement must convey the same information as would be required in a declaration under [37 CFR 1.130\(b\)](#). See [MPEP §§ 717.01\(b\)\(1\), 2155.02, and 2155.03](#). An applicant is not required to identify any inventor-originated public disclosures of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of that same subject matter, or to use the format specified in [37 CFR 1.77\(b\)\(6\)](#), but identifying any such public disclosures may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification as filed contains a specific reference to an inventor-originated public disclosure of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of that same subject matter, and an oath or declaration under [37 CFR 1.63](#) from the inventor or the appropriate joint inventor(s) has been made of record, the Office will consider it apparent from the specification that the potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of the same subject matter is not, in fact, prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#), provided there is a sufficient explanation of why the exception applies to a particular disclosure and there is no other evidence to the contrary. The applicant must also provide a copy of the prior inventor-originated public disclosure if it was made by way of a printed publication; see [37 CFR 1.130\(b\)](#). Applicants may not use [37 CFR 1.77\(b\)\(6\)](#) to add information to the specification about inventor-originated public disclosures of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(1\)](#) disclosure of that same subject matter after the date that the application is filed. Applicants should use [37 CFR 1.130\(b\)](#) to submit such information after filing.

The one-year grace period in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) is extended to the next succeeding business day if the end of the one-year grace period otherwise falls on a Saturday, Sunday, or federal holiday. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) and [35 U.S.C. 21\(b\)](#). The provisions of [35](#)

[U.S.C. 21\(b\)](#) still apply notwithstanding the provisions of [37 CFR 1.6\(a\)\(2\)](#) and [37 CFR 1.10](#), which accord a filing date as of the date of deposit as Priority Mail Express<sup>®</sup> with the U.S. Postal Service and [37 CFR 1.6\(a\)\(4\)](#), which accords a filing date as of the date of submission using the USPTO patent electronic filing system.

## **2154 Provisions Pertaining to Subject Matter in a U.S. Patent or Application Effectively Filed Before the Effective Filing Date of the Claimed Invention [R-11.2013]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(a\)\(2\)](#) sets forth three types of U.S. patent documents that are available as prior art as of the date they were effectively filed with respect to the subject matter relied upon in the document if they name another inventor. See [MPEP §§ 2151, 2154.01, and 2154.01\(a\)](#) for a discussion of the types of patent documents that qualify as prior art under [35 U.S.C. 102\(a\)\(2\)](#). See [MPEP § 2154.02 et seq.](#) for prior art exceptions under [35 U.S.C. 102\(b\)\(2\)](#) to [AIA 35 U.S.C. 102\(a\)\(2\)](#).

### **2154.01 Prior Art Under AIA 35 U.S.C. 102(a)(2) “U.S. Patent Documents” [R-11.2013]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(a\)\(2\)](#) sets forth three types of patent documents that are available as prior art as of the date they were effectively filed with respect to



the subject matter relied upon in the document if they name another inventor: (1) U.S. patents; (2) U.S. patent application publications; and (3) certain WIPO published applications. These documents are referred to collectively as “U.S. patent documents.” These documents may have different prior art effects under [pre-AIA 35 U.S.C. 102\(e\)](#) than under [AIA 35 U.S.C. 102\(a\)\(2\)](#). Note that a U.S. patent document may also be prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if its issue or publication date is before the effective filing date of the claimed invention in question.

If the issue date of the U.S. patent or publication date of the U.S. patent application publication or WIPO published application is not before the effective filing date of the claimed invention, it may be applicable as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) if it was “effectively filed” before the effective filing date of the claimed invention in question with respect to the subject matter relied upon to reject the claim. [MPEP § 2152.01](#) discusses the “effective filing date” of a claimed invention. [AIA 35 U.S.C. 102\(d\)](#) sets forth the criteria to determine when subject matter described in a U.S. patent document was “effectively filed” for purposes of [AIA 35 U.S.C. 102\(a\)\(2\)](#).

### **2154.01(a) WIPO Published Applications [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

The WIPO publication of a PCT international application that designates the United States is an application for patent deemed published under [35 U.S.C. 122\(b\)](#) for purposes of [AIA 35 U.S.C. 102\(a\)\(2\)](#) under [35 U.S.C. 374](#). Thus, under the AIA, WIPO publications of PCT applications that designate the United States are treated as U.S. patent application publications for prior art purposes, regardless of the international filing date, whether they are published in English, or whether the PCT international application enters the national stage in

the United States. Accordingly, a U.S. patent, a U.S. patent application publication, or a WIPO published application that names another inventor and was effectively filed before the effective filing date of the claimed invention, is prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#), unless an exception under [AIA 35 U.S.C. 102\(b\)\(2\)](#) applies. This differs from the treatment of a WIPO published application under [pre-AIA 35 U.S.C. 102\(e\)](#), where a WIPO published application is treated as a U.S. patent application publication only if the PCT application was filed on or after November 29, 2000, designated the United States, and is published under [PCT Article 21\(2\)](#) in the English language. See [MPEP § 2136.03](#), subsection II.

### **2154.01(b) Determining When Subject Matter Was Effectively Filed Under AIA 35 U.S.C. 102(d) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

[AIA 35 U.S.C. 102\(d\)](#) provides that a U.S. patent, U.S. patent application publication, or WIPO published application (“U.S. patent document”) is prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) with respect to any subject matter described in the patent or published application as of either its actual filing date ([AIA 35 U.S.C. 102\(d\)\(1\)](#)), or the filing date of a prior application to which there is a priority or benefit claim ([AIA 35 U.S.C. 102\(d\)\(2\)](#)). For prior art determinations under [AIA 35 U.S.C. 102](#), a reference patent document need only meet the “ministerial requirements” of [35 U.S.C. 119](#) and [120](#), and the provisional or other earlier application(s) to which the reference patent document claims a right of priority or benefit must “describe[] the subject matter” relied upon in the reference patent document as prior art. *Penumbra, Inc. v. RapidPulse, Inc.*, 2023 USPQ2d 292, IPR2021-01466, Paper 34 (March 10, 2023) (precedential as to section II.E.3). The “ministerial requirements” of [35 U.S.C. 119](#) and [120](#) are: (1)

containing a priority or benefit claim to the prior-filed application; (2) being filed within the applicable filing period requirement (copending with or within twelve months of the earlier filing, as applicable); and (3) having a common inventor or joint inventor or being by the same applicant. See [MPEP § 211](#) *et. seq.*

The AIA draws a distinction between actually being entitled to priority to, or the benefit of, a prior-filed application according to the definition of “effective filing date” of a claimed invention in [AIA 35 U.S.C. 100\(i\)\(1\)\(B\)](#), and merely being entitled to claim priority to, or the benefit of, a prior-filed application according to the use of “effectively filed” in [AIA 35 U.S.C. 102\(d\)](#). As a result of this distinction, the question of whether a patent or published application is actually entitled to priority or benefit with respect to any of its claims is not at issue in determining the date the patent or published application was “effectively filed” for prior art purposes. Thus, there is no need to evaluate whether any claim of a U.S. patent document is actually entitled to priority or benefit under [35 U.S.C. 119](#), [120](#), [121](#), [365](#), or [386](#) when applying such a document as prior art. “[T]he requirement that one of the claims in the patent [document] . . . be supported by the written description of the provisional application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph (or [AIA 35 U.S.C. § 112\(a\)](#)) is not applicable when examining an application subject to the first inventor to file provisions of the AIA.” *Penumbra*, 2023 USPQ2d at 15 (emphasis added) (quoting *Memorandum re: Critical Reference Date Under pre-AIA 35 U.S.C. § 102(e)* (April 5, 2018)). In other words, the requirement stated in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) does not apply to [AIA 35 U.S.C. 102\(d\)](#). See [MPEP § 2136.03](#) for the reference date under [pre-AIA 35 U.S.C. 102\(e\)](#) of U.S. patents, U.S. application publications, and international application publications entitled to the benefit of the filing date of prior application under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), or [365\(c\)](#).

[AIA 35 U.S.C. 102\(d\)](#) requires that a prior-filed application to which a priority or benefit claim is made must describe the subject matter from the U.S. patent document relied upon in a rejection. However,

[AIA 35 U.S.C. 102\(d\)](#) does not require that this description meet the enablement requirements of [35 U.S.C. 112\(a\)](#). As discussed previously with respect to [AIA 35 U.S.C. 102\(a\)\(1\)](#), the Office does not view the AIA as changing the extent to which a claimed invention must be described for a prior art document to anticipate the claimed invention under [AIA 35 U.S.C. 102](#).

The AIA also eliminates the so-called *Hilmer* doctrine. Under the *Hilmer* doctrine, [pre-AIA 35 U.S.C. 102\(e\)](#) limited the effective filing date for U.S. patents (and published applications) as prior art to their earliest U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). In contrast, [AIA 35 U.S.C. 102\(d\)](#) provides that if the U.S. patent document claims priority to one or more prior-filed foreign or international applications under [35 U.S.C. 119](#) or [365](#), the patent or published application was effectively filed on the filing date of the earliest such application that describes the subject matter. Therefore, if the subject matter relied upon is described in the application to which there is a priority or benefit claim, the U.S. patent document is effective as prior art as of the filing date of the earliest such application, regardless of where filed. When examining an application to which the AIA changes in [35 U.S.C. 102](#) and [103](#) do not apply, Office personnel will continue to apply the *Hilmer* doctrine, and foreign priority dates may not be used in determining [pre-AIA 35 U.S.C. 102\(e\)](#) prior art dates. Note that the international filing date of a published PCT application may be the [pre-AIA 35 U.S.C. 102\(e\)](#) prior art date under pre-AIA law under certain circumstances. See [MPEP § 2136](#).

### **2154.01(c) Requirement Of “Names Another Inventor” [R-11.2013]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

To qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#), the prior art U.S. patent, U.S. patent

application publication, or WIPO published application (“U.S. patent document”) must “name[ ] another inventor.” This means that if there is any difference in inventive entity between the prior art U.S. patent document and the application under examination or patent under reexamination, the U.S. patent document satisfies the “names another inventor” requirement of [AIA 35 U.S.C. 102\(a\)\(2\)](#). Thus, in the case of joint inventors, only one joint inventor needs to be different for the inventive entities to be different. Even if there are one or more joint inventors in common in a U.S. patent document and the later-filed application under examination or patent under reexamination, the U.S. patent document qualifies as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) unless an exception in [AIA 35 U.S.C. 102\(b\)\(2\)](#) is applicable.

### **2154.01(d) Provisional Rejections Under 35 U.S.C. 102(a)(2); Reference Is a Copending U.S. Patent Application [R-01.2024]**

If an earlier filed, copending, and unpublished U.S. patent application discloses subject matter which would anticipate the claims in a later filed pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional rejection under [35 U.S.C. 102\(a\)\(2\)](#) of the later filed application can be made. In addition, a provisional rejection under [35 U.S.C. 102\(a\)\(2\)](#) may be made, in the circumstances described below, if the earlier filed, pending application has been published as redacted ([37 CFR 1.217](#)) and the subject matter relied upon in the rejection is not supported in the redacted publication of the patent application.

#### **I. COPENDING U.S. APPLICATIONS HAVING AT LEAST ONE COMMON (JOINT) INVENTOR OR COMMON APPLICANT OR ARE COMMONLY ASSIGNED**

If a first application has (1) at least one common (joint) inventor or common applicant with a second application or the applications are commonly assigned, and (2) the first application, upon publication or issuance, would qualify as prior art under [35 U.S.C. 102\(a\)\(2\)](#) to the second application, then a provisional anticipation or obviousness rejection of the second application may be made on the basis of the first application. Since the first

application is not published or issued at the time of the rejection, the rejection must be provisionally made under [35 U.S.C. 102\(a\)\(2\)](#) or [103](#).

A provisional rejection based on [35 U.S.C. 102\(a\)\(2\)](#) prior art can be overcome in the same manner that a [35 U.S.C. 102\(a\)\(2\)](#) rejection can be overcome. See [MPEP § 2152.06](#). The provisional rejection can also be overcome by abandoning the applications and filing a new application containing the subject matter of both.

Form paragraph 7.15.01.aia should be used when making a provisional rejection under [35 U.S.C. 102\(a\)\(2\)](#).

#### **II. COPENDING APPLICATIONS HAVING NO COMMON (JOINT) INVENTOR, APPLICANT, OR ASSIGNEE**

If there is no common assignee, common applicant, or common (joint) inventor and the application was not published pursuant to [35 U.S.C. 122\(b\)](#), the confidential status of applications under [35 U.S.C. 122\(a\)](#) must be maintained and no rejection can be made relying on the first (earlier filed), unpublished application, or subject matter not supported in a redacted application publication, as prior art under [35 U.S.C. 102\(a\)\(2\)](#). For applications subject to [pre-AIA 35 U.S.C. 102\(g\)](#), if the filing dates of the applications are within 6 months of each other (3 months for simple subject matter) then interference may be proper. See [MPEP Chapter 2300](#). If the first application will not be published pursuant to [35 U.S.C. 122\(b\)](#), it must be allowed to issue once all the statutory requirements are met. After the patent has issued, it may be used as a reference in a rejection under [35 U.S.C. 102\(a\)\(2\)](#) in the still pending application as appropriate. See [MPEP §§ 2120.01](#) and [2154](#).

### **2154.02 Prior Art Exceptions Under 35 U.S.C. 102(b)(2) to AIA 35 U.S.C. 102(a)(2) [R-07.2022]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject*

to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]

See [MPEP § 2154.02\(a\)](#) for prior art exceptions to [35 U.S.C. 102\(a\)\(2\)](#) under [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) based on the inventor-originated disclosure exception. See [MPEP § 2154.02\(b\)](#) for prior art exceptions to [AIA 35 U.S.C. 102\(a\)\(2\)](#) based on inventor-originated prior public disclosures as provided for in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#). See [MPEP § 2154.02\(c\)](#) for the prior art exception under [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) to [AIA 35 U.S.C. 102\(a\)\(2\)](#) based on common ownership or obligation of assignment.

### **2154.02(a) Prior Art Exception Under AIA 35 U.S.C. 102(b)(2)(A) to AIA 35 U.S.C. 102(a)(2) (Inventor-Originated Disclosure Exception) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

[AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) provides an exception to the prior art provisions of [AIA 35 U.S.C. 102\(a\)\(2\)](#). This exception limits the use of an inventor's or at least one joint inventor's own work as prior art, when the inventor's or at least one joint inventor's own work is disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application ("U.S. patent document") by another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) exception may possibly apply to any U.S. patent document, regardless of its potential prior art date under [AIA 35 U.S.C. 102\(a\)\(2\)](#). In other words, there is no grace period limitation to the applicability of the [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) exception.

Specifically, [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) provides that a disclosure which would otherwise qualify as

prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) is excepted as prior art if the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. Thus, if the subject matter in a U.S. patent document upon which the rejection is based is by another who obtained the subject matter from the inventor or a joint inventor, the applicant may establish by way of an affidavit or declaration of attribution under [37 CFR 1.130\(a\)](#) that a disclosure is not prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). [MPEP § 2155.03](#) discusses the use of affidavits or declarations of attribution under [37 CFR 1.130\(a\)](#) to show that the disclosure was by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor under the exception of [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) for an inventor-originated disclosure.

Applicants can include a statement regarding any inventor-originated disclosures made in U.S. patent documents in the specification upon filing. See [37 CFR 1.77\(b\)\(6\)](#) and [MPEP § 608.01\(a\)](#). In order to be effective to show that an inventor-originated disclosure made in a U.S. patent document is not prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) because the [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) exception applies, the statement must convey the same information as would be required in a declaration under [37 CFR 1.130\(a\)](#). See [MPEP §§ 717.01\(a\)\(1\)](#), [2155.01](#), and [2155.03](#). An applicant is not required to identify any inventor-originated disclosure made in a U.S. patent document or to use the format specified in [37 CFR 1.77\(b\)\(6\)](#), but identifying any such disclosures may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification as filed contains a specific reference to an inventor-originated disclosure made in a U.S. patent document, and an oath or declaration under [37 CFR 1.63](#) from the inventor or the appropriate joint inventor(s) has been made of record, the Office will consider it apparent from the specification that the inventor-originated disclosure made in the U.S. patent document is attributable to the inventor or a joint inventor, provided there is a sufficient explanation of why the exception applies to a particular disclosure and there is no other evidence to the contrary. The applicant should also provide a copy of the inventor-originated disclosure made in a U.S. patent document (e.g., a copy of a U.S. patent



application). Applicants may not use [37 CFR 1.77\(b\)\(6\)](#) to add information about inventor-originated disclosures made in U.S. patent documents to the specification after the date that the application is filed. Applicants should use [37 CFR 1.130\(a\)](#) to submit such information after filing.

### **2154.02(b) Prior Art Exception Under AIA 35 U.S.C. 102(b)(2)(B) to AIA 35 U.S.C. 102(a)(2) (Inventor-Originated Prior Public Disclosure Exception) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) provides a second exception to prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). This provision excepts as prior art subject matter that was effectively filed by another after the subject matter had been publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. The [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) exception may possibly apply to any U.S. patent document, regardless of its potential prior art date under [AIA 35 U.S.C. 102\(a\)\(2\)](#). In other words, there is no grace period limitation to the applicability of the [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) exception.

Specifically, [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) provides that a disclosure which would otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) (a U.S. patent, U.S. patent application publication, or WIPO published application (“U.S. patent document”)) is excepted as prior art if the subject matter disclosed had been previously publicly disclosed by the inventor, a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor. If a previous inventor-originated public disclosure is not within the grace period of [AIA 35 U.S.C. 102\(b\)\(1\)](#), it would qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#), and could not be excepted under [AIA 35 U.S.C. 102\(b\)\(1\)](#). [MPEP § 2155.02](#) discusses the

use of affidavits or declarations to show a prior public disclosure of the subject matter by the inventor or a joint inventor, and [MPEP § 2155.03](#) discusses the use of affidavits or declarations to show a prior public disclosure of the subject matter by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Similar to the previous discussion of [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#), the exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) applies if the “subject matter disclosed [in the intervening disclosure] had, before such [intervening] disclosure was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter directly or indirectly from the inventor or joint inventor.” The exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) focuses on the “subject matter” that had been publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor). There is no requirement under [35 U.S.C. 102\(b\)\(2\)\(B\)](#) that the mode of prior disclosure by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor) be the same as the mode of disclosure of the intervening U.S. patent document (e.g., patenting, publication, public use, sale activity). There is also no requirement that the prior disclosure by the inventor or a joint inventor be a verbatim or *ipsisimis verbis* disclosure of the intervening U.S. patent document. What is required for subject matter in the intervening U.S. patent document to be excepted under [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) is that the subject matter must have been previously publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor). The subject matter in the prior disclosure being relied upon under [AIA 35 U.S.C. 102\(a\)](#) must be the same “subject matter” as the subject matter previously publicly disclosed by the inventor for the exceptions in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [102\(b\)\(2\)\(B\)](#) to apply. The exceptions in [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [102\(b\)\(2\)\(B\)](#) do not apply even if the only differences between the subject matter in the prior art disclosure that is relied upon under [AIA 35 U.S.C. 102\(a\)](#) and the subject matter previously

publicly disclosed by the inventor are mere insubstantial changes, or only trivial or obvious variations. This guidance maintains the identical subject matter interpretation of [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [102\(b\)\(2\)\(B\)](#).

The exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) applies only to the subject matter in the intervening U.S. patent document being relied upon for a rejection under [AIA 35 U.S.C. 102\(a\)\(2\)](#) that was also publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor) before the date the subject matter relied upon was effectively filed. The subject matter of an intervening U.S. patent document that was not previously publicly disclosed by the inventor or a joint inventor (or by another who obtained the subject matter from the inventor or joint inventor) is available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). For example, if the inventor or a joint inventor had publicly disclosed A, B, and C, and a subsequent intervening U.S. patent document discloses A, B, C, and D, then D of the intervening U.S. patent document remains available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). In other words, the exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) does not necessarily remove the entire disclosure in the intervening reference from being prior art.

In addition, if subject matter of an intervening U.S. patent document is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor (or another who obtained the subject matter directly or indirectly from the inventor or joint inventor), the exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) applies to such subject matter of the intervening U.S. patent document. To hold otherwise would unfairly deprive an inventor of a patent merely because a third party became aware of the inventor's public disclosure and then filed a patent application disclosing a genericized version of it. For example, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening U.S. patent document discloses a genus (i.e., provides a more generic disclosure of the species), the disclosure of the genus in the intervening U.S. patent document is not available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). Conversely, if the inventor or a joint inventor had

publicly disclosed a genus, and a subsequent intervening U.S. patent document discloses a species, the disclosure of the species in the subsequent intervening U.S. patent document would be available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). Likewise, if the inventor or a joint inventor had publicly disclosed a species, and a subsequent intervening U.S. patent document discloses an alternative species not also disclosed by the inventor or a joint inventor, the disclosure of the alternative species in the intervening U.S. patent document would be available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) because the "subject matter disclosed" requirement of [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) would not have been met.

Finally, [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) does not discuss "the claimed invention" with respect to either the subject matter disclosed by the inventor or a joint inventor, or the subject matter of the subsequent intervening U.S. patent document. The only inquiry with respect to the claimed invention is whether or not the subject matter in the prior art disclosure being relied upon anticipates or renders obvious the claimed invention. A determination of whether the exception in [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) is applicable to subject matter in an intervening U.S. patent document does not involve a comparison of the subject matter of the claimed invention to either the subject matter disclosed by the inventor or a joint inventor, or to the subject matter of the subsequent intervening U.S. patent document.

Applicants can include a statement in the specification upon filing regarding any inventor-originated public disclosures of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of that same subject matter. See [37 CFR 1.77\(b\)\(6\)](#) and [MPEP § 608.01\(a\)](#). In order to be effective to show that a potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of subject matter is not prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) because the [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) exception applies, the statement must convey the same information as would be required in a declaration under [37 CFR 1.130\(b\)](#). See [MPEP §§ 717.01\(b\)\(1\)](#), [2155.02](#), and [2155.03](#). An applicant is not required to identify any inventor-originated public disclosures of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of that same subject matter, or

to use the format specified in [37 CFR 1.77\(b\)\(6\)](#), but identifying any such public disclosures may expedite examination of the application and save applicants (and the Office) the costs related to an Office action and reply. If the patent application specification as filed contains a specific reference to an inventor-originated public disclosure of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of that same subject matter, and an oath or declaration under [37 CFR 1.63](#) from the inventor or the appropriate joint inventor(s) has been made of record, the Office will consider it apparent from the specification that the potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of the same subject matter is not in fact prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#), provided there is a sufficient explanation of why the exception applies to a particular disclosure and there is no other evidence to the contrary. The applicant must also provide a copy of the prior inventor-originated public disclosure if it was made by way of a printed publication; see [37 CFR 1.130\(b\)\(1\)](#). Applicants may not use [37 CFR 1.77\(b\)\(6\)](#) to add information to the specification about inventor-originated public disclosures of subject matter made prior to a potential [AIA 35 U.S.C. 102\(a\)\(2\)](#) disclosure of that same subject matter after the date that the application is filed. Applicants should use [37 CFR 1.130\(b\)](#) to submit such information after filing.

**2154.02(c) Prior Art Exception Under AIA 35 U.S.C. 102(b)(2)(C) to AIA 35 U.S.C. 102(a)(2) (Common Ownership or Obligation of Assignment) [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) provides a third exception to the prior art provisions of [AIA 35 U.S.C. 102\(a\)\(2\)](#). The exception of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) excepts subject matter disclosed in a U.S. patent, U.S. patent application publication, or WIPO published application (“U.S. patent

document”) from constituting prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) if the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, “were owned by the same person or subject to an obligation of assignment to the same person.” The [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception may possibly apply to any U.S. patent document, regardless of its potential prior art date under [AIA 35 U.S.C. 102\(a\)\(2\)](#). In other words, there is no grace period limitation to the applicability of the [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception.

[AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) resembles [pre-AIA 35 U.S.C. 103\(c\)](#) in that both concern common ownership, and offer an avenue by which an applicant may avoid certain disclosures that are commonly owned or deemed commonly owned. However, there are significant differences between [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [pre-AIA 35 U.S.C. 103\(c\)](#). If the provisions of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) are met, a U.S. patent document that might otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#) is not available as prior art under either [AIA 35 U.S.C. 102](#) or [103](#). This differs from [pre-AIA 35 U.S.C. 103\(c\)](#) in which prior art can preclude patentability under [pre-AIA 35 U.S.C. 102](#), even if the conditions of [pre-AIA 35 U.S.C. 103\(c\)](#) are met. The consequence of this distinction is that a published application or an issued patent that falls under the common ownership exception of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) may not be applied in either an anticipation or an obviousness rejection.

It is important to note the circumstances in which the [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception does not remove a U.S. patent document as a basis for a rejection. The [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception does not apply to a disclosure that qualifies as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) (disclosures made before the effective filing date of the claimed invention). Thus, if the publication date or issue date of a U.S. patent document is before the effective filing date of the claimed invention, it may be prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#), regardless of common ownership or the existence of an obligation to assign. Also, even if a U.S. patent or U.S. published application is not prior art under [AIA 35 U.S.C. 102](#) or [103](#) as a result of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#), a double patenting rejection (either

statutory under [35 U.S.C. 101](#) or non-statutory, sometimes called obviousness-type) may still be made on the basis of the claims of the U.S. patent or U.S. patent application publication. Furthermore, the U.S. patent document that does not qualify as prior art as a result of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) may still be cited, in appropriate situations, to indicate the state of the art when making a lack of enablement rejection under [35 U.S.C. 112\(a\)](#). A document does not need to qualify as prior art in order for its claims to provide the basis for a statutory or nonstatutory double patenting rejection. See, for example, [MPEP § 804.03](#). However, a secondary reference used in a nonstatutory double patenting rejection must be prior art; thus, when the [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception applies, a document cannot be used in this capacity.

The Office revised the rules of practice to include provisions that pertain to commonly owned or joint research agreement subject matter ([37 CFR 1.104\(c\)\(4\)](#) and [\(c\)\(5\)](#)). [37 CFR 1.104\(c\)\(4\)](#) applies to an application that is subject to [AIA 35 U.S.C. 102](#) and [35 U.S.C. 103](#), and [37 CFR 1.104\(c\)\(5\)](#) applies to an application that is subject to [pre-AIA 35 U.S.C. 102](#) and [103](#). Commonly owned subject matter under [AIA 35 U.S.C. 102](#) and [103](#) is treated under [37 CFR 1.104\(c\)\(4\)\(i\)](#), and commonly owned subject matter under [pre-AIA 35 U.S.C. 102](#) and [103](#) is treated under [37 CFR 1.104\(c\)\(5\)\(i\)](#). See [MPEP § 2146.01](#).

A clear and conspicuous statement by the applicant (or the applicant's representative) that the claimed invention of the application under examination and the subject matter disclosed in the U.S. patent document applied as prior art were owned by the same person or subject to an obligation of assignment to the same person not later than the effective filing date of the claimed invention will be sufficient to establish that the [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception applies. Likewise, when relying on the provisions of [pre-AIA 35 U.S.C. 103\(c\)](#), the applicant (or the applicant's representative) can provide a similar statement required to disqualify the cited prior art. The applicant may present supporting evidence such as copies of assignment documents, but is not required to do so. Furthermore, the Office will not request corroborating evidence in the absence of independent

evidence which raises doubt as to the veracity of such a statement. The statement under [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) will generally be treated by Office personnel analogously to statements made under [pre-AIA 35 U.S.C. 103\(c\)](#). See [MPEP § 2146.02](#), subsection II. In order to comply with the rules, a statement is required regardless of any assignment information that may have been recorded in the assignment database maintained by the Office.

## 2155 Use of Affidavits or Declarations Under 37 CFR 1.130 To Overcome Prior Art Rejections [R-07.2022]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

### **37 CFR 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.**

(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.

(b) *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. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was 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.

(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.

(2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed



on that date 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.

(c) *When this section is not available*. The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, in which case an applicant or a patent owner may file a petition for a derivation proceeding pursuant to [§ 42.401](#) *et seq.* of this title.

(d) *Applications and patents to which this section is applicable*. The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to a claimed invention that has an effective filing date as defined in [§ 1.109](#) that is on or after March 16, 2013; or

(2) A specific reference under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in [§ 1.109](#) that is on or after March 16, 2013.

The Office has provided a mechanism in [37 CFR 1.130](#) for filing an affidavit or declaration to establish that a disclosure is not prior art under [AIA 35 U.S.C. 102\(a\)](#) due to an exception in [AIA 35 U.S.C. 102\(b\)](#). Under [37 CFR 1.130\(a\)](#), an affidavit or declaration of attribution may be submitted to except a disclosure as prior art because it 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. Under [37 CFR 1.130\(b\)](#), an affidavit or declaration of prior public disclosure may be submitted to except an intervening disclosure as prior art if the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed in a U.S. patent, U.S. patent application publication, or WIPO published application, 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.

## 2155.01 Showing That the Disclosure Was Made by the Inventor or a Joint Inventor [R-07.2022]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) provides that a grace period disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if the disclosure was made by the inventor or a joint inventor. An applicant may show that a disclosure was made by the inventor or a joint inventor by way of an affidavit or declaration under [37 CFR 1.130\(a\)](#) (an affidavit or declaration of attribution). See *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) and [MPEP § 717.01\(a\)\(1\)](#). Where the authorship of the prior art disclosure includes the inventor or a joint inventor named in the application, an unequivocal statement from the inventor or a joint inventor that the inventor or joint inventor (or some combination of named inventors) invented the subject matter of the disclosure, accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence to the contrary. See *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). 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 except 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. However, an affidavit or declaration under [37 CFR 1.130\(a\)](#) that is only a naked assertion of inventorship and that fails to provide any context, explanation or evidence to support that assertion is insufficient. See *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017). See also *Ex parte Kroger*, 219 USPQ 370 (Bd. App. 1982) (affirming rejection notwithstanding declarations by the alleged actual

inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the nonapplicant author's inventorship). This is similar to the process for disqualifying a publication as not being by "others" discussed in [MPEP § 2132.01](#), except that [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) requires only that the disclosure be by the inventor or a joint inventor.

The following examples are provided for illustration only:

#### Example 1

On April 7, 2021, an attorney for AB Corp. files a U.S. nonprovisional patent application claiming subject matter X. Anwasha is the inventor named in a signed application data sheet (ADS), but there is no inventor's oath or declaration under [37 CFR 1.63](#) of record. The examiner finds a journal article disclosing subject matter X with a publication date of November 1, 2020, which is within the grace period. The journal article lists Anwasha and Bob as coauthors. There is no evidence of record to indicate that Bob did not invent subject matter X disclosed in the journal article. Accordingly, the examiner rejects the claim to X as being anticipated under [35 U.S.C. 102\(a\)\(1\)](#) by the journal article. In response to the prior art rejection, AB Corp.'s attorney files a declaration under [37 CFR 1.130\(a\)](#) signed by Anwasha averring that she is the sole inventor of the subject matter X disclosed in the article. Anwasha also explains in the declaration that Bob was a graduate student working under her direction and supervision and did not contribute to the conception of the claimed invention. In other words, Anwasha's declaration establishes that Bob was not a joint inventor of subject matter X.

The examiner should withdraw the rejection because the declaration establishes that the journal article is not prior art. Anwasha's declaration includes a statement that Anwasha invented X, so there is no need for the examiner to require a signed inventor's oath or declaration under [37 CFR 1.63](#) at this time in order to withdraw the rejection. Furthermore, the declaration properly includes a reasonable explanation of Bob's involvement with the journal article. A statement from Bob is not needed. There is no evidence in the record to suggest that Bob was a joint inventor of X.

#### Example 2

An attorney for AB Corp. files a U.S. patent application disclosing and claiming subject matter Y on June 2, 2021. Alexis is the inventor named in a signed ADS, but there is no inventor's oath or declaration under [37 CFR 1.63](#) on file. The examiner finds a U.S. patent application publication (PGPub) claiming subject matter Y and Z that was published on January 14, 2021, which is within the grace period. The PGPub lists Alexis and Mehdi as joint inventors. There is no evidence of record to indicate that Mehdi did not invent subject matter Y as disclosed and claimed in the PGPub to Alexis and Mehdi. Accordingly, the examiner rejects the claim to Y as being anticipated by the

PGPub under [35 U.S.C. 102\(a\)\(1\)](#) based on its publication date, and under [35 U.S.C. 102\(a\)\(2\)](#) based on its effectively filed date.

In response to the prior art rejections, AB Corp.'s attorney files a [37 CFR 1.130\(a\)](#) declaration signed by Alexis averring that she invented subject matter Y as disclosed and claimed in the PGPub. The examiner should maintain the rejections under both [35 U.S.C. 102\(a\)\(1\)](#) and [102\(a\)\(2\)](#) because the declaration fails to establish that Mehdi is not a joint inventor of Y. Alexis' declaration under [37 CFR 1.130\(a\)](#) does include a statement that Alexis invented Y, so there is no need for the examiner to require a signed inventor's oath or declaration under [37 CFR 1.63](#) at this time in order to withdraw the rejection. However, Alexis' declaration is ineffective because it lacks a reasonable explanation of Mehdi's role in the PGPub. If Alexis' declaration had stated that Mehdi was named as an inventor of the PGPub because Mehdi invented Z, the declaration would have been sufficient; a corroborating statement from Mehdi would not have been needed.

Note that in accordance with compact prosecution, it is appropriate in Example 2 for the examiner to reject under both sections of [35 U.S.C. 102\(a\)](#) because the U.S. patent document reference has a public availability date (that is, either a publication date or an issue date) within the grace period. If the [35 U.S.C. 102\(a\)\(1\)](#) date had been prior to the grace period, then no [35 U.S.C. 102\(a\)\(2\)](#) rejection over the same disclosure would have been necessary because no exception could possibly have applied to overcome the [35 U.S.C. 102\(a\)\(1\)](#) rejection. Given the facts of Example 2, however, an applicant's response could possibly establish an exception to overcome one of the rejections while allowing the examiner to maintain the other rejection. At the time that a rejection is made, the examiner cannot foresee how the applicant will respond. Thus, in order to conclude prosecution in a timely manner and avoid the possibility of an additional non-final action, the examiner should make both a [35 U.S.C. 102\(a\)\(1\)](#) rejection and a [35 U.S.C. 102\(a\)\(2\)](#) rejection when the [35 U.S.C. 102\(a\)\(1\)](#) date of a U.S. patent document is within the grace period year.

#### Example 3

On March 16, 2021, an attorney for Acme Corp. files a U.S. patent application claiming subject matter X. Ali is the inventor named in a signed ADS, but there is no inventor's oath or declaration under [37 CFR 1.63](#) on record. The examiner finds a September 10, 2021 U.S. patent application publication (PGPub) that names Ming as the inventor and that discloses but does not claim subject matter X. The effectively filed date of Ming's application is January 7, 2020, which is before Acme's filing date. Therefore, Ming's PGPub is potential prior art under [35 U.S.C. 102\(a\)\(2\)](#). However, Ming's PGPub is not potential prior art under [35 U.S.C. 102\(a\)\(1\)](#) because it published after Acme's filing date. The examiner should reject the claim to X under [35 U.S.C. 102\(a\)\(2\)](#) as being anticipated by Ming's PGPub. At the time of the rejection, the examiner has no information about Ali's interaction with Ming.

In the reply to the Office action, Acme's attorney files a declaration under [37 CFR 1.130\(a\)](#) signed by Ali to show that Ming's disclosure of X is not prior art because Ming learned

about X from Ali. The declaration from Ali explains the circumstances under which Ali privately told Ming about X. Ali's declaration does not state that Ali is the inventor of X.

The examiner should maintain the rejection under [35 U.S.C. 102\(a\)\(2\)](#) because the record fails to establish that Ali invented X. Specifically, Ali's [37 CFR 1.130\(a\)](#) declaration does not state that Ali invented X, and there is also no inventor's oath or declaration under [37 CFR 1.63](#) of record to establish that Ali invented X. Thus, although Ali told Ming about X, it is not clearly established on the record that Ali invented X. In order to establish that the exception under [35 U.S.C. 102\(b\)\(2\)\(A\)](#) applies and overcome the rejection, it is necessary to establish that Ali invented X. Acme's attorney could do that by submitting either a new declaration under [37 CFR 1.130\(a\)](#) which states that Ali invented X or an inventor's oath or declaration under [37 CFR 1.63](#) signed by Ali.

Note that, in this example, determining the grace period is not needed because the grace period is only relevant to potential prior art as of a public availability date. In other words, the grace period is only relevant when there is potential prior art under [35 U.S.C. 102\(a\)\(1\)](#). In this example, Ming's PGPub was not publicly available until after Acme Corp. filed the application claiming X. Therefore, Ming's PGPub was not prior art under [35 U.S.C. 102\(a\)\(1\)](#) and no exceptions involving the grace period can possibly apply.

#### Example 4

Similar to Example 3, on March 16, 2021, an attorney for Acme Corp. files a U.S. patent application claiming subject matter X. In contrast to Example 3, an inventor's oath or declaration under [37 CFR 1.63](#) signed by Ali is with the application. The examiner finds a U.S. patent to Gopal that issued on November 10, 2020 and discloses but does not claim subject matter X. Gopal's patent is potential prior art under [35 U.S.C. 102\(a\)\(1\)](#) because the issue date of Gopal's patent is before Acme's filing date and falls within the grace period. Accordingly, it is possible for an exception under [35 U.S.C. 102\(b\)\(1\)\(A\)](#) to apply. In addition, the effectively filed date of Gopal's application is also before Acme's filing date, so Gopal's patent is potential prior art under [35 U.S.C. 102\(a\)\(2\)](#) as well.

Similar to example 2, it is appropriate for the examiner to reject the claims to X as anticipated under both sections of [35 U.S.C. 102\(a\)](#) because the reference is a U.S. patent document having a public availability date (in this case, an issue date) that is within the grace period. The examiner should be aware that it is possible for the applicant to invoke a prior art exception under [35 U.S.C. 102\(b\)\(1\)\(A\)](#) and show that Gopal's patent is not prior art under [35 U.S.C. 102\(a\)\(1\)](#) but Gopal's patent still remains available as prior art under [35 U.S.C. 102\(a\)\(2\)](#). Therefore, the examiner should make anticipation rejections under both [35 U.S.C. 102\(a\)\(1\)](#) and [35 U.S.C. 102\(a\)\(2\)](#) in accordance with compact prosecution guidance. At the time of the rejection, the examiner has no information about Ali's interaction with Gopal.

In reply to the Office action, Acme's attorney files a [37 CFR 1.130\(a\)](#) declaration signed by Gopal averring that Ali told him

about subject matter X as disclosed in Gopal's patent. In the reply, Acme's attorney also calls the examiner's attention to the fact that an inventor's oath or declaration signed by Ali is already of record. Note that this example is similar to example 3, but here Gopal signs the [37 CFR 1.130\(a\)](#) declaration rather than Ali.

The examiner should withdraw the rejections under both [35 U.S.C. 102\(a\)\(1\)](#) and [102\(a\)\(2\)](#) based on the Gopal patent because the evidence of record establishes that the disclosure of X in Gopal's patent is attributable to Ali. In other words, there is evidence of record that Ali invented X and Gopal's disclosure originated with Ali. In view of Gopal's [37 CFR 1.130\(a\)](#) declaration, it is clear that Gopal did not invent X because the record shows that Gopal learned about it from Ali. Furthermore, there is an inventor's oath or declaration under [37 CFR 1.63](#), signed by Ali, of record in the application file. The above evidence shows that Ali is an inventor of X.

Note that, in this example, the fact that Gopal's patent did not claim X eliminates the possibility of derivation. If Gopal's patent did claim X, then derivation issues may be present. The PTAB will consider instituting a derivation proceeding when a patent applicant submits a petition under [37 CFR 42.402](#) alleging derivation by an earlier applicant or patentee.

### 2155.02 Showing That the Subject Matter Disclosed Had Been Previously Publicly Disclosed by the Inventor or a Joint Inventor [R-07.2022]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) provides that a grace period disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor. Similarly, [AIA 35 U.S.C. 102\(b\)\(2\)\(B\)](#) provides that a disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102\(a\)\(2\)](#) if the subject matter disclosed had, before such subject matter was effectively filed under [AIA 35 U.S.C. 102\(a\)\(2\)](#), been publicly disclosed by the inventor or a joint inventor. An applicant may show that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the

disclosure or effective filing date of the subject matter on which the rejection was based by way of an affidavit or declaration under [37 CFR 1.130\(b\)](#) (an affidavit or declaration of prior public disclosure). Specifically, the affidavit or declaration must identify the subject matter publicly disclosed and establish the date and content of their earlier public disclosure. If the earlier public disclosure is a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication in accordance with [37 CFR 1.130\(b\)\(1\)](#). If the earlier disclosure is not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter, as required by [37 CFR 1.130\(b\)\(2\)](#).

The manner of disclosure of subject matter referenced in an affidavit or declaration under [37 CFR 1.130\(b\)\(2\)](#) is not critical. Just as the prior art provision of [AIA 35 U.S.C. 102\(a\)\(1\)](#) encompasses any disclosure that renders a claimed invention “available to the public,” any manner of disclosure may be evidenced in an affidavit or declaration under [37 CFR 1.130\(b\)](#). That is, when using an affidavit or declaration under [37 CFR 1.130\(b\)](#) to except an intervening disclosure as prior art based on a prior public disclosure by an inventor or a joint inventor, it is not necessary for the subject matter to have been disclosed in the same manner or using the same words. For example, the inventor or a joint inventor may have publicly disclosed the subject matter in question via a slide presentation at a scientific meeting, while the intervening disclosure of the subject matter may have been made in a journal article. This difference in the manner of disclosure or differences in the words used to describe the subject matter will not preclude the inventor from submitting an affidavit or declaration under [37 CFR 1.130\(b\)](#) to except subject matter in the intervening disclosure (e.g., a journal article) as prior art.

The following examples are provided for illustration only:

#### Example 1

On May 18, 2021, an attorney for Acme Corp. files a U.S. patent application claiming subject matter X. An inventor’s oath or declaration under [37 CFR 1.63](#) signed by Maria is also filed with the application. During the prior art search, the examiner

finds a journal article authored by Keiko that published on March 16, 2021 and discloses the same subject matter X. The journal article by Keiko is publicly available before Acme’s filing date. Accordingly, the examiner should reject the claims to X as being anticipated by Keiko under [35 U.S.C. 102\(a\)\(1\)](#). At the time of the rejection, the examiner has no information about Maria’s prior public disclosure.

In reply to the Office action, Acme’s attorney files a [37 CFR 1.130\(b\)](#) declaration signed by Maria averring that she had disclosed X at a virtual conference on June 7, 2020, which is prior to the public availability date of Keiko’s disclosure of X in the journal article. The reply also includes a copy of Maria’s presentation slides at the virtual conference. In addition, the reply calls the examiner’s attention to the inventor’s oath or declaration signed by Maria that is already of record.

The examiner should withdraw the anticipation rejection under [35 U.S.C. 102\(a\)\(1\)](#) because the evidence of record establishes that Maria had made a prior public disclosure of the same subject matter disclosed in Keiko’s journal article. It is important to note that if a prior public disclosure is made by a printed publication, [37 CFR 1.130\(b\)\(1\)](#) requires that a copy be included with the declaration. Acme has complied with this requirement by supplying a copy of the conference presentation slides. Furthermore, the application file includes an inventor’s oath or declaration under [37 CFR 1.63](#) signed by Maria. Therefore, the record contains sufficient evidence that Maria is the inventor of X. Finally, it is clear that Maria disclosed the same subject matter as Keiko because both disclosed X.

#### Example 2

This example has the same facts as example 1 above, but in this example, the journal article to Keiko discloses not only X, but also Y and a genus that encompasses both X and Y. As in example 1, the examiner should make an anticipation rejection under [35 U.S.C. 102\(a\)\(1\)](#) for the claims to X.

At the time of the rejection, the examiner has no information about Maria’s prior public disclosure and cannot predict how the applicant will respond. Thus, in order to conclude prosecution in a timely manner and avoid the possibility of an additional non-final action, the examiner should consider whether Acme’s claim to X can be rejected as obvious over Keiko’s disclosure of Y. The disclosure of Y by Keiko is still available as prior art because Maria’s disclosure of X is not the same subject matter as Keiko’s disclosure of Y. If the applicant shows that the Keiko’s disclosure of X and the genus that encompasses X and Y is not prior art in response to the rejection, the examiner could maintain the obviousness rejection based on Keiko’s disclosure of Y and make the next Office action final, unless it is not appropriate for other reasons. Stated another way, the second Office action cannot be made final if a new obviousness rejection based on Keiko’s disclosure of Y is made in response to the filing of the [37 CFR 1.130\(b\)](#) declaration, assuming Acme did not amend the claims.

Note that Maria’s prior public disclosure of X is considered to be the same subject matter as Keiko’s later disclosed genus that



includes X, in the same sense that a species can be said to anticipate a genus. In other words, the inventor is not penalized just because a third party sees the inventor's disclosure and then re publicizes it in a more generalized fashion.

### **2155.03 Showing That the Disclosure was Made, or That Subject Matter had Been Previously Publicly Disclosed, by Another Who Obtained the Subject Matter Disclosed Directly or Indirectly From the Inventor or a Joint Inventor [R-01.2024]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

[AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) and [102\(b\)\(2\)\(A\)](#) provide similar treatment for disclosures of subject matter by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Specifically, [AIA 35 U.S.C. 102\(b\)\(1\)\(A\)](#) provides that a grace period disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102\(a\)\(1\)](#) if the disclosure was made by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, and [AIA 35 U.S.C. 102\(b\)\(2\)\(A\)](#) provides that a disclosure shall not be prior art to a claimed invention under [AIA 35 U.S.C. 102\(a\)\(2\)](#) if the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

In addition, [AIA 35 U.S.C. 102\(b\)\(1\)\(B\)](#) and [102\(b\)\(2\)\(B\)](#) respectively provide that a grace period disclosure under [AIA 35 U.S.C. 102\(a\)\(1\)](#), and that a disclosure under [AIA 35 U.S.C. 102\(a\)\(2\)](#) shall not be prior art to a claimed invention, if the subject matter disclosed had, before such grace period disclosure was made under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or before such subject matter was effectively filed according to [35 U.S.C. 102\(a\)\(2\)](#), been publicly disclosed by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An applicant may also show that another obtained the subject matter disclosed directly

or indirectly from the inventor or a joint inventor in an affidavit or declaration under [37 CFR 1.130\(b\)](#). Thus, an applicant may establish a prior public disclosure by another if the applicant can establish that subject matter disclosed originated with the inventor or a joint inventor and that the subject matter was communicated by the inventor or a joint inventor, directly or indirectly. Any documentation which provides evidence of the communication of the subject matter by the inventor or a joint inventor to the entity that made the disclosure of the subject matter directly or indirectly, such as by an assignee of the inventor, should accompany the affidavit or declaration.

### **2155.04 Enablement [R-11.2013]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102.](#)]*

An affidavit or declaration under [37 CFR 1.130\(a\)](#) or [\(b\)](#) need not demonstrate that the disclosure by the inventor, a joint inventor, or another who obtained the subject matter disclosed directly or indirectly from an inventor or a joint inventor was an “enabling” disclosure of the subject matter within the meaning of [35 U.S.C. 112\(a\)](#). Rather, an affidavit or declaration under [37 CFR 1.130](#) must show that: (1) the disclosure in question 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 ([37 CFR 1.130\(a\)](#)); or (2) 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 ([37 CFR 1.130\(b\)](#)).

### 2155.05 Who May File an Affidavit or Declaration Under 37 CFR 1.130 [R-01.2024]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

In accordance with [37 CFR 1.130](#), the applicant or patent owner may submit an affidavit or declaration. When an assignee, obligated assignee, or person showing sufficient proprietary interest is the applicant under [35 U.S.C. 118](#) rather than the inventor, the applicant or their representative must be the party that files the affidavit or declaration under [37 CFR 1.130](#) even if the inventor or any party with knowledge of the relevant facts signed the affidavit or declaration. In other words, the affidavit or declaration must be filed by a party having authority to take action in the application. Authority to file papers in an application generally does not lie with the inventor if the inventor is not the applicant. See [MPEP § 717.01\(c\)](#).

### 2155.06 Situations in Which an Affidavit or Declaration Is Not Available [R-01.2024]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#).]*

The provisions of [37 CFR 1.130](#) are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. A disclosure made more than one year before the effective filing date of a claimed invention is prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) that cannot be excepted as prior art under [AIA 35 U.S.C. 102\(b\)\(1\)](#).

Additionally, the provisions of [37 CFR 1.130](#) may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication naming another inventor if: (1) the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention; and (2) the affidavit or declaration contends that the inventor or a joint inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent. The provisions of [37 CFR 1.130](#) are not available if an affidavit or declaration would result in the Office issuing or confirming two patents containing patentably indistinct claims to two different parties. See *In re Deckler*, 977 F.2d 1449, 1451-52, 24 USPQ2d 1448, 1449 (Fed. Cir. 1992) ([35 U.S.C. 102](#), [103](#), and [135](#) “clearly contemplate—where different inventive entities are concerned—only one patent should issue for inventions which are either identical to or not patentably distinct from each other”) (quoting *Aelony v. Arni*, 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977)). In this situation, an applicant or patent owner may file a petition for a derivation proceeding pursuant to [37 CFR 42.401](#) et seq. ([37 CFR 1.130\(c\)](#)).

### 2156 Joint Research Agreements [R-01.2024]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159](#) et seq. to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2131-MPEP § 2138](#) and [MPEP § 2146](#) for examination of applications subject to [pre-AIA 35 U.S.C. 102](#) and [35 U.S.C. 103](#).]*

#### 35 U.S.C. 102 Conditions for patentability; novelty.

\*\*\*\*\*

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

\*\*\*\*\*

[AIA 35 U.S.C. 102\(c\)](#) provides three conditions that must be satisfied in order for subject matter disclosed which might otherwise qualify as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#), and a claimed invention, to be treated as having been owned by the same person or subject to an obligation of assignment to the same person (i.e., deemed common ownership) in applying common ownership provisions of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) in the context of a joint research agreement. First, the subject matter disclosed must have been developed and the claimed invention must have been made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention. See [35 U.S.C. 102\(c\)\(1\)](#). The AIA defines the term “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. See [35 U.S.C. 100\(h\)](#). Second, the claimed invention must have been made as a result of activities undertaken within the scope of the joint research agreement. See [35 U.S.C. 102\(c\)\(2\)](#). Third, the application for patent for the claimed invention must disclose, or be amended to disclose, the names of the parties to the joint research agreement. See [35 U.S.C. 102\(c\)\(3\)](#). Joint research agreement subject matter under [AIA 35 U.S.C. 102](#) and [103](#) is treated under [37 CFR 1.104\(c\)\(4\)\(ii\)](#). If these conditions are met, the joint research agreement subject matter is not available as prior art under [AIA 35 U.S.C. 102\(a\)\(2\)](#). See [MPEP § 717.02\(b\)](#), subsection IV, for the requirements to establish a joint research agreement, including when the processing fee under [37 CFR 1.71\(g\)\(2\)](#) is required.

The provisions of [AIA 35 U.S.C. 102\(c\)](#) generally track those of the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act). See [MPEP § 2146.01](#). The major differences between [AIA 35 U.S.C. 102\(c\)](#) and the CREATE

Act are that: (1) the AIA provision is keyed to the effective filing date of the claimed invention, while the CREATE Act focuses on the date that the claimed invention was made; and (2) the CREATE Act provisions only apply to obviousness rejections and not to anticipation rejections.

In order to invoke a joint research agreement to except a disclosure as prior art, the applicant (or the applicant's representative) must provide a statement that the disclosure of the subject matter on which the rejection is based and the claimed invention were made by or on behalf of parties to a joint research agreement under [AIA 35 U.S.C. 102\(c\)](#). The statement must also assert that the agreement was in effect on or before the effective filing date of the claimed invention, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. The statement should either be on or begin on a separate sheet and must not be directed to other matters ([37 CFR 1.4\(c\)](#)). The statement must be signed in accordance with [37 CFR 1.33\(b\)](#). See [MPEP § 717.02\(a\)](#), subsection II. If the names of the parties to the joint research agreement are not already stated in the application, it is necessary to amend the application to include the names of the parties to the joint research agreement in accordance with [37 CFR 1.71\(g\)](#). The amendment to include the names of the parties must be accompanied by a processing fee set in [37 CFR 1.17\(i\)](#) unless it is filed within one of the time periods set forth in [37 CFR 1.17\(g\)\(2\)](#). See [MPEP § 717.02\(b\)](#), subsection IV. An amendment limited to adding the names of the parties to the joint research agreement does not constitute new matter.

As is the case with establishing common ownership, the applicant may, but is not required to, present evidence supporting the existence of the joint research agreement. Furthermore, the Office will not request corroborating evidence in the absence of independent evidence which raises doubt as to the existence or nature of the joint research agreement.

As discussed previously, the [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception does not apply to a disclosure that qualifies as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) (public disclosures and certain non-public sales (see [MPEP § 2133.03](#)) made before the

effective filing date of the claimed invention). Thus, if the issue date or publication date of a U.S. patent document is before the effective filing date of the claimed invention, it may be prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#), regardless of the fact that the claimed invention resulted from a joint research agreement and the disclosure was by a party to the agreement.

## 2157 Improper Naming of Inventors [R-01.2024]

Although the AIA eliminated [pre-AIA 35 U.S.C. 102\(f\)](#), the patent laws still require the naming of the inventor of the claimed subject matter. See [35 U.S.C. 115\(a\)](#) (“[a]n application for patent that is filed under [\[35 U.S.C.\] 111\(a\)](#) or commences the national stage under [\[35 U.S.C.\] 371](#) shall include, or be amended to include, the name of the inventor for any invention claimed in the application”). The Office generally presumes that the named inventor in the application is the actual inventor to be named on the patent. See [MPEP § 2109](#). However, see the examples in [MPEP §§ 2155.01](#) and [2155.02](#) regarding the need to establish inventorship on the record in connection with an affidavit or declaration under [37 CFR 1.130](#). A situation in which an application names a person who is not the actual inventor or a joint inventor as the inventor or a joint inventor will be handled in a derivation proceeding under [35 U.S.C. 135](#) (see [MPEP §§ 2310-2315](#)), by a correction of inventorship under [37 CFR 1.48](#), or through a rejection under [35 U.S.C. 101](#) and [35 U.S.C. 115](#), as appropriate.

