AMERICA INVENTS ACT
IMPLEMENTATION

Welcome

America Invents Act First Inventor to File Roadshow

September 16 - October 9, 2014

AMERICA INVENTS ACT
IMPLEMENTATION

AIA FITF Roadshows

Concord * Madison * Alexandria * Dallas * Denver * Silicon Valley * Atlanta

AIA FITF Roadshow Agenda

Topic
Introductory Remarks
FITF – A Year *Plus* In Review • Review of examiner training • Statistics to date
Will My Application Be Examined Under AIA (FITF) Or Not? • 1.55/1.78 Statements • The power of the ADS • Have you checked your filing receipt? • Scenarios
BREAK
FITF Overview and Tips on Responding to Prior Art Rejections • 35 USC 102(a)(1) and 102(a)(2) – bases for rejections • 35 USC 102(b)(1) and 102(b)(2) – exceptions • Scenarios
Effective Use of AIA (FITF) Evidentiary Declarations • 37 CRF 130(a) and 130(b) • Scenarios
Tour of the AIA (FITF) Website and Q&A

AMERICA INVENTS ACT
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FITF — A Year *Plus* In Review

Overview

- Review of Examiner Training
- FITF Statistics

Review of Examiner Training

- FITF Overview Training (March 2013)
  - Introductory FITF Video
  - Live Overview Training
  - Follow-up Video

Review of Examiner Training

- FITF Comprehensive Training (Summer 2013)
  - FITF Definitions Video
  - AIA Rules/Regulations (non-FITF)
  - Live Comprehensive Training

Review of Examiner Training

- FITF Hands-On-Workshop (HOW) (began August 2013 and ongoing)
  - Small, Interactive Group Training
  - Live and Webcast sessions offered
  - Brief FITF Overview
  - Mock Application
  - Office Action Preparation

Review of Examiner Training

- AIA (FITF) Indicator Training (January 2014)
  - Determining AIA (FITF) Status
  - Review of AIA (FITF) Indicator
  - Situations Where AIA (FITF) Indicator May Need to be Updated

Review of Examiner Training

- AIA (FITF) Declarations under 37 CFR 1.130 (coming October 2014)
  - New Rule 37 CFR 1.130 and Evaluation of Declarations
    - 130(a) Declarations of Attribution
    - 130(b) Declarations of Prior Public Disclosure
  - Computer Based Training (CBT) Module for Examiners
  - Formal Requirements for 130 Declarations
  - Examples of 130(a) and (b) Declarations
  - Acknowledging 130 Declarations in Office Actions
  - Comparison of Declarations for Pre-AIA and AIA Applications

First Inventor To File (FITF) Statistics

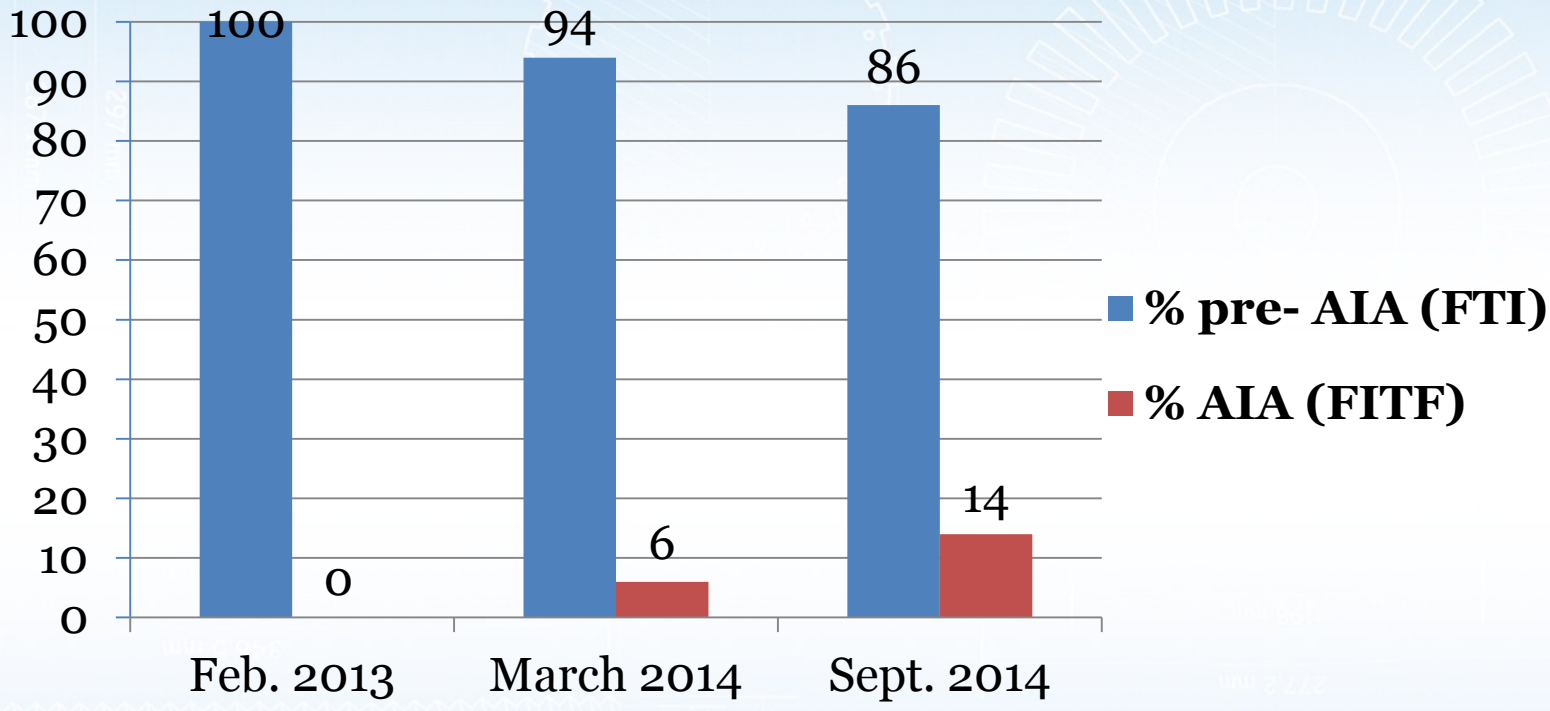
Pending Applications *

- Pre-AIA (FTI) approximately 86%
- AIA (FITF) approximately 14%

* as of September 2014

First Inventor To File (FITF) Statistics

Pending Applications



First Inventor To File (FITF) Statistics

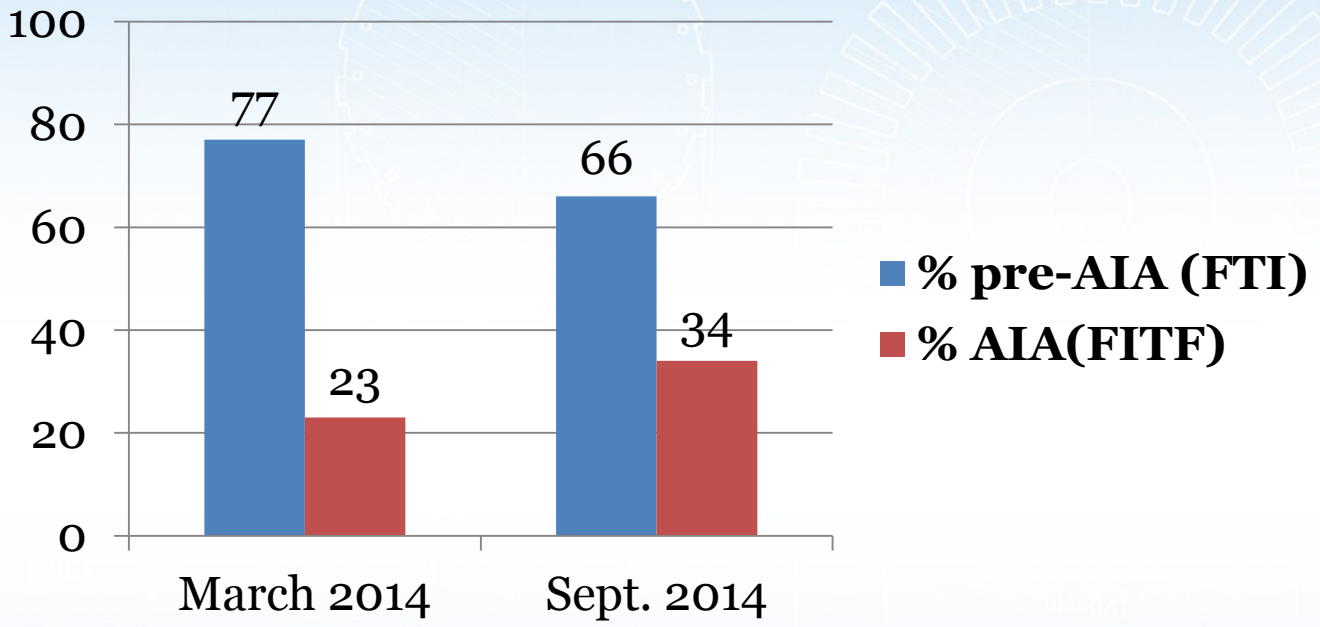
Applications filed on or after March 16, 2013 *

- Pre-AIA (FTI) approximately 66%
- AIA (FITF) approximately 34%

* Pending as of September 2014

First Inventor To File (FITF) Statistics

Applications filed on or after March 16, 2013 *



* Pending as of September 2014

First Inventor To File (FITF) Statistics

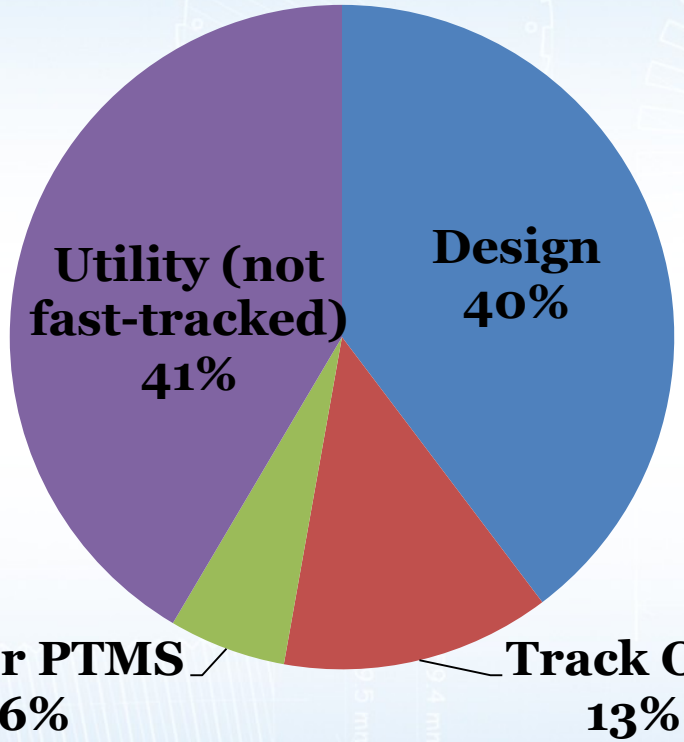
AIA (FITF) Applications*

- 26,508 have received at least a first action
  - 10,526 Design (39.7%)
  - 3,481 Track One (13.1%)
  - 1,500 Other Petition to Make Special (5.7%)
  - 11,001 Utility (not fast-tracked) (41.5%)

*as of September 2014

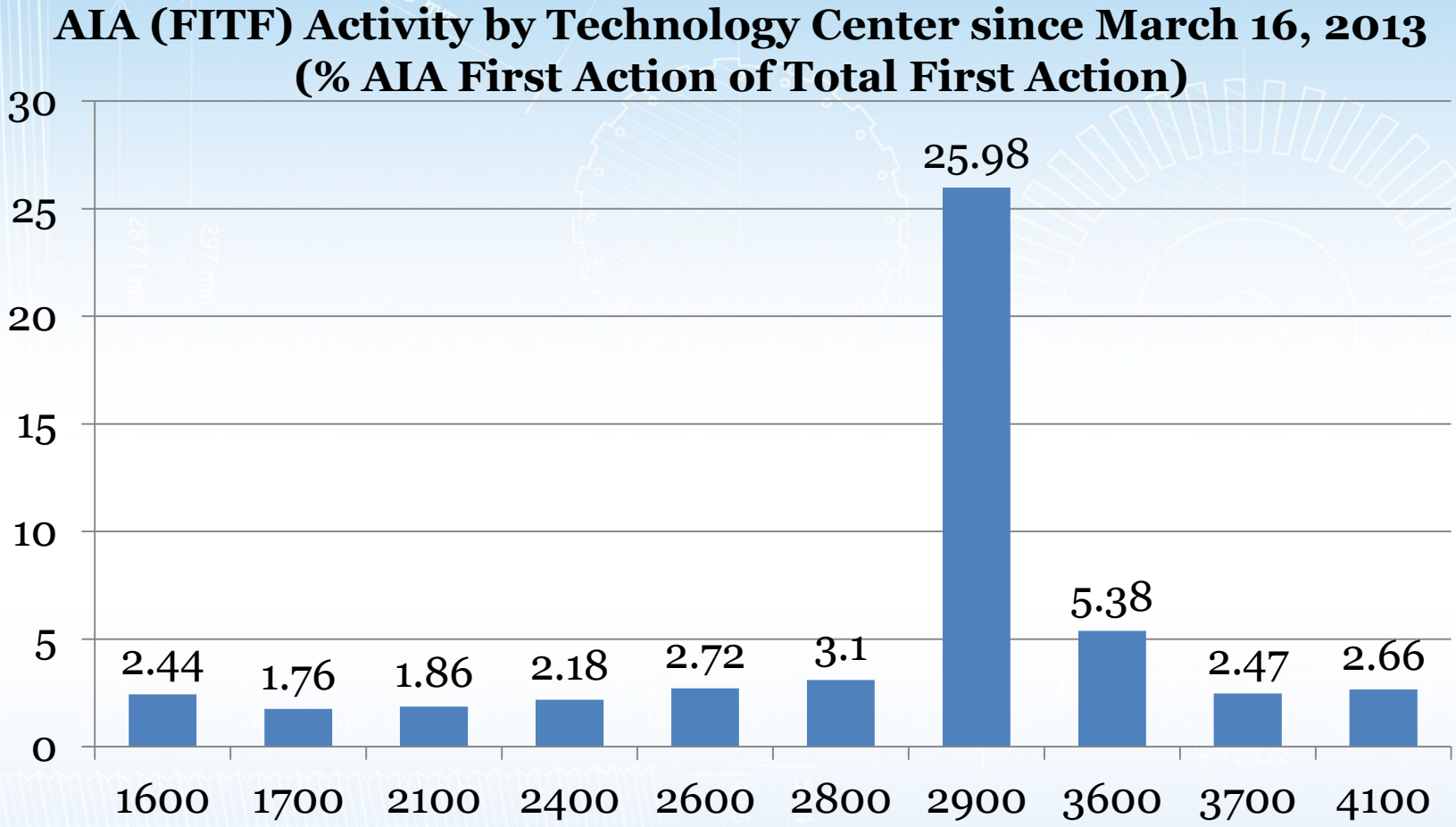
First Inventor To File (FITF) Statistics

AIA (FITF) Applications having received at least a first action*
% of total



*as of September 2014

First Inventor To File (FITF) Statistics



First Inventor To File (FITF) Statistics

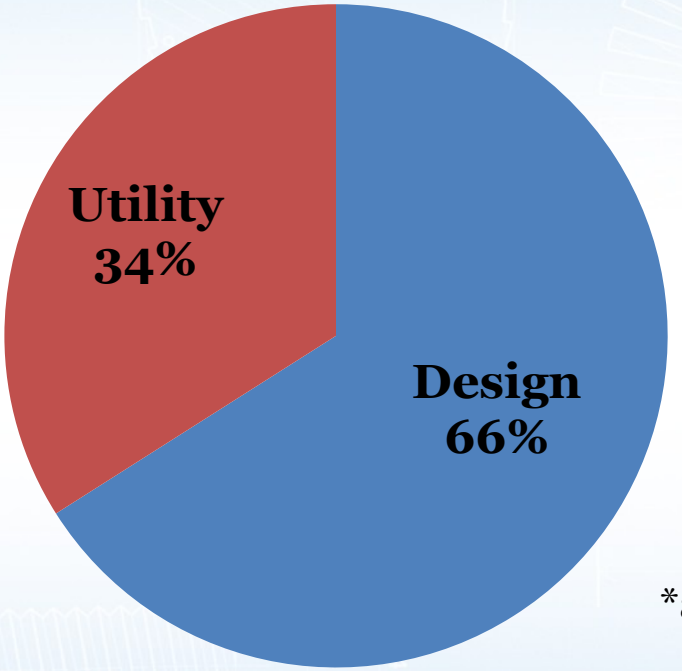
AIA (FITF) Applications*

- 12,584 have been allowed/patented
  - 8,295 Design (66%)
  - 4,289 Utility (34%)

*as of September 2014

First Inventor To File (FITF) Statistics

AIA (FITF) Applications that have been allowed or patented*



*as of September 2014

AMERICA INVENTS ACT
IMPLEMENTATION

Will My Application be Examined Under AIA (FITF) or not?

Overview

- How to determine if your application is subject to the AIA First Inventor to File (FITF) provisions
  - Pre-AIA (First to Invent) or AIA applications (FITF)
    - Transition applications
  - Required statement under 37 CFR 1.55 or 1.78 for AIA transition applications
  - Application Data Sheets Tips
- Scenarios to exemplify AIA determination in practice

Determining AIA (First Inventor to File) Status

- The First Inventor to File (FITF) provisions of the AIA, which became effective on March 16, 2013:
  - DO NOT apply to applications **filed before** March 16, 2013 (these applications are always pre-AIA (First to Invent or FTI) applications); and
  - Apply to certain applications **filed on or after** March 16, 2013.

Note: The U.S. filing date for 35 U.S.C. 371 national stage entries is the international filing date, not the 371(c) date.

Determining AIA (First Inventor to File) Status

- An application, **filed on or after** March 16, 2013, is an AIA (FITF) application if:
  - the application contains or ever contained a claim to an invention that has an effective filing date that is on or after March 16, 2013 (even if all such claims have now been cancelled);

  OR

  - the application is ever a CON, CIP, or DIV of an earlier application that contained at any time a claim having an effective filing date that is on or after March 16, 2013 (even if the domestic benefit claim is later deleted).

Determining AIA (First Inventor to File) Status

- The AIA definition of "effective filing date" (EFD) in 35 U.S.C. 100(i), which takes foreign priority into account, is used to determine whether any application, filed on or after March 16, 2013, is an AIA (FITF) or a pre-AIA (First To Invent) application (aka "AIA application" or "pre-AIA application," respectively).

- If an application filed on or after March 16, 2013 is determined to be a pre-AIA application, the pre-AIA definition of EFD, which does not take foreign priority into account, is used for examination.

Determining AIA (First Inventor to File) Status

- What does "contains or ever contained a claim" with an effective filing date on or after March 16, 2013 mean?

  - An application is considered to contain or to have ever contained such a claim if there is at least one claim having an effective filing date on or after March 16, 2013, that is:

    — pending and under consideration, **or**
    — withdrawn, **or**
    — now cancelled.

- Claims presented but not entered do not affect the AIA indicator status of an application.

Determining AIA (First Inventor to File) Status

- What does "contains or ever contained a claim" with an effective filing date on or after March 16, 2013 mean? (cont.)

  - An application is considered NOT to contain or to have ever contained such a claim if all claims entered have an effective filing date before March 16, 2013.

  Note: A claim with an effective filing date on or after March 16, 2013 that is cancelled on the same day that it is filed is considered to have **not ever been presented**. This is consistent with previous practice.

- A claim that comprises new matter, filed on or after March 16, 2013 in a pre-AIA application, will not change the status from pre-AIA to AIA, regardless of the filing date of the application.

Application Types Used to Determine When AIA (FITF) Applies

Filed **before** 3/16/2013

Filed **on or after** 3/16/2013
and
AT LEAST ONE foreign priority or domestic benefit claim to an appl'n filed **before 3/16/2013**

Filed **on or after** 3/16/2013
and
ALL foreign priority or domestic benefit claims, if any, are to an appl'n filed **on or after 3/16/2013**

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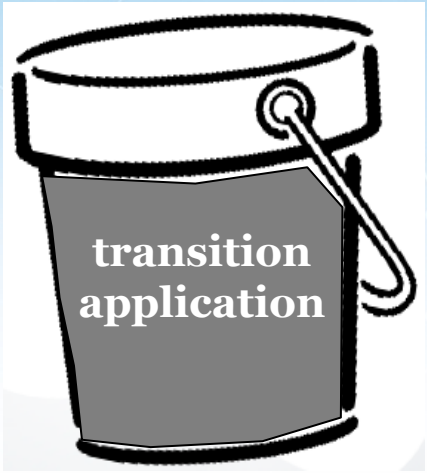
Transition Applications

- "**Transition Applications**" = Nonprovisional applications that are:
  - i. filed on or after March 16, 2013; ***and***
  - ii. claim foreign priority to, or domestic benefit of, an application filed before March 16, 2013.

- Transition applications may be either pre-AIA applications or AIA applications depending on the effective filing date of the claims in the application.

Transition Applications Can Be Either Pre-AIA or AIA (FITF)



Pre-AIA transition application

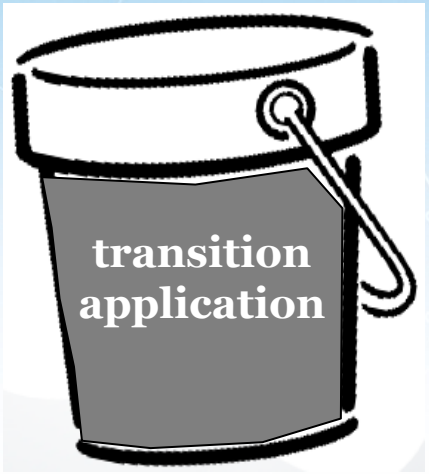
- Only ever contains claimed inventions that have an EFD ***before*** March 16, 2013

OR

AIA (FITF) transition application

- Contains or ever contained ***any*** claim to an invention that has an EFD that is ***on or after*** March 16, 2013 and/or
- Is ever a CON, DIV, or CIP of an AIA (FITF) application

1.55/1.78 Statements for AIA (FITF) Transition Applications



Pre-AIA transition application

- No statement under 37 CFR 1.55/1.78 is filed.

OR

AIA (FITF) transition application

- Statement under 37 CFR 1.55/1.78 is **required**.

1.55/1.78 Statements for AIA (FITF) Transition Applications

- When filing a transition application that contains or ever contained a claim to an invention having an effective filing date on or after March 16, 2013, a statement under 37 CFR 1.55(j) or 1.78(a)(6) or 1.78(d)(6) ("the 1.55/1.78 statement") is required.
  - Rule 55 relates to foreign priority claims
  - Rule 78 relates to domestic benefit claims

- A 1.78 statement in a child transition application is not needed if a parent contains a 1.55/1.78 statement.

Forms for Making a 1.55/1.78 Statement

- Updated versions of the application data sheet (ADS -- Form PTO/AIA/14) and the transmittal letter for 371 national stage filing (Form PTO-1390) are available for an applicant to make the 1.55/1.78 statement by marking a check box on the forms.

Application Data Sheet with 1.55/1.78 Statement Check Box

PTO/AIA/14 (03-13)
Approved for use through 01/31/2014. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

☒ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.
NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

1.55/1.78 Statement

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

☐ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

1.55/1.78 Statement

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

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1.55/1.78 Statement

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

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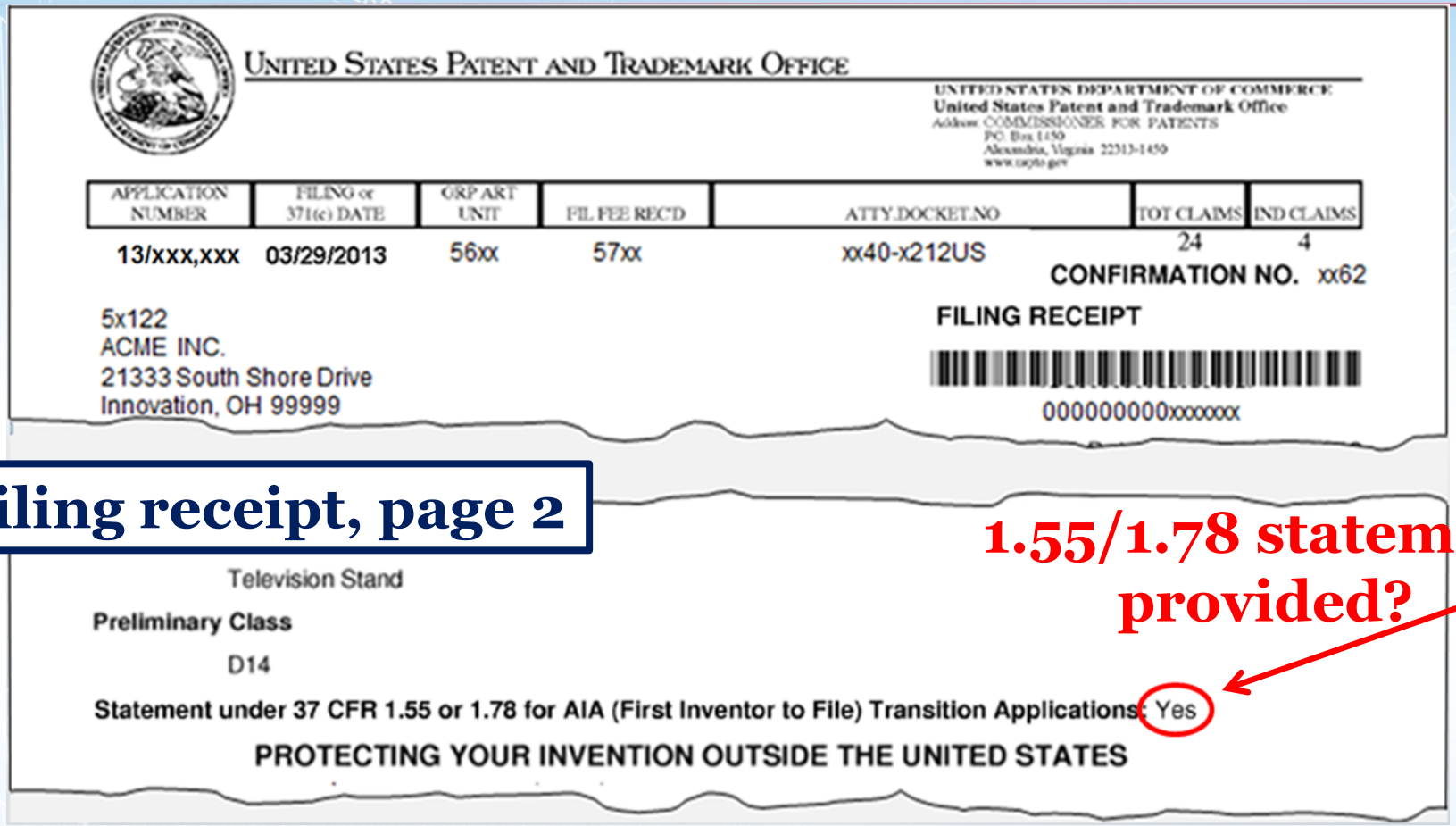
NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

1.55/1.78 Statement Reflected in the Filing Receipt



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
13/xxx,xxx	03/29/2013	56xx	57xx	xx40-x212US	24	4

CONFIRMATION NO. xx62

5x122
ACME INC.
21333 South Shore Drive
Innovation, OH 99999

FILING RECEIPT

000000000xxxxxxx

Filing receipt, page 2

Television Stand

Preliminary Class

D14

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: Yes

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

1.55/1.78 statement provided?

Making or Rescinding a 1.55/1.78 Statement Using a Separate Paper

- If applicant does not select the 1.55/1.78 statement check box on the ADS, applicant may provide the statement in **a separate document.**
- Applicant may also rescind an erroneous 1.55/1.78 statement in a separate document.
- To index the above separate documents correctly when filing online, applicant must select the document description "Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt."

Doc Code	Document Type
R.55.78.STMT	Make/Rescind AIA (First Inventor to File) 1.55/1.78 Stmnt

AIA (FITF) Application Types

1.55/1.78 statement
Not Relevant

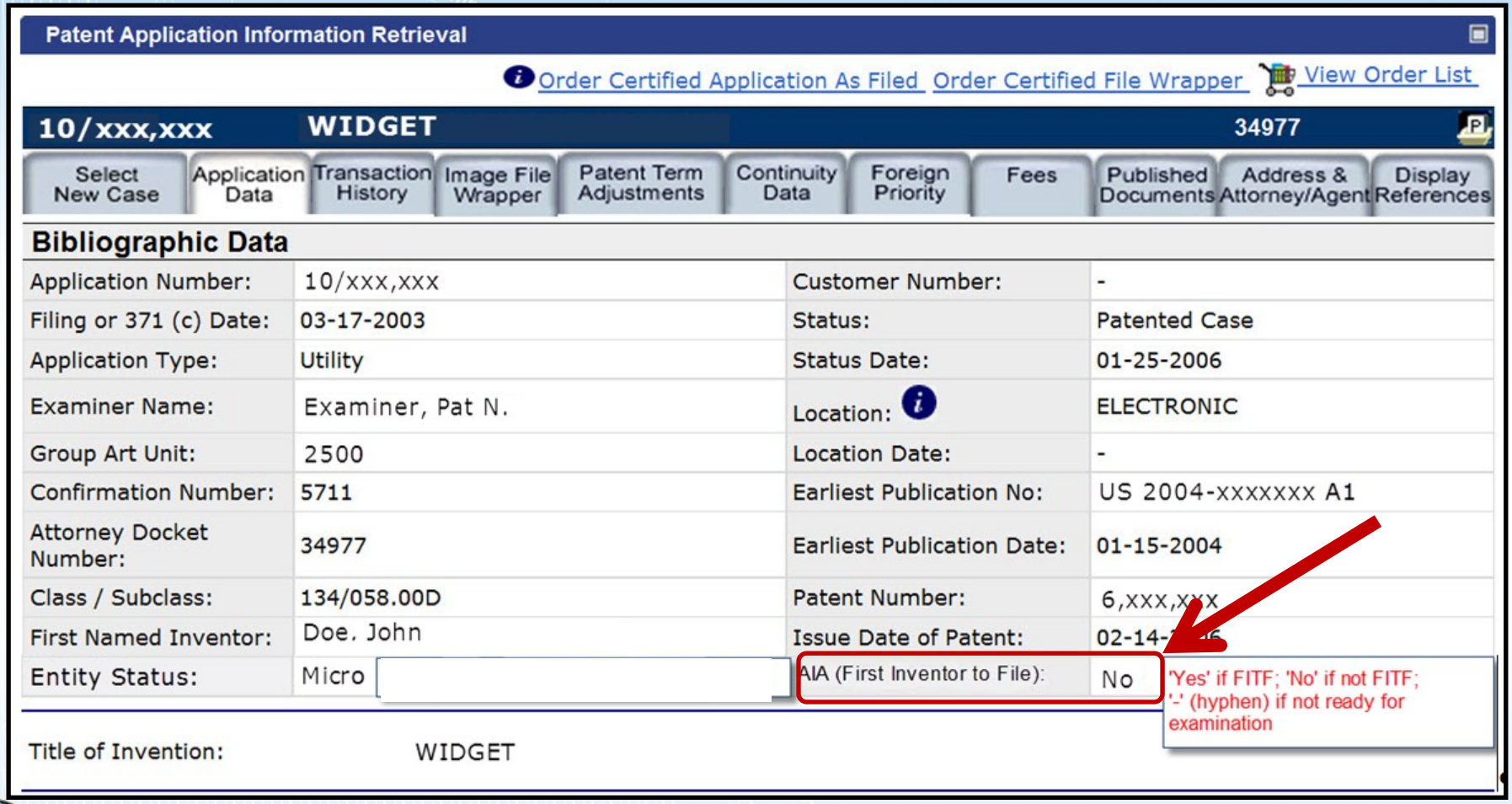
.

1.55/1.78 statement
NEEDED IF
the transition application contains or ever contained a claim to an invention having an EFD on or after 3/16/2013*

1.55/1.78 statement
Not Relevant

*A 1.78 statement in a child transition application is not needed if a parent contains a 1.55/1.78 statement.

