Affidavit Practice 37 CFR § 1.131 and § 1.132

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Carolina Säve, Attorney
What are Affidavits/ Declarations

• A verified signed statement
• No real difference between an Affidavit and a Declaration except how signed
• Designed to refute the factual basis of the rejection
131 v. 132 Declarations

37 C.F.R. 1.131 (applies only to pre-AIA “old rules” cases)

– Illustrates completion of the invention before the “prior art”

– Swear behind activities, patents and publications

37 C.F.R. 1.132

– Catch-all provision

• Present any other evidence
Affidavit Practice 37 CFR § 1.131 and § 1.132

Rule 1.131 Declaration

• Antedating patents or publications
• Effective against prior art under pre-AIA 35 U.S.C. § 102(a), 102(e), or 102(g)
• Not effective against 102(b) rejections
• Only used for “old rules” applications (pre-March 16, 2013)
  – Cannot use for “new rules” (AIA) applications
Content of a 131 Declaration

• **ALL of the inventors**
  - Owner (in Reexamination proceeding), or
  - Party qualified under:
    - 1.42 – Inventor is dead
    - 1.43 – Inventor is insane or legally incapacitated
    - 1.47 – Uncooperative or unavailable inventor

• **Format:**
  - Declaration – merely signed under penalty of perjury
  - Affidavit – signed before Notary Public as well as under penalty of perjury
Content of a 131 Declaration

• Declaration must be supported by some evidence
  - Sufficient factual evidence to establish
    • actual reduction to practice prior to reference date or
    • conception prior to reference date plus reduction to practice
  - A prima facie showing is sufficient
When to file the 131 Declaration

• Considered if filed before a final action
  
  Exception: If accelerated examination under 37 CFR 1.102, then
    – Submit before first action, or
    – Within one month after filing the petition for accelerated examination

Must show the reasons for delay if filed after final action
  – Consider filing RCE to force consideration
Actual reduction to practice

- Evidence must show prior reduction to practice
- Do not need separate evidence of conception
- Redact extraneous information
  - Internal reference numbers, dates, etc.
- Attach evidence to the declaration
  - Applicant has burden of explaining the meaning and pertinence of the evidence
  - Declarant does not have to explain inherently clear evidence
Model Declaration

• I am the inventor of the above referenced patent application

• Prior to (the prior art document's effective date), I completed my invention as described and claimed in the subject application as evidenced by the following:
  – Each of the compounds were made and tested prior to (the prior art document's effective date)
  – Each of the attached Exhibits have been redacted

• The statements made herein are true and that Declarant understands penalty for making willful false statements

• Signed by Declarant
Conception plus Diligence

**Conception**
- Mental part of the inventive act
- Must be supported by tangible evidence

**Diligence**
- Must establish diligence over critical period
  - Show continued activity toward reducing invention to practice from before reference publication date until either:
    - Actual Reduction to Practice, or
    - Filing an application
Conception plus Diligence

• Conception:
  – Supported by activities conducted
    • In the United States
    • In a NAFTA country after December 8, 1993; or
    • In a WTO country after January 1, 1996
  – Tangible evidence showing conception includes, for example:
    • Drawings
    • Research proposal
    • Disclosure to another person, etc.
Conception plus Diligence

• Diligence
  – Critical period - just prior to publication date of the reference until reduction to practice of Applicant’s invention
  – Requirements of Diligence
    • Continuous activity toward reduction to practice
      – Directed to reducing claimed invention or an obvious variant to practice
      – Inactivity can only be excused for cause
    • Inventor is responsible for diligence of those working for him
Overcoming a 102 Rejection

• The Declaration showing is commensurate with both the reference and the rejected claim, e.g., it recites all of the features recited in the reference.

