Challenging Pending Patent Applications: When, Where and What Type
Navigating Third-Party Submissions, Protests and Derivation Proceedings for Pre-Grant Applications

THURSDAY, MAY 26, 2016
1pm Eastern  |  12pm Central  |  11am Mountain  |  10am Pacific

Today’s faculty features:

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Pre-Grant Challenges

for

Leslie McDonell, Adriana Burgy, and Tom Irving
May 2016
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Strategic Use of Pre-Grant Challenges

- Preissuance submissions 35 U.S.C. § 122(e)
- Protests under 37 C.F.R. § 1.291
- Other Third Party Submissions
- AIA derivation proceedings
Pre-AIA

Board of Patent Appeals & Interferences

Examining Corps

Filing

Inter Partes Reexam

Ex Parte Reexam

Issuance

Pre-issuance Submissions
AIA Options

Patent Trial and Appeal Board

Examining Corps

Filing

Pre-issuance Submissions (revised and improved)

Ex Parte Reexam

Post-Grant Review

Inter Partes Review

Issuance
USPTO Stats

USPTO receives ~85/month

Source: http://www.uspto.gov/aia_implementation/statistics.jsp
USPTO Stats

Breakdown of Submissions By Technology Center
September 16, 2012 - November 6, 2015

Number of Submissions Per TC
- TC 1600: 535
- TC 1700: 749
- TC 2100: 184
- TC 2400: 168
- TC 2600: 186
- TC 2800: 493
- TC 3600: 408
- TC 3700: 562

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
USPTO Stats

Breakdown of Submission Compliance
November 6, 2015

Improper 21%
Unreviewed 1%
Proper 78%

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
USPTO Stats

Breakdown of Proper Submissions By Technology Center
September 16, 2012 - November 6, 2015

Number of Proper Submissions Per TC

<table>
<thead>
<tr>
<th>Technology Center</th>
<th>Number</th>
</tr>
</thead>
<tbody>
<tr>
<td>TC 1600</td>
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<td>TC 1700</td>
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<td>TC 2100</td>
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<td>TC 2800</td>
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<td>461</td>
</tr>
</tbody>
</table>

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
USPTO Stats

Breakdown of Documents Submitted
September 16, 2012 - November 6, 2015

- Non-Patent Literature, 2997
- Patents, 2954
- Foreign Reference, 1702
- Published US Apps, 2225

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
USPTO Stats: Examiner Survey

52% rated Great to Moderately Useful
48% rated Limited to Not Useful

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
USPTO Stats: Examiner Survey

63.5% rated Great to Moderately Useful
36.5% rated Limited to Not Useful

Source: http://www.uspto.gov/patent/initiatives/preissuance-submissions/resources
(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

See MPEP § 2128 for guidance regarding “printed publications”
NOTE: must be filed prior to not on the final date
TYPES OF APPLICATIONS

- Any non-provisional
  - Utility application
  - Design application
  - Plant application
  - Continuing application of any of the above

- Filed before, on, or after September 16, 2012
- Even if unpublished
- Even if abandoned
TYPES OF APPLICATIONS (cont.)

- Not available in
  - Reissue applications
  - Reexamination applications

- But can file protests in reissue applications
  (next section)
TYPES OF REFERENCES

- Need not qualify as prior art
- Can already be of record
- Can be cumulative
REQUIREMENTS

- List of items (patents, publications, or other printed publications).
- Concise description of relevance.
  - Narrative, claim chart, background of technology.
- Legible copy of non-US patent documents.
- Translation (if necessary).
- Statement of compliance with statute and rule.
- Fee ($180) per 10 documents.
  - No fee for 3 or fewer (if it is a party’s first submission).

35 U.S.C. § 122(e)(2) and 37 C.F.R. § 290
CONCISE DESCRIPTION

- Should explain how the publication is of potential relevance to the examination of the application:
  - Provide more than a bare statement
  **BUT**
  - Do **not** include arguments against patentability
  - Do **not** set forth conclusions regarding whether one or more claims are patentable
  - Do **not** include proposed rejections
  - Can’t appear to be participating in prosecution
PREISSUANCE SUBMISSIONS: CONSIDERATIONS

- No arguments against patentability but concise description of relevance shows examiner how a claim may not be patentable.
  - Claim charts may be one tool.
  - How to describe the relevance of the references should be carefully considered.