AIA (FITF) Indicator in PAIR



Tips for Application Data Sheets

- Prior to filing an ADS, double check the listing of domestic benefit and/or foreign priority information (priority and benefit information are required to be in an ADS for applications filed on or after September 16, 2012)
  - Typos in application numbers
  - Incorrect filing dates
  - Wrong relationship type (e.g. CON vs. CIP, etc.)

Tips for Application Data Sheets

- Be sure to indicate the correct relationship and order of the domestic benefit applications listed on the ADS. If the order is incorrect, then the Office of Patent Application Processing (OPAP) may not accurately capture the entire benefit claim.
  - An example of an incorrect relationship is misidentifying a 111(a) CON of a 371 national stage entry of the PCT application
  - Another example is non-specific relationship identifiers (e.g. "Continuing" is non-specific; must be Continuation, Divisional or CIP).
- The order of the applications should be listed beginning from the instant application and continuing through the list of parents in reverse chronological order (newest to oldest).

Tips for Application Data Sheets

- Foreign priority and domestic benefit claims in applications filed on or after September 16, 2012 **MUST** appear in an ADS. See 37 CFR 1.55 for foreign priority claims and 37 CFR 1.78 for domestic benefit claims.
  - Priority/benefit claims made in the first line of the specification or in the oath/declaration are not effective and will NOT be reflected in the filing receipt.

- Make sure the ADS is properly signed.

- Check the filing receipt promptly to ensure that information captured by the Office is correct.

Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
59/956,507	02/03/2014	3773	1260	45456-0102	12	1

CONFIRMATION NO. 7285

12346

FILING RECEIPT

*OC00000057605684

Inventor(s)
Charles Jordan, Sr. Brooklyn, NY
Alexander Robert Thompson, New York, NY
Kwan Jian Pak Seoul, KOREA, REPUBLIC OF

Applicant(s)
VICTOR PEST CONTROL COMPANY

Assignment For Published Patent Application
VICTOR PEST CONTROL COMPANY

Power of Attorney: The patent practitioners associated with Customer Number 12346

Domestic Priority data as claimed by applicant
NONE

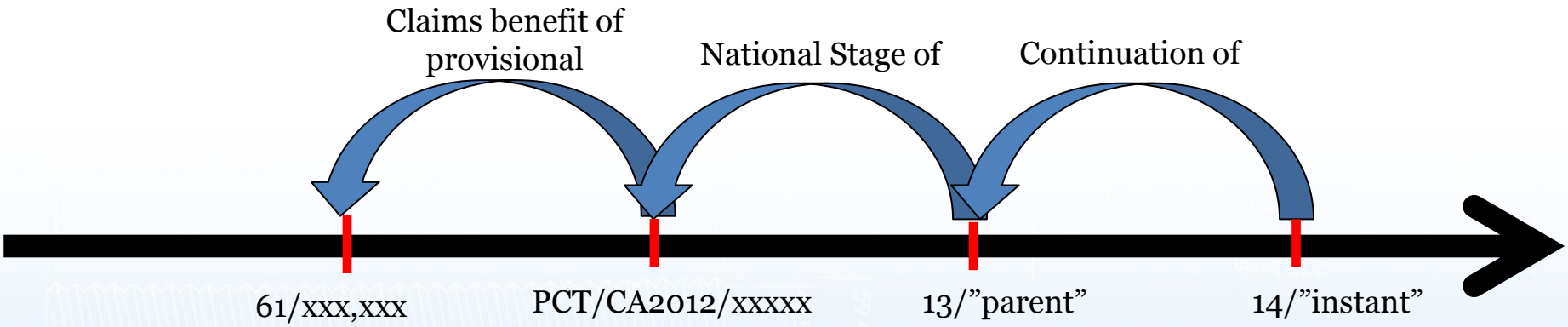
Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)
REPUBLIC OF KOREA 12-2013-004567892 10/2/2013
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Domestic Benefit Data

Foreign Priority Data

Tips for Application Data Sheets

Former Domestic Benefit Claim Practice:
This application is a continuation of U.S. Application No. 13/”parent”, filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-17.



Tips for Application Data Sheets: Newly Filed

This application is a continuation of U.S. Application No. 13/"parent", filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets: Newly Filed

This application is a continuation of U.S. Application No. 13/"parent", filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

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When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status			Remove

No Relationship to instant application →

Domestic Benefit/National Stage Information:

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Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/ "parent"	Continuation of		2013-11-19
Prior Application Status			Remove

AMERICA INVENTS ACT IMPLEMENTATION

Tips for Application Data Sheets

This application is a continuation of U.S. Application No. 13/“parent”, filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

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When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/“parent”	2013-11-19
Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/“parent”	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

This application is a continuation of U.S. Application No. 13/“parent”, filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/“parent”	2013-11-19
Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/“parent”	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

These blanks will be read as “this application is” which is inappropriate because the instant application is not directly related to both applications.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/“parent”	2013-11-19
Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Tips for Application Data Sheets

Information captured on the filing receipt:
This application is a continuation of U.S. Application No. 13/“parent”, filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

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Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/“parent”	2013-11-19
Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/“parent”	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status	Expired		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/CA2012/XXXXX	Claims benefit of provisional	61/XXX,XXX	2011-05-17

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

Tips for Application Data Sheets

- A corrected ADS (for applications filed on or after September 16, 2012) must be marked up as set forth in 37 CFR 1.76(c).
- A corrected ADS showing changes relative to the information of record is required regardless of whether an ADS has been previously filed or not.
- The corrected ADS will not be processed unless markings showing the changes are provided.
- For more information on a corrected ADS see MPEP 601.05(a).

Tips for Application Data Sheets

- A corrected ADS should be accompanied by a properly identified/indexed paper requesting action, such as,
  - a **request for a corrected filing receipt** or
  - a request to correct inventorship (Rule 48 petition)

- Information regarding proper indexing of papers can be found at the following three web sites:

  http://www.uspto.gov/ebc/portal/efs/rules_doc_codes.htm

  http://www.uspto.gov/patents/process/file/efs/guidance/EFS-WebQuickStartGuide.pdf

  http://www.uspto.gov/ebc/portal/efs/cbt/efs-web-training.ppt

Tips for Application Data Sheets

Scenario for correcting an ADS:
Initial filing receipt shows no domestic benefit claims because they were incorrectly entered on the initial ADS. An appropriate and timely, **corrected ADS** with markings to show changes relative to the information of record, as shown below, will be effective.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/"parent"	2013-11-19
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/"parent"	a 371 of international	PCT/CA2012/XXXXX	2012-05-16
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/CA2012/XXXXX	Claims benefit of provisional	61/XXX,XXX	2011-05-17

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.

"Take Home"

- Make sure the information in the filing receipt you receive is correct. In particular, check your filing receipt promptly to make sure that:
  - all domestic benefit and/or foreign priority claims have been accurately captured and
  - the presence or absence of a 1.55/1.78 statement has been accurately captured.

- If any information you provided on the ADS was not accurately captured by the USPTO, file a request for a corrected filing receipt.

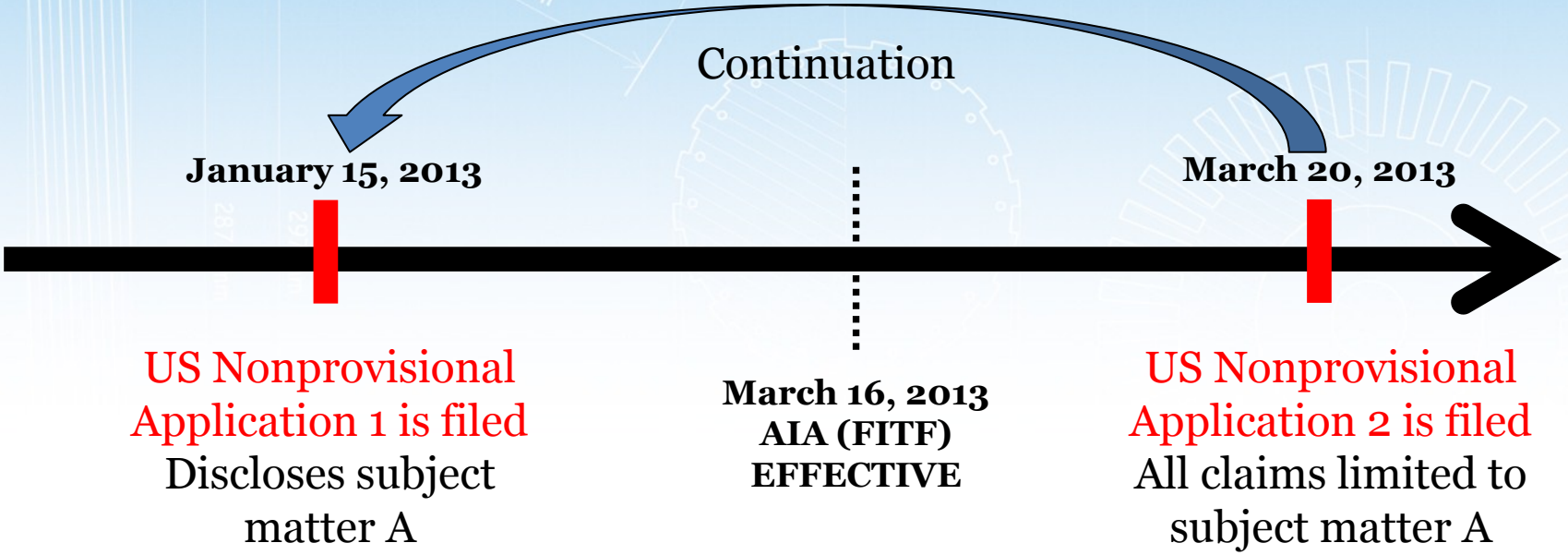
- If review of the filing receipt and the ADS identifies applicant errors, file both:
  - a request to correct the filing receipt and
  - a corrected ADS

AMERICA INVENTS ACT
IMPLEMENTATION

AIA First Inventor To File (FITF) Indicator

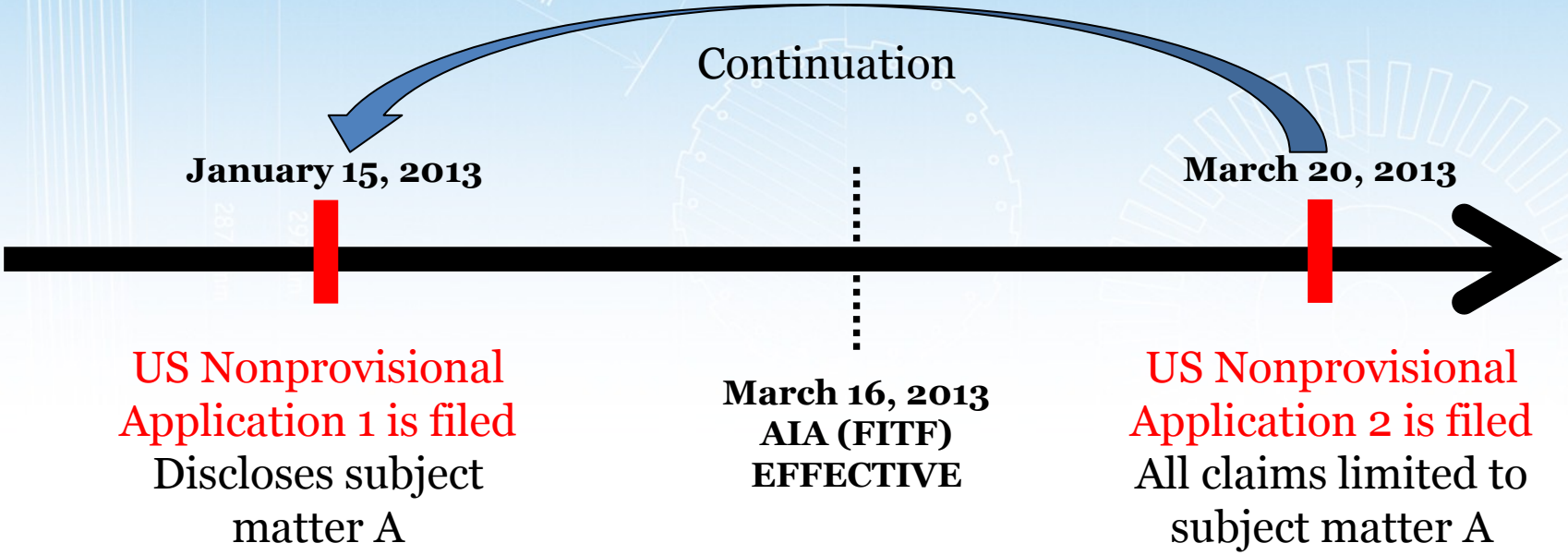
Sample Scenarios

Scenario A.1



Question A.1 — YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

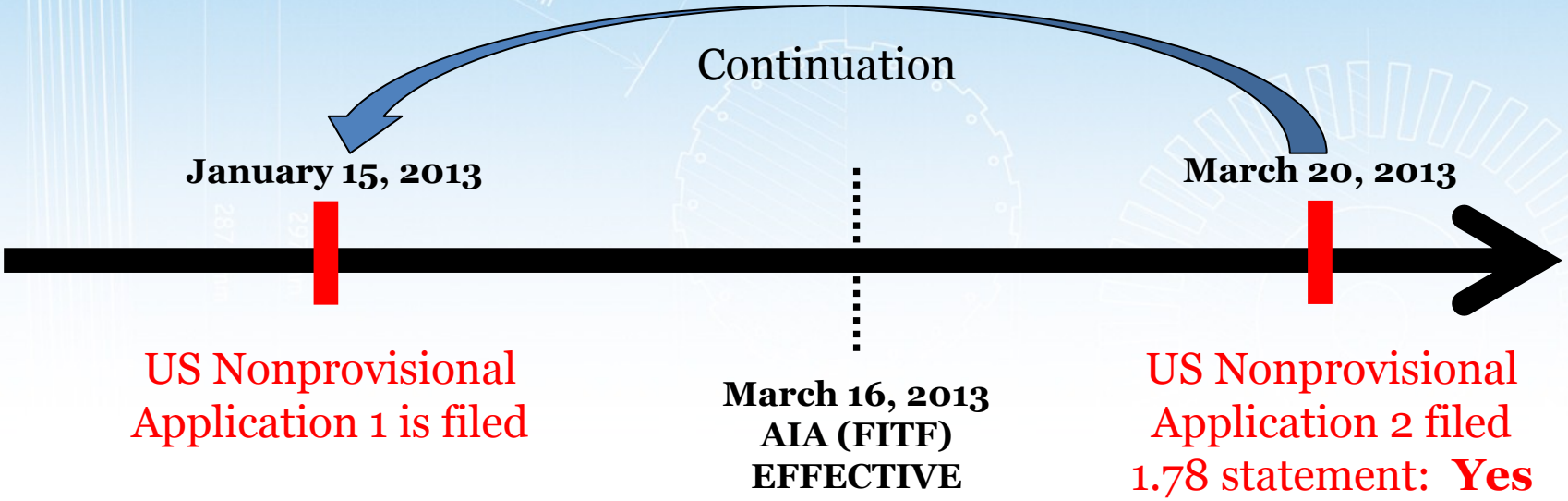
Scenario A.1



Question A.1 — Should the Applicant make a 1.78 statement in Application 2?

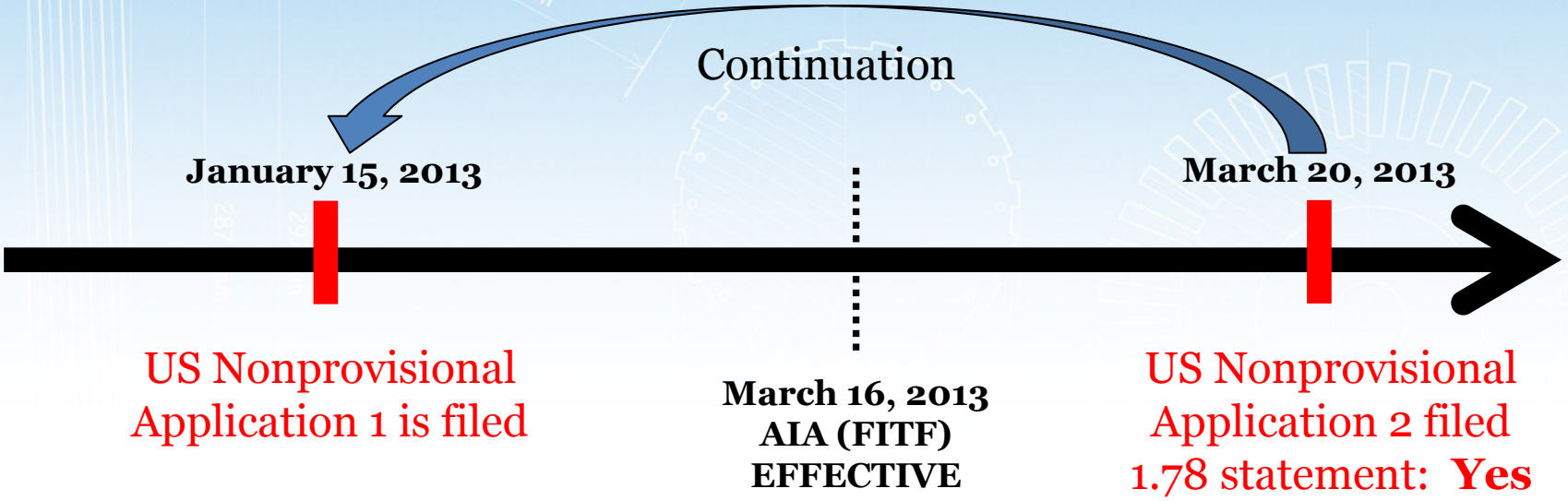
Answer A.1 — NO. Although Application 2 is filed after the AIA (FITF) effective date as transition application, there is no claimed invention with an effective filing date on or after 3/16/13.

Scenario A.2



Question A.2 – YES OR NO? If the 1.78 statement was provided by the applicant, will the Office designate Application 2 as Pre-AIA?

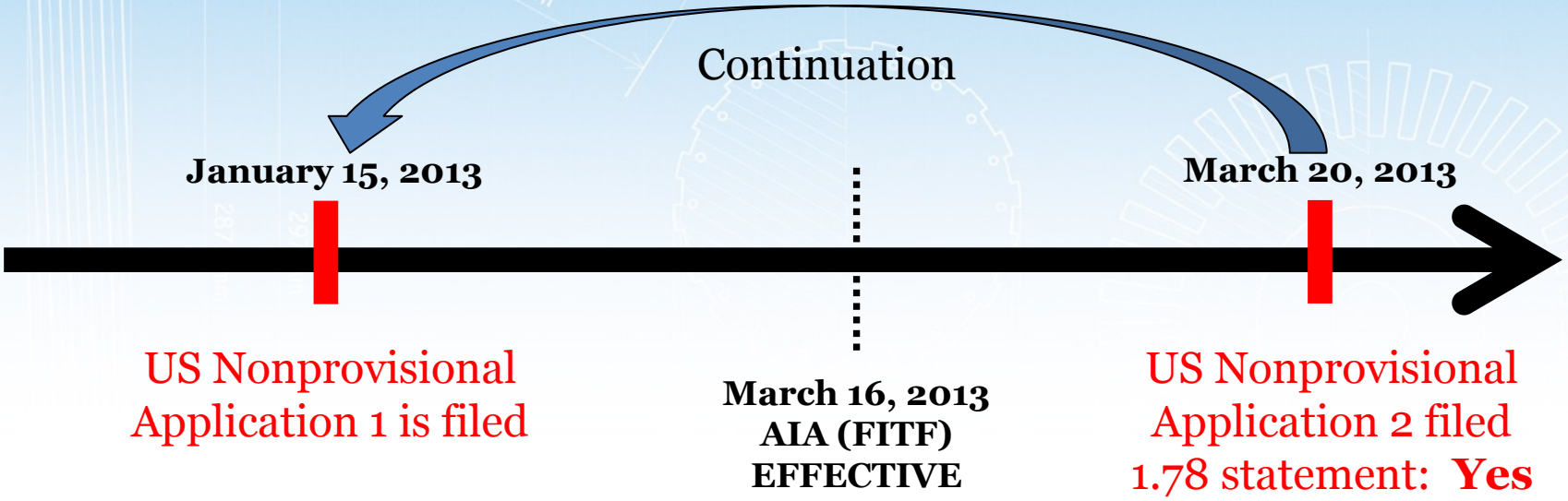
Scenario A.2



Question A.2 — Will the Office designate this application as pre-AIA?

Answer A.2 — NO. The Office will designate Application 2 as AIA (FITF). However, a conflict exists between the domestic benefit relationship and the 1.78 statement.

Scenario A.2



CON/DIV Conflict – if identified, the Office will resolve by notifying applicant and designating the application as pre-AIA despite Applicant's 1.78 statement

Conflict Between CON/DIV Benefit Claim and 1.78 Statement

CON/DIV conflict letter

Application Identified as a Pre-AIA Application

Despite the 37 CFR 1.55 or 1.78 Statement of Record

The statement under 37 CFR 1.55 or 1.78 ("the 1.55/1.78 statement") and the domestic benefit/national stage information in this application conflict as to whether this application is to be examined under the AIA (First Inventor to File) or pre-AIA (First to Invent) law.

This application, with a filing date on or after March 16, 2013, contains the 1.55/1.78 statement indicating that this application should be examined under the AIA (First Inventor to File). This statement was either (1) on the Application Data Sheet (ADS) by virtue of the 1.55/1.78 statement for AIA (First Inventor to File) Transition Applications check box being selected or (2) in an otherwise filed paper. The 1.55/1.78 statement provided:

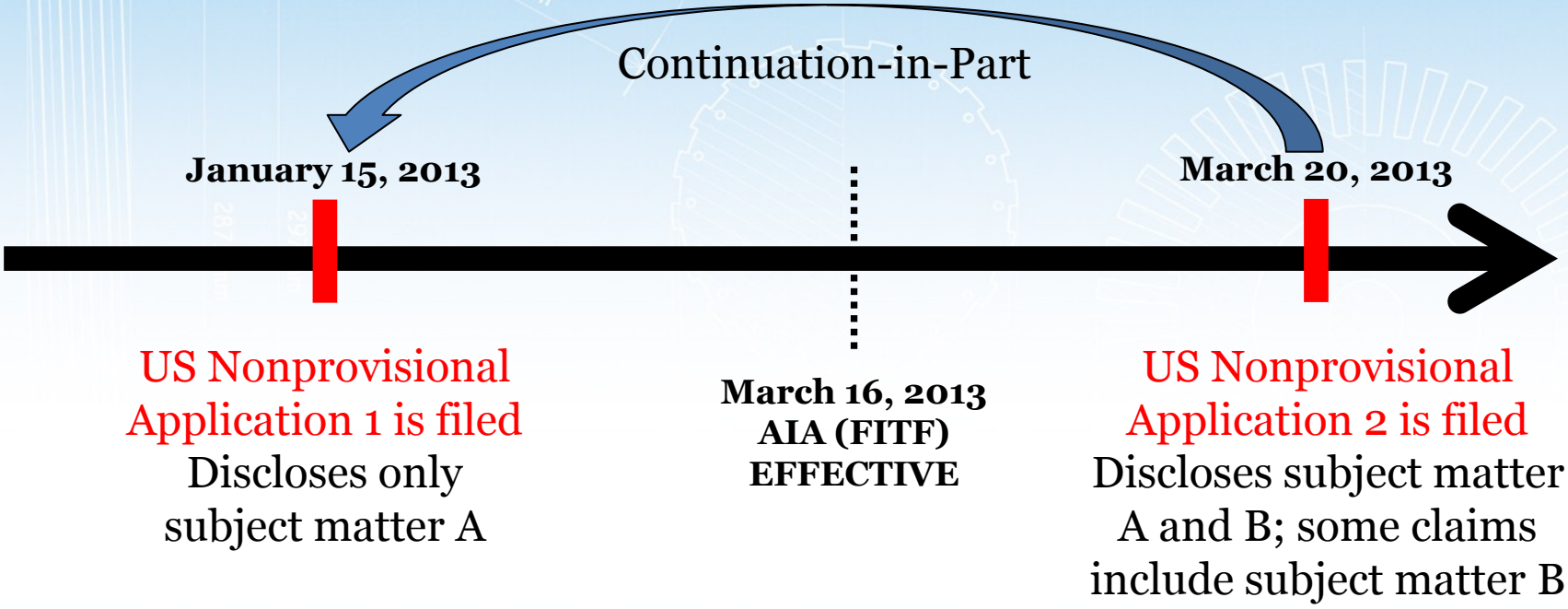
> This application * * * contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

However, this application is separately identified in the Domestic Benefit/National Stage Information section of the ADS as a continuation (CON) or divisional (DIV) of an application filed before March 16, 2013, indicating that this application should be examined under pre-AIA . . .

"Take Home"

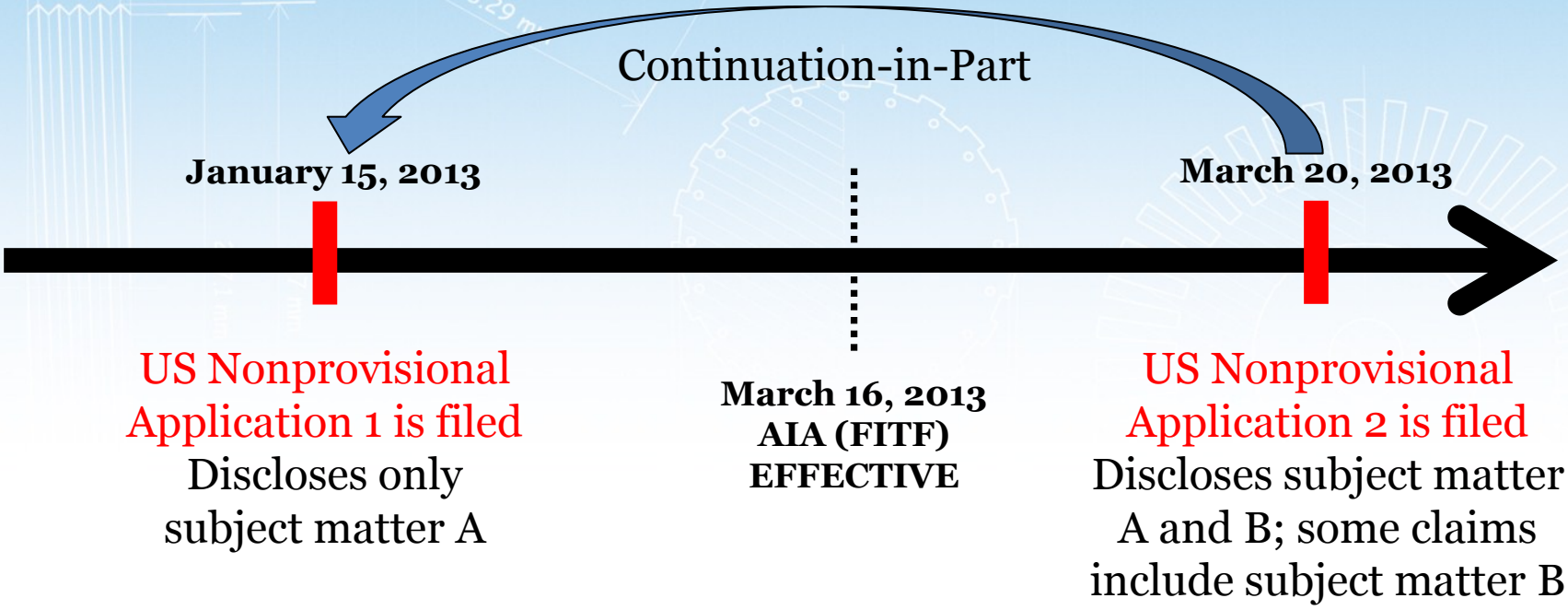
- Prior to filing an ADS, review the check box next to the 1.55/1.78 statement
- Do NOT check the 1.55/1.78 statement in transition applications that are proper CONs or DIVs of a parent application filed prior to March 16, 2013.
  - Since March 16, 2013, we have mailed CON/DIV conflict letters and changed the AIA indicator in over 2,000 applications.

Scenario B.1



Question B.1 — YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

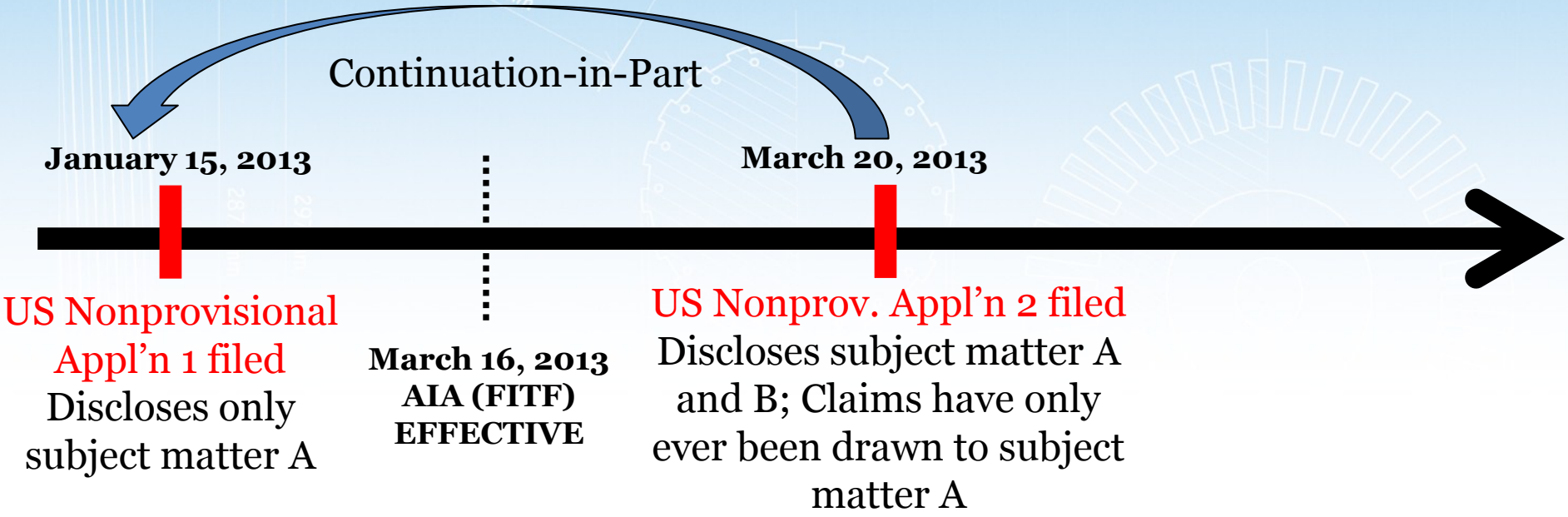
Scenario B.1



Question B.1 — Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

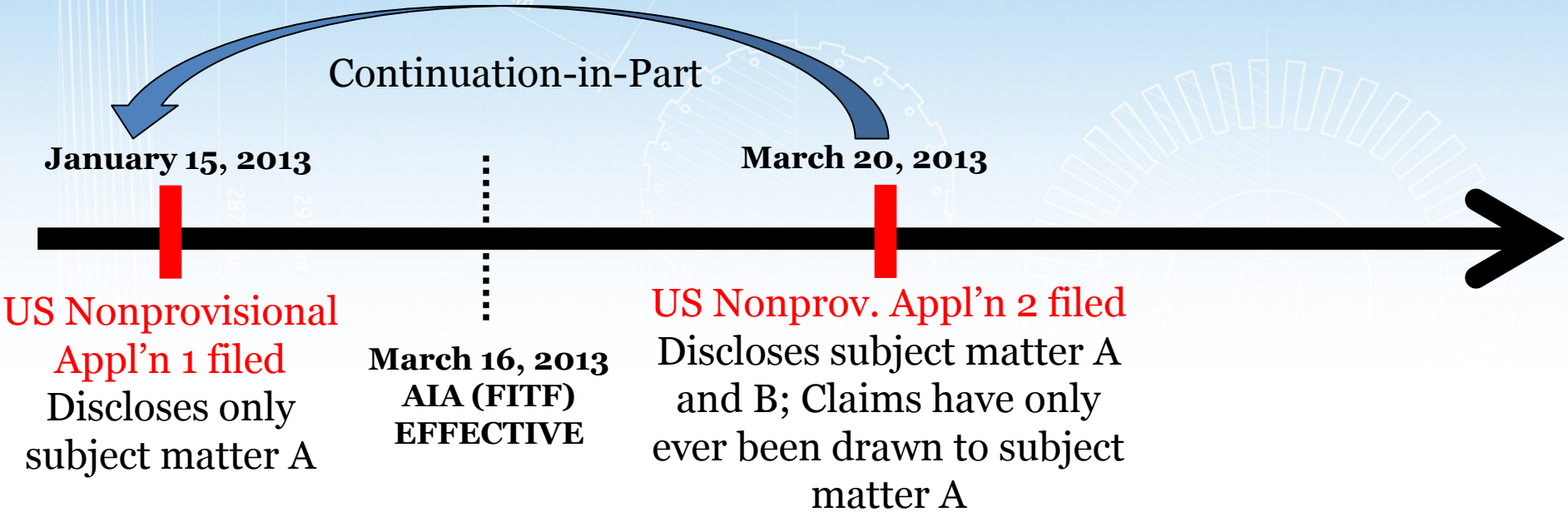
Answer B.1 — YES. It is a transition application and there is at least one claimed invention having an effective filing date on or after 3/16/13.