Where an application names an incorrect inventorship, the applicant should submit a request to correct inventorship under [37 CFR 1.48](#). See [MPEP § 602.01\(c\)](#) *et seq.* In the rare situation where it is clear that the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship under [37 CFR 1.48](#), Office personnel should reject the claims under [35 U.S.C. 101](#) and [35 U.S.C. 115](#).

Use Form Paragraph 7.04.02.aia to reject claims under [35 U.S.C. 101](#) and [115](#) for failing to set forth the correct inventorship.

### ¶ 7.04.101.aia Statement of Statutory Bases, 35 U.S.C. 101 and 35 U.S.C. 115— Improper Inventorship

[35 U.S.C. 101](#) reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[35 U.S.C. 115\(a\)](#) reads as follows (in part):

An application for patent that is filed under section [111\(a\)](#) or commences the national stage under section [371](#) shall include, or be amended to include, the name of the inventor for any invention claimed in the application.

The present application sets forth the incorrect inventorship because [1].

#### Examiner Note:

1. If form paragraph 7.04.01 is already being used for a rejection that is not based on improper inventorship, then in lieu of this form paragraph, use form paragraph 7.04.102.aia with form paragraph 7.04.01 for a rejection based on improper inventorship.
2. In bracket 1, insert the basis for concluding that the inventorship is incorrect.
3. This form paragraph must be followed by form paragraph 7.04.02.aia.

### ¶ 7.04.102.aia Statement of Statutory Basis, 35 U.S.C. 115— Improper Inventorship

[35 U.S.C. 115\(a\)](#) reads as follows (in part):

An application for patent that is filed under section [111\(a\)](#) or commences the national stage under section [371](#) shall include, or be amended to include, the name of the inventor for any invention claimed in the application.

The present application sets forth the incorrect inventorship because [1].

#### Examiner Note:

1. This form paragraph is to be used ONLY when a rejection under [35 U.S.C. 101](#) on another basis has been made and the statutory text thereof is already present.
2. This form paragraph must be preceded by form paragraph 7.04.01 for a rejection based on improper inventorship.
3. In bracket 1, insert an explanation of the supporting evidence establishing that an improper inventor is named.

### ¶ 7.04.02.aia Rejection, 35 U.S.C. 101/115

Claim [1] rejected under [35 U.S.C. 101](#) and [35 U.S.C. 115](#) for failing to set forth the correct inventorship for the reasons stated above.



**Examiner Note:**

1. In bracket 1, pluralize “Claim” if necessary, insert “is” or “are” as appropriate, and insert the claim number(s) which are under rejection.
2. This rejection must be preceded by either form paragraph 7.04.101.aia or 7.04.102.aia.

Note that a rejection under [pre-AIA 35 U.S.C. 102\(f\)](#) should not be made if the application is subject to examination under the first inventor to file (FITF) provisions of the AIA. See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2137](#) for information pertaining to [pre-AIA 35 U.S.C. 102\(f\)](#).

**2158 AIA 35 U.S.C. 103 [R-07.2022]**

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100](#) (note). See [MPEP § 2159](#) *et seq.* to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2141-MPEP § 2146](#) for information on [pre-AIA 35 U.S.C. 103](#) and [AIA 35 U.S.C. 103](#).]*

[AIA 35 U.S.C. 103](#) sets forth the nonobviousness requirement for patentability. There are, however, some important changes from [pre-AIA 35 U.S.C. 103](#).

The most significant difference between the [AIA 35 U.S.C. 103](#) and [pre-AIA 35 U.S.C. 103\(a\)](#) is that [AIA 35 U.S.C. 103](#) determines obviousness before the effective filing date of the claimed invention, rather than as of the time that the claimed invention was made. Under pre-AIA examination practice, the Office uses the effective filing date as a proxy for the invention date, unless there is evidence of record to establish an earlier date of invention. Thus, as a practical matter during examination, this distinction between the [AIA 35 U.S.C. 103](#) and [pre-AIA 35 U.S.C. 103](#) will result in a difference in practice only when the case under examination is subject to [pre-AIA 35 U.S.C. 103](#), and there is evidence in the case concerning a date of invention prior to the effective filing date. Such evidence is ordinarily presented by way of an affidavit or declaration under [37 CFR 1.131](#).

Next, the language of [AIA 35 U.S.C. 103](#) differs from that of [pre-AIA 35 U.S.C. 103](#) in that [AIA 35 U.S.C. 103](#) requires consideration of “the differences between the claimed invention and the prior art,” while [pre-AIA 35 U.S.C. 103](#) refers to “the differences between the subject matter sought to be patented and the prior art.” This difference in terminology does not indicate the need for any difference in approach to the question of obviousness. As pointed out by the Federal Circuit, “[t]he term ‘claims’ has been used in patent legislation since the Patent Act of 1836 to define the invention that an applicant believes is patentable.” *Hoechst-Roussel Pharms., Inc. v. Lehman*, 109 F.3d 756, 758, 42 USPQ2d 1220, 1222 (Fed. Cir. 1997) (citing Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117). Furthermore, in *Graham v. John Deere*, the second of the Supreme Court’s factual inquiries (the “Graham factors”) is that the “differences between the prior art and the claims at issue are to be ascertained.” 383 U.S. 1, 17, 148 USPQ 459, 467. Thus, in interpreting [35 U.S.C. 103](#) as enacted in the 1952 Patent Act—language that remained unchanged until enactment of the AIA—the Court equated “the subject matter sought to be patented” with the claims.

Further, [AIA 35 U.S.C. 103](#) does not contain any provision similar to [pre-AIA 35 U.S.C. 103\(b\)](#). [Pre-AIA 35 U.S.C. 103\(b\)](#) is narrowly drawn, applying only to nonobviousness of biotechnological inventions, and even then, only when specifically invoked by the patent applicant. [Pre-AIA 35 U.S.C. 103\(b\)](#) provides that under certain conditions, “a biotechnological process using or resulting in a composition of matter that is novel under [section 102](#) and nonobvious under subsection [\[103\(a\)\]](#) of this section shall be considered nonobvious.” In view of the case law since 1995, the need to invoke [pre-AIA 35 U.S.C. 103\(b\)](#) has been rare. As stated in [MPEP § 2147](#), in view of the Federal Circuit’s decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), the need to invoke [pre-AIA 35 U.S.C. 103\(b\)](#) rarely arose. Those cases continue to retain their validity under the AIA.

[AIA 35 U.S.C. 103](#) also eliminates [pre-AIA 35 U.S.C. 103\(c\)](#), but corresponding provisions have been introduced in [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [102\(c\)](#). [Pre-AIA 35 U.S.C. 103\(c\)](#) applied if subject

matter qualified as prior art only under [pre-AIA 35 U.S.C. 102\(e\)](#), [\(f\)](#), and/or [\(g\)](#), and only in the context of obviousness under [pre-AIA 35 U.S.C. 103\(a\)](#). If subject matter developed by another person was commonly owned with the claimed invention, or if the subject matter was subject to an obligation of assignment to the same person, at the time the claimed invention was made, then [pre-AIA 35 U.S.C. 103\(a\)](#) did not preclude patentability. Furthermore, under [pre-AIA 35 U.S.C. 103\(c\)](#), if a joint research agreement was in place on or before the date that the claimed invention was made, the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and the application for patent disclosed or was amended to disclose the names of the parties to the joint research agreement, common ownership or an obligation to assign was deemed to exist. As discussed previously, [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [102\(c\)](#) expand on this concept. Under the AIA, the common ownership, obligation to assign, or joint research agreement must exist on or before the effective filing date of the claimed invention, rather than on or before the date the invention was made. If the provisions of [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) are met, a disclosure is not prior art at all, whereas under [pre-AIA 35 U.S.C. 103\(c\)](#), certain prior art merely was defined as not precluding patentability. Finally, disclosures excepted as prior art under [AIA 35 U.S.C. 102\(b\)\(2\)\(C\)](#) and [102\(c\)](#) may not be applied in either an anticipation or an obviousness rejection, or as a secondary reference in a non-statutory double patenting rejection. In short, when an exception applies under the AIA, a reference may not be used for any purpose which requires prior art. However, the claims of such disclosures could be the basis for statutory double patenting or non-statutory double patenting rejections.

Generally speaking, and with the exceptions noted herein, pre-AIA notions of obviousness continue to apply under the AIA. [AIA 35 U.S.C. 102\(a\)](#) defines what is prior art both for purposes of novelty under [AIA 35 U.S.C. 102](#) as well as for purposes of obviousness under [AIA 35 U.S.C. 103](#). See *Hazeltine Res., Inc. v. Brenner*, 382 U.S. 252, 256, 147 USPQ 429, 430 (1965) (a previously filed patent application to another pending in the Office, but not patented or published, at the time an application is filed constitutes part of the “prior art” within the meaning

of [35 U.S.C. 103](#)). Thus, if a document qualifies as prior art under [AIA 35 U.S.C. 102\(a\)\(1\)](#) or [\(a\)\(2\)](#), and is not subject to an exception under [AIA 35 U.S.C. 102\(b\)](#), it may be applied for what it describes or teaches to those skilled in the art in a rejection under [AIA 35 U.S.C. 103](#). This is in accordance with pre-AIA case law indicating that in making determinations under [35 U.S.C. 103](#), “it must be known whether a patent or publication is in the prior art under [35 U.S.C. 102](#).” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). However, while a disclosure must enable those skilled in the art to make the invention in order to anticipate under [35 U.S.C. 102](#), a non-enabling disclosure is prior art for all it teaches for purposes of determining obviousness under [35 U.S.C. 103](#). *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991); *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989) (“Even if a reference discloses an inoperative device, it is prior art for all that it teaches.”). Office personnel should continue to follow guidance for formulating an appropriate rationale to support any conclusion of obviousness. See [MPEP § 2141](#) *et seq.* and the guidance documents available at <https://www.uspto.gov/PatentExaminationGuidance>.

## 2158.01 Form Paragraphs for Use in Rejections Under AIA 35 U.S.C. 103 [R-07.2022]

The following form paragraphs should be used in making the appropriate rejections under [35 U.S.C. 103](#).

### ¶ 7.06 Notice re prior art available under both pre-AIA and AIA

In the event the determination of the status of the application as subject to AIA [35 U.S.C. 102](#) and [103](#) (or as subject to [pre-AIA 35 U.S.C. 102](#) and [103](#)) is incorrect, any correction of the statutory basis (i.e., changing from AIA to pre-AIA) for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

#### Examiner Note:

1. This form paragraph must be used in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013, that claims priority to, or the benefit of, an application filed before March 16, 2013.

2. This form paragraph should only be used ONCE in an Office action.

**¶ 7.20.aia Statement of Statutory Basis, 35 U.S.C. 103**

The following is a quotation of [35 U.S.C. 103](#) which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section [102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. The statute is not to be cited in all Office actions. It is only required in first actions on the merits employing [35 U.S.C. 103](#) and final rejections. Where the statute is being applied, but is not cited in an action on the merits, use paragraph 7.103.
3. This form paragraph should only be used ONCE in a given Office action.
4. This form paragraph must precede any of form paragraphs 7.20.01.aia, 7.20.02.aia, 7.20.04.aia, 7.20.05.aia, 7.21.aia, 7.21.01.aia, 7.21.02.aia, and 7.22.aia when this form paragraph is used to cite the statute in first actions and final rejections.

**¶ 7.20.01.aia 103 Rejection Using Prior Art Excepted Under 102(b)(2)(C) Because Reference is Prior Art Under 102(a)(1)**

Applicant has provided a submission in this file that the claimed invention and the subject matter disclosed in the prior art reference were owned by, or subject to an obligation of assignment to, the same entity as [1] not later than the effective filing date of the claimed invention, or the subject matter disclosed in the prior art reference was developed and the claimed invention was made by, or on behalf of one or more parties to a joint research agreement not later than the effective filing date of the claimed invention. However, although subject matter disclosed in the reference [2] has been excepted as prior art under [35 U.S.C. 102\(a\)\(2\)](#), it is still applicable as prior art under [35 U.S.C. 102\(a\)\(1\)](#) that cannot be excepted under [35 U.S.C. 102\(b\)\(2\)\(C\)](#).

Applicant may overcome this rejection under [35 U.S.C. 102\(a\)\(1\)](#) by a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application, and is therefore, not prior art as set forth in [35 U.S.C. 102\(b\)\(1\)\(A\)](#). Alternatively, applicant may rely on the exception under [35 U.S.C. 102\(b\)\(1\)\(B\)](#) by providing evidence of a prior

public disclosure via an affidavit or declaration under [37 CFR 1.130\(b\)](#).

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This form paragraph must be included following form paragraph 7.20.aia or 7.15.aia where the [103](#) rejection is based on subject matter disclosed in a reference that has since been excepted under [102\(b\)\(2\)\(C\)](#), but still qualifies as prior art under [35 U.S.C. 102\(a\)\(1\)](#).
3. In bracket 1, identify the common assignee.
4. In bracket 2, identify the reference which discloses the subject matter that has been excepted.

**¶ 7.20.02.aia Joint Inventors, Common Ownership Presumed**

This application currently names joint inventors. In considering patentability of the claims the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were effectively filed absent any evidence to the contrary. Applicant is advised of the obligation under [37 CFR 1.56](#) to point out the inventor and effective filing dates of each claim that was not commonly owned at the time a later invention was effectively filed in order for the examiner to consider the applicability of [35 U.S.C. 102\(b\)\(2\)\(C\)](#) for any potential [35 U.S.C. 102\(a\)\(2\)](#) prior art against the later invention.

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This paragraph must be used in all applications with joint inventors (unless the claims are clearly restricted to only one claimed invention, e.g., only a single claim is presented in the application).

**¶ 7.20.04.aia 102 or 103 Rejection Using Prior Art Under 102(a)(2) That Is Attempted To Be Excepted Under 35 U.S.C. 102(b)(2)(C) Using the Common Ownership or Assignment Provision**

Applicant has attempted to show that subject matter disclosed in the reference [1] is excepted as prior art under [35 U.S.C. 102\(b\)\(2\)\(C\)](#) by showing that the claimed invention was owned by, or subject to an obligation of assignment to, the same entity as [2] at the time the claimed invention was effectively filed. However, applicant has failed to provide a statement that the claimed invention and the subject matter disclosed were owned by, or subject to an obligation of assignment to, the same person no later than the effective filing date of the claimed invention in a conspicuous manner, and therefore, the subject matter disclosed in the reference is not excepted as prior art under [35 U.S.C. 102\(a\)\(2\)](#). Applicant must file the required submission

in order to properly except the subject matter under [35 U.S.C. 102\(b\)\(2\)\(C\)](#). See [MPEP § 2154.02\(c\)](#).

In addition, applicant may rely upon the exception under [35 U.S.C. 102\(b\)\(2\)\(A\)](#) to overcome the rejection under [35 U.S.C. 102\(a\)\(2\)](#) either by a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application, and is therefore not prior art under [35 U.S.C. 102\(a\)\(2\)](#). Alternatively, applicant may rely on the exception under [35 U.S.C. 102\(b\)\(2\)\(B\)](#) by providing evidence of a prior public disclosure via an affidavit or declaration under [37 CFR 1.130\(b\)](#).

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph should be included in all actions containing rejections using [35 U.S.C. 102\(a\)\(2\)](#) prior art, whether anticipation or obviousness rejections, where an attempt has been made to except subject matter disclosed in the reference under [35 U.S.C. 102\(b\)\(2\)\(C\)](#), but where the applicant has not provided a proper statement indicating common ownership or assignment **not later than the effective filing date of the claimed invention**.

3. In bracket 1, identify the commonly owned applied art (e.g., patent or co-pending application).

4. In bracket 2, identify the common assignee.

**¶ 7.20.05.aia 102 or 103 Rejection Using Prior Art Under 102(a)(2) That Is Attempted To Be Excepted Under 35 U.S.C. 102(b)(2)(C) Using the Joint Research Agreement Provisions of 35 U.S.C. 102(c)**

Applicant has attempted to show that subject matter disclosed in the reference [1] is excepted as prior art under [35 U.S.C. 102\(b\)\(2\)\(C\)](#) by showing that the claimed invention was subject to a joint research agreement in effect not later than the effective filing date of the claimed invention. However, applicant has failed to [2]. Applicant must file the missing requirements in order to properly except the subject matter disclosed in the reference under [35 U.S.C. 102\(b\)\(2\)\(C\)](#). See [37 CFR 1.71\(g\)\(1\)](#) and [1.104\(c\)\(4\)\(ii\)](#).

In addition, applicant may overcome the rejection either by a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained, either directly or indirectly from the inventor or a joint inventor of this application, and is therefore, not prior art under [35 U.S.C. 102\(a\)\(2\)](#). Alternatively, applicant may rely on the exception under [35 U.S.C. 102\(b\)\(2\)\(B\)](#) by providing evidence of a prior public disclosure via an affidavit or declaration under [37 CFR 1.130\(b\)](#).

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the

Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph must be included in all actions containing obviousness or anticipation rejections where an attempt has been made to except subject matter disclosed in the [35 U.S.C. 102\(a\)\(2\)](#) prior art reference under [35 U.S.C. 102\(b\)\(2\)\(C\)](#) using the joint research agreement provisions but the attempt is ineffective.

3. In bracket 1, identify the reference which discloses subject matter that is sought to be excepted via [35 U.S.C. 102\(b\)\(2\)\(C\)](#).

4. In bracket 2, identify the reason(s) why the attempt is ineffective. The reason(s) could be noncompliance with the statutory requirements of [35 U.S.C. 102\(b\)\(2\)\(C\)](#) or rule requirements relating to the CREATE Act, such as failure to submit the required statement or failure to amend the specification to include the names of the parties to the joint research agreement. See [37 CFR 1.71\(g\)\(1\)](#) and [1.104\(c\)\(4\)\(ii\)](#).

**¶ 7.21.aia Rejection, 35 U.S.C. 103**

Claim [1] is/are rejected under [35 U.S.C. 103](#) as being unpatentable over [2].

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.

2. This form paragraph must be preceded by either form paragraph 7.20.aia or form paragraph 7.103.

3. An explanation of the rejection must follow this form paragraph. See [MPEP § 2144](#).

4. If this rejection is a provisional [35 U.S.C. 103](#) rejection based upon a copending application that would constitute prior art under [35 U.S.C. 102\(a\)\(2\)](#) if patented or published, use form paragraph 7.21.01.aia instead of this paragraph.

5. In bracket 1, insert the claim numbers which are under rejection.

6. In bracket 2, insert the prior art relied upon.

7. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

**¶ 7.21.01.aia Provisional Rejection, 35 U.S.C. 103, Common Assignee, Common Applicant, or at Least One Common (Joint) Inventor**

Claim [1] is/are provisionally rejected under [35 U.S.C. 103](#) as being obvious over copending Application No. [2] which has a common [3] with the instant application. The copending application would constitute prior art under [35 U.S.C. 102\(a\)\(2\)](#) if published or patented. This provisional rejection under [35 U.S.C. 103](#) is based upon a presumption of future publication or patenting of the copending application. [4]

This provisional rejection might be overcome by: (1) a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the



copending application was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with [35 U.S.C. 102\(b\)\(2\)\(A\)](#); (2) a showing under [37 CFR 1.130\(b\)](#) of a prior public disclosure under [35 U.S.C. 102\(b\)\(2\)\(B\)](#); or (3) a statement pursuant to [35 U.S.C. 102\(b\)\(2\)\(C\)](#) establishing that, not later than the effective filing date of the claimed invention, the subject matter disclosed in the copending application and the claimed invention either were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement. See generally [MPEP § 717.02](#).

#### Examiner Note:

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This form paragraph is used to provisionally reject claims over a copending application that discloses the claimed invention and would constitute prior art under [35 U.S.C. 102\(a\)\(2\)](#) if published under [35 U.S.C. 122](#) or patented. The copending application must have either a common assignee, common applicant ( [35 U.S.C. 118](#) ) or at least one common (joint) inventor.
3. If the claimed invention is fully disclosed in the copending application, use form paragraph 7.15.01.aia.
4. In bracket 1, insert the claim number(s) which is/are under rejection.
5. In bracket 2, insert the application number.
6. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.
7. In bracket 4, insert an explanation of obviousness. See [MPEP § 2144](#).
8. If the claimed invention is not patentably distinct from the invention claimed in the copending application, a provisional nonstatutory double patenting rejection should additionally be made using form paragraphs 8.33 and 8.37.

#### ¶ 7.21.02.aia Rejection, 35 U.S.C. 103, Common Assignee, Common Applicant, or at Least One Common (Joint) Inventor

Claim [1] is/are rejected under [35 U.S.C. 103](#) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effectively filed date of the reference, it constitutes prior art under [35 U.S.C. 102\(a\)\(2\)](#). [4]

This rejection under [35 U.S.C. 103](#) might be overcome by: (1) a showing under [37 CFR 1.130\(a\)](#) that the subject matter disclosed in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with [35 U.S.C. 102\(b\)\(2\)\(A\)](#); (2) a showing under [37 CFR 1.130\(b\)](#) of a prior public disclosure under [35 U.S.C. 102\(b\)\(2\)\(B\)](#); or (3) a statement pursuant to [35 U.S.C. 102\(b\)\(2\)\(C\)](#) establishing that, not later than the effective

filing date of the claimed invention, the subject matter disclosed and the claimed invention were either owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement. See generally [MPEP § 717.02](#).

#### Examiner Note:

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This paragraph is used to reject over a reference (patent or published application) that discloses the claimed invention, and that ONLY qualifies as prior art under [35 U.S.C. 102\(a\)\(2\)](#). If the reference qualifies as prior art under [35 U.S.C. 102\(a\)\(1\)](#), then this form paragraph should not be used (form paragraph 7.21.aia should be used instead). The reference must have either a common assignee, a common applicant ([35 U.S.C. 118](#) ), or at least one common (joint) inventor. This form paragraph should **not** be used in applications when the reference is not prior art in view of the [35 U.S.C. 102\(b\)\(2\)\(C\)](#) exception.
3. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.
4. In bracket 4, insert an explanation of obviousness. See [MPEP § 2144](#).

#### ¶ 7.22.aia Rejection, 35 U.S.C. 103, Further in View Of

Claim [1] is/are rejected under [35 U.S.C. 103](#) as being unpatentable over [2] as applied to claim [3] above, and further in view of [4].

#### Examiner Note:

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This form paragraph must be preceded by form paragraph 7.21.aia.
3. An explanation of the rejection must follow this form paragraph. See [MPEP § 2144](#).

#### ¶ 7.23.aia Test for Obviousness

The factual inquiries for establishing a background for determining obviousness under [35 U.S.C. 103](#) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This form paragraph may be used, if appropriate, in response to an argument regarding the applicability of the factors for determining obviousness.

**¶ 7.27.aia Rejection, 35 U.S.C. 102 or 103**

Claim(s) [1] is/are rejected under [35 U.S.C. 102\(2\)](#) as anticipated by or, in the alternative, under [35 U.S.C. 103](#) as obvious over [3].

**Examiner Note:**

1. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under [35 U.S.C. 102/103](#) as amended by the Leahy-Smith America Invents Act. This form paragraph must be preceded by form paragraph 7.03.aia.
2. This form paragraph is NOT intended to be commonly used as a substitute for a rejection under [35 U.S.C. 102](#). In other words, a single rejection under either [35 U.S.C. 102](#) or [35 U.S.C. 103](#) should be made whenever possible. Examples of circumstances where this paragraph may be used are as follows:
  - a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under [35 U.S.C. 102](#) is appropriate and given another interpretation, a rejection under [35 U.S.C. 103](#) is appropriate. See [MPEP §§ 2111 - 2116.01](#) for guidelines on claim interpretation.
  - b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See [MPEP §§ 2112 - 2112.02](#).
  - c. When the reference teaches a small genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under [35 U.S.C. 102](#). See [MPEP §§ 2131.02](#) and [2144.08](#) for more information on anticipation and obviousness of species by a disclosure of a genus.
  - d. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also [MPEP § 2113](#).
  - e. When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent of the claimed element and therefore anticipatory, or whether

the prior art element is an obvious variant of the claimed element. See [MPEP §§ 2183 - 2184](#).

- f. When the ranges disclosed in the reference and claimed by applicant overlap in scope but the reference does not contain a specific example within the claimed range. See the concurring opinion in *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). See [MPEP § 2131.03](#).
3. If the interpretation of the claim(s) renders the claim(s) indefinite, a rejection under [35 U.S.C. 112\(b\)](#) may be appropriate.
4. In bracket 1, insert the claim number(s) which is/are under rejection.
5. In bracket 2, insert the appropriate paragraph letter(s) in parenthesis.
6. In bracket 3, insert the prior art reference relied upon for the rejection.
7. A full explanation must follow this form paragraph, i.e., the examiner must provide an explanation of how the claims at issue could be considered to be anticipated, as well as how they could be considered to be obvious.
8. This form paragraph must be preceded by 7.07.aia and 7.08.aia and/or 7.12.aia or by form paragraph 7.103.
9. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.

### **2159 Applicability Date Provisions and Determining Whether an Application Is Subject to the First Inventor To File Provisions of the AIA [R-11.2013]**

Because the changes to [35 U.S.C. 102](#) and [35 U.S.C. 103](#) in the AIA apply only to specific applications filed on or after March 16, 2013, determining the effective filing date of a claimed invention for purposes of applying [AIA 35 U.S.C. 102](#) and [103](#) provisions or [pre-AIA 35 U.S.C. 102](#) and [103](#) provisions is critical.

#### **2159.01 Applications Filed Before March 16, 2013 [R-11.2013]**

The changes to [35 U.S.C. 102](#) and [103](#) in the AIA do not apply to any application filed before March 16, 2013. Thus, any application filed before March 16, 2013, is governed by [pre-AIA 35 U.S.C. 102](#) and [103](#) (i.e., the application is a pre-AIA first to invent application). Note that neither the filing of a request for continued examination, nor entry into the national stage under [35 U.S.C. 371](#), constitutes the filing of

a new application. Accordingly, even if a request for continued examination under [37 CFR 1.114](#) is filed on or after March 16, 2013, in an application that was filed before March 16, 2013, the application remains subject to [pre-AIA 35 U.S.C. 102](#) and [103](#). Similarly, a PCT application filed under [35 U.S.C. 363](#) before March 16, 2013, is subject to [pre-AIA 35 U.S.C. 102](#) and [103](#), regardless of whether the application enters the national stage under [35 U.S.C. 371](#) before or after March 16, 2013. Additionally, adding claims after March 16, 2013 in an application filed before March 16, 2013 via an amendment which contains new matter does not make the changes to [35 U.S.C. 102](#) and [35 U.S.C. 103](#) in the AIA applicable to the application because [35 U.S.C. 132\(a\)](#) prohibits the introduction of new matter into the disclosure. If new matter is added via amendment, claims directed to the new matter will be rejected under [pre-AIA 35 U.S.C. 112](#), first paragraph. See [MPEP § 608.04](#).

### **2159.02 Applications Filed on or After March 16, 2013 [R-01.2024]**

[AIA 35 U.S.C. 102](#) and [103](#) took effect on March 16, 2013. [AIA 35 U.S.C. 102](#) and [103](#) apply to any patent application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013. If a patent application (1) contains or contained at any time a claim to a claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that is on or after March 16, 2013 or (2) claims or ever claimed the benefit of an earlier filing date under [35 U.S.C. 120](#), [121](#), or [365](#) based upon an earlier application that ever contained such a claim, then [AIA 35 U.S.C. 102](#) and [103](#) apply to the application, (i.e., the application is an AIA application). If there is ever even a single claim to a claimed invention in the application having an effective filing date on or after March 16, 2013, [AIA 35 U.S.C. 102](#) and [103](#) apply in determining the patentability of every claimed invention in the application. This is the situation even if the remaining claimed inventions all have an effective filing date before March 16, 2013, and even if the claim to a claimed invention having an effective filing date on or after March 16, 2013, is canceled.

If an application filed on or after March 16, 2013, that did not previously contain any claim to a claimed invention having an effective filing date on or after March 16, 2013, (a pre-AIA application) is amended to contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, the application becomes an AIA application ([AIA 35 U.S.C. 102](#) and [103](#) apply to the application), provided that the newly added claimed invention has support under [35 U.S.C. 112\(a\)](#) in the application filed on or after March 16, 2013. The application also becomes subject to [AIA 35 U.S.C. 102](#) and [103](#) even if the claim to a claimed invention having an effective filing date on or after March 16, 2013, is subsequently canceled. If an amendment after an Office action causes the application to change from being governed by [pre-AIA 35 U.S.C. 102](#) and [103](#) (from being a pre-AIA application) to being governed by [AIA 35 U.S.C. 102](#) and [103](#) (to being a AIA application), any new ground of rejection necessitated by the change in applicable law would be considered a new ground of rejection necessitated by an amendment for purposes of determining whether the next Office action may be made final. See [MPEP § 706.07\(a\)](#).

An application filed on or after March 16, 2013, that, as originally filed, discloses and claims only subject matter also disclosed in an earlier application (filed before March 16, 2013) to which the later filed application is entitled to priority or benefit under [35 U.S.C. 119](#), [120](#), [121](#), [365](#), or [386](#), is a pre-AIA application. As [35 U.S.C. 132\(a\)](#) prohibits the introduction of new matter into the disclosure, an application may not contain a claim to a claimed invention that does not have support under [35 U.S.C. 112\(a\)](#) in the application (that is directed to new matter). Thus, an application cannot “contain” a claim to a claimed invention that is directed to new matter for purposes of determining whether the application ever contained a claim to a claimed invention having an effective filing date on or after March 16, 2013. Therefore, an amendment (other than a preliminary amendment filed on the same day as such application) seeking to add a claim to a claimed invention that is directed to new matter would not change the later filed application from a pre-AIA application into an AIA application.

Amendments that are believed to contain new matter should be treated as follows: (1) a new drawing should not be entered if the examiner discovers that the drawing contains new matter ([MPEP § 608.02](#), subsection II.); and (2) amendments to the written description or claims involving new matter are ordinarily entered, but the new matter is required to be canceled from the written description and the claims directed to the new matter are rejected under [35 U.S.C. 112\(a\)](#) ([MPEP § 608.04](#)). This process for treating amendments containing new matter is purely an administrative process for handling an amendment seeking to introduce new matter into the disclosure of the invention in violation of [35 U.S.C. 132\(a\)](#), and for resolving disputes between the applicant and an examiner as to whether a new drawing or amendment to the written description or claims would actually introduce new matter into the disclosure of the invention.

### **2159.03 Applications Subject to the AIA but Also Containing a Claimed Invention Having an Effective Filing Date Before March 16, 2013 [R-01.2024]**

Even if [AIA 35 U.S.C. 102](#) and [103](#) apply to a patent application, [pre-AIA 35 U.S.C. 102\(g\)](#) also applies to every claim in the application if it: (1) contains or contained at any time a claimed invention having an effective filing date as defined in [35 U.S.C. 100\(i\)](#) that occurs before March 16, 2013; or (2) is ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time such a claim. [Pre-AIA 35 U.S.C. 102\(g\)](#) also applies to any patent resulting from an application to which [pre-AIA 35 U.S.C. 102\(g\)](#) applied. See [MPEP § 2138](#) for guidance on [pre-AIA 35 U.S.C. 102\(g\)](#).

Thus, if an application contains, or contained at any time, any claim having an effective filing date that occurs before March 16, 2013, and also contains, or contained at any time, any claim having an effective filing date that is on or after March 16, 2013, each claim must be patentable under [AIA 35 U.S.C. 102](#) and [103](#), as well as [pre-AIA 35 U.S.C. 102\(g\)](#), for the applicant to be entitled to a patent. However, an application will not otherwise be concurrently subject to both [pre-AIA 35 U.S.C. 102](#) and [103](#) and [AIA 35 U.S.C. 102](#) and [103](#).

For these reasons, when subject matter is claimed in an application filed on or after March 16, 2013 having priority to or the benefit (e.g., under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#)) of a prior application filed before March 16, 2013, care must be taken to accurately determine whether AIA or [pre-AIA 35 U.S.C. 102](#) and [103](#) applies to the application. See also [MPEP § 2151](#).

### **2159.04 Applicant Statement in Transition Applications Containing a Claimed Invention Having an Effective Filing Date on or After March 16, 2013 [R-11.2013]**

The Office revised [37 CFR 1.55](#) and [1.78](#) to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of or priority to an application where the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application is prior to March 16, 2013 (termed as “a transition application”), and also contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect (“the [37 CFR 1.55](#) or [1.78](#) statement”). This information will assist the Office in determining whether the transition application is subject to [AIA 35 U.S.C. 102](#) and [103](#) or [pre-AIA 35 U.S.C. 102](#) and [103](#). However, applicant is not required to provide this information if the transition application claims the benefit of an earlier transition application in which a [37 CFR 1.55](#) or [37 CFR 1.78](#) statement has been filed. See [37 CFR 1.78\(c\)\(6\)\(i\)](#). See also [MPEP § 210](#).

### **2160 [Reserved]**

### **2161 Three Separate Requirements for Specification Under 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph [R-07.2015]**

#### **I. THE SPECIFICATION MUST INCLUDE A WRITTEN DESCRIPTION OF THE INVENTION,**



## ENABLEMENT, AND BEST MODE OF CARRYING OUT THE CLAIMED INVENTION

35 U.S.C. 112(a) (applicable to applications filed on or after September 16, 2012) provides:

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The first paragraph of [pre-AIA 35 U.S.C. 112](#) (applicable to applications filed before September 16, 2012) provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [emphasis added].

[35 U.S.C. 112\(a\)](#) and [pre-AIA 35 U.S.C. 112](#), first paragraph require that the specification include the following:

- (A) A written description of the invention;
- (B) The manner and process of making and using the invention (the enablement requirement); and
- (C) The best mode contemplated by the inventor of carrying out his invention.

## II. THE THREE REQUIREMENTS ARE SEPARATE AND DISTINCT FROM EACH OTHER

The written description requirement is separate and distinct from the enablement requirement. *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1341, 94 USPQ2d 1161, 1167 (Fed. Cir. 2010) (*en banc*) (If Congress had intended enablement to be

the sole description requirement of [§ 112](#), first paragraph, the statute would have been written differently.) *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (While acknowledging that some of its cases concerning the written description requirement and the enablement requirement are confusing, the Federal Circuit reaffirmed that under [35 U.S.C. 112](#), first paragraph, the written description requirement is separate and distinct from the enablement requirement and gave an example thereof.); *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978). See also, e.g., *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 681-685, 114 USPQ2d 1349, 1356, 1357 (Fed. Cir. 2015) (reversing and remanding the district court's grant of summary judgment of invalidity for lack of an adequate written description and lack of enablement because there were genuine issues of material fact regarding 1) whether the claims had sufficient written description support (“[t]he fact that . . . the specification do[es] not speak in haec verba of accessing ‘disparate databases’ does not eliminate as a genuine issue of material fact that the existence of at least some discussion, and therefore, possession, of the accessing of disparate databases, as claimed”); and 2) whether the claims were enabled (“the effort it took the inventor to reduce the invention to practice does not conclusively show lack of enablement”). An invention may be described without the disclosure being enabling (e.g., a chemical compound for which there is no disclosed or apparent method of making), and a disclosure could be enabling without describing the invention (e.g., a specification describing a method of making and using a paint composition made of functionally defined ingredients within broad ranges would be enabling for formulations falling within the description but would not describe any specific formulation). See *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975) (“[A] specification which ‘describes’ does not necessarily also ‘enable’ one skilled in the art to make or use the claimed invention.”). Best mode is a separate and distinct requirement from the enablement requirement. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

## 2161.01 Computer Programming, Computer Implemented Inventions, and 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph [R-07.2022]

The statutory requirements for computer-implemented inventions are the same as for all inventions, such as the subject matter eligibility and utility requirements under [35 U.S.C. 101](#) (see [MPEP §§ 2106](#) and [2107](#), respectively), the novelty requirement of [35 U.S.C. 102](#), the nonobviousness requirement of [35 U.S.C. 103](#), the definiteness requirement of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, and the three separate and distinct requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. In addition, claims with computer-implemented functional claim limitations may invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. See [MPEP § 2181](#), subsection II.B, and [§ 2181](#), subsection IV. for information regarding means- (or step-) plus- function limitations.

Even if a claim is not construed as a means-plus-function limitation under [35 U.S.C. 112\(f\)](#), computer-implemented functional claim language must still be evaluated for sufficient disclosure under the written description and enablement requirements of [35 U.S.C. 112\(a\)](#).

### I. DETERMINING WHETHER THERE IS ADEQUATE WRITTEN DESCRIPTION FOR A COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATION

The [35 U.S.C. 112\(a\)](#) or first paragraph of [pre-AIA 35 U.S.C. 112](#) contains a written description requirement that is separate and distinct from the enablement requirement. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340, 94 USPQ2d 1161, 1167 (Fed. Cir. 2010) (*en banc*). To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time of filing. *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000) (“The purpose of [the written description requirement] is to ensure that the scope of the right to exclude, as set forth in the

claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification”); *LizardTech Inc. v. Earth Resource Mapping Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1732 (Fed. Cir. 2005) (“Whether the flaw in the specification is regarded as a failure to demonstrate that the patentee [inventor] possessed the full scope of the invention recited in [the claim] or a failure to enable the full breadth of that claim, the specification provides inadequate support for the claim under [[§ 112\(a\)](#)]”); cf. *id.* (“A claim will not be invalidated on [[§ 112](#)] grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.”). While “[t]here is no special rule for supporting a genus by the disclosure of a species,” the Federal Circuit has stated that “[w]hether the genus is supported vel non depends upon the state of the art and the nature and breadth of the genus.” *Hynix Semiconductor Inc. v. Rambus Inc.*, 645 F.3d 1336, 1352, 98 USPQ2d 1711, 1724 (Fed. Cir. 2011); *id.* (further explaining that “so long as disclosure of the species is sufficient to convey to one skilled in the art that the inventor possessed the subject matter of the genus, the genus will be supported by an adequate written description.”). See also *Rivera v. Int’l Trade Comm’n*, 857 F.3d 1315, 1319-21, 123 USPQ2d 1059, 1061-62 (Fed. Cir. 2017) (affirming the Commission’s findings that “the specification did not provide the necessary written description support for the full breadth of the asserted claims,” where the claims were broadly drawn to a “container . . . adapted to hold brewing material” while the specification disclosed only a “pod adapter assembly” or “receptacle” designed to hold a “pod”).

Specifically, the specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art in a way that shows that the inventor actually invented the claimed invention at the time of filing. *Id.*; *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172. The function of the written description requirement is to ensure that the inventor had possession of the specific subject matter later claimed as of the filing date of the application relied on; how the specification accomplishes this is not material. *In re Herschler*, 591 F.2d 693, 700-01, 200 USPQ 711, 717 (CCPA 1979), further reiterated in *In re Kaslow*, 707 F.2d 1366, 217

USPQ 1089 (Fed. Cir. 1983); see also [MPEP §§ 2163 - 2163.04](#).

The written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, applies to all claims including original claims that are part of the disclosure as filed. *Ariad*, 598 F.3d at 1349, 94 USPQ2d at 1170. As stated by the Federal Circuit, “[a]lthough many original claims will satisfy the written description requirement, certain claims may not.” *Id.* at 1349, 94 USPQ2d at 1170-71; see also *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1343-46, 76 USPQ2d 1724, 1730-33 (Fed. Cir. 2005); *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1405-06 (Fed. Cir. 1997) (“The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention.”). Problems satisfying the written description requirement for original claims often occur when claim language is generic or functional, or both. *Ariad*, 593 F.3d at 1349, 94 USPQ2d at 1171 (“The problem is especially acute with genus claims that use functional language to define the boundaries of a claimed genus. In such a case, the functional claim may simply claim a desired result, and may do so without describing species that achieve that result. But the specification must demonstrate that the applicant [inventor] has made a generic invention that achieves the claimed result and do so by showing that the applicant [inventor] has invented species sufficient to support a claim to the functionally-defined genus.”).

For instance, generic claim language in the original disclosure does not satisfy the written description requirement if it fails to support the scope of the genus claimed. *Ariad*, 598 F.3d at 1349-50, 94 USPQ2d at 1171 (“[A]n adequate written description of a claimed genus requires more than a generic statement of an invention’s boundaries.”) (citing *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1405-06); *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968, 63 USPQ2d 1609, 1616 (Fed. Cir. 2002) (holding that generic claim language appearing in *ipsis verbis* in the original specification did not satisfy the written description requirement because it failed to support the scope of the genus claimed); *Fiers v. Revel*, 984 F.2d 1164, 1170, 25 USPQ2d

1601, 1606 (Fed. Cir. 1993) (rejecting the argument that “only similar language in the specification or original claims is necessary to satisfy the written description requirement”).

The Federal Circuit has explained that a specification cannot always support expansive claim language and satisfy the requirements of 35 U.S.C. 112 “merely by clearly describing one embodiment of the thing claimed.” *LizardTech v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346, 76 USPQ2d 1731, 1733 (Fed. Cir. 2005). The issue is whether a person skilled in the art would understand the inventor to have invented, and been in possession of, the invention as broadly claimed. In *LizardTech*, claims to a generic method of making a seamless discrete wavelet transformation (DWT) were held invalid under 35 U.S.C. 112, first paragraph, because the specification taught only one particular method for making a seamless DWT and there was no evidence that the specification contemplated a more generic method. “[T]he description of one method for creating a seamless DWT does not entitle the inventor . . . to claim any and all means for achieving that objective.” *LizardTech*, 424 F.3d at 1346, 76 USPQ2d at 1733.

Similarly, original claims may lack written description when the claims define the invention in functional language specifying a desired result but the specification does not sufficiently describe how the function is performed or the result is achieved. For software, this can occur when the algorithm or steps/procedure for performing the computer function are not explained at all or are not explained in sufficient detail (simply restating the function recited in the claim is not necessarily sufficient). In other words, the algorithm or steps/procedure taken to perform the function must be described with sufficient detail so that one of ordinary skill in the art would understand how the inventor intended the function to be performed. See [MPEP §§ 2163.02 and 2181](#), subsection IV.

The level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology. *Ariad*, 598 F.3d at 1351, 94 USPQ2d at 1172; *Capon v. Eshhar*, 418 F.3d 1349, 1357-58, 76 USPQ2d 1078,

1083-84 (Fed. Cir. 2005). Computer-implemented inventions are often disclosed and claimed in terms of their functionality. For computer-implemented inventions, the determination of the sufficiency of disclosure will require an inquiry into the sufficiency of both the disclosed hardware and the disclosed software due to the interrelationship and interdependence of computer hardware and software. The critical inquiry is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.

*Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682, 114 USPQ2d 1349, 1356 (citing *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351, 94 USPQ2d 1161, 1172 (Fed. Cir. 2010) in the context of determining possession of a claimed means of accessing disparate databases).

When examining computer-implemented functional claims, examiners should determine whether the specification discloses the computer and the algorithm (e.g., the necessary steps and/or flowcharts) that perform the claimed function in sufficient detail such that one of ordinary skill in the art can reasonably conclude that the inventor possessed the claimed subject matter at the time of filing. An algorithm is defined, for example, as “a finite sequence of steps for solving a logical or mathematical problem or performing a task.” Microsoft Computer Dictionary (5th ed., 2002). Applicant may “express that algorithm in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.” *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340, 86 USPQ2d 1609, 1623 (Fed. Cir. 2008) (internal citation omitted). It is not enough that one skilled in the art could write a program to achieve the claimed function because the specification must explain how the inventor intends to achieve the claimed function to satisfy the written description requirement. See, e.g., *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 681-683, 114 USPQ2d 1349, 1356, 1357 (Fed. Cir. 2015) (reversing and remanding the district court’s grant of summary judgment of invalidity for lack of adequate written description where there were genuine issues of material fact regarding “whether the specification show[ed] possession by the inventor of how

accessing disparate databases is achieved”). If the specification does not provide a disclosure of the computer and algorithm in sufficient detail to demonstrate to one of ordinary skill in the art that the inventor possessed the invention a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description must be made. For more information regarding the written description requirement, see [MPEP § 2162- § 2163.07\(b\)](#). If the specification does not provide a disclosure of sufficient corresponding structure, materials, or acts that perform the entire claimed function of a means- (or step-) plus- function limitation in a claim under [35 U.S.C. 112\(f\)](#) or the sixth paragraph of [pre-AIA 35 U.S.C. 112](#), “the applicant has in effect failed to particularly point out and distinctly claim the invention” as required by the [35 U.S.C. 112\(b\)](#) [or the second paragraph of [pre-AIA 35 U.S.C. 112](#)]. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (*en banc*). A rejection under [35 U.S.C. 112\(b\)](#) or the second paragraph of [pre-AIA 35 U.S.C. 112](#) must be made in addition to the written description rejection. See also [MPEP § 2181](#), subsection II.B.2(a).

## II. BEST MODE

The purpose of the best mode requirement is to “restrain inventors from applying for patents while at the same time concealing from the public the preferred embodiments of their inventions which they have in fact conceived.” *In re Gay*, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962). Only evidence of concealment, “whether accidental or intentional,” is considered in judging the adequacy of the disclosure for compliance with the best mode requirement. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987). “That evidence, in order to result in affirmance of a best mode rejection, must tend to show that the *quality* of an [inventor’s] best mode disclosure is so poor as to effectively result in concealment.” *In re Sherwood*, 613 F.2d 809, 816, 204 USPQ 537, 544 (CCPA 1980)(emphasis omitted); *White Consol. Indus. v. Vega Servo-Control Inc.*, 214 USPQ 796, 824 (S.D. Mich. 1982), *aff’d on related grounds*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); see also [MPEP §§ 2165 - 2165.04](#).



There are two factual inquiries to be made in determining whether a specification satisfies the best mode requirement. First, there must be a subjective determination as to whether the inventor knew of a best mode of practicing the invention at the time the application was filed. Second, if the inventor had a best mode of practicing the invention in mind, there must be an objective determination as to whether that best mode was disclosed in sufficient detail to allow one skilled in the art to practice it. *Fonar Corp. v. Gen. Elect. Co.*, 107 F.3d 1543, 41 USPQ2d 1801, 1804 (Fed. Cir. 1997); *Chemcast Corp. v. Arco Indus.*, 913 F.2d 923, 927-28, 16 USPQ2d 1033, 1036 (Fed. Cir. 1990). “As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. . . . [F]low charts or source code listings are not a requirement for adequately disclosing the functions of software.” *Fonar Corp.*, 107 F.3d at 1549, 41 USPQ2d at 1805 (citations omitted).

### III. DETERMINING WHETHER THE FULL SCOPE OF A COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATION IS ENABLED

To satisfy the enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” See, e.g., *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1402 (Fed. Cir. 1988). In *In re Wands*, the court set forth the following factors to consider when determining whether undue experimentation is needed: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

*Wands*, 858 F.2d at 737, 8 USPQ2d 1404. The undue experimentation determination is not a single

factual determination; rather, it is a conclusion reached by weighing all the factual considerations. *Id.*

All questions of enablement under [35 U.S.C. 112\(a\)](#) are evaluated against the claimed subject matter with the focus of the examination inquiry being whether everything within the scope of the claim is enabled. Accordingly, examiners should determine what each claim recites and what subject matter is encompassed by the claim when the claim is considered as a whole and not analyze the claim elements individually.

When basing a rejection on the failure of the applicant’s disclosure to meet the enablement provisions of [35 U.S.C. 112\(a\)](#) or the first paragraph of [pre-AIA 35 U.S.C. 112](#), USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). Once USPTO personnel have advanced a reasonable basis for questioning the adequacy of the disclosure, it becomes incumbent on the applicant to rebut that challenge and factually demonstrate that the application disclosure is sufficient. See *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973); *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); *In re Ghiron, supra*; see also [MPEP §§ 2164 - 2164.08\(c\)](#).

When a claim is not limited to any particular structure for performing a recited function and does not invoke [35 U.S.C. 112\(f\)](#), any claim language reciting the ability to perform a function per se would typically be construed broadly to cover any and all embodiments that perform the recited function. Because such a claim encompasses all devices or structures that perform the recited function, there is a concern regarding whether the applicant’s disclosure sufficiently enables the full scope of protection sought by the claim. *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971); *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). Applicants who present broad claim language

must ensure the claims are fully enabled. Specifically, the scope of the claims must be less than or equal to the scope of the enablement provided by the specification. *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999, 85 USPQ2d 1826, 1830 (Fed. Cir. 2008) (“The scope of the claims must be less than or equal to the scope of the enablement to ensure that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” (quotation omitted)).

For example, the claims in *Sitrick* were directed to “integrating” or “substituting” a user’s audio signal or visual image into a pre-existing video game or movie. While the claims covered both video games and movies, the specification only taught the skilled artisan how to substitute and integrate user images into video games. The Federal Circuit held that the specification failed to enable the full scope of the claims because the skilled artisan could not substitute a user image for a preexisting character image in movies without undue experimentation. Specifically, the court recognized that one skilled in the art could not apply the teachings of the specification regarding video games to movies, because movies, unlike video games, do not have easily separable character functions. Because the specification did not teach how the substitution and integration of character functions for a user image would be accomplished in movies, the claims were not enabled. *Sitrick*, 516 F.3d at 999-1001, 85 USPQ2d at 1830-32.

In *MagSil Corp. v. Hitachi Global Storage Techs., Inc.* 687 F.3d 1377, 103 USPQ2d 1769 (Fed. Cir. 2012), the Federal Circuit stated that “a patentee chooses broad claim language at the peril of losing any claim that cannot be enabled across its full scope of coverage,” finding “one skilled in the art could not have taken the disclosure in the specification regarding ‘change in the resistance by at least 10% at room temperature’ and achieved a change in resistance in the full scope of that term without undue experimentation.” 687 F.3d at 1381-82, 103 USPQ2d at 1771. “Thus, the specification enabled a marginal advance over the prior art, but did not enable at the time of filing a tunnel junction of resistive changes reaching even up to 20%, let alone the more recent achievements above 600%.” The court held that the “claims [were] invalid for lack of

enablement because their broad scope [was] not reasonably supported by the scope of enablement in the specification.” 687 F.3d at 1381-1382, 1384, 103 USPQ2d at 1771, 1772, 1774 (“MagSil did not fully enable its broad claim scope. Therefore, it cannot claim an exclusive right to exclude later tri-layer tunnel junctions that greatly exceed a 10% resistive change.”). See also *Convolve, Inc. v. Compaq Computer Corp.*, 527 Fed. App’x 910, 931 (Fed. Cir. 2013) (non-precedential), quoting *MagSil Corp.* (affirming grant of summary judgment of invalidity due to lack of enablement where the patentee “[b]y choosing such broad claim language, ... put itself ‘at the peril of losing any claim that cannot be enabled across its full scope of coverage.’”).

The specification need not teach what is well known in the art. However, applicant cannot rely on the knowledge of one skilled in the art to supply information that is required to enable the novel aspect of the claimed invention when the enabling knowledge is in fact not known in the art. *ALZA Corp. v. Andrx Pharms., LLC*, 603 F.3d 935, 941, 94 USPQ2d 1823, 1827 (Fed. Cir. 2010) (“ALZA was required to provide an adequate enabling disclosure in the specification; it cannot simply rely on the knowledge of a person of ordinary skill to serve as a substitute for the missing information in the specification.”); *Auto. Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1283, 84 USPQ2d 1108, 1114-15 (Fed. Cir. 2007) (“Although the knowledge of one skilled in the art is indeed relevant, the novel aspect of an invention must be enabled in the patent.”). The Federal Circuit has stated that “[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.” *Auto. Technologies*, 501 F.3d at 1283, 84 USPQ2d at 1115 (quoting *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997)). See also *Idenix Pharms. LLC v. Gilead Scis. Inc.*, 941 F.3d 1149, 1159-61, 2019 USPQ 2d 415844 (Fed. Cir. 2019). The rule that a specification need not disclose what is well known in the art is “merely a rule of supplementation, not a substitute for a basic enabling disclosure.” *Genentech*, 108 F.3d at 1366, 42 USPQ2d 1005; see also *ALZA Corp.*, 603 F.3d at 940-41, 94 USPQ2d at 1827. Therefore, the

specification must contain the information necessary to enable the novel aspects of the claimed invention. *Id.* at 941, 94 USPQ2d at 1827; *Auto. Technologies*, 501 F.3d at 1283-84, 84 USPQ2d at 1115 (“[T]he ‘omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or of any of the conditions under which a process can be carried out, undue experimentation is required.’”) (quoting *Genentech*, 108 F.3d at 1366, 42 USPQ2d at 1005). For instance, in *Auto. Technologies*, the claim limitation “means responsive to the motion of said mass” was construed to include both mechanical side impact sensors and electronic side impact sensors for performing the function of initiating an occupant protection apparatus. *Auto. Technologies*, 501 F.3d at 1282, 84 USPQ2d at 1114. The specification did not include any discussion of the details or circuitry involved in the electronic side impact sensor and thus, failed to apprise one of ordinary skill how to make and use the electronic sensor. Because the novel aspect of the invention was side impact sensors, the patentee could not rely on the knowledge of one skilled in the art to supply the missing information. *Auto. Technologies*, 501 F.3d at 1283, 84 USPQ2d at 1114.

Not everything necessary to practice the invention need be disclosed. *Trs. of Bos. Univ. v. Everlight Elecs. Co., LTD.*, 896 F.3d 1357, 1364, 127 USPQ2d 1609, 1614 (Fed. Cir. 2018) (explaining that while “the specification must enable the full scope of the claimed invention[,]” “[t]his is not to say that the specification must expressly spell out every possible iteration of every claim.”). For instance, “a specification need not disclose what is well known in the art.” *Id.* (quoting *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997)); see also *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003). This is of particular importance with respect to computer-implemented inventions due to the high level of skill in the art and the similarly high level of predictability in generating programs to achieve an intended result without undue experimentation. See [MPEP § 2164.08](#).