- Incorporate third-party submissions as part of a patent monitoring program or due diligence review.
  - Very low cost.
  - Accessible tool to small companies/independent inventors.
PREISSUANCE SUBMISSIONS: CONSIDERATIONS

- Consider making submission at the earliest opportunity - if initial submission found noncompliant, there will still be time to re-submit.

- May force patent applicant to amend claims.
HOW HANDLED BY PTO

- Reviewed for compliance before entered on record
- PTO will notify filer of non-compliance only if participating in e-Office Action program
- If non-compliant, may file another complete submission if still within time period
  - No amendments
  - Non-compliant submission does not toll timing
HOW HANDLED BY PTO (cont.)

- Consideration by examiner
  - Take up as part of next action.
  - Consider statement of relevance like IDS.
  - 3rd party not permitted a response to examiner’s treatment.

- Applicant actions
  - No need to file IDS.
  - Applicant need not reply to submission.

- Not for Reissue applications or Reexaminations
  - Not pre-issuance procedures.
  - Reissues: use Protests under 37 C.F.R. 1.291
PROS/CONS

- **Advantages**
  - Low cost
  - Description of relevance allowed
  - No estoppel on art/arguments
  - Anonymity

- **Disadvantages**
  - Fairly narrow window
  - No participation
  - “Best” art overcome
PROTESTS

- 37 C.F.R. § 1.291 *Protests by the public against pending applications*
  - A protest may be filed by a member of the public against a pending application
  - Must adequately identify the patent application
  - Recognizes the value of written protests in bringing information to the attention of the Office
PROTESTS: NUTS AND BOLTS

37 C.F.R. §1.291

- Filed by a member of the public against a pending application;
- Served and filed prior to the date the application was published or the date a notice of allowance was given or mailed, whichever occurs first.
- List of the information being submitted, including, as applicable: patent/application number, first named inventor, and issue/publication date; or author, title, publication date, publisher, place of publication.
- A concise explanation of the relevance of each item.
- A legible copy if item is not a patent or publication patent application.
- An English language translation if necessary.
PROTESTS: NUTS AND BOLTS

- 37 C.F.R. §1.291(b)(2): “A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section.”

- 37 C.F.R. §1.291(c)(5): “If it is a second or subsequent protest by the same party in interest, an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under §1.17(i) [$140] must be submitted.”
PROTESTS: NUTS AND BOLTS

- § 1.291(d): No Office communication to 3rd party
  - 3rd party involvement ends with submission of protest

- § 1.291(e): Where inequitable conduct is raised and satisfies entry, submission entered generally without comment on the issues raised

- § 1.291(f): Unless requested, no requirement for applicant reply to a protest
PROTESTS: NUTS AND BOLTS

§ 1.291: Protest in Reissue Application

- File throughout pendency of the reissue application prior to the mail date of the Notice of Allowance
- Ideally, within **TWO** months following the announcement in the Official Gazette
- Express written consent not applicable to reissue which is a post-issuance proceeding (M.P.E.P. § 1441.01)
PROS/CONS

Advantages

- Cost (first is free)
- Comments/arguments allowed
- Not restricted to patents, published applications, and printed publications
  - May even include inequitable conduct allegations
- No estoppel on art/arguments

Disadvantages

- Narrow window
- No participation
- Limited to one unless provide explanation according to rules and pay fee
# Preissuance Submission v. Protest

