

Invoking an AIA Exception to Prior Art, 1.130 Declarations

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Arguably, no other provision of the America Invents Act (AIA) is more important than 35 U.S.C. § 102. It defines what activities preclude patentability and what documents are available as prior art. Applications having an effective filing date that is on or after March 16, 2013 are subject to the new AIA § 102. As more AIA applications are being examined, granted and involved in post-grant proceedings, it is increasingly important to understand AIA § 102 and what conditions can create an exception to its rules.

AIA § 102 differs from the pre-AIA § 102 in several significant aspects, indicated below:

Pre-AIA 35 U.S.C. § 102 (Before March 16, 2013)	AIA 35 U.S.C. § 102 (On/after March 16, 2013)
A person shall be entitled to a patent unless - (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or	Corresponds to § 102(a)(1)
(c) he has abandoned the invention, or (d) <i>(Invention was first patented in a foreign country)</i>	No corresponding provision
(e) the invention was described in - 1. an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or 2. a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or	Corresponds to § 102(a)(2)
(f) he did not himself invent the subject matter sought to be patented, or	Corresponds to § 291
(g) <i>(Prior invention by another)</i>	No corresponding provision

Prior art is defined in 35 U.S.C. § 102(a)(1) and § 102(a)(2)

- According to § 102(a)(1), prior art includes **public disclosures** that are (i) available before the effective filing date of the claimed invention, and (ii) patented, described in a printed publication, in public use, on sale, or “otherwise available

to the public.”

- ◇ AIA did not change the pre-AIA “on-sale” bar. In reaching its decision in *Helsinn Healthcare*, the Supreme Court applied a presumption “that when Congress reenacted the same “on sale” language in the AIA, it adopted the earlier judicial construction of that phrase. *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 586 U. S. ____ (2019).
- According to § 102(a)(2), prior art also includes **issued or published U.S. patent documents** that (i) name another inventor, and (ii) were effectively filed before the effective filing date of the claimed invention.
- The availability of a disclosure as prior art depends upon the **effective filing date** of the claimed invention. See 35 U.S.C. § 100(i).
 - ◇ Unlike pre-AIA law, the AIA provides that a **foreign priority date can be the effective filing date** of a 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).

35 U.S.C. § 102(b) provides exceptions to the prior art defined in 35 U.S.C. § 102(a)

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

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Prior art exceptions under 35 U.S.C. § 102(b)(1)

- § 102(b)(1)(A) provides a **grace period for a disclosure made by an inventor, or obtained from an inventor** that prevents the disclosure from being used as the basis for rejection.
 - ◇ For the § 102(b)(1)(A) exception to apply to a public disclosure under § 102(a)(1), the disclosure must be:
 - » Made one year or less before the effective filing date of the claimed invention, and
 - » Made by the inventor or joint inventor or by “another” who obtained the disclosed subject matter directly or indirectly from the inventor or joint inventor (*i.e.*, an “inventor-originated” or “shielding” disclosure).
- § 102(b)(1)(B) provides a **grace period for an intervening disclosure by a third party** that prevents the disclosure from being used as the basis for rejection.
 - ◇ For the § 102(b)(1)(B) exception to apply to a third party’s public disclosure under § 102(a)(1) of subject matter X:
 - » The third party’s disclosure must have been made one year or less before the effective filing date of the claimed invention,
 - » An inventor-originated disclosure must have been made prior to the third party’s disclosure, and
 - » Both must have disclosed subject matter X.
- An exception under § 102(b)(1)(A) or § 102(b)(1)(B) may apply when:
 - ◇ The authorship/inventorship of the public disclosure only includes one or more joint inventor(s) or the entire

inventive entity of the application under examination, 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 C.F.R. § 1.77(b)(6). See https://www.uspto.gov/sites/default/files/aia_implementation/2014_aia_fitf_roadshow_slides.pdf

Prior art exceptions under 35 U.S.C. § 102(b)(2)

- § 102(b)(2)(A), § 102(b)(2)(B) and § 102(b)(2)(C) provide exceptions for a disclosure by a third party in a U.S. patent or published application that prevents the disclosure from being used as the basis for rejection.
 - ◇ Disclosure obtained from the inventor - For the § 102(b)(2)(A) exception to apply, the subject matter disclosed by the third party must have been obtained directly or indirectly from the inventor or a joint inventor.
 - ◇ Intervening disclosure by a third party - For the § 102(b)(2)(B) exception to apply:
 - » 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 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.
 - ◇ 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
 - » 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 C.F.R. § 1.77(b)(6). See https://www.uspto.gov/sites/default/files/aia_implementation/2014_aia_fitf_roadshow_slides.pdf
 - ◇ Commonly owned disclosures - For the § 102(b)(2)(C) exception to apply, the subject matter disclosed in the U.S. patent document and the claimed invention 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, and
 - » Not later than the effective filing date of the claimed invention.
 - » A statement is sufficient to invoke the common ownership exception. A declaration is not needed.

The burden of proof in characterizing a reference as prior art

- Unless the record is clear by a preponderance of the evidence that an exception applies, the Examiner must make or maintain any applicable rejection.
- Recall that for § 102(a)(2) prior art, the authorship of the patent reference must be different from the inventorship of the subject application.
 - ◇ **Tip:** the Examiner is looking for references having authorship that does not include all of the inventors and includes at least one author that is not listed as an inventor.

