

Intellectual Property Advisory

## “Why, I declare” ... Proper Use of Evidentiary Declarations under New (Post-AIA) Rule 37 C.F.R. 1.130

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The Leahy-Smith America Invents Act (AIA) was signed into law on September 16, 2011. While the AIA alters U.S. patent practice in several ways, perhaps the most significant change brought about by the law is the switch from a “first to invent” to a “first inventor to file” system, largely for purposes of harmonizing U.S. practice with the majority of other countries. This article explains the different ways that declarations can be used for evidentiary purposes under AIA rules and provides practical tips for right (and wrong) ways of using declarations.

U.S. utility applications fall under the AIA regime if the application contains or ever contained a claim to an invention with an effective filing date on or after March 16, 2013 or is a continuation, divisional, or continuation-in-part of an earlier application that at any time contained a claim to an invention with an effective filing date on or after March 16, 2013. As of September 2014, based on information provided by the U.S. Patent and Trademark Office (USPTO), approximately 34% of currently pending applications filed on or after March 16, 2013 are subject to the requirements of the new law.<sup>1</sup>

Before describing the use of evidentiary declarations in a post-AIA world, it is important to first understand what qualifies as prior art under the statute.

### The AIA Redefines Prior Art and Sets Out Exceptions for Its Application

In addition to the switch to a first inventor to file system, the AIA also overhauled the definitions of what is considered prior art for purposes of assessing the novelty and obviousness of claims during prosecution. In contrast to pre-AIA 35 U.S.C. §102, only two subsections of the AIA identify potential prior art.<sup>2</sup>

AIA 35 U.S.C. §102(a)(1) is most directly comparable to pre-AIA 35 U.S.C. §§102(a) and (b) and is for *public disclosures* having a public availability date prior to the effective filing date of the claimed invention under examination. AIA 35 U.S.C. §102(a)(2) is similar to old 35 U.S.C. §102(e) and is directed to issued or published U.S. patent documents<sup>3</sup> “by another” with an effective filing date prior to the effective filing date of the claimed invention under examination.

In contrast to pre-AIA rules, the AIA now contains exceptions to prior art identified under §§102(a)(1) and 102(a)(2). That is, even if a prior disclosure of claimed subject matter falls within the scope of §102(a)(1) and/or §102(a)(2), it may not be used in a prior art rejection if one of the exceptions of §§102(b)(1) or 102(b)(2) applies.<sup>4</sup> Practice Tip: With respect to the exceptions to §§102(a)(1) and 102(a)(2), it is important for practitioners to remember that §102(b)(1) exceptions apply *only* to §102(a)(1) prior art and that §102(b)(2) exceptions apply *only* to §102(a)(2) art, respectively. In other words, the exceptions for §102(b)(2) cannot be applied to §102(a)(1) art and §102(b)(1) exceptions cannot be applied to §102(a)(2) art.

### Declarations for §§102(b)(1)(A) and 102(b)(2)(A) Exceptions to Prior Art

While differing in their statutory requirements, the §§102(b)(1)(A) and 102(b)(2)(A) exceptions for art raised under §§102(a)(1) and 102(a)(2), respectively, are exceptions based on “attribution.” That is, if an applicant can demonstrate that the potential prior art originated with one or more members of the inventive entity, that art cannot be raised by an Examiner during prosecution or be relied upon for invalidation in litigation or during a post-issuance USPTO proceeding.



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For the 35 U.S.C. §102(b)(1)(A) exception to apply to potential prior art under §102(a)(1), the prior art must be (1) a public disclosure made within the one year grace period prior to the effective filing date of a claimed invention, and (2) an “inventor-originated disclosure.” That is to say, the subject matter in the publicly disclosed material must be attributable to the inventor, one or more co-inventors, or another who obtained the subject matter directly from the inventor or a co-inventor.

In contrast, for the 35 U.S.C. §102(b)(2)(A) exception to apply to potential prior art under §102(a)(2), the prior art U.S. patent or U.S. patent application publication must disclose subject matter that was obtained from one or more members of the inventive entity either directly or indirectly. Note that in contrast to the exception under §102(b)(1)(A), the §102(b)(2)(A) exception does not contain a grace period.