Scenario B.2



Question B.2 — YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

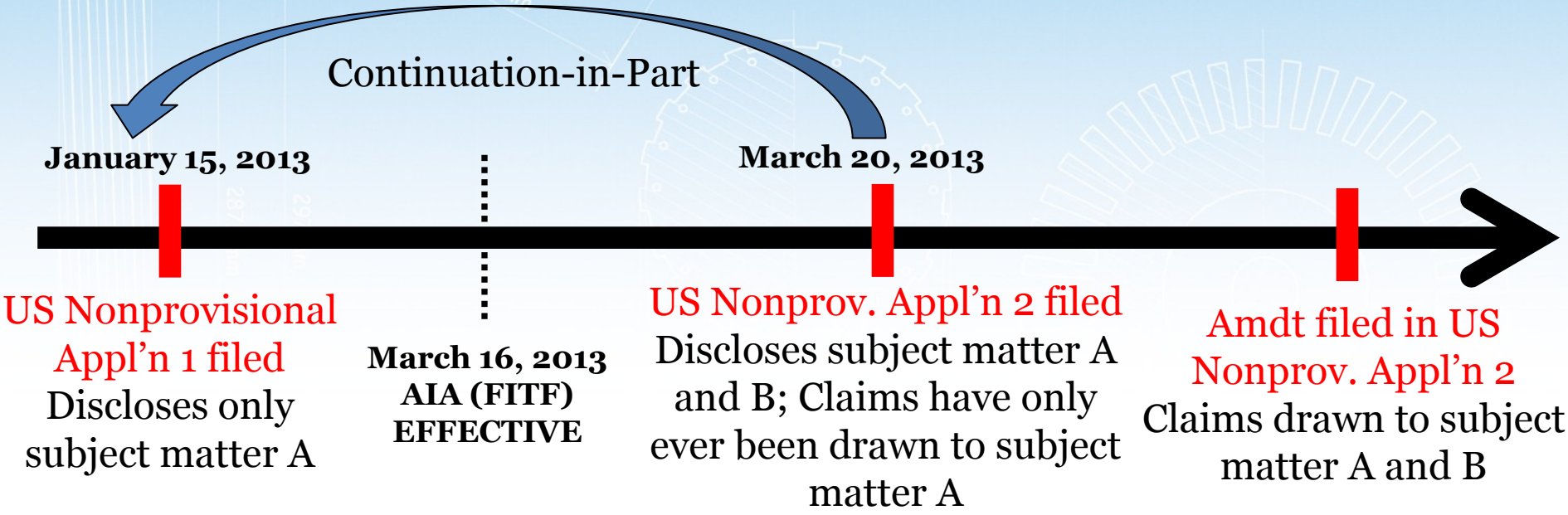
Scenario B.2



Question B.2 — Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

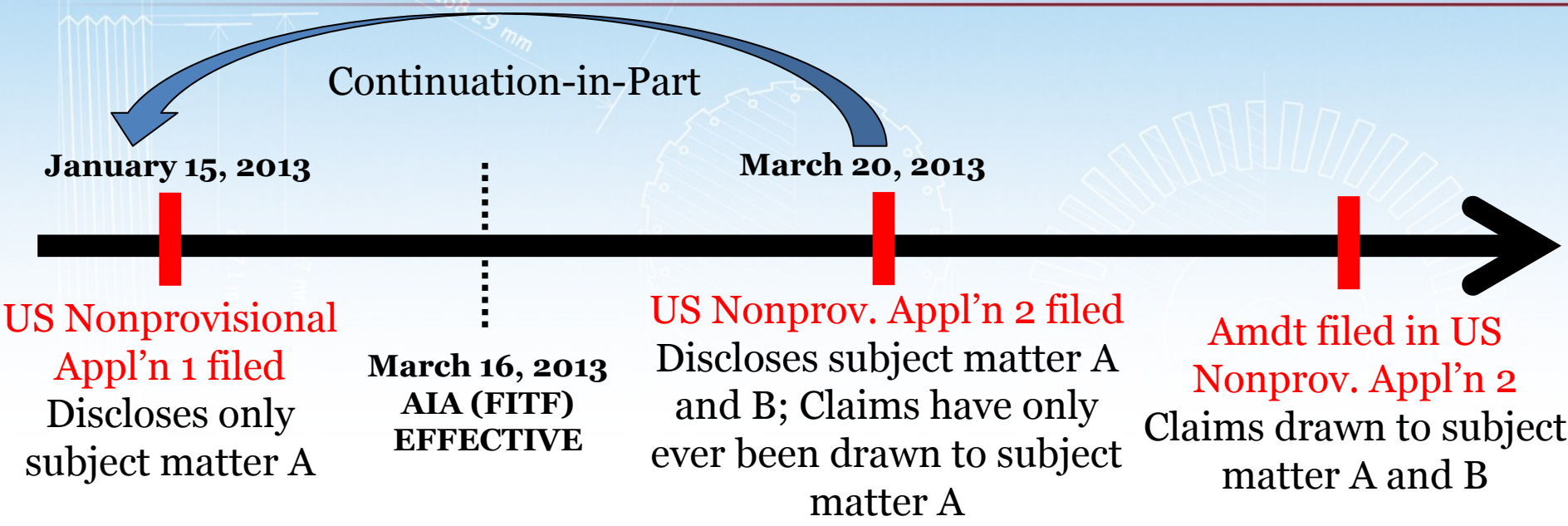
Answer B.2 — NO. Although it is an Transition Application, there is no claimed invention with an effective filing date on or after 3/16/13.

Scenario B.3



Question B.3 — YES OR NO? When the amendment is filed, should the Applicant make a 1.78 statement in Application 2 resulting in Application 2 being designated as AIA (FITF)?

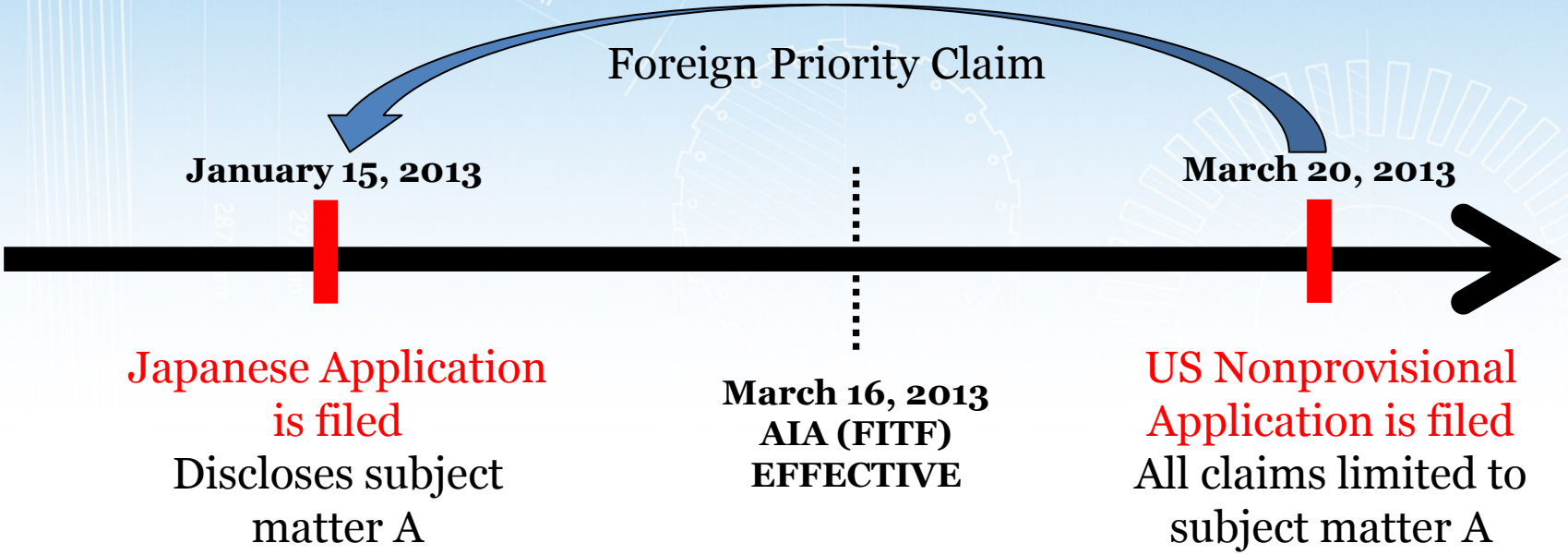
Scenario B.3



Question B.3 — When the amendment is filed, should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

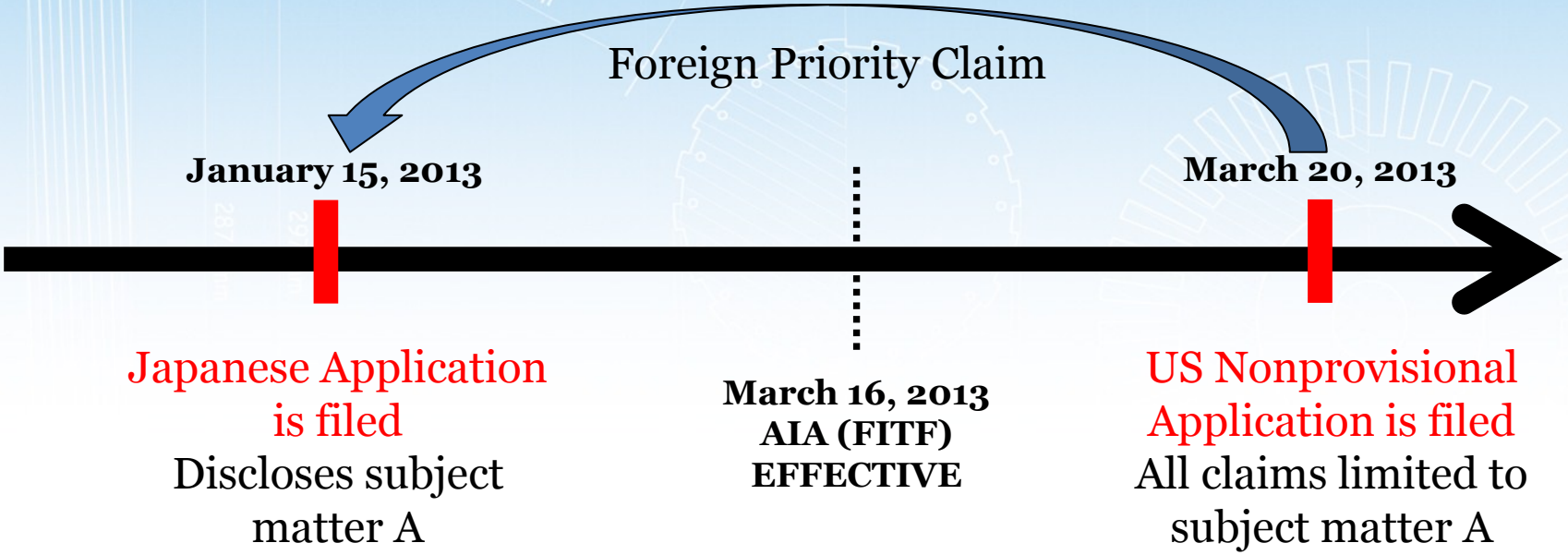
Answer B.3 — YES. The statement should be filed with the amendment either in a separate paper or by corrected ADS.

Scenario C.1



Question C.1 — YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

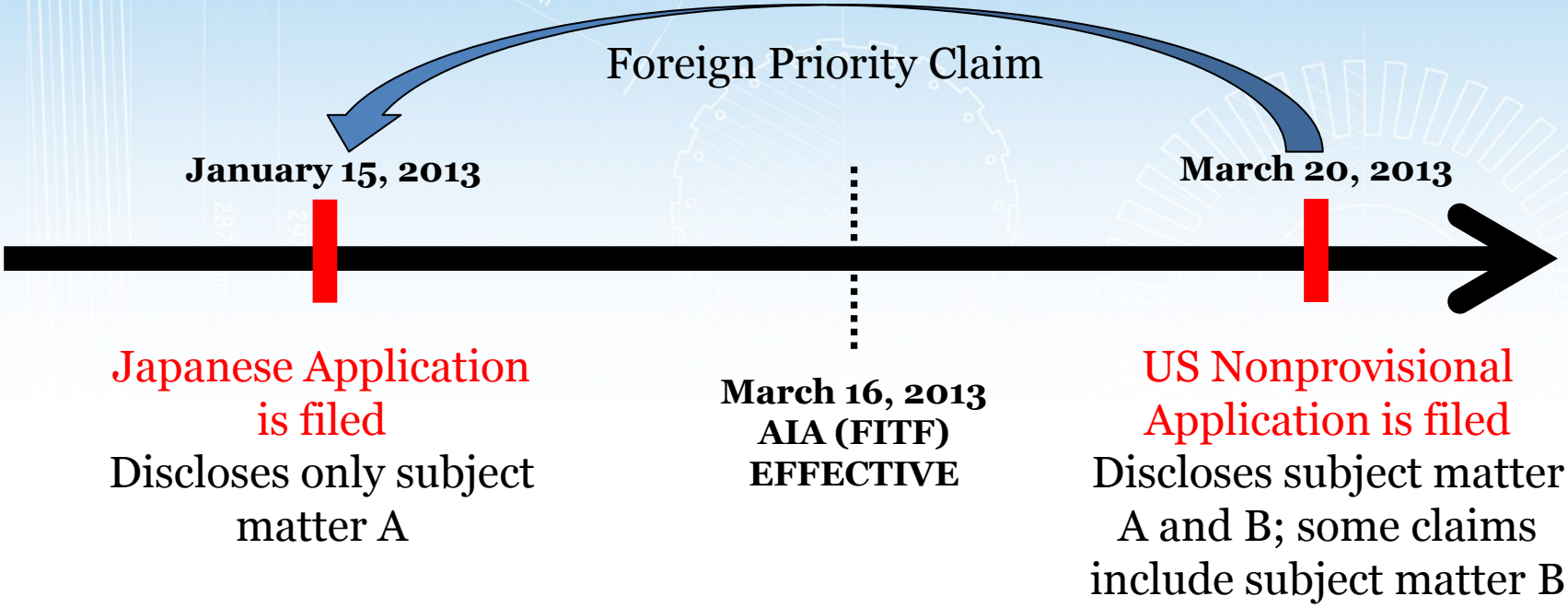
Scenario C.1



Question C.1 — Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

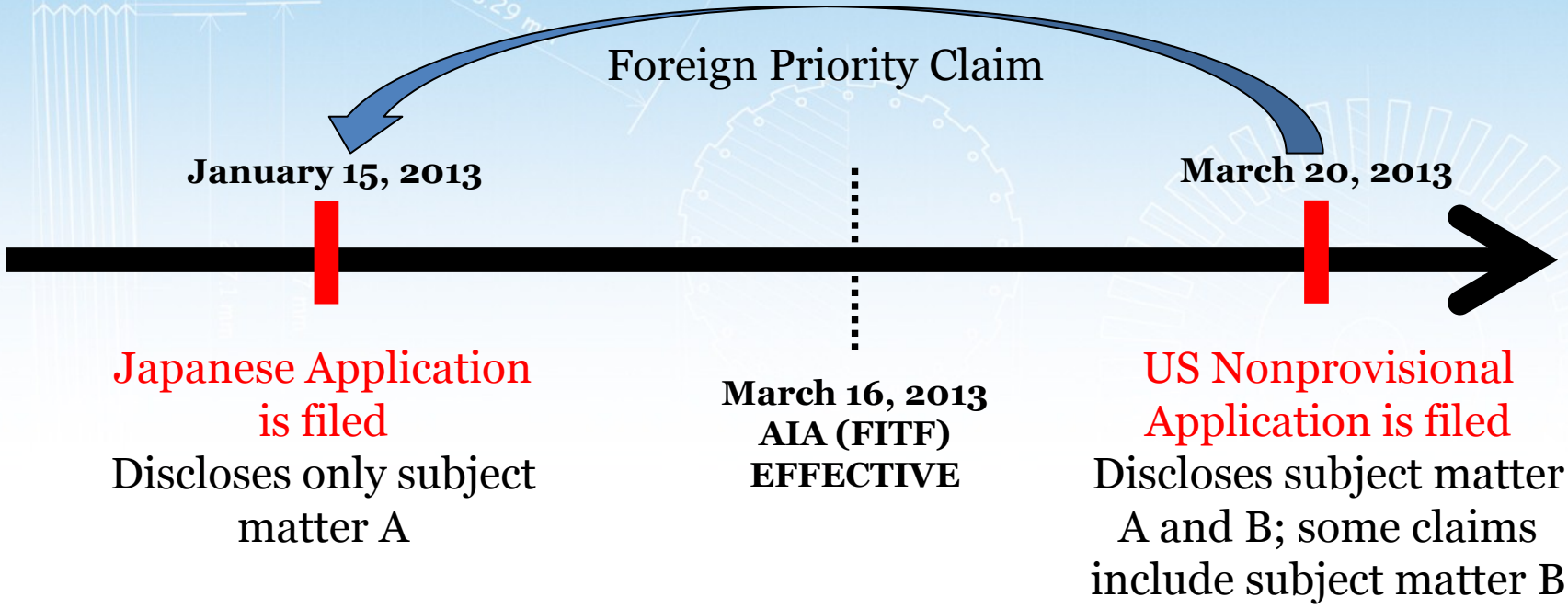
Answer C.1 — NO. Although it is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.

Scenario C.2



Question C.2 — YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated AIA?

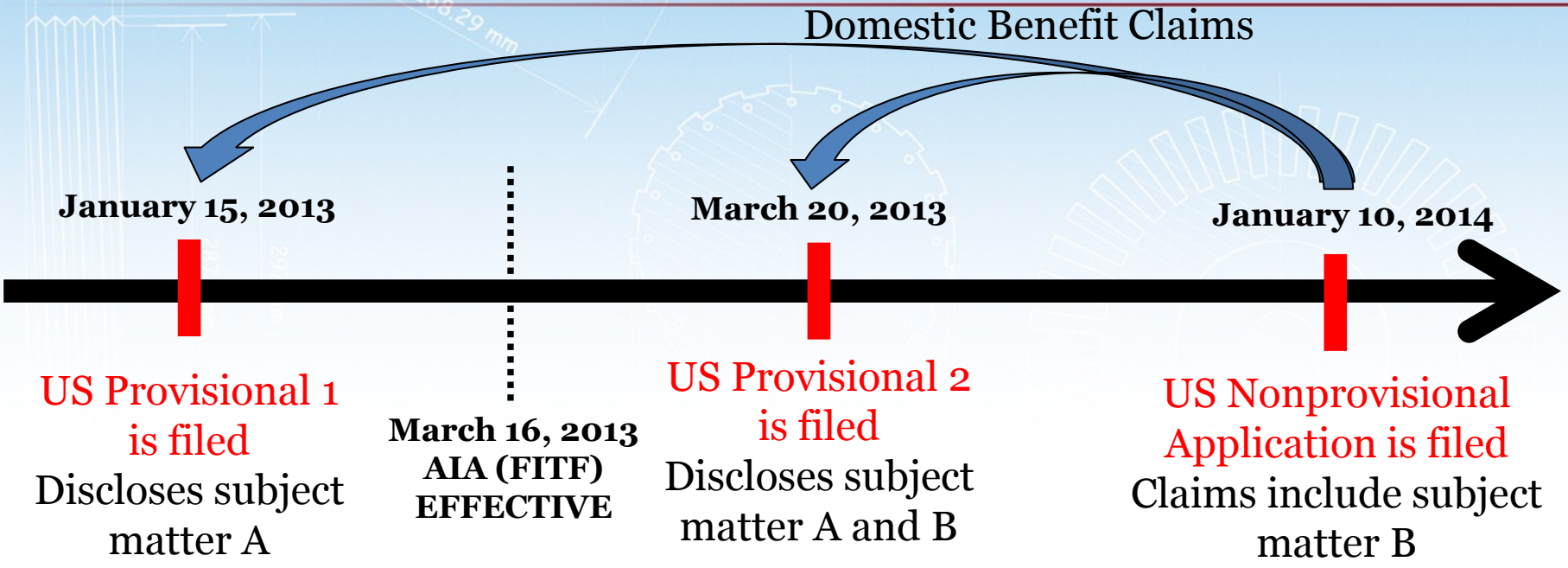
Scenario C.2



Question C.2 — Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

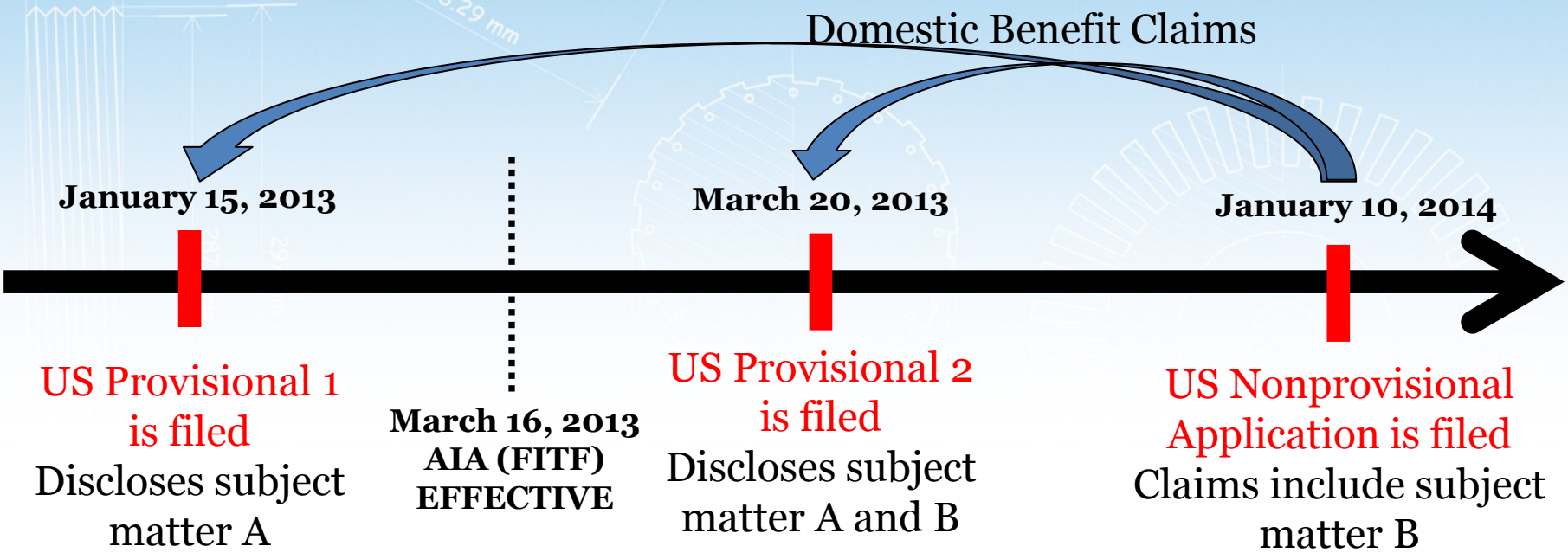
Answer C.2 — YES. It is a transition application and there is at least one claimed invention having an effective filing date on or after 3/16/13.

Scenario D.1



Question D.1 — YES OR NO? Should the Applicant make a 1.78 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

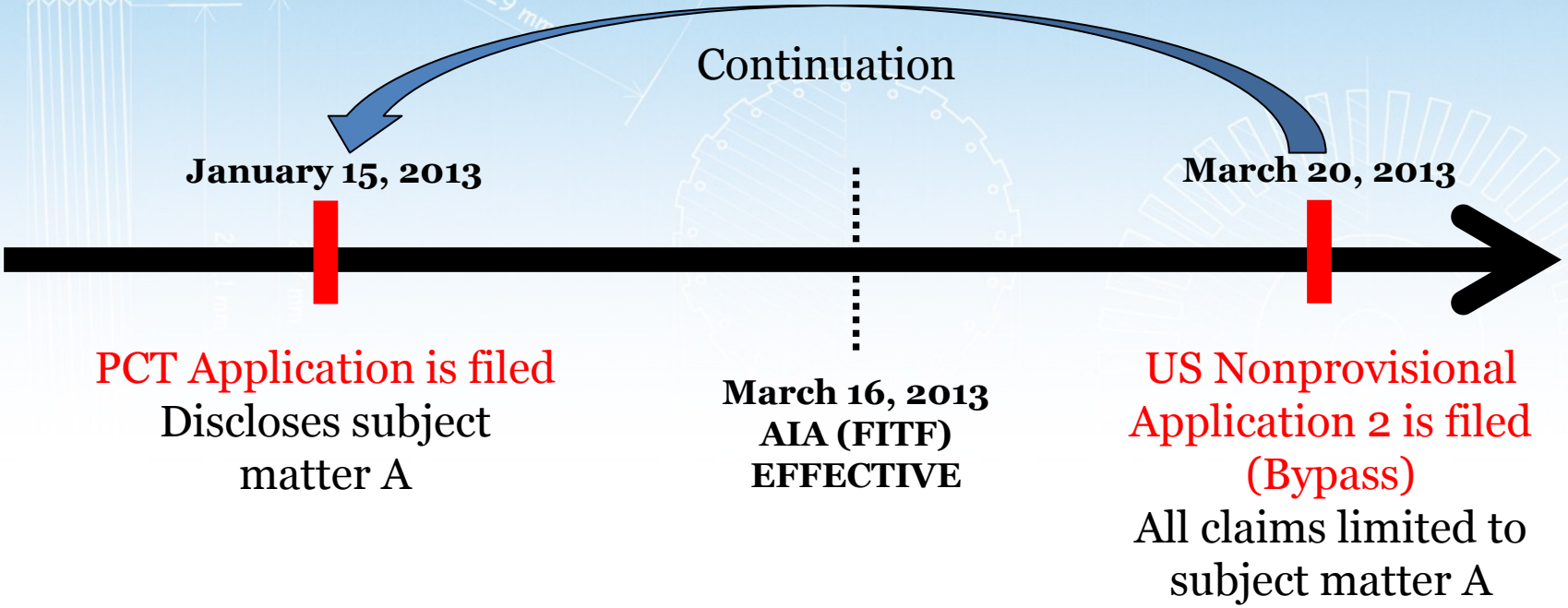
Scenario D.1



Question D.1 — Should the Applicant make a 1.78 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

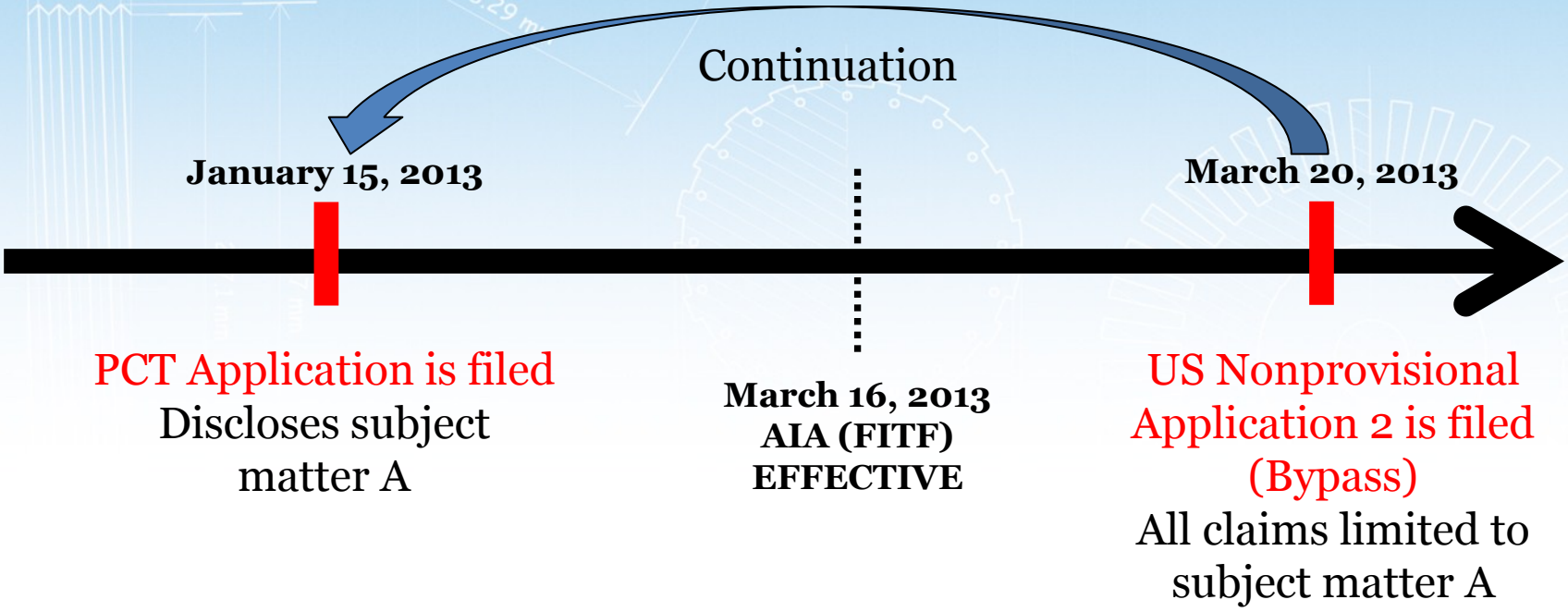
Answer D.1 — YES. It is a transition application with at least one claimed invention having an effective filing date on or after 3/16/13.

Scenario E.1



Question E.1 – YES OR NO? Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

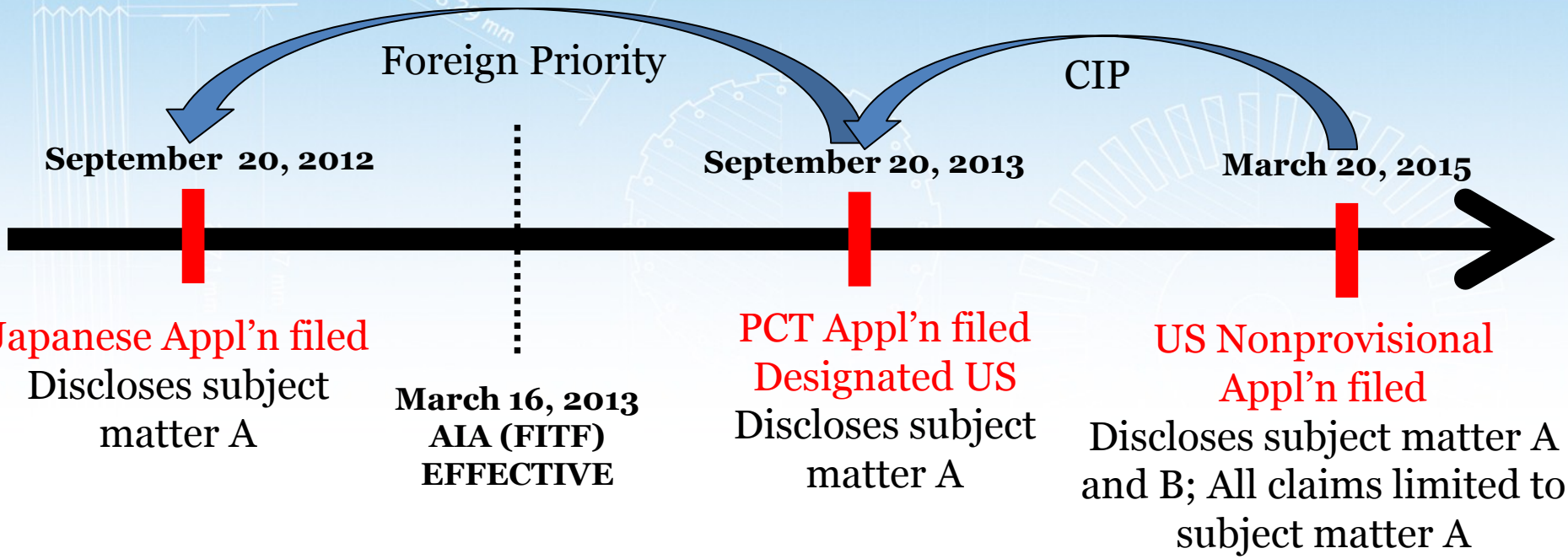
Scenario E.1



Question E.1 — Should the Applicant make a 1.78 statement in Application 2 resulting in the application being designated as AIA (FITF)?