<table>
<thead>
<tr>
<th></th>
<th>Preissuance Submission</th>
<th>Protest</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Content</strong></td>
<td>Printed Publications</td>
<td>Publications, information, arguments, and prior use</td>
</tr>
<tr>
<td><strong>Concise</strong></td>
<td>Description of Relevance</td>
<td>Explanation of Relevance</td>
</tr>
<tr>
<td><strong>Timing</strong></td>
<td>Pre- &amp; Post-Publication</td>
<td>Pre-Publication; Consent post-publication</td>
</tr>
<tr>
<td><strong>Timing of Filing</strong></td>
<td>Prior to Allowance and Prior to the later of: 6 month post-publication OR first rejection</td>
<td>Prior to allowance and prior to publication; OR prior to allowance and post-publication with consent</td>
</tr>
<tr>
<td><strong>Reissue?</strong></td>
<td>N/A</td>
<td>Up to Allowance</td>
</tr>
</tbody>
</table>

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Other Third Party Submissions

- **35 U.S.C. § 122(c):** No protest or other form of pre-issuance opposition may be initiated after publication of an application without the express written consent of the applicant (PROTEST – 37 C.F.R. § 1.290)

- **35 U.S.C. § 122(e):** Any third party may submit printed publications of potential relevance to the examination of an application for consideration and inclusion in the record of the application. Such submission must be timely (PREISSUANCE – 37 C.F.R. § 1.291)
Other Third Party Submissions

- Limitations on ways in which to protest, oppose the grant of, or have information entered and considered in a pending application
  - Need to comply with 37 C.F.R. §§ 1.290, 1.291 or will not be entered . . . Discarded!!

- USPTO can independently re-open the prosecution of a pending application on its own initiative
Other Third Party Submissions

- M.P.E.P. § 1134: Third Party Inquiries . . .

  Office personnel (including the Patent Examining Corps) are instructed to:

  1. not reply to or act upon any third-party inquiry or other submission in an application, except those in compliance with 37 C.F.R. § 1.290 or 37 C.F.R. § 1.291; and

  2. decline to accept oral or telephone comments or submissions about applications from third parties.

When refusing third-party telephone or oral discussions, examiners may call the party’s attention to the statutory prohibition on initiating protests, or 37 C.F.R. § 1.2 (all Office business should be transacted in writing), as appropriate. See Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application, 1269 Off. Gaz. Pat. Office 179 (April 22, 2003).

The Office may also refer third-party inquiries, or submissions not provided for in 37 C.F.R. § 1.290 or 37 C.F.R. § 1.291, by registered practitioners in applications to the Office of Enrollment and Discipline for appropriate action.
U.S. INTERFERENCE AND DERIVATION PROCEEDINGS

- Interference Winner: First to Invent
  - Compare conception and reduction to practice dates
  - Possible diligence consideration

- Derivation Winner: First to Conceive and communicate to another.

Note: Derivation proceedings existed before AIA, but revised to replace interferences as part of the move away from “first-to-invent”
New 35 U.S.C. § 135 provides:

- Petition to institute a derivation proceeding necessitates:
  - Substantial evidence of derivation
  - Earlier application filed without authorization
  - Within 1 year after first publication of a claim to the same or substantially the same subject matter

- Director *may* institute a derivation proceeding
- Director’s determination is final and nonappealable.
- Effective date, AIA SEC. 3(n)(1) and (2).
New 35 U.S.C. § 291 provides:

A may sue B if:

- B’s U.S. patent claims the same invention as A’s patent;
- B’s U.S. patent has an earlier effective filing date; and
- The subject matter of B’s patent was derived from A.

Suit must be filed within 1 year of issuance of B’s Patent.

Effective date, AIA SEC. 3(n)(1) and (2).
WHO MAY FILE

- Only an applicant for patent may file a petition to institute a derivation proceeding (Rule 42.402)
  - Includes reissue applicants (Rule 42.401)

- Incomplete petitions must be cured
  - Within one month, or
  - Within the statutory period for the derivation
NUTS AND BOLTS - Rule 42.405

- Petition must establish “same or substantially the same” relationships among:
  - Petitioner’s claim (P);
  - Respondent’s earlier claim (R); and
  - Invention disclosed by Petitioner to Respondent (D)
NUTS AND BOLTS - Rule 42.405 (cont.)