Under the new AIA regime, rule 37 C.F.R. 1.130(a) sets out the requirements for declarations<sup>5</sup> of attribution which can be used to invoke the §102(b)(1)(A) and the §102(b)(2)(A) exceptions. According to 1.130(a), when any claim of an application or a patent under reexamination is rejected, the applicant or a 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 the subject matter disclosed was obtained directly or indirectly from the inventor or joint inventor.

With respect to drafting Rule 130(a) Declarations of Attribution, they must show sufficient facts, in weight and character, to establish that raised prior art 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 the declaration will generally be considered acceptable to disqualify that reference unless evidence to the contrary exists.<sup>6</sup>

Example of a proper use of a Rule 130(a) Declaration: a company files a patent application claiming an invention and Inventor X is listed on the Application Data Sheet. During prosecution, the Examiner cites a journal article authored by Inventor X and Author Y under §102(a)(1) in a novelty rejection, where the article was publicly available six months before the effective filing date of the application. In response, the patent attorney for the company can file a Rule 130(a) Declaration signed by Inventor X asserting that he is the sole inventor of the subject matter disclosed in the journal article. Inventor X can also explain that Author Y was a lab technician working under his direction and supervision who did not contribute to the conception of the claimed invention. A Rule 130(a) Declaration such as this should be sufficient to establish that the journal article is not prior art to this application because it falls within the §102(b)(1)(A) exception for §102(a)(1) art.

## Declarations for §§102(b)(1)(B) and 102(b)(2)(B)

Exceptions to Prior ArtThe §§102(b)(1)(B) and 102(b)(2)(B) exceptions for prior art raised under §§102(a)(1) and 102(a)(2), respectively, are exceptions based on “prior public disclosure” by a third party. In other words, if an applicant can show that the potential prior art subject matter was preceded by an inventor-originated disclosure of the same subject matter, then the prior art can be disqualified.

For the §102(b)(1)(B) exception to apply to potential prior art under §102(a)(1), (1) the third party's disclosure must have been made during the one year grace period of the claimed invention; (2) an inventor-originated disclosure (*i.e.* a “shielding” disclosure) must have been made *prior to* the third party's disclosure; and (3) both the third party's disclosure and the inventor-originated disclosure must have disclosed the same subject matter.<sup>7</sup> The §102(b)(2)(B) exception can apply if (1) the third party's U.S. patent document is effectively filed before the effective filing date of the claimed invention; (2) an inventor-originated disclosure was made *prior to* the effectively filed date of the third party's U.S. patent document; and (3) both the third party's U.S. patent and the inventor-originated disclosure disclose the same subject matter. There is no grace period for the §102(b)(2)(B) exception.

Rule 37 C.F.R. 1.130(b) sets out the requirements for declarations of prior public disclosure which can be used to invoke the §102(b)(1)(B) and the §102(b)(2)(B) exceptions. Under this rule,

[w]hen 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 joint inventor.

Practice Tip: Rule 130(b) Declarations of Prior Public Disclosure should be drafted to show sufficient facts, in weight and character, to establish that the potential prior art subject matter 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. Notably, 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 art disclosure. The third party's disclosure is construed fairly strictly. If the third party's potential prior art disclosure (the intervening disclosure) discloses broad general description of the subject matter (e.g., a broad class encompassing X) and the inventor's disclosure describes specific subject matter X, then this would be deemed to be the same subject matter. However, an obvious variant of the third party's disclosure would not be deemed to be the same subject matter and the exceptions under §102(b)(1)(B) and §102(b)(2)(B) would not apply.<sup>8</sup>

Example of a proper use of a Rule 130(b) Declaration: a company files a patent application claiming an invention and an Application Data Sheet listing Inventor X. Two months prior to the effective filing date, Author Y discloses the claimed invention in a journal article, and the Examiner uses this as the basis for a novelty rejection under 35 U.S.C. §102(a)(1). However, unknown to the Examiner and six months prior to the effective filing date of the application, Inventor X publicly disclosed the invention at a scientific conference. In response to the rejection, the company's patent attorney can file a Rule 130(b) Declaration signed by Inventor X stating that he disclosed the invention at the conference, which was four months prior to Author Y's publication. With the declaration, the company's attorney also includes a copy of the printed conference proceeding and a copy of the abstract of the talk presented at the conference by Inventor X. The declaration further explains that the claimed subject matter is the same in both disclosures and that an inventor's oath or declaration under 37 C.F.R. 1.63 has been signed by Inventor X and is already of record.<sup>9</sup> A Rule 130(b) Declaration containing these pieces of information should be sufficient to disqualify Author Y's journal article as prior art.