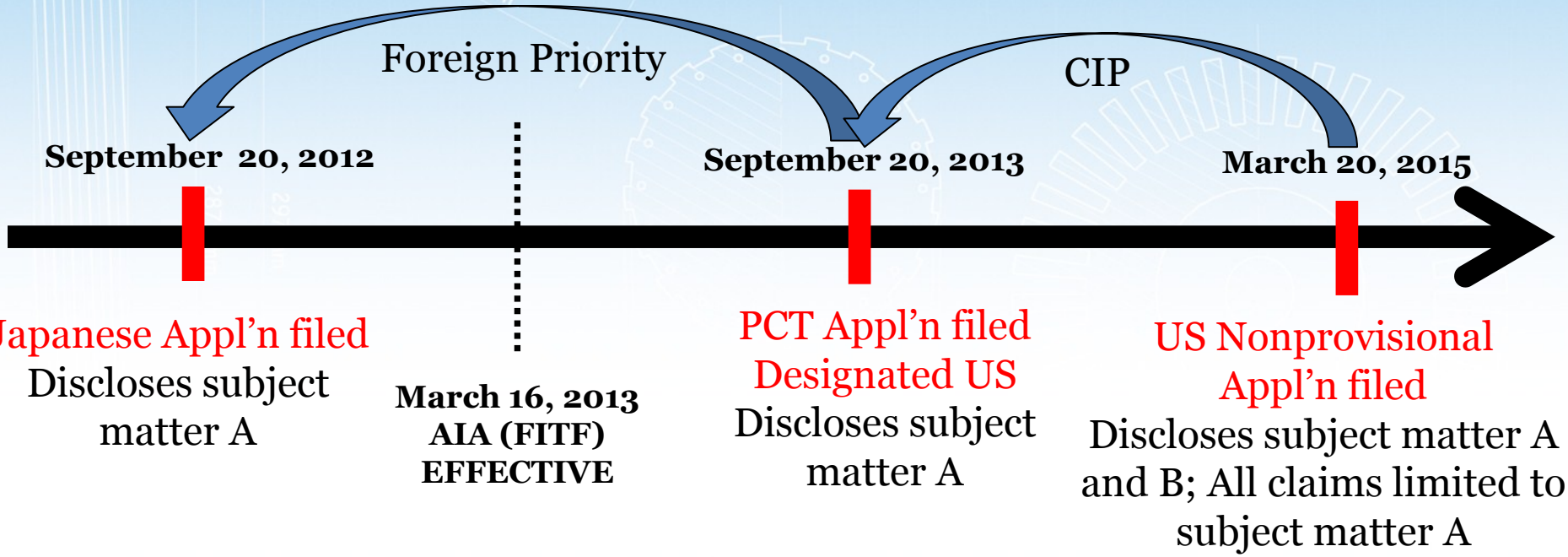
Answer E.1 — NO. Although Application 2 is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.

Scenario E.2



Question E.2 — YES OR NO? Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

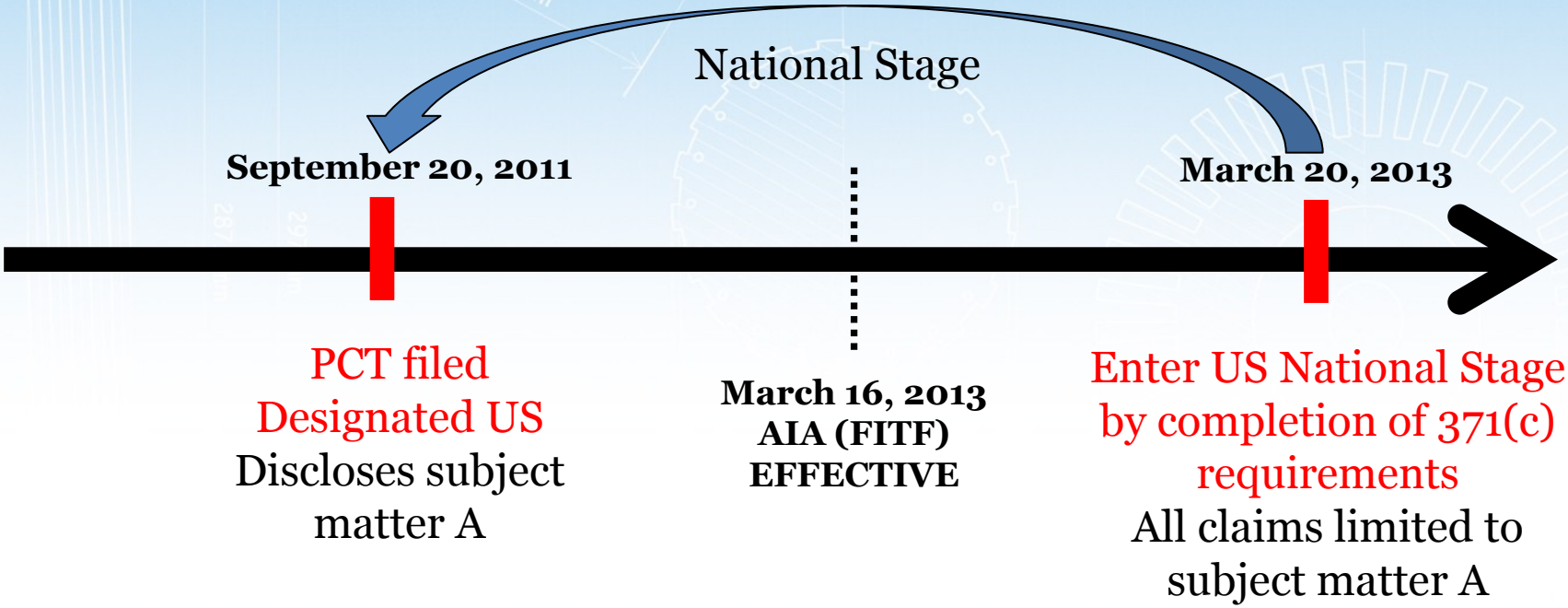
Scenario E.2



Question E.2 — Should the Applicant make a 1.55 statement in the Nonprovisional Application resulting in the application being designated as AIA (FITF)?

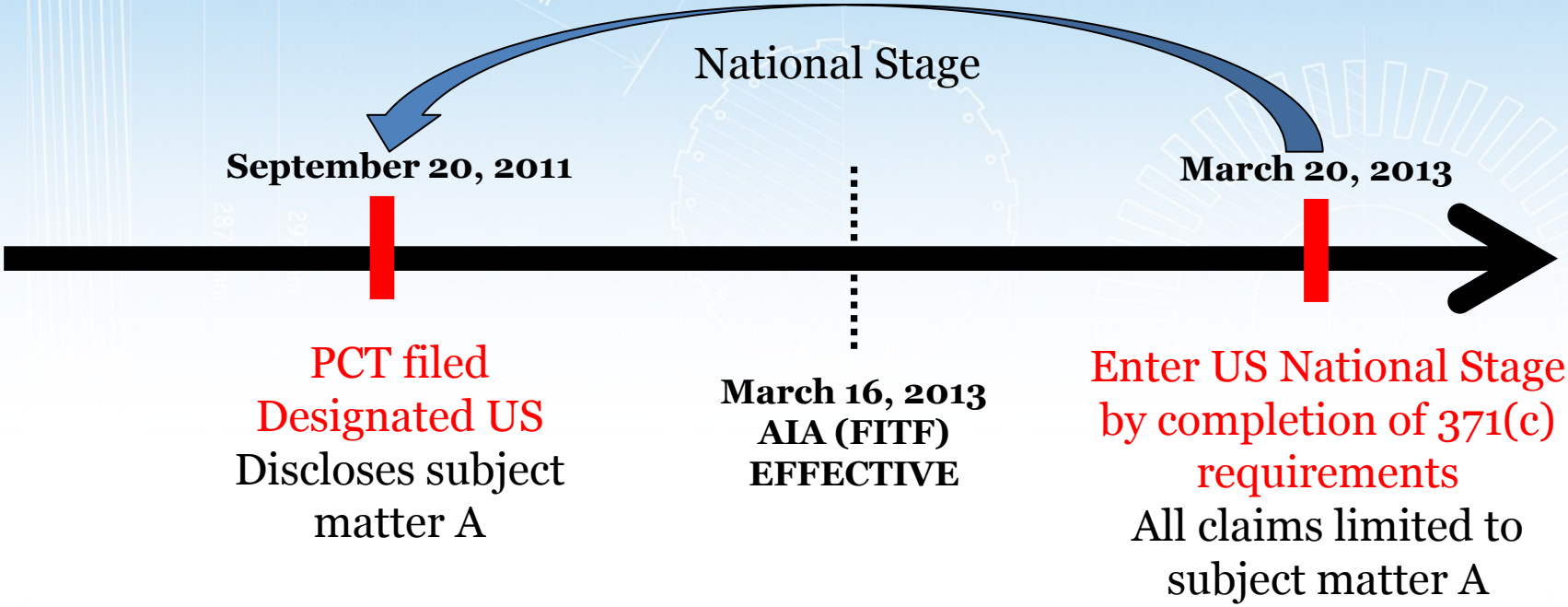
Answer E.2 — NO. Although the Nonprovisional Appl'n is a transition application, there is no claimed invention with an effective filing date on or after 3/16/13.

Bonus Scenario



Bonus Question — YES OR NO? Should the Applicant make a 1.55/1.78 statement resulting in the national stage application being designated as AIA (FITF)?

Bonus Scenario



Bonus Question — Should the Applicant make a 1.55/1.78 statement resulting in the national stage application being designated as AIA (FITF)?

Bonus Answer: NO. The 371 National Stage Application is not a transition application since its filing date is the filing date of the PCT.

Summary of "Take Homes"

- Think carefully about the 1.55/1.78 statement in a transition application
  - Effective filing dates are determined on a claim-by-claim basis
  - It only takes one claim with an effective filing date on or after March 16, 2013 to make the application an AIA (FITF) application

- Continuation-in-part transition applications filed on or after March 16, 2013 are not automatically AIA (FITF).

- Transition applications that claim foreign priority to/benefit of an application filed before March 16, 2013 are not always Pre-AIA (First to Invent).

- Transition CON or DIV applications that include the 1.78 statement appear to be in conflict. A proper transition CON or DIV application would add no new subject matter as compared with the parent, so the effective filing date of all the claims would be prior to March 16, 2013.

AMERICA INVENTS ACT
IMPLEMENTATION

FITF Overview and Tips on Responding to Prior Art Rejections

Potential Prior Art Is Identified in 35 U.S.C. 102(a)(1) and 102(a)(2)

Only two subsections of the AIA identify potential prior art:

- **102(a)(1)** is for **public disclosures** that have a public availability date *before the effective filing date* of the claimed invention under examination.

- **102(a)(2)** is for issued or published **U.S. patent documents** that are by another and that have an effectively filed date that is *before the effective filing date* of the claimed invention under examination.

Effective Filing Date under the AIA

- The availability of a disclosure as prior art under 102(a)(1) or 102(a)(2) depends upon the effective filing date (EFD) of the claimed invention.
- Unlike pre-AIA law, the AIA provides that a foreign priority date can be the effective filing date of a claimed invention.
- **During examination, the foreign priority date is treated as the effective filing date of the claimed invention IF**
  - the foreign application supports the claimed invention under 112(a), AND
  - the applicant has perfected the right of priority by providing:
    - a certified copy of the priority application, and
    - a translation of the priority application (if not in English).

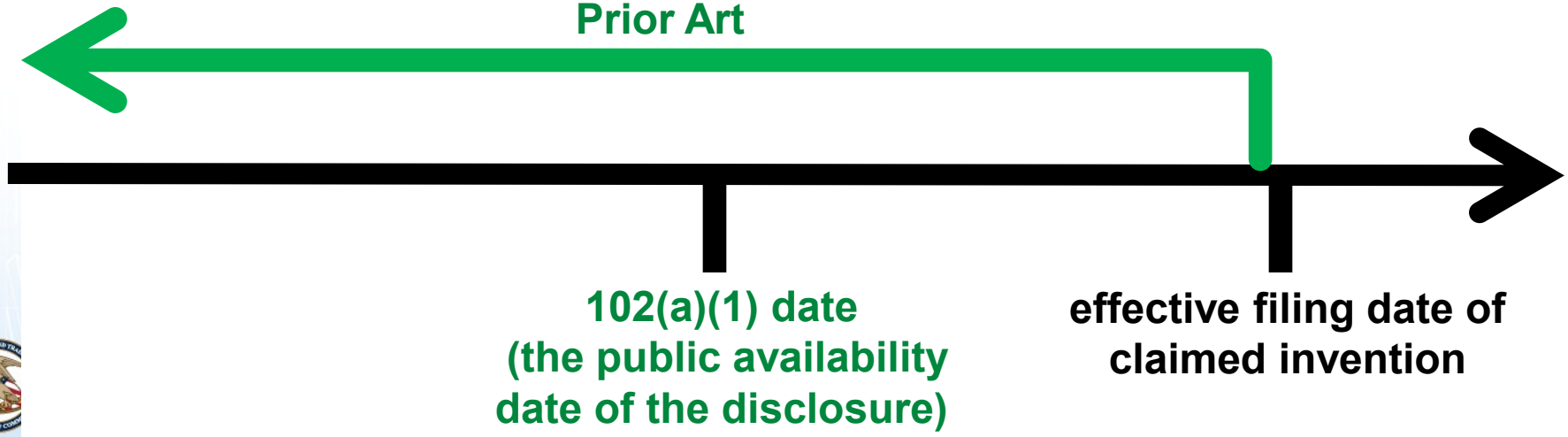
AIA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	**102(b)(1)**	**(A)** Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	**102(b)(2)**	**(A)** Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures

35 U.S.C. 102(a)(1): Public Disclosure with Public Availability Date before the Effective Filing Date of the Claimed Invention

102(a)(1) potential prior art includes **public disclosures** that have a public availability date before the effective filing date of the claimed invention and are:

- patented;
- described in a printed publication;
- in public use;
- on sale; or
- otherwise available to the public.



102(b)(1)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(A) exception to apply to a public disclosure under 102(a)(1), the public disclosure must be:

- within the grace period and

- an "inventor-originated disclosure" (i.e., the subject matter in the public disclosure must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly or indirectly from the inventor or a co-inventor).

102(b)(1)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(1)

For the 102(b)(1)(B) exception to apply to a third party's disclosure under 102(a)(1):

- the third party's disclosure must have been made during the grace period of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the third party's disclosure, and
- both the third party's disclosure and the inventor-originated disclosure must have disclosed the same subject matter.

Recognizing a 102(b)(1)(A) or 102(b)(1)(B) Exception to a Potential 102(a)(1) Reference

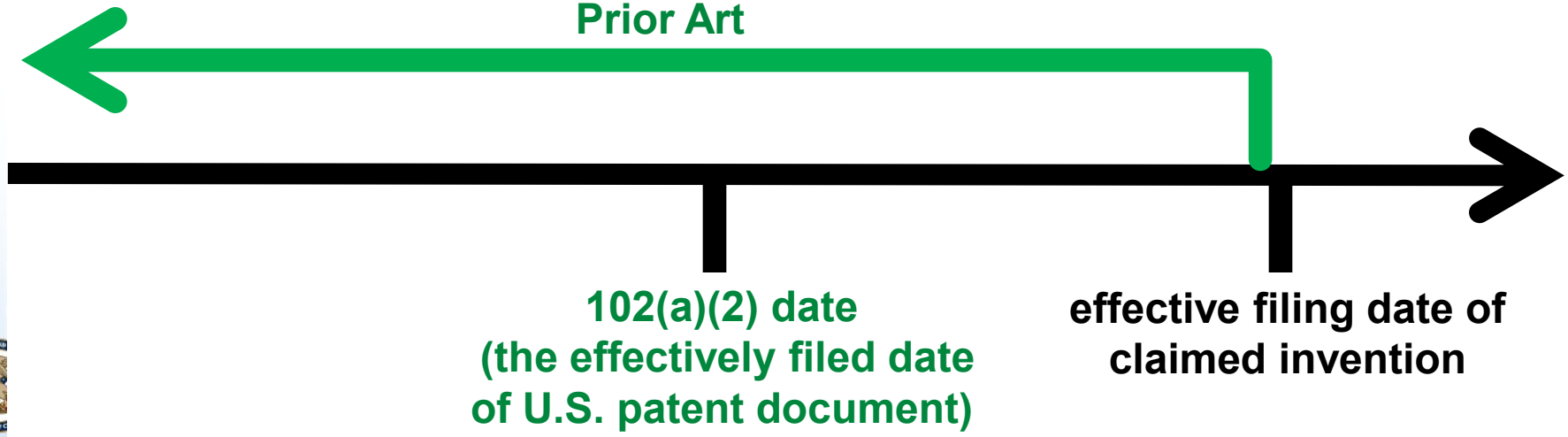
An exception under 102(b)(1)(A) or 102(b)(1)(B) may apply when:

- the authorship/inventorship of the potential reference disclosure only includes one or more joint inventor(s) or the entire inventive entity of the application under examination, or
- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or
- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).

35 U.S.C. 102(a)(2): U.S. Patent Documents with Effectively Filed Date before Effective Filing Date of the Claimed Invention

102(a)(2) potential prior art includes issued or published **U.S. patent documents** that name another inventor and have an effectively filed date before the effective filing date of the claimed invention:

- U.S. Patent;
- U.S. Patent Application Publication; or
- WIPO published PCT (international) application that designates the United States



102(b)(2)(A) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(A) exception to apply to a potential prior art U.S. patent document, the U.S. patent document must:

- disclose subject matter that was obtained from one or more members of the inventive entity, either directly or indirectly.

102(b)(2)(B) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(B) exception to apply to a third party's potential prior art U.S. patent document:

- the third party's U.S. patent document must have been effectively filed before the effective filing date of the claimed invention,
- an inventor-originated disclosure (i.e., shielding disclosure) must have been made prior to the effectively filed date of the third party's U.S. patent document, and
- both the third party's U.S patent document and the inventor-originated disclosure must have disclosed the same subject matter.

Recognizing a 102(b)(2)(A) or 102(b)(2)(B) Exception to a Potential 102(a)(2) Reference

An exception under 102(b)(2)(A) or 102(b)(2)(B) may apply when:

- the inventive entity of the disclosure only includes one or more joint inventor(s), *but not the entire inventive entity*, of the application under examination, or

- there is an appropriate affidavit or declaration under 37 CFR 1.130(a) (attribution) or 1.130(b) (prior public disclosure), or

- the specification of the application under examination identifies the potential prior art disclosure as having been made by or having originated from one or more members of the inventive entity, in accordance with 37 CFR 1.77(b)(6).

102(b)(2)(C) Exception to Potential Prior Art under 35 U.S.C. 102(a)(2)

For the 102(b)(2)(C) exception to apply, the subject matter of the U.S. patent document and the claimed invention in the application under examination must have been:

- owned by the same person,
- subject to an obligation of assignment to the same person, or
- deemed to have been owned by or subject to an obligation of assignment to the same person, in view of a joint research agreement,

not later than the effective filing date of the claimed invention.

Recognizing a 102(b)(2)(C) Exception to a Potential 102(a)(2) Reference

- A statement on the record that either common ownership in accordance with 102(b)(2)(C) or a joint research agreement (JRA) in accordance with 102(c) were in place may be made.
- A declaration or affidavit is not necessary.
- In the case of a JRA, the application must name or be amended to name the parties to the JRA.

AMERICA INVENTS ACT
IMPLEMENTATION

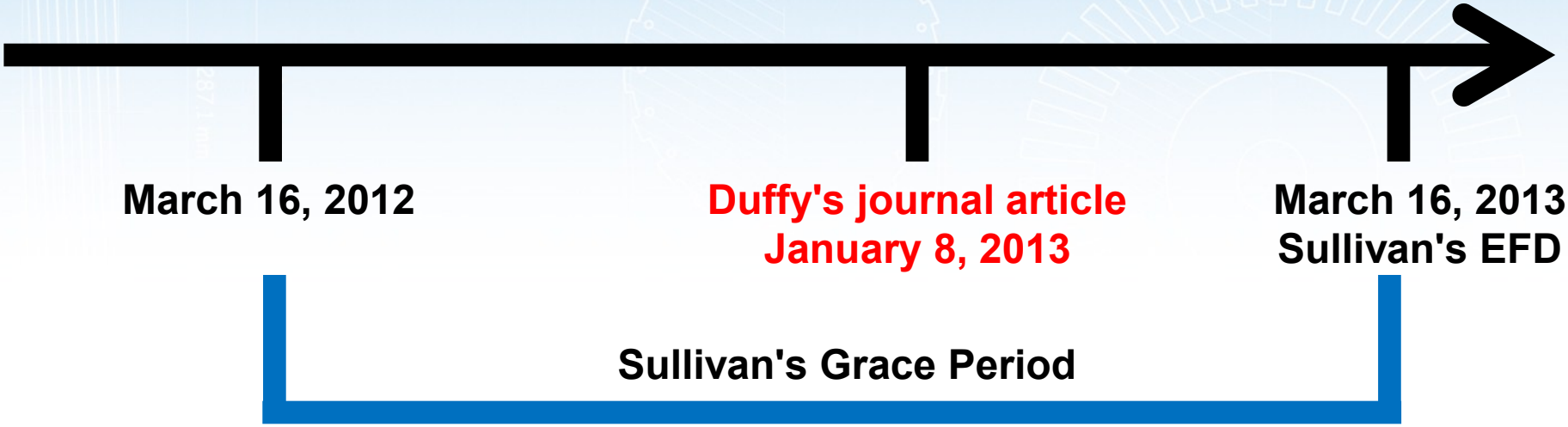
First Inventor To File (FITF)

Sample Scenarios

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)

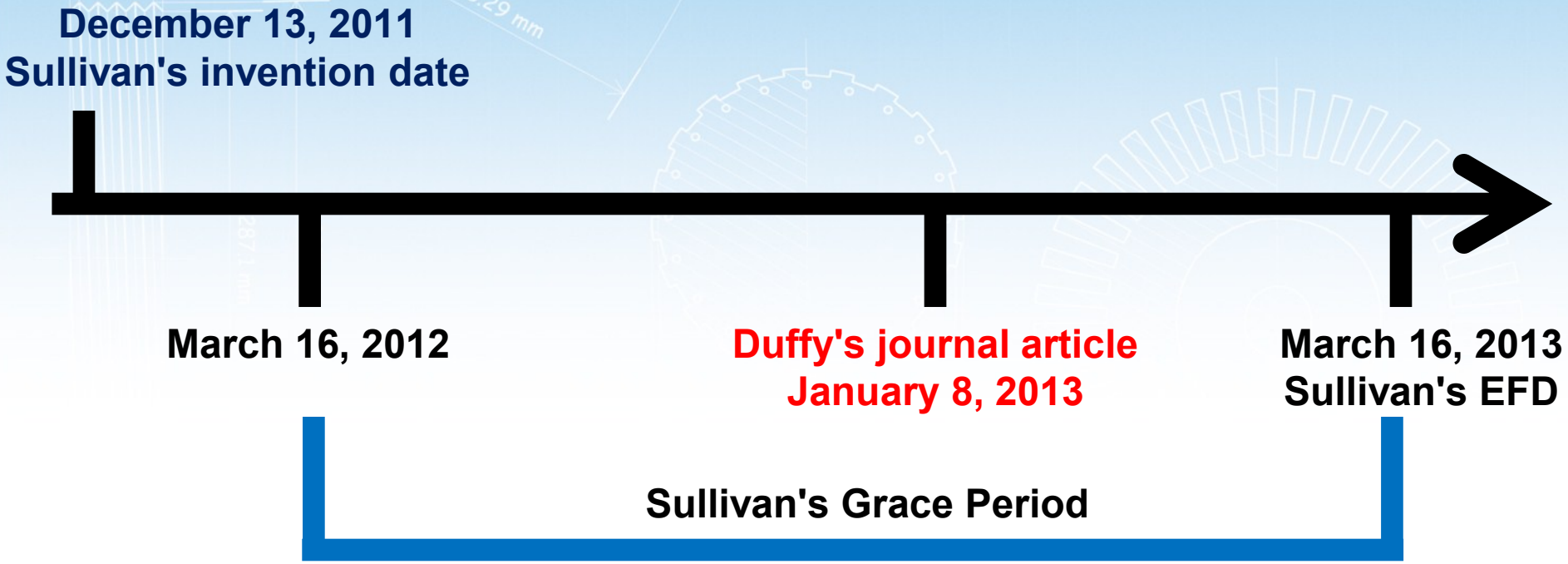
- On March 16, 2013, Sullivan files a nonprovisional utility patent application at the USPTO.
- Sullivan does not assert any foreign priority or domestic benefit under 35 U.S.C. 119, 120, 121, or 365.
- The patent examiner rejects all of the claims as anticipated under 35 U.S.C. 102(a)(1) by a journal article by Duffy, which became available to the public on January 8, 2013.

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



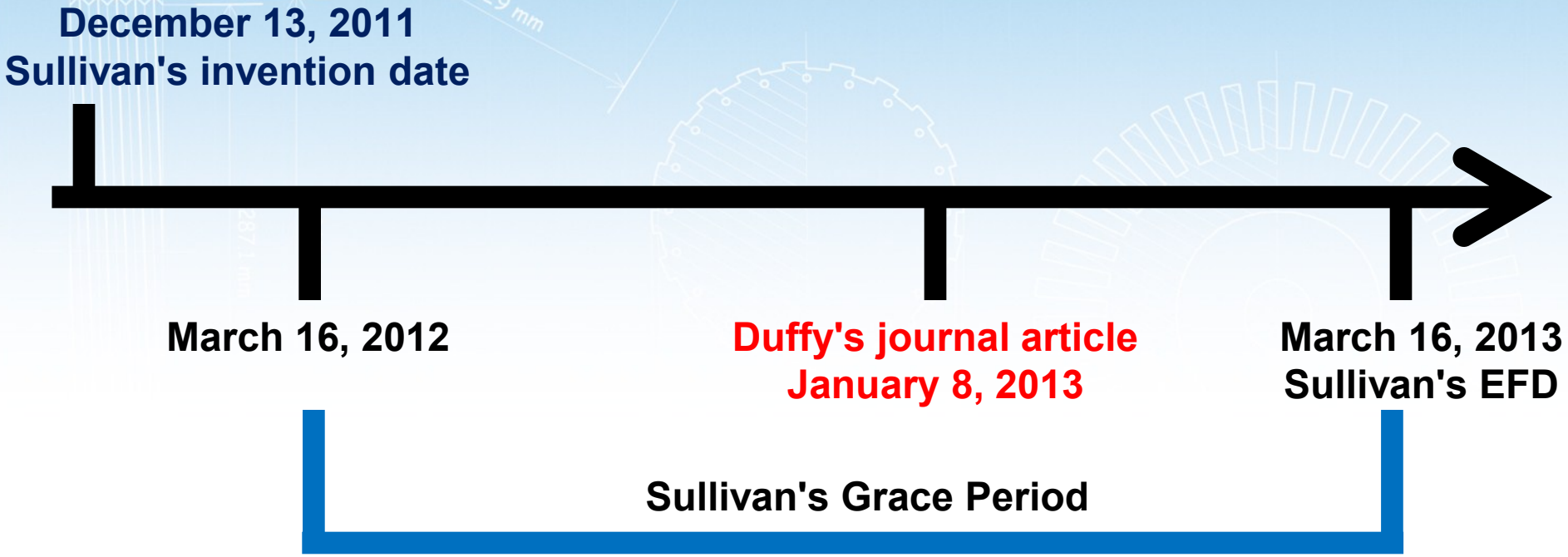
Sullivan receives an Office action rejecting all the claims under 35 U.S.C. 102(a)(1) as anticipated by Duffy. How could Sullivan properly respond to the Office action?

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



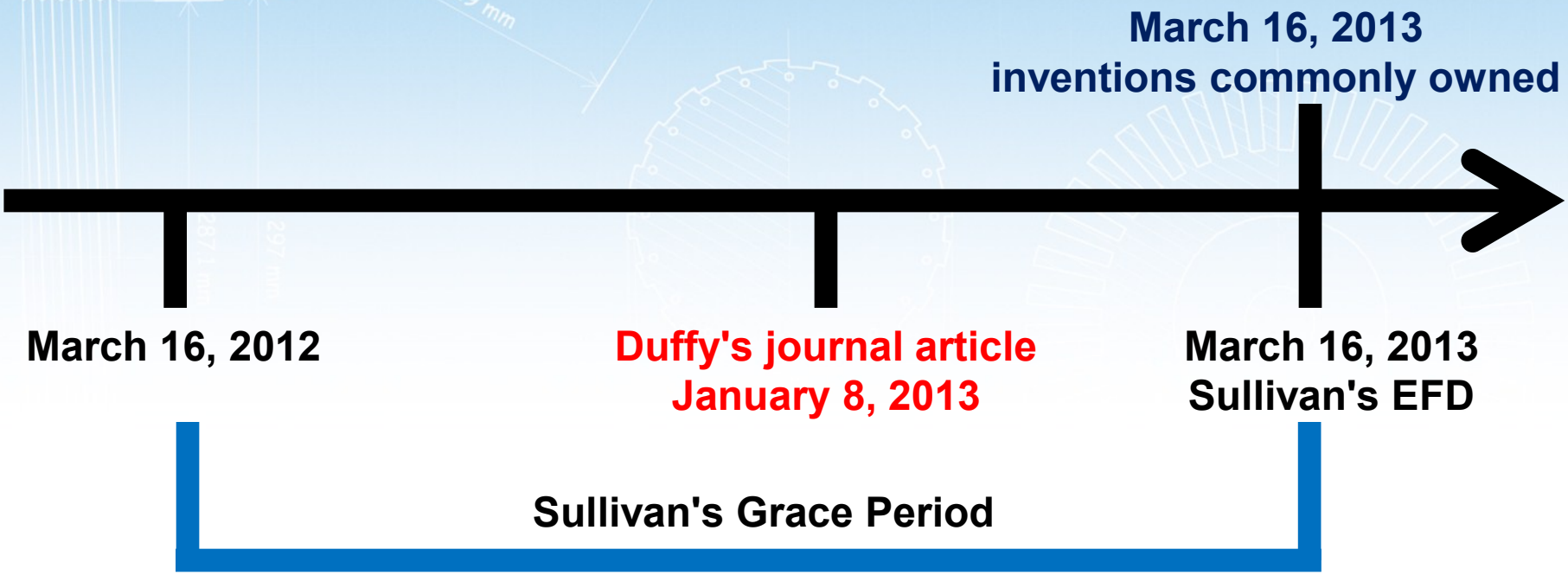
Question: Could Sullivan properly traverse the rejection by presenting a declaration under 37 CFR 1.131 establishing that Sullivan's invention date was December 13, 2011?