The Federal Circuit has repeatedly held that the specification must teach those skilled in the art how

to make and use the full scope of the claimed invention without undue experimentation. See *Trs. of Bos. Univ.*, 896 F.3d at 1364 (“The scope of enablement . . . is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.”) (quoting *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196, 49 USPQ2d 1671, 1676 (Fed. Cir. 1999))). For example, in *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 85 USPQ2d 1826 (Fed. Cir. 2008), the claims at issue were directed to “integrating” or “substituting” a user’s audio signal or visual image into a pre-existing video game or movie. *Id.* at 995-97. While the claims covered both video games and movies, the specification only taught the skilled artisan how to substitute and integrate user images into video games. *Id.* at 1000. The Federal Circuit held that the specification “did not enable the full scope of the asserted claims” because “one skilled in the art could not take the disclosure in the specification with respect to substitution or integration of user images in video games and substitute a user image for a pre-existing character image in movies without undue experimentation.” *Id.*

A rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph for lack of enablement must be made when the specification does not enable the full scope of the claim. USPTO personnel should establish a reasonable basis to question the enablement provided for the claimed invention and provide reasons for the uncertainty of the enablement. For more information regarding the enablement requirement, see [MPEP §§ 2164.01\(a\) - 2164.08\(c\)](#), especially, [MPEP § 2164.06\(c\)](#) for examples of computer programming cases. See also [MPEP § 2181](#), subsection IV.

### **2162 Policy Underlying 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph [R-08.2017]**

To obtain a valid patent, a patent application must contain a full and clear description of the invention for which a patent is sought in the manner prescribed by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. The requirement for an adequate written description ensures that the public receives

something in return for the exclusionary rights that are granted to the inventor by a patent. The grant of a patent helps to foster and enhance the development and disclosure of new ideas and the advancement of scientific knowledge. Upon the grant of a patent in the U.S., information contained in the patent becomes a part of the information available to the public for further research and development, subject only to the patentee's right to exclude others during the life of the patent.

In exchange for the patent rights granted, [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, sets forth the minimum requirements for the quality and quantity of information that must be contained in a patent application to justify the grant of a patent. As discussed in more detail below, the patentee must disclose sufficient information to demonstrate that the inventor had possession of the invention at the time of filing and to enable those skilled in the art to make and use the invention. The applicant must not conceal from the public the best way of practicing the invention that was known to the patentee at the time of filing the patent application. Failure to fully comply with the disclosure requirements could result in the denial of a patent, or in a holding of invalidity of an issued patent.

### **2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, first paragraph, “Written Description” Requirement [R-01.2024]**

The following Guidelines establish the policies and procedures to be followed by Office personnel in the evaluation of any patent application for compliance with the written description requirement of [35 U.S.C. 112](#). These Guidelines are based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the U.S. Supreme Court, as well as the U.S. Court of Appeals for the Federal Circuit and its predecessor courts.

The Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law. They are designed to assist Office personnel in analyzing claimed subject matter for

compliance with substantive law. Rejections will be based upon the substantive law, and it is these rejections that are appealable. Consequently, any perceived failure by Office personnel to follow these Guidelines is neither appealable nor petitionable.

These Guidelines are intended to form part of the normal examination process. Thus, where Office personnel establish a *prima facie* case of lack of written description for a claim, a thorough review of the prior art and examination on the merits for compliance with the other statutory requirements, including those of [35 U.S.C. 101](#), [102](#), [103](#), and [112](#), is to be conducted prior to completing an Office action that includes a rejection for lack of written description.

#### **I. GENERAL PRINCIPLES GOVERNING COMPLIANCE WITH THE “WRITTEN DESCRIPTION” REQUIREMENT FOR APPLICATIONS**

[35 U.S.C. 112\(a\)](#) and the first paragraph of [pre-AIA 35 U.S.C. 112](#) require that the “specification shall contain a written description of the invention ....” This requirement is separate and distinct from the enablement requirement. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340, 94 USPQ2d 1161, 1167 (Fed. Cir. 2010) (*en banc*); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991); see also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1890-93 (Fed. Cir. 2004) (discussing the history and purpose of the written description requirement); *In re Curtis*, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) (“conclusive evidence of a claim's enablement is not equally conclusive of that claim's satisfactory written description”). The written description requirement has several policy objectives. “[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant [inventor] has invented the subject matter which is claimed.” *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to convey to the public what the applicant claims as the invention. See *Regents of the Univ. of Cal. v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). “The ‘written description’ requirement



implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee [inventor] was in possession of the invention that is claimed." *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005). Further, the written description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969-70, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002). For example, it is now well accepted that a satisfactory description may be found in originally-filed claims or any other portion of the originally-filed specification. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980); *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). However, that does not mean that all originally-filed claims have adequate written support. The specification must still be examined to assess whether an originally-filed claim has adequate support in the written disclosure and/or the drawings.

An applicant shows that the inventor was in possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. Amer. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready

for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the inventor was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharm.*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it"). "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" *Enzo Biochem*, 323 F.3d at 963, 63 USPQ2d at 1612. An application specification may show actual reduction to practice by describing testing of the claimed invention or, in the case of certain biological materials, by specifically describing a deposit made in accordance with [37 CFR 1.801](#) *et seq.* See *Enzo Biochem*, 323 F.3d at 965, 63 USPQ2d at 1614 ("reference in the specification to a deposit may also satisfy the written description requirement with respect to a claimed material"); see also Deposit of Biological Materials for Patent Purposes, Final Rule, 54 Fed. Reg. 34,864 (August 22, 1989) ("The requirement for a specific identification is consistent with the description requirement of the first paragraph of [35 U.S.C. 112](#), and to provide an antecedent basis for the biological material which either has been or will be deposited before the patent is granted." *Id.* at 34,876. "The description must be sufficient to permit verification that the deposited biological material is in fact that disclosed. Once the patent issues, the description must be sufficient to aid in the resolution of questions of infringement." *Id.* at 34,880.) Such a deposit is not a substitute for a written description of the claimed invention. The written description of the deposited material needs to be as complete as possible because the examination for patentability proceeds solely on the basis of the written description. See, e.g., *In re Lundak*, 773 F.2d 1216, 227 USPQ 90 (Fed. Cir. 1985); see also 54 Fed. Reg. at 34,880 ("As a general rule, the more information that is provided about a particular deposited biological material, the better the examiner will be able to compare the identity and characteristics of the deposited biological material with the prior art.").

A question as to whether a specification provides an adequate written description may arise in the context of determining whether an original claim is described sufficiently (see, e.g., *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1733 (Fed. Cir. 2005); *Enzo Biochem*, 323 F.3d at 968, 63 USPQ2d at 1616 (Fed. Cir. 2002); *Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398)), whether new or amended claims are supported by the description of the invention in the application as filed (see, e.g., *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989)), whether a claimed invention is entitled to the benefit of or priority to an earlier filing date under [35 U.S.C. 119](#), [120](#), [365](#), or [386](#) (see, e.g., *New Railhead Mfg. L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 63 USPQ2d 1843 (Fed. Cir. 2002); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *Fiers v. Revel*, 984 F.2d 1164, 25 USPQ2d 1601 (Fed. Cir. 1993); *In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993)), or whether a specification provides support for a claim corresponding to a count in an interference (see, e.g., *Martin v. Mayer*, 823 F.2d 500, 503, 3 USPQ2d 1333, 1335 (Fed. Cir. 1987); *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1971)). Compliance with the written description requirement is a question of fact which must be resolved on a case-by-case basis. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991).

#### A. *Original Claims*

There is a presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“[W]e are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). However, as discussed in subsection I, *supra*, issues of adequate written description may arise even for original claims, for example, when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the inventor had possession of the claimed invention at the time of filing. The claimed invention as a whole may not be adequately described if the claims require an

essential or critical feature which is not adequately described in the specification and which is not conventional or known in the art. Consider the claim “A gene comprising SEQ ID NO:1.” The claim may be construed to include specific structures in addition to SEQ ID NO:1, such as a promoter, a coding region, or other elements. Although SEQ ID NO:1 is fully disclosed, there may be insufficient description of other structures embraced by the claim (e.g., promoters, enhancers, coding regions, and other regulatory elements). For guidance on subject matter eligibility of such claims, see [MPEP § 2106](#).

An invention described solely in terms of a method of making and/or its function may lack written descriptive support where there is no described or art-recognized correlation between the disclosed function and the structure(s) responsible for the function. For example, the amino acid sequence of a protein along with knowledge of the genetic code might put an inventor in possession of the genus of nucleic acids capable of encoding the protein, but the same information would not place the inventor in possession of the naturally-occurring DNA or mRNA encoding the protein. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995) (holding that a process could not render the product of that process obvious under [35 U.S.C. 103](#)). (For guidance on subject matter eligibility of claims to naturally-occurring compositions, see [MPEP § 2106](#).) The Federal Circuit has pointed out that, under United States law, a description that merely renders a claimed invention obvious may not sufficiently describe the invention for the purposes of the written description requirement of [35 U.S.C. 112](#). See *Eli Lilly*, 119 F.3d at 1567, 43 USPQ2d at 1405; compare *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997) (“As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed.... Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.”).

Written description issues may also arise if the knowledge and level of skill in the art would not have permitted the ordinary artisan to immediately envisage the claimed product arising from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a “laundry list” disclosure of every possible moiety does not necessarily constitute a written description of every species in a genus because it would not “reasonably lead” those skilled in the art to any particular species); *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) (“If n-propylamine had been used in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present specification. The trouble is that there is no such disclosure, easy though it is to imagine it.” (emphasis in original)); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) (“[T]he specification does not clearly disclose to the skilled artisan that the inventors ... considered the ratio... to be part of their invention .... There is therefore no force to Purdue’s argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion”).

### **B. New or Amended Claims**

The proscription against the introduction of new matter in a patent application ([35 U.S.C. 132](#) and [251](#)) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981); see also [MPEP §§ 2163.06](#) through [2163.07](#) for a more detailed discussion of the written description requirement and its relationship to new matter. The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include

the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Thus, the written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations that are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (an adequate description of a genus may not support claims to a subgenus or species within the genus).

While there is no *in haec verba* requirement, newly added claims or claim limitations must be supported in the specification through express, implicit, or inherent disclosure. An amendment to correct an obvious error does not constitute new matter where the ordinary artisan would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). With respect to the correction of sequencing errors in applications disclosing nucleic acid and/or amino acid sequences, it is well known that sequencing errors are a common problem in molecular biology. See, e.g., David Laehemann *et al.*, Denoising DNA deep sequencing data—high-throughput sequencing errors and their correction, 17 *Briefings in Bioinformatics* 154–1791 (2016); Peter Richterich, Estimation of Errors in ‘Raw’ DNA Sequences: A Validation Study, 8 *Genome Research* 251-59 (1998). For example, if an application as filed includes incorrect nucleic acid sequence information and references a deposit of the sequenced material made in accordance with the requirements of [37 CFR 1.801 et seq.](#), an amendment to correct the nucleic acid sequence may be permissible where the amendment conforms the sequence information to the compound described in the specification and covered by the claims. See *Cubist Pharm., Inc. v. Hospira, Inc.*, 805 F.3d 1112, 1118, 117 USPQ2d 1054, 1059 (Fed. Cir. 2015) (“The fact that the inventors were mistaken as to one aspect of the structure of daptomycin at the time the application [ ] was filed does not render the specification

inadequate to satisfy the written description requirement. It was enough that the specification disclosed relevant identifying characteristics that distinguished daptomycin from other compounds and thus showed that the inventors had possession of daptomycin, even though they may not have had an accurate picture of the entire chemical structure of that compound.” *Id.* at 1120, 117 USPQ2d at 1060.) Deposits made after the filing date may be relied upon to provide support for the correction of sequence information only if applicant submits a statement in compliance with [37 CFR 1.804](#) stating that the biological material which is deposited is the biological material specifically defined in the application as filed.

Under certain circumstances, omission of a limitation can raise an issue regarding whether the inventor had possession of a broader, more generic invention. See, e.g., *PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1248, 64 USPQ2d 1344, 1353 (Fed. Cir. 2002) (Claim for a method of inhibiting sprout growth on tubers by treating them with spaced, *sequential* application of two chemicals was held invalid for lack of adequate written description where the specification indicated that invention was a method of applying a “*composition*” containing the two chemicals.); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) (claims to a sectional sofa comprising, *inter alia*, a console and a control means were held invalid for failing to satisfy the written description requirement where the claims were broadened by removing the location of the control means); *Johnson Worldwide Assoc. v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) (stating that, in *Gentry Gallery*, the “court’s determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element--the ‘control means’ --as ‘the only possible location’ and that variations were ‘outside the stated purpose of the invention.’ ... *Gentry Gallery*, then, considers the situation where the patent’s disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an ‘essential element of [the inventor’s] invention.’”); see also *Tronzo v. Biomet*, 156 F.3d at 1158-59, 47 USPQ2d at 1833 (Fed. Cir. 1998) (claims to generic cup shape

were not entitled to filing date of parent application which disclosed “conical cup” in view of the disclosure of the parent application stating the advantages and importance of the conical shape.). A claim that omits an element that applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) (“[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any ‘aryl or substituted aryl radical’ would be suitable for the purposes of the invention but rather that only *certain aryl radicals* and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.”(emphasis in original)). A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may also be subject to rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as not enabling, or under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). See also [MPEP § 2172.01](#).

The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

## II. METHODOLOGY FOR DETERMINING ADEQUACY OF WRITTEN DESCRIPTION

### A. *Read and Analyze the Specification for Compliance with 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, first paragraph*

Office personnel should adhere to the following procedures when reviewing patent applications for compliance with the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. There is a presumption that an adequate written description of the claimed invention is



present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96, thus the examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize the written description of the invention as providing adequate support for the claimed invention. To make a *prima facie* case, it is necessary to identify the claim limitations that are not adequately supported, and explain why the claim is not fully supported by the disclosure. For example, in *Hyatt v. Dudas*, 492 F.3d 1365, 1371, 83 USPQ2d 1373, 1376-1377 (Fed. Cir. 2007), the examiner made a *prima facie* case by clearly and specifically explaining why applicant's specification did not support the particular claimed combination of elements, even though applicant's specification listed each and every element in the claimed combination. The court found the "examiner was explicit that while each element may be individually described in the specification, the deficiency was lack of adequate description of their combination" and, thus, "[t]he burden was then properly shifted to [inventor] to cite to the examiner where adequate written description could be found or to make an amendment to address the deficiency." *Id.*; see also *Stored Value Solutions, Inc. v. Card Activation Techs.*, 499 Fed.App'x 5, 13-14 (Fed. Cir. 2012) (non-precedential) (Finding inadequate written support for claims drawn to a method of processing debit purchase transactions requiring three separate authorization codes because "the written description [did] not contain a method that include[d] all three codes" and "[e]ach authorization code is an important claim limitation, and the presence of multiple authorization codes in [the claim] was essential").

With respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See, e.g., *Hyatt v. Dudas*, 492 F.3d 1365, 1370, n.4, 83 USPQ2d 1373, 1376, n.4 (Fed. Cir. 2007) (citing [MPEP § 2163.04](#) which provides that a "simple statement such as 'applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation '\_\_\_' in the application as filed' may be sufficient where the claim is a new or amended claim, the support for the limitation is not

apparent, and applicant has not pointed out where the limitation is supported."); see also [MPEP §§ 714.02](#) and [2163.06](#) ("Applicant should ... specifically point out the support for any amendments made to the disclosure."); and [MPEP § 2163.04](#) ("If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."). The inquiry into whether the description requirement is met is a question of fact that must be determined on a case-by-case basis. *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1297, 111 USPQ2d 1780, 1788 (Fed. Cir. 2014) ("Whether a patent claim is supported by an adequate written description is a question of fact."); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close [to the claimed invention] the description must come to comply with Sec. 112 must be left to case-by-case development."); *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96 (inquiry is primarily factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure).

### **1. For Each Claim, Determine What the Claim as a Whole Covers**

Claim construction is an essential part of the examination process. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1319-1320, 97 USPQ2d 1737, 1750 (Fed. Cir. 2011) (stating that "[t]he construction of the claims [is] important to the written description analysis" and patent holder's failure "to point to a genuine factual dispute over whether the specification disclosed" the claimed subject matter made summary judgment proper on that issue.); *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

The entire claim must be considered, including the preamble language and the transitional phrase. “Preamble language” is that language in a claim appearing before the transitional phrase, e.g., before “comprising,” “consisting essentially of,” or “consisting of.” The transitional term “comprising” (and other comparable terms, e.g., “containing,” and “including”) is “open-ended” in that it covers the expressly recited subject matter, alone or in combination with unrecited subject matter. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves the “claim open for the inclusion of unspecified ingredients even in major amounts”); see also [MPEP § 2111.03](#). “By using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention. A ‘consisting essentially of’ claim occupies a middle ground between closed claims that are written in a ‘consisting of’ format and fully open claims that are drafted in a ‘comprising’ format.” *PPG Indus. v. Guardian Indus.*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). For the purposes of searching for and applying prior art under [35 U.S.C. 102](#) and [103](#), absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase ‘consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”); see also *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1239-1240, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or

components would materially change the characteristics of the claimed invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964); see also [MPEP § 2111.03](#). The claim as a whole, including all limitations found in the preamble (see *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention)), the transitional phrase, and the body of the claim, must be sufficiently supported to satisfy the written description requirement. An applicant shows that the inventor was in possession of the claimed invention by describing the claimed invention with all of its limitations. *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

The examiner should evaluate each claim to determine if sufficient structures, acts, or functions are recited to make clear the scope and meaning of the claim, including the weight to be given the preamble. See, e.g., *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995) (“[A] claim preamble has the import that the claim as a whole suggests for it.”); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”). The absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of adequate written description. Limitations may not, however, be imported into the claims from the specification.

## **2. Review the Entire Application to Understand How Applicant Provides Support for the Claimed Invention Including Each Element and/or Step**

Prior to determining whether the disclosure provides adequate written description for the claimed subject matter, the examiner should review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to

understand how applicant provides support for the various features of the claimed invention. The disclosure of an element may be critical where those of ordinary skill in the art would require it to understand that inventor was in possession of the invention. Compare *Rasmussen*, 650 F.2d at 1215, 211 USPQ at 327 (“one skilled in the art who read Rasmussen’s specification would understand that it is unimportant how the layers are adhered, so long as they are adhered”) (emphasis in original), with *Amgen, Inc. v. Chugai Pharm.Co., Ltd.*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (“it is well established in our law that conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials, and to describe how to obtain it”). The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated that the inventor was in possession of the claimed invention. Such a review is conducted from the standpoint of one of ordinary skill in the art at the time the application was filed (see, e.g., *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)) and should include a determination of the field of the invention and the level of skill and knowledge in the art. For some arts, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986). However, sufficient information must be provided to show that the inventor had possession of the invention as claimed.

### **3. Determine Whether There is Sufficient Written Description to Inform a Skilled Artisan That Inventor was in Possession of the Claimed Invention as a Whole at the Time the Application Was Filed**

#### **(a) Original claims**

Possession may be shown in many ways. For example, possession may be shown by describing

an actual reduction to practice of the claimed invention. Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that inventor had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. See, e.g., *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000) (the written description “inquiry is a factual one and must be assessed on a case-by-case basis”); see also *Pfaff v. Wells Elec., Inc.*, 55 U.S. at 66, 119 S.Ct. at 311, 48 USPQ2d at 1646 (“The word ‘invention’ must refer to a concept that is complete, rather than merely one that is ‘substantially complete.’ It is true that reduction to practice ordinarily provides the best evidence that an invention is complete. But just because reduction to practice is sufficient evidence of completion, it does not follow that proof of reduction to practice is necessary in every case. Indeed, both the facts of the Telephone Cases and the facts of this case demonstrate that one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice.”).

A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998). See also *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652, 2 USPQ2d 1465, 1468 (Fed. Cir. 1987) (“[T]here cannot be a reduction to practice of the invention ... without a physical embodiment which includes all limitations of the claim.”); *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 593, 44 USPQ2d 1610, 1614 (Fed. Cir. 1997) (“[A] reduction to practice does not occur until the inventor has determined that the invention will work for its intended purpose.”); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996) (determining that the invention will work for its intended purpose may require testing depending on the character of the invention and the problem it

solves). Description of an actual reduction to practice of a biological material may be shown by specifically describing a deposit made in accordance with the requirements of [37 CFR 1.801](#) *et seq.*, especially [37 CFR 1.804](#) and [1.809](#); see also subsection I. *supra*.

An applicant may show that the inventor was in possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that the inventor was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 (“drawings alone may provide a ‘written description’ of an invention as required by [Sec. 112](#)”); *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant’s specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) (“In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.”); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406 (“In claims involving chemical materials, generic formulae usually indicate with specificity what the generic claims encompass. One skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. Accordingly, such a formula is normally an adequate description of the claimed genus.”). The description need only describe in detail that which is new or not conventional. See *Hybritech v. Monoclonal Antibodies*, 802 F.2d at 1384, 231 USPQ at 94. This is equally true whether the claimed invention is directed to a product or a process.

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that inventor was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. *Enzo Biochem*, 323 F.3d at 964, 63 USPQ2d at 1613 (quoting the Written Description Guidelines, 66 Fed. Reg. at 1106, n. 49, stating that “if the art has

established a strong correlation between structure and function, one skilled in the art would be able to predict with a reasonable degree of confidence the structure of the claimed invention from a recitation of its function”). “Thus, the written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function.” *Id.*

For some biomolecules, examples of identifying characteristics include a sequence, structure, binding affinity, binding specificity, molecular weight, and length. Although structural formulas provide a convenient method of demonstrating possession of specific molecules, other identifying characteristics or combinations of characteristics may demonstrate the requisite possession. As explained by the Federal Circuit, “(1) examples are not necessary to support the adequacy of a written description; (2) the written description standard may be met ... even where actual reduction to practice of an invention is absent; and (3) there is no per se rule that an adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure.” *Falkner v. Inglis*, 448 F.3d 1357, 1366, 79 USPQ2d 1001, 1007 (Fed. Cir. 2006); see also *Capon v. Eshhar*, 418 F.3d at 1358, 76 USPQ2d at 1084 (“The Board erred in holding that the specifications do not meet the written description requirement because they do not reiterate the structure or formula or chemical name for the nucleotide sequences of the claimed chimeric genes” where the genes were novel combinations of known DNA segments.). However, the claimed invention itself must be adequately described in the written disclosure and/or the drawings. For example, disclosure of an antigen fully characterized by its structure, formula, chemical name, physical properties, or deposit in a public depository does not, without more, provide an adequate written description of an antibody claimed by its binding affinity to that antigen, even when preparation of such an antibody is routine and conventional. See *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1378, 124 USPQ2d 1354, 1361 (Fed. Cir. 2017) (“knowledge of the chemical structure of an antigen [does not give] the required kind of structure-identifying information about the corresponding antibodies”); see also *Centocor Ortho Biotech, Inc. v. Abbott*



*Labs.*, 636 F.3d 1341, 1351-52, 97 USPQ2d 1870, 1877 (Fed. Cir. 2011)(patent disclosed the antigen the claimed antibody was supposed to bind, but did not disclose any antibodies with the specific claimed properties).

Other ways of establishing possession of a claimed invention may include unique cleavage by particular enzymes, isoelectric points of fragments, detailed restriction enzyme maps, a comparison of enzymatic activities, or antibody cross-reactivity. See *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966 (Stating that the written description requirement may be satisfied by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.”). Conversely, describing a composition by its function alone typically will not suffice to sufficiently describe the composition. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406 (Holding that description of a gene’s function will not enable claims to the gene “because it is only an indication of what the gene does, rather than what it is.”); see also *Fiers*, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991)). An adequate written description of a chemical invention also requires a precise definition, such as by structure, formula, chemical name, or physical properties, and not merely a wish or plan for obtaining the chemical invention claimed. See, e.g., *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 927, 69 USPQ2d 1886, 1894-95 (Fed. Cir. 2004) (The patent at issue claimed a method of selectively inhibiting PGHS-2 activity by administering a non-steroidal compound that selectively inhibits activity of the PGHS-2 gene product, however the patent did not disclose any compounds that can be used in the claimed methods. While there was a description of assays for screening compounds to identify those that inhibit the expression or activity of the PGHS-2 gene product, there was no disclosure of which peptides, polynucleotides, and small organic molecules selectively inhibit PGHS-2. The court held that “[w]ithout such disclosure, the claimed methods cannot be said to have been described.”).

If a claim limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, it must be

interpreted to cover the corresponding structure, materials, or acts in the specification and “equivalents thereof.” See [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. See also *B. Braun Medical, Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997). In considering whether there is [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, support for a means- (or step) plus- function claim limitation, the examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. A means- (or step-) plus- function claim limitation is adequately described under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, if: (1) The written description adequately links or associates adequately described particular structure, material, or acts to perform the function recited in a means- (or step-) plus- function claim limitation; or (2) it is clear based on the facts of the application that one skilled in the art would have known what structure, material, or acts disclosed in the specification perform the function recited in a means- (or step-) plus- function limitation. See *Aristocrat Techs. Australia PTY Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1336-37, 86 USPQ2d 1235, 1242 (Fed. Cir. 2008) (“consideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification.’ It is not enough for the patentee simply to state or later argue that persons of ordinary skill in the art would know what structures to use to accomplish the claimed function.”), quoting *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999); *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 953, 83 USPQ2d 1118, 1123 (Fed. Cir. 2007) (“The inquiry is whether one of skill in the art would understand the specification itself to disclose a structure, not simply whether that person would be capable of implementing a structure.”). Note also that a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, “cannot stand where there is adequate description in the specification to satisfy [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, regarding means-plus-function recitations that are not, per se, challenged for being unclear.” *In re Noll*, 545 F.2d

141, 149, 191 USPQ 721, 727 (CCPA 1976). See "Supplemental Examination Guidelines for Determining the Applicability of [35 U.S.C. 112](#), para. 6," 65 Fed. Reg. 38510, June 21, 2000; see also [MPEP § 2181](#). However, when a means- (or step-) plus-function claim limitation is found to be indefinite based on failure of the specification to disclose sufficient corresponding structure, materials, or acts that perform the entire claimed function, then the claim limitation necessarily lacks an adequate written description. Thus, when a claim is rejected as indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph because there is no corresponding structure, materials, or acts, or an inadequate disclosure of corresponding structure, materials, or acts, for a means- (or step-) plus-function claim limitation, then the claim must also be rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of an adequate written description.

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94. See also *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005) ("The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge.... As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution."). If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

A claim which is limited to a single disclosed embodiment or species is analyzed as a claim drawn to a single embodiment or species, whereas a claim which encompasses two or more embodiments or species within the scope of the claim is analyzed as a claim drawn to a genus. See also [MPEP § 806.04\(e\)](#).

**i) For Each Claim Drawn to a Single Embodiment or Species:**

(A) Determine whether the application describes an actual reduction to practice of the claimed invention.

(B) If the application does not describe an actual reduction to practice, determine whether the invention is complete as evidenced by a reduction to drawings or structural chemical formulas that are sufficiently detailed to show that inventor was in possession of the claimed invention as a whole.

(C) If the application does not describe an actual reduction to practice or reduction to drawings or structural chemical formula as discussed above, determine whether the invention has been set forth in terms of distinguishing identifying characteristics as evidenced by other descriptions of the invention that are sufficiently detailed to show that inventor was in possession of the claimed invention.

(1) Determine whether the application as filed describes the complete structure (or acts of a process) of the claimed invention as a whole. The complete structure of a species or embodiment typically satisfies the requirement that the description be set forth "in such full, clear, concise, and exact terms" to show possession of the claimed invention. [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph; *cf. Fields v. Conover*, 443 F.2d 1386, 1392, 170 USPQ 276, 280 (CCPA 1971) (finding a lack of written description because the specification lacked the "full, clear, concise, and exact written description" which is necessary to support the claimed invention). If a complete structure is disclosed, the written description requirement is satisfied for that species or embodiment, and a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description must not be made.

(2) If the application as filed does not disclose the complete structure (or acts of a process) of the claimed invention as a whole, determine whether the specification discloses other relevant identifying characteristics sufficient to describe the claimed invention in such full, clear, concise, and exact terms that a skilled artisan would recognize inventor was in possession of the claimed invention. For example, in the biotech art, if a strong correlation has been established between structure and function, one skilled in the art would be able to predict with

a reasonable degree of confidence the structure of the claimed invention from a recitation of its function. Thus, the written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. In contrast, without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In this latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406 (written description requirement not satisfied by merely providing “a result that one might achieve if one made that invention”); *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming a rejection for lack of written description because the specification does “little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate”).

Whether the specification shows that the inventor was in possession of the claimed invention is not a single, simple determination, but rather is a factual determination reached by considering a number of factors. Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the inventor was in possession of the claimed species is sufficient. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. The description needed to satisfy the requirements of [35 U.S.C. 112](#) “varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence.” *Capon v. Eshhar*, 418 F.3d at 1357, 76 USPQ2d at 1084. Patents and printed publications in the art should be relied upon to determine whether an art is mature and what the level of knowledge and skill is in the art. In most technologies which are mature, and wherein the knowledge and level of skill

in the art is high, a written description question should not be raised for claims present in the application when originally filed, even if the specification discloses only a method of making the invention and the function of the invention.

In contrast, for inventions in emerging and unpredictable technologies, or for inventions characterized by factors not reasonably predictable which are known to one of ordinary skill in the art, more evidence is required to show possession. For example, disclosure of only a method of making the invention and the function may not be sufficient to support a product claim other than a product-by-process claim. See, e.g., *Fiers v. Revel*, 984 F.2d at 1169, 25 USPQ2d at 1605; *Amgen*, 927 F.2d at 1206, 18 USPQ2d at 1021. Where the process has actually been used to produce the product, the written description requirement for a product-by-process claim is clearly satisfied; however, the requirement may not be satisfied where it is not clear that the acts set forth in the specification can be performed, or that the product is produced by that process. Furthermore, disclosure of a partial structure without additional characterization of the product may not be sufficient to evidence possession of the claimed invention. See, e.g., *Amgen*, 927 F.2d at 1206, 18 USPQ2d at 1021 (“A gene is a chemical compound, albeit a complex one, and it is well established in our law that conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials, and to describe how to obtain it. Conception does not occur unless one has a mental picture of the structure of the chemical, or is able to define it by its method of preparation, its physical or chemical properties, or whatever characteristics sufficiently distinguish it. It is not sufficient to define it solely by its principal biological property, e.g., encoding human erythropoietin, because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property. We hold that when an inventor is unable to envision the detailed constitution of a gene so as to distinguish it from other materials, as well as a method for obtaining it, conception has not been achieved until reduction to practice has occurred, i.e., until after the gene has been isolated.” (citations omitted)). In such instances the alleged conception

fails not merely because the field is unpredictable or because of the general uncertainty surrounding experimental sciences, but because the conception is incomplete due to factual uncertainty that undermines the specificity of the inventor's idea of the invention. *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 1229, 32 USPQ2d 1915, 1920 (Fed. Cir. 1994). Reduction to practice in effect provides the only evidence to corroborate conception (and therefore possession) of the invention. *Id.*

Any claim to a species that does not meet the test described under at least one of (a), (b), or (c) must be rejected as lacking adequate written description under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

**ii) For each claim drawn to a genus:**

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see i)(A) above), reduction to drawings (see i)(B) above), or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the inventor was in possession of the claimed genus (see i)(C) above). See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. See *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1337, 2021 USPQ2d 893 (Fed. Cir. 2021) (“[T]he written description must lead a person of ordinary skill in the art to understand that the inventor possessed the entire scope of the claimed invention. *Ariad*, 598 F.3d at 1353–54 (“[T]he purpose of the written description requirement is to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification.” (internal quotation marks omitted)).”).

A “representative number of species” means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the

variation within the genus. See *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1300, 111 USPQ2d 1780, 1790 (Fed. Cir. 2014) (Claims directed to a functionally defined genus of antibodies were not supported by a disclosure that “only describe[d] one type of structurally similar antibodies” that “are not representative of the full variety or scope of the genus.”). The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure “indicates that the patentee has invented species sufficient to constitute the gen[us].” See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615; *Noelle v. Lederman*, 355 F.3d 1343, 1350, 69 USPQ2d 1508, 1514 (Fed. Cir. 2004) (Fed. Cir. 2004) (“[A] patentee of a biotechnological invention cannot necessarily claim a genus after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated.”). “A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.” *In re Curtis*, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) (Claims directed to PTFE dental floss with a friction-enhancing coating were not supported by a disclosure of a microcrystalline wax coating where there was no evidence in the disclosure or anywhere else in the record showing applicant conveyed that any other coating was suitable for a PTFE dental floss.) On the other hand, there may be situations where one species adequately supports a genus. See, e.g., *Rasmussen*, 650 F.2d at 1214, 211 USPQ at 326-27 (disclosure of a single method of adheringly applying one layer to another was sufficient to support a generic claim to “adheringly applying” because one skilled in the art reading the specification would understand that it is unimportant how the layers are adhered, so long as they are adhered); *In re Herschler*, 591 F.2d 693, 697, 200 USPQ 711, 714 (CCPA 1979) (disclosure of corticosteroid in DMSO sufficient to support claims drawn to a method of using a mixture of a “physiologically active steroid” and DMSO because “use of known chemical compounds in a manner auxiliary to the invention must have a corresponding



written description only so specific as to lead one having ordinary skill in the art to that class of compounds. Occasionally, a functional recitation of those known compounds in the specification may be sufficient as that description.”); *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 285 (CCPA 1973) (the phrase “air or other gas which is inert to the liquid” was sufficient to support a claim to “inert fluid media” because the description of the properties and functions of the air or other gas segmentizing medium would suggest to a person skilled in the art that appellant’s invention includes the use of “inert fluid” broadly.). See *Juno*, 10 F.4th 1337, 2021 USPQ2d 893 (Fed. Cir. 2021) (where the claims are directed to species that bind to various selected targets, it is not fatal that all species are not disclosed as long as the patent provides other means of identifying which species would possess the claimed common structural characteristics or shared traits).

The Federal Circuit has explained that a specification cannot always support expansive claim language and satisfy the requirements of [35 U.S.C. 112](#) “merely by clearly describing one embodiment of the thing claimed.” *LizardTech v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346, 76 USPQ2d 1731, 1733 (Fed. Cir. 2005). The issue is whether a person skilled in the art would understand inventor to have invented, and been in possession of, the invention as broadly claimed. In *LizardTech*, claims to a generic method of making a seamless discrete wavelet transformation (DWT) were held invalid under [35 U.S.C. 112](#), first paragraph, because the specification taught only one particular method for making a seamless DWT and there was no evidence that the specification contemplated a more generic method. *Id.*; see also *Tronzo v. Biomet*, 156 F.3d at 1159, 47 USPQ2d at 1833 (Fed. Cir. 1998)(holding that the disclosure of a species in a parent application did not provide adequate written description support for claims to a genus in a child application where the specification taught against other species).

Satisfactory disclosure of a “representative number” depends on whether one of skill in the art would recognize that the inventor was in possession of the necessary common attributes or features possessed by the members of the genus in view of the species disclosed. For inventions in an unpredictable art,

adequate written description of a genus which embraces widely variant species cannot be achieved by disclosing only one species within the genus. See, e.g., *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. Instead, the disclosure must adequately reflect the structural diversity of the claimed genus, either through the disclosure of sufficient species that are “representative of the full variety or scope of the genus,” or by the establishment of “a reasonable structure-function correlation.” Such correlations may be established “by the inventor as described in the specification,” or they may be “known in the art at the time of the filing date.” See *AbbVie*, 759 F.3d at 1300-01, 111 USPQ2d 1780, 1790-91 (Fed. Cir. 2014) (Holding that claims to all human antibodies that bind IL-12 with a particular binding affinity rate constant (i.e.,  $k_{off}$ ) were not adequately supported by a specification describing only a single type of human antibody having the claimed features because the disclosed antibody was not representative of other types of antibodies in the claimed genus, as demonstrated by the fact that other disclosed antibodies had different types of heavy and light chains, and shared only a 50% sequence similarity in their variable regions with the disclosed antibodies.). Description of a representative number of species does not require the description to be of such specificity that it would provide individual support for each species that the genus embraces. For example, in the molecular biology arts, if an applicant disclosed an amino acid sequence, it would be unnecessary to provide an explicit disclosure of nucleic acid sequences that encoded the amino acid sequence. Since the genetic code is widely known, a disclosure of an amino acid sequence would provide sufficient information such that one would accept that an inventor was in possession of the full genus of nucleic acids encoding a given amino acid sequence, but not necessarily any particular species. Cf. *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) and *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). If a representative number of adequately described species are not disclosed for a genus, the claim to that genus must be rejected as lacking adequate written description under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

**(b) New Claims, Amended Claims, or Claims Asserting Entitlement to the Benefit of an Earlier**

**Priority Date or Filing Date under 35 U.S.C. 119, 120, 365, or 386**

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 (“[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See [MPEP §§ 714.02](#) and [2163.06](#) (“Applicant should ... specifically point out the support for any amendments made to the disclosure.”).

To comply with the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, or to be entitled to an earlier priority date or filing date under [35 U.S.C. 119](#), [120](#), [365](#), or [386](#), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim “is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.” *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998); see also *Akeva LLC v. Nike, Inc.*, 817 Fed. Appx. 1005, 1012-13, 2020 USPQ2d 10797 (Fed. Cir. 2020) (The court found that the continuation patents were not entitled to the benefit of an earlier filing date because the continuation patents removed a disclaimer that the invention did not cover shoes with conventional fixed rear soles that was present in the earlier filed patents); *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989) (Original specification for method of forming images using photosensitive microcapsules which describes removal of microcapsules from surface and warns that capsules not be disturbed prior to formation of image, unequivocally teaches absence of permanently fixed microcapsules and supports amended language of claims requiring that microcapsules be “not permanently fixed” to underlying surface, and therefore meets description

requirement of [35 U.S.C. 112.](#)); *In re Robins*, 429 F.2d 452, 456-57, 166 USPQ 552, 555 (CCPA 1970) (“[W]here no explicit description of a generic invention is to be found in the specification[,] ... mention of representative compounds may provide an implicit description upon which to base generic claim language.”); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily implicitly described by a genus encompassing it and a species upon which it reads); *Regents of the Univ. of Minnesota v. Gilead Scis., Inc.*, 61 F.4th 1350, 1356-58, 2023 USPQ2d 269 (Fed. Cir. 2023) ( The court found the later-filed patent claims could not receive benefit under [35 U.S.C. 120](#), because the earlier-filed applications did not have *ipsis verbis* disclosure of the claimed subgenus and did not provide sufficient blaze marks to provide the later-filed claims with sufficient support under [35 U.S.C. 112\(a\).](#)); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (citations omitted)); *Yeda Research and Dev. Co. v. Abbott GMBH & Co.*, 837 F.3d 1341, 120 USPQ2d 1299 (Fed. Cir. 2016) (“Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention’s inherent properties.”) (citing *Kennecott Corp. v. Kyocera Int’l, Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194 (Fed. Cir. 1987)). Furthermore, each claim must include all elements which applicant has described as essential. See, e.g., *Johnson Worldwide Assoc. Inc. v. Zebco Corp.*, 175 F.3d at 993, 50 USPQ2d at 1613; *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d at 1479, 45 USPQ2d at 1503; *Tronzo v. Biomet*, 156 F.3d at 1159, 47 USPQ2d at 1833.

If the originally filed disclosure does not provide support for each claim limitation, or if an element which applicant describes as essential or critical is

not claimed, a new or amended claim must be rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as lacking adequate written description, or in the case of a priority or benefit claim under [35 U.S.C. 119](#), [120](#), [365](#), or [386](#), the priority or benefit claim must be denied.

### III. COMPLETE PATENTABILITY DETERMINATION UNDER ALL STATUTORY REQUIREMENTS AND CLEARLY COMMUNICATE FINDINGS, CONCLUSIONS, AND THEIR BASES

The above only describes how to determine whether the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, is satisfied. Regardless of the outcome of that determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code.

Once Office personnel have concluded analysis of the claimed invention under all the statutory provisions, including [35 U.S.C. 101](#), [112](#), [102](#), and [103](#), they should review all the proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions, and reasons which support them. When possible, the Office action should offer helpful suggestions on how to overcome rejections.

#### ***A. For Each Claim Lacking Written Description Support, Reject the Claim Under 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, first paragraph, for Lack of Adequate Written Description***

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the

examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

When appropriate, suggest amendments to the claims which can be supported by the application's written description, being mindful of the prohibition against the addition of new matter in the claims or description. See *Rasmussen*, 650 F.2d at 1214, 211 USPQ at 326.

#### ***B. Upon Reply by Applicant, Again Determine the Patentability of the Claimed Invention, Including Whether the Written Description Requirement Is Satisfied by Reperforming the Analysis Described Above in View of the Whole Record***

Upon reply by applicant, before repeating any rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, written description requirement, must be thoroughly analyzed and discussed in the next Office action. See *In re Alton*, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996).

### 2163.01 Support for the Claimed Subject Matter in Disclosure [R-11.2013]

A written description requirement issue generally involves the question of whether the subject matter of a claim is supported by [conforms to] the disclosure of an application as filed. If the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, or denial of the benefit of the filing date of a previously filed application. The claim should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the abstract, specification or drawings attempting to add new disclosure to that originally presented. While the test or analysis of description requirement and new matter issues is the same, the examining procedure and statutory basis for addressing these issues differ. See [MPEP § 2163.06](#).

### 2163.02 Standard for Determining Compliance With the Written Description Requirement [R-07.2022]

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed

subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, inventor was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows that the inventor was in possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the inventor was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the Univ. of Cal. v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharm.*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by “whatever characteristics sufficiently distinguish it”).

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C.112](#), first paragraph - description requirement, or denial of the benefit of



the filing date of a previously filed application, as appropriate.

See [MPEP § 2163](#) for examination guidelines pertaining to the written description requirement.

### **2163.03 Typical Circumstances Where Adequate Written Description Issue Arises [R-01.2024]**

A description requirement issue can arise in a number of different circumstances where it must be determined whether the subject matter of a claim is supported in an application as filed. See [MPEP § 2163](#) for examination guidelines pertaining to the written description requirement. Most typically, the issue will arise in the following circumstances:

#### **I. AMENDMENT AFFECTING A CLAIM**

An amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). An amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.

#### **II. RELIANCE ON FILING DATE OF PARENT APPLICATION UNDER 35 U.S.C. 120**

Under [35 U.S.C. 120](#), the claims in a U.S. application are entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). See also *Regents of the Univ. of Minnesota v. Gilead Scis., Inc.*, 61 F.4th 1350, 2023 USPQ2d 269 (Fed. Cir. 2023). The court noted that the Board evaluated whether the earlier-filed applications provided an “*ipsis verbis*” disclosure of the claimed subgenus. In reviewing this evaluation, the court agreed with the Board that the earlier-filed applications recited a compendium of common organic chemical functional groups, yielding a laundry list disclosure of different moieties

for every possible side chain or functional group. *Id.* at 1357. Thus, it was unclear how many compounds actually fell within the described genera and subgenera. *Id.* The court also noted that the Board then evaluated whether the prior applications “provided sufficient blaze marks to provide written description support for the ‘830 patent claims.” *Id.* at 1357. The court agreed with the Board that there were no adequate blaze marks. *Id.* at 1358. Therefore, the court held that the earlier-filed applications did not provide sufficient written description to support the later-filed patent claims under [35 U.S.C. 120](#).

#### **III. RELIANCE ON PRIORITY UNDER 35 U.S.C. 119**

Under [35 U.S.C. 119\(a\) or \(e\)](#), the claims in a U.S. application are entitled to the benefit of a foreign priority date or the filing date of a provisional application if the corresponding foreign application or provisional application supports the claims in the manner required by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. *Purdue Pharma LP v. Iancu*, 767 Fed. Appx. 918, 923-24, 2019 USPQ2d 136363 (Fed. Cir. 2019); *In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993); *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973); *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

#### **IV. SUPPORT FOR A CLAIM CORRESPONDING TO A COUNT IN AN INTERFERENCE**

In an interference proceeding, the claim corresponding to a count must be supported by the specification in the manner provided by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1971) (A broad generic disclosure to a class of compounds was not a sufficient written description of a specific compound within the class.). Furthermore, when a party to an interference seeks the benefit of an earlier-filed U.S. patent application, the earlier application must meet the requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph for the subject matter of the count. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

## V. ORIGINAL CLAIM NOT SUFFICIENTLY DESCRIBED

While there is a presumption that an adequate written description of the claimed invention is present in the specification as filed. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976), a question as to whether a specification provides an adequate written description may arise in the context of an original claim. An original claim may lack written description support when (1) the claim defines the invention in functional language specifying a desired result but the disclosure fails to sufficiently identify how the function is performed or the result is achieved or (2) a broad genus claim is presented but the disclosure only describes a narrow species with no evidence that the genus is contemplated. See *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349-50 (Fed. Cir. 2010) (*en banc*). The written description requirement is not necessarily met when the claim language appears *in ipsius verbis* in the specification. “Even if a claim is supported by the specification, the language of the specification, to the extent possible, must describe the claimed invention so that one skilled in the art can recognize what is claimed. The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement.” *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 968, 63 USPQ2d 1609, 1616 (Fed. Cir. 2002).

See [MPEP § 2163](#), subsection I.A and [MPEP § 2163](#), subsection II.A.3(a) for further discussion of rebutting the presumption of adequate written description for originally presented claims.

## VI. INDEFINITENESS REJECTION OF A MEANS-(OR STEP-) PLUS-FUNCTION LIMITATION

A claim limitation expressed in means- (or step-) plus-function language “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. If the specification fails to disclose sufficient corresponding structure, materials, or acts that perform the entire claimed function, then the claim limitation is indefinite because the applicant has in effect failed to particularly point out

and distinctly claim the invention as required by [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (*en banc*). Such a limitation also lacks an adequate written description as required by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, because an indefinite, unbounded functional limitation would cover all ways of performing a function and indicate that the inventor has not provided sufficient disclosure to show possession of the invention. See also [MPEP § 2181](#).

### 2163.04 Burden on the Examiner with Regard to the Written Description Requirement [R-11.2013]

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

## I. STATEMENT OF REJECTION REQUIREMENTS

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion (see [MPEP § 2163](#) for examination guidelines pertaining to the written description requirement). These findings should:

- (A) Identify the claim limitation(s) at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of

“unpredictability in the art” is not a sufficient reason to support a rejection for lack of adequate written description. A simple statement such as “Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation ‘\_\_\_\_\_’ in the application as filed.” may be sufficient where the claim is a new or amended claim, the support for the limitation is not apparent, and applicant has not pointed out where the limitation is supported.

See *Hyatt v. Dudas*, 492 F.3d 1365, 1370, 83 USPQ2d 1373, 1376 (Fed. Cir. 2007) (holding that “[MPEP] § 2163.04 [subsection] (I)(B) as written is a lawful formulation of the *prima facie* standard for a lack of written description rejection.”).

When appropriate, suggest amendments to the claims which can be supported by the application’s written description, being mindful of the prohibition against the addition of new matter in the claims or description. See *Rasmussen*, 650 F.2d at 1214, 211 USPQ at 326.

## II. RESPONSE TO APPLICANT’S REPLY

Upon reply by applicant, before repeating any rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, fully respond to applicant’s rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, written description requirement, must be thoroughly analyzed and discussed in the next Office action. See *In re Alton*, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996).

## 2163.05 Changes to the Scope of Claims [R-01.2024]

The failure to meet the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, or to be entitled to an earlier priority date or filing date under [35 U.S.C. 119](#), [120](#), or [365\(c\)](#), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See [MPEP § 2163](#) for examination guidelines pertaining to the written description requirement.

### I. BROADENING CLAIM

#### A. Omission of a Limitation

Under certain circumstances, omission of a limitation can raise an issue regarding whether the inventor had possession of a broader, more generic invention. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) (claims to a sectional sofa comprising, *inter alia*, a console and a control means were held invalid for failing to satisfy the written description requirement where the claims were broadened by removing the location of the control means.); *Johnson Worldwide Assoc. v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) (In *Gentry Gallery*, the “court’s determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element--the ‘control means’--as ‘the only possible location’ and that variations were ‘outside the stated purpose of the invention.’ *Gentry Gallery*, 134 F.3d at 1479, 45 USPQ2d at 1503. *Gentry Gallery*, then, considers the situation where the patent’s disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an ‘essential element of [the inventor’s] invention.’”); *Tronzo*

*v. Biomet*, 156 F.3d at 1158-59, 47 USPQ2d at 1833 (Fed. Cir. 1998) (claims to generic cup shape were not entitled to filing date of parent application which disclosed “conical cup” in view of the disclosure of the parent application stating the advantages and importance of the conical shape.); *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984) (reissue claim omitting “in synchronism” limitation with respect to scanning means and indexing means was not supported by the original patent’s disclosure in such a way as to indicate possession, as of the original filing date, of that generic invention.).

A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) (“[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any ‘aryl or substituted aryl radical’ would be suitable for the purposes of the invention but rather that only certain aryl radicals and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.”) (emphasis in original). Compare *In re Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983) (In a reissue application, a claim to a display device was broadened by removing the limitations directed to the specific tapered shape of the tips without violating the written description requirement. The shape limitation was considered to be unnecessary since the specification, as filed, did not describe the tapered shape as essential or critical to the operation or patentability of the claim.). A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may also be subject to rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as not enabling, or under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). See also [MPEP § 2172.01](#).

### ***B. Addition of Generic Claim***

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species. A “representative number of species” means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. See *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1300, 111 USPQ2d 1780, 1790 (Fed. Cir. 2014) (Claims directed to a functionally defined genus of antibodies were not supported by a disclosure that “only describe[d] one type of structurally similar antibodies” that “are not representative of the full variety or scope of the genus.”). The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure “indicates that the patentee has invented species sufficient to constitute the gen[us].” See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615. “A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.” *In re Curtis*, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) (Claims directed to PTFE dental floss with a friction-enhancing coating were not supported by a disclosure of a microcrystalline wax coating where there was no evidence in the disclosure or anywhere else in the record showing applicant conveyed that any other coating was suitable for a PTFE dental floss.) On the other hand, there may be situations where one species adequately supports a genus. See, e.g., *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326-27 (CCPA 1981) (disclosure of a single method of adheringly applying one layer to another was sufficient to support a generic claim to “adheringly applying” because one skilled in the art reading the specification would understand that it is unimportant how the layers are adhered, so long as they are adhered); *In re Herschler*, 591 F.2d 693, 697, 200 USPQ 711, 714 (CCPA 1979) (disclosure of corticosteroid in DMSO sufficient to support claims drawn to a method of using a mixture of a



“physiologically active steroid” and DMSO because “use of known chemical compounds in a manner auxiliary to the invention must have a corresponding written description only so specific as to lead one having ordinary skill in the art to that class of compounds. Occasionally, a functional recitation of those known compounds in the specification may be sufficient as that description.”); *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 285 (CCPA 1973) (the phrase “air or other gas which is inert to the liquid” was sufficient to support a claim to “inert fluid media” because the description of the properties and functions of the air or other gas segmentizing medium would suggest to a person skilled in the art that appellant’s invention includes the use of “inert fluid” broadly.). However, in *Tronzo v. Biomet*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1833 (Fed. Cir. 1998), the disclosure of a species in the parent application did not suffice to provide written description support for the genus in the child application where the specification taught against other species. See also *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (generic and subgeneric claims in the U.S. application were not entitled to the benefit of foreign priority where the foreign application disclosed only two of the species encompassed by the broad generic claim and the subgeneric Markush claim that encompassed 21 compounds).

## II. NARROWING OR SUBGENERIC CLAIM

The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a “laundry list” disclosure of every possible moiety for every possible position does not constitute a written description of every species in a genus because it would not “reasonably lead” those skilled in the art to any particular species); and *Regents of the Univ. of Minnesota v. Gilead Scis., Inc.*, 61 F.4th 1350, 1356-58, 2023 USQ2d 269 (Fed. Cir. 2023).

*In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) (“If n-propylamine had been used

in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present specification. The trouble is that there is no such disclosure, easy though it is to imagine it.”) (emphasis in original); *In Ex parte Ohshiro*, 14 USPQ2d 1750 (Bd. Pat. App. & Inter. 1989), the Board affirmed the rejection under [35 U.S.C. 112](#), first paragraph, of claims to an internal combustion engine which recited “at least one of said piston and said cylinder (head) having a recessed channel.” The Board held that the application which disclosed a cylinder head with a recessed channel and a piston without a recessed channel did not specifically disclose the “species” of a channeled piston.

While these and other cases find that recitation of an undisclosed species may violate the description requirement, a change involving subgeneric terminology may or may not be acceptable. Applicant was not entitled to the benefit of a parent filing date when the claim was directed to a subgenus (a specified range of molecular weight ratios) where the parent application contained a generic disclosure and a specific example that fell within the recited range because the court held that subgenus range was not described in the parent application. *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971). On the other hand, in *Ex parte Sorenson*, 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987), the subgeneric language of “aliphatic carboxylic acid” and “aryl carboxylic acid” did not violate the written description requirement because species falling within each subgenus were disclosed as well as the generic carboxylic acid. See also *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (“Whatever may be the viability of an inductive-deductive approach to arriving at a claimed subgenus, it cannot be said that such a subgenus is necessarily described by a genus encompassing it and a species upon which it reads.” (emphasis added)). Each case must be decided on its own facts in terms of what is reasonably communicated to those skilled in the art. *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984).

### III. RANGE LIMITATIONS

With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of “25%- 60%” and specific examples of “36%” and “50%.” A corresponding new claim limitation to “at least 35%” did not meet the description requirement because the phrase “at least” had no upper limit and caused the claim to read literally on embodiments outside the “25% to 60%” range, however a limitation to “between 35% and 60%” did meet the description requirement.

See also *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) (“[T]he specification does not clearly disclose to the skilled artisan that the inventors... considered the... ratio to be part of their invention.... There is therefore no force to Purdue’s argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion”). See also *General Hosp. Corp. v. Sienna Biopharmaceuticals, Inc.*, 888 F.3d 1368, 1372, 126 USPQ2d 1556, 1560 (Fed. Cir. 2018) (written description support for the claimed concentration is lacking where the specification discloses a range of optical densities and several discrete values in the range with no explicitly defined maximum concentration; and even if the specification may be read to convert each disclosed value into a range, there is insufficient written description for the entire claimed range where the disclosed range minimally overlaps with the claimed range). Compare *Union Oil of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232-33 (Fed. Cir. 2000) (Description in terms of ranges of chemical properties which work in combination with ranges of other chemical properties to produce an automotive gasoline that reduces emissions was found to provide an adequate written description even though the exact chemical components of each combination were not disclosed and the specification did not disclose any distinct embodiments corresponding to any claim at issue. “[T]he Patent

Act and this court’s case law require only sufficient description to show one of skill in the . . . art that the inventor possessed the claimed invention at the time of filing.”).

### 2163.06 Relationship of Written Description Requirement to New Matter [R-07.2022]

Lack of written description is an issue that generally arises with respect to the subject matter of a claim. If an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed. Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.

