Effective Affidavit Practice

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Setting precedent.

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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.*

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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

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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

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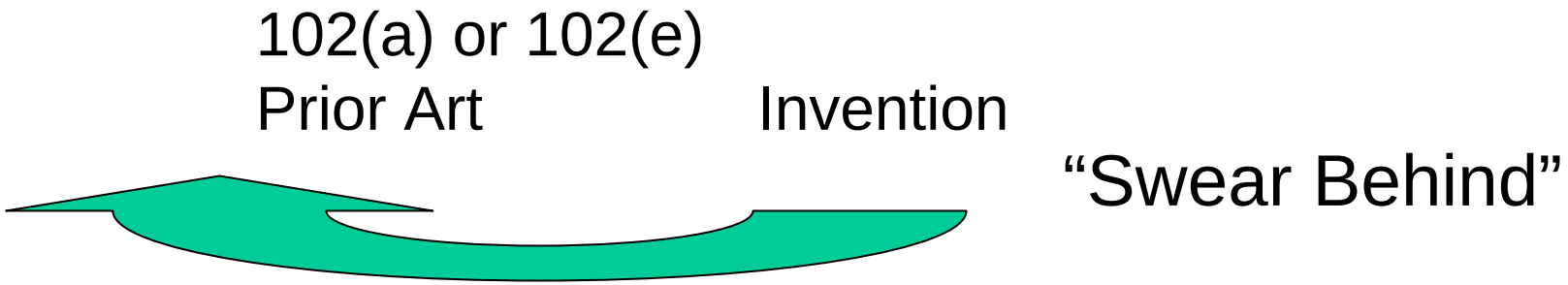
Rule 131 Declarations



What does "Invention" mean? (*e.g.*, MPEP § 715.07)

- Reduction to practice
- Conception + diligence until reduction to practice

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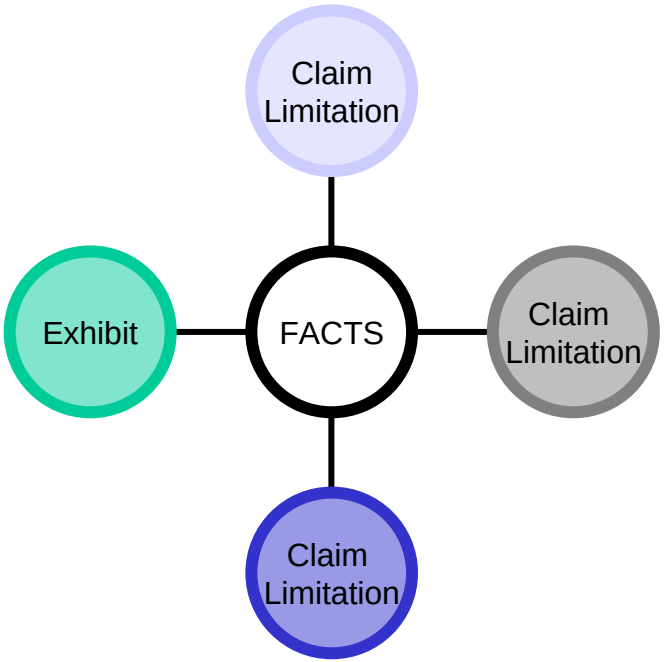
Rule 131 Declarations



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

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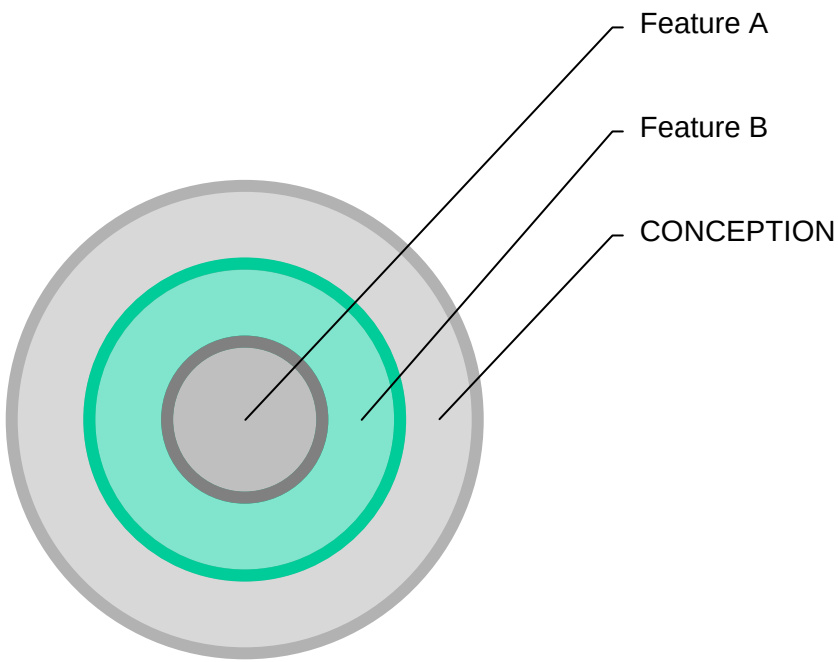
Conception