- Petition must also establish:
  - The earlier claimed invention was derived from an inventor named in Petitioner’s patent application.
  - This inventor did not authorize the filing of the earlier patent application.
  - Must be supported by corroborated, substantial evidence, including at least one affidavit that, if left unrebutted, would support a determination of derivation.
TRIAL

- A derivation proceeding is a trial operating under the same rules as *Inter Partes* Reviews, Post Grant Reviews, and Covered Business Method Reviews.

- Estoppel: “the losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after judgment that is inconsistent with that party’s failure to move” (Rule 42.73(d)(2))

- Deriver gets no prior user rights (§ 273(e)(2))
TIPS

- Present the best case possible in the petition
  - Unlike interference practice, where proofs of derivation can be developed through discover after institution, the PTAB has a “goal of avoiding institution of costly proceedings that lack merit.”

- Explicitly identify how the evidence establishes each element.

- Maintain corroborating evidence of work to establish conception, not merely possession
Importance Of Determining Inventorship Pre- And Post-AIA

- Who owns the Patent?
- What is Prior Art?
- Double Patenting
- Best Mode & Inequitable Conduct

Often becomes issue during discovery!
The proper and correct naming of the inventor permits the legal chain of title to be established from the inventor to the assignee-applicant for patent.

And inventors still required to be named, even if patent application filed by non-inventor (assignee).

AIA SEC. (3)(n)(2) expressly brings into play 35 U.S.C. §§ 102(g), 135, and 291, where proof of first inventorship may be critical.

AIA’s derivation proceedings are under new 35 U.S.C. §135.

For those U.S. patents and applications with claims having an EFD prior to March 16, 2013, “first-to-invent” still applies. As noted earlier, pre-AIA will be around until at least 2034!
§ 1.110 Inventorship and ownership of the subject matter of individual claims.

When one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its EFD (as defined in § 1.109) or on its date of invention, as applicable, when necessary for purposes of an Office proceeding. The Office may also require an applicant or patentee to identify the invention dates of the subject matter of each claim when necessary for purposes of an Office proceeding.
Inventor may use an affidavit/declaration to show prior public disclosure and disqualify prior art.

If assert derivation in the affidavit/declaration, inventor may file petition for derivation proceeding, but does not have to (as was in the proposed rules).

Statement may be sufficient.

See pp. 11027 of Rules (2/14/13).
See pp. 11063, 11067 of Examination Guidelines (2/14/13).
Rule 130 applicable to AIA applications.

- disqualifying prior art by establishing that the disclosure was by the inventor/joint inventor or was a prior public disclosure of the subject matter.

- “Section 1.130(a) pertains to the provisions of subparagraph (A) of AIA 35 U.S.C. 102(b)(1) and (b)(2)...Section 1.130(b) pertains to the provisions of subparagraph (B) of AIA 35 U.S.C. 102(b)(1) and (b)(2).”

Rule 131 applicable to pre-AIA applications.

- prior invention.

For mixed applications, “the provisions of § 1.131 are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013. Because of AIA SEC 3(n)(2).

See pp. 11030, 11036 of Rules (2/14/13).
Proposed rules included provision to make derivation proceeding mandatory.

Final rules permit, but do not make mandatory.

“Section 1.130 as adopted in this final rule does not include a requirement to file a petition for a derivation proceeding and instead provides that an applicant or patent owner may file a petition for a derivation proceeding if the patent or pending application naming another inventor claims an invention that is the same or substantially the same as the applicant’s or patent owner’s claimed invention.”

See pp. 11045 of Rules (2/14/13).
§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act. (see next slide)

(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.
FITF Final Rule
Removing Prior Art

- § 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.
  - (b) **Affidavit or declaration of prior public disclosure.** When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
    - (1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.
    - (2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed on that date by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
No Rule 130 affidavit when rejection is based upon a public disclosure made more than one year before the effective filing date of the claimed invention.