• Removes the reference as art
Overcoming a 102 Rejection

• The Declaration showing is commensurate with the rejected claim but does not read on the reference
  – The showing is sufficient - possession of one embodiment may give Applicant right to claim as broadly as the prior art allows

\[ \text{102 reference} \]
\[ \text{Claimed invention} \]
\[ \text{131 Showing} \]
Overcoming a 102 Rejection

• The Declaration showing is not commensurate with the rejected claim or the reference.
  – Showing can remove reference if the rejected claim would be obvious from the showing’s content.
Overcoming a 103 Rejection

• A 103 rejection based on reference that is prior art under 102(a) or 102(e) can be overcome by a 131 Declaration
• A showing commensurate with the rejected claim removes the reference underlying 103 rejection
Overcoming a 102/103 Rejection

• A 102 or 103 rejection based on reference that is prior art under 102(a) or 102(e) can be overcome by antedating the relevant disclosure of the reference without regard to the claimed invention.
132 Declarations

• Can show that a §102(a) or §102(e) reference is attributable to the Applicant (old rules)

• Declarations used to present evidence in support of the patentability of the claimed invention
  – Rebuttal of §112 rejections
  – Rebuttal of §103 rejections
  – Rebuttal of §102 rejections
    • Rebut allegation of inherency in prior art disclosure
  – Rebuttal of §101 rejections
Attributing Reference to Applicant

• §102(a) or §102(e) require knowledge, documents or activities of “another”

• Useful where the publication authorship is not identical to the inventorship of the application

• A 132 Declaration may be filed to establish that the reference content cited is the Applicant’s own work

• Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by Applicant himself/herself or on his/her behalf

• Not limited to acts which occurred in this country or in a NAFTA/ WTO member country because Applicant is not showing a date of invention
Attesting Reference to Applicant

• Inventor Coauthored Publication
  – No presumption of inventorship
  – Who executes the §132 Declaration?
    • Coauthors can disclaim inventorship
    • Inventor can execute a Declaration asserting
      – That he/she was the inventor of the claim
      – The coauthors of the publication were not authors
      – Must have a “reasonable showing supporting the basis for the applicant’s position”
Attributing Reference to Applicant

• If the reference is a patent having an inventor in common with the application
  – A prior patent having common inventors but not identical inventorship are “by another” §102(e) prior art
  – Inventors can file a Declaration showing that the relevant portions relied upon by the Examiner were contributed by the inventive entity
Advocacy by 132 Declaration

• Vehicle for introducing relevant evidence
  – Submission of evidence in support of Applicant’s argument such as a controverted fact, inference or proposition

• To possess probative value, the §132 Declaration evidence must:
  – Be relevant to the precise contested issue
  – Tend to induce a belief about the probability of the controverted point or fact
Overcoming Obviousness

• Attacking the reference
  – Promote a particular interpretation of a reference
  – Show that the reference is irrelevant
  – Show that the reference is not operable

• Comparative test results
  – Test results for test performed on both invention as claimed and closest prior art

• Showing commercial success
  – Broad acceptance in marketplace
  – Information on advertising and brand name recognition

• Showing long felt need
  – Not satisfied by another
  – Invention satisfies long felt need
  – Persistent long felt need
Addressing §112 rejections

• 132 Declarations may be used to present evidence rebutting rejection or objection asserting insufficient disclosure:
  – Establish the level of knowledge in the field
  – Rebut a holding of undue experimentation
Post AIA

• Post AIA cases will use affidavits differently.
• 131 Declarations will fade out of use.
• 132 Declarations will still be used.
• More declarations on prior publication / grace period under new (post-AIA) Rule 130.
Post AIA

• Declarations on prior publication are covered by new Rule 130
  – Applies only to applications filed on or after March 16, 2013
  – Used to establish entitlement to the one-year grace period

• A Rule 130 Declaration can be used:
  – To disqualify a disclosure as prior art by showing that the disclosure was made by the inventor(s), or the subject matter disclosed was obtained from the inventor(s)
  – 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(s) or another who obtained the subject matter disclosed directly or indirectly from the inventor(s).
Thank you!

Please contact me if you have any further questions.

Email: csave@mintz.com