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



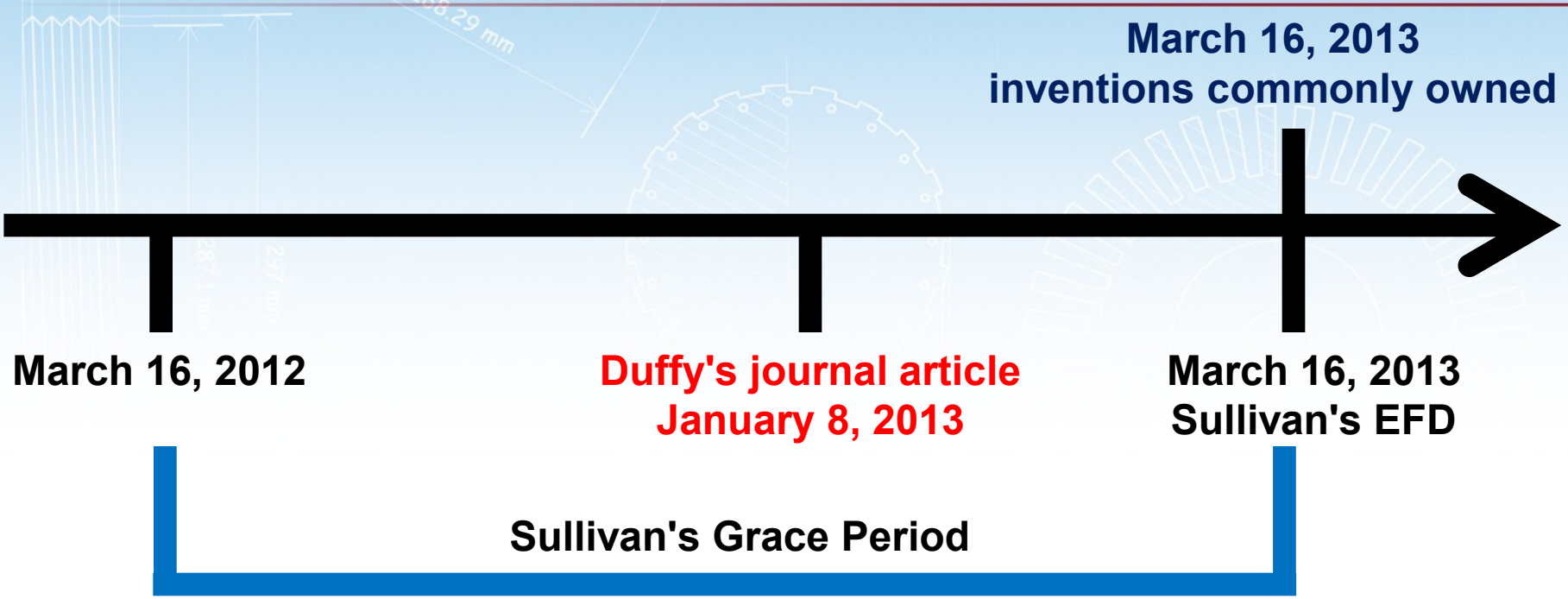
NO. Because the AIA is a first-inventor-to-file system rather than a first-to-invent system, an applicant cannot overcome a reference by showing an earlier date of invention.

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



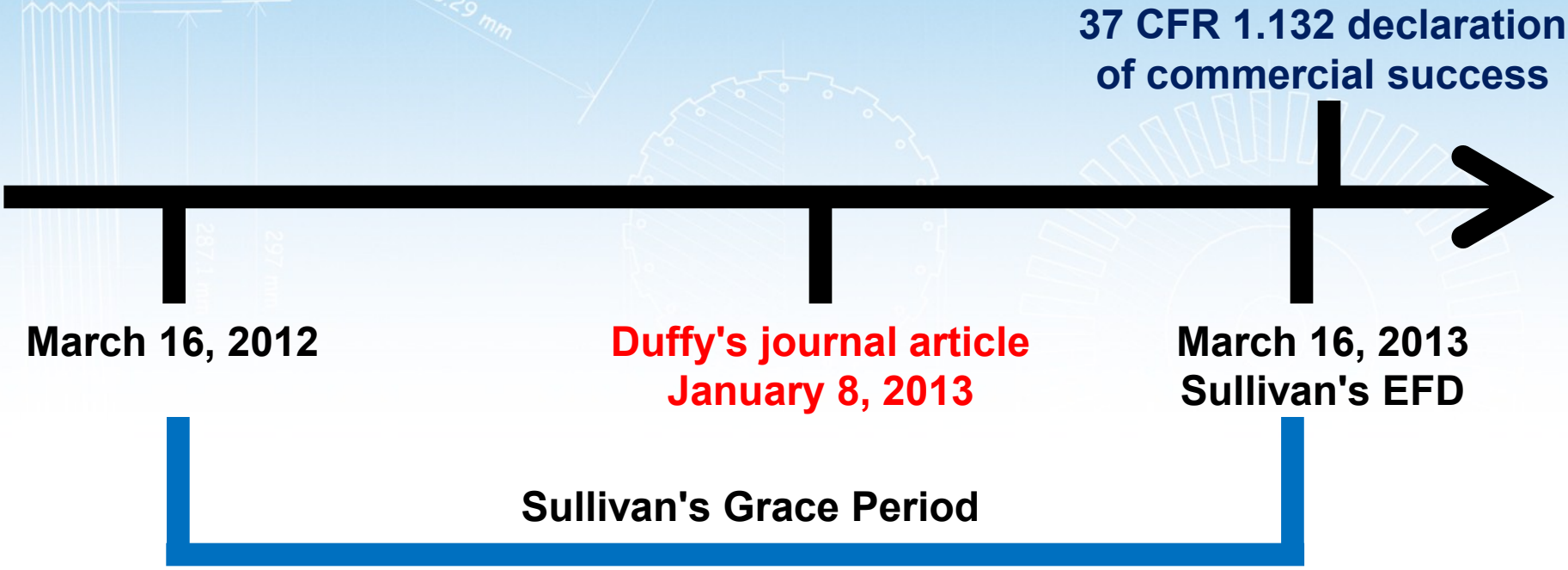
Question: Could Sullivan properly traverse by presenting a statement under 35 U.S.C. 102(b)(2)(C) that the invention in the Duffy article and in the Sullivan application were commonly owned on March 16, 2013?

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



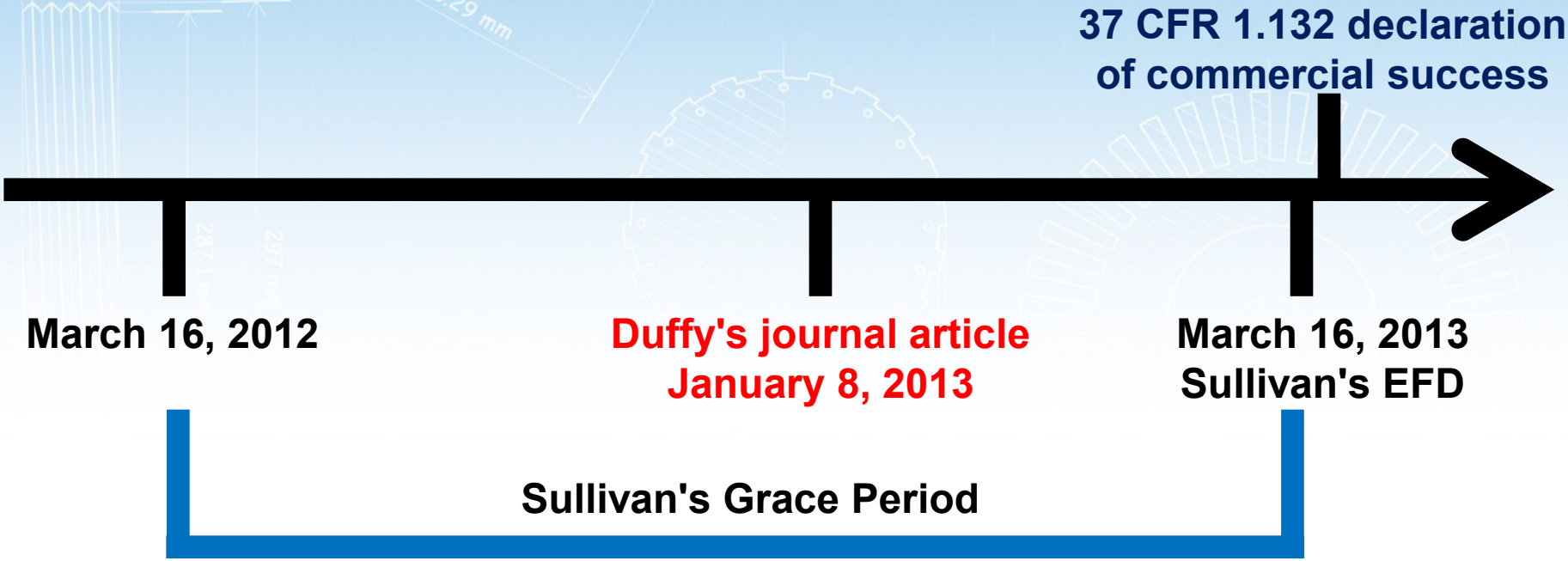
NO. The rejection was made under 102(a)(1), and the common ownership exception of 102(b)(2)(C) only applies to rejections made under 102(a)(2). Therefore, even though Sullivan can establish common ownership as of his effective filing date, the traversal is unavailing.

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



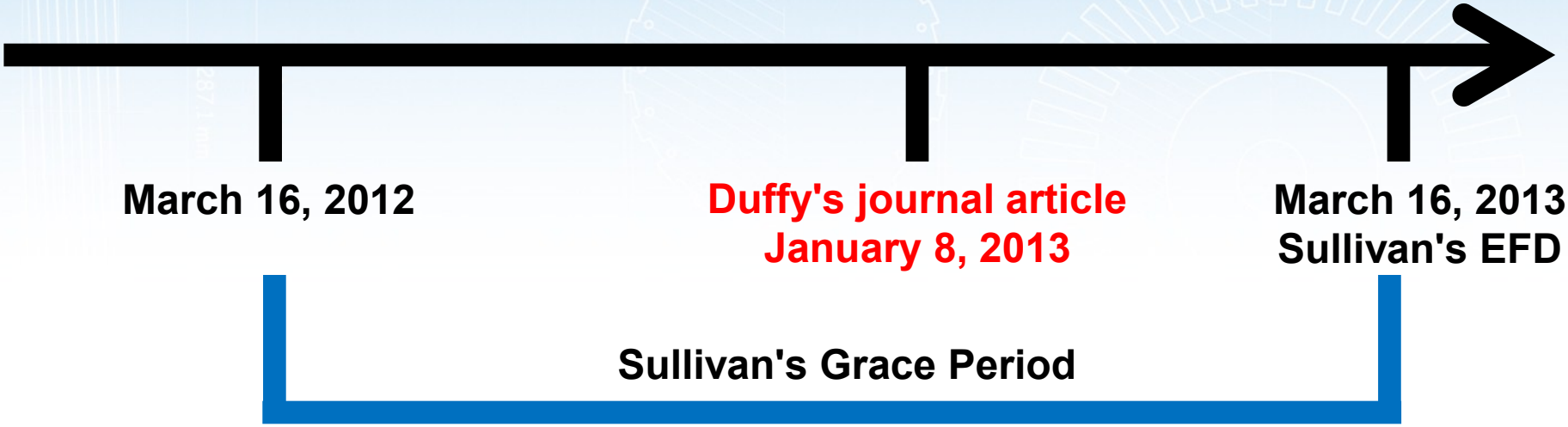
Question: Could Sullivan properly traverse by submitting a 37 CFR 1.132 declaration about the commercial success of his invention, including sales figures as well as market share, and establishing a nexus between the claimed invention and the commercial success?

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



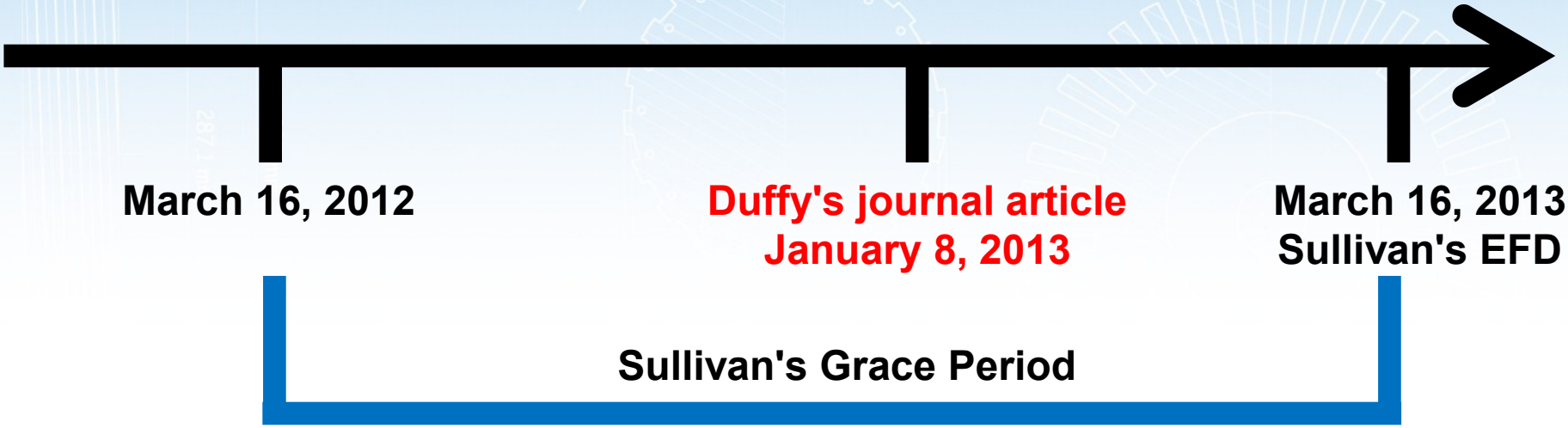
NO. A declaration to establish so-called "secondary considerations" such as commercial success may be used to traverse an obviousness rejection, but not an anticipation rejection. This applies to both AIA and pre-AIA applications.

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Question: Could Sullivan could properly traverse by arguing that the Duffy article is not prior art under 102(a)(1) because it an inventor-originated disclosure?

Scenario 1. Traversing a Rejection under 35 U.S.C. 102(a)(1)



YES. Sullivan could appropriately sign and file a declaration under 37 CFR 1.130(a) averring that he is the inventor of the claimed subject matter and that Duffy, his research assistant, obtained the subject matter disclosed in the journal article from him.

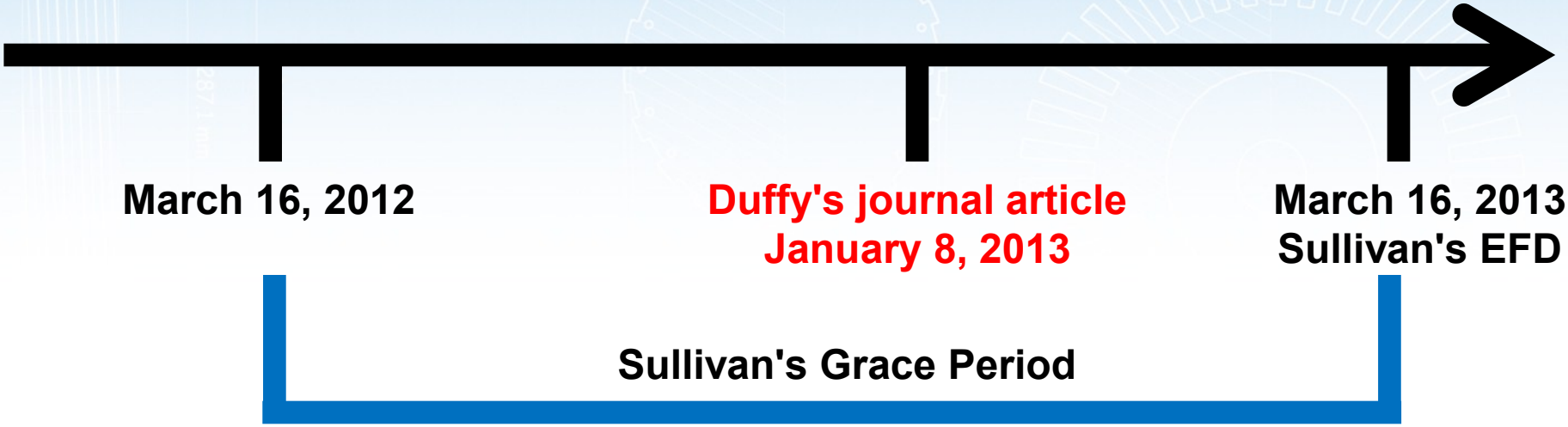
Scenario 1a. Traversing a Rejection under 35 U.S.C. 102(a)(1)

- On March 16, 2013, Sullivan files a nonprovisional utility patent application at the USPTO. Sullivan includes a statement in the specification under 37 CFR 1.77(b)(6) that the subject matter of the instant invention was described in an article authored by his research assistant Duffy on January 8, 2013.

- Sullivan does not assert any foreign priority or domestic benefit under 35 U.S.C. 119, 120, 121, or 365.

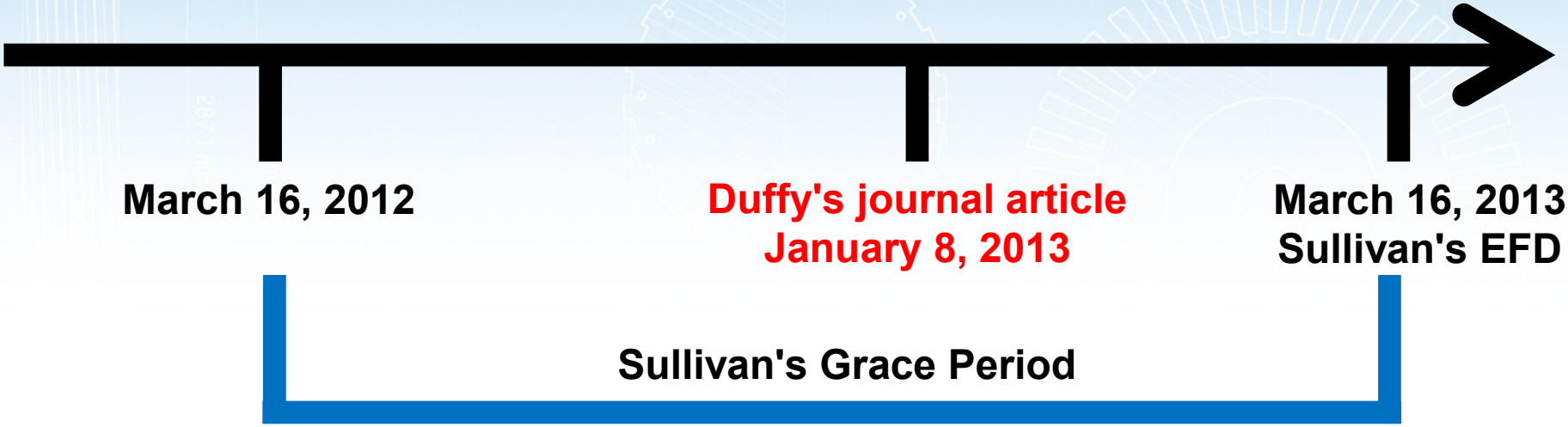
- The patent examiner rejects all of the claims as anticipated under 35 U.S.C. 102(a)(1) by a journal article by Duffy, which became available to the public on January 8, 2013.

Scenario 1a. Traversing a Rejection under 35 U.S.C. 102(a)(1)



Question: Could Sullivan properly traverse the examiner's 102(a)(1) rejection over Duffy by citing the 1.77(b)(6) statement and without submitting a 130(a) declaration?

Scenario 1a. Traversing a Rejection under 35 U.S.C. 102(a)(1)



YES. Sullivan could properly traverse by arguing that the Duffy article is not prior art under 102(a)(1) because it is an inventor-originated disclosure. Sullivan would not need to provide a declaration or affidavit under 37 CFR 1.130(a) since he already provided a statement under 37 CFR 1.77(b)(6) in the originally filed specification.

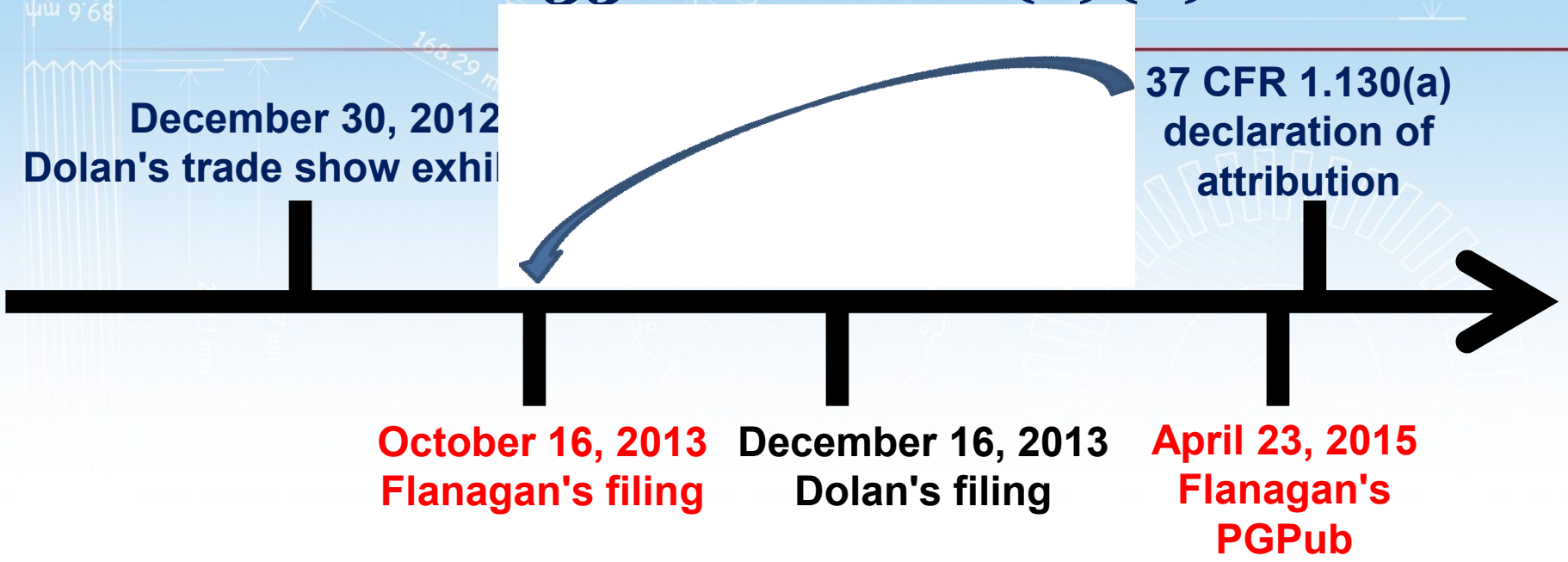
Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

- Dolan filed his patent application on December 16, 2013. The application contains one claim directed to widget X.
- Dolan exhibited his invention of widget X at a trade show on December 30, 2012.
- The examiner locates a U.S. patent application publication disclosing widget X to Flanagan. The application was filed on October 16, 2013 and published on April 23, 2015.

Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

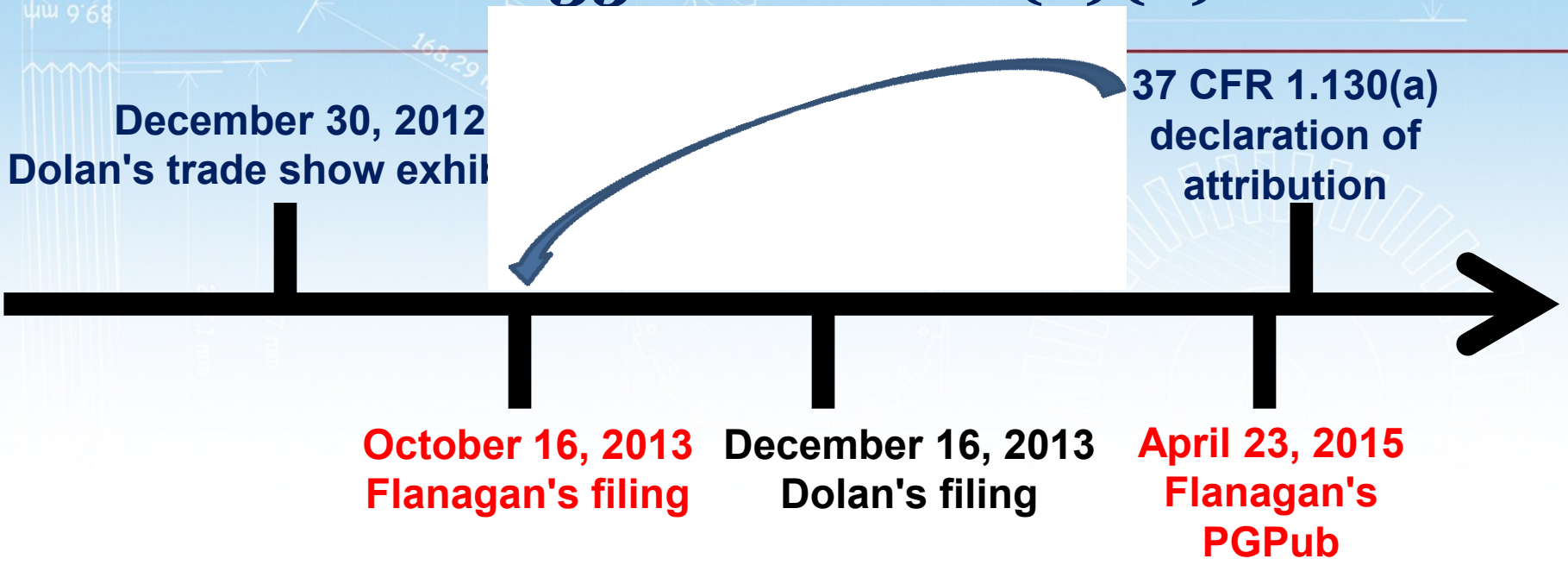
Dolan's attorney receives an Office action rejecting the claim under 35 U.S.C. 102(a)(2) over Flanagan's patent application publication. How could she properly respond to the Office action?

Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Question: Can Dolan's attorney submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him?

Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



YES. Dolan can invoke the 35 U.S.C. 102(b)(2)(A) exception by submitting a declaration under 37 CFR 1.130(a) showing that Flanagan's disclosure of widget X was directly or indirectly obtained from Dolan, who invented it.

Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

Question: Can Dolan's attorney properly traverse the rejection by submitting a declaration under 37 CFR 1.130(b) to establish that Dolan had publicly disclosed widget X before the date that Flanagan's application was effectively filed?

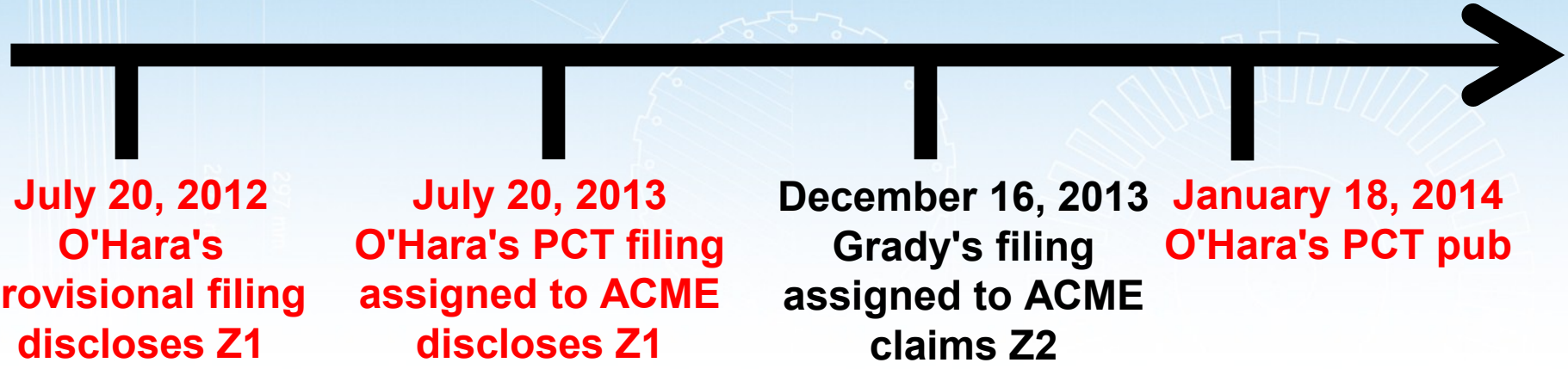
Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

YES. Dolan can invoke the 35 U.S.C. 102(b)(2)(B) exception by submitting a declaration under 37 CFR 1.130(b) to show that he had invented and publicly disclosed widget X before Flanagan's patent application was effectively filed and that the widget X of the trade show is the same as the widget X of Flanagan's filing.

Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

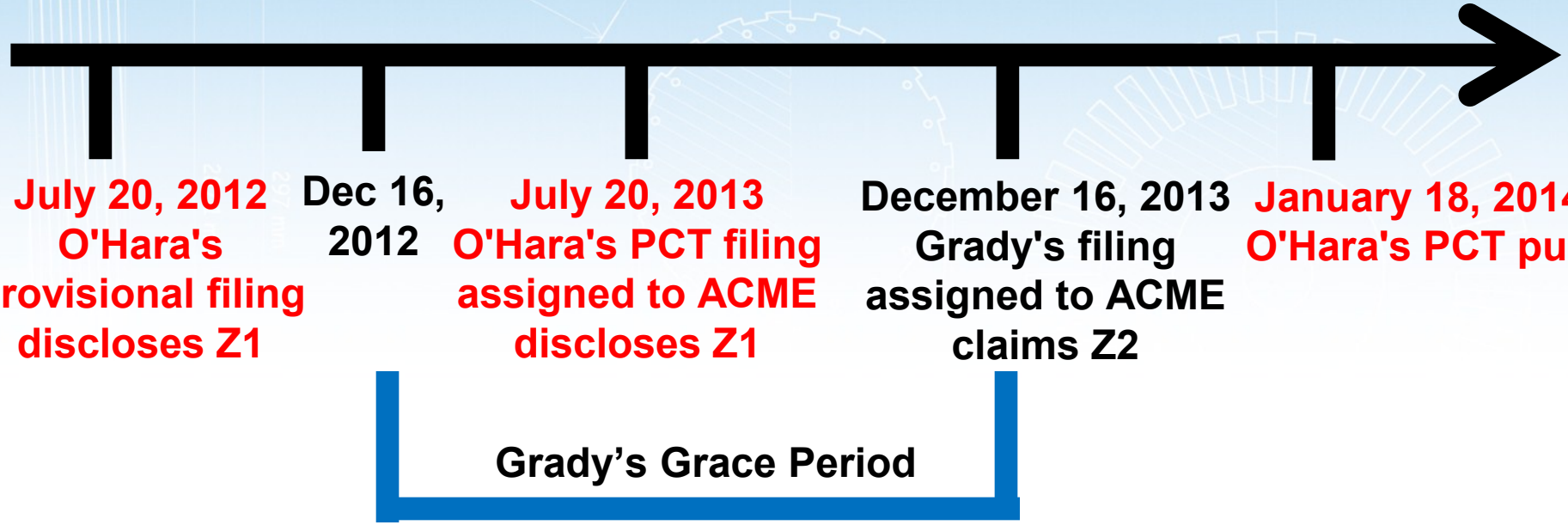
- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ACME Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.

Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



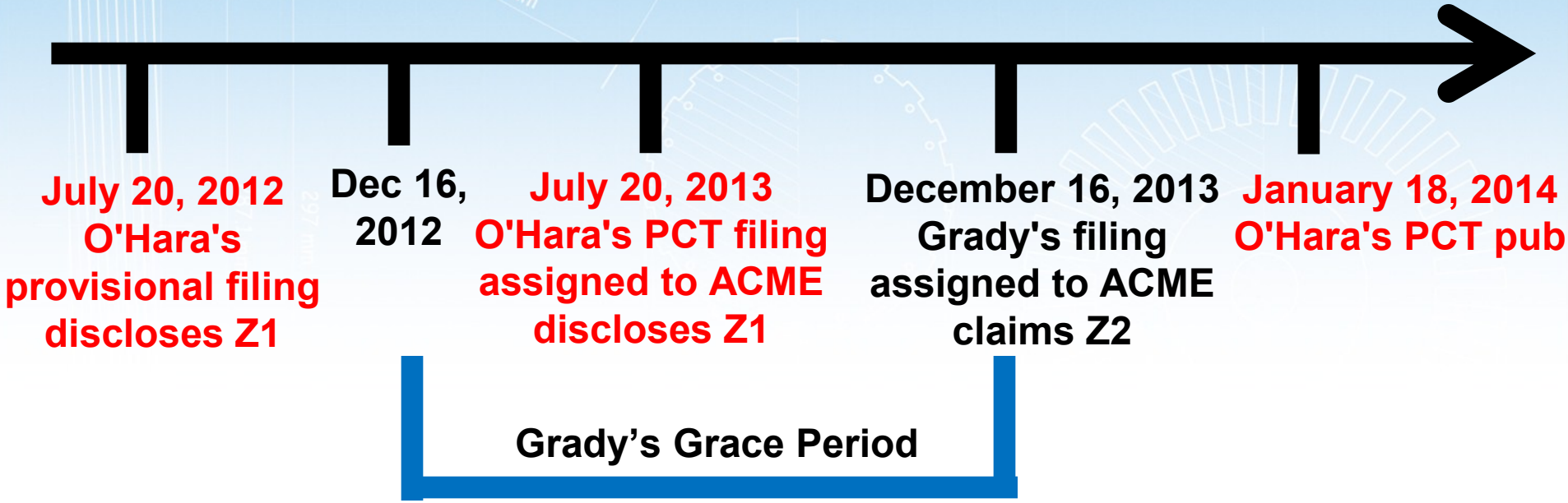
Consider whether Grady's attorney may invoke the common ownership exception to establish that the O'Hara publication is not prior art to Grady's claimed invention.