Overcoming a rejection under § 102(a) by filing a declaration under 37 C.F.R. § 1.130

- An applicant may overcome a rejection under § 102(a) by filing a declaration under 37 C.F.R. § 1.130 to invoke a prior art exception under § 102(b).
 - ◇ 37 C.F.R. § 1.130 - "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..."
 - ◇ 37 C.F.R. § 1.130(a) - Affidavit or declaration of attribution
 - » "...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."
 - ◇ 37 C.F.R. § 1.130(b) - Affidavit or declaration of prior public disclosure
 - » "...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.”

- If the prior disclosure is a printed publication, a copy of that disclosure must accompany the declaration.
- If the prior disclosure is not a printed publication, the declaration must describe the subject matter “with sufficient detail and particularity” to determine what subject matter was publically disclosed on that date and by whom.

“That is my/our work!” - invoking an attribution exception using a § 1.130(a) declaration

- § 1.130(a) declarations are used to invoke a § 102(b)(1)(A) or § 102(b)(2)(A) attribution exception, and thereby disqualify a reference as prior art.
- A successful § 1.130(a) declaration must show that the cited reference or subject matter originated with the inventor(s):
 - ◇ It provides an unequivocal statement from the inventor(s) that they invented the subject matter (not necessary if the inventor’s declaration has been filed), and
 - ◇ Provides a reasonable explanation of the presence of authors who are not listed as inventors:
 - » Explain that the disclosure was not by the inventor(s) but the cited subject matter therein was obtained from the inventor(s) (e.g., a collaborator), or
 - » Explain that the non-inventor author(s) were merely working under the direction and supervision of the inventor(s) (i.e., *In re Katz*). 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.

“I/we made it public first!” - invoking an prior (shielding) disclosure exception using a § 1.130(b) declaration

- § 1.130(b) declarations are used to invoke a § 102(b)(1)(B) or § 102(b)(2)(B) prior (shielding) disclosure exception, and thereby disqualify a reference as prior art.
- A successful § 1.130(b) declaration must show that the same subject matter within the cited reference was previously and publicly disclosed in an inventor-originating disclosure. See MPEP 717.01(b)(1). Specifically, it must:
 - ◇ Describe, with sufficient detail and particularity, the subject matter in the inventor-originating prior public disclosure,
 - » **Tip:** A mere statement of “sameness” will not likely be enough. Provide a nexus between the subject matter cited by the Examiner and what was previously disclosed by the inventor. Show specific facts to establish that the potential prior art subject matter disclosed was previously publicly disclosed in an inventor-originated disclosure.
 - ◇ Provide the date of the inventor-originating prior disclosure, and
 - ◇ Be accompanied by a copy of the inventor-originating prior disclosure (if it is a printed publication).
 - ◇ 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).
- The prior, public, inventor-originating disclosure must have disclosed **the same** subject matter to be shielding, and a shielding reference is only effective against that same subject matter.
 - ◇ It is possible that only a portion of a third party’s intervening reference will be disqualified as prior art and that other portions of that same reference may be used.
- What is “the same” subject matter?
 - ◇ A prior disclosure of the claimed species **will** shield a third party disclosure of the genus. However, a prior disclosure of the genus **will not** shield a third party disclosure of the claimed species, unless the claimed species is also disclosed.
 - ◇ A prior inventor disclosure does not disclose the same subject matter if it would only render the cited subject matter obvious. See MPEP 717.01(b)(2).
- Disqualifying prior art under § 102(a)(1) or § 102(a)(2) does not remove that reference from use for other patentability considerations such as 35 U.S.C. §§ 101, 112(a), 112(b) and obviousness-type double patenting.

Formal Requirements of Rule 130 Declarations

- The formal requirements of Rule 130 declarations are the same as pre-AIA requirements.
 - ◇ The declaration must be timely. See MPEP 717.01(f).
 - ◇ The declaration must include the required statements for declarations. See MPEP 717.01(c).

- ◇ If exhibits are included, they must comply with 37 C.F.R. § 1.91.
- ◇ The person who signs the declaration must be someone with knowledge of the facts addressed.
- ◇ The person who files the declaration must be someone who may sign a paper under 37 C.F.R. § 1.33(b) [patent practitioner or applicant].

Remember:

- When a declaration states that a disclosure by another is an inventor-originated disclosure, it must be clear on the record that the subject matter was both obtained from a person named as an inventor and invented by a person named as an inventor. This can be accomplished by
 - ◇ Stating that the declarant is the inventor of the subject matter in the declaration; or
 - ◇ Filing a Rule 63 inventor's declaration naming the declarant as an inventor and signed by the declarant inventor.
 - ◇ An ADS naming the declarant as an inventor is not sufficient.
- For 130(a) declarations:
 - ◇ When the inventor attributes a reference to himself and the reference names someone else in addition to the inventor, a reasonable explanation of the other person's involvement is required. The other person does not need to provide a declaration or statement.
- For 130(b) declarations:
 - ◇ The inventor-originated prior public disclosure must be compared to the potential prior art disclosure, not to the claimed invention.
 - ◇ The examiner should mark the proper box in item 1 on the office action summary sheet and on the Notice of Allowability, to indicate that a Rule 130(b) declaration was filed. This information will also appear on the face of the patent.
- Review of the declarations.
 - ◇ A primary examiner decides whether the declaration is sufficient as to formal matters. If the applicant disagrees with the examiner's opinion, review is by way of a petition under 37 C.F.R. § 1.181.
 - ◇ A primary examiner also decides whether the declaration is sufficient on the merits. If the applicant disagrees with the examiner's opinion, review is by way of an appeal of the rejection to the PTAB.