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

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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

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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

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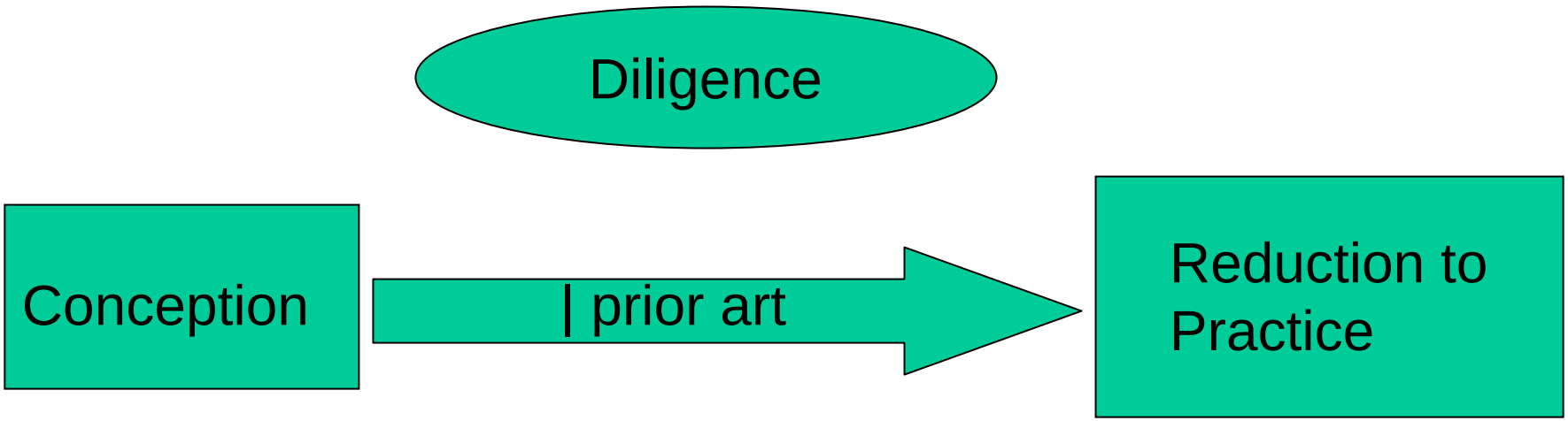
Diligence

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



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Rule 132 Declarations

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

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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

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Traversing 102 Rejections

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

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Traversing 103 Rejections

- No *prima facie* case
- Rebutting *prima facie* case with secondary considerations

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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

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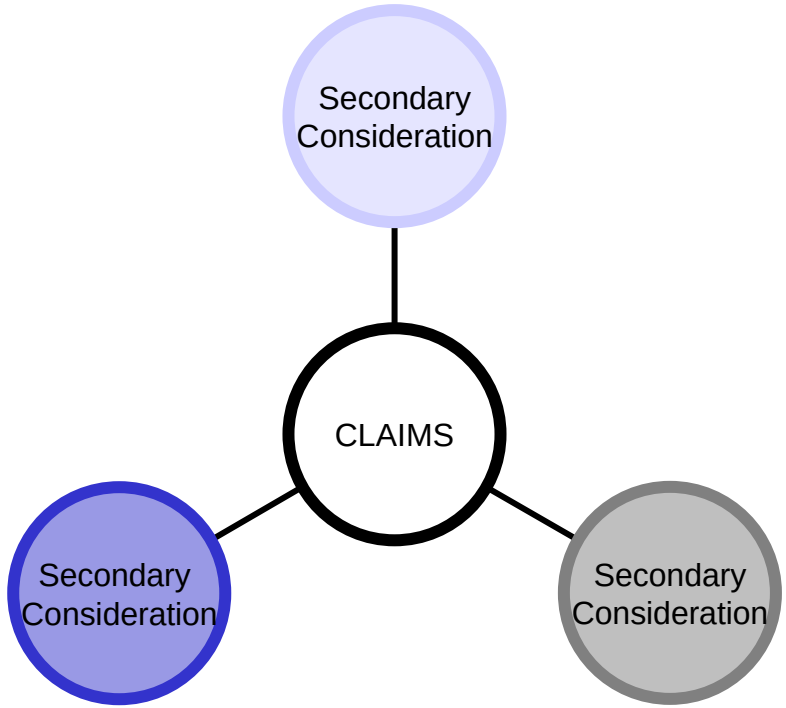
Secondary Considerations

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



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Secondary Considerations

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

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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

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Commercial Success

- Nexus between success and claimed invention
- Market share trend
- Differences between claimed invention and other products on the market
- Pricing / advertising

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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

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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

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Risk of Inequitable Conduct

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

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Inequitable Conduct

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

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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

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Thanks for your attention – Questions?

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