There are two statutory provisions that prohibit the introduction of new matter. The first provision is [35 U.S.C. 132](#), which provides that no amendment shall introduce new matter into the disclosure of the invention. The second provision is [35 U.S.C. 251](#), which provides that no new matter shall be introduced into the application for reissue.

#### I. TREATMENT OF NEW MATTER

If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under [35 U.S.C. 132](#) or [251](#) as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.

When the claims have not been amended, *per se*, but the specification has been amended to add new matter, a rejection of the claims under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph,

should be made whenever any of the claim limitations are affected by the added material.

When an amendment is filed in reply to an objection or rejection based on [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, a study of the entire application is often necessary to determine whether or not “new matter” is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure.

## II. REVIEW OF NEW MATTER OBJECTIONS AND/OR REJECTIONS

While ordinarily an objection is petitionable, and a rejection is appealable, when the objection is “determinative of the rejection”, such as the case where the examiner has indicated that the disclosure contains new matter, the matter may be addressed by the Patent Trial and Appeal Board. See [MPEP § 1201](#). For instance, if the claims and specification or drawings contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.

## III. CLAIMED SUBJECT MATTER NOT DISCLOSED IN REMAINDER OF SPECIFICATION

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Form paragraph 7.44 may be used where originally claimed subject matter lacks proper antecedent basis in the specification. See [MPEP § 608.01\(o\)](#).

### **2163.07 Amendments to Application Which Are Supported in the Original Description [R-08.2017]**

Amendments to an application which are supported in the original description are NOT new matter.

## I. REPHRASING

Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application may not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000). In *Schering*, the original disclosure was drawn to recombinant DNA molecules and used the term “leukocyte interferon.” Shortly after the filing date, a scientific committee abolished the term in favor of “IFN-(a),” since the latter term more specifically identified a particular polypeptide and since the committee found that leukocytes also produced other types of interferon. The court held that the subsequent amendment to the specification and claims substituting the term “IFN-(a)” for “leukocyte interferon” merely renamed the invention and did not constitute new matter. The claims were limited to cover only the interferon subtype coded for by the inventor’s original deposits.

## II. OBVIOUS ERRORS

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Where a foreign priority document under [35 U.S.C. 119](#) is of record in the U.S. application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending U.S. application. *Ex parte Bondiou*, 132 USPQ 356 (Bd. Pat. App. & Int. 1961). This prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more

applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. This prohibition does not apply where the U.S. application explicitly incorporates the foreign priority document by reference. For applications filed on or after September 21, 2004, where all or a portion of the specification or drawing(s) is inadvertently omitted from the U.S. application, a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application that is present on the filing date of the application is considered an incorporation by reference of the prior-filed foreign application as to the inadvertently omitted portion of the specification or drawing(s), subject to the conditions and requirements of [37 CFR 1.57\(a\)](#). See [37 CFR 1.57\(a\)](#) and [MPEP § 217](#).

Where a U.S. application as originally filed was in a non-English language and an English translation thereof was subsequently submitted pursuant to [37 CFR 1.52\(d\)](#), if there is an error in the English translation, applicant may rely on the disclosure of the originally filed non-English language U.S. application to support correction of an error in the English translation document.

### **2163.07(a) Inherent Function, Theory, or Advantage [R-07.2022]**

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973); *Yeda Research and Dev. Co. v. Abbott GMBH & Co.*, 837 F.3d 1341, 120 USPQ2d 1299 (Fed. Cir. 2016) (“Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention’s inherent properties.” (citing *Kennecott Corp. v. Kyocera Int’l, Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987))). “To establish

inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

### **2163.07(b) Incorporation by Reference [R-11.2013]**

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. See [37 CFR 1.57](#) and [MPEP § 608.01\(p\)](#) for Office policy regarding incorporation by reference. See [MPEP § 2181](#) for the impact of incorporation by reference on the determination of whether applicant has complied with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph is invoked.

### **2164 The Enablement Requirement [R-11.2013]**

The enablement requirement refers to the requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent.

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The



information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. However, to comply with [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, it is not necessary to “enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect.” *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003) (an invention directed to a general system to improve the cleaning process for semiconductor wafers was enabled by a disclosure showing improvements in the overall system). Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. A patent claim is invalid if it is not supported by an enabling disclosure.

The enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, is separate and distinct from the written description requirement.

*Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) (“the purpose of the ‘written description’ requirement is broader than to merely explain how to ‘make and use’”). See also [MPEP § 2161](#). Therefore, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, even if a new limitation is not described in the original disclosure, the addition of a new limitation in and of itself may not create an enablement problem provided that one skilled in the art could make and use the claimed invention with the new limitation. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria.

Furthermore, when the limitation is not described in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claimed invention. When claimed subject matter is only presented in the claims and not in the specification portion of the application, the specification should be objected to for lacking the

requisite support for the claimed subject matter using form paragraph 7.44. See [MPEP § 2163.06](#). This is an objection to the specification only and enablement issues should be treated separately.

### **2164.01 Test of Enablement [R-01.2024]**

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Minerals Separation Ltd. v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. See also *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term “undue experimentation,” it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. See [MPEP § 2164.06](#) for discussion of quantity of experimentation, including determining reasonableness of experimentation. See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361,

77 USPQ2d 1041 (Fed. Cir. 2005)(discussion of problems with a prior art feature does not mean that one of ordinary skill in the art would not know how to make and use this feature). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

In *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 2023 USPQ2d 602 (2023), the Supreme Court, held that claims drawn to a genus of monoclonal antibodies, which were functionally claimed by their ability to bind to a specific protein, PCSK9, were invalid due to lack of enablement. The claims at issue were functional, in that they defined the genus by its function (the ability to bind to specific residues of PCSK9) as opposed to reciting a specific structure (the amino acid sequence of the antibodies in the genus). The Supreme Court concluded that the patents at issue failed to adequately enable the full scope of the genus of antibodies that performed the function of binding to specific amino acid residues on PCSK9 and blocking the binding of PCSK9 to a particular cholesterol receptor, LDLR.

The Court clarified that the specification does not always need to “describe with particularity how to make and use every single embodiment within a claimed class.” *Id.* at 610-11. However, “[i]f a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent’s specification must enable a person skilled in the art to make and use the entire class....The more one claims, the more one must enable.” *Id.*

The specification may require a reasonable amount of experimentation to make and use the invention and what is reasonable will depend on the nature of the invention and the underlying art. For example, “it may suffice to give an example (or a few examples) if the specification also discloses some general quality . . . running through the class that gives it a peculiar fitness for the particular purpose” and “disclosing that general quality may reliably enable a person skilled in the art to make and use all of what is claimed, not merely a subset.” *Id.* at 611 (internal quotations omitted). However, the Supreme Court found that Amgen failed to enable all that it

claimed, even if allowing for a reasonable degree of experimentation. *Id.* at 613; see also *Baxalta Inc. v. Genentech, Inc.*, 81 F.4th 1362, 1367, 2023 USPQ2d 1103 (Fed. Cir. 2023) (“[t]he facts of this case are more analogous to—and are, in fact, indistinguishable from—those in *Amgen*. We do not interpret *Amgen* to have disturbed our prior enablement case law, including *Wands* and its factors.”). Moreover, “[w]e see no meaningful difference between *Wands*’ ‘undue experimentation’ and *Amgen*’s ‘[un]reasonable experimentation’ standards. *Id.* at footnote 4. See also *Guidelines for Assessing Enablement in Utility Applications and Patents in View of the Supreme Court Decision in Amgen Inc. et al. v. Sanofi et al.*, 89 FR 1563 (January 10, 2024), which explains that regardless of the technology the *Wands* factors should be used when assessing enablement.

## QUANTITY OF EXPERIMENTATION

A specification may call for a reasonable amount of experimentation to make and use a patented invention. What is reasonable in any case will depend on the nature of the invention and the underlying art. *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 2023 USPQ2d 602 (2023) (citing *Minerals Separation Ltd. v. Hyde*, 242 U.S. 261, 270-71 (1916)). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int’l Trade Comm’n 1983), *aff’d. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). See [MPEP § 2164.06](#) for further discussion of quantity of experimentation.

### **2164.01(a) Undue Experimentation Factors [R-01.2024]**

In order to determine compliance with the enablement requirement of [35 U.S.C. 112\(a\)](#), the Federal Circuit developed a framework of factors in

*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), referred to as the *Wands* factors to assess whether any necessary experimentation required by the specification is “reasonable” or is “undue.” Consistent with *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 2023 USPQ2d 602 (2023), the *Wands* factors continue to provide a framework for assessing enablement in a utility application or patent, regardless of technology area. See *Guidelines for Assessing Enablement in Utility Applications and Patents in View of the Supreme Court Decision in Amgen Inc. et al. v. Sanofi et al.*, 89 FR 1563 (January 10, 2024). These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO’s determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement). In *Wands*, the court noted that there was no disagreement as to the facts, but merely a disagreement as to the interpretation of the data and the conclusion to be made from the facts. *In re Wands*, 858 F.2d at 736-40, 8 USPQ2d at 1403-07. The court held that the specification was enabling with respect to the claims at issue and found that “there was considerable direction and guidance” in the specification; there was “a high level of skill in the art at the time the application was filed;” and “all of the methods needed to practice the invention were well known.” 858 F.2d at 740, 8 USPQ2d at 1406. After considering all the factors related to the enablement issue, the court concluded that “it would not require undue experimentation to obtain

antibodies needed to practice the claimed invention.” *Id.*, 8 USPQ2d at 1407.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The *Wands* factors are probative of the essential inquiry in determining whether one must engage in more than a reasonable amount of experimentation. The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. These factual considerations are discussed more fully in [MPEP § 2164.08](#) (scope or breadth of the claims), [§ 2164.05\(a\)](#) (nature of the invention and state of the prior art), [§ 2164.05\(b\)](#) (level of one of ordinary skill), [§ 2164.03](#) (level of predictability in the art and amount of direction provided by the inventor), [§ 2164.02](#) (the existence of working examples) and [§ 2164.06](#) (quantity of experimentation needed to make or use the invention based on the content of the disclosure).

The specification may require a reasonable amount of experimentation to make and use the invention and what is reasonable will depend on the nature of the invention and the underlying art. *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 596, 2023 USPQ2d 602 (2023). For example, “it may suffice to give an example (or a few examples) if the specification also discloses some general quality . . . running through the class that gives it a peculiar fitness for the

particular purpose” and “disclosing that general quality may reliably enable a person skilled in the art to make and use all of what is claimed, not merely a subset.” *Id.* at 611 (internal quotations omitted). However, while the specification in *Amgen* identified 26 exemplary antibodies that performed the claimed function by their amino acid sequences, the claims at issue were directed to a class which included “a ‘vast’ number of additional antibodies” that Amgen had not described by their amino acid sequences. *Id.* at 613. The Court found that Amgen sought to monopolize an entire class by their function, even though that class was much broader than the 26 exemplary antibodies disclosed by their amino acid structure. *Id.* at 613.

In *Amgen Inc. v. Sanofi, Aventisub LLC*, 987 F.3d 1080 (Fed. Cir. 2021), which the Supreme Court affirmed, the Federal Circuit explicitly applied the *Wands* factors to assess whether the specification of Amgen’s patent provided sufficient enablement, for purposes of [35 U.S.C. 112\(a\)](#), to make and use the full scope of the claimed invention. The court relied on evidence showing that the scope of the claims encompassed millions of antibodies and that it was necessary to screen each candidate antibody in order to determine whether it met the functional limitations of the claim. *Id.* at 1088. Consequently, the Federal Circuit concluded that there was a lack of enablement. See also the following cases across various technology areas: *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 959 F.3d 1091, 2020 USPQ2d 10550 (Fed. Cir. 2020); *Wyeth & Cordis Corp. v. Abbott Laboratories*, 720 F.3d 1380, 107 USPQ2d 1273 (Fed. Cir. 2013); *Enzo Life Sciences, Inc. v. Roche Molecular Systems, Inc.*, 928 F.3d 1340 (Fed. Cir. 2019); and *Idenix Pharmaceuticals LLC v. Gilead Sciences Inc.*, 941 F.3d 1149, 2019 USPQ2d 415844 (Fed. Cir. 2019).

### **2164.01(b) How to Make the Claimed Invention [R-08.2012]**

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of [35 U.S.C. 112](#) is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed

invention may be made does not render a claim invalid under [35 U.S.C. 112](#). *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 954 (1987).

Naturally, for unstable and transitory chemical intermediates, the “how to make” requirement does not require that the applicant teach how to make the claimed product in stable, permanent or isolatable form. *In re Breslow*, 616 F.2d 516, 521, 205 USPQ 221, 226 (CCPA 1980).

A key issue that can arise when determining whether the specification is enabling is whether the starting materials or apparatus necessary to make the invention are available. In the biotechnical area, this is often true when the product or process requires a particular strain of microorganism and when the microorganism is available only after extensive screening.

The court in *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971), made clear that if the practice of a method requires a particular apparatus, the application must provide a sufficient disclosure of the apparatus if the apparatus is not readily available. The same can be said if certain chemicals are required to make a compound or practice a chemical process. *In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981).

### **2164.01(c) How to Use the Claimed Invention [R-08.2017]**

If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, [35 U.S.C. 112](#) is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965); see also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995).

For example, it is not necessary to specify the dosage or method of use if it is known to one skilled in the art that such information could be obtained without undue experimentation. If one skilled in the art, based on knowledge of compounds having similar



physiological or biological activity, would be able to discern an appropriate dosage or method of use without undue experimentation, this would be sufficient to satisfy [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. The applicant need not demonstrate that the invention is completely safe. See also [MPEP §§ 2107.01](#) and [2107.03](#).

When a compound or composition claim is limited by a particular use, enablement of that claim should be evaluated based on that limitation. See *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991) (claiming a chimeric gene capable of being expressed in any cyanobacterium and thus defining the claimed gene by its use).

In contrast, when a compound or composition claim is not limited by a recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for nonenablement based on how to use. If multiple uses for claimed compounds or compositions are disclosed in the application, then an enablement rejection must include an explanation, sufficiently supported by the evidence, why the specification fails to enable each disclosed use. In other words, if any use is enabled when multiple uses are disclosed, the application is enabling for the claimed invention.

## **2164.02 Working and Prophetic Examples [R-01.2024]**

Compliance with the enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, does not turn on whether an example is disclosed. An example may be “working” or “prophetic.” A working example is based on work actually performed. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved. The claims should be drafted in a manner that assists readers in differentiating between actual working examples and prophetic examples (i.e., prophetic examples should not be described using the past tense, but rather in future or present tense).

An applicant need not have actually reduced the invention to practice prior to filing. In *Gould v. Quigg*, 822 F.2d 1074, 1078, 3 USPQ 2d 1302, 1304

(Fed. Cir. 1987), as of Gould’s filing date, no person had built a light amplifier or measured a population inversion in a gas discharge. The court held that “The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it.” 822 F.2d at 1078, 3 USPQ2d at 1304 (quoting *In re Chilowsky*, 229 F.2d 457, 461, 108 USPQ 321, 325 (CCPA 1956)).

The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970). *Allergan, Inc. v. Sandoz Inc.*, 796 F.3d 1293, 1310, 115 USPQ2d 2012, 2023 (Fed. Cir. 2015) (“Only a sufficient description enabling a person of ordinary skill in the art to carry out an invention is needed.”). Lack of a working example, however, is a factor to be considered, especially in a case involving an unpredictable and undeveloped art. But because only an enabling disclosure is required, applicant need not describe all actual embodiments.

The courts have further cautioned that the presence of prophetic examples alone should not be the basis for asserting that a specification is not enabling; rather, a lack of operative embodiments and undue experimentation should be determinative. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984).

### **I. NONE OR ONE WORKING EXAMPLE**

When considering the factors relating to a determination of non-enablement, if all the other factors point toward enablement, then the absence of working examples will not by itself render the invention non-enabled. In other words, lack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement. A single working example in the specification for a claimed invention is enough to preclude a rejection which states that nothing is enabled since at least that embodiment would be enabled. However, a rejection

stating that enablement is limited to a particular scope may be appropriate.

The presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with all the other factors. In some instances, “it may suffice to give an example (or a few examples) if the specification also discloses ‘some general quality . . . running through’ the class that gives it ‘a peculiar fitness for the particular purpose.’” *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 611, 2023 USPQ2d 602 (2023) (citing *Incandescent Lamp*, 159 U. S. 465, 475, 16 S. Ct. 75, 40 L. Ed. 221 (1895)). However, it should be noted that that “[t]he more one claims, the more one must enable.” *Id.* at 610. To make a valid rejection, the examiner must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate that one example across the entire scope of the claims.

## II. CORRELATION: *IN VITRO*/ *IN VIVO*

The issue of “correlation” is related to the issue of the presence or absence of working examples. “Correlation” as used herein refers to the relationship between *in vitro* or *in vivo* animal model assays and a disclosed or a claimed method of use. An *in vitro* or *in vivo* animal model example in the specification, in effect, constitutes a “working example” if that example “correlates” with a disclosed or claimed method invention. If there is no correlation, then the examples do not constitute “working examples.” In this regard, the issue of “correlation” is also dependent on the state of the prior art. In other words, if the art is such that a particular model is recognized as correlating to a specific condition, then it should be accepted as correlating unless the examiner has evidence that the model does not correlate. Even with such evidence, the examiner must weigh the evidence for and against correlation and decide whether one skilled in the art would accept the model as reasonably correlating to the condition. *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (reversing a USPTO decision based on finding that *in vitro* data did not support *in vivo* applications).

Since the initial burden is on the examiner to give reasons for the lack of enablement, the examiner must also give reasons for a conclusion of lack of correlation for an *in vitro* or *in vivo* animal model example. However, a rigorous or an invariable exact correlation is not required, as stated in *Cross v. Iizuka*, 753 F.2d 1040, 1050, 224 USPQ 739, 747 (Fed. Cir. 1985):

[B]ased upon the relevant evidence as a whole, there is a reasonable correlation between the disclosed *in vitro* utility and an *in vivo* activity, and therefore a rigorous correlation is not necessary where the disclosure of pharmacological activity is reasonable based upon the probative evidence. (Citations omitted.)

## III. WORKING EXAMPLES AND A CLAIMED GENUS

For a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art (in view of level of skill, state of the art and the information in the specification) would expect the claimed genus could be used in that manner without undue experimentation. Proof of enablement will be required for other members of the claimed genus only where adequate reasons are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation. In some instances “it may suffice to give an example (or a few examples) if the specification also discloses ‘some general quality . . . running through’ the class that gives it ‘a peculiar fitness for the particular purpose.’” *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 611, 2023 USPQ2d 602 (2023) (citing *Incandescent Lamp*, 159 U. S., at 475, 16 S. Ct. 75, 40 L. Ed. 221, 1895 Dec. Comm'r Pat. 675).

## IV. PROPHETIC EXAMPLES

When prophetic examples are described in a manner that is ambiguous or that implies that the results are actual, the adequacy and accuracy of the disclosure may come into question. If the characterization of the results, when taken in light of the disclosure as a whole, reasonably raises any questions as to

whether the results from the examples are actual, the examiner should determine whether to reject the appropriate claims based on an insufficient disclosure under the enablement and/or written description requirements of [35 U.S.C. 112\(a\)](#) following the guidance in [MPEP §§ 2164](#) and [2163](#), respectively. When such a rejection(s) is made, the applicant should reply with the results of an actual test or example that has been conducted, or by providing relevant arguments and/or declaration evidence that there is strong reason to believe that the result would be as predicted, being careful not to introduce new matter into the application. See *Hoffmann-La Roche, Inc. v. Promega Corp.*, 323 F.3d 1354, 1367, 66 USPQ2d 1385, 1394 (Fed. Cir. 2003) (improperly identifying a prophetic example in the past tense validly raises an inequitable conduct issue based on the intent of the inventors in drafting the example in the past tense, when the example, in fact, is prophetic); and *Apotex Inc. v. UCB, Inc.*, 763 F.3d 1354, 1362, 112 USPQ2d 1081, 1087 (Fed. Cir. 2014) (the inventor “admitted that he never performed the experiments described in the . . . patent, and yet he drafted the examples in the specification entirely in past-tense language.”). No results should be represented as actual results unless they have actually been achieved. See [MPEP § 2004](#), item 8.

### **2164.03 Relationship of Predictability of the Art and the Enablement Requirement [R-07.2022]**

The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The “amount of guidance or direction” refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling.

See, e.g., *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004) (“Nascent technology, however, must be enabled with a ‘specific and useful teaching.’ The law requires an enabling disclosure for nascent technology because a person of ordinary skill in the art has little or no knowledge independent from the patentee’s instruction. Thus, the public’s end of the bargain struck by the patent system is a full enabling disclosure of the claimed technology.” (citations omitted)).

The “predictability or lack thereof” in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability. In particular, the court in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971), stated:

[I]n the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles. Most often, additional factors, such as the teachings in pertinent references, will be available to substantiate any doubts that the asserted scope of objective enablement is in fact commensurate with the scope of protection sought and to support any demands based thereon for proof. [Footnote omitted.]

The scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required. A single embodiment may provide broad enablement in cases

involving predictable factors, such as mechanical or electrical elements. *In re Vickers*, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); *In re Cook*, 439 F.2d 730, 734, 169 USPQ 298, 301 (CCPA 1971). However, in applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims.

*In re Soll*, 97 F.2d 623, 624, 38 USPQ 189, 191 (CCPA 1938). In cases involving unpredictable factors, such as most chemical reactions and physiological activity, more may be required. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Vaeck*, 947 F.2d 488, 496, 20 USPQ2d 1438, 1445 (Fed. Cir. 1991). This is because in art areas having a high degree of uncertainty (i.e. the unpredictable arts) it is not reasonably predictable from the disclosure of one species, what other species will work.

#### **2164.04 Burden on the Examiner Under the Enablement Requirement [R-08.2017]**

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that the examiner intends to use when examining the application, based on their understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. See *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an

invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, “it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” 439 F.2d at 224, 169 USPQ at 370 (emphasis in original).

According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons explaining the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)) (discussed in [MPEP § 2164.07](#) regarding the relationship of the enablement requirement to the utility requirement of [35 U.S.C. 101](#)).

While the analysis and conclusion of a lack of enablement are based on the factors discussed in [MPEP § 2164.01\(a\)](#) and the evidence as a whole, it is not necessary to discuss each factor in the enablement rejection. However, it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a



whole. *In re Wands*, 858 F.2d 731, 737, 740, 8 USPQ2d 1400, 1404, 1407 (Fed. Cir. 1988). The explanation of the rejection should focus on those factors, reasons, and evidence that lead the examiner to conclude e.g., that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See MPEP § 2164.06(a). References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required.

In accordance with the principles of compact prosecution, if an enablement rejection is appropriate, the first Office action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. Providing the best rejection in the first Office action will also allow the second Office action to be made final should applicant fail to provide appropriate convincing arguments and/or evidence. Citing new references and/or expanding arguments in a second Office action could prevent that Office action from being made final. The principles of compact prosecution also dictate that if an enablement rejection is appropriate and the examiner recognizes limitations that would render the claims enabled, the examiner should note such limitations to applicant as early in the prosecution as possible.

In other words, the examiner should always look for enabled, allowable subject matter and communicate

to applicant what that subject matter is at the earliest point possible in the prosecution of the application.

### **2164.05 Determination of Enablement Based on Evidence as a Whole [R-07.2022]**

Once the examiner has weighed all the evidence and established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the application as a guide. *In re Brandstadter*, 484 F.2d 1395, 1406-07, 179 USPQ 286, 294 (CCPA 1973). The evidence provided by applicant need not be absolute but merely convincing to one skilled in the art, based on a preponderance of the evidence standard.

Applicant may submit factual affidavits under 37 CFR 1.132 or cite references to show what one skilled in the art knew at the time of filing the application. A declaration or affidavit is, itself, evidence that must be considered. The weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) (Stating that an “expert’s opinion on [an] ultimate legal conclusion must be supported by something more than a conclusory statement”); *cf. In re Alton*, 76 F.3d 1168, 1174, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996) (declarations relating to the written description requirement should have been considered).

Applicant should be encouraged to provide evidence demonstrating that the disclosure enables the claimed invention. In chemical and biotechnical applications, evidence actually submitted to the FDA to obtain approval for clinical trials may be submitted, but is not required. Considerations made by the FDA for approving clinical trials are different from those made by the USPTO in determining whether a claim is enabled. See *Scott v. Finney*, 34 F.3d 1058, 1063, 32 USPQ2d 1115, 1120 (Fed. Cir. 1994) (“Testing for full safety and effectiveness of a prosthetic device is more properly left to the [FDA].”). Once that evidence is submitted, it must be weighed with all

other evidence according to the standards set forth above so as to reach a determination as to whether the disclosure enables the claimed invention.

To overcome a *prima facie* case of lack of enablement, applicant must present argument and/or evidence that the disclosure would have enabled one of ordinary skill in the art to make and use the claimed invention at the time of filing. This does not preclude applicant from providing a declaration after the filing date which demonstrates that the claimed invention works. However, the examiner should carefully compare the steps, materials, and conditions used in the experiments of the declaration with those disclosed in the application to make sure that they are commensurate in scope; i.e., that the experiments used the guidance in the specification as filed and what was well known to one of skill in the art at the time of filing. Such a showing also must be commensurate with the scope of the claimed invention, i.e., must reasonably enable the full scope of the claimed invention. See *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1352, 2021 USPQ2d 519 (Fed. Cir. 2021) (The court found that undue experimentation was required to enable the full scope of the claims where there was ample evidence that relevant artisans would not know how to perform the claimed invention for more than a narrow range of the claimed scope of invention. Moreover, there was no evidence of actual reduction to practice to support patentee's rebuttal of the lack of enablement determination).

The examiner must then weigh all the evidence of record, including the specification, any new evidence supplied by applicant, and any evidence and scientific reasoning previously presented in the rejection and then decide whether the claimed invention is enabled, based on a preponderance of the evidence standard. The examiner should **never** make this determination based on personal opinion. The determination should always be based on the weight of all the evidence of record.

### **2164.05(a) Specification Must Be Enabling as of the Filing Date [R-07.2022]**

Whether the specification would have been enabling as of the filing date involves consideration of the nature of the invention, the state of the prior art, and

the level of skill in the art. The initial inquiry is into the nature of the invention, i.e., the subject matter to which the claimed invention pertains. The nature of the invention becomes the backdrop to determine the state of the art and the level of skill possessed by one skilled in the art.

The state of the prior art is what one skilled in the art would have known, at the time the application was filed, about the subject matter to which the claimed invention pertains. The relative skill of those in the art refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains at the time the application was filed. See [MPEP § 2164.05\(b\)](#). See *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1352, 2021 USPQ2d 519 (Fed. Cir. 2021).

The state of the prior art provides evidence for the degree of predictability in the art and is related to the amount of direction or guidance needed in the specification as filed to meet the enablement requirement. The state of the prior art is also related to the need for working examples in the specification.

The state of the art for a given technology is not static in time. It is entirely possible that a disclosure which would not have been enabled if filed on January 2, 1990 might be enabled if the same disclosure had been filed on January 2, 1996. Therefore, the state of the prior art must be evaluated for each application based on its filing date.

[35 U.S.C. 112\(a\)](#) requires the specification to be enabling only to a person “skilled in the art to which it pertains, or with which it is most nearly connected.” In general, the pertinent art should be defined in terms of the problem to be solved rather than in terms of the technology area, industry, trade, etc. for which the invention is used.

The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed.

Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The state of the art existing at the filing date of the application is used to determine whether a particular disclosure is enabling as of the filing date. *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1325-26 (Fed. Cir. 2004) (Stating that “a patent document cannot enable technology that arises after the date of application.”). Information published for the first time after the filing date generally cannot be used to show what was known at the time of filing. *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402,405-06 (CCPA 1976); *In re Budnick*, 537 F.2d 535, 538, 190 USPQ 422, 424 (CCPA 1976) (In general, if an applicant seeks to use a patent to prove the state of the art for the purpose of the enablement requirement, the patent must have an issue date earlier than the effective filing date of the application.). While a later dated publication cannot supplement an insufficient disclosure in a prior dated application to make it enabling, an applicant can offer the testimony of an expert based on the publication as evidence of the level of skill in the art at the time the application was filed. *Gould v. Quigg*, 822 F.2d 1074, 1077, 3 USPQ2d 1302, 1304 (Fed. Cir. 1987).

In general, the examiner should not use post-filing date references to demonstrate that a patent is not enabled. Exceptions to this rule could occur if a later-dated reference provides evidence of what one skilled in the art would have known on or before the effective filing date of the patent application. *In re Hogan*, 559 F.2d 595, 605, 194 USPQ 527, 537 (CCPA 1977). If a publication demonstrates that those of ordinary skill in the art would find that a particular invention was not enabled years after the filing date, the publication would be evidence that the claimed invention was not possible at the time of filing. See *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513-14 (Fed. Cir. 1993) (The court found that an article published 5 years after the filing date of the application adequately supported the examiner’s position that the physiological activity of certain viruses was sufficiently unpredictable so that a person skilled in the art would not have believed that the success with one virus and one

animal could be extrapolated successfully to all viruses with all living organisms. Accordingly, the court held that the applicant’s earlier-filed claims not limited to the specific virus or the specific animal were nonenabled).

### **2164.05(b) Specification Must Be Enabling to Persons Skilled in the Art [R-01.2024]**

The relative skill of those in the art refers to the skill level of those in the art in the technological field to which the claimed invention pertains. See *United Therapeutics Corp. v Liquidia Techs., Inc.*, 74 F.4th 1360, 1370, 2023 USPQ2d 862 (Fed. Cir. 2023) (The court found that the claims directed to administration of treprostinil to treat all five types of pulmonary hypertension, which were construed to not require safety and efficacy, were adequately enabled by the specification which described administration, concentrations and dosages as well as an open label study despite potential safety concerns associated with one type of pulmonary hypotension. The record included evidence that “a skilled artisan would understand that the claimed administration of treprostinil would vasodilate the pulmonary vasculature, improve hemodynamics, and in this way for a single dose, treat a patient’s elevated pulmonary blood pressure independent of the type (i.e., group) of pulmonary hypertension patient.”).

Where different arts are involved in the invention, the specification is enabling if it enables persons skilled in each art to carry out the aspect of the invention applicable to their specialty. *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968). See *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1352, 2021 USPQ2d 519 (Fed. Cir. 2021) (The court found that undue experimentation was required to enable the full scope of the claims where there was ample evidence that relevant artisans would not know how to perform the claimed invention for more than a narrow range of the claimed scope of invention).

When an invention, in its different aspects, involves distinct arts, the specification is enabling if it enables those skilled in each art, to carry out the aspect proper to their specialty. “If two distinct technologies are relevant to an invention, then the disclosure will be adequate if a person of ordinary skill in each of

the two technologies could practice the invention from the disclosures.” *Technicon Instruments Corp. v. Alpkem Corp.*, 664 F. Supp. 1558, 1578, 2 USPQ2d 1729, 1742 (D. Ore. 1986), aff’d in part, vacated in part, rev’d in part, 837 F. 2d 1097 (Fed. Cir. 1987) (unpublished opinion), appeal after remand, 866 F. 2d 417, 9 USPQ 2d 1540 (Fed. Cir. 1989). In *Ex parte Zechnall*, 194 USPQ 461 (Bd. Pat. App. & Int. 1973), the Board stated “appellants’ disclosure must be held sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants’ invention.” 194 USPQ at 461.

## 2164.06 Quantity of Experimentation [R-01.2024]

“A specification may call for a reasonable amount of experimentation to make and use a claimed invention, and reasonableness in any case will depend on the nature of the invention and the underlying art.” *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 596, 2023 USPQ2d 602 (2023).

The quantity of experimentation needed to be performed by one skilled in the art is only one factor involved in determining whether “undue experimentation” is required to make and use the invention. “[A]n extended period of experimentation may not be undue if the skilled artisan is given sufficient direction or guidance.” *In re Colianni*, 561 F.2d 220, 224, 195 USPQ 150, 153 (CCPA 1977). “The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.” *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (citing *In re Angstadt*, 537 F.2d 498, 502-04, 190 USPQ 214, 217-19 (CCPA 1976)). Time and expense are merely factors in this consideration and are not the controlling factors. *United States v. Telectronics Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989).

In the chemical arts, the guidance and ease in carrying out an assay to achieve the claimed

objectives may be an issue to be considered in determining the quantity of experimentation needed. For example, if a very difficult and time consuming assay is needed to identify a compound within the scope of a claim, then this great quantity of experimentation should be considered in the overall analysis. Time and difficulty of experiments are not determinative if they are merely routine. Quantity of examples is only one factor that must be considered before reaching the final conclusion that undue experimentation would be required. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

### I. EXAMPLE OF REASONABLE EXPERIMENTATION

In *United States v. Telectronics, Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989), the court reversed the findings of the district court for lack of clear and convincing proof that undue experimentation was needed. The court ruled that since one embodiment (stainless steel electrodes) and the method to determine dose/response was set forth in the specification, the specification was enabling. The question of time and expense of such studies, approximately \$50,000 and 6-12 months standing alone, failed to show undue experimentation.

### II. EXAMPLE OF UNREASONABLE EXPERIMENTATION

In *Amgen Inc. v. Sanofi, Aventisub LLC*, 987 F.3d 1080 (Fed. Cir. 2021), which the Supreme Court affirmed, the Federal Circuit relied on evidence showing that the scope of the claims encompassed millions of antibodies and that it was necessary to screen each candidate antibody in order to determine whether it met the functional limitations of the claim. *Id.* at 1088. Consequently, the Federal Circuit concluded that there was a lack of enablement.

In *In re Ghiron*, 442 F.2d 985, 991-92, 169 USPQ 723, 727-28 (CCPA 1971), functional “block diagrams” were insufficient to enable a person skilled in the art to practice the claimed invention with only a reasonable degree of experimentation because the claimed invention required a “modification to prior art overlap computers,” and because “many of the components which appellants



illustrate as rectangles in their drawing necessarily are themselves complex assemblages . . . . It is common knowledge that many months or years elapse from the announcement of a new computer by a manufacturer before the first prototype is available. This does not bespeak of a routine operation but of extensive experimentation and development work. . . .” See *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1352, 2021 USPQ2d 519 (Fed. Cir. 2021) (The court found that undue experimentation was required to enable the full scope of the claims where there was ample evidence that relevant artisans would not know how to perform the claimed invention for more than a narrow range of the claimed scope of invention).

### **2164.06(a) Examples of Enablement Issues-Missing Information [R-08.2017]**

It is common that doubt arises about enablement because information is missing about one or more essential claim elements or relationships between elements which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why the missing information is needed to provide enablement.

#### **I. ELECTRICAL AND MECHANICAL DEVICES OR PROCESSES**

Enablement serves the dual function of ensuring adequate disclosure of the claimed invention and of preventing claims broader than the disclosed invention. Broad claim language is used at the peril of losing any claim that cannot be enabled across its full scope. For example, in *MagSil Corp. v. Hitachi Global Storage Technologies, Inc.*, 687 F.3d 1377, 103 USPQ2d 1769 (Fed. Cir. 2012), the claim recited a change in resistance by at least 10% at room temperature, but the specification contained no showing that the knowledge of a person of ordinary skill in the art at the time of filing would have been able to achieve resistive changes in values that greatly exceed 10% without undue experimentation (noting that it took nearly 12 years of experimentation to achieve modern values above 600%). Similarly in *Auto. Techs. Int’l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1283, 84 USPQ2d

1108, 1115 (Fed. Cir. 2007), a claim limitation means responsive to the motion of a mass was construed to include both mechanical and electronic side impact sensors for performing the function of initiating an occupant protection apparatus. The specification did not disclose any details or circuitry for electronic side impact sensors, and thus, failed to apprise one of ordinary skill how to make and use the electronic sensor.

A disclosure of an electrical circuit apparatus, depicted in the drawings by block diagrams with functional labels, was held to be nonenabling in *In re Gunn*, 537 F.2d 1123, 1129, 190 USPQ 402, 406 (CCPA 1976), where there was no indication in the specification as to whether the parts represented by boxes were “off the shelf” or must be specifically constructed or modified for applicant’s system. Also there were no details in the specification of how the parts should be interconnected, timed and controlled so as to obtain the specific operations desired by the applicant. In *In re Donohue*, 550 F.2d 1269, 193 USPQ 136 (CCPA 1977), the lack of enablement was caused by lack of information in the specification about a single block labeled “LOGIC” in the drawings. See also *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 57 USPQ2d 1293 (Fed. Cir. 2001) (Claims directed to a method of determining the location of a horizontal borehole in the earth failed to comply with enablement requirement of [35 U.S.C. 112](#) because certain computer programming details used to perform claimed method were not disclosed in the specification, and the record showed that a person of skill in art would not understand how to “compare” or “rescale” data as recited in the claims in order to perform the claimed method.).

*In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971), involved a method of facilitating transfers from one subset of program instructions to another which required modification of prior art “overlap mode” computers. The Board rejected the claims on the basis that, *inter alia*, the disclosure was insufficient to satisfy the requirements of [35 U.S.C. 112](#), first paragraph and was affirmed. The Board focused on the fact that the drawings were “block diagrams, i.e., a group of rectangles representing the elements of the system, functionally labeled and interconnected by lines.” 442 F.2d at 991, 169 USPQ

at 727. The specification did not particularly identify each of the elements represented by the blocks or the relationship therebetween, nor did it specify particular apparatus intended to carry out each function. The Board further questioned whether the selection and assembly of the required components could be carried out routinely by persons of ordinary skill in the art.

An adequate disclosure of a device may require details of how complex components are constructed and perform the desired function. The claim before the court in *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974), was directed to a system which comprised several component parts (e.g., computer, timing and control mechanism, A/D converter, etc.) only by generic name and overall ultimate function. The court concluded that there was not an enabling disclosure because the specification did not describe how “complex elements known to perform broadly recited functions in different systems would be adaptable for use in Appellant’s particular system with only a reasonable amount of experimentation” and that “an unreasonable amount of work would be required to arrive at the detailed relationships appellant says that he has solved.” 500 F.2d at 566, 182 USPQ at 302.

## II. MICROORGANISMS

Patent applications involving living biological products, such as microorganisms, as critical elements in the process of making the invention, present a unique question with regard to availability. For example, in *In re Argoudelis*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970), the court considered the enablement of claims drawn to a fermentative method of producing two novel antibiotics using a specific microorganism and claims to the novel antibiotics so produced. As stated by the court, “a unique aspect of using microorganisms as starting materials is that a sufficient description of how to obtain the microorganism from nature cannot be given.” 434 F.2d at 1392, 168 USPQ at 102. It was determined by the court that availability of the biological product via a public depository provided an acceptable means of meeting the written description and the enablement requirements of [35 U.S.C. 112](#), first paragraph.

To satisfy the enablement requirement a deposit must be made “prior to issue” but need not be made prior to filing the application. *In re Lundak*, 773 F.2d 1216, 1223, 227 USPQ 90, 95 (Fed. Cir. 1985).

The availability requirement of enablement must also be considered in light of the scope or breadth of the claim limitations. The Board considered this issue in an application which claimed a fermentative method using microorganisms belonging to a species. Applicants had identified three novel individual strains of microorganisms that were related in such a way as to establish a new species of microorganism, a species being a broader classification than a strain. The three specific strains had been appropriately deposited. The issue before the Board focused on whether the specification enabled one skilled in the art to make any member of the species other than the three strains which had been deposited. The Board concluded that the verbal description of the species was inadequate to allow a skilled artisan to make any and all members of the claimed species. *Ex parte Jackson*, 217 USPQ 804, 806 (Bd. Pat. App. & Int. 1982).

See [MPEP § 2402](#) - [§ 2411.03](#) for a detailed discussion of the deposit rules. See [MPEP § 2411.01](#) for rejections under [35 U.S.C. 112](#) based on deposit issues.

## III. DRUG CASES

See [MPEP § 2107](#) - [§ 2107.03](#) for a discussion of the utility requirement under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, in drug cases.

### **2164.06(b) Examples of Enablement Issues — Biological and Chemical Cases [R-10.2019]**

The following summaries should not be relied on to support a case of lack of enablement without carefully reading the case.

#### **I. SEVERAL DECISIONS RULING THAT THE DISCLOSURE WAS NONENABLING**

(A) In *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999), the court held that two patents with claims directed

to genetic antisense technology (which aims to control gene expression in a particular organism), were invalid because the breadth of enablement was not commensurate in scope with the claims. Both specifications disclosed applying antisense technology in regulating three *E. coli* genes. Despite the limited disclosures, the specifications asserted that the “[t]he practices of this invention are generally applicable with respect to any organism containing genetic material which is capable of being expressed ... such as bacteria, yeast, and other cellular organisms.” Thus, the court construed the claims to encompass the application of antisense methodology in a broad range of organisms. Ultimately, the court relied on the fact that (1) the amount of direction presented and the number of working examples provided in the specification were very narrow compared to the wide breadth of the claims at issue, (2) antisense gene technology was highly unpredictable, and (3) the amount of experimentation required to adapt the practice of creating antisense DNA from *E. coli* to other types of cells was quite high, especially in light of the record, which included notable examples of the inventor’s own failures to control the expression of other genes in *E. coli* and other types of cells. Thus, the teachings set forth in the specification provided no more than a “plan” or “invitation” for those of skill in the art to experiment using the technology in other types of cells.

(B) In *In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993), Wright’s 1983 application disclosed a vaccine against the RNA tumor virus known as Prague Avian Sarcoma Virus, a member of the Rous Associated Virus family. Wright claimed a vaccine “comprising an immunologically effective amount” of a viral expression product using functional language. *Id.* at 1559, 27 USPQ2d at 1511. The examiner rejected Wright’s claims covering all RNA viruses as well as all avian RNA viruses. The examiner provided a teaching that, in 1988, a vaccine for another retrovirus (i.e., HIV) remained an intractable problem. This evidence, along with evidence that the RNA viruses were a diverse and complicated genus, convinced the Federal Circuit that the invention was not enabled for either all retroviruses or even for avian retroviruses.

(C) In *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), Goodman’s 1985

application functionally claimed a method of producing protein in plant cells by expressing a foreign gene. The court stated that “[n]aturally, the specification must teach those of skill in the art ‘how to make and use the invention as broadly as it is claimed.’” *Id.* at 1050, 29 USPQ2d at 2013. Although protein expression in dicotyledonous plant cells was enabled, the claims covered protein expression in any plant cell. The examiner provided evidence that even as late as 1987, use of the claimed method in monocot plant cells was not enabled. *Id.* at 1051, 29 USPQ2d at 2014.

(D) In *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991), the court found that several claims to a chimeric gene capable of being expressed in Cyanobacteria cells were not supported by an enabling disclosure. The court determined that claims at issue were not limited to any particular genus or species of cyanobacteria and the specification mentioned nine genera and the working examples employed one species of cyanobacteria. The court then reasoned that the claims were not enabled after “[t]aking into account the relatively incomplete understanding of the biology of cyanobacteria as of appellants’ filing date, as well as the limited disclosure by appellants of the particular cyanobacterial genera operative in the claimed invention....”

(E) In *In re Colianni*, 561 F.2d 220, 222-23, 195 USPQ 150, 152 (CCPA 1977), the court affirmed a rejection under [35 U.S.C. 112](#), first paragraph, because the claims were directed to a method of mending a fractured bone by applying “sufficient” ultrasonic energy to the bone, but applicant’s specification did not define what constituted a “sufficient” dosage or teach one of ordinary skill how to select the appropriate intensity, frequency, or duration of the ultrasonic energy.

## II. SEVERAL DECISIONS RULING THAT THE DISCLOSURE WAS ENABLING

(A) In *PPG Indus. v. Guardian Indus.*, 75 F.3d 1558, 1564, 37 USPQ2d 1618, 1623 (Fed. Cir. 1996), the court found PPG’s claims to a UV-absorbing, ceramide-free glass enabled, even though PPG’s specification included several examples in which faulty UV transmittance data made it appear as though the production of a cerium oxide-free glass satisfying the UV transmittance limitation would be difficult, because the

specification indicated that such glass could be made. The specification was also found to indicate how to minimize the cerium content while maintaining low UV transmittance.

(B) In *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988), the court reversed the rejection for lack of enablement under [35 U.S.C. 112](#), first paragraph, concluding that undue experimentation would not be required to practice the claimed immunoassay using monoclonal antibodies to detect hepatitis B-surface antigen (HBsAg). The court found that the nature of monoclonal antibody technology was such that experiments first involve the entire attempt to make monoclonal hybridomas to determine which ones secrete antibody with the desired characteristics. The court found that the specification also provided considerable direction and guidance on how to practice the claimed invention and presented working examples, that all of the methods needed to practice the invention were well known, and that there was a high level of skill in the art at the time the application was filed. Furthermore, the applicant carried out the entire procedure for making a monoclonal antibody against HBsAg three times and each time was successful in producing at least one antibody which fell within the scope of the claims.

(C) In *In re Bundy*, 642 F.2d 430, 434, 209 USPQ 48, 51-52 (CCPA 1981), the court ruled that appellant's disclosure was sufficient to enable one skilled in the art to use the claimed analogs of naturally occurring prostaglandins even though the specification lacked any examples of specific dosages, because the specification taught that the novel prostaglandins had certain pharmacological properties and possessed activity similar to known E-type prostaglandins.

### **2164.06(c) Examples of Enablement Issues – Computer Programming Cases [R-10.2019]**

To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation.

In computer applications, it is not unusual for the claimed invention to involve two areas of prior art

or more than one technology, e.g., an appropriately programmed computer and an area of application of said computer. *White Consol. Indus. v. Vega Servo-Control, Inc.*, 214 USPQ 796, 821 (S.D.Mich. 1982). In regard to the “skilled in the art” standard, in cases involving both the art of computer programming, and another technology, the examiner must recognize that the knowledge of persons skilled in both technologies is the appropriate criteria for determining sufficiency. See *In re Naquin*, 398 F.2d 863, 158 USPQ 317 (CCPA 1968); *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *White Consol. Indus.*, 214 USPQ at 822, *aff'd on related grounds*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983).

In a typical computer application, system components are often represented in a “block diagram” format, i.e., a group of hollow rectangles representing the elements of the system, functionally labeled, and interconnected by lines. Such block diagram computer cases may be categorized into (A) systems that include but are more comprehensive than a computer and (B) systems wherein the block elements are totally within the confines of a computer. For instances where a computer invention is claimed using functional language, that is not limited to a specific structure, see [MPEP § 2161.01](#) or [MPEP § 2181](#), subsection II.B.2(a).

### **I. BLOCK ELEMENTS MORE COMPREHENSIVE THAN A COMPUTER**

The first category of such block diagram cases involves systems which include a computer as well as other system hardware and/or software components. In order to meet the burden of establishing a reasonable basis for questioning the adequacy of such disclosure, the examiner should initiate a factual analysis of the system by focusing on each of the individual block element components. More specifically, such an inquiry should focus on the diverse functions attributed to each block element as well as the teachings in the specification as to how such a component could be implemented. If based on such an analysis, the examiner can reasonably contend that more than routine experimentation would be required by one of ordinary skill in the art to implement such a component or components, then enablement of the



component or components should specifically be challenged by the examiner as part of a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection. Additionally, the examiner should determine whether certain of the hardware or software components depicted as block elements are themselves complex assemblages which have widely differing characteristics and which must be precisely coordinated with other complex assemblages. Under such circumstances, a reasonable basis may exist for challenging such a functional block diagram form of disclosure. See *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971) and *In re Brown, supra*. Even if the applicant has cited prior art patents or publications to demonstrate that particular block diagram hardware or software components are old, it should not always be considered as self-evident how such components are to be interconnected to function in a disclosed complex manner. See *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 301 (CCPA 1974) and *In re Forman*, 463 F.2d 1125, 1129, 175 USPQ 12, 16 (CCPA 1972).

For example, where the specification provides in a block diagram disclosure of a complex system that includes a microprocessor and other system components controlled by the microprocessor, a mere reference to a commercially available microprocessor, without any description of the precise operations to be performed by the microprocessor, fails to disclose how such a microprocessor would be properly programmed to (1) either perform any required calculations or (2) coordinate the other system components in the proper timed sequence to perform the functions disclosed and claimed. If a particular program is disclosed in such a system, the program should be carefully reviewed to ensure that its scope is commensurate with the scope of the functions attributed to such a program in the claims. *In re Brown*, 477 F.2d at 951, 177 USPQ at 695. If (1) the disclosure fails to disclose any program and (2) more than routine experimentation would be required of one skilled in the art to generate such a program, the examiner clearly would have a reasonable basis for challenging the sufficiency of such a disclosure. The amount of experimentation that is considered routine will vary depending on the facts and circumstances of individual cases and should be reviewed on a case-by-case basis. No exact numerical standard has

been fixed by the courts, but the “amount of required experimentation must, however, be reasonable.”

*White Consol. Indus.*, 713 F.2d at 791, 218 USPQ at 963. One court apparently found that the amount of experimentation involved was reasonable where a skilled programmer was able to write a general computer program, implementing an embodiment form, within four hours. *Hirschfield v. Banner*, 462 F. Supp. 135, 142, 200 USPQ 276, 279 (D.D.C. 1978), *aff'd*, 615 F.2d 1368 (D.C. Cir. 1986), *cert. denied*, 450 U.S. 994 (1981). Another court found that, where the required period of experimentation for skilled programmers to develop a particular program would run to one to two man years, this would be “a clearly unreasonable requirement” (*White Consol. Indus.*, 713 F.2d at 791, 218 USPQ at 963).

## II. BLOCK ELEMENTS WITHIN A COMPUTER

The second category of block diagram cases occurs most frequently in pure data processing applications where the combination of block elements is totally within the confines of a computer, where there is no interfacing with external apparatus other than normal input/output devices. In some instances, it has been found that particular kinds of block diagram disclosures were sufficient to meet the enabling requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. See *In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973), *In re Comstock*, 481 F.2d 905, 178 USPQ 616 (CCPA 1973). The *Comstock* and *Knowlton* decisions turned on the appellants’ disclosure of (1) a reference to and reliance on an identified prior art computer system, and (2) an operative computer program for the referenced prior art computer system. In *Knowlton*, the disclosure was presented in such a detailed fashion that the individual program’s steps were specifically interrelated with the operative structural elements in the referenced prior art computer system. The court in *Knowlton* indicated that the disclosure did not merely consist of a cursory explanation of flow diagrams or a bare group of program listings together with a reference to a proprietary computer in which they might be run. The disclosure was characterized as going into considerable detail in explaining the interrelationships between the disclosed hardware and software elements. Under such circumstances,

the court considered the disclosure to be concise as well as full, clear, and exact to a sufficient degree to satisfy the literal language of [35 U.S.C. 112](#), first paragraph. It must be emphasized that because of the significance of the program listing and the reference to and reliance on an identified prior art computer system, absent either of these items, a block element disclosure within the confines of a computer should be scrutinized in precisely the same manner as the first category of block diagram cases discussed above.

Regardless of whether a disclosure involves block elements more comprehensive than a computer or block elements totally within the confines of a computer, USPTO personnel, when analyzing method claims, must recognize that the specification must be adequate to teach how to practice the claimed method. If such practice requires a particular apparatus, then the application must provide a sufficient disclosure of that apparatus if such is not already available. See *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971) and *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402, 406 (CCPA 1976). When USPTO personnel question the adequacy of computer system or computer programming disclosures, the reasons for finding the specification to be nonenabling should be supported by the record as a whole. In this regard, it is also essential for USPTO personnel to reasonably challenge evidence submitted by the applicant. For example, in *In re Naquin*, *supra*, an affiant's statement that the average computer programmer was familiar with the subroutine necessary for performing the claimed process, was held to be a statement of fact as it was unchallenged by USPTO personnel. In other words, unless USPTO personnel present a reasonable basis for challenging the disclosure in view of the record as a whole, a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection in a computer system or computer programming application may not be sustained on appeal. See *In re Naquin*, *supra*, and *In re Morehouse*, 545 F.2d 162, 165-66, 192 USPQ 29, 32 (CCPA 1976).

While no specific universally applicable rule exists for recognizing an insufficiently disclosed application involving computer programs, an examining guideline to generally follow is to

challenge the sufficiency of disclosures that fail to include the programmed steps, algorithms or procedures that the computer performs necessary to produce the claimed function. These can be described in any way that would be understood by one of ordinary skill in the art, such as with a reasonably detailed flowchart which delineates the sequence of operations the program must perform. In programming applications where the software disclosure only includes a flowchart, as the complexity of functions and the generality of the individual components of the flowchart increase, the basis for challenging the sufficiency of such a flowchart becomes more reasonable because the likelihood of more than routine experimentation being required to generate a working program from such a flowchart also increases.

As stated earlier, once USPTO personnel have advanced a reasonable basis or presented evidence to question the adequacy of a computer system or computer programming disclosure, the applicant must show that the specification would enable one of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. In most cases, efforts to meet this burden involve submitting affidavits, referencing prior art patents or technical publications, presenting arguments of counsel, or combinations of these approaches.

### III. AFFIDAVIT PRACTICE (37 CFR 1.132)

In computer cases, affidavits must be critically analyzed. Affidavit practice at the outset usually involves analyzing the skill level and/or qualifications of the affiant, which should be of the person of ordinary skill in the art. When an affiant's skill level is higher than that required by the person of ordinary skill in the art for a particular application, an examiner may challenge the affidavit as insufficient should the affiant not submit evidence demonstrating the amount of experimentation required by a person of ordinary skill in the art to implement the invention. An affiant having a skill level or qualifications above that of the person of ordinary skill in the art would require less experimentation to implement the claimed invention than that for the person of ordinary skill. Similarly, an affiant having a skill level or qualifications below

that of the person of ordinary skill in the art would require more experimentation to implement the claimed invention than that for the person of ordinary skill in the art. In either situation, the standard of the person of ordinary skill in the art would not have been met.