Scenario 3:Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



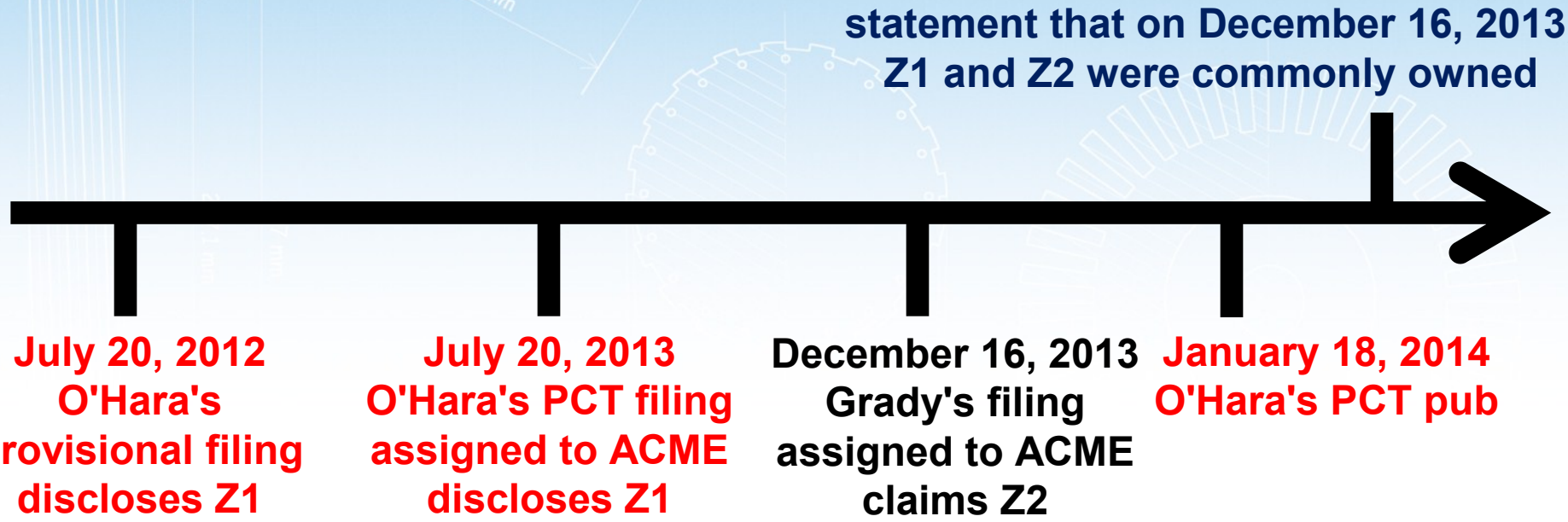
Question: May Grady invoke the 102(b)(2)(C) common ownership exception in this case even though the effectively filed date of O'Hara's PCT publication is prior to Grady's grace period?

Scenario 3: Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



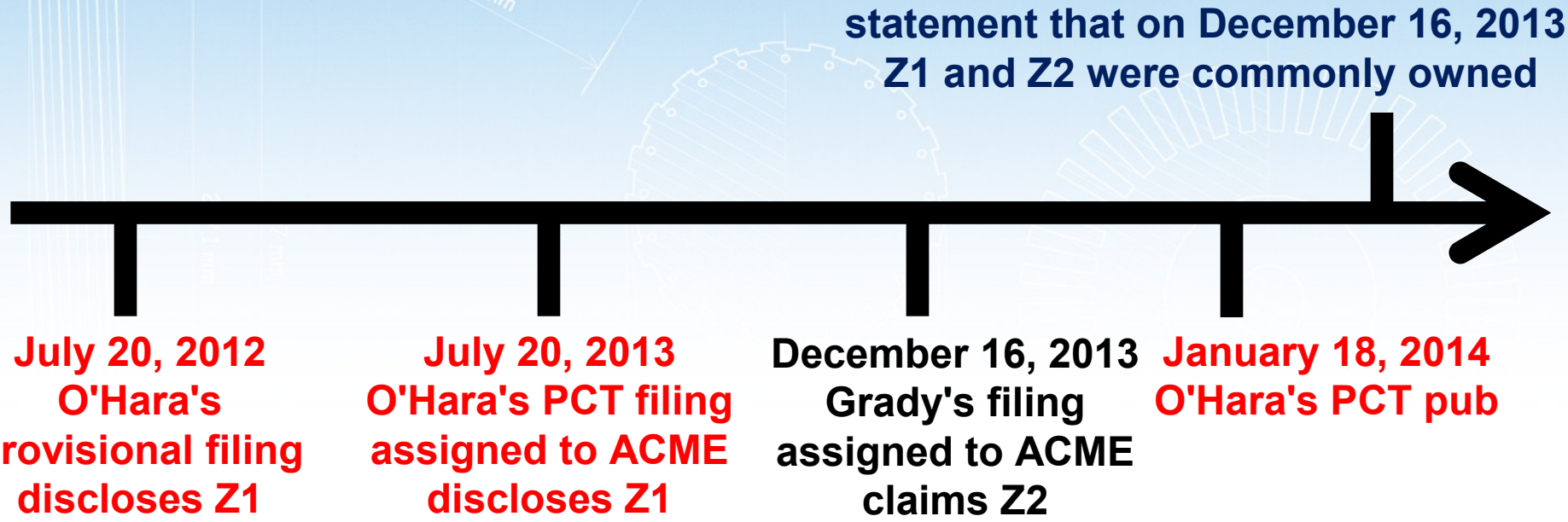
YES. The 102(b)(2)(C) exception, as well as the 102(b)(2)(A) and 102(b)(2)(B) exceptions, are <u>not</u> limited to grace period disclosures. Thus, Grady may invoke the common ownership exception of 102(b)(2)(C) to overcome the 102(a)(2) rejection over O'Hara's PCT publication.

Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



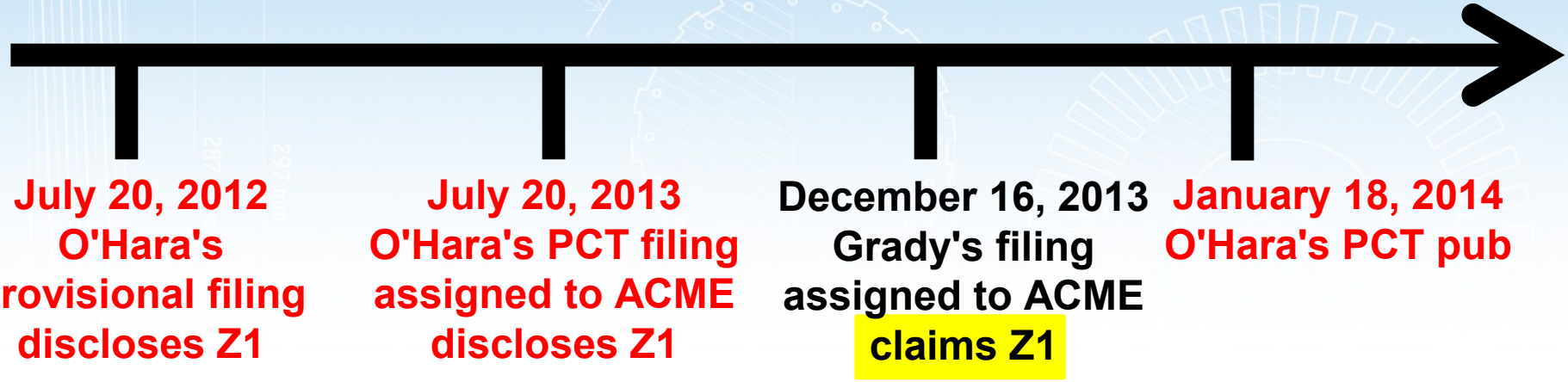
Question: If Grady's attorney provides a statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned as of December 16, 2013, can he expect the examiner to withdraw the rejection?

Scenario 3. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



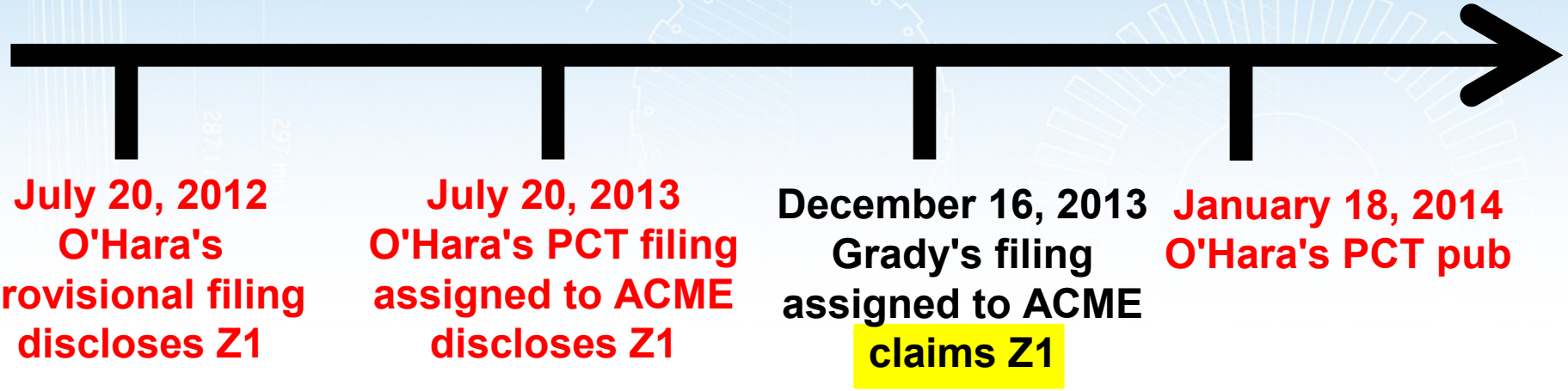
YES. A statement that Grady's claimed method Z2 and O'Hara's disclosed method Z1 were commonly owned not later than Grady's effective filing date is sufficient. A declaration is not needed.

Scenario 3a. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



Question: Could Grady's attorney have invoked the common ownership exception if **Grady had claimed Z1** and the examiner had made an anticipation rejection under 102(a)(2)?

Scenario 3a. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

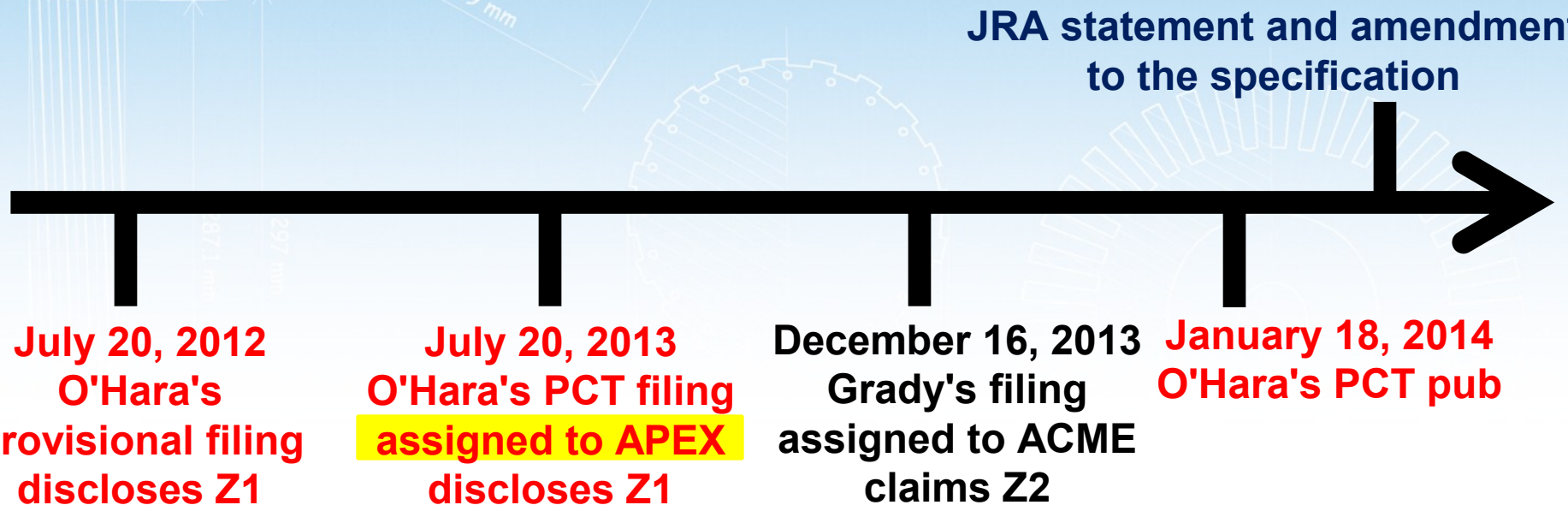


YES. Unlike the pre-AIA 103(c) common ownership exception which applies only to obviousness rejections, the 102(b)(2)(C) exception under the AIA may be invoked to overcome both obviousness and anticipation rejections.

Scenario 3b. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

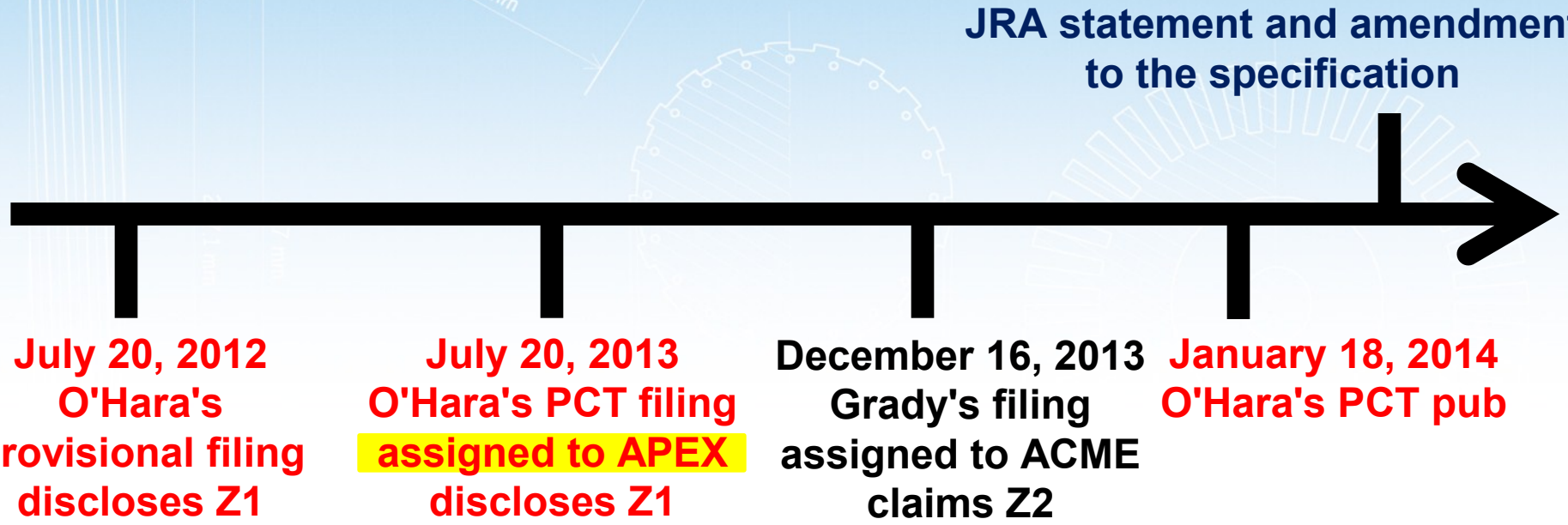
- Grady filed a patent application, assigned to ACME Corp., on December 16, 2013. His application contains one claim directed to method Z2.
- The examiner found a PCT application publication by O'Hara, published on January 18, 2014, assigned to ~~ACME~~ APEX Corp., which disclosed method Z1. The PCT application designated the United States and was filed on July 20, 2013. It claimed benefit of a provisional application filed on July 20, 2012, which also disclosed method Z1.
- Z2 is obvious over Z1. The examiner issues an Office action rejecting Grady's claim under 35 U.S.C. 103 as obvious over O'Hara's published PCT application.

Scenario 3b. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)



Question: If Grady's attorney provides a statement that ACME and APEX were parties to a joint research agreement (JRA) in effect on or before December 16, 2013, and that Grady's claimed method Z2 resulted from activities within the scope of the JRA, can he expect the examiner to withdraw the rejection as long as he amends the specification to disclose the names of the parties to the JRA?

Scenario 3b. Relying on the Common Ownership Exception under 35 U.S.C. 102(b)(2)(C)

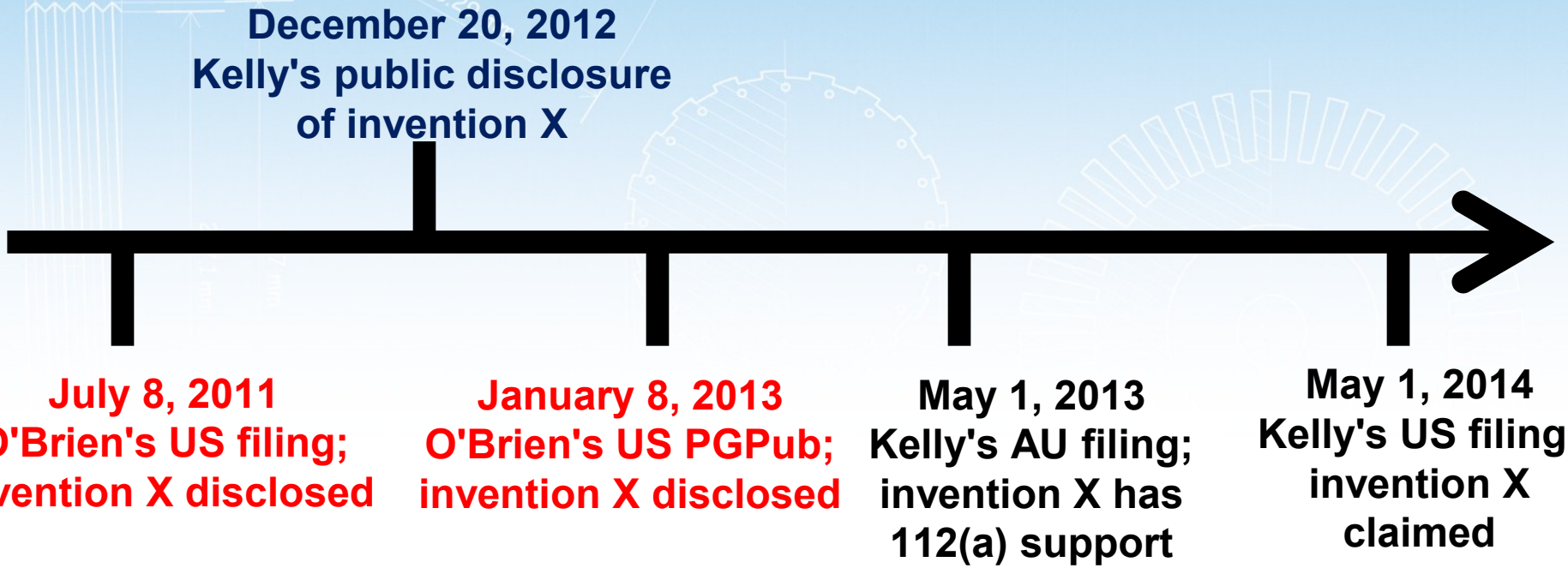


YES. An appropriate JRA statement by Grady's attorney is sufficient to overcome an anticipation or obviousness rejection based on a 102(a)(2) disclosure, provided that the specification names or is amended to name the parties to the JRA. A declaration is not needed.

Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

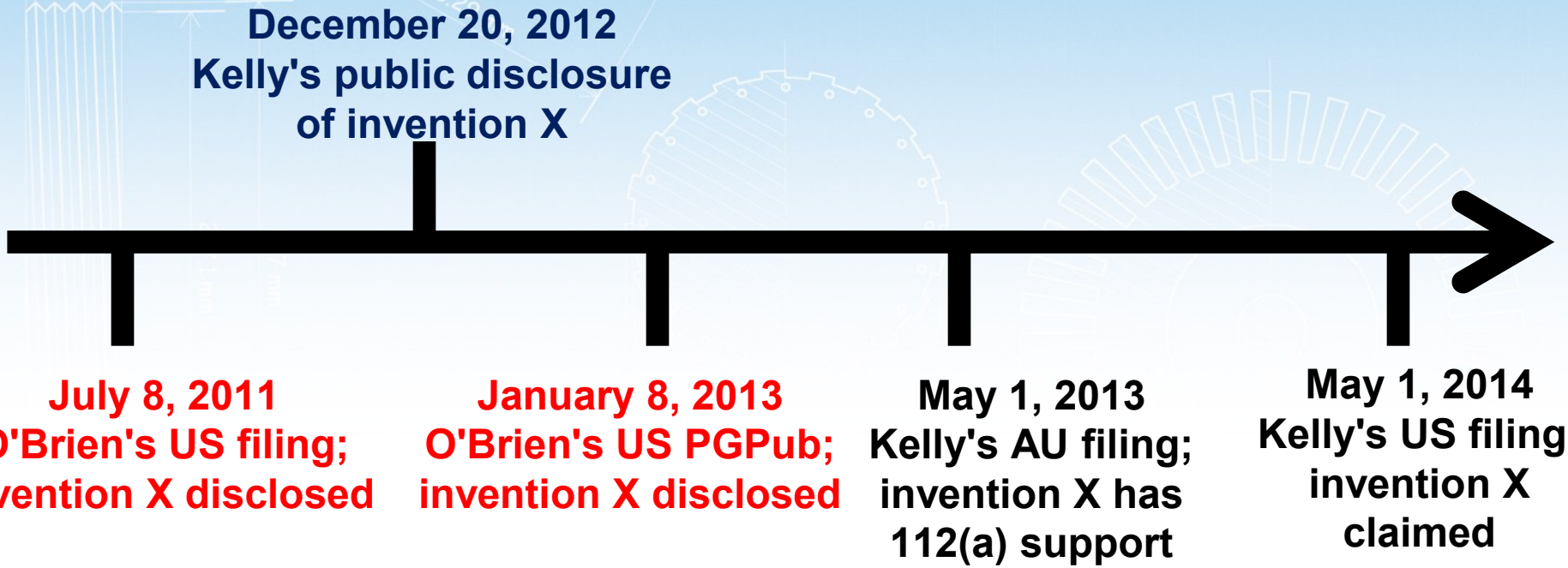
- On May 1, 2014, Kelly files a nonprovisional patent application at the USPTO claiming invention X.
- Kelly asserts a foreign priority claim under 35 U.S.C. 119(a)-(d) based on his Australian application filed May 1, 2013. He submits a certified copy of the English-language Australian application to the USPTO. The Australian application provides support under 35 U.S.C. 112(a) for invention X.
- The examiner rejects Kelly's claims as anticipated under 35 U.S.C. 102(a)(1) and 102(a)(2) by a U.S. patent application publication to O'Brien dated January 8, 2013, based on an application filed on July 8, 2011. O'Brien's application discloses invention X. There are no other rejections of record, and the examiner is not aware of any other relevant art.

Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



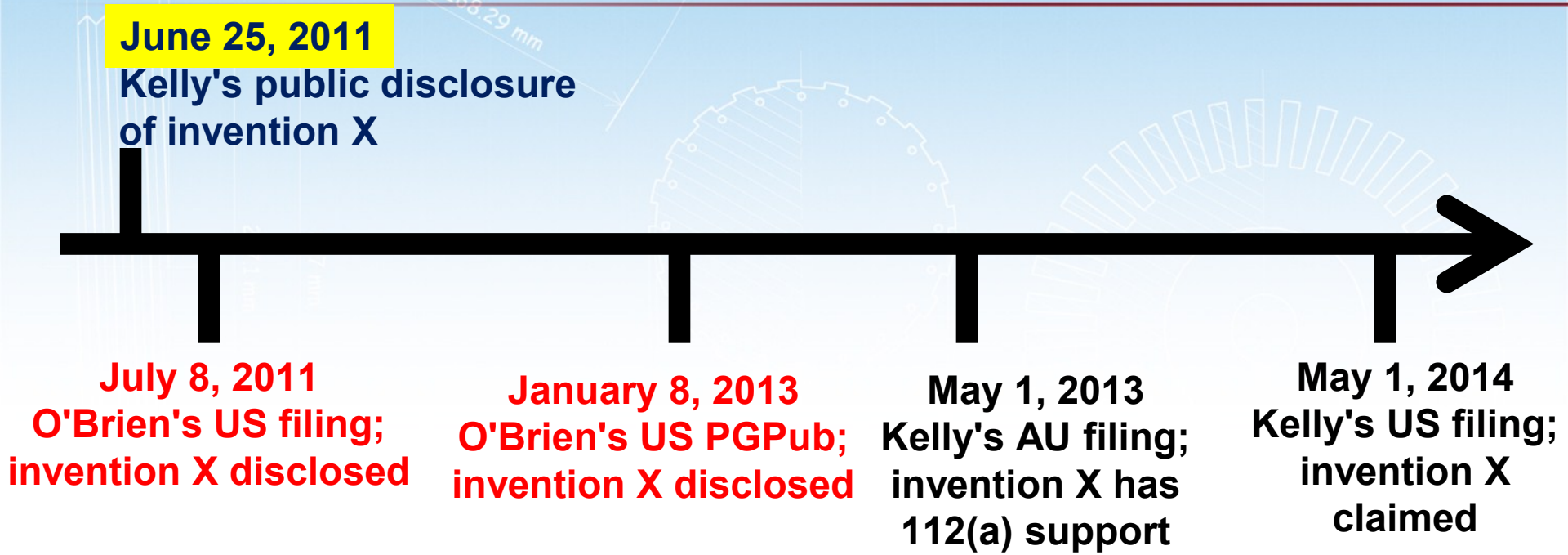
Question: Should Kelly expect allowance of his claims if he submits a declaration under 37 CFR 1.130(b) showing that he invented X, that he publicly disclosed invention X on December 20, 2012, and that the invention X of Kelly's prior public disclosure is the same as the invention X of O'Brien's US PGPub?

Scenario 4. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



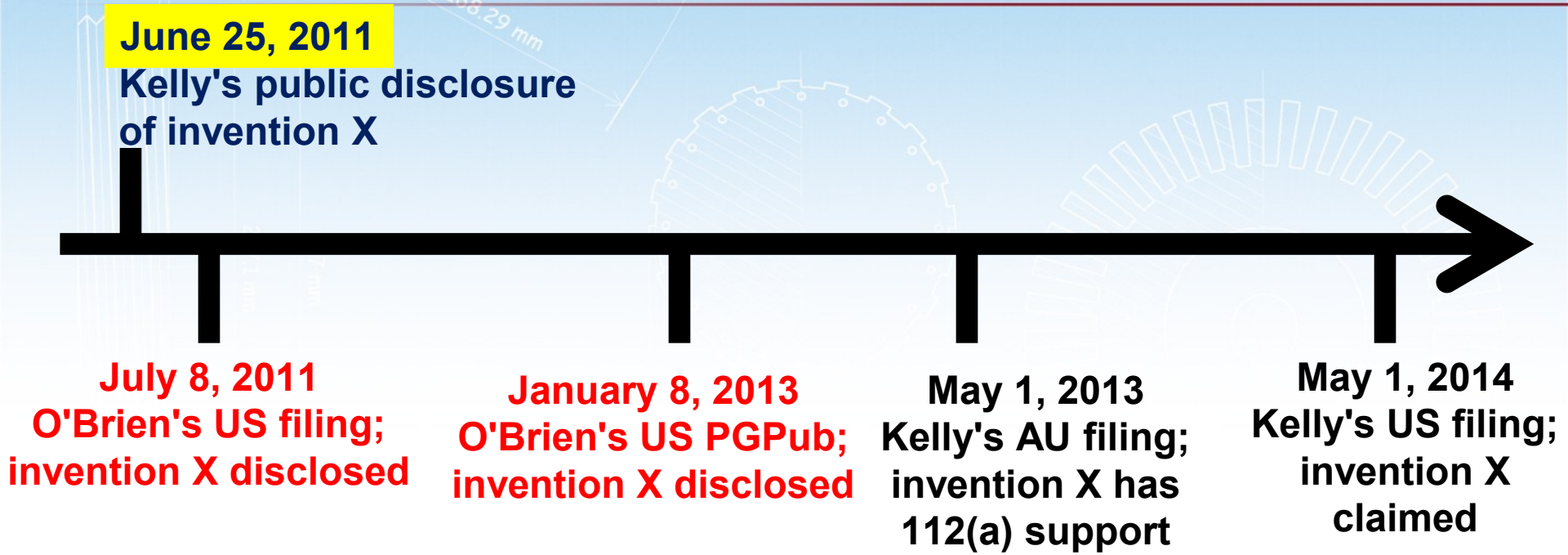
NO. Kelly's declaration establishes that O'Brien's PGPub is not 102(a)(1) art as of its publication date, but O'Brien's PGPub is still 102(a)(2) art as of the date that it was effectively filed.

Scenario 4a. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)



Question: Should Kelly expect allowance of his claims if he submits a declaration under 37 CFR 1.130(b) showing that he invented X, that he publicly disclosed invention X on **June 25, 2011**, and that the invention X of Kelly's prior public disclosure is the same as the invention X of O'Brien's US PGPub?

Scenario 4a. Traversing a Rejection under 35 U.S.C. 102(a)(1) or 102(a)(2)

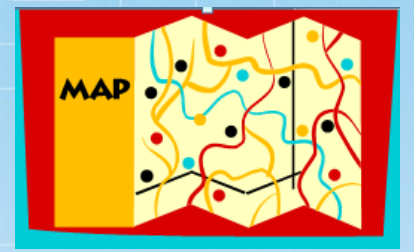


NO. Although Kelly's declaration under 37 CFR 1.130(b) is sufficient to establish that O'Brien's PGPub is not prior art under either 102(a)(1) or 102(a)(2), Kelly's prior public disclosure is itself 102(a)(1) prior art to Kelly's claimed invention.

AMERICA INVENTS ACT
IMPLEMENTATION

Effective Use of AIA (FITF) Evidentiary Declarations

Topics of Discussion



- New Rule 37 CFR 1.130 and Evaluation of Declarations
  - 130(a) Declarations of Attribution
  - 130(b) Declarations of Prior Public Disclosure
  - 37 CFR 1.77(b)(6) Statements
- Formal Requirements for 130 Declarations
- Examples of 130(a) and (b) Declarations
- Points to Consider after Filing 130 Declarations
- Comparison of Declarations for Pre-AIA and AIA Applications

Summary of New Regulation 37 CFR 1.130

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

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

New Rule 37 CFR 1.77 (b)(6): An Alternative to Declarations under 130

37 CFR 1.77 *Arrangement of application elements*.

(b) The specification should include the following sections in order:

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

- Pre-emptively include statements of (A) attribution or (B) prior public disclosure in the specification upon filing.
- Substantive requirements for statements under 1.77(b)(6) are the same as for 130 declarations.
- Such a statement cannot be added after the original filing date without being considered new matter.

