Affidavit/Declaration - Overview

- Rule 130 Declarations – Used with Terminal Disclaimer in very limited circumstances
- Rule 131 Declarations – To show invention before the §§ 102(a) & (e) reference priority date
- Rule 132 Declarations – Secondary Factors + More
  - Submit evidence of surprising/unexpected results
  - Commercial Success
  - Long-felt need and failure of others, etc.
Declarations - Overview

• Timely submitted, *i.e.*, as early as possible (MPEP § 715.09)
• Written document signed under oath by declarant with personal knowledge of facts
• Careful explanation of facts with no material omissions
• Submitted with supporting documents or exhibits
Rule 130 Declarations

- 37 C.F.R. § 1.130
  - Obviousness-type double patenting rejection over commonly owned patent or published application; and
  - Inventor is the prior inventor of the subject matter in the reference

- Rarely used, requires the Declaration and a Terminal Disclaimer; other options often better
Rule 131 Declarations

102(a) or 102(e)  
Prior Art      Invention

“Swear Behind”

What does “Invention” mean? (e.g., MPEP § 715.07)  
• Reduction to practice  
• Conception + diligence until reduction to practice
Rule 131 Declarations

- “Nexus”: The declaration must tie the claim features to the facts showing prior invention, as evidenced by one or more exhibits.
Conception

- “Formation in the mind … of a definite and permanent idea of the complete and operative invention…”
- Conception must encompass all claimed features.
Conception

• Types of proof of conception (e.g., MPEP § 715.07):
  – Lab notebook
  – Sketches / diagrams
  – Scientific test results (e.g., from lab)
  – Invention disclosure form
  – Draft patent application
  – Contemporaneous email explaining any of the above
Reduction to Practice

- Actual reduction to practice
- Constructive reduction to practice
  - Filing an application that satisfies written description and enablement
  - Relying on 35 U.S.C. § 119 priority claim
- See, e.g., MPEP § 2138.05 for guidance
Diligence

- Working towards either actual or constructive reduction to practice (See MPEP § 2138.06)
Rule 132 Declarations

- Traverse 101 or 112 rejection
- Remove a prior art reference
- Traverse 102 rejection
- Traverse 103 rejection
Removing a Reference

- By showing that portion in reference derives from inventor’s own work
- By showing co-ownership
- By showing a later date of publication, or by showing lack of public availability
Traversing 102 Rejections

- Prior art reference is not enabled
- Alleged inherent disclosure is incorrect
- A claim element is missing from the reference
Traversing 103 Rejections

• No *prima facie* case
• Rebutting *prima facie* case with secondary considerations
Prima Facie Case

• Requires teaching, suggestion, or motivation (or other test) to modify references or combine features (MPEP § 2143.01)
• Requires reasonable expectation of success (MPEP § 2143.02)
• Requires that all elements are disclosed or suggested (MPEP § 2143.03)
• Deficiencies in any of these provide grounds for declaration to show no prima facie case exists
Secondary Considerations

- Must show nexus between merits of claimed invention and secondary considerations (MPEP §716.01(b))
Secondary Considerations

• Surprising and unexpected results
• Commercial success
• Long-felt need and failure of others
• Skepticism of experts
• Copying
Surprising and Unexpected Results

• Results must be surprisingly superior
• Comparison of claimed invention with closest prior art (if feasible)
• Any characteristic flowing from disclosed invention may be suitable
Commercial Success

- Nexus between success and claimed invention
- Market share trend
- Differences between claimed invention and other products on the market
- Pricing / advertising
Long-Felt Need and Failure of Others

- Persistent need over time
- Claimed invention must satisfy the need
- Failed attempts by others to solve the problem
Skepticism of Experts and Copying

• Invention met with initial incredulity
• Copying coupled with failed attempted to develop competing products
• Independent declarant or evidence likely required to best show
• Copying evidence introduces other issues
Risk of Inequitable Conduct

- Misrepresentation or failure to disclose material information
- Intent to deceive
- Results in unenforceability of entire patent
Inequitable Conduct

• Failure to disclose complete testing conditions
• Failure to disclose all test results
• Failure to disclose relationship of declarant to inventor or assignee
Conclusion

• Declarations are useful to overcome rejections; possibly the only option short of appeal
• Declarations must be complete, accurate, and truthful because of heavy reliance by PTO
• Benefit of a declaration often outweighs the risks due to possibly expedited prosecution
Thanks for your attention – Questions?

Jeff Wolfson
202.654.4565
jeff.wolfson@haynesboone.com