In computer systems or programming cases, the problems with a given affidavit, which relate to the sufficiency of disclosure issue, generally involve affiants submitting few facts to support their conclusions or opinions. Some affidavits may go so far as to present conclusions on the ultimate legal question of sufficiency. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973), illustrates the extent of the inquiry into the factual basis underlying an affiant's conclusions or opinions. In *Brandstadter*, the invention concerned a stored program controller (computer) programmed to control the storing, retrieving, and forwarding of messages in a communications system. The disclosure consisted of broadly defined block diagrams of the structure of the invention and no flowcharts or program listings of the programs of the controller. The court quoted extensively from the examiner's Office actions and examiner's answer in its opinion where it was apparent that the examiner consistently argued that the disclosure was merely a broad system diagram in the form of labeled block diagrams along with statements of a myriad of desired results. Various affidavits were presented in which the affiants stated that all or some of the system circuit elements in the block diagrams were either well-known in the art or "could be constructed" by the skilled design engineer, that the controller was "capable of being programmed" to perform the stated functions or results desired, and that the person having ordinary skill in the art "could design or construct or was able to program" the system. The court did consider the affiants' statements as being some evidence on the ultimate legal question of enablement but concluded that the statements failed in their purpose since they recited conclusions or opinions with few facts to support or buttress these conclusions. With reference to the lack of a disclosed computer program or even a flowchart of the program to control the message switching system, the record contained no evidence as to the number of programmers needed, the number of man-hours and the level of skill of the programmers

to produce the program required to practice the invention.

Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure, and knowledge in the art can be expected to rebut a *prima facie* case of nonenablement, but not opinion evidence directed to the ultimate legal question of enablement. See *Hirschfield*, 462 F. Supp. at 143, 200 USPQ at 281. Where an affidavit shows that an inventor described the problem to be solved to an affiant, which then enabled the affiant to generate a computer program to solve the problem, such an affidavit will fail to demonstrate that the application alone would have taught a person of ordinary skill in the art how to make and use the claimed invention. See *In re Brown*, 477 F.2d at 951, 177 USPQ at 695. In *Brown*, the court indicated that it had not been factually established that the applicant had not conveyed to the affiant vital and additional information in their several meetings in addition to that set out in the application. For an affidavit to be relevant to the determination of enablement, it must be probative of the level of skill of the person of ordinary skill in the art as of the time the applicant filed his application. See *In re Gunn*, 537 F.2d 1123, 1128, 190 USPQ 402, 406 (CCPA 1976). In that case, each of the affiants stated what was known at the time the affiant executed the affidavit, and not what was known at the time the applicant filed his application.

#### IV. REFERENCING PRIOR ART DOCUMENTS

The commercial availability of an identified prior art computer system is very pertinent to the issue of enablement. But in some cases, this approach may not be sufficient to meet the applicant's burden. Merely citing excerpts from technical publications in an affidavit in order to satisfy the enablement requirement is not sufficient if it is not made clear that a person skilled in the art would know which, or what parts, of the cited circuits could be used to construct the claimed device or how they could be interconnected to act in combination to produce the required results. See *In re Forman*, 463 F.2d 1125, 1129, 175 USPQ 12, 16 (CCPA 1972). This analysis would appear to be less critical where the circuits comprising applicant's system are essentially

standard components of an identified prior art computer system and a standard device attached thereto.

Prior art patents and patent application publications are often relied on by applicants to show the state of the art for purposes of enablement. However, these documents must have a publication date earlier than the effective filing date of the application under consideration. See *In re Budnick*, 537 F.2d 535, 538, 190 USPQ 422, 424 (CCPA 1976). An analogous point was made in *In re Gunn*, *supra*, where the court indicated that patents issued after the filing date of the application under examination are not evidence of subject matter known to any person skilled in the art since their subject matter may have been known only to the patentees and the Patent and Trademark Office.

Merely citing prior art patents to demonstrate that the challenged components are old may not be sufficient proof since, even if each of the enumerated devices or labeled blocks in a block diagram disclosure were old, *per se*, this would not make it self-evident how each would be interconnected to function in a disclosed complex combination manner. Therefore, the specification in effect must set forth the integration of the prior art; otherwise, it is likely that undue experimentation, or more than routine experimentation would be required to implement the claimed invention. See *In re Scarbrough*, 500 F.2d 560, 565, 182 USPQ 298, 301 (CCPA 1974). The court also noted that any cited patents which are used by the applicant to demonstrate that particular box diagram hardware or software components are old must be analyzed as to whether such patents are germane to the instant invention and as to whether such patents provide better detail of disclosure as to such components than an applicant's own disclosure. Also, any patent or publication cited to provide evidence that a particular programming technique is well-known in the programming art does not demonstrate that one of ordinary skill in the art could make and use correspondingly disclosed programming techniques unless both the known and disclosed programming techniques are of approximately the same degree of complexity. See *In re Knowlton*, 500 F.2d 566, 572, 183 USPQ 33, 37 (CCPA 1974).

## V. ARGUMENTS OF COUNSEL

Arguments of counsel may be effective in establishing that an examiner has not properly met the burden or has otherwise erred in the examiner's position. However, it must be emphasized that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). For example, in a case where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement. See *In re Knowlton*, 500 F.2d at 572, 183 USPQ at 37; *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

### **2164.07 Relationship of Enablement Requirement to Utility Requirement of 35 U.S.C. 101 [R-11.2013]**

The requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph as to how to use the invention is different from the utility requirement of [35 U.S.C. 101](#). The requirement of [35 U.S.C. 101](#) is that some specific, substantial, and credible use be set forth for the invention. On the other hand, [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph requires an indication of how the use (required by [35 U.S.C. 101](#)) can be carried out, i.e., how the invention can be used.

If an applicant has disclosed a specific and substantial utility for an invention and provided a credible basis supporting that utility, that fact alone does not provide a basis for concluding that the claims comply with all the requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. For example, if an applicant has claimed a process of treating a certain disease condition with a certain compound and provided a credible basis for asserting that the compound is useful in that regard, but to actually practice the invention as claimed a person skilled in the relevant art would have to engage in an undue amount of experimentation, the claim may be defective under [35 U.S.C. 112](#), but not [35 U.S.C.](#)



[101](#). To avoid confusion during examination, any rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, based on grounds other than “lack of utility” should be imposed separately from any rejection imposed due to “lack of utility” under [35 U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph.

## I. WHEN UTILITY REQUIREMENT IS NOT SATISFIED

### A. *Not Useful or Operative*

If a claim fails to meet the utility requirement of [35 U.S.C. 101](#) because it is shown to be nonuseful or inoperative, then it necessarily fails to meet the how-to-use aspect of the enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. As noted in *In re Fouche*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971), if “compositions are in fact useless, appellant’s specification cannot have taught how to use them.” 439 F.2d at 1243, 169 USPQ at 434. The examiner should make both rejections (i.e., a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph and a rejection under [35 U.S.C. 101](#)) where the subject matter of a claim has been shown to be nonuseful or inoperative.

The [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. A [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection should not be imposed or maintained unless an appropriate basis exists for imposing a rejection under [35 U.S.C. 101](#). In other words, Office personnel should not impose a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection grounded on a “lack of utility” basis unless a [35 U.S.C. 101](#) rejection is proper. In particular, the factual showing needed to impose a rejection under [35 U.S.C. 101](#) must be provided if a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, rejection is to be imposed on “lack of utility” grounds. See [MPEP § 2107 - § 2107.03](#) for a more detailed discussion of the utility requirements of [35](#)

[U.S.C. 101](#) and [35 U.S.C. 112\(a\)](#) or [pre-AIA 112](#), first paragraph.

### B. *Burden on the Examiner*

When the examiner concludes that an application claims an invention that is nonuseful, inoperative, or contradicts known scientific principles, the burden is on the examiner to provide a reasonable basis to support this conclusion. Rejections based on [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, and [35 U.S.C. 101](#) should be made.

#### **Examiner Has Initial Burden To Show That One of Ordinary Skill in the Art Would Reasonably Doubt the Asserted Utility**

The examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention’s asserted utility. *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Swartz*, 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000); *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)).

### C. *Rebuttal by Applicant*

If a rejection under [35 U.S.C. 101](#) has been properly imposed, along with a corresponding rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, the burden shifts to the applicant to rebut the *prima facie* showing. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). There is no predetermined amount or character of evidence that must be provided by an applicant to support an asserted utility. Rather, the character and amount of evidence needed to support an asserted utility will vary depending on what is claimed (*Ex parte Ferguson*, 117 USPQ 229, 231 (Bd. App. 1957)), and whether the asserted utility appears to contravene established scientific principles and beliefs. *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967 ); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325

(CCPA 1956). Furthermore, the applicant does not have to provide evidence sufficient to establish that an asserted utility is true “beyond a reasonable doubt.” *In re Irons*, 340 F.2d 974, 978, 144 USPQ 351, 354 (CCPA 1965). Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not true. See [MPEP § 2107.02](#) for a more detailed discussion of consideration of a reply to a *prima facie* rejection for lack of utility and evaluation of evidence related to utility.

## II. WHEN UTILITY REQUIREMENT IS SATISFIED

In some instances, the utility of the claimed invention will be provided, but the skilled artisan will not know how to effect that use. In such a case, no rejection will be made under [35 U.S.C. 101](#), but a rejection will be made under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. As pointed out in *Mowry v. Whitney*, 81 U.S. (14 Wall.) 620 (1871), an invention may in fact have great utility, i.e., may be “a highly useful invention,” but the specification may still fail to “enable any person skilled in the art or science” to use the invention. 81 U.S. (14 Wall.) at 644.

### 2164.08 Enablement Commensurate in Scope With the Claims [R-01.2024]

All questions of enablement are evaluated against the claimed subject matter. When considering whether claims in a utility patent application or patent are enabled, USPTO personnel will use the *Wands* factors to ascertain whether the amount of experimentation required to enable the full scope of the claimed invention is reasonable. See *Guidelines for Assessing Enablement in Utility Applications and Patents in View of the Supreme Court Decision in Amgen Inc. et al. v. Sanofi et al.*, 89 FR 1563 (January 10, 2024). See also [MPEP § 2164.01\(a\)](#). The focus of the examination inquiry is whether everything within the scope of the claim is enabled. Accordingly, the first analytical step requires that the examiner determine exactly what subject matter is encompassed by the claims. See, e.g., *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003) (When a range is

claimed, there must be reasonable enablement of the scope of the range. Here, the claims at issue encompassed amounts of silicon as high as 10% by weight, however the specification included statements clearly and strongly warning that a silicon content above 0.5% by weight in an aluminum coating causes coating problems. Such statements indicate that higher amounts will not work in the claimed invention.). The examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. No claim should be overlooked. With respect to dependent claims, [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112](#), fourth paragraph, should be followed. These paragraphs state “a claim in a dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers” and requires the dependent claim to further limit the subject matter claimed.

The courts have repeatedly held that “the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation’” or that any experimentation must be “reasonable”. See *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 2023 USPQ2d 602 (2023); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 959 F.3d 1091, 2020 USPQ2d 10550 (Fed. Cir. 2020); *Wyeth & Cordis Corp. v. Abbott Laboratories*, 720 F.3d 1380, 107 USPQ2d 1273 (Fed. Cir. 2013); *Enzo Life Sciences, Inc. v. Roche Molecular Systems, Inc.*, 928 F.3d 1340 (Fed. Cir. 2019); and *Idenix Pharmaceuticals LLC v. Gilead Sciences Inc.*, 941 F.3d 1149, 2019 USPQ2d 415844 (Fed. Cir. 2019). See also *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further, the scope of enablement must only bear a “reasonable correlation” to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). See *Amgen Inc. et al. v. Sanofi et al.*, 598 U.S. 594, 611, 2023 USPQ2d 602 (2023) (The Court stated that “[t]he more one claims, the more one must enable.”).

With respect to the breadth of a claim, the relevant concern is whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. The Federal Circuit, citing *McRO*, provided guidance on the application of enablement to genus claims, holding that “[a]lthough a specification does not need to describe how to make and use every possible variant of the claimed invention, when a range is claimed, there must be reasonable enablement of the scope of the range.”

*Sanofi-Aventisub*, 987 F.3d at 1085 (internal quotations omitted). *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003) (alleged “pioneer status” of invention irrelevant to enablement determination).

The propriety of a rejection based upon the scope of a claim relative to the scope of the enablement concerns (1) how broad the claim is with respect to the disclosure and (2) whether one skilled in the art could make and use the entire scope of the claimed invention without undue experimentation. A scope of enablement rejection must identify the claimed subject matter for which the specification is not enabling and explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998). See also [MPEP §§ 2164.01\(a\) and 2164.04](#). The explanation should include any questions posed by the examiner which were not satisfactorily resolved and consequently raise doubt as to enablement.

An enabling disclosure may be set forth by specific example or broad terminology; the exact form of disclosure is not dispositive. *In re Marzocchi*, 439 F.2d 220, 223-24 169 USPQ 367, 370 (CCPA 1971). A rejection of a claim under [35 U.S.C. 112](#) as broader than the enabling disclosure is a [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, enablement rejection and not a [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, definiteness rejection. Claims are not rejected as broader than the enabling disclosure under [35 U.S.C. 112](#) for noninclusion of limitations dealing with

factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *In re Skrivan*, 427 F.2d 801, 806, 166 USPQ 85, 88 (CCPA 1970). One does not look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed. Cir. 1983); *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). In *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the court stated:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for “preferred” materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

When analyzing the enabled scope of a claim, the teachings of the specification must not be ignored because claims are to be given their broadest reasonable interpretation that is consistent with the specification. “That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims.” *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984).

The record must be clear so that the public will have notice as to the patentee’s scope of protection when the patent issues. If a reasonable interpretation of the claim is broader than the description in the specification, it is necessary for the examiner to make sure the full scope of the claim is enabled. Limitations and examples in the specification do not generally limit what is covered by the claims. See also *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1370, 2023 USPQ2d 862 (Fed. Cir. 2023) (the court found that the claims directed to administration of treprostinil to treat all five types of pulmonary hypertension, which were construed to not require safety and efficacy, were adequately

enabled by the specification which described administration, concentrations and dosages as well as an open label study despite potential safety concerns associated with one type of pulmonary hypotension. The record included evidence that “a skilled artisan would understand that the claimed administration of treprostinil would vasodilate the pulmonary vasculature, improve hemodynamics, and in this way for a single dose, treat a patient’s elevated pulmonary blood pressure independent of the type (i.e., group) of pulmonary hypertension patient.”).

The breadth of the claims was a factor considered in *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *cert. denied*, 502 U.S. 856 (1991). In *Amgen*, the patent claims were directed to a purified DNA sequence encoding polypeptide analogs of the protein erythropoietin (EPO). The court stated that:

Amgen has not enabled preparation of DNA sequences sufficient to support its all-encompassing claims. . . . [D]espite extensive statements in the specification concerning all the analogs of the EPO gene that can be made, there is little enabling disclosure of particular analogs and how to make them. Details for preparing only a few EPO analog genes are disclosed. . . . This disclosure might well justify a generic claim encompassing these and similar analogs, but it represents inadequate support for Amgen’s desire to claim all EPO gene analogs. There may be many other genetic sequences that code for EPO-type products. Amgen has told how to make and use only a few of them and is therefore not entitled to claim all of them.

927 F.2d at 1213-14, 18 USPQ2d at 1027. However, when claims are directed to any purified and isolated DNA sequence encoding a specifically named protein where the protein has a specifically identified sequence, a rejection of the claims as broader than the enabling disclosure is generally not appropriate because one skilled in the art could readily determine any one of the claimed embodiments.

See also *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (The evidence did not show that a skilled artisan would have been able to carry out the steps required to practice the full scope of claims which encompass “any and all live, non-pathogenic vaccines, and processes for making such vaccines, which elicit immunoprotective activity in any animal toward any RNA virus.” (original emphasis)); *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993) (The specification did not enable the broad scope of the claims for producing mammalian peptides in plant cells because the specification contained only an example of producing gamma-interferon in a dicot species, and there was evidence that extensive experimentation would have been required for encoding mammalian peptide into a monocot plant at the time of filing); *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (Where applicant claimed a composition suitable for the treatment of arthritis having a potency of “at least” a particular value, the court held that the claim was not commensurate in scope with the enabling disclosure because the disclosure was not enabling for compositions having a slightly higher potency. Simply because applicant was the first to achieve a composition beyond a particular threshold potency did not justify or support a claim that would dominate every composition that exceeded that threshold value.); *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991) (Given the relatively incomplete understanding in the biotechnological field involved, and the lack of a reasonable correlation between the narrow disclosure in the specification and the broad scope of protection sought in the claims, a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph for lack of enablement was appropriate.); *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1352, 2021 USPQ2d 519 (Fed. Cir. 2021) (The court found that undue experimentation was required to enable the full scope of the claims where there was ample evidence that relevant artisans would not know how to perform the claimed invention for more than a narrow range of the claimed scope of invention).

If a rejection is made based on the view that the enablement is not commensurate in scope with the



claim, the examiner should identify the subject matter that is considered to be enabled.

### **2164.08(a) Single Means Claim [R-11.2013]**

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an enablement rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

### **2164.08(b) Inoperative Subject Matter [R-08.2012]**

The presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling).

Although, typically, inoperative embodiments are excluded by language in a claim (e.g., preamble), the scope of the claim may still not be enabled where undue experimentation is involved in determining those embodiments that are operable. A disclosure of a large number of operable embodiments and the identification of a single inoperative embodiment did not render a claim broader than the enabled scope because undue experimentation was not involved in determining those embodiments that were operable. *In re Angstadt*, 537 F.2d 498, 502-503, 190 USPQ 214, 218 (CCPA 1976). However, claims reading

on significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative. *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984); *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971).

### **2164.08(c) Critical Feature Not Claimed [R-08.2012]**

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of [35 U.S.C. 112](#). See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

## **2165 The Best Mode Requirement [R-08.2017]**

### **I. REQUIREMENT FOR A DISCLOSURE OF THE BEST MODE**

A third requirement of [35 U.S.C. 112\(a\)](#) (applicable to applications filed on or after September 16, 2012) is that:

The specification. . . shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The third requirement of the first paragraph of [pre-AIA 35 U.S.C. 112](#) (applicable to applications filed before September 16, 2012) is that:

The specification. . . shall set forth the best mode contemplated by the inventor of carrying out his invention.

The best mode requirement is a safeguard against the desire on the part of some people to obtain patent protection without making a full disclosure as required by the statute. The requirement does not permit inventors to disclose only what they know to be their second-best embodiment, while retaining the best for themselves. *In re Nelson*, 280 F.2d 172, 126 USPQ 242 (CCPA 1960).

Determining compliance with the best mode requirement requires a two-prong inquiry. First, it must be determined whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention. This is a subjective inquiry which focuses on the inventor's state of mind at the time of filing. Second, if the inventor did possess a best mode, it must be determined whether the written description disclosed the best mode such that a person skilled in the art could practice it. This is an objective inquiry, focusing on the scope of the claimed invention and the level of skill in the art. *Eli Lilly & Co. v. Barr Labs. Inc.*, 251 F.3d 955, 963, 58 USPQ2d 1865, 1874 (Fed. Cir. 2001). All applicants are required to disclose for the claimed subject matter the best mode contemplated by the inventor even if the inventor was not the discoverer of that mode. *Benger Labs. Ltd. v. R.K. Laros Co.*, 209 F. Supp. 639, 135 USPQ 11 (E.D. Pa. 1962).

Failure to disclose the best mode need not rise to the level of active concealment or inequitable conduct in order to support a rejection. Where an inventor knows of a specific material or method that will make possible the successful reproduction of the claimed invention, but does not disclose it, the best mode requirement has not been satisfied. *Union*

*Carbide Corp. v. Borg-Warner*, 550 F.2d 355, 193 USPQ 1 (6th Cir. 1977).

## II. IMPACT OF FAILURE TO DISCLOSE THE BEST MODE PURSUANT TO THE AIA

Section 15 of the Leahy-Smith America Invents Act (AIA), Public Law 112-29, 125 Stat. 284 (September 16, 2011), did not eliminate the requirement in [pre-AIA 35 U.S.C. 112](#), first paragraph, for a disclosure of the best mode, (see [35 U.S.C. 112\(a\)](#)) but effective September 16, 2011, it amended [35 U.S.C. 282](#) (the provision that sets forth defenses in a patent validity or infringement proceeding) to provide that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. As this change is applicable only in patent validity or infringement proceedings, it does not alter current patent examining practices as set forth above for evaluation of an application for compliance with the best mode requirement of [35 U.S.C. 112](#).

Prior to September 16, 2011, for an invention claimed in a later-filed application to receive the benefit of the filing date of an earlier-filed application, [35 U.S.C. 119\(e\)](#) and [120](#) required that the invention claimed in the later-filed application be disclosed in the earlier-filed application in the manner provided by [pre-AIA 35 U.S.C. 112](#), first paragraph. Section 15 of the Leahy-Smith America Invents Act also amended [35 U.S.C. 119\(e\)](#) and [120](#) to modify this requirement such that the disclosure in the earlier filed application must be made in the manner provided by [pre-AIA 35 U.S.C. 112](#), first paragraph, "other than the requirement to disclose the best mode." This change should not noticeably impact patent examining procedure. [MPEP § 201.08](#) provides that there is no need to determine whether the earlier-filed application contains a disclosure of the invention claimed in the later filed application in compliance with [pre-AIA 35 U.S.C. 112](#), first paragraph, unless the filing date of the earlier-filed application is actually necessary (e.g., to overcome a reference). Examiners should consult with their supervisors if it appears that an earlier-filed application does not disclose the best mode for carrying out a claimed invention and the filing date of the earlier-filed application is actually necessary.

[35 U.S.C. 119\(e\)](#) and [120](#) were further amended effective for applications filed on or after September 16, 2012 to refer to [35 U.S.C. 112\(a\)](#) rather than [pre-AIA 35 U.S.C. 112](#), first paragraph.

## **2165.01 Considerations Relevant to Best Mode [R-07.2022]**

### **I. DETERMINE WHAT IS THE INVENTION**

Determine what the invention is — the invention is defined in the claims. The specification need not set forth details not relating to the essence of the invention. *In re Bosy*, 360 F.2d 972, 149 USPQ 789 (CCPA 1966). See also *Northern Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281, 55 USPQ2d 1065 (Fed. Cir. 2000) (Unclaimed matter that is unrelated to the operation of the claimed invention does not trigger the best mode requirement); *Eli Lilly & Co. v. Barr Lab. Inc.*, 251 F.3d 955, 966, 58 USPQ2d 1865, 1877 (Fed. Cir. 2001) (“[P]atentee’s failure to disclose an unclaimed preferred mode for accomplishing a routine detail does not violate the best mode requirement because one skilled in the art is aware of alternative means for accomplishing the routine detail that would still produce the best mode of the claimed invention.”).

### **II. SPECIFIC EXAMPLE IS NOT REQUIRED**

There is no statutory requirement for the disclosure of a specific example — a patent specification is not intended nor required to be a production specification. *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962).

The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. Best mode may be represented by a preferred range of conditions or group of reactants. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966).

### **III. DESIGNATION AS BEST MODE IS NOT REQUIRED**

There is no requirement in the statute that inventors point out which of their embodiments they consider to be their best; that the disclosure includes the best mode contemplated by the inventor is enough to

satisfy the statute. *Ernsthausen v. Nakayama*, 1 USPQ2d 1539 (Bd. Pat. App. & Inter. 1985).

### **IV. UPDATING BEST MODE IS NOT REQUIRED**

There is no requirement to update in the context of a foreign priority application under [35 U.S.C. 119](#), *Standard Oil Co. v. Montedison, S.p.A.*, 494 F.Supp. 370, 206 USPQ 676 (D.Del. 1980) (better catalyst developed between Italian priority and U.S. filing dates). Furthermore, it is not necessary to update the best mode in applications claiming the benefit of an earlier filing date under [35 U.S.C. 119\(e\)](#) or [120](#), which indicate that the disclosure in the earlier filed application must be made in the manner provided by [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, “other than the requirement to disclose the best mode.” See [MPEP § 2165](#), subsection II.

### **V. DEFECT IN BEST MODE CANNOT BE CURED BY NEW MATTER**

If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976).

Any proposed amendment of this type (adding a specific mode of practicing the invention not described in the application as filed) should be treated as new matter. New matter under [35 U.S.C. 132](#) and [251](#) should be objected to and coupled with a requirement to cancel the new matter.

## **2165.02 Best Mode Requirement Compared to Enablement Requirement [R-07.2022]**

The best mode requirement is a separate and distinct requirement from the enablement requirement of [35 U.S.C. 112\(a\)](#) or the first paragraph of [pre-AIA 35 U.S.C. 112](#). *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

The best mode provision of [35 U.S.C. 112](#) is not directed to a situation where the application fails to set forth any mode — such failure is equivalent to

nonenablement. *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

The enablement requirement looks to placing the subject matter of the claims generally in the possession of the public. "If, however, the applicant [inventor] develops specific instrumentalities or techniques which are recognized by the [inventor] at the time of filing as the best way of carrying out the invention, then the best mode requirement imposes an obligation to disclose that information to the public as well." *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 USPQ 2d 1737, 1742 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 954 (1987).

### **2165.03 Requirements for Rejection for Lack of Best Mode [R-11.2013]**

#### **I. ASSUME BEST MODE IS DISCLOSED UNLESS THERE IS EVIDENCE TO THE CONTRARY**

The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during *inter partes* proceedings.

#### **II. EXAMINER MUST DETERMINE WHETHER THE INVENTOR KNEW THAT ONE MODE WAS BETTER THAN ANOTHER, AND IF SO, WHETHER THE DISCLOSURE IS ADEQUATE TO ENABLE ONE OF ORDINARY SKILL IN THE ART TO PRACTICE THE BEST MODE**

According to the approach used by the court in *Chemcast Corp. v. Arco Indus.*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990), a proper best mode analysis has two components:

(A) Determine whether, at the time the application was filed, the inventor knew of a mode of practicing the claimed invention that the inventor considered to be better than any other.

The first component is a subjective inquiry because it focuses on the inventor's state of mind at the time the application was filed. Unless the examiner has evidence that the inventors had information in their possession

(1) at the time the application was filed

(2) that a mode was considered to be better than any others by the inventors,

there is no reason to address the second component and there is no proper basis for a best mode rejection. If the facts satisfy the first component, then, and only then, is the following second component analyzed:

(B) Compare what was known in (A) with what was disclosed - is the disclosure adequate to enable one skilled in the art to practice the best mode?

Assessing the adequacy of the disclosure in this regard is largely an objective inquiry that depends on the level of skill in the art. Is the information contained in the specification disclosure sufficient to enable a person skilled in the relevant art to make and use the best mode?

A best mode rejection is proper only when the first inquiry can be answered in the affirmative, and the second inquiry answered in the negative with reasons to support the conclusion that the specification is nonenabling with respect to the best mode.

### **2165.04 Examples of Evidence of Concealment [R-07.2022]**

In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an inventor's best mode disclosure is so poor as to effectively result in concealment.

#### **I. EXAMPLES — BEST MODE REQUIREMENT SATISFIED**

In one case, even though the inventor had more information in his possession concerning the contemplated best mode than was disclosed (a known computer program) the specification was held to



delineate the best mode in a manner sufficient to require only the application of routine skill to produce a workable digital computer program. *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980).

In another case, the claimed subject matter was a time controlled thermostat, but the application did not disclose the specific Quartzmatic motor which was used in a commercial embodiment. The court concluded that failure to disclose the commercial motor did not amount to concealment since similar clock motors were widely available and widely advertised. There was no evidence that the specific Quartzmatic motor was superior except possibly in price. *Honeywell v. Diamond*, 499 F.Supp 924, 208 USPQ 452 (D.D.C. 1980).

There was held to be no violation of the best mode requirement even though the inventor did not disclose the only mode of calculating the stretch rate for plastic rods that he used because that mode would have been employed by those of ordinary skill in the art at the time the application was filed. *W.L. Gore & Assoc., Inc. v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

There was no best mode violation where the patentee failed to disclose in the specification “[k]nown ways to perform a known operation” to practice the claimed invention. “Known ways of performing a known operation cannot be deemed intentionally concealed absent evidence of intent to deliberately withhold that information.” *High Concrete Structures Inc. v. New Enter. Stone & Lime Co.*, 377 F.3d 1379, 1384, 71 USPQ2d 1948, 1951 (Fed. Cir. 2004). The unintentional failure to disclose in the specification the use of a crane to support the patented frame in order to carry out the method of loading and tilting the frame was held not to defeat the best mode requirement because one of ordinary skill in the art would understand and use a crane to move heavy loads. *Id.* “The best mode requirement of [\[35 U.S.C.\] § 112](#) is not violated by unintentional omission of information that would be readily known to persons in the field of the invention.” *Id.*

There was no best mode violation where there was no evidence that the monoclonal antibodies used by the inventors differed from those obtainable

according to the processes described in the specification. It was not disputed that the inventors obtained the antibodies used in the invention by following the procedures in the specification, that these were the inventors’ preferred procedures, and that the data reported in the specification was for the antibody that the inventors had actually used. *Scripps Clinic and Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001 (Fed. Cir. 1991).

Where an organism was created by the insertion of genetic material into a cell obtained from generally available sources, all that was required to satisfy the best mode requirement was an adequate description of the means for carrying out the invention, not deposit of the cells. As to the observation that no scientist could ever duplicate exactly the cell used by applicants, the court observed that the issue is whether the disclosure is adequate, not that an exact duplication is necessary. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 18 USPQ 2d 1016 (Fed. Cir. 1991).

There was held to be no violation of the best mode requirement where the Solicitor argued that concealment could be inferred from the disclosure in a specification that each analog is “surprisingly and unexpectedly more useful than one of the corresponding prostaglandins . . . for at least one of the pharmacological purposes.” It was argued that appellant must have had test results to substantiate this statement and this data should have been disclosed. The court concluded that no withholding could be inferred from general statements of increased selectivity and narrower spectrum of potency for these novel analogs, conclusions which could be drawn from the elementary pharmacological testing of the analogs. *In re Bundy*, 642 F.2d 430, 435, 209 USPQ 48, 52 (CCPA 1981).

## II. EXAMPLES — BEST MODE REQUIREMENT NOT SATISFIED

The best mode requirement was held to be violated where inventors of a laser failed to disclose details of their preferred TiCuSil brazing method which were not contained in the prior art and were contrary to criteria for the use of TiCuSil as contained in the

literature. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ 2d 1737 (Fed. Cir. 1987).

The best mode requirement was violated because an inventor failed to disclose whether to use a specific surface treatment that he knew was necessary to the satisfactory performance of his invention, even though how to perform the treatment itself was known in the art. The argument that the best mode requirement may be met solely by reference to what was known in the prior art was rejected as incorrect.

*Dana Corp. v. IPC Ltd. P'ship*, 860 F.2d 415, 8 USPQ2d 1692 (Fed. Cir. 1988).

## 2166 Rejections Under 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph [R-10.2019]

Rejections based on [35 U.S.C. 112\(a\)](#) or the first paragraph of [pre-AIA 35 U.S.C. 112](#) are discussed in [MPEP §§ 2161 - 2165.04](#). For a discussion of the utility requirements of [35 U.S.C. 112\(a\)](#) or the first paragraph of [pre-AIA 35 U.S.C. 112](#), first paragraph, and [35 U.S.C. 101](#), see [MPEP §§ 2107 - 2107.03](#). Form paragraphs 7.30.01, 7.31.01 through 7.31.05 and 7.33.01 should be used, as appropriate, to make rejections under [35 U.S.C. 112\(a\)](#) or the first paragraph of [pre-AIA 35 U.S.C. 112](#).

### ¶ 7.30.01 Statement of Statutory Basis, 35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112

The following is a quotation of [35 U.S.C. 112\(a\)](#):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of [pre-AIA 35 U.S.C. 112](#):

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

### Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.

2. Form paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

### ¶ 7.31.01 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph, Description Requirement, Including New Matter Situations

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for applications subject to [pre-AIA 35 U.S.C. 112](#), the inventor(s), at the time the application was filed, had possession of the claimed invention. [2]

### Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. In bracket 1, pluralize "Claim" if necessary, insert claim number(s), and insert --is-- or --are-- as appropriate.

3. In bracket 2, identify (by suitable reference to page and line numbers and/or drawing figures) the subject matter not properly described in the application as filed, and provide an explanation of your position. The explanation should include any questions the examiner asked which were not satisfactorily resolved and consequently raise doubt as to possession of the claimed invention at the time of filing.

Form paragraph 7.31.02 should be used when it is the examiner's position that nothing within the scope of the claims is enabled. In such a rejection, the examiner should explain all the reasons why nothing within the scope of the claim is enabled. To make sure all relevant issues are raised, this should include any issues regarding the breadth of the claims relative to the guidance in the disclosure.

### ¶ 7.31.02 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph, Enablement

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. [2]

### Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. If the problem is one of scope, form paragraph 7.31.03 should be used.

3. In bracket 2, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also [MPEP §§ 2164.01\(a\) and 2164.04](#). The explanation should include any questions the examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.

4. Where an essential component or step of the invention is not recited in the claims, use form paragraph 7.33.01.

Form paragraph 7.31.03 should be used when it is the examiner's position that something within the scope of the claims is enabled but the claims are not limited to that scope.

**¶ 7.31.03 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph: Scope of Enablement**

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, because the specification, while being enabling for [2], does not reasonably provide enablement for [3]. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to [4] the invention commensurate in scope with these claims. [5]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 1, pluralize "Claim" if necessary, insert claim number(s), and insert --is-- or --are-- as appropriate.
3. This form paragraph is to be used when the scope of the claims is not commensurate with the scope of the enabling disclosure.
4. In bracket 2, identify the claimed subject matter for which the specification is enabling. This may be by reference to specific portions of the specification.
5. In bracket 3, identify aspect(s) of the claim(s) for which the specification is not enabling.
6. In bracket 4, fill in only the appropriate portion of the statute, i.e., one of the following: --make--, --use--, or --make and use--.
7. In bracket 5, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also [MPEP §§ 2164.01\(a\) and 2164.04](#). The explanation should include any questions posed by the examiner which were not satisfactorily resolved and consequently raise doubt as to enablement.

**¶ 7.31.04 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph: Best Mode Requirement**

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, because the best mode contemplated by the inventor or a joint inventor, or for applications subject to

[pre-AIA 35 U.S.C. 112](#), the inventor(s), has not been disclosed. Evidence of concealment of the best mode is based upon [2].

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, insert the basis for holding that the best mode has been concealed, e.g., the quality of applicant's disclosure is so poor as to effectively result in concealment.
3. Use of this form paragraph should be rare. See [MPEP §§ 2165- 2165.04](#).

**¶ 7.31.05 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph: Scope of Enablement of a "Single Means" Claim**

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, because the claim purports to invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, but fails to recite a combination of elements as required by that statutory provision and thus cannot rely on the specification to provide the structure, material or acts to support the claimed function. As such, the claim recites a function that has no limits and covers every conceivable means for achieving the stated function, while the specification discloses at most only those means known to the inventor. Accordingly, the disclosure is not commensurate with the scope of the claim.

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 1, pluralize "Claim" if necessary, insert claim number(s), and insert --is-- or --are-- as appropriate.
3. This form paragraph is to be used only when the claim recites a single element and that element is in means-plus-function format. This situation should be rare.

Form paragraph 7.33.01 should be used when it is the examiner's position that a feature considered critical or essential by applicant to the practice of the claimed invention is missing from the claim.

**¶ 7.33.01 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph, Essential Subject Matter Missing From Claims (Enablement)**

Claim [1] rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as based on a disclosure which is not enabling. The disclosure does not enable one of ordinary skill in the art to practice the invention without [2], which is/are critical or essential to the practice of the invention but not included in the claim(s). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). [3]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, recite the subject matter omitted from the claims.

3. In bracket 3, give the rationale for considering the omitted subject matter critical or essential.
4. The examiner shall cite the statement, argument, date, drawing, or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims which are rejected.

## 2167-2170 [Reserved]

### 2171 Two Separate Requirements for Claims Under 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph [R-11.2013]

#### 35 U.S.C. 112 Specification.

\*\*\*\*\*

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

\*\*\*\*\*

#### Pre-AIA 35 U.S.C. 112 Specification.

\*\*\*\*\*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

\*\*\*\*\*

Two separate requirements are set forth in [35 U.S.C. 112\(b\)](#) and [pre-AIA 35 U.S.C. 112](#), second paragraph, namely that:

(A) the claims must set forth the subject matter that the inventor or a joint inventor regards as the invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter to be protected by the patent grant.

The first requirement is a subjective one because it is dependent on what the inventor or a joint inventor for a patent regards as his or her invention. Note that although [pre-AIA 35 U.S.C. 112](#), second paragraph, uses the phrase “which applicant regards as his invention,” [pre-AIA 37 CFR 1.41\(a\)](#) provides that a patent is applied for in the name or names of the actual inventor or inventors.

The second requirement is an objective one because it is not dependent on the views of the inventor or any particular individual, but is evaluated in the context of whether the claim is definite — i.e.,

whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Although an essential purpose of the examination process is to determine whether or not the claims define an invention that is both novel and nonobvious over the prior art, another essential purpose of patent examination is to determine whether or not the claims are precise, clear, correct, and unambiguous. The uncertainties of claim scope should be removed, as much as possible, during the examination process.

The inquiry during examination is patentability of the invention as the inventor or a joint inventor regards it. If the claims do not particularly point out and distinctly claim that which the inventor or a joint inventor regards as his or her invention, the appropriate action by the examiner is to reject the claims under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). If a rejection is based on [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what the inventor or a joint invention regards as the invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. Pat. App. & Inter. 1984).

### 2172 Subject Matter Which the Inventor or a Joint Inventor Regards as The Invention [R-07.2022]

#### I. FOCUS FOR EXAMINATION

A rejection based on the failure of the claims to set forth the subject matter that the inventor regards as the invention is appropriate only where an inventor has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which the inventor or a joint inventor regards as the invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). See also *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).



## II. EVIDENCE TO THE CONTRARY

Evidence that shows that a claim does not correspond in scope with that which an inventor regards as an inventor's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant (see e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 55 USPQ2d 1279 (Fed. Cir. 2000) and *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969)), or in affidavits filed under [37 CFR 1.132](#) (see, e.g., *In re Cormany*, 476 F.2d 998, 177 USPQ 450 (CCPA 1973)). The content of the specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which an inventor regards as his or her invention. As noted in *In re Ehrreich*, 590 F.2d 902, 907, 200 USPQ 504, 508 (CCPA 1979), agreement, or lack thereof, between the claims and the specification is properly considered only with respect to [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. For information on rejections under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, see [MPEP § 2172.01](#)

## III. SHIFT IN CLAIMS PERMITTED

[35 U.S.C. 112\(b\)](#) or the second paragraph of [pre-AIA 35 U.S.C. 112](#) does not prohibit the inventor or a joint inventor from changing what inventor or a joint inventor regards as the invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (permitting claims and submission of comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method)). The fact that claims in a continuation application were directed to originally disclosed subject matter which had not been regarded as part of the invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under [35 U.S.C. 120](#). *In re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970).

### **2172.01 Unclaimed Essential Subject Matter [R-07.2022]**

This section pertains to guidance for determining whether to make a rejection under [35 U.S.C. 112\(b\)](#)

or [pre-AIA 35 U.S.C. 112](#), second paragraph, as failing to claim the subject matter that the inventor or a joint inventor (or, for applications subject to [pre-AIA 35 U.S.C. 112](#), the applicant) regards as his or her invention.

Depending on the specific facts at issue, a claim which omits subject matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as not enabling (see, e.g., *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)); under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as lacking an adequate written description (see, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998)); under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as indefinite (see, e.g., *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)); or under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as failing to claim the subject matter that the inventor or a joint inventor (or, for applications subject to [pre-AIA 35 U.S.C. 112](#), the applicant) regards as the invention (see, e.g., *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

If a claim omits matter that appears to be necessary to adequately describe the invention, or to make and use the invention, follow the guidance set forth in [MPEP § 2163](#) *et seq.* (especially [§ 2163](#), subsection I, and [§ 2163.05](#)) and [MPEP § 2164](#) *et seq.* (especially [§ 2164.08\(c\)](#)), respectively, to determine whether a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, based on an inadequate written description and/or lack of enablement should be made.

If a claim fails to interrelate essential elements of the invention as defined by applicant(s) in the specification, the claim may be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as indefinite. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. & Inter.

1965) (“[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result”); *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. & Inter. 1965) (A claim does not necessarily fail to comply with [35 U.S.C. 112](#), second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.). See [MPEP § 2172](#) for guidance in determining whether a rejection based on indefiniteness would be appropriate.

Rejections under [35 U.S.C. 112\(b\)](#) (or [pre-AIA 35 U.S.C. 112](#), second paragraph) for failing to claim the subject matter that the inventor or a joint inventor regards as the invention based on the omission of essential matter must explain the basis for concluding that the inventor regards the omitted matter to be essential to the invention. See, e.g., *Ex parte Robertson*, Appeal 2016-001938, op. at 4 (PTAB 2017)(Rejection reversed because examiner failed to identify where in the specification the unclaimed elements were described as essential. Board noted that summary of the invention in the specification did not include features alleged by examiner to be essential.); *Ex parte Mehta*, Appeal No. 2000-0160, op. at 5-6 (Bd. Pat. App. & Inter. 2002)(Claims that did not require an inert coating failed to comply with the second paragraph of [35 U.S.C. 112](#) because “it is clear from Appellant’s brief that Appellant regards his invention as including the inert coating. Absent an inert electrically conducting coating, there is nothing to protect the exposed metal surfaces from damaging interactions with chemicals that lead to the problem of exploding vias as argued by Appellant.”). Features described as preferred or illustrative in the specification are not critical or essential. See, e.g., *In re Goffe*, 542 F.2d 564, 191 USPQ 429 (CCPA 1976)(“In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Broad language in the disclosure (including the abstract) omitting an allegedly critical feature tends to rebut the argument of criticality ... [and] features that are merely preferred are not critical.” *Id.* at 567, 191 USPQ at 432 (citations omitted)).

## 2173 Claims Must Particularly Point Out and Distinctly Claim the Invention [R-10.2019]

Optimizing patent quality by providing clear notice to the public of the boundaries of the inventive subject matter protected by a patent grant fosters innovation and competitiveness. Accordingly, providing high quality patents is one of the agency’s guiding principles. The Office recognizes that issuing patents with clear and definite claim language is a key component to enhancing the quality of patents and raising confidence in the patent process.

[35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph requires that a patent application specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention. (Note that although [pre-AIA 35 U.S.C. 112](#), second paragraph, uses the phrase “which applicant regards as his invention,” [pre-AIA 37 CFR 1.41\(a\)](#) provides that a patent is applied for in the name or names of the actual inventor or inventors.) In patent examining parlance, the claim language must be “definite” to comply with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. Conversely, a claim that does not comply with this requirement of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is “indefinite.”

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what the inventor or a joint inventor regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph with respect to the claimed invention.

It is of utmost importance that patents issue with definite claims that clearly and precisely inform persons skilled in the art of the boundaries of protected subject matter. Therefore, claims that do not meet this standard must be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second

paragraph as indefinite. Such a rejection requires that the applicant respond by explaining why the language is definite or by amending the claim, thus making the record clear regarding the claim boundaries prior to issuance. As an indefiniteness rejection requires the applicant to respond by explaining why the language is definite or by amending the claim, such rejections must clearly identify the language that causes the claim to be indefinite and thoroughly explain the reasoning for the rejection.

### 2173.01 Interpreting the Claims [R-10.2019]

[Editor Note: This MPEP section is **applicable** to applications subject to the first inventor to file (FITF) provisions of the AIA except that the relevant date is the "effective filing date" of the claimed invention instead of the "time of the invention," which is only applicable to applications subject to [pre-AIA 35 U.S.C. 102](#). See [35 U.S.C. 100 \(note\)](#) and [MPEP § 2150 et seq.](#)]

A fundamental principle contained in [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is that applicants are their own lexicographers. They can define in the claims what the inventor or a joint inventor regards as the invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See [MPEP § 2111.01](#). Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

#### I. BROADEST REASONABLE INTERPRETATION

The first step to examining a claim to determine if the language is definite is to fully understand the subject matter of the invention disclosed in the application and to ascertain the boundaries of that subject matter encompassed by the claim. During examination, a claim must be given its broadest reasonable interpretation consistent with the

specification as it would be interpreted by one of ordinary skill in the art. Because the applicant has the opportunity to amend claims during prosecution, giving a claim its broadest reasonable interpretation will reduce the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."). The focus of the inquiry regarding the meaning of a claim should be what would be reasonable from the perspective of one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010); *In re Buszard*, 504 F.3d 1364, 84 USPQ2d 1749 (Fed. Cir. 2007). In *Buszard*, the claim was directed to a flame retardant composition comprising a flexible polyurethane foam reaction mixture. *Buszard*, 504 F.3d at 1365, 84 USPQ2d at 1749. The Federal Circuit found that the Board's interpretation that equated a "flexible" foam with a crushed "rigid" foam was not reasonable. *Id.* at 1367, 84 USPQ2d at 1751. Persuasive argument was presented that persons experienced in the field of polyurethane foams know that a flexible mixture is different than a rigid foam mixture. *Id.* at 1366, 84 USPQ2d at 1751. See [MPEP § 2111](#) for a full discussion of broadest reasonable interpretation.

Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification. The plain meaning of a term means the ordinary and customary meaning given to the term by those of ordinary skill in the art at the time of the invention. The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the specification, drawings, and prior art. However, the best source for determining the meaning of a claim term is the specification - the greatest clarity is obtained when the specification serves as a glossary for the claim terms. The presumption that a term is given its ordinary and customary meaning may be rebutted by the applicant by clearly setting forth a different definition of the term in the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997)

(the USPTO looks to the ordinary use of the claim terms taking into account definitions or other “enlightenment” contained in the written description); But c.f. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (“We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.”); *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (The claims at issue were drawn to a “hair brush.” The court upheld the Board’s refusal to import from the specification a limitation that would apply the term only to hairbrushes for the scalp. “[T]his court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages.”). When the specification sets a clear path to the claim language, the scope of the claims is more easily determined and the public notice function of the claims is best served. See [MPEP § 2111.01](#) for a full discussion of the plain meaning of claim language.

If an Office action has issued where the plain meaning of the claim terms was used, applicant may point out that the term has been given a special definition. Since there is a presumption that claim terms are given their plain meaning, and the use of special definitions is an exception, the applicant must point to where the specification as filed provides a clear and intentional use of a special definition for the claim term to be treated as having a special definition.

An applicant may not add a special definition or disavowal after the filing date of the application. However, an applicant may point out or explain in remarks where the specification as filed contains a special definition or disavowal.

## II. DETERMINE WHETHER OR NOT EACH CLAIM LIMITATION INVOKES 35 U.S.C. 112(f) or PRE-AIA 35 U.S.C. 112, SIXTH PARAGRAPH

As part of the claim interpretation analysis, examiners should determine whether each limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph or not. If the claim limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth

paragraph, the claim limitation must “be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” [35 U.S.C. 112\(f\)](#) and [pre-AIA 35 U.S.C. 112](#), sixth paragraph; see also *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (*en banc*) (“[W]e hold that paragraph six applies regardless of the context in which the interpretation of means-plus-function language arises, i.e., whether as part of a patentability determination in the PTO or as part of a validity or infringement determination in a court.”). See [MPEP § 2181](#), subsection I. for more information regarding the determination of whether a limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, and means- (or step-) plus- function claim limitations.

### 2173.02 Determining Whether Claim Language is Definite [R-01.2024]

*[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to pre-AIA 35 U.S.C. 102, the relevant time is "at the time of the invention". See MPEP § 2150 et seq. Many of the court decisions discussed in this section involved applications or patents subject to pre-AIA 35 U.S.C. 102. These court decisions may be applicable to applications and patents subject to AIA 35 U.S.C. 102 but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]*

During prosecution, applicant has an opportunity and a duty to amend ambiguous claims to clearly and precisely define the metes and bounds of the claimed invention. The claim places the public on notice of the scope of the patentee’s right to exclude. See, e.g., *Johnson & Johnston Assoc. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052, 62 USPQ2d 1225, 1228 (Fed. Cir. 2002) (*en banc*). As the Federal Circuit stated in *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1654, 1663 (Fed. Cir. 2008):



We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.

A decision on whether a claim is indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.

*Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1350, 94 USPQ2d 1241, 1245 (Fed. Cir. 2010); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). In *Orthokinetics*, a claim directed to a wheel chair included the phrase “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof.” 806 F.2d at 1568, 1 USPQ2d at 1082. The court found the phrase to be as accurate as the subject matter permits, since automobiles are of various sizes. *Id.* at 1576, 1 USPQ2d at 1088. “As long as those of ordinary skill in the art realized the dimensions could be easily obtained, [§ 112](#), 2d para. requires nothing more.” *Id.* Claim terms are typically given their ordinary and customary meaning as understood by one of ordinary skill in the pertinent art, and the generally understood meaning of particular terms may vary from art to art. See [MPEP § 2111.01](#). Therefore, it is important to analyze claim terms in view of the application’s specification from the perspective of those skilled in the relevant art since a particular term used in one patent or application may not have the same meaning when used in a different application. *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1318, 74 USPQ2d 1184, 1188 (Fed. Cir. 2005).

#### **I. CLAIMS UNDER EXAMINATION ARE CONSTRUED DIFFERENTLY THAN PATENTED CLAIMS**

Patented claims are not given the broadest reasonable interpretation during court proceedings involving infringement and validity, and can be interpreted based on a fully developed prosecution record. While

“absolute precision is unattainable” in patented claims, the definiteness requirement “mandates clarity.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910, 110 USPQ2d 1688, 1693 (2014). A court will not find a patented claim indefinite unless the claim interpreted in light of the specification and the prosecution history fails to “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Id.* at 899, 110 USPQ2d at 1689.

The Office does not interpret claims when examining patent applications in the same manner as the courts. *In re Packard*, 751 F.3d 1307, 1312, 110 USPQ2d 1785, 1788 (Fed. Cir. 2014); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989). During prosecution the Office construes claims by giving them their broadest reasonable interpretation consistent with the specification in an effort to establish a clear record of what the applicant intends to claim. Such claim construction during prosecution may effectively result in a lower threshold for ambiguity than a court’s determination. *Packard*, 751 F.3d at 1323-24, 110 USPQ2d at 1796-97 (Plager, J., concurring). However, applicant has the ability to amend the claims during prosecution to ensure that the meaning of the language is clear and definite prior to issuance or provide a persuasive explanation (with evidence as necessary) that a person of ordinary skill in the art would not consider the claim language unclear. *In re Buszard*, 504 F.3d 1364, 1366, 84 USPQ2d 1749, 1750 (Fed. Cir. 2007)(claims are given their broadest reasonable interpretation during prosecution “to facilitate sharpening and clarifying the claims at the application stage”); see also *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Ex parte McAward*, Appeal 2015-006416 (PTAB Aug. 25, 2017) (precedential).

See [MPEP § 2111](#) *et seq.* for a detailed discussion of claim interpretation during the examination process. The lower threshold is also applied because the patent record is in development and not fixed during examination, and the agency does not rely on it for interpreting claims. *Packard*, 751 F.3d at

1325, 110 USPQ2d at 1798 (Plager, J., concurring). *Burlington Indus. Inc. v. Quigg*, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987) (“Issues of judicial claim construction such as arise after patent issuance, for example during infringement litigation, have no place in prosecution of pending claims before the PTO, when any ambiguity or excessive breadth may be corrected by merely changing the claim.”).

During examination, after applying the broadest reasonable interpretation consistent with the specification to the claim, if the metes and bounds of the claimed invention are not clear, the claim is indefinite and should be rejected. *Packard*, 751 F.3d at 1311, 110 USPQ2d at 1787 (“[W]hen the USPTO has initially issued a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirements of [§ 112\(b\)](#).”); *Zletz*, 893 F.2d at 322, 13 USPQ2d at 1322. For example, if the language of a claim, given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation, then a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is appropriate. Examiners, however, are cautioned against confusing claim breadth with claim indefiniteness. A broad claim is not indefinite merely because it encompasses a wide scope of subject matter provided the scope is clearly defined. Instead, a claim is indefinite when the boundaries of the protected subject matter are not clearly delineated and the scope is unclear. For example, a genus claim that covers multiple species is broad, but is not indefinite because of its breadth, which is otherwise clear. But a genus claim that could be interpreted in such a way that it is not clear which species are covered would be indefinite (e.g., because there is more than one reasonable interpretation of what species are included in the claim). See [MPEP § 2173.05\(h\)](#), subsection I., for more information regarding the determination of whether a Markush claim satisfies the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

## II. THRESHOLD REQUIREMENTS OF CLARITY AND PRECISION

The examiner’s focus during examination of claims for compliance with the requirement for definiteness of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is whether the claim meets the threshold requirements of clarity and precision set forth in the statute, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, the examiner should allow claims which define the patentable subject matter with the required degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted so long as [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is satisfied. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. “As the statutory language of ‘particular[ity]’ and ‘distinct[ness]’ indicates, claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms. It is the claims that notify the public of what is within the protections of the patent, and what is not.” *Packard*, 751 F.3d at 1313, 110 USPQ2d at 1788. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary

skill in the art of its scope and, therefore, serves the notice function required by [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, 10 Fed. App'x 890 (Fed. Cir. 2001) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by [35 U.S.C. 112](#).)

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is appropriate. See *IBSA Institut Biochimique, S.A. v. Teva Pharm. USA, Inc.*, 966 F.3d 1374, 1378-81, 2020 USPQ2d 10865 (Fed. Cir. 2020) (The court affirmed a district court's finding of indefiniteness based upon a detailed analysis of the claim language itself as well as intrinsic and extrinsic evidence); *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, the claim must not be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

Examiners should note that Office policy is not to employ *per se* rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in [MPEP § 2173.05\(d\)](#) are fact specific and should not be applied as *per se* rules.

### III. RESOLVING INDEFINITE CLAIM LANGUAGE

#### A. Examiner Must Establish a Clear Record

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of an application. See [MPEP § 1302.14](#), subsection I. In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner should provide clear explanations of all actions taken during prosecution of the application. See [MPEP § 707.07\(f\)](#). Thus, when a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is appropriate based on the examiner's determination that a claim term or phrase is *prima facie* indefinite, the examiner should clearly communicate in an Office action any findings and reasons which support the rejection and avoid a mere conclusion that the claim term or phrase is indefinite. See [MPEP § 706.03](#) and [MPEP § 707.07\(g\)](#).

[MPEP § 2173.05](#) provides numerous examples of rationales that may support a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, such as functional claim limitations, relative terminology/terms of degree, lack of antecedent basis, etc. Only by providing a complete explanation in the Office action as to the basis for determining why a particular term or phrase used in the claim is indefinite will the examiner enhance the clarity of the prosecution history record.