## Formalities of Rule 130 Declarations

As with any evidentiary declaration, and in accordance with pre-AIA practice, the person who signs a declaration under Rule 130 must be someone with knowledge of the facts stated in the declaration itself. This can be anyone from an inventor to a joint inventor, or someone else familiar with the facts.

However, new to AIA declaration procedure, the person who *files* a Rule 130 Declaration (*i.e.* the individual signing the transmittal letter) must be someone who may sign a paper under 37 C.F.R. 1.33(b). As such, this person may differ from the individual signing the declaration. If the applicant is an organization or a corporation, a registered patent practitioner must sign the transmittal letter to file the declaration.

## Conclusion

With the passage of time and as more patent applications fall under the AIA regime, it will be crucial for patent practitioners to fully understand and make use of the tools available to them under the new system. An effective Rule 130(a) or 130(b) Declaration can disqualify a disclosure which would otherwise be considered prior art under 35 U.S.C. §§102(a)(1) or 102(a)(2). Consequently, a complete understanding of the circumstances with respect to when these declarations may be used during prosecution will be critical for obtaining the broadest possible patent coverage for clients' inventions.

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**If you have any questions about this topic, please contact the author(s) or your principal Mintz Levin attorney.**

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## Endnotes

<sup>1</sup> 2014 USPTO AIA Fall Roadshow Presentation (available at [http://www.uspto.gov/aia\\_implementation/2014\\_aia\\_fitf\\_roadshow\\_slides.pdf](http://www.uspto.gov/aia_implementation/2014_aia_fitf_roadshow_slides.pdf)), October 7, 2014, Cupertino, CA.

<sup>2</sup> See <http://www.gpo.gov/fdsys/pkg/USCODE-2013-title35/html/USCODE-2013-title35-partII-chap10-sec102.htm> for the statutory text of 35 U.S.C. §§102(a)(1) and 102(a)(2).

<sup>3</sup> Note: This also includes International (PCT) applications that designate the United States for National Phase entry.

<sup>4</sup> See <http://www.gpo.gov/fdsys/pkg/USCODE-2013-title35/html/USCODE-2013-title35-partII-chap10-sec102.htm> for the statutory text of 35 U.S.C. §§102(b)(1) and 102(b)(2).

<sup>5</sup> While the word “declaration” is used throughout this article, 37 C.F.R. 1.130 applies to affidavits as well. Although these two types of evidence may differ with respect to formalistic requirements, substantively they are considered identical.

<sup>6</sup> 2014 USPTO AIA Fall Roadshow Presentation (available at [http://www.uspto.gov/aia\\_implementation/2014\\_aia\\_fitf\\_roadshow\\_slides.pdf](http://www.uspto.gov/aia_implementation/2014_aia_fitf_roadshow_slides.pdf)), October 7, 2014, Cupertino, CA; see also, MPEP §717.01.

<sup>7</sup> Note that according to its training materials, the USPTO has determined that obviousness is *not* the standard for determining whether the third party subject matter is the same as the inventor-originated subject matter. As such, it is likely that the disclosures would have to be sufficient to anticipate one another under the rules governing the establishment of novelty; see 2014 USPTO AIA Fall Roadshow Presentation (available at [http://www.uspto.gov/aia\\_implementation/2014\\_aia\\_fitf\\_roadshow\\_slides.pdf](http://www.uspto.gov/aia_implementation/2014_aia_fitf_roadshow_slides.pdf)), October 7, 2014, Cupertino, CA.

<sup>8</sup> 2014 USPTO AIA Fall Roadshow Presentation (available at [http://www.uspto.gov/aia\\_implementation/2014\\_aia\\_fitf\\_roadshow\\_slides.pdf](http://www.uspto.gov/aia_implementation/2014_aia_fitf_roadshow_slides.pdf)), October 7, 2014, Cupertino, CA.

<sup>9</sup> This is needed for purposes of establishing that Inventor X is the sole and unambiguous inventor of the subject matter at issue. Had the inventor’s oath or declaration under 37 C.F.R. 1.63 not been filed when the Rule 130(b) Declaration was submitted, Inventor X would have needed to unambiguously state that he is the inventor of the claimed subject matter in the declaration itself.