New Rule 37 CFR 1.77 (b)(6): An Example to Establish Attribution

An example of a 1.77(b)(6) statement in a specification used to establish attribution of a prior public disclosure:

STATEMENT REGARDING PRIOR DISCLOSURES BY THE INVENTOR OR A JOINT INVENTOR UNDER 37 C.F.R. 1.77(b)(6)

[0002] A prior developed trapping device, a predecessor model to the present invention, was offered for sale on March 27, 2013 by the Victor Pest Control Company (Victor) as shown on their website, www.victorpest.com/store/rat-control/m240. Victor Pest Control Company obtained the prior developed trapping device from two of the present inventors, Charles Jordan Sr. and Alexander Robert Thompson who, during the course of their employment, developed the trapping device that their employer began selling on March 27, 2013. A copy of a print out of the website offering the trapping device for sale is provided on a concurrently filed Information Disclosure Statement pursuant to the guidance of 78 Fed. Reg. 11076 (Feb. 14, 2013).

Declarations under 130(a) and 130(b)

Declaration Rule	Applicable Exception	Purpose
130(a)	102(b)(1)(A) and (b)(2)(A)	attribution: showing that the potential prior art subject matter originated with one or more members of the inventive entity
130(b)	102(b)(1)(B) and (b)(2)(B)	prior public disclosure: showing that the potential prior art subject matter was preceded by an inventor-originated disclosure of the same subject matter

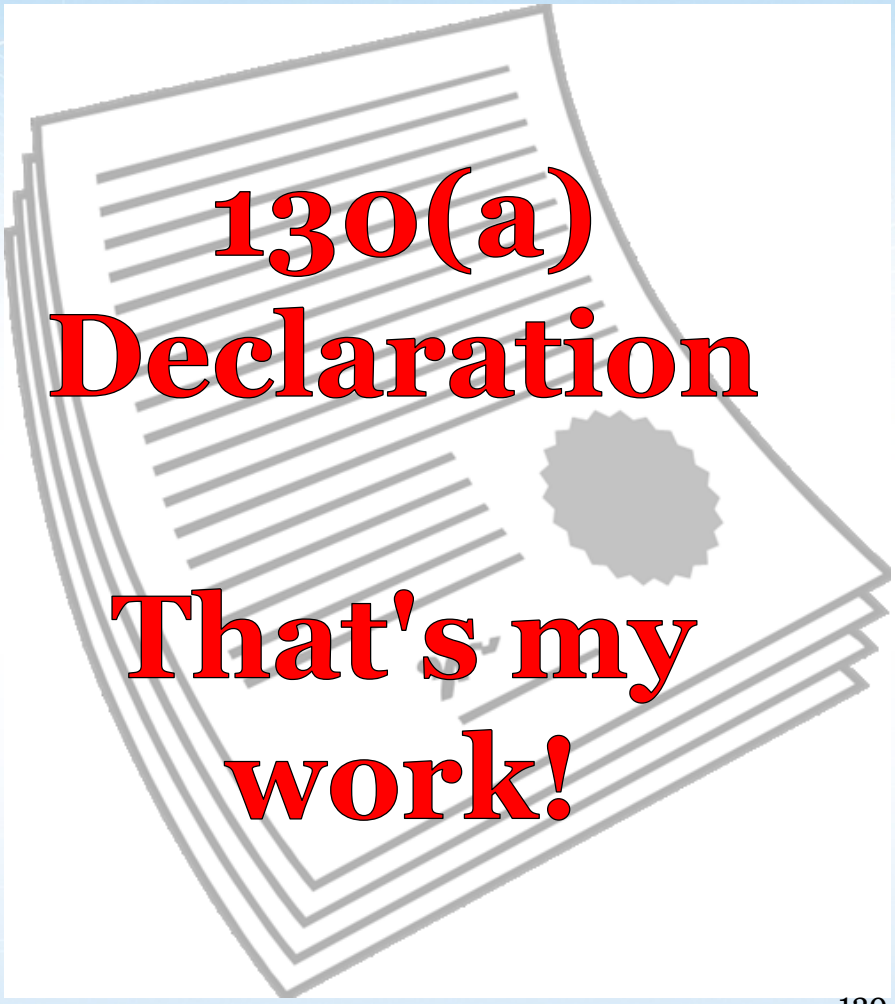
Note that a statement is sufficient (i.e., a declaration is not required) to invoke the 102(b)(2)(C) common ownership exception.

130(a) Declaration of Attribution

37 CFR 1.130(a) states:

(a) *Affidavit or declaration of attribution*. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

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



130(a) Declarations of Attribution

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

- 102(b)(1)(A) exception:

  A potential prior art 102(a)(1) disclosure made one year or less before the effective filing date of a claimed invention is not prior art to the claimed invention if it was an inventor-originated disclosure.

- 102(b)(2)(A) exception:

  A potential prior art 102(a)(2) disclosure is not prior art to the claimed invention if it was an inventor-originated disclosure. The grace period is not relevant to any of the 102(b)(2) exceptions.

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

Drafting Rule 130(a) Declarations of Attribution

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

  If the declaration provides both

  1. an unequivocal statement from one or more joint inventors that he/she/they invented the potential prior art subject matter, and
  2. a reasonable explanation of the presence of additional authors/inventors of the potential prior art subject matter

  then it will generally be acceptable unless there is evidence to the contrary.

  See MPEP 717.01(a)(1).

- It is not necessary to show that the inventor-originated disclosure was an enabling disclosure within the meaning of 35 U.S.C. 112(a). See MPEP 717.01(a)(1) and 2155.04.

130(b) Declarations of Prior Public Disclosure

37 CFR 1.130(b) states in part:

> *Affidavit or declaration of prior public disclosure*. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

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

130(b) Declarations of Prior Public Disclosure

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

- 102(b)(1)(B) exception:

  A potential prior art 102(a)(1) disclosure made one year or less before the effective filing date of a claimed invention is not prior art to the claimed invention if the subject matter of the potential prior art disclosure was disclosed in a previous inventor-originated public disclosure.

- 102(b)(2)(B) exception:

  A 102(a)(2) disclosure is not prior art to the claimed invention if the subject matter of the potential prior art disclosure was disclosed in a previous inventor-originated public disclosure. The grace period is not relevant to any of the 102(b)(2) exceptions.

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

Drafting Rule 130(b) Declarations of Prior Public Disclosure

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

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

  See MPEP 717.01(b)(1).

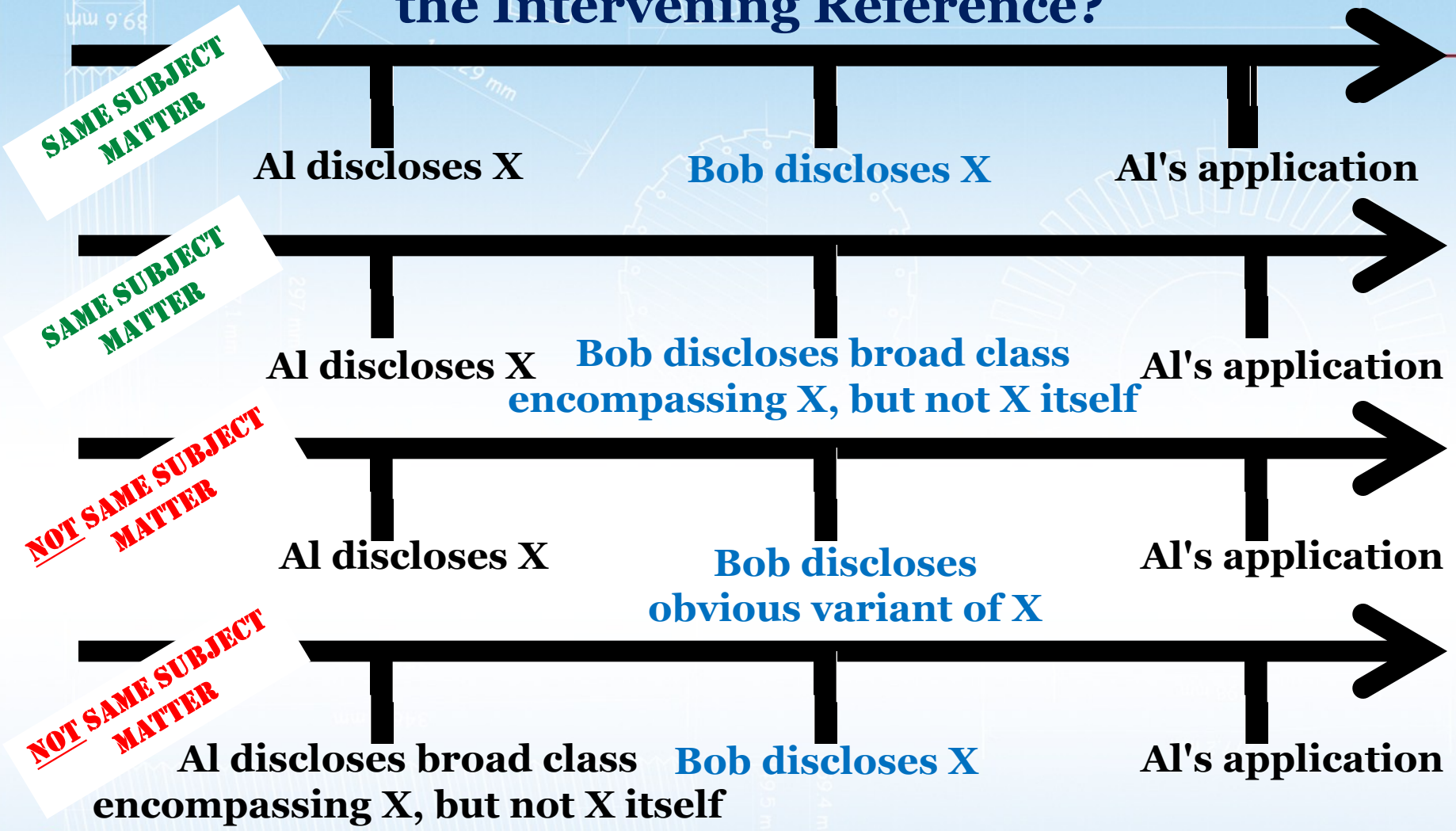
- It is not necessary to show that the inventor-originated disclosure was an enabling disclosure within the meaning of 35 U.S.C. 112(a). See MPEP 717.01(a)(1).

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

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

See MPEP 717.01(b)(2).

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



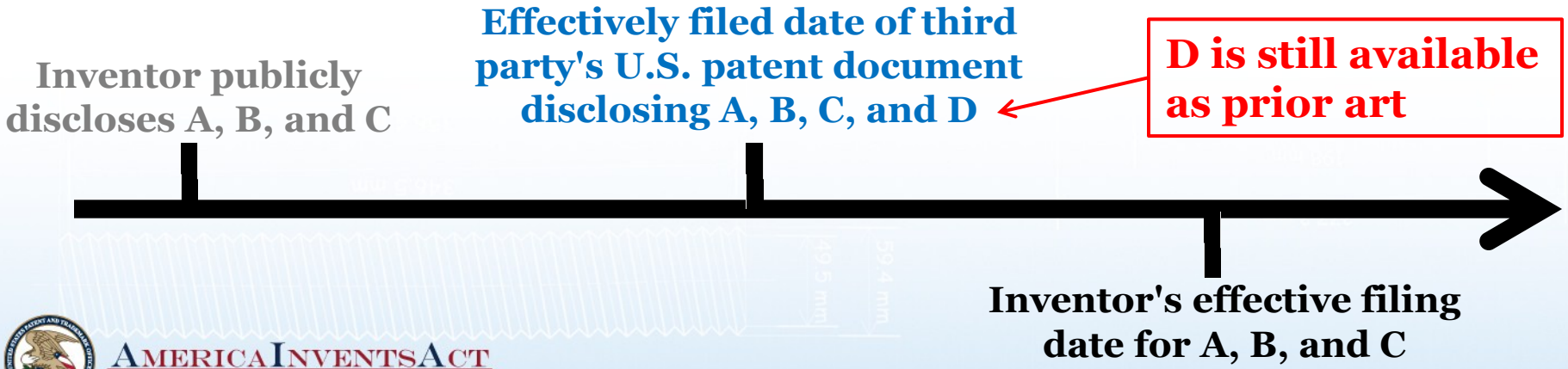
It Is Possible For Only a Portion of a Third Party's Disclosure to Be Disqualified as Prior Art

- Only that portion of the third party's intervening disclosure that was in a previous inventor-originated disclosure (i.e., the same "subject matter") is disqualified as prior art under 35 U.S.C. 102(a)(1) or (a)(2) when the respective 102(b)(1)(B) or (b)(2)(B) exception applies.

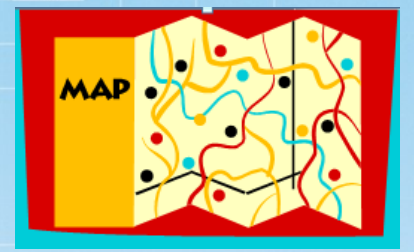
- Any other portion of the third party's intervening disclosure that was not part of the previous inventor-originated disclosure is still available for use in a prior art rejection. In other words, the claimed invention is not shielded from any portion of the third party's disclosure that has not been disqualified.

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

- The inventor publicly discloses and later claims A, B, and C.
- A U.S. patent document to a third party, which was effectively filed before the inventor's effective filing date but after the inventor's public disclosure (i.e., an intervening reference), discloses A, B, C, and D.
- D, as disclosed in the U.S. patent document, is still available for use in an obviousness rejection because it qualifies as prior art under 35 U.S.C. 102(a)(2).



Topics of Discussion



- New Rule 37 CFR 1.130 and Evaluation of Declarations
  - 130(a) Declarations of Attribution
  - 130(b) Declarations of Prior Public Disclosure
  - 37 CFR 1.77(b)(6) Statements
- Formal Requirements for 130 Declarations
- Examples of 130(a) and (b) Declarations
- Points to Consider after Filing 130 Declarations
- Comparison of Declarations for Pre-AIA and AIA Applications

Formalities of Rule 130 Declarations

The formal requirements have not changed as compared with requirements for other evidentiary declarations under pre-AIA law.

1. Is it timely? See MPEP 717.01(f).

2. Does it include the necessary statements for declarations? See MPEP 717.01(c). If an affidavit has been submitted rather than a declaration, has it been properly witnessed? See MPEP 602 and 717.01(c).

3. If exhibits are included, do they comply with 37 CFR 1.91? See MPEP 717.01(c); see also MPEP 608.03(a).

Formalities of Rule 130 Declarations

4. As with any evidentiary declaration, the person who signs a 130 declaration must be someone with knowledge of the facts addressed. This may be the inventor or a joint inventor, or someone else. See MPEP 717.01(c).

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

When Is a 130(a) or (b) Declaration Not Appropriate?

- An applicant may not rely on a declaration under rule 130(a) or 130(b) to establish an exception to prior art when the disclosure was publicly available before the grace period.
- This follows from the requirements of 102(b)(1) that a disclosure under 102(a)(1) is not subject to an exception if it was made more than one year before the effective filing date of the claimed invention.
- An examiner need not consider such 130 declarations on the merits. The applicant should be informed that the declaration does not comply with 37 CFR 1.130(c).

  See 37 CFR 1.130(c) and MPEP 717.01(a)(1).

When Is a 130(a) Declaration Not Appropriate?

An applicant may not rely on a declaration of attribution under rule 130(a) to establish an exception to prior art when both of the following apply:

- the disclosure is a U.S. patent or U.S. patent application publication having **patented or pending claims** drawn to an invention that is the same or substantially the same as (i.e., not patentably distinct from) the invention claimed in the application under examination, AND
- the declaration contends that an inventor named in the disclosure derived the claimed invention from the inventor or a joint inventor named in the application under examination.

The examiner need not consider the declaration on the merits. The applicant should be informed that the declaration does not comply with 37 CFR 1.130(c). The applicant may file a petition for a derivation proceeding.

See MPEP 717.01(a)(1) and 717.01(d).

The Preponderance Standard and Rule 130

From MPEP 2142:

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

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

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

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

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

A disclosure that has been disqualified as prior art in view of an exception may still be used:

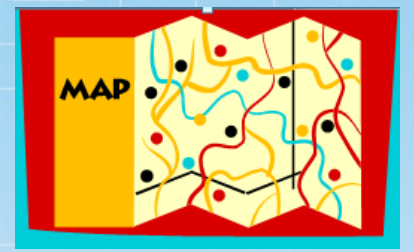
- in a non-statutory double patenting rejection when the disqualified disclosure is a U.S. patent or U.S. patent application publication and the patented or pending claims are not patentably distinct from the claims of the application under examination;
- in a statutory double patenting rejection under 35 U.S.C. 101 when the disqualified disclosure is a U.S. patent or U.S. patent application publication and the patented or pending claims are drawn to the same subject matter as the claims of the application under examination; and/or
- as evidence relevant to an inquiry concerning statutory subject matter under 35 U.S.C. 101, or enablement, written description, or definiteness under 35 U.S.C. 112.

Additional Information

- A rule 130 declaration is not needed to invoke the common ownership exception under 35 U.S.C. 102(b)(2)(C). A statement is sufficient. See MPEP 717.02(b)(III).

- Although this slide set is focused on rule 130 declarations during prosecution of patent applications, rule 130 declarations may also be submitted during reexamination proceedings.

Topics of Discussion



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Important Points to Learn from the Rule 130 Declaration Examples

For all 130 declarations:

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

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

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

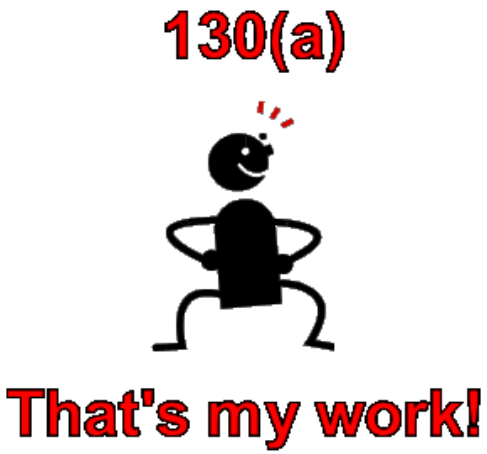
For all 130 declarations:

These declarations are only intended to be used to invoke an exception under AIA 35 U.S.C. 102(b).

An effective 130 declaration establishes that a disclosure is not prior art to the claimed invention.

A 130 declaration is not appropriate when the only purpose is to make a prior public disclosure of record in the application.

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



For 130(a) declarations:

When an inventor is attributing a reference to him- or herself to invoke the 102(a)(1)(A) or 102(a)(2)(A) exception, and the reference names someone else in addition to the inventor, a reasonable explanation of the other person's involvement is required.

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

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

For 130(b) declarations:

In order for the 102(a)(1)(B) or 102(a)(2)(B) exception to apply, the inventor-originated prior public disclosure must have disclosed the same subject matter as the potential prior art disclosure.

The inventor-originated prior public disclosure must be compared to the potential prior art disclosure; it is not relevant to compare either disclosure to the claimed invention.

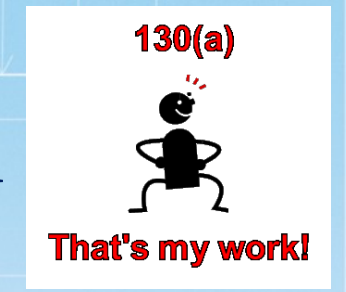
Important Points to Learn from the Rule 130 Declaration Examples (cont.)

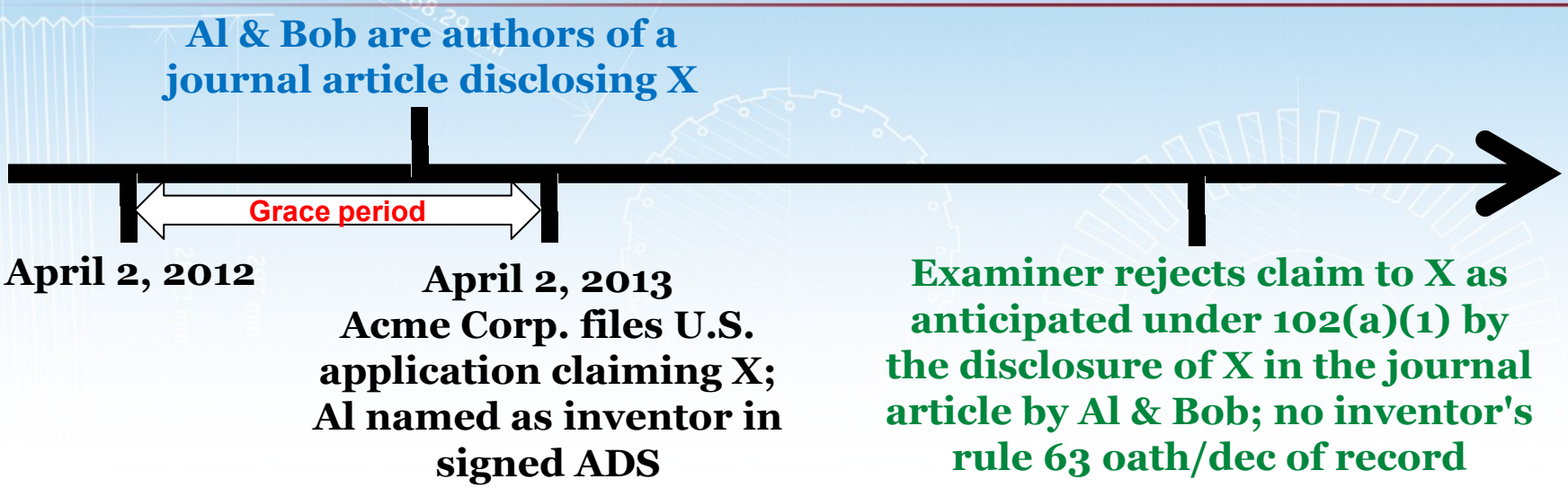
For 130(b) declarations (cont.):

A mere statement that the subject matter of the disclosures is the same may not be sufficient. Often it will be necessary to include an explanation of how the prior public disclosure is the same as the potential prior art disclosure.

Obviousness is not the standard for "same subject matter." See MPEP 717.01(b)(2).

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

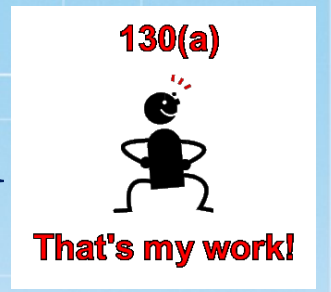




Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration signed by Al averring that Al is the sole inventor of X as disclosed in the journal article. Al also explains in the declaration that Bob was a graduate student working under his direction and supervision, and that Bob did not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

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

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



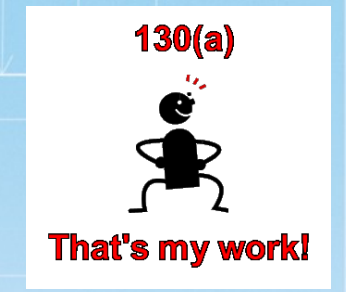
Answer: Yes.

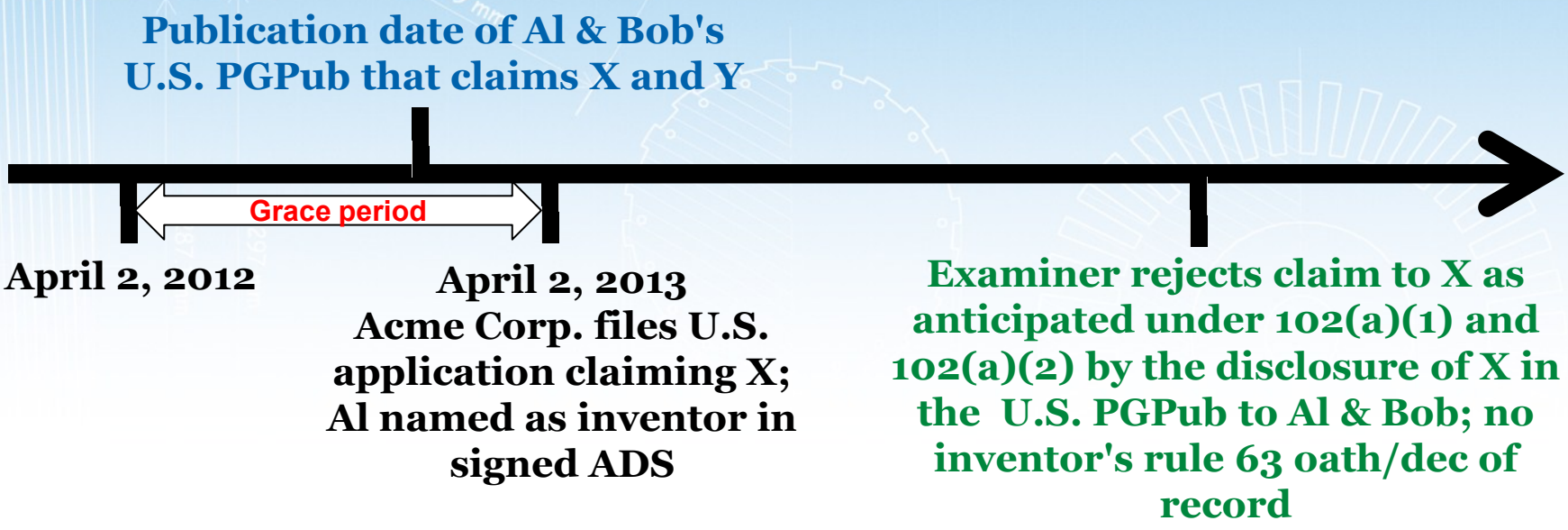
The declaration is sufficient to establish that the disclosure of X in the journal article is not prior art.

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

A declaration from Bob stating that he did not invent X is not required. See *In re Katz*, 215 USPQ 14 (CCPA 1982) and MPEP 717.01(a)(1).

Example 2: 130(a) Declaration to Invoke 102(b)(1)(A) and (b)(2)(A) Exceptions for Inventor-Originated Disclosure

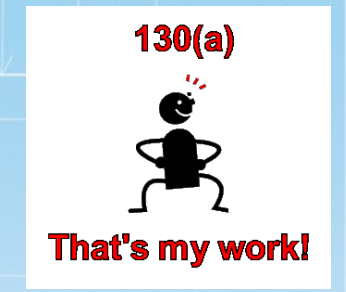




Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration signed by Al averring that he invented X as disclosed in the U.S. PGPub.

Question: Is the declaration sufficient to disqualify the disclosure of X in Al and Bob's U.S. PGPub as prior art under 102(a)(1), 102(a)(2), or both?

Example 2: 130(a) Declaration to Invoke 102(b)(1)(A) and (b)(2)(A) Exceptions for Inventor-Originated Disclosure (cont.)

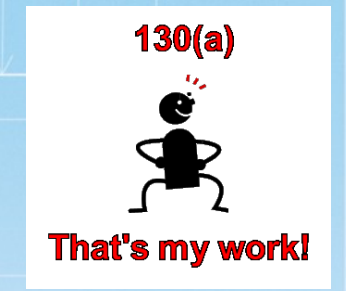


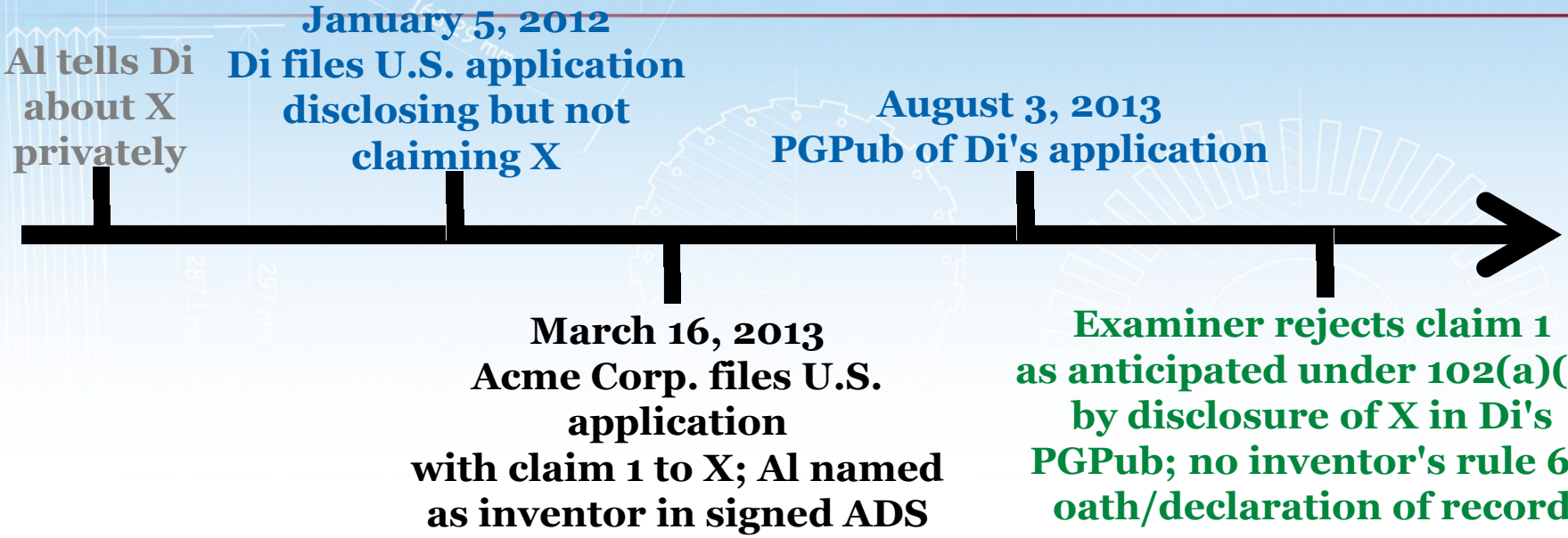
Answer: No, for both.

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

- Because Al avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- However, it is not clear whether Bob, in addition to Al, is also a joint inventor of X. In other words, the declaration is consistent with the conclusion that Bob contributed to the conception of the invention.
- The declaration does not establish that Bob obtained his knowledge of X as disclosed in the U.S. PGPub from Al.

Example 3: 130(a) Declaration to Invoke 102(b)(2)(A) Exception for Inventor-Originated Disclosure

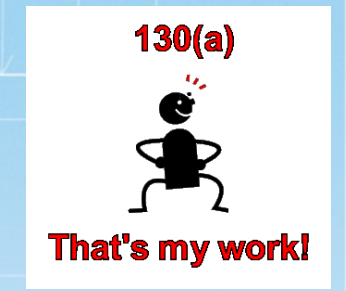




Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration that was signed by Al in which Al explains the circumstance under which he privately told Di about X (i.e., not a public disclosure) before Di's filing date. The declaration does not state that Al invented X.

Question: Is the declaration sufficient to disqualify the disclosure of X in Di's PGPub as prior art?

Example 3: 130(a) Declaration to Invoke 102(b)(2)(A) Exception for Inventor-Originated Disclosure (cont.)



Answer: No.

The 130(a) declaration is not sufficient to disqualify the disclosure of X in the PGPub as prior art.

- Al has not established that he invented X.
- It would be consistent with Al's declaration to conclude that Al learned of X from a third party and communicated it to Di. In that case, Di's PGPub would not be an inventor-originated disclosure.

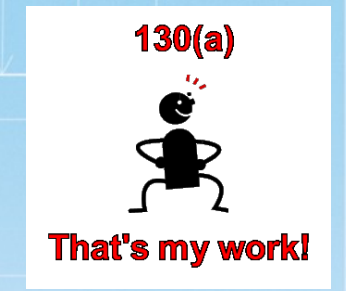
An inventor-originated disclosure is a disclosure of subject matter that was invented by one who is named as the inventor or a joint inventor in the application under examination.