#### B. An Office Action Should Provide a Sufficient Explanation

The Office action must set forth the specific term or phrase that is indefinite and why the metes and bounds are unclear. Since a rejection requires the applicant to respond by explaining why claim language would be recognized by a person of ordinary skill in the art as definite or by amending the claim, the Office action should provide enough information for the applicant to prepare a meaningful response. "Because claims delineate the patentee's right to exclude, the patent statute requires that the scope of the claims be sufficiently definite to inform

the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent.” *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249, 85 USPQ2d 1654, 1658 (Fed. Cir. 2008). Thus, during prosecution, claims are given their broadest reasonable interpretation consistent with the specification “to facilitate sharpening and clarifying the claims at the application stage” when claims are readily changed. *In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007); see also *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

To comply with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, applicants are required to make the terms that are used to define the invention clear and precise, so that the metes and bounds of the subject matter that will be protected by the patent grant can be ascertained. See [MPEP § 2173.05\(a\)](#), subsection I. It is important that a person of ordinary skill in the art be able to interpret the metes and bounds of the claims so as to understand how to avoid infringement of the patent that ultimately issues from the application being examined. See [MPEP § 2173.02](#), subsection II (citing *Morton Int ’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)); see also *Halliburton Energy Servs.*, 514 F.3d at 1249, 85 USPQ2d at 1658 (“Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.”). Examiners should bear in mind that “[a]n essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *Zletz*, 893 F.2d at 322, 13 USPQ2d at 1322.

Accordingly, when rejecting a claim as *prima facie* indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, the examiner should provide enough information in the Office action to permit applicant to make a meaningful response, as the indefiniteness rejection requires the applicant to explain or provide evidence as to why the claim language is not indefinite or amend the claim. For example, in making a *prima facie* case of indefiniteness, the examiner should point out the

specific term or phrase that is indefinite, explain in detail why such term or phrase renders the metes and bounds of the claim scope unclear and, whenever practicable, indicate how the indefiniteness issues may be resolved to overcome the rejection. See [MPEP § 707.07\(d\)](#). If the applicant does not adequately respond to the *prima facie* case, the examiner may make the indefiniteness rejection final. *Packard*, 751 F.3d at 1312, 110 USPQ2d at 1788.

The focus during the examination of claims for compliance with the requirement for definiteness under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. See [MPEP § 2173.02](#), subsection II. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement. Furthermore, when the examiner determines that more information is necessary to ascertain the meaning of a claim term, a requirement for information under [37 CFR 1.105](#) may be appropriate. See [MPEP § 704.10](#) regarding requirements for information.

It is highly desirable to have applicants resolve ambiguity by amending the claims during prosecution of the application rather than attempting to resolve the ambiguity in subsequent litigation of the issued patent. *Halliburton Energy Servs.*, 514 F.3d at 1255, 85 USPQ2d at 1663. Thus, in response to an examiner’s rejection for indefiniteness, an applicant may resolve the ambiguity by amending the claim, or by providing a persuasive explanation on the record that a person of ordinary skill in the relevant art would not consider the claim language unclear. *In re Packard*, 751 F.3d 1307, 1311, 110 USPQ2d 1785, 1787 (Fed. Cir. 2014). For the latter option, in some cases, it may be necessary for the applicant to provide a separate definition (such as from an art-recognized dictionary) to show how the ordinarily-skilled artisan would have understood the claim language at issue. *Id.*

If the examiner considers applicant’s arguments and/or amendments to be persuasive, the examiner



should indicate in the next Office communication that the previous rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, has been withdrawn and provide an explanation as to what prompted the change in the examiner's position (e.g., by making specific reference to portions of applicant's remarks).

By providing an explanation as to the action taken, the examiner will enhance the clarity of the prosecution history record. As noted by the Supreme Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that “[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process.” In *Festo*, the Court held that “a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.” With respect to amendments made to comply with the requirements of [35 U.S.C. 112](#), the Court stated that “[i]f a [§ 112](#) amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a [§ 112](#) amendment is necessary and narrows the patent's scope—even if only for the purpose of better description—estoppel may apply.” *Id.* at 1840, 62 USPQ2d at 1712. The Court further stated that “when the court is unable to determine the purpose underlying a narrowing amendment—and hence a rationale for limiting the estoppel to the surrender of particular equivalents—the court should presume that the patentee surrendered all subject matter between the broader and the narrower language...the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question.” *Id.* at 1842, 62 USPQ2d at 1713. Thus, whenever possible, the examiner should make the record clear by providing explicit reasoning for making or withdrawing any rejection related to [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

### ***C. Provide Claim Interpretation in Reasons for Allowance When Record is Unclear***

Pursuant to [37 CFR 1.104\(e\)](#), if the examiner believes that the record of the prosecution as a whole

does not make clear the reasons for allowing a claim or claims, the examiner may set forth such reasoning in reasons for allowance. Further, prior to allowance, the examiner may also specify allowable subject matter and provide reasons for indicating such allowable subject matter in an Office communication. See [MPEP § 1302.14](#), subsection I. One of the primary purposes of [37 CFR 1.104\(e\)](#) is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify subsequent litigation of an issued patent. See [MPEP § 1302.14](#), subsection I. In meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising their responsibility to the public to see that the file history is complete. See [MPEP § 1302.14](#), subsection I.

For example, when allowing a claim based on a claim interpretation which might not be readily apparent from the record of the prosecution as a whole, the examiner should set forth in reasons for allowance the claim interpretation applied in determining that the claim is allowable over the prior art. See [MPEP § 1302.14](#), subsection II.G. This is especially the case where the application is allowed after an interview. The examiner should ensure, however, that statements of reasons for allowance do not place unwarranted interpretations, whether broad or narrow, upon the claims. See [MPEP § 1302.14](#), subsection I.

### ***D. Open Lines of Communication with the Applicant – When Indefiniteness Is the Only Issue, Attempt Resolution through an Interview before Resorting to a Rejection***

Examiners are reminded that interviews can be an effective examination tool and are encouraged to initiate an interview with the applicant or applicant's representative at any point during the pendency of an application, if the interview can help further prosecution, shorten pendency, or provide a benefit to the examiner or applicant. Issues of claim interpretation and clarity of scope may lend themselves to resolution through an examiner interview. For example, the examiner may initiate

an interview to discuss, among other issues, the broadest reasonable interpretation of a claim in light of the specification, the meaning of a particular claim limitation, and the scope and clarity of preamble language, functional language, intended use language, and means-plus-function limitations, etc.

An interview can serve to develop and clarify such issues and lead to a mutual understanding between the examiner and the applicant, potentially eliminating the need for the examiner to resort to making a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. The examiner is reminded that the substance of any interview, whether in person, by video conference, or by telephone must be made of record in the application, whether or not an agreement was reached at the interview. See [MPEP § 713.04](#); see also [37 CFR 1.2](#) (“The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.”). Examples of [35 U.S.C. 112](#) issues that should be made of record after the interview include: why the discussed claim term is or is not sufficiently clear; why the discussed claim term is or is not inconsistent with the specification; why the discussed claim term does or does not invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph (and if it does, the identification of corresponding structure, material, or acts in the specification for a [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph limitation); and any claim amendments discussed that would resolve identified ambiguities.

### **2173.03 Correspondence Between Specification and Claims [R-07.2022]**

The specification should ideally serve as a glossary to the claim terms so that the examiner and the public can clearly ascertain the meaning of the claim terms. Correspondence between the specification and claims is required by [37 CFR 1.75\(d\)\(1\)](#), which provides that claim terms must find clear support or antecedent basis in the specification so that the meaning of the terms may be ascertainable by reference to the specification. Glossaries of terms used in the claims are a helpful device for ensuring

adequate definition of terms used in claims. If the specification does not provide the needed support or antecedent basis for the claim terms, the specification should be objected to under [37 CFR 1.75\(d\)\(1\)](#). See [MPEP § 608.01\(o\)](#) and [MPEP § 2181](#), subsection IV. Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the claim terms provided no new matter is introduced, or amend the claim.

A claim, although clear on its face, may also be indefinite when a conflict or inconsistency between the claimed subject matter and the specification disclosure renders the scope of the claim uncertain as inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Moore*, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971); *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). For example, a claim with a limitation of “the clamp means including a clamp body and first and second clamping members, the clamping members being supported by the clamp body” was determined to be indefinite because the terms “first and second clamping members” and “clamp body” were found to be vague in light of the specification which showed no “clamp member” structure being “supported by the clamp body.” *In re Anderson*, 1997 U.S. App. Lexis 167 (Fed. Cir. January 6, 1997) (unpublished). In *Cohn*, a claim was directed to a process of treating an aluminum surface with an alkali silicate solution and included a further limitation that the surface has an “opaque” appearance. *Id.* The specification, meanwhile, associated the use of an alkali silicate with a glazed or porcelain-like finish, which the specification distinguished from an opaque finish. *Cohn*, 438 F.2d at 993, 169 USPQ at 98. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the claim was internally inconsistent based on the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment, and therefore indefinite. *Id.* In addition, inconsistencies in the meaning of terms or phrases between claims may render the scope of the claims to be uncertain. *Tvngo Ltd. (BVI) v. LG*

*Elects. Inc.*, 861 Fed. Appx. 453, 459-60, 2021 USPQ2d 697 (Fed. Cir. 2021) ("The issue is not breadth of the dependent claims but their use of the disputed phrase in a way that contradicts the independent claims. The dependent claims state that 'said overlay activation criterion includes . . . a user command information,' which conflicts with the independent claim's use of this same phrase."). "When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in '[o]ther claims of the patent in question,' which 'can also be valuable sources of enlightenment as to the meaning of a claim term.'" *Id.* at 460 (quoting *Philips v. AWH Corp.*, 415 F.3d 1303, 1314, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005)).

#### **2173.04 Breadth Is Not Indefiniteness [R-10.2019]**

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971); *In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) ("Breadth is not indefiniteness."). A broad claim is not indefinite merely because it encompasses a wide scope of subject matter provided the scope is clearly defined. But a claim is indefinite when the boundaries of the protected subject matter are not clearly delineated and the scope is unclear. For example, a genus claim that covers multiple species is broad, but is not indefinite because of its breadth, which is otherwise clear. But a genus claim that could be interpreted in such a way that it is not clear which species are covered would be indefinite (e.g., because there is more than one reasonable interpretation of what species are included in the claim).

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which the inventor or a joint inventor regards as the invention as evidenced by statements outside of the application as filed, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection

under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either [35 U.S.C. 102](#) or [103](#) would be appropriate.

#### **2173.05 Specific Topics Related to Issues Under 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph [R-11.2013]**

The following sections are devoted to a discussion of specific topics where issues under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, have been addressed. These sections are not intended to be an exhaustive list of the issues that can arise under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, but are intended to provide guidance in areas that have been addressed with some frequency in recent examination practice. The court and Board decisions cited are representative. As with all appellate decisions, the results are largely dictated by the facts in each case. The use of the same language in a different context may justify a different result.

See [MPEP § 2181](#) for guidance in determining whether an applicant has complied with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is invoked.

#### **2173.05(a) New Terminology [R-07.2022]**

##### **I. THE MEANING OF EVERY TERM SHOULD BE APPARENT**

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Claim language may not be "ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention." *In re Packard*, 751 F.3d 1307, 1311, 110 USPQ2d 1785, 1787 (Fed. Cir. 2014). Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent

examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also [MPEP § 2111](#) - [§ 2111.01](#). When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

## II. THE REQUIREMENT FOR CLARITY AND PRECISION MUST BE BALANCED WITH THE LIMITATIONS OF THE LANGUAGE

Courts have recognized that it is not only permissible, but often desirable, to use new terms that are frequently more precise in describing and defining the new invention. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Although it is difficult to compare the claimed invention with the prior art when new terms are used that do not appear in the prior art, this does not make the new terms indefinite.

New terms are often used when a new technology is in its infancy or is rapidly evolving. The requirements for clarity and precision must be balanced with the limitations of the language and the science. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute ([35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph) demands no more.

*Packard*, 751 F.3d at 1313, 110 USPQ2d at 1789 ("[H]ow much clarity is required necessarily invokes some standard of reasonable precision in the use of language in the context of the circumstances."). This does not mean that the examiner must accept the best effort of applicant. If the language is not considered as precise as the subject matter permits, the examiner should provide reasons to support the conclusion of indefiniteness and is encouraged to suggest alternatives that would not be subject to rejection.

## III. TERMS USED CONTRARY TO THEIR ORDINARY MEANING MUST BE CLEARLY REDEFINED IN THE WRITTEN DESCRIPTION

Consistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term."); *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990). Accordingly, when there is more than one meaning for a term, it is incumbent upon applicant to make clear which meaning is being relied upon to claim the invention. Until the meaning of a term or phrase used in a claim is clear, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is appropriate. It is appropriate to compare the meaning of terms given in technical dictionaries in order to ascertain the accepted meaning of a term in the art. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). See also [MPEP § 2111.01](#).

### 2173.05(b) Relative Terminology [R-01.2024]

The use of relative terminology in claim language, including terms of degree, does not automatically render the claim indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, 35 F.4th 1345, 1349, 2022 USPQ2d 509 (Fed. Cir. 2022) ("Based on the intrinsic record alone, we conclude that the written description



provides, with reasonable certainty, the scope of the term self-similar.”).

## I. TERMS OF DEGREE

Terms of degree are not necessarily indefinite. “Claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370, 112 USPQ2d 1188, 1192-93 (Fed. Cir. 2014) (citing *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 65-66 (1923) (finding ‘substantial pitch’ sufficiently definite because one skilled in the art ‘had no difficulty ... in determining what was the substantial pitch needed’ to practice the invention)). Thus, when a term of degree is used in the claim, the examiner should determine whether the specification provides some standard for measuring that degree. *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357, 1367, 94 USPQ2d 1385, 1391 (Fed. Cir. 2010); *Enzo Biochem, Inc., v. Applera Corp.*, 599 F.3d 1325, 1332, 94 USPQ2d 1321, 1326 (Fed. Cir. 2010); *Seattle Box Co., Inc. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). If the specification does not provide some standard for measuring that degree, a determination must be made as to whether one of ordinary skill in the art could nevertheless ascertain the scope of the claim (e.g., a standard that is recognized in the art for measuring the meaning of the term of degree). For example, in *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992), the phrases “relatively shallow,” “of the order of,” “the order of about 5mm,” and “substantial portion” were held to be indefinite because the specification lacked some standard for measuring the degrees intended.

The claim is not indefinite if the specification provides examples or teachings that can be used to measure a degree even without a precise numerical measurement (e.g., a figure that provides a standard for measuring the meaning of the term of degree). See, e.g., *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-72, 112 USPQ2d 1188, 1193 (Fed. Cir. 2014) (observing that although there is no absolute or mathematical precision required, “[t]he claims, when read in light of the specification and

the prosecution history, must provide objective boundaries for those of skill in the art”).

Proper claim interpretation regarding a term of degree requires determining whether its usage within the context of the claim(s) and specification is clear. The identification of a claim term as one of degree alone is not enough to conclude a claim is indefinite. *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, 35 F.4th 1345, 1349, 1351, 2022 USPQ2d 509 (Fed. Cir. 2022) (noting that “claim 57 does not use the term similar in isolation as a term of degree but in the context of a self-referential or self-repeating geometric pattern for configuring microphones in an array, . . .”).

During prosecution, an applicant may also overcome an indefiniteness rejection by providing evidence that the meaning of the term of degree can be ascertained by one of ordinary skill in the art when reading the disclosure. For example, in *Enzo Biochem*, the applicant submitted a declaration under [37 CFR 1.132](#) showing examples that met the claim limitation and examples that did not. *Enzo Biochem*, 599 F.3d at 1335, 94 USPQ2d at 1328 (noting that applicant overcame an indefiniteness rejection over “not interfering substantially” claim language by submitting a declaration under [37 CFR 1.132](#) listing eight specific linkage groups that applicant declared did not substantially interfere with hybridization or detection).

Even if the specification uses the same term of degree as in the claim, a rejection is proper if the scope of the term is not understood when read in light of the specification. While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions, when the scope of the claim is unclear a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is proper. See *In re Wiggins*, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973).

When relative terms are used in claims wherein the improvement over the prior art rests entirely upon size or weight of an element in a combination of elements, the adequacy of the disclosure of a standard is of greater criticality.

## II. REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE

A claim may be rendered indefinite when a limitation of the claim is defined by reference to an object and the relationship between the limitation and the object is not sufficiently defined. That is, where the elements of a claim have two or more plausible constructions such that the examiner cannot readily ascertain positional relationship of the elements, the claim may be rendered indefinite. See, e.g., *Ex parte Miyazaki*, 89 USPQ2d 1207 (Bd. Pat. App. & Inter. 2008) (precedential) and *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). In *Miyazaki*, the Board held that claims to a large printer were not sufficiently definite because:

The language of claim 1 attempts to claim the height of the paper feeding unit in relation to a user of a specific height who is performing operations on the printer... Claim 1 fails to specify, however, a positional relationship of the user and the printer to each other.

*Miyazaki*, 89 USPQ2d at 1212. In *Brummer*, the Board held that a limitation in a claim to a bicycle that recited “said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for” was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Brummer*, 12 USPQ2d at 1655.

On the other hand, a claim limitation specifying that a certain part of a pediatric wheelchair be “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats” was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase “so dimensioned” is as accurate as the subject matter permits, noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

## III. APPROXIMATIONS

### A. “About”

In determining the range encompassed by the term “about,” one must consider the context of the term as it is used in the specification and claims of the application. *Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Labs., Ltd.*, 476 F.3d 1321, 1326, 81 USPQ2d 1427, 1432 (Fed. Cir. 2007). In *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as “exceeding about 10% per second” is definite because infringement could clearly be assessed through the use of a stopwatch. However, in another case, the court held that claims reciting “at least about” were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term “about.” *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).

### B. “Essentially”

The phrase “a silicon dioxide source that is essentially free of alkali metal” was held to be definite because the specification contained guidelines and examples that were considered sufficient to enable a person of ordinary skill in the art to draw a line between unavoidable impurities in starting materials and essential ingredients. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (CCPA 1983). The court further observed that it would be impractical to require applicants to specify a particular number as a cutoff between their invention and the prior art.

### C. “Similar”

The term “similar” in the preamble of a claim that was directed to a nozzle “for high-pressure cleaning units or similar apparatus” was held to be indefinite since it was not clear what applicant intended to cover by the recitation “similar” apparatus. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

A claim in a design patent application which read: “The ornamental design for a feed bunk or similar structure as shown and described.” was held to be indefinite because it was unclear from the specification what applicant intended to cover by the recitation of “similar structure.” *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

#### D. “Substantially”

The term “substantially” is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation “to substantially increase the efficiency of the compound as a copper extractant” was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation “which produces substantially equal E and H plane illumination patterns” was definite because one of ordinary skill in the art would know what was meant by “substantially equal.” *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

#### E. “Type”

The addition of the word “type” to an otherwise definite expression (e.g., Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. Pat. App. & Inter. 1955). Likewise, the phrase “ZSM-5-type aluminosilicate zeolites” was held to be indefinite because it was unclear what “type” was intended to convey. The interpretation was made more difficult by the fact that the zeolites defined in the dependent claims were not within the genus of the type of zeolites defined in the independent claim. *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

### IV. SUBJECTIVE TERMS

When a subjective term is used in the claim, the examiner should determine whether the specification supplies some objective standard for measuring the scope of the term. Some objective standard must be

provided in order to allow the public to determine the scope of the claim. A claim term that requires the exercise of subjective judgment without restriction may render the claim indefinite. *In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289 (CCPA 1970). Claim scope cannot depend solely on the unrestrained, subjective opinion of a particular individual purported to be practicing the invention. *Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350, 75 USPQ2d 1801, 1807 (Fed. Cir. 2005)); see also *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1373, 112 USPQ2d 1188 (Fed. Cir. 2014) (holding the claim phrase “unobtrusive manner” indefinite because the specification did not “provide a reasonably clear and exclusive definition, leaving the facially subjective claim language without an objective boundary”).

For example, in *Datamize*, the invention was directed to a computer interface screen with an “aesthetically pleasing look and feel.” *Datamize*, 417 F.3d at 1344-45, 75 USPQ2d at 1802-03. The meaning of the term “aesthetically pleasing” depended solely on the subjective opinion of the person selecting features to be included on the interface screen. Nothing in the intrinsic evidence (e.g., the specification) provided any guidance as to what design choices would result in an “aesthetically pleasing” look and feel. 417 F.3d at 1352, 75 USPQ2d at 1808. The claims were held indefinite because the interface screen may be “aesthetically pleasing” to one user but not to another. 417 F.3d at 1350, 75 USPQ2d at 1806. See also *Ex parte Anderson*, 21 USPQ2d 1241 (Bd. Pat. App. & Inter. 1991) (the terms “comparable” and “superior” were held to be indefinite in the context of a limitation relating the characteristics of the claimed material to other materials).

During prosecution, the applicant may overcome a rejection by amending the claim to remove the subjective term, or by providing evidence that the meaning of the term can be ascertained by one of ordinary skill in the art when reading the disclosure. However, “[f]or some facially subjective terms, the definiteness requirement is not satisfied by merely offering examples that satisfy the term within the specification.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1261, 113 USPQ2d 1097, 1108 (Fed. Cir. 2014).

## 2173.05(c) Numerical Ranges and Amounts Limitations [R-11.2013]

Generally, the recitation of specific numerical ranges in a claim does not raise an issue of whether a claim is definite.

### I. NARROW AND BROADER RANGES IN THE SAME CLAIM

Use of a narrow numerical range that falls within a broader range in the same claim may render the claim indefinite when the boundaries of the claim are not discernible. Description of examples and preferences is properly set forth in the specification rather than in a single claim. A narrower range or preferred embodiment may also be set forth in another independent claim or in a dependent claim. If stated in a single claim, examples and preferences lead to confusion over the intended scope of the claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph should be made. The Examiner should analyze whether the metes and bounds of the claim are clearly set forth. Examples of claim language which have been held to be indefinite are (A) “a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius”; and (B) “a predetermined quantity, for example, the maximum capacity.”

While a single claim that includes both a broad and a narrower range may be indefinite, it is not improper under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, to present a dependent claim that sets forth a narrower range for an element than the range set forth in the claim from which it depends. For example, if claim 1 reads “A circuit ... wherein the resistance is 70-150 ohms.” and claim 2 reads “The circuit of claim 1 wherein the resistance is 70-100 ohms.”, then claim 2 should not be rejected as indefinite.

### II. OPEN-ENDED NUMERICAL RANGES

Open-ended numerical ranges should be carefully analyzed for definiteness. For example, when an independent claim recites a composition comprising “at least 20% sodium” and a dependent claim sets

forth specific amounts of nonsodium ingredients which add up to 100%, apparently to the exclusion of sodium, an ambiguity is created with regard to the “at least” limitation (unless the percentages of the nonsodium ingredients are based on the weight of the nonsodium ingredients). On the other hand, the court held that a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of A, 20-80% of B and 1-25% of C) was not indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. It was observed that subject matter which cannot exist in fact can neither anticipate nor infringe a claim. *In re Kroekel*, 504 F.2d 1143, 183 USPQ 610 (CCPA 1974).

In a claim directed to a chemical reaction process, a limitation required that the amount of one ingredient in the reaction mixture should “be maintained at less than 7 mole percent” based on the amount of another ingredient. The examiner argued that the claim was indefinite because the limitation sets only a maximum amount and is inclusive of substantially no ingredient resulting in termination of any reaction. The court did not agree, holding that the claim was clearly directed to a reaction process, and explaining that “[t]he imposition of a maximum limit on the quantity of one of the reactants without specifying a minimum does not warrant distorting the overall meaning of the claim to preclude performing the claimed process.” *In re Kirsch*, 498 F.2d 1389, 1394, 182 USPQ 286, 290 (CCPA 1974).

Some terms have been determined to have the following meanings in the factual situations of the reported cases: the term “up to” includes zero as a lower limit, *In re Mochel*, 470 F.2d 638, 176 USPQ 194 (CCPA 1974); and “a moisture content of not more than 70% by weight” reads on dry material, *Ex parte Khusid*, 174 USPQ 59 (Bd. App. 1971).

### III. “EFFECTIVE AMOUNT”

The common phrase “an effective amount” may or may not be indefinite. The proper test is whether or not one skilled in the art could determine specific values for the amount based on the disclosure. See *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The phrase “an effective amount . . . for growth stimulation” was held to be definite where



the amount was not critical and those skilled in the art would be able to determine from the written disclosure, including the examples, what an effective amount is. *In re Halleck*, 422 F.2d 911, 164 USPQ 647 (CCPA 1970). The phrase “an effective amount” has been held to be indefinite when the claim fails to state the function which is to be achieved and more than one effect can be implied from the specification or the relevant art. *In re Frederickson*, 213 F.2d 547, 102 USPQ 35 (CCPA 1954). The more recent cases have tended to accept a limitation such as “an effective amount” as being definite when read in light of the supporting disclosure and in the absence of any prior art which would give rise to uncertainty about the scope of the claim. In *Ex parte Skuballa*, 12 USPQ2d 1570 (Bd. Pat. App. & Inter. 1989), the Board held that a pharmaceutical composition claim which recited an “effective amount of a compound of claim 1” without stating the function to be achieved was definite, particularly when read in light of the supporting disclosure which provided guidelines as to the intended utilities and how the uses could be effected.

### **2173.05(d) Exemplary Claim Language (“for example,” “such as”) [R-07.2015]**

Description of examples or preferences is properly set forth in the specification rather than the claims. If stated in the claims, examples and preferences may lead to confusion over the intended scope of a claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph should be made. The examiner should analyze whether the metes and bounds of the claim are clearly set forth. Note that the mere use of the phrase “such as” or “for example” in a claim does not by itself render the claim indefinite.

Examples of claim language which have been held to be indefinite because the intended scope of the claim was unclear are:

(A) “R is halogen, for example, chlorine”;

(B) “material such as rock wool or asbestos” *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1949);

(C) “lighter hydrocarbons, such, for example, as the vapors or gas produced” *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949);

(D) “normal operating conditions such as while in the container of a proportioner” *Ex parte Steigerwald*, 131 USPQ 74 (Bd. App. 1961); and

(E) “coke, brick, or like material”. *Ex parte Caldwell*, 1906 C.D. 58 (Comm’r Pat. 1906).

The above examples of claim language which have been held to be indefinite are fact specific and should not be applied as *per se* rules. See [MPEP § 2173.02](#) for guidance regarding when it is appropriate to make a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

### **2173.05(e) Lack of Antecedent Basis [R-01.2024]**

A claim is indefinite when it contains words or phrases whose meaning is unclear. *In re Packard*, 751 F.3d 1307, 1314, 110 USPQ2d 1785, 1789 (Fed. Cir. 2014). The lack of clarity could arise where a claim refers to “said lever” or “the lever,” where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of “said lever” in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended. A claim which refers to “said aluminum lever,” but recites only “a lever” earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made. Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”). Inherent components of elements recited have antecedent basis in the recitation of the elements themselves. For example, the limitation “the outer surface of said sphere” would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir. 2001) (holding that recitation of “an ellipse” provided antecedent basis for “an ellipse having a major diameter” because “[t]here can be no dispute that

mathematically an inherent characteristic of an ellipse is a major diameter”).

### **I. EXAMINER SHOULD SUGGEST CORRECTIONS TO ANTECEDENT PROBLEMS**

Antecedent problems in the claims are typically drafting oversights that are easily corrected once they are brought to the attention of applicant. The examiner’s task of making sure the claim language complies with the requirements of the statute should be carried out in a positive and constructive way, so that minor problems can be identified and easily corrected, and so that the major effort is expended on more substantive issues. However, even though indefiniteness in claim language is of semantic origin, it is not rendered unobjectionable simply because it could have been corrected. *In re Hammack*, 427 F.2d 1384, 1388 n.5, 166 USPQ 209, 213 n.5 (CCPA 1970).

### **II. A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE IS NOT NECESSARILY INDEFINITE**

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

### **III. A CLAIM IS NOT *PER SE* INDEFINITE IF THE BODY OF THE CLAIM RECITES ADDITIONAL ELEMENTS WHICH DO NOT APPEAR IN THE PREAMBLE**

The mere fact that the body of a claim recites additional elements which do not appear in the claim’s preamble does not render the claim indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *In re Larsen*, 10 Fed. App’x 890 (Fed. Cir. 2001) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The examiner rejected the claim under [35 U.S.C. 112](#), second paragraph, because the omission from the

claim’s preamble of a critical element (i.e., a linear member) renders that claim indefinite. The court reversed the examiner’s rejection and stated that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor’s contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by [35 U.S.C. 112](#), paragraph 2.).

### **2173.05(f) Reference to Limitations in Another Claim [R-11.2013]**

A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. For example, claims which read: “The product produced by the method of claim 1.” or “A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions .....” are not indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) (where reference to “the nozzle of claim 7” in a method claim was held to comply with [35 U.S.C. 112](#), second paragraph). However, where the format of making reference to limitations recited in another claim results in confusion, then a rejection would be proper under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

When examining a dependent claim, the examiner should also determine whether the claim complies with [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112](#), fourth paragraph. See [MPEP § 608.01\(n\)](#), subsection III.

### **2173.05(g) Functional Limitations [R-07.2022]**

A claim term is functional when it recites a feature “by what it does rather than by what it is” (e.g., as evidenced by its specific structure or specific

ingredients). *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 229 (CCPA 1971). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

*Id.* In fact, [35 U.S.C. 112\(f\)](#) and [pre-AIA 35 U.S.C. 112](#), sixth paragraph, expressly authorize a form of functional claiming (means- (or step-) plus- function claim limitations discussed in [MPEP § 2181](#) *et seq.*). Functional language may also be employed to limit the claims without using the means-plus-function format. See, e.g., *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363, 52 USPQ2d 1001, 1005 (Fed. Cir. 1999). Unlike means-plus-function claim language that applies only to purely functional limitations, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1311, 75 USPQ2d 1321, 1324 (Fed. Cir. 2005) (*en banc*) (“Means-plus-function claiming applies only to purely functional limitations that do not provide the structure that performs the recited function.”), functional claiming often involves the recitation of some structure followed by its function. For example, in *In re Schreiber*, the claims were directed to a conical spout (the structure) that “allow[ed] several kernels of popped popcorn to pass through at the same time” (the function). *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As noted by the court in *Schreiber*, “[a] patent applicant is free to recite features of an apparatus either structurally or functionally.” *Id.*

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term “operatively connected” is “a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components,” that is, the term “means the claimed components must be connected in a way to perform a designated function.” “In the absence of modifiers, general descriptive terms are typically construed as having their full meaning.”

*Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, “subject to any clear and unmistakable disavowal of claim scope, the term ‘operatively connected’ takes the full breath of its ordinary meaning, i.e., ‘said tube [is] operatively connected to said cap’ when the tube and cap are arranged in a manner capable of performing the function of filtering.” *Id.* at 1120, 72 USPQ2d at 1008.

Other examples of permissible function language include the following.

It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such as “members adapted to be positioned” and “portions . . . being resiliently dilatible whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

Notwithstanding the permissible instances, the use of functional language in a claim may fail “to provide a clear-cut indication of the scope of the subject matter embraced by the claim” and thus be indefinite. *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971). For example, when claims merely recite a description of a problem to be solved or a function or result achieved by the invention, the boundaries of the claim scope may be unclear.

*Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1654, 1663 (Fed. Cir. 2008) (noting that the Supreme Court explained that a vice of functional claiming occurs “when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty”) (quoting *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938)); see also *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 234, 55 USPQ 381 (1942) (holding indefinite claims that recited substantially pure carbon black “in the form of commercially uniform, comparatively small, rounded smooth aggregates having a spongy or porous exterior”). Further, without reciting the particular structure, materials or steps that

accomplish the function or achieve the result, all means or methods of resolving the problem may be encompassed by the claim. *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1353, 94 USPQ2d 1161, 1173 (Fed. Cir. 2010) (*en banc*). See also *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801 (Fed. Cir. 2005) where a claim directed to a software based system for creating a customized computer interface screen recited that the screen be “aesthetically pleasing,” which is an intended result and does not provide a clear cut indication of scope because it imposed no structural limits on the screen. Unlimited functional claim limitations that extend to all means or methods of resolving a problem may not be adequately supported by the written description or may not be commensurate in scope with the enabling disclosure, both of which are required by [35 U.S.C. 112\(a\)](#) and [pre-AIA 35 U.S.C. 112](#), first paragraph. *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983); *Ariad*, 598 F.3d at 1340, 94 USPQ2d at 1167. For instance, a single means claim covering every conceivable means for achieving the stated result was held to be invalid under [35 U.S.C. 112](#), first paragraph because the court recognized that the specification, which disclosed only those means known to the inventor, was not commensurate in scope with the claim. *Hyatt*, 708 F.2d at 714-715, 218 USPQ at 197. For more information regarding the written description requirement and enablement requirement under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, see [MPEP §§ 2161-2164.08\(c\)](#). Examiners should keep in mind that whether or not the functional limitation complies with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is a different issue from whether the limitation is properly supported under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, or is distinguished over the prior art.

When a claim limitation employs functional language, the examiner’s determination of whether the limitation is sufficiently definite will be highly dependent on context (e.g., the disclosure in the specification and the knowledge of a person of ordinary skill in the art). *Halliburton Energy Servs.*, 514 F.3d at 1255, 85 USPQ2d at 1663. For example, a claim that included the term “fragile gel” was found to be indefinite because the definition of the term in the specification was functional, i.e., the fluid

is defined by what it does rather than what it is (“ability of the fluid to transition quickly from gel to liquid, and the ability of the fluid to suspend drill cuttings at rest”), and it was ambiguous as to the requisite degree of the fragileness of the gel, the ability of the gel to suspend drill cuttings (i.e., gel strength), and/or some combination of the two. *Halliburton Energy Servs.*, 514 F.3d at 1255-56, 85 USPQ2d at 1663. In another example, the claims directed to a tungsten filament for electric incandescent lamps were held invalid for including a limitation that recited “comparatively large grains of such size and contour as to prevent substantial sagging or offsetting during a normal or commercially useful life for such a lamp or other device.” *General Elec. Co.*, 304 U.S. at 370-71, 375. The Court observed that the prior art filaments also “consisted of comparatively large crystals” but they were “subject to offsetting” or shifting, and the Court further found that the phrase “of such size and contour as to prevent substantial sagging and offsetting during a normal or commercially useful life for a lamp or other device” did not adequately define the structural characteristics of the grains (e.g., the size and contour) to distinguish the claimed invention from the prior art. *Id.* at 370. Similarly, a claim was held invalid because it recited “sustantially (sic) pure carbon black in the form of commercially uniform, comparatively small, rounded smooth aggregates having a spongy or porous exterior.” *United Carbon Co.*, 317 U.S. at 234. In the latter example, the Court observed various problems with the limitation: “commercially uniform” meant only the degree of uniformity buyers desired; “comparatively small” did not add anything because no standard for comparison was given; and “spongy” and “porous” are synonyms that the Court found unhelpful in distinguishing the claimed invention from the prior art. *Id.* at 233.

In comparison, a claim limitation reciting “transparent to infrared rays” was held to be definite because the specification showed that a substantial amount of infrared radiation was always transmitted even though the degree of transparency varied depending on certain factors. *Swinehart*, 439 F.2d at 214, 169 USPQ at 230. Likewise, the claims in another case were held definite because applicant provided “a general guideline and examples sufficient to enable a person of ordinary skill in the



art to determine whether a process uses a silicon dioxide source ‘essentially free of alkali metal’ to make a reaction mixture ‘essentially free of alkali metal’ to produce a zeolitic compound ‘essentially free of alkali metal.’” *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 293 (Fed. Cir. 1983).

Examiners should consider the following factors when examining claims that contain functional language to determine whether the language is ambiguous: (1) whether there is a clear cut indication of the scope of the subject matter covered by the claim; (2) whether the language sets forth well-defined boundaries of the invention or only states a problem solved or a result obtained; and (3) whether one of ordinary skill in the art would know from the claim terms what structure or steps are encompassed by the claim. These factors are examples of points to be considered when determining whether language is ambiguous and are not intended to be all inclusive or limiting. Other factors may be more relevant for particular arts. The primary inquiry is whether the language leaves room for ambiguity or whether the boundaries are clear and precise.

During prosecution, applicant may resolve the ambiguities of a functional limitation in a number of ways. For example: (1) “the ambiguity might be resolved by using a quantitative metric (e.g., numeric limitation as to a physical property) rather than a qualitative functional feature” (see *Halliburton Energy Servs.*, 514 F.3d at 1255-56, 85 USPQ2d at 1663); (2) applicant could demonstrate that the “specification provide[s] a formula for calculating a property along with examples that meet the claim limitation and examples that do not” (see *id.* at 1256, 85 USPQ2d at 1663 (citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1341, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003))); (3) applicant could demonstrate that the specification provides a general guideline and examples sufficient to teach a person skilled in the art when the claim limitation was satisfied (see *Marosi*, 710 F.2d at 803, 218 USPQ at 292); or (4) applicant could amend the claims to recite the particular structure that accomplishes the function.

## 2173.05(h) Alternative Limitations [R-01.2024]

### I. MARKUSH GROUPS

A claim which recites a list of alternatives to define a limitation is an acceptable claim construction which should not necessarily be rejected as confusing under [35 U.S.C. 112\(b\)](#) or as improper. See [MPEP § 2117](#) for guidelines regarding the determination of whether a Markush grouping is improper.

Treatment of claims reciting alternatives is not governed by the particular format used (e.g., alternatives may be set forth as “a material selected from the group consisting of A, B, and C” or “wherein the material is A, B, or C”). See, e.g., the *Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications* (“Supplementary Guidelines”), 76 Fed. Reg. 7162, 7166 (February 9, 2011). Claims that set forth a list of alternatives from which a selection is to be made are typically referred to as Markush claims, after the appellant in *Ex parte Markush*, 1925 Dec. Comm’r Pat. 126, 127 (1924). The listing of specified alternatives within a Markush claim is referred to as a Markush group or Markush grouping. *Abbott Labs v. Baxter Pharmaceutical Products, Inc.*, 334 F.3d 1274, 1280-81, 67 USPQ2d 1191, 1196-97 (Fed. Cir. 2003) (citing to several sources that describe Markush groups).

See [MPEP § 2117](#) for a general discussion of Markush claims and guidelines regarding the determination of whether a Markush grouping is improper, and [MPEP § 803.02](#) for a discussion of election requirements in Markush claims.

A Markush grouping is a closed group of alternatives, i.e., the selection is made from a group “consisting of” (rather than “comprising” or “including”) the alternative members. *Abbott Labs.*, 334 F.3d at 1280, 67 USPQ2d at 1196. If a Markush grouping requires a material selected from an open list of alternatives (e.g., selected from the group “comprising” or “consisting essentially of” the recited alternatives), the claim should generally be rejected under [35 U.S.C. 112\(b\)](#) as indefinite because it is unclear what other alternatives are intended to

be encompassed by the claim. See *In re Kiely*, 2022 USPQ2d 532 at 2\* (Fed. Cir. 2022) (each independent claim recites "a selection from the group comprising a person, an animal, an animated character, a creature, an alien, a toy, a structure, a vegetable, and a fruit." ... (emphasis added). "Given the breadth of variation among the specified alternatives and the use of the open-ended word 'comprising' to define the scope of the list, we affirm the Board's conclusion that the pending claims recite improper Markush language and are indefinite under § 112(b)."). If a claim is intended to encompass combinations or mixtures of the alternatives set forth in the Markush grouping, the claim may include qualifying language preceding the recited alternatives (such as "at least one member" selected from the group), or within the list of alternatives (such as "or mixtures thereof"). *Id.* at 1281. See also [MPEP § 2111.03](#).

A Markush grouping may include a large number of alternatives, and as a result a Markush claim may encompass a large number of alternative members or embodiments, but a claim is not necessarily indefinite under [35 U.S.C. 112\(b\)](#) for such breadth. *In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) ("Breadth is not indefiniteness."). In certain circumstances, however, a Markush group may be so expansive that persons skilled in the art cannot determine the metes and bounds of the claimed invention. For example, if a claim defines a chemical compound using one or more Markush groups, and that claim encompasses a massive number of distinct alternative members, the claim may be indefinite under [35 U.S.C. 112\(b\)](#) if one skilled in the art cannot determine its metes and bounds due to an inability to envision all of the compounds defined by the Markush group(s). In such a circumstance, a rejection of the claim for indefiniteness under [35 U.S.C. 112\(b\)](#) is appropriate.

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Similarly, the double inclusion of an element by members of a Markush group is not, in itself,

sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear. For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro." See, e.g., *Eli Lilly & Co. v. Teva Parenteral Meds.*, 845 F.3d 1357, 1371, 121 USPQ2d 1277, 1287 (Fed. Cir. 2017) (redundancy of including both "vitamin B12" and "cyanocobalamin" (which were recognized on the record as referencing the same compound) within a Markush group of methylmalonic acid lowering agents did not render the claims indefinite).

## II. "OPTIONALLY"

Another alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term "optionally." In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language "containing A, B, and optionally C" was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term "optionally" in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989). In the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under [35 U.S.C. 112\(b\)](#) and explain why there is confusion.

### 2173.05(i) Negative Limitations [R-07.2022]

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed

that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation “said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber” in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation “incapable of forming a dye with said oxidized developing agent” was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). In describing alternative features, the applicant need not articulate advantages or disadvantages of each feature in order to later exclude the alternative features. See *Inphi Corporation v. Netlist, Inc.*, 805 F.3d 1350, 1356-57, 116 USPQ2d 2006, 2010-11 (Fed. Cir. 2015). The mere absence of a positive recitation is not basis for an exclusion. However, a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). “Rather, as with positive limitations, the disclosure must only ‘reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’ ... While silence will not generally suffice to support a negative claim limitation, there may be circumstances in which it

can be established that a skilled artisan would understand a negative limitation to necessarily be present in a disclosure.” *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 2022 USPQ2d 569 (Fed. Cir. 2022) (quoting *Ariad Pharm. Inc. v. Eli Lilly & Co.*, 589 F.3d 1336, 1351, 94 USPQ2d 1161, 1172). Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as failing to comply with the written description requirement. See [MPEP § 2163 - § 2163.07\(b\)](#) for a discussion of the written description requirement of [35 U.S.C. 112\(a\)](#) and [pre-AIA 35 U.S.C. 112](#), first paragraph.

### **2173.05(j) Old Combination [R-11.2013]**

#### **A CLAIM SHOULD NOT BE REJECTED ON THE GROUND OF OLD COMBINATION**

With the passage of the 1952 Patent Act, the courts and the Board have taken the view that a rejection based on the principle of old combination is NO LONGER VALID. Claims should be considered proper so long as they comply with the provisions of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

A rejection on the basis of old combination was based on the principle applied in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 37 USPQ 1 (1938). The principle was that an inventor who made an improvement or contribution to but one element of a generally old combination, should not be able to obtain a patent on the entire combination including the new and improved element. A rejection required the citation of a single reference which broadly disclosed a combination of the claimed elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. The case of *In re Hall*, 208 F.2d 370, 100 USPQ 46 (CCPA 1953) illustrates an application of this principle.

The court pointed out in *In re Bernhart*, 417 F.2d 1395, 163 USPQ 611 (CCPA 1969) that the statutory language (particularly point out and distinctly claim) is the only proper basis for an old combination

rejection, and in applying the rejection, that language determines what an applicant has a right and obligation to do. A majority opinion of the Board of Appeals held that Congress removed the underlying rationale of *Lincoln Engineering* in the 1952 Patent Act, and thereby effectively legislated that decision out of existence. *Ex parte Barber*, 187 USPQ 244 (Bd. App. 1974). Finally, the Court of Appeals for the Federal Circuit, in *Radio Steel and Mfg. Co. v. MTD Products, Inc.*, 731 F.2d 840, 221 USPQ 657 (Fed. Cir. 1984), followed the *Bernhart* case, and ruled that a claim was not invalid under *Lincoln Engineering* because the claim complied with the requirements of [35 U.S.C. 112](#), second paragraph. Accordingly, a claim should not be rejected on the ground of old combination.

### **2173.05(k) Aggregation [R-08.2012]**

A claim should not be rejected on the ground of “aggregation.” *In re Gustafson*, 331 F.2d 905, 141 USPQ 585 (CCPA 1964) (an applicant is entitled to know whether the claims are being rejected under [35 U.S.C. 101](#), [102](#), [103](#), or [112](#)); *In re Collier*, 397 F.2d 1003, 1006, 158 USPQ 266, 268 (CCPA 1968) (“[A] rejection for ‘aggregation’ is non-statutory.”).

If a claim omits essential matter or fails to interrelate essential elements of the invention as defined by applicant(s) in the specification, see [MPEP § 2172.01](#).

### **2173.05(l) [Reserved]**

### **2173.05(m) Prolix [R-08.2012]**

Examiners should reject claims as prolix only when they contain such long recitations or unimportant details that the scope of the claimed invention is rendered indefinite thereby. Claims are rejected as prolix when they contain long recitations that the metes and bounds of the claimed subject matter cannot be determined.

### **2173.05(n) Multiplicity [R-11.2013]**

*37 CFR 1.75 Claim(s).*

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

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Where, in view of the nature and scope of applicant’s invention, applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, may be appropriate. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), “applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case.” See also *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969). Undue multiplicity rejections based on [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, should be applied judiciously and should be rare.

If an undue multiplicity rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is appropriate, the examiner should contact applicant by telephone explaining that the claims are unduly multiplied and will be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. Note [MPEP § 408](#). The examiner should also request that applicant select a specified number of claims for purpose of examination. If applicant is willing to select, by telephone, the claims for examination, an undue multiplicity rejection on all the claims based on [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, should be made in the next Office action along with an action on the merits on the selected claims. If applicant refuses to comply with the telephone request, an undue multiplicity rejection of all the claims based on [35 U.S.C. 112\(b\)](#)



or [pre-AIA 35 U.S.C. 112](#), second paragraph, should be made in the next Office action. Applicant's reply must include a selection of claims for purpose of examination, the number of which may not be greater than the number specified by the examiner. In response to applicant's reply, if the examiner adheres to the undue multiplicity rejection, it should be repeated and the selected claims will be examined on the merits. This procedure preserves applicant's right to have the rejection on undue multiplicity reviewed by the Patent Trial and Appeal Board.

Also, it is possible to reject one claim over an allowed claim if they differ only by subject matter old in the art. This ground of rejection is set forth in *Ex parte Whitelaw*, 1915 C.D. 18, 219 O.G. 1237 (Comm'r Pat. 1914). The *Ex parte Whitelaw* doctrine is restricted to cases where the claims are unduly multiplied or are substantial duplicates. *Ex parte Kochan*, 131 USPQ 204, 206 (Bd. App. 1961).

### **2173.05(o) Double Inclusion [R-08.2012]**

There is no *per se* rule that "double inclusion" is improper in a claim. *In re Kelly*, 305 F.2d 909, 916, 134 USPQ 397, 402 (CCPA 1962) ("Automatic reliance upon a 'rule against double inclusion' will lead to as many unreasonable interpretations as will automatic reliance upon a 'rule allowing double inclusion'. The governing consideration is not *double inclusion*, but rather is what is a reasonable construction of the language of the claims."). Older cases, such as *Ex parte White*, 127 USPQ 261 (Bd. App. 1958) and *Ex parte Clark*, 174 USPQ 40 (Bd. App. 1971) should be applied with care, according to the facts of each case.

The facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim gives rise to indefiniteness in that claim. The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not lead to any uncertainty as to the scope of that claim for either examination or infringement purposes. On the other hand, where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

### **2173.05(p) Claim Directed to Product-By-Process or Product and Process [R-07.2022]**

There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention.

#### **I. PRODUCT-BY-PROCESS**

A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *Purdue Pharma v. Epic Pharma*, 811 F.3d 1345, 1354, 117 USPQ2d 1733, 1739 (Fed. Cir. 2016); *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, so long as it is clear that the claim is directed to the product and not the process.

An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 141 (Bd. App. 1972).

#### **II. PRODUCT AND PROCESS IN THE SAME CLAIM**

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1318, 97 USPQ2d 1737, 1748-49 (Fed. Cir. 2011). In *Katz*, a claim directed to "[a] system with an interface means for providing automated voice messages...to certain of said individual callers, *wherein said certain of said individual callers digitally enter data*" was determined to be indefinite because the italicized claim limitation is not directed to the system, but rather to actions of the individual callers, which creates confusion as to when direct infringement occurs. *Katz*, 639 F.3d at 1318, 97 USPQ2d at 1749 (citing *IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377, 1384, 77 USPQ2d

1140, 1145 (Fed. Cir. 2005), in which a system claim that recited “an input means” and required a user to use the input means was found to be indefinite because it was unclear “whether infringement ... occurs when one creates a system that allows the user [to use the input means], or whether infringement occurs when the user actually uses the input means.”); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) (claim directed to an automatic transmission workstand and the method of using it held ambiguous and properly rejected under [35 U.S.C. 112](#), second paragraph).

In contrast, when a claim recites a product and additional limitations which focus on the capabilities of the system, not the specific actions or functions performed by the user, the claim may be definite under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *Mastermine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307, 124 USPQ2d 1618 (Fed. Cir. 2017).

### 2173.05(q) “Use” Claims [R-10.2019]

Attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. For example, a claim which read: “[a] process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon” was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

“Use” claims that do not purport to claim a process, machine, manufacture, or composition of matter fail to comply with [35 U.S.C. 101](#). *In re Moreton*, 288 F.2d 708, 709, 129 USPQ 227, 228 (CCPA 1961) (“one cannot claim a new use *per se*, because it is not among the categories of patentable inventions specified in [35 U.S.C. § 101](#)”). In *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: “The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction.” In *Clinical Products Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C.

1966), the district court held the following claim was definite, but that it was not a proper process claim under [35 U.S.C. 101](#): “The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid.”

Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

#### I. A “USE” CLAIM MAY BE REJECTED UNDER 35 U.S.C 101 AND/OR 112

It is appropriate to reject a claim that recites a use but fails to recite steps under [35 U.S.C. 101](#) and [35 U.S.C. 112\(b\)](#) if the facts support both rejections. For failure to recite a claim within one of the statutory classes under [35 U.S.C. 101](#), the appropriate form paragraph is 7.05.01. For indefiniteness under [35 U.S.C. 112\(b\)](#), the appropriate form paragraph is 7.34.01.

#### II. BOARD HELD STEP OF “UTILIZING” WAS NOT INDEFINITE

It is often difficult to draw a fine line between what is permissible, and what is objectionable from the perspective of whether a claim is definite. In the case of *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992), the Board held that a claim which clearly recited the step of “utilizing” was not indefinite under [35 U.S.C. 112](#), second paragraph. (Claim was to “A method for unloading nonpacked, nonbridging and packed, bridging flowable particle catalyst and bead material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 7.”).

### 2173.05(r) Omnibus Claim [R-10.2019]

Some applications are filed with an omnibus claim which reads as follows: A device substantially as shown and described. This claim should be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#),

second paragraph, because it is indefinite in that it fails to point out what is included or excluded by the claim language. See *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993), for a discussion of the history of omnibus claims and an explanation of why omnibus claims do not comply with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

Such a claim can be rejected using form paragraph 7.35. See [MPEP § 2175](#).

### **2173.05(s) Reference to Figures or Tables [R-10.2019]**

Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table “is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant’s convenience.” *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. Generally, the presence or absence of such reference characters does not affect the scope of a claim. See [MPEP § 608.01\(m\)](#) for information pertaining to the treatment of reference characters in a claim.

### **2173.05(t) Chemical Formula [R-11.2013]**

Claims to chemical compounds and compositions containing chemical compounds often use formulas that depict the chemical structure of the compound. These structures should not be considered indefinite nor speculative in the absence of evidence that the assigned formula is in error. The absence of corroborating spectroscopic or other data cannot be the basis for finding the structure indefinite. See *Ex parte Morton*, 134 USPQ 407 (Bd. App. 1961), and *Ex parte Sobin*, 139 USPQ 528 (Bd. App. 1962).

A claim to a chemical compound is not indefinite merely because a structure is not presented or because a partial structure is presented. For example, the claim language at issue in *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) referred to a chemical compound as a “polypeptide of at least 24 amino acids having the following sequence.” A rejection under [pre-AIA 35 U.S.C. 112](#), second paragraph, for failure to identify the entire structure was reversed and the court held: “While the absence of such a limitation obviously broadens the claim and raises questions of sufficiency of disclosure, it does not render the claim indefinite.” Chemical compounds may be claimed by a name that adequately describes the material to one skilled in the art. See *Martin v. Johnson*, 454 F.2d 746, 172 USPQ 391 (CCPA 1972). A compound of unknown structure may be claimed by a combination of physical and chemical characteristics. See *Ex parte Brian*, 118 USPQ 242 (Bd. App. 1958). A compound may also be claimed in terms of the process by which it is made without raising an issue of indefiniteness.

### **2173.05(u) Trademarks or Trade Names in a Claim [R-07.2022]**

The presence of a trademark or trade name in a claim is not, *per se*, improper under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim. It is important to recognize that a trademark or trade name is used to identify a source of goods, and is not the name of the goods themselves. Thus a trademark or trade name does not define or describe the goods associated with the trademark or trade name. See definitions of trademark and trade name in [MPEP § 608.01\(v\)](#).

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). See also *Eli Lilly & Co. v. Apotex, Inc.*, 837 Fed. Appx. 780, 784-85, 2020 USPQ2d 11531 (Fed. Cir. 2020) (“Following Patent Office procedure, the Examiner in this case rejected the claims of the ‘821 application as

indefinite because they improperly used the trade name 'ALIMTA.' In response to the rejection, Lilly canceled its claims reciting the trade name and pursued claims using the generic name for the same substance, which mooted the rejection. Additionally, as the district court observed, the Examiner 'explicitly noted that pemetrexed disodium was 'also known by the trade name ALIMTA' ' in the contemporaneous obviousness rejection."'). The claim scope is uncertain since the trademark or trade name cannot be used properly to describe any particular material or product. In fact, the value of a trademark would be lost to the extent that it became the generic name of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. If the applicant responds to such a rejection by replacing the trademark or trade name with a generic term, the examiner should determine whether there is sufficient support in the application for use of a generic term. See [MPEP § 2163](#), subsection II.A.3(b).