“Note that the provisions of § 1.130 are available to establish that a rejection under AIA 35 U.S.C. 102(a)(2) is based on an application or patent that was effectively filed more than one year before the effective filing date of the claimed invention under examination, but not publicly disclosed more than one year before such effective filing date, where the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.” See pp. 11036 of Rules (2/14/13).
FITF Removing Final Rule

When Rule 130 Not Available: Cannot Use Rule 130 to Avoid A Derivation Proceeding

- No Rule 130 affidavit when two applications to same subject matter, one is applied as 102(a)(2) art, and the inventor of the other alleges that the 102(a)(2) art derived a relevant invention disclosed therein from the inventor.

See pp. 11036 of Rules (2/14/13).
“Permitting two different applicants to each aver or declare that an inventor named in the other application derived the claimed invention without a derivation proceeding to resolve who the true inventor is could result in the Office issuing two patents containing patentably indistinct claims to two different parties. Thus, the Office needs to provide that the provisions of § 1.130 are not available in certain situations to avoid the issuance of two patents containing patentably indistinct claims to two different parties.”

See pp. 11036 of Rules (2/14/13).
§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.

(c) When this section is not available. The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant’s or patent owner’s claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, in which case an applicant or a patent owner may file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title.
§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.

(d) Applications and patents to which this section is applicable. The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013.
Type of evidence sufficient to show that the “disclosure originated with the inventor or a joint inventor …is necessarily a case-by-case determination.”

“an ‘unequivocal’ statement from the inventor or a joint inventor that he/she (or some specific combination of named inventors) invented the subject matter of the disclosure, accompanied by a reasonable explanation of the presence of additional authors, may be acceptable in the absence of evidence to the contrary. However, a mere statement from the inventor or a joint inventor without any accompanying reasonable explanation may not be sufficient where there is evidence to the contrary.”

See pp. 11065 of Examination Guidelines (2/14/13).
§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under § 1.42 or § 1.46, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e) as in effect on March 15, 2013. …Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application naming another inventor which claims interfering subject matter as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.
§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.

(c) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 as in effect on March 15, 2013, on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b) as in effect on March 15, 2013, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

1. A terminal disclaimer in accordance with § 1.321(c); and

2. An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104 as in effect on March 15, 2013.
§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.

(d) The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

1. A claim to an invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013; or

2. A specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to an invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013.
For mixed applications ("transition applications," i.e., JMM), when Rule 131 could be used, only pre-AIA §102(g).

“Section 1.131(e) is added to provide that, in an application for patent to which the provisions of §1.130 apply, and to any patent issuing thereon, the provisions of §1.131 are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013.”
FITF Revision to Rule 131:
Text of Rule 131

- § 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.
  - (e) In an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, the provisions of this section are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013
“the Office is clarifying that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal).”

See pp. 11035 of Rules (2/14/13).
Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in order for the exception based on a previous public disclosure of subject matter by the inventor or a joint inventor to apply. The examination guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor.”

See pp. 11035 of Rules 2/14/13.
FITF Final Rules
130 and 131 Affidavits/Declarations
Comments

- For disqualification of prior art based on public disclosure in a printed publication – provide copy to USPTO.

- If no printed publication, provide sufficient detail of the public disclosure.

See pp. 11035 of Rules (2/14/13).
“The Office needs these details to determine not only whether the inventor is entitled to disqualify the disclosure under AIA 35 U.S.C. 102(b), but also because if the rejection is based on a U.S. patent application publication or WIPO publication of an international application to another and such application is also pending before the Office, this prior disclosure may be prior art under AIA 35 U.S.C. 102(a) to the other earlier filed application, and the Office may need this information to avoid granting two patents on the same invention.”

See pp. 11035 of Rules (2/14/13).
Impact on Licensing

- Determine which law should have been applied by USPTO by analyzing EFD of all claims.
  - AIA
  - Pre-AIA
  - Transitional (JMM): AIA plus part of pre-AIA

- Determine that the correct law was applied by USPTO.
Impact on Licensing

- Consider any statements by patentee about which law applies.

- Determine inventorship and ownership (no change there).

- Consider any affidavits filed, particularly under Rule 130 to establish exceptions to §102(a)(1) and/or §102(a)(2) prior art.
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