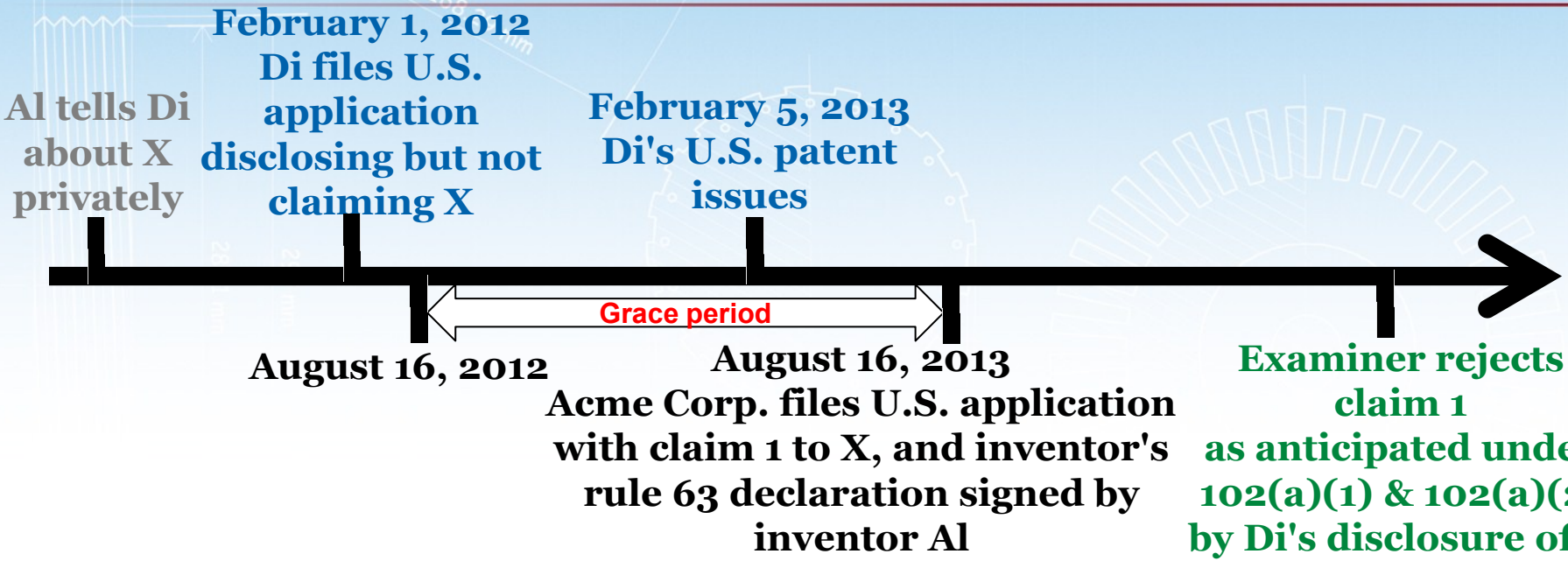
The declaration would have been sufficient if an inventor's rule 63 oath/declaration signed by Al had been of record.

Alternatively, if Acme Corp.'s attorney had submitted a timely 130(a) declaration signed by Al averring that Al invented X as disclosed in the PGPub to Di, it would have been sufficient.

See *In re Facius*, 161 USPQ 294 (CCPA 1969) and MPEP 717.01(a)(1).

Example 4: 130(a) Declaration to Invoke 102(b)(1)(A) and 102(b)(2)(A) Exceptions for Inventor-Originated Disclosure

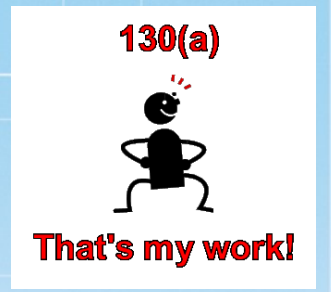




Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration signed by Di in which she explains the circumstances under which Al privately told her about X (i.e., not a public disclosure). The attorney also points out that an inventor's oath or declaration under 37 CFR 1.63 signed by inventor Al is already of record.

Question: Is the declaration sufficient to disqualify the disclosure of X in Di's patent as prior art under 102(a)(1) and 102(a)(2).?

Example 4: 130(a) Declaration to Invoke 102(b)(1)(A) and 102(b)(2)(A) Exceptions for Inventor-Originated Disclosure (cont.)



Answer: Yes, for both.

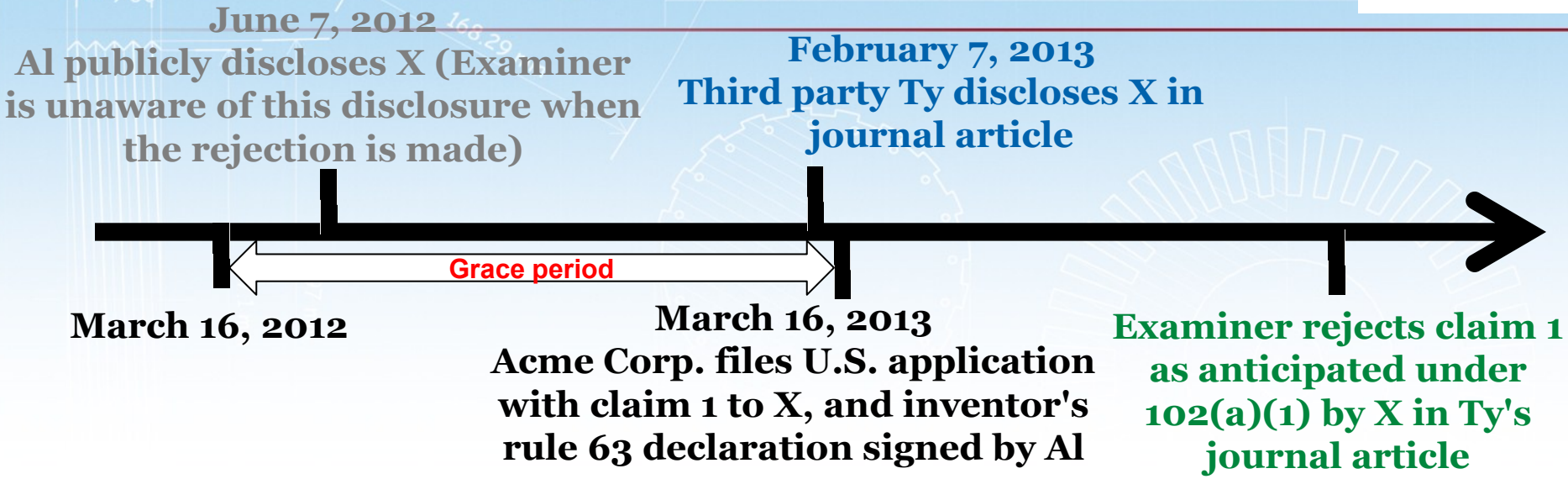
The declaration is sufficient to disqualify the disclosure of X in Di's patent as both 102(a)(1) and 102(a)(2) prior art.

- The declaration establishes that Di learned about X from Al.
- Al's inventor's declaration under 37 CFR 1.63, which is of record in Acme Corp.'s application, establishes that Al is the inventor of X.

See *In re Mathews*, 161 USPQ 276 (CCPA 1969) and MPEP 717.01(a)(1).

Note that because Di's patent is a 102(a)(1) disclosure within the grace period, in accordance with compact prosecution the examiner should make the rejection under both 102(a)(1) and 102(a)(2) to guard against the possibility that the applicant could overcome the 102(a)(1) rejection but not the 102(a)(2) rejection. Also, although Di's patent issued on a pre-AIA application, there is no possibility of an interference or derivation proceeding because Di did not claim X.

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



Applicant's Reply: Acme Corp.'s attorney files a 130(b) declaration signed by Al in which Al avers that he disclosed X at a conference on June 7, 2012. A copy of the printed conference proceeding, which is not prior art, is also filed. The proceeding includes an abstract by Al that discloses X. The declaration explains how X is the same in both disclosures. The attorney points out that an inventor's oath or declaration under 37 CFR 1.63 signed by Al is already of record.

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

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

Answer: Yes.

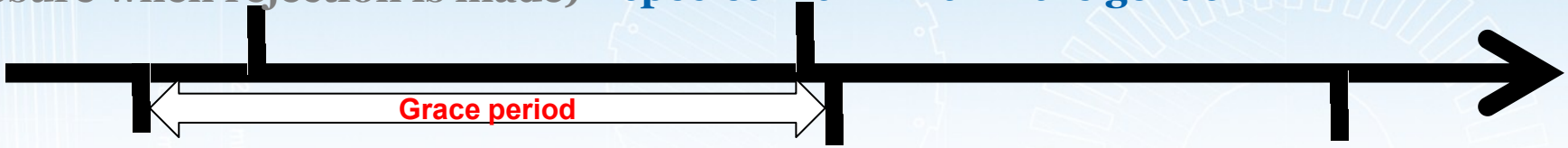
The declaration is sufficient to disqualify the disclosure of X in Ty's journal article as prior art.

- A copy of the printed conference proceeding is included with the declaration, as required by 37 CFR 1.130(b)(1).
- Al's inventor's oath or declaration under 37 CFR 1.63 establishes that he invented X.
- The declaration explains how X is the same in both disclosures
- Al publicly disclosed the same subject matter X before it had been disclosed by the third party Ty.

Example 6: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure

June 7, 2012
Al publicly discloses species X (Examiner is unaware of this disclosure when rejection is made)

February 7, 2013
Third party Ty's journal article discloses a genus, as well as species X & Y within the genus



March 16, 2012

March 16, 2013
Acme Corp. files U.S. application with claim 1 to species X, and inventor's rule 63 declaration signed by Al

Examiner rejects claim 1 as being anticipated under 102(a)(1) by Ty's disclosure of X

Applicant's Reply: Acme Corp.'s attorney files a 130(b) declaration signed by Al in which Al avers that he disclosed species X at a conference on June 7, 2012. A copy of the printed conference proceeding, which is not prior art, is included. The proceeding contains an abstract by Al disclosing species X. The declaration explains how X is the same in both disclosures. The attorney points out that an inventor's oath or declaration under 37 CFR 1.63 signed by Al is already of record.

Question: Is the declaration sufficient to disqualify Ty's disclosure of X as prior art?

Example 6: 130(b) Declaration to Invoke 102(b)(1)(B) Exception for Inventor-Originated Prior Public Disclosure (cont.)

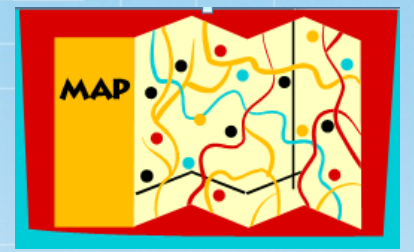
Answer: Yes.

The declaration is sufficient to disqualify the disclosures of the genus and species X in Ty's journal article as prior art.

- A copy of the printed conference proceeding is included with the declaration, as required by 37 CFR 1.130(b)(1).
- The declaration explains how X is the same in both disclosures
- Al's inventor's oath or declaration under 37 CFR 1.63 establishes that he invented X.
- Al publicly disclosed the same subject matter X before it had been disclosed by the third party Ty.

However, Ty's disclosure of species Y is not disqualified as prior art. If an obviousness rejection of species X over species Y is applicable, such a rejection would not be overcome with this 130(b) declaration.

Topics of Discussion



- New Rule 37 CFR 1.130 and Evaluation of Declarations
  - 130(a) Declarations of Attribution
  - 130(b) Declarations of Prior Public Disclosure
  - 37 CFR 1.77(b)(6) Statements
- Formal Requirements for 130 Declarations
- Examples of 130(a) and (b) Declarations
- Points to Consider after Filing 130 Declarations
- Comparison of Declarations for Pre-AIA and AIA Applications

Review of 130 Declarations

- A primary examiner decides whether a declaration is sufficient as to formal matters, including timeliness. If the applicant is unsatisfied with the examiner's decision, review is by way of a petition under 37 CFR 1.181, which is decided by the TC Director. See MPEP 717.01(e).

- A primary examiner decides whether a declaration is sufficient on the merits. If the applicant is unsatisfied with the examiner's decision, review is by way of appeal of a rejection to the PTAB. See MPEP 717.01(f).

IMPORTANT! Notice of 130(b) Declarations on Office Forms

- The examiner should mark the 130(b) declaration acknowledgment checkbox and provide the filing date of the 130(b) declaration on the appropriate form (e.g., Office Action Summary, Notice of Allowability, Advisory, etc.).
- If the checkbox is properly marked and a U.S. patent eventually issues on the application, information about the 130(b) declaration will be printed on the face of the patent.
- Examiners who find the patent during a future prior art search for another application will thereby be alerted to the existence of potential prior art having an earlier date than the patent itself.
- Applicants should confirm that their 130(b) declaration has been acknowledged in the action subsequent to its submission.

Acknowledgement of a 130(b) Declaration on the Office Action Summary

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

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

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

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

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

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

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

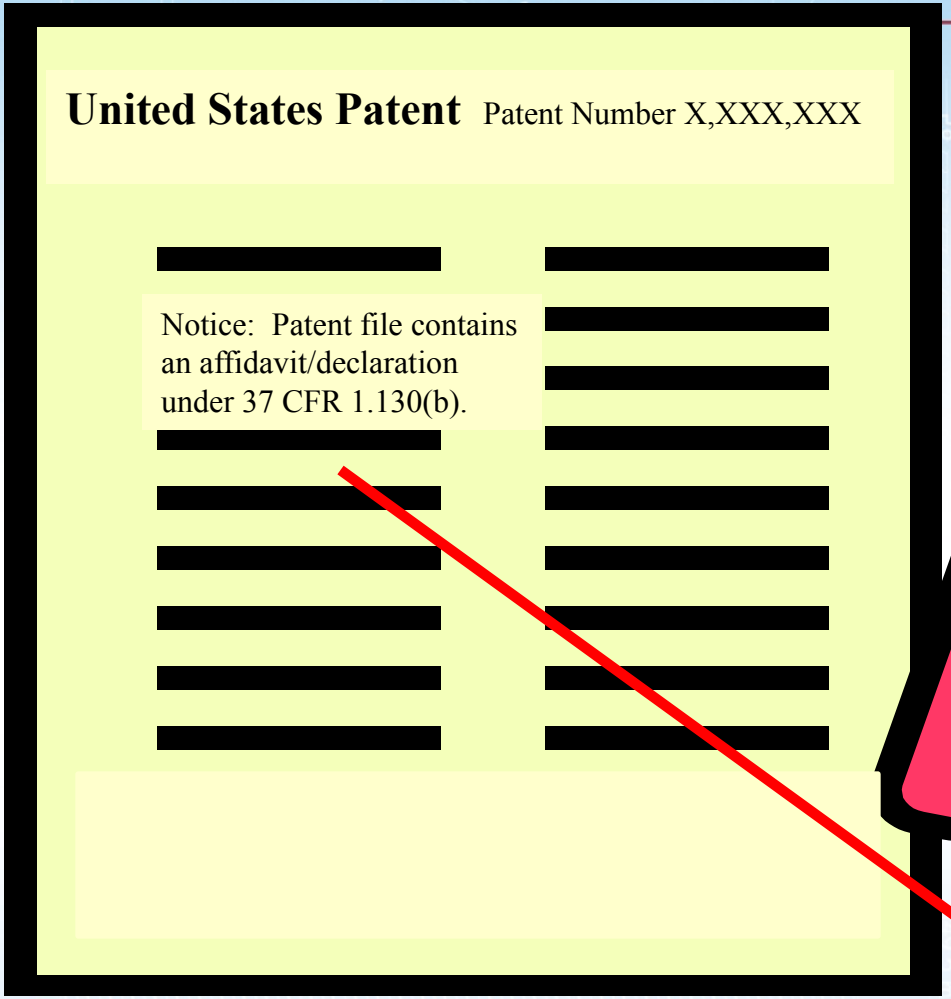
1. ☐ This communication is responsive to _____.

   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☐ The allowed claim(s) is/are _____. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov .

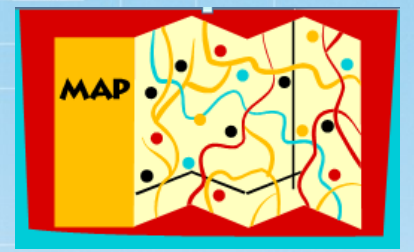
130(b) Declaration Information on the Face of an Issued Patent



The 130(b) notice alerts examiners and the public that the file history of the patent may contain prior art with an earlier date than the effectively filed date of the patent.

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

Topics of Discussion



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- Comparison of Declarations for Pre-AIA and AIA Applications

Comparison of Declarations for Pre-AIA and AIA Applications

Purpose	Current Rule (as of MPEP 9th ed.)	
	Pre-AIA (First-to-Invent) Applications	AIA (First-Inventor-to-File) Applications
Earlier date of invention (formerly rule 131)	131(a)	Not available
Attribution (Katz Type Declaration)	132	130(a)
Prior public disclosure	Not available	130(b)
Rare current common ownership declaration with terminal disclaimer (not the more frequently used common ownership statement under pre-AIA 103(c) or AIA 102(b)(2)(C))	131(c) Formerly pre-AIA 130(a)	Not available
Other traversal of rejection or objection (e.g., unexpected results, commercial success, etc.)	132	132

Document Codes and Document Descriptions for Declarations after March 15, 2013

RULE FOR SUBMISSION OF DECLARATION	DOCUMENT DESCRIPTION IN IFW	DOC CODE
130(a)	Affidavit-Rule 130(a)-AIA (FITF) ONLY	AF/D.130A
130(b)	Affidavit-Rule 130(b)-AIA (FITF) ONLY	AF/D.130B
131(a) or 131(c)	Affidavit-Rule 131-pre-AIA (FTI) ONLY	AF/D.131
132	Affidavit-traversing rejectns or objectns rule 132	AF/D.132
Not Covered by a Specific Rule	Affidavit-not covered under specific rule	AF/D.OTHER

AMERICA INVENTS ACT
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AIA Implementation Information

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- Patent Examination
- Inter Partes Disputes
- Fees and Budgetary Issues
- AIA Studies and Reports
- Programs
- Implementation Status

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AIA Statistics

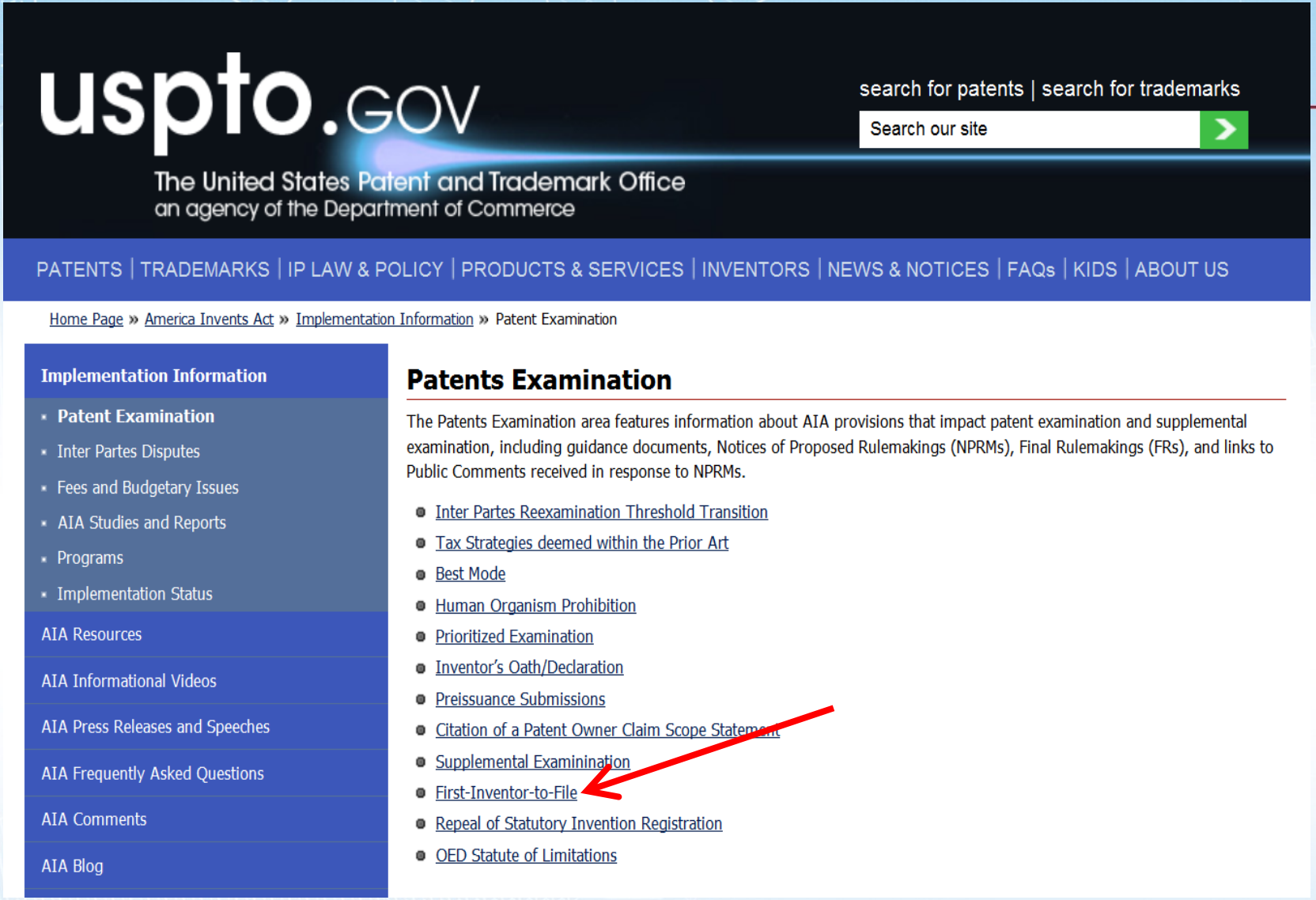
Leahy-Smith America Invents Act Implementation

President Barack Obama signs the America Invents Act September 16, 2011, at Thomas Jefferson High School for Science and Technology in Alexandria, VA.

USPTO Seeking Written Comments on Virtual Marking for AIA Report

The AIA requires the USPTO to report on the effectiveness of virtual marking as an alternative to physically marking articles with patent information. The AIA contained a provision permitting a virtual mark as a means of providing public notice that an article is subject to patent protection in lieu of a physical mark on the patented article. The AIA mandates the USPTO to complete the report for Congress by September 16, 2014

AIA Patent Examination



AIA Patent Examination: First Inventor to File

First-Inventor-to-File

The First Inventor to File (FITF) provisions transition the U.S. to a first-inventor-to-file system from a first-to-invent system. The FITF provision includes a 1-year grace period. Specifically, prior art disclosures made publicly available one year or less before the effective filing date can be overcome by applicant showing (1) the prior art disclosure was by another who obtained the disclosed subject matter from the applicant (a deriver), see 102(b)(1)(A), or (2) the applicant or a deriver publicly disclosed the subject matter before the date of the prior art disclosure, see 102(b)(1)(B). The effective filing date for a claimed invention in an application now includes the filing date of a prior foreign application if applicant is entitled to foreign priority and thus, in this situation, the 1-year grace period will be measured from the foreign priority date claimed. A prior disclosure of the invention which is publicly available more than one year before the effective filing date of an application continues to be a statutory bar. Prior public use or sale is no longer limited to the U.S. For prior art purposes, U.S. patents and patent application publications are available as prior art as of any foreign priority date, provided that the subject matter being relied upon is disclosed in the foreign priority application. Applicants can now rely on common ownership or joint research agreement provisions to overcome rejections under 35 U.S.C. 102. In addition, derivation proceedings are established in place of interference proceedings for FITF applications and patents. The FITF provisions take effect on March 16, 2013. 35 U.S.C. 102 and 103 in effect before March 16, 2013 will apply to applications filed before March 16, 2013, and continuations and divisionals of such applications. 35 U.S.C. 102 and 103 in effect on March 16, 2013, will apply to any application that ever contains a claim that has an effective filing date on or after March 16, 2013. 35 U.S.C. 102(g) in effect before March 16, 2013, will apply if the application ever contains a claim that has an effective filing date before March 16, 2013.

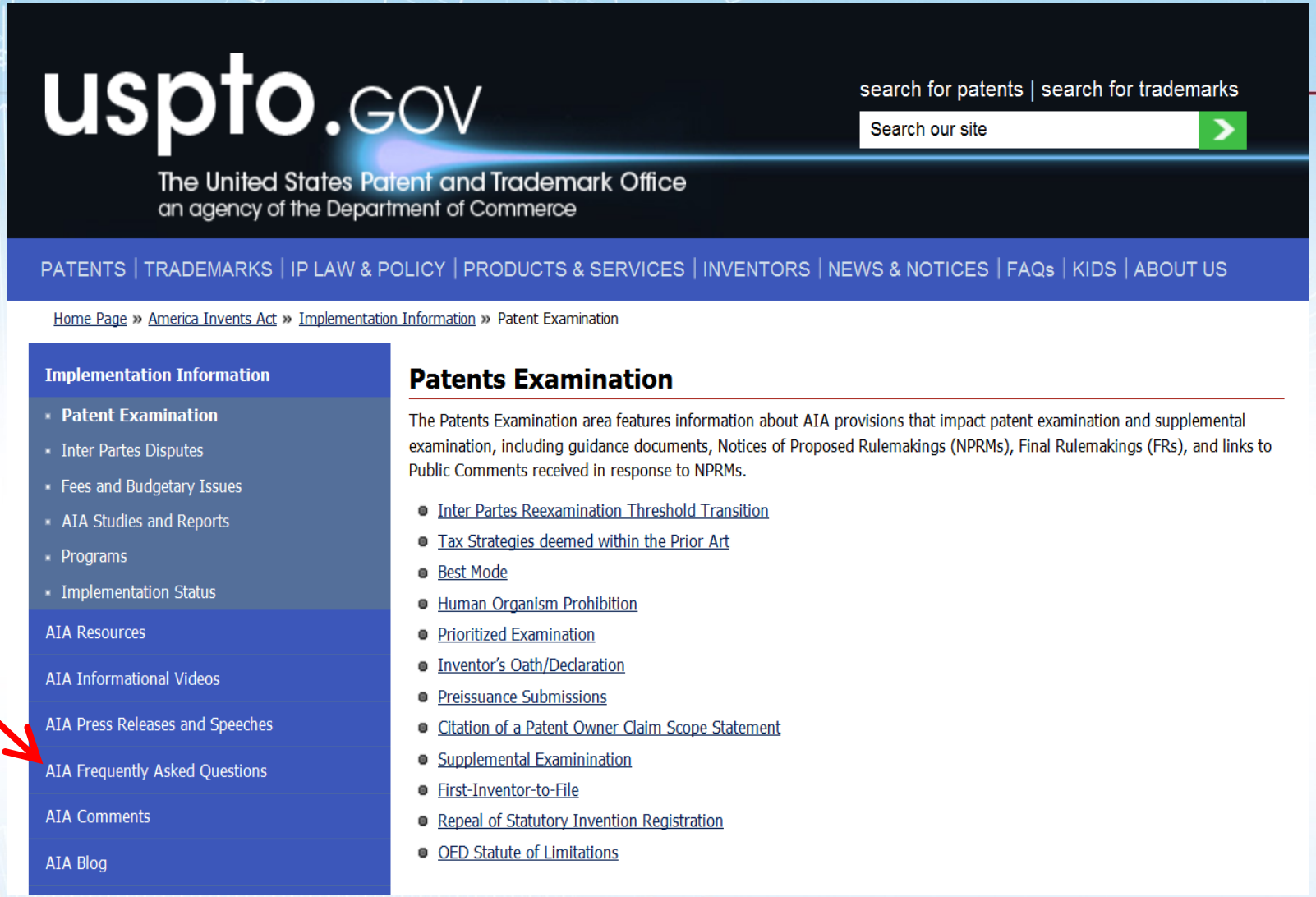
FITF Public Forum, April 1, 2014

- Slideset *[PPT]*

Examiner Training

- First-Inventor-to-File Training Plan for USPTO Examiners *[PDF]*
- First-Inventor-to-File Statutory Framework Chart *[PDF]*
- Overview CBT (March 2013) (46 min) Video | Slides *[PDF]*
- Overview Follow-On Video (March 2013) (27 min) Video | Slides *[PDF]*
- FITF Definitions (June 2013) (14 min) Video | Slides *[PDF]* / Handout *[PDF]*
- Comprehensive Examiner Training Slides (Summer 2013) Video | Slides *[PDF]*
- AIA FITF Indicator Training (Fall 2013) Video

AIA Patent Examination



AIA Patent Examination: Frequently Asked Questions

Frequently Asked Questions: First Inventor to File

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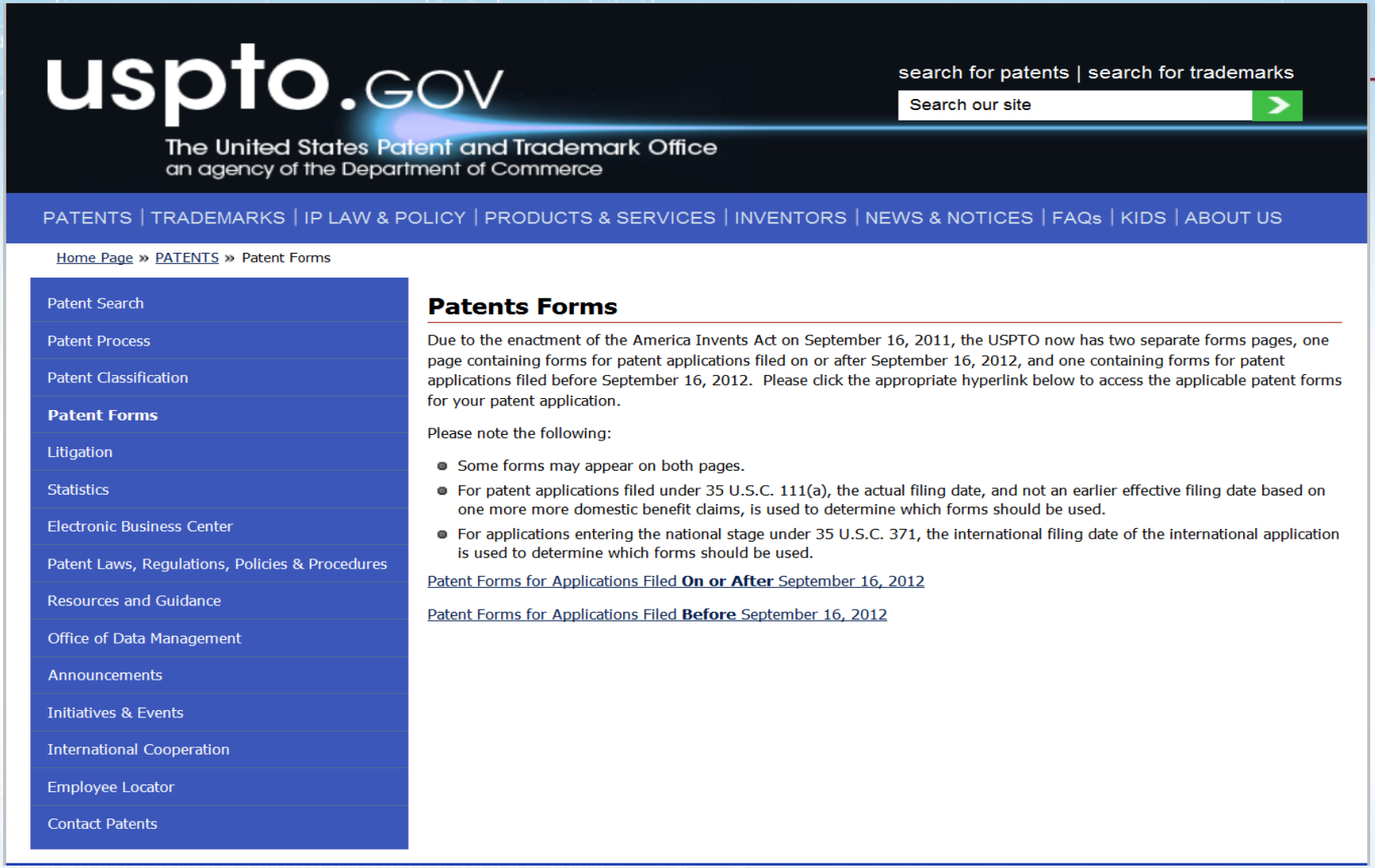
AMERICA INVENTS ACT
IMPLEMENTATION

Patent Forms



AMERICA INVENTS ACT
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THANK YOU
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Time for Q&A

For future questions:
HelpAIA@uspto.gov.

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Mary Till	OPLA	mary.till
Susy Tsang-Foster	OPLA	susy.tsang-foster
Kathleen Bragdon	TC 1600	kathleen.bragdon
Chris Grant	TC 2400	chris.grant
Tom Hughes	TC 3700	tom.hughes
Cassandra Spyrou	TC 2800	cassandra.spyrou
MaryBeth Jones	OPQA	marybeth.jones
Gerald Leffers	OPQA	gerald.leffers
Steven Saras	OPQA	steven.saras
Donald Sparks	OPQA	donald.sparks
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