If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. If its presence in the claim causes confusion as to the scope of the claim, then the claim should be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

### **2173.05(v) Mere Function of Machine [R-11.2013]**

Process or method claims are not subject to rejection by U.S. Patent and Trademark Office examiners under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, solely on the ground that they define the inherent function of a disclosed machine or apparatus. *In re Tarczy-Hornoch*, 397 F.2d 856, 158 USPQ 141 (CCPA 1968). The court in *Tarczy-Hornoch* held that a process claim, otherwise patentable, should not be rejected merely because the application of which it is a part discloses an apparatus which will inherently carry out the recited steps.

### **2173.06 Practice Compact Prosecution [R-07.2022]**

#### **I. INTERPRET THE CLAIM AND APPLY ART WITH AN EXPLANATION OF HOW AN INDEFINITE TERM IS INTERPRETED**

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the chance to provide evidence of patentability and otherwise reply completely at the earliest opportunity. See [MPEP § 706](#). Under the principles of compact prosecution, the examiner should review each claim for compliance with every statutory requirement for patentability in the initial review of the application and identify all of the applicable grounds of rejection in the first Office action to avoid unnecessary delays in the prosecution of the application. See [37 CFR 1.104\(a\)\(1\)](#) ("On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.").

Thus, when the examiner determines that a claim term or phrase renders the claim indefinite, the examiner should make a rejection based on indefiniteness under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as well as a rejection(s) in view of the prior art under [35 U.S.C. 102](#) or [103](#) that renders the prior art applicable based on the examiner's interpretation of the claim. See *In re Packard*, 751 F.3d 1307, 1312, 110 USPQ2d 1785, 1788 (Fed. Cir. 2014) (stating that the *prima facie* case is appropriately used for making an indefiniteness rejection). When making a rejection over prior art in these circumstances, it is important that the **examiner state on the record how the claim term or phrase is being interpreted** with respect to the prior art applied in the rejection. By rejecting each claim on all reasonable grounds available, the examiner can avoid piecemeal examination. See [MPEP § 707.07\(g\)](#) ("Piecemeal



examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available . . . .”).

## II. PRIOR ART REJECTION OF CLAIM REJECTED AS INDEFINITE

All words in a claim must be considered in judging the patentability of a claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). The fact that terms may be indefinite does not make the claim obvious over the prior art. When the terms of a claim are considered to be indefinite, at least two approaches to the examination of an indefinite claim relative to the prior art are possible.

First, where the degree of uncertainty is not great, and where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, an appropriate course of action would be for the examiner to enter two rejections: (A) a rejection based on indefiniteness under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph; and (B) a rejection over the prior art based on the interpretation of the claims which renders the prior art applicable. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). When making a rejection over prior art in these circumstances, it is important for the examiner to point out how the claim is being interpreted. Second, where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under [35 U.S.C. 103](#) should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

The first approach is recommended from an examination standpoint because it avoids piecemeal examination in the event that the examiner's [35 U.S.C. 112](#), second paragraph rejection is not affirmed, and may give applicant a better appreciation for relevant prior art if the claims are redrafted to avoid the [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph rejection.

## 2174 Relationship Between the Requirements of 35 U.S.C. 112(a) and (b) or Pre-AIA 35 U.S.C. 112, First and Second Paragraphs [R-11.2013]

The requirements of [35 U.S.C. 112\(a\)](#) and [\(b\)](#) or the first and second paragraphs of [pre-AIA 35 U.S.C. 112](#) are separate and distinct. If a description or the enabling disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact alone does not render the claim imprecise or indefinite or otherwise not in compliance with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph; rather, the claim is based on an insufficient disclosure ([35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph) and should be rejected on that ground. *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). If the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In *Mayhew*, the examiner argued that the only mode of operation of the process disclosed in the specification involved the use of a cooling zone at a particular location in the processing cycle. The claims were rejected because they failed to specify either a cooling step or the location of the step in the process. The court was convinced that the cooling bath and its location were essential, and held that claims which failed to recite the use of a cooling zone, specifically located, were not supported by an enabling disclosure ([35 U.S.C. 112](#), first paragraph).

In addition, if a claim is amended to include an invention that is not described in the application as filed, a rejection of that claim under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as being directed to subject matter that is not described in the specification as filed may be appropriate. *In re Simon*, 302 F.2d 737, 133 USPQ 524 (CCPA 1962). In *Simon*, which involved a reissue application containing claims to a reaction product of a composition, applicant presented claims to a reaction product of a composition comprising the subcombination A+B+C, whereas the original claims

and description of the invention were directed to a composition comprising the combination A+B+C+D+E. The court found no significant support for the argument that ingredients D+E were not essential to the claimed reaction product and concluded that claims directed to the reaction product of a subcombination A+B+C were not described ([35 U.S.C. 112](#), first paragraph) in the application as filed. See also *In re Panagrossi*, 277 F.2d 181, 125 USPQ 410 (CCPA 1960).

## 2175 Form Paragraphs for Use in Rejections Under 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph [R-01.2024]

Rejections under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112, second paragraph](#), are discussed in [MPEP §§ 2171 - 2174](#) and [2181](#), subsection II. Form paragraphs 7.30.02, 7.34 through 7.34.05, 7.34.07 through 7.34.10, 7.34.12 through 7.34.15, 7.35, and 7.35.01 should be used to make rejections under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112, second paragraph](#).

### ¶ 7.30.02 Statement of Statutory Basis, 35 U.S.C. 112(b) and pre-AIA 35 U.S.C. 112, Second Paragraph

The following is a quotation of [35 U.S.C. 112\(b\)](#):

(B) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of [pre-AIA 35 U.S.C. 112](#), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

#### Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.

2. Paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

### ¶ 7.34 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph, Failure To Claim Inventor's Invention

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as failing to set forth the subject matter

which the inventor or a joint inventor, or for applications subject to [pre-AIA 35 U.S.C. 112](#) the applicant, regards as the invention. Evidence that claim [2] fail(s) to correspond in scope with that which the inventor or a joint inventor, or for pre-AIA applications the applicant, regards as the invention can be found in the reply filed [3]. In that paper, the inventor or a joint inventor, or for pre-AIA applications the applicant, has stated [4], and this statement indicates that the invention is different from what is defined in the claim(s) because [5].

#### Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. This paragraph is to be used only where inventor or applicant has stated, somewhere other than in the application, as filed, that the invention is something different from what is defined in the claim(s).

3. In bracket 3, identify the submission by inventor or applicant (which is not the application, as filed, but may be in the remarks by applicant, in the brief, in an affidavit, etc.) by the date the paper was filed in the USPTO.

4. In bracket 4, set forth what inventor or applicant has stated in the submission to indicate a different invention.

5. In bracket 5, explain how the statement indicates an invention other than what is being claimed.

### ¶ 7.34.01 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor (or for applications subject to [pre-AIA 35 U.S.C. 112](#), the applicant), regards as the invention.

#### Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. In bracket 1, pluralize "Claim" if necessary, insert claim number(s), and insert --is-- or --are-- as appropriate. Any claim dependent on a listed rejected claim should be reviewed to determine if the dependent claim should be rejected as indefinite for the same reason(s) as the listed rejected claim(s), and if so, the dependent claim(s) should be added to the listed rejected claim(s).

3. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.10, and/or 7.34.23 - 7.34.24 as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See [MPEP §§ 2171 - 2174](#) for guidance. See also form paragraph 7.34.15 for *pro se* applicants.

### ¶ 7.34.02 Terminology Used Inconsistent with Accepted Meaning

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “[1]” in claim [2] is used by the claim to mean “[3],” while the accepted meaning is “[4].” The term is indefinite because the specification does not clearly redefine the term.

#### Examiner Note:

1. In bracket 3, point out the meaning that is assigned to the term by applicant’s claims, taking into account the entire disclosure.
2. In bracket 4, point out the accepted meaning of the term. Support for the examiner’s stated accepted meaning should be provided through the citation of an appropriate reference source, e.g., textbook or dictionary. See [MPEP § 2173.05\(a\)](#).
3. This paragraph must be preceded by form paragraph 7.34.01.
4. This paragraph should only be used where the specification does not clearly redefine the claim term at issue.

### ¶ 7.34.03 Relative Term - Term of Degree Rendering Claim Indefinite

The term “[1]” in claim [2] is a relative term which renders the claim indefinite. The term “[1]” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. [3]

#### Examiner Note:

1. In bracket 3, explain which parameter, quantity, or other limitation in the claim has been rendered indefinite by the use of the term appearing in bracket 1.
2. This form paragraph must be preceded by form paragraph 7.34.01.

### ¶ 7.34.04 Broader Range/Limitation And Narrow Range/Limitation in Same Claim

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) may be considered indefinite if the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See [MPEP § 2173.05\(c\)](#). In the present instance, claim [1] recites the broad recitation [2], and the claim also recites [3] which is the narrower statement of the range/limitation. The claim(s) are considered indefinite because there is a question or doubt as to whether the feature introduced by such narrower language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims.

#### Examiner Note:

1. In bracket 2, insert the broader range/limitation and where it appears in the claim; in bracket 3, insert the narrow range/limitation and where it appears. This form paragraph may be modified to fit other instances of indefiniteness in the claims.
2. This form paragraph must be preceded by form paragraph 7.34.01.

### ¶ 7.34.05 Lack of Antecedent Basis in the Claims

Claim [1] recites the limitation [2] in [3]. There is insufficient antecedent basis for this limitation in the claim.

#### Examiner Note:

1. In bracket 2, insert the limitation which lacks antecedent basis, for example --said lever-- or --the lever--.
2. In bracket 3, identify where in the claim(s) the limitation appears, for example, --line 3--, --the 3<sup>rd</sup> paragraph of the claim--, --the last 2 lines of the claim--, etc.
3. This form paragraph should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate. It must be preceded by form paragraph 7.34.01.

### ¶ 7.34.07 Claims Are a Literal Translation

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

#### Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

### ¶ 7.34.08 Indefinite Claim Language: “For Example”

Regarding claim [1], the phrase “for example” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See [MPEP § 2173.05\(d\)](#).

#### Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

### ¶ 7.34.09 Indefinite Claim Language: “Or The Like”

Regarding claim [1], the phrase “or the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable. See [MPEP § 2173.05\(d\)](#).

#### Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

**¶ 7.34.10 Indefinite Claim Language: “Such As”**

Regarding claim [1], the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See [MPEP § 2173.05\(d\)](#).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.34.01.

**¶ 7.34.12 Essential Steps Omitted**

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See [MPEP § 2172.01](#). The omitted steps are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the steps omitted from the claims.
3. Give the rationale for considering the omitted steps critical or essential. The rationale must explain the basis for concluding that the inventor regards the omitted matter to be essential to the invention.

**¶ 7.34.13 Essential Elements Omitted**

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See [MPEP § 2172.01](#). The omitted elements are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the elements omitted from the claims.
3. Give the rationale for considering the omitted elements critical or essential. The rationale must explain the basis for concluding that the inventor regards the omitted matter to be essential to the invention.

**¶ 7.34.14 Essential Cooperative Relationships Omitted**

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See [MPEP § 2172.01](#). The omitted structural cooperative relationships are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the structural cooperative relationships of elements omitted from the claims.
3. Give the rationale for considering the omitted structural cooperative relationships of elements being critical or essential.

**¶ 7.34.15 Rejection Under 35 U.S.C. 112, Pro Se**

Claim [1] rejected as failing to define the invention in the manner required by [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

The claim(s) are narrative in form and replete with indefinite language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

**¶ 7.35 Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim - Omnibus Claim**

Claim [1] rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. Use this paragraph to reject an “omnibus” type claim. No further explanation is necessary.
3. An example of an omnibus claim is: “A device substantially as shown and described.”

**¶ 7.35.01 Trademark or Trade Name as a Limitation in the Claim**

Claim [1] contains the trademark/trade name [2]. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe [3] and, accordingly, the identification/description is indefinite.

**Examiner Note:**

1. In bracket 2, insert the trademark/trade name and where it is used in the claim.
2. In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.



**2176-2180 [Reserved]****2181 Identifying and Interpreting a 35 U.S.C. 112(f) or Pre-AIA 35 U.S.C. 112, Sixth Paragraph Limitation [R-07.2022]**

This section sets forth guidelines for the examination of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, “means or step plus function” limitations in a claim. Throughout this section, reference is made to [35 U.S.C. 112\(f\)](#), however the guidance is equally applicable to [pre-AIA 35 U.S.C. 112](#), sixth paragraph.

The Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), stated:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

In *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349, 115 USPQ2d 1105, 1111 (Fed. Cir. 2015) the court stated:

[t]he standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.

Therefore, the broadest reasonable interpretation of a claim limitation that invokes [35 U.S.C. 112\(f\)](#) is the structure, material or act described in the specification as performing the entire claimed function and equivalents to the disclosed structure, material or act. As a result, [section 112\(f\)](#) limitations will, in some cases, be afforded a more narrow interpretation than a limitation that is not crafted in “means plus function” format. Structural elements may appear in both product claims and process

claims; thus, all claim types should be reviewed for the presence of “means-plus-function” limitations. *Rain Computing, Inc. v. Samsung Elecs. Am. Inc.*, 989 F.3d 1002, 1006, 2021 USPQ2d 284, (Fed. Cir. 2021) (“Applicants are free to invoke [§ 112 ¶ 6](#) for a claim term nested in a method claim. We have never held otherwise.”). See also *Media Rights Technologies, Inc. v. Capital One Financial Corp.*, 800 F.3d 1366, 1374, 116 USPQ2d 1144 (Fed. Cir. 2015) (holding that the term “compliance mechanism” in a method claim was a means-plus-function term).

**I. DETERMINING WHETHER A CLAIM LIMITATION INVOKES 35 U.S.C. 112(f) or PRE-AIA 35 U.S.C. 112, SIXTH PARAGRAPH**

The USPTO must apply [35 U.S.C. 112\(f\)](#) in appropriate cases, and give claims their broadest reasonable interpretation (BRI), in light of and consistent with the written description of the invention in the application. In determining the BRI, examiners should establish the meaning of each claim term consistent with the specification as it would be interpreted by one of ordinary skill in the art, including identifying and construing functional claim limitations. If a claim limitation recites a term and associated functional language, the examiner should determine whether the claim limitation invokes [35 U.S.C. 112\(f\)](#). Application of [35 U.S.C. 112\(f\)](#) is driven by the claim language, not by applicant’s intent or mere statements to the contrary included in the specification or made during prosecution. See *In re Donaldson Co.*, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that [35 U.S.C. 112](#), sixth paragraph “merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation”). The Federal Circuit has held that applicants (and reexamination patentees) before the USPTO have the opportunity and the obligation to define their inventions precisely during proceedings before the USPTO. See *In re Morris*, 127 F.3d 1048, 1056–57, 44 USPQ2d 1023, 1029–30 (Fed. Cir. 1997) ([35 U.S.C. 112](#), second paragraph places the burden of precise claim drafting on the applicant); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during

prosecution of a pending application before the USPTO); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (patentee who had a clear opportunity to negotiate broader claims during prosecution but did not do so, may not seek to expand the claims through the doctrine of equivalents, for it is the patentee, not the public, who must bear the cost of failure to seek protection for this foreseeable alteration of its claimed structure).

A claim limitation is presumed to invoke [35 U.S.C. 112\(f\)](#) when it explicitly uses the term “means” or “step” and includes functional language. The presumption that [35 U.S.C. 112\(f\)](#) applies is overcome when the limitation further includes the structure, material or acts necessary to perform the recited function. See *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259-60, 85 USPQ2d 1787, 1789 (Fed. Cir. 2008) (“Sufficient structure exists when the claim language specifies the exact structure that performs the function in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.”); see also *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376, 65 USPQ2d 1865, 1874 (Fed. Cir. 2003).

By contrast, a claim limitation that does not use the term “means” or “step” will trigger the rebuttable presumption that [35 U.S.C. 112\(f\)](#) does not apply. See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1310, 75 USPQ2d 1321, 1324 (Fed. Cir. 2005) (*en banc*); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369, 62 USPQ2d 1658, 1664 (Fed. Cir. 2002); *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 703-04, 48 USPQ2d 1880, 1886–87 (Fed. Cir. 1998). Even in the face of this presumption, the examiner should nonetheless consider whether the presumption is overcome. The presumption that [35 U.S.C. 112\(f\)](#) does not apply to a claim limitation that does not use the term “means” is overcome when “the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Williamson*, 792 F.3d at 1349, 115 USPQ2d at 1111 (Fed. Cir. 2015) (*en banc*) (quoting *Watts v. XL Systems, Inc.*, 232 F.3d 877, 880, 56 USPQ2d 1836, 1838 (Fed. Cir. 2000)); see also *Personalized Media Communications, LLC*

*v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998).

Instead of using “means” in such cases, a substitute term acts as a generic placeholder for the term “means” and would not be recognized by one of ordinary skill in the art as being sufficiently definite structure for performing the claimed function. “The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Williamson*, 792 F.3d at 1349, 115 USPQ2d at 1111; see also *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996).

Accordingly, examiners will apply [35 U.S.C. 112\(f\)](#) to a claim limitation if it meets the following 3-prong analysis:

(A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;

(B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and

(C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

A determination that a claim is being interpreted according to [35 U.S.C. 112\(f\)](#) should be expressly stated in the examiner’s Office action. If a claim limitation uses the term “means” or “step,” but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office action explaining the reasons why a claim limitation which uses the term “means” or “step” is not being treated under [35 U.S.C. 112\(f\)](#).

In response to the Office action that finds that [35 U.S.C. 112\(f\)](#) is invoked, if applicant does not want

to have the claim limitation interpreted under [35 U.S.C. 112\(f\)](#), applicant may: (1) present a sufficient showing to establish that the claim limitation recites sufficient structure to perform the claimed function so as to avoid interpretation under [35 U.S.C. 112\(f\)](#); or (2) amend the claim limitation in a way that avoids interpretation under [35 U.S.C. 112\(f\)](#) (e.g., by reciting sufficient structure to perform the claimed function).

In the event that it is unclear whether the claim limitation falls within the scope of [35 U.S.C. 112\(f\)](#), a rejection under [35 U.S.C. 112\(b\)](#) may be appropriate.

**A. The Claim Limitation Uses the Term “Means” or “Step” or a Generic Placeholder (A Term That Is Simply A Substitute for “Means”)**

With respect to the first prong of this analysis, a claim element that does not include the term “means” or “step” triggers a rebuttable presumption that [35 U.S.C. 112\(f\)](#) does not apply. When the claim limitation does not use the term “means,” examiners should determine whether the presumption that [35 U.S.C. 112\(f\)](#) does not apply is overcome. The presumption may be overcome if the claim limitation uses a generic placeholder (a term that is simply a substitute for the term “means”). The following is a list of non-structural generic placeholders that may invoke [35 U.S.C. 112\(f\)](#): **“mechanism for,” “module for,” “device for,” “unit for,” “component for,” “element for,” “member for,” “apparatus for,” “machine for,” or “system for.”** *Welker Bearing Co., v. PHD, Inc.*, 550 F.3d 1090, 1096, 89 USPQ2d 1289, 1293-94 (Fed. Cir. 2008); *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1354, 80 USPQ2d 1225, 1228 (Fed. Cir. 2006); *Personalized Media*, 161 F.3d at 704, 48 USPQ2d at 1886-87; *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1214-1215, 48 USPQ2d 1010, 1017 (Fed. Cir. 1998). Note that there is no fixed list of generic placeholders that always result in [35 U.S.C. 112\(f\)](#) interpretation, and likewise there is no fixed list of words that always avoid [35 U.S.C. 112\(f\)](#) interpretation. Every case will turn on its own unique set of facts.

"The standard is whether the words of the claim are understood by persons of ordinary skill in the art to

have a sufficiently definite meaning as the name for structure." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349, 115 USPQ2d 1105, 1111 (Fed. Cir. 2015). The issue in *Williamson* was whether a “distributed learning control module” limitation in claims directed to a distributed learning system should be interpreted as a means-plus-function limitation. See *Williamson*, 792 F.3d at 1347, 115 USPQ2d at 1110. The Federal Circuit concluded that “the ‘distributed learning control module’ limitation fails to recite sufficiently definite structure and that the presumption against means-plus function claiming is rebutted.” *Id.* at 1351, 115 USPQ2d at 1113. In support, the Federal Circuit determined that “the word ‘module’ does not provide any indication of structure because it sets forth the same black box recitation of structure for providing the same specified function as if the term ‘means’ had been used.” *Id.* at 1350-51, 115 USPQ2d at 1112.

If persons of ordinary skill in the art reading the specification understand the term to have a sufficiently definite meaning as the name for the structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function (e.g., “filters,” “brakes,” “clamp,” “screwdriver,” and “locks”) [35 U.S.C. 112\(f\)](#) will not apply. *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1372-73, 66 USPQ2d 1444, 1451-52 (Fed. Cir. 2003); *CCS Fitness*, 288 F.3d at 1369, 62 USPQ2d at 1664; *Watts v. XL Sys. Inc.*, 232 F.3d 877, 880-81, 56 USPQ2d 1836, 1839 (Fed. Cir. 2000); *Personalized Media*, 161 F.3d at 704, 48 USPQ2d at 1888; *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996) (“Many devices take their names from the functions they perform.”). Similarly, the terms “code” and “application” have been found not to be generic placeholders where persons of ordinary skill in the art would understand the terms in combination with the function performed by the code or application as connoting structure.

*Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 1368-69, 2022 USPQ2d 288 (Fed. Cir. 2022); see also *Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1008-1009, 126 USPQ2d 1765 (Fed. Cir. 2018) (finding that “a person of ordinary skill in the art could reasonably discern from the claim language that the words ‘program’ ... and ‘user interface code’ ... are used not as generic terms or black box

recitations of structure or abstractions....”). The term is not required to denote a specific structure or a precise physical structure to avoid the application of [35 U.S.C. 112\(f\)](#). See *Watts*, 232 F.3d at 880, 56 USPQ2d at 1838; *Inventio AG v. Thyssenkrupp Elevator Americas Corp.*, 649 F.3d 1350, 99 USPQ2d 1112 (Fed. Cir. 2011) (holding that the claim terms “modernizing device” and “computing unit” when read in light of the specification connoted sufficient, definite structure to one of skill in the art to preclude application of [35 U.S.C. 112](#), sixth paragraph). The following are examples of structural terms that have been found **not** to invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), paragraph 6: “circuit,” “detent mechanism,” “digital detector,” “reciprocating member,” “connector assembly,” “perforation,” “sealingly connected joints,” and “eyeglass hanger member.” See *Mass. Inst. of Tech.*, 462 F.3d at 1355-1356, 80 USPQ2d at 1332 (the court found the recitation of “aesthetic correction circuitry” sufficient to avoid [pre-AIA 35 U.S.C. 112](#), paragraph 6, treatment because the term circuit, combined with a description of the function of the circuit, connoted sufficient structure to one of ordinary skill in the art.); *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1321, 72 USPQ2d 1065, 1071 (Fed. Cir. 2004); *Apex*, 325 F.3d at 1373, 66 USPQ2d at 1452; *Greenberg*, 91 F.3d at 1583-84, 39 USPQ2d at 1786; *Personalized Media*, 161 F.3d at 704-05, 39 USPQ2d at 1786; *CCS Fitness*, 288 F.3d at 1369-70, 62 USPQ2d at 1664-65; *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996); *Watts*, 232 F.3d at 881, 56 USPQ2d at 1839; *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1318-19, 50 USPQ2d 1161, 1166-67 (Fed. Cir. 1999).

For a term to be considered a substitute for “means,” and lack sufficient structure for performing the function, it must serve as a generic placeholder and thus not limit the scope of the claim to any specific manner or structure for performing the claimed function. It is important to remember that there are no absolutes in the determination of terms used as a substitute for “means” that serve as generic placeholders. The examiner must carefully consider the term in light of the specification and the commonly accepted meaning in the technological art. Every application will turn on its own facts.

If the examiner has not interpreted a claim limitation as invoking [35 U.S.C. 112\(f\)](#) and an applicant wishes to have the claim limitation treated under [35 U.S.C. 112\(f\)](#) applicant must either: (A) amend the claim to include the phrase “means” or “step”; or (B) rebut the presumption that [35 U.S.C. 112\(f\)](#) does not apply by showing that the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts to perform that function. See *Watts*, 232 F.3d at 881, 56 USPQ2d at 1839 (Fed. Cir. 2000) (Claim limitations were held not to invoke [35 U.S.C. 112](#), sixth paragraph, because the absence of the term “means” raised the presumption that the limitations were not in means-plus-function form and the applicant did not rebut that presumption.); see also *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002) (“[W]here a method claim does not contain the term ‘step[s] for,’ a limitation of that claim cannot be construed as a step-plus-function limitation without a showing that the limitation contains no act.”).

Some of the following examples illustrate situations where the term “means” or “step” was not used but either the Board or courts nevertheless determined that the claim limitation fell within the scope of [35 U.S.C. 112\(f\)](#). Note that the examples are fact specific and should not be applied as *per se* rules. See *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356, 50 USPQ2d 1372, 1374-75 (Fed. Cir. 1999) (“ink delivery means positioned on ...” invokes [35 U.S.C. 112](#), sixth paragraph since the phrase “ink delivery means” is equivalent to “means for ink delivery”); *Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Rader, J., concurring) (“Claim elements without express step-plus-function language may nevertheless fall within [Section 112](#), Para. 6 if they merely claim the underlying function without recitation of acts for performing that function.... In general terms, the ‘underlying function’ of a method claim element corresponds to *what* that element ultimately accomplishes in relationship to what the other elements of the claim and the claim as a whole accomplish. ‘Acts,’ on the other hand, correspond to *how* the function is accomplished.... If the claim element uses the phrase ‘step for,’ then [Section 112](#), Para. 6 is presumed to apply.... On the other hand,



the term ‘step’ alone and the phrase ‘steps of’ tend to show that [Section 112](#), Para. 6 does not govern that limitation.”); *Personalized Media*, 161 F.3d at 703–04, 48 USPQ2d at 1886–87 (Fed. Cir. 1998); *Mas-Hamilton*, 156 F.3d at 1213, 48 USPQ2d at 1016 (Fed. Cir. 1998) (“lever moving element for moving the lever” and “movable link member for holding the lever...and for releasing the lever” were construed as means-plus-function limitations invoking [35 U.S.C. 112](#), sixth paragraph since the claimed limitations were described in terms of their function rather than their mechanical structure); *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1463, 45 USPQ2d 1545, 1550 (Fed. Cir. 1998) (“use of the word ‘means’ gives rise to a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses”) (quotation omitted). However, compare *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1317–19, 50 USPQ2d 1161, 1166–67 (Fed. Cir. 1999) (holding that although the claim elements “eyeglass hanger member” and “eyeglass contacting member” include a function, these claim elements do not invoke [35 U.S.C. 112](#), sixth paragraph because the claims themselves contain sufficient structural limitations for performing these functions); *O.I. Corp. v. Tekmar*, 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997) (method claim that paralleled means-plus-function apparatus claim but lacked “step for” language did not invoke [35 U.S.C. 112](#), sixth paragraph).

When applicant uses the term “means” or “step” in the preamble, a rejection under [35 U.S.C. 112\(b\)](#) may be appropriate when it is unclear whether the preamble is reciting a means- (or step-) plus-function limitation or whether the preamble is merely stating the intended use of the claimed invention. When applicant merely states an intended use of the claimed invention in the preamble (e.g., “A device for printing, comprising ...”), the examiner should not construe such language as reciting a means-plus-function limitation.

The examiner is reminded that, absent a determination that a claim limitation invokes [35 U.S.C. 112\(f\)](#), the broadest reasonable interpretation will not be limited to “corresponding structure... and equivalents thereof.” *Morris*, 127 F.3d at 1055, 44 USPQ2d at 1028 (“no comparable mandate in

the patent statute that relates the claim scope of non-§ 112 paragraph 6 claims to particular matter found in the specification”).

### ***B. The Term “Means” or “Step” or the Generic Placeholder Must Be Modified By Functional Language***

With respect to the second prong of this analysis, it must be clear that the element in the claims is set forth, at least in part, by the function it performs as opposed to the specific structure, material, or acts that perform the function. See *York Prod., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996) (holding that a claim limitation containing the term “means” does not invoke [pre-AIA 35 U.S.C. 112](#), sixth paragraph, if the claim limitation does not link the term “means” to a specific function); *Caterpillar Inc. v. Detroit Diesel Corp.*, 961 F.Supp. 1249, 1255, 41 USPQ2d 1876, 1882 (N.D. Ind. 1996) (stating that [pre-AIA 35 U.S.C. 112](#), sixth paragraph, “applies to functional method claims where the element at issue sets forth a step for reaching a particular result, but not the specific technique or procedure used to achieve the result.”); *O.I. Corp.*, 115 F.3d at 1582–83, 42 USPQ2d at 1782 (With respect to process claims, “[[pre-AIA 35 U.S.C. 112](#), sixth paragraph] is implicated only when steps *plus function* without acts are present.... If we were to construe every process claim containing steps described by an ‘ing’ verb, such as passing, heating, reacting, transferring, etc., into a step-plus-function, we would be limiting process claims in a manner never intended by Congress.” (emphasis in original)); see also *Baran v. Medical Device Techs., Inc.*, 616 F.3d 1309, 1317, 96 USPQ2d 1057, 1063 (Fed. Cir. 2010) (the claimed function may include the functional language that precedes the phrase “means for.”). However, “the fact that a particular mechanism...is defined in functional terms is not sufficient to convert a claim element containing that term into a ‘means for performing a specified function’ within the meaning of [section 112\(6\)](#).” *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1786 (Fed. Cir. 1996) (“detent mechanism” defined in functional terms was not intended to invoke [35 U.S.C. 112](#), sixth paragraph); see also *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166–67 (Fed. Cir. 1999) (although the claim

elements “eyeglass hanger member” and “eyeglass contacting member” include a function, these claim elements do not invoke [pre-AIA 35 U.S.C. 112](#), sixth paragraph, because the claims themselves contain sufficient structural limitations for performing those functions). Also, a statement of function appearing only in the claim preamble is generally insufficient to invoke [35 U.S.C. 112\(f\)](#). *O.I. Corp.*, 115 F.3d at 1583, 42 USPQ2d at 1782 (“[A] statement in a preamble of a result that necessarily follows from performing a series of steps does not convert each of those steps into step- plus-function clauses. The steps of ‘passing’ are not individually associated in the claims with functions performed by the steps of passing.”).

The mere use of the term “means” with no associated function rebuts the presumption that [35 U.S.C. 112\(f\)](#) is invoked. A function must be recited within the claim limitation, but it is not necessary that a particular format be used. Typically, the claim limitation will use the linking word “for” to associate “means” or a generic placeholder with the function. However, other linking words may be used, such as “so that” or “configured to”, provided it is clear that the claim element is reciting a function. In certain circumstances, it is also not necessary to use a linking word if other words used with “means”, or the generic placeholder, convey the function. Such words, however, cannot convey specific structure for performing the function or the phrase will not be treated as invoking [35 U.S.C. 112\(f\)](#). For example, “ink delivery means”, “module configured to deliver ink” and “means for ink delivery” could all be interpreted as claim elements that invoke [35 U.S.C. 112\(f\)](#). See *Signtech USA*, 174 F.3d at 1356, 50 USPQ2d at 1374-75.

***C. The Term “Means” or “Step” or the Generic Placeholder Must Not Be Modified By Sufficient Structure, Material, or Acts for Achieving the Specified Function***

With respect to the third prong of this analysis, the term “means” or “step” or the generic placeholder recited in the claim must not be modified by sufficiently definite structure, material, or acts for achieving the specified function. See *Seal-Flex*, 172 F.3d at 849, 50 USPQ2d at 1234 (Rader, J., concurring) (“Even when a claim element uses

language that generally falls under the step-plus-function format, however, [\[35 U.S.C.\] 112 ¶ 6](#) still does not apply when the claim limitation itself recites sufficient acts for performing the specified function.”); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 54 USPQ2d 1449 (Fed. Cir. 2000) (holding “second baffle means” does not invoke [35 U.S.C. 112](#), sixth paragraph, because the word “baffle” itself imparts structure and the claim further recites the structure of the baffle); *Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303–04, 50 USPQ2d 1429, 1435–36 (Fed. Cir. 1999) (holding “positioning means for moving” does not invoke [35 U.S.C. 112](#), sixth paragraph, because the claim further provides a list of the structure underlying the means and the detailed recitation of the structure for performing the moving function removes this element from the purview of [35 U.S.C. 112](#), sixth paragraph); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996) (holding “perforation means...for tearing” does not invoke [35 U.S.C. 112](#), sixth paragraph, because the claim describes the structure supporting the tearing function (i.e., perforation)). In other situations, the Federal Circuit has come to a different conclusion. See *Unidynamics Corp. v. Automatic Prod. Int’l*, 157 F.3d 1311, 1319, 48 USPQ2d 1099, 1104 (Fed. Cir. 1998) (holding that “spring means” invokes [35 U.S.C. 112](#), sixth paragraph).

Examiners will apply [35 U.S.C. 112\(f\)](#) to a claim limitation that uses the term “means” or generic placeholder associated with functional language, unless that term is (1) preceded by a structural modifier, defined in the specification as a particular structure or known by one skilled in the art, that denotes the type of structural device (e.g., “filters”), or (2) otherwise modified by sufficient structure or material for achieving the claimed function. Similarly, examiners will apply [35 U.S.C. 112\(f\)](#) to a claim limitation that uses the term “step for” unless that term is modified by sufficient acts for performing the claimed function.

A limitation will not invoke [35 U.S.C. 112\(f\)](#) if there is a structural modifier that further describes the term “means” or the generic placeholder. For example, although a generic placeholder like “mechanism” standing alone may invoke [35 U.S.C. 112\(f\)](#) when

coupled with a function, it will not invoke [35 U.S.C. 112\(f\)](#) when it is preceded by a structural modifier (e.g., “detent mechanism”). *Greenberg*, 91 F.3d at 1583, 39 USPQ2d at 1786 (holding that the term “detent mechanism” did not invoke [35 U.S.C. 112](#), sixth paragraph because the structural modifier “detent” denotes a type of structural device with a generally understood meaning in the mechanical arts). By contrast, a generic placeholder (e.g., “mechanism,” “element,” “member”) coupled with a function may invoke [35 U.S.C. 112\(f\)](#) when it is preceded by a non-structural modifier that does not have any generally understood structural meaning in the art (e.g., “colorant selection mechanism,” “lever moving element,” or “movable link member”). See *Massachusetts Inst. of Tech.*, 462 F.3d at 1354, 80 USPQ2d at 1231 (The claim recited use of a colorant selection mechanism, to which the court performed a means-plus-function analysis under [pre-AIA 35 U.S.C. 112](#), sixth paragraph. The court held that the term “colorant selection”, which modifies the generic term “mechanism”, was not defined in the specification, had no dictionary definition, nor any generally understood meaning in the art, the term does not connote sufficient structure to a person of ordinary skill in the art to avoid [pre-AIA 35 U.S.C. 112](#), sixth paragraph treatment.); *Mas-Hamilton*, 156 F.3d at 1214-1215, 48 USPQ2d at 1017; see also *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351, 115 USPQ2d 1105, 1113 (Fed. Cir. 2015) (determining that “[t]he prefix ‘distributed learning control’ does not impart any structural significance to the term [‘module’]”).

To determine whether a word, term, or phrase coupled with a function denotes structure, examiners may check whether: (1) the specification provides a description sufficient to inform one of ordinary skill in the art that the term denotes structure; (2) general and subject matter specific dictionaries provide evidence that the term has achieved recognition as a noun denoting structure; and/or (3) the prior art provides evidence that the term is an art-recognized structure to perform the claimed function. *Ex parte Rodriguez*, 92 USPQ2d 1395, 1404 (Bd. Pat. App. & Int. 2009) (precedential).

During examination, however, applicants have the opportunity and the obligation to define their inventions precisely, including whether a claim

limitation invokes [35 U.S.C. 112\(f\)](#). Thus, if the term “means” or “step” or a generic placeholder is modified by sufficient structure, material or acts for achieving the specified function, the USPTO will consider that presumption has been rebutted and will not apply [35 U.S.C. 112\(f\)](#) until such modifying language is deleted from the claim limitation.

It is necessary to decide on an element by element basis whether [35 U.S.C. 112\(f\)](#) applies. Not all terms in a means-plus-function or step-plus-function clause are limited to what is disclosed in the written description and equivalents thereof, since [35 U.S.C. 112\(f\)](#) applies only to the interpretation of the means or step that performs the recited function. See, e.g., *IMS Technology Inc. v. Haas Automation Inc.*, 206 F.3d 1422, 54 USPQ2d 1129 (Fed. Cir. 2000) (the term “data block” in the phrase “means to sequentially display data block inquiries” was not the means that caused the sequential display, and its meaning was not limited to the disclosed embodiment and equivalents thereof). Each claim must be independently reviewed to determine the applicability of [35 U.S.C. 112\(f\)](#) even where the application contains substantially similar process and apparatus claims. *O.I. Corp.*, 115 F.3d at 1583-1584, 42 USPQ2d at 1782 (“We understand that the steps in the method claims are essentially in the same language as the limitations in the apparatus claim, albeit without the ‘means for’ qualification.... Each claim must be independently reviewed in order to determine if it is subject to the requirements of [section 112](#), ¶ 6. Interpretation of claims would be confusing indeed if claims that are not means- or step- plus function were to be interpreted as if they were, only because they use language similar to that used in other claims that are subject to this provision.”).

## II. DESCRIPTION NECESSARY TO SUPPORT A CLAIM LIMITATION WHICH INVOKES 35 U.S.C. 112(f) OR PRE-AIA 35 U.S.C. 112, SIXTH PARAGRAPH

[35 U.S.C. 112\(f\)](#) states that a claim limitation expressed in means- (or step-) plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.” “If one employs means plus function language in a claim,

one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the [35 U.S.C. 112\(b\)](#) [or the second paragraph of [pre-AIA section 112](#)].” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (*en banc*).

***A. The Corresponding Structure Must Be Disclosed In the Specification Itself in a Way That One Skilled In the Art Will Understand What Structure Will Perform the Recited Function***

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means- (or step-) plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). In *Atmel*, the patentee claimed an apparatus that included a “high voltage generating means” limitation, thereby invoking [35 U.S.C. 112](#), sixth paragraph. The specification incorporated by reference a non-patent document from a technical journal, which described a particular high voltage generating circuit. The Federal Circuit concluded that the title of the article in the specification may, by itself, be sufficient to indicate to one skilled in the art the precise structure of the means for performing the recited function, and it remanded the case to the district court “to consider the knowledge of one skilled in the art that indicated, based on unrefuted testimony, that the specification disclosed sufficient structure corresponding to the high-voltage means limitation.” *Id.* at 1382, 53 USPQ2d at 1231.

If there is no disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of [35 U.S.C. 112\(b\)](#). The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means- (or step-) plus-function claim limitation. See *id.* at 1380, 53 USPQ2d at 1229; *In re Dossel*, 115

F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997). However, “[a] bare statement that known techniques or methods can be used does not disclose structure” in the context of a means plus function limitation. *Biomedino, LLC v. Waters Technology Corp.*, 490 F.3d 946, 952, 83 USPQ2d 1118, 1123 (Fed. Cir. 2007) (Disclosure that an invention “may be controlled by known differential pressure, valving and control equipment” was not a disclosure of any structure corresponding to the claimed “control means for operating [a] valving” and the claim was held indefinite). See also *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1115-18, 63 USPQ2d 1725, 1731-34 (Fed. Cir. 2002) (Court interpreted the language of the “third monitoring means for monitoring the ECG signal...for activating ...” to require the same means to perform both functions and the only entity referenced in the specification that could possibly perform both functions is the physician. The court held that excluding the physician, no structure accomplishes the claimed dual functions. Because no structure disclosed in the embodiments of the invention actually performs the claimed dual functions, the specification lacks corresponding structure as required by [35 U.S.C. 112](#), sixth paragraph, and fails to comply with [35 U.S.C. 112](#), second paragraph.).

Whether a claim reciting an element in means- (or step-) plus-function language fails to comply with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, because the specification does not disclose adequate structure (or material or acts) for performing the recited function is closely related to the question of whether the specification meets the description requirement in [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. See *In re Noll*, 545 F.2d 141, 149, 191 USPQ 721, 727 (CCPA 1976) (unless the means-plus-function language is itself unclear, a claim limitation written in means-plus-function language meets the definiteness requirement in [35 U.S.C. 112](#), second paragraph, so long as the specification meets the written description requirement in [35 U.S.C. 112](#), first paragraph). In *Aristocrat Techs. Australia PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1336-37, 86 USPQ2d 1235, 1242 (Fed. Cir. 2008), the court stated:



Enablement of a device requires only the disclosure of sufficient information so that a person of ordinary skill in the art could make and use the device. A section 112(f) or pre-AIA] paragraph 6 disclosure, however, serves the very different purpose of limiting the scope of the claim to the particular structure disclosed, together with equivalents. ... For example, in *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380[, 53 USPQ2d 1225, 1230] (Fed. Cir. 1999), the court embraced the proposition that ‘consideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification.’ It is not enough for the patentee simply to state or later argue that persons of ordinary skill in the art would know what structures to use to accomplish the claimed function. The court in *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 953[, 83 USPQ2d 1118, 1123] (Fed. Cir. 2007), put the point this way: “The inquiry is whether one of skill in the art would understand the specification itself to disclose a structure, not simply whether that person would be capable of implementing that structure.”

The invocation of [35 U.S.C. 112\(f\)](#) does not exempt an applicant from compliance with [35 U.S.C. 112\(a\)](#) and [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), first and second paragraphs. See *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 493 (CCPA 1973) (“[The sixth paragraph of section 112] cannot be read as creating an exception either to the description requirement of the first paragraph ... or to the definiteness requirement found in the second paragraph of [section 112](#). Means-plus-function language can be used in the claims, but the claims must still accurately define the invention.”).

Under certain limited circumstances, the written description does not have to explicitly describe the structure (or material or acts) corresponding to a means- (or step-) plus-function limitation to particularly point out and distinctly claim the invention as required by [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *Dossel*, 115 F.3d at 946, 42 USPQ2d at 1885. Under

proper circumstances, drawings may provide a written description of an invention as required by [35 U.S.C. 112](#). *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991). Further, disclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description if it would have been clear to those skilled in the art what structure must perform the function recited in the means-plus-function limitation. See *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1379, 53 USPQ2d 1225, 1228 (Fed. Cir. 1999) (stating that the “one skilled in the art” analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation); *Dossel*, 115 F.3d at 946–47, 42 USPQ2d at 1885 (“Clearly, a unit which receives digital data, performs complex mathematical computations and outputs the results to a display must be implemented by or on a general or special purpose computer (although it is not clear why the written description does not simply state ‘computer’ or some equivalent phrase.”).

A claim may also be indefinite when the 3-prong analysis for determining whether the claim limitation should be interpreted under [35 U.S.C. 112\(f\)](#) is inconclusive because of ambiguous words in the claim. After taking into consideration the language in the claims, the specification, and how those of ordinary skill in the art would understand the language in the claims in light of the disclosure, the examiner should make a determination regarding whether the words in the claim recite sufficiently definite structure that performs the claimed function. If the applicant disagrees with the examiner’s interpretation of the claim limitation, the applicant has the opportunity during the application process to present arguments, and amend the claim if needed, to clarify whether [35 U.S.C. 112\(f\)](#) applies.

### ***B. Computer-Implemented Means-Plus-Function Limitations***

For a computer-implemented [35 U.S.C. 112\(f\)](#) claim limitation, the specification must disclose an algorithm for performing the claimed specific computer function, or else the claim is indefinite under [35 U.S.C. 112\(b\)](#). See *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367, 88 USPQ2d

1751, 1757 (Fed. Cir. 2008). See also *In re Aoyama*, 656 F.3d 1293, 1297, 99 USPQ2d 1936, 1939 (Fed. Cir. 2011) (“[W]hen the disclosed structure is a computer programmed to carry out an algorithm, ‘the disclosed structure is not the general purpose computer, but rather that special purpose computer programmed to perform the disclosed algorithm.’”) (quoting *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999)).

In cases involving a special purpose computer-implemented means-plus-function limitation, the Federal Circuit has consistently required that the structure be more than simply a general purpose computer or microprocessor and that the specification must disclose an algorithm for performing the claimed function. See, e.g., *Noah Systems Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312, 102 USPQ2d 1410, 1417 (Fed. Cir. 2012); *Aristocrat*, 521 F.3d at 1333, 86 USPQ2d at 1239.

For a computer-implemented means-plus-function claim limitation invoking [35 U.S.C. 112\(f\)](#) the Federal Circuit has stated that “a microprocessor can serve as structure for a computer-implemented function only where the claimed function is ‘coextensive’ with a microprocessor itself.” *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 622, 114 USPQ2d 1711, 1714 (Fed. Cir. 2015), citing *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316, 97 USPQ2d 1737, 1747 (Fed. Cir. 2011). “It is only in the rare circumstances where any general-purpose computer without any special programming can perform the function that an algorithm need not be disclosed.” *EON Corp.*, 785 F.3d at 621, 114 USPQ2d at 1714, quoting *Ergo Licensing, LLC v. CareFusion* 303, Inc., 673 F.3d 1361, 1365, 102 USPQ2d 1122, 1125 (Fed. Cir. 2012). “[S]pecial programming’ includes any functionality that is not ‘coextensive’ with a microprocessor or general purpose computer.” *EON Corp.*, 785 F.3d at 623, 114 USPQ2d at 1715 (citations omitted). “Examples of such coextensive functions are ‘receiving’ data, ‘storing’ data, and ‘processing’ data—the only three functions on which the Katz court vacated the district court’s decision and remanded for the district court to determine whether disclosure of a microprocessor was sufficient.” 785 F.3d at 622, 114 USPQ2d at 1714.

Thus, “[a] microprocessor or general purpose computer lends sufficient structure only to basic functions of a microprocessor. All other computer-implemented functions require disclosure of an algorithm.” *Id.*, 114 USPQ2d at 1714

To claim a means for performing a specific computer-implemented function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat*, 521 F.3d 1328 at 1333, 86 USPQ2d at 1239. In this instance, the structure corresponding to a [35 U.S.C. 112\(f\)](#) claim limitation for a computer-implemented function must include the algorithm needed to transform the general purpose computer or microprocessor disclosed in the specification. *Aristocrat*, 521 F.3d at 1333, 86 USPQ2d at 1239; *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340, 86 USPQ2d 1609, 1623 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.*, 989 F.3d 1002, 1007-8, 2021 USPQ2d 284 (Fed. Cir. 2021).

The corresponding structure is not simply a general purpose computer by itself but the special purpose computer as programmed to perform the disclosed algorithm. *Aristocrat*, 521 F.3d at 1333, 86 USPQ2d at 1239. Thus, the specification must sufficiently disclose an algorithm to transform a general purpose microprocessor to the special purpose computer. See *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1241. (“*Aristocrat* was not required to produce a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy [35 U.S.C. § 112](#) ¶ 6. It was required, however, to at least disclose the algorithm that transforms the general purpose microprocessor to a ‘special purpose computer programmed to perform the disclosed algorithm.’” (quoting *WMS Gaming*, 184 F.3d at 1349, 51 USPQ2d at 1391.)) An algorithm is defined, for example, as “a finite sequence of steps for solving a logical or mathematical problem or performing a task.” *Microsoft Computer Dictionary*, Microsoft Press, 5th edition, 2002. Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or “in any other manner that provides sufficient

structure.” *Finisar*, 523 F.3d at 1340, 86 USPQ2d at 1623; see also *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1366, 65 USPQ2d 1934, 1941 (Fed. Cir. 2003); *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997); *Typhoon Touch Inc. v. Dell Inc.*, 659 F.3d 1376, 1385, 100 USPQ2d 1690, 1697 (Fed. Cir. 2011); *In re Aoyama*, 656 F.3d at 1306, 99 USPQ2d at 1945.

The Federal Circuit case law regarding special purpose computer-implemented means-plus-function claims is divided into two distinct groups. The first group includes cases in which the specification discloses no algorithm, and the second group includes cases in which the specification does disclose an algorithm, but an issue exists as to whether the disclosure is adequate to perform the entire claimed function(s). The sufficiency of the algorithm is determined in view of what one of ordinary skill in the art would understand as sufficient to define the structure and make the boundaries of the claim understandable. See *Noah*, 675 F.3d at 1313, 102 USPQ2d at 1417.

Accordingly, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is appropriate if the specification discloses no corresponding algorithm associated with a computer or microprocessor. *Aristocrat*, 521 F.3d at 1337-38, 86 USPQ2d at 1242. For example, in *Advanced Ground Information Systems, Inc. v. Life360, Inc.*, 830 F.3d 1341, 119 USPQ2d 1526 (Fed. Cir. 2016), the Federal Circuit determined that the term "symbol generator" is a computer-implemented means-plus-function limitation and that "[t]he specifications of the patents-in-suit do not disclose an operative algorithm for the claim elements reciting 'symbol generator.'" 830 F.3d at 1348-49, 119 USPQ2d at 1529-30. The Federal Circuit upheld the district court's determination that the term "symbol generator" is indefinite, observing that "although the district court recognized that the specification describes, in general terms, that symbols are generated based on the latitude and longitude of the participants, it nonetheless determined that the specification fails to disclose an algorithm or description as to how those symbols are actually generated." 830 F.3d at 1349, 119 USPQ2d at 1530 (internal quotation marks and alterations omitted). See also, *Blackboard, Inc. v. Desire2Learn, Inc.*,

574 F.3d 1371, 1382-83, 91 USPQ2d 1481, 1490-91 (Fed. Cir. 2009) (concluding that the description of a server computer's "access control manager" software feature was insufficient disclosure of corresponding structure to support the computer-implemented "means for assigning" limitation because "what the patent calls the 'access control manager' is simply an abstraction that describes the function of controlling access to course materials ... [b]ut how it does so is left undisclosed."); *Aristocrat*, 521 F.3d at 1334-35, 86 USPQ2d at 1240 (explaining that "the [patent's] description of the embodiments is simply a description of the outcome of the claimed functions, not a description of the structure, i.e., the computer programmed to execute a particular algorithm").

Mere reference to a general purpose computer with appropriate programming without providing an explanation of the appropriate programming, or simply reciting "software" without providing detail about the means to accomplish a specific software function, would not be an adequate disclosure of the corresponding structure to satisfy the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *Aristocrat*, 521 F.3d at 1334, 86 USPQ2d at 1239; *Finisar*, 523 F.3d at 1340-41, 86 USPQ2d at 1623. In addition, merely referencing a specialized computer (e.g., a "bank computer"), some undefined component of a computer system (e.g., "access control manager"), "logic," "code," or elements that are essentially a black box designed to perform the recited function, will not be sufficient because there must be some explanation of how the computer or the computer component performs the claimed function. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1383-85, 91 USPQ2d 1481, 1491-93 (Fed. Cir. 2009); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1366-67, 88 USPQ2d 1751, 1756-57 (Fed. Cir. 2008); *Ex parte Rodriguez*, 92 USPQ2d 1395, 1405-06 (Bd. Pat. App. & Inter. 2009).

If the specification explicitly discloses an algorithm, the sufficiency of the disclosure of the algorithm must be determined in light of the level of ordinary skill in the art. *Aristocrat*, 521 F.3d at 1337, 86 USPQ2d at 1241; *AllVoice Computing PLC v. Nuance Commc'ns, Inc.*, 504 F.3d 1236, 1245, 84 USPQ2d 1886, 1893 (Fed. Cir. 2007); *Intel Corp.*,

319 F.3d at 1366-67, 65 USPQ2d 1934, 1941 (knowledge of a person of ordinary skill in the art can be used to make clear how to implement a disclosed algorithm). The examiner should determine whether one skilled in the art would know how to program the computer to perform the necessary steps described in the specification (i.e., the invention is enabled), and that the inventor was in possession of the invention (i.e., the invention meets the written description requirement). Thus, the specification must sufficiently disclose an algorithm to transform a general purpose microprocessor to a special purpose computer so that a person of ordinary skill in the art can implement the disclosed algorithm to achieve the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

The sufficiency of the algorithm is determined in view of what one of ordinary skill in the art would understand as sufficient to define the structure and make the boundaries of the claim understandable. For example, in *Williamson*, the Federal Circuit found that the term “distributed learning control module” is a means-plus- function limitation that performs three specialized functions (i.e., “receiving,” “relaying,” and “coordinating”), which “must be implemented in a special purpose computer.” *Williamson*, 792 F.3d at 1351-52, 115 USPQ2d at 1113. The Federal Circuit explained that “[w]here there are multiple claimed functions, as we have here, the [specification] must disclose adequate corresponding structure to perform all of the claimed functions.” *Id.*, 115 USPQ2d at 1115. Yet the Federal Circuit determined that the specification “fails to disclose any structure corresponding to the ‘coordinating’ function.” *Id.* at 1354, 115 USPQ2d at 1115. Specifically, the Federal Circuit found no “disclosure of an algorithm corresponding to the claimed ‘coordinating’ function,” concluding that the figures in the specification relied upon by patentee as disclosing the required algorithm, instead describe “a presenter display interface” and not an algorithm corresponding to the claimed “coordinating” function. *Id.* at 1353-54, 115 USPQ2d at 1114-15. Accordingly, the Federal Circuit affirmed the district court’s judgment that claims containing the “distributed learning control module” limitation are invalid for indefiniteness under [35 U.S.C. 112\(b\)](#). *Id.* at 1354, 115 USPQ2d

at 1115. See also *Noah*, 675 F.3d at 1319, 102 USPQ2d at 1421 (holding that “[c]omputer-implemented means-plus- function claims are indefinite unless the specification discloses an algorithm to perform the function associated with the limitation[.]” and that “[w]hen the specification discloses an algorithm that only accomplishes one of multiple identifiable functions performed by a means-plus- function limitation, the specification is treated as if it disclosed no algorithm.”).

Similarly in *Media Rights Technologies, Inc. v. Capital One Financial Corp.*, 800 F.3d 1366, 1374, 116 USPQ2d 1144, 1149 (Fed. Cir. 2015), the Federal Circuit determined that the term “compliance mechanism” is a means-plus-function limitation that performs four computer implemented functions (i.e., “controlling data output by diverting a data pathway; monitoring the controlled data pathway; managing an output path by diverting a data pathway; and stopping the play of media content”). The Federal Circuit determined “that the specification fails to adequately disclose the structure to perform all four of [the ‘compliance mechanism’s’] functions” and affirmed the district court’s decision that the “compliance mechanism” limitation is indefinite. *Id.* at 1375, 116 USPQ2d at 1150. Specifically, the Federal Circuit found that “the specification fails to disclose an operative algorithm for both the ‘controlling data output’ and ‘managing output path’ functions[.]” which “both require diverting a data pathway[.]” because the recited C++ source code in the specification “only returns various error messages” and “does not, accordingly, explain how to perform the diverting function[.]” *Id.* at 1374–75, 116 USPQ2d at 1149-50. “Additionally, the specification does not disclose sufficient structure for the ‘monitoring’ function[.]” because the disclosed “set of rules . . . which the ‘copyright compliance mechanism’ applies to monitor the data pathway to ensure there is no unauthorized recording of electronic media . . . provides no detail about the rules themselves or how the ‘copyright compliance mechanism’ determines whether the rules are being enforced.” *Id.* at 1375, 116 USPQ2d at 1150.

In several Federal Circuit cases, the patentees argued that the requirement for the disclosure of an algorithm can be avoided if one of ordinary skill in



the art is capable of writing the software to convert a general purpose computer to a special purpose computer to perform the claimed function. See, e.g., *Blackboard*, 574 F.3d at 1385, 91 USPQ2d at 1493; *Biomedino*, 490 F.3d at 952, 83 USPQ2d at 1123; *Atmel Corp.*, 198 F.3d at 1380, 53 USPQ2d at 1229. Such argument was found to be unpersuasive because the understanding of one skilled in the art does not relieve the patentee of the duty to disclose sufficient structure to support means-plus-function claim terms. *Blackboard*, 574 F.3d at 1385, 91 USPQ2d at 1493 (“A patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function.”); *Atmel Corp.*, 198 F.3d at 1380, 53 USPQ2d at 1229 (“[C]onsideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification.”). The specification must explicitly disclose the algorithm for performing the claimed function, and simply reciting the claimed function in the specification will not be a sufficient disclosure for an algorithm which, by definition, must contain a sequence of steps. *Blackboard*, 574 F.3d at 1384, 91 USPQ2d at 1492 (stating that language that simply describes the function to be performed describes an outcome, not a means for achieving that outcome); Microsoft Computer Dictionary, Microsoft Press, 5th edition, 2002; see also *Encyclopaedia Britannica, Inc. v. Alpine Elecs., Inc.*, 355 Fed. App'x 389, 394-95 (Fed. Cir. 2009) (holding that implicit or inherent disclosure of a class of algorithms for performing the claimed functions is not sufficient, and the purported “one-step” algorithm is not an algorithm at all) (unpublished). *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623, 114 USPQ2d 1711, 1716 (Fed. Cir. 2015) (disagreeing “that a microprocessor can serve as sufficient structure for a software function if a person of ordinary skill in the art could implement the software function”); *Blackboard*, 574 F.3d at 1385, 91 USPQ2d at 1492 (explaining that “[t]he fact that an ordinarily skilled artisan might be able to design a program to create an access control list based on the system users’ predetermined roles goes to enablement[,]” whereas “[t]he question before us is whether the specification contains a sufficiently precise description of the ‘corresponding structure’ to satisfy [pre-AIA] [section 112](#), paragraph 6, not

whether a person of skill in the art could devise some means to carry out the recited function”).

Often the supporting disclosure for a computer-implemented invention discusses the implementation of the functionality of the invention through hardware, software, or a combination of both. In this situation, a question can arise as to which mode of implementation supports the means-plus-function limitation. The language of [35 U.S.C. 112\(f\)](#) requires that the recited “means” for performing the specified function shall be construed to cover the corresponding “structure or material” described in the specification and equivalents thereof. Therefore, by choosing to use a means-plus-function limitation and invoke [35 U.S.C. 112\(f\)](#) applicant limits that claim limitation to the disclosed structure, i.e., implementation by hardware or the combination of hardware and software, and equivalents thereof. Therefore, the examiner should not construe the limitation as covering pure software implementation.

However, if there is no corresponding structure disclosed in the specification (i.e., the limitation is only supported by software and does not correspond to an algorithm and the computer or microprocessor programmed with the algorithm), the limitation should be deemed indefinite as discussed above, and the claim should be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. It is important to remember that claims must be interpreted as a whole; so, a claim that includes a means-plus-function limitation that corresponds to software *per se* (and is thus indefinite for lacking structural support in the specification) is not necessarily directed as a whole to software *per se* unless the claim lacks other structural limitations.

As noted below in subsection III., if it is unclear whether there is sufficient supporting structure or whether the algorithm is adequate to perform the entire claimed function, it is appropriate to reject the claim under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

When a claim containing a computer-implemented [35 U.S.C. 112\(f\)](#) claim limitation is found to be indefinite under [35 U.S.C. 112\(b\)](#) for failure to disclose sufficient corresponding structure (e.g., the

computer and the algorithm) in the specification that performs the entire claimed function, it will also lack written description under [35 U.S.C. 112\(a\)](#). See [MPEP § 2163.03](#), subsection VI. Examiners should further consider whether the disclosure contains sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the full scope of the claimed invention in compliance with the enablement requirement of [35 U.S.C. 112\(a\)](#). See [MPEP § 2161.01](#), subsection III, and [MPEP § 2164.08](#).

***C. The Supporting Disclosure Clearly Links or Associates the Disclosed Structure, Material, or Acts to the Claimed Function***

The structure disclosed in the written description of the specification is the corresponding structure only if the written description of the specification or the prosecution history **clearly links or associates** that structure to the function recited in a means- (or step-) plus-function claim limitation under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. See *B. Braun Medical Inc., v. Abbott Laboratories*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997). The requirement that a particular structure be clearly linked with the claimed function in order to qualify as corresponding structure is the *quid pro quo* for the convenience of employing [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, and is also supported by the requirement of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, that an invention must be particularly pointed out and distinctly claimed. See *Medical Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1211, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003). For a means- (or step-) plus- function claim limitation that invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, is appropriate if one of ordinary skill in the art cannot identify what structure, material, or acts disclosed in the written description of the specification perform the claimed function.

**III. DETERMINING 35 U.S.C. 112(b) or PRE-AIA 35 U.S.C. 112 SECOND PARAGRAPH**

**COMPLIANCE WHEN 35 U.S.C. 112(f) or Pre-AIA 35 U.S.C. 112 SIXTH PARAGRAPH IS INVOKED**

Once the examiner determines that a claim limitation is a means-plus-function limitation invoking [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, the examiner should determine the claimed function and then review the written description of the specification to determine whether the corresponding structure, material, or acts that perform the claimed function are disclosed. Note that drawings may provide a written description of an invention as required by [35 U.S.C. 112](#). See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The corresponding structure, material, or acts may be disclosed in the original drawings, figures, tables, or sequence listing. However, the corresponding structure, material, or acts cannot include any structure, material, or acts disclosed only in the material incorporated by reference or a prior art reference. See *Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1317, 94 USPQ2d 1261, 1267 (Fed. Cir. 2010) (stating, “[s]imply mentioning prior art references in a patent does not suffice as a specification description to give the patentee outright claim to all of the structures disclosed in those references.”); *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). The disclosure must be reviewed from the point of view of one skilled in the relevant art to determine whether that person would understand the written description to disclose the corresponding structure, material, or acts. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1338, 88 USPQ2d 1865, 1879 (Fed. Cir. 2008); *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1211-12, 68 USPQ2d 1263, 1269 (Fed. Cir. 2003). To satisfy the definiteness requirement under [35 U.S.C. 112\(b\)](#) or [35 U.S.C. 112](#), second paragraph, the written description must clearly link or associate the corresponding structure, material, or acts to the claimed function. *Telcordia Techs., Inc. v. Cisco Systems, Inc.*, 612 F.3d 1365, 1376, 95 USPQ2d 1673, 1682 (Fed. Cir. 2010). A rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph is appropriate if the written description fails to link or associate the disclosed structure, material, or acts to the claimed function, or if there

is no disclosure (or insufficient disclosure) of structure, material, or acts for performing the claimed function. *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850. A bare statement that known techniques or methods can be used would not be a sufficient disclosure to support a means-plus-function limitation. *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 953, 83 USPQ2d 1118, 1123 (Fed. Cir. 2007).

A rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph may be appropriate in the following situations when examining means-plus-function claim limitations under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph:

(1) when it is unclear whether a claim limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph;

(2) when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph is invoked and there is no disclosure or there is insufficient disclosure of structure, material, or acts for performing the claimed function; and/or

(3) when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph is invoked and the supporting disclosure fails to clearly link or associate the disclosed structure, material, or acts to the claimed function.

A claim may be indefinite when the 3-prong analysis for determining whether the claim limitation should be interpreted under [35 U.S.C. 112\(f\)](#) is inconclusive because of ambiguous words in the claim. After taking into consideration the language in the claims, the specification, and how those of ordinary skill in the art would understand the language in the claims in light of the disclosure, the examiner should make a determination regarding whether the words in the claim recite sufficiently definite structure that performs the claimed function. If the applicant disagrees with the examiner's interpretation of the claim limitation, the applicant has the opportunity during the examination process to present arguments, and amend the claim if needed, to clarify whether [35 U.S.C. 112\(f\)](#) applies.

When the examiner cannot identify the corresponding structure, material, or acts, a rejection

under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph should be made. In some cases, a requirement for information under [37 CFR 1.105](#) may be made to require the identification of the corresponding structure, material, or acts. See [MPEP § 704.11\(a\)](#), Example R. If a requirement for information under [37 CFR 1.105](#) is made and the applicant states that the applicant lacks such information or the reply does not identify the corresponding structure, material, or acts, a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph should be made. For more information, see [MPEP § 704.12](#) (“Replies to requirements for information must be complete and filed within the time period set including any extensions. Failure to reply within the time period set will result in the abandonment of the application.”).

If the written description sets forth the corresponding structure, material, or acts in compliance with [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, the claim limitation must “be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. However, functional limitations that are not recited in the claim, or structural limitations from the written description that are unnecessary to perform the claimed function, cannot be imported into the claim. *Welker Bearing*, 550 F.3d 1090, 1097, 89 USPQ2d 1289, 1294 (Fed. Cir.2008); *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1233, 57 USPQ2d 1679, 1685 (Fed. Cir. 2001).

The following guidance is provided to determine whether applicant has complied with the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is invoked:

(A) If the corresponding structure, material or acts are described in the specification in specific terms (e.g., an emitter-coupled voltage comparator), are linked to or associated with the claimed function and one skilled in the art could identify the structure, material or acts from that description as being adequate to perform the claimed function, then the requirements of [35 U.S.C. 112\(b\)](#) and (f) or [pre-AIA](#)

[35 U.S.C. 112](#), second and sixth paragraphs and are satisfied. See *Atmel*, 198 F.3d at 1382, 53 USPQ2d 1231.

(B) If the corresponding structure, material or acts are described in the specification in broad generic terms and the specific details of which are incorporated by reference to another document (e.g., attachment means disclosed in U.S. Patent No. X, which is hereby incorporated by reference, or a comparator as disclosed in the Y article, which is hereby incorporated by reference), Office personnel must review the description in the specification, without relying on any material from the incorporated document, and apply the “one skilled in the art” analysis to determine whether one skilled in the art could identify the corresponding structure (or material or acts) for performing the recited function to satisfy the definiteness requirement of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. See *Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 75 USPQ2d 1116 (Fed. Cir. 2005) (“The inquiry under [35 U.S.C.] § 112, ¶ 2, does not turn on whether a patentee has ‘incorporated by reference’ material into the specification relating to structure, but instead asks first ‘whether structure is described in the specification, and, if so, whether one skilled in the art would identify the structure from that description.’”).

(1) If one skilled in the art would be able to identify the structure, material or acts from the description in the specification for performing the recited function, then the requirements of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, are satisfied. See *Atmel Corp.* 198 F.3d at 1379, 53 USPQ2d at 1228 (stating that the “one skilled in the art” analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation). See also *Dossel*, 115 F.3d at 946-47, 42 USPQ2d at 1885 (The function recited in the means-plus-function limitation involved “reconstructing” data. The issue was whether the structure underlying this “reconstructing” function was adequately described in the written description to satisfy [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. The court stated that “[n]either the written description nor the claims uses the magic word ‘computer,’ nor do they quote computer code that may be used in the invention. Nevertheless, when the written

description is combined with claims 8 and 9, the disclosure satisfies the requirements of [Section 112](#), Para. 2.” The court concluded that based on the specific facts of the case, one skilled in the art would recognize the structure for performing the “reconstructing” function since “a unit which receives digital data, performs complex mathematical computations and outputs the results to a display must be implemented by or on a general or special purpose computer.”).

(2) If one skilled in the art would not be able to identify the structure, material or acts from description in the specification for performing the recited function, then applicant will be required to amend the specification to contain the material incorporated by reference, including the clear link or associated structure, material or acts to the function recited in the claim. See [37 CFR 1.57\(d\)\(3\)](#). Applicant should not be required to insert all of the subject matter described in the entire referenced document into the specification. To maintain a concise specification, applicant should only include the relevant portions of the referenced document that correspond to the means- (or step-) plus-function limitation.

#### **IV. DETERMINING WHETHER 35 U.S.C. 112(a) or PRE-AIA 35 U.S.C. 112, FIRST PARAGRAPH SUPPORT EXISTS**

A means- (or step-) plus-function limitation that is found to be indefinite under [35 U.S.C. 112\(b\)](#) based on failure of the specification to disclose corresponding structure, material or act that performs the entire claimed function also lacks adequate written description and may not be sufficiently enabled to support the full scope of the claim. The principal function of claims is to provide notice of the boundaries of the right to exclude by defining the limits of the invention, and means-plus-function claims rely on the disclosure to define those limits. Accordingly, an inadequate disclosure may give rise to both an indefiniteness rejection for a means-plus-function limitation and a failure to satisfy the written description and enablement requirements of [section 112\(a\)](#) or [pre-AIA section 112](#), first paragraph.

When a claim containing a computer-implemented [35 U.S.C. 112\(f\)](#) claim limitation is found to be



indefinite under [35 U.S.C. 112\(b\)](#) for failure to disclose sufficient corresponding structure (e.g., the computer and the algorithm) in the specification that performs the entire claimed function, it will also lack written description under [section 112\(a\)](#). See [MPEP § 2163.03](#), subsection VI. Examiners should further consider whether the disclosure contains sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the full scope of the claimed invention in compliance with the enablement requirement of [section 112\(a\)](#). See [MPEP § 2161.01](#), subsection III, and [MPEP § 2164.08](#).

The Federal Circuit has recognized the problem of providing a sufficient disclosure for functional claiming, particularly with generic claim language, explaining that “The problem is especially acute with genus claims that use functional language to define the boundaries of a claimed genus. In such a case, the functional claim may simply claim a desired result, and may do so without describing species that achieve that result. But the specification must demonstrate that the applicant [inventor] has made a generic invention that achieves the claimed result and do so by showing that the applicant [inventor] has invented species sufficient to support a claim to the functionally-defined genus.” *Ariad Pharmaceuticals Inc. v. Eli & Lilly Co.*, 598 F.3d 1336, 1349, 94 USPQ2d 1161, 1171 (Fed. Cir. 2010) (*en banc*).

Thus, the means- (or step-) plus- function claim must still be analyzed to determine whether there exists corresponding adequate support for such claim limitation under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph. In considering whether there is [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph support for the claim limitation, the examiner must consider whether the specification describes the claimed invention in sufficient detail to establish that the inventor or joint inventor(s) had possession of the claimed invention as of the application's filing date. Additionally, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claim as to enable one skilled in the pertinent art to make and use the claimed invention. This

enablement requirement of [35 U.S.C. 112\(a\)](#) is separate and distinct from the written description requirement. *Ariad*, 598 F.3d at 1342, 94 USPQ2d at 1165. The enablement requirement serves a different purpose than the written description requirement in that it ensures that the invention is communicated to the interested public in a meaningful way. See [MPEP § 2164](#). In considering whether there is [35 U.S.C. 112](#), para. 1 support for the claim limitation, the examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. See *In re Mott*, 539 F.2d 1291, 1299, 190 USPQ 536, 542–43 (CCPA 1976) (claims); *In re Anderson*, 471 F.2d 1237, 1240, 176 USPQ 331, 333 (CCPA 1973) (claims); *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 54 USPQ2d 1437 (Fed. Cir. 2000) (unpublished) (abstract); *In re Armbruster*, 512 F.2d 676, 678–79, 185 USPQ 152, 153–54 (CCPA 1975) (abstract); *Anderson*, 471 F.2d at 1240, 176 USPQ at 333 (abstract); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (drawings); *In re Wolfensperger*, 302 F.2d 950, 955–57, 133 USPQ 537, 541–43 (CCPA 1962) (drawings).

Merely restating a function associated with a means-plus-function limitation is insufficient to provide the corresponding structure for definiteness. See, e.g., *Noah*, 675 F.3d at 1317, 102 USPQ2d at 1419; *Blackboard*, 574 F.3d at 1384, 91 USPQ2d at 1491; *Aristocrat*, 521 F.3d at 1334, 86 USPQ2d at 1239. It follows therefore that such a mere restatement of function in the specification without more description of the means that accomplish the function would also likely fail to provide adequate written description under [section 112\(a\)](#) or [pre-AIA section 112](#), first paragraph.

[37 CFR 1.75\(d\)\(1\)](#) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what

structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with [35 U.S.C. 112\(a\)](#) and [\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to [37 CFR 1.75\(d\)](#) and [MPEP § 608.01\(o\)](#) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element in a manner that does not add prohibited new matter to the specification. See [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph (“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” (emphasis added)); see also *B. Braun Medical*, 124 F.3d at 1424, 43 USPQ2d at 1900 (holding that “pursuant to this provision [[35 U.S.C. 112](#), sixth paragraph], structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing [112](#), paragraph 6.”); *Medical Instrumentation and Diagnostic Corp. v. Elekta AB*, 344 F.3d 1205, 1218, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003) (Although one of skill in the art would have been able to write a software program for digital to digital conversion, such software did not fall within the scope of “means for converting” images as claimed because nothing in the specification or prosecution history clearly linked or associated such software with the function of converting images into a selected format.); *Wolfensperger*, 302 F.2d at 955, 133 USPQ at 542 (just because the disclosure provides support for a

claim element does not mean that the USPTO cannot enforce its requirement that the terms and phrases used in the claims find clear support or antecedent basis in the written description).

## V. SINGLE MEANS CLAIMS

A single means claim is a claim that recites a means-plus-function limitation as the only limitation of a claim. [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, by its terms is limited to “an element in a claim for a combination.” Therefore, single means claims that do not recite a combination cannot invoke [section 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph. As such, they are not limited to the structure, material or act disclosed in the specification that performs the claimed function. Thus, a single means limitation that is properly construed will cover all means of performing the claimed function. The long-recognized problem with a single means claim is that it covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor. *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983). A claim of such breadth reads on subject matter that is not enabled by the specification, and therefore, should be rejected under [section 112\(a\)](#) or [pre-AIA section 112](#), first paragraph. See also [MPEP § 2164.08\(a\)](#).

It is important to distinguish between claims that recite multiple functional limitations (a common practice particularly in the computer-related arts) and claims that recite a single element in means-plus-function terms (rare in most arts). In computer-implemented inventions, a microprocessor may be programmed with different algorithms, with each algorithm performing a separate function. Each of these separately programmed functions should be interpreted as a separate element.

Applicants frequently draft claims to computer-related inventions using a shorthand drafting technique that recites a generic placeholder, such as a “system”, that performs a series of functions. This shorthand drafting technique does not avoid invoking [35 U.S.C. 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph. See [MPEP § 2181](#), subsection II.B. Each function recited in this manner

should be interpreted as a separate [section 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph limitation.

For example, consider the following claim:

9. An image processing assembly that filters pixel values, comprising:

a system configured to:

extract a first pixel value; and

compare the first pixel value to a pixel threshold to filter pixel values that exceed the threshold value.

Assume the specification that supports this claim discloses that the system is a microprocessor programmed with two separate algorithms, one for performing the extraction and another for comparing the pixel values. A proper interpretation would treat these elements as separate limitations each of which invoke treatment under [section 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph since the word “system” has no structural meaning and in this case is serving as a generic placeholder for “means”.

The claim elements under [35 U.S.C. 112\(f\)](#) or [pre-AIA section 112](#), sixth paragraph would be interpreted as:

system configured to extract a first pixel value;  
and

system configured to compare the first pixel value to a pixel threshold to filter pixel values that exceed the threshold value.

This claim would not be considered a “single means” claim.

Compare this type of claim to the claim in *Hyatt* that was found to recite only a single element, which is drafted in “means-plus-function” format but fails to be in a combination.

35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals.

*In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.)

## VI. ENSURE THAT THE RECORD IS CLEAR

When an examiner interprets a claim limitation under the provisions of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, the Office action should specify that the examiner has done so. A claim limitation is presumed to invoke [35 U.S.C. 112\(f\)](#) when it explicitly uses the term “means” and includes functional language without corresponding structure recited in the claim. When the examiner has determined that [35 U.S.C. 112\(f\)](#) applies, the examiner should also specify what the specification identifies as the corresponding structure. If the corresponding structure for the claimed function is not clearly identifiable in the specification, the Office action should, nevertheless, attempt to identify what structure is most closely associated with the means- (or step-) plus-function limitation to facilitate a prior art search. This is especially true when there may be confusion as to which disclosed implementation of the invention supports the limitation, as explained in subsection II.B., above. By contrast, a claim limitation that does not use the term “means” will trigger the presumption that [35 U.S.C. 112\(f\)](#) does not apply.

When [35 U.S.C. 112\(f\)](#) issues are raised, the two rebuttable presumptions regarding the application of [35 U.S.C. 112\(f\)](#) should be established in the prosecution record. Examiners should apply the applicable presumption and the 3-prong analysis to interpret a functional claim limitation in accordance with [35 U.S.C. 112\(f\)](#) including determining if the claim sets forth sufficient structure for performing the recited function. A determination that a claim is being interpreted according to [35 U.S.C. 112\(f\)](#) should be expressly stated in the Office action. By this, the applicant and the public are notified as to the claim construction used by the examiner during prosecution. Also, if the applicant intends a different claim construction, the issue can be clarified early in prosecution. In response to the Office action that determined [35 U.S.C. 112\(f\)](#) was invoked, if applicant does not want to have the claim limitation interpreted under [35 U.S.C. 112\(f\)](#) applicant may: (1) present a sufficient showing to establish that the claim limitation recites sufficient structure to perform the claimed function so as to avoid interpretation under [35 U.S.C. 112\(f\)](#); or (2) amend the claim limitation in a way that avoids

interpretation under [35 U.S.C. 112\(f\)](#) (e.g., by reciting sufficient structure to perform the claimed function).

See [MPEP § 2187](#) for applicable form paragraphs.

When allowing a claim that was treated under [35 U.S.C. 112\(f\)](#) the examiner should indicate that the claim was interpreted under the provisions of [35 U.S.C. 112\(f\)](#) in reasons for allowance if such an explanation has not previously been made of record. As noted above, the indication should also clarify the associated structure if not readily apparent in the specification.

### **2182 Search and Identification of the Prior Art [R-08.2017]**

The application of a prior art reference to a means- (or step-) plus-function limitation requires that the prior art element perform the identical function specified in the claim. However, if a prior art reference only teaches identity of function to that specified in a claim, then an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means- (or step-) plus-function. Similarly, if the prior art reference teaches the identical structure or acts but is silent about performing the claimed function, a reasonable presumption is that the prior art structure inherently performs the same function. The examiner must provide a “sound basis for believing” that the prior art structure or acts would be capable of performing the claimed function. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See [MPEP § 2114](#), subsection I, for more information on establishing inherency for functional limitations.

The means- (or step-) plus- function limitation should be interpreted in a manner consistent with the specification disclosure. The Federal Circuit explained the two step analysis involved in construing means- (or step-) plus- function limitations in *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34, 69 USPQ2d 1481, 1486 (Fed. Cir. 2004):

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113, 63 USPQ2d 1725, 1730 (Fed. Cir. 2002). The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210, 68 USPQ2d 1263, 1267 (Fed. Cir. 2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997)).

If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning. If no definition is provided, some judgment must be exercised in determining the scope of the limitation. See, e.g., *B. Braun Medical, Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997) (“We hold that, pursuant to [\[35 U.S.C. 112\]](#), sixth paragraph], structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing [112](#), paragraph 6.” The court refused to interpret a means-plus-function limitation as corresponding to a disclosed valve seat structure, as argued by patentee, since there was no indication in the specification or prosecution history that this structure corresponds to the recited function, and there was an explicitly clear association between that function and a traverse cross section bar structure disclosed in the specification.).



## 2183 Making a *Prima Facie* Case of Equivalence [R-01.2024]

[Editor Note: This MPEP section is applicable regardless of whether an application is examined under the AIA or under pre-AIA law. For applications subject to the first inventor to file (FITF) provisions of the AIA, the relevant time is "before the effective filing date of the claimed invention". For applications subject to [pre-AIA 35 U.S.C. 102](#), the relevant time is "at the time of the invention". See [MPEP § 2150](#) et seq. Many of the court decisions discussed in this section involved applications or patents subject to [pre-AIA 35 U.S.C. 102](#). These court decisions may be applicable to applications and patents subject to [AIA 35 U.S.C. 102](#) but the relevant time is before the effective filing date of the claimed invention and not at the time of the invention.]

If the examiner finds that a prior art element

- (A) performs the function specified in the claim,
- (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
- (C) is an equivalent of the means- (or step-) plus-function limitation,

the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. See *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) ("The disclosed and prior art structures are not identical, but the claim may nonetheless be anticipated. ... However, the Board made no finding that the delay means of claim 1 and that embodied in the Curtis device are structurally equivalent. Accordingly, its decision as to the anticipation of claim 1 is deficient and must be vacated.")

Factors that will support a conclusion that the prior art element is an equivalent are:

(A) The prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315 (Fed. Cir. 2000) (An internal adhesive sealing the

inner surfaces of an envelope pocket was not held to be equivalent to an adhesive on a flap which attached to the outside of the pocket. Both the claimed invention and the accused device performed the same function of closing the envelope, but the accused device performed the function in a substantially different way (by an internal adhesive on the inside of the pocket) with a substantially different result (the adhesive attached the inner surfaces of both sides of the pocket)); *Odetics Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999); *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977). The concepts of equivalents as set forth in *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U.S. 605, 85 USPQ 328 (1950) are relevant to any "equivalents" determination.

*Polumbo v. Don-Joy Co.*, 762 F.2d 969, 975 n.4, 226 USPQ 5, 8-9 n.4 (Fed. Cir. 1985).

(B) A person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification. *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus. Inc.*, 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998); *Lockheed Aircraft Corp. v. United States*, 193 USPQ 449, 461 (Ct. Cl. 1977); *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196, 1 USPQ2d 2052 (Fed. Cir. 1987).

(C) There are insubstantial differences between the prior art element and the corresponding element disclosed in the specification. *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138 (Fed. Cir. 2000);

*Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865, 1875 (1997);

*Valmont Industries, Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 25 USPQ2d 1451 (Fed. Cir. 1993). See also *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000) (A structure lacking several components of the overall structure corresponding to the claimed function and also differing in the number and size of the parts may be insubstantially different from the disclosed structure. The limitation in a means- (or step-) plus-function claim is the overall structure corresponding to the

claimed function. The individual components of an overall structure that corresponds to the claimed function are not claim limitations. Also, potential advantages of a structure that do not relate to the claimed function should not be considered in an equivalents determination under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph).

A showing of at least one of the above-noted factors by the examiner should be sufficient to support a conclusion that the prior art element is an equivalent. The examiner should then conclude that the claimed limitation is met by the prior art element. In addition to the conclusion that the prior art element is an equivalent, examiners should also demonstrate, where appropriate, why it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute applicant's described structure, material, or acts for that described in the prior art reference. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent. See also *In re Walter*, 618 F.2d 758, 768, 205 USPQ 397, 407-08 (CCPA 1980) (treating [35 U.S.C. 112](#), sixth paragraph, in the context of a determination of statutory subject matter and noting “[i]f the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions . . . the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions”); *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971) (treating as improper a rejection under [35 U.S.C. 112](#), second paragraph, of functional language, but noting that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not

possess the characteristics relied on”); *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under [35 U.S.C. 102](#) or obviousness under [35 U.S.C. 103](#)).

See [MPEP § 2184](#) when determining whether the applicant has successfully met the burden of proving that the prior art element is not equivalent to the structure, material or acts described in the applicant's specification.

### **IF NONEQUIVALENCE SHOWN, EXAMINER MUST CONSIDER OBVIOUSNESS**

However, even where the applicant has met that burden of proof and has shown that the prior art element is not equivalent to the structure, material or acts described in the applicant's specification, the examiner must still make a [35 U.S.C. 103](#) analysis to determine if the claimed means- (or step-) plus-function would have been obvious from the prior art to one of ordinary skill in the art. Thus, while a finding of nonequivalence prevents a prior art element from anticipating a means- (or step-) plus-function limitation in a claim, it does not prevent the prior art element from rendering the claim limitation obvious to one of ordinary skill in the art. Because the exact scope of an “equivalent” may be uncertain, it would be appropriate to apply a [35 U.S.C. 102/103](#) rejection where the balance of the claim limitations are anticipated by the prior art relied on. A similar approach is authorized in the case of product-by-process claims because the exact identity of the claimed product or the prior art product cannot be determined by the examiner. *In re Brown*, 450 F.2d 531, 173 USPQ 685 (CCPA 1972). In addition, although it is normally the best practice to rely on only the best prior art references in rejecting a claim, alternative grounds of rejection may be appropriate where the prior art shows elements that are different from each other, and different from the specific structure, material or acts described in the specification, yet perform the function specified in the claim.

## 2184 Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a *Prima Facie* Case Is Made [R-11.2013]

The specification need not necessarily describe the equivalents of the structures, material, or acts corresponding to the means-(or step-) plus-function claim element. See *In re Noll*, 545 F.2d 141, 149-50, 191 USPQ 721, 727 (CCPA 1976) (if the meaning of equivalents is well understood in patent law, then an applicant need not describe in his specification the full range of equivalents of his invention).

*Cf. Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986) (“a patent need not teach, and preferably omits, what is well known in the art”). Where, however, the specification is silent as to what constitutes equivalents and the examiner has made out a *prima facie* case of equivalence, the burden is placed upon the applicant to show that a prior art element which performs the claimed function is not an equivalent of the structure, material, or acts disclosed in the specification. See *In re Mulder*, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983).

If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to:

- (A) Teachings in the specification that particular prior art is not equivalent;
- (B) Teachings in the prior art reference itself that may tend to show nonequivalence; or
- (C) [37 CFR 1.132](#) affidavit evidence of facts tending to show nonequivalence.

### I. TEACHINGS IN APPLICANT’S SPECIFICATION

When the applicant relies on teachings in applicant’s own specification, the examiner must make sure that the applicant is interpreting the means- (or step-) plus- function limitation in the claim in a manner which is consistent with the disclosure in the

specification. If the specification defines what is meant by “equivalents” to the disclosed embodiments for the purpose of the claimed means-(or step-) plus- function, the examiner should interpret the limitation as having that meaning. If no definition is provided, some judgment must be exercised in determining the scope of “equivalents.” Generally, an “equivalent” is interpreted as embracing more than the specific elements described in the specification for performing the specified function, but less than any element that performs the function specified in the claim. See, e.g., *NOMOS Corp. v. BrainLAB USA Inc.*, 357 F.3d, 1364, 1368, 69 USPQ2d 1853, 1856 (Fed. Cir. 2004) (where only one embodiment is described, the corresponding structure is limited to that embodiment and equivalents thereof). To interpret means- (or step-) plus-function limitations as limited to a particular means (or step) set forth in the specification would nullify the provisions of [35 U.S.C. 112](#) requiring that the limitation shall be construed to cover the structure described in the specification and equivalents thereof. *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574, 225 USPQ 236, 238 (Fed. Cir. 1985).

The scope of equivalents embraced by a claim limitation is dependent on the interpretation of an “equivalent.” The interpretation will vary depending on how the element is described in the supporting specification. The claim may or may not be limited to particular structure, material or acts (e.g., steps) as opposed to any and all structure, material or acts performing the claimed function, depending on how the specification treats that question. See, e.g., *Ishida Co. v. Taylor*, 221 F.3d 1310, 55 USPQ2d 1449 (Fed. Cir. 2000) (The court construed the scope of a means-plus-function claim element where the specification disclosed two structurally very different embodiments for performing the claimed function by looking separately to each embodiment to determine corresponding structures. The court declined to adopt a single claim construction encompassing both embodiments since it would be so broad as to describe systems both with and without the fundamental structural features of each embodiment.).

If the disclosure is so broad as to encompass any and all structures, materials or acts for performing the

claimed function, the claims must be read accordingly when determining patentability. When this happens the limitation otherwise provided by “equivalents” ceases to be a limitation on the scope of the claim in that an equivalent would be any structure, material or act other than the ones described in the specification that perform the claimed function. For example, this situation will often be found in cases where (A) the claimed invention is a combination of elements, one or more of which are selected from elements that are old, *per se*, or (B) apparatus claims are treated as indistinguishable from method claims. See, for example, *In re Meyer*, 688 F.2d 789, 215 USPQ 193 (CCPA 1982); *In re Abele*, 684 F.2d 902, 909, 214 USPQ 682, 688 (CCPA 1982); *In re Walter*, 618 F.2d 758, 767, 205 USPQ 397, 406-07 (CCPA 1980); *In re Maucorps*, 609 F.2d 481, 203 USPQ 812 (CCPA 1979); *In re Johnson*, 589 F.2d 1070, 200 USPQ 199 (CCPA 1978); and *In re Freeman*, 573 F.2d 1237, 1246, 197 USPQ 464, 471 (CCPA 1978).

On the other end of the spectrum, the “equivalents” limitation as applied to a claim may also operate to constrict the claim scope to the point of covering virtually only the disclosed embodiments. This can happen in circumstances where the specification describes the invention only in the context of a specific structure, material or act that is used to perform the function specified in the claim.

## II. FACTORS TO BE CONSIDERED IN DECIDING EQUIVALENCE

When deciding whether an applicant has met the burden of proof with respect to showing nonequivalence of a prior art element that performs the claimed function, the following factors may be considered. First, unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 961 (1988).

Second, while there is no litmus test for an “equivalent” that can be applied with absolute certainty and predictability, there are several indicia

that are sufficient to support a conclusion that one element is or is not an “equivalent” of a different element in the context of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. Indicia that will support a conclusion that one element is or is not an equivalent of another are set forth in [MPEP § 2183](#).

## III. MERE ALLEGATIONS OF NONEQUIVALENCE ARE NOT SUFFICIENT

In determining whether arguments or [37 CFR 1.132](#) evidence presented by an applicant are persuasive that the element shown in the prior art is not an equivalent, the examiner should consider and weigh as many of the above-indicated or other indicia as are presented by applicant, and should determine whether, on balance, the applicant has met the burden of proof to show nonequivalence. However, under no circumstance should an examiner accept as persuasive a bare statement or opinion that the element shown in the prior art is not an equivalent embraced by the claim limitation. Moreover, if an applicant argues that the means- (or step-) plus-function language in a claim is limited to certain specific structural or additional functional characteristics (as opposed to “equivalents” thereof) where the specification does not describe the invention as being only those specific characteristics, the claim should not be allowed until the claim is amended to recite those specific structural or additional functional characteristics. Otherwise, a claim could be allowed having broad functional language which, in reality, is limited to only the specific structure or steps disclosed in the specification. This would be contrary to public policy of granting patents which provide adequate notice to the public as to a claim’s true scope.

## IV. APPLICANT MAY AMEND CLAIMS

Finally, as in the past, applicant has the opportunity during proceedings before the Office to amend the claims so that the claimed invention meets all the statutory criteria for patentability. An applicant may choose to amend the claim by further limiting the function so that there is no longer identity of function with that taught by the prior art element, or the applicant may choose to replace the claimed means- (or step-) plus-function limitation with specific



structure, material or acts that are not described in the prior art.

### **2185 Related Issues Under 35 U.S.C. 112(a) or (b) and Pre-AIA 35 U.S.C. 112, First or Second Paragraphs [R-10.2019]**

Interpretation of claims as set forth in [MPEP § 2181](#) may create some uncertainty as to what the inventor or a joint inventor regards as the invention. If this issue arises, it should be addressed in a rejection under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. While [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, permits a particular form of claim limitation, it cannot be read as creating an exception either to the description, enablement or best mode requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph or the definiteness requirement of [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph. *In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973).

If a means- (or step-) plus-function limitation recited in a claim is not supported by corresponding structure, material or acts in the specification disclosure, the following rejections under [35 U.S.C. 112](#) should be considered:

(A) under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as not being supported by an enabling disclosure because the person skilled in the art would not know how to make and use the invention without a description of elements to perform the function. Note that the description of an apparatus with block diagrams describing the function, but not the structure, of the apparatus is not fatal under the enablement requirement of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, as long as the structure is conventional and can be determined without an undue amount of experimentation. *In re Ghiron*, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971);

(B) under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph as lacking adequate written description because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. As an example, if the means- (or step-)

plus-function limitation is computer-implemented, and the specification does not provide a disclosure of the computer and algorithm in sufficient detail to demonstrate to one of ordinary skill in the art that the inventor possessed the invention, see [MPEP § 2161.01](#) and [MPEP § 2181](#), subsection IV, a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description must be made; and

(C) under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, as being indefinite. See *Noah Systems v. Intuit*, 675 F.3d 1302, 1311-19, 102 USPQ2d 1410, 1415-21 (Fed. Cir. 2012); *In re Aoyama*, 656 F.3d 1293, 1297-98, 99 U.S.P.Q.2d 1936, 1940 (Fed. Cir. 2011); *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41, 86 USPQ2d 1609, 1622-23 (Fed. Cir. 2008); and [MPEP § 2181](#).

The examiner must also consider an application for compliance with the requirements of [35 U.S.C. 101](#), [35 U.S.C. 102](#), and [35 U.S.C. 103](#). When examining the claims under [35 U.S.C. 102](#) or [103](#) a determination of whether the prior art anticipates or renders obvious the claimed subject matter, including the means or step that performs the function specified in the claim, must be made. In the situation when there is no corresponding structure, etc., in the specification to limit the means- (or step-) plus-function limitation, an equivalent is any element that performs the specified function.

### **2186 Relationship to the Doctrine of Equivalents [R-07.2022]**

The doctrine of equivalents arises in the context of an infringement action. If an accused product or process does not literally infringe a patented invention, the accused product or process may be found to infringe under the doctrine of equivalents. The essential objective inquiry is: “Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?” *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40, 41 USPQ2d 1865, 1875 (1997). In determining equivalence, “[a]n analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed

element, or whether the substitute plays a role substantially different from the claimed element.” 520 U.S. at 40, 41 USPQ2d at 1875.

[35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, permit means- (or step-) plus-function limitations in claims to combinations, “with the proviso that application of the broad literal language of such claims must be limited to only those means that are ‘equivalent’ to the actual means shown in the patent specification. This is an application of the doctrine of equivalents in a restrictive role, narrowing the application of broad literal claim elements.” 520 U.S. at 28, 41 USPQ2d at 1870. Accordingly, decisions involving the doctrine of equivalents should be considered, but should not unduly influence a determination under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, during *ex parte* examination. See [MPEP § 2183](#).

### **2187 Form Paragraphs for Use Relating to 35 U.S.C. 112(f) or Pre-AIA 35 U.S.C. 112, Sixth Paragraph [R-07.2022]**

Form paragraphs 7.30.03.h, 7.30.03, and 7.30.05 - 7.30.07 should be used, as appropriate, when a claim limitation invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. See [MPEP § 2181](#). For rejections under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph relating to [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, use form paragraphs 7.34.23 - 7.34.24

#### **¶ 7.30.03.h Header for Claim Interpretation**

##### *CLAIM INTERPRETATION*

#### **Examiner Note:**

1. This form paragraph may be used in a first Office action or when a claim interpretation issue first arises, and need only be used once in an application, when appropriate.
2. This form paragraph may be used to preface any clarifying remarks regarding claim interpretation that the examiner chooses to add to enhance the prosecution record.
3. This form paragraph should precede form paragraphs 7.30.03 and 7.30.05, when applicable.

#### **¶ 7.30.03 Statement of Statutory Basis, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph**

The following is a quotation of [35 U.S.C. 112\(f\)](#):

(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The following is a quotation of [pre-AIA 35 U.S.C. 112](#), sixth paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

#### **Examiner Note:**

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Use this paragraph ONLY ONCE in a given Office action when claim elements use “means” (or “step for”) or otherwise invoke treatment under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph.
3. This form paragraph must be preceded by 7.30.03.h and followed with form paragraph 7.30.05.

#### **¶ 7.30.05 Broadest Reasonable Interpretation under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph: Use of “Means” (or “Step”) in Claim Drafting and Rebuttable Presumptions Raised**

The claims in this application are given their broadest reasonable interpretation using the plain meaning of the claim language in light of the specification as it would be understood by one of ordinary skill in the art. The broadest reasonable interpretation of a claim element (also commonly referred to as a claim limitation) is limited by the description in the specification when [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is invoked.

As explained in [MPEP § 2181](#), subsection I, claim limitations that meet the following three-prong test will be interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph:

(A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;

(B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and

(C) the term "means" or "step" or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

Use of the word "means" (or "step") in a claim with functional language creates a rebuttable presumption that the claim limitation is to be treated in accordance with [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. The presumption that the claim limitation is interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function.

Absence of the word "means" (or "step") in a claim creates a rebuttable presumption that the claim limitation is not to be treated in accordance with [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. The presumption that the claim limitation is not interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function.

Claim limitations in this application that use the word "means" (or "step") are being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, except as otherwise indicated in an Office action. Conversely, claim limitations in this application that do not use the word "means" (or "step") are not being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, except as otherwise indicated in an Office action.

**Examiner Note:**

1. Use this paragraph ONLY ONCE in a given Office action the first time that a claim limitation uses "means" (or "step") or otherwise invokes treatment under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, by using a substitute term for "means" that serves as a generic placeholder.
2. This paragraph must be preceded with form paragraph 7.30.03 unless already cited in a previous Office action.
3. When a claim limitation is being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph (i.e., it meets the three-prong test), to provide clarification the examiner may identify the structure, material, or act disclosed in the specification that supports the recited function by adding explanatory remarks after this paragraph.
4. When the presumptions raised are rebutted by the claim language, for example by not using "means" and failing to recite structure that performs the function, or by using "means" along with definite structure that performs the function, use form paragraph 7.30.06 and/or 7.30.07.
  - (a) Follow this form paragraph with form paragraph 7.30.06 when, despite the absence of the word "means," a claim limitation is interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph.
  - (b) Follow this form paragraph with form paragraph 7.30.07 when, despite the presence of the word "means," a claim limitation is **not** being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph.

5. A claim limitation interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, that raises issues under [35 U.S.C. 112\(a\)](#) and/or [112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), first and/or second paragraphs, respectively, should also be addressed, as appropriate. See [MPEP § 2185](#).

**¶ 7.30.06 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph, Invoked Despite Absence of "Means"**

This application includes one or more claim limitations that do not use the word "means," but are nonetheless being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, because the claim limitation(s) uses a generic placeholder that is coupled with functional language without reciting sufficient structure to perform the recited function and the generic placeholder is not preceded by a structural modifier. Such claim limitation(s) is/are: [1] in claim [2].

Because this/these claim limitation(s) is/are being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, it/they is/are being interpreted to cover the corresponding structure described in the specification as performing the claimed function, and equivalents thereof.

If applicant does not intend to have this/these limitation(s) interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, applicant may: (1) amend the claim limitation(s) to avoid it/them being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph (e.g., by reciting sufficient structure to perform the claimed function); or (2) present a sufficient showing that the claim limitation(s) recite(s) sufficient structure to perform the claimed function so as to avoid it/them being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph.

**Examiner Note:**

1. Use this paragraph ONLY ONCE in a given Office action the first time that a claim limitation invokes treatment under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph by using a substitute term for "means" that serves as a generic placeholder.
2. In bracket 1, identify each claim limitation, and in bracket 2 indicate the claim(s) in which each respective limitation appears.
3. This paragraph must be preceded with form paragraph 7.30.05 unless already cited in a previous Office action.

**¶ 7.30.07 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph, Not Invoked Despite Presence of "Means" or "Step"**

This application includes one or more claim limitations that use the word "means" or "step" but are nonetheless **not** being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph because the claim limitation(s) recite(s) sufficient structure, materials, or acts to entirely perform the recited function. Such claim limitation(s) is/are: [1] in claim [2].

Because this/these claim limitation(s) is/are **not** being interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, it/they is/are **not** being interpreted to cover

only the corresponding structure, material, or acts described in the specification as performing the claimed function, and equivalents thereof.

If applicant intends to have this/these limitation(s) interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, applicant may: (1) amend the claim limitation(s) to remove the structure, materials, or acts that performs the claimed function; or (2) present a sufficient showing that the claim limitation(s) does/do not recite sufficient structure, materials, or acts to perform the claimed function.

#### Examiner Note:

1. Use this paragraph ONLY ONCE in a given Office action the first time that a claim limitation includes the word "means" or "step" but does **not** invoke treatment under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph because sufficient structure, materials, or acts to perform the recited function are present.

2. In bracket 1, identify each claim limitation, and in bracket 2 indicate the claim(s) in which each respective limitation appears.

3. This paragraph must be preceded with form paragraph 7.30.05 unless already cited in a previous Office action.

#### ¶ 7.34.23 Rejections Under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph: Claim Limitation is Interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth paragraph, but Disclosure of the Structure, Material, or Acts for Performing the Function Recited in a Claim Is Lacking, Insufficient, or Not Clearly Linked

Claim limitation "[1]" invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for performing the entire claimed function and to clearly link the structure, material, or acts to the function. [2] Therefore, the claim is indefinite and is rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

Applicant may:

(a) Amend the claim so that the claim limitation will no longer be interpreted as a limitation under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph;

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the entire claimed function, without introducing any new matter ([35 U.S.C. 132\(a\)](#)); or

(c) Amend the written description of the specification such that it clearly links the structure, material, or acts disclosed therein to the function recited in the claim, without introducing any new matter ([35 U.S.C. 132\(a\)](#)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts and clearly links them to the function so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant should clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter ([35 U.S.C. 132\(a\)](#)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see [37 CFR 1.75\(d\)](#) and [MPEP §§ 608.01\(o\)](#) and [2181](#).

#### Examiner Note:

1. In bracket 1, recite the limitation that invokes [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph.

2. In bracket 2, explain why there is insufficient disclosure of the corresponding structure, material, or acts for performing the entire claimed function or why there is no clear linkage between the structure, material, or acts and the function. For example, explain that (i) the disclosure is devoid of any structure that performs the function in the claim, (ii) the structure described in the specification does not perform the entire function in the claim, or (iii) no association between the structure and the function can be found in the specification.

3. This form paragraph must be preceded by form paragraphs 7.30.03.h, 7.30.03, and 7.30.05 (to set forth the claim interpretation and statutory basis for [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph), and then 7.30.02 or 7.103 and 7.34.01 (to set forth the statutory basis for the indefiniteness rejection and identify the claim at issue) and 7.30.06, if appropriate (invoked despite the absence of means).

4. When a rejection is made under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph, because the disclosure is inadequate to support the limitation interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, for lack of written description should also be considered. See [MPEP § 2181](#), subsection IV.

#### ¶ 7.34.24 Rejections under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph: Unclear Whether Claim Limitation Is To Be Interpreted Under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph – Result of 3-Prong Test Inconclusive

Claim limitation [1] has been evaluated under the three-prong test set forth in [MPEP § 2181](#), subsection I, but the result is inconclusive. Thus, it is unclear whether this limitation should be interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, because [2]. The boundaries of this claim limitation are ambiguous; therefore, the claim is indefinite and is rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

In response to this rejection, applicant must clarify whether this limitation should be interpreted under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. Mere assertion regarding applicant's intent to invoke or not invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph is insufficient. Applicant may:



(a) Amend the claim to clearly invoke [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, by reciting "means" or a generic placeholder for means, or by reciting "step." The "means," generic placeholder, or "step" must be modified by functional language, and must not be modified by sufficient structure, material, or acts for performing the claimed function;

(b) Present a sufficient showing that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, should apply because the claim limitation recites a function to be performed and does not recite sufficient structure, material, or acts to perform that function;

(c) Amend the claim to clearly avoid invoking [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, by deleting the function or by reciting sufficient structure, material or acts to perform the recited function; or

(d) Present a sufficient showing that [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, does not apply because the limitation does not recite a function or does recite a function along with sufficient structure, material or acts to perform that function.

#### Examiner Note:

1. This paragraph should be used after the examiner has attempted to perform the three-prong analysis from [MPEP § 2181](#), subsection I, and is unable to conclude whether the claim limitation should be treated under [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph, because of ambiguous words in the claim. This situation should be rare.

2. In bracket 1, identify the claim and claim limitation that causes the claim to be rejected under [35 U.S.C. 112\(b\)](#) or [pre-AIA 35 U.S.C. 112](#), second paragraph.

3. In bracket 2, identify the reason that the three-prong test was inclusive. The possibilities include:

(a) the term "means" or generic placeholder is modified by a word, which is ambiguous regarding whether it conveys structure or function;

(b) the term "step" is modified by a word, which is ambiguous regarding whether it conveys an act or a function;

(c) the claim limitation uses the word "means" or a generic placeholder coupled with functional language, but it is modified by some structure or material that is ambiguous regarding whether that structure or material is sufficient for performing the claimed function;

(d) the claim limitation uses the word "step" coupled with functional language, but it is modified by some act that is ambiguous regarding whether that act is sufficient for performing the claimed function.

4. This form paragraph may also be used in response to an applicant's reply in which applicant disputes the application of [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph. See [MPEP § 706.07\(a\)](#) for guidance on when the second action may be made final.

5. This form paragraph must be preceded by form paragraphs 7.30.03.h, 7.30.03, and 7.30.05 (to set forth the claim interpretation and statutory basis for [35 U.S.C. 112\(f\)](#) or [pre-AIA 35 U.S.C. 112](#), sixth paragraph), and then 7.30.02 or 7.103 and

7.34.01 (to set forth the statutory basis for the indefiniteness rejection).

## 2188-2189 [Reserved]

## 2190 Prosecution Laches and Res Judicata [R-07.2022]

### I. PROSECUTION LACHES

The Federal Circuit affirmed a rejection of claims in a patent application on the ground that applicant had forfeited his right to a patent under the doctrine of prosecution history laches for unreasonable and undue delay in prosecution. *In re Bogese*, 303 F.3d 1362, 1369, 64 USPQ2d 1448, 1453 (Fed. Cir. 2002) (Applicant "filed twelve continuation applications over an eight-year period and did not substantively advance prosecution when required and given an opportunity to do so by the PTO."). See also *Hyatt v. Hirshfeld*, 998 F.3d 1347, 2021 USPQ2d 591 (Fed. Cir. 2021). While there are no firm guidelines for determining when laches is triggered, it applies only in egregious cases of unreasonable and unexplained delay in prosecution. For example, where there are "multiple examples of repetitive filings that demonstrate a pattern of unjustified delayed prosecution," laches may be triggered. *Symbol Tech. Inc. v. Lemelson Med., Educ., & Research Found.*, 422 F.3d 1378, 1385, 76 USPQ2d 1354, 1360 (Fed. Cir. 2005) (Court discussed difference between legitimate reasons for refiling patent applications and refilings for the business purpose of delaying the issuance of previously allowed claims.). An examiner should obtain approval from the TC Director before making a rejection on the grounds of prosecution history laches.

### II. RES JUDICATA

A patent owner or applicant may be precluded from seeking a claim that is not patentably distinct from a claim that was finally refused or canceled during an administrative trial or federal court proceeding under the doctrine of *res judicata*. Similarly, a patent owner may be precluded from seeking an amendment of a specification or drawing that was denied entry during a trial if the application or patent for which the amendment is sought has the same written description as the patent or application that was the

subject of the administrative trial or federal court proceeding. See [37 CFR 42.73\(d\)\(3\)](#).

A patent owner or applicant may be precluded from seeking a claim that is not patentably distinct from a claim that was previously rejected if the rejection was affirmed on appeal and the decision on appeal became final. A *res judicata* rejection should be applied only when the earlier decision was a decision of the Patent Trial and Appeal Board (or its predecessor Board) or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. See *In re Hitchings*, 342 F.2d 80, 85, 144 USPQ 637, 641 (CCPA 1965) (holding that unappealed rejections from examiners cannot have a preclusive effect).

When making a rejection on *res judicata*, any prior art rejection under [35 U.S.C. 102](#) or [35 U.S.C. 103](#) should ordinarily be made on the basis of the same prior art, especially in continuing applications. In most situations, the same prior art which was relied upon in the earlier decision would again be applicable.

In the following cases, a rejection of a claim based on the ground of *res judicata* was sustained where it was based on a prior adjudication, against the inventor, on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

*Edgerton v. Kingsland*, 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947).

*In re Katz*, 467 F.2d 939, 167 USPQ 487 (CCPA 1970) (prior decision by a district court).

In the following cases, *res judicata* rejections were reversed for various reasons.

*In re Fried*, 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (*res judicata* not applicable based on the definition of a “final” Board decision found in an older version of the MPEP).

*In re Hellbaum*, 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (*res judicata* not applicable because the previously adjudicated and current claims were too different to satisfy the “identity of issues” element of *res judicata*).

*In re Herr*, 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (*res judicata* not applicable despite similarities between previously adjudicated and current claims because applicant provided new evidence of patentability).

*In re Kaghan*, 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (*res judicata* not applicable based on the definition of a “final” Board decision found in an older version of the MPEP).

*In re Craig*, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (*res judicata* not applicable because the previously adjudicated and current claims were too different to satisfy the “identity of issues” element of *res judicata*).

*In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (*res judicata* not applicable because the previously adjudicated and current claims were too different to satisfy the “identity of issues” element of *res judicata*).

*In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (*res judicata* not applicable despite similarities between previously adjudicated and current claims because applicant provided new evidence of patentability).

*In re Ackermann*, 444 F.2d 1172, 170 USPQ 340 (CCPA 1971) (*res judicata* not applicable because the previously adjudicated and current claims were too different to satisfy the “identity of issues” element of *res judicata*).

*Plastic Contact Lens Co. v. Gottschalk*, 484 F.2d 837, 179 USPQ 262 (D.C. Cir. 1973) (*res judicata* not applicable based on the definition of a “final” Board decision found in an older version of the MPEP).